

INVENTION ANALYSIS AND CLAIMING: Amend or Argue — PART II¹



BY RONALD SLUSKY

Ronald Slusky mentored dozens of attorneys in “old school” invention analysis and claiming principles over a 31-year career at Bell Laboratories. He is now in private practice in New York City. This article is adapted from his 2007 book “*Invention Analysis and Claiming: A Patent Lawyer’s Guide*.” Ron’s two-day seminar based on the book will be given this month in **Dallas** and next month in **Washington, D.C.** Ron also offers the seminar on-premises to law firms and in-house patent departments. See www.sluskyseminars.com Ron can be reached at 212-246-4546 and rdslusky@verizon.net.

The accompanying flow diagram presents a systematic approach for determining what’s to be done when a claim is rejected under §102 or §103. There are five options (boxes 12, 14, 16, 18 and 20) when addressing the rejection on the merits, with the choice of option being made based on the answers to four questions (boxes 11, 13, 15 and 17). Another option is to cancel the claim irrespective of the rejection’s merits (box 10).

Last month’s column looked at the options associated with first and second questions (boxes 11 and 13). This month’s column looks at the options associated with the third and fourth questions (boxes 15 and 17).

QUESTION 3: DOES THE CITED PRIOR ART DISCLOSE THE INVENTIVE CONCEPT? (BOXES 15, 16, 18)

Even though a rejected claim reads on the cited prior art, that prior art may be “invention-irrelevant” (see below). Our next topic of inquiry, then, is “Is the cited prior art invention-relevant?” That is, does the cited prior art disclose the inventor’s contribution to the art?

If the answer is “yes,” we will have to swear behind the cited prior art (if we can) if we want to pursue the claim in its present form. This option is further discussed in the next section.

Otherwise, we will have to amend the claim, or, equivalently, to cancel it in favor of a dependent claim that recites the limitations we would have added by amendment. The discussion here assumes that we will amend.

The strategy we use in deciding *how* to amend, however, depends on whether or not the cited prior art is invention-relevant or invention-irrelevant

For example, suppose the inventive concept is mounting a building or other large structure on springs to dampen earthquake vibrations and thereby protect the structure from damage or collapse. The patent application contains the following broad claim to that concept:

1. Apparatus comprising a structure, and one or more springs supporting the structure.

Suppose the examiner finds prior art disclosing the inventor’s teachings. In the face of such *invention-relevant* prior art, claim 1 must be amended to retreat from the originally-staked-out invention boundaries. The inventor and the attorney thought that the naked notion of mounting earthquake-damage-prone structures on springs was new, but that turned out not to be so. Patentability will have to be predicated on at least one fallback feature, such as a unique type of spring that the inventor may have devised for this particular use.

But even if the examiner does not find prior art disclosing the inventive concept, s/he will still be able to reject claim 1 because it reads not only on earthquake-protected buildings but also on such *invention-irrelevant* prior art as pogo sticks, bathroom scales, vibration-damped machinery and all kinds of other spring-mounted “structures” known in the prior art. Here, however, there is no need to retreat to a narrower view of the invention—to fall back—by adding embodiment-detail-type limitations.

Rather, the claim should be amended to more precisely define what was always intended by the term “structure”—buildings and other earthquake-damage-prone structures—thereby preserving coverage for the inventive concept at its (assumedly non-obvious) full breadth while excluding invention-irrelevant prior art like pogo sticks and bathroom scales.

There is a methodological process for determining what limitations should be added to a claim depending on whether the cited prior art is invention-relevant or invention-irrelevant. The process involves the same problem-solution paradigm that we used in drafting the claim in the first instance. We will see in a future column how our spring-mounted-building claim could be amended per that process.

QUESTION 4: DOES THE INVENTION PRE-DATE THE REFERENCE(S)? (BOXES 17, 20)

Pursuant to 37 CFR 1.131 (“Rule 131”), a reference is not citable against an invention if the invention pre-dates the reference and the reference does not give rise to a statutory bar under 35 U.S.C. 102(b). “Pre-dates the reference” means that prior to the effective date of the reference, the inventor a) conceived the claimed subject matter and b) either reduced the invention to practice or was diligent toward that end. Procedurally, the inventor’s dates of conception and reduction to practice are presented in a declaration under Rule 131. The process is referred to as “swearing behind” the reference.

The best practice is to use this option only as a last resort, when no option other than narrowing or canceling the claim is available. As embodied in the flow diagram, then, all of the following should apply before we consider swearing behind a reference:

- a) We have no argument to make for non-obviousness; AND
- b) The claim reads on the cited prior art; AND
- c) The cited prior art is invention-relevant.

Stated in the negative, it is the best practice *not* to swear behind a reference if the cited prior art

- a) Is arguably non-obvious; OR

- b) Does not anticipate the claim; OR
- c) Is not invention-relevant.

We should thus swear behind a reference (assuming the relevant dates allow us to do so) only when a reference or an obvious modification or combination of reference(s) discloses the inventive concept.

There are several reasons for this.

Prior art similar or identical to the cited prior art—but too early to swear behind—may show up after the patent issues. By having sworn behind the cited prior art rather than arguing against it, we will have passed up an opportunity to establish on the record that the examiner ultimately accepted our arguments and agreed that the cited prior art was not obvious or that the claims did not read on it. This can only help strengthen the presumption of validity vis-à-vis similar but too-early-to-swear-behind prior art that may show up downstream.

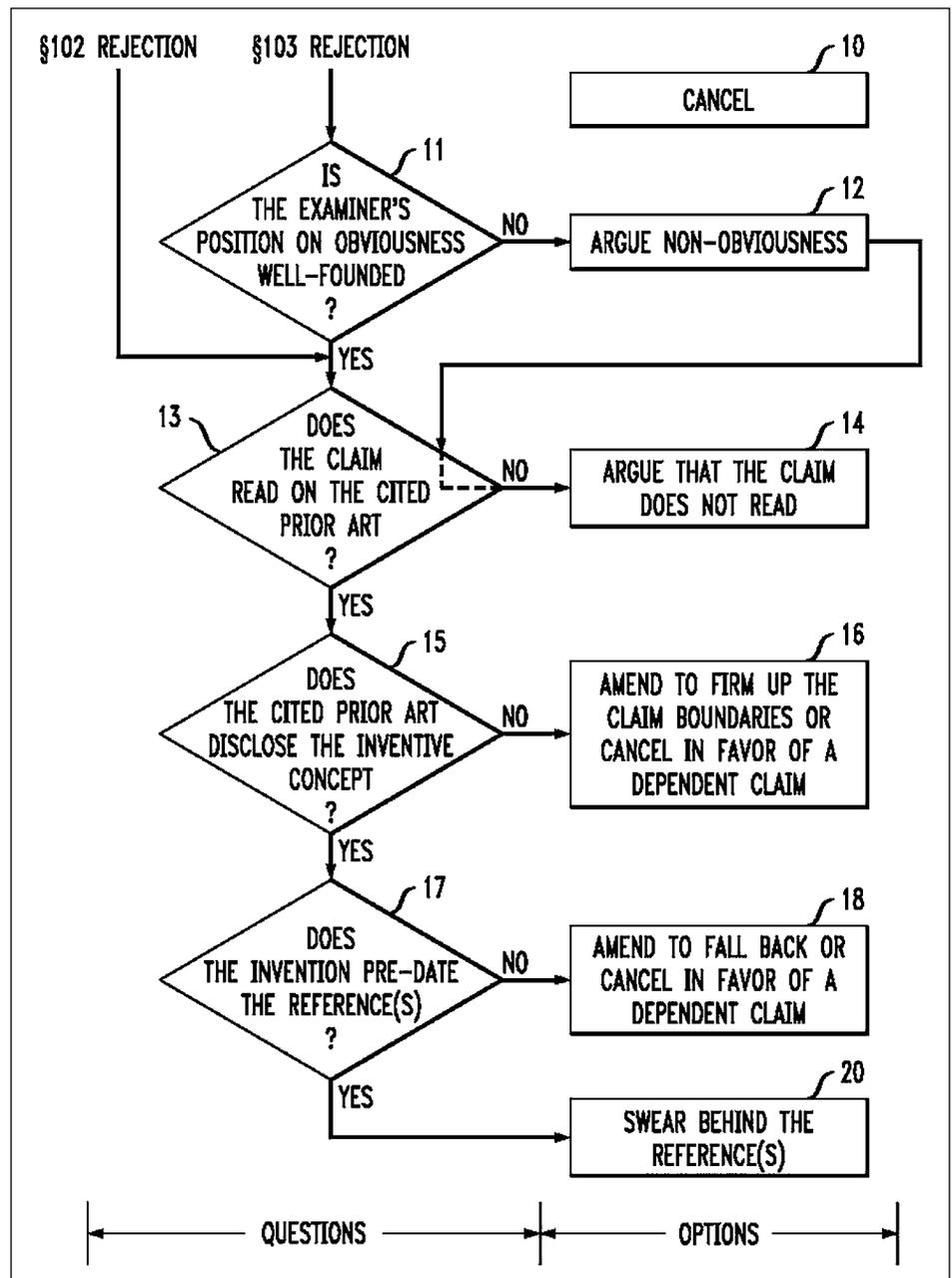
One might think to take a belt-and-suspenders approach, both arguing against rejection on the merits and swearing behind the prior art. But then it will not be clear on the record that the examiner accepted the substantive arguments, as opposed to having simply accepted the Rule 131 declaration. Indeed, the Opposing Team² will argue to the court that the latter was the case. If the examiner is not persuaded by our arguments on the merits, we can consider filing a Rule 131 declaration at *that* time.

Moreover, a claim reading on invention-irrelevant prior art has probably missed the essence of the invention. Such a claim is always in danger of reading on other prior art that is also invention-irrelevant but is too early to swear behind. Thus by simply swearing behind the cited invention-irrelevant prior art we will have passed up the opportunity to improve the claim and, hopefully, distinguish over invention-irrelevant prior art that may turn up only after the patent has issued, when there is little or nothing that can be done about it.

Next month: Be Detailed Where the Invention Lives.

ENDNOTES

1. Copyright © 2007, 2009 American Bar Association. Adapted with Permission. All Rights Reserved.
2. *Intellectual Property Today*, October, 2007.



To subscribe to
Intellectual Property Today
 call 800.232.8078