

Wegner Red Letter

A Monthly Newsletter Looking to What's Next in Patent Law

April 2015



THE PTO *GLOSSARY INITIATIVE*: DISCONNECT WITH THE *RULES OF PRACTICE*

(an excerpt from *PATENT DRAFTING, A Management Guide*)

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§ 830 “Summary of the Invention”, Outdated Office Advice

The *Summary of the Invention* should include a definition of *certain* (but not all) terms used in the claims, while the *Rules of Practice in Patent Cases* says nothing about this key feature of a patent application. At the same time the Agency's leadership, without regard to the existing regime, has started a “pilot” to consider the possibility of an across the board set of definitions in a “glossary”: The Patent Office *Glossary Initiative* represents perhaps the best example of Agency leadership to seeking to (unknowingly) depart from more than a century of practice. Throughout there is an ongoing failure of leadership to understand its own *Rules of Practice in Patent Cases* and its *Manual of Patent Examining Procedure*. *Glossary Initiative*, U.S. Patent and Trademark Office, <http://www.uspto.gov/patent/initiatives/glossary-initiative> (last visited March 27, 2015).

In a nutshell, the Patent Office *Glossary Initiative* seeks to test the waters as to whether a new practice should be introduced to mandate a “glossary” within each patent application to provide a definition of the terms used in the application. To be sure, the *Summary of the Invention* should be a fixture of every patent application and *should* include a definition of a term at the point of novelty to cabin the “broadest reasonable interpretation” rule of claim construction at the Patent Trial and Appeal Board.



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But, in the Patent Office guidance on the *Summary of the Invention*, there is no mention of a such a definitional section to deal with cabining the “broadest reasonable interpretation rule”.

Instead, the *Rules of Practice in Patent Cases* focuses upon a disclosure of the “nature of the invention”, an archaic nineteenth century statutory provision grounded in the Patent Act of 1836 but eliminated from the patent law more than sixty (60) years ago.

This present discussion first provides a consideration of what *should* be contained in a proper *Summary of the Invention* and then discusses the guidance the Patent Office provides in its *Rules of Practice of Patent Cases* and *Manual of Patent Examining Procedure*.

§ 831 Patent Office Rule 73 and MPEP 608.01(d)

Even today, more than sixty years since a relevant statutory change, the official *Manual* guidance on how to draft a Summary of the Invention quotes the *Rules of Practice in Patent Cases* for the proposition that the “summary of the invention [should indicate] its nature ***, which may include a statement of the object of the invention[.]” MPEP 608.01(d), *Brief Summary of Invention* (quoting 37 C.F.R. 1.73, *Summary of the invention*)(emphasis added).



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More completely, the paragraph from which this statement was excerpted reads (with emphasis added):

“A brief summary of the invention indicating its *nature and substance*, which may include a statement of the *object of the invention*, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.”

Nature of the invention? Substance of the invention?

“Object” of the invention?

The *Manual* further states:

“Since the purpose of the brief summary of invention is to apprise the public, and more especially those interested in the particular art to which the invention relates, of the nature of the invention, the summary should be directed to the specific invention being claimed, in contradistinction to mere generalities which would be equally applicable to numerous preceding patents. That is, the subject matter of the invention should be described in one or more clear, concise sentences or paragraphs. ***

“The brief summary, if properly written to set out *the exact nature, operation, and purpose of the invention*, will be of material assistance in aiding ready understanding of the patent in future searches. The brief summary should be more than a mere statement of the objects of the invention, which statement is also permissible under 37 CFR 1.73.”

MPEP 608.01(d), *Brief Summary of Invention* (emphasis added).



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§ 832 What the *Manual* Should (but doesn't) Require

Before considering what the *Manual* should *not* say, it is important to note what the *Manual* itself *does not* say about the content of a *Summary of the Invention*. Each of the following points *should be* in the *Manual* to reflect case law decisions over the past several decades. The absence of these features manifests a failure to update the *Manual*:

Thus, the Patent Office rule nowhere says that the *Summary of the Invention* *should contain* a verbatim recitation of claim language, *should contain* exemplification of alternate elements where an element in the claims has a limited disclosure, and *should contain* an express definition at the point of novelty, particularly as a way to cabin the “broadest reasonable interpretation” of the claims.

None of these important elements for a *Summary of the Invention* is housed within Rule 73.



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§ 832[a] Verbatim Recitation of the Claim Language

There are several key requirements for an optimum *Summary of the Invention* outlined earlier in this book. See § 510, “*Summary of the Invention*”, a *Definitional Section*, noting that a verbatim restatement of the features of the *claimed* invention should be provided; see also § 331, *A Verbatim Copy of the Claims*, and, particularly, § 511, *The Summary Should Mirror the Language of “Claim 1”*.

§ 832[b] Exemplification of Claim Elements

Where an element of a claim is performed with reference to only a single feature representing that element without setting forth plural features, case law has in some instances interpreted the element as limited to the single feature; here, the *Summary* should include *alternate* examples to ensure a broad scope of protection. See § 512, *Exemplifications to Provide “Written Description” Support* (discussing *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed.Cir.2005); *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed.Cir.2001)).



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§ 832[c] Cabining the “Broadest Reasonable Interpretation”

The Patent Office rule for claim construction at the Patent Trial and Appeal Board gives all terms their “broadest reasonable interpretation”. This can be mitigated by an express definition of a term in the *Summary of the Invention*. An otherwise ambiguous term at the point of novelty should be expressly defined in the *Summary of the Invention* to trump the “broadest reasonable interpretation” rule.

Thus, in order to avoid an unfettered “broadest reasonable interpretation” claim interpretation at the Patent Office, it is important that there is a *specific definition* of the critical terminology, as explained in *In re Buszard*, 504 F.3d 1364 (Fed. Cir. 2007); *In re Paulsen*, 30 F.3d 1475 (Fed. Cir. 1994)(Lourie, J.); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995)(en banc)(Archer, C.J.), *aff'd*, 517 U.S. 370 (1996); and *Saffran v. Johnson & Johnson*, ___ F.3d ___ (Fed. Cir., 2013)(O’Malley, J., concurring in part).

"Claims are generally given their 'broadest reasonable interpretation' *consistent with the specification* during reexamination." *In re Cuozzo Speed Technologies, LLC*, ___F.3d ___ (Fed. Cir. 2015)(Dyk, J.)(emphasis added)(quoting *In re Rambus, Inc.*, 753 F.3d 1253, 1255 (Fed. Cir. 2014)); *see also Oracle America, Inc. v. Google, Inc.*, ___Fed. App’x __, ___ (Fed. Cir. 2015)(O’Malley, J.)(quoting *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984))("Although claims are given



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their ‘broadest reasonable construction’ on reexamination, that construction must be ‘consistent with the specification.’). As explained by the *en banc* Court in *In re Etter*, 756 F.2d 852 (Fed. Cir. 1985)(*en banc*)(Markey, C.J.): “[T]his court [in *Yamamoto*] said that claims subject to reexamination will ‘be given their broadest reasonable interpretation *consistent with the specification* ***.” *Etter*, 756 F.2d at 858 (quoting *Yamamoto*, 740 F.2d at 1571)(emphasis added) .

As explained by Chief Judge Prost, “if an applicant wants a claim term [in reexamination] to have a specific meaning, the applicant can *** *provide an express definition for the claim term in the specification*. See [*In re Yamamoto*, 740 F.2d 1569, 1571-72 (Fed.Cir.1984)](noting that an applicant can overcome a rejection by amending the claim language); [*In re Morris*, 127 F.3d 1048, 1054 (Fed.Cir.1997)] (noting that the PTO must take into account definitions contained in the specification when interpreting claim language).” *Buszard*, 504 F.3d at 1358(Prost, J., dissenting)(emphasis added).

“If the patentee wishes to rely upon a particular definition for interpretation of his patent, it is important that a *specific definition* be provided in the specification: “Although an inventor is indeed free to define the specific terms used to describe his or her invention, this must be done with reasonable clarity, deliberateness, and precision. ‘Where an inventor chooses to be his own lexicographer and to give terms uncommon meanings, he must set out his



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uncommon definition in some manner within the patent disclosure' so as to give one of ordinary skill in the art notice of the change. See *Intellicall, Inc., v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88 (Fed.Cir.1992).” *Paulsen*, 30 F.3d at 1480.

As explained by Chief Judge Archer:

“[Federal Circuit] cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs. See *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir.2002).” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005)(en banc)(Bryson, J.). Thus, a patentee is free to be his own lexicographer. *Autogiro [Co. of America v. United States]*, 384 F.2d 391, 397 (1967)]. The caveat is that any special definition given to a word must be clearly defined in the specification. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388, 21 USPQ2d 1383, 1386 (Fed. Cir.1992).”

Markman, 52 F.3d at 980.



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Circuit Judge O'Malley stresses the point that there should be a specific definition if the applicant's definition is to trump the otherwise broadest reasonable interpretation:

To find a special definition mandated by the written description, a term must be 'clearly' redefined, and an 'express intent' to do so must be evident from the patent. See *Elekta Instrument S.A. v. O.U.R. Scientific Int'l, Inc.*, 214 F.3d 1302, 1307 (Fed. Cir. 2000) ('While we have held many times that a patentee can act as his own lexicographer to specifically define terms of a claim contrary to their ordinary meaning, the written description in such a case must clearly redefine a claim term so as to put a reasonable competitor or one reasonably skilled in the art on notice that the patentee intended to so redefine that claim term.

Absent an express intent to impart a novel meaning, claim terms take on their ordinary meaning.')(citations and internal quotation marks omitted); see also *Edwards Lifesciences LLC v. Cook Inc.*, 582 F.3d 1322, 1329 (Fed. Cir. 2009) ('Similarly, we will adopt a definition that is different from the ordinary meaning when the patentee acted as his own lexicographer and clearly set forth a definition of the disputed claim term in either the specification or prosecution history.')(internal quotation marks omitted); *Cannon Rubber Ltd. v. The First Years, Inc.*, 163 F. App'x 870, 875 (Fed. Cir. 2005) ('These two cited instances, however, do not clearly indicate that the patentee intended to assign a more narrow definition to the phrase 'in the body' than it would otherwise possess.').

Saffran v. Johnson & Johnson , ___ F.3d at ___(O'Malley, J., concurring in part).



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§ 833 The “Nature of the Invention” Rule

While there is no rule mandating a definitional section in the *Summary of the Invention*, there is a rule even today that mandates a disclosure of the “nature of the invention:

There is no better example of a provision in the first edition that was proper at the time that *remains* today – even in the Rules of Practice of Patent Cases – when long overruled either by statutory enactment or case law. The *Manual of Patent Examining Procedure* through its numerous revisions dating back to the original 1949 first edition provides a snapshot of the failure of the Office to update its guidance to keep in tune with statutory changes:

§ 833[a] The 1949 First Edition Correctly Cited the “Nature” Rule

The original 1949 edition of the *Manual* includes a quotation from the Rules of Practice:

Summary of the Invention. A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

§ 608.01(d), *General Statement of Invention* (quoting Rule 73)(Original 1949 edition).



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By 1961, the *same Rule 73* is recited in the same section of the *Manual* (since retitled as *Brief Summary of the Invention*). In addition, the following statement has been added to the *Manual*:

“[T]he purpose of the brief summary of invention is to apprise the public ... of the nature of the invention[.] ***

The brief summary, if properly written to set out the exact nature, operation and purpose of the invention will be of material assistance in aiding ready understanding of the invention in future searches. See [§] 905.04. ***

The brief summary of invention should be consistent with the subject matter of the claims. ***

MPEP § 608.01(d), *Brief Summary of the Invention* (Third edition 1961).

§ 833]b] Early Statutory Origins for the “Nature” Requirement

A “correct[]” indication of an invention’s “nature” and “design” was introduced as a statutory requirement of the 1836 patent law as a codification of the case law interpretation of the 1793 Patent Act as explained in *Hogg v. Emerson*, 47 U.S. (6 How.) 437 (1848)(Woodbury, J.).



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As explained in the Curtis treatise, the 1836 patent law made it a statutory requirement that a patent “shall contain a short description * * * of the invention * * *, correctly indicating [the] nature and design [of the invention.]” George Ticknor Curtis, *A Treatise on the Law of Patents for Useful Inventions*, §221, p. 251 n.3 (Boston: Little, Brown, and Company 1873 (4th ed.))(citing *Hogg v. Emerson*, 47 U.S. (6 How.) at 482, and quoting from The act of Congress of July 4, 1836, c. 357, § 6: “[E]very patent shall contain a short description or title of the invention or discovery, correctly indicating its nature and design[.]”).

The page cited by *Curtis* from *Hogg v. Emerson* puts the 1836 statutory origin of the requirement for a disclosure of the “nature and design” of the invention in perspective as part of the evolution of the requirements to define the invention:

“[T]he revising act as to patents, in July 4th, 1836, changed the phraseology of the law in this respect, in order to conform to this long usage and construction under the act of 1793, and required not in terms any abstract of the petition in the patent, but rather 'a short description' or title of the invention or discovery, 'correctly indicating its *nature and design*,' and 'referring to the specification for the particulars thereof, a copy of which shall be annexed to the patent.' And it is that—the specification or schedule—which is fully to specify 'what the patentee claims as his invention or discovery.' Sec. 5. (5 Statutes at Large, 119.)



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It was, therefore, from this long construction, in such various ways established or ratified, that, in the present patent, the schedule, or, in other words, the specification, was incorporated expressly and at length into the letters themselves, not by merely annexing them with wafer or tape, as is argued, but describing the invention as an 'improvement, a description whereof is given in the words of the said John B. Emerson himself, in the schedule hereto annexed, and is made a part of these presents.' Hence, too, wherever this form has been adopted, either before or since the act of 1836, it is as much to be considered with the letters,— literae patentees, — in construing them, as any paper referred to in a deed or other contract. Most descriptions of lands are to be ascertained only by the other deeds and records expressly specified or referred to for guides; and so of schedules of personal property, annexed to bills of sale. *Foxcroft v. Mallett*, 4 How. 378; 21 Maine, 69; 20 Pick. 122; Phil. on Pat. 228; *Earle v. Sawyer*, 4 Mason, C. C. 9; *Ex parte Fox*, 1 Ves. & Beames, 67. The schedule, therefore, is in such case to be regarded as a component part of the patent. Peters, C. C. 394, and *Davis v. Palmer et al.*, 2 Brockenbrought, 301.

Hogg v. Emerson, 47 U.S. (6 How.) at 482 (emphasis added).

Prior to the reference in *Hogg v. Emerson* to the “nature of the invention” quoted above, the earlier history of the patent law and practice in both England and the United States is explained:

[T]he improvement referred to in the writ and in the letters-patent [in the current case], with the schedule or specification annexed, was in truth one and the same.

Coupling the two last together, they constitute the very thing described in the writ. But whether they can properly be so united here, and the effect of it to remove the difficulty, have been questioned, and must therefore be further examined. We are apt to be misled, in this country, by the laws and forms bearing on this point in England being so different in some respects from what exist here.



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[T]he patent [as] first issued... contains no reference to the specification, except a stipulation that one shall, in the required time, be filed, giving a more minute description of the matter patented. (Webster on Pat. 5, 88; Godson on Pat. 6, App.) It need not be filed under two to four months, in the discretion of the proper officer. (Godson on Pat. 176.)

Under these circumstances, it will be seen that the patent, going out alone there, must in its title or heading be fuller than here, where it goes out with the minute specification. But even there it may afterwards be aided, and its matter be made more clear, by what the specification contains. They are, says Godson on Pat. 108, 'connected together,' and 'one may be looked at to understand the other.' See also 2 Hen. Bl. 478; 1 Webst. Pat. R. 117; 8 D. & E. 95.

There, however, it will not answer to allow the specification, filed separately and long after, to be resorted to for supplying any entire omission in the patent; else something may be thus inserted afterwards which had never been previously examined by the proper officers, and which, if it had been submitted to them in the patent and examined, might have prevented the allowance of it, and which the world is not aware of, seeing only the letters-patent without the specification, and without any reference whatever to its contents. 3 Brod. & Bingh. 5.

The whole facts and law, however, are different here. This patent issued March 8th, 1834, and is therefore to be tested by the act of Congress then in force, which passed February 21st, 1793. (1 Statutes at Large, 318.)



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In the third section of that act it is expressly provided, 'that every inventor, before he can receive a patent,' 'shall deliver a written description of his invention,' &c.;—thus giving priority very properly to the specification rather than the patent.

This change from the English practice existed in the first patent law, passed April 10th, 1790 (1 Statutes at Large, 109), and is retained in the last act of Congress on this subject, passed July 4th, 1836 (5 Statutes at Large, 119).

It was wisely introduced, in order that the officers of the government might at the outset have before them full means to examine and understand the claim to an invention better, and decide more judiciously whether to grant a patent or not, and might be able to give to the world fuller, more accurate, and early descriptions of it than would be possible under the laws and practice in England.

In this country, then, the specification being required to be prepared and filed before the patent issues, it can well be referred to therein in extenso, as containing the whole subject-matter of the claim or petition for a patent, and then not only be recorded for information, as the laws both in England and here require, but beyond what is practicable there, be united and go out with the letters-patent themselves, so as to be sure that these last thus contain the substance of what is designed to be regarded as a portion of the petition, and thus exhibit with accuracy all the claim by the inventor.

But before inquiring more particularly into the effect of this change, it may be useful to see if it is a compliance with the laws in respect to a petition which existed when this patent issued, but were altered in terms shortly after.



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A petition always was, and still is, required to be presented by an inventor when he asks for a patent, and one is recited in this patent to have been presented here. It was also highly important in England, that the contents of the petition as to the description of the invention should be full, in order to include the material parts of them in the patent, no specification being so soon filed there, as here, to obtain such description from, or to be treated as a portion of the petition, and the whole of it sent out with the patent, and thus complying with the spirit of the law, and giving fuller and more accurate information as to the invention than any abstract of it could.

In this view, and under such laws and practice here, it will be seen that the contents of the petition, as well as the petition itself, became a very unimportant form, except as construed to adopt the specification, and the contents of the latter to be considered substantially as the contents of the former.

Accordingly, it is not a little curious, that, though the act of 1793, which is to govern this case, required, like that of 1790, a petition to be presented, and the patent when issued, as in the English form, to recite the 'allegations and suggestions of the petition,' (1 Statutes at Large, p. 321, sec. 1, and p. 110, sec. 3,) yet, on careful inquiry at the proper office, so far as its records are restored, it appears that, after the first act of 1790 passed, the petitions standing alone seldom contained any thing as to the patent beyond a mere title; sometimes fuller, and again very imperfect and general, with no other allegations or suggestions, or descriptions whatever, except those in the schedule or specification. The only exception found is the case of *Evans v. Chambers*, 2 Wash. C. C. 125, in a petition filed December 18th, 1790.



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Though the records of the patent-office before 1836 were consumed [by the fire in the Patent Office] in that year, many have been restored, and one as far back as August 10th, 1791, where the petition standing alone speaks of having invented only 'an easy method of propelling boats and other vessels through the water by the power of horses and cattle.' All the rest is left to the schedule. Other petitions, standing alone, are still more meagre; one, for instance, in 1804, asks a patent only of a 'new and useful improvement, being a composition or tablets to write or draw on'; another, only 'a new and useful improvement in the foot-stove'; and another, only 'a new and useful improvement for shoemaking'; and so through the great mass of them for nearly half a century. But the specification being filed at the same time, and often on the same paper, it seems to have been regarded, whether specially named in the petition or not, as a part of it, and as giving the particulars desired in it; and hence, to avoid mistakes as to the extent of the inventor's claim, and to comply with the law, by inserting in the patent at least the substance of the petition, the officers inserted, by express reference, the whole descriptive portion of it as contained in the schedule. This may have grown out of the decision of *Evans v. Chambers*, in order to remedy one difficulty there. Cases have been found as early as 1804, and with great uniformity since, explicitly making the schedule annexed a part of the letters-patent. Proofs of this exist, also, in our reports, as early as 1821, in *Grant et al. v. Raymond*, 6 Peters, 222; and one, 1st Oct., 1825, in *Gray et al. v. James et al.*, Peters, C. C. 394; and 27 Dec. 1828, *Wilson v. Rousseau*, 4 How. 649.

Indeed, it is the only form of a patent here known at the patent-office, and the only one given in American treatises on patents. Phillips on Pat. 523. Doubtless this use of the schedule was adopted, because it contained, according to common understanding and practice, matter accompanying the petition as a part of its substance, and all the description of the invention ever desired either in England or here in the petition. Hence it is apparent, if the schedule itself was made a part of



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the patent, and sent out to the world with it, all, and even more, was contained in it than could be in any abstract or digest of a petition, as in the English form.

Hogg v. Emerson, 47 U.S. (6 How.) at 478-81.

The importance of the specification to interpret the scope of the patent right was emphasized by Justice Woodbury:

[W]hen we are called upon to decide the meaning of the patent included in these letters, it seems our duty not only to look for aid to the specification as a specification, which is customary, (1 Gall. 437; 2 Story, R. 621; 1 Mason, C. C. 477,) but as a schedule, made here an integral portion of the letters themselves, and going out with them to the world, at first, as a part and parcel of them, and for this purpose united together for ever as identical.

It will thus be seen, that the effect of these changes in our patent laws and the long usage and construction under them is entirely to remove the objection, that the patent in this case was not as broad as the claim in the writ, and did not comply substantially with the requirements connected with the petition.

From want of full attention to the differences between the English laws and ours, on patents, the views thrown out in some of the early cases in this country do not entirely accord with those now offered. Paine, C. C. 441; *Pennock et al. v. Dialogue*, 2 Pet. 1. Some other diversity exists at times, in consequence of the act of 1793, and the usages under it in the patent-office, not being in all respects as the act of 1836. But it is not important, in this case, to go farther into these considerations.

Hogg v. Emerson, 47 U.S. (6 How.) at 478-81.



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§ 833[c] The 1870 Law Mandating Claims to Define the Invention

Perhaps the “nature” of the invention disclosure requirement made sense in the early to mid-nineteenth century when claims were not mandatory as the definition of the invention. But, in the 1870 law that made the patent claim the mandatory feature to define the invention, the now-anachronistic “nature of the invention” requirement was maintained: “[E]very patent shall contain a short title or description of the invention or discovery, correctly indicating its *nature and design....*” *Long v. Rockwood*, 277 U.S. 142, 146 (1928)(McReynolds, J.)(quoting Chapter 230, Act July 8, 1870, 16 Stat. 201 (Rev. Stat. § 4884; section 40, Title 35, U. S. Code (35 USCA § 43; Comp. St. § 9428)).

§833[d] Definition of Infringement in the 1952 Patent Act

As explained in the *Aro* case, the 1952 Patent Act provided an express statutory definition of infringement as 35 USC § 271(a). *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 350 n.5 (1961). Regarding prior law, the Court in *Aro* explained that:

Although there was no statutory provision defining infringement prior to [the 1952 Patent Act], the definition [of infringement] adopted is consonant with the long-standing statutory prescription of the terms of the patent grant, which was contained in § 4884 of the Revised Statutes as follows:

“Every patent shall contain a short title or description of the invention or discovery, *correctly indicating its nature and design*, and a grant to the patentee *



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* * of the exclusive right to make, use, and vend the invention or discovery throughout the United States * * *” (Emphasis supplied [by the Court].)

This provision is now contained without substantial change in 35 U.S.C. § 154, 35 U.S.C.A. § 154.

Aro, 365 U.S. at 350 n.5 (emphasis supplied in part by the Court and by this writer).

Quoting the words of the late Pasquale J. Federico, up through the eve of the effective date of the 1952 Patent Act, the statute required “a ... description of the invention ... correctly stating its nature and design.” P. J. Federico, *Commentary on the New Patent Act* [1954], reproduced at 75 J. Pat. And Trademark Off. Soc’y

But, the statutory basis for the “nature” and “design” disclosure requirement ceased with the effective date of the 1952 Patent Act: “The old statute [before the 1952 Patent Act] required ‘a short title or description of the invention or discovery, correctly stating its nature and design’; this has been shortened to ‘a short title of the invention’ since the title is of no legal significance.” *Id.*



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About this Paper

This paper is reproduced from the current version of § 830, “*Summary of the Invention*”, *Outdated Office Advice*, taken from the author’s work in progress, *PATENT DRAFTING: A Management Guide for Original Application Draftsmanship under the New Patent Law*, scheduled for publication in 2016.

The first seven chapters of the book focus on the practical aspects of how to draft a patent application. Because there are so many areas of Patent Office guidance that are *incorrect* or outdated, a special chapter has been included at the end to analyze such areas, § 800, *The Manual of Patent Examining Procedure (MPEP)*. The section reproduced, here, is just one of several major areas where the Office comes up short with its guidance for patent applicants.



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