

“ESSENCE” OF THE INVENTION, BUT WHY NOT THE CLAIMS?*

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I. OVERVIEW

Determining the “essence” of an invention has been superseded since the nineteenth century creation of a system of patent claims to define an invention.

It is now 180 years since the Patent Act of 1836 which introduced claims in patents and approaching 150 years since the primacy of claiming was firmly established in the Patent Act of 1870. *Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc.*, 62 F.3d 1512, 1526 (Fed. Cir. 1995), *subsequent proceedings*, *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997)(“The claiming requirement ... was contained in the Patent Act of 1870 (‘[B]efore any inventor or discoverer shall receive a patent ... he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery....’); see also Patent Act of 1836 (requiring inventor to ‘particularly specify and point out the part ... which he claims’).” (citations omitted). See § II, “*The Name of the Game is the Claim.*”

* This paper is adapted from a monograph now in the process of final editing, Wegner, *First to File Patent Drafting* (2016), § 8[d], “*Essence*” of the *Invention*. © MMXVI Harold C. Wegner

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Thus, once there was a well established regime of claims to define the scope of protection, there was no longer room to speak of the “essence” of an invention. Yet, even today as exemplified by *Secure Web Conference Corp. v. Microsoft*, ___ Fed App’x ___ (Fed. Cir. 2016)(Stoll, J.), jurists have used a determination of “essence” of an invention to twist the meaning of claim language: “We are mindful not to limit claims to preferred embodiments, but in this case, *** [the drawings] depict the essence of the claimed invention rather than a preferred embodiment.” See § III, *Claims Trump the “Essence” of the Invention*. For the most part, the Federal Circuit has done a satisfactory job of putting to bed anachronisms of the patent law, but as seen from *Secure Web Conference v. Microsoft*, anachronisms continue even today. See § IV, *An Anachronism that Continues Today*.

II. “THE NAME OF THE GAME IS THE CLAIM”

It is wrong to define the invention in terms of an “essence” of the invention. The invention is what is *claimed*: There is no room to refer to some “essence” based upon the specification. As stated by the late Giles Sutherland Rich, “the name of the game is the claim.” Giles S. Rich, *The Extent of the Protection and Interpretation of Claims—American Perspectives*, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499, 501 (1990). Yet, even today, as seen from *Secure Web Conference Corp. v. Microsoft*, there are still references to definition of an invention in terms of its “essence” such as where claims are narrowed within their literal scope based upon a determination that the “essence” is what is disclosed in the specification even though not a stated limitation to the claims.

III. CLAIMS TRUMP THE “ESSENCE” OF THE INVENTION

“Reliance on a finding that a ‘novel element’, or ‘essence’ (or ‘gist’, or ‘key’) of a structural invention lies in the operation of a specification-described embodiment of the claimed structure would render meaningless the statutory requirement for claiming, 35 U.S.C. Sec. 112[.]” *SRI Intern. v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1128 n.7 (Fed. Cir. 1985)(en banc)(Markey, C.J., joined by P. Newman, J., additional views); *see also Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 949 (Fed. Cir. 1987)(en banc)(Nies, J., additional views)(“It is axiomatic under our precedent that one cannot obtain patent protection for an *inventive concept* or for the *heart* or ‘*essence*’ of an invention or for an achieved result. ...”).

It is an anachronism to refer to the “essence of the invention” when what is at stake is whatever is *claimed* as the invention. References to the “essence” of the invention were made in cases long pre-dating the system of patent claims to define the invention and may be traced back as early as 1814. *See Hilton Davis*, 62 F.3d at 1563(Nies, J., dissenting, joined in part by Archer, C.J.)(citing *Odiorne v. Winkley*, (No. 10,432) 18 F.Cas. 581 (C.C.Mass. 1814)(Story, J.)(Historically, “[o]ne who used the ‘essence’ of the invention was an infringer.”).

IV. AN ANACHRONISM THAT CONTINUES TODAY

The Supreme Court continued to refer to the “essence” of the invention up through cases early in the twentieth century. *The Telephone Cases, Dolbear v. American Bell Tel. Co.*, 126 U.S. 1, 573 (1888)(Bradley, J., joined by Field, Harlan, JJ., dissenting)(“The essence of the invention claimed by Mr. Bell is the transmission of articulate speech to a distance, by means of an electrical current subjected to undulations produced by the air vibrations of the voice.”); *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 416 (1901)(“The essence of the invention lies in the fact that the tip is so regulated by a stop that the reservoir can never be wholly emptied[.]”); *Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 422 (1908)(“The claim is not for a function, but for mechanical means to bring into working relation the folding plate and the cylinder. This relation is the very essence of the invention, and marks the advance upon the prior art.”).

Even today, despite the fact that it is what is *claimed* that is at stake – as opposed to an “essence” of the invention, recent case law has shaped the scope of protection by reference to the “essence” of the invention. *Secure Web Conference v. Microsoft*, quoted at the outset of this paper, does not stand alone. *See, e.g., Invitrogen Corp. v. Clontech Laboratories, Inc.*, 429 F.3d 1052, 1064 (Fed. Cir. 2005)(Gajarsa, J.) (quoting *Heard v. Burton*, 333 F.2d 239, 240 (CCPA 1964))(“The ‘essence of the invention’ was ‘using eta-aluminum, a specific type of hydrated aluminum oxide, as support material for platinum’ in a reforming process in which the platinum-alumina combination served as a catalyst.”); *Boehringer Ingelheim v. Schering-Plough Corp.*, 320 F.3d 1339, 1343 (Fed. Cir. 2003)(Clevenger, J.)(“[A]s we explained in *Griffin v. Bertina*, 285 F.3d 1029

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(Fed.Cir.2002), preamble language will limit the claim if it recites not merely a context in which the invention may be used, but *the essence of the invention* without which performance of the recited steps is nothing but an academic exercise. *Id.* at 1033.”)(emphasis added); *Ventana Medical Systems v. Biogenex Laboratories*, 473 F.3d 1173, 1185 (Fed. Cir. 2006)(Lourie, J., dissenting)(“Those statements *** describe the essence of the invention[.]”).

Case law from the first decade of existence of the Federal Circuit had shown the limited role for a consideration of an invention’s “essence”.

As stated in *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1533 n.8 (Fed. Cir. 1987)(Markey, C.J.):

“In determining priority of invention, consideration of the ‘gist’ or ‘essence’ of the invention may be appropriate. See, e.g., *Stansbury v. Bond*, 482 F.2d 968, 974 (CCPA 1973); *McCutchen v. Oliver*, 367 F.2d 609, 611 (CCPA 1966); *Hall v. Taylor*, 332 F.2d 844, 848 (CCPA 1964). We are aware of dicta that state consideration of the ‘essence’, ‘gist’, or ‘heart’ of the invention may be helpful in determining infringement under the doctrine of equivalents. *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861 (Fed.Cir.1985); *Atlas Powder Co. v. E.I. Du Pont De Nemours & Co.*, 750 F.2d 1569, 1582 (Fed.Cir.1984) (both citing *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567 (Fed.Cir.1983). That dicta may not be read as implying that specific claim limitations can be ignored as insignificant or immaterial in determining infringement. It must be read as shorthand for the considerations set forth in *Graver Tank*, i.e., that the infringer should not appropriate the invention by making substitutions for those limitations, when the substitutions do not substantially change the function performed, or the way it is performed, by the invention.”.

In *Coleman v. Dines*, 754 F.2d 353, 354 (Fed. Cir. 1985)(Davis, J.), the court had said that “it is the selection and discovery of compounds having the necessary combination of volatility and vibrational sensitivities which is the ‘essence of the invention.’”.

V. CONCLUSION

The Federal Circuit bears a special responsibility to properly deal with patent law doctrines without resort to anachronisms in statutory scheme: We are now far removed from the nineteenth century evolution of the primacy of claims to define the scope of protection for a patent.