

FIRST TO FILE PATENT DRAFTING

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An Excerpt (pp. 189-193):

§ 8. Elements that Should NOT be in a First Filing

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Second, the technical field need not be stated in the case of “an entirely new conception[.]” *Id.* (“[But], ... in cases where the invention does not pertain to existing technical fields such as an invention developed based on an entirely new conception which is completely different from prior art, it suffices [insofar as the requirement for the technical field to which an invention pertains] that the statement[] of the new technical field developed by the invention be provided and an application for such an invention does not need to state the existing technical fields.”)

§8[d] “Essence” of the invention

Prior to 1870 the United States did not require formal claims to define the scope of protection, although earlier in 1836 a system of claims had been introduced. During this earlier period, instead of speaking of the “claimed invention” as today, one spoke of “the essence of the invention”. In other words, the definition of the invention was originally defined as “the essence of the invention” prior to the requirement for claims, whereas since 1870 “the essence of the invention” is an anachronism as the claims define the scope of protection. 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). Thus, it makes no sense, for example, for a court to say that it does not “limit claims to preferred embodiments, but in this case, *** [the drawings] depict the essence of the claimed invention rather than a preferred embodiment.” *Secure Web Conference Corp. v. Microsoft*, __ Fed App'x __ (Fed. Cir. 2016)(Stoll, J.).

The Federal Circuit in its first decade of existence emphasized the fact that the “essence” of an invention is an anachronism that should no longer be used. *See 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); *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1533 n.8 (Fed. Cir. 1987)(Markey, C.J.); *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 949 (Fed. Cir. 1987)(en banc)(Nies, J., additional views). Yet, even today, confusion (and improper usage) of the “essence of the invention” continues to exist both in the *Manual of Patent Examining Procedure* and recent Federal Circuit case law.

§ 8[d][1] Early Nineteenth Century “Essence” Definition of the Invention

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Citing an opinion from over two hundred years ago penned by Supreme Court Justice Joseph Story, riding circuit, Circuit Judge Nies traces usage of the term “essence of the invention” as the methodology to identify the invention in the early nineteenth century before formal claims were required. *See Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc.*, 62 F.3d 1512, 1563 (Fed. Cir. 1995)(Nies, J., dissenting, joined in part by Archer, C.J.), *subsequent proceedings sub nom Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 39 n.8 (1997)) (“One who used the ‘essence’ of the invention was an infringer.”)

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 to 1814 in *Odiorne v. Winkley*, (No. 10,432) 18 F.Cas. 581 (C.C.Mass. 1814)(Story, J.), that “[o]ne who used the ‘essence’ of the invention was an infringer.” *Hilton Davis*, *supra*, 62 F.3d at 1563 (Nies, J., dissenting, joined in part by Archer, C.J.)(citing *Odiorne v. Winkley*).

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

Early in the history of the Federal Circuit the Chief Judge in three opinions explained that it was no longer proper to refer to the “essence” of the invention. *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)

§ 8[d][2] “Essence” Determination is an Anachronism Since 1870

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. *See 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).

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. Thus, 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.

§ 8[d][3] Continued Use of Outdated Terminology

From 1870 onward, the “essence of the invention” has been an anachronism. The confusion that still exists today is seen in the *Manual of Patent Examining Procedure* which in successive sentences first correctly states that the claims define the invention but then in the immediately following sentence refers to the “essence of the invention” in the context of disclosure. In the context of identifying the best mode contemplated, the *Manual* states that one should “[d]etermine what the invention is — the invention is defined in the claims. The specification need not set forth details not relating to the essence of the invention.” MPEP § 2165.01, *Considerations Relevant to Best Mode* (Rev. 11)(2013), § I, *Determine What is the Invention* (emphasis added; citations omitted). Equally unhelpful are current cases which perpetuate this misunderstanding. *See also Secure Web; supra; Flexiteek Americas, Inc. v. Plasteak, Inc.*, ___ Fed. App’x ___, ___, slip op. at 6 (Fed. Cir. 2015)(Prost, C.J.)(quoting trial court)(Certain characterization “is necessary for the term's construction to embody the ‘essence of the invention.’”).

Thus, 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.

Earlier cases include *Skelly Oil Co. v. Universal Oil Products Co.*, 31 F.2d 427, 431 (3rd Cir., 1929)(“Since the form and size of the heating element of the invention are not claimed by the patent as novel and as they have nothing to do with the *essence of the invention*, the defendant's substitution of one kind of heater for that preferably or incidentally disclosed by the patent falls out of the issue of infringement.”)(emphasis added); *McKays Co. v. Penn Electric Switch Co.*, 60 F.2d 762, 766 (8th Cir. 1932)(“Except where form is of the essence of the invention, it has little weight in the decision [on infringement.]”); *Mercoid Corp. v. Minneapolis-Honeywell Reg. Co.*, 133 F.2d 811, 814 (7th Cir. 1943), *subsequent proceedings*, 320 U.S. 680 (1944) (“[Mercoid's M-80] provides for the sequence

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of operations which is the precise essence of Freeman's advance in the art.”); *In re West*, 166 F.2d 582, 584 (CCPA 1948)(“Neither of the secondary references teaches [the particular feature] which is the essence of the present 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* the “additional views” of Circuit Judge Nies in *Pennwalt, supra*(“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. ...”).

Two years after Chief Judge Markey dealt with the “essence of the invention” in the *en banc SRI* case, he once again emphasized the fact that it is improper to refer to the “essence of the invention” in *Perkin-Elmer, supra*:

“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.”.

Shortly after *Perkin-Elmer* Chief Judge Markey again pointed out in his “additional views” in *Pennwalt* that “one cannot obtain patent protection for ... the ... ‘essence’ of an invention”, *Pennwalt, supra*, 833 F.2d at 949.

Even one member on the Federal Circuit with literally fifty (50) plus years involvement in patent law has difficulty understanding that “essence of the invention” effectively died nearly 150 years ago with the Patent Act of 1870. *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[.]”); *Lexington Luminance LLC v. Amazon.com Inc.*, __ Fed. App’x

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___, ___, slip op. at 10 (Fed. Cir. 2015)(Lourie, J.) (“[T]he substrate that is described in the contested language is not the essence of the invention that is being claimed.”).

The author of *Ventana Medical Systems* and *Lexington Luminance* 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 (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);

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.’”.

~~§8[e] “Essential” Feature of the Invention~~

~~“In determining obviousness, there is ‘no legally recognizable or protected 'essential' [feature]... of the invention” *Aro Manufacturing Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 345 (1961).~~

~~§8 [f] “Exact Nature” of the Invention~~

~~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).~~

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