



# Pitfalls for the foreign practitioner

U.S. Patent practice

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# U.S. Patent practice

## ☛ *Pitfalls for the foreign practitioner*

**Jeffrey G. Sheldon and Timothy H.P. Richardson of US based Sheldon & Mak, explore some of the pitfalls of U.S. patent practice**

**T**his article discusses some pitfalls in U.S. patent practice that may not be well understood by foreign practitioners. Ignorance of these pitfalls can result in a U.S. patent which is flawed, sometimes fatally. Starting with claim drafting.

### Product-by- process claims

In the United States, the scope of product-by-process claims is uncertain. The Federal Circuit, in 1992, held that “process terms in product-by-process claims serve as limitations in determining infringement”; but in 1991 and 2006 held that product-by-process claims are not limited to a product prepared by the process<sup>1</sup>. Thus, it appears possible that a product-by-process claim may be anticipated by the prior disclosure of the same product made by a different process and, if valid, may not be infringed by the same product made by a different process. It is, therefore, advisable to include not only product-by-process claims, but also simple process claims, and, if possible, claims to the product *per se*.

### Composition claims

Typically, compositions are claimed in the form of:

- (a) ingredient A;
- (b) ingredient B; and
- (c) ingredient C.

However, if any of the ingredients, after having been put together, has reacted completely, then the defined composition no longer exists. The Federal Circuit has held that, under such circumstances, a person who mixed the three ingredients together does not literally infringe the claim<sup>2</sup>.

It is, therefore, advisable, when the invention is directed to a composition (or indeed any article) which may undergo a change after it has been prepared, to include not only a claim of the kind set out above, but also a claim to the process of preparing the composition (or article), and a composition (or article)-by-process claim.



## “Means” clauses

In many non-US jurisdictions, functional “means” clauses (e.g. “means for heating;” “means for connecting”) cover any structure performing the recited function. But under U.S. law, an element defined by a means clause is generally limited to the structure(s) for performing that function specifically described in the specification, and “equivalents” thereof.

It is advisable, therefore, for broad claim coverage, to use a word that has the same meaning as the “means for” clause in place of the “means for” clause (for example “heater” instead of “means for heating”). Even if such a word is used, and especially if it is not, it is advisable for the specification to disclose every conceivable structure that can perform the claimed function.

## Independent and dependent claims

In litigation of U.S. patents, dependent claims have limited value. Theoretically, a court or jury can determine that a dependent claim is valid, despite finding its parent independent claim invalid. Practically, such determinations are rare. In general, even if the validity of a dependent claim is separately argued, the dependent claim survives or falls with the independent claim from which it depends.

It is, therefore, advisable to include more than one independent claim of each type (product, process etc.), the first claim being as broad as possible, and the subsequent claim(s) including features which can be relied upon for patentability, even if the first claim is found invalid. If the likely infringement is known, an independent “picture” claim focused on the infringement can be extremely valuable.

## Identifying the inventor(s)

In the United States, it is critically important to name the inventors correctly, even when all the inventors have assigned their interests to the same assignee. Procedures exist for correcting errors in naming the inventors, but proof is required that the error was made without deceptive intention. If the mistake cannot be corrected, the patent can be invalid. If the inventors are incorrectly named, and the true inventors have not all assigned their interests to the same assignee, the joint ownership provisions of U.S. law (see below), can have very serious consequences.

The following guidelines will help identify the correct inventors:

- Too many inventors are better than too few
- Joint inventors need not work together physically or at the same time<sup>4</sup>. However, joint inventorship requires at least some collaboration or connection<sup>5</sup>
- Joint inventors need not to make the same type or amount of contribution<sup>6</sup>. A co-



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inventor can merely suggest a limitation in a claim<sup>7</sup>. However, one who contributes only an obvious element is not a co-inventor<sup>8</sup>

- A joint inventor need not contribute to the subject matter of every claim. Contribution to a single claim is sufficient<sup>9</sup>
- A person who merely follows designs and experiments of another is not a joint inventor<sup>10</sup>. Similarly, one who merely explains how or why the invention works<sup>11</sup> or merely participates in consultations prior to or after conception<sup>12</sup>, or made no contribution until after the invention was reduced to practice<sup>13</sup>, or whose activities were “simply the exercise of the normal skill of an ordinary machinist”<sup>14</sup>, is not an inventor
- A supervisor or employer of an inventor is not a joint inventor merely because he or she is a supervisor or employer<sup>15</sup>
- If the invention is described in a technical paper, the authors of the papers should be compared with the named inventors.
- A contributor to one of multiple structures within the scope of a “means-plus function” clause is a joint inventor, unless the structure is simply a reduction to practice of another inventor’s concept<sup>16</sup>. If a particular structure is the subject of a claim, the contributor should be named as an inventor.

## Information disclosure

In the United States, unlike many non-US jurisdictions, the inventors and all others involved in the preparation and prosecution of

the application (including in particular agents and attorneys representing the inventors or the assignee) are under an obligation to disclose to the Patent Office (PTO) any “material information”, i.e. information that an examiner would consider important in deciding whether to allow the application<sup>17</sup>. Typically this is done in an Information Disclosure Statement. This obligation remains in force so long as the U.S. application (including any continuing application) is pending. Failure to fulfil this obligation can make the patent unenforceable and even a suspicion of failure results in major expense in litigation<sup>18</sup>.

The authors recommend that, even if there is doubt as to whether particular information is “material,” it should be cited to the PTO.

The following checklist is useful for identifying material information:

- Publications and patents authored by the inventor(s)
- Other documents known to the inventor(s)
- Information obtained by the inventor(s) and others at public conventions and seminars
- References located by any search for information related to the invention
- References cited in related United States applications or in related foreign applications<sup>19</sup>
- Published related foreign application
- Related United States applications or patents, including parent and sister applications and patents<sup>20</sup>
- Commercial activity relating to the invention prior to the U.S. (or PCT) filing date<sup>21</sup>
- Information from related litigation<sup>22</sup>

## The “best mode” requirement

United States law requires not only that the specification should describe the invention in sufficient detail that a person can practice the invention, but also, contrary to many non-US jurisdictions that the specification shall “set forth the best mode contemplated by the inventor of carrying out his invention”<sup>23</sup>. A U.S. patent is invalid if it is proved that the inventor, at the time of filing the US or PCT application, knew that the specification failed to disclose the best mode of carrying out the claimed invention. The best mode disclosure need not be updated in a continuation or divisional application. But a continuation-in-part (CIP) application should include the best mode known to the inventor at the date of filing of the CIP.

The following checklist provides some guidelines as to what should be disclosed, or need not be disclosed, to comply with the “best mode” requirement:

- The requirement applies only to claimed invention
- Only the best mode as of the (US or PCT) filing date need be disclosed
- If there was a commercial embodiment of the

invention at the U.S. or PCT filing date, it is *prima facie* the best method known to the inventor, and should be disclosed in the specification

- The specification need only disclose what the inventor subjectively believed to be the best mode
- The best mode must be disclosed even if the applicant did not invent it
- The description of the best mode has to be objectively enabling
- The disclosure of the best mode cannot rely on prior art that is non-conventional or not widely known.
- The best mode must be disclosed, but need not be identified as such. For example, the best mode requirement is satisfied if there are numerous examples, one of which is the best mode, but which is not identified as such.

## Joint Ownership

In the United States, unlike many non-US jurisdictions, each owner of a jointly owned U.S. Patent has an independent right to exploit the patent, without any compensation to the other owners unless there is an agreement to the contrary. Therefore, unless it is intended that different law should apply, there should be a written agreement between the joint owners which overrides the U.S. law, and that written agreement should be recorded at the PTO.

## Small Entity Status

The PTO halves many official fees for "small entity" applicants. However this concession should be used with caution. The first requirement for "small entity" status is that any entity (individual, partnership, corporation) with an interest in the patent application does not employ 500 or more people. However, there is a further, easily overlooked, requirement that each such person should not be controlled by, or control, an organisation employing more than 500 people. Thus, subsidiaries of large companies are not "small entities". Moreover, the "interest" does not have to be an ownership interest. If any large entity has rights in the invention such as by a license, or even if there is an obligation to assign to a large entity, small entity status cannot be claimed. Unintentional, improper claiming of small entity status can be corrected with suitable evidence, but until the correction cannot be made, the patent can be unenforceable.

## Conclusion

These are examples of the pitfalls that result from the differences between patent practice in the U.S. and in many non-U.S.

### About the authors

**Jeffrey G. Sheldon** (right) is the founding partner of Sheldon & Mak, PC. He is past President of the Los Angeles Intellectual Property Law Association, past Chairman of the Intellectual Property Law Section of the State Bar of California and has served as a Committee Chairman for both the American Bar Association Intellectual Property Law Section and the American Intellectual Property Law Association.



**Tim Richardson** is a US registered patent agent, a European Patent Attorney and a UK Chartered Patent Agent. He has been in private practice as a partner in J.A.Kemp & Co. (London) and in corporate practice as a senior member of the Raychem Intellectual Property Law Department (Menlo Park, California). He has now returned to private practice. He is a special consultant to Sheldon & Mak.

jurisdictions. Most of these pitfalls can be avoided by following the recommendations above. ☺

### Notes

- 1 Atlantic Thermoplastics Co. v. Faytex Corp., 970 F.2d 834, 23 U.S.P.Q.2d 1481 (Fed. Cir. 1992); Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565 (Fed. Cir. 1991); SmithKline Beecham Corp. v. Apotex Corp., No. 04-1522 (February 24, 2006)
- 2 Exxon Chem. Patents, Inc. v. Lubrizol Corp., 64 F.3d 1553 (Fed. Cir. 1995)
- 3 Cardiac Pacemakers, Inc. v. St. Jude Med., Inc., 296 F.3d 1106 (Fed. Cir. 2002)
- 4 35 U.S.C.A. § 116
- 5 Stern v. Columbia Univ., 434 F.3d 1375 (Fed. Cir. 2006)
- 6 35 U.S.C.A. § 116
- 7 Pannu v. Iolab Corp., 155 F.3d 1344, 47 U.S.P.Q.2d 1657 (Fed. Cir. 1998)
- 8 Ethicon Inc. v. United States Surgical Corp., 135 F.3d 1456, 45 U.S.P.Q.2d 1545 (Fed. Cir. 1998)
- 9 Stern v. Columbia Univ., 434 F.3d 1375 (Fed. Cir. 2006)
- 10 Mattor v. Coolegem, 530 F.2d 1391 (C.C.P.A. 1976)
- 11 GAF Corp. v. AMCHEM Prod., 514 F.Supp. 943 (E.D. Pa. 1981)
- 12 O'Reilly v. Morse, 15 How. 62 (1853)
- 13 Credle v. Bond, 25 F.3d 1566 (Fed. Cir. 1994)
- 14 Acromed Corp. v. Sofamer Danek Group, Inc., 253 F.3d 1371 (Fed. Cir. 2001)
- 15 Koehring Co. v. E.D. Etnyre & Co., 254 F.Supp. 334, 338 (N.D. Ill. 1966)
- 16 Ethicon Inc. v. United States Surgical Corp., 135 F.3d 1456 (Fed. Cir. 1998)
- 17 Digital Control Inc. v. The Charles Machine Works, 437 F.3d 1309 (Fed. Cir. 2006)
- 18 Kingsdown Medical Consultants, Ltd. v. Hollister, 863 F.2d 867 (Fed. Cir. 1988)
- 19 37 C.F.R. § 1.56(a)(1)
- 20 Dayco Prod. Inc. v. Total Containment, Inc., 329 F.2d 1358 (Fed. Cir. 2003)
- 21 Brasseler, U.S.A. I, LP v. Stryker Sales Corp., 267 F.3d 888 (Fed. Cir. 2001)
- 22 M.P.E.P. § 2001.06(c)
- 23 35 U.S.C. § 112

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