Patent Claim Dissection

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Judge Giles Rich is famous for his aphorism, “the name of the game is the claim.” In many ways, particularly in its early years, the Federal Circuit adhered to this maxim, elevating the importance of the claim, and in particular claim limitations, in its jurisprudence. Even the Supreme Court appeared to embrace this approach in the Court’s approach to the doctrine of equivalents and its limitations.
But in other ways, the Federal Circuit and Supreme Court have derogated from the centrality of the claims. The claim, at best, appears to be a starting point for a broader analysis that reduces the importance of the claim and its limitations, if not ignoring the claim altogether.

In this paper, we review this complicated history, delineating areas where the Federal Circuit and Supreme Court have emphasized the centrality of the claim. Areas where this dynamic is apparent include claim construction, the all-elements rule of the doctrine of equivalents, the anticipation standard, and generally the obviousness standard. In contrast, the courts have stepped away from the claim in a variety of places, such as patentable subject matter, patent exhaustion, the coextensiveness requirement for the presumption of nexus for secondary considerations of nonobviousness, enablement, and inventorship.

We dissect the caselaw to assess whether there is a coherent theory that underlies this various ways that courts dissect the claims in these circumstances and conclude that there is not: each exercise of dissection appears to address the circumstances of each particular doctrine. We also find literature in this area unpersuasive and argue for a return to the primacy of the claim even in these circumstances, overring doctrinal adjustments that can account that may be driving the courts’ step away from the claim language.