Patent Claim Anti-Dissection

We aren't sold on a title yet....

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Judge Rich's aphorism…

"The name of the game is the claim."

Giles S. Rich, *Extent of Protection and Interpretation of Claims--American Perspectives*, 21 INT'L REV. INDUS. PROP. & COPYRIGHT L. 497, 499 (1990).

But is it?

- Broader project – address substantive issues as well as institutional questions about the Federal Circuit and PTAB
- Institutional questions are primary driver (although not apparent from this slice of the project)
- Answers likely have changed since heyday of claim construction debates

Claim Centrality – All Elements Rule

- Novelty
- Obviousness
- Claim construction and literal infringement
- Doctrine of equivalents and the all-elements rule

Claim Dissection (?)

- Subject matter eligibility
- Patent exhaustion
- Co-extensiveness for obviousness presumption of nexus
- Enablement (?)
- Written Description (?)
- Inventorship
  - Amy R. Motomura, *The Inventorship Fallacy*, 58 UC Davis L. Rev. 2379 (2025)

Is There a Coherent Theory for Departures from the Claim?

- "Problems" with peripheral claiming
  - Departures have little to do with peripheral nature of the claim; instead a disregard for limitations
- Condemning creative claim drafting
  - Drafting claims to cover accused devices are not inequitable conduct and viewed as good
- Difference between "claiming" and "covering/infringement"
  - Relevant only to nexus, and nexus is a misapplication
- Point of novelty -- Mark A. Lemley, *Point of Novelty*, 105 NW. U. L. REV. 1253 (2011)
  - Misnomer & doctrines (exhaustion, nexus) are not about excavating novelty

Preliminary Normative Inclinations– Return Focus to the Claims and Their Limitations

- Transacting around various rules; default rules
- ***What if courts regularly adopted patent rules with an eye to encouraging/facilitating creative claim drafting?***
  - Eligibility – approach more akin to *Chakrabarty*
    - If playing games, captured by other doctrines
  - Exhaustion – require the actual patented invention as claimed be on sale; perhaps no substantial non-infringing use
  - Coextensiveness – object on sale covered by the claim gets presumption; use other items to rebut
  - Enablement/WD – focus on the limitations
  - Inventorship – *tough questions* but tie closely to conception

Companion Piece on Problematic Obviousness Doctrines

- Presumption of nexus for secondary considerations
- Phoenix of TSM
  - Especially from PTAB (hard to monitor given volume…more below)
  - Returning to rigid application? Judges applying it in muddled fashion to advance their own views?
- Reasonable expectation of success
  - Implicit v. explicit for TSM?
  - All arts or just chemical/bio?
- Could fix doctrines easily
  - E.g. why are nexus and TSM both binary and not merely part of a factual assessment?

Advent of the PTAB/IPR—*may be a separate paper. Happy for comments.*

- AIA's creation of PTAB and IPRs created an expert tribunal
- Focused extensively on obviousness
- Has center of gravity shifted to PTAB, leaving CAFC merely as court of error correction
- Yet, unlike DCTs, PTAB decisions themselves do not seem to rely on each other
  - No internal doctrinal development – potential loss for innovation
- DCTs do not seem to cite PTAB decisions
- Failure of an "expert trial court"?

What Does This Say About the Fed. Cir.?

- More research on our part needed
- Intuition – judges are hiding behind process rules to mask dissension over substantive principles
- Loss of transparency, broader discussion, and doctrinal innovation
- No consensus theory on the relationship between PTAB and Fed. Cir.

Thank you!

- Constructive feedback to timothy.holbrook@du.edu
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