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Dedication

This book is dedicated to the faculty of PLI claim-drafting tutors, who gave most generously of their time and talents in the patent bar review course, helping the students to draft better claims. The book is also dedicated to Ruth Druss, Program Attorney of PLI and founder of the PLI patent and patent bar review courses, and to Carol Faber, who encouraged the writing.

I also dedicate this book to my partners in Ostrolenk Faber LLP, who have always set the highest standards of professionalism in all respects.

But the highest tribute goes to John L. Landis, the author of the first two editions of this book, who so thoroughly covered and so clearly presented the material that writing the following editions was a pleasure.
About the Author

ROBERT C. FABER has been an intellectual property lawyer for over forty years. He is a graduate of Cornell University and Harvard Law School. He is a partner in the New York City intellectual property law firm of Ostrolenk Faber LLP.

A member of the faculty of PLI’s Patent Bar Review course, which focused on the Agent’s Examination and claims writing, for more than twenty years, of the faculty of PLI’s Advanced Claim and Amendment writing course since its inception, and of the faculty of PLI’s Fundamentals of Patent Prosecution since its inception, Mr. Faber has lectured on intellectual property and patent matters for PLI, the Bureau of National Affairs, the American Intellectual Property Law Association, the New York State Bar Association, and other organizations.
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The enthusiastic reception of the previous editions of this book in America and abroad, including a translation into Japanese, has led to this expanded, revised version, incorporating new cases, and further discussion of developing fields.

Mr. Landis, for many years the chief lecturer for the Institute in the area of drafting patent claims, passed away in 1984. His contribution, as well as the contributions of John D. Kaufmann, Bryan W. Sheffield, Myron Cohen, and Rochelle Seide, will long endure.

The experienced patent practitioner will find this volume both a distillation of advanced technique and a review of the fundamentals of the field. The person new to patent practice will welcome the absence of jargon and the inclusion of texts of relevant statutes, rules, and procedural interpretations. The attorney or businessperson with occasional need to evaluate an existing patent should find the numerous claims, both court-approved and specially developed for illustrative purposes, convenient keys to understanding the result of the drafting process.
Introduction

The primary object of this treatise is to present a simple and direct approach to the mechanics of claim drafting. The major emphasis in chapters 1–6 is on practical techniques for composing claims to many different types of inventions. In chapters 1–6, there is also emphasis on various preferred claim-drafting practices and techniques that have grown up over the years by case law, Patent and Trademark Office rules and memoranda, and, simply, custom, as well as definitions and preferred usage of stylized words and phrases in the patent law, such as “comprising,” “consisting,” “means for,” “step for,” and “whereby.”

There is also extensive discussion of many case law doctrines relating to nonart rejections, both classic rules and modern trends. In many of these areas, there have been liberalizing trends by the courts in recent years to overthrow or simplify rejections not based on prior art. In particular, this treatise covers both the classic and the more recent constructions of means clauses (section 3:29), inherent function of the apparatus doctrine (section 4:5), mental steps and computer programs (section 4:10), product-by-process claims (section 5:2), claims referring to drawings (section 6:6), new use claims and preamble limitations (section 6:7), Jepson claims (section 6:8), undue multiplicity (section 8:4), old combination (section 8:5), aggregation (section 8:6), and printed matter (section 8:7).

There are many examples of suggested claims to various types of inventions: machines (chapter 3), processes (chapter 4), articles of manufacture (chapter 5), compositions of matter (chapter 6), computer inventions (section 4:10), designs (section 5:4) and plants (section 5:6), as well as dependent claims (section 2:9), Jepson claims (section 6:8), generic and species claims (section 6:9), subcombination claims (section 6:10), and biotechnology (chapter 9).

1. Court or Patent and Trademark Office Board of Patent Appeals and Interferences decisions. The Board is an administrative tribunal in the Patent and Trademark Office that hears appeals from adverse decisions of the patent examiners on substantive issues. The Board usually sits in panels of three designated members.
2. Formerly the Patent Office.
3. Rejections based on doctrines other than anticipation or obviousness over prior art.
4. The Court of Customs and Patent Appeals was a special five-judge federal court having jurisdiction over appeals from Patent Office administrative tribunals, as well as customs appeals. The C.C.P.A. was succeeded in 1982 by the United States Court of Appeals for the Federal Circuit.
Many comments about and quotations from claims on appeal and in litigation are given, so that the reader can see for himself or herself which types of limitations and phrases have been judicially approved and which not.

Unfortunately, it is too often true that the inventor or patentee wins or loses because of formal rules and language problems in the claims, not because of any lack of “invention” over the prior art. This book is intended to help the practitioner in designing claims around these myriad rules and doctrines, to draft the most effective types of claims for each type of invention.