

TechRoadmap *Directions*

Intellectual Property Issues of Interest to High Tech Companies

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Welcome

Properly identifying exactly what your invention is may be one of the most difficult things for an inventor, or an inventor's company, to do. All of us have a built-in bias to love our offspring and this bias carries over to our inventions. And we like to talk about the things we love.

Unfortunately, every word you use in your patent application, particularly in your claims, is subject to intense scrutiny when you take an infringer to court. To see how including extra words can hurt you, read "*Conventionally, Pruning Your Claims is Standard Wisdom*".

Who else should read this?



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IP Links of Interest

- [US Patent Office](#) A host of useful, official information.
- [EKMS, Inc.](#) A strategic IP management partner of TechRoadmap.
- [The Patent Cafe](#) An on-line portal for IP matters.
- [AlvaMed, LLC](#) A medical device consulting company we work with.
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• Pruning Your Claims

An overgrown shrub may be natural but that doesn't guarantee it will be healthy and strong.

Usually a good pruning that lets light and air into the center of the plant results in a happier bush. The same is true with overly wordy patent claims.



Acting as your Director of Intellectual Property TechRoadmap can work with you and your patent attorney to develop patent claims that are both precise and concise.

• Conventionally, Pruning Your Claims is Standard Wisdom

Like the inhabitants of Lake Wobegon, where all children are above average, we are so invested in our inventions, so anxious to sell them to the world, that **we want to embellish their descriptions with every aspect of every feature**. Unfortunately, in the world of patents, **every embellishing word limits** our ability to enforce our patent broadly. (Note that the patent laws indirectly encourage this behavior by insisting on an enabling and best mode disclosure).

In a recent court decision, PC Connector Solutions (PCCS) lost its infringement suit against Smartdisk Corp because **it included what it felt were clarifying words** in the patent claims; **words like "conventional", "traditional" and "standard"**. PCCS owns the patent for a coupler to connect peripherals to a computer using the diskette drive rather than the I/O ports and Smartdisk makes diskette-shaped, media card (e.g., smart media) readers that are inserted into a computer's disk drive instead of being connected to the I/O ports.

Smartdisk was judged non-infringing because **PCCS's clarifying words were deemed to limit its claims**. The word **"conventional"** (in Claim 1) was interpreted as only referring to technologies existing at the time of the invention and the flash memories and smart cards used with the accused devices were obviously not peripherals that were **"normally connectible** to a conventional computer input/output port" in existence at the time of filing in 1988 - they weren't even in existence. Similarly, the terms **"traditionally connectable"** and **"standard"** in claim 10 **were construed as referring only to I/O technologies existing in 1988**.

PCCS argued to no avail that **the terms merely clarify the manner of connecting peripherals** to a computer-i.e., through dedicated I/O ports typically clustered at the rear of the chassis-without imposing a time-based limitation on the I/O technologies involved.

The Court of Appeals pointed out that **a claim cannot have different meanings at different times**; its meaning must be interpreted as of its effective filing date. So today's "conventional" USB port cannot be covered by PCCS's 1988 claim; on the other hand, had they claimed a "dedicated" I/O port, then a USB port probably would have been covered.

In hindsight we are left to wonder **why any modifier was needed at all**; wouldn't the expression "computer input/output port" have sufficed to describe what they were talking about?

• Tip of the Month

Prune your claims:

- **Be aware of word meanings** - An infringer will try to define your words to his advantage. Look in dictionaries for hidden meanings to your words.
- **Prune your claims** - Try removing words from your claims and see if they still describe your invention. Ask "will the pruned claim still function?"
- **Let one or more non-inventors read the claims** - If someone of ordinary skill in the art "gets it", your claim is probably okay. But make sure they're unbiased.

• Disclaimer

Nothing in this newsletter should be construed as legal advice. TechRoadmap serves as an interface between companies and their legal counsel.