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THE IMPORTANCE OF SYNCHRONIZING THE SCOPE OF THE CLAIMS AND SPECIFICATION

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Draft broad claims. Draft narrow claims. Draft claims covering the full range of scope from broad to narrow. We've heard these principles from our earliest days in the profession. The importance of a patent having a range of claims is as great now as it has ever been. However, it is equally important that scope of the specification be commensurate with the scope of the claims. It is vital in the predictable arts as well as the unpredictable arts to provide a broad specification to support broad claims. A broad specification is one that includes a sufficient number of species or embodiments to demonstrate that the inventor was in possession of the invention described in the broad claims. As will be described through the cases presented below, when broad claims in a patent are supported by a narrow specification, the courts restrict the scope of the claims to the embodiment (typically only one embodiment) described in the specification or may hold the broad claims invalid for lack of written description support under 35 U.S.C. Section 112, first paragraph. This applies not only to regular patent applications, but also to provisional patent applications if a patent owner desires to obtain the benefit of the filing date of the provisional patent application.

A. Claiming too broadly/disclosing too narrowly – Is the scope of your claims commensurate with the scope of your specification?

1. *Claiming More Broadly Than the Disclosure Can Be a Problem in Even Predictable Technologies*

This section discusses two Federal Circuit cases, *Honeywell v. ITT and TG Fluid Systems*[1] and *LizardTech v. Earth Resource Mapping*[2]. In both cases, the Federal Circuit determined that a mismatch exists between the scope of the claims and the scope of the specification. In *Honeywell*, the Federal Circuit construed the claims to be of narrow scope to match the specification, i.e., read limitations into the claims from the specification. In *LizardTech*, the Federal Circuit held the claim invalid for lack of written description support.

In *Honeywell v. ITT and TG Fluid Systems,* the Federal Circuit interpreted broad claim limitations narrowly in affirming summary judgment of non-infringement by a product clearly encompassed literally within the well-established, ordinary meaning of the claim terminology. While the case joins an all-too-long list of recent Federal Circuit opinions importing limitations from preferred embodiments into claims – albeit under the rhetoric of interpreting the claims "in

[1] 452 F.3d 1312, 79 U.S.P.Q.2d 1294 (Fed. Cir. 2006). The author thanks Paul Gardner for this discussion of *Honeywell.*

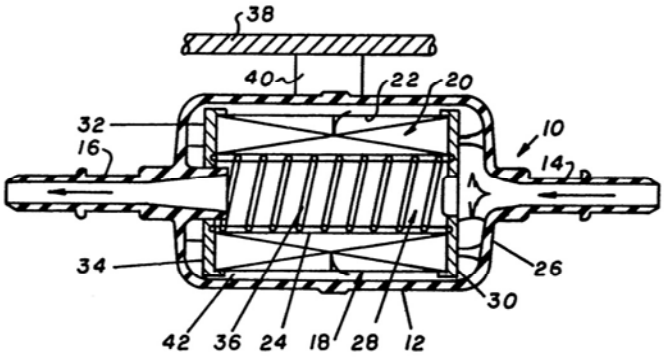
[2] 424 F.3d 1336 (Fed. Cir. 2005).

light of the specification" – the rationale expressed by the court warrants careful study, for it emphasizes the dangers attendant to single embodiment disclosures and discussing advantages of an invention over the prior art in patent specifications.

The patent in *Honeywell*, U.S. Patent No. 5,164,879, ('879 patent) entitled "Electrostatically Dissipative Fuel System Component," is directed to a polymeric fuel system component designed to prevent leakage in a fuel filter housing made of polymeric (as opposed to metallic) material. As explained in the patent, such leakage occurs in prior art electronic fuel injection (EFI) system filter housings due to the formation and growth of microscopic holes in the polymeric housing, holes created by the buildup of electrostatic charge and subsequent discharge or "arcing" through the housing to the grounded vehicle body. The buildup of electrostatic charge is the consequence of electrons being stripped from the outermost shells of hydrocarbon paraffin as the fuel moves rapidly through the EFI system.

The leakage problem is solved by the invention of the '879 patent by interlacing the polymeric housing material with electrically conductive fibers. As a result, the fibers in the housing complete an electrical discharge path between the fuel and the grounded vehicle body, resulting in continuous drainage of the electrostatic charge to ground, thereby preventing the buildup of charge that would lead to arcing and creation of leakage holes.

The single embodiment disclosed in the *Honeywell* patent, depicted below, is a fuel *filter* 10 whose polymeric housing material 12 contains *stainless steel* fibers. However, the claims in issue broadly recite "[a] fuel injection system *component*" (not limited to a fuel filter), containing "*electrically conductive* fibers" (not limited to stainless steel).



Defendants' accused products, called "quick connects," are nut-like structures that join various components of a fuel injection system together, such as a fuel line to a fuel filter. Accordingly, as the district court and Federal Circuit acknowledged, those products come within the ordinary meaning of "a fuel injection system component," which the district court defined as "any constituent part of the fuel injection system of a motor vehicle including, for example, fuel filters, fuel lines, *and connectors*"(emphasis added). However, the district court refused to accord the terminology its ordinary meaning. Instead, the court interpreted the term restrictively

Title search: The Importance of Synchronizing the Scope of the Claims and Specification

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