



Impact of Your Specification on Claim Validity/Scope

14th Annual Advanced Patent Law Institute

March 22, 2019



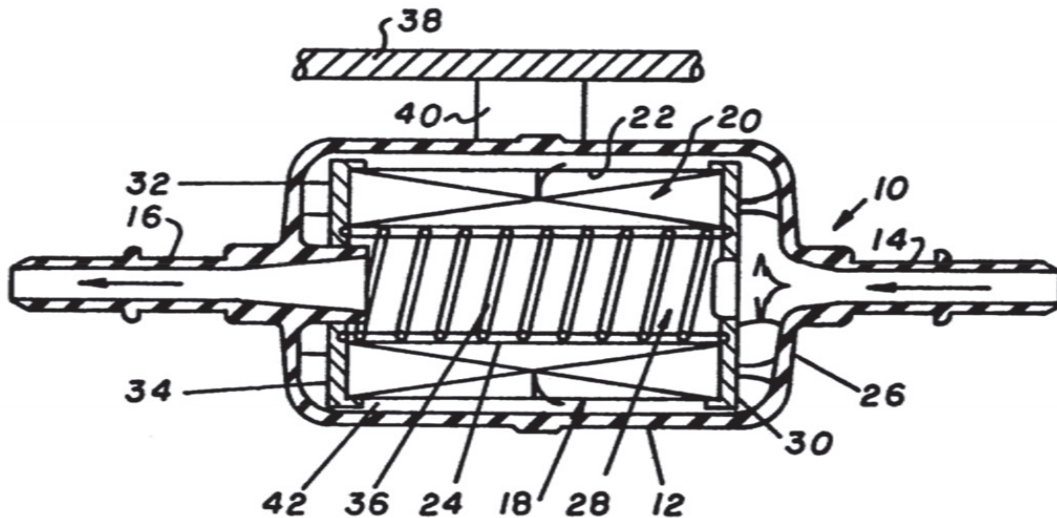
THE IMPORTANCE OF SYNCHRONIZING THE SCOPE OF THE CLAIMS AND SPECIFICATION

Claiming Too Broadly/Disclosing Too Narrowly – Is the scope of your claims commensurate with the scope of your specification?

- Claiming more broadly than the disclosure can be a problem in even predictable technologies
- It is as if the Federal Circuit asks “What did the inventor really invent? Did the inventor or the patent attorney invent the broad claims?” The Federal Circuit is smart enough to realize that patent attorneys invent broad claims.
- But what can the federal Circuit confidently know that the inventor actually invented? The disclosed embodiment(s) in the specification.
- You broaden the specification NOT by generalizing the specification and eliminating details as you do with claims. You broaden specification by adding detailed embodiments/examples to the specification to demonstrate that the inventor invented the claimed genus.

THE IMPORTANCE OF SYNCHRONIZING THE SCOPE OF THE CLAIMS AND SPECIFICATION

Honeywell v. ITT and TG Fluid Systems – Broad Claim Construed Narrowly



THE IMPORTANCE OF SYNCHRONIZING THE SCOPE OF THE CLAIMS AND SPECIFICATION

Honeywell v. ITT and TG Fluid Systems – Broad Claim Construed Narrowly

- I. Specification – Single embodiment: A polymeric fuel filter with steel fibers to create electrical conductivity.
- II. Claims – A polymeric “fuel system component” with “conductive fibers” to create electrical conductivity.
- III. Defendant – A polymeric quick disconnect with carbon fibers to create electrical conductivity.
- IV. District Court – Ordinary meaning of “fuel system component” includes quick disconnect, BUT specification restricts meaning to fuel filter. “Conductive fibers” covers carbon fibers. Summary judgment – no infringement.
- V. Federal Circuit – Affirmed judgment – partially different reasoning
 - A. Specification states 4 times that fuel filter “is the invention.”
 - B. Fuel filter is the only disclosed component with conductive fibers.

THE IMPORTANCE OF SYNCHRONIZING THE SCOPE OF THE CLAIMS AND SPECIFICATION

Honeywell v. ITT and TG Fluid Systems – Broad Claim Construed Narrowly

- C. During prosecution, applicant stated the switch in the claims from “fuel filter” to “fuel system component” was intended to cover “all fuel system components.” Federal Circuit says this is ambiguous and possibly inconsistent with the specification.
- D. Federal Circuit – “conductive fibers” limited to steel fibers.
- E. Specification listed **advantages** of steel fibers over carbon fibers.
- F. Specification says steel fibers better than carbon fibers.
- G. If the specification could speak, it would say, “Don’t use carbon fibers.”
- H. The scope was not limited to steel fibers, it only excludes carbon fibers.

THE IMPORTANCE OF SYNCHRONIZING THE SCOPE OF THE CLAIMS AND SPECIFICATION

LizardTech – Original Broad Claim In Predictable Art Invalid No Written Description Support

- Method of viewing images from large data files.
- Prior art – Break image into tiles and compress each tile separately using DWT.
- Prior art problem – Artifacts at edges of tiles.
- Patent Specification – Eliminate artifacts at edges of tiles to create “seamless” imaging by calculating DWT coefficients beyond the boundary of each tile and maintaining updated sums of the DWT coefficients for each tile even beyond the edge of the tile.

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](https://utcle.org/elibrary)

Title search: Impact of Your Specification on Claim Validity/Scope

Also available as part of the eCourse

[2019 Advanced Patent Law \(USPTO\) eConference](#)

First appeared as part of the conference materials for the
14th Annual Advanced Patent Law Institute session

"Impact of Your Specification on Claim Validity/Scope"