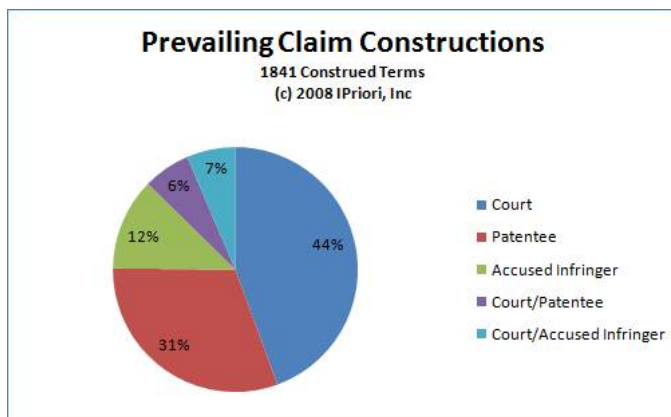


# PIPLA NEWS

*The official newsletter of the Pittsburgh Intellectual Property Law Association*

## Spotlight on Claim Construction

An ongoing project reviews patent claim construction orders adding the salient features to into a thesaurus of claim constructions. Additionally, I characterize the constructions in several factors including the 'prevailing construction', or more simply, 'who won.' Presented here is a summary chart of a limited set of outcomes.



The results show that a Patentees prevails 37% of the time; the Accused Infringer 19% of the time, and the Court directly analyzes and crafts a construction in 44% of the instances. These numbers fluctuate slightly as new Markman orders are abstracted, however the prevailing relationship between Court, Patentees and Accused Infringer has been consistent. It may not be surprising that Accused Infringers have such limited success, but it is surprising that Patentees don't do better. That this occurs is clear, but *why* the outcomes occur this way is not. A few Markman orders include observations by the Court on the Markman process, revealing insight into a difficult task. An example is:

*"In this case, the parties have raised sophistry to a premiere art. As one travels life's byways, one often encounters problems akin to picking flyspecks from*

## IN THIS ISSUE

Spotlight on Claim Construction Stuart Soffer, IPriori, Inc.	1
Job Posting	2
Every Which Way But Markush Brett S. Squires, Jones Day	2
Wacky Patents: Time/Life Theory	3
The Webb Law Firm Promotes Patent Attorneys	4

*pepper. The attorneys in this case have left no doubt about their ability to do so, especially where the same attorneys represent two different accused infringers that attach different meanings to the same phrases."*

Claim Construction Order in *Fellowes, Inc. v. Michilin Prosperity Company*, 12/15/2006

I bring this up today since it fits the context of a recent paper by Dave Schwartz of John Marshall Law School, "Practice Makes Perfect? An Empirical Study of Claim Construction Reversal Rates in Patent Cases"(1), reported by Dennis Crouch.

(1) [http://papers.ssm.com/sol3/papers.cfm?abstract\\_id=1012949](http://papers.ssm.com/sol3/papers.cfm?abstract_id=1012949)

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**Job Posting****Kennametal Inc.  
Position Available****Patent Counsel**

Kennametal Inc. (NYSE:KMT) is the world's premier supplier of tooling, engineered components and advanced materials consumed in production processes. We have the following opening:

**Title:**

Patent Counsel

**Location:**

Kennametal World Headquarters in Latrobe, PA (40 miles east of Pittsburgh)

**Education and Attributes:**

The Patent Attorney position will require a Juris Doctor from an accredited law school and a B.S. in Mechanical or Chemical Engineering, Metallurgy, or Ceramics, and three to seven years patent experience. Admissions to the Pennsylvania and Patent bars are required.

**Job Description:**

Kennametal Inc. has an excellent opportunity for employment with the Office of the General Counsel, Intellectual Property Law Department, at our corporate offices in Latrobe, PA. Kennametal is the leading global supplier of tooling, engineered components and advanced materials that are consumed in production processes. We provide customers with a broad range of technologically advanced tools, tooling systems and technical services.

The candidate will be responsible for the preparation and prosecution of U.S. and foreign patent applications, drafting and negotiating research, license and confidentiality agreements, drafting legal opinions, general counseling and providing assistance to the Chief Counsel for Intellectual Property in advising Kennametal's operating divisions of their intellectual property rights.

**To Apply:**

Submit a resume through the Corporate website ([www.kennametal.com](http://www.kennametal.com)) under the Career link.

Kennametal Inc. (NYSE:KMT) is the world's premier supplier of tooling, engineered components and advanced materials consumed in production processes. The company improves customers' competitiveness by providing superior economic returns through the delivery of application knowledge and advanced technology to master the toughest of materials application demands. Companies producing everything from airframes to coal, from medical implants to oil wells and from turbochargers to motorcycle parts recognize Kennametal for extraordinary contributions to their value chains. Customers buy over \$2.2 billion annually to Kennametal products and services – delivered by our 14,000 talented employees in over 60 countries – with almost 50 percent of these revenues coming from outside the United States. Visit us at [www.kennametal.com](http://www.kennametal.com).

**Every Which Way But Markush**

*Brett S. Squires, Jones Day*

The U.S. Patent and Trademark Office has recently proposed rules regarding the examination of patent applications that include claims containing Markush groups or similar alternative language. The Office states that Markush groups and similar alternative language are now liberally being used to claim multiple inventions and hundreds of alternative embodiments of a single invention. The Office further states that the current liberal use of Markush groups and similar alternative language departs from the original officially sanctioned use of Markush groups in claim drafting. The Office points to the propagation of Markush groups across all areas of technology and the disproportionate amount of Office resources that the proper search and examination of claims containing Markush groups having multiple inventions or hundreds of alternative embodiments consume, as compared to other types of claims, for necessitating the proposed rules.

Markush groups were originally sanctioned for use in the chemical arts when an applicant could only define his invention by setting forth at least one set of alternatives from which a selection must be made. The Office initially presumed that the members of a Markush group were patentably

indistinct from each other. This presumption was overturned due to the liberalization of Markush groups: “the original rigid, emergency-engendered restrictions have been progressively relaxed through the years to the point where it is no longer possible to indulge in a presumption that the members of a Markush group are recognized by anyone to be equivalents except as they ‘possess at least one property in common which is mainly responsible for their function in the claimed relationship.’” *In re Ruff*, 256 F.2d 590, 598, 118 USPQ 340, 348 (CCPA 1958). However, the liberalization of Markush groups does not extend to allow members of a Markush group to lack unity of invention and the Office has the right to rely on rules derived from case law “to determine whether the claims before it were or were not in proper form to be examined for patentability.” *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980).

The Office intends to use the proposed rules regarding the examination of patent applications that include claims containing Markush groups or similar alternative language to establish official procedures for the examiner to follow when examining a claim that recites multiple independent and distinct inventions or alternatives that lack unity of invention. The proposed rules provide for restriction of an application to one invention where multiple independent and distinct inventions are recited as alternatives in a single claim. The proposed rules set forth guidelines for determining when a restriction is proper for an application that recites a list of alternatives. The guidelines for determining when a claimed list of alternatives is limited to a single invention and should not be subject to a restriction requirement are when at least one of the following two conditions is met: 1. all of the species encompassed by the claim share a substantial feature essential for a common utility, or 2. all of the species are *prima facie* obvious over each other. Claim language that encompasses more than one embodiment by using generic terminology, without requiring selection from a list of alternatives, such as “a means for,” or “a step for,” are not subject to the proposed rules, thus allowing a practitioner to draft claims that are not subject to the proposed rules every which way but Markush.

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## WACKY PATENTS

### Time/Life Theory

(U.S. Patent Application Publication US  
2007/0154871)

The applicant hypothesizes that cosmic microwave background radiation and black holes lie at the opposite end of the time spectrum. The applicant forms this hypothesis based on cosmic microwave background radiation, a form of electromagnetic radiation that fills the universe and is thought to be left over from the big bang, and x-ray radiation, an x-ray signature is left by matter falling into a black hole, lying at the opposite ends of the electromagnetic spectrum. The applicant uses this hypothesis to create a formula that describes life as the total of all energy received and transmitted by any physical entity from the beginning of its existence to the end of its existence. The applicant theorizes that the pattern of received energy and reflected energy is spherically concentric and defined by a time/life mathematical formula for a spherical surface radiating from a central point at the speed of light. The spherical surface can be perceived as either an expansion or a collapse to represent one life cycle. The difference in perception of the spherical surface is the basis for gender with males perceiving the spherical surface as expanding at the speed of light and females perceiving the spherical surface as collapsing at the speed of light. For example a man who dies at the age of 40, his total experience of time can include only those things contained within a sphere 40 light years in radius from the time and place of his birth. The applicant then delves into subatomic theory stating that the expansion first perspective is manifested at the base level of stable physical existence as a proton. The collapse first perspective is manifested at the base level of stable physical existence as a neutron, and electrons represent a potential to become either a proton or a neutron. Accordingly, an initiating proton and an initiating neutron through their preferred motion and alignment create a scaffold effect of probable configuration that allows the construction of virtually any complex physical form including galaxies, stars, planets, human being, and bacteria. The applicant concludes that the expansion and collapse of the spherical surfaces in the dimension of time is the foundation of physical existence responsible for light, gravity, and matter. The application is currently rejected by the U.S. Patent and

Trademark Office under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement; under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention; and under 35 U.S.C. § 101, as being directed to non-statutory subject matter, lacking patentable utility, being inoperative, and not being supported by either a specific, substantial or credible asserted utility or a well established utility.

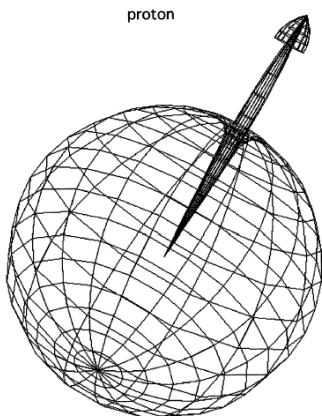
### Time/Life Mathematical Formula

$$\alpha\omega = \frac{4\pi c^3}{i^2}$$

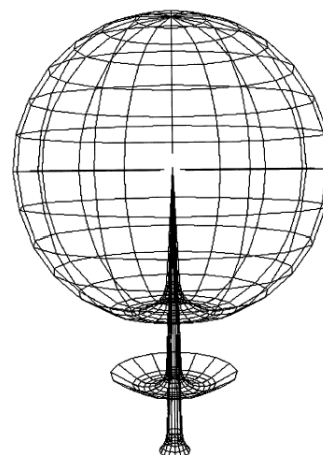
$\alpha\omega$  = duration of life (units are time such as years)

$c$  = speed of light (300,000,000 meter per second)

$i^2$  = imaginary unit equal to -1



neutron



### THE WEBB LAW FIRM PROMOTES PATENT ATTORNEYS

The Webb Law Firm, a legal practice concentrating exclusively in intellectual property (patents, trademarks, copyrights) law and related litigation issues, recently announced the promotion of four patent attorneys:

- Christian E. Schuster, a resident of Harmony, PA, was promoted to director and vice president. He was formerly shareholder and vice president with the firm.
- Ann M. Cannoni, a resident of Zelienople, PA, was promoted to shareholder and vice president. She was formerly a shareholder with the firm.
- Nathan J. Prepelka, a resident of Carnegie, PA, was promoted to shareholder and vice president. He was formerly a shareholder with the firm.
- J. Matthew Pritchard IV, a resident of Wexford, PA, was promoted to shareholder. He was formerly an associate with the firm.

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