

## Drafting Patent Applications to Avoid Claim Scope Disavowal Issues

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*Legal Update*

Now more than ever, care should be taken when drafting patent applications to avoid unintentionally narrowing the claims under the doctrine of claim scope disavowal.

The general rule in claim construction is that the words of a claim are given their ordinary and customary meaning. The doctrine of claim scope disavowal is an important exception to this general rule and arises when the patentee disavows the full scope of a claim term, either in the specification or during prosecution.

Specification-based disavowal can occur in many ways, as highlighted by recent Federal Circuit decisions. For example, in May of this year the Federal Circuit issued the *Chicago Board* decision, reaffirming the notion that disparaging prior art or alternative embodiments in the specification can give rise to a disavowal. The *Chicago Board* court stated that “[t]he specification goes well beyond expressing the patentee’s preference for a fully automated exchange over a manual or a partially automated one, and its repeated derogatory statements about the latter reasonably may be viewed as a disavowal of that subject matter from the scope of the Patent’s claims.”

Specification-based disavowal can also occur when the specification characterizes the “invention.” In its 2006 *Honeywell* decision, the Federal Circuit applied the doctrine of claim scope disavowal to construe the claim term “fuel system component” as being limited only to fuel *filters*. The court’s claim construction was based on repeated statements in the specification characterizing the “invention.” The specification made statements such as: “this *invention* relates to a fuel filter,” “according to the present *invention*, a fuel filter for a motor vehicle is made from a moldable material. . . ,” and “[the sole drawing illustrates] a fuel filter made pursuant to the teachings of the present *invention*.” (Emphasis added).

This doctrine took center stage again in the Federal Circuit’s recent *Abbott* decision on September 28, 2012. In *Abbott*, the court vacated the reexamination claim construction of the Board of Patent Appeals and Interferences (BPAI), finding that Abbott had disavowed such a broad construction.

In particular, the Federal Circuit construed the claim term “electrochemical sensor” as excluding external cables or wires. The court relied on the specification’s criticism of prior art to arrive at this claim construction: “Abbott’s patents repeatedly, consistently, and exclusively depict an electrochemical sensor without external cables or wires while simultaneously disparaging sensors with external cables or wires.”

The court latched onto the following language in the patent’s specification:

“Some devices include a sensor guide which rests on or near the skin of the patient and may be attached to the patient to hold the sensor in place. These sensor guides are typically bulky and do not allow for freedom of movement. In addition, the sensor guides or the sensors include cables or wires for connecting the sensor to other equipment to direct the signals from the sensors to an analyzer. The size of the sensor guides and presence of cables and wires hinders the convenient use of these devices for everyday applications. There is a need for a small, compact device that can operate the sensor and provide signals to an analyzer without substantially restricting the movements and activities of a patient.”

The ultimate decision as to whether there has been a disavowal of claim scope is very much dependent on the facts of a particular case. In addition, the case law surrounding the doctrine is constantly evolving, and there are numerous cases that come down on either side of the issue.

Nonetheless, by taking steps proactively at the application drafting stage, applicants can largely avoid unintentionally disavowing the full scope of their claims. The following practical tips may be helpful to applicants seeking to avoid application of the doctrine of claim scope disavowal.

First, applicants can try to avoid characterizing the “invention” in the specification. In fact, it may be advisable to omit the term “invention” altogether in the specification, and to instead refer to “exemplary embodiments” and the like.

Second, while discussing prior art in the specification can be unavoidable in some cases, care should be exercised to limit remarks that criticize or distinguish the prior art. If an applicant must criticize the prior art, the criticism should try to be made non-specific and not linked to any particular feature, as this can help mitigate a finding of disavowal.

Finally, the specification should disclose multiple embodiments whenever possible and should try to disclose alternative options for any key claim features. The specification should try to foresee and disclose obvious variations and potential design-arounds, as their disclosure may help prevent a future finding of claim scope disavowal.

**This advisory was prepared by Nutter's Intellectual Property practice. For more information, please contact your Nutter attorney at 617.439.2000.**

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