

Patent Law and
Boilerplate, Cautionary Language, Caveats, Qualifications, Provisos, Criteria,
Repudiations, Stipulations, Macros, Disclaimers, Rote Text, Broadening Language,
Formulaic Text, and Restatements of Aphorisms:
Useless, Helpful or Harmful?

Dov Greenbaum JD PhD

Assistant Professor Molecular Biophysics and Biochemistry, Yale University

Patent Attorney, Reinhold Cohn Group¹

The Supreme Court's periodic forays² into patentable subject matter³, most recently in *Alice v CLS*,⁴ may result in yet another set of guidelines for patent attorneys and examiners as to how best draft software and business method applications such that the claims fall within the purview of patentable subject matter.⁵ If history is any guide, patent attorneys will be steered to use claim language that allows for the continued patenting of software and/or business methods, provided that the proper limiting language, as supported by the specification, is used.

Patents do not typically rank relatively high in terms of gripping and engrossing reading. The language, syntax and structure typical of patents are not necessarily what one would want to use to promote the Progress of Science and useful Arts. This readability, which is supposed to be set out in "full, clear, concise, and exact terms"⁶ is often even further diminished by the additive boilerplate, repetitive and redundant language and disclaimers, among other fillers, that patent drafters add to protect themselves from past, current and future shifts in patent policy, among other uncertainties in the prosecution of the patent application and its subsequent possible litigations.

¹ The opinions expressed herein are my own and may not necessarily reflect the opinions of the law firm, its practitioners or its clients.

² *Bilski v. Kappos*, 130 S. Ct. 3218 (2010); *Mayo Collaborative v. Prometheus Labs.*, 132 S. Ct. 1289 (2012); *Association for Molecular Pathology v. Myriad Genetics, Inc.*, 132 S. Ct. 1794 (2012)

³ 35 USC § 101

⁴ *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.* Docket nos. 13-298 (2014)

⁵ <http://www.uspto.gov/patents/law/exam/memoranda.jsp>

⁶ 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112

In short, patent drafters often load up patents with seemingly extraneous language for a number of possible of reasons. Not least is the conventional wisdom that they have nothing to lose: it can't hurt and can only help.⁷

They may be mistaken.

The Patent Specification

In the *quid pro quo* of patents, the patentee is required, in exchange for a 20 year monopoly on their invention, to provide an enabling disclosure of their invention;⁸ i.e., the patent specification.

Under 35 USC § 112, “[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.”⁹

“This *quid pro quo* is fundamental to patent systems. The statutory requirements of description, enablement, and best mode, implement this policy, for these requirements facilitate understanding and elaboration of the inventor's contribution.”¹⁰

Somewhat counter-intuitively,¹¹ these three statutory requirements are separate and distinct with corresponding distinct requirements.^{12 13 14} The written description requirement, as described above, the somewhat related¹⁵ enablement requirement that requires the patentee to “disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to

⁷ Or, “[F]or the apparent purpose of warding off evil spirits and narrow claim construction.” Joseph E. Root, Rules of Patent Drafting: Guidelines from Federal Circuit Case Law, 85 (Feb 2, 2011).

⁸ *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 999 (Fed. Cir. 2008)

⁹ 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112,

¹⁰ *Classen Immunotherapies, Inc. v. Biogen IDEC*, 659 F.3d 1057, 1072 (Fed. Cir. 2011).

¹¹ *Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1362 (Fed. Cir. 2010)(Rader. J. dissenting)

¹² *Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d at 1341 (Enablement and Written Description are distinct requirements)

¹³ *In re Newton*, 414 F.2d 1400 (CCPA 1969) (Best mode is a separate requirement)

¹⁴ *Univ. of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916, 921 (Fed.Cir. 2004) (Although overlapping written description and enablement are distinct and a patent can be invalidated on either grounds)

¹⁵ *Capon v. Eshhar*, 418 F.3d 1349, 1360 (Fed. Cir. 2005)

enable one skilled in the pertinent art to make and use the claimed invention”¹⁶ without undue experimentation,¹⁷ and a recently subdued best mode requirement, e.g., the best mode contemplated by the inventor of carrying out his invention. While post the AIA (American Invents Act)¹⁸, the best mode is no longer a viable defense in patent infringement suits,¹⁹ it remains a requirement in patent drafting,²⁰ its goal, to force inventors to make a full disclosure, including the best way to practice the invention.²¹

And although the written description and the enablement requirements usually rise and fall together,²² a patent specification can fulfill the written description requirement without necessarily being enabling, and the curious corollary,²³ an invention specification can be enabling without necessarily fulfilling the written description requirement.²⁴

As set out in 37 CFR § 1.71, in order to comply with the written description requirement the patentee must "convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the [claimed] invention”²⁵ Thus, fulfilling the written description requirement also confirms that the patentee is either in possession of the invention or has reduced the invention to practice, although possession and reduction to practice does not necessarily satisfy the requirement.²⁶

Whether or not the patentee has actually complied is a question of fact.²⁷ According the Manual of Patent Examining Procedure “the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.”²⁸ Accordingly, the applicant is

¹⁶ MPEP § 2164 The Enablement Requirement.

¹⁷ *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

¹⁸ Leahy–Smith America Invents Act (AIA) Pub. L. 112–29 (Sept. 16, 2011).

¹⁹ Section 15 of the AIA, amending 35 U.S.C. § 282.

²⁰ 35 USC § 112(a)

²¹ *In re Nelson*, 280 F.2d 172, (CCPA 1960).

²² *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1345(Fed. Cir. 2005).

²³ *In re Barker*, 559 F.2d 588, 595 (C.C.P.A. 1977) (Markey, J., dissenting).

²⁴ *In re Armbruster*, 512 F.2d 676, 677 (CCPA 1975).

²⁵ *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319 (Fed. Cir. 2003); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed.Cir.1991)

²⁶ *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 969 (Fed. Cir. 2002).

²⁷ *ICU Med., Inc. v. Alaris Med. Sys., Inc.*, 558 F.3d 1368, 1376 (Fed. Cir. 2009).

²⁸ MPEP § 2163.02 Standard for Determining Compliance With the Written Description Requirement [R-11.2013]

supposed to describe the invention with all of its limitations using, for example the figures and text of the application.²⁹

The factual question notwithstanding, the courts have seen fit to regulate this question of fact: the description needed to satisfy the requirements of 35 USC § 112 “varies with the nature and scope of the invention at issue, and with the scientific and technologic knowledge already in existence.”³⁰ Thus, for example, the requirements for the written description are not applied uniformly across all technologies;³¹ the law is applied differently to the predictable arts (e.g., simple mechanics) than to the non-predictable arts (e.g., biotechnology).³² Given these distinctions in application, it is likely that some of the case law cited herein may be applicable only to the art of that case, and the courts may (although they may not) rule differently when presented with different circumstances and particularly with different art.

Drafting a coherent and statutorily correct specification in light of the law and that supports the claims of the patent is no easy task³³; claim limitations must be supported in the specification through express, implicit, or inherent disclosure³⁴

The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention.³⁵

²⁹ *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

³⁰ *Capon v. Eshhar*, 418 F.3d 1349, 1357 (Fed. Cir. 2005).

³¹ Greenbaum, Dov. "An Analysis of Federal Circuit Discrimination: The Evolution of the Written Description Requirement Vis-a-Vis DNA and Biotechnological Inventions Concerns for Synthetic Biology." *Recent patents on DNA & gene sequences* 5.3 (2011): 153-165.

³² *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1367 (Fed. Cir. 1997); *In re Fisher*, 421 F.3d 1365 (Fed. Cir. 2005) .

³³ *Sperry v. Florida*, 373 U.S. 379, 383 (1963)(“ drafting of the specification and claims of the patent application, 35 U. S. C. § 112 ... constitute[s] one of the most difficult legal instruments to draw with accuracy”).

³⁴ MPEP § 2163

³⁵ *Topliff v. Topliff*, 145 U.S. 156 (1892).

Examiners reviewing a patent application are trained to determine if “the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.”³⁶

The difficulty of composing an adequate specification notwithstanding, the patentee is assumed to have successfully done this when they submit their application.³⁷ Nevertheless, this presumption and the adequacy of the specification can be raised by the examiner.³⁸

The specification also provides guidance for the courts³⁹ to conduct claim construction. Courts apply two somewhat conflicting cannons in construing claims based on the specifications. As a result of *Phillips*, the court is supposed to construe claims in light of the specification, giving claims “their broadest reasonable interpretation consistent with the specification⁴⁰”; but, simultaneously, “without unnecessarily importing limitations from the specification into the claims.”⁴¹

Patent Claims

“The name of the game is the claim.”⁴²

Claim language can change drastically over the lifespan of a patent; the set of claims as filed are rarely the same set of claims in the final patent. The patentee has numerous opportunities during the prosecution⁴³ and later post-grant and litigation phases of the patent to change or alter the meaning of a claim, as necessary.

Claims may be changed for a number of reasons: to clarify terminology, to overcome prior art raised by the examiner, to overcome other statutory rejections cited by the examiner, to better fit with the eventual marketed product, to better represent the invention as it matures, to encompass an infringing product,(with some limitations) to survive post-grant review,⁴⁴ or to survive a

³⁶ *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).

³⁷ *In re Wertheim*, 541 F.2d 257, 262, (CCPA 1976).

³⁸ *Regents of the Univ. of Cal. v. Eli Lilly*, 119 F.3d 1559 (Fed. Cir. 1997).

³⁹ *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996).

⁴⁰ *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005).

⁴¹ *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371 (Fed. Cir. 2003).

⁴² Giles S. Rich, *Extent of Protection and Interpretation of Claims—American Perspectives*, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990).

⁴³ 37 CFR §1.121

⁴⁴ 35 USC §§ 316(d) 35 U.S.C. §§ 326 (d)

change in the law, among other reasons. Claims can also be added to reissued patents⁴⁵ and continuation applications⁴⁶ during the lifetime of the parent prosecution, provided that they too are supported by the specification.

However, these changes must be supported by the specification. “While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure.... If the originally filed disclosure does not provide support for each claim limitation, or if an element which applicant describes as essential or critical is not claimed, a new or amended claim must be rejected under 35 USC § 112(a) or pre-AIA 35 USC § 112, para. 1, as lacking adequate written description.⁴⁷

As such, drafters often need to think about including language that will provide the necessary statutory support for new claims and claim amendments, most of which only become a necessity once given future unknowns become knowable. This leads drafters in many instances to effectively hedge their bets, putting in language, often straight-up boilerplate, that attempts to broaden and/or allow wiggle room within the specification to allow for changes in the claims down the line to account for these changing realities. In other instances, drafters just put in boilerplate language indifferent to the necessity of altering claims language later. Whatever the purpose of the boilerplate, perhaps it’s probably at least best not to have the majority of the specification as boilerplate.⁴⁸

The reasons for adding such language notwithstanding, it seems reasonable to appreciate whether such boilerplate language can ever help, or whether it can even hurt future developments within the application. With a greater appreciation for how such language is perceived by the courts, drafters may choose differently when drafting their specifications.

Boilerplate

In general, it would seem that the courts don’t think very highly of general boilerplate language in a specification.

⁴⁵ 35 USC § 251

⁴⁶ MPEP § 201.07

⁴⁷ MPEP § 2163

⁴⁸ US Patent 7,773,702 to Einbindier.

Exaltation of Form over Substance

As far back as 1981, the Court of Customs and Patent Appeals, the immediate precursor to the Federal Circuit, suggested that the Patent and Trademark Office Board of Appeals insistence that the patentee include “a boilerplate recitation in the specification that the specific embodiment shown was not meant to limit the breadth of the claims, or that the example given was only one of several methods which could be employed” was an “exaltation of form over substance.”⁴⁹ More recently, in oral arguments in *Laube v Rea* (2013-1048) (Fed. Cir. Sept. 17, 2013)(Non Precedential) the Federal Circuit responded similarly phrased language comprising:

“While the invention has been particularly shown and described with respect to the illustrated and preferred embodiments thereof, it will be understood by those skilled in the art that the foregoing and other changes in form and details may be made therein without departing from the spirit and scope of the invention.”

By stating:

“that’s in virtually every patent ...that boilerplate alone can’t be the answer if its every patent ... you shouldn’t think that the boilerplate will help you.”⁵⁰

Nor is such a disclaimer necessarily necessary. In *Golight v Walmart*⁵¹ the Federal Circuit reiterated earlier rulings that found that “[a]bsent a clear disclaimer of particular subject matter, the fact that the inventor anticipated that the invention may be used in a particular manner does not limit the scope to that narrow context.”

Unpersuasive Boilerplate

And even when it is employed, the Court may view boilerplate as unpersuasive or unhelpful.⁵²

For example, in *Akeva LLC v. Adidas*,⁵³ the court ruled that while the disclaimer claimed one thing: “it is intended that the present invention cover all possible combinations of the features shown in the different embodiments, as well as modifications and variations of the invention, provided they come within the scope of the claims and their equivalents,”

⁴⁹*In re Max Otto Henri RASMUSSEN* 650 F.2d 1212, f7 (1981).

⁵⁰ Oral Arguments available at <http://www.cafc.uscourts.gov/oral-argument-recordings/all/laube.html>

⁵¹ *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F. 3d 1327 (Fed. Cir 2004).

⁵² *Nagle Indus. v. Ford Motor Co.*, 194 F.3d 1339 (Fed. Cir. 1999).

⁵³ *Akeva LLC, Adidas-Salomon AG; Adidas America, Inc*, 208 Fed. Appx. 861 (Fed. Cir. 2006).

the specification suggested another. The court determined that when the specification, when “read as a whole clearly demonstrates that the scoop [sic] of the invention is narrower than the disclaimer implies.”⁵⁴

There are other instances where the court ignored the teachings of the disclaiming boilerplate in favor of reading the rest of the specification.

In *Silicon Graphics, Inc. v. ATI Technologies* the court suggested that “general language in the specification ... does not work to contradict the specific language...”⁵⁵

And for example, in *Wireless v. Sony*,⁵⁶ the court dismissed boilerplate language that the patentee argued should broaden the scope of the specification to cover the claimed infringing product, noting that the vague broadening language of the boilerplate was not helpful in dissuading the court from their more narrower reading of the specification.

In light of these decisions, Judge Lourie, in a recent dissent, summarizes the Federal Circuit’s seeming position with regard to boilerplate:

The fine distinctions we often make concerning what is disclosed in a specification arise of course from how the inventors describe aspects of their invention. They describe embodiments of the invention ... in frequent boilerplate, [to] indicate that the invention isn't to be limited to what is expressly disclosed (as if they were unable to describe anything else they actually invented). Questions then arise as to whether an invention is limited to a preferred embodiment, or to the disclosed embodiments, or to what the specification in some language indicates is part of the invention. ... In almost all cases, the inventors, and their patent solicitors, knew what was invented and generally disclosed their invention in competent language. Unfortunately, the nature of our adversary system often causes those patents to be asserted against someone engaged in activity not contemplated by the inventors as part of their invention. So the patent is used as a business weapon against such parties, and litigation counsel attempt to fit a square peg into a round hole, or, in other words, to fit into the claim language what the inventors never contemplated as part of their invention. ... But in construing the claims we should avail ourselves of the knowledge we glean from the patent specification to see what the inventors disclosed as their invention. The bottom line of claim construction should be

⁵⁴ See also: *Les Traitments Des Eaux Poseidon, Inc. v. KWI, INC.*, 135 F. Supp. 2d 126(D. Mass 2001) (actual language in the specification “belies” the disclaiming language”).

⁵⁵ *Silicon Graphics, Inc. v. ATI Technologies, Inc.*, 607 F. 3d 784, 791-2 (Fed. Cir. 2010).

⁵⁶ *Wireless Agents LLC v. Sony Ericsson Mobile Communs. Ab*, 189 Fed. Appx. 965 (Fed. Cir. 2006).

that the claims should not mean more than what the specification indicates, in one way or another, the inventors invented.⁵⁷

Taking their cue from the Federal Circuit, lower courts have also found boilerplate unpersuasive when it seems to conflict with the specification.

In *Les Traitments Des Eaux Poseidon, Inc. v. KWI*, the court found that boilerplate suggesting that the general description was non-restrictive carried “little weight, however. It is not possible to have an "essential" structural feature also be "non-restrictive.”⁵⁸

Further, in *Ex Parte Shirley*⁵⁹ the Board of Patent Appeals and Interferences (BPAI, now the Patent Trial and Appeal Board (PTAB)) found that efforts to disclaim a statement as not constituting prior art failed: “the use of alternative characterizations like “related art” and prophylactic prior-art disclaimers, such as the one included in the present Specification, are commonplace in patent prosecution. ... these alternative characterizations and prior-art disclaimers must be reviewed on a case-by-case basis, and in light of the record as a whole, to determine which disclosures and statements, if any, actually constitute prior-art admissions.”⁶⁰

Boilerplate Disclaiming Prior Art

It behooves the drafting agent to be careful when disclosing anything that can be construed as prior art as it can be used as an admission against oneself.⁶¹

Another background disclaimer, provided it is supported by the specification may also be helpful: disclaiming a complete description of earlier art. As per the MPEP “Care should be taken to see that inaccurate statements or inaccurate experiments are not introduced into the specification, either inadvertently or intentionally.”⁶² Intentional misrepresentations can invalidate the patent.⁶³

⁵⁷ *Arlington Industries, Inc. v. Bridgeport Fittings*, 632 F. 3d 1246, 1257-58 (Fed. Cir. 2011).

⁵⁸ 135 F. Supp. 2d at 135.

⁵⁹ Appeal 2009-2352.

⁶⁰ *Ex parte Shirley*, at 25.

⁶¹ *In re Nomiya*, 509 F.2d 566, 571 (CCPA 1975).

⁶² MPEP § 2004.

⁶³ *Hoffmann-La Roche, Inc. v. Promega Corp.*, 323 F. 3d 1354 (Fed. Cir. 2003).

Non-Boilerplate Boilerplate

Arguably, the best boilerplate are broadening statements, that while simplistically seem like boilerplate, they are in actuality targeted and focused to the actual case and that represent the actual intent of the inventor rather than the copy and paste skills of the drafter.⁶⁴ Thus, broadening statements done right may be broad enough to effectively provide cover, but specific enough to the invention that the courts can appreciate that broader scope was at least contemplated, not just grabbed with a drafter's language. Thus in *Fromson*, the court found that a boiler-plate statement that other "suitable liquids" can be used, is insufficiently specific to include dissolving electrolytes such as are used by *Fromson*.⁶⁵ It is perhaps this insufficiently specific cue that many of the lower courts have subsequently looked to when faced with the issue of changing claim language based on boilerplate.

Thus whereas the "cautionary language" relied upon by the plaintiff in *ICHL* that "various modifications" can be made and "alternative materials, shapes and dimensions may be utilized," did "not compel the construction Plaintiff advances."⁶⁶ and in other cases where "generalized statements are nevertheless unpersuasive,"⁶⁷ When the language does seem to be tied directly to the application before the examiner or the courts, such language may be useful.

As such when language was written to be relevant to the application at hand, it has been found to carry weight. For example, in *Grant St. Group v Realauction*, the district court found that a clause "It will be appreciated that although the embodiments described herein relate to financial instruments such as municipal bond auctions, the disclosed process is applicable to many other types of auctions" carries some weight as "One of skill in the art would see this as more than boilerplate. It refers to "financial instruments," "such as municipal bond auctions" and that the process is applicable to many other types of auctions. Granted it is not a lot but it focuses squarely on financial instruments and other types of auctions which is the subject to be constructed."⁶⁸

⁶⁴ *Honeywell Int'l, Inc. v. ITT Indus. Inc.*, 452 F.3d 1312, (Fed. Cir. 2006).

⁶⁵ *Fromson v. Anitec Printing Plates*, 132 F.3d 1437, 1447 (Fed. Cir. 1997).

⁶⁶ *ICHL, LLC v. NEC Corporation Of America* (E.D. Tex. 2010) ("Such boilerplate language is given no weight here")

⁶⁷ *Aspex Eyewear, Inc. v. Altair Eyewear, Inc.*, 386 F. Supp. 2d 526 (S.D.N.Y. 2005).

⁶⁸ *Grant St. Group, Inc. v. Realauction.com, LLC*, 2010 U.S. Dist. LEXIS 141157, 29-30 (W.D. Pa. 2010).

This is most recently evident in *Northrop v Intel*⁶⁹ where the court concluded that the statement 'the present invention may be made to conform to any one of a variety of data transfer algorithms,' wasn't just "mere 'boilerplate' suggestion of broad application," as that the patentee "provide[d] substantive, albeit general, support for that declared intention."

Boilerplate Lists

While it would seem straight forward then that optimally one should put in relevant boilerplate, and at worst that boilerplate would be given no weight; the Federal Circuit has not made it that simple. One particular area of boilerplate is fraught with risks: Lists

In some instances, boilerplate can be 'useful' when applied to lists. In one recent example, boilerplate was used to expressly announce that said that a provided list was non-exhaustive.⁷⁰ In its analysis, the court found that as the list was "explicitly prefaced with a description that the enumerated articles are "example[s]." The natural reading of this paragraph, and the only reading that does not violate this court's repeated prohibition against importing limitations from the specification, is of a non-exhaustive list that, if anything, broadens the definition of "communications medium."⁷¹

Here, the Federal Circuit acknowledged boilerplate as supporting what is anyway their rule against importing limitations from the specification. Thus the language in the application was useful to the court, the court nevertheless also based their ruling on other justifications as well.

⁷² Similarly in *PersonalWeb v Microsoft*, the court found that a construction could not be limited to a non-exhaustive list of "merely permissive" alternatives.⁷³

Other instances of boilerplate related to listings have been less than helpful. Particularly when that list expands the scope of the description to allow for a lot of alternatives, and then only

⁶⁹ *Northrop Grumman Corp. v. Intel Corp.*, 325 F.3d 1346 (Fed. Cir. 2003).

⁷⁰ *Dealertrack, Inc. v. Huber*, 674 F.3d 1315 (Fed. Cir. 2012).

⁷¹ 674 F.3d at 1322.

⁷² See also, *JVI, Inc. v. Truckform Inc.*, 2012 U.S. Dist. LEXIS 181769, 27-28 (D.N.J. Dec. 26, 2012)(While the inclusion of this sort of boilerplate phrase does not dictate my construction of Plaintiff's claims, it cautions against reading limitations into the claims.)

⁷³ *PersonalWEB TECHNOLOGIES, LLC v. Microsoft Corp.*, No. 6:12-CV-663. (E.D. Texas August 6, 2013)(and related cases).

claims one or some of those alternatives, the courts may find that the specification lacks sufficient disclosure, e.g., lacks blaze marks to show how the patentee came to claim just a small percentage of the specification's disclosed list.⁷⁴

In general, the courts have not been fond of these 'laundry lists' of possible limitations.⁷⁵ In *Novozymes*, the patentee provided a laundry list of 8.598 x 1042 different possibilities and subsequently filed a continuation application with claims directed toward an infringing product. In court, *Novozymes*' patent was found invalid under 35 USC § 112. The court ruled that "no reasonable jury could find that the claims of the '723 patent meet the written description requirement of § 112, ¶ 1; one searches the ... application in vain for the disclosure of even a single species that falls within the claims or for any "blaze marks" that would lead an ordinarily skilled investigator toward such a species among a slew of competing possibilities."⁷⁶

Another problem with boilerplate lists may occur if and when an inventor is being deposed and they distance themselves by the boilerplate lists added in by the patent drafter. Such a situation may raise heretofore unappreciated issues of inventorship, although Federal Circuit case law suggests that "an inventor's after-the-fact testimony is of little weight compared to the clear import of the patent disclosure itself."⁷⁷

Public Dedication of unclaimed Boilerplate

Some patentees provide numerous examples of alternatives to the preferred embodiment within the specification. This is often presented in some form of boilerplate-like language as seen in some cases cited above. While this may seem to provide the patentee with broad scope and coverage if and when their claims evolve, it may also result in some unintended consequences;

⁷⁴ *In re Ruschig*, 379 F. 2d 990 – (C.C.P.A. 1967).

⁷⁵ *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996).

⁷⁶ *Novozymes v. Dupont Nutrition Biosciences APS*, No. 2012-1433 (Fed. Cir. July 22, 2013).

⁷⁷ *Solomon v. Kimberly-Clark Corp.*, 216 F. 3d 1372, 1379-80 (Fed. Cir. 2000)(citing *Markman*).

for example, limiting the extent to which the patentee can claim infringement under the doctrine of equivalents.

In litigation, the doctrine of equivalents (DOE) allows the patent holder to claim infringement even in the absence of literal infringement.⁷⁸ Although typically limited through prosecution history estoppel,⁷⁹ the patentee is also estopped from claiming infringement under the DOE when they have dedicated the subject matter to the public: "[W]hen a patent drafter discloses but declines to claim subject matter . . . this action dedicates that unclaimed subject matter to the public . . . Application of the doctrine of equivalents to recapture subject matter deliberately left unclaimed would "conflict with the primacy of the claims in defining the scope of the patentee's exclusive right."⁸⁰

This public dedication rule can include even matter that was disclosed only via an incorporation by reference, even just in the background section,⁸¹ if that "disclosure of that subject matter is of such specificity that one of ordinary skill in the art could identify the subject matter that had been disclosed and not claimed."⁸² It is however limited to instances where "that unclaimed subject matter must have been identified by the patentee as an alternative to a claim limitation."⁸³ It remains unclear as to whether instances of a disclosure of only one limitation from a set of limitations is limited to when said limitation is part of the independent claim. Arguably, the doctrine of claim differentiation⁸⁴ would limit the applicability of the disclosure-dedication rule in instances where the limitation is in the dependent claim and that dependent claim would be interpreted to have the same scope as the independent claim if the other described embodiments were by default dedicated to the public.

Boilerplate and Changing Patent Law

⁷⁸ *Warner-Jenkinson Company, Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997).

⁷⁹ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002).

⁸⁰ *Johnson & Johnston Assocs., Inc. v. R.E. Serv. Co., Inc.*, 285 F.3d 1046, 1054 (Fed.Cir.2002).

⁸¹ *Toro Co. v. White Consolidated Industries, Inc.*, 383 F. 3d 1326 (Fed. Cir. 2004).

⁸² *SanDisk Corp. v. Kingston Technology Co., Inc.*, 695 F. 3d 1348 (Fed. Cir. 2012).

⁸³ *Pfizer, Inc. v. Teva Pharmaceuticals USA, Inc.*, 429 F.3d 1364 (Fed.Cir.2005).

⁸⁴ *Ecolab, Inc. v. Paraclipse, Inc.*, 285 F.3d 1362, 1375 (Fed. Cir. 2002).

In some instance, as the courts slowly evolve 35 USC §101 jurisprudence, patentees may find it necessary to include additional boilerplate language that allows them to rewrite their claims as the law itself is rewritten underneath them.

Although, this isn't always necessary. When *In re Nuijten* was decided⁸⁵, the Director of the USPTO, then David Kappos, allowed those who had claims directed to computer readable media that covered unpatentable signals per se to be amended such that they would now be limited to permissible non-transitory signals. Director Kappos allowed these changes even when they weren't supported explicitly in the specification: "Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals per se."⁸⁶ Kappos took cover for this decision behind an earlier 1987 decision wherein the USPTO allowed the inclusion of a non-human limitation to avoid 101 rejections. This was a rather novel situation, particularly as under a somewhat complicated to enforce Federal Circuit law, it would seem that if non-transitory was not expressly disclaimed in the application, it cannot be expressly excluded from the claims.⁸⁷

Patentees may not be as lucky the next time. As such, it may be prudent to include specification language for hedging against further narrowing of patentable subject matter.

Boilerplate and Functional Claiming

Software claims also benefit from boilerplate and disclaiming language when drafting claims that may be construed as functional claims, i.e., when the recitation uses descriptive language about "what it does rather than ... what it is"⁸⁸ While functional claiming is not disallowed per se, the courts often find such language to be indefinite.⁸⁹ Examiners will often look to the specification to find support and patentees can, when faced with a rejection, "amend the claims to recite the

⁸⁵ *In re Nuijten*, 500 F. 3d 1346 (Fed. Cir. 2007).

⁸⁶ David J. Kappos, Subject Matter Eligibility of Computer Readable Media 1/26/2010

⁸⁷ *In re Bimeda Research & Development Ltd.*, No. 12-1420 (Fed. Cir. July 25, 2013).

⁸⁸ *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 229 (CCPA 1971).

⁸⁹ *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1353 (Fed. Cir. 2010) (*en banc*).

particular structure that accomplishes the function.”⁹⁰ Here, boilerplate language involving parts of computers and their functions may be useful in providing 112 support for said amended claims.

Functional claiming is a claim drafting technique that is showing a resurgence, particularly in the fields of hi tech and software. Functional claiming intends to cover all possible devices that do the recited function, thus providing the patentee with broad scope. In the post AIA patent law, the former 6th paragraph, now §(f), provides the relevant law for many instances of functional claiming: “An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”⁹¹

“[I]f one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.”⁹²

“If there is no corresponding structure disclosed in the specification (i.e., the limitation is only supported by software and does not correspond to an algorithm and the computer or microprocessor programmed with the algorithm), the limitation should be deemed indefinite as discussed above, and the claim should be rejected under 35 U.S.C. 112 ... Absence of the word “means” in a claim creates a rebuttable presumption that the claim element is not to be treated in accordance with 35 U.S.C. § 112(f). The presumption that § 112(f) is not invoked is rebutted when the claim element recites function but fails to recite sufficiently definite structure or material to perform that function”⁹³

⁹⁰ MPEP § 2173

⁹¹ 35 USC §112 (f)

⁹² *In re Donaldson*, 16 F.3d 1189, 1195 (Fed. Cir. 1994) (en banc).

⁹³ MPEP §2181 Identifying a 35 U.S.C. 112, Sixth Paragraph Limitation

In *Aristocrat*,⁹⁴ the court ruled that the patentee failed to provide sufficient support for their functional claims. The court found that that the patentee had disclosed only “at most, pictorial and mathematical ways of describing the claimed function of the game control means. That is not enough to transform the disclosure of a general-purpose microprocessor into the disclosure of sufficient structure to satisfy section 112 paragraph 6.” In subsequent cases, the court provided a narrow exception⁹⁵: in *In re Katz* the court found that an algorithm doesn’t have to be disclosed when the function can be achieved by any standard computer without any need for any subsequent special programming. To provide useful support however, the specification must provide clear guidance, for example, a link between a computer implemented means-plus-function limitation and the corresponding algorithm.⁹⁶

Other Jurisdictions

The above law is relevant primarily in practice before the United States Patent Office and US Federal Courts. In other jurisdictions, for example, examiners may be more wary of introducing new and amended claims that are not supported literally, *in haec verba*, in the specifications, or supported only in specific embodiments not relevant to the changing claim, both for narrowing⁹⁷ and for expanding the scope of the claimed invention in light of the specification.⁹⁸ In such situations, the drafter has to be especially careful in providing sufficient disclosure without saying too much.

Practical Considerations

The take home message is clear: one ought not just add copied boilerplate or disclaimers without at least attempting to integrate them into the scope of the specification.

⁹⁴ *Aristocrat Technologies Australia PTY Ltd. v. International Game Technology*, 521 F.3d 1328 (Fed. Cir. 2008).

⁹⁵ *Ergo Licensing, LLC v. CareFusion 303, Inc.*, 673 F.3d 1361 (Fed. Cir. 2012).

⁹⁶ *ePlus v. Lawson*, 700 F.3d 509 (Fed. Cir. 2012).

⁹⁷ EPO Guidelines for examination §4.1 The subject-matter to be excluded is not disclosed in the application as originally filed (so-called undisclosed disclaimers) (citing for example, cases G 1/03 and G 2/03).

⁹⁸ EPO Guidelines for examination §2.3 Content of the application as "originally" filed – general rules, citing The European Patent Convention, Article 123, available, at http://www.epo.org/law-practice/legal-texts/html/guidelines/e/h_iv_2_3.htm

When considering drafting boilerplate language it is also worth considering specifically why you want such language, what you intend to accomplish, will it be useful or useless given the caselaw and most importantly, whether or not it can actually harm your application, or a later position taken by the patentee.

In some instances this analysis is relatively straightforward, but in most, given the dearth of on point precedential rulings, it's not necessarily straightforward to determine the usefulness or even the harm of adding a set of boilerplate.