


33RD ATRIP CONGRESS

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FACULTÉ DE DROIT DE MONTPELLIER – FRANCE

Patent claim interpretation and new technologies: re-thinking the problem/solution approach

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PATENT CLAIM INTERPRETATION AND NEW TECHNOLOGIES: RE-THINKING THE PROBLEM/SOLUTION APPROACH

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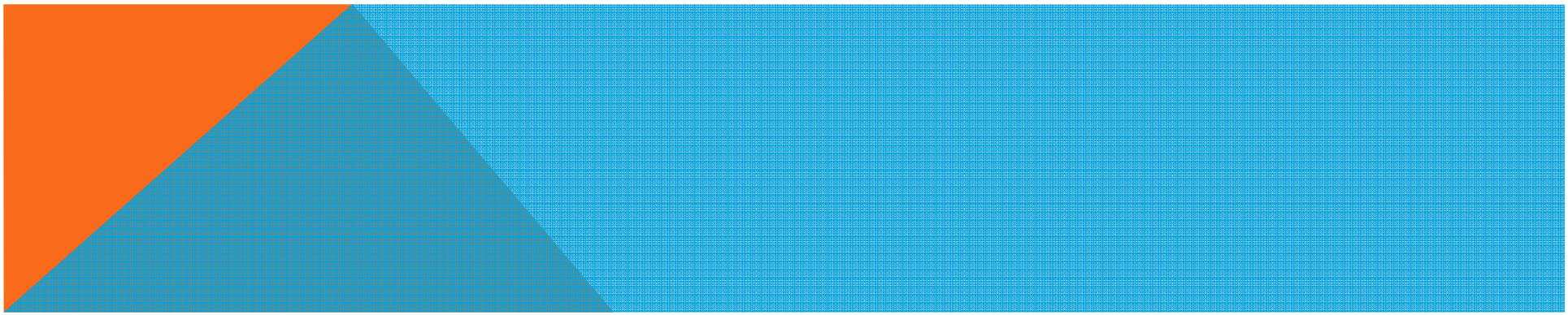
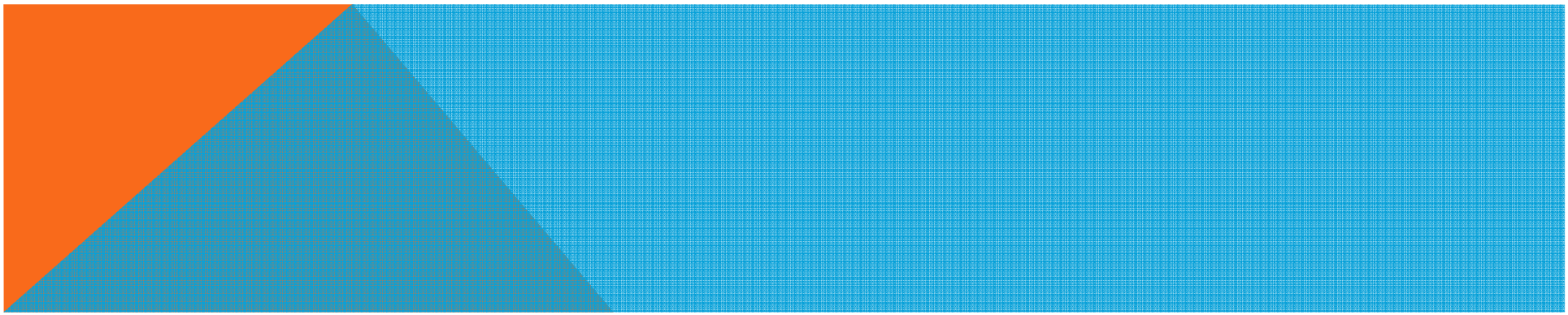
Abstract: The challenges of the Patent Law are innumerous. One of them is based on how we should interpret the scope of a patent protection. According to the TRIPS Agreement, the full disclosure of the technology is mandatory in order to obtain patent protection. At the same time, claim construction techniques are often based on broad protection and on what competitors would do to avoid infringement in the marketplace, and not only on the disclosure invention itself.

This study proposes a re-think of the patent claim interpretation using the problem/solution approach as a way to help to understand the scope of protection of the new technologies. Using the Equality Principle as a route to understand the scope of the patent protection (based on the differences in the multiple and always challenging new technologies in the different technology fields) we propose this re-thinking in order to look into the problem/solution approach as a way to help the patent claim interpretation techniques related to new technologies.



TOPICS

- **Patent Claim Interpretation;**
- **Some of the challenges related to the new technologies;**
- **Problem/solution approach;**
- **A re-think of the problem/solution approach.**



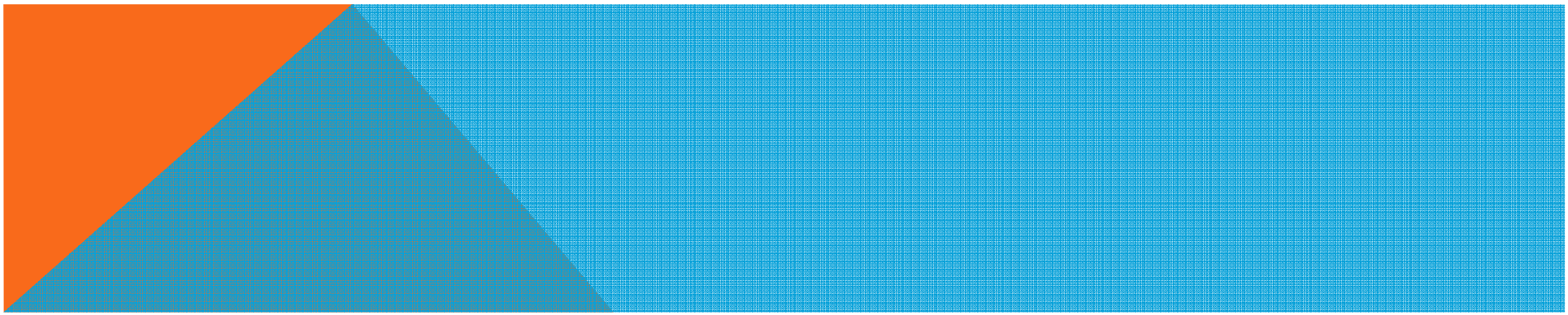
PATENT CLAIM INTERPRETATION

- **Hipertextualism or literalism: Examination of the text itself with little or no resort to other sources (ordinary meaning of the text)*;**

- **Pragmatic textualism or contextualism: More open to the examination of sources outside the claim text, including the prosecution history, technical documents and expert testimony in the relevant art*;**

- **Dynamic claim interpretation (Dan Burk conclusions): *"Dynamic claim interpretation, like dynamic statutory interpretation, is not a call to abandon the text under consideration, but it is a call to recognize that meaning is not manifest, immutable, or hermetic"*.**

*See Dan Burk's paper: "Dynamic claim interpretation", 2012, available at http://ssrn.com/abstract=2005251



CHALLENGES OF THE NEW TECHNOLOGIES

The New York Times: The Patent, Used as a Sword (By Charles Duhigg and Steve Lohr – October 7, 2012) – available at: http://www.nytimes.com/2012/10/08/technology/patent-wars-among-tech-giants-can-stifle-competition.html?pagewanted=all&_r=0

"(…) Soon, Apple's engineers were asked to participate in monthly "invention disclosure sessions." One day, a group of software engineers met with three patent lawyers, according to a former Apple patent lawyer who was at the meeting.

The first engineer discussed a piece of software that studied users' preferences as they browsed the Web.

"That's a patent," a lawyer said, scribbling notes.

Another engineer described a slight modification to a popular application.

"That's a patent," the lawyer said.

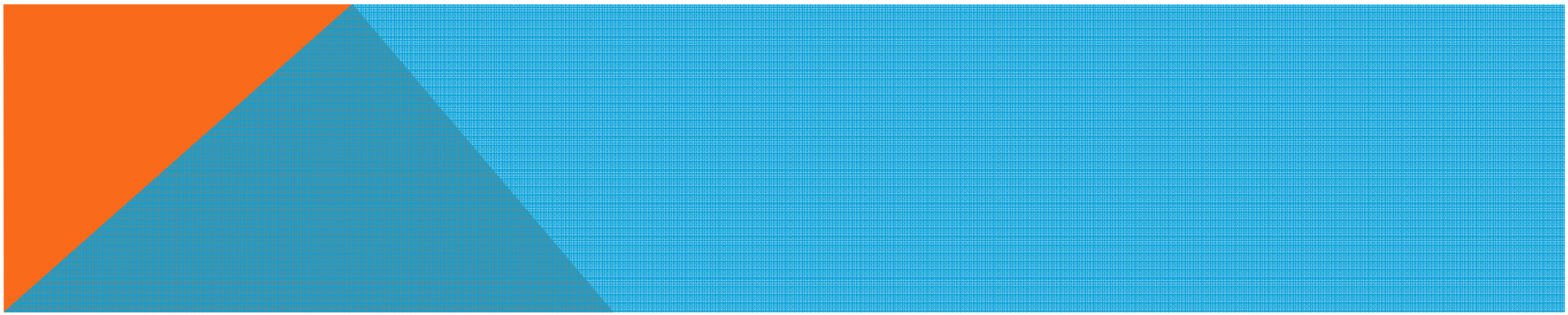
Another engineer mentioned that his team had streamlined some software.

"That's another one," the lawyer said.

"Even if we knew it wouldn't get approved, we would file the application anyway," the former Apple lawyer said in an interview. "If nothing else, it prevents another company from trying to patent the idea."

The disclosure session had yielded more than a dozen potential patents when an engineer, an Apple veteran, spoke up. "I would like to decline to participate," he said, according to the lawyer who was at the meeting. The engineer explained that he didn't believe companies should be allowed to own basic software concepts.

***It is a complaint heard throughout the industry. The increasing push to assert ownership of broad technologies has led to a destructive arms race, engineers say. Some point to so-called patent trolls, companies that exist solely to sue over patent violations. Others say big technology companies have also exploited the system's weaknesses**."*



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(...)

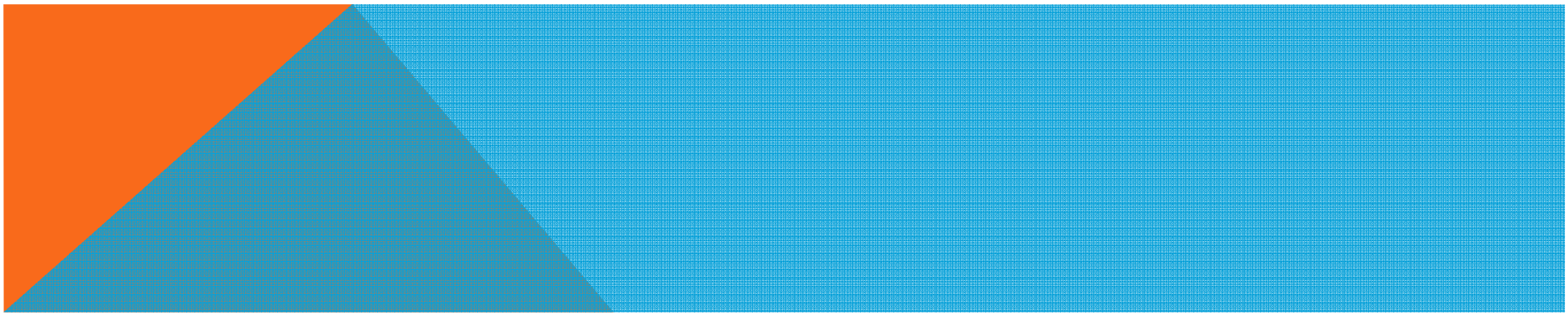
"**If you give the same application to 10 different examiners, you'll get 10 different results," said Raymond Persino, a patent lawyer who worked as an examiner from 1998 to 2005**."

(…)

"Though submitting an application repeatedly can incur large legal fees, it is often effective. **About 70 percent of patent applications are eventually approved after an applicant has altered claims, tinkered with language or worn down the patent examiners**."

(…)

"Intellectual property is property, just like a house, and its owners deserve protection," said Jay P. Kesan, a law professor at the University of Illinois. "We have rules in place, and they're getting better. And if someone gets a bad patent, so what?" he said. "You can request a re-examination. You can go to court to invalidate the patent. **Even rules that need improvements are better than no rules at all**."

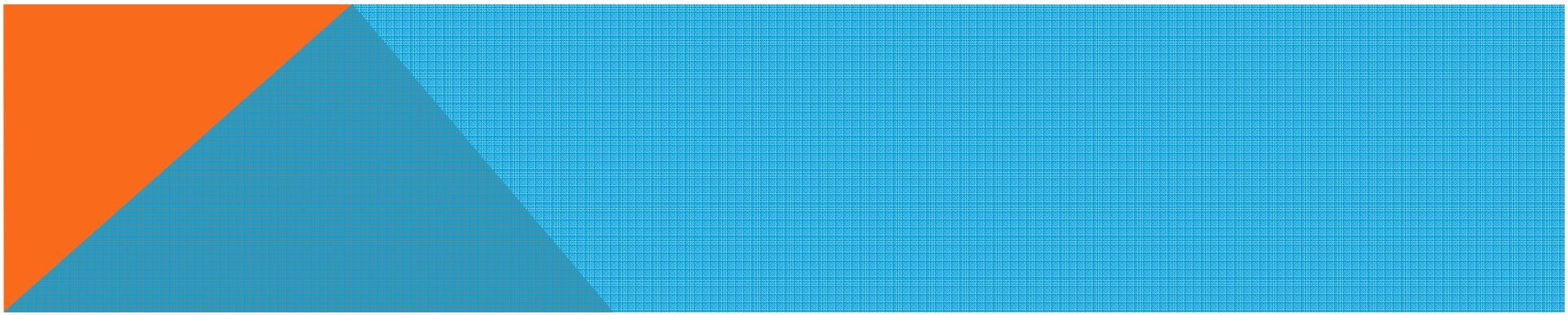


THE PROBLEM/SOLUTION APPROACH

Art. 56 of the European Patent Convention: “An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art”;

35 U.S.C. § 103: “A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made”.

Art. 13 of the Brazilian Industrial Property Law: “An invention is endowed with inventive step when, to a technician versed in the subject, it is not derived in an evident or obvious way from the state of the art”.



THE PROBLEM SOLUTION APPROACH

INVENTOR'S PERSPECTIVE

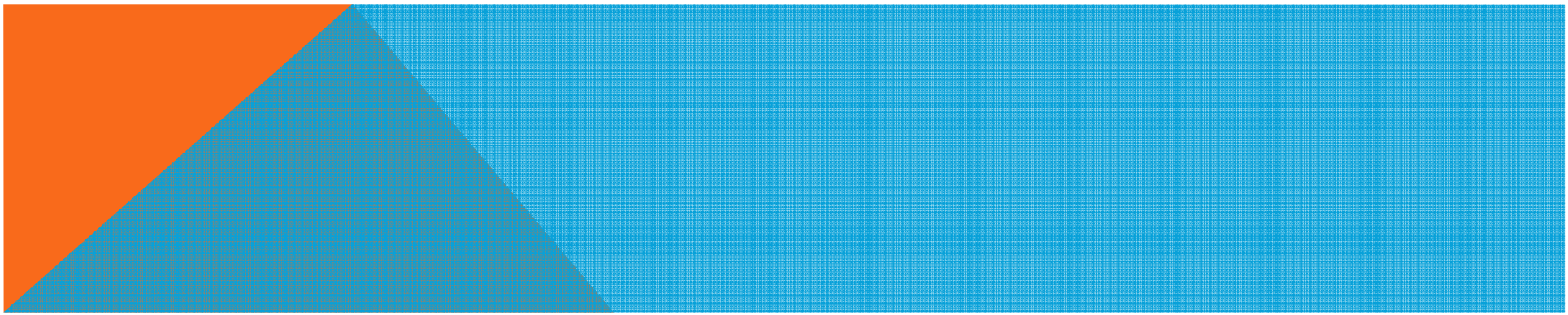
- Focused on the invention itself;

- Usually limited (or none) knowledge about disclosure, enablement, patent draft and claim construction techniques.

LAWYER/PATENT ATTORNEY PERSPECTIVE

- Focused on the best protection of the invention;

- Usually reasonable knowledge about disclosure, enablement, patent draft and claim construction techniques.



THE PROBLEM SOLUTION APPROACH

EPO AND BPTO(SIMILAR)

In the problem-and-solution approach, there are three main stages:

(i) determining the "closest prior art",

(ii) establishing the "objective technical problem" to be solved, and

(iii) considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person.

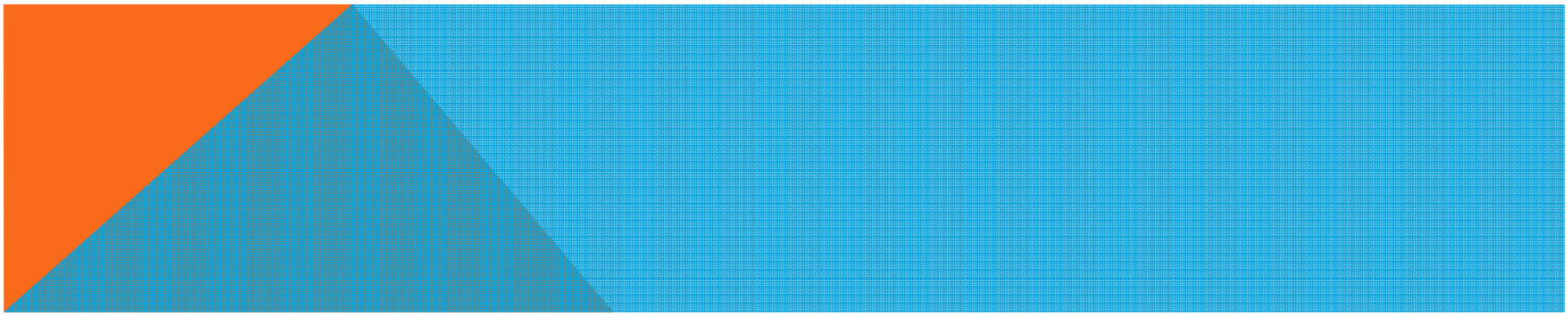
RE-THINKINGPOSSIBILITIES

(i) Clearly defining the problem(s) and solution(s) as proposed by the applicant;

(ii) determining the "closest prior art";

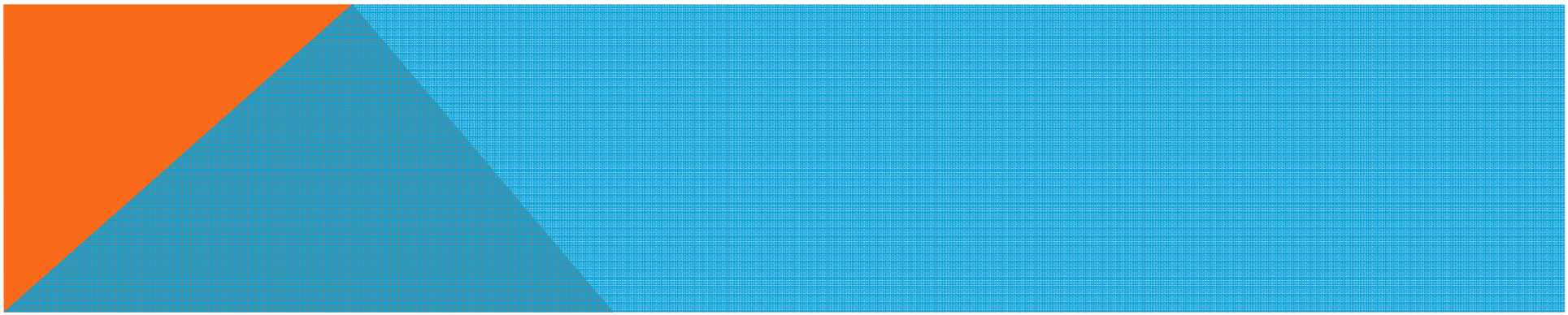
(iii) establishing the "objective technical problem" to be solved, and

(iv) considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person.



A RE-THINK OF THE PROBLEM/SOLUTION APPROACH

- **Dynamic claim interpretation as a way of looking into the problem/solution approach and its boundaries;**
- **New technologies leads to a return to (and a re-thinking of) the basis of the Patent Law;**
- **The problem/solution approach (based on the applicant patent disclosure) should be "highlighted" in the basis of examination and interpretation procedures since it is the most important condition to fulfill the inventive step requirement;**
- **Equality principle should "contaminate" the interpretation procedure.**



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THANK YOU!

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