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Food For Thought

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Patent Claim Charts

A claim chart is a table in which claim language is reproduced down the far left column and information regarding the analysis of the claim language is presented in the columns to the right.

Thorough, detailed claim charts are essential to understanding and testing substantive positions regarding claim interpretation, infringement, and validity. They are important tools for reliable risk-assessment; pre-negotiation and pre-litigation preparation; deciding whether to sue or to break off negotiations; guiding discovery; preparing claim construction briefs; preparing for and arguing at the claim construction hearing; setting up, briefing, and arguing summary judgment; presentation of your case at trial; success on appeal at the Federal Circuit; etc.

Claim charts also provide a useful template to guide the analysis of claim construction, infringement, and validity – helping to force all relevant issues to be expressly addressed. Properly-done claim charts therefore reveal strengths and weaknesses of your case – revealing the risks and helping to avoid unexpected and painful losses and the sting of attorneys' fee awards.

This Food For Thought provides some suggested best practices for claim charts.

Prelude: Parsing the Claim Language

- For all claim charts, the claim language should first be carefully parsed. Each word, phrase, and clause of a claim is important and can mean the difference between victory and defeat. But this step is often missed or poorly done, with potentially disastrous results.
 - Careful parsing serves multiple purposes:
 - It shows relationships between words, phrases, and clauses in the claim;
 - It ensures that every word, phrase, or clause that is potentially subject to interpretation is analyzed; and
 - It provides a roadmap for determining that every limitation of the claim (i) is found in the accused product, (ii) is found in the prior art; (iii) has the requisite support for enablement and written description; and/or (iv) is reviewed for its potential role vis-a-vis other doctrines (e.g., is the limitation, by itself or in combination with other limitations, "well-understood, routine, and conventional" for purposes of patent eligibility?).
 - As an example, the claim language "wherein the container including the composition and a biological sample located therein is storable at room temperature at room temperature for at least 14 days" is best parsed, at least initially, as follows:

Parsed Claim Language	Reasons for Parsing
wherein the container	This is <i>the object</i> of the limitation, the thing to which the remainder of the limitation refers.
including	I set the "including" clause off by itself for two reasons: (i) because that's how the claim drafter decided to write the claim, and (ii) just in case it makes a difference (which I can't tell at this preliminary "parsing" stage of the analysis). So, for the time being I want to keep the <i>container</i> and <i>its contents</i> analytically distinct. I indented this "including" clause to indicate how it is subordinate to and modifies the "container" language above it and how it at least facially further defines the object of the limitation.
the composition and	This is the first of two things that are in or associated with the container. I indented it to show how it is part of the "including" clause.

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a biological sample	This is a new concept ("a . . .") and the second thing that is in or associated with the container. I indented it to show how it is part of the "including" clause.
located therein	This language is parsed into its own row because it is a separate concept from the other two parts of the "including" clause (location vs. physical identity) and because there are <i>potential</i> ambiguities regarding, e.g., whether the biological sample is merely in the container or also necessarily in the composition. I can't tell at the parsing stage whether there is a real issue – but careful parsing showed me that there was at least a potential issue.
is storable	I set this two-word phrase off by itself because I want to be sure in my analysis to explore the issues regarding this phrase initially without distraction from the preceding or subsequent claim language. For example, the word "storable" or its other forms (e.g., "store," "storage") might be expressly or implicitly defined in or limited by the intrinsic evidence or might be a term of art in the field – in either case, it might limit the claim in a way that is not immediately obvious based on the claim language. I indented this phrase to indicate how it is subordinate to and modifies the "container" language above it. For the moment I kept it at the same indent level as "including . . ." because there is ambiguity about precisely what it is that is "storable" – e.g., is it the container when it has the composition and sample in it that is "storable" or is it the combination of all three – the container, the composition, and the sample – that is "storable"? These are different concepts, but I can't tell at this stage whether it matters.
at room temperature	I set these two phrases off separately (i) because each may be subject to interesting intrinsic or extrinsic evidence; and (ii) to maintain clarity that there are two separate limitations here.
for at least 14 days,	I indented these farther to indicate how they are subordinate to and modify the "storable" language above it.

- Failing to adequately parse – *i.e.*, lumping too much of a claim limitation into a single row of a claim chart – is a hallmark of weak and unreliable analysis. Nuances are not seen, opportunities for creative claim interpretation are missed, and, worst of all, critically important limitations on the scope of the claims end up buried, not recognized, and not analyzed.ⁱ
- Careful parsing aside, the relationships between and among multiple aspects of a limitation and their relationships to the claim as a whole must be kept in mind. Using indentations and colors to highlight repeated or related words or phrases can help.

Act I: Claim Construction Charts

- Claim construction charts are completed first. *Always*. You cannot determine whether there is infringement, a prior art issue, a written description problem, or other issue until the scope of the claim is analyzed and the issues, the alternative potential constructions, and objective likelihood of the district court adopting a given construction are known. ⁱⁱ
- Claim construction charts should include columns for each category of relevant evidence, including: ⁱⁱⁱ
 - plain meaning of the words of the claim as well as grammar, context, consistency, transitional words, and other information and clues to claim scope extractable from the claim language itself;
 - inferences that can be drawn from other claims (e.g., consistency, claim differentiation, independent/dependent relationships, etc.);
 - the specification ("the single best guide to the meaning of a disputed claim term" ^{iv});
 - the prosecution history (including any parent applications);
 - other intrinsic evidence (e.g., cited art);
 - other familial patents/applications; and
 - extrinsic evidence.
- The individual cells in the columns for each form of evidence should include both the relevant evidence and the argument(s) regarding how that evidence affects the meaning and scope of the limitation at issue. These cells

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should include direct quotations (or close paraphrasing) and citations to the precise location of the quote or other relevant information.

- Claim construction charts should also include columns for the proposed construction and supporting arguments (*i.e.*, the interpretation that supports your side of the case) and the potential weaknesses and counterarguments (this helps identify and clarify the likely areas of dispute upon which the claim construction phase will focus).
 - For purposes of generating an objective analysis, consider three relevant categories of claim constructions:
 - The one most likely to be adopted by the district court because it comports most closely with Federal Circuit precedent. I'll call this one "FC's Construction " for short.
 - The one under which an accused product infringes (*i.e.*, the one the plaintiff loves and the defendant hates). I'll call this one "P's Construction " for short.
 - The one under which an accused product does not infringe (*i.e.*, the one the plaintiff hates and the defendant loves). I'll call this one "D's Construction " for short
 - To varying degrees each of P's Construction and D's Construction will typically overlap with FC's Construction.
 - In general, the "proposed construction" column will focus on one of P's Construction or D's Construction and the "potential weaknesses and counterarguments" column will focus on the other. In each case, it is important to note where the arguments in each of these columns differ from FC's Construction – *e.g.*, if your proposed construction for a word, phrase, clause, or limitation differs from what would likely succeed based on Federal Circuit precedent, then that point should be clear in the cell for potential weaknesses and counterarguments.
- Note Regarding Efficiency: In many cases there will be particular claim language that appears, at least initially, to be of special interest – *e.g.*, in terms of providing a non-infringement position or bringing a piece of prior art within the scope of the claim. Analyzing the claim construction issues for that claim language first can be more efficient and, depending on the situation and needs, could be all that needs to be done at that time.

Act II: Infringement/Non-Infringement Claim Charts

- Infringement and non-infringement claim charts should include a column in which claim construction issues are indicated in summary form to keep them in mind and to ensure they are addressed as part of the analysis.
- Infringement and non-infringement claim charts should also include columns for:
 - the facts (*i.e.*, regarding the accused product) – this should include direct quotations (or close paraphrasing) and citations to the precise location of the quote or other relevant information;
 - arguments in favor of infringement (with subdivisions for literal infringement and doctrine of equivalents where appropriate); and
 - weaknesses in those arguments and counter-arguments – this helps identify and clarify the likely areas of dispute upon which the infringement case will focus.
- A common mistake is the focus an infringement or non-infringement chart and analysis exclusively on one's own proposed claim construction – *i.e.*, the one under which you are most likely to win. It's important to bring objectivity to the analysis by identifying weaknesses and counterarguments (*e.g.*, regarding the evidence itself and with respect to alternative claim constructions).
- Note that infringement and non-infringement arguments should *always* be linked to specific claim language. But I have seen, frighteningly often, an almost studious avoidance of specific claim language by many patent lawyers when explaining non-infringement positions.^v The claim chart format helps force the analysis to focus on the claim language.
- Separate charts should be done for each accused product to the extent they differ in any material way.

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- Depending on the statutory basis for alleged infringement, additional or different columns and special features may be useful.
 - As an example, if contributory infringement [*i.e.*, §271(c)] is at issue then it can be useful to color code the claim limitations to indicate which are found in the accused product and which are not. The other unique elements of contributory infringement (*i.e.*, material part of the invention, not staple article or commodity suitable for substantial non-infringing use, and knowledge/intent) often do not parse into a limitation-by-limitation format. But it can be helpful to include the evidence and argument for those elements in the same document – to keep things in one place for ease of reference and to help ensure nothing is overlooked. Sometimes additional columns and merged cells can provide appropriate space, while other times it will fit better in outline or table form below the claim chart. The claim chart then becomes more of an "elements of the infringement tort" document.
- Note Regarding Efficiency: As for claim construction analysis, there will sometimes be particular claim language that appears, at least initially, to be of special interest – *e.g.*, in terms of providing a non-infringement position or bringing a piece of prior art within the scope of the claim. Analyzing the infringement and non-infringement issues for that claim language first can be more efficient and, depending on the situation and needs, could be all that needs to be done at that time.

Act III: Validity/Invalidity Claim Charts

- Validity and invalidity claim charts should include a column in which claim construction issues are indicated in summary form to keep them in mind and to ensure they are addressed as part of the analysis.
- Validity and invalidity claim charts should include columns for
 - the facts (*i.e.*, regarding the disclosure of the prior art, the disclosure of the specification, etc.) – this should include direct quotations (or close paraphrasing) and citations to the precise location of the quote or other relevant information;
 - arguments in favor of validity (*e.g.*, how/why the prior art teaches the limitation, how/why the specification fails to disclose the limitation, etc.); and
 - weaknesses in those arguments and counter-arguments – this helps identify and clarify the likely areas of dispute upon which the validity case will focus.
- As for infringement and non-infringement charts, a common mistake is to focus the invalidity or invalidity chart and analysis exclusively on one's own proposed claim construction – *i.e.*, the one under which you are most likely to win. It's important to bring objectivity to the analysis by identifying weaknesses and counter-arguments (*e.g.*, regarding the evidence itself and with respect to alternative claim constructions).
- Note that prior art-based validity and invalidity arguments should *always* be linked to specific text, figures, or charts in the prior art. The claim chart format helps force the analysis to focus on the specific teaching in the prior art of each and every claim limitation.
- Separate charts should be done for each anticipatory reference, each group of obviousness references, enablement, written description, and other issues.
- Depending on the statutory basis for invalidity, additional or different columns and special features may be useful.
 - As an example, public use situations include elements regarding accessibility to the public/commercial exploitation and reduction to practice/enabling disclosure. Some aspects of those elements may involve individual claim limitations while other aspects do not. It can be helpful to include the evidence and argument for those elements in the same document as the claim chart – to keep things in one place for ease of reference and to help ensure nothing is overlooked, rendering the claim chart document more of an "elements of the defense" document.



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- Note Regarding Efficiency: As for the claim construction and infringement analyses, analyzing the validity issues for claim language of special interest first can be more efficient and, depending on the situation and needs, could be all that needs to be done at that time.

Examples of templates for claim construction, infringement, and anticipation charts are appended to this Food For Thought for reference.

ⁱ Many times I have seen claim charts with poorly parsed claim language in which meaningful claim limitations are overlooked – *i.e.*, the other columns, which represent the substantive analysis, focus on only part of the language in a glob of claim language shoehorned into a given row. Careful parsing is an important, but simple, way to ensure thorough analysis.

ⁱⁱ I was invited to a meeting once at which two of my direct reports were providing "final" advice to an internal client regarding infringement for purposes of clearing a product for sale. As the meeting got underway, I flipped through the specification and saw a few things that were at least facially inconsistent with the non-infringement position that they were explaining. I asked a few gentle questions about the specification (I did not want to spook the internal client) and quickly realized that they had not seen the inconsistent stuff and had not even read the specification, at least not carefully. Instead, they were basing their legal advice on their interpretation of the "plain meaning" of the claim language, without regard to the content of the specification – or, for that matter, the content of the prosecution history and other intrinsic evidence. I adjourned the meeting and asked them to please embark on a claim construction analysis before moving to infringement.

In light of what I had seen, I realized that I needed to ensure my own compliance with California Rule of Professional Conduct 5.1 (responsibilities of supervisory lawyers) by ensuring their compliance with California Rule of Professional Conduct 1.1 (competence). So, I asked them to run the results past me before advising the internal client about the infringement analysis and risks.

ⁱⁱⁱ I usually use Excel for claim charts so I can make my columns whatever width I need and can add as many columns to the right as I need.

^{iv} *Vitronics v. Conceptronic*, 90 F.3d 1576, 1582 (Fed. Cir. 1996); reinforced in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005)(en banc).

^v You can spot this kind of "dodge" easily. For example, when, rather than identifying specific claim language as the starting place, the patent attorney starts talking about "what they really invented," "what the patent is really all about," etc., you can be pretty sure that they do not have an authentic non-infringement position (much less a persuasive or winning non-infringement position).

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Claim Construction Chart – US Patent No. x,xxx,xxx

Claim Language	Language, Grammar, Plain Meaning	Other Claims	Specification	Prosecution History	Familial Patents (Specs, Pros Histories)	Other Intrinsic Evidence	Extrinsic Evidence	PROPOSED CONSTRUCTION & Arguments in Favor	Potential Weaknesses/Counterarguments
1. A container									
for preservation of a biological sample									
comprising:									
a composition comprising:									
at least one preservative,									
at least one buffering agent, and									
at least one enzyme inhibitor,									
a synthetic matrix comprising:									
at least one fiber									
selected from the group consisting of:									
a copolymer of lactide, glycolide, and trimethylene carbonate, and									
titanium-coated polypropylene,									
wherein an amount of the at least one buffering agent relative to an amount of the one or more enzyme inhibitors is									
about 8 parts by weight of buffering agent to									
about 3 parts by weight of enzyme inhibitor, and									
wherein the container									
including									
the composition and									
a biological sample									
located therein									
is storable									
at room temperature									
for at least 14 days.									

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Infringement Chart – US Patent No. x,xxx,xxx

Claim Language	Claim Construction Issues ¹	Facts – Accused Product	Argument in Favor of Infringement	Potential Weaknesses/Counterarguments
1. A container				
for preservation of a biological sample				
comprising:				
a composition comprising:				
at least one preservative,				
at least one buffering agent, and				
at least one enzyme inhibitor,				
a synthetic matrix comprising:				
at least one fiber				
selected from the group consisting of:				
a copolymer of lactide, glycolide, and trimethylene carbonate, and				
titanium-coated polypropylene,				
wherein an amount of the at least one buffering agent relative to an amount of the one or more enzyme inhibitors is				
about 8 parts by weight of buffering agent to				
about 3 parts by weight of enzyme inhibitor, and				
wherein the container				
including				
the composition and				
a biological sample				
located therein				
is storable			Literal:	Literal:
			DoE:	DoE:
at room temperature				
for at least 14 days.				

¹ See Claim Construction Chart for this patent for the details.

Anticipation Chart – US Patent No. x,xxx,xxx

Claim Language	Claim Construction Issues ¹	Facts – Disclosure of Prior Art X	Argument in Favor of Anticipation	Potential Weaknesses/Counterarguments
1. A container				
for preservation of a biological sample				
comprising:				
a composition comprising:				
at least one preservative,				
at least one buffering agent, and				
at least one enzyme inhibitor,				
a synthetic matrix comprising:				
at least one fiber				
selected from the group consisting of:				
a copolymer of lactide, glycolide, and trimethylene carbonate, and				
titanium-coated polypropylene,				
wherein an amount of the at least one buffering agent relative to an amount of the one or more enzyme inhibitors is				
about 8 parts by weight of buffering agent to				
about 3 parts by weight of enzyme inhibitor, and				
wherein the container				
including				
the composition and				
a biological sample				
located therein				
is storable				
at room temperature				
for at least 14 days.				

¹ See Claim Construction Chart for this patent for the details.