

# Preface

More than one hundred years ago, U.S. Supreme Court Justice Brown observed that, “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.”<sup>1</sup> More recently, the U.S. Court of Appeals for the Federal Circuit has squarely placed the burden on patent attorneys to skillfully draft patents, stating that, “Given a choice of imposing the higher costs of careful [patent] prosecution on patentees, or imposing the costs of foreclosed business activity on the public at large, this court believes the costs are properly imposed on the group best positioned to determine whether or not a particular invention warrants investment at a higher level, that is, the patentees.”<sup>2</sup>

There are many books on how to draft a patent application and claims. Such venerable tomes as Landis on Mechanics of Patent Claim Drafting provide numerous examples and guidance to patent attorneys in the finer points of patent drafting.

This book takes a different approach, intended to guide the patent drafter through the minefield of court decisions that have over the years whittled away at the scope and validity of patents. Instead of focusing on the basic mechanics of patent claim drafting, this book explains and emphasizes techniques that produce broader interpretations of patents, strengthened validity, and a resulting greater strength of the patent in litigation and less resistance by licensing targets. The book focuses on real-life examples taken from court decisions – especially those from the U.S. Court of Appeals for the Federal Circuit – in which patents were interpreted, enforced, or licensed in a way that was either beneficial or detrimental to the patent owner. Based on the lessons learned from these court decisions, grouped into clearly identifiable principles and areas of technology, the book provides detailed advice for drafting patents so as to avoid problems and maximize leverage.

Patents are not only litigated. They are frequently licensed, both under threat of litigation, and based on a perceived need to obtain rights to

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<sup>1</sup>Topliff v. Topliff, 145 U.S. 156, 171 (1892).

<sup>2</sup>Sage Prods., Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1426, 44 USPQ2d 1103 (Fed. Cir. 1997).

intellectual property that may carry a competitive advantage in the marketplace. The licensing revenues generated by a patent or portfolio of patents are closely linked to the scope and strength of the patents that are the subject of the license. The ability to produce and identify broad patents that are difficult to challenge can be an important element of a successful patent licensing program.

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Banner & Witcoff, Ltd.

October 2008