Identifying Information

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Paper Information

Title:	Without Preamble
Abstract:	I'll jump right in: The Federal Circuit is ignoring a significant share of the words of patent claims. That's a bad idea as a matter of policy. It is virtually impossible to tell when the court is going to do it. And it's inconsistent with the idea that the claims define the scope of the invention, and with how the Supreme Court thinks about claim construction and its closest analogies, statutory interpretation and construing contracts. The culprit is a labyrinthine set of rules the Federal Circuit uses to decide whether or not to include the "preamble" to a patent claim as a part of the claim. The words of the preamble, which can sometimes amount to more than half of the whole claim, might or might not be treated as part of the invention depending on a complex of factors, including whether the claim reads as a complete sentence without it, whether the same words are used in both the preamble and the body of the claim, whether the body of the claim includes the magic word "said," and whether the preamble "is necessary to breathe life and meaning into the claim." In Part I I discuss the origins of the preamble rule and how it got to its current confused state. In Part II I suggest that the rule serves no useful purpose, and that if and when the Supreme Court gets such a case it will sweep the rule away. Patent applicants should be drafting patents with that fact in mind, and the rest of us should be interpreting claims with one eye on the fact that this is a doctrine whose days are numbered.