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GHOST OF CLAIMS PAST:
A SHORT REFRESHER ON JEPSON CLAIMS

We round up the year with a pop-quiz about Jepson claims. Who said the following and when? You have 10 seconds:

To my mind many of the present difficulties of our patent system, . . . would virtually disappear if inventors could be induced to confine their descriptions to the essential invention and its necessary setting, and their claims to a particular and distinct pointing out of the invention itself as distinguished from the setting.

If you guessed retired Chief Judge Paul Michel and last month, you were off by just a tad. In fact, Assistant Commissioner Clay made this observation in 1917 in the case for which Jepson claims are named.¹ Which leads to a second question—if Jepson claims have been around so long, seem so logical and are endorsed by the *Code of Federal Regulations*² and the *MPEP*,³ why are they so little used? If either of these questions has you stumped, I’ve created a Refresher Course on Jepson claims that will enhance your IP IQ just in time for the new year.

1. What is a Jepson Claim?

A Jepson claim “first describes the scope of the prior art and then claims an improvement over the prior art.”⁴ The preamble before the words “wherein the improvement comprises” recites what exists in the art. The applicant’s invention follows those words.⁵ Thus, when following the Jepson form, a patent’s preamble recites “elements or steps of the claimed invention which are conventional or known.”⁶

By definition, a Jepson claim is a combination claim.⁷ The claimed invention “consists of the preamble *in combination with* the improvement.”⁸ When the Jepson form is used, the claim preamble “defines not only the context of the claimed invention, but also its scope.”⁹

A Jepson claim importantly, “suggests the structural importance of the recitations found in the preamble.”¹⁰ When a patentee uses a Jepson claim, the preamble carefully defines, in part, the structural elements of his claimed invention.¹¹

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1 *Ex Parte Jepson*, 1917 C.D. 62, 70, 243 O.G. 525 (Ass’t Comm’r Pat. 1917).
 2 37 C.F.R. § 1.75(e) (2010).
 3 U.S. Patent and Trademark Office, *Manual of Patent Examining Procedure* § 608.01(m) (8th ed. 2010).
 4 *Dow Chem. Co. v. Sumitomo Chem. Co., Ltd.*, 257 F.3d 1364, 1368 (Fed. Cir. 2001); *Micron Tech. v. Tessera, Inc.*, 440 F. Supp. 2d 591, 595 (E.D. Tex. 2006); 37 C.F.R. § 1.75(e) (2010).
 5 *Hilton Davis Chem. Co. v. Warner-Jenkinson Co., Inc.*, 62 F.3d 1512, 1552 n.2 (Fed. Cir. 1995) (Lourie, J., dissenting).
 6 *See, e.g., Epcon Gas Sys., Inc. v. Bauer Compressors, Inc.*, 279 F.3d 1022, 1029 (Fed. Cir. 2002); *Kegel Co. v. AMF Bowling, Inc.*, 127 F.3d 1420, 1426 (Fed. Cir.1997); *Rowe v. Dror*, 112 F.3d 473, 479 (Fed. Cir. 1997); 37 C.F.R. § 1.75(e) (2010).
 7 *Rowe*, 112 F.3d at 479; *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 315 (Fed. Cir. 1985).
 8 *Pentec, Inc.*, 776 F.2d at 315 (emphasis added).
 9 *See, e.g., Epcon Gas Sys., Inc.*, 279 F.3d at 1029; *Rowe*, 112 F.3d at 479; *Pentec, Inc.*, 776 F.2d at 315.
 10 *Rowe*, 112 F.3d at 479.
 11 *Epcon Gas Sys., Inc.*, 279 F.3d at 1029 (citing *Kegel*, 127 F.3d at 1426).



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37 C.F.R. § 1.75(e) requires that Jepson claims contain specific information in a narrowly defined form, and there appear to be no exceptions to these requirements.

The phrase “characterized by,” without more detail, does not satisfy the requirements of 37 C.F.R. § 1.75(e) for creating a Jepson claim.

2. Other Than *Jepson*, Is There Any Support for Such Claims?

Yes. 37 C.F.R. § 1.75(e) (2010) describes and encourages Jepson-style claims, providing:

Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:

- (1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known,
- (2) a phrase such as “wherein the improvement comprises,” and
- (3) those elements, steps and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

Courts rely on 37 C.F.R. § 1.75(e) (2010) when analyzing Jepson issues.¹² The *MPEP* also endorses Jepson claims.¹³

3. Do Courts Liberally Construe *Jepson* When Reviewing Claim Language?

Not in a broad sense. The tightly defined “Jepson form” must apparently be used to gain this judicial benediction. While the Federal Circuit has not spoken directly to this issue, *Micron Technology, Inc. v. Tessera, Inc.*,¹⁴ a 2006 Eastern District of Texas case, provides the following guidance, which is consistent with Federal Circuit precedent:

- 37 C.F.R. § 1.75(e) requires that Jepson claims contain specific information in a narrowly defined form, and there appear to be no exceptions to these requirements.
- Merely referring to prior art in the preamble is not enough to create a Jepson claim because 37 C.F.R. § 1.75(e) requires that the preamble set forth a “general description” of *all known elements*.
- A preamble cannot be considered as written in Jepson form just because what is found there is described elsewhere in the specification as prior art.
- The phrase “characterized by,” without more detail, does not satisfy the requirements of 37 C.F.R. § 1.75(e) for creating a Jepson claim. This phrase fails to communicate that subsequent language comprises an improvement over the previously stated elements of prior art.

You *can*, however, use limited variations in the transitional language to create Jepson claims. The key is making sure the (a) preamble language preceding the transition phrase describes prior art, (b) transition language communicates that subsequent claim language constitutes an improvement over prior art, and (c) no prior art appears after the transition phrase.¹⁵ Examples that work include “the improvement comprising”¹⁶; “the improvement wherein”¹⁷; and “the improvement which comprises.”¹⁸

4. What does the *Jepson* decision say?

In *Jepson*,¹⁹ the primary examiner sought instructions as to the proper form of two claims relating to the addition of a solenoid to a known apparatus for operating car lights using a battery and

¹² *Micron Tech. v. Tessera, Inc.*, 440 F. Supp. 2d 591, 595-96 (E.D. Tex. 2006) (citing *Epcon Gas Sys., Inc.*, 279 F.3d at 1029 (Fed. Cir. 2002) and *Kegel Co.*, 127 F.3d at 1426).

¹³ U.S. Patent and Trademark Office, *Manual of Patent Examining Procedure* § 608.01(m) (8th ed. 2010).

¹⁴ 440 F. Supp. 2d 591, 595-97 (E.D. Tex. 2006).

¹⁵ *Id.* at 596-97.

¹⁶ *Kegel*, 127 F.3d at 1426, 1423; *Rowe*, 112 F.3d at 476.

¹⁷ *Epcon Gas*, 279 F.3d at 1029, 1030.

¹⁸ *Dow Chem. v. Sumitomo Chem. Co., Ltd.*, 257 F.3d 1364 (Fed. Cir. 2001).

¹⁹ *Ex Parte Jepson*, 1917 C.D. 62, 243 O.G. 525 (Ass’t Comm’r Pat. 1917).

While the preamble in other claim forms generally does not limit scope, except under specific circumstances, the preamble elements in a Jepson-type claim are impliedly admitted to be in the prior art.

The Federal Circuit has held that, “obviousness should not be based on an implied admission erroneously creating imaginary prior art. That is not the intent of § 103.”

charging the battery using a generator. Not surprisingly, the claims in question used language similar to what is now known as the “Jepson” format. The preamble of each claim contained known elements followed by the phrase “the combination with” or “characterized by” and followed with the inventive portion of the claim.

The examiner objected because, under existing case law, the preamble was not an element and did not limit the claim. Addressing the objection, Assistant Commissioner Clay observed, “in many complicated inventions, and especially inventions which are mere improvements added to old structures, no complete statement of structure can be made without reference to something that is old.”²⁰

Based on this, he could “see no reason why the preamble of the claim should not perform the double function of completing the setting of the real invention claimed and also disclaiming the old parts of the apparatus, which constitute nothing but setting.”²¹ So he concluded that, “When an applicant presents a claim, as in this case, which does particularly point out his exact invention, there is certainly nothing in the law to interdict his doing it by including the old parts of the structure in a preamble and set apart from the structure which constitutes the real invention.”²²

5. What Are Examples of Jepson Claims?

Here is a simple example of the Jepson form: “In a process for making widgets, with elements A, B, and C [the prior art], **wherein the improvement comprises** [the transitional phrase], element D [the inventive element(s)].” There are numerous other more complex examples in the case law.²³

6. Do Preambles in Jepson Claims Limit Claim Scope?

Yes. While the preamble in other claim forms generally does not limit scope, except under specific circumstances,²⁴ the preamble elements in a Jepson-type claim are impliedly admitted to be in the prior art.²⁵ Importantly, the admission arising from a Jepson claim is an implied admission only.²⁶ The Federal Circuit has held that, “obviousness should not be based on an implied admission erroneously creating imaginary prior art. That is not the intent of § 103.”²⁷

7. Are There Exceptions to the Rule that Preambles in Jepson Claims Are Limiting?

Yes, there are two circumstances where the preamble of a Jepson claim may not limit claim scope:

- When the form is used to avoid a double patenting rejection in a co-pending case unavailable to the public,²⁸ or
- When the preamble is the inventor’s own work.²⁹

For an instructive example of a failed attempt to overcome the implied admission of prior art in a Jepson claim preamble, refer to *In re Fout*.³⁰

²⁰ *Id.* at 67.

²¹ *Id.* at 68.

²² *Id.* at 70.

²³ See, e.g., *Hilton Davis Chem. Co. v. Warner-Jenkinson Co., Inc.*, 520 U.S. 17, 22 (1997); *Kegel Co., Inc. v. AMF Bowling, Inc.*, 127 F.3d 1420, 1423 (Fed. Cir. 1997); *Rowe v. Dror*, 112 F.3d 473, 476 (Fed. Cir. 1997).

²⁴ *Symantec Corp. v. Computer Assoc. Int’l, Inc.*, 522 F.3d 1279, 1288-89 (Fed. Cir. 2008); *Epcon Gas Sys., Inc. v. Bauer Compressors, Inc.*, 279 F.3d 1022, 1029 (Fed. Cir. 2002).

²⁵ *Sjolund v. Musland*, 847 F.2d 1573, 1576-77 (Fed. Cir. 1988); *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 315 (Fed. Cir. 1985); *In re Ehrreich*, 590 F.2d 902, 909-10 (C.C.P.A. 1979).

²⁶ *In re Ehrreich*, 590 F.2d at 910; *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d at 315.

²⁷ *Reading & Bates Constr. Co. v. Baker Energy Res. Corp.*, 748 F.2d 645, 649-50 (Fed. Cir. 1984).

²⁸ *In re Ehrreich*, 590 F.2d at 910.

²⁹ *Pentec, Inc.*, 776 F.2d at 315 (citing *Reading & Bates Constr. Co.*, 748 F.2d at 649).

³⁰ *In re Fout*, 675 F.2d 297, 298-301 (C.C.P.A. 1982).

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ABOUT SHB

Shook, Hardy & Bacon offers expert, efficient and innovative representation to our clients. We know that the successful resolution of intellectual property issues requires a comprehensive strategy developed in partnership with our clients.



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8. Are Jepson Claims Widely Used?

No, Jepson claims are not widely used. More than 20 years ago, Judge Pauline Newman observed, "According to the modern style, patent claims no longer merely claim the salient features, the 'heart' of the invention."³¹ Judge Newman also noted that Jepson claims were an exception to this trend.³² (Apparently, the "modern style" came into vogue sometime before 1917 when *Jepson* was decided.) Consistent with Judge Newman's observation, publicly available statistics on patent issuance suggest a dramatic decline in the number of Jepson claims issued over the past 20 years.

9. Why This Precipitous Decline?

There are five key observations:

- The preamble is, at a minimum, an implied admission that the disclosed elements are in the prior art.
- Courts may be inclined to find an implied admission of the existence of a combination of the described elements, as though they were a single reference. This may happen even if the combination of old elements is not disclosed in the prior art.
- While the admission is implied only, case law has effectively limited the ability of an applicant to rebut the implied admission to just two situations.³³
- In determining patentability, the applicant/patentee is effectively limited to the novelty and non-obviousness of the single improvement described in the claim.
- In light of the foregoing, and especially after *KSR*,³⁴ the likelihood of § 103 invalidity is enhanced when a Jepson claim is used.

10. What Should Practitioners Do?

Here are five practical suggestions:

- Use Jepson claims when you need to very specifically and clearly claim the invention. There may be advantages to doing this in a particular situation. Carefully weigh the advantages and disadvantages of using a Jepson claim.
- Prevailing practice is not to claim the salient feature of the invention, but to claim the entire combination of new and old elements. Think twice about going against the flow.
- Use of a Jepson claim will likely limit flexibility in arguing claim scope at trial. But, if clarity is critical, go for it.
- Consider challenging combination claims that did not use the Jepson form when they should have. Argue invalidity under 35 U.S.C. § 112 based on 37 C.F.R. § 1.75(e), because the claim does not set forth the invention in "clear, concise, and exact terms."
- Recognize that use of a Jepson claim may result in quicker patent issuance.

³¹ *Pennwalt Corp. v. Durand-Waylan, Inc.*, 833 F.2d 931, 959 (Fed. Cir. 1987) (Newman, J., writing separately).

³² *Id.* at n.5.

³³ See *In re Fout*, 675 F.2d 297, 298-301 (C.C.P.A. 1982).

³⁴ *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007).