

WORDSMITHING, AKAMAI AND THE “ALL ELEMENTS” RULE*

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“Requiring [] awkward wordsmithing by the claim drafter goes against a patentee's obligation to clearly claim the invention.”***

“[T]he advice on better claiming is cold comfort for owners of the many thousands of already-issued patents.”****

I. OVERVIEW

The level of minimum claim drafting skills by patent practitioners has undoubtedly suffered as a result of the Lehman Administration’s abolition of any testing of claim drafting skills as part of the patent registration examination; the abolition predated the dawn of the internet patenting boom; the practice continues to the present time to the detriment of the innovative community.

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*** Donald R. Dunner *et al.*, *Combined Petition for Panel Rehearing and Rehearing En Banc of Plaintiff-Appellant Akamai Technologies, Inc.*, *supra* note *.

**** Unsuccessful brief *amicus curiae* of the Intellectual Property Owners Association supporting petition for rehearing *en banc* in *Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318, 1327 (Fed.Cir.2008), discussing the statement by the Court I *BMC Resources, Inc. v. Paymentech L.P.*, 498 F.3d 1373, 1381 (Fed. Cir. 2007)(Rader, J.), that proper claim drafting avoids the single infringer issue.

The Lehman decision was implemented prior to the hiring of most internet patent attorneys stimulated by *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998)(Rich, J.). Hence, a majority of internet patent practitioners have never been tested for claim drafting competence.

The naked evisceration of the patent licensure examination as a way to establish the competency of a patent practitioner undermines a key foundation for the continued licensure of patent agents under *Sperry* where the Court recognized that “reform [had been] effected by the Patent Office, which now requires all practitioners to pass a rigorous examination....” *Sperry v. Florida*, 373 U.S. 379, 395-96 (1963).

Historically, until this unfortunate and short-sighted change by the Office, the would be patent practitioner was necessarily required to learn and study the practice of claim drafting in order to become a registered patent practitioner, including practice in the actual preparation of claims. *See § II, Classic Requirement to Learn Claim Drafting Skills.* Grading examinations including claim drafting questions was deemed “too time-consuming” by the OED which simply *abolished* everything other than multiple choice questions for the patent registration examination. *See § III, Lehman’s Abolition of the “Afternoon Portion”.* The OED clearly recognized that the Office must teach claim drafting and promised to do so when it abolished the claim drafting requirement from the licensure examination: The promise went unfulfilled. *See § IV, The Abandoned Promise to Teach Claim Drafting.* Instead, claim drafting had to be learned on the job through the give and take of dealing with Examiner rejections which may teach how to gain a claim through the examination maze but teaches nothing about gaining meaningful protection to safeguard the applicant’s intellectual property. *See § V, Claim Drafting Education on the Job.*

As a direct consequence of the short-sighted abolition of claim drafting as a requirement for licensure, the current generation of freshly minted patent practitioners has now moved more toward the creation of narrow picture claims, often with only the thought of passing patent Examiner muster and without consideration of fundamental patent infringement issues. Thousands of applicants have been left with patents of no commercial value whatsoever. *See* § VI, “*Cold Comfort*” for *Picture Claim Victims*. The *en banc* argument *Akamai* featured questions from the bench dealing with the limitations of words and, particularly, whether meaningful coverage for some meritorious inventions could be obtained in a two-actor infringement scenario. *See* § VII, *Akamai, Failure to Define a Single Direct Infringer*

The imprimatur of having the title of a “registered patent practitioner” today has lost its shine. Given that a significant number of those holding this title have never studied claim drafting in the context of patent enforcement, the imprimatur has a hollow ring: It is no longer a signal to the public that such a person is able to gain meaningful patent protection for an applicant. *See* § VIII, “*Registered Practitioner*”, *A Shallow Imprimatur*. As a result, since lawyers (registered as patent attorneys or not) exclusively deal with patent infringement opinions, the value of an *attorney* is enhanced while the patent agent without that imprimatur is marginalized. *See* § IX, *Bar Membership as a Metric to Gauge Proficiency*

The long range answer to the claim drafting dilemma is to *restore* the requirement for claim drafting as part of the licensure examination. The overall answer to the questions of legal competence posed by the new patent law also requires a realistic confrontation of training and competency issues: The solution is not to benefit the patent profession in the first instance, but rather the primary goal is to service the community of inventors and entrepreneurs and provide this

greater community with a broader base of legal services at economical prices: The imprimatur of licensure as either a patent agent or attorney should give the public confidence in choosing counsel to draft and protect patents for America’s precious intellectual property. *See* § X, *Maintaining the Patent Agent Profession*.

II. CLASSIC REQUIREMENT TO LEARN CLAIM DRAFTING SKILLS

The Patent Office started testing patent candidates for licensure for many decades from an era long before the multiple choice question came in vogue: Essay examination questions were presented that challenged the candidate’s ability to apply legal principles.

Even after multiple choice examinations became popular in society at large and even after much of the patent registration examination focused upon multiple choice tests of knowledge of the patent system, the essay examination and claim drafting questions in particular continued to be at the heart of the licensure test. In the 1970’s and up through the mid-1990’s the examination comprised a morning session that was entirely multiple choice while essays were featured in the “Afternoon Portion” of the examination.

A claim drafting exercise was at the heart of the “Afternoon Portion”. Two fact patterns were offered, one of a mechanical invention and the other of a chemical invention; the candidate could elect either one for his examination. (choose). The applicant would then need to draft a set of claims for generic and more specific coverage of the invention in the fact pattern. This was the major stumbling block for licensure for many of the candidates.

As a result, then-George Washington University Law School Professor Irving Kayton through his private bar review (as well as other private organizations) taught specialized patent claim drafting courses. The Kayton course included both classroom instruction as well as very small parallel breakout claim drafting sessions of no more than about ten students each; they were taught by the best and brightest recent law school graduates. The Kayton course became very popular, and provided excellent training on both *how* to draft claims to pass the examination, but more importantly taught candidates how to draft claims for *meaningful protection*.

III. LEHMAN’S ABOLITION OF THE “AFTERNOON PORTION”

In 1998, the rush to filing internet business method patents was spurred on by the imprimatur given to patenting in this area in *State Street Bank*. The year before, the Lehman Administration abolished the requirement for a minimum proficiency in claim drafting skills as part of the patent licensure process. This witches brew of circumstances has led to a generation of patent practitioners in the internet arts who were never tested for claim drafting proficiency with the unfortunate result that many thousands of patents written in this area have useful protection on the order of fools gold.

A. Abandonment of the Claim Drafting Questions

In 1997 the Office *abandoned* all but the multiple choice portion of the examination. As explained by Professor Thomas, “the PTO abandoned the claims drafting portion of its registration examination in favor of a series of multiple choice questions. The official explanation for the shift was that the examination was too time-consuming to grade....” John R. Thomas, *Claim Re-Construction: The Doctrine of Equivalents in the Post-Markman Era*, 87 J. Pat. & Trademark Off.

Soc'y 781, 798-99 (2005)(footnotes omitted citing Department of Commerce, U.S. Pat. & Trademark Off., *Registration Examination for Patent Practitioners and the Establishment of a Continuing Legal Education Requirement and an Annual Fee for Registered Patent Practitioners*, 61 Fed. Reg. 51,072 (Sept. 30, 1996); Department of Commerce, U.S. Pat. & Trademark Off., *Changes to Representation of Others Before the United States Patent and Trademark Office*, 69 Fed. Reg. 35,428 (June 24, 2004).

As explained by the PTO in its proposal to abolish the essay examination, “the preparation and administration of the Registration Examination has taxed OED's resources. ... The Registration Examination restructuring should provide greater assurance to our patent applicants that registered practitioners possess the essential skills necessary to practice before the PTO in patent cases.” 61 Federal Register at 51073.

A first hand account of the transition in 1997 is provided by one of this writer's colleagues:

“In the summer of 1997 – days before some of my fellow first-year associates ... and I were about to head to Bethesda, MD, for Kayton's prep course -- we got word that live claim drafting would not be part of the exam. Instead, the afternoon session of the exam would involve multiple-choice questions aimed at testing claim-drafting acumen.

When we arrived, Kayton explained that nobody knew exactly what the new afternoon session would involve, but Kayton's minions had located some claim-drafting-oriented multiple-choice questions from older exams, which were then added to the volumes of three-ring binders that we had already received.

The fact that I remember my break-out instructor ... and the problem before us (drafting claims for a traveling lawn sprinkler), causes me to conclude that I must have retained something valuable from the lesson, as well.

I recall that the afternoon portion of the actual exam included several questions where all of the multiple-choice options seemed incorrect. (I remember that a particularly frustrating one involved a threaded champagne bottle closure.) I must have been right about some of those, as we were told that there was a record number of questions that were thrown out, in the scoring process, and that the withdrawn questions seemed to have created a distinct spike in the historical pass rate....”

B. The Registration Examination Today

1. Focus on Everything *but* Claim Drafting

The PTO Registration examination of today appears totally devoid of any questions that even relate to how claims should be drafted. This is seen from the fact that the first source for questions is based upon the *Manual of Patent Examining Procedure. Practitioner Registration Examination Source Material – Source Materials for the Registration Examination*, U.S. Patent and Trademark Office website, last visited November 15, 2011, http://www.uspto.gov/ip/boards/oed/exam/reg_exam_source_material.jsp (“For the updated registration examination beginning April 12, 2011, the source material for the questions and answers will be [based upon six sources]”).

A search under “claim drafting” in the *Manual* (Westlaw FIP-MPEP) gives only three hits, relating to of three isolated aspects of claim interpretation, “comprising” and other claim transitions (§ MPEP 2111.03, *Transitional Phrases*); “[a]cceptability of the claim language depend[ing] on whether one of ordinary skill in the art would understand what is claimed, in light of the specification”(MPEP § 2173.05(b), *Relative Terminology*); and interpretation of “means” claims (MPEP § 2181, *Identifying a 35 U.S.C. 112, Sixth Paragraph Limitation*).

In addition to information from the *Manual*, the *Practitioner Registration Examination Source Material* lists five further sources for test questions, none focused remotely on claim drafting:

2. Examination Guidelines Update: Developments in the Obviousness Inquiry After *KSR v. Teleflex* (available at <http://edocket.access.gpo.gov/2010/pdf/2010-21646.pdf>);

“3. New Interim Patent Subject Matter Eligibility Examination Instructions, August 2009 (available at http://www.uspto.gov/web/offices/pac/dapp/opla/2009-08-25_interim_101_instructions.pdf);

“4. Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos* (available at <http://edocket.access.gpo.gov/2010/pdf/2010-18424.pdf>);

“5. Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos*, July 2010 (available at http://www.uspto.gov/patents/law/exam/bilski_guidance_27jul2010.pdf); and

“6. Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. § 112 and for Treatment of Related Issues in Patent Applications (available at <http://edocket.access.gpo.gov/2011/pdf/2011-2841.pdf>).”

2. A Quick \$ 3,000 Passport to the Patent Agent Profession

There is a world of difference between the educational requirements and practical training for a patent agent and a patent lawyer. The latter has *at least* a three year, full time legal education (or four years if an evening student), all after having a B.S. in a science or engineering program that qualifies one to sit for the patent practitioner examination.

The patent agent, after receiving the same B.S. degree, can *immediately* take the examination to qualify as a patent agent. Thus, for example, a twenty-one year old B.S. graduate may sit for the patent practitioner examination. For under \$ 3,000 he can enroll with either of the two most popular patent bar review courses and, if he’s a good multiple choice test taker, be fairly well assured that he will soon be a registered patent agent, available to serve the public with the full imprimatur of his licensure by the government, *simply by virtue of being able to pass a single multiple choice test without any training of any kind whatsoever nor any experience in how to write a patent claim.*

A 98.3 % pass rate by taking a bar review course? Yes, according to one course advertisement. <http://www.omnipreppatent.com/passrate.htm>. A more widely known course that focuses entirely on examination passage without teaching about such irrelevant matters as claim drafting, claims a pass rate of roughly 90 %. <http://ipwatchdog.com/patent-bar-exam/patent-bar-review-courses/>. “[E]ventually everyone who takes [the PLI] course passes” because the test can be retaken over and over. *Id.* Thus, a PLI instructor explains that “the pass rate [with or without a review course]... is typically in the range of 50%. ... The pass rate for those who take the [PLI] live ... course is generally around 89 % and the pass rate for those who take the [PLI] home study version is roughly 87 %, with both percentages reflecting first time takers. I have personally never spoken to anyone who has taken the course and did not ultimately pass the exam, so eventually everyone who takes this course passes.” *Id.*

According to one bar examination course advertisement, the patent registration examination is an *open book* examination focused upon the *Manual* where the test taker will have a *searchable* on line version of the text: “All of the questions on the exam will come from the ... [*Manual*] ... The testing facility will provide you with an online, searchable version of the [*Manual*].”

www.omnipreppatent.com/examformat.htm Another patent bar course says that the *Manual* is not enough: It advertises that the *questions that will be given* should be provided, integrated into a study of the *Manual*:

PatBar offers detailed, customized and hand-selected materials, broken down into concise, easily digestible modules and summaries. You cannot learn the MPEP by rote memorization; only the PatBar Method promotes your mastery of the MPEP. ... PatBar includes previous *and current* exam questions, meticulously culled from recent test-takers and correlated to the materials in your study sessions. <http://patbar.com/patent-bar.shtml>.

Two of the more popular continuing education organizations offering patent bar review courses bluntly advertise that the entire focus of their courses relates to passing the patent bar examination and thus has nothing to do with teaching how to draft claims:

“The [PLI course] is geared to one thing and one thing only - ensuring you pass the PTO Exam! *** All course materials are 100% Exam-Focused, and updated continually to all current USPTO rules tested on the Exam.”
www.pli.edu/Patentbarreview/default.aspx.

“WHAT YOU NEED TO KNOW TO PASS THE NEW EXAM! ...[O]ur [PRG] industry-leading Patent Bar Review Course is 100% focused on helping you to pass the latest version of the exam.”
www.patentresources.com/Courses.aspx?link=Patent+Bar+Review+%E2%80%93+Classroom+or+Online+Video+Course.

The latter course is focused upon a memory bank of 2000 questions: Learn the questions and answers and, presto, you’re a registered patent agent:

“You’ll love the new [PRG] web-based [examination material]. You’ll get every edge to pass the new exam with:

Approximately 2,000 exam Q&As

Access to both a study mode and an automatically timed simulated exam mode

Rationales behind each correct answer and explanations of why the other answers are incorrect.” *Id.*

IV. THE ABANDONED PROMISE TO TEACH CLAIM DRAFTING

When the Office abolished claim drafting from the examination in favor of multiple choice examination of patentability and practice principles, the Office openly admitted that elimination of the claim drafting portion of the examination created a vacuum in its testing procedure, which it planned to fill through yet another mechanism:

“As a further requirement for registration, the PTO is considering substituting the claim drafting portion of the Registration Examination with a comprehensive course on preparation and prosecution of patent applications, including drafting of specifications, claims, and responses to office actions. The PTO is also considering apprenticeships as alternatives to the comprehensive course.” 61 Federal Register at 51073.

But, the Office adopted neither proposal nor does the current examination provide even a hint or suggestion of a question that tests *how to draft claims*.

With the total abolition of any need to gain claim drafting skills to pass the patent registration examination, this led to the demise of claim drafting courses by the private bar that had *de facto* been a mandatory part of training leading up to taking the patent bar examination.

While claim drafting is still taught by the private organizations, the classes are more often at a higher level of claim interpretation that do not challenge claim skills in a meaningful way. More importantly, patent practitioners as a rule do not find it necessary for their practice, particularly if all they do is prep’n’pros work where the need for meaningful post-grant coverage is not apparent from such a perspective.

Certainly, the Kayton era of claim drafting instruction in small, parallel groups where students actually wrote claims and had them critiqued on the spot is long gone.

V. CLAIM DRAFTING EDUCATION ON THE JOB

A. Learning from an Examiner’s Rejections

The bulk of patent claim drafting education today comes from the give and take of patent practice before the examiner. Claims are rejected by Examiners whereupon the patent practitioner crafts claim amendments to overcome the rejections. In this way, the patent practitioner learns how to *gain allowance* of the claims and to deal with patent practice *rejections* of claims.

While this on the job training may be meaningful in terms of gaining the grant of patents, the training is mythical in terms of creating claims that will protect the applicants’ inventions: This is a case of the blind leading the blind, because an Examiner’s concern is that the claims meet the formal requirements of 35 USC § 112 and define a novel and nonobvious contribution under 35 USC §§102, 103.

The typical examiner has never drafted a claim for a client in his entire professional life, which typically has not included any practice outside the Office. It is of no concern to the Examiner whether the claims provide meaningful protection, a subject that has nothing to do with the examiner’s role in the patent examination process. (As seen from the above discussion of the *Manual of Patent Examining Procedure* the Patent Office places no emphasis on claim drafting skills particularly as this is not the function of the Office; neither are career examiners trained in this area nor do they have any experience whatsoever in the crafting of claims, absent the few who have joined the Office after being in outside practice.)

B. Learning through Legal Practice

A substantial minority of patent practitioners are lawyers who earn their bread and butter in major and sometimes boutique law firms through a litigation practice or an upper end counseling practice which includes a focus on opinions on infringement and validity.

This training is not a satisfactory alternative for the patent system at large as it is only a minority of practitioners who fit into this mold.

VI. “COLD COMFORT” FOR PICTURE CLAIM VICTIMS

Perhaps the most dramatic example of the breakdown of patent licensure may be found in the area of internet patenting where multistep inventions were routinely describing as involving the “*transmission by ‘A’*” of information on the internet to a server “B” and then “*transmission by server ‘B’*” of further data, a claim having no single direct infringer. It is a simple matter to recast the claim to focus on a single actor, for example, by claims the steps of “*transmission by ‘A’*” followed by “*receipt by ‘A’ of a transmission by server ‘B’*”. Yet, without the legal training enjoyed by the minority of practitioners who are part of a litigation

or upper end counseling practice, the newly minted patent practitioner by and large has learned his craft through the give and take of examiner rejections. As noted in the quotation from a leading intellectual property organization, *thousands* of patents have been written without this necessary focus on a single actor direct infringer, receiving the “cold comfort” of the advice of the current Chief Judge that the claims could have been better drafted.

The problem for the patent practitioner untutored in drafting an enforceable patent is that the self-training by many practitioners has been with the goal of obtaining a patent. This goal is achieved without a focus upon what the claims mean in terms of actual protection: It is not that the practitioner is not generally aware that such protection is important; rather, the issue becomes one of theory and not practice where the person never had significant actual dealings reading granted patent claims on potentially infringing products.

The experience gained from dealing with examiners also leads the practitioner toward the presentation of narrow claims. Narrow claims are more easily allowed. Picture claims that include all the elements of an embodiment are easiest to draft and are favored by examiners because they are easiest to understand and, being so very narrow in scope, much easier to examine than broad generic claims.

Without the training in litigation or upper end counseling, the experienced patent practitioner with only prep’n’pros experience before the Office more often than not tends to craft claims *for allowance* and without primary regard for *infringement coverage*.

VII. AKAMAI, FAILURE TO DEFINE A SINGLE DIRECT INFRINGER

Akamai in its petition seeking *en banc* review had focused upon the difficulties of “wordsmithing” to meet the single direct infringer rule. During the oral argument, however, counsel for Akamai shifted gears. Instead, counsel focused on a unique, bold challenge to the correctness of *BMC v. Paymentech* based upon pre-1952 case law with a set of three legal theories that are outside the scope of this paper.* While counsel looked to these principles based upon pre-1952 case law, the bench itself brought up the original issue of “wordsmithing” that had played a dominant role in the initial petition for *en banc* review.

A. The Automobile Engine without the “Connecting Plugs”

The Court appeared troubled by the fact that some of the claims to two-actor internet inventions could be circumvented so that the invention would have no enforceable scope whatsoever. The example was posed from the bench of a hypothetical inventive automobile engine that included conventional connecting “plugs” to attach the engine to the automobile: What happens where the engine manufacturer sells his engines on the open market *without* the plugs, and the automobile manufacturer buys the engines and adds the plugs. All steps are carried out but there is no single direct infringer.

* *McKesson Technologies Inc. v. Epic Systems Corp.*, App. No. 2010-1291, *vacated panel opinion*, 2011 WL 1365548, 98 USPQ2d 1281 (Fed. Cir. 2011), is not considered in this paper because the *en banc* argument in *McKesson* (immediately following *Akamai*) clearly distanced McKesson’s factual situation from the bold approach of *Akamai*; McKesson instead sought to live within the framework of *BMC v. Paymentech* by instead seeking a broadened interpretation of what constitutes “direction and control” by the single actor who works with others. The McKesson argument, if anything, goes against the Akamai argument and instead supports upholding the basic single direct infringer rule of *BMC v. Paymentech*.

The answer to the hypothetical question is that since all patentable features reside in aspects of the engine *without the conventional plugs*, the claim should have focused upon the engine, *per se*, with no element reciting the conventional plugs. Thus, in many ways, this hypothetical is just a reworking of the “all elements” debate that has flourished at the Federal Circuit for literally twenty -five years: Where the patentee fails to limit the claim to the *essential* elements necessary for patentability and for the performance of the invention, the patentee opens the door to third parties copying the invention, minus a nonessential element. The third parties are thus off the hook for infringement under the “all elements” rule.

B. The *Texas Instruments-Pennwalt* “All Elements” Rule Controversy

The high point for *disregarding* the “all elements” rule and providing justice for the patentee came a quarter century ago when a panel found infringement in *Texas Instruments, Inc. v. U.S. Int'l Trade Comm.*, 805 F.2d 1558 (Fed.Cir.1986). Instead of abrogating the “all elements” rule for *literal* infringement, the panel did so for the doctrine of equivalents:

“[I]t is the claimed invention *as a whole* that must be considered in determining whether there is infringement by the accused devices also considered *as a whole*. It is not appropriate in this case, where all of the claimed functions are performed in the accused devices by subsequently developed or improved means, to view each such change as if it were the only change from the disclosed embodiments of the invention. *It is the entirety of the technology embodied in the accused devices that must be compared with the patent disclosure.* Any other view distorts both the correct interpretation of the claims and their application to the accused devices.” *Texas Instruments*, 805 F.2d at 1569-70.

The American Intellectual Property Law Association filed an *amicus curiae* brief in *Texas Instruments* which *challenged* the panel’s circumvention of the “all elements” rule. This marked the first time in the entire history of this organization that it filed an *amicus* brief challenging a pro-patentee holding of either the Federal Circuit or either of its predecessor courts.

A year later in *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed.Cir.1987) (*en banc*)(Bissell, J.), the *en banc* Federal Circuit *sub silentio* overruled *Texas Instruments* without the opportunity to take *Texas Instruments en banc*.*

In *Pennwalt* the patentee had claimed an automated method of sorting fruit with many claimed steps including *unnecessary* “position indicating means” steps which the accused infringer simply *eliminated* and thereby avoided infringement because it did not perform “all elements” of the claimed invention. In the same sense, the claim proposed by the *Akamai* bench of a engine with conventional plugs should be claimed as to the inventive features – the engine itself – without a claim limitation to the plugs. As pointed out by Judge Nies in *Pennwalt*, “[t]he claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms.’ *Texas Instruments*, 833 F.2d at 949-50 (Nies, J., Additional Views)(quoting *White v. Dunbar*, 119 U.S. 47, 52 (1886)).

* For a considerable period of time and until well after *Pennwalt* was decided, the panel in *Texas Instruments* withheld releasing a vote on rehearing by the panel, thus precluding an *en banc* vote in that case, whereupon the Court *sua sponte* chose the vehicle of *Pennwalt* to *sub silentio* overrule *Texas Instruments*. *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed.Cir.1987) (*en banc*)(Bissell, J.). The vote for rehearing *en banc* in *Texas Instruments* was released only the year after *Pennwalt*. *Texas Instruments*, 846 F.2d 1369(1988)(Order den. reh’g by the panel and reh’g en banc)(Newman, J.).

C. Internet Claiming, a Microcosm of the “All Elements” Rule

The example of internet claim shortcomings is but a small microcosm of the frequent failure of patentees to provide claims of any value. There is case after case of a truly meritorious invention that is patentable, yet the claim draftsman has either made a serious grammatical mistake such as failing to provide claim wording to capture a literally described embodiment in the specification as in *Malta v. Schulmerich Carillons, Inc.*, 952 F.2d 1320 (Fed. Cir. 1991)(Rich, J.), or where there is a grammatical mistake such as where the preposition “to” was used instead of “at” as in *Chef America Inc. v. Lamb Weston, Inc.*, 358 F.3d 1371, 1373 (Fed.Cir.2004).

For example, sometimes, even a preferred embodiment is copied by the accused infringer, one that is fully *disclosed* in the specification; but, the claim wording comes up short as in *Malta v. Schulmerich Carillons*. Even here, the debate continued; a dissent argued along the lines of the overruled *Texas Instruments* case that the court should be “[l]ooking ... at the invention as a whole....” *Malta v. Schulmerich Carillons, Inc.*, 952 F.2d at 1340 (Newman, J., dissenting).

That every patentable invention should somehow have an enforceable right is difficult to square with the numerous precedents that have found valuable inventions to lack any scope of protection due to oversights or mistakes made by the patent attorney. For example, in *Chef America*, the patentee claimed heating bakery dough “to” near-incineration temperatures (instead of flash-heating “at” such temperatures). Instead of providing a bakery product with “a light, flaky, crispy texture,” ... which the patented process is intended to provide, the resultant product of such heating will be something that... resembles a charcoal briquet.”

Chef America, 358 F.3d at 1373. But, “[even ‘a nonsensical result does not require the court to redraft the claims.... patent. Rather, where... claims are susceptible to only one reasonable interpretation and that interpretation results in a nonsensical construction of the claim as a whole, the claim must be invalidated.” *Chef America*, 358 F.23d at 1374 (quoting *Process Control Corp. v. Hydrexclaim Corp.*, 190 F.3d 1350, 1357 (Fed.Cir.1999)).

VIII. “REGISTERED PRACTITIONER”, A SHALLOW IMPRIMATUR

The PTO has thus put its imprimatur on patent practitioners who have never been tested for minimum competency in claim drafting, the single most important part of application draftsmanship. Furthermore, it is extremely difficult for the purchaser of patent legal services to determine what constitutes a “good” claim from a “bad” claim.

Indeed, the consumers of patent practitioner talent are not always able to make a judgment as to the quality of a patent practitioner, much as a prospective patient for brain surgery is unable on his own to distinguish amongst the potential surgeons who may perform a life or death operation. The problem in the patent area is underscored by Professor Thomas who writes that “[s]uboptimally drafted claims may arise ... from a persistent and widespread inability [of patent law consumers] to discern good claims drafters from bad.” John R. Thomas, *Claim Re-Construction: The Doctrine of Equivalents in the Post-Markman Era*, 87 J. Pat. & Trademark Off. Soc'y 781, 799 (2005).

IX. BAR MEMBERSHIP AS A METRIC TO GAUGE PROFICIENCY

To be sure, there are other ways of testing the ability of a candidate’s proficiency than passing the patent registration examination: It’s called a year law school education coupled with passing a State bar examination.

Thus, if someone is able to both graduate from law school and become a member of the bar, then such a person does not need to take a licensure examination to establish his ability to express himself in English. By way of contrast, the patent agent candidate who has no formal legal training, perhaps a twenty-one year old graduate from an engineering school may be able to “test out” on a multiple choice test: He is able to become fully licensed as a registered patent agent without establishing his proficiency in concepts in concise, legal English, and *a fortiori* is unable to properly draft patent claims.

X.. MAINTAINING THE PATENT AGENT PROFESSION

Sage plutocrat Hal Wegner proposes that patent agents be proscribed from practicing before the new Patent Trial and Appeal Board.... Hal wants slicker reptilian obfuscation from higher-priced lawyers. Next up on Hal's hit list - those lame pro se prosecutors that are creating a backlog with their dime-store applications. After all, the only ‘people’ deserving patent protection are corporations.

-- “The Patent Hawk”*

The Leahy Smith Act – more formally the *Leahy Smith America Invents Act*, Public Law 112-29 (September 16, 2011), greatly restructures the statutory patent landscape and opens the door to questions concerning representation before the Office, particularly with its highly complex legal administrative patent trials:

* The Patent Hawk a/k/a Gary Odom, *Back of the Bus*, The Patent Prospector, September 26, 2011, http://www.patenthawk.com/blog/2011/09/back_of_the_bus.html.

Should patent agent practice be continued in its present form? Should patent agent practice focus on prosecution? Should lawyers, without more, be admitted to practice at the new Patent Trial and Appeal Board, the PTAB?

Are registered patent practitioners uniformly competent to draft enforceable claims? Does this implicate continued patent agent practice? The current paper focuses upon this last set of questions as part of an overall rethinking of patent licensure under *Sperry v. Florida*, 373 U.S. 379 (1963).

Questions raised in the wake of the Leahy Smith Act create a new professional divide prosecution practitioners and between the ranks of “prep’n’pros” mainstream patent practitioners and lawyers involved in patent enforcement.

Yet, the public interest should overshadow differences between the disparate parts of the registered patent practitioner bar and further differences between the attorneys within and outside the patent attorney category. Are practitioners, whether attorney or agent, *qualified* to represent the public at the Patent Office in prosecution areas? Or, a legal practice in the administrative trials at the PTAB? Is the supply of counsel artificially limited because of guild-like restrictions on practice, minimizing supply and maximizing price of patent legal services?

The mainstream prep’n’pros practitioner at the Office prepares and prosecutes patent applications while a significant minority of the lawyers who perform the bulk of today’s more legal services such as interferences and reexaminations will gravitate toward the trial work created under the Leahy Smith Act at the Board level, the statutorily rechristened Patent Trial and Appeal Board, the PTAB.

The overall theme of an ongoing study by this writer is the growing divide between the “prep’n’pros” mainstream patent practitioner and the legal specialty practice areas that will now become ever more important at the PTAB;

That ongoing study includes a focus on the very narrow scope of patent licensure that a patent agent enjoys where the Patent Office considers a patent agent to be practicing *law* outside the scope of his patent agent licensure where he drafts a patent assignment or gives an opinion on the infringement or validity of a patent. For the moment, however, this paper focuses upon a single aspect of the divide within the profession, “wordsmithing”:

A rising tension exists between lawyers and patent agents concerning the future of patent practice under the Leahy Smith Act where some wonder whether the patent agent profession is in jeopardy at some point in the future.

To be sure, to continue the viability of the patent agent profession the minimum standards for licensure must be upgraded to include within the licensure an assurance of a minimum competence level by a patent agent. When the Supreme Court in 1963 placed its imprimatur on patent agent practice it specifically cited the “reform ... effected by the Patent Office, which now requires all practitioners to pass a rigorous examination....” *Sperry*, 373 U.S. at 395-96(citation to regulation omitted).

Surely, *some* aspects of practice at the Office comprising administrative trials at the new Patent Trial and Appeal Board will require an understanding of complex legal and procedural rules and litigation aspects such as discovery including depositions of key witnesses.

It is not within this writer’s agenda that patent agent practice should be proscribed but rather that the system should be reformed whereby patent agents and lawyers will be better able to represent their clients before the Office. Certainly, at the very center is the need for better claim drafting skills. Whether the practice should be bifurcated to have Ph.D. and other highly technical trained scientists and engineers focused upon procurement before the examiner and have trial level practice at the new PTAB restricted to lawyers is a bridge that does not yet have to be crossed.

To the extent that lawyers are, without more, admitted to practice at the PTAB, this would in any event *increase* the supply of talent available to all, *increase* price competition. The legal consumer would benefit. Any change in practice would, of course, require a grandfather clause to permit all currently registered patent practitioners the right to continue practice within the scope of their licensure.

The Patent Hawk expresses mock concern about “those ... pro se prosecutors that are creating a backlog...” being proscribed from practice; this is not a practical problem as the backlog is created more by the major corporations with thousands of patents in their portfolios.

Neither is there any way that pro se representation could or should be eliminated even if that were a goal: If a capital murder defendant is permitted *pro se* representation where his very life is on the line *a fortiori* the inventor should and must be permitted to act *pro se*.

The answer is *not* to simply “do nothing” as a way to advance the cause of patent agents. To the contrary, the Leahy Smith Act coupled with increased competition will in the end lead to the crippling of the patent agent profession, absent reforms in the system. The current interpretation of the scope of patent agent licensure is quite limited and calls into question the legality of various patent agents (and patent attorneys not licensed where they practice) who today represent clients in legal matters that deal with infringement and validity opinions and other matters outside the licensure of a patent agent, and hence outside the safe harbor of *Sperry*. *Changes to Representation of Others Before the United States Patent and Trademark Office (Final Rule)*, 73 Federal Register 47650 (August 14, 2008)

The extreme nature of the problem is seen by the fact that the typical patent agent who does no more than draft assignments is practicing outside *Sperry* and subject to criminal prosecution by a State that chooses to enforce its laws against the unauthorized practice of law:

Registration does not authorize a registered practitioner to recommend or determine the terms to be included in an assignment. The practitioner is not authorized to select or recommend a particular form assignment from among standard form assignments. Registration does not authorize a practitioner to draft an assignment or other document in circumstances that do not contemplate a proceeding before the Office involving a patent application or patent. For example, where an assignment is prepared in contemplation of selling a patent or in contemplation of litigation, there is no proceeding before the Office. When, after a patent issues, there is no proceeding before the Office in which the patent agent may represent the patent owner, drafting an assignment or causing the assignment to be signed are not activities reasonably necessary and incidental to representing a patent owner before the Office. *Id.*, 73 Federal Register at 47666.

If the Patent Office interpretation is followed by a State, the patent agent who merely drafts a patent assignment is outside the licensure “safe harbor” of *Sperry*, 373 U.S. at 383, and subject to criminal prosecution in a State court for the unauthorized practice of law.

Patent agents represent a critical area of prep’n’pros practice, particularly insofar as drafting of cutting edge high technology applications by a Ph.D. specialist in the area can offer assistance to the applicant that may not be equaled by others.

The system must be reformed so that (a) the scope of licensure is defined in a way to more broadly reflected the realities of a patent practice to encompass such matters as patent contracts and opinions; while (b) *prospective* licensure requirements are tightened up so that all persons who are licensed will have established their proficiencies in the areas of their licensure.

Without reforms, the patent agent will stand in the precarious position of being at least arguably outside the safe harbor of *Sperry* and thus subject to prosecution for unauthorized practice of law while at the same time holding a licensure with an imprimatur that has lost its shine.