
Patent Claim Preambles

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Background: Claim Interpretation

A typical patent claim includes a preamble, a connecting term such as “comprising” (or some other transition word), and a body. Generally, the preamble is not used to define the scope of the invention but rather it is the body of the claim that serves that function. However, when the preamble is relied upon to define the claimed invention, it will be construed as a limitation.

To determine whether the preamble is relied upon to define the claimed invention, courts look to the plain meaning of the claim, to the written description of the invention in the patent specification, and to the prosecution history. For example, if the preamble recites additional structure or steps that are part of the invention, the preamble may operate as a claim limitation. Similarly, if a patent applicant “clearly relies” on the preamble to distinguish its invention from the prior art, the preamble may limit the claim scope. Also, when the preamble introduces a term used later in the claim, the preamble may be give limiting effect. Two recent cases illustrate when preamble language will narrow the scope of a claim.

Storage Technology Corp. v. Cisco Sys., Inc.

One patent in [Storage Technology](#) related to the forwarding of packets by a network device.

The preamble of one of the independent claims referred to a “protocol data unit forwarding device for use in a communication network” and the preamble of the other independent claim referred to a “method of operating a forwarding device within a communication network.” The body of each claim also recited two processors.

The plaintiff, StorageTek, argued that the reference to a “forwarding device” in the preamble did not mean that the two processors recited in the claim had to be part of a single device. Rather, StorageTek argued that the reference to the “forwarding device” did not require a specific device and that the two processors could be anywhere in the communication network.

The court disagreed and held that the “forwarding device” was a claim limitation. In support of its holding, the court noted that the written description in the patent emphasized that “a key benefit of the invention is that the use of” a preprocessor “within a forwarding device reduces the processing

otherwise performed by the forwarding device.” In addition, the court pointed to a figure in the patent that showed a forwarding device that contained both processors.

The court also found that the prosecution history supported its holding. As originally written, the body of the claims referred back to the forwarding device by including the phrase “such that subsequent processing of the protocol data unit by the protocol data unit forwarding device is reduced.” The court noted that though the phrase was subsequently eliminated, it was evidence that the applicants considered the two processors to be part of the forwarding device recited in the preamble. The court also pointed to the applicants’ argument that the deleted phrase was “unnecessary” because the function was recited elsewhere in the claim.

Additionally, the court noted that the applicants distinguished their invention over the prior art by relying upon the existence of the “forwarding device.” Therefore, it was proper to construe the preamble language as a claim limitation. In a second patent, the court ruled that preamble language did not act as a claim limitation. The preamble of claim 1 of the second patent referred to a “policy caching method.” The Federal Circuit concluded that the preamble language referred to the invention as a whole and was “a convenient label for the invention,” rather than a claim limitation. Significantly, there was no prosecution history, such as claim amendments, relating to the preamble language of the patent.

Invitrogen Corp. v. Biocrest Manufacturing

The patent in *Invitrogen* claimed a process for making E. coli cells that had enhanced capacity to accept foreign DNA. Such capacity is termed “competence.” The preamble of claim 1 referenced a “process for producing transformable E. coli cells of improved competence.”

The Federal Circuit found that the reference to “improved competence” in the preamble limited the scope of the claim because the applicants relied on it to distinguish the invention over the prior art. Originally, the preamble had only referenced “competent E. coli cells.” However, in response to a rejection by the Patent Office, the applicants changed the language to recite “E. coli cells of improved competence.” In discussing the prior art, the applicants stressed that it did not teach producing cells of improved competence. By contrast, the applicants stated that “the cells produced according to the claimed methods have improved competence.”

Thus, by amending the claim in response to a prior art rejection and by referring to the preamble language in its argument, the applicants had relied on the preamble language to distinguish their invention from the prior art. Accordingly, the court construed the preamble language as a limitation on the claim scope.

Summary

These decisions illustrate when claim preambles may be considered to limit claim scope. When the patent specification or statements from the file history indicate that a term in the preamble corresponds to a particular structure, or when the patent applicant uses a term in the preamble to distinguish the prior art, then the preamble term is more likely to be construed as a claim limitation. However, when there are no statements in the patent or file history to indicate that the preamble

term represents anything more than a label or descriptive name for the invention as a whole, then the term is less likely to be construed as a claim limitation.

Donald Steinberg

donald.steinberg@wilmerhale.com