

SCOTUS (Supreme Court of the United States) on the Art of Claims Drafting in the Wake of Cuozzo.

On June 20, 2016, the U.S. Supreme Court decided *Cuozzo Speed Technologies, LLC v. Lee*. The case was first brought in the Patent Trial and Appeal Board, which concluded that Cuozzo's claims 10, 14 and 17 were obvious in light of three (3) prior art patents. The Board cancelled all three (3) claims. Cuozzo appealed to the Federal Circuit claiming among other allegations that the Board improperly used the "Broadest reasonable construction" standard to interpret the claims rather than the "ordinary meaning" standard used by the Court in claims construction. The Board also took other measures and the Supreme Court's decision addressed a number of issues, which are not of interest in this opinion. Accordingly, our focus is limited to the impact this case may have on claims drafting in view of the two different standards used in claims interpretation as articulated in Cuozzo.

In today's environment, a practitioner faces a daunting task to draft claims that will stand the test of time. The confluence of different technological developments along with an unsettled patent's jurisprudence in the US ushers in this new paradigm. Specifically, the US entry into the first to file system enacted by AIA (America Invents Act) with its associated changes to the US patent system, two different standards used in claims interpretation, Industry 4.0 (rapidly changing technology with short time to live (TTL)), IoT (Internet of Things), AI (artificial Intelligence), 3-D printing with quantum computing lurking in the background all contribute to this unprecedented time in technological history. As I wrote in a previous article, "there is NO bright-line test in software patent eligibility in a post Alice world." Therefore, with a changing environment, a new approach in claims drafting is called for in harmony with this new era or paradigm. This new environment requires that claims be drafted with precision.

The US Supreme Court's dictum alluded to this new paradigm in its Cuozzo decision stating: "*The broadest reasonable construction standard helps ensure precision in drafting claims and prevents a patent from tying up too much knowledge, which in turn, helps members of the public draw useful information from the disclosed invention and understand the lawful limits of the claim.*" Such precision requires that a claim be drafted to satisfy this 5-point stratagem:

- 1) Who is the potential infringer?
- 2) Degree of difficulty to design around?
- 3) State of Technology:
 - a. Nascent field of technology;
 - b. Technology half way in its maturity phase;
 - c. Mature technology or crowded field of technology.
- 4) IP/Patent strategy objectives:
 - a. Claims drafted to be used offensively/defensively;
 - b. Claims drafted to be used in cross-licensing; and
- 5) Prosecution strategy.

The quality of patents remains a thorny issue; but now more than ever, precision in claims drafting is paramount. Such precision mandates that the above 5-point guide posts be adapted to a particular case to thereby delineate the exact metes and bounds of the claims.