



Expert Commentary

What Does the Word "Comprising" Mean, and Why Should I Care?

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In their intellectual property law column, Sanford E. Warren Jr. and Kenneth T. Emanuelson examine the negative nature of patent rights and the distributed nature of patent right ownership, providing entertaining examples of each.

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In general, intellectual property is fairly ethereal stuff. It's all about the ownership of things you can't see, smell, touch, or feel. You can't literally carry around your patent rights in your pocket or the backseat of your car. (Then again, storage is pretty much a cinch, and a bad patent claim generally won't get lost behind the cushions and smell up your whole car on a hot Summer day.)

Legal intangibles are tough enough to get a handle on even without the added complexities piled on by the innumerable intellectual property technicalities that our laws have created over the last 225 years. Unfortunately for the general public, intellectual property law has, over the centuries, developed its own independent rules, some of which jibe pretty well with the rest of the world's, and some of which don't really seem to fit at all, at least at first glance.

Although each branch of intellectual property law has its own set of particular, and sometimes weird, rules, probably no area is more rife with idiosyncrasies, picky rules, and peculiar concepts than the patent law. We patent attorneys speak in what seems like our own arcane language, using words like "comprising" as if it were going out of style (someone forgot to tell us that it did a long time ago), writing extremely long sentences violating all rules of proper English (at least we include a lot of semicolons), and using the word "said" when any normal person, or even a normal attorney, would simply use "the." Believe it or not, we generally have very good reasons for doing these things.

Demystifying Patent Terminology

As a patent attorney, it is often my job to translate the sometimes bizarre set of patent terminology and rules into English for the benefit of my non-lawyer clients. Unless my client is an attorney, or at least fairly well-versed in the law, responding to his question in patent-ese won't help him much in making his decisions in the real world. For example, I could tell a client concerned about infringement that "One or more of the dependent

claims may be valid and not anticipated by the prior art, but the effect of prosecution history estoppel will act to circumscribe their scope to their literal range, thereby eliminating any range of equivalents" and leave him no better off than he was before he came to me for advice.

Unless the client has experience in the patent law, I might as well give him an answer in Gaelic. Although some attorneys may believe that their understanding of legal jargon provides them with an "edge" over their clients, I believe that my relationships with my clients will be much closer and stronger where my clients understand what I'm doing and can have a meaningful role in the legal decision-making process.

In this article, and a few more to follow, I am going to attempt to provide the reader with a greater degree of insight into some of the basic concepts of patent law. Although a thorough grasp of the many subtleties and particularities of patent law can take years, or even decades, to attain, the fundamental concepts are really not that difficult to understand. It is my sincere hope that the broad outlines I lay out in these articles will encourage some of my readers to take a greater interest in the details of patent law. For others, I hope that they will at least serve to demystify some of the quirkiest concepts and make the whole subject just a little more palatable.

Addressing Patent Concerns and Questions

Most patent questions from my clients fall into one of three categories. Often, a client comes in with an invention and wants to know if he can get a patent on it. A second group includes those clients who already have patents and want to stop their competitors from building knock-off products. A final group includes those clients who are actively producing products and have been accused of patent infringement by a competitor. The questions raised by each of these groups are related, but distinct. Accordingly, I have decided to deal with them separately.

With respect to the first group, a client will often come in the door carrying an odd-looking contraption and want to know whether he can get a patent on it. In general, the answer is, "Probably so." Provided that the person sitting in my office developed this contraption, he can most likely get some form of limited patent protection for it.

My answer, however, is probably not of much use to my client. What my client really should have asked was whether he can get patent rights in his invention that will meaningfully further his business goals. The answer to that question is generally that the client can likely acquire certain limited patent rights that will further certain of his business goals. Then the inevitable follow-up question arises: "How much will it cost?" The prudent client will weigh the cost of those rights in fees against some estimate of the value of those rights in profits and decide accordingly.

Negative and Positive Patent Rights

In order to determine the value of any patent rights likely to be received, it is important to first understand the nature of patent rights themselves. The popular conception of a patent conceives of a formal paper giving the inventor the exclusive right to make, use, and sell the invention described in the patent. This popular conception is wrong on two fronts: (1) a patent doesn't really give anyone the right to do anything (except sue), and

(2) the invention described in the patent doesn't determine the scope of the patent rights. I will deal with point (1) in this article and follow up with point (2) in the next.

With respect to point (1), patent rights are purely negative rights, and do not carry with them any positive rights to do anything except to sue those infringing on the rights. In other words, a patent provides you with a form of veto power over certain actions by others, but it doesn't necessarily empower you to act yourself. This is in stark contrast to more traditional forms of property, such as real estate, which carry both positive and negative rights.

If you're in legal control of your home, you're legally empowered to enjoy the home as you see fit (a positive right) while also being legally empowered to eject other persons from the premises (a negative right). If home ownership were the same as patent ownership, you might in certain cases be able to exclude others from your house, but not be able to go there yourself.

A Prehistoric Analogy

The seemingly strange, and yet relatively common, situation where an inventor can't practice his own patented invention occurs where the inventor's contribution builds upon some earlier invention that is still protected by an enforceable patent. As an illustration, I often use the example of a three-legged stool. Sometime a long time ago, someone, probably a caveman, got tired of sitting on the ground all the time. Necessity being the mother of invention, this person took a flat piece of wood and stuck three sticks to the backside of it and made the world's first three-legged stool. I doubt they had a patent system back in those days, but let's pretend that they did, and let's pretend that this first caveman inventor, who we'll call "Caveman 1," received a patent #1 titled "Ooga Mooga Ugh," (which loosely translates as "Three-Legged Stool.") Patent #1 claims, "A stool comprising a seat and three legs attached to the seat."

Let's suppose that the "Ooga Mooga Ugh" became an instant hit and took the world by storm. Soon, Caveman 1 becomes a captain of industry and puts the manufacturers of dirt mounds and vaguely chair-shaped rocks completely out of business. Owing to his patent, Caveman 1 is the only person empowered to build the "Ooga Mooga Ugh" and builds a huge monopoly empire.

Most people are fairly happy with Caveman 1's contribution to the world of technology, but after a while, a certain limitation in the design becomes apparent. One day, one of Caveman 1's loyal customers falls asleep in one of the new stools. Startled by the sound of a Tyrannopotamus in the bushes, the sleeping caveman (we'll call him Caveman 2) falls over backwards off the stool and hits his head.

Whether through natural ingenuity or owing to hallucinations induced by the head blow, Caveman 2 decides that the "Ooga Mooga Ugh" can be improved. Grabbing a couple of bones and a vine, Caveman 2 builds a back for his stool, thereby creating what he calls the "Ooga Booga Wooga." Caveman 2 promptly gets patent #2 on the "Ooga Booga Wooga." Patent #2 claims, "A stool comprising a seat, three legs attached to the seat, and a back attached to the seat."

Caveman 2 is ready and able to begin manufacturing when he receives a stone tablet from Caveman 1's thugs. It reads:

Our client owns Patent # 1 for "Ooga Mooga Ugh." Your Ooga Booga Wooga infringes Patent # 1. Stop or else.—Onebrow, Gump & Hunchback, L.L.P.

Under these facts, even though Caveman 2 owns a patent on his new stool, he cannot make, use, or sell any of his patented inventions without the permission of Caveman 1. This is true due to the fact that even though Caveman 2 has created a new invention in his "Three-Legged Stool with Back," his invention cannot be made without necessarily incorporating Caveman 1's invention of the "Three-Legged Stool."

So, in light of the above, does this mean that Caveman 2's patent is worthless? Not at all. Properly utilized, Caveman 2's patent can actually be very valuable. While it is true that Caveman 2 can't manufacture his invention without the permission of Caveman 1, it's also the case that Caveman 1 can't manufacture any backed three-legged stools without the permission of Caveman 2.

Conceivably, many of Caveman 1's customers would prefer to have a back on their three-legged stools. In this situation, Caveman 2 can leverage his patent rights—which constitute, in a sense, veto rights against Caveman 1—to his own advantage. He may negotiate a monetary license with Caveman 1, allowing him to make the invention in exchange for money, or he may wish to negotiate a cross-license with Caveman 1, whereby each party grants the other party the right to make, use, and sell the other party's patented invention. If Caveman 2 is uninterested in the manufacturing business, he may wish to sell his patent outright to Caveman 1. Accordingly, it can be seen that Caveman 2's patent can be extremely valuable, even though it grants him only negative rights.

Co-Inventor Rights

A closely-related, and equally quirky, aspect of the patent law relates to the rights granted to co-inventors. In a purely theoretical sense, the negative rights granted by a patent could be allotted to co-owners in any number of ways. One possibility is that each co-owner could have an absolute veto right against every other person in the world except for the other co-owners. Under this scheme, any person wishing to practice the invention would need the permission of each and every co-owner to do so. If he didn't have unanimous permission, any of the co-owners could sue him at will.

Another possible scheme for the allotment of rights among co-owners is that in which no co-owner has any veto right against any person absent the unanimous agreement of the other co-owners. Under this scheme, any person wishing to practice the invention would need the permission of only one owner to do so. So long as one co-owner consented to such practice, the other co-owners would be completely helpless to stop him.

Other intermediate schemes could be contemplated, including a "majority rule" scheme, major and minor inventors, or the like, but each of the above "unanimous" schemes represents the two outer extremes.

In the United States, the latter scheme of patent ownership is employed. That is, any person wishing to practice an invention need only acquire the permission of one of several co-owners to do so. So, for example, in the case of a patent having five owners, four of which are rabid Armani-clad capitalists and the fifth of which is a "peace and love" type individual in tie-dye and Birkenstocks, the Armani set would be helpless to stop the latter from granting the invention to the public at large, to or any subset of humanity he may choose at his will.

It can be seen here that as there are more co-owners, there is an ever-increasing chance that one or more of the owners will, for one reason or another, refuse to help in enforcement efforts. Accordingly, an increase in the number of co-owners of a patent tends to decrease the chance that the patent will ultimately be successfully enforced.

In the real world, patent rights are generally transferred from inventors to the corporations that employ them. A given patent, even one that is the product of numerous individual inventors, will generally be wholly owned by a single corporation, which is a single legal entity even though it may have millions of shareholders. In those cases, decisions as to patent enforcement are under the exclusive control of the corporation's officers, rather than the individual inventors and shareholders. Patent ownership will sometimes be shared by two or more separate companies in a joint venture arrangement, but owing to the enforceability issues discussed above, such shared ownership is often best avoided.

Conclusion

To sum up, rights in a patent represent only negative rights, and the grant of a patent on an invention does not necessarily mean that the patent owner can practice the invention claimed. Furthermore, enforcement of these negative rights against members of the public requires the unanimous consent of the owners of the patent, so that enforcement of a patent having multiple owners can be difficult, if not impossible.

While this article has highlighted certain quirky principles of patent law—the negative nature of patent rights and the distributed nature of patent right ownership—these are by no means the only, or even the most important ones. The next article will cover an equally-important principle: determination of the scope of the negative right that the patent holder can legitimately claim against the public.

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