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WRITE LIKE A PATENT LITIGATOR: AVOID COMMON MISTAKES MADE BY NON-PATENT  
LAWYERS

TED L. FIELD

ABSTRACT

Following, or not following, conventions as an attorney may lead to a question of credibility. Particularly with patent law, there are certain conventions and usage errors commonly made by practitioners who are not familiar with patent law. While these errors may be irrelevant in plain English, they are often important components in the specialized language of patent law. This article discusses the importance of these components by examining examples of particular usages that often give rise to error.

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## WRITE LIKE A PATENT LITIGATOR: AVOID COMMON MISTAKES MADE BY NON-PATENT LAWYERS

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### I. INTRODUCTION

Language matters. Say that you are a patent litigator working on a case. Your opponent files a motion for summary judgment. When you see a copy of the motion, you see that the title is: “MOTION FOR SUMMARY JUDGEMENT OF NONINFRINGEMENT.” What is the first thing that you notice? Does the fact that “judgment” is spelled as “judgement”—i.e., with an “e”—strike you as odd? Does it immediately give you a certain impression of opposing counsel? If you are like many attorneys, you might wonder how that attorney got through law school without learning to spell “judgment” without an “e.”<sup>1</sup> And you might be thinking that lawyers simply don’t spell “judgment” with an “e”!<sup>2</sup> Indeed, even though “judgement” is a perfectly acceptable spelling of the word,<sup>3</sup> an attorney who spells “judgment” with an “e” might instantly lose credibility with his or her readers,<sup>4</sup> merely by not spelling “judgment” according to the convention of legal usage.<sup>5</sup>

The spelling of “judgment” without an “e” is an example of a convention that signals to the reader that the writer is a member of a particular group—namely, the legal profession. But a writer who fails to follow this convention by spelling “judgment” with an “e” may signal the opposite to the reader—that the writer is not truly a member of the legal profession. Within the specialty of patent law, there are similar conventions that patent litigators follow when writing. A few of these conventions have the potential to trip up lawyers—and even district court judges or Supreme Court justices—who are relatively unfamiliar with patent law. If a writer fails to follow these conventions in a document, then a seasoned patent litigator or Federal Circuit judge reading the document might be left with the impression that the writer truly is not a patent litigator, thus potentially hurting the writer’s credibility.

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<sup>1</sup> See PETER M. TIERSMA, LEGAL LANGUAGE 52 (1999).

<sup>2</sup> See *id.*

<sup>3</sup> MERRIAM WEBSTER’S COLLEGIATE DICTIONARY 677 (11th ed. 2003); *Judgement/Judgment, n.*, OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/101892> [<https://perma.cc/NCQ2-PPC6>].

<sup>4</sup> See TIERSMA, *supra* note 1, at 52.

<sup>5</sup> *Judgement/Judgment, n.*, *supra* note 3 (“[*J*udgment has remained the standard spelling in British legal contexts when used to refer to a judicial decision . . . , as well as in U.S. usage.”).

This article discusses usage errors commonly made by practitioners and others in language relating to patent law. First, Part II provides background on reasons why the specialized language of patent law is important. Second, Part III gives five examples of particular usages that often give rise to error. These usages are:

- “Infringe” versus “infringe on”;
- “Doctrine of equivalents” versus “doctrine of equivalence”;
- “Limitation” versus “element”;
- “File an application” versus “file a patent”; and
- “Would have been obvious” versus “is obvious.”

The discussion of each of these usages identifies the errors commonly made with respect to that usage, and it also provides advice on how writers can avoid the errors.

## II. THE IMPORTANCE OF THE SPECIALIZED LANGUAGE OF PATENT LAW

Every major human specialty acquires its own particular vocabulary and conventional language usages.<sup>6</sup> Indeed, “every major human institution, such as medicine, business, education or the law, develops not just a specialist vocabulary, but a special way of conceiving and construing the world, and a specialized language to express this understanding.”<sup>7</sup> Of course, the law has developed its own specialized language.<sup>8</sup> And even sub-specialties within the law have developed their own specialized languages and language usages.<sup>9</sup> Patent law is one such sub-specialty.

The need for specialized language is twofold. First, specialized language allows for efficiency in communication between members of the specialty.<sup>10</sup> Second, specialized language serves a “sociocultural role” in that “[i]t can mark membership in a specialist group, or club.”<sup>11</sup>

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<sup>6</sup> JOHN GIBBONS, *FORENSIC LINGUISTICS: AN INTRODUCTION TO LANGUAGE IN THE JUSTICE SYSTEM* 36 (2003).

<sup>7</sup> *Id.*

<sup>8</sup> *See, e.g.*, JOHN M. CONLEY & WILLIAM M. O'BARR, *JUST WORDS: LAW, LANGUAGE, AND POWER* xi (2d. ed. 2005) (describing the “vibrant interdisciplinary field of law and language studies”); GIBBONS, *supra* note 6, at 2 (“It is . . . not only the law that permeates our lives, but the language of the law . . .”); BERNARD S. JACKSON, *MAKING SENSE IN LAW: LINGUISTIC, PSYCHOLOGICAL AND SEMIOTIC PERSPECTIVES* 89–90 (1995) (“[T]here may, in a sense, be a kind of ‘legal grapholect’—a form of language, including a vocabulary, which is ‘standard’ for lawyers, in the sense that all are *expected* to command it . . .”); DAVID MELLINKOFF, *THE LANGUAGE OF THE LAW* 3 (1963) (defining the “language of the law” as “the customary language used by lawyers in those common law jurisdictions where English is the official language”); TIERSMA, *supra* note 1, at 1 (describing the study of “the complex language of lawyers”); Robert B. Benson, *The End of Legalese: The Game Is Over*, N.Y.U. REV. L. & SOC. CHANGE 519, 520 (1984–85) (describing criticisms of “lawyers’ language”); Lawrence M. Friedman, *Law and Its Language*, 33 GEO. WASH. L. REV. 563, 563 (1964–65) (“[I]t is perfectly clear that there is a legal jargon and that it consists of (a) a vocabulary of terms used by legal specialists but not understood by the general public; and (b) a legal style . . .”); Lawrence M. Solan & Peter M. Tiersma, *Introduction*, in *THE OXFORD HANDBOOK OF LANGUAGE AND LAW* 1 (Peter M. Tiersma & Lawrence M. Solan eds., 2012) (“What is it about legal language that sounds so different . . .?”).

<sup>9</sup> *See* JACKSON, *supra* note 8, at 97 (“Even *within* the legal community, there exist many different occupational groups, each with its own version of legal language.”).

<sup>10</sup> GIBBONS, *supra* note 6, at 36–37; TIERSMA, *supra* note 1, at 71; Friedman, *supra* note 8, at 564.

<sup>11</sup> GIBBONS, *supra* note 6, at 37; *accord* TIERSMA, *supra* note 1, at 51; Friedman, *supra* note 8, at 566–67.

Specialized language allows for efficiency because specialized terms allow for the communication of concepts that would otherwise require “long and clumsy explanations each time reference was made to the technical process or notion.”<sup>12</sup> If the English language lacks terms for certain specialized concepts, then specialists who must frequently communicate these concepts will naturally invent terms of art for these concepts.<sup>13</sup> Thus, specialized language allows specialists to save time in communicating these concepts.<sup>14</sup> And specialized language can also allow specialists to communicate concepts with more precision than without specialized language.<sup>15</sup>

Moreover, the use of specialized language signals to readers that the writer is part of a particular group.<sup>16</sup> Thus, “lawyers use language to set themselves apart from the mass of the population and to create group cohesion.”<sup>17</sup> By using specialized legal language, lawyers “subtly communicate to each other that they are members of the same club or fraternity.”<sup>18</sup> Indeed,

[s]pecialized vocabulary reinforces the group feelings of members. The use of words, phrases, and expressions known to other members of the group, but not to outsiders, helps define the group and give it a sense of meaning and reality. A common vocabulary and style enable lawyers to recognize one another as lawyers and to distinguish themselves collectively from laymen. The uniqueness and the toughness of legal language enhance the claim of lawyers to be members of a “profession.”<sup>19</sup>

In this way, the use of shared legal language has a positive effect on lawyers.

But there is also a downside to the use of specialized language to define group membership.<sup>20</sup> By defining who is a member of a particular group, the use of

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<sup>12</sup> GIBBONS, *supra* note 6, at 36; *see also* Friedman, *supra* note 8, at 564 (“Any group with common problems or interests tends to develop a specialized vocabulary for ease of communication within the group.”).

<sup>13</sup> Friedman, *supra* note 8, at 564.

<sup>14</sup> *Id.*

<sup>15</sup> *See* GIBBONS, *supra* note 6, at 37 (“There is . . . a real need for specialist language in the conceptual realm . . . in order to be precise.”); TIERSMA, *supra* note 1, at 71 (“Much of the linguistic behavior of the legal profession is geared towards speaking and writing as clearly and precisely as possible.”). *But see id.* at 85 (“[T]he claimed precision of legal language is largely a ‘myth.’ . . . There is no doubt that lawyers tend to exaggerate the precision of legal language.” (footnote omitted)) (citing David Mellinkoff, *The Myth of Precision and the Law Dictionary*, 31 UCLA L. REV. 423 (1983)); Friedman, *supra* note 8, at 564 (“Some authorities have admired, or at least excused, the fussy precision of technical legal writing; most, however, have cursed it. The cursers include Jeremy Bentham, who spoke of ‘nomenclature devised in a barbarous age, by a mixture of stupidity, ignorance, error, and lawyer-craft.’” (quoting MELLINKOFF, *supra* note 8, at 265)).

<sup>16</sup> GIBBONS, *supra* note 6, at 37; *accord* TIERSMA, *supra* note 1, at 51; Friedman, *supra* note 8, at 566–67.

<sup>17</sup> TIERSMA, *supra* note 1, at 51.

<sup>18</sup> GIBBONS, *supra* note 6, at 37.

<sup>19</sup> Friedman, *supra* note 8, at 566–67 (footnotes omitted).

<sup>20</sup> GIBBONS, *supra* note 6, at 37; *see also* TIERSMA, *supra* note 1, at 107 (“Jargon is more objectionable when it serves mainly to suggest that the speaker or writer is a member of the legal fraternity. All too often, ‘talking like a lawyer’ seems to be its only function.”).

specialized language also necessarily defines who is not a member of that group.<sup>21</sup> Thus, the use of legal language has not only an inclusive effect but also an exclusive effect.<sup>22</sup> This exclusive effect can shape the way that members of the general public view lawyers:

In the eyes of the public, the linguistic characteristics . . . incorporated into the formulation of the law are frequently seen as an obstacle to understanding its content and as often leading to communicative failure wherever such texts are in focus. The fact that societies have specific professions especially designed to act as links between the public and the legal system itself suggests the potential risk of problems arising from the incompatibility of the routines of ordinary communication and those of the language of legal texts.<sup>23</sup>

For better or for worse, readers belonging to a particular group expect that writers in that same group will use the appropriate specialist language for that group.<sup>24</sup> And, for better or for worse, readers are likely to look down upon a writer who fails to live up to this expectation.<sup>25</sup> Of course, a writer's failure to use appropriate specialist language does not mean that the writer is a bad person in any sort of moral sense, or is less intelligent for doing so.<sup>26</sup> But readers will nonetheless likely assign lesser credibility to writing that fails to conform with the language norms appropriate to the specialty group at issue because the reader will perceive that the writer does not truly

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<sup>21</sup> See GIBBONS, *supra* note 6, at 37 (“[I]n-group language . . . also operates to exclude those who are not members of the group . . . .”); TIERSMA, *supra* note 1, at 69 (“[E]mphasis on group cohesion necessarily excludes those who do not belong and who have not learned to ‘talk like lawyers.’”); *cf.* Benson, *supra* note 8, at 529 (“Anthropologists have observed that formal language functions as ‘a form of power for the powerful.’”).

<sup>22</sup> GIBBONS, *supra* note 6, at 37; TIERSMA, *supra* note 1, at 69.

<sup>23</sup> Risto Hiltunen, *The Grammar and Structure of Legal Texts*, in THE OXFORD HANDBOOK OF LANGUAGE AND LAW 39, 39 (Peter M. Tiersma & Lawrence M. Solan eds., 2012); *see also* GIBBONS, *supra* note 6, at 37 (“[I]f the language needed to operate within a specialist field is unintelligible to non-specialists, this creates a need for the services of a specialist to mediate between ordinary people and the specialist field. Put crudely, it makes work and money for lawyers.”); TIERSMA, *supra* note 1, at 69 (“[E]mphasis on group cohesion necessarily excludes those who do not belong and who have not learned to ‘talk like lawyers.’ When dealing with the public, that is obviously the wrong message to send.”)

<sup>24</sup> See GIBBONS, *supra* note 6, at 36–37; *see also* Maurizio Gotti, *Text and Genre*, in THE OXFORD HANDBOOK OF LANGUAGE AND LAW 52, 60 (Peter M. Tiersma & Lawrence M. Solan eds., 2012) (“With time, several text types have arisen—some derived from genres common in general language, others crafted specifically to meet the needs of specialists. Through training and professional engagements, specialists learn to follow given norms and patterns in each type of text.”).

<sup>25</sup> See Gotti, *supra* note 24, at 60 (“The conventional use of genres also produces certain expectations among readers, and whenever the rules are broken a text may be misunderstood or rejected.”); *cf.* Benson, *supra* note 8, at 529 (“[T]here is solid empirical research revealing that . . . people draw conclusions about your social status, power, and personality from the way you speak.”).

<sup>26</sup> See ROGER SHUY, LINGUISTIC BATTLES IN TRADEMARK DISPUTES 6 (2002) (“[L]inguistic research continues to show that those who vary from the norms of [language standardization] are indeed not deviant, stupid, ignorant or immoral.”).

belong to that group.<sup>27</sup> And, in some cases, writing that fails to conform with these norms will be less precise and thus less understandable by the reader.<sup>28</sup>

As discussed above in the Introduction, the spelling of the word “judgment” without an “e” is an example of a legal usage that signals to others that the writer is a member of the legal community.<sup>29</sup> Other than group cohesion, there is no good reason for lawyers to insist upon spelling “judgement” without an “e.”<sup>30</sup> Actually, there is a better argument for spelling it *with* an “e”:

For the most part, the spelling of legal terms is the same as ordinary English. An interesting deviation is *judgment*. In nonlegal writing, *judgement* and *judgment* both occur. The Oxford English Dictionary lists both alternatives, although *judgement* comes first and is presumably preferred. As a logical matter, *judgement* makes more sense: just add the suffix *-ment* to the word *judge*. Nonetheless, in legal circles one always encounters *judgment*, the less logical alternative; *judgement* is a virtual pariah. I was specifically told during law school that lawyers spell the word without an *e*. . . . The reason . . . is not merely tradition; . . . spellings such as *judgment* have come to be perceived as signaling membership in the profession.<sup>31</sup>

Thus, attorneys notice when another attorney spells “judgment” with an “e,” and they are likely to look down upon that attorney for doing so.<sup>32</sup>

Patent law is a specialty of the law that has its own specialized language usages.<sup>33</sup> To maintain maximum credibility, a patent lawyer must not only write using the specialized language of the law but must also write using the even-more specialized language of patent law. Readers who specialize in patent law may view a writer who fails at these tasks as being less credible<sup>34</sup>—much the same way that most lawyers would view someone who spells “judgment” with an “e” as being less credible. But a writer who successfully uses the specialized language of patent law ensures that other patent lawyers—as well as judges of the U.S. Court of Appeals for the Federal Circuit<sup>35</sup>—will view the writer as a “true” patent lawyer.

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<sup>27</sup> See Gotti, *supra* note 24, at 60.

<sup>28</sup> For example, failure to use appropriate terms of art may render writing less clear. See GIBBONS, *supra* note 6, at 39 (characterizing terms of art as “more accurate or more efficient when referring to legal concepts” than general language).

<sup>29</sup> TIERSMA, *supra* note 1, at 52.

<sup>30</sup> See *id.*

<sup>31</sup> *Id.*

<sup>32</sup> See *id.*; cf. Gotti, *supra* note 24, at 60 (“The conventional use of genres also produces certain expectations among readers, and whenever the rules are broken a text may be misunderstood or rejected.”).

<sup>33</sup> Cf. JACKSON, *supra* note 8, at 97 (“Even *within* the legal community, there exist many different occupational groups, each with its own version of legal language.”).

<sup>34</sup> At the very least, writing outside the norms of the language of patent law may cause the reader to stop and notice, even if the reader is not otherwise left with a negative impression. Persuasive writing is weak if it causes the reader to be distracted from the flow of the text.

<sup>35</sup> Federal Circuit judges are much more likely to recognize (and use) the correct usage of the specialized language of patent law than either district court judges or even Supreme Court justices. As discussed *infra* in Part III, some district court judges and Supreme Court justices make the same errors as non-patent lawyers do when writing about patent law.

## III. EXAMPLES OF IMPROPER USAGES IN PATENT-LAW LANGUAGE

This Part gives five examples of particular usages that often give rise to error in writings of attorneys and judges who are relatively lacking in patent-law experience. These examples are:

- “Infringe” versus “infringe on”;
- “Doctrine of equivalents” versus “doctrine of equivalence”;
- “Limitation” versus “element”;
- “File an application” versus “file a patent”; and
- “Would have been obvious” versus “is obvious.”

The following sections discuss each of these examples in turn.

## A. “Infringe” Versus “Infringe on”

In a patent-infringement suit, the patentee attempts to prove that the accused infringer’s “process, machine, manufacture, or composition of matter”<sup>36</sup> infringes one or more claims of the patentee’s patent.<sup>37</sup> It is proper to write that something *infringes* a patent or a patent claim, but it is improper to write that something *infringes on*<sup>38</sup> a patent or patent claim. An example of proper usage is:

[T]here is substantial evidence that [the] accused system *infringes* claim 10.<sup>39</sup>

But the following is an example of improper usage:

There is no reasonable factual dispute that T-Mobile’s required method of transmitting contactless data from the antenna to the SIM Card *infringes on* the ‘043 patent.<sup>40</sup>

The problem here stems from the fact that “infringe” can, in general, be used properly as either a transitive or intransitive verb.<sup>41</sup> A transitive verb is a verb that “is

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<sup>36</sup> 35 U.S.C. § 101 (2006).

<sup>37</sup> Patent infringement is the unauthorized “mak[ing], us[ing], offer[ing] to sell, or sell[ing] any patented invention, within the United States or import[ing] into the United States any patented invention during the term of the patent therefor.” 35 U.S.C. § 271(a) (2006).

<sup>38</sup> In addition to “infringes on,” “infringes upon” is also an incorrect usage that commonly appears. See, e.g., Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 23 (1997) (“The jury found that . . . Warner-Jenkinson *infringed upon* the patent under the doctrine of equivalents.” (emphasis added)); Windy City Innovations, LLC v. Microsoft Corp., 193 F. Supp. 3d 1109, 1110 (N.D. Cal. 2016) (“[P]laintiff seeks . . . [an] injunction preventing defendant from continuing to *infringe upon* the patents at issue . . .” (emphasis added)); Reply Brief for Plaintiff-Appellant at 8, Lumen View Tech. LLC v. Findthebest.com, Inc., 811 F.3d 479 (Fed. Cir. 2016) (Nos. 2015–1325, 2015–1275) (“Lumen has consistently argued that FTB *infringes upon* the ‘073 Patent . . .” (emphasis added)).

<sup>39</sup> Alfred E. Mann Found. for Sci. Research v. Cochlear Corp., 841 F.3d 1334, 1341 (Fed. Cir. 2016) (emphasis added).

<sup>40</sup> On Track Innovations Ltd. v. T-Mobile USA, Inc., 106 F. Supp. 3d 369, 394 (S.D.N.Y. 2015) (emphasis added).

<sup>41</sup> See MERRIAM WEBSTER’S COLLEGIATE DICTIONARY 642 (11th ed. 2003); *Infringe*, v.1, OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/95644> [<https://perma.cc/KKU2-7K7R>].



used with an object.”<sup>42</sup> For example, in the following sentence, “loves” is used as a transitive verb: “She loves animals.”<sup>43</sup> In this sentence, the noun “animals” is the object of the verb “loves.”<sup>44</sup> In contrast, an intransitive verb is a verb that “does not have an object.”<sup>45</sup> For example, in the following sentence, “work” is used as an intransitive verb: “I work for a large firm in Paris.”<sup>46</sup> There is no object in this sentence—the phrase “for a large firm” is a prepositional phrase, not an object. Therefore, the verb “work” is, indeed, being used as an intransitive verb.<sup>47</sup>

Like many other verbs,<sup>48</sup> “infringe” can be used as either a transitive or intransitive verb.<sup>49</sup> Using “infringe” as a transitive verb looks like this: “The invention *infringed* claim 2 of the patent.” In this sentence, “claim 2” is the object of the verb “infringed.” And using “infringe” as an intransitive verb looks like this: “The invention *infringed on* claim 2 of the patent.” There is no object in this sentence—the phrase “on claim 2” is a prepositional phrase, not an object. And because there is no object, the verb is intransitive.<sup>50</sup>

When writing about patent law,<sup>51</sup> the preferred usage of the verb “infringe” is as a transitive verb. The Oxford English Dictionary defines the transitive version of “infringe” as: “To commit a breach or infraction of (a law, obligation, right, etc.); to violate or break (an oath, pledge, treaty, etc.); to transgress, contravene.”<sup>52</sup> In contrast, the same dictionary defines the intransitive version of “infringe” as: “To break in or encroach *on* or *upon*.”<sup>53</sup> Infringement of a patent fits the transitive definition much better: to infringe a patent is “[t]o commit a breach or infraction of (a law, obligation, right, etc.),”<sup>54</sup> much more than it is “[t]o break in or encroach *on* or *upon*.”<sup>55</sup> Thus, the transitive form of “to infringe” should be the correct usage based on the definition in the Oxford English Dictionary.

Even though the transitive form of “to infringe” better fits the dictionary definition than the intransitive form, a writer who instead writes “infringes on” does not lose any meaning or precision: “infringes a patent” and “infringes on a patent” seemingly convey the exact same meaning. But that does not make the two forms interchangeable in the specialized language of patent law, any more than “judgment” and “judgement” are

<sup>42</sup> Oxford University Press, *Transitive and Intransitive Verbs*, OXFORD DICTIONARIES, <http://en.oxforddictionaries.com/grammar/transitive-and-intransitive-verbs> [https://perma.cc/8M7R-ZBY8]. An object is “[t]he person or thing affected by a verb.” Oxford University Press, *Grammar A–Z*, OXFORD DICTIONARIES, <http://en.oxforddictionaries.com/grammar/grammar-a-z#object> [https://perma.cc/7LKZ-3TAH].

<sup>43</sup> *Transitive and Intransitive Verbs*, *supra* note 42.

<sup>44</sup> *See Grammar A–Z*, *supra* note 42.

<sup>45</sup> *Transitive and Intransitive Verbs*, *supra* note 42.

<sup>46</sup> *Id.*

<sup>47</sup> *See id.*

<sup>48</sup> *See id.*

<sup>49</sup> *See* MERRIAM WEBSTER’S COLLEGIATE DICTIONARY, *supra* note 41; *Infringe*, v.1, *supra* note 41.

<sup>50</sup> *See Transitive and Intransitive Verbs*, *supra* note 42.

<sup>51</sup> The same is true for trademark law and copyright law, as well. It is correct to write that “Acme *infringed* the trademark” (as opposed to “Acme *infringed on* the trademark”). Similarly, it is correct to write “XYZ *infringed* the copyright” (as opposed to “XYZ *infringed on* the copyright”).

<sup>52</sup> *Infringe*, v.1, *supra* note 41.

<sup>53</sup> *Id.*

<sup>54</sup> *Id.*

<sup>55</sup> *Id.*

interchangeable in the specialized language of the law as a whole.<sup>56</sup> Even though the difference between “infringes” and “infringes on” seems to be “trivial,”<sup>57</sup> the transitive form has become the conventional usage despite this seemingly trivial difference.

It is useful to look to the Federal Circuit’s usage of a particular term to determine what the convention is with respect to the specialized language of patent law. Federal Circuit usage of a particular term is authoritative for at least two reasons. First, because the Federal Circuit has exclusive jurisdiction over patent appeals,<sup>58</sup> Federal Circuit judges are much more familiar with patent cases than district court judges and Supreme Court justices, who only occasionally hear patent cases.<sup>59</sup> Thus, they are very careful with their usage of patent-law terms. Second, because the Federal Circuit is the “the court of last resort” in almost all patent cases,<sup>60</sup> the Federal Circuit actually establishes many of the norms in patent-law language, which patent attorneys then adopt.

The Federal Circuit’s consistent usage of the transitive form of “infringe” confirms that this usage is the accepted convention. Since the creation of the Federal Circuit in 1982,<sup>61</sup> with only a few exceptions, this court uses the transitive form of “infringe.”<sup>62</sup> Out of hundreds of usages of “infringe,”<sup>63</sup> the court used the less desirable intransitive form of “infringe on” or “infringe upon” only nine times.<sup>64</sup> The main exceptions in which

<sup>56</sup> See TIERSMA, *supra* note 1, at 52.

<sup>57</sup> *Id.* at 51 (“Some of the clearest examples of ‘talking like a lawyer’ are also, in a sense, the most trivial: minor quirks in pronunciation, spelling and punctuation.”).

<sup>58</sup> 28 U.S.C. § 1295(a)(1) (2006).

<sup>59</sup> See Paul M. Janicke, *The Patent Malpractice Thicket, or Why Justice Holmes Was Right*, 50 HOUS. L. REV. 437, 477 (2012) (“Members of Congress working in recent years on bills to improve patent litigation have noticed that the typical federal judge seldom sees a patent case.”).

<sup>60</sup> William C. Rooklidge & Matthew F. Weil, *En Banc Review, Horror Pleni, and the Resolution of Patent Law Conflicts*, 40 SANTA CLARA L. REV. 787, 815 (2000).

<sup>61</sup> “Congress created the U.S. Court of Appeals for the Federal Circuit in 1982 when it enacted the Federal Court Improvements Act of 1982 (FCIA).” Ted L. Field, *Improving the Federal Circuit’s Approach to Choice of Law for Procedural Matters in Patent Cases*, 16 GEO. MASON L. REV. 643, 643 (2009).

<sup>62</sup> See, e.g., Alfred E. Mann Found. for Sci. Research v. Cochlear Corp., 841 F.3d 1334, 1341 (Fed. Cir. 2016) (“[T]here is substantial evidence that [the] accused system *infringes* claim 10.” (emphasis added)).

<sup>63</sup> To investigate the Federal Circuit’s usage of “infringe on” or “infringe upon,” the author searched the Westlaw “Federal Circuit Court of Appeals Cases” database using the following search term: **adv: (“infringe on” “infringe upon”) /s (patent claim)**. This search yielded 133 hits for the Federal Circuit. Of these 133 hits, almost all of them were usages within the headnotes prepared by West publishing, rather than in the official text of the cases. See, e.g., Flexiteek Americas, Inc. v. Plasteak, Inc., 603 F. App’x 994, 994 (Fed. Cir. 2015) (“A competitor’s surface covering product . . . did not *infringe on* patent . . . .” (emphasis added)); Gemalto S.A. v. HTC Corp., 754 F.3d 1364, 1364 (Fed. Cir. 2014) (“[A]lleged infringers did not *infringe on* patent . . . .” (emphasis added)); Ncube Corp. v. SeaChange Int’l Inc., 732 F.3d 1346, 1346 (Fed. Cir. 2013) (“District Court did not abuse its discretion in determining that the modification of the Connection Table . . . made it more than colorably different from the ITV system that had been found to *infringe on* patent . . . .” (emphasis added)).

<sup>64</sup> See United Constr. Prod., Inc. v. Tile Tech, Inc., 843 F.3d 1363, 1371 (Fed. Cir. 2016); ePlus, Inc. v. Lawson Software, Inc., 789 F.3d 1349, 1359 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 1166, 194 L. Ed. 2d 177 (2016); Emergis Techs., Inc. v. PNM Res., 263 F. App’x 63, 64 (Fed. Cir. 2008); TriMed, Inc. v. Stryker Corp., 514 F.3d 1256, 1259 (Fed. Cir. 2008); Citizens Elecs. Co. v. OSRAM GmbH, 225 F. App’x 890, 891 (Fed. Cir. 2007); Vanguard Research, Inc. v. PEAT, Inc., 304 F.3d 1249, 1252 (Fed. Cir. 2002); Delta Sys., Inc. v. Indak Mfg. Corp., 4 F. App’x 857, 859 (Fed. Cir. 2001); Manchak v. Chem. Waste Mgmt., Inc., 217 F.3d 860 (Fed. Cir. 1999); Orthopedic Equip. Co. v. All Orthopedic Appliances,

the Federal Circuit uses “infringe on” or “infringe upon” occur where the court is directly quoting another source.<sup>65</sup> Interestingly, in one instance of such a direct quote, the Federal Circuit, in quoting the Supreme Court’s opinion in *Warner–Jenkinson Co. v. Hilton Davis Chemical Co.*,<sup>66</sup> noted the incorrect usage of “infringe upon” by including a “[sic]”<sup>67</sup> notation within the quote, as follows:

Under the doctrine of equivalents, “a product or process that does not literally *infringe upon* [sic] the express terms of a patent claim may nonetheless be found to infringe if there is ‘equivalence’ between the elements of the accused product or process and the claimed elements of the patented invention.”<sup>68</sup>

By using “[sic]” here, the Federal Circuit thus implicitly rejected the intransitive use of “infringe on.”<sup>69</sup>

In contrast, district courts, the U.S. Supreme Court, and practitioners use the intransitive “infringe on” form more often than the Federal Circuit does. Although district courts use the correct “infringe” form most of the time, they nonetheless use the incorrect “infringe on” form more frequently than the Federal Circuit does. A search of district court opinions<sup>70</sup> revealed numerous usages of the less-desirable “infringe on” form.<sup>71</sup> And another search<sup>72</sup> also revealed that the Supreme Court has used the “infringe on” form nine times,<sup>73</sup> although the Supreme Court almost always

Inc., 707 F.2d 1376, 1383 (Fed. Cir. 1983), *abrogated by* *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276 (Fed. Cir. 2011).

<sup>65</sup> See, e.g., *SanDisk Corp. v. Kingston Tech. Co.*, 695 F.3d 1348, 1363 (Fed. Cir. 2012) (quoting *Warner–Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21 (1997)); *Grober v. Mako Prod., Inc.*, 686 F.3d 1335, 1344 (Fed. Cir. 2012) (quoting the district court transcript); *In re Bill of Lading Transmission & Processing Sys. Patent Litig.*, 681 F.3d 1323, 1341 (Fed. Cir. 2012) (quoting the complaint).

<sup>66</sup> 520 U.S. 17 (1997).

<sup>67</sup> The notation “[sic]” is used within a quotation “to indicate that an error or oddity in quoted matter appeared in the original.” BRYAN A. GARNER, *THE REDBOOK: A MANUAL ON LEGAL STYLE* § 1.40(b), at 29 (2d ed. 2006).

<sup>68</sup> *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1315 (Fed. Cir. 1998) (Lourie, J.) (quoting *Warner–Jenkinson*, 520 U.S. at 21).

<sup>69</sup> See GARNER, *supra* note 67.

<sup>70</sup> The author searched the Westlaw “Federal District Court Cases” database using the following search term: **adv: (“infringe on” /1 patent) (patent & “infringe on” /1 claim)**.

<sup>71</sup> See, e.g., *Limelight Networks, Inc. v. XO Commc’ns, LLC*, No. 3:15-CV-720-JAG, 2017 WL 976623, at \*4 (E.D. Va. Mar. 13, 2017) (“The Court cannot say that Akamai does not *infringe on* Limelight’s asserted ‘155 Patent as a matter of law . . . .” (emphasis added)); *Ottah v. BMW*, No. 15 CV 02465-LTS, 2017 WL 437412, at \*4 (S.D.N.Y. Feb. 1, 2017) (“This evidence demonstrates that the accused cameras do not meet the ‘removable attachment’ limitation of the ‘840 patent’s claim and thus do not literally *infringe on* the patent.” (emphasis added)); *Capstan AG Sys., Inc. v. Raven Indus., Inc.*, No. 16-CV-04132-DDC-KGS, 2017 WL 106839, at \*2 (D. Kan. Jan. 11, 2017) (“Plaintiff alleges that Raven’s Hawkeye system and CNH’s AIM Command FLEX system *infringe on* plaintiff’s two PinPoint®-related patents.” (emphasis added)).

<sup>72</sup> The author searched the Westlaw “U.S. Supreme Court Cases” database using the following search term: **adv: patent & (“infringe on” “infringe upon”) /s (patent claim)**.

<sup>73</sup> See *Commil USA, LLC v. Cisco Sys., Inc.*, 135 S. Ct. 1920, 1924 (2015) (“One form of patent injury occurs if unauthorized persons or entities copy, use, or otherwise *infringe upon* the patented invention.” (emphasis added)); *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 59 n.5 (1998) (“The court found that the Wells device did not literally *infringe on* Pfaff’s ‘377 patent based on the physical location of

uses the “infringe” form. Finally, yet another search revealed that practitioners often have used the “infringe on” form in appellate documents (i.e., appeal briefs, certiorari petitions, Supreme Court briefs, etc.)<sup>74</sup> and trial-court documents.<sup>75</sup>

To maintain maximum credibility with all readers, a careful writer should always use the transitive form of “infringe,” rather than the intransitive form “infringe on.”

### B. “*Doctrine of Equivalents*” Versus “*Doctrine of Equivalence*”

The “doctrine of equivalents” is a doctrine of patent infringement. There are two types of patent infringement: (1) literal infringement and (2) infringement under the doctrine of equivalents.<sup>76</sup> An accused product infringes a patent claim literally if the product meets each and every limitation of the claim literally.<sup>77</sup> But even if a product

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the sockets’ conductive pins.” (emphasis added)); Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 21 (1997) (“Under this doctrine, a product or process that does not literally *infringe upon* the express terms of a patent claim may nonetheless be found to infringe if there is ‘equivalence’ between the elements of the accused product or process and the claimed elements of the patented invention.” (emphasis added)); Dawson Chem. Co. v. Rohm & Haas Co., 448 U.S. 176, 183 (1980) (“Petitioners did not cease manufacture and sale of propanil after that patent issued, despite knowledge that farmers purchasing their products would *infringe on* the patented method by applying the propanil to their crops.” (emphasis added)); Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327, 327 (1945) (“Respondent, Interchemical Corporation, asserts that inks made by the petitioner *infringe on* claims 3, 10, 11, 12 and 13 . . . .” (emphasis added)); Mitchell v. Tilghman, 86 U.S. (19 Wall.) 287, 377 (1873) (“That Mowry’s process did not *infringe on* Whitney’s patent . . . .” (emphasis added)); Burr v. Duryee, 68 U.S. (1 Wall.) 531, 566 (1863) (“But these two grounds are not pressed, except in the event of the court declaring that the defendant’s machine *infringes upon* that patent. (emphasis added)); Troy Iron & Nail Factory v. Corning, 55 U.S. (14 How.) 193, 204 (1852) (“other than that which should *infringe upon* Burden’s patent” (emphasis added)); Hogg v. Emerson, 47 U.S. (6 How.) 437, 464 (1848) (“It assumes that all persons may, with impunity, *infringe upon* all or any patents . . . .” (emphasis added)).

<sup>74</sup> See, e.g., Petition for Writ of Certiorari at 19, Conte v. Jakks Pacific, Inc., 135 S. Ct. 679 (2014) (No. 14–301), 2014 WL 4536921, at \*19 (“In this case, there is no dispute that the Care Bear Doll literally *infringes on* all elements of Claim 9 of the ‘457 Patent. . . .” (emphasis added)); Corrected Brief of Appellant Non-Confidential at 45, Catheter Connections v. Ivera Med., No. 14–1443 (Fed. Cir. June 30, 2014), 2014 WL 3728700, at \*45 (“As shown above, the Tips product does not have any recesses and thus does not *infringe on* claim 1 of the ‘308 Patent.” (emphasis added)); Brief of Google Inc. et al. as *Amici Curiae* in Support of Respondents at 31, Alice Corp. Pty. v. CLS Bank Int’l, 134 S. Ct. 2347 (2014) (No. 13–298), 2014 WL 828041, at \*31 (“Moreover, the fast pace of innovation leads to ‘the danger that new products will inadvertently *infringe on* patents issued *after* these products were designed.” (first emphasis added)).

<sup>75</sup> See, e.g., Defendant’s Brief in Support of Motion to Stay Pending *Inter Partes* Review at 2, Shower Enclosures Am., Inc., v. BBC Distribution Corp., No. 3:15-CV-627 (N.D. Ind. Jan. 10, 2017), 2017 WL 406084 (“Plaintiff alleges that a product . . . distributed by BBC *infringes on* Patent ‘944.” (emphasis added)); Joint Initial Status Report at 2, T-Rex Prop. AB v. Tabletop Media, LLC, No. 1:16-cv-6932 (N. D. Ill. Nov. 2, 2016), 2016 WL 8453743 (“Plaintiff asserts that Defendant *infringes on* claims of a patent covering a digital information system.” (emphasis added)); Memorandum in Support of Motion for Partial Summary Judgment on the ‘343 Patent (Literal Non-Infringement) at 7, Bonutti Research, Inc. v. Lantz Med., Inc., No. 1:14-cv-609-SEB-MJD (S.D. Ind. Sep. 20, 2016), 2016 WL 5958416 (“[T]he Lantz products do not literally *infringe on* any claims of the ‘343 patent.” (emphasis added)).

<sup>76</sup> See, e.g., Microsoft Corp. v. GeoTag, Inc., 817 F.3d 1305, 1313 (Fed. Cir.), *cert. denied sub nom. GeoTag, Inc. v. Google Inc.*, 137 S. Ct. 313 (2016).

<sup>77</sup> See, e.g., *id.*

does not literally infringe a claim, it can still infringe it under the doctrine of equivalents.<sup>78</sup> An accused product infringes a claim under the doctrine of equivalents if the product has elements that meet each and every limitation of the claim either literally or equivalently.<sup>79</sup> An element on the accused product is equivalent to a claim limitation if the element is only insubstantially different from the limitation.<sup>80</sup>

The Supreme Court first applied what today we call the doctrine of equivalents in 1853 in *Winans v. Denmead*.<sup>81</sup> Although the Court in *Winans* used the word “equivalents” to discuss infringement,<sup>82</sup> the Court did not use the term “doctrine of equivalents.” The Court first used the term “doctrine of equivalents” in the modern sense in 1950 in *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*<sup>83</sup> The Court described the doctrine of equivalents as follows:

The doctrine of equivalents evolved in response to this experience. The essence of the doctrine is that one may not practice a fraud on a patent. Originating almost a century ago in the case of *Winans v. Denmead*, it has been consistently applied by this Court and the lower federal courts, and continues today ready and available for utilization when the proper circumstances for its application arise. To temper unsparing logic and prevent an infringer from stealing the benefit of the invention a patentee may invoke this doctrine to proceed against the producer of a device if it performs substantially the same function in substantially the same way to obtain the same result.<sup>84</sup>

It is proper to refer to this doctrine as the “doctrine of *equivalents*.” But it is improper to refer to this doctrine as the “doctrine of *equivalence*.” According to the Oxford English Dictionary, an “equivalent” is “something tantamount or virtually identical.”<sup>85</sup> But “equivalence” means “[t]he condition of being equivalent; equality of value, force, importance, significance, etc.”<sup>86</sup> Thus, it is proper to write “doctrine of *equivalents*” instead of “doctrine of *equivalence*” because the doctrine is one that involves the things that are “virtually identical.”<sup>87</sup> But it is proper to use the term “equivalence” in other ways when actually referring to “[t]he condition of being equivalent,”<sup>88</sup> such as to refer to the “equivalence” of an element and a claim

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<sup>78</sup> See, e.g., *id.*

<sup>79</sup> See, e.g., *id.*

<sup>80</sup> See, e.g., *Brilliant Instruments, Inc. v. GuideTech, LLC*, 707 F.3d 1342, 1346 (Fed. Cir. 2013).

<sup>81</sup> 56 U.S. (15 How.) 330 (1853); see *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950); Joseph S. Cianfrani, *An Economic Analysis of the Doctrine of Equivalents*, 1 VA. J.L. & TECH. 1, 9 (1997).

<sup>82</sup> See *Winans*, 56 U.S. (15 How.) at 337 (“It may be admitted, without hesitation, that the substitution of mechanical or chemical equivalents, as they are called, will not affect the rights of a patentee.”).

<sup>83</sup> 339 U.S. 605.

<sup>84</sup> *Id.* at 608 (citation, footnote, and internal quotation marks omitted).

<sup>85</sup> *Equivalent*, *adj. and n.*, OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/63843> [<https://perma.cc/H4Z9-NCGD>].

<sup>86</sup> *Equivalence*, *n.*, OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/63840> [<https://perma.cc/68XQ-VZ5E>].

<sup>87</sup> *Equivalent*, *adj. and n.*, *supra* note 85.

<sup>88</sup> *Equivalence*, *n.*, *supra* note 86.

limitation—in other words, it is proper to refer to the “equivalence” of a pair of “equivalents.”

Usage by the Supreme Court and the Federal Circuit confirms that the correct term is “doctrine of *equivalents*” and not “doctrine of *equivalence*.” The Supreme Court has always used the term “doctrine of equivalents”; the Court has never used the term “doctrine of *equivalence*” in the patent-law context.<sup>89</sup> And to the extent that the Federal Circuit has used this term, it has mostly done so in direct quotations of other sources.<sup>90</sup> Indeed, in several instances where the court quoted other sources using the term “doctrine of *equivalence*,” the Federal Circuit noted the improper use of the word “equivalence” by using the term “[sic].”<sup>91</sup> But out of hundreds of mentions of the concept of the “doctrine of equivalents” since the court’s inception in 1982, the Federal Circuit has only used the term “doctrine of *equivalence*” eight times when not quoting another source.<sup>92</sup>

Despite this virtually consistent usage of “doctrine of equivalents” by the Supreme Court and Federal Circuit, many district court opinions nonetheless erroneously use

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<sup>89</sup> The author searched the Westlaw “U.S. Supreme Court Cases” database using the following search term: **adv: “doctrine #of equivalence”**. The search resulted in only one case, but the case had nothing to do with patent law. *See* *Daube v. United States*, 289 U.S. 367, 367 (1933) (involving income-tax law).

<sup>90</sup> *See, e.g., Creative Internet Advert. Corp. v. YahooA, Inc.*, 476 F. App’x 724, 733 (Fed. Cir. 2011) (quoting a trial transcript); *Medtronic Navigation, Inc. v. BrainLAB Medizinische Computersysteme GmbH*, 603 F.3d 943, 949 (Fed. Cir. 2010) (quoting a transcript of a district court judge); *AquaTex Indus., Inc. v. Techniche Sols.*, 479 F.3d 1320, 1325 (Fed. Cir. 2007) (referring to the “Defendant’s Memorandum as to the *Doctrine of Equivalence*” (emphasis added)).

<sup>91</sup> *See, e.g., In re Itron, Inc.*, 31 F. App’x 664, 665 (Fed. Cir. 2002) (“We hold that prosecution history estoppel acts as a complete bar to the application of the *doctrine of equivalence [sic]* when an amendment has narrowed the scope of the claim for a reason related to patentability.” (emphasis added)); *Rivera-Davila v. Asset Conservation, Inc.*, 230 F.3d 1378 (Fed. Cir. 2000) (quoting a trial transcript: “What they use falls clearly under the terms of our claim eleven under the *doctrine of equivalence [sic]*.” (emphasis added)); *Atlanta Motoring Accessories, Inc. v. Saratoga Techs., Inc.*, 33 F.3d 1362, 1366 (Fed. Cir. 1994) (“If literal infringement is not established, the second step is to apply the *doctrine of equivalence [sic]* to the accused device.” (emphasis added)).

<sup>92</sup> *See Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1365 (Fed. Cir. 2007) (“It does not mean that the failure of the patent to mention safety or ease of use makes this evidence irrelevant to the analysis under the *doctrine of equivalence*.” (emphasis added)); *Old Town Canoe Co. v. Confluence Holdings Corp.*, 448 F.3d 1309, 1314 (Fed. Cir. 2006) (“As to the *doctrine of equivalence*, Confluence argues that prosecution history estoppel applies and precludes a finding of infringement under the doctrine of equivalents in this case.” (emphasis added)); *Doyle v. Crain Indus., Inc.*, 49 F. App’x 920, 924 (Fed. Cir. 2002) (“Based on this record no reasonable jury could find infringement under the *doctrine of equivalence*.” (emphasis added)); *Home Diagnostics, Inc. v. Lifescan, Inc.*, 37 F. App’x 516, 517 (Fed. Cir. 2002) (“Lifescan, Inc. appeals from the judgment . . . granting Home Diagnostics Inc.’s motion for summary judgment of no infringement, either literal or under the *doctrine of equivalence*.” (emphasis added)); *Int’l Game Tech. v. WMS Gaming Inc.*, 215 F.3d 1345 (Fed. Cir.), *on reh’g in part*, 217 F.3d 850 (Fed. Cir. 1999) (“In ruling on the motion for a preliminary injunction, the district court did not reach the issue of infringement under the *doctrine of equivalence*.” (emphasis added)); *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1384 (Fed. Cir. 1998) (“discussing the public-notice function of claims in the context of a *doctrine of equivalence* analysis” (emphasis added)); *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1572 (Fed. Cir. 1984) (“The district court rejected those assertions for the product claims at issue, holding that . . . Du Pont’s products infringed the claims under the *doctrine of equivalence*.” (emphasis added)); *Nestier Corp. v. Menasha Corp.-Lewisystems Div.*, 739 F.2d 1576, 1579 (Fed. Cir. 1984) (“Our review of the record and arguments on appeal reveals no error or abuse of discretion by the District Court in failing to include an instruction to the jury concerning infringement under the *doctrine of equivalence*.” (emphasis added)).

the term “doctrine of *equivalence*.” Even though district court opinions usually use the correct term “doctrine of equivalents,” there are nonetheless many opinions that use the incorrect term “doctrine of *equivalence*.”<sup>93</sup> Moreover, the same error appears in many documents written by practitioners submitted to district courts,<sup>94</sup> as well as to the Supreme Court and Federal Circuit.<sup>95</sup>

To further clarify, the following are examples of correct and incorrect usage of “equivalents” and “equivalence.”

**Correct:** “To grant a motion for summary judgment on the ground of no infringement, the court must conclude that no reasonable jury could find literal infringement or infringement under the *doctrine of equivalents*.”<sup>96</sup>

**Incorrect:** “[T]here is no infringement under the *doctrine of equivalence*.”<sup>97</sup>

**Correct:** “There is no reason why a narrowing amendment should be deemed to relinquish *equivalents* unforeseeable at the time of the amendment and beyond a fair interpretation of what was surrendered.”<sup>98</sup>

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<sup>93</sup> See, e.g., *Arcelormittal & Arcelormittal Atlantique Et Lorraine v. AK Steel Corp.*, No. CV 13-685-SLR, 2017 WL 239344, at \*3 (D. Del. Jan. 19, 2017) (“The issue was litigated to a verdict of non-infringement under the *doctrine of equivalence* . . .” (emphasis added)); *ABS Glob., Inc. v. Inguran, LLC*, No. 14-CV-503-WMC, 2016 WL 4009987, at \*2 (W.D. Wis. July 25, 2016) (“The first concern would appear best dealt with by a jury instruction from the court should a specific patented technology bar or limit any *doctrine of equivalence* claim.” (emphasis added)); *LTJ Enterprises, Inc. v. Custom Mktg. Co., LLC*, 168 F. Supp. 3d 1202, 1214 (D. Minn. 2016) (“There is also no infringement under the *doctrine of equivalence*.” (emphasis added)).

<sup>94</sup> See, e.g., Plaintiff’s First Amended Complaint at 3, *Davies Innovations Inc. v. Sturm, Ruger & Co.*, No. 1:16-cv-00352-LM (D.N.H. Mar. 28, 2017), 2017 WL 1901382 (“Defendant’s manufacture of the SR-556 and SR-762 AR-style rifles infringes at least Claims 1, 5, 8 and 9, of the ‘722 Patent by both literal infringement and under the *doctrine of equivalence*.” (emphasis added)); Defendant FCA US LLC’s Motion for Summary Judgment at 19, *Signal IP, Inc. v. Fiat U.S.A. Inc.*, No. 2:14-cv-13864-MAG-PJK (E.D. Mich. Feb. 2, 2017), 2017 WL 2230260 (“Signal cannot, however, survive summary judgment by now asserting infringement under the *doctrine of equivalence* . . .” (emphasis added)); Joint Rule 16(b)/26(f) Report at 8, *WP Banquet, LLC v. Target Corp.*, No. 16-CV-02082 JAK (JPRx) (C.D. Cal. Oct. 7, 2016), 2016 WL 8231202 (“Plaintiffs do not assert literal infringement for those three patents, but instead rely on a *doctrine of equivalence* theory . . .” (emphasis added)).

<sup>95</sup> See, e.g., Brief for Appellee—Director of the United States Patent and Trademark Office at 26 n.8, *In re Arunachalam*, No. 2016–1607 (Fed. Cir. May 9, 2017), 2017 WL 2182491 (“Arunachalam uses the term prosecution history estoppel, but this doctrine relates to infringement claims under the *doctrine of equivalence*, not claim construction.” (emphasis added)); Corrected Brief of Plaintiffs-Appellants at 23, *Enzo Biochem, Inc. v. Applera Corp.*, No. 2016–1881 (Fed. Cir. July 1, 2016), 2016 WL 3586845, at \*23 (“They did not identify prior art, prosecution history estoppel or any other substantive bar to a *doctrine of equivalence* theory.”); Petition for Rehearing in Part at 2, *Bowman v. Monsanto Co.*, 133 S. Ct. 1761 (2013) (No. 11–796), 2013 WL 2470133, at \*2 (“Graver Tank subsequently petitioned for rehearing on the limited issue of whether the narrow claims were infringed under the *doctrine of equivalence*.” (emphasis added)).

<sup>96</sup> *Comcast Cable Commc’ns, LLC v. Sprint Commc’ns Co., LP*, 203 F. Supp. 3d 499, 552 (E.D. Pa. 2016) (emphasis added; internal quotation marks omitted).

<sup>97</sup> *N5 Techs. LLC v. Capital One N.A.*, 56 F. Supp. 3d 755, 761 (E.D. Va. 2014) (emphasis added).

<sup>98</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 738 (2002) (emphasis added).

**Incorrect:** “A narrowing amendment relinquishes only foreseeable *equivalence*.”

**Correct:** “The en banc Federal Circuit affirmed, holding that . . . the question of *equivalence* is for the jury to decide.”<sup>99</sup>

**Incorrect:** “The question of *equivalents* is a question of fact.”

A writer who erroneously writes “doctrine of *equivalence*” does not lose any accuracy or precision: the reader will understand exactly what the writer means.<sup>100</sup> But “doctrine of *equivalents*” and “doctrine of *equivalence*” are still not interchangeable in the specialized language of patent law.<sup>101</sup> Even though the difference between “doctrine of *equivalents*” and “doctrine of *equivalence*” may seem to be “trivial,”<sup>102</sup> using the improper form reveals to the reader that the writer may not be a “true” patent lawyer. Thus, a careful writer will always use the correct version to maintain maximum credibility with all readers.

### C. “Limitation” Versus “Element”

Every patent must have one or more claims,<sup>103</sup> which define the scope of the patented invention.<sup>104</sup> Claims are made up of constituent parts, which are properly called “limitations.”<sup>105</sup> It is improper to refer to the constituent parts of a claim as “elements.”<sup>106</sup> Instead, “elements” properly refers only to a constituent part of an accused device or a prior-art reference, not to a constituent part of a claim.<sup>107</sup>

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<sup>99</sup> Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 17 (1997) (emphasis added).

<sup>100</sup> For uses of “equivalents” and “equivalence” other than following the phrase “doctrine of,” the writer may actually lose precision and meaning, thus confusing the reader in addition to giving the reader the impression that the writer is not a “true” patent lawyer.

<sup>101</sup> Cf. TIERSMA, *supra* note 1, at 52 (discussing the difference between the usage of “judgment” versus “judgement”).

<sup>102</sup> *Id.* at 51 (“Some of the clearest examples of ‘talking like a lawyer’ are also, in a sense, the most trivial: minor quirks in pronunciation, spelling and punctuation.”).

<sup>103</sup> See 35 U.S.C. § 112(b) (2006 & Supp. 2011) (“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.”).

<sup>104</sup> See *id.*; Phillips v. AWH Corp., 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (“It is a bedrock principle of patent law that the claims of a patent define the invention to which the patentee is entitled the right to exclude.” (internal quotation marks omitted)).

<sup>105</sup> For example, consider the following (fictitious) claim:

1. A widget, comprising:

(a) a first doodad connected to a first surface of the widget;  
(b) a second doodad connected to a second surface of the widget; and  
(c) a fastener joining the first doodad to the second doodad.

In this claim, each of (a), (b), and (c) is a limitation of the claim.

<sup>106</sup> *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1297 n.5 (Fed. Cir. 2016); *Dawn Equip. Co. v. Kentucky Farms Inc.*, 140 F.3d 1009, 1015 n.1 (Fed. Cir. 1998); *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1533 n.9 (Fed. Cir. 1987).

<sup>107</sup> *Amdocs*, 841 F.3d at 1297 n.5; *Dawn Equip.*, 140 F.3d at 1015 n.1; *Perkin-Elmer*, 822 F.2d at 1533 n.9.



No speculation is required to determine what the Federal Circuit's preference is as to the usage of "limitation" versus "element." Indeed, the court explicitly explained the difference as early as 1987 as follows:

References to "elements" can be misleading. "Elements" often is used to refer to structural parts of the accused device or of a device embodying the invention. . . . An element of an embodiment of the invention may be set forth in the claim (*e.g.*, "said connecting means" in clause (h) of the present claim). It is the *limitation* of a claim that counts in determining both validity and infringement, and a limitation may include descriptive terms (*e.g.*, "tapped into the coil at a point near, but spaced from, the grounded end thereof" in clause (h)). Because claims are composed of a number of limitations, the limitations have on occasion been referred to as "claim elements" or "elements of the claim," but clarity is advanced when sufficient wording is employed to indicate when "elements" is intended to mean a component of an accused device or of an embodiment of an invention and when it is intended to mean a feature set forth in or as a limitation in a claim.<sup>108</sup>

For these reasons, in addition to not seeming to be a "true" patent lawyer, a writer who uses "limitation" and "element" improperly may actually lose precision and meaning.

Moreover, the court further commented on the distinction between "limitation" and "element" in 1998 as follows:

The statute refers to a claim "element," but this court has moved towards the custom of referring to claim "limitations," reserving the word "elements" for describing the parts of the accused device, though the court on occasion continues to use the words interchangeably. Herein we refer to claim limitations.<sup>109</sup>

The court again recognized this distinction in 2016: "[T]his court often has used the term 'limitation' to refer to requirements stated in a patent claim, and the term 'element' to refer to the parts of an entity accused of infringing."<sup>110</sup> Today, the Federal

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<sup>108</sup> *Perkin-Elmer*, 822 F.2d at 1533 n.9.

<sup>109</sup> *Dawn Equip.*, 140 F.3d at 1015 n.1 (citation omitted).

<sup>110</sup> *Amdocs*, 841 F.3d at 1297 n.5.

Circuit consistently uses the term “limitation” to refer to a part of a claim,<sup>111</sup> and “element” to refer to a part of an accused device or a prior-art reference.<sup>112</sup>

Interestingly, despite the Federal Circuit’s consistent practice with respect to these terms, the Supreme Court does not use the terms “limitation” and “element” consistently the same way. The Federal Circuit has even expressly recognized this fact.<sup>113</sup> Indeed, the Supreme Court often uses the term “element” to refer to what the Federal Circuit consistently calls a claim “limitation.”<sup>114</sup>

Even though the Supreme Court does not seem to care about the difference between the use of “limitation” and “element,” using these terms improperly nonetheless reveals to many potential readers—particularly Federal Circuit judges—that the writer may not be a “true” patent lawyer. Thus, a careful writer will always use the correct terms to maintain maximum credibility with as many readers as possible.

#### D. “File an Application” Versus “File a Patent”

To obtain a U.S. patent, an inventor must file a patent application at the U.S. Patent and Trademark Office (“USPTO”).<sup>115</sup> The USPTO examines the application, and, if the application meets all requirements for patentability, then the USPTO issues a patent.<sup>116</sup> There can be no patent unless an inventor first files an application. Thus,

<sup>111</sup> See, e.g., *Phil-Insul Corp. v. Airlite Plastics Co.*, 854 F.3d 1344, 1350 (Fed. Cir. 2017) (“Looking at the prosecution history, the court found that the patentee added the *limitation* ‘at least two rows’ in Claim 1 to distinguish it from prior art . . .” (emphasis added)); *Rembrandt Wireless Techs., LP v. Samsung Elecs. Co.*, 853 F.3d 1370, 1376 (Fed. Cir. 2017) (“[T]he applicant inserted the ‘different types’ *limitation* into its claims after the examiner had already issued a notice of allowance.” (emphasis added)); *Core Wireless Licensing S.a.r.l. v. Apple Inc.*, 853 F.3d 1360, 1362 (Fed. Cir. 2017) (“A magistrate judge conducted the claim construction proceedings and construed the ‘means for comparing’ *limitation* of claim 17 . . .” (emphasis added)).

<sup>112</sup> See, e.g., *In re Chudik*, 851 F.3d 1365, 1369 (Fed. Cir. 2017) (“Rambert Figure 2 shows *element* 27b in contact with anchoring *element* 27a, which in turn contacts the glenoid cavity.” (emphasis added)); *Meiresonne v. Google, Inc.*, 849 F.3d 1379, 1382 (Fed. Cir. 2017) (“A combination of known *elements* is likely to be obvious when it yields predictable results.” (emphasis added)); *Spectrum Pharm., Inc. v. Sandoz Inc.*, 802 F.3d 1326, 1337 (Fed. Cir. 2015) (“[A] patentee may establish infringement under the doctrine of equivalents if an *element* of the accused product performs substantially the same function in substantially the same way to obtain the same result as the claim *limitation*.” (emphasis added; internal quotation marks omitted)).

<sup>113</sup> See *Amdocs*, 841 F.3d at 1297 n.5 (“Though the Supreme Court does not uniformly adhere to the practice, this court often has used the term ‘limitation’ to refer to requirements stated in a patent claim, and the term ‘element’ to refer to the parts of an entity accused of infringing.”).

<sup>114</sup> See, e.g., *Life Techs. Corp. v. Promega Corp.*, 137 S. Ct. 734, 738 n.2 (2017) (“[W]e do not consider how to identify the ‘components’ of a patent or whether and how that inquiry relates to the *elements* of a patent claim.” (emphasis added)); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2154 (2016) (“The problem for *Cuozzo* is that claim 17 . . . incorporates all of the *elements* of claims 10 and 14.” (emphasis added)); *Alice Corp. Pty. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2357 (2014) (“[W]e must examine the *elements* of the claim to determine whether it contains an “inventive concept” sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” (emphasis added)); *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2126 (2014) (“The claim sets forth additional *elements* . . .” (emphasis added)).

<sup>115</sup> See 35 U.S.C. § 111(a) (2006).

<sup>116</sup> See 35 U.S.C. § 151 (2006).

it is correct to write that an inventor “filed an application,” and it is incorrect to write that an inventor “filed a patent.” But practitioners,<sup>117</sup> judges,<sup>118</sup> and laypeople<sup>119</sup> often make the mistake of writing that an inventor “filed a patent” instead of “filed an application.”

Writing “filed a patent” instead of “filed an application” will certainly cause a writer to lose credibility with readers who are accustomed to specialized patent-law language because there is no such thing as “filing a patent.” Additionally, the phrase “filed a patent” implies that an inventor can obtain patent protection merely by “filing a patent.” But obtaining patent rights is not like obtaining real-property rights merely by filing a deed to be recorded. Instead, an inventor can obtain patent rights only by filing an application and undergoing a rigorous examination process. Thus, the phrase “filed a patent” trivializes what it takes to get patent protection. Therefore, a careful writer will always write “filed an application” and not “filed a patent” to maintain maximum credibility with readers.

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<sup>117</sup> See, e.g., Brief of Plaintiff-Appellant Neal R. Verfuert at 7 n.8, *Verfuert v. Orion Energy Sys., Inc.*, No. 16–3502 (7th Cir. May 2, 2017), 2017 WL 1928210, at \*7 n.8 (“Foley & Lardner also prepared and *filed patents* for Digital Lumens’ LightRules Management System . . . .” (emphasis added)); Reply Brief of Plaintiff-Appellant Xitronix Corporation at 16 n.12, *Xitronix Corp. v. KLA-Tencor Corp.*, No. 2016–2746 (Fed. Cir. Apr. 7, 2017), 2017 WL 1361260, at \*16 n.12 (“Once a *patent is filed*, no ‘new matter’ can be added to it.” (emphasis added)); Plaintiff Globeride, Inc.’s Reply to Defendant Pure Fishing Inc.’s Opposition to Motion for Partial Summary Judgment at 11, *Globeride, Inc. v. Pure Fishing, Inc.*, No. 2:15-cv-03000-R-SS (C.D. Cal. Mar. 6, 2017) (“Dr. Tipton *filed the ‘318 Patent* on June 18, 1990.” (emphasis added)); CTP Innovations, LLC’s Response in Opposition to Defendant Quad/Graphics, Inc.’s Rule 12(b)(6) Motion to Dismiss Under 35 U.S.C. § 101 at 25, *CTP Innovations, LLC v. Quad/Graphics, Inc.*, No. 2:16-cv-01361-JRG-RSP (E.D. Tex. Jan. 24, 2017), 2017 WL 774038 (“[S]uch statements . . . are assertions that the features of the actual claim element would have been ‘obvious’ at the time the *patent was filed*.” (emphasis added)); Plaintiff’s Motion to Compel Answers to Plaintiff’s First Set of Interrogatories and Requests for Production at 2, *T-Rex Property AB v. Four Winds Interactive, LLC*, No. 1:16-cv-6934 (N.D. Ill. Jan. 9, 2017), 2017 WL 1458943 (“The ‘603 Patent *was filed* on April 28, 1999 . . . .” (emphasis added)).

<sup>118</sup> See, e.g., *InfoGation Corp. v. ZTE Corp.*, No. 16-CV-01901-H-JLB, 2017 WL 1821402, at \*11 (S.D. Cal. May 5, 2017) (“Definiteness is measured from the viewpoint of a PHOSITA at the time the *patent was filed*.” (emphasis added)); *Oneida Grp. Inc. v. Steelite Int’l U.S.A. Inc.*, No. 17CV0957ADSAKT, 2017 WL 1954805, at \*7 (E.D.N.Y. May 10, 2017) (“Erwin made the decision to *file two design patents* on behalf of Tablewerks for this product.” (emphasis added)); *Barkan Wireless Access Techs., L.P. v. Cellco P’ship*, No. 2:16-CV-293-JRG-RSP, 2017 WL 2099565, at \*6 (E.D. Tex. May 14, 2017) (“Plaintiff has not demonstrated that this evidence is contemporaneous with the *filing of the patents-in-suit* . . . .” (emphasis added)).

<sup>119</sup> See, e.g., Stipe, #Nokia Filed a Patent for a #Graphene Based Carbon Monoxide Detector, NOKIAMOB.NET (July 5, 2017), <http://nokiamob.net/2017/05/07/nokia-filed-a-patent-for-a-graphene-based-carbon-monoxide-detector> [https://perma.cc/Q79A-AYDR] (“Finnish telecommunications giant Nokia *filed last August a patent* for ‘An apparatus for detecting carbon monoxide.’” (emphasis added)); *Amazon Files Patent for Flying Warehouse*, BBC NEWS (Dec. 29, 2016), <http://www.bbc.com/news/technology-38458867> [https://perma.cc/FW6R-WPX5] (“Amazon has *filed a patent* for massive flying warehouses equipped with fleets of drones that deliver goods to key locations.” (emphasis added)); *Revealed: Wakefield’s Secret First MMR Patent Claims “Safer Measles Vaccine,”* BRIANDEER.COM, <http://briandeer.com/wakefield/vaccine-patent.htm> (last visited May 19, 2017) (“[H]e had *filed a patent* claiming to have discovered his own, allegedly safer, measles vaccine.” (emphasis added)); Alex Cranz, *Oh Yes, Apple Just Filed a Patent for a Sick Vape*, GIZMODO (Jan. 27, 2017, 10:57 AM), <http://gizmodo.com/oh-yes-apple-just-filed-a-patent-for-a-sick-vape-1791694420> [https://perma.cc/2QAN-AQDL] (“Apple just *filed a patent* for a vaporizer.” (emphasis added)).

*E. “Would Have Been Obvious” Versus “Is Obvious”*

An invention is not entitled to patent protection unless it meets the utility, novelty, and nonobviousness requirements.<sup>120</sup> An invention fails to meet the nonobviousness requirement “if the differences between the claimed invention and the prior art are such that the claimed invention as a whole *would have been obvious* before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.”<sup>121</sup> An invention that fails to meet this requirement is not patentable,<sup>122</sup> and where a court determines that a claim in a patent should not have issued for failing this requirement, then that claim is invalid.<sup>123</sup> It is correct to write that a claim is unpatentable or invalid because the claimed invention “would have been obvious,” which tracks the statute verbatim.<sup>124</sup> But it is incorrect to write that the claim is unpatentable or invalid because it “is obvious” or “was obvious.”

Writing “would have been obvious” is important because the language of § 103 captures two important concepts to avoid hindsight in the nonobviousness inquiry: that it (1) is objective;<sup>125</sup> and (2) requires the decision maker to consider the obviousness of the claimed invention at a time before the filing date of the application.<sup>126</sup> The nonobviousness inquiry is objective because

[t]he inquiry is not whether a claimed invention *is subjectively* obvious to the inventor or a particular judge, jury, or expert witness; instead, the question is whether the claimed invention *would have been* obvious to a hypothetical “person having ordinary skill in the art to which the claimed invention pertains” (“PHOSITA”). This hypothetical PHOSITA is analogous to the reasonably prudent person used in applying the objective standard for duty of care in negligence law.<sup>127</sup>

And the inquiry “requires the decision-maker to make an historical judgment: whether the invention would have been obvious at the time the invention was made in the past.”<sup>128</sup> Indeed, “[t]o reach a proper non-obvious conclusion, the decision-maker must step backward in time to a moment when the invention was unknown.”<sup>129</sup>

Importantly, the tense and mode of the verbal phrase “would have been” is vital in capturing both of these concepts. “Would have been obvious” is consistent with the fact that the inquiry is objective and considers the hypothetical PHOSITA. And it is consistent with the fact that the inquiry must consider the situation in the past, before the filing of the application. Using “was obvious” is incorrect because to be

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<sup>120</sup> 35 U.S.C. §§ 101-103 (2006 & Supp. 2011).

<sup>121</sup> *Id.* at § 103 (emphasis added).

<sup>122</sup> *Id.*

<sup>123</sup> 35 U.S.C. § 282(b)(2) (2006).

<sup>124</sup> *Id.* at § 103.

<sup>125</sup> *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (“The analysis is objective.”); Ted L. Field, *Obviousness as Fact: The Issue of Obviousness in Patent Law Should Be a Question of Fact Reviewed with Appropriate Deference*, 27 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 555, 584 (2017).

<sup>126</sup> Gregory N. Mandel, *Patently Non-Obvious: Empirical Demonstration That the Hindsight Bias Renders Patent Decisions Irrational*, 67 *OHIO ST. L.J.* 1391, 1399 (2006).

<sup>127</sup> Field, *supra* note 125, at 584 (footnotes omitted).

<sup>128</sup> Mandel, *supra* note 126, at 1399.

<sup>129</sup> *Id.*

unpatentable or invalid, the claimed invention does not have to have been obvious to anyone in actuality; instead, the requirement is that the invention “would have been obvious” to a hypothetical PHOSITA, who does not actually exist. And using “is obvious” is incorrect because it brings the inquiry into the present; instead, the requirement is that the invention “would have been obvious” at a time before the filing of the application. Thus, to be wholly accurate, a writer must follow the language of the statute exactly and write “would have been obvious.”

Despite the importance of using the statute’s exact language, not everyone does so. Many district court opinions incorrectly contain “was obvious” or “is obvious” instead of “would have been obvious.”<sup>130</sup> And many practitioner documents do the same.<sup>131</sup> Even the Supreme Court has gotten in on this unfortunate action.<sup>132</sup> Indeed, this author finds it a bit troubling that the Court repeatedly used the terms “was obvious” and “is obvious” in *KSR International Co. v. Teleflex Inc.*,<sup>133</sup> which is an extremely important case concerning the nonobviousness inquiry.

To further clarify, the following are examples of correct and incorrect usage of “would have been obvious,” and “was obvious” and “is obvious.”

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<sup>130</sup> See, e.g., *Polara Eng’g, Inc. v. Campbell Co.*, No. SA CV 13-00007-DFM, 2017 WL 754609, at \*8 (C.D. Cal. Feb. 27, 2017) (“[T]he burden is on Campbell to establish by clear and convincing evidence that the patent *is obvious*.” (emphasis added)); *Merck Sharp & Dohme Corp. v. Hospira Inc.*, No. CV 14-915-RGA, 2016 WL 8231143, at \*19 (D. Del. Oct. 7, 2016) (“I conclude that Defendant has made a *prima facie* showing that claim 21 *is obvious* over the ‘323 patent.” (emphasis added)); *United Therapeutics Corp. v. Watson Labs., Inc.*, 200 F. Supp. 3d 272, 276 (D. Mass. 2016) (“UTC argues that these requests seek documents relevant to Watson’s defense, which is that UTC’s patents are invalid because the patented invention *was obvious* in light of the prior art.” (emphasis added)); *Blatchford Prod., Ltd. v. Freedom Innovations, LLC*, No. 1:14-CV-529, 2015 WL 13102004, at \*1 (S.D. Ohio Sept. 29, 2015) (“Freedom Innovations alleged that each claim of both patents *was obvious* or anticipated by a number of prior art references.” (emphasis added)).

<sup>131</sup> See, e.g., Notice of Motion and Motion for Summary Judgment of Invalidity of the ‘764 and ‘085 Patents by Defendant Incstores LLC and Memorandum of Points and Authorities in Support Thereof at 7, *The Parallax Group Int’l, LLC v. Incstores LLC*, No. 8:16-cv-929-AG-DFM (C.D. Cal. Apr. 7, 2017), 2017 WL 1830255 (“[T]he claim of the ‘764 patent *is obvious* under 35 U.S.C. § 103 over the EVAHWCG reference.” (emphasis added)); Brief of Intervenors Inteplast Group Ltd. and Minigrip LLC at 60, *Reynolds Presto Prods. v. Int’l Trade Comm’n*, No. 2017–1027 (Fed. Cir. Mar. 13, 2017), 2017 WL 1078393, at \*60 (“[C]laim 1 of the ‘002 patent *is obvious* over the ‘056 patent, alone or in combination with the ‘396 patent.” (emphasis added)); Brief for Appellees at 3, *Daiichi Sankyo Co. v. Accord Healthcare Inc.*, Nos. 2017–1052, 2017–1053 (Fed. Cir. Mar. 8, 2017), 2017 WL 1035822, at \*3 (“[T]hey are unpatentable if it *was obvious* to combine the drugs in *any* ‘pharmacologically effective amounts.” (first emphasis added)); Defendant and Counter-Claimant Campbell Company’s Reply in Support of Motion for Judgment As a Matter of Law at 40, *Polara Eng’g, Inc. v. Campbell Co.*, No. SACV 13-00007 DFM (JPRx) (C.D. Cal. Oct. 17, 2016), 2016 WL 8730030 (“It is likewise undisputed that every limitation of the Beckwith ‘476 *was obvious* to ‘one skilled in the art.” (emphasis added)).

<sup>132</sup> See *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2138 (2016) (“Garmin backed up its request by stating, for example, that the invention described in claim 17 *was obvious* in light of three prior patents . . . .” (emphasis added)); *Dann v. Johnston*, 425 U.S. 219, 225 (1976) (“We hold that respondent’s invention *was obvious* under 35 U.S.C. § 103 and therefore reverse.” (emphasis added)); *United States v. Adams*, 383 U.S. 39, 50 (1966) (“[T]he issue is whether bringing them together as taught by Adams *was obvious* in the light of the prior art.” (emphasis added)).

<sup>133</sup> 550 U.S. 398 (2007).

**Correct:** “[T]he subject matter of the asserted claims of the ‘764 patent *would have been obvious* over Koga and Ryu.”<sup>134</sup>

**Incorrect:** “Claim 6 *was obvious* over the prior art.”

**Incorrect:** “Claim 8 *is obvious* in light of the cited prior-art references.”

Finally, the following examples show correct usages of “was” and “is” with respect to the patentability or validity of the claims, as opposed to whether the claimed subject matter would have been obvious to a PHOSITA.

**Correct:** “Claim 20 *was* unpatentable due to obviousness.”

**Correct:** “Claim 12 *is* invalid for obviousness.”

**Incorrect:** “Claim 15 *would have been* invalid for obviousness.”

Writing “is obvious” or “was obvious” instead of “would have been obvious” will cause a writer to lose credibility with some readers. Unlike some of the other usages discussed in this article, making this mistake can cause a writer’s argument concerning nonobviousness to fail to track the statute. Thus, a rule statement for the nonobviousness inquiry that uses “is obvious” or “was obvious” instead of “would have been obvious” is legally incorrect. Therefore, a careful writer will always write “would have been obvious” and not “is obvious” or “was obvious.”

#### IV. CONCLUSION

Language matters. For better or for worse, readers judge writers by the language that they use. This fact is particularly important for writers who write within a specialty—such as law—or within a subspecialty—such as patent law. Specialties and subspecialties like the law and patent law have evolved their own specialized language forms. It is important for writers to recognize these specialized language forms and conform to them. Conforming to these specialized language forms gives writers at least two important benefits: (1) taking advantage of the accuracy and precision afforded by the use of specialized language; and (2) appearing to belong to the in-group of patent lawyers. By adhering to the conventions of the specialized language of patent law, including the five examples given in this article, writers in patent litigation can maximize their credibility with their readers.

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<sup>134</sup> *Asetek Danmark A/S v. CMI USA Inc.*, 852 F.3d 1352, 1360 (Fed. Cir. 2017) (emphasis added).