

# ARTICLE

## PREAMBLE INTERPRETATION: CLARIFYING THE “GIVING LIFE, MEANING AND VITALITY” LANGUAGE

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I. INTRODUCTION

Claim construction<sup>1</sup> is the process of determining the actual meaning of a claim.<sup>2</sup> The proper construction of a claim is critical since such construction clarifies the metes and bounds of a claim for the purposes of determining patentability of an invention, infringement of a patent, and validity of a patent.<sup>3</sup> To help lower courts ascertain the true meaning of a claim, the Court of Appeals for the Federal Circuit (“Federal Circuit”) has developed numerous rules and guidelines, such as a “presumption in favor of ordinary meaning,”<sup>4</sup> “claim differentiation,”<sup>5</sup> and “bans on reading in limitations.”<sup>6</sup> While these rules and guidelines are developed primarily for the purpose of interpreting a term in the body of a claim, they apply equally to a preamble as a preamble is also part of the claim.<sup>7</sup> Unlike the body of a claim, a preamble does not necessarily contribute to the definition of a claim, i.e., a preamble does not necessarily become a limitation.<sup>8</sup> If a preamble at issue does not constitute a

<sup>1</sup> “Claim construction” and “claim interpretation” mean the same thing in patent law. WEST GROUP, WORDS AND PHRASES (1958 & Supp. 2001) (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 n.6 (Fed. Cir. 1995)).

<sup>2</sup> ROBERT L. HARMON, PATENTS AND THE FEDERAL CIRCUIT § 6.1 (6th ed. 2003).

<sup>3</sup> 5A DONALD S. CHISUM, CHISUM ON PATENTS § 18.01 (2002) (“The language of the claim or claims in the specification of a patent is the measure of the exclusive rights conferred by that patent.”); 2 JOHN GLADSTONE MILLS III ET AL., PATENT LAW FUNDAMENTALS § 15:3 (2d ed. 2003) (“Patent claims are frequently analogized to the metes and bounds of a deed to real property or to the fence enclosing such property. Both the metes and bounds of a deed and the claims of a patent define the physical extent of the property.”).

<sup>4</sup> 5A CHISUM, *supra* note 3, § 18.03[2][b][ii] (stating that unless particularly defined, a term will be given its ordinary meaning).

<sup>5</sup> *Id.* § 18.03[2][b][iii]. “Claim differentiation” is a doctrine for claim construction. The doctrine creates a rebuttable presumption that each claim in a patent has a different scope. *Id.* § 18.03[6]. Therefore, in construing the language in one claim of a patent, consideration must be given to the language in other claims in the patent. *Id.*; *see also* HARMON, *supra* note 2, § 6.7(d) (stating that “[e]ach claim defines a separate invention . . . narrow claim limitations cannot be read into broad claims either to avoid invalidity or to escape infringement”).

<sup>6</sup> 5A CHISUM, *supra* note 3, §18.03[2][c][i] (explaining that while it is proper to use the specification to interpret a term in a claim, it is improper to add the limitations stated in the specification into the claim).

<sup>7</sup> *See* *Bell Communications Research v. Vitalink Communications Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995) (“We construe claim preambles, like all other claim language, consistently with these [basic claim construction] principles.”).

<sup>8</sup> *Cf. In re Rockwell*, 150 F.2d 560, 562 (C.C.P.A. 1945) (stating that a preamble that

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limitation, there is no need to delve into the complicated process of claim construction. Preamble interpretation focuses primarily on determining whether a preamble constitutes a limitation of a claim.

As a general rule, a preamble that recites an intended use, a purpose, or an environment is not a limitation.<sup>9</sup> A preamble becomes a limitation if it gives life, “meaning and vitality” to a claim.<sup>10</sup> Despite the guidance of these rules in determining the limiting effect of a preamble, court decisions have shown difficulty in applying them. First, the determination of a preamble’s limiting effect requires district court judges, who generally do not have technical backgrounds, to assume afresh the duties of the patent office, and to engage in extensive analysis of the claim language against prior art references.<sup>11</sup> Second, the Federal Circuit has used the “giving life, meaning and vitality” test in a conclusory rather than analytical manner so the numerous opinions rendered by the Federal Circuit do not provide clear and useful guidance to determine when a preamble becomes a limitation. Third, given that a limitation is a series of limiting words or phrases that specifically identifies an invention in a claim,<sup>12</sup> a limitation contributes to the definition of a claim and must give it life, meaning and vitality. As Judge Nies of the Federal Circuit conceded, “[t]o say that a preamble is a limitation if it gives ‘meaning to the claim’ may merely state the problem rather than lead one to the answer.”<sup>13</sup>

Claims serve to put the public on notice of the metes and bounds of a patent and hence, a patentee’s right to exclude others from making, using and selling a product covered by the patent.<sup>14</sup> Since a preamble may become a limitation and contribute to the definition of a claim in certain situations, it is imperative to clarify the rules for preamble interpretation. This will help district court judges and practitioners correctly apply the rules and confidently determine the boundary of a claim. Accordingly, this article is aimed at clarifying the rules

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recites an intended use, a purpose, or an environment is not a limitation).

<sup>9</sup> *Id.*

<sup>10</sup> *Id.*

<sup>11</sup> *Corning Glass Works v. Sumitomo Electric U.S.A. Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989) (“The effect preamble language should be given can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.”).

<sup>12</sup> HARMON, *supra* note 2, § 6.7(f).

<sup>13</sup> *Corning Glass Works*, 868 F.2d at 1257.

<sup>14</sup> 5A CHISUM, *supra* note 3, § 18.04[1](a)[iii][F]. Claims give the public fair notice of what are the metes and bounds of the claimed invention on which patentee and the Patent and Trademark Office have agreed. *Id.* “Notice permits other parties to avoid actions which infringe the patent and to design around the patent.” *Id.*; see also 2 MILLS ET AL., *supra* note 3, § 15:1 (stating that “[t]he primary purpose of the claiming requirement may be said to ‘guard against unreasonable advantages to the patentee and disadvantage to others arising from uncertainty as to their respective rights’”).

used for preamble interpretation. Part II gives the general background of the role of a claim in a patent and the general principles of claim construction. Part III explores the frequently cited rules for preamble interpretation. Part IV is an overview of court decisions in which preambles were found to be limitations. Part V clarifies the “giving life, meaning and vitality” language and provides guidelines to determine when a preamble becomes a limitation.

## II. SETTING THE STAGE FOR CLAIM CONSTRUCTION

### A. *The Role of a Claim in a Patent*

Claims are the most important part of a patent.<sup>15</sup> Claims define the rights conferred by a patent.<sup>16</sup> Claims also determine whether a patent is infringed<sup>17</sup> and whether a patent should be granted.<sup>18</sup>

The earliest patent statutes in the United States required a claim to be accompanied by a patent specification<sup>19</sup> The Patent Act of 1793 required that an invention be described “in such full, clear, and exact terms, as to distinguish the same from all other things before known.”<sup>20</sup> The U.S. Supreme Court in *Evans v. Eaton*<sup>21</sup> interpreted the “distinguish” language of the Patent Act of 1793 as containing a requirement distinct from the requirements governing the disclosure of the specification.<sup>22</sup> That is, the U.S. Supreme Court interpreted the “distinguish” language as imposing a duty on an inventor to include

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<sup>15</sup> For a discussion of the role of claims in a patent, *see* 2 MILLS ET AL., *supra* note 3, § 15:3 (“[C]laims are the only definitive statement of the invention represented by the patent. The patentee is legally bound by and limited to the recitations contained in the claims of his patent. Claiming has been characterized by the Supreme Court as a patentee’s ‘most solemn act.’”).

<sup>16</sup> 2 MILLS ET AL., *supra* note 3, § 15:3 (“Patent claims are frequently analogized to the metes and bounds of a deed to real property or to the fence enclosing such property. Both the metes and bounds of a deed and the claims of a patent define the physical extent of the property.”).

<sup>17</sup> *Westek Associates v. Tri-Lite Electronics*, 722 F. Supp. 474, 483 (N.D. Ill. 1989); 2 MILLS ET AL., *supra* note 3, § 15:4 (“The claims must be sufficiently clear . . . to enable contemporary inventors to ascertain whether or not they are infringing. Claims must plainly and reliably inform the public what infringes and what does not without resort to complex test or historical production information.”).

<sup>18</sup> 2 MILLS ET AL., *supra* note 3, § 15:4 (“An invention must be accurately defined [in the claims] to be patentable . . . If an invention’s subject matter is such that a patentee . . . is incapable of ascribing reasonable limits to his claims, regardless how meritorious the invention may be, it cannot be patented.”).

<sup>19</sup> 3 CHISUM, *supra* note 3, § 8.02.

<sup>20</sup> *Id.*

<sup>21</sup> 20 U.S. (7 Wheat. 356) (1822).

<sup>22</sup> 3 CHISUM, *supra* note 3, § 8.02[1].

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paragraphs that later became known as claims.<sup>23</sup> Congress later codified this interpretation in the Patent Act of 1836 which required that an applicant “shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery.”<sup>24</sup> Since the Act of 1836, an inventor is required not only to fully explain his invention, but also to include claims to “particularly specify and point out the part, improvement or combination which he claims as his own invention or discovery.”<sup>25</sup> Claims have become the exclusive measure of an inventor’s patent application for purposes of determining both patentability and infringement.

*B. The Structure of a Claim*

A claim contains three parts: a preamble, a transitional word or phrase, and a body.<sup>26</sup> A preamble is generally an introductory statement of a claim which expressly or implicitly indicates the statutory class of a claimed invention.<sup>27</sup> A preamble can also serve to summarize an invention recited in the body of the claim, its relation to the prior art, or its intended use or properties.<sup>28</sup>

A transitional word or phrase connects the preamble to the body of the claim.<sup>29</sup> The transitional word or phrase indicates whether the elements stated in the body of the claim are “open-ended” or “closed-ended.”<sup>30</sup> An open-ended claim is open to additional elements and is not limited to the combination of the elements recited in the body of the claim.<sup>31</sup> A closed-ended claim excludes addition of elements and is limited to the elements stated in the body of the claim.<sup>32</sup> The commonly used transitional words or phrases are “comprising,” “including,” “having,” “consisting of,” and “consisting essentially of.”<sup>33</sup> “Comprising,” “including,” and “having” are typical transitional words for an open-ended claim, while “consisting of” is a typical transitional phrase for a closed-ended claim.<sup>34</sup> The phrase “consisting essentially of” represents a middle ground between a closed-ended claim and

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<sup>23</sup> *Id.* § 8.02.

<sup>24</sup> *Id.*

<sup>25</sup> *Id.*

<sup>26</sup> ROBERT C. FABER, LANDIS ON MECHANICS OF PATENT CLAIM DRAFTING § 7, II-12 (4th ed. 2002); *see also*, 3 CHISUM, *supra* note 3, § 8.06[1][b].

<sup>27</sup> FABER, *supra* note 26, § 6, II-4

<sup>28</sup> *See id.*

<sup>29</sup> DONALD S. CHISUM ET AL., PRINCIPLES OF PATENT LAW 103 (2d ed. 2001).

<sup>30</sup> *Id.*

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

<sup>32</sup> *Id.* at n.21.

<sup>33</sup> *Id.* at 103 nn.20-21.

<sup>34</sup> *Id.* at n.21.

an open-ended claim.<sup>35</sup>

The body of the claim comprises a recitation or listing of the elements or parts of the invention and a description of how the elements integrate to make up the operative invention recited in the preamble.<sup>36</sup> In most cases, the elements recited in the body of a claim form “the nucleus of an invention.”<sup>37</sup>

All words in a claim must be considered in determining patentability.<sup>38</sup> However, it does not follow that all words in a claim have the effect of delineating the scope of a claim; not all words in a claim are limitations.<sup>39</sup>

### *C. Words that Identify an Invention Are Limitations*

A claim is composed of limitations. A limitation is a series of limiting words or phrases that specifically identify the invention in a claim.<sup>40</sup> Limitations serve to define the metes and bounds of the subject matter and thus the scope of protection conferred by a patent.<sup>41</sup> A limitation may include words that describe physical bodies and/or physical operations.<sup>42</sup> Generally, the more limitations there are in a claim, the narrower the scope of that claim.

Courts have used the words “element” and “limitation” interchangeably,<sup>43</sup> but the two words have distinct meanings.<sup>44</sup> The term “element” refers to a structural part of an allegedly infringing device or of a device embodying an invention.<sup>45</sup> The term “limitation” refers to the words that are used to define a claim. Nonetheless, the term “element” may also be used to refer to a series of limitations that, taken together, make up a component of a claimed invention.<sup>46</sup>

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<sup>35</sup> FABER, *supra* note 26, § 8.

<sup>36</sup> *Id.*

<sup>37</sup> 2 MILLS ET AL., *supra* note 3, § 15:11.

<sup>38</sup> *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970).

<sup>39</sup> For example, a preamble must be examined when determining patentability of a claim, but it is generally not a limitation.

<sup>40</sup> HARMON, *supra* note 2, § 6.7(f).

<sup>41</sup> *See id.* § 1.3.

<sup>42</sup> *See* 2 MILLS ET AL., *supra* note 3, § 15.6 (stating that structural language, which is determinative of the metes and bounds of a patent claim, includes both physical bodies and physical operations). Examples of physical bodies are “a housing,” “a tube,” “a beam.” Examples of physical operations are “rotating,” “sucking,” “heating.” *See id.*

<sup>43</sup> 2 MILLS ET AL., *supra* note 3, § 15:5 (“Although the Patent Act [35 U.S.C §112, ¶ 6] employs the word ‘element’ to refer to a feature, the Federal Circuit has moved towards the custom of referring to claim ‘limitations,’ reserving the word ‘element’ for describing the parts of an accused embodiment, although it continues to use these two words interchangeably.”).

<sup>44</sup> 3 CHISUM, *supra* note 3, § 8.06[1][b][iii].

<sup>45</sup> HARMON, *supra* note 2, § 6.7(f), at 326-7.

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

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D. *Inventor as Lexicographer*

When drafting a claim, an inventor is allowed to be his own lexicographer.<sup>47</sup> An inventor may use a term with his own specially defined meaning, even departing from the well-accepted meaning, provided that the term is clearly defined in the specification.<sup>48</sup> Unless particularly defined, a word used in a claim will be given its ordinary meaning.<sup>49</sup> Even if a term is not particularly defined in the specification, the meaning of a term may nonetheless be changed by an argument made before the U.S. Patent and Trademark Office (“PTO”) during patent prosecution.<sup>50</sup>

The reason for allowing an inventor to be his own lexicographer is that available words are often insufficient to fully and precisely describe an inventor’s novel ideas.<sup>51</sup> To enable an inventor to clearly describe his or her novel ideas without being constrained by the limited terminology of the technical art to which his or her invention pertains, it is necessary to allow an inventor to freely choose the words to define his or her invention. However, a grant to an inventor to freely choose the words to describe his or her invention imposes on the public the burden of determining whether the patent uses an ordinary meaning which is well-established in the art or a special meaning particularly defined by an inventor.<sup>52</sup> As the United States Court of Claims in *Autogiro Co. of America v. United States* put it, “the sanction of new words or hybrids from old ones not only leaves one unsure what a rose is, but also unsure whether a rose is a rose.”<sup>53</sup> To solve this problem, courts have developed numerous canons, rules, and doctrines for claim construction.

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<sup>47</sup> CHISUM, *supra* note 29, at 104 (citing *Autogiro Co. of America v. U.S.*, 384 F.2d 391, 397 (C.C.P.A. 1967) (“An inventor is allowed to be his own lexicographer because available words are often insufficient to fully and precisely describe an inventor’s novel invention.”)).

<sup>48</sup> *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (“Where an inventor chooses to be his own lexicographer and to give terms uncommon meanings, he must set out his uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change.” (quoting *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388 (Fed. Cir. 1992))).

<sup>49</sup> *Westek Associates v. Tri-Lite Electronics*, 722 F. Supp. 474, 484 (N.D. Ill. 1989); 5A CHISUM, *supra* note 3, § 18.03[2][a].

<sup>50</sup> GLENN W. RHODES, [2001-2002] PATENT LAW HANDBOOK § 1.02 (2002) (“Arguments made in prosecution history can also change the ordinary meaning of a claim term.” (citing *Hockerson-Halberstadt, Inc. v. Avia Group Intern.*, 222 F.3d 951 (Fed. Cir. 2000))).

<sup>51</sup> See CHISUM, *supra* note 29, at 104 (citing *Autogiro Co. of Am. v. U.S.*, 384 F.2d 391, 397 (C.C.P.A. 1967) (“An inventor is allowed to be his own lexicographer because available words are often insufficient to fully and precisely describe an inventor’s novel invention.”)).

<sup>52</sup> *Id.*

<sup>53</sup> 384 F.2d 391, 397 (Ct. Cl. 1967).

*E. Claim Construction*

Claim construction is the process of ascertaining the actual meaning of a term or an entire claim.<sup>54</sup> Claim construction is performed a matter of law.<sup>55</sup> When the meaning of a term in a claim is in dispute, courts must examine all relevant patent documents<sup>56</sup> to ascertain the actual meaning of the term as it was used in the context of the patent and not just use its “dictionary or technically-accepted meanings.”<sup>57</sup> At times, the courts have said that the purpose of claim construction is to find what an inventor really meant.<sup>58</sup> More precisely, the purpose of claim construction is to find the meaning of a term agreed upon by both an inventor and the PTO.<sup>59</sup> Courts interpret the meaning of a claim from the objective perspective of a person skilled in the art and at the time of the invention.<sup>60</sup>

The Federal Circuit has developed numerous canons, rules, and guides to aid the lower courts in finding the true meaning of a claim. Since a preamble is a part of a claim, these canons, rules, and guides are equally applicable to the preamble.<sup>61</sup> Unlike the body of a claim, however, a preamble is not necessarily a limitation of a claim. Before delving into the complicated process of claim construction, it is first necessary to determine whether a

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<sup>54</sup> See HARMON, *supra* note 2, § 6.7(c).

<sup>55</sup> *Id.* § 6.1 at 269.

<sup>56</sup> Vitronics v. Conceptronic, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (explaining that in interpreting a claim, the court should look first to the intrinsic evidence, i.e., the claims, the specification, and the prosecution history); *cf.* Texas Digital Systems v. Telegenix, 308 F.3d 1193 (Fed. Cir. 2002) (stating that dictionaries, treaties and encyclopedias are intrinsic evidence).

<sup>57</sup> CHISUM, *supra* note 29, at 837 (explaining that a term may have a specific meaning in the context of the record, including the claims, the specification, the drawings, and the prosecution history). A claim has been analogized as a contract, which is a bilateral instrument. 5A CHISUM, *supra* note 3, § 18.03 [2][a]. Therefore, in determining the meaning of a term, one should determine first “what a patentee intended to claim as his invention or discovery” and then determine “what invention or discovery the patent office intended to grant a temporary monopoly.” *Id.*

<sup>58</sup> Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257 (Fed. Cir. 1989).

<sup>59</sup> HARMON, *supra* note 2, § 6.1, at 269. Claims have been analogized to contracts between an inventor and the public represented by the PTO. 5A CHISUM, *supra* note 3, § 18.03[2][a]. Following the contract analogy, claim construction has been analogized to contract interpretation. *Id.* This contract analogy was rejected in Markman v. Westview Instruments, 52 F.3d 967, 985 (Fed. Cir. 1995).

<sup>60</sup> HARMON, *supra* note 2, § 6.1, at 269.

<sup>61</sup> Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 621 (“Preamble construction presents no deeper mystery than the broader task of claim construction, of which it is but a part.”).

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preamble at issue constitutes a limitation.

### III. PREAMBLE INTERPRETATION

“A preamble may serve a variety of purposes depending on its content.”<sup>62</sup> Consistent with claim construction principles, a preamble will be construed in the manner suggested by the claim as a whole.<sup>63</sup> As a general rule, a preamble that recites an intended use, a purpose, or an environment is not a limitation.<sup>64</sup> A preamble will become a limitation if it gives life, “meaning and vitality” to a claim.<sup>65</sup> As will become clear in Section IV, the two frequently cited rules above apply to most of the cases in which preamble interpretation is an issue, though there are situations in which these two rules do not help to resolve the problem encountered in preamble interpretation. This section will explore the two frequently cited rules for preamble interpretation.

#### A. *The General Rule*

As a general rule, a preamble that recites an intended use, a purpose, or an environment is not a limitation.<sup>66</sup> A justification for this general rule is that the body of a claim is the part designed to recite all of the necessary components of an invention.<sup>67</sup> The language recited in the preamble is generally intended to serve as an illustration of what embodies the novel and distinctive combination defined in the body of a claim, and it is not intended to limit the novel combination to the described use, purpose, or environment.<sup>68</sup>

As an example, assume an inventor creates a transmission mechanism that performs a distinctive operation to carry out a particular function. The inventor uses the preamble “improved variable speed gear applicable for motorcycles” to name this invention. Suppose the novel and distinctive feature of this invention resides in the structure and operation of the transmission mechanism defined in the body of the claim, and that this invention is not limited in application to motorcycles, despite the inventor’s initial intent to find a transmission mechanism for motorcycles. Since the transmission

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<sup>62</sup> C. R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1350 (Fed. Cir. 1998).

<sup>63</sup> *Bell Communications Research*, 55 F.3d at 620.

<sup>64</sup> *In re Rockwell*, 150 F.2d 560, 562 (C.C.P.A. 1945).

<sup>65</sup> *See id.*

<sup>66</sup> *Id.*

<sup>67</sup> FABER, *supra* note 26, § 9, II-14 (“The body of the claim lists the main elements of the combination (parts, steps, chemicals, etc.) and tell how they work together or are related to each other.”).

<sup>68</sup> *See* 2 MILLS ET AL., *supra* note 3, § 15:33 (“[A] patent claim can cover or dominate a later invention without fully describing the later invention . . . [a] patent owner’s decision to manufacture and market one embodiment of his invention does not limit his patent to that embodiment.”).

mechanism can easily find applications in other fields apart from motorcycles, it goes against patent policy to limit the inventor's invention to use in motorcycles merely because the preamble recites motorcycles. In this situation, the recitation of motorcycles merely serves as an illustration of an embodiment of the transmission mechanism that is the subject matter of the invention.<sup>69</sup> The preamble language should be considered a suggested use or embodiment of the invention and should not be used to limit the claim.<sup>70</sup>

Therefore, "a claim is an abstraction and generalization of an indefinitely large number of concrete [devices]."<sup>71</sup> In the absence of special circumstances, to better protect an inventor's novel ideas, the words contained in the preamble should only be used "to define the useful purpose to which [a] patentee intended his device to be devoted," and should not be construed to mean that the claimed combination can be used only in the device recited in the preamble.<sup>72</sup>

#### *B. Origin of the "Giving Life, Meaning and Vitality" Rule*

A preamble is a limitation of a claim if it "gives life, meaning and vitality to a claim."<sup>73</sup> The language "giving life, meaning and vitality" was first used by the Seventh Circuit Court of Appeals ("Seventh Circuit") in *Schram Glass Mfg. Co. v. Homer Brooke Glass Co.*<sup>74</sup> in 1918.<sup>75</sup>

In *Schram Glass Mfg. Co.*, the alleged infringer attempted to invalidate the patentee's patent on grounds that an earlier apparatus anticipated the patent's claims.<sup>76</sup> The patent was directed to "an automatic device for cutting or separating an unsupported freely flowing stream of molten material into unformed molten masses."<sup>77</sup> The patent addressed the long existing problem of having to temporarily interrupt the free flow of molten glass to prevent glass

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<sup>69</sup> *Id.* § 15:9.

<sup>70</sup> *See id.* § 15:33 ("[A] patent claim can cover or dominate a later invention without fully describing the later invention . . . A patent owner's decision to manufacture and market one embodiment of his invention does not limit his patent to that embodiment.").

<sup>71</sup> *Id.* § 15:5.

<sup>72</sup> *Braren v. Horner*, 47 F.2d 358, 363 (C.C.P.A. 1931) (quoting Circuit Judge Taft's opinion in *Stearns v. Russell*, 85 F.218, 224 (6th Cir. 1898)).

<sup>73</sup> *See In re Rockwell*, 150 F.2d 560, 562 (C.C.P.A. 1945).

<sup>74</sup> 249 F. 228, 232-33 (7th Cir. 1918), *cert. denied*, 247 U.S. 520 (1918).

<sup>75</sup> *Bell Communications Research, Inc. v. Vitalink Communication Corp.*, 55 F.3d 615, 621 n.1 (Fed. Cir. 1995).

<sup>76</sup> *Schram Glass*, 249 F. at 231.

<sup>77</sup> *Id.* at 229. Claim 1 reads: "An automatic device for cutting or separating an unsupported freely flowing stream of molten material into unformed molten masses, the same comprising a cutting knife and means for moving the same and means for supporting the severed stream of continuously flowing material." *Id.*

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from falling off as an empty mold replaced a filled mold.<sup>78</sup> The patent at issue provided a more economical method of conveying molten glass from the furnace to the mold by providing a cup-shaped cutting knife to momentarily receive and support the molten glass continuously flowing from the furnace while an empty mold was put into place.<sup>79</sup>

The alleged anticipatory prior art concerned a measuring device. The measuring device provided a moving plate with a measuring cavity to receive molten glass.<sup>80</sup> When a fixed amount of molten glass was received in the measuring cavity of the moving plate, the moving plate then slid away from the flowing path to interrupt the free flow of molten glass.<sup>81</sup> The molten glass caught in the measuring cavity of the moving plate was then released into a mold. As a result, the measuring device was able to control the amount of molten glass received in a mold.<sup>82</sup>

The alleged infringer argued that the measuring device anticipated the patent because the measuring device was of a like construction to that of the patent and could be used to perform the function the patent achieved, even though the inventor of the measuring device did not conceive the same purpose of providing a continuous flow of molten glass as the patent did.<sup>83</sup>

After reviewing the record of the patent and comparing it to the prior art, the court concluded that the measuring device could not carry out the idea of “using a continuous flowing stream of glass, cutting and temporarily supporting it.”<sup>84</sup> Concluding that the preamble language “an unsupported freely flowing stream of molten material” was “the essence of the value of [the patentee’s] discovery,” the court held that the preamble was a limitation and therefore sustained the validity of the patent.<sup>85</sup> The court reasoned that the

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<sup>78</sup> *Id.*

<sup>79</sup> *Id.* at 230.

<sup>80</sup> *Id.* at 231.

<sup>81</sup> *Id.*

<sup>82</sup> *Schram Glass Mfg. Co. v. Homer Brooke Glass Co.*, 249 F. 228, 231 (7th Cir. 1918), *cert. denied*, 247 U.S. 520 (1918).

<sup>83</sup> *Id.*; *cf. Bristol-Myers Squibb Co. v. Ben Venue Labs.*, 246 F.3d 1368, 1376 (Fed. Cir. 2001) (finding that a prior invention could anticipate a subsequent invention which states a new use not conceived by the prior invention if the new use is inherent in the prior invention).

<sup>84</sup> *Schram Glass*, 249 F. at 231.

<sup>85</sup> *Id.* (sustaining the validity of the patent because even though the alleged anticipatory measuring device disclosed all the elements enumerated in the body of the claim, it did not anticipate the essential feature recited in the preamble). It is well settled that to anticipate a claim, an anticipatory invention must contain each and every limitations of the claim. 1 CHISUM, *supra* note 3, § 3.02 n.11 (2002). It should be noted that the question of whether a reference is analogous art is not relevant to the issue of anticipation. The Manual of Patent Examination Procedure, § 2131.05, available at <http://www.uspto.gov/web/offices/pac/>

preamble “so affect[ed] the enumerated elements as to *give life and meaning and vitality* to them, as they appear in the combination.”<sup>86</sup> The court further explained that it did not treat the preamble as an additional element to the claim but rather gave the preamble “the same effect that would be given to an adjective or adverb that limits, enlarges, or qualifies the word it modifies.”<sup>87</sup>

Thereafter, the Court of Customs and Patent Appeals (“C.C.P.A.”) in *Braren v. Horner* subscribed to the Seventh Circuit’s “giving life, meaning and vitality” rule.<sup>88</sup> Citing *Schram Glass Mfg.*, the court held that a preamble would be considered a limitation when “an examination of the facts disclosed by the record will show that the words thus considered as limitations, were an essential element in the novelty of the device and of the invention in issue there.”<sup>89</sup>

One year after *Braren* was decided, another panel of the C.C.P.A. in *Hall v. Shimadzu* adopted the phrase “giving life, meaning and vitality” coined by the Seventh Circuit.<sup>90</sup> In *Hall*, the senior party of an interference proceeding claimed a process of manufacturing a fine powder of lead suboxide intermingled with a powder of metallic lead, while the junior party claimed a process of manufacturing olive gray powder.<sup>91</sup> The junior party’s process contained steps similar to those recited in the body of the claim of the senior party.<sup>92</sup> The junior party asserted that his prior conception anticipated the senior party’s claim.<sup>93</sup> After reviewing all relevant documents, the court held that the preamble of the count,<sup>94</sup> “a process of manufacturing a fine powder of

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mpep/mpep\_e8r2\_2100\_508.pdf (citing *State Contracting & Eng’g Corp v. Condotte America, Inc.*, 346 F.3d 1057, 1068 (Fed. Cir. 2003)). A reference directed to an entirely different problem than the one addressed by the inventor can still anticipate an invention if the reference “explicitly or inherently discloses every limitation recited in the claims.” *Id.*; 1 CHISUM, *supra* § 3.02 n.11 (Matthew Bender 2002) (stating that to anticipate a claim, an anticipatory invention must contain each and every limitation of the claim).

<sup>86</sup> *Schram Glass*, 249 F. at 232 (emphasis added).

<sup>87</sup> *Id.* at 233.

<sup>88</sup> *See* 47 F.2d 358 (C.C.P.A. 1931).

<sup>89</sup> *Id.* at 364 (citing *Schram Glass Mfg. Co. v. Homer Brooke Glass Co.*, 249 F. 228 (7th Cir. 1918), *cert. denied*, 247 U.S. 520 (1918)).

<sup>90</sup> 59 F.2d 225, 227 (C.C.P.A. 1932).

<sup>91</sup> *Id.* at 226.

<sup>92</sup> *Id.* at 227.

<sup>93</sup> *Id.* at 226.

<sup>94</sup> A count is not a claim. The count of an interference is merely the vehicle for contesting the priority and determining what evidence is relevant to the issue of priority. 3 CHISUM, *supra* note 3, § 10.09[4][c][ii]. In a common pattern, an applicant copies a patentee’s claim, and the count is then the applicant’s claim. *Id.* After the count is made, an issue can arise as to whether the applicant has disclosure support in his specification for the patentee’s claim. *Id.* If the applicant does not have support for the patentee’s claim, he has

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lead suboxide intermingled with a powder of metallic lead,” was a limitation because the court agreed with the senior party that the preamble language was “the very heart” of the count and thus was “necessary to give life and meaning and vitality to the count.”<sup>95</sup>

C. *Difficulty in Applying The “Giving Life, Meaning and Vitality” Rule*

Since *Braren v. Horner* and *Hall v. Shimadzu*, the “giving life, meaning and vitality” language has been extensively used in preamble interpretation. This “giving life, meaning and vitality” rule seems self-explanatory—a preamble must be a limitation if it gives life, meaning and vitality to a claim, suggesting that a limiting preamble must be important to a claim. However, how important should a preamble be to justify a limiting effect? Courts applying the “giving life, meaning and vitality” test since *Schram Glass* and *Hall* have neglected to fully clarify the actual meaning of the test.

In *Schram Glass*, the court used the “giving life, meaning and vitality” language to describe a preamble that the court considered to be “the essence of the value of [the patentee’s] discovery,” suggesting that the phrase is related to patentability of an invention. In *Hall*, the court made a similar suggestion by using the phrase to describe the preamble as “the very heart of an invention.”

However, in later court decisions, the C.C.P.A. and the Federal Circuit used the language in a conclusory, rather than an analytical manner. As a result, the numerous decisions do not provide a useful guideline as to how to apply this rule correctly.

For example, in *Kropa v. Robie*, the court found the preamble, “abrasive article,” was a limitation because it gave life and meaning to the count.<sup>96</sup> The court explained that the preamble gave life, meaning and vitality because it was by the preamble that the subject matter defined by the claim was known as an abrasive article.<sup>97</sup>

Similarly, in *Corning Glass Works v. Sumitomo Electric*, the court held that the preamble, “an optical waveguide,” was a limitation on the grounds that it gave “life and meaning” to the claimed invention.<sup>98</sup> The court reached this conclusion based on the observation that:

Here, the ‘915 specification makes clear that the inventors were working on the particular problem of an effective optical communication system not on general improvements in conventional optical fibers. To read the claim in light of the specification indiscriminately to cover all types of

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no right to claim that the patentee’s invention is substantially the same as his invention. *Id.*; 2 MILLS ET AL., *supra* note 3, § 11:44.

<sup>95</sup> *Hall*, 59 F.2d at 227.

<sup>96</sup> 187 F.2d 150, 152 (C.C.P.A. 1951).

<sup>97</sup> *Id.*

<sup>98</sup> 868 F.2d 1251, 1257 (Fed. Cir. 1989).

optical fibers would be divorced from reality. The invention is restricted to those fibers that work as waveguides as defined in the specification, which is not true with respect to fibers constructed with the limitations [recited in the body of the claim]. Thus, we conclude that the claim preamble in this instance does not merely state a purpose or intended use for the claimed structure. Rather, those words do give ‘life and meaning’ and provide further positive limitations to the invention claimed.<sup>99</sup>

Moreover, in *In re Paulsen*, the preamble, “computer,” was held to be a limitation after the court concluded that “in the instant case, review of the ‘456 patent as a whole reveals that the term ‘computer’ is one that ‘breathes life and meaning into the claims and hence, is a necessary limitation to them.’”<sup>100</sup>

Despite conceding the difficulty in applying the “giving life, meaning and vitality” rule, the Federal Circuit nonetheless did not try to clarify this rule or explain how to correctly apply it.<sup>101</sup> The court reiterated that the determination of whether a preamble is a limitation or a mere statement of intended use or purpose “can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to be encompassed by the claim.”<sup>102</sup>

#### IV. OVERVIEW OF COURT DECISIONS—PREAMBLES ARE FOUND LIMITING

In order to determine when a preamble becomes a limitation of a claim, it is necessary to understand the actual meaning of the “giving life, meaning and vitality” language. This section will analyze cases where courts have found preambles limiting. Classifying these cases based on their contexts will help provide some clues to the actual meaning of the “giving life, meaning and vitality” test.

##### A. *Comparison with Prior Art Not Necessary*

In the first line of cases, the limiting effect of a preamble is determined without comparing the claim to the prior art. In these cases, preambles do not generally recite a use or environment for the combination defined in the body of the claim. Preambles in these cases recite a term intimately meshed with the body of the claim and thus provide a definition for a term appearing in the

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<sup>99</sup> *Id.*

<sup>100</sup> 30 F.3d 1475, 1479 (Fed. Cir. 1994).

<sup>101</sup> See *Corning Glass Works*, 868 F.2d at 1256. “No litmus test can be given with respect to when the introductory words of a claim, the preamble, constitute a statement of purpose for a device or are, in themselves, additional structural limitations of a claim . . . . The effect preamble language should be given can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” *Id.* at 1257.

<sup>102</sup> *Id.*

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body.<sup>103</sup>

In *Bell Communications Research v. Vitalink Communications Corporation*, the court held that the preamble was a limitation to the claim because the body of the claim referred back to a term in the preamble.<sup>104</sup> The claim read:

A method for transmitting a *packet* over a system . . . said *packet* originated by a source device . . . destined for a destination device . . . said *packet* including a source address and a destination address . . . said method comprising the steps of . . . assigning, by said source device, one of said trees to broadcast said *packet* and associating with said *packet* an identifier indicative of said one of said trees . . .<sup>105</sup>

The court held that the body of the claim, by referring to “said packet,” expressly incorporated by reference the preamble phrase “said packet including a source address and a destination address.”<sup>106</sup> By examining the claim language, the court concluded that the preamble was a limitation and held that only a method for transmitting packets that have both source and destination addresses can literally infringe the claim at issue.<sup>107</sup>

The same reasoning was applied in *Pitney Bowes Inc. v. Hewlett-Packard Co.* where the claim at issue read:

A method of producing on a photoreceptor an image of *generated shapes* made up of *spots*, comprising:

directing a plurality of beams of light towards a photoreceptor, each beam of light generating a *spot* on the photoreceptor and controlling a parameter of the light beams to produce *spots* of different sizes whereby the appearance of smoothed edges are given to the *generated shapes*.<sup>108</sup>

The court found that the term “generated shapes” could only be understood

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<sup>103</sup> See *Pitney Bowes v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999) (stating that if the body of the claim sets forth a complete invention and the preamble provides no definition for the terms in the claim, the preamble is not a limitation); see also *Kropa v. Robie*, 187 F.2d 150, 158 (C.C.P.A. 1951) (citing *In re Braren v. Horner*, 47 F.2d 358 (C.C.P.A. 1931) and stating that where the structure recited in the body of the claim was a self-contained description and did not depend for completeness upon the preamble, the preamble clause was not a limitation); 3 CHISUM, *supra* note 3, § 8.06 n.22 (“When the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined . . . is the one the patent protects.”); *Id.* § 8.06 n.29 (“When . . . a patentee uses the preamble to recite material limitations of the claimed invention, this court will give effect to that usage.”).

<sup>104</sup> 55 F.3d 615, 621 (Fed. Cir. 1995).

<sup>105</sup> *Id.* at 618 (emphasis added).

<sup>106</sup> *Id.* at 621.

<sup>107</sup> *Id.*

<sup>108</sup> *Pitney Bowes*, 182 F.3d 1298, 1302 (Fed. Cir. 1999) (emphasis added).

in the context of the preamble statement “producing on a photoreceptor an image of generated shapes made up of spots.”<sup>109</sup> It was only through the preamble that the court could discern that the term “spots” in the body of the claim referred to the components that together made up the images of generated shapes on the photoreceptor.<sup>110</sup> Therefore, the court held that the preamble was a limitation. The court reasoned that the preamble was a limitation because it was not merely a statement describing the invention’s intended field of use, but rather a statement that “gave life, meaning and vitality to the claim.”<sup>111</sup>

*B. Comparison with Prior Art Necessary*

The Federal Circuit has said that in order to determine whether a preamble is a limitation of a claim, it must identify what an inventor has actually invented by reviewing the whole record,<sup>112</sup> suggesting that it is necessary to compare a claim to the prior art.<sup>113</sup> As explained below, the courts compare a claim with the prior art to determine when a preamble “gives life, meaning and vitality” to a claim.<sup>114</sup>

1. Prosecution Proceedings

In *In re Covey*, the court found the preamble “tire” to be a limitation despite agreeing that the preamble recited an environment in which the combination defined in the body of the claim was used.<sup>115</sup> The preamble read: “In a tire, having a casing, crepe rubber formed integral therewith to prevent skidding.”<sup>116</sup>

The primary reference disclosed the use of carborundum cloth or fabric for the tread of tires.<sup>117</sup> The secondary reference concerned the use of crepe

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<sup>109</sup> *Id.* at 1306.

<sup>110</sup> *Id.*

<sup>111</sup> *Id.*

<sup>112</sup> *Corning Glass Works v. Sumitomo Electric*, 868 F.2d 1251, 1257 (Fed. Cir. 1989).

<sup>113</sup> If a patent examiner makes an obviousness objection to a claim during prosecution of a patent, the applicant can overcome the objection by distinguishing her invention from the cited prior art. *See HARMON, supra* note 2, § 6.7(i), at 333. As a result, the prosecution record and the prior art provide important clues in determining what the inventor actually invented. Also, a patent holder’s invention may be further defined as a result of invalidity claims after a patent has been issued, where the claim(s) must be construed and new prior art may surface. *See id.*

<sup>114</sup> *See* 2 MILLS ET AL., *supra* note 3, § 15:9 (“A claim preamble can also be construed as a limitation where it appeared that the preamble had been relied upon by the PTO to distinguish it over the prior art.”).

<sup>115</sup> *In re Covey*, 63 F.2d 982, 983 (C.C.P.A. 1933).

<sup>116</sup> *Id.* at 982.

<sup>117</sup> *Id.*

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rubber for the tread of soles and heels of shoes.<sup>118</sup> The court found the feature recited in the preamble to be a limitation because the use of crepe rubber for the tread of tires was not analogous to its use for soles of shoes, because the feature recited in the preamble met a long-felt need in this industry, and because the feature required exercise of inventive faculty and was not obvious in view of the cited references.<sup>119</sup>

In *In re Reichel*, the preamble, “an expansible diaphragm device”, was regarded as a limitation.<sup>120</sup> The claim at issue in *In re Reichel* read:

An expansible diaphragm device comprising means providing a chamber and including a supporting shell, a diaphragm closing said chamber and movable in response to a difference in pressure at opposite sides of the diaphragm, said diaphragm having a peripheral flange portion inclined at an angle toward the normally preponderating pressure side of said diaphragm, and an annular connection between said flange portion and the shell, said connection comprising sealing material within the annular space defined by the peripheral edge of the shell and the inclined flange portion of the diaphragm so that the sealing material is not susceptible to tension due to movements of the diaphragm occasioned by pressure preponderance changes of the device as long as the normal relation or direction of preponderance is maintained.<sup>121</sup>

The cited prior art devices were all directed to a metallic container using flanges to counteract the pressure on the diaphragm and could not achieve the salient “expansible” feature.<sup>122</sup> The court reasoned that while the claimed invention had a structure similar to the prior art, the prior art reference was designed to avoid expansion and contraction as far as possible and could not anticipate the claimed invention.<sup>123</sup>

In *In re Echerd*, the claim read:

A flame-resistant, drapable, pipe lagging material characterized by having sufficient flexibility and wet strength to permit the same to be wrapped when wet around insulated pipe surfaces and the like, and having sufficient adhesive characteristics to firmly bond itself to such surfaces upon subsequent drying, said pipe lagging material comprising a porous,

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<sup>118</sup> *Id.*

<sup>119</sup> *Id.* at 983; *see also* *Kropa v. Robie*, 187 F.2d 150, 155-59 (C.C.P.A. 1951) (listing 37 cases in an appendix, discussing the limiting effect of the preambles). Judge Johnson commented on the *Covey* case that “the preamble specified an environment in which the limitations recited in the body of the claim, while previously known, was not obviously useful and this invention met a long-felt need in this industry.” *Id.* at 158.

<sup>120</sup> 84 F.2d 221, 223 (C.C.P.A. 1936).

<sup>121</sup> *Id.* at 221.

<sup>122</sup> *Id.* at 223.

<sup>123</sup> *Id.*

woven, textile fabric base, having substantial flexibility in both wet and dry state, and a latent adhesive composition consisting essentially of an inorganic hydrophilic siliceous material impregnated in and firmly bonded to said fabric base and substantially inseparable therefrom through leaching-out in water and through flexure in dry condition, and having adhesive characteristics, when wet, to adhere the pipe lagging material to a surface around which it is wound and, when subsequently dried, to firmly bond and form with said fabric base an adherent, non-dusting covering on such surface.<sup>124</sup>

The issue in this case was whether the features “sufficient flexibility and wet strength to permit the pipe lagging material to be wrapped” and “sufficient adhesive characteristics to firmly bond itself to such surfaces upon subsequent drying” were limitations of the claim.<sup>125</sup> The court rejected the finding of the Board of Appeals that these features were inherent properties or intended new uses of the old material.<sup>126</sup> The court held that these features constituted limitations of the claim, because, during patent prosecution, the inventor overcame nonobviousness arguments by claiming these distinctive features of the pipe lagging material over the cited prior art references.<sup>127</sup>

## 2. *Interference Proceedings*<sup>128</sup>

As discussed above, in *Hall v. Shimadzu*, the preamble, “[a] process of manufacturing a fine powder of lead suboxide intermingled with [a] powder of metallic lead,”<sup>129</sup> was considered a limitation because the court found the feature recited in the preamble was the essence of the senior party’s invention and was not contemplated by the junior party’s invention directed to a process of manufacturing olive gray powder.<sup>130</sup>

In *Kropa v. Robie*, the court found that the preamble, “abrasive article,” was a limitation.<sup>131</sup> The claim at issue read: “An abrasive article comprising abrasive grains and a hardened binder comprising the additive reaction product

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<sup>124</sup> 471 F.2d 632, 633 (C.C.P.A. 1973).

<sup>125</sup> *Id.* at 634.

<sup>126</sup> *Id.* at 635.

<sup>127</sup> *Id.*

<sup>128</sup> An interference proceeding determines priority between two parties claiming the same invention. 3 CHISUM, *supra* note 3, § 10.09[4][c][i]. In an interference, one or more of the parties may seek to establish a pre-filing date of invention by offering proof on the issues of conception, reduction to practice, and diligence. *Id.* § 10.09[1][a]. The count of an interference is merely the vehicle for contesting the priority of invention and determining what evidence is relevant to the issue of priority. *Id.* § 10.09.

<sup>129</sup> 59 F.2d 225, 225 (C.C.P.A. 1932).

<sup>130</sup> *Id.* at 227.

<sup>131</sup> *Kropa v. Robie*, 187 F.2d 150, 151 (C.C.P.A. 1951).

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of a substantially neutral unsaturated monomeric material and an unsaturated esterification product of an aliphatic alcohol and a polybasic acid.”<sup>132</sup>

The subject matter in the interference proceeding was an abrasive article in which a particular kind of synthetic resin bonded abrasive grains together.<sup>133</sup> The issue was whether the alleged anticipatory prior art inherently disclosed an abrasive article when it enumerated carborundum (silicon carbide), sand, and granite dust as fillers, which under some circumstances may be considered abrasive grains.<sup>134</sup> The court held that the alleged anticipatory prior art did not “inherently disclose” an abrasive article, because the prior art characterized those substances as fillers combined with other substances that could not be used as abrasive grains.<sup>135</sup> The court explained that “the mixture of the resin with ‘carborundum,’ sand or granite dust in proportions commonly understood as appropriate for the addition of filler would not inevitably—if at all—yield an abrasive article, as that term is understood by the art and the appellee’s patent where the counts originated.”<sup>136</sup> The court concluded that the preamble “abrasive article” was a vital term of the claim that gave life and meaning to the claim.<sup>137</sup> The court added that the preamble revealed that the subject matter defined in the body of the claim was comprised of an abrasive article.<sup>138</sup>

In *Smith v. Bousquet*, the court found that the preamble, “an insecticide composition,” was a limitation and not just a suggested use.<sup>139</sup> The claim read: “An insecticide containing as its essential active ingredient phenthiazine.”<sup>140</sup> The court held that the preamble was a limitation of the claim, because the composition, “phenthiazine,” was previously known,<sup>141</sup> and it was the

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<sup>132</sup> *Id.* at 150.

<sup>133</sup> *Id.* at 151.

<sup>134</sup> *Id.*

<sup>135</sup> *Id.* at 155.

<sup>136</sup> *Id.* at 152.

<sup>137</sup> *Kropa*, 187 F.2d at 152.

<sup>138</sup> *Id.*

<sup>139</sup> 111 F.2d 157, 158 (C.C.P.A. 1940); *see also Kropa*, 187 F.2d at 159 (holding that the preamble is a limitation if “it specifies an article or composition in which there inheres a field of specific use”).

<sup>140</sup> *Bosquet*, 111 F.2d at 158. The junior party claimed an insecticide made with the claimed phenthiazine, which was a composition claimed by the senior party. *Id.* The court reversed the Board’s decision that the invention at issue resided solely in the discovery that the old compounds claimed by the junior party were useful as insecticides. *Id.* The court reasoned that although both the junior party and senior party suggested in their specification that phenthiazine might be used as an insecticide, their records indicated that both parties were unaware of the insecticidal effect of their invention until successful tests were made some time thereafter. *Id.* at 162.

<sup>141</sup> *Id.* at 158.

preamble that recited a use which had not been previously recognized.<sup>142</sup>

### 3. *Invalidity Proceedings*

As mentioned earlier, in *Schram Glass*, where the “giving life and meaning” phrase originated, the court considered the preamble, “an automatic device for cutting or separating an unsupported freely flowing stream of molten material into unformed molten masses,” a limitation.<sup>143</sup> The alleged anticipatory prior art described a measuring device that contained all of the elements recited in the body of the claim.<sup>144</sup> The court found that the feature of cutting or separating an unsupported freely flowing stream of molten material into unformed molten masses was the primary feature of the claim and could not be achieved by the measuring device.<sup>145</sup> The court thus interpreted the preamble as a limitation sustaining the validity of the claim.<sup>146</sup>

In *Corning Glass Works v. Sumitomo Electric U.S.A.*, the court held that the words “optical waveguide” in the preamble were a limitation.<sup>147</sup> The claim read:

An optical waveguide comprising:

(a) a cladding layer formed of a material selected from the group consisting of pure fused silica and fused silica to which a dopant material on at least an elemental basis has been added, and

(b) a core formed of fused silica to which a dopant material on at least an elemental basis has been added to a degree in excess of that of the cladding layer so that the index of refraction thereof is of a value greater than the index of refraction of said cladding layer, said core being formed of at least 85 percent by weight of fused silica and an effective amount up to 15 percent by weight of said dopant material.<sup>148</sup>

The patent detailed a particular type of optical fiber with carefully coordinated physical characteristics and parameters.<sup>149</sup> The issue was whether a previously disclosed, substantially transparent, luminescent, fiber shaped glass could inherently function as a waveguide.<sup>150</sup> The patent specification explained that “optical waveguides are a unique type of optical fiber . . . [and

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<sup>142</sup> *Id.* at 162.

<sup>143</sup> *Schram Glass Mfg. Co. v. Homer Brooke Glass Co.*, 249 F. 228, 232-33 (7th Cir. 1918).

<sup>144</sup> *Id.* at 231-32.

<sup>145</sup> *Id.*

<sup>146</sup> *Id.* at 232-33.

<sup>147</sup> 868 F.2d 1251, 1256-57 (Fed. Cir. 1989).

<sup>148</sup> *Id.* at 1256.

<sup>149</sup> *Id.*

<sup>150</sup> *Id.* at 1256-57.

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that] for an optical fiber to function as an optical waveguide, the transmitted light must be limited to preselected modes and the diameter of the core, the index of refraction of the core and the index of refraction of the cladding layer must be carefully coordinated.”<sup>151</sup> The court held that the preamble was a limitation by referring to the definition of “optical waveguide” in the specification.<sup>152</sup> The court reasoned that “the claim preamble [optical waveguide] in this instance did not merely state a purpose or intended use for the claimed structure . . . . Rather, those words do give ‘life and meaning’ and provide further positive limitations to the invention claimed.”<sup>153</sup>

In *Strattec Security Corporation v. General Automotive Specialty Co.*, the court held that the preamble, “a packaged electronic component that is made of only four elements,” was a limitation.<sup>154</sup> The claim read:

A packaged electronic component that is made of only four elements, the component including:

an insulating body;

an electronic chip disposed within the insulating body and having a pair of terminals; and

a pair of electrically conductive sheet-like members . . . .<sup>155</sup>

The court found that during patent prosecution, the patentee not only added the words “only four elements” to the preamble but also argued that the four-element structure of the claimed invention was simple, novel and nonobvious over the cited references.<sup>156</sup> The court held that the preamble was a limitation.<sup>157</sup>

#### V. CLARIFYING THE “GIVING LIFE, MEANING AND VITALITY” LANGUAGE

An overview of court decisions shows that courts use the “giving life,

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<sup>151</sup> *Id.* at 1256.

<sup>152</sup> *Id.* at 1257. A patent will be invalidated if it infringes the scope of the prior art despite the fact that the invention discloses a novel and inventive subject matter. 2 MILLS ET AL., *supra* note 3, § 15:5.

<sup>153</sup> *Corning Glass Works*, 868 F.2d at 1257.

<sup>154</sup> 126 F.3d 1411, 1417 (Fed. Cir. 1997).

<sup>155</sup> *Id.* at 1416.

<sup>156</sup> *Id.* at 1417.

<sup>157</sup> *Id.*; *see also* *Hubbell v. U.S.*, 179 U.S. 77, 81 (1900) (“If an applicant, in order to get his patent, accepts one with a narrower claim than that contained in his original application, he is bound by it. If dissatisfied with the decision rejecting his application, he should pursue his remedy by appeal.”); *Kropa v. Robie*, 187 F.2d 150, 152 (C.C.P.A. 1951) (holding that “where a claim was expressly or by necessary implication given the effect of a limitation, the introductory phrase was deemed essential to point out the invention defined by the claim”).

meaning and vitality” language to implement two different types of exceptions to the general rule that a preamble is not a limitation. In the first situation, it is not necessary for the courts to compare the claims to prior art in order to determine whether the preamble serves as a limitation.<sup>158</sup> In the second situation, the court’s determination of whether the preamble serves as a limitation depends primarily on a comparison with prior art.<sup>159</sup> This section will discuss the two types of exceptions to clarify the rules used for preamble interpretation and show that the category of prior-art-distinguishing preambles falls closely in line with the original meaning of “giving life, meaning and vitality.”

*A. Definiteness-related Preambles vs. Prior-art-distinguishing Preambles*

An overview of court decisions showed that there are two situations in which a preamble can be found to be limiting. In the first situation, a preamble can be so closely related to the language in the body of the claim that it becomes a limitation. A typical example is a preamble that provides an antecedent basis for a term in the claim body and becomes an indispensable part of the claim. Referring back to *Bell Communications Research*<sup>160</sup> and *Pitney Bowes*,<sup>161</sup> in Section IV, Part A, it is the interrelationship between the preamble and the body of the claim that makes this type of preamble important. More specifically, a preamble of this type contributes to the completeness of a claim, regardless of the subject matter defined in the claim. Ignoring a preamble of this type may render a claim incomplete and indefinite under the statutory definiteness requirement.<sup>162</sup> Since a preamble of this type is important to a claim’s form, rather than its substance, the limiting effect of this type of preamble can be determined solely by examining the claim language. For preambles that are closely related to the language in the body of the claim, comparison of the claim to the prior art is not necessary. Therefore, this type of preamble may be properly described as a “definiteness-related preamble.”

In the second situation, the significance of a preamble cannot be determined merely by looking at the claim language. In this situation, the body of the claim contains a complete description of the subject matter; the claim does not depend on the preamble for its completeness in terms of the statutory definiteness requirement.<sup>163</sup> Referring back to the cases in Section IV, Part B,

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<sup>158</sup> See *supra* Part IV.A.

<sup>159</sup> See *supra* Part IV.B.

<sup>160</sup> *Bell Communications Research v. Vitalink Communications Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995).

<sup>161</sup> *Pitney Bowes v. Hewlett-Packard Co.*, 182 F.3d 1298, 1306 (Fed. Cir. 1999).

<sup>162</sup> 35 U.S.C. § 112, ¶ 2 (2000).

<sup>163</sup> 35 U.S.C. § 112, ¶ 2 (2000).

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the bodies of these claims recite a complete combination, while the preambles recite an environment in which the combination is used,<sup>164</sup> a use or purpose intended for the combination,<sup>165</sup> or a salient property of the combination.<sup>166</sup> The court found that those preambles further defined the subject matter of an invention. More specifically, those preambles further modified the combination defined in the body of the claim and distinguished the claims from the prior art to satisfy the statutory novelty<sup>167</sup> and nonobviousness<sup>168</sup> requirements. Therefore, this type of preamble can be described as a “prior-art-distinguishing preamble.”

*B. The Actual Meaning of “Giving Life, Meaning and Vitality”*

While courts use the “giving life, meaning and vitality” language to describe two different situations where a preamble will be found limiting, it is the prior-art-distinguishing preambles that most closely follow the original meaning of the test. When the “giving life, meaning and vitality” phrase was first used by the Seventh Circuit in *Schram Glass*<sup>169</sup> and later adopted by the C.C.P.A. in *Hall*,<sup>170</sup> this phrase referred to a feature recited in the preamble essential to the novelty and distinctiveness of the invention. In *Schram Glass*, the preamble, “an automatic device for cutting or separating an unsupported freely flowing stream of molten material,” recited the novel and distinctive feature of the invention, which was not contemplated by the previously conceived measuring device.<sup>171</sup> In *Hall*, the preamble, “a process of manufacturing a fine powder of lead suboxide intermingled with a powder of metallic lead,” recited the novel and distinctive feature of the invention, which was not contemplated by the previously disclosed process of manufacturing olive gray powder.<sup>172</sup> The Seventh Circuit and the C.C.P.A. used the preambles to modify the combinations defined in the body of the claim to patentably distinguish the claim from the prior art.

After *Schram Glass* and *Hall*, courts used the “giving life, meaning and

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<sup>164</sup> See *In re Covey*, 63 F.2d 982, 983 (C.C.P.A. 1933).

<sup>165</sup> See *Kropa v. Robie*, 187 F.2d 150, 152 (C.C.P.A. 1951); *Hall v. Shimadzu*, 59 F.2d 225, 227 (C.C.P.A. 1932); *Schram Glass Mfg. Co. v. Homer Brooke Glass Co.* 249 F. 228, 232 (7th Cir. 1918).

<sup>166</sup> See *Strattec Security Corp. v. General Automotive Specialty Co.*, 126 F.3d 1411, 1418 (Fed. Cir. 1997); *In re Echerd*, 471 F.2d 632, 635 (C.C.P.A. 1973); *In re Reichel*, 84 F.2d 221, 223 (C.C.P.A. 1936).

<sup>167</sup> 35 U.S.C. § 102 (2000).

<sup>168</sup> 35 U.S.C. § 103 (2000).

<sup>169</sup> *Schram Glass Mfg. Co. v. Homer Brooke Glass Co.* 249 F. 228, 232 (7th Cir. 1918).

<sup>170</sup> *Hall v. Shimadzu*, 59 F.2d 227, 227 (C.C.P.A. 1932).

<sup>171</sup> 249 F.2d at 232.

<sup>172</sup> 59 F.2d at 227.

vitality” language in their opinions to also refer to a novel and distinctive feature of an invention recited in a preamble, although the courts did not explicitly state this in their opinions. Instead of describing the preamble as novel and distinctive to the invention, the courts used “giving life, meaning and vitality” to describe a preamble that they deemed a limitation after reviewing the patent record and the prior art. In *In re Paulsen*, the court found that the preamble, “computer,” was a novel and distinctive feature of the claim at issue because the prior art desktop calculator did not actually contemplate application to a computer, although it disclosed the basic elements recited in the body of the claim.<sup>173</sup> Similarly, in *Kropa v. Robie*, the preamble, “abrasive article,” was indeed a novel and distinctive feature, given that the prior art reference, a reactive resin-reactive solvent combination mixed with a filler, did not contemplate the use of the combination as an abrasive article.<sup>174</sup> In *Corning Glass Works*, the preamble, “an optical waveguide,” was indeed a novel and distinctive feature, because the prior art reference, which disclosed each and every element recited in the claim body, did not contemplate the function and structure of the waveguide.<sup>175</sup>

Regardless of the proceedings in which the issue of preamble interpretation arises, prior-art-distinguishing preambles recite a novel and distinctive feature. The courts have used these preambles to modify a combination defined in the body of a claim to patentably distinguish the whole claim from the prior art. If the preambles previously discussed would have been disregarded, their respective claims would have been anticipated or rendered obvious by prior inventions. More specifically, the court found these preambles limiting despite prior art references that taught, suggested, or rendered obvious a combination in the body of a claim because the prior art references did not disclose the combination with the additional limitation recited in the preamble. When preambles recite novel and distinctive features, treating them as limitations of claims allows the courts to establish or sustain the patentability of an invention in a prosecution, invalidity or interference proceeding.<sup>176</sup>

The court cannot, however, arbitrarily rewrite a claim by reading in limitations from the patent specification.<sup>177</sup> Using a preamble to modify a combination defined in the body of a claim is not to narrow the scope of the claim for the purposes of avoiding anticipation, sustaining validity, or

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<sup>173</sup> *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994).

<sup>174</sup> 187 F.2d at 152.

<sup>175</sup> *Corning Glass Works v. Sumitomo Electric U.S.A. Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989).

<sup>176</sup> While an interference is a proceeding to determine the priority between two inventors of the same invention, patentability is a threshold question which determines whether an interference exists. 3 CHISUM, *supra* note 3, § 10.09.

<sup>177</sup> *Corning Glass Works*, 868 F.2d at 1257.

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establishing patentability.<sup>178</sup> The scope of the patent protection as defined by the claims remains the same.<sup>179</sup> By interpreting a preamble as a limitation, the courts merely *give effect* to that usage.<sup>180</sup>

The underlying principles of patent law support the above interpretation of the “giving life, meaning and vitality” phrase. The goal of patent law is to bring a steady flow of innovations to the public by awarding a patent owner temporary exclusive rights for his or her invention. An inventor is entitled to a patent for an invention that is useful, novel and nonobvious. It should not matter whether the useful, novel and nonobvious feature is stated in the preamble or in the body of the claim. Denying an inventor a patent merely because a prior art reference anticipates or renders obvious a combination defined in the body of a claim, but not the combination with the preamble included, will do a disservice to the goal of the patent law. The “giving life, meaning and vitality” rule reflects a need to ensure that an inventor receives a patent for his novel and distinctive invention regardless of how he uses the preamble to describe his invention.

C. *Conclusion*

As a general rule, a preamble is not a limitation. A court will find a preamble limiting only in two situations. Where a preamble is an indispensable part of a claim in terms of a complete description of a claim, the preamble is a definiteness-related preamble and a limitation. The typical example of such a preamble is one that provides an antecedent basis for a term in the body of the claim. For this type of preamble, examining the claim language alone is sufficient to determine whether a preamble is a limitation of the claim.

Where a preamble recites a novel and distinctive feature of an invention, the preamble is a prior-art-distinguishing preamble and a limitation. A prior-art-distinguishing preamble further defines and modifies a combination defined in the body of a claim to precisely describe the inventor’s actual invention or discovery and to patentably distinguish the claim from the prior art. Therefore, a prior-art-distinguishing preamble gives life, meaning and vitality to a claim that would otherwise be anticipated or rendered obvious by a prior invention if

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<sup>178</sup> *Id.*; see also HARMON, *supra* note 2, § 6, at 268 (“The construction of claims is simply a way of elaborating the normally terse language of the claims, in order to understand and explain, but not to change, the scope of the claims.”).

<sup>179</sup> See HARMON, *supra* note 2, § 6, at 268 (“The construction of claims is simply a way of elaborating the normally terse language of the claims, in order to understand and explain, but not to change, the scope of the claims.”).

<sup>180</sup> See *Corning Glass Works*, 868 F.2d at 1257 (stating that reading a claim in light of the specification to interpret limitations explicitly recited in the claim is different from narrowing the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim).

the preamble is not deemed a limitation.