

# Client Alert

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## Overlook Patent Claim Preambles at Your Peril

Most patent claim preambles are mere bystanders that get little attention during claim drafting—but two recent cases from the Federal Circuit show that they can swing the outcome of an infringement or a validity challenge for good or ill.

Draft carefully out there.

In a first case, *In Re Fought*, No. 2019-1127 (Fed. Cir. Nov. 4, 2019), the Federal Circuit found the claim preamble sufficient to distinguish a prior art reference that the Patent Office had found to be anticipatory.

In *Fought*, a patent applicant is pursuing a patent for a “travel trailer” having two compartments, a living quarters portion and a garage portion, separated by a wall that can be moved to change the relative size of the portions without altering the overall size of the trailer. However, the claims at issue, while reciting a “travel trailer” in the preamble, recite the living and garage portions as simply a first and second compartment.

The examiner and Patent Trial and Appeal Board (PTAB) both rejected the claims as anticipated by two prior art patents, one to a cargo trailer and one to a shipping container. The examiner and PTAB found the applicant’s argument that the “travel trailer” was not a cargo trailer, but rather a recreational vehicle that includes a living quarters, to be unavailing, finding the “travel trailer” language to be a mere statement of intended use.

On appeal, the Federal Circuit reversed and remanded the anticipation rejections. The court found that “travel trailer” was not simply a statement of intended use; instead, the towability of the travel trailer and the requirement for a living quarters (as shown by the applicant’s extrinsic evidence) were structural requirements. The court further found that one of the pending claims relied on “travel trailer” in the preamble as antecedent basis for a limitation in the body of the claims.

In a second case, *Curver Luxembourg, SARL v. Home Expressions Inc.*, No. 2018-2214 (Fed. Cir. Sept. 12, 2019), the Federal Circuit found that the preamble of a design patent claim can determine its scope.

Curver brought suit over plastic baskets sold by Home Expressions that incorporate an overlapping “Y” pattern. Curver alleged that these baskets infringed its design patent that disclosed a similar overlapping “Y” pattern.

Traditionally, determining the scope of a design patent has focused on the figures of the patent where the design is illustrated. And indeed, the figures in Curver’s patent showed a design very similar to that of the Home Expressions baskets, but the figures did not show the design being applied to a basket (or to any particular article). The figures only showed the design applied to a generic surface or panel, with the patent’s single claim reciting in the preamble that it was for an “ornamental design for a pattern for a chair, as shown and described.”

Recognizing that this was a case of first impression, the Federal Circuit turned to the language of the statute, which provides that a patent may be obtained for a “new, original and ornamental design for an

article of manufacture” (35 U.S.C. § 171). Thus, Curver’s design patent could not cover the overlapping “Y” pattern in the abstract, but only as applied to an article of manufacture. The Federal Circuit affirmed that, because the claim preamble recited that it was “for a pattern for a chair,” the Home Expressions basket could not infringe, as no ordinary observer would confuse a basket for a chair.<sup>1</sup>

These two cases demonstrate that all words in a patent can be important, no matter where they are located. Inventors and practitioners alike must be aware of the effect their word choices may have down the road with respect to both prosecution and litigation of a patent.

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<sup>1</sup> The court further noted that Curver had limited its patent to chairs during prosecution when the examiner rejected Curver’s original application directed to a “furniture part” as too vague to meet the “article” requirement. It’s unclear whether the examiner would have allowed Curver to obtain a claim directed at a basket or container (through amendment or continuation), but having recited a chair in the preamble, Curver may not have realized how much it was giving up.