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Preambles for Replaceable Component Claims:
Canon v. GCC International, Ltd. (Fed. Cir. 2007)

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Preambles for Replaceable Component Claims:

When a client produces a replaceable component, one may choose to define the replaceable component by how it cooperates with a main apparatus, if the claim otherwise would have no patentable distinction. The goal is a claim directed just to the replaceable component, and not to a combination of the replaceable component with the main apparatus.

Often, we do this by reciting the main apparatus in the claim preamble, and then, in the body of the claim, explaining how the replaceable component cooperates with the main apparatus. This way, the main apparatus is treated as the environment in which the replaceable component is used.

Preambles for Replaceable Component Claims:

The preamble generally does not limit the scope of a claim. DeGeorge v. Bernier, 768 F.3d 1318 (Fed. Cir. 1985).

There may be circumstances where a claim will be construed to require a feature recited in the claim preamble. C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1350 (Fed. Cir. 1998).

Choosing the right preamble can be particularly important for a claim that is directed to a replaceable component for use in a machine. Having a strong claim preamble can prevent a defendant from raising the defenses of (1) permissible repair and (2) implied license.

Preambles for Replaceable Component Claims:

The recent unpublished decision in Canon v. GCC International, Ltd., No. 2006-1615 (Fed. Cir. November 16, 2007) is instructive. The relevant facts are:

- ♦ Plaintiff Canon manufactures laser printers and fax machines that use replaceable toner cartridges. Canon owns U.S. patent no. 6,336,018 to Kawai, et al. Kawai contains 79 claims, most drawn to process cartridges, and a few to an electrophotographic image forming apparatus.
- ♦ Defendant GCC International sells replacement toner cartridges for use in Canon's laser printers and fax machines.

Preambles for Replaceable Component Claims:

- ♦ Canon sued GCC International in the Southern District of New York for infringing claim 58 of Kawai. Canon obtained a preliminary injunction preventing GCC International from making, using, offering or selling toner cartridges falling within the scope of claim 58.
- ♦ Defendant GCC International appealed the grant of the preliminary injunction to the Federal Circuit. The Federal Circuit upheld the District Court's grant of the preliminary injunction. Although the Federal Circuit's decision is nonprecedential, the court's comments are informative for those who prosecute claims covering replaceable components of machines such as printers.

Preambles for Replaceable Component Claims:

Claim 58 of Kawai reads:

58. A **process cartridge detachably mountable to a main assembly of an electrophotographic image forming apparatus**, wherein **said main assembly includes a motor, a driving rotatable member for receiving driving force from said motor, and a hole defined by twisted surfaces, said hole being substantially coaxial with said driving rotatable member**, said process cartridge comprising:

a cartridge frame;

an electrophotographic photosensitive drum;

process means actable on said photosensitive drum, said process means including a developing roller for developing a latent image formed on said photosensitive drum, and a charging member for electrically charging said photosensitive drum;

a projection provided at a longitudinal end of said photosensitive drum, wherein **said projection has an engaging portion for engagement with the twisted surfaces** and a supporting portion for supporting said engaging portion, wherein said end of said photosensitive drum is provided with a shaft for supporting said photosensitive drum on said cartridge frame, and said engaging portion is supported on said shaft by said supporting portion, and a cross section of said supporting portion in a direction crossing with a longitudinal direction of said photosensitive drum is smaller than a cross section of said engaging portion, and **said supporting portion is capable of entering said hole**, and wherein **when said driving rotatable member rotates with said hole** and said engaging portion of said projection engaged with each other, rotational driving force is transmitted from said driving rotatable member to said photosensitive drum **through engagement between said hole and said projection, and said projection is urged inwardly of said hole, wherein said engaging portion is contacted to said twisted surfaces at at least three points**, and wherein said end of said photosensitive drum is provided with a drum gear which is effective to transmit a driving force received by said engaging portion from the main assembly to said developing roller.

Preambles for Replaceable Component Claims:

Claim 58 is drawn to a process cartridge, but some claim features are described with reference to structure of the apparatus in which the process cartridge is used. Here the drafter of the claim walked a thin line between claiming the features of the cartridge so narrowly as to be easily avoided and claiming the apparatus as well.

Defendant GCC International asked the District Court to construe claim 58 to cover the process cartridge together with the "main assembly" of the image forming apparatus.

Why did GCC International do this? To rely on the defenses of permissible repair and implied license.

The District Court held that claim 58 of Kawai was directed to the process cartridge alone, not the combination of the process cartridge and the main assembly. That prevented GCC International from raising the permissible repair and implied license defenses.

Preambles for Replaceable Component Claims:

The Federal Circuit avoided having to construe claim 58 by stating:

“On the present record, there is a reasonably debatable question of whether Claim 58 should be construed to cover the cartridge alone or the cartridge as part of a combination. Therefore, **this court is not now reaching its final conclusion as to the matter.** However, **even if Claim 58 were construed to cover the cartridge as part of a combination,** Canon would still have a substantial likelihood of success.

If Claim 58 were construed as covering a combination, **it is unlikely that the covered combination would include the toner cartridge and the entirety of the printer or fax machine** since most of the components of such machines are not claimed. On the contrary, as appears from the claims, **the most likely combination would be one consisting of the toner cartridge and the claimed "hole defined by twisted surfaces."** '018 Patent cl. 58.”

Slip op. at 6.

Preambles for Replaceable Component Claims:

The Federal Circuit did not cite any authority for its conclusion regarding claim 58.

The parties' briefs on appeal are informative.

Canon relied on cases supporting the proposition that an invention can be described with reference to the structure in which the invention will be used without claiming the combination of the invention and the structure.

Preambles for Replaceable Component Claims:

Williams Mfg. Co. v. United Shoe Machinery Corp., 316 U.S. 364, 369 (1942)

“In describing the novel combinations embodied in the claims, it was necessary to make reference to certain portions of the machine in connection with which the new combinations were to operate and with which they were to dovetail, n7 **but, in mentioning these other mechanical parts, the claim does not purport to embody them as elements of the claimed combination.**”

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

“In the case at bar, **the preamble of claim 21 recites the portion and structure of the gun housing into which the needles fit, and provides reference points in the gun that aid in defining the needles as set forth in the body of the claim. M3 Systems is incorrect in stating that the preamble must contain details of the integrated mechanical cocking structure, for the gun structure is not part of the separate claims to the needles. The question of anticipation of the '056 claims relates to the needles, not the gun.** To the extent that the jury verdicts of anticipation may have been based on M3's incorrect construction of the preamble, they can not be sustained. On the correct construction of the preamble, it contributes no basis of invalidity on the ground of anticipation.”

Preambles for Replaceable Component Claims:

In re Stencel, 828 F.2d 751, 754 (Fed. Cir. 1987)

“As a matter of claim draftsmanship, appellant is not barred from describing the driver in terms of the **structure imposed upon it by the collar having plastically deformable lobes**. The framework -- the teachings of the prior art -
- against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims themselves are so limited.”

Ricoh Co., Ltd. v. Katun Corp., 380 F. Supp.2d 418, 435 (D. N.J. 2005)

“Although the Court finds that the preamble to claim 1 of the '963 patent is limiting, the '963 patent claims solely a lid, and not a combination of lid, container and image forming apparatus. The presence of the lid, bottle and image forming apparatus are not required.... Here, the '963 patent claims in dispute do not claim all bottle lids broadly. **The preamble clearly states, and it is reflected throughout the patent specification and prosecution history, that what is claimed is solely a lid, specifically designed to function with developer containers to be used in the environment of the image forming apparatus.** Similar to the printer ribbon in Smith Corona, claimed in the context of the other printer parts, here the lid is claimed in relation to the environment of the bottle and the image forming apparatus. **The '963 patent does not claim a combination of lid, container, and image forming apparatus.**”

Preambles for Replaceable Component Claims:

Smith Corona Corp. v. Pelikan, Inc., 784 F. Supp. 452, 461, 465 (M.D. Tenn. 1992), aff'd, 1 F.3d 1252 (Fed. Cir. 1993 (unpublished)) (criticizing Wells and Gerber Garment)

“In support of this argument, Pelikan primarily relies, as it did in its motion for summary judgment, on Wells Manufacturing Corp. v. Littlefuse, Inc., 547 F.2d 346 (7th Cir. 1976) and Shure Brothers, Inc. v. Korvettes, Inc., 198 U.S.P.Q. (BNA) 283 (N.D. Ill. 1978), two cases which predate the creation of the Federal Circuit. After reviewing Wells Manufacturing, Shure Brothers, Stencel, and the other cases cited by the parties, the Court remains convinced that, based on its interpretation of Stencel, **'[p]atentability can be predicated upon how a claimed item mates with another item without claiming the combination of the two items.'** Smith Corona's memorandum in opposition to summary judgment motion (filed December 19, 1990; Docket Entry No. 47), p. 23 (emphasis in original).

* * * *

Accordingly, the Court finds that **the proper construction of claims 11-15 in the '171 patent is to the ribbon cassette alone**, and that its instruction to the jury on this issue was a correct statement of law.”

Preambles for Replaceable Component Claims:

Lifescan, Inc. v. Polymer Technology Int'l Corp., 35 U.S.P.Q.2d 1225, 1228-29, (W.D. Wa. 1995)

“Mention of the meter in which the strip is used serves to describe certain strip features, not to describe a combination of strip and meter. **The mention of the meter apparatus in the first sentence of claim 1 serves to identify the environment in which the strip will be used, not to create a claim to the method of determining glucose levels in blood or to the combination of strip and meter.** See e.g., Smith Corona Corp. v. Pelikan, Inc., 784 F. Supp. 452, 463 (M.D. Tenn. 1992), *aff'd*, 1 F.3d 1252 (Fed. Cir. 1993); see also In re Stencel, 828 F.2d 751, 754-55 (Fed. Cir. 1987).”

“Therefore, after reviewing the claim language, the patent specification, the prosecution history, the expert deposition testimony submitted, and the prior art, the court has determined that the proper meaning or interpretation of the '468 patent is that it is directed to the test strips per se, rather than to a method or combination of strip and meter. Additionally, the '468 patent claims refer to the strips themselves and are not limited to the strips when in the apparatus, with whole blood upon them....”

Preambles for Replaceable Component Claims:

GCC International relied on cases reaching contrary outcomes.

Bicon, Inc. v. Straumann Co., 441 F.3d 945 (Fed. Cir. 2006)

“Despite the fact that the claim begins with a reference to the emergence cuff alone, the full text of the claim, read in the context of the entire patent, indicates that **the claimed invention is the combination of the emergence cuff and the abutment**, operating together in the fashion recited in the claim and described in the specification.”

Gerber Garment Tech., Inc. v. Lectra Systems, Inc., 916 F.2d 683, 688-89 (Fed. Cir. 1990)

“That 'a tool in the form of a cutting blade' appears in the preamble of claim 15 is not determinative of whether it is a claim limitation. See Corning Glass Works v. Sumitomo Elec., Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). Where words in the preamble 'are necessary to give meaning to the claim and properly define the invention,' they are deemed limitations of the claim. Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir.), cert. denied, 469 U.S. 857, 105 S.Ct. 187, 83 L.Ed.2d 120 (1984); see Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 866, 228 USPQ 90, 92 (Fed. Cir. 1985).”

Preambles for Replaceable Component Claims:

Gerber Garment, cont'd

“The cutting blade is 'necessary to give meaning' to claims 15 and 16 and 'properly define the invention.' Perkin-Elmer, 732 F.2d at 896, 221 USPQ at 675. **The cutting blade appears not only in the preamble, but is referenced repeatedly in the body of the claim. It is integral to the claim itself.** Moreover, Gerber's Remarks accompanying a May 7, 1973 amendment referred to the cutting blade as a limitation of claim 15 and relied on the cutting blade penetration of the support means to distinguish the prior art. Hence the cutting blade is not merely an aspect of the claim environment, but an affirmative limitation of claim 15. Claim 16 depends from claim 15 and thus incorporates all the limitations of that claim.”

Wells Mfg. Corp. v. Littelfuse, Inc., 547 F.2d 346, 353-54 (7th Cir. 1976) (Jepson claim)

“Claim 1 of the Raab patent follows the format set forth in Rule 75(e). Thus, Rule 75(e) and the Patent Office Guidelines indicate that the preamble of claim 1 of the Raab patent contains 'elements of the claimed combination which are old.’”

Preambles for Replaceable Component Claims:

Wells Mfg, cont'd

Numerous cases have held that the preamble portion of Ex Parte Jepson Type Claims form part of the patented combination.... Jepson Type Claims have been regarded in some cases as consistently defining a combination including the old structure set forth in the preamble.... In other cases, the determination of whether elements in the preamble are considered to be part of the patented invention depends upon whether the preamble is necessary to give life and meaning and vitality to the claims or counts.... (citations omitted).

The preamble in claim 1 of the Raab patent states more than the purpose or intended use of the switch mechanism. First, the function of the various elements of the switch mechanism can be understood only with reference to the interrelationship of the elements to the link members. In addition, the inventive quality of the switch mechanism in part arises from the positioning of the elements of the switch mechanism with reference to the link members. Thus, **the portion of the claim following 'the improvement comprising' depends on at least the link members in the preamble for a description of the complete structure essential to the functioning of the switch device.** Without determining whether all of the elements recited in the preamble are part of the structure of the patented combination, at least the link members are necessary to give life, meaning and vitality to the claim.”

Preambles for Replaceable Component Claims:

Why did GCC International's defenses depend on having claim 58 construed to include the image forming apparatus?

GCC International argued that since claim 58 covered the main apparatus and cartridge, replacing a spent cartridge was a permissible repair of the entire combination. GCC International relied on Everpure, Inc. v. Cuno, Inc., 875 F.2d 300, 302-03 (Fed. Cir. 1989) as holding the replacement of a spent filter was a permissible repair of the patented combination of a head and the filter.

Preambles for Replaceable Component Claims:

The Doctrine of Permissible Repair

- Permissible repair is an affirmative defense to a charge of infringement. Contrast repairs for ordinary wear to reconstruction of a fully-worn combination.
- To rely on this defense, the activity by the defendant must not be so substantial as to make a new article.
- For the permissible repair defense to apply, the patentholder must exhaust its patent rights to the article through the "first sale doctrine". Exhaustion only occurs where an article is sold with the authority of the patent owner. Infringing products first sold abroad and brought into the U.S. by the buyer would not be subject to exhaustion, and so the permissible repair defense would not be available. Patent exhaustion is the subject of a case now pending before the U.S. Supreme Court which could change the current law as set out by the Federal Circuit (Quanta Computer, Inc. v. LG Electronics, Inc.)

Preambles for Replaceable Component Claims:

The Doctrine of Implied License

- Implied license is an affirmative defense to a charge of infringement.
- The purchaser of a patented article receives an implied license to sell and use that article, and also to repair the article so that it will function properly. The purchaser also receives an implied license under any of the seller's patents that cover the article, and any reasonably contemplated uses for that article (see Hewlett-Packard Co. v. Repeat-O-Type Stencil, 123 F.3d 1445 (Fed. Cir. 1997)).

Preambles for Replaceable Component Claims:

Taking the case as a whole, Canon v. GCC International suggests that the Federal Circuit will continue to allow an applicant to define a replaceable component with reference to the main apparatus in which the replaceable component is used, without treating the claim as a combination claim requiring both the replaceable component and the main apparatus.

It will be interesting to see if the final decision in Canon v. GCC International addresses the issue of defining a replaceable component with reference to the main apparatus in which that replaceable component is to be used.

Preambles for Replaceable Component Claims:

Practice Reminders

- Can a replaceable component be claimed without any reference to the main apparatus in which it will be used?
- If the reference to the main apparatus is required, recite only the necessary structure of the main apparatus in the claim preamble.
- Consider a claim to the combination of the main apparatus and the replaceable component, but only if there are claims to the replaceable component itself.

Preambles for Replaceable Component Claims:

- Use "said" and "the" to distinguish parts of the claimed component from parts of the main apparatus (environment) in which it is to be used. For example:

An ink cartridge mountable in a printer having an ink supply needle, comprising:
a body portion having a bottom wall;
a supply port disposed on said bottom wall,
said supply port being shaped to receive the ink supply needle when said ink cartridge is mounted to the printer...

- In remarks, take care to refer to the invention as the replaceable component; be cautious when referring to the main apparatus.

Preambles for Replaceable Component Claims:

Thank You!

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