



Morgan Lewis

IP WEBINAR SERIES

BETTER SAFE THAN SORRY

Preamble

March 13 |

Jitsuro Morishita

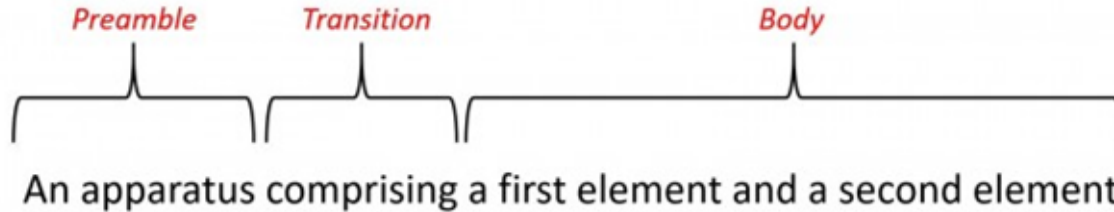
jitsuro.morishita@morganlewis.com



Morgan Lewis

PREABLE

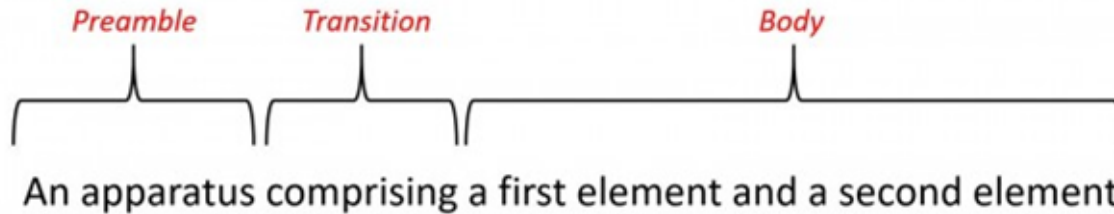
Preamble as claim limitation



Generally, the preamble **is not used to define the scope of the invention** but rather it is the body of the claim that serves that function.

However, when the preamble is relied upon to define the claimed invention, it will be construed as a limitation.

Transition Word

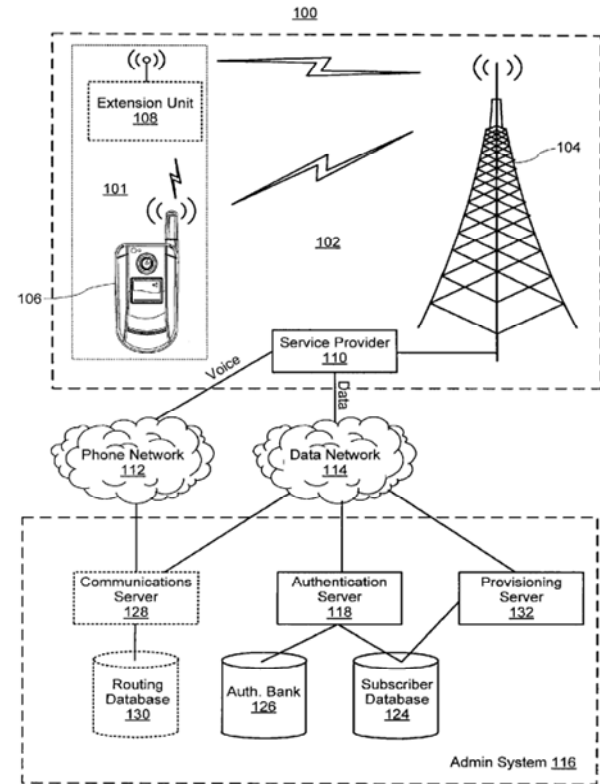


- Comprising, Having, Including (Open-ended)
- Consisting of (Closed-ended)
- Consisting essentially of (Hybrid)

*No transition does not mean no preamble. Omitting of transition word is not recommended.

Preamble as claim limitation

A preamble limits the invention if it recites an **essential structure or step** or is necessary to give **life, meaning, and vitality** to the claim.



SIMO Holds. v. H.K. uCloudlink Network Tech. (Fed. Cir. 2021)

8. A wireless communication client or extension unit **comprising** a plurality of memory, processors, programs, communication circuitry, authentication data stored on a subscribed identify module (SIM) card and/or in memory and **non-local calls database**, at least one of the plurality of programs stored in the memory comprises instructions executable by at least one of the plurality of processors for:

- enabling** an initial setting of the wireless communication client or the extension unit and a remote administration system;

- establishing** a data communication link to transmit information among the wireless communication client or the extension unit, and the remote administration system;

- establishing** a local authentication information request in response to a local authentication request by a local cellular communication network, wherein the local authentication information request comprises information regarding the local authentication request for local authentication information received by the foreign wireless communication client or the extension unit from the local cellular communication network, and wherein the data communication link is distinct from the local cellular communication network;

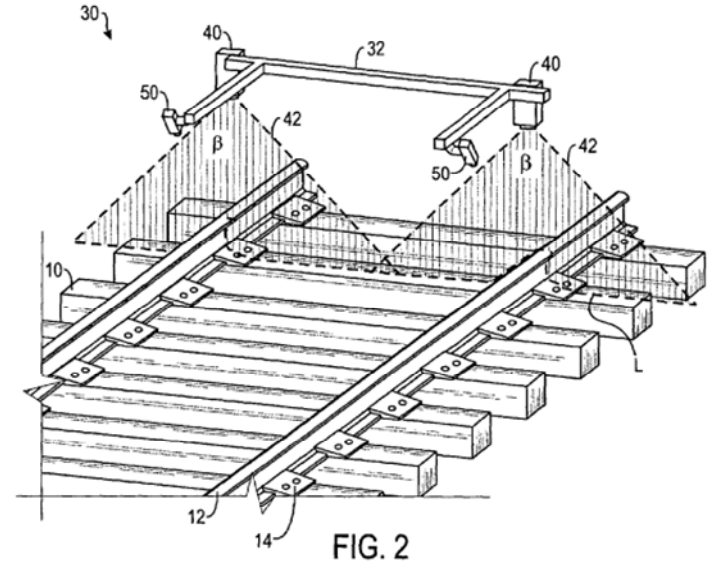
- relaying** the local authentication information request to the remote administration system via the data communication link and obtaining suitable local authentication information from the remote administration system via the data communication link;

- establishing** local wireless services provided by the local cellular communication network to the wireless communication client or the extension unit by sending the local authentication information obtained from the remote administration system to the local cellular communication network over signal link; and

- providing** a communication service to the wireless communication client or the extension unit according to the established local wireless services.

Preamble as claim limitation

If the preamble recites **additional structure or steps that are part of the invention**, the preamble may operate as a claim limitation.



Georgetown Rail Equip. Co. v. Holland LP, (Fed. Cir. 2017)

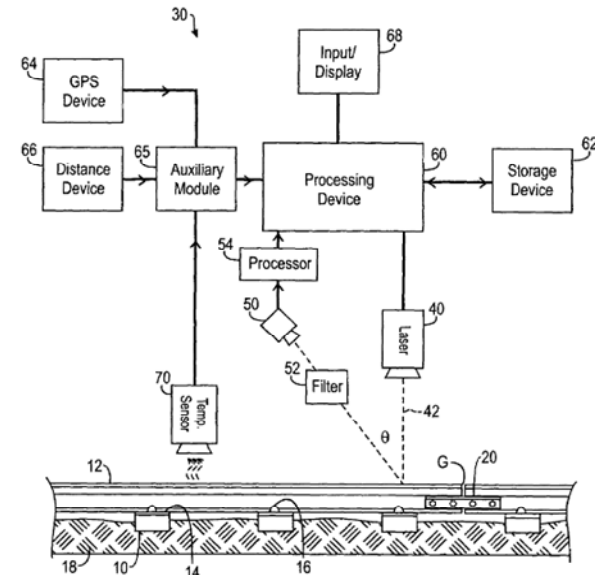
16. A system for inspecting a railroad track bed, including the railroad track, **to be mounted on a vehicle for movement along the railroad track**, the system comprising:

at least one light generator...;

at least one optical receiver...; and

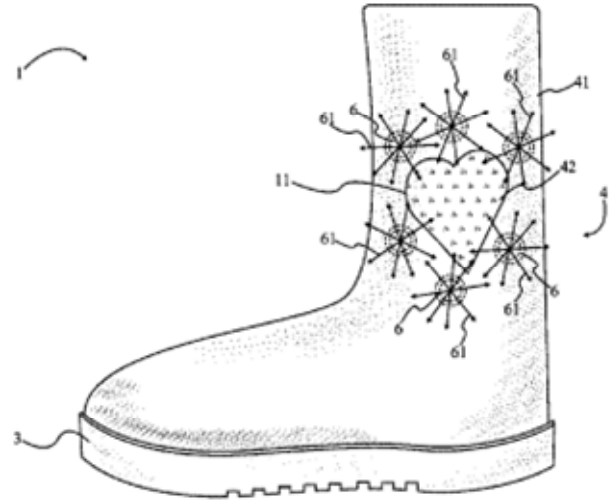
at least one processor ... the algorithm comprising the steps of:

- (a) analyzing ...;
- (b) determining ...;
- (c) if a tie plate is present, determining ...;
- (d) comparing...; and
- (e) determining...



Preamble as claim limitation

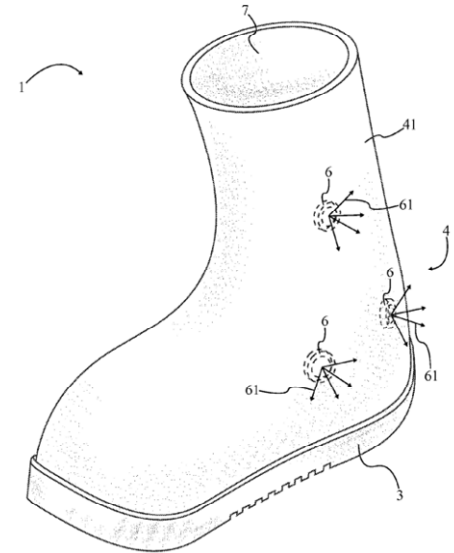
When limitations in the body of the claim **rely upon and derive antecedent basis** from the preamble, then the preamble may act as a necessary component of the claimed invention.



Shoes by Firebug LLC v. Stride Rite Children's Gr., (Fed. Cir. 2020)

1. An internally illuminated textile footwear comprises:

- a sole and an upper;
- an illumination system;
- the illumination system comprises a power source and a plurality of illumination sources;
- a liner;
- an interfacing layer;
- the interfacing layer being adjacently connected to the upper;
- the interfacing layer being positioned between the liner and the upper;
- the plurality of illumination sources being adjacently connected to the interfacing layer;
- the plurality of illumination sources being positioned between the interfacing layer and the upper;
- the upper being perimetrically connected to the sole;
- the liner being positioned interior to the upper;
- the upper being a light diffusing section;
- the illumination system being housed within **the footwear**; and
- the plurality of illumination sources emitting light, wherein the light enters the light diffusing section, then exits the upper as diffused light, creating a visual impression of internal radiant illumination across an outer surface of the upper.



Shoes by Firebug LLC v. Stride Rite Children's Gr., (Fed. Cir. 2020)

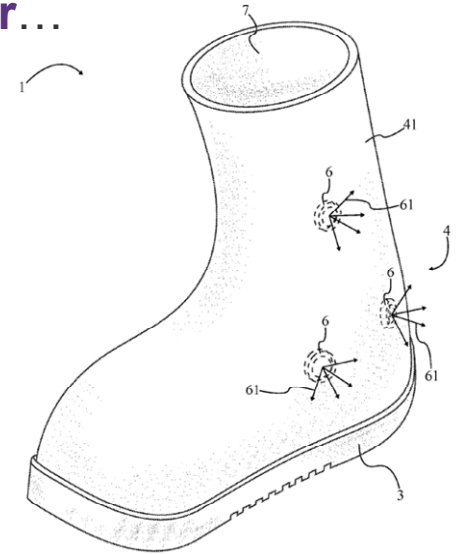
1. An internally illuminated textile footwear comprises:

• • •

the illumination system being housed within **the footwear**...

Preamble may not be divided into separate portions but **must be read together as a whole**.

The court **may not** give limiting effects to some terms in the preamble **but not** give limiting effects to other terms.

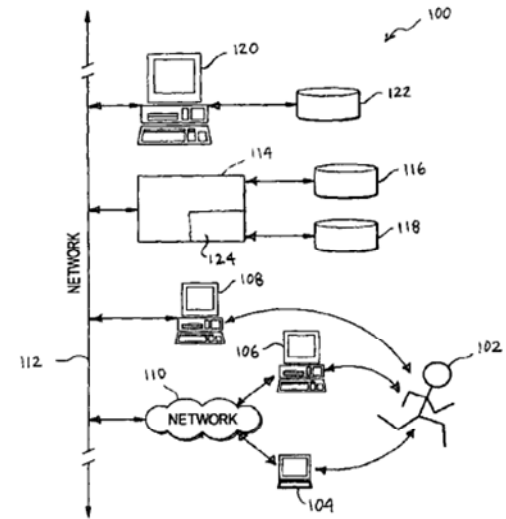


Pacing Techs. v. Garmin International (Fed. Cir. 2015)

25. A repetitive motion pacing system for pacing a user comprising:

a web site adapted to allowing the user to pre-select from a set of user-selectable activity types an activity they wish to perform and entering one or more target tempo or target pace values corresponding to the activity...

28. The repetitive motion pacing system of claim 25, wherein the repetitive motion pacing system can determine a geographic location of the data storage and playback device.



Preamble as claim limitation

If a patent applicant “clearly relies” on the preamble to distinguish its invention from the prior art, the preamble may limit the claim scope.

The claim preamble may be a factor to consider when deciding patent eligibility under section 101.



Morgan Lewis

JUDICIARY

United States Supreme Court



Article III Section 1: The judicial Power of the United States, shall be vested in one supreme Court, and in such inferior Courts as the Congress may from time to time ordain and establish. The Judges, both of the supreme and inferior Courts, **shall hold their Offices during good Behaviour**, and shall, at stated Times, receive for their Services a **Compensation which shall not be diminished** during their Continuance in Office.

Court System: Supreme Court



Justice Thomas (72)



Justice Breyer (82)



Chief Justice Roberts (66)



Justice Sotomayor (67)



Justice Gorsuch (54)



Justice Ketanji Brown (52)



Justice Souter (81)



Justice Ginsburg (87)



Justice Alito (70)



Justice Kagan (61)



Justice Kavanaugh (56)



Justice Barrett (49)

Morgan Lewis

Controversial U.S. Supreme Court Cases

Brown v. Board of Education (1954)

- Holding **segregation of schools** unconstitutional

Loving v. Virginia (1967)

- Holding racial integrity law that forbade **interracial marriage** unconstitutional

***Roe v. Wade* (1973)**

- Holding women's rights to **abortion** based on their right to privacy

Nat. Fed. of Independent Business v. Sebelius, Secretary of Health and Human Services (2010)

- Holding **Obama Care** to be constitutional

Obergefell v. Hodges (2015)

- Holding all states to legalize **same-sex marriages**

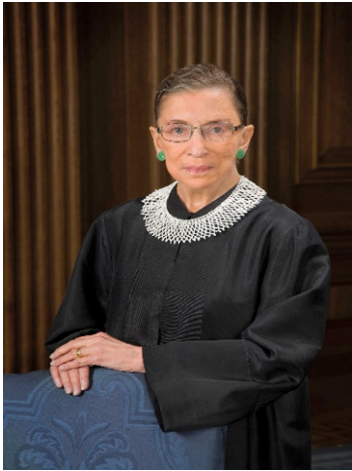
Students for Fair Admissions, Inc. v. University of North Carolina (2023?)

- Whether **Affirmative Action** is constitutional

Decease of Justice Scalia in Feb. 2016



Decease of Justice Ginsburg in Sep. 2020



Roe v. Wade



World ▾ Business ▾ Legal ▾ Markets ▾ More ▾



United States



7 minute read · June 28, 2022 3:53 AM GMT+9 · Last Updated 8 months ago



U.S. Supreme Court overturns Roe v. Wade, ends constitutional right to abortion

By Lawrence Hurley and Andrew Chung

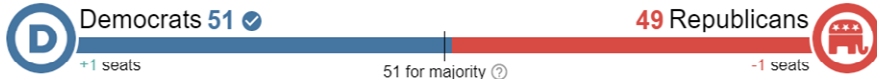
Morgan Lewis



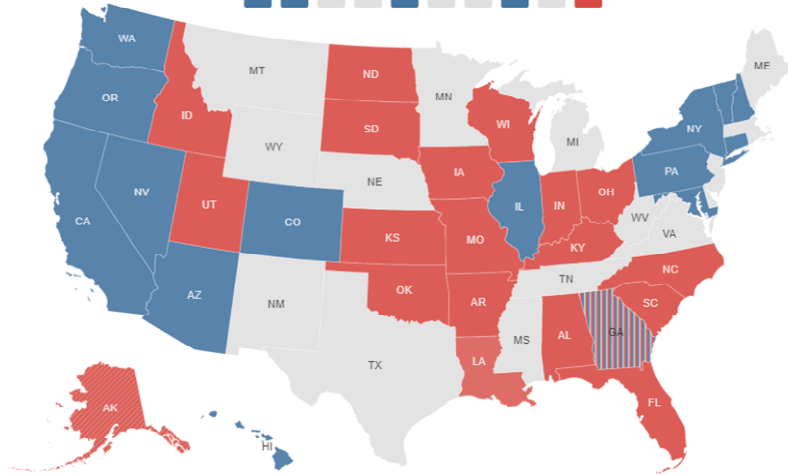
2022 Mid-Term Election

2022 Senate Results

Last updated: 2/20/2023, 11:14:58 AM

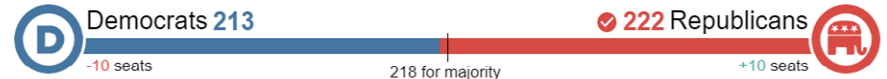


Tap a state below for detailed results

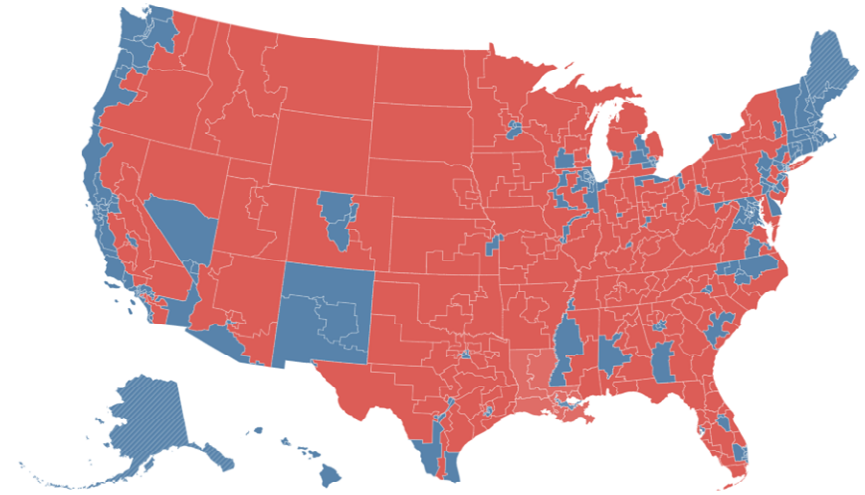


2022 House Results

Last updated: 2/20/2023, 11:15:31 AM



Tap a state below for detailed results



IP Webinar Series: Better Safe than Sorry 2023

- No. 1: Important IP Cases (2023.01.23)
- No. 2: Preamble (2023.03.13)
- No. 3: A-C Privilege (2023.05.22)**
- No. 4: Means Plus Function (2023.07.24)
- No. 5: Extraterritorial Activity (2023.09.25)
- No. 6: US Litigation Basics (2023.11.20)



THANK YOU

© 2023 Morgan, Lewis & Bockius LLP
© 2023 Morgan Lewis Stamford LLC
© 2023 Morgan, Lewis & Bockius UK LLP

Morgan, Lewis & Bockius UK LLP is a limited liability partnership registered in England and Wales under number OC378797 and is a law firm authorised and regulated by the Solicitors Regulation Authority. The SRA authorisation number is 615176.

Our Beijing and Shanghai offices operate as representative offices of Morgan, Lewis & Bockius LLP. In Hong Kong, Morgan, Lewis & Bockius is a separate Hong Kong general partnership registered with The Law Society of Hong Kong. Morgan Lewis Stamford LLC is a Singapore law corporation affiliated with Morgan, Lewis & Bockius LLP.

This material is provided for your convenience and does not constitute legal advice or create an attorney-client relationship. Prior results do not guarantee similar outcomes. Attorney Advertising.



Biography



Partner

Tokyo: 03-4578-2530

Mobile: 070-1498-0066

Jitsuro.morishita@morganlewis.com

Jitsuro Morishita devotes his practice to resolving complex global disputes in the areas of intellectual property, antitrust, governmental investigations, environmental issues, and labor.

Early in his career, he worked in-house for two global technology companies, Pioneer Corporation and Fujifilm Corporation, bringing unique expertise to advocate using profound understanding of Japanese company cultures.

Jitsuro is devoted to bringing his clients (i) easy communication using excellent communication skills, (ii) pleasant surprises from creative and out-of-the-box ways of thinking, and (iii) deep satisfaction through great results and client-friendly experiences.