
The Claim Construction Game™

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Edward D. Manzo

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General

1. Statute: “and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification ...” 35 U.S.C. Section 112. This applies only sometimes (in means + function or step + acts) claim elements. The U.S. does not have a general claim interpretation statute, unlike the EPC, the EAPC, and many foreign countries.
2. Whether Claim Construction is Needed. Claim construction is required in order to decide whether the claim recites statutory subject matter. *In re Nuijten* (2007) – Court had to construe a claim concerning a “signal” before deciding whether the claim recites statutory subject matter.
3. Claim construction is relevant to determining whether there has been a best mode determination. *AllVoice Computing v. Nuance Commc’ns, Inc.*, 504 F.3d 1236, 1241 (Fed. Cir. 2007) reversed a finding that the best mode was not disclosed. The D.Ct. improperly assumed that additional functions were present in a means-plus-function clause. When the claim was properly construed, there was no best mode violation.
4. Preliminary Injunction: Claim construction is needed before imposing a preliminary injunction in a patent case. *Chamberlain Group v. Lear Corp.*, 516 F.3d 1331, 1340 (2008) (“a correct claim construction is almost always a prerequisite for imposition of a preliminary injunction.”)
5. General Rules. Whether a claim construction renders a claimed invention inoperable is: generally viewed with skepticism. *Cordis v. Medtronic*, 511 F.3d 1157, 1174 (2008).
6. Each word in a claim is presumed to have meaning. *Foremost In Packaging Sys. v. Cold Chain Technologies*, 485 F.3d 1153 (2007); *In re Gabapentin Patent Litigation*, 503 F.3d 1254, (2007); *Stumbo v. Eastman Outdoors, Inc.*, --- F.3d ----, 2007 WL 4180137 (2007); Court rejected patentee's proffered construction, in part because that construction would render some of the claim language superfluous. *Bicon v. Straumann*, 441 F.3d at 950 (2006).
7. In patent claims, different words (presumptively) have different meanings. *Acumed LLC v. Stryker Corp.*, 483 F.3d 800, 807 (2007); *NMT Medical Inc. v. Cardia, Inc.*, 2007 U.S. App. LEXIS 13466 (2007); *Central Admixture Pharmacy Services v. Advanced Cardiac Solutions*, 482 F. 3d 1347 (2007); *Logan v. Hormel Foods*, 217 Fed. Appx. 992, 2007 WL 200942 (2007) (non-precedential); *Microstrategy Inc. v. Businessobjects Americas*, 2007 WL 1842701 at *4

(2007) (non-precedential); *Applied Medical Resources v. U.S. Surgical* (2006). However, even though different words may be used, they are not given different meanings where the words are used synonymously. *Semitoool v. Dynamic Microsystems* (2006).

8. The word “conventional” in a patent claim has to be construed as of the filing date of the patent. *PC Connector v. Smartdisk* (2005).

9. When a claim says a structure *may* have certain characteristics, that is *not* a limitation on the claim. As a matter of linguistics, optional elements do not narrow the claim because they can always be omitted. *In re Johnston*, 435 F.3d 1381, 1384 (Fed. Cir. 2006).

Nature of Claim

10. Independent or Not? A claim 4 in a patent provides: “A process comprising obtaining progeny from a ... plant *obtained by the process of claim 1* which comprises said DNA.” Where claim 1 does not call for obtaining progeny, claim 4 is dependent and requires performance of all steps of claims 1 and 4 to be infringed.: *Monsanto v. Syngenta* (2007).

PTO

11. PTO Claim Interpretations. A claim element calls for a “flexible polyurethane foam reaction mixture.” The PTO erroneously rejected the claim as anticipated by prior art that has a rigid foam, explaining that when crushed, it becomes flexible (like crushing a rock into sand). *In re Buszard*, Sept. 27, 2007: “No matter how broadly ‘flexible foam reaction mixture’ is construed, it is not a rigid foam reaction mixture.” It is unreasonable to equate flexible with rigid.

Preambles

12. The recitals of a preamble limit claim scope when they are necessary to breathe life and meaning into the claim. *Kropa v. Robie* (1951).

13. The recitals of the preamble do *not* limit the scope of the claim when the body of the claim sets out the complete invention. *See Eaton v. Rockwell* (2003).

14. Current case rulings don’t always decide whether the preamble language breathes life or meaning into the claim. In *Kim v. ConAgra* (2006), preamble language imposed a functional limitation in a composition claim. No discussion whether the preamble gave life, meaning, or vitality to the claim. Instead, the Court focused on the specification and based its ruling on *Phillips*, as claims “must be read in view of the specification, of which they are a part.” *Accord, Bass Pro Trademarks v. Cabela’s* (2007) and *MBO v. Becton Dickinson* (2007).

15. It is unclear whether *Kropa v. Robie*, 38 C.C.P.A. 858, 187 F.2d 150, 152 (CCPA 1951) is still the law. No *en banc* case has reversed it, unless *Phillips* did so *sub silentio*.

16. Transition Phrases. When a claim sets forth a method “comprising the steps of” plural elements, the elements can properly be construed to mean producing ONLY what the claim elements recite. *Dippin’ Dots v. Mosey* (2007), stating : “freezing ... into beads” as a claim element means freezing into beads *and only beads*,” and “The presumption raised by the term ‘comprising’ does not reach into each of the ... steps to render every word and phrase therein open-ended – especially where the patentee has narrowly defined the claim term ...”

17. The D.Ct. incorrectly construed “comprised of” in a preamble (“...unique authorized information ... *comprised of* machine-readable code elements coded according to a detectable

series, the system comprising...”) as a closed end term. *CIAS v. Alliance Gaming* (2007) (“comprised of” is an open-ended term, like “comprising”).

Method Claims

18. **Sequences of Steps.** In a patent on a system performing a method, even where the claims do not specify the sequence of steps, the claims can be properly construed to allow for only the sequence in the specification. *Automed v. Knapp Logistics* (2007). Another relevant fact in this case, however, is that in a reissue appl’n, the patentee sought to add “before or after” to one of the steps in the claim. The Examiner called this new matter, and the patentee withdrew the amendment.

19. Steps in a method claim do not have to be performed in the order in which they are recited, i.e., they can be performed in a different order and still be within the (literal) scope of the claim. *Cybersettle, Inc. v. National Arbitration Forum, Inc.*, 2007 WL 2112787, *6 (Fed.Cir.2007) (non-precedential).

Routine Claim Terms

20. “A” and “an” generally mean “one or more” in a patent claim, unless the context indicates otherwise. “The general rule does not apply when the context clearly evidences that the usage is limited to the singular.” *Tivo v. Echostar*, 516 F.3d 1290 (2008) (claims and written description make clear that singular meaning applies). That “a” or “an” means one or more “is best described as a rule.” *Baldwin Graphic Syst.v. Siebert*, 512 F.3d 1338 (2008).

21. In a patent claim, “a” can mean “each and every.” In *CAT Tech. v. Tubemaster*, 528 F.3d 871 (2008), one patent called for “a spacing between adjacent plates having a width not greater than the smallest dimension of a single particle ...” If that language were satisfied by a single point, it would defeat the whole purpose of the invention and make no sense. Judge Mayer called this “semantic antics.”

22. “a” or “an” followed by “said”: When the Court recently said, “Because the initial phrase carries no definitive numerosity, the anaphoric phrases do not alter that meaning in the slightest,” it meant the later phrase takes on the numerical value of its antecedent one. The word “said” in a claim does not imply that the structure is plural when the earlier antecedent did not say. “a” or “an” means one or more and referring to the structure later in the claim as “said [structure]” does not restrict it to singular. *Baldwin Graphic Systems, Inc. v. Siebert, Inc.*, 512 F.3d 1338 (2008) -- Referring to a phrase [“a pre-soaked fabric roll ...”] later in the claim with “said” does not mean that it was singular to begin with.

Established Meaning

23. Where a specification and file history showed that when a claim used the word “heading” of an aircraft, it really meant its “bearing” (Note that “bearing” and “heading” mean distinctly different things in navigation). The Court allowed the patentee to be a lexicographer and read “heading” as “bearing.” *Honeywell Intl v. Universal Avionics Sys.* 493 F.3d 1358 (2007).

Claim Differentiation.

24. Claim differentiation raises a presumption that an independent claim should not be construed as requiring a limitation added by a dependent claim. “Thus, the claim differentiation tool works best in the relationship between independent and dependent claims.” However, claim differentiation does not mean that an independent claim is ALWAYS broader than a dependent

claim that adds language to it. Claim differentiation will not be applied to construe claims more broadly than the specification indicates. *Curtiss-Wright v. Velan* (2006); *Black & Decker v. Rob't Bosch*, 260 Fed.Appx., 2008 WL 60501 (2008); *Regents of Univ. of California v. Dakocytomation*, 517 F.3d 1364 (2008).

25. Also, claim differentiation is "a limited tool" that alone will not support a claim construction at odds with the specification. *Id.*

Effects of the Specification

26. Claims can be broadly construed because it is improper to import details from the specification. When examining the specification for context, the Court "will not at any time import limitations from the specification into the claims." *Varco v. Pason Systems*, 436 F.3d at 1373 (2006).

27. On the other hand, claims cannot be construed more broadly than the invention described in the specification. While "claims need not be limited to the preferred embodiment when the invention is more broadly described, 'neither do the claims enlarge what is patented beyond what the inventor has described as the invention.'" *Inpro II v. T-Mobile*, 450 F.3d 1350, 1355 (2006).

28. Indeed, Claims can be narrowly construed because the inventor is not entitled to a broad claim meaning divorced from the context of the specification. *Outside the Box v. Travel Caddy*, 260 Fed.Appx. 316, 2008 WL 145247 (2008) (written description + drawings do not support broad interpretation of "between"); *Old Town Canoe v. Confluence* (2006). The Court will not construe claims to cover subject matter broader than what the patentee described in its specification, regarded as comprising its invention. *Ventana Medical Sys. v. BioGenex*, 473 F.3d 1173 (2006).

29. A statement in the specification describing the "present invention" limits the scope of the claims. In *Verizon v. Vonage* (2007), the majority found that statements in the "Disclosure of the Invention" portion of the specification limited the scope of the claim phrase "localized wireless gateway system" to one that performs compression and packetization functions at the gateway.

30. Disparaging Prior Art in the Specification. In a patent specification, disparaging certain approaches to solving a problem is not irrelevant. The claims were narrowly construed in *Honeywell Intl. v. ITT Indus.* (2006) to exclude because the prior art that the inventor disparaged or demeaned.

31. Specification Examples. Sometimes specification examples matter. Claims were narrowly construed when all of the preferred embodiments had a common, narrow feature. *Aquatex v. Technische Solutions*, 419 F.3d 1374 (2005).

32. It is *not* always proper to construe claim language to comport with the specification examples. *Acumed v. Stryker* (2007) (improper to import details from the preferred embodiment into the claims as a limitation); *Verizon v. Vonage* (2007).

33. A claim recites a phrase broadly in claim 1, without using a Markush group. However, the specification describes that phrase in terms of a Markush group. The phrase in claim 1 is *not* limited to the Markush group of the specification. *Abbott v. Andrx*, 473 F.3d 1196, 1210 (2007)

34. Lexicography. When a patent specification recites that a phrase (used in the specification) "is" something, that signifies that the patentee *may* be serving as lexicographer. *Abbott v. Andrx*, 473 F.3d 1196, 1210 (2007).

35. Excluding Preferred Embodiments. Construing a claim so it does not read on the preferred embodiment is usually wrong. As a general rule, the Court has a strong preference not to exclude a preferred embodiment from a claim construction. *Primos v. Hunter's Specialties*, 451 F.3d 841, 849 (2006); *Verizon v. Vonage* (Sept. 26, 2007). Exceptions exist:

- a. a claim may be construed to exclude the preferred embodiment where the language of the claim is clear, as courts will not rewrite a claim to say what the inventor really meant to say, even when the error and the correct meaning are evident. *Chef America v. Lamb-Weston*, 358 F.3d 1371 (Fed. Cir. 2004); see also *Helmsderfer v. Bobrick*, 527 F.3d 1379 (2008).
- b. a claim need not cover *all* embodiments, as a patentee may draft different claims to cover different embodiments. *Intamin v. Magnetar Tech.* (2007) ; *Helmsderfer, supra*; *General Atomics Diazyme v. Axis-Shield*, 2008 WL 2019490 (2008).

Prosecution History

36. Disavowals. A disavowal may occur even *after* a patent issues. In *Verizon v. Vonage* (2007), the Court found a clear and unambiguous disavowal of scope (of the term “wireless”) in the later prosecution of the parent application – which was still pending after the divisional application issued and became the 880 patent-in-suit.

37. A disavowal can occur without an amendment to claim language. *Cordis v. Medtronic*, 511 F.3d 1157 (2008) (can have a binding disavowal through argument).

38. The test for whether a disavowal has occurred is whether a competitor would reasonably believe an applicant had surrendered the relevant subject matter. *Cordis v. Medtronic, id.* citing *Cybor* (en banc).

39. Prosecution disclaimer does not apply to an ambiguous disavowal, and prosecution disclaimer does not apply if an applicant simply describes features of the prior art and does not distinguish the claimed invention based on those features. *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366 (2008).

40. Rescission/Recapture. Facts: (1) In a parent prosecution, the patentee explained that the prior art fails to provide a combination of 2 elements, one being a slit. All claims were then allowed. (2) A continuation amended the claim to broaden “slit” to “opening.” An attorney letter with the CTN application referred to this broadening. The examiner then allowed all claims without comment.

- a. The court properly construed the claim to require not just *any* opening, but a slit. “The district court correctly ruled that the word ‘opening’ is not correctly construed to eliminate the ... mechanism provided by the slitted diaphragm.” Any rescission of a prosecution disclaimer “must be sufficiently clear to inform the examiner that the previous disclaimer, and the prior art that it was made to avoid, may need to be revisited.” Otherwise, the law prohibits recapture of surrendered scope. *Hakim v. Cannon Avent Gp.*, 479 F.3d 1313, 1317-18 (2007).

41. In a parent patent, to overcome prior art, the applicant narrowed a claim element “arranging ...” by adding “... by reducing the distance [to a range of values] ...” It repeatedly argued the range and eventually overcame the rejection. The CAFC called this a clear, unmistakable disclaimer. A divisional patent issued with substantially the same “arranging” language but

without the range. The divisional patent claim was limited to the range in *Heuft v. Industrial Dynamics*, 2008 WL 2518562 (2008).

Prior Art

42. **Validity over prior art.** The Court will not construe claims narrowly to avoid prior art when the claim is not ambiguous. See *SmithKline Beecham v. Apotex* (2004) and (2005); *Phillips (en banc)*. Claims should not usually be construed with a view to making them valid over the prior art, as validity is not a primary concern when construing claims. “Claim construction should not, of course, be blind to validity issues: ‘claims should be so construed, if possible, as to sustain their validity.’” [citation omitted] However, validity construction should be used as a LAST RESORT, not a first principle. *MBO v. Becton Dickinson* (2007)

112-6 Claims

43. **Clear Linking and 112-6.** Clear linking between the specification structure and the means claim language is a non-statutory requirement. Structure in the specification is corresponding structure only if the specification or file history *clearly links* or associates that structure to the function recited in the claim.” *Medical Inst. v. Elekta*, 344 F.3d 1205 (2003); accord, *Biomedino v. Waters Tech.* (2007); *Maurice Mitchell Innov. v. Intel* (2007)

44. A claim is invalid for indefiniteness where the patentee fails to clearly link the “means” to a definite structure. *Biomedino v. Waters Tech.* (2007); *Maurice Mitchell Innovations v. Intel* (2007).

45. **Sufficiency of disclosure:** Fact: The only references in the specification to the “control means” are a box labeled “Control” in Figure 6 and a statement that the regeneration process of the invention “may be controlled automatically by known differential pressure, valving and control equipment.” This is insufficient under 112-6. *Biomedino v. Waters* (2007). A bare statement that known techniques or methods *can* be used is insufficient. Accord, *Maurice Mitchell Innovations v. Intel*: The mere mention of a complicated integrated circuit having hundreds or thousands of circuits is both too broad and not linked to the “means for causing” limitation of the claim. (invalid)

46. **Sufficiency of disclosure:** *Aristocrat Tech. Australia v. Intl Game Technology*, ___ F.3d ___, 2008 WL 819764 (2008), upholding SJ of indefiniteness, ruled that disclosing that when the winning combination is displayed is simply describing the function, not the algorithm by which it is performed. Not a question of whether an algorithm was disclosed with enough specificity for a POSITA to understand; here, none was disclosed at all. One is not required to produce a listing of source code or highly detailed description of the algorithm. What is required is to disclose at least the algorithm that “transforms the general purpose microprocessor to a ‘special purpose computer programmed to perform the disclosed algorithm.’” [citing *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 1349 (Fed. Cir. 1999)]

47. The law does not require corresponding structure to be explicitly identified as long as a POSITA would understand what structure is identified in the specification. *Aristocrat Technologies v. Multimedia Games* 2008 WL 484449 (Feb. 22, 2008) (non precedential): *WMS Gaming v. Intl Game Tech.*, 184 F.3d 1339 (1999) does not stand for the proposition that a particular algorithm must be identified **if the algorithm needed “would be readily apparent” to a POSITA.**

48. Functions and 112-6 Claims. It is NOT true that *all* functions of the corresponding structure belong in the claim construction of a 112-6 means element. Do not import unclaimed functions into a means + function claim element in the claim construction or infringement analysis. Restrict the inquiry to the way that the structure performs the *properly-defined function* and do not be influenced by the manner in which the structure performs other, extraneous functions. *Applied Medical Resources v. U.S. Surgical*, 448 F.3d at 1334 (2006).

49. When a particular mechanism is defined in functional terms, that does NOT convert the claim element containing that term into a means for performing a specified function within the meaning of 112-6. *Trimed v. Stryker*, 514 F.3d 1256, 85 U.S.P.Q.2d 1787 (Fed.Cir. 2008) ruled that “holes... providing means for allowing the pin to slide axially therein but preventing compression ...” is not governed by 112-6, despite the functional language.

Extrinsic Evidence

50. Dictionaries. A district court may properly begin its claim construction by referring to dictionary meanings. *Old Town Canoe v. Confluence* (2006): when D.Ct. began its analysis by referring to dictionary definitions, this “was not an improper attempt to find meaning in the abstract divorced from the context of the intrinsic record but [instead] properly was a starting point in its analysis ...”

51. Some terms are so simple that even a layman can understand them, and in such cases using a dictionary to ascertain meaning is proper. *AGFA v. Creo Prods.* (2006): “... the ordinary meaning of some claim terms may be readily apparent even to lay judges, and claim construction in such cases involves little more than the application of widely accepted meaning of commonly understood words. In such cases, general purpose dictionaries may be helpful. This case falls squarely within those guidelines from *Phillips*.”

52. Dictionary use is not prohibited so long as the ultimate claim construction is grounded in the intrinsic evidence and not based on dictionary definitions in the abstract.. *Mangosoft v. Oracle*, 525 F.3d 1327 (2008) (claim construction outcome consistent with dictionary definition offered by Oracle)

53. Experts. Expert witness testimony on claim meaning may not be received when intrinsic evidence is sufficient. The expert witness testimony regarding claim meaning must be excluded because the intrinsic evidence is sufficient to construe the claim and an expert cannot contradict the intrinsic evidence. *See Inpro II* (2006).

54. An expert need not be permitted to explain how a POSITA would understand the technical details, even though patents are not written for laymen. *Serio-US v. Plastic Recovery*: trial courts have discretion to hear expert testimony on claim construction. Here, the D.Ct. consulted expert testimony only “to provide background on the technology at issue, to explain how an invention works, to ensure that the court’s understanding of the technical aspects of the patent is consistent with that of a [POSITA] , or to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field.”

55. Experts may opine on whether a 112-6 “means” element defines structure. *DePuy v. Medtronic* (2006) affirmed the use of experts for determining whether language in a claim element recites “structure” in context of determining whether §112, ¶6 applies.

56. A party in a claim construction hearing does not have an absolute right to present expert testimony. *Inpro II v. T-Mobile* affirmed a D.Ct. exclusion of expert testimony after limiting the

claim language to the only embodiment disclosed in the specification for the element in question. While expert testimony *may* be heard, the “decision as to the need for and use of experts is within the sound discretion of the district court.”

57. Nevertheless, in some cases, expert witness testimony as to claim meaning is expected by the court. *Verizon v. Vonage*, 503 F.3d 1295, 1303 n.2, (2007) “*** There is nothing in the specification or prosecution history that would compel Vonage's interpretation. Vonage offers no supporting dictionary definition of the term ‘translation.’ Under these circumstances one might have expected Vonage to provide expert testimony that those skilled in the art would understand the term ‘translation’ to have the meaning that Vonage urged.”

58. Indefiniteness: The phrase “fragile gel” used in the claims was challenged as insolubly ambiguous. Even though the court found it was clearly linked to the specification, that did not end the matter because the written description was insufficient, in the Court’s view, to allow a POSITA to translate this into “meaningfully precise claim scope.” *Halliburton v M-I*, 514 F.3d 1244, 1251 (Fed. Cir. 2008).

Procedure

59. A D.Ct. has a duty to construe claim language that is disputed and may not simply leave it to the jury even if the court believes the disputed language has a “well-understood definition” that it thought a jury would understand. *O2 Micro Intern. Ltd. v. Beyond Innovation Technology Co., Ltd.*, 521 F.3d 1351, 1362, 86 U.S.P.Q.2d 1304 (Fed. Cir. 2008): “When the parties present a fundamental dispute regarding the scope of a claim term, it is the court’s duty to resolve it.”

60. Attorneys have a duty to assist the court in claim construction and breaches that duty by not simplifying the case but on the contrary inundating the court with paper and arguments. *LSI Industries, Inc. v. ImagePoint, Inc.* Slip Copy, 2008 WL 2165340 ((Fed. Cir. 2008) (non-precedential).

61. Under CAFC precedent, no deference is owed to a D.Ct. claim construction or to any underlying factual findings predicate to construing the meaning and scope of claims. *Gillespie v. Dywidag* (2007).

62. The background rule re the role of the accused product in claim construction is that a claim is to be construed in light of the claim language and *not in light of the accused device*. *SRI Intl v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1118 (1985) (*en banc*). However, this does NOT mean that the accused product or process should remain unknown to the judge during claim construction. *Exigent v. Atrana* (2006); *Wilson Sporting Goods v. Hillerich*: “... giving meaning to claim terms always takes place in the context of a specific accused infringing device or process. While a trial court should certainly not prejudge the ultimate infringement analysis by construing claims with an aim to include or exclude an accused product or process, knowledge of that product or process provides meaningful context for the first step of the infringement analysis, claim construction.” 442 F.3d at 1326-27, 1330-31. Accord, *Byrne v. Black & Decker Corp.*, 2007 WL 1492101 at *4 (2007) (non-precedential)

63. An argument cannot be made on appeal if it was not properly raised in main argument section of the brief, and only peripherally in footnotes. *Kao v. Unilever* (2006).

64. A claim construction argument cannot be made on appeal if it was not raised in the district court. *Conoco v. Energy* (2006); *Exigent v. Atrana* (2006); *Halliburton* (2008).

65. When a patentee takes inconsistent positions on claim construction in different lawsuits against different, unrelated defendants, judicial estoppel would apply if the patentee's current position is inconsistent with a prevailing position it previously took (and it prevailed). In *Transclean Corp. v. Jiffy Lube Intern., Inc.*, 474 F.3d 1298, 1307 (Fed.Cir.2007), the Court noted "that a party may be judicially estopped from asserting clearly inconsistent positions on claim construction, which is a question of law." See also, *Decisioning.com, Inc. v. Federated Department Stores, Inc.*, 527 F.3d 1300, 1312-13, 86 U.S.P.Q.2d 1769 (Fed. Cir. 2008).

66. No judicial estoppel arises from presenting an argument that a court rejects. See, *LSI Industries v. Imagepoint*, 2008 WL 2165340 at *4 (2008).

67. Claim constructions in jury instructions cannot be challenged on appeal if the appellant failed to object to them before they were given to the jury. *Serio-US Indis. v. Plastic Recovery Technologies* (2006) – except in circuits which has a "futile objection" rule, e.g. CA7. *Cardiac Pacemakers v. St. Jude Medical* (2004). See also, *Andersen v. Fiber* (2007), n.2; *Verizon v. Vonage*, (2007) n.5.

68. The Federal Circuit does not review the claim construction process used by the District Court. *Acumed v. Stryker*, 483 F.3d 800, 809, n.2 (2007) ("We review only the district court's finished product, not its process.")

69. On remand, a pre-*Phillips* (*en banc*) Fed. Cir. claim interpretation is binding on the D.Ct. if it did not adopt the methods of *Phillips*. A claim construction is the law of the case, unless it is in conflict with a subsequent *en banc* or Supreme Court decision. *E-Pass v. 3Com* (2007).

70. It is improper to interpret the Federal Circuit's claim interpretation. "... the terms courts use to enunciate the proper construction of a claim are not themselves limitations that require interpretation." *E-Pass v. 3Com*, 473 F.3d at 1220 (2007).

71. In a suit in D.Ct. between two private parties, the court publishes a claim construction. In a subsequent reexamination of the patent at the USPTO, issue preclusion does not apply, and the PTO can construe the claim independent of the D.Ct. ruling. The PTO is not collaterally estopped as it was not a party to the suit and was not vouched in. *In re Trans Texas Holdings*, 498 F.3d 1290 (Fed. Cir. 2007).

72. In appeals involving patent claim construction, the CAFC affirmed summary judgments of non-infringement in 2007 about 75% of the time. 28 of 38 were affirmed (74%).

Indefiniteness

73. In claim construction, some ambiguity is tolerated. *Acumed v. Stryker*, 483 F.3d 800, 806 (2007): "... a sound claim construction need not always purge every shred of ambiguity. The resolution of some line-drawing problems ... is properly left to the trier of fact. *** There may be some area of imprecision within the district court's ... construction ..."

74. A claim is indefinite if the written description is not clear enough to provide needed specificity. *Halliburton v. M-I*, 514 F.3d 1244 (Fed. Cir. 2008) ("fragile gel" indefinite even though definition is supported by the specification; this "does not end the inquiry" because a POSITA could not "translate the definition into [a] meaningfully precise claim scope.")

75. Even when claim terms can be expressed in words, this alone is not enough for the claim term to be definite: the patent must also inform a POSITA of bounds of the claim, and merely

expressing the claim term in other words may or may not provide those bounds. *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357 (Fed. Cir. 2008):

In and of itself, a reduction of the meaning of a claim term into words is not dispositive of whether the term is definite. *Halliburton Energy Serv., Inc. v. M-I LLC*, 514 F.3d 1244, 1251 (Fed.Cir.2008). And if reasonable efforts at claim construction result in a definition that does not provide sufficient particularity and clarity to inform skilled artisans of the bounds of the claim, the claim is insolubly ambiguous and invalid for indefiniteness. *See id.* at 1249-51.

76. A D.Ct. “may only correct an error in a patent by interpretation of the patent ‘if (1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation of the claims.’” *Fargo Electronics v. IRIS, Ltd.*, 2008 WL 2570822 at *2 (2008), citing *Novo Indus. v. Micro Molds*, 350 F.3d 1348 (2003).

- a. In *Fargo*, multiple reasonable interpretations arose, and they would result in different scope. The D.Ct. would have had to engage in conjecture to select one meaning, and thus could not correct the claim.

Design Patents

77. It is NOT the law that in a design patent, each drawing feature is a feature of the claim construction, and if one is missing from the accused product, there is no infringement. *Amini* (2006): “... the trial court mistakenly analyzed each element separately instead of analyzing the design as a whole from the perspective of an ordinary observer. ... [a] discounting of functional elements must not convert the overall infringement test to an element-by-element comparison.” Note that in *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (1995), the Court found no infringement when two specific individual features of the patented design were absent from the accused product. The Court ruled that the accused product lacked these ornamental features and had a substantially different ornamental appearance. 67 F.3d at 1577-78.

78. Federal Circuit jurisprudence does not prohibit a claim construction of a design patent claim that is highly detailed. See *Arminak v. Saint-Gobain Calmar* (2007) (“our case law does not prohibit detailed claim construction of design patent drawings. It merely disapproves claim construction that goes beyond the novel, nonfunctional ornamental features visually represented by the claimed drawings”; “meticulous and accurate” description of figures not error).

79. The Federal Circuit now dissuades trial courts from verbal descriptions of what the drawings show as their claim constructions. *Egyptian Goddess v. Swisa* (2008, *en banc*).

80. The “point of novelty” for proving design patent infringement no longer applies. *Egyptian Goddess v. Swisa* (2008, *en banc*).

81. Interpreting Certificates of Correction. A certificate of correction can be invalidated without invalidating the patent also. *Central Admixture v. Advanced Cardiac Solutions*, 482 F.3d 1347, 1356 (2007).

82. Even if the claims as interpreted are broadened by the certificate, the certificate not necessarily invalid. To prove invalidity, one must also show that the clerical or typographical error, or how to correct that error, is not clearly evident to one of skill in the art.” *Id.* at 1353.

Claim Construction and Sanctions

83. In deciding whether the case is “exceptional” on a motion to award fees against plaintiff for filing a baseless suit, if claim meaning is disputed the D.Ct. should decide whether (i) plaintiff’s proposed claim meaning is reasonable AND (ii) there is sufficient evidence to justify an infringement contention under that interpretation. *Innovation Technologies v. Splash! Medical Devices*, 528 F.3d 1348 (2008).

84. Where a litigant essentially ignores the claim construction and continues to try the case when it knows it has no legitimate basis to prevail, even if a jury finds for that same party, the court may overturn the verdict and award sanctions against that party and its counsel. *Medtronic Navigation, Inc. v. BrainLAB Medizinische Computersysteme GmbH*, 2008 WL 410413 (D. Colo. 2008).

**Edward D. Manzo
Cook Alex Ltd.
200 W. Adams Street
Suite 2850
Chicago, IL 60606**

**312-236-8500
www.CookAlex.com
emanzo@cookalex.com**