



Patent Claim Construction

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2008 Status

- In 2006-08, the Fed. Cir. implemented its pronouncements in *Phillips (2005, en banc)*.
- The predictability of claim constructions has slightly improved from *pre-Phillips* era but is still a problem.
- The battle of dictionaries ended; we refer mainly to the specification, but dictionaries still allowed.
- The central focus is claim language in the context of the whole specification.
- Another factor is increasingly referenced: determining what the court thinks the “real invention” is.



2008 Status – ctd.

- Tension remains between claim language and the patent’s written description.
- Specifications called for more narrow interpretations than broad ones in 2007.
- Narrow claim interpretations can still arise through the process of deducing what a POSITA (person of ordinary skill in the art) would assimilate from reading the intrinsic evidence or from a legal conclusion as to “the real invention.”



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2008 Status – ctd.

- If the claim language is very broad:
 - ❖ it might be interpreted broadly, as written, or
 - ❖ it could be ruled broader than the disclosure and the claim ruled invalid for lack of written description under 112-1, or
 - ❖ It could be construed to be commensurate with the specification’s scope via the understanding of the POSITA.
- Courts can now refer to the accused product or process for context in framing the issues needed to be resolved in claim construction (to promote judicial efficiency).
- Experts are permitted to testify.
- District courts can have “rolling claim constructions.”



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Phillips (en banc, 2005) in a Nutshell

- The patent specification, not a dictionary definition, is the primary guide.
- The understanding of a POSITA provides an objective baseline “from which to begin claim interpretation.”
- The POSITA is deemed to read claim term in context of entire patent, not just the particular claim where it appears.
- Dictionaries are not prohibited and not the primary source for interpreting claim language.



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Phillips (en banc, 2005) in a Nutshell

- *Phillips* reiterated prior cases stating:
 - ❖ "The claims are directed to the invention that is described in the specification; they do not have meaning removed from the context from which they arose."
 - ❖ "Ultimately, the interpretation to be given a term can only be determined and confirmed with a full **understanding of what the inventors actually invented and intended to envelop with the claim.** The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction."



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Federal Circuit cases re:

Applications and General Rules

Claim Construction - Generally

- It is required in determining whether **Section 101** is satisfied. *In re Nuijten*, 500 F.3d 1346, 1352 (2007).
- It is “almost always a prerequisite” to granting a preliminary injunction because it bears on the likelihood of success on the merits. *Chamberlain Group, Inc. v. Lear Corp.*, 516 F.3d 1331, 1340-41 (2008).
- It is implicated in a **best mode** challenge, *AllVoice Computing PLC v. Nuance Commc'ns, Inc.*, 504 F.3d 1236, 1241 (2007). (Applying the best mode standard calls for a court to determine if the inventor had a best mode of practicing the claimed invention as of the filing date.)



General Rules

➤ Each word in a claim has 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).



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General Rules

➤ Different meanings for different words:

- ❖ *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).



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General Rules

- The presumption of different meanings for different words was rebutted in *Semitoool v. Dynamic Microsystems* (2006), where the Court held that different terms (“processing chamber” and “processing vessel”) were coextensive and concluded that the “processing chamber” meant the entire interior of a processing vessel.
- See also, *LSI Industries, Inc. v. ImagePoint, Inc. Slip Copy, 2008 WL 2165340 (2008)*.



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General Rules

- **Different meaning for different words, ctd.**
- “although . . . the general assumption is that different terms have different meanings, the same is generally not true for terms in the preamble.” *Symantec Corp. v. Computer Assoc. Intern., Inc.*, 522 F.3d 1279, 86 U.S.P.Q.2d 1449 (Fed. Cir. 2008).



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General Rules

- **The same words have the same meaning.**
 - ❖ *Pods, Inc. v. Porta Stor, Inc.*, 484 F.3d 1359, 1366 (2007).
 - ❖ *Aspex Eyewear v. Concepts In Optics* 2007 WL 46967 (2007) (non-prec.)
 - ❖ But see, *Baldwin Graphic Systems, Inc. v. Siebert, Inc.*, 512 F.3d 1338 (Fed. Cir. 2008)



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General Rules

- **Omit Permissive Features: *In re Johnston*** (2006) had a dependent claim reciting: "... further including that said wall may be smooth, corrugated, or profiled with increased dimensional proportions as pipe size is increased."
- "The Board ruled that this additional content did not narrow the scope of the claim because these limitations are stated in the permissive form "may." As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted. We affirm the Board's ruling that claim 3 as written is anticipated." 435 F.3d at 1384.



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Federal Circuit cases re:

Intrinsic Evidence

Intrinsic Evidence

- ***Panduit v. HellermannTyton (2006)***: when Fed. Cir. determines the meaning of a disputed claim limitation, it “looks principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.”
- Intrinsic evidence is the “primary focus in determining the ordinary and customary meaning of a claim limitation ...” ***Atofina v. Great Lakes Chem. (2006)***
- intrinsic evidence (claims, written description, prosecution history) is more reliable than extrinsic evidence (dictionaries, treatises, expert testimony). ***Chamberlain Group v. Lear, 516 F.3d 1331, 1335 (2008)***.



Intrinsic Evidence

- ***Lucent Technologies, Inc. v. Gateway, Inc.***, 525 F.3d 1200 (2008): intrinsic evidence includes --
 - ❖ the claim language,
 - ❖ the specification and
 - ❖ the prosecution history.
 - ❖ different portions of the specification may be used in any claim construction: the abstract, the summary of the invention, the description of the preferred embodiment, and the claims.



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Intrinsic Evidence

- Claim language itself stands at the top of the intrinsic evidence hierarchy, followed by “the rest of the intrinsic evidence.”
- The Court looks first to the words of the asserted and non-asserted claims to define the scope of the patented invention. ***Abbott v. Andrx (2006)***.
- Claim construction calls for looking at *all* of the intrinsic evidence (claim language, written description, and prosecution history) with the claim language being most important.



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Intrinsic Evidence

- ***Old Town Canoe v. Confluence (2006)***: Fed. Cir. “begin[s] its claim construction with the words of the claim, which are generally given their ordinary and customary meaning.”
- However, “there is no magic formula or catechism for conducting claim construction” and no specific sequence is required.
- 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 ...”



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Intrinsic Evidence

- The claims, both asserted and unasserted, are part of the intrinsic evidence, and the Court applies a presumption of internal consistency.
- The Court applied this rule in ***PODS v. Porta Stor (2007)***. The parties had agreed that “frame” in claim 1 meant having 4 sides. It found that the same word had the same meaning in claim 29.
- Defendant pointed to no evidence in the specification or file history to rebut the presumption.



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Intrinsic Evidence

- ***Intamin v Magnetar Tech. (2007):***
 - ❖ “... the court consults primarily the claims themselves in context, with much of that context supplied by the specification and the prosecution history.”
 - ❖ Dependent claims can supply additional context.

Federal Circuit cases re:

Plain Meaning

Plain Meaning

- *Zenith Electronics Corp. v. PDI Communication Systems, Inc.*, 522 F.3d 1348 (2008) (“operating power”)
- *Innogenetics, N.V. v. Abbott Laboratories*, 512 F.3d 1363 (2008) (“as”)
- *Regents of Univ. of Cal. v. Dakocytomation Cal., Inc.* ___ F.3d ___ (2008) (“morphologically identifiable chromosome or cell nucleus”)



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Plain Meaning

- *Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc.*, 520 F.3d 1358 (2008) (“and”).
- *Decisioning.com, Inc. v. Federated Department Stores, Inc.*, 527 F.3d 1300 (2008) (“compare ... and...”)
- *Symantec Corp. v. Computer Assoc. Intern., Inc.*, 522 F.3d 1279 (2008) (“personal computer or work station”)



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Plain Meaning

- ***Acumed v. Stryker* (2007)**
 - ❖ applied the common, lay meaning to a “curved shank” on a body of a surgical nail body; this can include small discontinuities, just as an arch is formed of small linear components.
- ***Intamin v. Magnetar Tech.* (2007):**
 - ❖ plain meaning of “length”
- ***E-Pass Technologies v. Microsoft* (2007):**
 - ❖ Fed. Cir. used plain language of claim in construing “verify use of [a] card.”

Plain Meaning

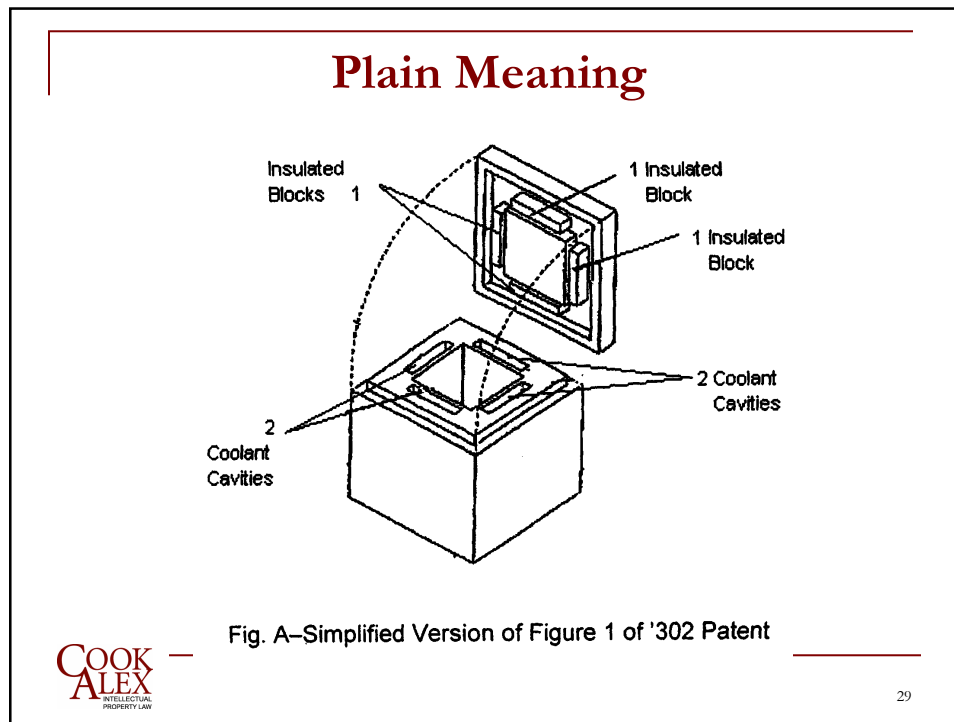
- ***Motionless Keyboard v. Microsoft* (2007):**
 - ❖ plain meaning of “concavity in said housing at said key-actuation position” and “...keyboard within said concavity” were clear and defined a depression within a housing of the device with a keyboard entirely within that depression. The specification (including figures) confirmed this meaning.

Plain Meaning

- ***In re Omeprazole Patent Litigation (2007):***
 - ❖ included a claim phrase “...forming ... a separating layer as a water soluble salt product ...”
 - ❖ Defendant Andrx asserted that it had no water soluble separating layer.
 - ❖ Fed. Cir.: claim 1 does not claim a separating layer that is water soluble, but rather a salt product that is water soluble.
 - ❖ The specification confirmed this plain meaning.

Plain Meaning

- ***Foremost in Packaging Sys. v. Cold Chain Tech. (2007):***
 - ❖ claim language: “the insulated block being adapted to slidably engage the coolant cavity, thereby the coolant and the insulated block together substantially filling the coolant cavity.”
 - ❖ Fed. Cir. affirmed a claim construction requiring the cover block to be inserted *into* the coolant cavity in order to “slidably engage” it.
 - ❖ Note the following simplified patent figure:



Plain Meaning

- ❖ The Court's reasoning was based on the plain claim language, requiring that the parts work together:
 - "If the insulating block does not extend down into the coolant cavities, the coolant and the insulated block cannot "together" substantially fill the cavity. In that situation the only way the coolant cavity would be substantially filled would be if the coolant itself performs that function. The insulated block would have no role in that process. The claims, however, require that the two elements of the container perform that filling function 'together,' not that one of them do so separately."

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Plain Meaning

Honeywell Intl v. Universal Avionics Sys. (2007)

- Reversed D.Ct. construction of “signals representative of” (aircraft position, flight path angle, and speed ...)
- D.Ct. interpreted these as specific instantaneous signals at a given sampling time.
- This was too restrictive. The patent does not require numerical or instantaneous signals. These signals are simply inputs into the system which uses its algorithms to process the information into appropriate warnings.



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Federal Circuit cases re:

Understanding of a POSITA

Understanding of a POSITA

- ***Honeywell v. Universal Avionics*, 488 F.3d 982 (2007):**
 - ❖ relied often on the understanding of a POSITA in construing claim terms.
 - ❖ With respect to the claim term “*signals representative* of a position of the aircraft, a flight path angle of the aircraft and the speed of the aircraft...” a POSITA would not limit the language to “numerical or instantaneous values.”
 - ❖ To construe the claim term “a first *alert envelope*,” the understanding of a POSITA suffices.



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Understanding of a POSITA

- ***Honeywell*, ctd.**
 - ❖ “...the claim itself provides considerable information about its meaning. *** The district court, however, incorrectly added the limitations not found in the specific language of the claim. Specifically, the trial court read in requirements that the alert envelope appear ‘in the vertical plane’ and ‘surrounded by a continuous boundary.’ *** In sum, one of skill in this art would agree that the claim defines this term adequately without additional limitations.”



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Federal Circuit cases re:

Patentee as Lexicographer

Patentee as Lexicographer

- ***Abbott v. Andrx (2007)***
 - ❖ rejected a claim that Abbott had been its own lexicographer.
 - ❖ Claims included “pharmaceutically acceptable polymer.”
 - ❖ Dependent claim 3 recited a Markush group for this. Claims 1-2 did not recite the group.
 - ❖ Specification recited the Markush group; D.Ct. adopted it in construing claim 1.
 - ❖ Held, a “Markush group” has no meaning in context of written description; D.Ct. erred.



Patentee as Lexicographer

- ***Abbott v. Andrx (2007)*, ctd.**
 - ❖ Written description states that the pharmaceutically acceptably polymer “*is*” a specific set of polymers.
 - ❖ When inventor uses the word “*is*” in the spec’n., this MAY signal intent to be a lexicographer.
 - ❖ Compare to other def’ns. in the spec’n.– they use the form, “... as used herein *means* ...”
 - ❖ Experts disagree on how a POSITA would interpret the phrase.
 - ❖ At prel. inj. stage, D.Ct. erred in limiting claims to the hydrophilic, water-soluble compounds selected from the list given in the WD of the patent.



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Patentee as Lexicographer

***Honeywell v. Universal*, 493 F.3d 1358 (2007):**

- Patentee’s lexicography was central to the outcome.
- Issue: the meaning “heading” and “bearing” of aircraft. Claim 1 referred to “the heading of the aircraft.”
- D.Ct. and a panel majority construed it to have the meaning normally given to “bearing.” In light of a patent figure and language of the specification, this “most naturally aligns with the patent’s description of the invention” (quoting precedent), is consistent with the prosecution history, and embraced the preferred embodiment rather than excluding it.



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Patentee as Lexicographer

- ***Sinorgchem v. ITC (2007)***:
 - ❖ panel majority, over a strong dissent, declared that certain language in the specification was lexicography that superseded allegedly inconsistent other language or examples in the specification.
- ***Hyperphrase Technologies v. Google (2007)*** (non-prec.):
 - ❖ determined that part of the specification was the inventor's lexicography for "data reference."



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Federal Circuit cases re:

Preambles

Preambles-1

- Main question: does the preamble limit the scope of the claim?
- Is *Kropa v. Robie* 38 C.C.P.A. 858, 187 F.2d 150, 152 (CCPA 1951) and its progeny still the law?
- This issue is determined on a case-by-case basis in light of “the overall form of the claim, and the invention as described in the specification and illuminated in the prosecution history.” *Allen Engineering v. Bartell Industries*, 299 F.3d 1336 (Fed. Cir. 2002).



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Preambles-2

Eaton Corp. v. Rockwell International Corp., 323 F.3d 1332 (2003): Fed. Cir. reiterated the following general rules dealing with preamble language:

- ❖ A preamble limits the claim when it recites “essential structure or steps” or if it is necessary to “give life, meaning, and vitality” to the claim.
- ❖ “A preamble has the import that the claim as a whole suggests for it.” When the claim uses text in both the preamble and the claim body to define the invention claimed, the invention as so defined is protected by the patent.



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Preambles-3

Eaton, ctd:

- ❖ When limitations in the body of the claim rely upon and find their antecedents in the preamble, that preamble may act as a necessary component of the claimed invention.
- ❖ However, if the body of the claim sets out the complete invention, then the preamble language *may* be superfluous.

Preambles-4

➤ ***MBO v. Becton Dickinson (2007):***

- ❖ Case said that from reading the specification and file history, the invention provides, as an essential feature, immediate needle safety.
- ❖ It is therefore appropriate to ensure that the claims include this feature too.
- ❖ When mentioned in the preamble, it is necessary to give life, meaning and vitality to the claim and may be used as a limitation.

Preambles-5

➤ ***Bass Pro Trademarks v. Cabela's (2007)***

- ❖ involved a claim on a combination vest + folding chair. The Federal Circuit vacated a D.Ct. order which minimized the meaning of “vest” – which was in the claim preamble.
- ❖ However, during prosecution, the patentee used the distinction of a vest to overcome prior art without a vest, and it referred to a “unique combination of vest and pivotable seat.”
- ❖ Vest was thus a material part of the claim.
- ❖ The Fed. Cir. did not discuss or cite *Kropa v. Robie*.

Bass Pro (left) v. Cabela's (right)

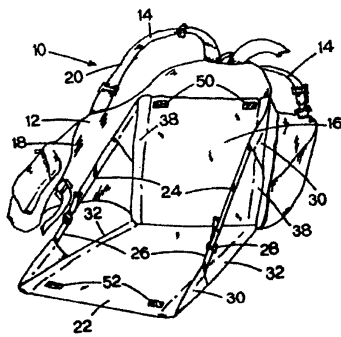


Fig. 1



Preambles

- *Halliburton Energy Services, Inc. v. M-I LLC*, 514 F.3d 1244 (2008) (parties had agreed preamble language was a limitation; courts found it indefinite)

Transition Clauses

- ***Dippin' Dots v. Mosey (2007):***
 - ❖ When a claim sets forth a method “comprising the steps of” plural elements, the elements are properly construed to mean producing **ONLY** what the claim elements recite.
 - ❖ “freezing ... into beads” as a claim element means freezing into beads *and only beads*.
 - ❖ “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 ...”

Transition Clauses

- One firm was drawn into litigation for prosecuting a patent and using “consisting of” as the transition clause in a claim.
 - ❖ *Immunocept, LLC v Fulbright & Jaworski, LLP*, 504 F.3d 1281(2007).

Words in Claim Body- “About”

- ***Ortho-McNeil Pharma. v. Caraco Pharma.*** (2007).
 - ❖ Federal Circuit addressed the meaning of “about”
 - ❖ “About” does not have a universal meaning.
 - ❖ Its meaning depends on technological facts of the particular case
 - ❖ It avoids a strict numerical boundary.
 - ❖ The inventor’s intended meaning is relevant.
 - ❖ The Court focuses on the criticality of the parameter.
 - ❖ Intrinsic and extrinsic evidence is useful.



Federal Circuit cases re:

Section 112, Para. 6

§112, ¶6

- Presumption 1: 112-6 applies when “means” in claim followed by a function.
- Presumption 2: 112-6 does NOT apply when “means” is not in claim.
- Presumption 2 rebutted in *MIT v. Abacus (2006)*.



§112, ¶6

Claim in *MIT*:

- 1. A system for reproducing a color original in a medium using a selected multiplicity of reproduction colorants, the system comprising in serial order:
 - *** b. display means connected to the scanner for receiving the appearance signals and ***aesthetic correction circuitry*** for interactively introducing aesthetically desired alterations into said appearance signals to produce modified appearance signals; and
 - c. ***colorant selection mechanism*** for receiving said modified appearance signals and for selecting corresponding reproduction signals representing values of said reproducing colorants to produce in said medium a colorimetrically-matched reproduction.



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§112, ¶6

MIT-ctd:

- D.Ct.: both the “aesthetic correction circuitry” and the “colorant selection mechanism” are ruled by 112-6.
- Fed. Cir.: agreed as to “colorant selection mechanism” and disagreed as to “aesthetic correction circuitry.”
- presumptively, the “colorant selection mechanism” was not a §112, ¶6 claim element.
- “The generic terms ‘mechanism,’ ‘means,’ ‘element,’ and ‘device,’ typically do not connote sufficiently definite structure.”



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§112, ¶6

MIT-ctd:

- the patentee used “mechanism” and “means” as synonyms.
- At least one dictionary definition equates mechanism with means.
- The term “mechanism” standing alone connotes no more structure than the term “means.”
- Claim language that further defines a generic term like “mechanism” can sometimes add sufficient structure to avoid 112 ¶6.

§112, ¶6

MIT-ctd:

- a claim term defined solely in functional terms, without more, would fall within §112, ¶6 .
- “the term ‘colorant selection,’ which modifies ‘mechanism’ here, is not defined in the specification and has no dictionary definition, and there is no suggestion that it has a generally understood meaning in the art. We therefore agree ... that ‘colorant selection mechanism’ does not connote sufficient structure to a person of ordinary skill in the art to avoid 112 ¶6 treatment.”

§112, ¶6

MIT-ctd:

- Agree that “aesthetic correction circuitry” connotes sufficient structure to avoid §112, ¶6.
- Unlike “mechanism,” dictionary definitions establish that “circuitry,” by itself, connotes structure.
- “The claim language here too does not merely describe a circuit; it adds further structure by describing the operation of the circuit. The circuit's input is ‘appearance signals’ produced by the scanner; its objective is to ‘interactively introduc[e] aesthetically desired alterations into said appearance signals’; and its output is ‘modified appearance signals.’... This description of the operation of the circuit is sufficient to avoid 112 ¶6.”

§112, ¶6

- **Aspex Eyewear, Inc. v. Altair Eyewear, Inc.**, Slip Copy, 2008 WL 2950997 (2008) (non-precedential):
- claim did not recite “means,” but called for “two retaining mechanisms for supporting a pair of lenses, and defining a frontal plane.”
- D.Ct. held that this limitation was ruled by §112, ¶ 6.
- CAFC affirmed, analogizing to *MIT v. Abacus* (2006).
- CAFC said that the term “mechanism” standing alone connotes no more structure than the term “means.” Evidence was that “retaining mechanism” had no meaning in the eyeglass industry.

§112, ¶6

- ***LG Electronics v. Bizcom***: a control unit for controlling a communication unit, where the control unit comprises a CPU and a partitioned memory system, is *not* in means plus function form; it provided sufficient structure for performing the function to avoid §112, ¶6 .
- ***DePuy v. Medtronic***: presumption that a claim element was outside the scope of §112, ¶6 was not rebutted. §112, ¶6 applies only to purely functional limitations that do not provide structure that performs the recited function. Omission of the word “means” raises a rebuttable presumption that §112 ¶6 does not apply. The presumption flowing from the absence of the term “means” is strong and not readily overcome. 469 F.3d at 1023.

§112, ¶6 : Methodology

- ***Applied Medical Resources v. U.S. Surgical***, 448 F. 3d at 1332 (2006):
 - ❖ Claim construction of a means-plus-function limitation includes two steps. First, the court must determine the claimed function. [citation omitted] Second, the court must identify the corresponding structure in the written description of the patent that performs that function.
- ***See Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.***, 296 F.3d 1106 (Fed. Cir. 2002) for detailed discussion of 112-6 methodology.

§112, ¶6 : Structure/Clear Linking

- “[S]tructure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history *clearly links* or associates that structure to the function recited in the claim.” *Medical Instrumentation and Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205 (Fed. Cir. 2003) [emphasis added]. *Accord, Linear Technology Corp. v. Impala Linear Corp.*, 379 F.3d 1311, 1321 (Fed. Cir. 2004).
- In 2006, it was mentioned in only non-precedential decisions. *Kinzenbaw v. Case LLC*, 179 Fed. Appx. 20 (Fed. Cir. 2006), *Competitive Techs. v. Fujitsu, Ltd.*, 185 Fed. Appx. 958 (Fed. Cir. 2006).

§112, ¶6 : Structure/Clear Linking

- *Biomedino v. Waters Technologies* (2007)
 - ❖ Affirmed invalidity for indefiniteness where patentee failed to clearly link “means” to any definite structure
 - ❖ Clear linking is the *quid pro quo* for using 112-6.
 - ❖ With no clear disclosure as to structure the patentee intends to correspond to the claimed function, then the patentee has not paid the price and is attempting to claim in functional terms unbounded by any reference to structure.
 - ❖ A POSITA must be able to see what corresponds.

§112, ¶6 : Structure / Clear Linking

- Under §112, ¶6, "...is sufficient corresponding structure disclosed when the specification simply recites that a claimed function can be performed by known methods or using known equipment where prior art of record and the testimony of experts suggest that known methods and equipment exist?" *Biomedino*, 490 F.3d 946, 951 (2007)
- In this case, there is nothing to suggest a structure for the claimed control means. While a patentee need not disclose details well known in the art, the spec'n must disclose *some* structure.
- A bare statement that known techniques or methods can be used does *not* disclose structure.



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§112, ¶6 : Structure / Clear Linking

- ***Maurice Mitchell Innovations v. Intel***, 2007 WL 2777968 (non-prec.)
 - ❖ affirmed SJ of invalidity that a claim containing a 112 ¶6 element was indefinite because there was no clearly linked corresponding structure in the specification.
 - ❖ a POSITA must be able to "... understand the scope of the invention when the claims are read in conjunction with the specification."
 - ❖ When using 112 ¶6 one must set forth adequate disclosure in the specification showing what is meant by that language.
 - ❖ With no structure in the specification corresponding to the 112 ¶6 limitation, the claim is indefinite.
 - ❖ the only possible structure that might correspond to the claimed function did not contain any structure.
 - ❖ Had "no disclosed link between that purported structure and the claimed function."



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§112, ¶6: The Function

- ***Applied Medical Resources v. U.S. Surgical*** (2006):
 - ❖ A court errs when it improperly imports unclaimed functions into a means-plus-function claim limitation.
 - ❖ defining a claimed function to require more than is actually claimed is a claim construction error
 - ❖ Or, error can occur during infringement analysis if a court improperly determines the way in which the disclosed structure performs the previously-defined function.
 - ❖ the inquiry should be restricted to the way in which the structure performs the *properly-defined function* and should not be influenced by the manner in which the structure performs other, extraneous functions. [emphasis by the Court] 448 F.3d at 1334.



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Federal Circuit cases re:

Effects of the Written Description

Effects of Written Description

- Often the biggest claim construction issues:
- 35 U.S.C. §112, ¶1 requires each patent specification to “contain a written description of the invention ...”
- 35 U.S.C. §112, ¶2 requires the specification to “conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”



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Effects of Written Description

United States v. Adams, 383 U.S. 39, 49, 86 S.Ct. 708, 15 L.Ed.2d 572, 579 (1966):

- The Supreme Court explained the relationship between the written description and the claims somewhat tersely:
 - ❖ [I]t is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention...



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Effects of Written Description

- Federal Circuit *en banc* in *Johnson & Johnston Assoc. v. R.E. Service Co.*, 285 F.3d 1046 (Fed. Cir. 2002) (DOE case) noted:
 - ❖ Consistent with its scope definition and notice functions, the claim requirement presupposes that a patent applicant defines his invention in the claims, not in the specification. After all, the claims, not the specification, provide the measure of the patentee's right to exclude. 285 F.3d 1046, 1052.

Effects of Written Description

- 2 possible outcomes: broad or narrow construction of claim
- Broad interpretation cases generally explain that:
 - ❖ the claim language itself is not limited;
 - ❖ nothing in the written description compels a narrow interpretation; and
 - ❖ court will not import details from the specification.

Effects of Written Description

- Narrow interpretation cases say that:
 - ❖ the construction most naturally aligns or best aligns with the disclosed invention, or
 - ❖ The specification discloses necessary material, or contains special emphasis, disavowals, disclaimers, etc., or
 - ❖ the patentee is not entitled to a claim scope divorced from the context of the specification,
 - ❖ cannot enlarge the scope of the invention.

Broad v. Narrow (2007)

Broad:

Acumed v. Stryker
Colassi v. Cybex
Cybersettle v. Natl. Arbitration Forum
Honeywell v. Universal
In re Omeprazole Pat. Lit.
Intamin v. Magnetar
MBO Laboratories
Saunders v. Comfortrac

Narrow:

Andersen
Automed v. Knapp
Data Encryption v. Microsoft
Dippin' Dots
E-Pass v. Microsoft
Logan v. Hormel Foods
Motionless Keyboard
MyMail v. AOL
Ormco v. Align
SafeTCare
Toshiba v. Juniper Networks
U.S. Phillips v. Iwasaki
Verizon v. Vonage

Broad v. Narrow (2008)

Broad:

Innogenetics v. Abbott,
Uniloc v Microsoft,

Narrow:

PSN Illinois v. Ivoclar,
Mangosoft v. Oracle,
Finisar v. DirectTV Group,
Outside the Box v. Travel
Caddy,
Black & Decker v. Rob't
Bosch Tool Corp.,
Energies Tech. v PNM
Resources,
Nazomi Comm. v. ARM,
TALtech v Esquel Apparel,

Broad Interpretation Cases

- *Acumed v. Stryker (2007)*:
 - ❖ Improper to attempt to read a feature of a preferred embodiment into the claims as a limitation.
 - ❖ Transverse in broad claim is not limited to “perpendicular” as in the specification example.
 - ❖ Use of word “perpendicular” in the specification indicates that the patentee by using the word “transverse” in the claim intended not to be limited to perpendicular. This implies a broader scope.

Broad Interpretation Cases

- ***In re Omeprazole Patent Litigation (2007):***
 - ❖ Defendant asserted that one patent included a limitation of performing the claimed process at a temperature < 42° C.
 - ❖ Fed. Cir. held this is only an example from the specification.
 - ❖ “Absent some clear intent to the contrary, this court does not import examples from the specification into the claims.” 483 F.3d 1364, 1372.

Narrow Interpretation Cases

- ***Automed Tech. v. Knapp Logistics (2007):***
 - ❖ involved a system performing a method (automatically filling vials with drugs). The claims did not specify an order as to vial-filling and vial-labeling.
 - ❖ Held, *per curiam*, that claims are limited to the order in the specification.
 - ❖ Note also, however, that in a continuation reissue application, the patentee sought to amend a claim to provide for labeling “before or after” filling. This was rejected as new matter, and the patentee withdrew the amendment.

Narrow Interpretation Cases

➤ ***Andersen v. Fiber Composites* (2007)**

- ❖ construed claims narrowly in light of the specification and prosecution history.
- ❖ The specification described the invention as a whole. 474 F.3d 1361, 1367.
- ❖ Rejected the presumption of claim differentiation
 - Cannot broaden claims beyond correct scope
 - Claims not otherwise identical anyway. *Id.* at 1370.



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Narrow Interpretation Cases

➤ ***MyMail v. America Online* (2007)**

- ❖ Aff'd. SJ non-infringement based on claim construction.
- ❖ D.Ct. and Fed. Cir. both referred to the specification to determine which entity in a process for internet connection performed an authentication step.
- ❖ The specification pointed to the "NSP" entity and not the "ASP" entity. The D.Ct. ruled that the patent requires the NSP to perform authentication, and as all defendants were ASPs rather than NSPs, they could not infringe. The Fed. Cir. agreed.



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Narrow Interpretation Cases

➤ *Honeywell v. Universal Avionics (2007)*

- ❖ mentioned above re the understanding of a POSITA as enough to construe some of the claim terms. The Court referred to the specification for others where the claim phrase was not a term of art:
- ❖ “look ahead distance” was properly construed with reference to its usage in the patent, taking limitations therefrom.
- ❖ “terrain floor boundary,” also not a term of art, is understood from the specification, using some limitations therein.



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Federal Circuit cases re:

Disclaimers and Disavowals

Disclaimers or Disavowals

- ***Pfizer v. Ranbaxy*** (2006): the specification explained, “This invention contemplates only the trans-form of the compounds of formula I above.” Fed. Cir. noted that this specifically disclaimed 2 of the 4 possible isomers that could be generated from the chemical compound at issue but at the same time ruled that there was no further disclaimer in the specification, and none would be incorporated into the disputed claims.
- Court expressly rejected Ranbaxy’s argument that the claims in issue should be further limited, stating that the limitation that Ranbaxy sought to impose in the claim language was merely an example of the specification rather than a limitation in the claim language.

Disclaimers or Disavowals

- ***Atofina v. Great Lakes Chemical*** (2006) also found express disclaimers or disavowals in the specification and the file history. As to former, the specification stated:
 - ❖ (1) the catalyst is “based on pure chromium (without the addition of another metal oxide,”
 - ❖ (2) it is necessary to have a catalyst containing solely chromium,” and
 - ❖ (3) it is “unnecessary to employ special additives to increase [the fluorination reaction’s] selectivity ...”

Disclaimers or Disavowals

- **Honeywell Int'l v. ITT Indus.** (2006) limited claim scope based on specification disclaimer or disavowal.
- D.Ct. broadly construed “electrically conductive fibers” to include fibers that conduct electricity, including metal and carbon fibers.
- Fed. Cir. limited the interpretation of this element to *exclude* carbon fibers, as the patentee had “demeaned” the use of carbon fibers at several locations within the specification, thereby disavowing the ability to interpret this element to include carbon fibers.
- “If the written description could talk, it would say, ‘Do not use carbon fibers.’”



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Disclaimers or Disavowals

- **On Demand v. Ingram** (2006) found a disclaimer or disavowal to limit “customer.” The patent was for printing books one at a time at high speed at a retail outlet. The accused product was used by commercial printers to print multiple or single copies of books at high speed. The defendant did not sell directly to the public at retail, but rather sold wholesale to retailers.
- The patent focuses on customers who order and immediately receive “printed to order” books. The claims were not limited to a particular type of customer, and there was no *explicit* disavowal of other types of customers in the patent. However, the patent specification repeatedly reinforced its usage of the term “customer” as the retail consumer.



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Disclaimers or Disavowals

Ventana v. BioGenex (2006): *no disclaimer or disavowal.*

- The specification statements and descriptions were too general.
- “Such general statements [by the inventors indicating that the invention is intended to improve upon prior art automated staining methods], without more, will not be interpreted to disclaim every feature of every prior art device discussed in the ‘BACKGROUND ART’ section of the patent.”



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Disclaimers or Disavowals

➤ ***SafeTCare v. Tele-Made*** (2007)

- ❖ Claim called for electric motors “for exerting a pushing force” on deck sections to cause them to rotate upwardly relative to a frame and adjust a mattress contour of a hospital bed.
- ❖ Issue was push vs. pull: complicated by a lifting lever.
- ❖ Fed. Cir. referred to the spec’n -- it repeatedly specified *pushing* forces against the lift dogs (levers) and called that “an important feature.”
- ❖ The patentee distinguished prior art that *pulled* the lift dogs.
- ❖ Patentee thereby **disclaimed** motors that pull the lift dog (as defendant’s). Court affirmed SJ of no infringement.



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Federal Circuit cases re:

Whether the Preferred Embodiment May be Excluded

Excluding the Preferred Embodiment

- Strong preference to construe claims to INCLUDE at least one of the preferred embodiment(s).
- ***Sinorgchem v. ITC (2007)*** ruled that not all claims must cover all embodiments, and that an inventor's lexicography can (and here, did) exclude at least one example set forth in the specification.
- ***Cybersettle v. Natl Arbitration Forum (2007)*** (non-prec.) also rejected an argument that an embodiment was being excluded. The Court noted that other claims covered that excluded embodiment.



Excluding the Preferred Embodiment

- ***Intamin v Magnetar Tech. (2007)***
 - ❖ confirmed that a claim need not cover *all* embodiments, as a patentee may draft different claims to cover different embodiments.
- ***Oatey v. IPS Corp. (2008)***
 - ❖ Exclude where embodiments are clearly disclaimed in the spec'n or file history
- **See also:**
 - ❖ ***Helmsderfer v. Bobrick (2008)***
 - ❖ ***Lucent v. Gateway (2008)***
 - ❖ ***Gen. Atomics v. Axis-Shield (2008)***
 - ❖ ***Energizer Holdings v. ITC (2008)***



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Federal Circuit cases re:

Claim Construction and Validity

Claim Construction and Validity

- ***Pfizer v. Ranbaxy***: courts “should not rewrite claims to preserve validity.”
- ***SRAM v. AD-II***: The Court also applied this rule at least implicitly here also. AD-II contended that the claim at issue was broadly written and invalid over a Japanese reference. D.Ct. construed the claim narrowly and granted summary judgment of no invalidity. The Federal Circuit vacated, noting that the claim was broadly written and that the Court was powerless to rewrite it, and remanded for the D.Ct. to reconsider the prior art, due to an unclear record.

Claim Construction and Validity

- ***MBO v. Becton Dickinson (2007)***
 - ❖ stated that “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.



Federal Circuit cases re:

Claim Differentiation

Claim Differentiation

- Presence of dependent claim adding a limitation raises presumption that the limitation is not in the independent claim.
 - ❖ ***Baldwin Graphic Sys. v. Siebert (2008) (differentiation applied)***
 - ❖ ***Abbott v. Andrx*** (implies that parent claim is “likely broader”)
 - ❖ ***Acumed v. Stryker*** (presumption raised)
 - ❖ ***Saunders Group v. Comfortrac*** (presumption raised)
 - ❖ ***Ortho-McNeil Pharm v. Caraco Pharm.***
 - ❖ ***Intamin v. Magnetar Tech.***
 - ❖ ***See also, MBO Labs v. Beckton Dickinson***



Claim differentiation

- Claim differentiation can be rebutted.
 - ❖ ***Andersen v. Fiber Composites*** (doctrine not paramount; intrinsic evidence in form of written description and file history can overcome it).
 - ❖ ***Shanghai Meihao Electric v. Leviton Mfg.***
 - ❖ ***Microstrategy v. Businessobjects Americas***
 - ❖ ***Regents of Univ. of Cal. v. Dakocytomation Cal.*** (2008)
 - ❖ ***Nazomi v. ARM*** (2008)



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Federal Circuit cases re:

Effects of the Prosecution History

Prosecution History Effects

- Limiting cases
- Non-limiting cases
- Broadening cases
- Non-broadening cases
- Related prosecutions

Prosecution History – Limiting Cases

- ***Monsanto v. Syngenta Seeds (2007)*** relied on file history and other factors to rule that claim 4 was dependent, not independent. The original claim was clearly dependent and was revised after allowance, with counsel stating in the file history that the change did not introduce new matter and is allowable without further search and consideration.

Prosecution History – Limiting Cases

- ***CIAS v. Alliance Gaming (2007)*** reaffirmed that arguments alone, without amendment, can have a limiting effect. The Court specifically rejected the idea that because there was no rejection based on a specific prior art reference, and hence no amendments were made or needed, that this did not negate the arguments made during reexamination to distinguish over that reference.
- ***Ormco v. Align (2007)*** relied on statements where the inventor distinguished a computerized method of the invention from a prior art method using operator intervention. This occurred in the prosecution history of a parent patent.



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Prosecution History – Limiting Cases

- ***Hakim v. Cannon Avent Gp.***, 479 F.3d 1313, 1317-18 (2007):
- In parent case, patentee said the prior art lacks a combination of 2 elements, one being a slit. All claims then allowed.
- Patentee filed a continuation with an amendment to broaden the “slit” claim language to an “opening.” Submitted an attorney letter stating that he was doing this broadening. The examiner allowed all claims without comment.
- Held, the claim is properly construed to require a slit rather than just any opening.
 - ❖ A disclaimer made during prosecution can be rescinded, but to permit recapture, the rescission “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, there is no recapture of surrendered scope.)



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Prosecution History – Limiting Cases

➤ See also:

- ❖ *Hakim v. Cannon Avent (2007)*
- ❖ *Pods v. Porta Stor (2007)*
- ❖ *Bass Pro v. Cabela's (2007)*
- ❖ *Andersen v. Fiber Composite (2007)*
- ❖ *Automed v. Knapp Logistics (2007, non-prec.)*
- ❖ *Logan v. Hormel Foods (2007, non-prec.)*
- ❖ *Microstrategy v. Businessobjects Americas (2007, non-prec.)*
- ❖ *Cybersettle v. Natl. Arbitration Forum (2007, non-prec.)*



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Prosecution History – Limiting Cases

- ❖ *Regents of Univ. of Cal. v. Dakocytomation Cal. (2008)*
- ❖ *Computer Docking Station Corp. v. Dell (2008)*
- ❖ *Helena Labs v Alpha Scientific (2008)*
- ❖ *Nazomi v ARM (2008)*
- ❖ *Bd. Regents of Univ. Texas v. Benq America (2008)*
- ❖ *LSI v ImagePoint (2008)*
- ❖ *Heuft v Industrial Dynamics (2008)*



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Prosecution Hist.– Non-limiting Cases

- ***NMT Medical v. Cardia* (2007):**
 - ❖ Reversing the D.Ct., the Fed. Cir. examined the prosecution history and found no unambiguous basis to vary from the meaning of the claims as read in light of the specification.
 - ❖ Court has declined to apply doctrine of prosecution disclaimer where the alleged disavowal of claim scope is ambiguous.

Prosecution Hist.– Non-limiting Cases

- The Fed. Cir. was not persuaded that the prosecution history limited claim scope in several further 2007 cases:
 - ❖ *AllVoice Computing v. Nuance Commc'ns* (D.Ct. took disclosures of file history out of context and viewed them in a way different than a POSITA would);
 - ❖ *Elbex Video v. Sensormatic Electronics* – a prosecution disclaimer must be clear and unmistakable

Prosecution Hist.– Non-limiting Cases

- 2007 cases, ctd:
 - ❖ *Honeywell Intl. v. Universal Avionics Systems* – statements were not sufficiently clear and deliberate to meet the high standard for finding disclaimer.
- 2007 cases:
 - ❖ *Baldwin Graphic Sys. v. Siebert*

Prosecution Hist. – Broadening Cases

- ***Saunders Group v. Comfortrac (2007)*** refused to narrow the claim scope where a petition to make special was consistent with the argument that the asserted claims should not be interpreted to include non-recited pressure activated seals.
- ***Cordis v. Medtronic (2008)***

File Hist. – Non-Broadening Cases

➤ ***Honeywell v. ITT (2006):***

- ❖ declined to follow the patentee’s statements in the file history trying to broaden the scope of the invention, stating,
- ❖ “Where, as here, the written description clearly identifies what his invention is, an expression by a patentee during prosecution that he intends his claims to cover more than what his specification discloses is entitled to little weight.”

➤ ***Intl. Rectifier v. IXYS (2008)***



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Examiner Statements

- ***Ventana v. BioGenex (2006):*** the issue was the meaning of “dispensing.”
- PTO examiner issued a restriction requirement and stated that “the process as claimed can be practiced by another materially different apparatus or by hand, such as a manual pipette means.”
- To the Court, this meant that the PTP examiner did not consider the word “dispensing” in the claim to be limited to the “direct” dispensing illustrated in the preferred embodiment, urged by the defendant, and adopted by the district court. The Court cited this as a reason for reversing the D.Ct. claim construction.



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Prosecution Hist. – Examiner Statements

Schoenhaus v. Genesco (2006): The patentee urged that the Examiner did not explain why he added the word “rigid” via Examiner’s Amendment and that this addition was not intended to limit the scope to a “rigid” heel seat.

- The Court disagreed: “[w]here no explanation is established, . . . the court should presume that the PTO had a substantial reason related to patentability for including the limiting element added by amendment.”
- The rationale: “gives proper deference to the role of claims in defining an invention and providing public notice, and to the primacy of the PTO in ensuring that the claims allowed cover only subject matter that is properly patentable in a proffered patent application.”



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Federal Circuit cases re:

Extrinsic Evidence

Extrinsic Evidence - generally

- ***Abbott Labs v Andrx Pharm.***, 473 F.3d 1196, 1211 (2007):
 - ❖ The Court reaffirmed availability of extrinsic evidence in claim construction in
 - ❖ Did not use extrinsic evidence in that case
 - ❖ Cited *Phillips* regimen: ordinary + customary meaning to a POSITA, look at words of claims themselves, written description and extrinsic evidence.
- ***Acumed v. Stryker* (2007)**: the Court said of one extrinsic patent that it is "...purely extrinsic evidence and therefore merits little consideration." 483 F.3d 800, 809.



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Extrinsic Evidence - generally

- ***MBO Laboratories v. Becton, Dickinson* (2007)**
 - ❖ noted that extrinsic evidence (testimony, dictionaries, learned treatises, or other material not part of the public record associated with the patent) may be helpful but is LESS SIGNIFICANT than the intrinsic record.



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Extrinsic Evidence-Dictionaries

- ***L.B. Plastics v. Amerimax Home Products (2007)*** approved the use of dictionaries in determining the meaning of “continuous heat weld” where the specification had very sparse reference to the welding. The intrinsic evidence offered “no further guidance to the meaning of the terms ‘weld,’ ‘fuse,’ or ‘ultrasonic or heat welding’...”
- ***Verizon v. Vonage (2007)*** used a dictionary in interpreting “server,” which was not defined in the specification.
- ***Pods v. Porta Stor (2007)*** approved the use of dictionaries in a confirmatory role.
- ***In re Trans Texas Holdings (2007)*** also referred to dictionary definitions.
- ***Byrne v. Black & Decker (2007)*** (non-prec.) found (harmless) error in relying on dictionary definitions rather than relying upon intrinsic evidence (including other claim language).



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Extrinsic Evidence-Dictionaries

- 2008 cases re dictionaries:
 - ❖ *Chamberlain v. Lear* (dictionary use reversed where specification was clear)
 - ❖ *Helmsderfer v. Bobrick Washroom Eqmt.* (intrinsic evidence was silent, dictionary used)
 - ❖ *Aspex Eyewear v. Altair* (rejected dictionary meanis for “therein”)
 - ❖ *Innogenetics v Abbott* (rejected dictionary meaning of “while”)
 - ❖ *Symantec v. Computer Associates* (dictionary used)



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Extrinsic Evidence – Experts

- ***Ortho-McNeil Pharma. v. Caraco Pharma.*, 476 F.3d 1321 (2007):**
 - ❖ both the D.Ct. and Fed. Cir. resorted to expert witness testimony re the criticality of a range when construing the word “about” used in the claim. The Court also relied heavily on intrinsic evidence.

Extrinsic Evidence - Experts

- ***Verizon v. Vonage* (2007)** remarked at the *absence* of expert testimony as to how a POSITA would understand a term in dispute, stating that without support in the specification or file history, nor dictionary definition:
 - ❖ ***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. But Vonage has not called our attention to any such testimony. ... Verizon's expert did testify that [a POSITA] would understand extraction to constitute translation. We see no error in the district court's failure to include Vonage's interpretation in the jury charge.

Extrinsic Evidence - Experts

- The Court denied weight to expert testimony in *Sinorgchem v. ITC (2007)*:
 - ❖ We attribute no weight to that testimony because the experts did not identify any evidence that those skilled in the art would recognize that “controlled amount,” or any term used in the specification, has an accepted meaning in the field of chemistry. Under such circumstances, testimony as to how one skilled in the art would interpret the language in the specification is entitled to little or no weight.



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Extrinsic Evidence - Experts

- *Symantec v. Computer Associates (2008)* (CAFC rejected expert testimony on meaning of claim terms “computer” and “computer system;” used dictionary instead.



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Federal Circuit cases re:

Context of Accused Product

No Need to Construe in a Vacuum

- **Background rule:**
 - ❖ 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 (Fed. Cir. 1985) (*en banc*).
- ***Exigent v. Atrana (2006)*:**
 - ❖ judicial efficiency makes it wholly appropriate to consider the accused product when deciding what aspect of the claim should be construed.



No Need to Construe in a Vacuum

- ***Wilson Spng. Goods v. Hillerich (2006):***
 - ❖ "... 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. *** "This court, of course, repeats its rule that "claims may not be construed with reference to the accused device." 442 F.3d at 1326-27, 1330-31.(Rader, J.)



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No Need to Construe in a Vacuum

- ***Accord:***
 - ❖ ***Lava Trading v. Sonic Trading (2006)***
 - ❖ ***Serio-US v. Plastic Recovery (2006)***
 - ❖ ***MIT v. Abacus (2006)***
 - ❖ ***Toshiba v. Juniper Networks (2007, non-prec.)***
 - ❖ ***Byrne v. Black & Decker (2007, non-prec.)***
- ***Compare, Jang v. Boston Scientific (2008)***



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Federal Circuit cases re:

Design Patents

Design Patents

- **35 U.S.C. §171.** Patents for designs. Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefore, subject to the conditions and requirements of this title.
- **37 C.F.R. §1.153. (a)** The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.



Design Patents

- Considerable confusion in the bar re scope of design patents.
- Not a substitute for utility patents
- Different infringement test – had 2 parts until August 2008
- Doctrine of Equivalents not directly transferable but principles apply under the S.Ct.'s *Gorham* test
- Form of claim construction now discretionary.



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Design Patents

- precedential rulings in 2006:
 - ❖ ***Amini v. Anthony***
 - ❖ ***Lawman v. Winner***
 - ❖ ***PHG Tech. v. St. John Cos.***
- precedential rulings in 2007:
 - ❖ ***Egyptian Goddess v. Swisa*** (*opinion withdrawn, en banc rehearing granted*)
 - ❖ ***Arminak v. Saint-Gobain Calmar***
- precedential rulings in 2008:
 - ❖ ***Egyptian Goddess v. Swisa*** (*en banc*)



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Design Patents

Amini v. Anthony:

- design patent on a 4-post bed frame having various designs ornamenting the posts, legs, feet, headboard, and footboard. After expert discovery, D.Ct. granted SJ of non-infringement. Fed. Cir. reversed.
- Functionality Rule: “If a design includes both functional and ornamental features, infringement occurs if an ordinary person would be deceived by reason of the common features in the claimed and accused design *which are ornamental.*” [internal punctuation and citation omitted, emphasis added]



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Design Patents

Amini, ctd.

- Infringement Rule: For there to be infringement, the deception must result from similarities in the *overall* design, not similarities in specific ornamental features considered in isolation.
- The overall infringement test does *not* involve an element-by-element comparison. D.Ct. erred in granting SJ (non-infringement) when it focused on just one feature of the patented design -- “four hollow metal orb and bed posts which are absent in the accused bed frame.”



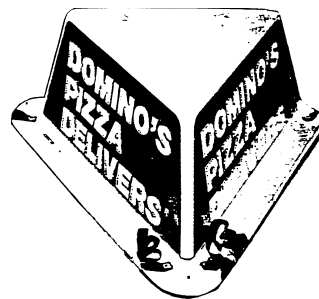
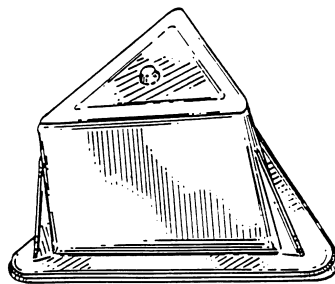
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Design Patents

- ***Amini***: "... the trial court mistakenly analyzed each element separately instead of analyzing the design as a whole from the perspective of an ordinary observer. ... The trial court is correct to factor out the functional aspects of various design elements, but that discounting of functional elements must not convert the overall infringement test to an element-by-element comparison."
- ***But see, Elmer v. ICC Fabricating, Inc.***, 67 F.3d 1571 (Fed. Cir. 1995), finding 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.

Design Patents

- ***Elmer***: pat'd. design (L) and accused design (R):



Design Patents - Functionality

➤ *PHG Technologies v. St. John Companies* (2006)

- ❖ involved the question of functionality of a patented design.
- ❖ Fed. Cir. vacated a preliminary injunction on two design patents for a sheet of medical labels. One design has a border, the other does not.
- ❖ Both designs include 11 rows of labels, each row having three labels (see next slide):

Design Patents - Functionality

FIG. 1

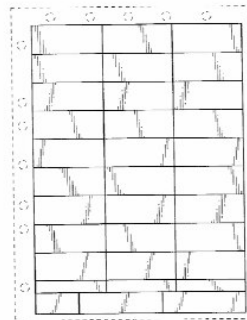
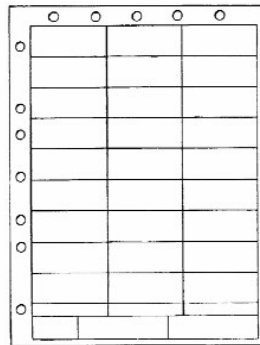


FIG.1

Design Patents – Functionality

PHG, ctd:

- Rows 1-9: labels sized for a standard medical chart
- Row 10: smaller labels sized for pediatric wristband
- Row 11: labels for an adult wristband
- Both design patents depend from a utility patent application.
- Because there are “a multitude” of ways to arrange different sizes of labels on an 8.5 x 11 inch sheet, D.Ct. rejected defendant’s argument that the designs were merely functional and not primarily ornamental.



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Design Patents – Functionality

PHG, ctd.:

- Fed. Cir.: if a patented design is *primarily functional* rather than ornamental, the patent is invalid.
- A design of a useful article is deemed functional when its appearance is dictated by the use or purpose of the article.
- This determination ultimately rests on analyzing the overall appearance.
- One factor in this issue is whether alternative designs would adversely affect utility. Existence of alternative designs may or may not assist in determining whether the design can overcome a functionality challenge.
- Precedents say when there are several ways to achieve the function, then the design of the article is more likely to serve a primarily ornamental purpose. However, if the alternative designs would adversely affect the utility of the article, then they are not really “alternatives” within the meaning of the Court’s precedents.



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Design Patents – Functionality

- **PHG**, ctd.
- One factor in this issue is whether alternative designs would adversely affect utility. Existence of alternative designs may or may not assist in determining whether the design can overcome a functionality challenge.
- Precedents say when there are several ways to achieve the function, then the design of the article is more likely to serve a primarily ornamental purpose. However, if the alternative designs would adversely affect the utility of the article, then they are not really “alternatives” within the meaning of the Court’s precedents.



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Design Patents – Functionality

PHG, ctd.:

- The D.Ct. failed to explain whether the alternative designs would adversely affect the utility of the medical label sheet. The evidence explained the functional advantage of the particular arrangement of labels in the design and that alternative designs would adversely affect utility.
- This evidence sufficed to raise a substantial question of invalidity, and the patentee offered no evidence refuting the functionality evidence.
- Accordingly, the evidence indicated clear error by the D.Ct. in finding likely success on the merits, and the Fed. Cir. vacated the preliminary injunction.



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Design Patents- Claim Construction

***Lawman v. Winner* (2006):**

- Concerned point of novelty and an exception to the claim construction requirement.
- *En banc* ruling in *Egyptian Goddess* (2008) eliminated the point of novelty test for infringement.



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Design Patents

- ***Arminak v. Saint-Gobain Calmar*, 501 F.3d 1314 (2007):**
 - ❖ D.Ct. must construe design patent claims to determine the meaning and scope.
 - ❖ D.Ct. claim construction was not made erroneous because it was filled with minute detail. Fed. Cir. does not prohibit a detailed claim construction of design patent drawings.
 - ❖ Fed. Cir. disapproves of claim constructions that go beyond the novel, nonfunctional ornamental features visually represented by the drawings or that fail to encompass the claimed ornamental features of the design as a whole.
 - ❖ The “meticulous and accurate description” of the figures in the design patents “demonstrated the proper consideration of the claimed designs as a whole.”



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Design Patents – *Egyptian Goddess*

- ***Egyptian Goddess v. Swisa***, ___ F.3d ___, 2008 WL 4290856 (*en banc*):
 - ❖ claim construction:
 - D.Ct. discretion to use words to describe
 - may simply refer to drawings in the patent
 - ❖ point of novelty test – don't use in determining infringement
 - ❖ ordinary observer test – modified to account for prior art



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Egyptian Goddess - 2

- Burdens of proof:
 - ❖ patentee still has ultimate burden to prove infringement,
 - ❖ if prior art is asserted as a defense, the burden to produce prior art and compare it to the accused product and patented design falls to the alleged infringer;
- Comments to the jury:
 - ❖ trial court may comment about the evidence, comparing it to the patented design, etc.,
 - ❖ May declare what features are ornamental vs. those which are purely functional.



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Egyptian Goddess - 3

➤ **New ordinary observer test:**

- ❖ When the claimed design and the accused product are considered in light of the prior art, then the hypothetical ordinary observer's attention will be drawn to those differences.
- ❖ If the designs are close, small differences are likely to be "important to the eye of the hypothetical ordinary observer."
- ❖ "The question before this court under the standard we have set forth above is whether an ordinary observer, familiar with the prior art ... designs, would be deceived into believing the Swisa buffer is the same as the patented buffer."

Egyptian Goddess - 4



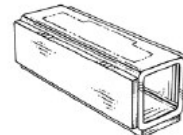
Falley Buffer Block



Nailco Patent



Swisa Buffer



'389 patent

Egyptian Goddess - 5

- Plaintiff's expert focused on similarities:
 - ❖ patented design and accused product are both tubular; both have square cross section; both have multiple raised rectangular pads on the sides; and in both, the corners of the tubes are not covered.
- Defendant's expert focused on the differences among the prior art designs, the accused design, and the patented design.
 - ❖ the number of sides with an abrasive surface would be important to consumers, who note whether the product is a 3-way buffer or a 4-way buffer; this difference is "immediately apparent to any consumer used to buying nail buffers..."

Egyptian Goddess - 6

- The controlling question on infringement in this case was stated by the Court this way:
 - ❖ "The question before this court under the standard we have set forth above is whether an ordinary observer, familiar with the prior art Falley and Nailco designs, would be deceived into believing the Swisa buffer is the same as the patented buffer."
- SJ non-infringement affirmed.



Federal Circuit cases re:

**Procedure, Timing, Jurisdiction
& Related Topics**

Duty of Attorneys

- *LSI Industries v. ImagePoint* (2008): lawyers not only must represent client zealously, but also have a duty to the court to aid in fair administration of justice. This includes helping the trial court with the claim construction process.



Duty of Courts

- *O2 Micro Intern. v. Beyond Innovation*, 521 F.3d 1351 (2008) ruled that trial courts must resolve issues re proper scope of claims.
 - ❖ “In deciding that “only if’ needs no construction” because the term has a “well-understood definition,” the district court failed to resolve the parties’ dispute because the parties disputed not the *meaning* of the words themselves, but the *scope* that should be encompassed by this claim language.”
 - ❖ “A determination that a claim term “needs no construction” or has the “plain and ordinary meaning” may be inadequate when a term has more than one “ordinary” meaning or when reliance on a term’s “ordinary” meaning does not resolve the parties’ dispute.”



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Jurisdiction

- ***Regents of the Univ. of Cal. v. Dako North America*, 477 F.3d 1335 (2007):**
 - ❖ In a rare case, the Court granted permission to appeal under 28 USC 1292(b) a claim construction.
 - ❖ Appeals were already pending from denials of preliminary injunctions
 - ❖ The D.Ct. revisited the claim construction in deciding a SJ motion.
 - ❖ Here, judicial efficiency is promoted by hearing the certified appeal, as the matters are intertwined with pending appeals.



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Jurisdiction

- *Immunocept v. Fulbright & Jaworski*, 504 F.3d 1281 (2007) ruled that there is federal court subject matter jurisdiction over a malpractice claim involving the scope of a patent claim.
 - ❖ cf. *Air Measurement Technologies, Inc. v. Akin Gump Strauss Hauer & Feld, L.L.P.*, 504 F.3d 1262 (Fed. Cir. 2007).

Standard of Review

- *De novo*, but likely to be reviewed. See ***Amgen v. Hoechst*** (*denying rehearing*)

Scope of Review

- Fed. Cir. does not exercise its discretion in the first instance. Its task “is solely to review the district court’s decisions for an abuse of discretion.” ***Acumed v. Stryker*, 483 F.3d 800,811 (2007)** (remanding for *post-eBay reconsideration* of permanent injunction).
- The Fed.Cir. focuses on the outcome rather than the opinion used by the tribunal below to reach its decision. *Ormco v. Align Technology*, 498 F.3d 800, 809 n.2 (2007).



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Scope of Review

- The scope of review can be limited by failure to file an amended notice of appeal. This occurred in *Dippin’ Dots v. Mosey*, 476 F.3d 1337, 1342 (2007) because the appellant failed to amend its notice of appeal to mention orders by the district court subsequent to the notice of appeal.
- *But see, Pods v. Porta Stor*, 484 F.3d 1359, 1365 (2007), where the Court treated a failure to file an amended notice of appeal forgivingly.



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Scope of Review-Waiver

- *Central Admixture v. Advanced Cardiac Solutions*, 482 F.3d 1347,1356 (2007):
 - ❖ A claim construction argument not raised at the D.Ct. during the claim construction phase is waived and will not be considered on appeal.
- *MyMail v. America Online*, 476 F.3d 1372, 1376 (2007):
 - ❖ When counsel agreed orally at the *Markman* hearing on certain aspects of the claim meaning, on appeal he “cannot now argue against that claim construction simply because it resulted in an adverse ruling on [SJ].” (internal citations omitted)



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Scope of Review-Waiver

- *Halliburton v. M-I (2008)*
 - ❖ CAFC applied waiver
 - ❖ key issue was meaning of preamble phrase “fragile gel drilling fluid”
 - ❖ Court relied on dependent claims which the D.Ct. did not construe
 - ❖ CAFC said arguments on appeal that the dependent claims add more definiteness was waived because no evidence shown that it was raised below.



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Post Review Issues

- ***E-Pass Technologies v. 3Com*, 473 F.3d 1213 (2007)**
 - ❖ involved interesting issues of post Fed. Cir. review proceedings at the D.Ct. Between the remand and the D.Ct. proceedings, the Fed. Cir. decided *Phillips en banc*.
 - ❖ Held, the first Fed. Cir. panel decision (pre-*Phillips*) is the law of the case unless it is in conflict with a subsequent *en banc* decision of the Federal Circuit or the Supreme Court.
 - ❖ Also, it is improper to interpret the interpretation: "... the terms courts use to enunciate the proper construction of a claim are not themselves limitations that require interpretation." 473 F.3d at 1220.
- Law of the case also applied in *Ormco v. Align*, 498 F.3d 1319 (2007)



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Post Review Issues

- 2008 cases:
 - ❖ *Miken Composites v. Wilson Sporting Goods* (2008) (claim construction issue raised in two earlier cases involving the same patent in suit in *Miken*).
 - ❖ *Symantec Corp. v. Computer Assoc. Intern., Inc.*, 522 F.3d 1279 (2008) (referred back to its earlier construction to ensure consistency)



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Ambiguity

- ***Acumed v. Stryker***, 483 F.3d 800, 806 (2007)
 - ❖ In claim construction, not all ambiguity need be purged.
 - ❖ “However, 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, but this accused product is in no danger of falling within that area.”



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Ambiguity

- ***Central Admixture v. Advanced Cardiac Solutions***, 482 F.3d 1347, 1356 (2007):
 - ❖ The phrase, “adapted to be diluted” does not have any “significant ambiguity” and much less any “intractable ambiguity making the claim ‘not amenable to construction,’ which is the requirement to demonstrate indefiniteness.”



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Indefiniteness

- *Datamize v. Plumtree Software* (2005) -- “aesthetically pleasing look and feel” interface screens. Court sought:
 - ❖ an “objective definition identifying a standard for determining when an interface screen is ‘aesthetically pleasing,’”
 - ❖ a “workable objective standard,” “some objective standard,” “an objective anchor,”
 - ❖ something to “notify the public of the patentee's right to exclude since the meaning of the claim language would depend on the unpredictable vagaries of any one person's opinion ...”



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Indefiniteness

- *Biomedino v. Waters Technologies* (2007)
 - ❖ Held patent invalid for using 112-6 “means” claiming without providing a clear structure that corresponds to the function claimed.
 - ❖ Merely referring to prior art generally, rather than specifically, is insufficient.



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Indefiniteness

- ***Young v. Lumenis, Inc. (2007)*** (cat's claw case)
- Concluded that "near" is not indefinite
- Indefiniteness is only when claims are not amenable to construction OR are insolubly ambiguous.
- Depends on whether claim terms can be given any reasonable meaning – whether a PHOSITA would understand what is claimed
- As used in the claim, "near" is not insolubly ambiguous and does not depart from the ordinary and customary meaning of the word, as meaning "close to or at"
- Specification is consistent with this.



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Indefiniteness: *Halliburton v. M-I*

- ***Halliburton Energy Services v. M-I, 514 F.3d 1244 (Fed. Cir. 2008)***:
 - ❖ Involved fragile gel drilling fluid.
 - ❖ Spec'n described fragileness
 - ❖ Fig. 3 graphed test results
 - ❖ Proposed construction was for (1) fragile, (2) effective as drilling fluid, and (3) w/o substantial clay additives.
 - ❖ One prior art fluid discussed in patent had (1) +(2) but not (3).
 - ❖ Court refused to interpret broad claims to include feature (3):
 - ❖ Not persuaded by spec'n.
 - ❖ Claim differentiation applied.



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Halliburton-2

- Rejected construction for fragileness.
- Phrase was anchored in specification and supported by a drawing
- However, Court disagreed that these disclosures provided meaningfully precise boundaries
- Need more than articulating a claim construction: must have boundaries.
- Claim construction sought functional definition.
- Court wanted to leave room for future improvements; invalidated all claims as indefinite.



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Indefiniteness: *Star Scientific* (2008)

- ***Star Scientific v. R.J. Reynolds Tobacco*, 537 F.3d 1357 (Fed.Cir.2008):**
 - ❖ Cited *Halliburton* for the proposition that 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.**
 - ❖ Claims here had been construed by D.Ct.
 - ❖ Construction was clear.



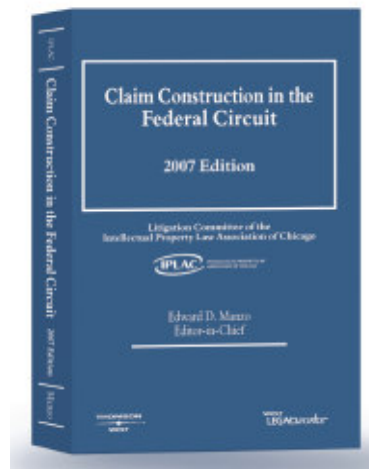
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PTO Claim Construction

- *In re Margolin* (2007)
 - ❖ Reaffirms rule that in a rejection over prior art, the Board first construes claims for purposes of examination
 - ❖ Board applies the broadest reasonable meaning of the terms as they would be understood by a POSITA.

Thank you!

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- General reference: *Claim Construction in the Federal Circuit* (2008 ed.) (Thomson West, Manzo, editor-in-chief)
 - ❖ on Westlaw as database CLAIMCFC.



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- I.P. litigation, client counseling, oversee prosecution, opinions, mediation
- Editor-in-chief:



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- ❖ ***Patent Claim Interpretation—Global Edition*** (~ Nov. 1, 2008)

- Vice President of IPLAC (IP Law Assn. of Chicago)
- Jury Instruction Committee (patents subcommittee) for Seventh Federal Circuit (2005-08).

