

The University of Texas School of Law

16th ANNUAL ADVANCED PATENT LAW INSTITUTE

DEVELOPMENTS IN CLAIM CONSTRUCTION

October 27 - 28, 2011
Austin, Texas

Kenneth R. Adamo*

Kirkland & Ellis LLP
300 N. LaSalle
Chicago, IL 60654

E-mail: kradamo@kirkland.com

*Member, Illinois, New York, Ohio and Texas Bars. This article reflects only the present considerations and views of the author, which should not be attributed to Kirkland & Ellis LLP or to any of his or its former or present clients. © 2011 Kenneth R. Adamo. All Rights Reserved.

TABLE OF CONTENTS

	Page
Introduction.....	1
General Rules of Claim Construction	1
Specification As Claim Construction Tool	3
1. Arlington Industries, Inc. v. Bridgeport Fittings, Inc.	3
2. Retractable Technologies, Inc. v. Becton, Dickson & Co.	5
3. Markem-Imaje Corp. v. Zipher Ltd.	7
Claim Differentiation	10
Preambles As Claim Limitations	12
Means Plus Function Limitations	15
Claim Terms and Claim Structures.....	18
1. There Is No Hard Rule That “A” or “An” In A Comprising Claim Means “One Or More Than One.”	18
2. “At Least About” May Be Indefinite.	19
3. When Is A Range Not A Range.....	20
4. Combining Multiple Parts Of A Whole To Create A “Plurality” Renders Any Differences Between Plural And Singular Claim Language Superfluous	21
Sequence of Steps in Method Claim.....	22
Dependent Claims	24
Binding Effect of Prior Claim Construction	24
1. Effects on the Patent Owner	24
2. Effects on New Parties/”Strangers” to the Earlier Case and Markman Construction.....	25
3. Related Claim Construction Consistency/Common Sense Points	28
a. A Construction In Case 1 May Be Relevant To Willfulness Issues In Case 2.....	28

TABLE OF CONTENTS (CONT'D)

	Page
b. Judicial Estoppel Applies to Claim Construction If You Try to Give Court a Moving Target.....	28
c. If the Court Changes the Claim Construction During Trial, Ask For Another Trial.....	29
d. Reexamination Changes In Claim Construction May Cost You In Trial Court Credibility.....	30
Markman Procedural Issues and Miscellaneous	30
1. Juice, Bites and the Like	30
2. If You're Going to Offer Expert Testimony Extrinsic Evidence, You'd Better Do It According to Hoyle.	31
3. O2 Micro Construction Issues Only Arise In Factually-Identical Procedural Circumstances.....	32
4. ED Texas's Latest Contribution to Effective Markman Practices: The Mini-Markman.....	33
Conclusion	34

Introduction

Claim construction remains the cornerstone of the two principal considerations in every matter involving U.S. patents: infringement and the validity of the claims in issue. As is usual in the jurisprudence of the United States Court of Appeals for the Federal Circuit (“Federal Circuit”), while the basics of claim construction are set, the court’s recent opinions have, as always, demonstrated that the devil is in the details. One may expect that the changeover of the court’s bench, both in the judges themselves, as well as in the position of Chief Judge, will tell in these claim construction cases, as well as the usual revisiting, refinement and refocusing inherent in the case-to-case factual/situational differences presented to the court.

General Rules of Claim Construction

For the most part, the substantive basics of how - correctly - to carry out claim construction, remain as stated in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (*en banc*). Intrinsic evidence - the claim itself whose terms are in issue, other claims, the specification and the prosecution history (file wrapper) - remains ascendant, with extrinsic sources, including expert testimony, maintaining their secondary roll.

See, e.g., ERBE Elektromedizin GmbH v. Canady Tech. LLC, 629 F.3d 1278 (Fed. Cir. 2010) (intrinsic evidence, particularly prosecution history, confirmed correctness of trial court construction of term); *Solvay S.A. v. Honeywell Int’l Inc.*, 628 F.3d 1359 (Fed. Cir. 2010) (rejected Honeywell’s narrow construction of “isolating,” finding that neither claim language nor the specification required isolation of the non-ozone depleting hydrofluorocarbon whose method of making was in issue; specification showed use of “isolating”, “separating” and “drawing off” interchangeably, with expert testimony interpreting “isolating” to mean “purifying” being insufficient to overcome the intrinsic evidence); *Lazare Kaplan Int’l, Inc. v. Photoscribe Techs., Inc.*, 628 F.3d 1359 (Fed. Cir. 2010) (non-infringement rulings regarding claims 1 and 7 of ‘351 patent vacated, based on improper construction of the term “controlling the directing,” trial court erroneously limited the term to “automatic” feedback derived from optimal images of a gemstone “during” the laser burn process; nothing in the claim language or the prosecution history that expressly precluded “manually” imaging “before” the laser burn process began. *Id.* at 1368. Further, were multiple statements in the ‘351 patent specification indicating that the “controlling” limitation included “control based on either automated or manual feedback derived from optical images or a gemstone, before or during the laser burn process.” *Id.* at 1369); *St. Clair Intellectual Prop. Consultants, Inc. v. Canon, Inc.*, 412 Fed. Appx. 270 (Fed. Cir. 2011) (trial court construed “computer apparatus” as “a computer and any operating system or application software loaded on the computer”; interpreted “data formats” to mean the arrangement of digital data in a file; and construed “plurality of different data formats” to include both still images and movie formats; at trial, jury found each of asserted claims was valid/infringed by Fuji products; finding error in claim construction, Federal Circuit reversed infringement finding; court found that the plain language of the limitation “different data formats for different types of computer apparatus,” recited in claims 16 and 17 of the ‘459 patent and claim 10 of the ‘219 patent, referred to data formats that corresponded to particular “computer architectures,” i.e., operating systems combined with hardware; reviewing the common specification and prosecution history, the court determined that the problem being solved by the

patented inventions related to compute architecture incompatibility rather than data format incompatibility. The court concluded that to remain “faithful” to the invention, “computer apparatus” must be construed to mean “computer architecture.” *Id.* at 275; finding that the data formats of the accused Fuji products did not correspond to specific computer architectures, the Federal Circuit held that Fuji’s products did not infringe claims 16 and 17 of the ‘459 patent and claim 10 of the ‘219 patent; the court next rejected St. Clair’s contention that claim 1 of the ‘010 patent, and claims 1 and 3 of the ‘899 patent should be construed differently than the asserted claims of the ‘459 and ‘219 patents because the claims use different language. Although finding no evidence in the record that St. Clair agreed to construe the asserted claims consistently across all the patents, the Federal Circuit concluded that since each patent shares a common specification and uses similar terminology, the limitations in the asserted claims of the ‘010 and ‘899 patents should have the same meaning as the asserted claims of the ‘459 and ‘219 patents. Additionally, “[b]ecause an examiner in reexamination can be considered one of ordinary skill in the art, of his construction of the asserted claims carries significant weight,” the Federal Circuit found that remarks made by five examiners, including three Supervisory Patent Examiners, during reexamination of the asserted patents, supported Fuji’s construction of “computer apparatus” to mean “computer architecture.” *Id.* at 276; the court also rejected the trial court’s construction of “plurality of data formats” recited in claim 16 of the ‘459 patent to include movie data formats as well as still images. Reviewing the specification, the Federal Circuit found that the words “still” and “image” consistently referred to a single picture. Further, the court stated that the specification’s two ambiguous references to movie formats were insufficient to overcome the explicit references to still picture formats; in dissent, Judge Moore criticized the majority’s reliance on the examiner’s statements during reexamination, pointing out that a patentee’s remarks, not the examiner’s, are relevant in determining whether claim scope was disavowed (Bloomberg Law Reports, (Intellectual Property, Jan. 31, 2011, pgs. 13-14).)

See also Nuclimate Air Quality Sys. Inc. v. Airtex Mfg. P’ship, Civil Action No. 5:08-cv-00317 (N.D.N.Y. Jan. 10, 2011). (The court granted defendant’s motion for summary judgment of infringement of its air handling system patent following claim construction. “[T]he court’s reading of the specification, which is the most relevant of the intrinsic evidence and must be relied upon before less significant extrinsic evidence such as dictionary definitions or the deposition testimony of a party, reveals that the terms ‘transverse vertical cross-section’ and ‘Venturi effect’...are not ambiguous and are, as [defendant] argues, readily understood. Further, the terms are satisfied by the [accused product.]”)

Claim scope issues arising in connection with a reissued patent called for strict adherence to the *Phillips* analytic regime in *ALA Engineering Ltd. v. Magotteaux Int’l SA*, --- F.3d ---, Appeal No. 2011-1058, 2011 WL 3862645 (Fed. Cir. Aug. 31, 2011). There, the Federal Circuit reversed a trial court’s summary judgment that Magotteaux’s reissue patent claims for composite wear components were invalid under Section 251 because the patentee had not impermissibly recaptured any surrendered subject matter upon reissue. While claim scope may be broadened through reissue within two years after the patent grant, the recapture rule “prevents a patentee from regaining subject matter deliberately surrendered during the prosecution of the original patent.” Magotteaux sought to replace the original patent claim language “homogenous solid solution” with “homogenous ceramic composite,” and the USPTO reissued the patent with this change. After employing its claim construction framework from *Phillips v. AWH* - focusing on the claims, written description, and original prosecution history and using the extrinsic evidence