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DEVELOPMENTS IN CLAIM CONSTRUCTION

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Kenneth R. Adamo*

Kirkland & Ellis LLP

300 N. LaSalle

Chicago, IL 60654

(312) 862-2671

E-mail: kradamo@kirkland.com

*Member, Illinois, New York, Ohio and Texas Bars. This paper 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. © 2013 Kenneth R. Adamo. All Rights Reserved.

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Introduction

Claim construction still comprises the bedrock providing essential foundation to the two principal considerations in every litigated matter involving U.S. patents: the infringement and the validity of the claims in issue. Claim construction is also part and parcel of every prosecution before the USPTO, albeit under an (alleged to be) different construction paradigm, “broadest reasonable construction in view of the specification”. And it is certainly a major driver in the new USPTO post grant IPR procedure, where the petitioner is required to provide (at least a limited) claim construction as part of its petition seeking PTAB review (*see* 37 CFR § 42.104(b)).

The recent jurisprudence of the United States Court of Appeals for the Federal Circuit (“Federal Circuit”), while maintaining the basics of claim construction in a substantially fixed state, displays challenging if not confusing variance in its further derivation and refinement of that law, year-on-every year. These variations are not simply artifacts of the different factual situations presented by each case; they are the effects of panel differences and the legal beliefs, positions and understandings of each judge, possibly amplified by the marked personnel changeover in the Federal Circuit over the last several years.

The United States Supreme Court has not revisited *Markman* since it was decided in 1995, such that it’s jurisprudence, which trumps all others, has not shifted to cause the Federal Circuit to have to shift to follow along.

The resulting challenge is to stay with a changing court as its seminal claim construction rules are revisited, refocused and then applied, driven or facilitated by the situational differences as the panels or the *en banc* court finds them, case-to-case.

General Rules of Claim Construction

The substantive basics to correctly carry out claim construction continue as stated in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (*en banc*). Intrinsic evidence – the specific claim whose term(s) are in issue, other claims, the specification and the prosecution history (file wrapper) – controls, with extrinsic evidence, including expert testimony and dictionaries, continuing in its secondary role.

As to what arguably happens when one diverges from this methodology, *see Kruse Tech. Partnership v. Volkswagen AG*, 2013 U.S. App. LEXIS 20457 (Fed. Cir. 2013) where the Federal Circuit affirmed the trial court’s summary judgment of non-infringement.

The control issue was a conflict between the plain language of claim 1 of the ‘562 patent in suit and its dependent claim 4. Claim 1 was limited by requiring the “the combustion as a result of the introduction of the second fraction is a substantially isothermal process.” Claim 4 essentially divided combustion into “first, constant pressure combustion:” and then “secondly,, isothermal combustion.”

Focusing on the use of the word “the” and “is” in claim 1, the majority concluded that the claim “requires a substantially constant temperature for the entire second fraction combustion.” The court said it would not alter that construction simply to avoid a conflict with claim 4.

Quoting *Haemonetics Corp. v. Baxter healthcare Corp.*, 607 F.3d 776, 782 (Fed. Cir. 2010), the court said, “we do not redraft claims to contradict their plain language in order to avoid a nonsensical result.”

The court also rejected the argument that the construction would exclude an embodiment disclosed in the specification that showed the combustion divided into two portions, where only the second portion was isothermal. **“The mere fact that there is an alternative embodiment disclosed in the asserted patent that is not encompassed by our claim construction does not outweigh the language of the claim, especially when the court’s construction is supported by the intrinsic evidence,”** the court said, quoting *August Tech. Corp. v. Camteck, Ltd.*, 655 F.3d 1278, 1285 (Fed. Cir. 2011).

Judge Wallach dissented, stating that: **“I agree with the majority that claims should be construed based on precepts of English grammar, that the doctrine of claim differentiation is not a hard and fast rule, and that claims need not encompass every disclosed alternative embodiment,”** **“However, when a particular interpretation of a claim simultaneously violates all of these doctrines, such a construction may not be tenable.”** In order to “stay true to the claim language and the written description of the invention,” he interpreted the word “substantially” in claim 1 to refer to the duration of the combustion rather than as a modifier of “isothermal process.” He said that the claim language was ambiguous and recourse to the specification—including embodiments that majority was willing to exclude—supported his interpretation.

Dutra, “Volkswagen Non-infringement of Engine Patent Affirmed by Split Federal Circuit,” 86 PTCJ 1183 (Oct. 2013).

1. Even Though It Is Extrinsic Evidence, Expert Testimony Should Be Disregarded Carefully, If It Is For Evidentiary Reasons

In *SkinMedica, Inc. v. Histogen, et al.*, 2013 U.S. App. LEXIS 17627 (Fed. Cir. 2013), the Federal Circuit affirmed a grant of summary judgment of noninfringement, which was grounded in the trial court’s claim construction. The slip opinion ran 43 pages in manuscript, responded to by Chief Judge Rader’s 8 page dissent.

Among other claim construction evidence reviewed by Judge Prost, writing for the panel majority, was the deposition testimony of Dr. Salomon, offered by SkinMedica to refute the finding of a disclaimer of “beads” as satisfying the “culturing in three-dimensions” element of representative claim 1 of the ‘494 patent in suit. The trial court had given no weight to that testimony, finding that it was “inconsistent with the intrinsic patent record.” *Id.* at *13

In concluding that “Dr. Salomon’s opinions are unhelpful to our analyses here[:] They are conclusory and incomplete; they lack any substantive explanation tied to the intrinsic record; and they appear to conflict with the plain language of the written description” *Id.* at *62-63, the court noted that:

SkinMedica asserts that Dr. Salomon testified that three-dimensional bead cultures can produce the same benefits of three-dimensional culturing described by the patents. To support that assertion, it points us to a single passage from Dr.

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