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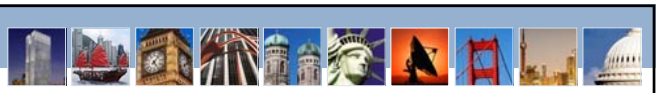

The University of Texas School of Law

20th ANNUAL ADVANCED PATENT LAW INSTITUTE

# RECENT DEVELOPMENTS IN CLAIM CONSTRUCTION

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## Deference to District Court in Claim Construction Review

- *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S.Ct. 831 (2015)

> [W]hen the trial court reviews only evidence intrinsic to the patent (the patent claims and specifications, along with the patent's prosecution history), the judge's determination will amount solely to a determination of law, and the Court of Appeals will review that construction *de novo*. **In some cases, however, the trial court will need to look beyond the patent's intrinsic evidence and to consult extrinsic evidence in order to under-stand, for example, the background science or the meaning of a term in the relevant art during the relevant time period....In cases where those subsidiary facts are in dispute, courts will need to make subsidiary factual findings about that extrinsic evidence. These are the "evidentiary underpinnings" of claim construction that we discussed in *Markman*, and this subsidiary fact finding must be reviewed for clear error on appeal.** Slip op. at 11-12 (emphasis added).

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## Federal Circuit Applying *Teva*

- *Lighting Ballast Control LLC v. Philips Elect. N. Am. Corp.*, 790 F.3d 1329 (Fed. Cir. 2015)
  - Deferring to trial court's factual findings based on extrinsic evidence.
- *In re Papst Licen. Digital Camera Pat. Litig.*, 778 F.3d 1255 (Fed. Cir. 2015)
  - Giving no deference to the trial court's review of expert extrinsic evidence because the evidence was not relied upon to understand the meaning of the claims.
- *Fenner Inv., Ltd. v. Cellco P'ship*, 778 F.3d 1320 (Fed. Cir. 2015)
  - Affirming trial court's construction based on *de novo* review of intrinsic evidence.
- *Enzo Biochem v. Applera Corp.*, 780 F.3d 1149 (Fed. Cir. 2015)
  - Reversing trial court's constructions after *de novo* review of intrinsic evidence.
- *Shire Dev. LLC v. Watson Pharm, Inc.*, 787 F.3d 1359 (Fed. Cir. 2015)
  - Reviewing *de novo* trial court's constructions, where court heard testimony from expert witnesses, because there was no indication that trial court relied on experts.

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## Federal Circuit Applying *Teva* (cont.)

- *Kaneka v. Xiamen Kingdomway Group, TomTom, Inc. v. Adolph*, 790 F.3d 1298 (Fed. Cir. 2015) and 790 F.3d 1315 (Fed. Cir. 2015)
  - Reviewing trial court's constructions *de novo* where the meaning of disputed terms could be ascertained from the intrinsic evidence.
- *Info-Hold, Inc. v. Applied Media Techs. Corp.; Info-Hold, Inc. v. Muzak LLC*, 783 F.3d 1262 (Fed. Cir. 2015) and 783 F.3d 1365 (Fed. Cir. 2015)
  - Declining to review trial court's constructions for clear error where there was no factual dispute about content of extrinsic evidence and the trial court made no findings based on extrinsic evidence.
- *Cephalon, Inc. v. Abraxis Bioscience, LLC*, 2015 WL 3756870 (Fed. Cir. June 17, 2015)
  - "The terms 'microparticles' and 'nanoparticles' are technical words, and how the relevant scientific community understands them is therefore a question of fact reviewable for clear error."
- *See also* Cherny and O'Quinn, *Claim Construction's Journey In The 9 Months Since Teva*, Law360, http://www.law360.com/ip/articles/718512/(11/2/15)

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## Specification As Claim Construction Tool

- Objects of the Invention
  - *Pacing Tech., LLC v. Garmin Int'l, Inc.*, 778 F.3d 1021 (Fed. Cir. 2015).
- The Present Invention
  - *FenF, LLC v. SmartThingz, Inc.*, 601 Fed. Appx. 950 (Fed. Cir. 2015).
    - The phrase "the present invention" is often a keystone for interpreting a claim in light of the specification.
- Single Embodiment is Not a Restriction Absent Clear Intention
  - *Info-Hold, Inc. v. Applied Media Techs. Corp.*, 783 F.3d 1262 (Fed. Cir. 2015).
    - The Federal Circuit "expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment." Slip op. at 9
    - "[T]he scope of the invention is properly limited to the preferred embodiment if the patentee uses words that manifest a clear intention to restrict the scope of the claims to that embodiment." Slip op. at 10.
- Importing Limitations or Reading Out Preferred Embodiment
  - *Inline Plastics Corp. v. EasyPak, LLC,* 799 F.3d 1364 (Fed. Cir. 2015).

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## Preamble As Limitation

- Yes
  - *Groupon, Inc. v. Blue Calypso*, CBM2013-00033 (PTAB 12/17/14).
  - *Pacing Techs, LLC v. Garmin Int'l, Inc.*, 778 F.3d 1021 (Fed. Cir. 2015).
    - Preamble acted as a disclaimer.
- No
  - *TomTom, Inc. v. Adolph*, 790 F.3d 1315 (Fed. Cir. 2015).
  - *Agilysys, Inc. v. Ameranth, Inc.*, CBM2014-00015 (PTAB 3/20/15).

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# Title search: Recent Developments in Claims Construction



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