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RECENT DEVELOPMENTS IN CLAIM CONSTRUCTION

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General Construction Principles

- *Cardsoft, LLC v. VeriFone*, 769 F.3d 1114 (Fed. Cir. 2015)
 - Reliance on prior precedent defining “virtual machine” does not trigger deferential review under *Teva*, as extrinsic evidence, where precedent was consistent with the intrinsic record.
- *Akzo Nobel Coatings, Inc. v. Dow Chem. Co.*, 811 F.3d 1334 (Fed. Cir. 2016)
 - Construction that gives all terms meaning is preferred over one that does not.
- *SimpleAir v. Sony Ericsson Mob. Comm’ns AB*, 820 F.3d 419 (Fed. Cir. 2016)
 - Construction that renders some terms superfluous is generally disfavored.
- *Atlas IP, LLC v. St. Jude Medical, Inc.*, 804 F.3d 1185 (Fed. Cir. 2015)
 - Construction that results in inoperability should be viewed with skepticism.
- *LifeNet Health v. Lifecell Corp.*, 2016 WL 4933224 (Fed. Cir. 2016)
 - No *O2 Micro* violation, where claim construction argument presented on appeal was not unresolved at the trial court level.

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Timing of Claim Construction

- *Phoenix Lic., LLC v. Adv. Am., Cash Adv. Centers, Inc.*, 2-15-CV-01367 (E.D. Tex. 9/30/16) [Gilstrap, J.]
 - **Denying Section 101 motion**, noting that many Section 101 motions are resolved without claim construction, **holding that claim construction was needed** to obtain “a full understanding of the basic character of the claimed subject matter.”
- *Malibu Boats, LLC v. Master Craft Boat Co., LLC*, 3-15-CV-00276 (E.D. Tenn. 2/11/16)
 - **Denying summary judgment, despite earlier claim construction of the same patent in another case**, holding that further claim construction was required.
- *Shenzhen Leown Elecs. v. Disney Ent., Inc.*, IPR2015-001656 (PTAB 3/18/16)
 - **Denying new claim construction in a rehearing request**, based on new evidence and argument, **as improper because cannot overlook or misapprehend new matters**.
- *Akamai Techs., Inc. v. Limelight Net., Inc.*, 805 F.3d 1368 (Fed. Cir. 2015)
 - **Denying claim construction challenge at jury instruction stage**, where **construction was not disputed** during the *Markman* hearing.

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Plain Meaning – Ordinary Meaning, Ordinary Artisan, After Reading Entire Patent

- *Eon Corp IP Holdings LLC v. Silver Spring Networks, Inc.*, 815 F.3d 1314 (Fed. Cir. 2016)
 - “Plain and ordinary” meaning construction must provide the jury with a clear understanding of the disputed claim scope. **Instructing the jury to assume the plain and ordinary meaning without resolving the parties’ dispute as to claim scope left the legal task of claim construction to the jury. This is improper under *O2 Micro*.**
 - Trial court’s approach erred for two reasons: there was no single, accepted meaning of the disputed terms, and the plaintiff’s definition was not viewed in context of the patent and was completely untethered from the invention.
 - **Claim construction order that a term needs no construction “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.”**
- *Tr. of Columbia Univ. v. Symantec Corp.*, 811 F.3d 1359 (Fed. Cir. 2016)
 - Claim terms must be interpreted in the context of the specification.
 - **Federal Circuit rejected Columbia’s argument that claim terms must carry their “accustomed meaning in the relevant community” unless expressly redefined or disavowed.** The Court explained that terms are to be interpreted in the context of the specification and that any resort to dictionaries only comes later, if necessary.

Specification As Claim Construction Tool

- *Straight Path IP Grp, Inc. v. Sipnet EU*, 806 F.3d 1356, 1361 (Fed. Cir. 2015)
 - **“When claim language has as plain a meaning on an issue as the language does here, leaving no genuine uncertainties on interpretive questions relevant to the case, it is particularly difficult to conclude that the specification reasonably supports a different meaning.** The specification plays a more limited role than in the common situation where claim terms are uncertain in meaning in relevant respects. . . . **Reflecting the distinct but related roles of the claims and specification, the governing approach to claim construction thus maintains claim language’s key (not always decisive) role in claim construction: it stresses the importance of the specification in identifying and resolving genuine uncertainties about claim language, and in stating redefinitions or disavowals, while it rejects a sequenced, dictionary-driven, burden-shifting approach to claim construction.** Under our *Phillips* approach, the plainness of the claim language necessarily affects what ultimate conclusions about claim construction can properly be drawn based on the specification.”

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