



The University of Texas School of Law

12th ANNUAL ADVANCED PATENT LAW INSTITUTE

RECENT DEVELOPMENTS IN CLAIM CONSTRUCTION

March 9-10, 2017
U.S. Patent and Trademark Office – Alexandria, VA

Kenneth R. Adamo*
Eugene Goryunov**

Kirkland & Ellis LLP
300 N. LaSalle
Chicago, IL 60654
(312) 862-2671

E-mail: kradamo@kirkland.com ; egoryunov@gmail.com

*Member, Illinois, New York, Ohio and Texas Bars. **Member, Illinois Bar. This presentation reflects only the present considerations and views of the authors, which should not be attributed to Kirkland & Ellis LLP or to any of their or its former or present clients. © 2017 Kenneth R. Adamo and Eugene Goryunov. All Rights Reserved.



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.

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.
- *Arthrex, Inc. v. Smith & Nephew, Inc.*, 2-15-CV-01047-RSP (E.D. Tex. 12/22/16)
 - **Claim construction waived**, when first requested during jury change conference.

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.

4

Specification As Claim Construction Tool

- *ProFoot Inc. v. Merck & Co., Inc.*, Appeal No. 2016-1216, slip op. (Fed. Cir. Oct. 26, 2016)
 - The Federal Circuit said a trial court’s ruling on claim construction was not made in error when he determined that a claim requiring a “neutralizer” to customize orthotic shoe inserts required three components — a housing, a protractor and an adjustable plate — that basically comprised a measuring device. On appeal, ProFoot said the claim construction was too narrow, that a neutralizer should be defined by functional ability rather than by particular physical elements.
 - The court affirmed: **“Although ProFoot is correct that the asserted claims do not recite the specific components that comprise the neutralizer, we agree with the district court that, when read in the context of the ’568 patent, this term requires a device that includes these components.”** **“Because the [abstract and] specification consistently and repeatedly discloses that the neutralizer includes the housing, protractor, and angularly adjustable plate components, the district court did not err in including them in its construction,”** the court said.
 - **In addition, the court said the prosecution history of the parent application lends credence to the trial court’s claim construction ruling:** the claimed neutralizer was not found in the originally filed claim set but was added during prosecution with an express claim requirement that the neutralizer include the physical elements (housing, protractor, etc.). **Although the physical components are not included in the child application, the court noted that the patentee never indicated that it intended the child-patent neutralizer to be any different from the parent-patent neutralizer.**
 - **ProFoot made a claim-differentiation argument i.e., the child application does not include the express limitations that are included in the parent and therefore should be seen as broader.** The court rejected that argument as not providing any further information as to what the inventor understood “neutralizer” to include.

5

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](http://utcle.org/elibrary)

Title search: Recent Developments in Claim Construction

Also available as part of the eCourse

[2017 Advanced Patent Law \(USPTO\) eConference](#)

First appeared as part of the conference materials for the
12th Annual Advanced Patent Law Institute session
"Claims Construction"