

The University of Texas School of Law

22nd ANNUAL ADVANCED PATENT LAW INSTITUTE

RECENT  
DEVELOPMENTS IN  
CLAIM CONSTRUCTION

November 2-3, 2017  
Four Seasons Hotel  
Austin, Texas

Kenneth R. Adamo\*

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

E-mail: [kradamo@kirkland.com](mailto: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. © 2017 Kenneth R. Adamo. All Rights Reserved.

## TABLE OF CONTENTS

	<u>Page</u>
<b>I. GENERAL CONSTRUCTION .....</b>	<b>1</b>
1. Failure to Construe Is An <i>02 Micro</i> Violation .....	1
<b>II. TIMING OF CLAIM CONSTRUCTION .....</b>	<b>5</b>
1. Early Construction.....	5
2. Claim Construction Relating to 35 U.S.C. §101 - Based Motions.....	6
3. Amending Infringement/Invalidity Contentions Post- Construction .....	7
<b>III. USE OF SPECIAL MASTER FOR CLAIM CONSTRUCTION.....</b>	<b>7</b>
<b>IV. USE OF SPECIFICATION RE CLAIM CONSTRUCTION .....</b>	<b>8</b>
<b>V. ORDINARY/PLAIN MEANING .....</b>	<b>17</b>
<b>VI. EXTRINSIC EVIDENCE/DICTIONARIES .....</b>	<b>21</b>
<b>VII. TRANSITIONAL TERMS.....</b>	<b>22</b>
1. “Consisting Essentially of” .....	22
<b>VIII. PREAMBLES.....</b>	<b>24</b>
<b>IX. NEGATIVE LIMITATIONS.....</b>	<b>29</b>
<b>X. MARKUSH GROUP LIMITATIONS.....</b>	<b>33</b>
<b>XI. PRODUCT BY PROCESS CLAIMS.....</b>	<b>35</b>
<b>XII. MIXED APPARATUS AND METHOD CLAIMS.....</b>	<b>37</b>
<b>XIII. JEPSON-FORM CLAIMS.....</b>	<b>38</b>
<b>XIV. MEANS PLUS FUNCTION LIMITATIONS/FUNCTIONAL CLAIMING RE IPR INITIATION .....</b>	<b>41</b>
<b>XV. MEANS PLUS FUNCTION LIMITATIONS /FUNCTIONAL LIMITATIONS .....</b>	<b>42</b>

<b>XVI. MEANING OF MISCELLANEOUS TERMS.....</b>	<b>49</b>
1. “On” .....	49
2. “Said” .....	50
<b>XVII. PROSECUTION HISTORY DISCLAIMER.....</b>	<b>51</b>
<b>XVIII. EXPERT TESTIMONY IN CONFLICT WITH <i>MARKMAN</i></b>	
<b>CONSTRUCTION.....</b>	<b>61</b>
<b>XIX. NEW CLAIM CONSTRUCTION.....</b>	<b>67</b>
<b>XX. NEW CLAIM CONSTRUCTION -- NEW EVIDENCE .....</b>	<b>70</b>
<b>XXI. IPR/CBMR/PGR CLAIM CONSTRUCTION .....</b>	<b>71</b>
1. Broadest Reasonable Interpretation Basics .....	71
2. Broadest Reasonable Interpretation Particulars .....	76
<b>XXII. APPEAL &amp; INTERLOCUTORY REVIEW.....</b>	<b>79</b>
<b>XXIII. SANCTIONS .....</b>	<b>83</b>

Claim construction continues as the bedrock providing essential foundation to the two principal considerations in every litigation/contested matter involving U.S. patents: the infringement and the validity of the claims in issue. Claim construction is also part and parcel of every USPTO proceeding under its “broadest reasonable construction in view of the specification to one of ordinary skill in the art,” claim construction rubric, particularly in the new USPTO post grant IPR/PGR/CBMR procedures, where the petitioner is required to provide (at least a limited) claim construction as part of its petition seeking PTAB review. *See* 37 C.F.R. § 42.104(b).

Yet again, the latest jurisprudence of the United States Court of Appeals for the Federal Circuit (“Federal Circuit”) and its overseeing court, the United States Supreme Court has, while - possibly surprisingly - maintaining the *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (*en banc*), over-arching methodology intact (even insofar as the PTAB is usually concerned), has made major and minor changes in applicable precedent and procedure.<sup>1</sup>

## I. GENERAL CONSTRUCTION

### 1. Failure to Construe Is An 02 Micro Violation

As discussed in Crouch’s Patently-O Blog post of August 15, 2017, in *Homeland Houseware v. Whirlpool Corp.*, Appeal No. 2016-1511, slip op (Fed. Cir. Aug. 4, 2017), the federal lawsuit reversed the PTAB’s IPR invalidity judgment favoring Whirlpool, holding that the challenged claims were invalid as anticipated.

The underlying claimed invention was an *automatically* pulsed blender cycle. The basic idea was to occasionally go through a “deceleration phase” that slows the cutter blade down to a reduced “predetermined settling speed” before accelerating the blade back to the normal operating speed. The claims required that the settling speed be “indicative of the items in the container having settled around the cutter assembly.”

The basic issue on appeal was whether the prior art (U.S. Patent No. 6,609,821 to Wulf) anticipated Whirlpool’s patent:

“The Board determined that Wulf did not anticipate the ‘688 patent because its disclosures did not meet the “settling speed” limitation.

---

<sup>1</sup> USITC, District Court and PTAB materials, not otherwise attributed, were physically sourced / excerpted from Author - reviewed *Docket Report* daily published documents, in accordance with License and Permitted Uses for *Docket Report*, <http://home.docketnavigator.com/terms-of-use> (5/22/13 rev.).

However, **the Board did “not adopt any explicit construction of the term for [its] Final Written Decision,”**

The Federal Circuit first found that the PTAB should have construed the disputed language:

**Just as district courts must, “[w]hen the parties raise an actual dispute regarding the proper scope of . . . claims, . . . resolve that dispute,”** *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1360 (Fed. Cir. 2008), **the Board also must resolve such disputes in the context of IPRs.**

Judge Dyk, writing for the panel, then took on the claim construction and anticipation analysis on its own:

**Given that the Board did not rely on extrinsic evidence here as to claim construction, we can determine the correct construction of “settling speed”** and then determine whether the Board correctly held that Wulf does not meet the limitations of claim 1.

Crouch was not taken with the end result:

In my view, the court’s statement reprinted above is wrong in so many ways. **Of course the the Board did not “rely on extrinsic evidence” in claim construction — since the board “declined to provide a construction.” Further, even when the claim construction considered is a question of law and reviewed de novo, the appellate court is still a reviewing court – not a court of first instance.** Here, the court reviews substantial intrinsic evidence in making its claim construction determination, and **it is merely a legal fiction that the resulting conclusions are not ‘factual interpretations’ that should be based upon more than a review of the appellate docket submissions. . . .**

The actual claim construction issue here is somewhat odd – the claim language states that “the speed of the cutter assembly is reduced from the operating speed to a predetermined settling speed . . . indicative of the items in the container having settled around the cutter assembly.” The construction offered by the federal circuit here is that the settling speed is “slower than the operating speed and permits settling of the blender contents.” **WOW – good thing that the court provided a construction here since that wasn’t apparent from the claims.**

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 Claims Construction: Fall 2017

Also available as part of the eCourse

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

First appeared as part of the conference materials for the 22<sup>nd</sup> Annual Advanced Patent Law Institute session "Recent Developments in Claims Construction"