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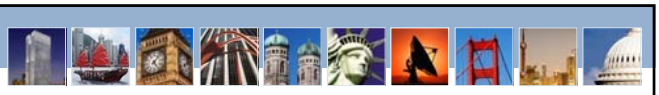

22nd Annual Advanced Patent Law Institute

RECENT DEVELOPMENTS IN CLAIM CONSTRUCTION

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Failure to Construe is an *O2 Micro* Violation

- *Homeland Houseware v. Whirlpool Corp*., 865 F.3d 1372 (Fed. Cir. 2017).
  - **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.**
- *NobelBiz Inc. v. Global Connect, LLC*, 2017 WL 3044641 (Fed. Cir. July 19, 2017).
  - The parties had asked the court to construe several patent claim terms, but the court declined, saying those terms should be given their plain and ordinary meaning, and allowed experts on both sides to testify to the meaning of the terms during trial. **"Allowing the experts to make arguments to the jury about claim scope was erroneous," the panel wrote. "The district court had the responsibility to determine the scope of the asserted claims."**
  - Pursuant to *O2 Micro*, **it is not enough for the court to simply state that the definition use "well understood" when the parties dispute the scope covered by the claims because that would leave the jury with the responsibility of determining the claim scope.**

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Failure to Construe is an *O2 Micro* Violation (cont.)

- *Asetek Danmark v. CMI USA Inc.*, 852 F.3d 1352 (Fed. Cir. 2017).
  - The Federal Circuit rejected CMI's argument because it did not request construction of the claim terms "removably attached" or "removably coupled" and did not object to the trial court's jury instructions on these claim terms.
  - The court stated that **"where the parties and the district court elect to provide the jury only with the claim language itself, and do not provide an interpretation of the language in the light of the specification and the prosecution history," the jury's findings "must be tested by the charge actually given and by giving the ordinary meaning of the language of the jury instruction,"** and the only question is one of substantial evidence.

3

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Plain and Ordinary Meaning

- *TVIIM, LLC v. McAfee, Inc.*, 851 F.3d 1356 (Fed. Cir. 2017).
  - The Federal Circuit addressed the issue of whether jury determinations of invalidity and non-infringement were inconsistent **where claim terms had more than one possible "plain and ordinary meaning."**
  - The court upheld the verdict and the trial court's subsequent denial of a new trial, **concluding that the patentee had waived any claim construction arguments, that the determinations of non-infringement and invalidity were consistent, and that any claim construction error was harmless in light of the patentee's concessions regarding invalidity.**

4

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Timing of Claim Construction – Early Construction

- *Iris Connex, LLC v. Acer Am. Corp*., Civil Action No. 2-15-cv-1909 (E.D. Tex. 9/12/16).
  - "[E]arly claim construction on a limited set of disputed terms followed by entry of summary judgment is appropriate if a superficial understanding of the accused products makes it clear that a single limitation is obviously absent from the accused products and that full blown discovery could not lead a reasonable jury to any other conclusion."
- *Scripps Research, Int'l v. Illumina Inc.*, Civil Action No. 16-cv-661 (S.D. Cal. Apr. 14, 2017).
  - It is unusual for a court to perform claim construction at the motion-to-dismiss stage but a court may do so under certain circumstances: "Defendant's argument is premised on what is perhaps one of the most appropriate exercises of claim construction at the pleading stage: a claim of lexicography; that is, that the '596 patent itself allegedly provides an explicit definition of parameter 'a.' If true, the patent's definition would control, Plaintiff's infringement theory based on another construction would be erroneous, and reliance on extrinsic evidence would be inappropriate."

5

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Timing of Claim Construction – Section 101

- *Tatcha, LLC v. Landmark Tech. LLC*, Civil Action No. 3-16-cv-483 (N.D. Cal. Mar. 20, 2017).
  - The court denied without prejudice plaintiff's motion for judgment on the pleadings on the ground that defendant's financial transaction processing patent encompassed unpatentable subject matter because claim construction had not occurred: "[Defendant] asserts that the '[patent] claims a specific hardware improvement to the terminal: an unconventional arrangement of components such that its DMA unit is positioned independently along a second information handling connection, so data can be stored immediately into memory without having to traverse the first information handling connection which is fully engaged with video playback.' In [defendant's] view, this purportedly unconventional arrangement is required by the claims, especially the 'means for controlling' and 'mans for interactively controlling' limitations . . .. **[A] more developed record and claim construction will be helpful in resolving the parties' dispute over whether the claimed invention relies on this arrangement, and whether the purportedly unique arrangement is claimed, among other issues**."

6

Title search: Recent Developments in Claims Construction: Fall 2017

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"Recent Developments in Claims Construction"