

The University of Texas School of Law

23rd ANNUAL ADVANCED PATENT LAW INSTITUTE

RECENT
DEVELOPMENTS IN
CLAIM CONSTRUCTION

November 1-2, 2018
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

* 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. © 2018 Kenneth R Adamo. All Rights Reserved.

REVISED

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. GENERAL CLAIM CONSTRUCTION	17
1. Does the Court Have to Be Asked to Construe a Specific Claim Element?	17
2. Failure To Construe As An <i>O2 Micro</i> Violation	19
3. Mandatory PTAB Claim Construction	20
4. PTAB May Not Have to Construe Claim Element.....	22
III. TIMING OF CLAIM CONSTRUCTION; TIMING OF STATEMENT OF CLAIM ELEMENT MEANING	23
1. Construing Claim Limitation at Pleading Stage	23
2. Definitions for Claim Limitation Required.....	24
IV. WAIVER OF CLAIM CONSTRUCTION.....	25
V. EARLY CLAIM CONSTRUCTION	28
1. Disputed Claim Construction Should Not Ordinarily Be Decided on F. R. Civ. P. 12(b)(6) Motion.....	29
VI. CLAIM CONSTRUCTION RELATING TO 35 USC § 101 MOTIONS	30
1. Deferral of Motion to Dismiss on 35 USC § 101 Grounds Because Claim Construction Has Not Occurred	30
2. Addressing 35 USC § 101 Without Claim Construction.....	32
VII. CLAIM CONSTRUCTION RELATING TO SUMMARY JUDGMENT	32
1. No Summary Judgment Absent Claim Construction.....	32
2. Additional Construction Required Before Consideration of Summary Judgment.....	33
VIII. PRELIMINARY INJUNCTION & CLAIM CONSTRUCTION.....	34
IX. CLAIM CONSTRUCTION MAY EVOLVE	35

X.	INTERLOCUTORY REVIEW, CLAIM CONSTRUCTION.....	36
XI.	USE OF SPECIFICATION RE CLAIM CONSTRUCTION	36
	1. Claim Element Cannot be Uncoupled From the Specification.....	36
	2. Claim Construction That Excludes Structure Recited in Specification Likely Incorrect.....	37
	3. Reading-In Preferred Embodiments from the Specifications Leads to An Incorrect Claim Construction.....	38
	4. Broadest Reasonable Construction Must Be Gauged “In Light of the Speculation”.....	44
	5. Construction Relying on Later-Added Claims is Likely to be Incorrect.	45
	6. Incorporation By Reference.....	46
XII.	IPR PROCEEDINGS AS INTRINSIC EVIDENCE RE CLAIM CONSTRUCTION.....	49
XIII.	PREAMBLES	50
	1. Preambles as Limitations	50
	2. Preambles that Are not Limiting.....	51
XIV.	FUNCTIONAL CLAIMING	58
	1. Hybrid Claims.....	61
XV.	CONFUSING STRUCTURAL LIMITATIONS WITH PROCESS LIMITATIONS.....	64
XVI.	MEANS PLUS FUNCTION CLAIM LIMITATIONS.....	69
	1. The Basics.....	69
	2. “Means” Recited / Not Recited in Claim, Presumption of “Means Plus Function” Limitation.....	70
	3. Interface of PTAB Rules and Means-Plus-Function Means.....	73
	4. Extrinsic Evidence Is Not Necessary to Defeat a Means-Plus-Function Interpretation of a Claim Element.....	73
XVII.	NEGATIVE LIMITATIONS.....	74

XVIII.	MARKUSH GROUP LIMITATIONS	77
XIX.	PRODUCT BY PROCESS LIMITATIONS	79
XX.	PROCESS CLAIM - ORDER OF STEPS - PRODUCT BY PROCESS.....	80
XXI.	FUNCTIONAL MISCELLANEOUS TERMS	81
	1. A, An.....	81
	2. About.....	82
	3. At Least One of A and B.....	82
	4. I.E.....	84
	5. Wherein.....	85
XXII.	MEANING OF MISCELLANEOUS TERMS	86
XXIII.	CLAIM DIFFERENTIATION	100
XXIV.	PROSECUTION HISTORY AS CLAIM CONSTRUCTION TOOL	101
XXV.	TRANSITIONAL TERMS (“COMPRISING”, “CONSISTING ESSENTIALLY OF”, “CONSISTING OF”) AND “WHEREIN / WHEREBY” CLAUSES.....	104
	1. “Comprising”	104
	2. “Consists essentially of”	104
	3. “Consisting Of”	105
XXVI.	EXTRINSIC EVIDENCE - DICTIONARIES	105
	1. Extrinsic Evidence	105
	2. Dictionaries	105
XXVII.	PROSECUTION DISCLAIMER.....	106
XXVIII.	MARKMAN PROCEDURE	118
	1. Additional Claim Construction After First <i>Markman</i> Proceeding.....	122
	2. Handling Indefiniteness As Part of <i>Markman</i> Construction.....	123
XXIX.	LIMITATIONS ON CLAIM CONSTRUCTION PROCEEDINGS.....	123

1.	Use of Opposing Party’s Claim Construction.....	123
2.	Winning Patent Owner Cannot Challenge a “Too Restrictive” Claim Construction.....	124
3.	Patent Owner’s Claim Construction May Be Used to Find Patent Unpatentable	125
4.	Alternative Claim Constructions.....	126
5.	Construction Relying on Later-Added Claims is Likely to be Incorrect.....	126
XXX.	ITC CLAIM CONSTRUCTION	127
XXXI.	IPR/CBMR/PGR CLAIM CONSTRUCTION	129
1.	Broadest Reasonable Interpretation Is Not <i>Per Se</i> Broadest Possible Interpretation.....	129
2.	Present a Construction That You Believe Is Correct.....	132
XXXII.	EFFECTS OF PTAB’S PRECEDENTIAL DECISION.....	133
1.	Background.....	133
XXXIII.	IPR CLAIM CONSTRUCTION PROCEDURE.....	136
XXXIV.	POPR AND CLAIM CONSTRUCTION	137
XXXV.	CHANGES FOR CLAIM CONSTRUCTION STANDARD USED IN PTAB PROCEEDINGS - FROM BRI TO <i>PHILLIPS V. AWH</i>	138
1.	Introduction.....	138
2.	The Details, Concisely Stated.....	146
3.	Key Portions Of The Federal Register Notice, May 9, 2018, Vol. 83, No 90 (Docket No. PTO-P-2018-0036).....	147
4.	The Specific Rules, As Amended.	150
5.	Other Issues That May Arise	152
6.	The Final Rule - Revised Rules Adopt <i>Phillips</i>	154
XXXVI.	DISTRICT COURT / DISTRICT COURT CROSS EFFECTS OF CLAIM CONSTRUCTION.....	155

XXXVII.	DISTRICT COURT / PTAB CROSS EFFECTS OF CLAIM CONSTRUCTIONS	155
XXXVIII.	NEW CLAIM CONSTRUCTION.....	156
XXXIX.	PRESENTATION OF PTAB: NEW CLAIM CONSTRUCTION	157
XL.	PTAB BOUND BY PRIOR FEDERAL CIRCUIT CLAIM CONSTRUCTION	159
XLI.	COLLATERAL ESTOPPEL ISSUES INVOLVING CLAIM CONSTRUCTION DETERMINATION.....	166
	1. Collateral Estoppel or issue preclusion.....	167
	2. Judicial estoppel.....	168
XLII.	<i>STARE DECISIS</i>	169
XLIII.	TIMELY DISCLOSURE OF EXPERT TESTIMONY PARTICULARS	173
XLIV.	DISCOVERY RE EXPERT SUPPORTING CLAIM CONSTRUCTION.....	174
XLV.	EXPERT TESTIMONY CONTRARY TO <i>MARKMAN</i> CONSTRUCTION.....	174
	1. Expert Testimony Does Not Contradict Court’s Claim Construction	174
	2. Expert Testimony Contradicts Claim Construction.....	175
XLVI.	SANCTIONS AFTER <i>MARKMAN</i> CONSTRUCTION	180
XLVII.	VACATING CLAIM CONSTRUCTION FOLLOWING SETTLEMENT	183
XLVIII.	LIMITATIONS ON EXPERT WITNESS TESTIMONY RE CLAIM CONSTRUCTION.....	184
XLIX.	HARMLESS ERROR RE CLAIM CONSTRUCTION	186
L.	CONCLUSION.....	187

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 (BRI),” claim construction rubric, as had particularly been the case with 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). That has all changed, however, as of November 13, 2018, when all post-grant proceedings will drop BRI and instead adopt *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc), and its claim construction regime for all petitions filed on or after November 12, 2018.

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 maintaining the *Phillips v. AWH Corp.* over-arching methodology intact, made major and minor changes in applicable precedent and procedure.¹

I. INTRODUCTION

United States Letters Patent No. 10,000,000 issued on June 19, 2018, to Raytheon Company; it was entitled Coherent Ladar using Intra-Pixel Quadrature Detection, and the named investor was Joseph Marron, of Manhattan Beach, CA. It had just over six (6) pages of specifications and twenty (20) claims, ten (10) system claims, ten (10) LADAR method claims. Nothing terribly unique there (other than the claimed subject matter, of course).

Yet, Professor Crouch, in his always educational and often enjoyable Patent-O Daily Review: Boiler Plate Language in Patents (June 24, 2018), blog posting had just this to say about U.S. 10,000,000:

The Specification of U.S. Patent No. 10,000,000 is short - only about three pages long. However, the patentee made room for the following boilerplate:

- Although specific advantages have been enumerated above, various embodiments may include some, none, or all of the enumerated advantages.
- [O]ther technical advantages may become readily apparent to one of ordinary skill in the art after review of the following figures and description.
- It should be understood at the outset that, although exemplary embodiments are illustrated in the figures and described below, the principles of the present disclosure may be implemented using any number of techniques, whether currently known or not.

¹ USITC, District Court and PTAB materials, not otherwise attributed, which are sources / quoted in this paper, 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.).

The present disclosure should in no way be limited to the exemplary implementations and techniques illustrated in the drawings and described below.

- Unless otherwise specifically noted, articles depicted in the drawings are not necessarily drawn to scale.
- Modifications, additions, or omissions may be made to the systems, apparatuses, and methods described herein without departing from the scope of the disclosure. For example, the components of the systems and apparatuses may be integrated or separated. Moreover, the operations of the systems and apparatuses disclosed herein may be performed by more, fewer, or other components and the methods described may include more, fewer, or other steps. Additionally, steps may be performed in any suitable order. As used in this document, “each” refers to each member of a set or each member of a subset of a set.
- To aid the Patent Office and any readers of any patent issued on this application in interpreting the claims appended hereto, applicants wish to note that they do not intend any of the appended claims or claim elements to invoke 35 U.S.C. 112(f) unless the words “means for” or “step for” are explicitly used in the particular claim.

Not sure what the specific point he was reaching for was but I suggest - if you let a civilian or a grammar school child read this out loud and watch their faces - you may appreciate how jurors in a patent case may feel.

Now, onto the joys of U.S. claim construction.

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

[2018 Advanced Patent Law \(Austin\) eConference](#)

First appeared as part of the conference materials for the

23rd Annual Advanced Patent Law Institute session

"Recent Developments in Claims Construction"