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RECENT DEVELOPMENTS IN CLAIM CONSTRUCTION

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Claim construction continues to provide 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 was 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 USPTO post grant IPR/PGR/CBMR proceedings, 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 changed, however, as of November 13, 2018, when all post-grant proceedings dropped BRI and adopted *Phillips v. AWH Corp.*, 415 F.3d 1303, (Fed. Cir 2005) (en banc), and its claim construction regime for all petitions filed on or after November 12, 2018.

And again, the latest decisions of the United States Court of Appeals for the Federal Circuit (“Federal Circuit”), the trial courts and PTAB panels, while maintaining the *Phillips v. AWH Corp.* over-arching methodology, made major and minor changes in applicable precedent and procedure.¹

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://homedocketnavigator.com/terms-of-use> (5/22/13 rev.).

I. CLAIM CONSTRUCTION BASICS

Several recent Federal Circuit and trial court decisions have contained detailed discussions of the *Phillips v. AWH Corp* claim regime and provide an excellent jumping-off place for a claim construction analysis.

For example, in *E.I. duPont de Nemours & Co V. Unifrax I LLC*, Appeal No. 2017-2575, slip op. (Fed. Cir. April 17, 2019), the Federal Circuit affirmed the trial court's determination that the claims of U.S. Patent No. 8,607,926 on a Composite Flame Barrier Laminate for a Thermal and Acoustic Insulation Blanket were not invalid and were infringed.

The '926 patent claims composite laminates that are incorporated into thermal-acoustic blankets installed on the interior of airline fuselages to shield passengers from flames and reduce noise. **At issue was the term "100% by weight" in the claims. Unifrax argued that the "100% by weight" term does not allow for any amount of organic additives in the refractory layer. According to Unifrax, "'100%' means one hundred percent." The Federal Circuit considered whether the context of the entire patent and other intrinsic evidence supported such an interpretation and concluded it did not.**

The Federal Circuit began with the language of the claims:

That claim 1 recites a residual moisture content of up to "[10%] by weight" in addition to "100% by weight" platelets in the refractory layer undercuts Unifrax's plain meaning argument that "'100%' means one hundred percent." Unifrax's position would require that the term "100% by weight" be considered alone, without reference to the surrounding claim language. The claim's reference to both "100% by weight" platelets and 10% residual moisture, however, supports the conclusion that "100% by weight" is relative to carrier material. It would be nonsensical if the total percentage of components comprising the inorganic refractory layer exceeded 100%.

The Federal Circuit then turned to the specification, which described "preferably at least 85% of the layer comprises platelets" with the remainder being "some residual dispersant." The Federal Circuit found that this language supports the trial court's conclusion that the disclosed embodiments, including the 100% platelet embodiment, allow for some amount of residual dispersant.

Unifrax argued that all 24 of the examples had 100% by weight inorganic platelets with no residual dispersant, but the Federal Circuit noted that the specification also listed other "suitable materials" that contain a residual dispersant, and thus, less than 100% inorganic material for the refractory layer. The Federal Circuit also rejected Unifrax's argument that it was improper to use the specification of the patent's parent in construing the claims in the continuation-in-part patent at issue, noting that the subject matter in the parent was common to the continuation-in-part application.

Finally the Federal Circuit rejected the argument that the patent owner limited the scope of the claims during prosecution. During prosecution the patentees amended the claims to

add the 100% limitation to distinguish prior art with a 70% concentration. The Federal Circuit found that in making the amendment, the patent owner did not disclaim the presence of non-carrier materials such as dispersants.

Based upon the claim language itself, the specification, the specification of the related cases, and a careful examination of the prosecution history, the Federal Circuit concluded that the trial court's interpretation of "100% by weight" was not erroneous.

Having affirmed the trial court's claim construction, the Federal Circuit went on to affirm the finding of infringement.

The case was a tutorial in claim construction, giving a practical example of how claim terms are construed in light of the surrounding language; how the entire specification and not just the examples are used in determining the meaning of claim terms; how the specifications of related applications are used in determining the meaning of claims terms; and even how the prosecution history is used in determining the meaning of claim terms.

Wheelock, "Federal Circuit Gives a Masters Class in Claim Construction," Lexology <https://www.lexology.com/library/april17,2019> See also *Choon's Design LLC v. Idea Village Products Corp.*, Appeal No. 2018-1934, slip op (Fed Cir. June 24, 2019) at 6-9 and n. 3 ("Choon's criticizes the district court for "select[ing] which terms to construe with an eye towards the [] infringement issues and the accused device." Appellant's Br. 37 **As we have previously explained, however "although the claims are construed objectively and without reference to the accused device, only those terms need to be construed that are in controversy, and only to the extent necessary to resolve the controversy."** *Vivid Techs., v. Am. Sci. & Eng'g, Inc.*, 200 F. 3d 795, 803 (Fed. Cir. 1999). The district court did not err in considering the accused product in order to identify the claim terms material to infringement.")

Judge Mazzant's claim construction decision in *E-System Design Inc v. Mentor Graphics Corp.* Civil Action No. 4: 17-cv-682 (ED Tex 2017), Claim Construction Memorandum Opinion and Order (Dec 17, 2018), also sets out an excellent summary of the key *Phillips v. AWH Corp's* analysis concepts. See, e.g., Slip op. 2-5, 10-11, 16-17 ("Idiosyncratic language, highly technical terms, or terms coined by the inventors are best understood by reference to the specification"), 19-20, 22 (In general, 'only those terms need to be constructed that are in controversy, and only to the extent necessary to resolve the controversy'), 30-31.

Analysis of the "plain and ordinary meaning" of claim terms was the focus of *Wis. Alumni Research Found. v. Apple Inc.*, Appeal Nos. 17-2265, -2380 (Fed. Cir. Sept. 28, 2018), which involved hotly contested disputes as to the plain and ordinary meaning of key claim terms.

The Wisconsin Alumni Research Foundation (WARF) owns a patent directed to a data speculation decision circuit that uses predictions to help increase the efficiency of computer processing functions running in parallel. The claims require that a prediction be associated with a "particular" load instruction. WARF filed a patent infringement complaint against Apple asserting the patent.

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