

University of Texas School of Law  
28<sup>th</sup> Annual Advanced Patent Law Institute  
November 2-3, 2023

# Recent Developments in Claim Construction

November 2, 2023

Kenneth R. Adamo\*  
Law Offices of KRAdamo  
360 W. Illinois, Apt 620  
Chicago, IL 60654  
kradamo23@gmail.com

\*Member, Illinois, New York, Ohio and Texas Bars. This presentation reflects only the present considerations and views of the author, which should not be attributed to the Law Office of KRAdamo or any of his or its present or former clients.

© 2023 Kenneth R. Adamo. All Rights Reserved.

1

1

## What's New... and (Possibly) Different

- Contrary to previous outings, there will be no soup-to-nuts presentation approach:
  - Not going to talk about: preambles; transitional terms; construing claims narrowly to preserve validity; design patents; references numerals in claims; negative/conditional limitations; mixed applications/method claims; indefiniteness.
  - Will, however, address “and” / “or” / “wherein” / “including” ... for the sake of historical continuity
  - Old standbys will be addressed, but with a light touch: means-plus-function limitations; prosecution disclaimer; forfeiture of construction; *Oz Micro*; product-by-process limitations.
  - Will start with a conundrum

2

2

## Construction-of-the-Construction: One-E-Way, Inc. v. Apple Inc.

Guided by Professor Crouch, at his semi-ironic best, consider *One-E-Way, Inc. v. Apple, Inc.*, Appeal No. 2022-2020, slip op. (Fed. Cir. Aug. 14, 2023), a non-precedential opinion written for the panel by Chief Judge Moore.

In “Meta Claim Construction: Finding Meaning In the Meaning,” Dennis Crouch’s Patently-O-Daily Review (Aug. 15, 2023), the trial court:

sided with Apple on summary judgment, finding no infringement. On appeal, the Federal Circuit has affirmed, holding that Apple’s accused Bluetooth products do not infringe One-E-Way’s patents. Although the parties had agreed to the construction of the “unique user code” term, they disagreed over the construction-of-the-construction. On appeal, the court treated this meta-construction effectively as a form of claim construction—looking for the ordinary meaning rather than a contract-like interpretation that would have looked more toward discerning the intent of the parties.

Dennis Crouch, “Meta Claim Construction: Finding Meaning In the Meaning,” Dennis Crouch’s Patently-O-Daily Review (Aug. 15, 2023)

3

3

## Construction-of-the-Construction (cont.)

To start, Prof. Crouch set out the salient facts and the trial court’s ruling:

One-E-Way sued Apple for infringing the claims of two patents related to a wireless digital audio system that allows private listening without interference. The system uses a transmitter connected to an audio source and a receiver connected to headphones. The transmitter contains a code generator that generates a “unique user code” associated with a specific user to allow pairing between the transmitter and receiver.

During the infringement litigation, the parties agreed to construe “unique user code” as a “fixed code (bit sequence) specifically associated with one user of a device(s).” Although Apple’s Bluetooth products do transmit a unique code to establish the connection, the code is not unique to the user, but rather it is unique to the Bluetooth device. The [trial] court agreed with Apple’s assessment and granted summary judgment of non-infringement.

Dennis Crouch, “Meta Claim Construction: Finding Meaning In the Meaning,” Dennis Crouch’s Patently-O-Daily Review (Aug. 15, 2023)

4

4

## Construction-of-the-Construction (cont.)

The One-E-Way position on appeal was laid out next:

On appeal, One-E-Way argued that the "unique user code" limitation is still met by Apple's accused Bluetooth products. Specifically, One-E-Way contended that even though the Bluetooth address codes are associated with devices, the codes are still associated with individual users through operation of the device. In other words, One-E-Way argued that Bluetooth pairing to a particular device is equivalent to pairing with a specific user. This argument makes the assumption that each device is limited to just "one user."

Followed by a pause for a personal aside: "Although that assumption is not strictly true, I expect that it holds true in 99% of cases. For a while, I shared Bluetooth headphones with one of my daughters—it did not work well at all."

Dennis Crouch, "Meta Claim Construction: Finding Meaning In the Meaning," Dennis Crouch's Patently-O-Daily Review (Aug. 15, 2023)

5

5

## Construction-of-the-Construction (cont.)

He then related in summary Chief Judge Moore's reasoning in allowing the finding of non-infringement:

The Federal Circuit rejected this argument, finding that it was inconsistent the claim construction which clearly states the code is associated with "one user." rather than the device itself. Even if the Bluetooth address code is associated with a user through use of the device, the code remains fundamentally associated with the device. The Federal Circuit found no evidence that the code itself becomes directly linked to the user, rather than the device, through pairing and use.

Dennis Crouch, "Meta Claim Construction: Finding Meaning In the Meaning," Dennis Crouch's Patently-O-Daily Review (Aug. 15, 2023)

6

6

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 \(utcle.org/elibrary\)](https://utcle.org/elibrary)

## Title search: Recent Developments in Claim Construction

Also available as part of the eCourse

[2023 Advanced Patent Law \(Austin\) eConference](#)

First appeared as part of the conference materials for the

28<sup>th</sup> Annual Advanced Patent Law Institute session

"Recent Developments in Claim Construction"