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Recent Developments in Claim Construction

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Kenneth R. Adamo*
Law Office of KRAdamo
360 W. Illinois St., 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.

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What's New… and (Possibly) Different

- Again, 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 "a" / "the" / "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 / waiver of construction arguments; consistency of claim term usage; own lexicographer

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Claim Construction Must Be Based on What is Generally Known at the Time of Invention

A basic binding precept of claim construction was set out by Judge Kleeh in *In re Aflibercept Patent Litigation,* Civil Action No. 1-24-md-03103 (N.D. W. Va. 2024), Motion for Preliminary Injunction (April 19, 2024):

> "On the legal question of whether Gokarn is available, while the Court observes the footnote cited by [Plaintiff], the Court defers to the Federal Circuit's more recent *en banc* decision in [*Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005)], that **claim construction must be based on what was generally known by the POSA 'at the time of the invention**.' . . . The Court therefore finds that Gokarn cannot be used as [Plaintiff] suggests, that is, as evidence of the POSA's understanding of what was generally known in the art as of the filing date of the '865 patent."

Claim Terms Should Be Used Consistently Throughout Patent

In *Infernal Technology LLC, Terminal Reality Inc. v. Sony Interactive Entertainment LLC,* Appeal No. 2022-1647-1739, slip op. (Fed. Cir. Feb. 2, 2024), the trial court correctly rejected Infernal's "storing" step argument because it conflicts with the agreed-upon meaning of "light image data" and with the Asserted Patents' specifications and claims:

> **Sony contends that Infernal is impermissibly attempting to reargue the settled claim construction of "light image data" and "light accumulation buffer."** While the district court indicated that Infernal's motion for new trial "seeks to reargue claim construction," it ultimately rejected "[Infernal's] new claim construction arguments" and found that Infernal's theory that "light image data" does not carry a perspective requirement contradicted the settled claim constructions on the merits. *Decision*, 2022 WL 822110, at *3. **To the extent that Infernal's arguments can be interpreted as proposing new claim constructions, we reject those new construction arguments as untimely; the time to contest the settled claim constructions was before the case was submitted to the jury, and, most preferably, during the *Markman* process**. Thus, we agree with the district court that **Infernal's arguments will fail where they contradict the agreed upon constructions** of the terms "light image data" and light accumulation buffer." *See id.* ("The [c]ourt finds that [Infernal's] argument is contrary to the agreed constructions this [c]ourt entered during *Markman*.")

Slip op. at 15.

Claim Terms Should Be Used Consistently… cont.

> Infernal contends that the district court's error was including the entire construction of "light image data" whenever it is used in the claim, and that for the "storing" step, "light image data" should not mean "2D data representing the light emitted by the light source to illuminate the scene *as viewed from the light source's perspective*" but instead merely "2D data representing the light emitted by the light source to illuminate the scene. J.A. 1673 (Joint Claim Construction Chart) (emphasis added). **This argument directly contradicts the settled claim constructions and fails to overcome the presumption that "claim terms-are-normally used consistently throughout the patent."** *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005); *see also, Phonometrics v. Northern Telecom Inc.*, 133 F.3d 1459, 1465 (Fed. Cir. 1998); *In re Varma*, 816 F.3d 1352, 1363 (Fed. Cir. 2016).

Slip op. at 16. *See also,* slip op. at 17-18.

Claim Terms Should Be Used Consistently… cont.

Vascular Solutions et al. v. Medtronic, Inc. et al., Appeal No. 2024-1390, slip op. (Fed. Cir. Sept. 16, 2024) [Mazzant, J.] ("It is true that our law indicates that "a claim term should be construed consistently with its appearance in other places in the same claim or in other claims of the same patent." *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed. Cir. 2001); *see also Samsung Elecs. Co., Ltd. v. Elm 3DS Innovations, LLC*, 925 F.3d 1373, 1378 (Fed. Cir. 2019) ("Where multiple patents derive from the same parent application and share many common terms, we must interpret the claims consistently across all asserted patents."). This decision does not diverge from our law on the matter. Rather, this decision clarifies that the term "substantially rigid portion" be construed the same way across the patents, but that construction can be a functional construction that does not specify the boundary of the "substantially rigid portion.")

Slip op. at 16-17. *See* Kacthikeyan et al., "The Boundary of a Claim Construction Can Vary Across Different Independent Claims," Federal Circuit IP Blog, Lexology (Oct. 9, 2024); Shah et al., "Function Over Form: Federal Circuit's New Guidance on Patent Claim Construction," Brooks Kushman PC, Lexology (Sept. 26, 2024); McDermott, "When Can Same Claim Limitation Have Different Meanings? When It's Functional, of Course," IP Update, Lexology (Sept. 26, 2024).

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