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24<sup>th</sup> ANNUAL ADVANCED PATENT LAW INSTITUTE

# RECENT DEVELOPMENTS IN CLAIM CONSTRUCTION

Kenneth R. Adamo\*  
Law Office of KR Adamo  
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 Law Office of KR Adamo or any of his or its former or present clients. © 2019 Kenneth R Adamo. All Rights Reserved.

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## TIMING OF CLAIM CONSTRUCTION

§101

***MyMail Ltd. v. ooVoo LLC, FAC Search & Media Inc., Appeal Nos. 18-1758, - 1759, slip op. (Fed Cir. Aug 16, 2019)*** Fed. Cir.

Vacated/remanded trial court decision for failure to address parties' claim construction dispute before ruling on F.R. Civ. P 12 (c) motion.

Patent eligibility may be determined on a Rule 12(c) motion, but **only** when there are no factual allegations that, if taken as true, prevent resolving the eligibility of question as a matter of law," ... The court noted that under *Aatrix*, "if the parties raise a claim construction dispute at the Rule 12 (c) stage, **the district court must either adopt the non-moving party's constructions or resolve the dispute to whatever extent is necessary to conduct the § 101 analysis.**"

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## TIMING OF CLAIM CONSTRUCTION

### Preliminary Construction

**In *International Designs Corporation LLC v. Haus Art International Inc*, Civil Action no. 2-17-cv-08411 (CD Cal 2017), Claim Construction Procedure (March 1, 2019), the court granted defendant's motion for summary judgement that it did not infringe plaintiff's hair band patent and rejected plaintiffs' argument that the court was improperly modifying its claim construction:" [I]t is this Court's practice to reserve the right to revisit its claim construction rulings if previously-undisclosed argument comes to light about the impact of a particular claim construction on dispositive issues in the case. ... However, with early claim construction proceedings come the risk that a particular claim interpretation does not adequately address the key dispute between the parties." (page 9)**

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## TIMING OF CLAIM CONSTRUCTION

### Failure to State a Claim

***IDB Ventures, LLC v. Charlotte Russe Holdings, Inc.*, Civil Action No. 2-17-cv-00660(ED Tex 2017), Motion to Dismiss – Failure to State a Claim (FRCP 12(b)(6)) (Oct 31, 2018) (court denied defendants' motion to dismiss plaintiff's direct infringement claim for failure to state a claim because defendants' claim construction arguments were premature: "[T]he defendants contend that the asserted claims, on their face, do not read on defendants' systems . . . . [T]he defendants' argument depends on a claim construction issue that is not as clear-cut as the defendants suggest and cannot be resolved based on the limited showing made in the motions to dismiss . . . ."**

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## TIMING OF CLAIM CONSTRUCTION

### Summary Judgement

In *Simplot Company v. McCann Foods USA Inc*, Civil Action No. 1-16-cv-00449 (D. Idaho 2015), Motion to Stay / Continue Summary Judgement (FRCP 56(d)) (Nov 29, 2018), the court granted defendant's motion to stay briefing on plaintiff's motion for summary judgement of noninfringement pending rulings on claim construction and the pleadings:" [Plaintiff] has filed a Motion for Partial Summary Judgement based on the Court's *Markman* ruling. The Court's *Markman* ruling, however, is the subject of [defendant's] Motion for Reconsideration . . . . [Plaintiff] asserts that [defendant] is stalling, and that this is nothing more than a fishing expedition. . . . While there is some ambiguity in [ defendant's] purported discovery, that is unavoidable considering the Court has yet to rule on two motions which will clarify the parameters of the claims – and accordingly, the discovery – moving forward in this case." (page 3)).

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## TIMING OF CLAIM CONSTRUCTION

### Timeliness of Claim Construction and Revised / Amended Connections

In a patent infringement action pending in the Eastern District of Michigan, *Webasto Thermo & Comfort N. Am., Inc. v. BesTop, Inc.*, No. 2:16-cv-13456, Order No. 209 (E.D. Mich. May 20, 2019), the court overruled defendant BesTop's objections to the Special Master's recommendation to grant plaintiff, Webasto's, motion to strike BesTop's second amended noninfringement and invalidity contentions. **BesTop served each of these after claim construction**—which construed the disputed terms according to their customary and ordinary meaning—and without leave to do so untimely. **The court concluded that its claim construction order could not serve as the basis for tardy changes in a party's theories of noninfringement and invalidity.**

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