The University of Texas School of Law

25th Annual Advanced Patent Law Institute

Recent Developments in Claim Construction

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Timing of Claim Construction

1. §101

Claim construction required before §101 inquiry made

***Teradyne Inc v. Astronics Test Systems* (CD Cal Aug 7, 2020)**

***Enserion LLC v. Orthofix* (ED Tex Sept 16, 2020)**

V. Saltui Winery v. Landmark Technology (ND Cal Sept 30, 2020)

2. Early Claim Construction

No jumping the gun.

SSI Technologies, LLC v. KUS Dongguan Zhengyang Electronic Mechanical LTD, Civil Action No. 3-20-cv-00019 (WD Wisc 2020), Motion to Compel Discovery (July 20, 2020) (court denied defendant's motion to compel plaintiff to disclose its claim construction contentions as contrary to the scheduling order: **"This court puts claim construction deadlines in its patent lawsuit scheduling orders for a reason, and the court's case-specific deadlines clearly trump defendant's general reliance on Rule 33 as a basis to jump the gun. . .)**

Claim Construction: Prior Proceeding

Admissibility / application of claim construction from a first trial court / PTAB proceeding in a second trial court / PTAB proceeding is supported by case law (*Power Integrations v. Lee,* 797 F. 3d1318, 1326 (Fed Cir. 2015)) and statute (35 USC § 301; 37 CFR § 42. 100(b)).

In ***Salazar v. AT&T Mobility LLC er al,*** Civil Action No. 2: 20-cv-0004-JRG (ED Tex 2020), Claim Construction Memorandum and Order (ED Tex 2020), Chief Judge Galstrap was presented with a *Markman* construction from an earlier case:

> **D. Previous Constructions of Disputed Terms**
>
> **D-1. Prior court constructions are entitled to reasoned deference.**
>
> The "importance of uniformity in the treatment of a given patent" suggests a level of deference to previous court constructions of disputed claim terms. *See Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1329 (Fed. Cir. 2008) (quoting *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996)); *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 329 (2015) (noting that "prior cases . . sometimes will serve as persuasive authority"). **While the "doctrine of *stare decisis* does not compel one district court judge to follow the decision of another . . . previous claim constructions in cases involving the same patent are entitled to substantial weight."** *TQP Dev., LLC v. Intuit Inc.*, No. 2:12-CV-180-WCB, 2014 U.S. Dist. LEXIS 84057, at *21–22 (E.D. Tex. June 20, 2014) (Bryson, J.).

See ***Emerson Electric Co. v. SIPCO, LLC,*** Appeal No. 2019-1301, slip op. (Fed Cir. Sept 30, 2020) (SIPCO cross-appealed PTAB's claim construction of "low-power radio frequency signal": Federal Circuit rejected SIPCO arguments that the PTAB should have construed this limitation consistently with how the court construed the limitation "low-power transceiver" in a prior appeal involving SIPCO and similar subject matter, **explaining that it is not bound by prior constructions on different patents because claim construction issues are highly fact and case-specific, as they rely on intrinsic evidence - *i.e.,* the claim language, the written description, and the prosecution history of the particular patent-at-issue** ("Federal Circuit Affirms PTAB's Claim Construction, Despite Reaction of Incorrect Legal Standard, and Concluded that Substantial Evidence Supports its Unpatentability Findings," Shearman & Sterling LLP IP blog (Oct 8, 2020).)

Title search: Recent Developments in Claim Construction

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First appeared as part of the conference materials for the
25th Annual Advanced Patent Law Institute session
"Recent Developments in Claim Construction"