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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 *ex parte* 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 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. (Some of the decisions reported herein applied BRI construction because of the filing dates of litigation and / or post grant proceedings)

As is the norm, 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.

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

Claim Construction Basics

1. Intrinsic Evidence

The scope of a claim term may be limited when intrinsic evidence establishes the context of the patent to be narrowly focused. *MCRO, Inc. v. Bandai Namco Games America*. Appeal No. - Slip op (Fed Cir. ____). In *MCRO*, the trial court defined the claim term "morph set weight" to require three-dimensional vectors, then granted Bandai's motion for summary judgement of non-infringement. On appeal, the parties did not dispute that when "morph set weight" is construed to require three-dimensional vectors, the Developers do not infringe. MCRO argued that the trial court erred in construing the term "morph set weight" by narrowly construing "vector" to require three-dimensional vectors, rather than adopting MCRO's broader construction of "vector" which included any ordered set of numbers.

The Federal Circuit rejected MCRO's argument finding spatial terms such as "vertex" and "topology" used in the specification to describe the claimed process, as well as recitation of "three-dimensional characters" in the preamble of the asserted claims "strongly favor[ed] the narrow geometric meaning of 'vector'." The Federal Circuit also found support in an equation summarizing the claimed process. Because the equation required addition of a three-dimensional vector with a sum of the vectors at issue, the court concluded the summed vectors must also be three dimensional. The Federal Circuit concluded that the meaning most appropriate in the context of the patent was that "vector"

required three-dimensional vectors and affirmed the trial court's claim construction and finding of non-infringement.

Tsunoaki et al, "Intrinsic Evidence Establishing the Context of a Claim Term Can Limit Claim Scope", Lexology Knobbe Martens (May 26, 2020).

Timing of Claim Construction

1. §101

Teradyne, Inc. v. Astronics Test Systems, Inc., et al, Civil Action No. 2-20-cv-02713 (CD Cal 2020), Motion to Dismiss-Failure to State a Claim (Aug 7, 2020) (court denied without prejudice defendant's motion to dismiss on the ground that plaintiff's over-voltage test patent encompassed unpatentable subject matter because claim construction and a technology tutorial had not occurred: **"The Court agrees with [plaintiff] that the §101 inquiry in this case would be aided by further proceedings, including a technology tutorial and claim construction.** The meaning of the claim phrase 'with the output being a test result and/of being an over-voltage indication' will likely be relevant to not just a §101 challenge, but other invalidity challenges. ... Although [defendant] suggests that means-plus function claiming is not relevant to the §101 inquiry, a narrowed, structurally focused construction of various claim limitations (or the opposite) could ultimately matter here." (page 7)).

Enserion LLC v. Orthofix, Inc., Civil Action No. 4-20-cv-00108 (ED Tex 2020), Motion to Dismiss-Failure to State a Claim (Sept 16, 2020) (court denied without prejudice defendant's motion to dismiss on the ground that plaintiff's cloud-assisted rehabilitation system patent encompassed unpatentable subject matter because claim construction had not occurred: **"Determining the claims' scope -- and thus whether they are directed at patent ineligible subject matter -- often requires claim construction. ... This is such a case.** The claim construction hearing is currently scheduled (in 5 months) and will provide the Court a more complete understanding of the claimed invention." (page 3))

V. Sattui Winery v. Landmark Technology A, LLC, Civil Action No. 3-19-cv-05207 (ND Cal 2019), Motion to Dismiss - Failure to State a Claim (Sept 30, 2020) (court denied without prejudice plaintiff's motion to dismiss on the ground that defendant's data processing patent encompassed unpatentable subject matter because claim construction had not occurred: "The Court defers plaintiff's motion to dismiss the counterclaims for patent ineligibility until after claim construction. The motion is terminated without prejudice." (page 1)).

2. Early Claim Construction

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.** As common sense would suggest, in light of the court-ordered deadlines, additional discovery on this topic may be sought later. If defendant had

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