

CLASS 10

**CLAIM CONSTRUCTION 1:
WHO DECIDES CLAIM CONSTRUCTION?**

**PATENT LAW & POLICY
PROFESSOR WAGNER**



Today's Agenda

Introduction to Claims

Who Decides Claim Construction?

1

Introduction to Claims

Course Design

✓ The Standards for Patentability

- Determines whether a patent is valid
- Applies both in Prosecution and Enforcement

2. The Enforcement of Patents

- How patents are enforced, after issue

3. The Institutional Design of the Patent System

- The legal process
- Limits on patents
- Remedies
- Policy & reform issues (note: Subject Matter limits here)

Claim Construction is Critical to All

The Primacy of Patent Claims

Why should we use the claims as the primary yardstick of patent rights?

Don't they have less information than the specification?

Can't patentees manipulate claim language to their advantage?



*To coin a phrase, the name of
the game is the claims.*

— Judge Giles S. Rich, 1990

Are claims more like ...

Statutes

Contracts

Neither/Both

The Two-Step Infringement Analysis

[1] Interpret the claim

[2] Determine whether all elements of the claim are present in the accused device/product.
[for literal infringement]

The Two-Step Validity Analysis

[1] Interpret the claim

[2] Determine whether the claim meets the standards for patentability (§112, §102, §103)



How do you write claims?



United States Patent 4,111,111 Patent Number No. 3,024
Method 200,000 Date of Patent: Aug. 11, 1989

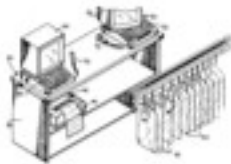
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CLASSIFICATION
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G06F 103/00
G06F 133/00
G06F 153/00
G06F 173/00
G06F 193/00
G06F 213/00
G06F 233/00
G06F 253/00
G06F 273/00
G06F 293/00
G06F 313/00
G06F 333/00
G06F 353/00
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What Does Claim Construction Look Like?



1. The inventory control and reporting system, comprising;

a data input device for manual operation by an attendant, . . . ;

a data processor including memory operable to record said information and means to maintain an inventory total, . . . ;

a dot matrix printer operable under control of the data processor to generate a written record of the indicia associated with sequential transactions, . . . and,

at least one optical scanner connected to the data processor and operable to detect said bar codes on all articles passing a predetermined station,

whereby said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom.

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Inventory?

Receivables?

Clothing?

Either / both?

**DETAILED DESCRIPTION OF THE
PREFERRED EMBODIMENTS**

The inventory control system of the invention requires the input of information together with the input of items to be placed in inventory, the information and the items to be uniquely positively associated with one another throughout processing. Every transaction is recorded, including identification of the articles placed in inventory. The more complete the information input and associated with each article, the better the possible reporting power of the system.

The present system is applicable to a range of embodiments of varying complexity. The best inventory control and management information reporting systems has the ability to determine and report the current location of any given article in inventory. The system should also be able to reconcile the inventory against the cash on hand, or as having finished processing through a certain area of the plant. According to the present invention, initial data input is minimized, and later logging of inventory articles, for example, passing stations within the system, or passing out of the system, is accomplished by means of an automatic optical scanner.

Inventory?

Receivables?

Clothing?

Either / both?

2

Who Decides Claim Construction?

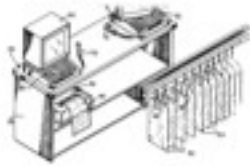
United States Patent 5,514,814
Markman
Patent Number No. 5,514,814
Date of Patent Sep. 12, 1995

INVENTORS
Robert Markman, et al.
By: [Signature]

ATTORNEY
[Signature]

REFERENCES CITED
U.S. Pat. No. 5,111,111
U.S. Pat. No. 5,111,112
U.S. Pat. No. 5,111,113
U.S. Pat. No. 5,111,114
U.S. Pat. No. 5,111,115
U.S. Pat. No. 5,111,116
U.S. Pat. No. 5,111,117
U.S. Pat. No. 5,111,118
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U.S. Pat. No. 5,111,122
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U.S. Pat. No. 5,111,195
U.S. Pat. No. 5,111,196
U.S. Pat. No. 5,111,197
U.S. Pat. No. 5,111,198
U.S. Pat. No. 5,111,199
U.S. Pat. No. 5,111,200

Markman v Westview Instruments (1996)



*[Claim construction as] a mongrel practice (like construing a term of art following receipt of evidence).
— Markman v. Westview (1996)*



The construction of written instruments is one of those things that judges often do and are likely to do better than jurors unburdened by training in exegesis. Patent construction in particular "is a special occupation, requiring, like all others, special training and practice. The judge, from his training and discipline, is more likely to give a proper interpretation to such instruments than a jury; and he is, therefore, more likely to be right, in performing such a duty, than a jury can be expected to be."



In the main, we expect, any credibility determinations will be subsumed within the necessarily sophisticated analysis of the whole document, required by the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole.... Thus, in these cases a jury's capabilities to evaluate demeanor, to sense the "mainsprings of human conduct," or to reflect community standards, are much less significant than a trained ability to evaluate the testimony in relation to the overall structure of the patent.



Finally, we see the importance of uniformity in the treatment of a given patent as an independent reason to allocate all issues of construction to the court.... It was just for the sake of such desirable uniformity that Congress created the Court of Appeals for the Federal Circuit as an exclusive appellate court for patent cases, observing that increased uniformity would "strengthen the United States patent system in such a way as to foster technological growth and industrial innovation."...



THE, in assessing whether Applicant's alleged advertising evidence is admissible. Leadman was denied any relief in terms advertising because a non-affiliate operative to Defendant advertising media, and its relevance to the date of the present case is questionable.

The Court also failed to address whether that Applicant's sales were "qualifying as a result of the advertising." In 2002, available sales were from EBARA for the two last months of the month, as is established over the next several months. The company was located previously in the trade press for its immediate services. Because the Court did not discuss this evidence, its use and value to the case is...

Edward R. PHILLIPS, Plaintiff-Appellant,

AWH CORPORATION, Defendant-Appellee, et al.,
Defendant-Appellee.

No. 04-1100, 04-1100.
United States Court of Appeals,
Federal Circuit.

July 26, 2005.
Background: (Court of Appeals for the Federal Circuit) will provide and deliver the official for information. The United States District Court for the District of Columbia, No. 04-1100, 04-1100, is granted.

Phillips v. AWH Corp. (Fed. Cir. 2005)

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AWH CORPORATION, Defendant-Appellee, et al.,
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Now more than ever I am convinced of the futility, indeed the absurdity, of this court's persistence in adhering to the falsehood that claim construction is a matter of law devoid of any factual component. Because any attempt to fashion a coherent standard under this regime is pointless, as illustrated by our many failed attempts to do so, I dissent.

— Judge Mayer (dissenting)



Edward R. PHILLIPS, Plaintiff-Appellant,
AWH CORPORATION, Defendant-Appellee, et al.,
Defendant-Appellee.

While this court treats the district court as an intake clerk, whose only role is to collect, shuffle and collate evidence, the reality, as revealed by conventional practice, is far different. . . .

If we persist in deciding the subsidiary factual components of claim construction without deference, there is no reason why litigants should be required to parade their evidence before the district courts or for district courts to waste time and resources evaluating such evidence. . . . Instead, all patent cases could be filed in this court; we would determine whether claim construction is necessary, and, if so, the meaning of the claims. Those few cases in which claim construction is not dispositive can be remanded to the district court for trial. In this way, we would at least eliminate the time and expense of the charade currently played out before the district court.

Eloquent words can mask much mischief. The court's opinion today is akin to rearranging the deck chairs on the Titanic—the orchestra is playing as if nothing is amiss, but the ship is still heading for Davy Jones' locker.

— Judge Mayer (dissenting)

NEXT CLASS

CLAIM CONSTRUCTION II THE PROCESS OF CLAIM CONSTRUCTION

**PATENT LAW & POLICY
PROFESSOR WAGNER**

