

CLASS 11

CLAIM CONSTRUCTION 2:
THE PROCESS OF CLAIM CONSTRUCTION

PATENT LAW & POLICY
PROFESSOR BEAUCHAMP & WAGNER



Today's Agenda

The Process of Claim Construction

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The Process of Claim Construction

Sidebar: Means-Plus Function Claims

The Supreme Court had often disapproved functional claims (why?)

Congress added 112 ¶ 6 in 1952 to address the issue

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Claims (or elements) written in 112 ¶ 6 format are called "means-plus-function" claims / elements. How are they to be construed? Is this different from typical claims?

Identifying MPF Claims

The MPF Rules:

Using the word "means" triggers a presumption in favor of 112 § 6 treatment; non-use of "means" creates the opposite presumption

The presumption can be overcome if the element does or does not recite "sufficient structure"

Elements without structure are 112 § 6 elements

Elements with structure are not.

Identifying MPF Claims

The MPF Rules:

Example from: Personalized Media Communications (not assigned)

Element: "a digital detector for receiving .. and detecting."

Is this an MPF element? (Why?)

What happens if you claim in 112 § 6 format, but don't provide structure in the specification?

What happens if you try to claim functionally, but the court determines that 112 § 6 doesn't apply?

PHILLIPS v. AWH CORP. 1205
Case 1:05-cv-00123-UNA

2005. In assessing defendant's liability for trademark infringement, the court must first determine whether defendant's use of the mark is likely to cause confusion among consumers. The Board also failed to address evidence that defendant's sales rose quickly as a result of its advertising. In 2001, cumulative sales rose from \$800,000 to \$4,000,000 over the next seven months. The company was featured prominently in the trade press for its innovative activities. Because the Board did not address this

Edward B. PHILLIPS, Plaintiff-Appellant,
v.
AWH CORPORATION, Defendant-Appellee,
Nos. 05-2285, 05-2286,
United States Court of Appeals,
Federal Circuit,
July 12, 2005.

Background: Owner of patent for multi-increment wall panels and lesser the utility for infringement. The United States District Court for the District of

For the reasons articulated, I believe the Board committed legal error in weighing the evidence and acted arbitrarily in not considering evidence. These errors had a "bearing on ... the substance of the decision reached" by the Board. See *In re Wertz*, 504 F.2d 1202, 1219 (Fed. Cir. 1974) (internal quotation omitted). Therefore, I will vacate the Board's determination of no acquired distinctiveness and remand for reconsideration consistent with this opinion.

I. Patent 4-02201

Limitation to patent claim for multi-increment wall, calling for "means disposed inside shell for increasing its load bearing capacity" comprising "internal steel baffles" extending inwardly from steel shell walls, radial sufficient structure to avoid nonreciprocity-function treatment. 35 U.S.C.A. § 112, par. 6.

Key

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

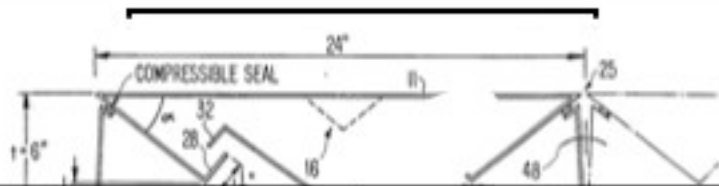
whether the Board considered this evidence in determining the extent to which defendant's use had trademark significance.

summary judgment for former distribution, and never appealed. The Court of Appeals 505 F.2d 1202.

Means disposed inside the shell for increasing its load bearing capacity comprising internal steel baffles extending inwardly from the steel shell walls.

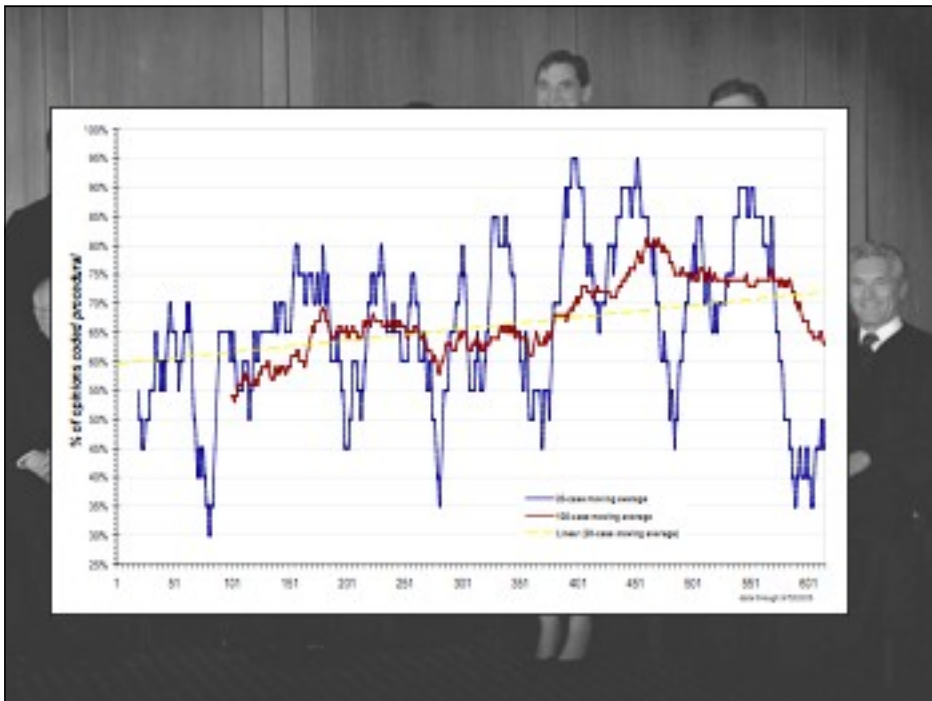
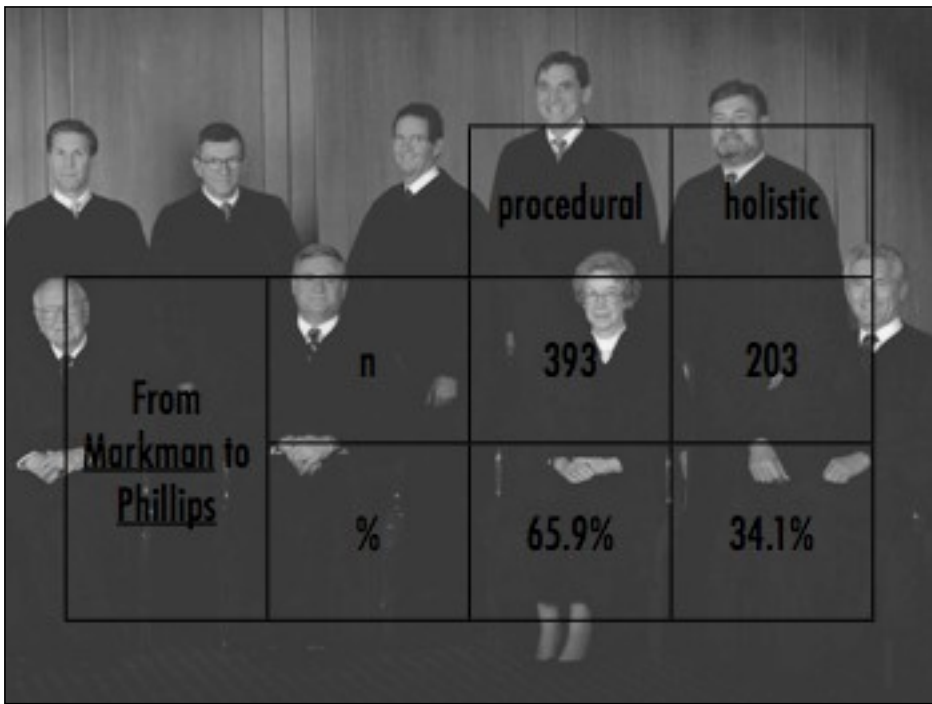
Key

means disposed inside shell for increasing its load bearing capacity" comprising "internal steel baffles" extending inwardly from steel shell walls, radial sufficient structure to avoid nonreciprocity-function treatment. 35 U.S.C.A. § 112, par. 6.



Panel Majority	Panel Dissent
Baffles must be at angles other than 90° to the wall	Baffles can be at any angle
Patent specification describes deflection as a purpose of the invention; 90° baffles are part of the prior art	Nothing in the claims suggests a specific angular requirement

procedural			holistic		
Primary focus on 'ordinary meaning' of claim language; specification only useful if it provides a clear definition; typical use of dictionaries, experts for 'ordinary meaning'			Primary focus on 'context' of claim language, via inferences from specification, prosecution history; little interest in dictionaries, 'plain meaning'		
strong (Ps)	intermediate (Pi)	weak (Pw)	weak (Hw)	intermediate (Hi)	strong (Hs)



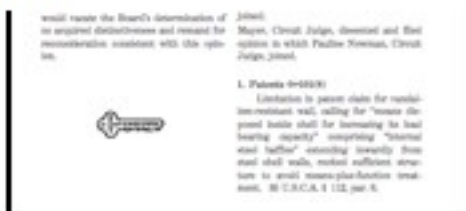


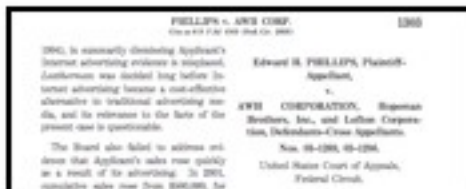
Although the concern expressed by the court in *Texas Digital* was valid, the methodology it adopted placed too much reliance on extrinsic sources such as dictionaries, treatises, and encyclopedias and too little on intrinsic sources, in particular the specification and prosecution history. While the court noted that the specification must be consulted in every case, it suggested a methodology for claim interpretation in which the specification should be consulted only after a determination is made...

That approach, in our view, improperly restricts the role of the specification in claim construction.



As we have noted above, however, we do not intend to preclude the appropriate use of dictionaries. Dictionaries or comparable sources are often useful to assist in understanding the commonly understood meaning of words and have been used both by our court and the Supreme Court in claim interpretation.





[T]he line between construing terms and importing limitations can be discerned with reasonable certainty and predictability if the court's focus remains on understanding how a person of ordinary skill in the art would understand the claim terms. For instance, although the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments.



[W]e [have] recognized that there is no magic formula or catechism for conducting claim construction. Nor is the court barred from considering any particular sources or required to analyze sources in any specific sequence, as long as those sources are not used to contradict claim meaning that is unambiguous in light of the intrinsic evidence....

The sequence of steps used by the judge in consulting various sources is not important; what matters is for the court to attach the appropriate weight to be assigned to those sources in light of the statutes and policies that inform patent law.





claims ordinarily given their ordinary and accustomed meaning	claims are intended to be read as part of the specification	"reference evidence may be used in court, but it is unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence."
language that which a person of ordinary skill in the art would ascribe	"the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to convey with the claims."	patentees can be their own best interpreter
claims are often helpful; courts are often used in their ordinary manner	ictionaries often available; patentees often use terms idiosyncratically	"If the language of the patent, including the preamble, introduction, or description of claim supports the inventor's interpretation, the court should give it weight."

"[w]hat matters is for the court to attach the appropriate weight to be assigned to those sources in light of the statutes and policies that inform patent law."

Non-Phillips Canons of Construction

Claims are intended to be interpreted so as to preserve their validity.

Claims are construed according to the purpose of the invention.

Different claims are interpreted differently.
In this case, the claim is interpreted as if it were a different claim.

Claims are construed to conform with the specific language.

Limitations from a specification cannot be imported into the claim.

The claim should be interpreted to cover the preferred embodiment.





Results

Pre- and Post-Phillips Results (all court opinions)

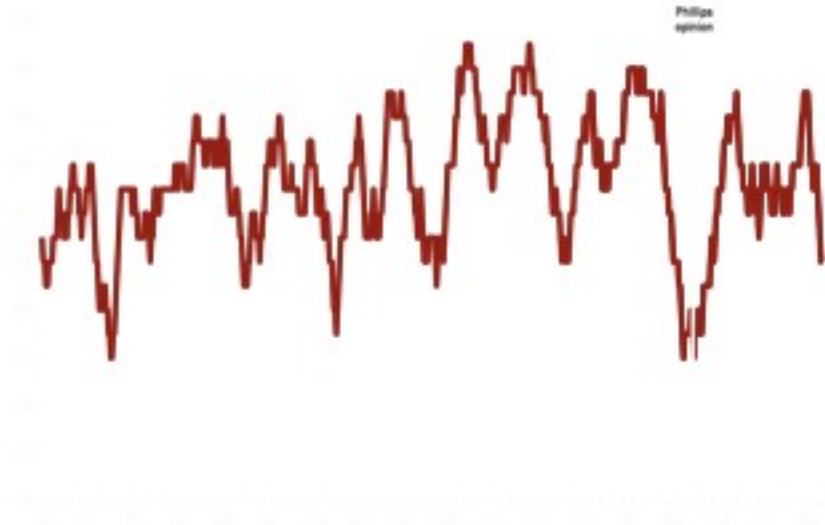
		procedural	holistic
Pre- <u>Phillips</u>	n	393	203
	%	65.9%	34.1%
Post- <u>Phillips</u>	n	74	42
	%	63.8%	36.2%

Results

Pre- and Post-Phillips Results (court opinions, symmetric about Phillips)

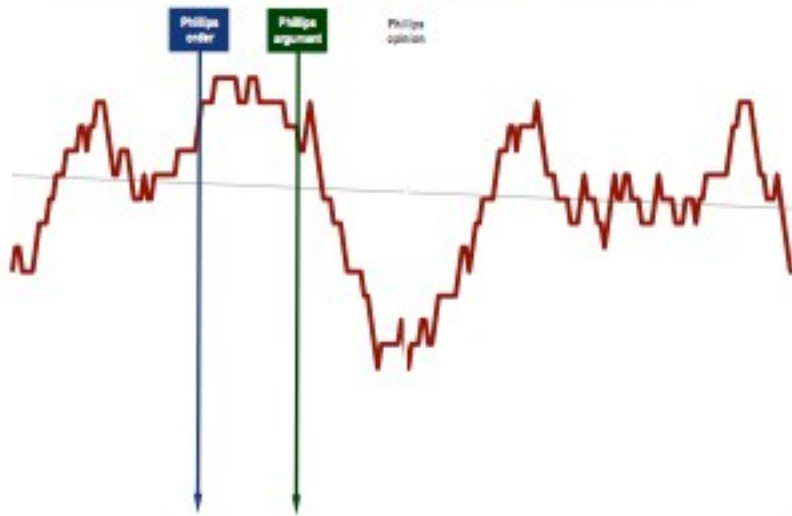
		procedural	holistic
Pre-Phillips	n	79	37
	%	68.1%	31.9%
Post-Phillips	n	74	42
	%	63.8%	36.2%

Methodological Trend - Federal Circuit Claim Construction 1995-2007
(court opinions, 20-case lagged average, n = 712)

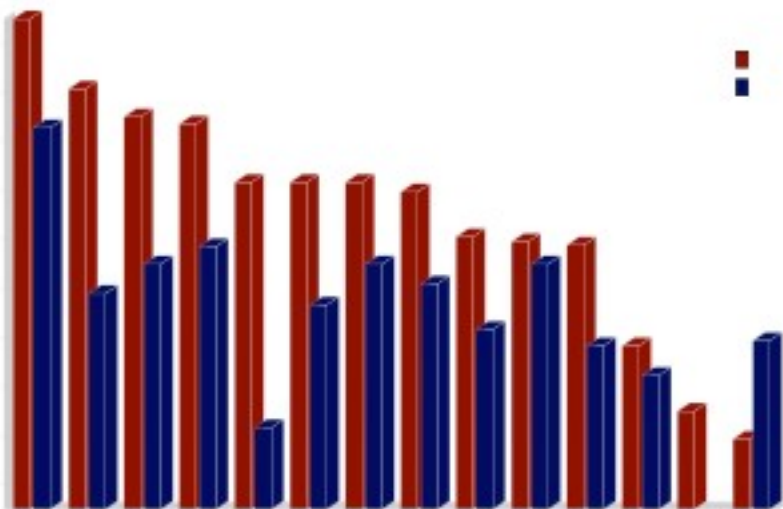


Methodological Trend - Federal Circuit Claim Construction 1995-2007

(court opinions, symmetric about Phillips, 20-case logged average, n = 231)

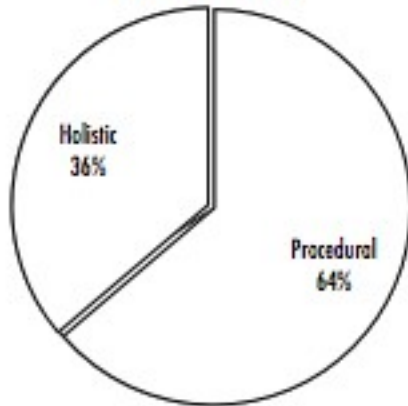


Judges' Methodological Approaches - Post-Phillips



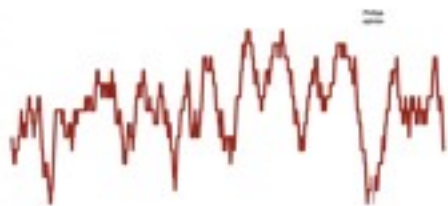
The Phillips Effect?

post-Phillips



- Substantial split remains.
- No meaningful effect on jurisprudence.

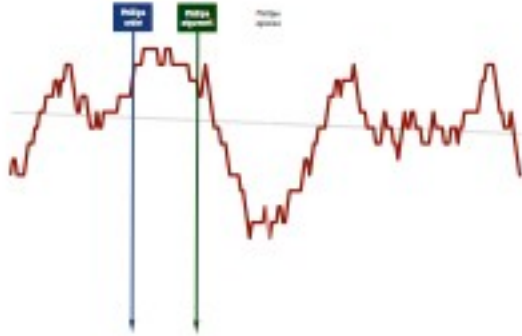
The Phillips Effect?



No substantial change in trends.

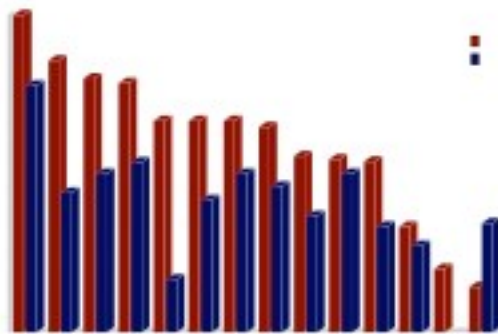
The Phillips Effect?

Any effect appears to have been temporary.



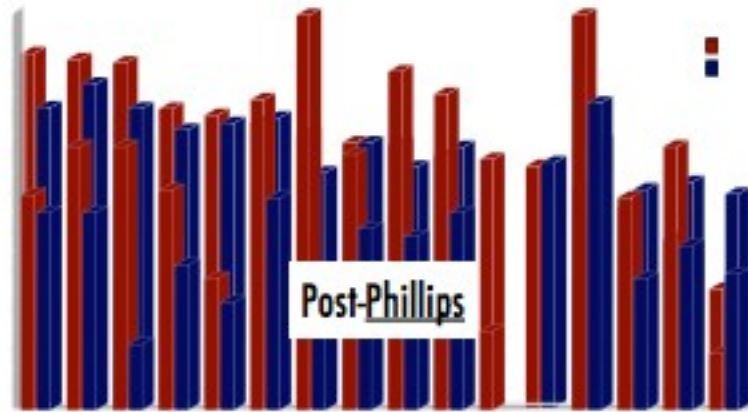
The Phillips Effect?

Judges remain
deeply divided
in their
approach.



The Phillips Effect?

Many Judges have changed their predominant approach.



**Phillips goes en banc
to “clarify” jurisprudence
of methodological approach ...**

**... but no meaningful change
in court’s jurisprudence, trends,
or divergent judicial
approaches.**



Hypothesis 1:

**The Non-Binding Nature of
the Phillips Opinion**
[Judges do what they want]

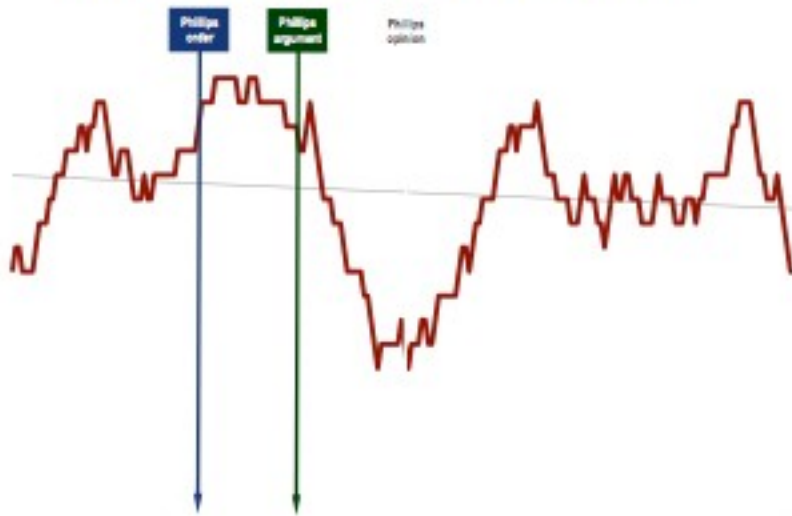


Hypothesis 2:

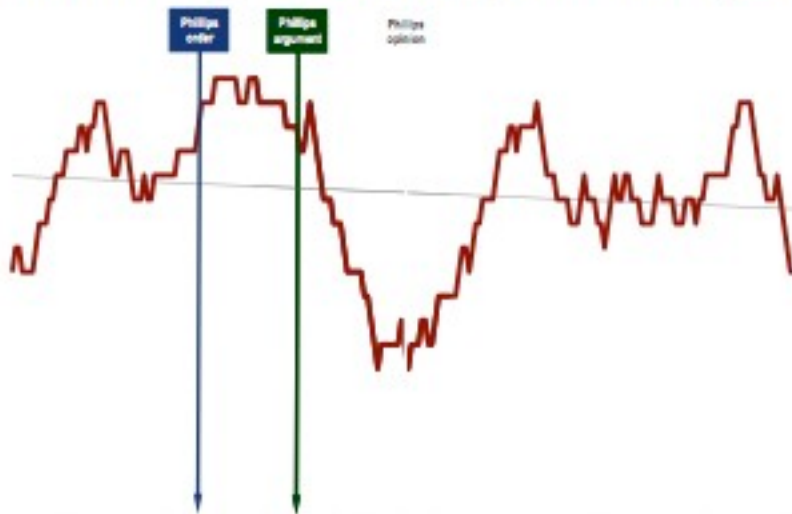
The Court's Decision-Making Process
[Unexpected results?]

Methodological Trend - Federal Circuit Claim Construction 1995-2007

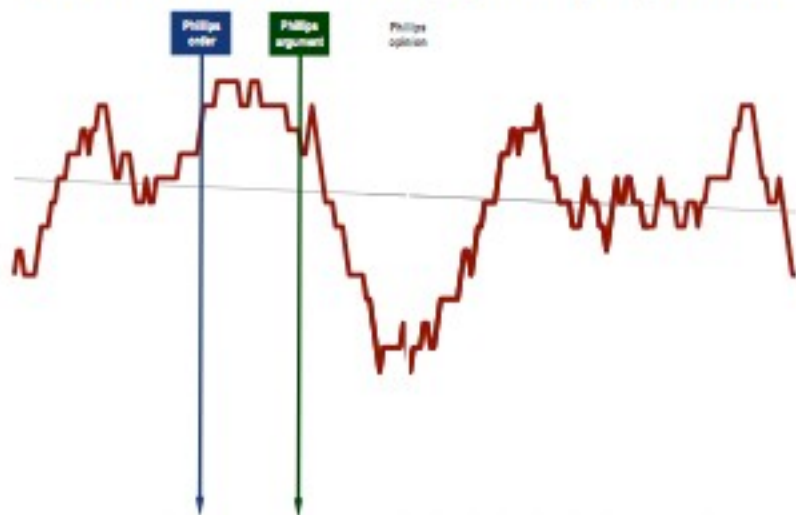
(court opinions, symmetric about Phillips, 20-case logged average, n = 231)



A substantial change between oral argument and the opinion.



...then a return to approximately pre-Phillips equilibrium.



Hypothesis 3:

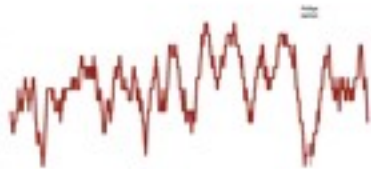
A Results-Oriented Federal Circuit
[Claim Construction = flexible, all-purpose tool]



Hypothesis 4:

Patent Drafting Drives the Result

[$\frac{2}{3}$ of patents are amenable to definition
via their own terms; $\frac{1}{3}$ are more messy]



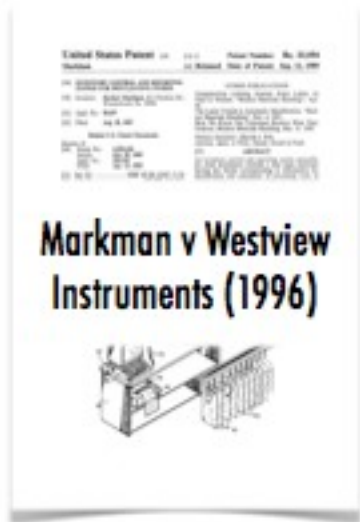
Hypothesis 5:

Jurisprudential Time Lag

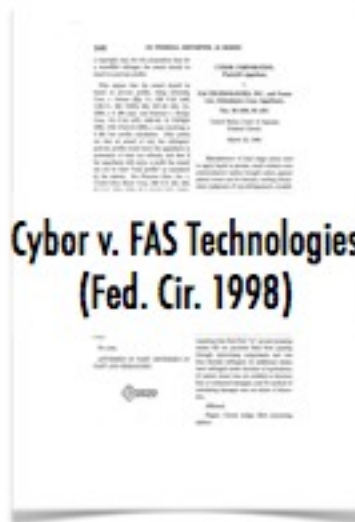
[won't see changes for five or more years]



**Hypothesis 6:
Various Failures and
Limitations of the Study**



**Markman v Westview
Instruments (1996)**



**Cybor v. FAS Technologies
(Fed. Cir. 1998)**

Markman v Westview Instruments (1996)

[T]reating interpretive issues as purely legal will promote (though it will not guarantee) intrajurisdictional certainty through the application of stare decisis on those questions not yet subject to interjurisdictional uniformity under the authority of the single appeals court.

Cybor v. FAS Technologies (Fed. Cir. 1998)

Indeed, the [uniformity passage] demonstrates that the Supreme Court endorsed this court's role in providing national uniformity to the construction of a patent claim, a role that would be impeded if we were bound to give deference to a trial judge's asserted factual determinations incident to claim construction.

NEXT CLASS

**CLAIM CONSTRUCTION III
CLASS EXERCISE**

**PATENT LAW & POLICY
PROFESSOR BEAUCHAMP & WAGNER**

