Claim Construction II:
The Process of Claim Construction
Claim Format

Administrative:

• Tuesday, February 26: Class Exercise 2 (materials in the Distribution Center)
The Process of Claim Construction

or . . . how does a court construe claim language?

Vitronics v Conceptronics (Fed Cir 1986)

- Key claim language: solder reflow temperature
- Patentee: solder reflow temperature = “peak” reflow temperature
- Defendant: solder reflow temperature = “liquidis” temperature (183º C)

Note: “peak” is about 20º higher than “liquidis”, and would capture the accused device

Tools at the District Court’s Disposal
(how much weight should each of these get?)

Paid Expert

Patent Specification

Vitronics Employee

Paper written by Vitronics Employee

Vitronics court filings
The Process of Claim Construction

or . . . how does a court construe claim language?

The Vitronics Framework: establishes two “classes” of information

1. Intrisnic evidence
   • Claims
   • Specification
   • Prosecution History

2. Extrinsic Evidence
   • Experts
   • Other witnesses
   • Outside documents

Relationship between the two classes of information:
where the intrisnic evidence “resolves” the issue, it is “improper” to rely upon the extrinsic evidence

How much does the Vitronics Framework help the issue?

What if the intrisnic evidence points different directions?

When do you know that the construction issue has been “resolved”?

Is it possible to avoid extrinsic evidence? Should we?
**The Process of Claim Construction**

*Johnson Worldwide (Fed Cir 1999)*

**Invention:** trolling motor steering apparatus

**Key limitations:**

a) “A heading detector . . . said heading detector being disposed to transmit said heading signals to said steering circuit.”

b) “a heading lock coupled to a trolling motor”

**Issue:** does the heading detector have to be physically attached to the trolling motor?

<table>
<thead>
<tr>
<th>Information</th>
<th>Direction</th>
<th>Weight?</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Claims</strong></td>
<td>Unqualified, broad language</td>
<td></td>
</tr>
<tr>
<td><strong>Written Description</strong></td>
<td>Interchangeable use of “heading”</td>
<td></td>
</tr>
<tr>
<td></td>
<td>Possible inference that the preferred embodiment has a physical coupling</td>
<td></td>
</tr>
<tr>
<td><strong>Drawings</strong></td>
<td>Figure 1 (above) shows compass attached to motor</td>
<td></td>
</tr>
</tbody>
</table>
The Process of Claim Construction

Johnson Worldwide (Fed Cir 1999)
invention: trolling motor steering apparatus

The Johnson Worldwide “presumption”:

1. Presume claim terms have their ordinary meaning

2. Two circumstance can override the ordinary meaning:
   a) A patentee-provided definition (lexicographer), or
   b) where the claim language is unclear.

How do you find the ordinary meaning?
Any problem with Vitronics?

Thus, Johnson Worldwide attempts to reconcile two conflicting canons of claim interpretation:

1. Claims must be read as part of the specification (i.e., in context)
2. Claims cannot be limited by “reading in” limitations from the specification
The Process of Claim Construction

Johnson Worldwide (Fed Cir 1999)
invention: trolling motor steering apparatus

The Struggles Continue

Johnson Worldwide is the most-cited claim construction case among district courts

And yet the Federal Circuit still wavers . . .

<table>
<thead>
<tr>
<th>Case</th>
<th>Description</th>
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</thead>
<tbody>
<tr>
<td>Watts v XL Sys (2000)</td>
<td>“sealingly connected” limited to the only sealing connection shown in the specification</td>
</tr>
<tr>
<td>Wang v AOL (1999)</td>
<td>“frame” limited to only the character-based systems in the specification</td>
</tr>
<tr>
<td>Toro Co. (1999)</td>
<td>“including a restriction ring” limited to a permanent attachment because that was shown in the specification</td>
</tr>
<tr>
<td>Scimed (2001)</td>
<td>Claimed catheters were limited to a coaxial structure due to statements in the written description; court distinguishes Johnson Worldwide by saying that “the written description can provide guidance as to the meaning of the claims, thereby distating the matter in which the claims are to be construed, even if the guidance is not provided in explicit definitional format.”</td>
</tr>
</tbody>
</table>
# The Process of Claim Construction

## (Some of) The Canons of Claim Construction

| The ordinary meaning of a claim term controls. | Extrinsic evidence cannot be used where the intrinsic evidence is workable. |
| The preferred embodiment / written description / specification cannot be used to adjust claim scope. | The claim shall be interpreted in light of the written description / specification. |
| Different claims, with different words, have different scope. *(Claim differentiation.)* | The claim shall be interpreted to cover the preferred embodiment. |
The Process of Claim Construction

A special problem: “recipe” claiming
Claim covers a mixture of ingredients, not the end result:
“a [composition] containing the following . . . [list of ingredients].”

Thus, infringement centers upon the starting ingredients, not the ending ingredients.

Exxon v Lubrizol: the Federal Circuit interpreted the claim literally, holding that the claim covered a chemical composition that had the specific ingredients at the end.

Exxon had not presented proofs on this point, and thus lost on literal infringement.
Neither party to the case had suggested this particular claim construction.

Lessons?
1. Claim language will be taken seriously, so draft carefully
2. Consider alternative claim constructions -- the Federal Circuit will!
A note on Claim Format

Parts of the claim

<table>
<thead>
<tr>
<th>1. A dining chair</th>
<th>preamble</th>
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<tr>
<td>comprising</td>
<td>transitional phrase</td>
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<td>claim body (element / limitation)</td>
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<tr>
<td>a seat</td>
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<td>a plurality of legs</td>
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</table>

1. Does the preamble limit the scope of the claim? (i.e., does the claim cover a reading chair?)

   Doctrinal rule: the preamble limits the claim when it “breaths life and meaning into the claim”

   Real rule: the preamble limits the claim whenever it limits the claim
   • Descriptions of use are not usually limitations
   • If the claim is structural, then structure in the preamble wil limit the claim
   • If the body of the claim refers back to the preamble, then probably a limitation
# A note on Claim Format

## Parts of the claim

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## Transitional phrases

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<th>Meaning</th>
<th>Coverage</th>
</tr>
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<tbody>
<tr>
<td>comprising</td>
<td>Open-ended</td>
<td>Additional elements covered</td>
</tr>
<tr>
<td>consisting of</td>
<td>Closed-ended</td>
<td>Additional elements not covered</td>
</tr>
<tr>
<td>consisting essentially of</td>
<td>Semi-open</td>
<td>Additional elements covered if not “material” to the claim</td>
</tr>
</tbody>
</table>
A note on Claim Format

Means-Plus-Function Claims

Remember that the Supreme Court had disapproved of functional claims 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?

How do you identify a MPF element?

Cole v Kimberly Clark

*element*: “perforation means extending from the leg band means to the waist band means through the outer impermeable layer means for tearing” (“perforation means . . . for tearing”)
A note on Claim Format

Means-Plus-Function Claims

The MPF rules:
1. Using the word “means” triggers a presumption in favor of 112 ¶ 6 treatment
2. 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

Personalized Media Comm’ns

*element*: “a digital detector for receiving . . . and detecting”

*Is this a MPF element? Why or Why not?*
1. What happens if you claim in 112 ¶ 6 format, but don’t provide structure in the specification?
2. What happens if you try to claim functionally, but the court decides 112 ¶ 6 doesn’t apply?

*Might there be a better way to distinguish between MPF and traditional elements?*