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# Claim Construction on Appeal

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## The Final Showdown:

- Where should you **focus**?
- What **predictability** can you provide to your client?

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## FOCUS:

- You Have a New Audience
  - They wrote the law
- Your Process
  - What appellate strategies work?
  - Can you expect any deference?
  - What about changing your claim construction on appeal?

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## PREDICTABILITY?

- Specifically applicable precedent.
- *En Banc* precedent.
  - ➔ Does *Phillips* clarify?
  - ➔ Is *Cybor* safe precedent?
- Panel driven?

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## FOCUS:

- *This audience is expert*
  - ➔ Adjust your BS meter accordingly
  - ➔ Present only appellate-worthy issues

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## **FOCUS: Appellate-Worthy Claim Construction Issues**

- Select from multiple issues
- Prioritize the selected issues
- Craft the selected issues

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## **FOCUS: Selecting from multiple issues**

- Choose the best – discard the rest.
- More than 4 issues lose punch.
- Consider trial myopia.

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## FOCUS: Selecting from multiple issues

- Standard of review: *de novo*.
  - However, not always an entirely new bite at the apple.
  - How would the Federal Circuit consider the *process* performed by the district court?
  - Could this be classified as an *infringement argument*, rather than claim construction?

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## FOCUS: Selecting from multiple issues

- Appellant:
  - Choose the issue that, if decided your way, compels complete victory.
  - Keep the issues clean –
    - Avoid issues that intertwine with each other.
    - Avoid issues that have contradictory proofs.

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## FOCUS: Selecting from multiple issues

- Appellee:
  - You are stuck with what appellant chooses, but . . .
  - You are not stuck with Appellant's characterization. (see crafting and prioritizing the issues)

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## FOCUS: Prioritizing the selected issues

- All claim construction issues are not equal.
  - most obvious error in the district court's decision.
  - least contradictory arguments, *i.e.*, stick with intrinsic evidence.
  - order is important to Appellee too.

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## FOCUS: Crafting the selected issues

- Appellant – it's all claim construction.
  - ➔ Sometimes claim construction makes the infringement determination a matter of law.
    - ◆ *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*  
73 F.3d 1573, 1578 (Fed. Cir. 1996).
  - ➔ Don't forget to object to jury instructions (FED. R. CIV. P. 51).

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## FOCUS: Crafting the selected issues

- Appellee: this is all really an infringement argument masquerading as claim construction.
  - ➔ Bound-up in the facts of infringement and must be determined under the clearly erroneous standard.
    - ◆ Complex scientific principles
    - ◆ Expert testimony
    - ◆ Testing necessary

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## PREDICTABILITY

- Based on the issues?
- Based on precedent?
- Based on the panel?

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## PREDICTABILITY: Issues

- Straight forward application of *solid* precedent to your issues.
  - *Markman, Vitronics, Phillips*
- Show that the District Court properly walked through the rubric.
  - First Intrinsic: claims, specification, file history.
  - Then Extrinsic: only necessary to clarify.

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## PREDICTABILITY: Issues

- **Specific case similarities of limited use.**
  - ➔ Patents are interpreted with respect to the intrinsic evidence
  - ➔ Hence, case law turns on the intrinsic evidence which varies from case to case
- **Many seemingly contradictory cases may be resolved by reading the entire case.**
  - ➔ What distinctions can you draw from decisions that appear to cut against you? Don't generalize.
  - ➔ Consider the intrinsic evidence . . . .

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## PREDICTABILITY: Precedent

- **Does *Phillips* clarify?**
  - ➔ *Phillips* returns the court to the procedure outline in *Markman* and *Vitronics*.
  - ➔ If you faithfully can apply that procedure, the chances of achieving your desired result increase.

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## PREDICTABILITY: Precedent

### ● Is *Cybor* safe precedent?

- Much criticism of *Cybor*, but it is *en banc* precedent.
- Over 30 amicus briefs in *Phillips*, most recommended revisiting the *de novo* issue.
- Consider: Claims should be construed from the perspective of **one of ordinary skill in the art**. (*strategy call*)

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## PREDICTABILITY: Panel

### NOTICE: Announcement of Panel Members

Beginning February 6, 2006, the membership of each argument panel will be posted on the [Pending Argument Calendar](#) each morning of court week at 9:00am. For those days on which the court schedules an afternoon session, the panel membership will be posted at 11:00am.

<http://fedcir.gov/>

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## Changing Claim Construction on Appeal

- “Slippery Slope”
  - ➔ Under *de novo* review, what prevents the Federal Circuit from adopting an entirely different claim construction than decided or argued below?
  - ➔ If the Federal Circuit can adopt its own claim construction, why shouldn’t litigants be able to argue something different on appeal?
    - ◆ Equity, Judicial Economy

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## WAIVER of Claim Constructions

- Earlier Federal Circuit case law finds waiver of claim construction arguments.
  - ➔ *Eli Lilly & Co. v. Aradigm Corp.*, 376 F.3d 1352, 1360 (Fed. Cir. 2004) (failure to raise until after jury instructions too late).
  - ➔ *Hewlett-Packard Co. v. Mustek Sys., Inc.*, 340 F.3d 1314, 1321 (Fed. Cir. 2003) (JMOL too late to change claim construction).
- But – Federal Circuit retains case-by-case discretion whether to apply waiver.

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## WAIVER: Recent Cases

- *Gaus v. Conair Corp.*,  
363 F.3d 1284, 1288 (Fed. Cir. 2004) (Bryson, J.)  
(no waiver because construction has not changed  
and embodies the “same concept.”).
- *Harris Corp. v. Ericsson*,  
417 F.3d 1241 (Fed. Cir. 2005) (Prost, J.)  
(*Gajarsa, dissenting*) (relies on *Gaus*).
- *LizardTech, Inc. v. Earth Resource Mapping,  
Inc.*, 424 F.3d 1336 (Fed. Cir. 2005) (Bryson, J.)  
(Change of claim construction *waived*. Plaintiff  
agreed to district court’s construction.)

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## Recent Cases: *Harris v. Ericsson* (Fed. Cir. 2005)

- Defendant failed at district court to argue  
application of *WMS Gaming* presented on  
appeal
  - A computer-implemented means-plus-function term is limited  
to the corresponding structure disclosed in the specification  
and equivalents thereof, and the corresponding structure is  
the algorithm.
- Plaintiff argued waiver.

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## Recent Cases: *Harris v. Ericsson* (Fed. Cir. 2005)

### ● Held:

- Choice of law on claim construction waiver  
– Federal Circuit (of course).
- Same construction, just a different theory,  
*i.e.*, *Gaus*.
- Change in claim scope extremely minor.

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## *Harris v. Ericsson*

### ● “Change in claim scope extremely minor”

- “Shifting from a ‘function’ theory to a ‘structure’ theory **modifies the claim scope in one minor way**: equivalent structure infringes literally (as long as the equivalent structure was a technology that was available prior to the issue date of the patent), whereas an equivalent function would infringe under the doctrine of equivalents.”

*Harris*, 417 F.3d at 1252.

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## ***Harris v. Ericsson***

- Other differences:
  - **Literal infringement under § 112, ¶ 6 differs:**
    - ◆ Function must be “*identical*.”
    - ◆ Structure may be “equivalent structure.”
  - **Equivalents analysis differs:**
    - ◆ Under § 112, ¶ 6, equivalent structure infringes literally – and is existing technology
    - ◆ DOE – later developed technology
    - ◆ Different factual evidence and considerations

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## ***Harris v. Ericsson***

- How was *WMS Gaming* overlooked?
  - **Leading law firms**
  - **Special master**
- Is this an appropriate case to allow such a change in litigation strategy on appeal?

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## WAIVER: Considerations

- No new claim construction on appeal.
  - ➔ *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1370 (Fed. Cir. 2002).
  - ➔ *Interactive Gift Express*, 256 F.3d 1323, 1346 (Fed. Cir. 2001).
- Changed claim construction *waived* if adopted construction not objected to at trial. *Lizardtech*.

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## WAIVER: Considerations

- BUT:
  - if you can argue that changed claim construction actually just the “*same concept*” with additional support and does not change scope.
- *Gaus, Harris*, allowed “*same concept*” idea.

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QUESTIONS?



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