

Claim Construction Procedure and Timing

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Overview

- *Markman* does not dictate the logistics for claim construction:
 - Procedure
 - Timing

Overview (cont'd)

- Procedural Options for Claim Construction
 - paper record alone
 - hearing with attorney argument only
 - hearing with live testimony

Overview (cont'd)

- Timing Options for Claim Construction
 - before discovery
 - during fact discovery
 - close of fact discovery
 - close of expert discovery
 - in conjunction with summary judgment motions
 - during trial

Procedural Options

Paper Record

- *Markman* does not compel “*Markman* hearings”
- *Markman* hearings are sometimes deemed unnecessary:
 - *Revlon Consumer Products Corp. v. Estee Lauder Companies, Inc.*, No. 00 Civ. 5960 RMB AJP, 2003 WL 21751833, at *14 (S.D.N.Y. July 30, 2003) (“A ‘*Markman* hearing’ to interpret the claim language is unnecessary in this case, because the sole disputed claim term -- ‘completely coated’ -- is neither ambiguous nor highly technical.”)

Paper Record (cont'd)

- *Revlon* cites the following cases in which *Markman* hearings were deemed unnecessary:
 - *Aspex Eyewear, Inc. v. E'Lite Optik, Inc.*, No. Civ. A. 398CV2996, 2002 WL 1751381, at *1 (N.D. Tex. Apr. 4, 2002)
 - *Rogers v. Desa Int'l, Inc.*, 166 F. Supp. 2d 1202 (E.D. Mich. 2001)
 - *Electronic Planroom, Inc. v. McGraw-Hill Cos.*, 135 F. Supp. 2d 805 (E.D. Mich. 2001)
 - *Interactive Gift Express, Inc. v. Compuserve Inc.*, 95 Civ. 6871, 1998 WL 247485, at *1 (S.D.N.Y. May 15, 1998), *vacated on other grounds*, 256 F.3d 1323 (Fed. Cir. 2001)
 - *Brosnan v. Rollerblade, Inc.*, No. C97-0782, C97- 3258, 1998 WL 209155, at *1 (N.D. Cal. Apr. 27, 1998)
 - *LRC Elec., Inc. v. John Mezzalingua Assocs., Inc.*, 974 F. Supp. 171 (N.D.N.Y. 1997)
- Claim construction on paper record avoids multiple “trials”

Paper Record (case summaries)

- *Aspex Eyewear, Inc.*, 2002 WL 1751381, at *11 n.6 ("A *Markman* hearing is unnecessary in this case. In some patent cases, a claim construction hearing allows the court to question and evaluate attorney argument and/or witness testimony regarding the competing claim constructions. This process may be helpful when the claims are ambiguous or the technology is complex. Nothing, however, mandates the use of a *Markman* hearing in every patent case. Courts retain the discretion to construe the claims on the basis of a paper record alone. In a case such as the present one, where the technology is accessible to the court and the claims are relatively straightforward, a *Markman* hearing is unnecessary .")
- *Desa Int'l, Inc.*, 166 F. Supp. 2d at 1205 (finding it unnecessary to hold a *Markman* hearing: "Given the lack of technical and linguistic complexity and lack of conflicting factual evidence, I find the papers filed are sufficient to construe the claims.")
- *Electronic Planroom, Inc.*, 135 F. Supp. 2d at 832 n.25 ("[T]he Court is satisfied that, for purposes of the present motions, the claims may be construed by resort to the plain meaning and ordinary understanding of their terms.... Under these circumstances, the Court finds it unnecessary to conduct a separate *Markman* hearing before ruling on the pending motions.");
- *Interactive Gift Express, Inc.*, 1998 WL 247485, at *1 n.3 ("The Court notes at the outset that no *Markman* hearing is needed in this case because the Court does not require expert or other testimony to aid it in its claim construction.")
- *Brosnan*, 1998 WL 209155, at *3 (deciding claim construction issue without *Markman* hearing: "Although the Court has yet to hold a formal claims construction hearing in this case, the interpretation of the claims at issue for this motion has been thoroughly briefed and argued by the parties.");
- *LRC Elec., Inc.*, 974 F. Supp. at 181-82 (N.D.N.Y. 1997) ("A *Markman* hearing to define the [disputed claim] term ... would only be necessary if the Court needed expert testimony to interpret the term.... After carefully considering the language used in claim one, the specification, and Webster's Dictionary, the Court finds that the meaning of the [claim] term ... is the one stated in Webster's Dictionary and hence no *Markman* hearing[] is needed in the instant case....").

Evidentiary Hearing

- Opportunity for the Court to engage in Q & A with attorneys, experts and fact witnesses
 - flush out disputed questions of “law”
 - evaluate extrinsic evidence

Timing Options

Before Discovery Begins

- Discovery is not required prior to claim construction. *Vivid Technologies, Inc. v. Am. Science & Eng'g, Inc.*, 200 F.2d 795 (Fed. Cir. 1999).
- **Advantages**
 - costly discovery may be avoided
 - may facilitate early settlement discussions
 - facilitates focused discovery
 - tactical advantage to patentee of forcing defendant to take early positions
- **Disadvantages**
 - potential inefficiencies of addressing claim terms not actually at issue
 - useful evidence might not yet be available
 - can lead to multiple rounds of claim construction
 - can lead to constructions which themselves require constructions
 - constructions may not facilitate efficient summary judgment proceedings

After Fact Discovery

- **Advantages**

- both parties in position to fully articulate positions
- likely that only claim terms at issue will be addressed
- all evidence is available
- evidence and expert testimony need not be presented in the alternative
- increased certainty that claim construction is final
- efficient summary judgment procedures

- **Disadvantages**

- claim construction may give rise to need for further discovery

After Fact Discovery (cont'd)

- *MacNeill Engineering Co. v. Trisport, Ltd.*, 126 F. Supp. 2d 51, 55 (D. Mass. 2001) (“It has now become generally accepted that, barring a case so clear that quick resolution is manifestly in the litigant's interests to minimize transaction costs, the best time to hold the Markman hearing is at the summary judgment stage of the litigation--at or near the close of discovery while some time yet remains before trial for the parties to gear up (or settle) in light of the judge's claim construction.”)

After Expert Discovery

- **Disadvantages**
 - experts need to opine in the alternative
 - does not facilitate efficient resolution by summary judgment
 - claim construction may give rise to need for additional fact and expert discovery

In Conjunction with Summary Judgment Motions

- Some courts have expressed disapproval of free-standing *Markman* hearings:
 - *MediaCom Corp. v. Rates Technology, Inc.*, 4 F. Supp. 2d 17 (D. Mass. 1998)
 - *Thomson Consumer Elecs. v. Innovatron, S.A.*, 43 F. Supp. 2d 26 (D.D.C. 1999)

In Conjunction with Summary Judgment Motions (cont'd)

- **Advantages**

- Court will have context for analysis and ruling
- avoids unnecessary claim constructions

- **Disadvantages**

- not all disputed claim terms give rise to summary judgment motions
- if summary judgment motions cannot be made early, evidence and expert opinions must be provided in the alternative
- legal standards for claim construction may be conflated with legal standards for infringement or validity

Early Summary Judgments Can Sometimes Be Filed Prior to Claim Construction

- “In the instant case, plaintiff has advanced no construction of any of the claims of the ‘850 patent that would bear upon the written- description issue, or that would affect my decision on that issue.” *Univ. of Rochester v. G.D. Searle & Co.*, 249 F. Supp. 2d 216, 221 n.2 (W.D.N.Y. 2003), *aff’d*, 358 F.3d 916 (Fed. Cir. 2004).
- *SIBIA Neurosciences, Inc. v. Cadus Pharm. Corp.*, 225 F.3d 1349, 1355 (Fed. Cir. 2000) (finding it unnecessary to decide construction of the term "cell," since claim in question was obvious in any event).

At Trial

- **Advantages**

- avoids delay concomitant with *Markman* proceedings
- puts the Court in the best position to know how claim construction rulings impact case
- allows the Court to hear evidence without concern over restrictions on consideration of extrinsic evidence

- **Disadvantages**

- summary judgment is very difficult to obtain
- trial will be much more complicated
- party whose claim construction is rejected may be prejudiced
- may cause juror confusion

35 U.S.C. § 112 Issues

- Claim construction without consideration of 35 U.S.C. § 112 issues may result in claims construed such that they are invalid for indefiniteness, lack of written description and/or lack of enablement
- Law that “claims should be so construed, if possible, as to sustain their validity” (*Rhine v. Casio*, 183 F.3d 1342, 1345 (Fed. Cir. 1999)) suggests claim construction and § 112 issues should be considered together
- However, the Federal Circuit held in *Phillips* that “While we have acknowledged that claims should be construed to preserve their validity, we have not applied that principle broadly, and we have certainly not endorsed a regime in which validity analysis is a regular component of claim construction”

Thank You

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