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LITIGATION STRATEGIES – ISSUES IN CLAIM CONSTRUCTION  
JANUARY 26, 2007

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I.  
THE UNCOMFORTABLE ROLE OF THE ADVOCATE  
IN CLAIM CONSTRUCTION

Claim construction is an area of our practice where zealous advocacy of extreme positions is rarely the best policy, persistent advocacy of difficult positions is often rewarded, and credibility – as to the technology, as to the law, and as to the record is critical. Nonetheless, claim construction poses some difficult problems for counsel: temptations to advocate too zealously arise, to our client’s detriment. Here are some thoughts as to how to deal with specific instances of such temptations, bearing in mind the overarching importance of credibility and the varying perspective depending upon which side of the court you are seated upon.

II.  
IS THE SABER MORE DANGEROUS THAN THE EPEE?  
OR HOW NARROW DO YOU WANT YOUR CLAIM TO BE?

To state the obvious generality:

Patentee/plaintiffs want narrow claim constructions for validity purposes, broad claim constructions for infringement purposes;

Accused infringers/defendants want broad claim construction for validity purposes, narrow constructions for infringement purposes.

Claims are to be interpreted identically, however, regardless of the purpose. *See e.g.*, Federal Circuit Bar Association Model Patent Jury Instructions, No. 7.1. This forces counsel to consider, as to each contentious limitation, whether a broader or a narrower interpretation would better serve the client’s interests.

Most often, by the time a case gets to claim construction, the plaintiff is more worried about its infringement case than losing the patent on validity grounds. Hence, the plaintiff is pushing for as broad an interpretation as possible. Conversely, it seems, the defendant is more often convinced that it can win an easy summary judgment of non-infringement, if only the court grants a narrow interpretation of the claim. So this, then, is the classic duel. The plaintiff wants to fight with the broad saber, the defendant wants to limit the weapons to the fine épée. And the judge, playing seconds for both dueling parties, has to decide.

This norm presents a landmine to counsel credibility. Where the patent is a small but critical improvement over copious prior art, which the defendant has copied wholesale, plaintiff’s counsel will be arguing for a narrow reading of the claim. Conversely, if the defendant believes it should have design freedom in this area, given all the similar prior art, defendant’s counsel needs to advance a broad interpretation.

Either of these changes from the norm (and they both generally happen together), will place counsel's credibility in jeopardy. The impact upon defense counsel, however, is likely to be greater. To the spectator, the plaintiff is saying: "the defendant is copying my patent so closely that you can narrow me down to just my best mode as shown in figure 1, and I still win on infringement." But the defendant, on the other hand, is perceived to be conceding that infringement is so problematic that the defendant must risk overcoming the presumption of validity, the clear and convincing standard of proof, and the unspoken confidence of the jury that our government would never make a mistake.

If this is defendant's position, the trial judge will likely be surprised. *See, Advanced Medical Optics, Inc. v. Alcon Laboratories, Inc.*, Transcript, Claim Construction Hearing, Dec. 20, 2004, p. 46. Counsel must address the court's likely reaction preemptively:

Explain at the outset of discussion of this limitation/element that the defendant is seeking a broader interpretation than is the plaintiff;

Point out (if possible and if the court will permit substantive discussion) that the interpretation of this element does not affect the powerful non-infringement arguments defendant has;

Cast the discussion as one in which the plaintiff's interpretation is unnaturally narrow rather than one in which defendant's is surprisingly broad;

Do not go broader than the record will support.

### III.

#### "FUZZY LOGIC" AND THE FEDERAL CIRCUIT

In *Warner Jenkinson*, the Supreme Court addressed a claim that required that a step of a dye filtration process occur at a pH level "from approximately 6.0 to 9.0." *Warner-Jenkinson Co., Inc. v. Hilton-Davis Chemical Co.*, 520 U.S. 17, 117 S. Ct. 1040 (1997). This is simply the most famous example of vague claim terms that the courts are required to construe. And when a trial judge confronts such claiming, counsel is often front and center in explaining how close is close and how high is high.

Particularly troubling examples:

#### ***"at least about"***

A search for patents issued since 1976 in which the phrase "at least about" appears in the claims returned 67,376 hits.

#### **U.S. Patent No. 7,158,607**

13. The method of claim 1, wherein said irradiating further comprises generating X-ray radiation having a filtered broad beam energy spectrum, a half-power energy being substantially in a range from ***at least about*** 100 keV to about 250 keV.

**U.S. Patent No. 7,158,545**

2. The quantum cascade laser of claim 1, wherein said non-radiative relaxation of the lower lasing state into the relaxation state at a selected operating temperature of said laser is faster than a corresponding relaxation rate of said upper lasing state into said lower lasing state, and wherein said resonant LO-phonon emission selectively depopulates the lower lasing state such that a ratio of a lifetime of said upper lasing state relative to lifetime of said lower lasing state is *at least about* 10.

**U.S. Patent No. 3,933,476**

1. A method for grain refining aluminum which comprises
  - a. providing a bath of molten aluminum base metal
  - b. making an addition to the bath of molten aluminum in the form of a blended mixture consisting essentially of finely divided titanium, aluminum and KBF.sub.4, the aggregate amount of titanium in the addition being *at least about* 0.005% by weight of the molten metal and being in an amount sufficient to provide in the molten bath a percentage titanium content selected from the range of about 0.01 to 0.08%, the aggregate amount of KBF.sub.4 in the addition being such as to contain boron in an amount equivalent to a percentage of the molten bath falling within the polygon (A) of the graph of FIG. 1 of the drawing corresponding to the selected percentage of titanium, the amount of aluminum being from about one-tenth to 4 times the weight of titanium in the mixture.

*“close to”* (122,000 hits since 1976.)

**U.S. Patent No. 7,159,158**

3. The method according to claim 2, further comprising the steps of: preparing judging values for specifying the data components (X<sub>2</sub>, . . . , X<sub>n</sub>) having data of logical addresses included in address spaces (A<sub>2</sub>, . . . , A<sub>n</sub>) *close* to the address space A<sub>1</sub>, the data components (X<sub>2</sub>, . . . , X<sub>n</sub>) having the data stored sequentially in the order of closeness to the address space A<sub>1</sub>; specifying a data component X<sub>k</sub> (k=1, 2, . . . , n), by k-time specifying operation, by means of the judging values in accordance with an address space including an input logical address; and outputting the data component X<sub>k</sub>.

*“rough”* (6,000 hits since 1976)

**U.S. Patent No. 7,130,098**

1. A macroscopic mirror for wide angle scanning applications comprising: a silicon substrate section of a predetermined shape and macroscopic size cut from a silicon wafer comprising a flat, polished surface side and an etched, *rough* surface side; and a plurality of layers, including a layer of reflective medium, disposed on the flat, polished surface of said substrate section in such a manner to minimize flexural distortion of said flat surface.

*“big”* (934 hits since 1976)

### U.S. Patent No. 7,149,411

1. A non-linear reproduction control method of a multimedia stream comprising: judging a skip direction by interpreting whether a skip request is a forward skip or a backward skip when the skip request is inputted from the user; determining a skip unit by judging whether the user request is a *big* unit or a small unit; selecting a structural information or semantic information alternation point of the multimedia stream mostly adjacent to the present reproduction position as a reproduction resuming point on the basis of the determined skip direction and skip unit; and resuming reproduction of the media from the selected point.

The Federal Circuit has, of course, provided guidance as to how such terms should be interpreted. But that guidance is entirely subjective and contextual. Counsel must provide the context in order that the court can make the necessary specific determination.

Ignoring what *Warner-Jenkinson* now stands for, the case is a useful illustration of the role of counsel in quantifying these essentially subjective qualifiers. The invention related to a filtration system for dyes. The inventors contended that if one operated the filtration system at something too far below a pH of 6.0, the dye would foam. The exact point at which foaming began, however, was never clearly specified and appears not to have concerned the inventors over much. The argument was therefore available that 6.0 should not be a hard floor, but merely a shorthand to the rough vicinity in which, as the acidity of the system decreased, foaming diminished to an acceptable level. Hence, a pH of 5.8 might really be well within the claimed invention if the system could be operated with no foaming at this level of acidity. This argument, of course, would need to be supported by references to the specification, the file history, and perhaps, extrinsic evidence, but if that record is there, counsel is both advancing the cause of the client while assisting the judge in solving the interpretation problem.

Defendants, on the other hand, are likely to object to subjective qualifiers under any number of theories: Section 112 problems, encompassing the prior art, etc. Take the example of “rough.” At a sufficient level of magnification, all surfaces appear rough. As a result, people concerned with the degree of roughness have well defined criteria by which this quality can be specified. The most familiar of these, of course, is the granularity of sandpaper – 50 grit, 150 grit, etc. But far more comprehensive standards exist and are frequently specified where such details are important. Examples include the surfaces of molds where roughness affects the ease with which the molded product can be removed from the mold; the surfaces of bearings in which friction increases with roughness; and the quality of a mirror.

The trial judge likely has no idea that such standards exist. To the judge, perhaps, the use of rough versus smooth makes some sense because in the common experience, there is little other way to describe the texture of a surface. Defense counsel is there to open the judge’s eyes to the dangers that such an ambiguous claim presents in the real world and the ease with which the patent applicant could have created a claim that was clear. Again, it requires a command of the subject matter and the ability to present adequate extrinsic evidence.

#### IV. THE PLAIN, ORDINARY MEANING OF “FLUORINATED XANTHENE DERIVATIVE”

Claim construction is a question of law. With any disputed term, we start with the plain, ordinary meaning. We then check that the inventor has not expressly adopted a different definition in the body of the specification. Finally, assuming that the inventor did not do so, we read the term “in light of” the specification, the file history, and the prior art of record. Thus, as is the case with statutes, it should be pretty easy to interpret the claims as a matter of law from the undisputed record before the court.

If only it were that simple.

The problem lies in that very first step, of course. The plain, ordinary meaning of a plain, ordinary word may be pretty simple. But what is the plain, ordinary meaning of “fluorinated xanthene derivative,” “parasitic capacitance,” and the innumerable other technical terms used in claims? The test is not what is the plain ordinary meaning in plain, ordinary usage. The test is what is the plain, ordinary meaning to one of skill in the art to which the patent obtains. And how is the judge supposed to know that?

The judge, of course, looks to counsel. Counsel, in turn, must have gone to school with the client to understand the terminology. And here, the courts are frequently offering us a gift in the form of a tutorial hearing. These tutorials constitute an opportunity to establish our bona fides as a resource on which the court can rely for exactly this sort of guidance. Demonstrate your command of the subject and your integrity in the tutorial. You and your client will be well served at the subsequent claim construction hearing.

As an aside, the court will sometimes leave it to the parties whether to present the tutorial as a Q&A with an expert, by way of a lawyer at the podium with graphics, or through the use of a video. The lawyer at the podium offers advantages over either of the other options.

When asked to submit a video, many parties often simply film their trial counsel or their expert talking at the podium. They thereby lose the pedagogical advantages of animation and video. But doing a good video is so incredibly expensive and takes sufficient time that many clients are not willing to do this early in the case. Moreover, the video has to be comprehensive enough to anticipate all possible questions from the bench, without being so comprehensive that it buries the salient points.

While an expert testimony approach has the advantages of inherent credibility, command of the material, and real time responsiveness, there are risks in putting your key witness on the stand, in what may well become an unscripted back and forth with the judge. In addition, at this stage of the case, between the judge, your expert and you, the only one of the three of you who knows what the important legal issues are going to be is you. So a dialogue between the judge and the expert frequently wanders far from any real issue in the case.

So make yourself an expert, take the podium, and use the tutorial to establish in the court’s eyes your credibility while steering the court to those parts of the technology that are

important to your client's case. Then use the court's improved understanding of the technology to help the judge see the key technical claim terms through the eyes of one of skill in the art.

## V. OOPS, I DID IT AGAIN – WHEN DOES A MISTAKE COUNT?

Finally, the court must depend on counsel when confronted with apparent anomalies in the claim language. Between the Patent Office printer and the soliciting attorney, someone is going to make a mistake. Sometimes, those mistakes are in the claims and sometimes those claims get litigated. When that happens, counsel must take the court to a place where *Markman* does little good.

The operative law, *Novo Indus., L.P. v. Micro Molds Corp.*, 350 F. 3d 1348 (Fed. Cir. 2003), permits the trial court to correct an error in the claims if:

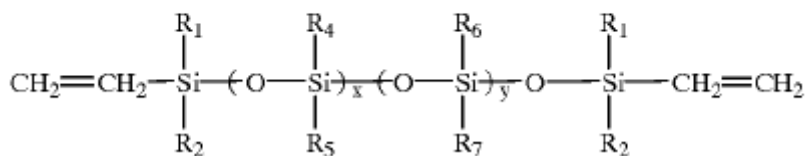
1. Based on what is written the claims and the specification, the correction is not subject to reasonable debate; and
2. The prosecution history does not contradict the correction.

How this plays out in practice is, of course, much more complicated. Let's look at two examples.

In a certain patent, the claims refer to "sensing a vacuum" or a "sensed vacuum" multiple times. But in one claim, the phrase "sending a vacuum" is used. That claim went to litigation. The defendant argued that one cannot "send" a vacuum any more than one can put sunshine in a bottle. And therefore, the claim was fatally defective under section 112. The plaintiff argued that "sending a vacuum" was clearly a typographical error, probably caused by the proximity of the "S" and "D" keys on a QWERTY keyboard. Result: the claim was corrected to read "sensing a vacuum" and a withdrawal was made from defense counsel's credibility account.

Here is, perhaps, a more subtle problem. In a patent to a product made from a particular class of polymers, the claims require:

a cross-linked silicone polymer of the reaction between a  
copolymer having the formula



To a chemist, this is either absurd or breathtaking: known forms of carbon do not form five bonds, as shown occurring in the penultimate carbons at each end of this chain. Since the specification does not refer to any some new isotope of carbon, it must be presumed that the

formula is simply mistaken. But how to correct it? Should there be a double bond and only one H to the penultimate carbons, or a single bond and two Hs?

First, look at the application. In this case, that was not helpful as the formula is shown the same way and the claim allowed on a first office action. Therefore, compare the claim to the formula in the specification. Unfortunately, the formula isn't shown in the specification. The formula is, however, described as follows:

30 The polymer has end blockers containing siloxane units of the formula  $R_1R_2R_3\text{-Si-O}_n$  wherein  $R_1$  and  $R_2$  are alkyl, aryl or substituted alkyl or substituted aryl groups, and  $R_1$  and  $R_2$  may be identical or different from one another. The  $R_3$  group of the end blocking siloxane units is an alkenyl group. Preferably, the end blocker is a dimethylvinyl siloxane unit.

To one of skill in the art, this is as much beyond reasonable debate as the first example. Counsel must help the judge understand that the problem is not with  $R_1$  or  $R_2$ , because these can include both substituted groups and aryl groups and the defective part of the formula clearly is neither of those. That means that the mystery group in the formula must correspond to  $R_3$ , which means that it is an alkenyl group. The alkenyl group is characterized by a double bond. Therefore, the double bond in the formula of the claims is right and the H must be a single H. The formula now works.

Can *Novo* take you this far? Only if the court knows that it can depend upon counsel and counsel can clearly and authoritatively explain the technological context of the mistake.