

CLAIM CONSTRUCTION FROM MARKMAN UNTIL PHILIPS

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Claim Construction a Question of Law

- “Judges, not jurors, are the better suited to find the acquired meaning of patent terms.”
 - *Markman v. Westview*, 517 U.S. 370, 398 (1996)
- Claim construction reviewed *de novo*, without deference to district court.
 - *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed Cir 1998 (*en banc*.)

Transitional Phrases Between Preamble and Body

- “Comprising” is OPEN. It means “including.” AT LEAST the following:
Invitrogen Corp. v. Biocrest Mfg, 327 F.3d 1364, 1368 (Fed. Cir. 2003)
- “Consisting of” is CLOSED. ONLY the following:
 - *PPG Indus. v. Guardian Indus. Corp.*, 156 F.3d 1351, 1354 (Fed. Cir. 1998)
- “Consisting essentially of” “is middle ground” between comprising and consisting. It permits additional components if they do not “materially affect the basic and novel properties of the invention.”
 - *PPG Indust. V. Guardian Indus. Corp.*, 156 F.3d 1351, 1354 (Fed. Cir. 1998)
- “Having” can be open or closed, depending on context. No presumption either way.
 - *Crystal Semiconductor Cor. V. TriTech Microelectronics International, Inc.*, 246 F.3d 1336 (Fed. Cir. 2001)

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PREAMBLE AS LIMITATION

- Preamble which is “necessary to give life, meaning and vitality” to a claim is a limitation.
 - *Catalina Mktg., Int'l v. Coolsavings.com*, 289 F.3d 801, 807-08 (Fed Cir. 2002)
- Whether a preamble is a limitation is a question of law for the court.
 - *Id.*

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Lexicography

- Lexicography is other side of coin of ordinary and accustomed meaning.
- “A patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication.”
 - *Markman v. Westview*, 52 F.3d 967, 978 (Fed. Cir. 1995) (en banc)

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Implicit Lexicography

- “The written description can provide guidance as to the meaning of the claims, thereby dictating the manner in which the claims are to be construed, even if the guidance is not provided in explicit definitional format.”
 - *Scimed Life Systems v. ACS*, 242 F.3d 1337 (Fed. Cir. 2001)
- “Although the term’s ordinary meaning may have supported a broader reading ... we found that “the patentees defend the term mode by implication, through the term’s consistent use throughout the ‘786 patent specification.”
 - *Teleflex Inc. v. Ficosa North American Corp.*, 299 F.3d 1313, 1327 (Fed. Cir. 2002)
- The specification “may alter the meaning of a claim term where a patent applicant consistently uses a claim term in a manner more or less expansive than its general usage in the art.”
 - *Alloc, Inc. v. ITC*, 342 F.3d 1361 (Fed. Cir. 2003)

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Use of Prosecution History in Claim Construction

Prosecution history limits claim scope:

- “The prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution.”
 - *Southwall Technologies, Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995)

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Prosecution History of Parent Limits Scope of Later Continuation Application

- The prosecution history of a parent patent may limit the scope of a later patent application using the same claim term.
 - *Alloc, Inc. v. ITC.*, 342 F.3d 1361 (Fed. Cir. 2003)
- “When multiple patents derive from the same initial application, the prosecution history regarding a claim limitation in any patent that has issued applies with equal force to subsequently issued patents that contain the same claim limitation.”
 - *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 980 (Fed. Cir. 1999)
- “The prosecution history of a parent application may limit the scope of a later application using the same claim term.”
 - *Augustine Med., Inc. v. Gaymar Indus., Inc.*, 181 F.3d 1291, 1300 (Fed. Cir. 2000)

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Markman v. Westview (Federal Circuit) 52 F.3d 967 (Fed. Cir. 1995) (en banc)

- Intrinsic (patent and history) evidence controls
- “To ascertain the meaning of claims, we consider three sources: the claims, the specification, and the prosecution history.”
- “The focus in construing disputed terms in claim language is on the objective test of what one of ordinary skill in the art at the time of invention would have understood the term to mean.” “Claims must be read in view of the specification of which they are a part.”
- “For claim construction purposes, the written description may act as a sort of dictionary, which explains the invention, and may define terms used in the claims.”
- To construe claim language, the court should also consider the patent’s prosecution history. “This undisputed public record of proceedings in the PTO is of primary significance in understanding the claims.”

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Extrinsic Evidence Under Markman

- Extrinsic evidence consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises.
- This evidence may be helpful to explain scientific principles, the meaning of technical terms, and terms of art that appear in the patent and prosecution history.
- Extrinsic evidence is to be used for the court’s understanding of the patent, not for the purpose of varying or contradicting the terms of the claims.

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Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576 (Fed. Cir. 1996)

Intrinsic evidence (the claims, specification, and prosecution history) is the most significant source of the legally operative meaning of disputed claim language.

- The specification is always highly relevant to the claim construction analysis. Usually it is dispositive; it is the single best guide to the meaning of a disputed term.
- Dictionary definitions, although a form of extrinsic evidence may be relied on by the court “so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents.”

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Claims Construed in Light of Specification

Renishaw PLC v. Marposs Societa' Per Azioni, 158 F.3d 1243,
1248 (Fed. Cir. 1998)

- Claims are to be construed in light of the specification, of which they are a part.
- Limitations may not be imported into the claims from the specification.
- “As rules at the core of claim construction methodology, they provide guideposts for a spectrum of claim construction problems.”

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One of Skill in the Art

Multiform Desiccant, Inc. v. Medzam, Ltd.,
133 F.3d 1473, 1477 (Fed. Cir. 1998)

- “It is the person of ordinary skill in the field of the invention through whose eyes the claims are construed. Such person is deemed to read the words used in the patent documents with an understanding of their meaning in the field, and to have knowledge of any special meaning and usage in the field.”

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Specification Interprets But Does Not Limit Claims

Alloc, Inc. v. ITC, 342 F.3d 1361 (Fed. Cir. 2003)

- “The court recognizes that it must interpret the claims in light of the specification ... yet avoid impermissibly importing limitation, from the specification. That balance turns on how the specification characterizes the claimed invention.”

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Claim Terms Usually Have Ordinary Meaning

Leggett & Platt v. Hickory Springs,
285 F.3d 1353, 1357 (Fed. Cir. 2002)

- “As a general rule, terms in a patent claim receive their plain, ordinary, and accepted meaning within the community of those of ordinary skill in the relevant art. A ‘heavy presumption’ favors this accepted meaning. To discern accepted meaning, however, the construing court consults the specification and relevant prosecution history to provide context for understanding the meaning of the terms to one of skill in the art at the time of the invention.”

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Limiting Claim Scope to Disclosed Embodiment

Modine Mfg. v. ITC, 75 F.3d 1545 (Fed. Cir. 1996)

- “When the preferred embodiment in the specification is described as the invention itself, the claims are not entitled to a broader scope than that embodiment.”

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Limiting Claim Scope to Disclosed Embodiment

Teleflex Inc. v. Ficosa, 299 F.3d 1313
(Fed. Cir. 2002), quoting *Wang*, 197 F.3d at 1383

- “Whether an invention is fairly claimed more broadly than the preferred embodiment in the specification is a question specific to the content of the specification, the context in which the embodiment is described, the prosecution history and if appropriate, the prior art.”

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Heavy Presumption of Ordinary Meaning

Johnson Worldwide Associates, Inc. v. Zebco Corp., 175 F.3d 985
(Fed. Cir. 1999)

- Establishes heavy presumption of ordinary meaning
- Two ways to overcome presumption:
 - Lexicography
 - If claim term deprives claim of clarity, look to intrinsic evidence to determine meaning
- “Courts must presume that the terms in a claim mean what they say, and, unless otherwise compelled, give full effect to the ordinary and accustomed meaning of claim terms.”

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Dictionaries Become Primary
Texas Digital Sys. v. Telegenix, 308 F.3d 1193 (Fed. Cir. 2002)

Dictionary definitions presumptive of ordinary meaning

- “[Dictionaries, encyclopedias and treatises] may be the most meaningful sources of information to aid judges in better understanding both the technology and the terminology used by those skilled in the art to describe the technology.”
- “Consulting the written description and prosecution history as a threshold step in the claim construction process, before any effort is made to discern ordinary and customary meanings attributed to the words themselves, invites a violation of our precedent counseling against importing limitations into the claims.”
- Overriding concern with importing limitations into the claims.
- Ordinary meaning determined at time of issuance.

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Dictionaries Step Back
Brookhill-Wilk 1 LLC v. Intuitive Surgical, Inc., 334 F.3d 1294 (Fed. Cir. 2003)

Dictionary definitions in the abstract not determinative:

- “Our precedent referencing the use of dictionaries should not be read to suggest that abstract dictionary definitions are alone determinative. In construing claim terms, the general meanings gleaned from reference sources, such as dictionaries, must always be compared to the use of other terms in context, and the intrinsic record must always be consulted to identify which of the possible dictionary meanings is most consistent with the use of the words by the inventor.”
- While dictionaries and treatises are useful resources in determining the ordinary and customary meaning or meanings of disputed claim terms, the correct meaning of a word or phrase is informed only by considering the surrounding text [R]esort must always be made to the surrounding text of the claims in question, the other claims, the written description, and the prosecution history.”

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Context Emphasized Between Texas Digital and Philips

- After Texas Digital, the Federal Circuit returned to context again. “The meaning of patent terms depends on the usage of those terms in the context by one of skill in the art.”

Middleton, Inc. v. 3M, 311
F.3d 1384, 389 (Fed. Cir. 2002)

- “The best indicator of claim meaning is its usage in context as understood by one of skill in the art at the time of invention.”

Moba, B.V. v. Diamond Automation
325 F.3d 1306 (Fed. Cir. 2003)

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“Ordinary Meaning” Determined at Invention

- “The focus in construing disputed terms in claim language is ... on the objective test of what one of ordinary skill in the art at the time of invention would have understood the term to mean.”

Markman, 52 F.3d at 986

- “When a claim term understood to have a narrow meaning when the application is filed later acquires a broader definition, the literal scope of the term is limited to what it was understood to mean at the time of filing.”

Schering Corp. v. Amgen, Inc.,
222 F.3d 1347, 1352-54 (Fed. Cir. 2000)

- Because patentee did not prove an earlier invention date than the date of its patent application, “we consider the meaning of the claim as of the date of the invention was constructively reduced to practice - - the date the patent application was filed.”

Kopykake Enterprises, Inc. v. the Lucks Co.,
264 F.3d 1377 (Fed. Cir. 2001)

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“Ordinary Meaning” Determined At Issuance

- Dictionaries, encyclopedias and treatises, publicly available at the time the patent is issued, are objective resources that serve as reliable sources of information on the established meanings that would have been attributed to the terms to the terms of the claims by those of skill in the art.”

Texas Digital, 308 F.3d at 1202-03

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Return to Ordinary Meaning at Time of Invention

- The meaning of claim terms depends on the usage of those terms in the context by one of skill in the art at the time of invention

Middleton v. Minnesota Mining & Mfg.,
311 F.3d 1384 (Fed. Cir. 2002)

- “We hold that the district court did not ignore the plain meaning of the claims, but properly gave objective meaning to them as they were understood at the time the patent application was filed.”

Plant Genetic Systems v. DeKalb Genetics Corp.,
315 F.3d 1335, 1345 (Fed. Cir. 2003)

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