

Claim Construction on Appeal

Meredith Martin Addy
February 2007, Law Seminars International

© BRINKS HOFER GILSON & LIONE

USEBRINKSSM
Intellectual Property Law Worldwide

The Final Showdown:

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

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?

3

Meredith Addy

PREDICTABILITY?

- Specifically applicable precedent.
- *En Banc* precedent.
 - ↳ *Markman* of course.
 - ↳ Does *Phillips* clarify?
 - ↳ Is *Cybor* safe precedent?
- Panel driven?

4

Meredith Addy

FOCUS:

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

5

Meredith Addy

FOCUS: Appellate-Worthy Claim Construction Issues

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

6

Meredith Addy

FOCUS: Selecting from multiple issues

- Choose the best – discard the rest.
- More than 4 issues lose punch.
(really should stick with 3)
- Consider trial myopia.

7

Meredith Addy

FOCUS: Selecting from multiple issues

- Standard of review: *de novo*.
 - ➔ But . . . not really a new bite at the apple.
 - ➔ District court process.
 - ➔ Claim construction . . . or infringement?

8

Meredith Addy

FOCUS: Selecting from multiple issues

- Appellant:
 - ➔ Choose the issue that *compels* complete victory.
 - ➔ Keep the issues clean –
 - ➔ Not-intertwined.
 - ➔ Not contradictory proofs.

9

Meredith Addy

FOCUS: Selecting from multiple issues

- Appellee:
 - ➔ Stuck with Appellant's issues
... but ...
 - ➔ You are not stuck with Appellant's order or characterization.

10

Meredith Addy

FOCUS: Prioritizing the selected issues

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

11

Meredith Addy

FOCUS: Crafting the selected issues

- Appellant – it's all claim construction.
 - Claim construction may make infringement a matter of law.
 - *Athletic Alternatives, Inc.*
 - Don't forget to object to jury instructions (FED. R. CIV. P. 51).

12

Meredith Addy

FOCUS: Crafting the selected issues

- Appellee: it's all about infringement masquerading as claim construction.
 - ➔ Bound-up in the facts determined under the clearly erroneous standard.
 - ➔ Complex scientific principles
 - ➔ Expert testimony
 - ➔ Testing necessary

13

Meredith Addy

PREDICTABILITY

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

14

Meredith Addy

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; can also use to show supports.

15

Meredith Addy

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

16

Meredith Addy

PREDICTABILITY: Precedent

● Does *Phillips* clarify?

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

17

Meredith Addy

PREDICTABILITY: Precedent

● Is *Cybor* safe precedent?

- Much criticism of *Cybor*.
- Over 30 amicus briefs in *Phillips*.
- Consider: **one of ordinary skill in the art.**
(*strategy call*)

18

Meredith Addy

PREDICTABILITY: Precedent

- *Cybor* is NOT safe precedent . . .
do you have the next *Cybor*?

“I have come to believe that reconsideration [of *Cybor*’s *de novo* review for claim construction] is appropriate and revision may be advisable.”

Amgen v. Hoechst Marion Roussel, Inc. (Nov. 22, 2006)
(denial of *en banc*) (Michel, C.J.).

19

Meredith Addy

PREDICTABILITY: Deference

- Four problems under the *Cybor* regime:
 - ➔ high reversal rate;
 - ➔ lack of predictability;
 - ➔ loss of district court “comparative” advantage;
 - ➔ diminution of importance of Federal Circuit precedence.

20

Meredith Addy

PREDICTABILITY: Deference

● *Cybor Theory:*

- Claim construction purely legal like statutory construction.
 - Statutory construction → Judge = OSITA
 - Claim construction → Judge \diamond OSITA

21

Meredith Addy

PREDICTABILITY: Deference

● *Rethinking Cybor:*

- *Amgen en banc* votes:
 - Michel, Newman, Rader, Moore
- *Amgen en banc* “not this time”
 - Gajarsa, Linn, Dyk
 - ▶ “In an appropriate case we would be willing to reconsider limited aspects of the *Cybor* decision.”
- ??? *Amgen* ???
 - Mayer (but see *Cybor* and *Phillips*)
 - Lourie, Clevenger, Schall, Prost

22

Meredith Addy

QUESTIONS?



NBC Tower - Suite 3600 | 455 N. Cityfront Plaza Drive | Chicago, IL 60611-5599 | Telephone 312.321.4200 | Fax 312.321.4299