The Scope of Patents
Claim Construction & Patent Infringement

Introduction to Intellectual Property Law & Policy

Professor Wagner

Lecture Agenda

Claim Construction

(Literal) Patent Infringement

The Doctrine of Equivalents

What Does Claim Construction Look Like?

What is Claim Construction?

Claims define the scope of the patent.

The scope of disclosure
The relationship to prior art
The scope of the right to exclude

What is Claim Construction?

Claims define the scope of the patent.

Claim Construction is the process of determining the scope of the patent.

What is Claim Construction?

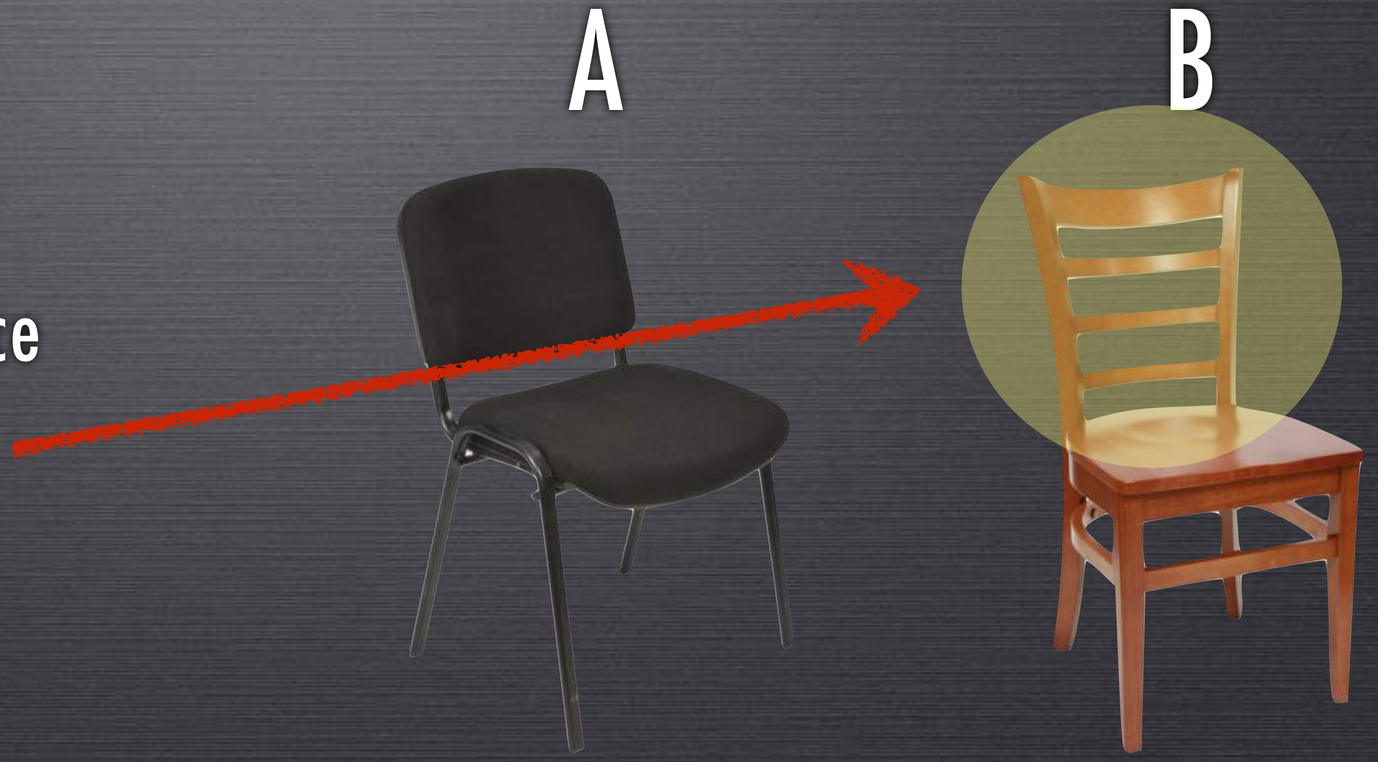
1. A sitting device comprising:
   A generally horizontal surface
   A generally vertical surface
   At least four legs

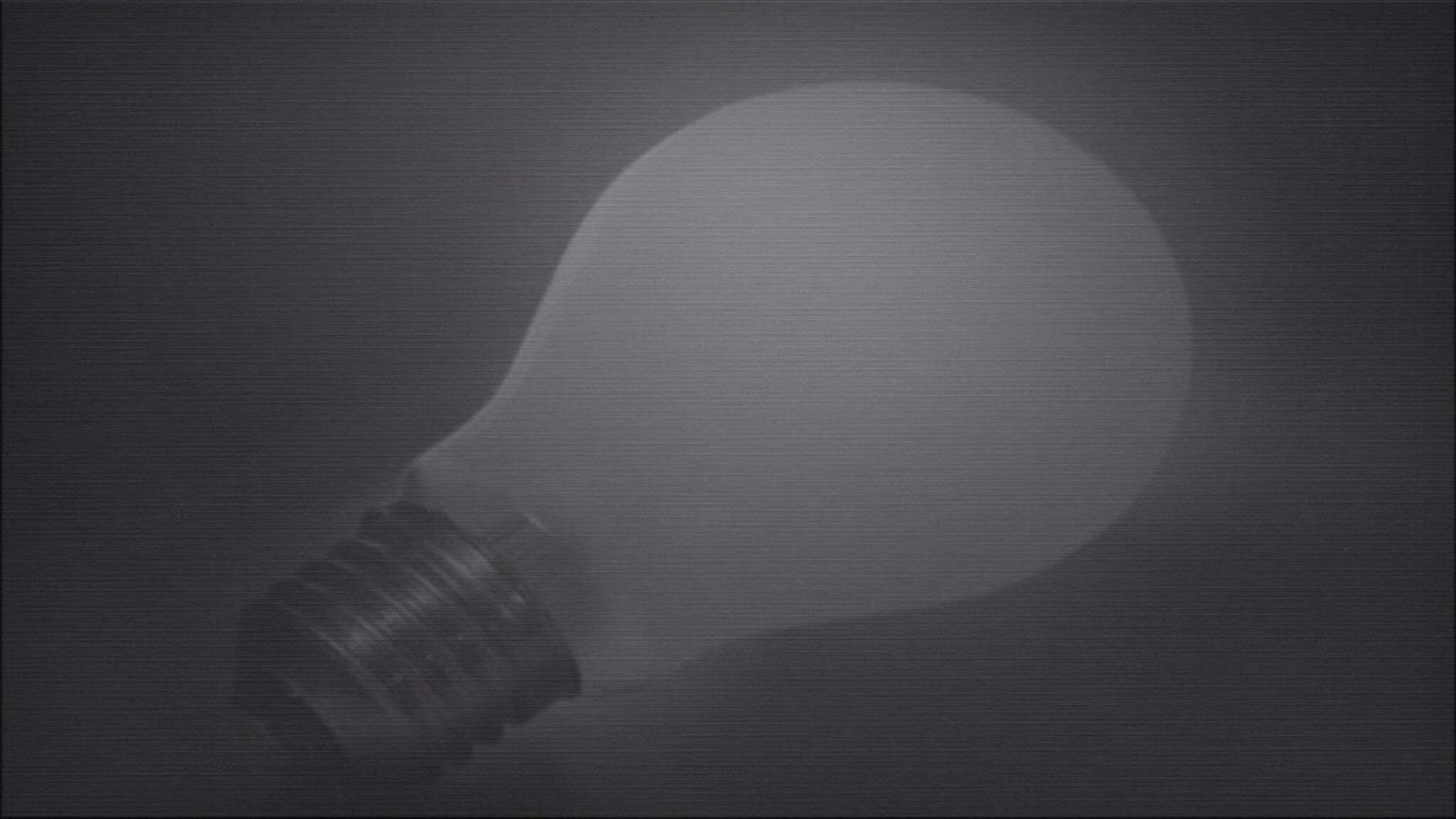
A

B

What is Claim Construction?

1. A sitting device comprising:
   A generally horizontal surface
   A generally vertical surface
   At least four legs





Who Decides Claim Construction?

Markman v. Westview Insts. (1997)

The Court describes claim construction as a ‘mongrel practice’.

The court allocates authority to judges.

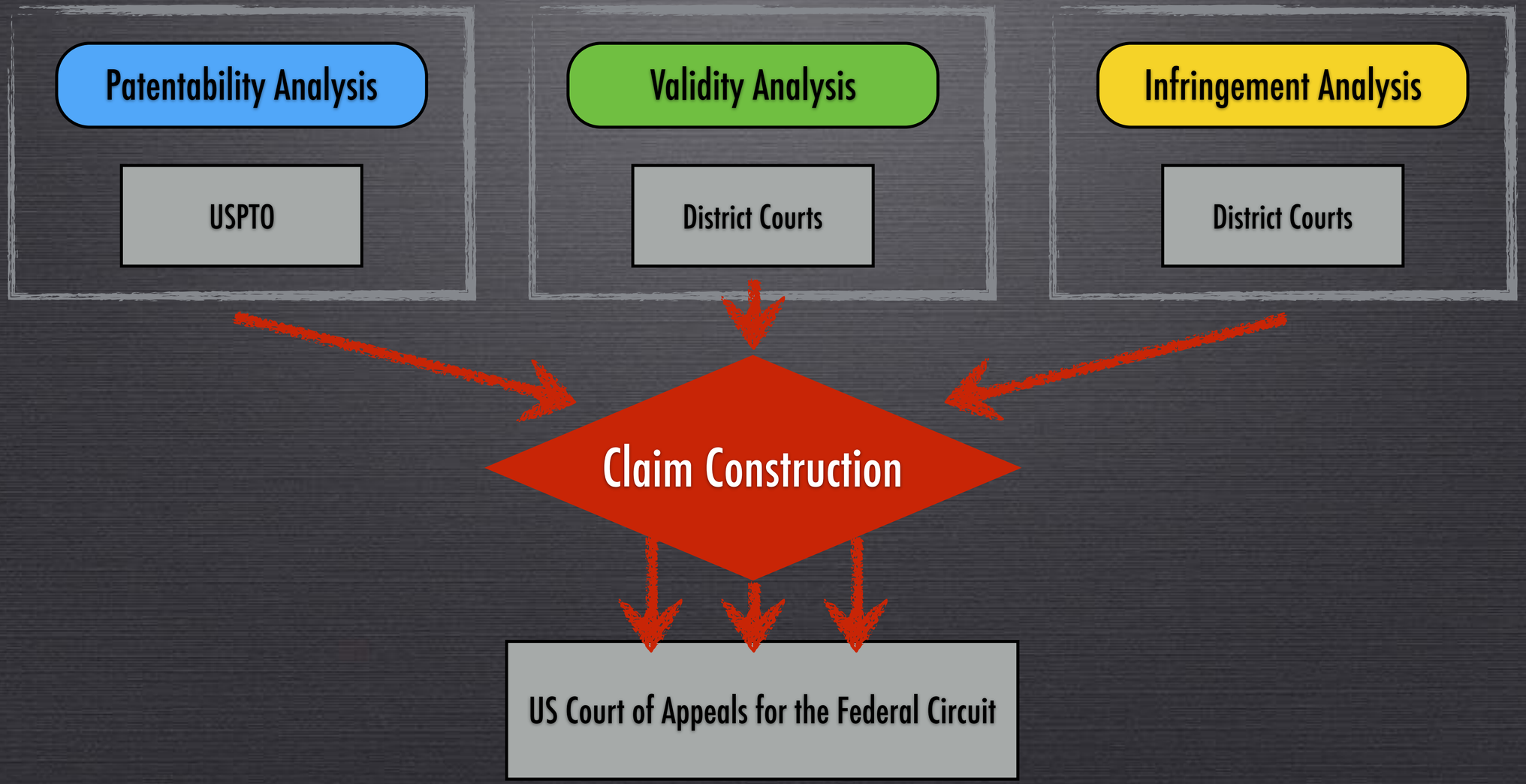
For functional reasons:

Judges are better at interpreting written documents

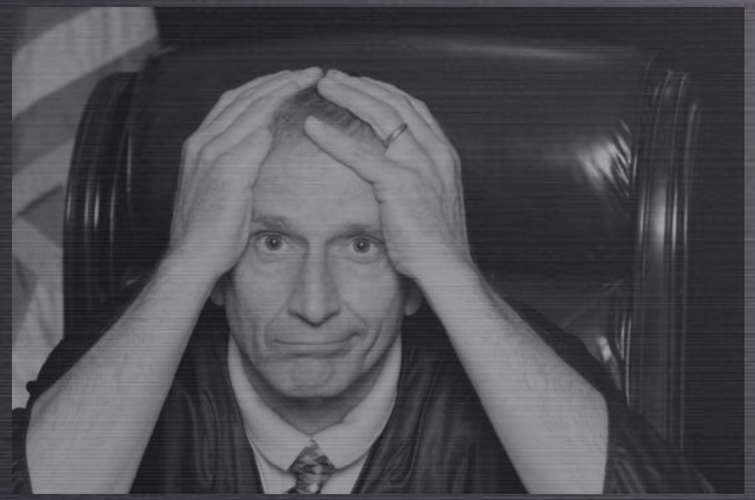
It should better enable Federal Circuit review of decisions

The Centrality of Claim Construction

"In the patent law, the name of the game is the claims" (Judge GS Rich, 1990)



The Debate over Allocation of Authority

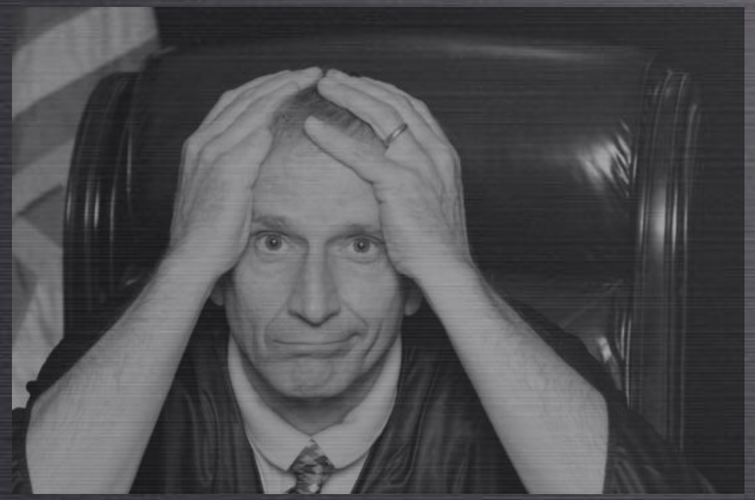


In Markman v Westview (1996), the Supreme Court gave claim construction to judges.

This meant that the Federal Circuit has dominated claim construction: appellate review has been "de novo" (no deference, a re-do). This in turn resulted in high rates of reversals and dissatisfaction.

In Teva v Sandoz (2015), the Supreme Court revisited, and held that review of claim construction was mostly "de novo".

The Debate over Allocation of Authority

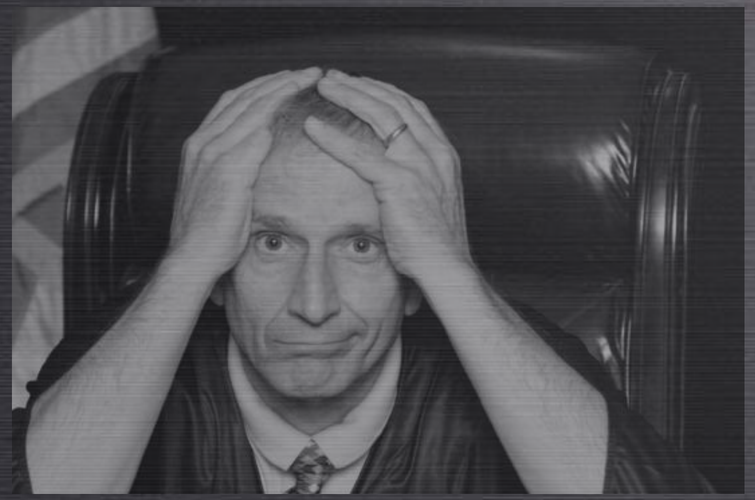


In Markman v Westview (1996), the Supreme Court gave claim construction to judges.

This meant that the Federal Circuit has dominated claim construction:
appellate review has been "de novo" (no deference, a re-do).
This in turn resulted in high rates of reversals and dissatisfaction.

In Teva v Sandoz (2015), the Supreme Court revisited,
and held that review of claim construction was mostly "de novo".

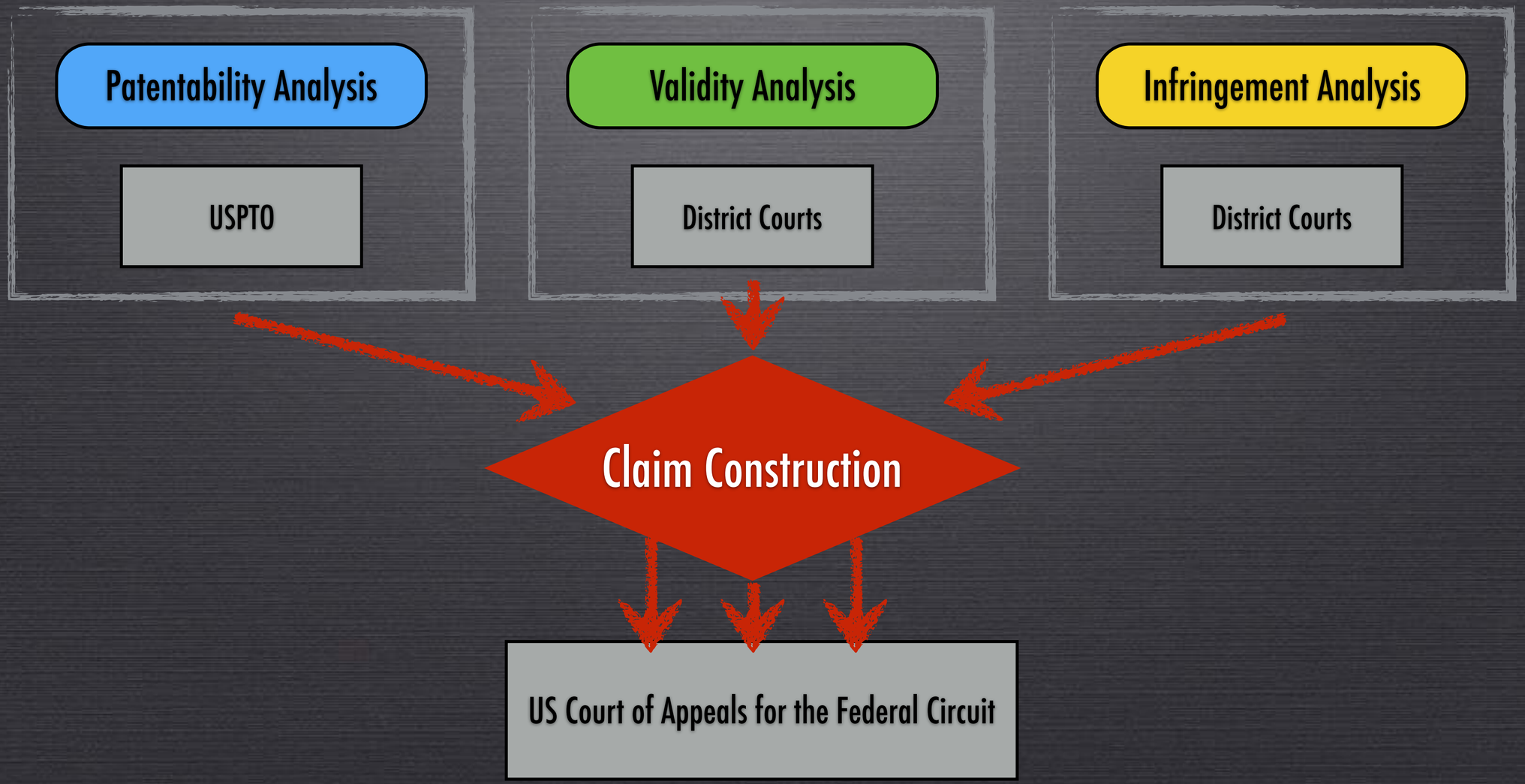
The Debate over Allocation of Authority

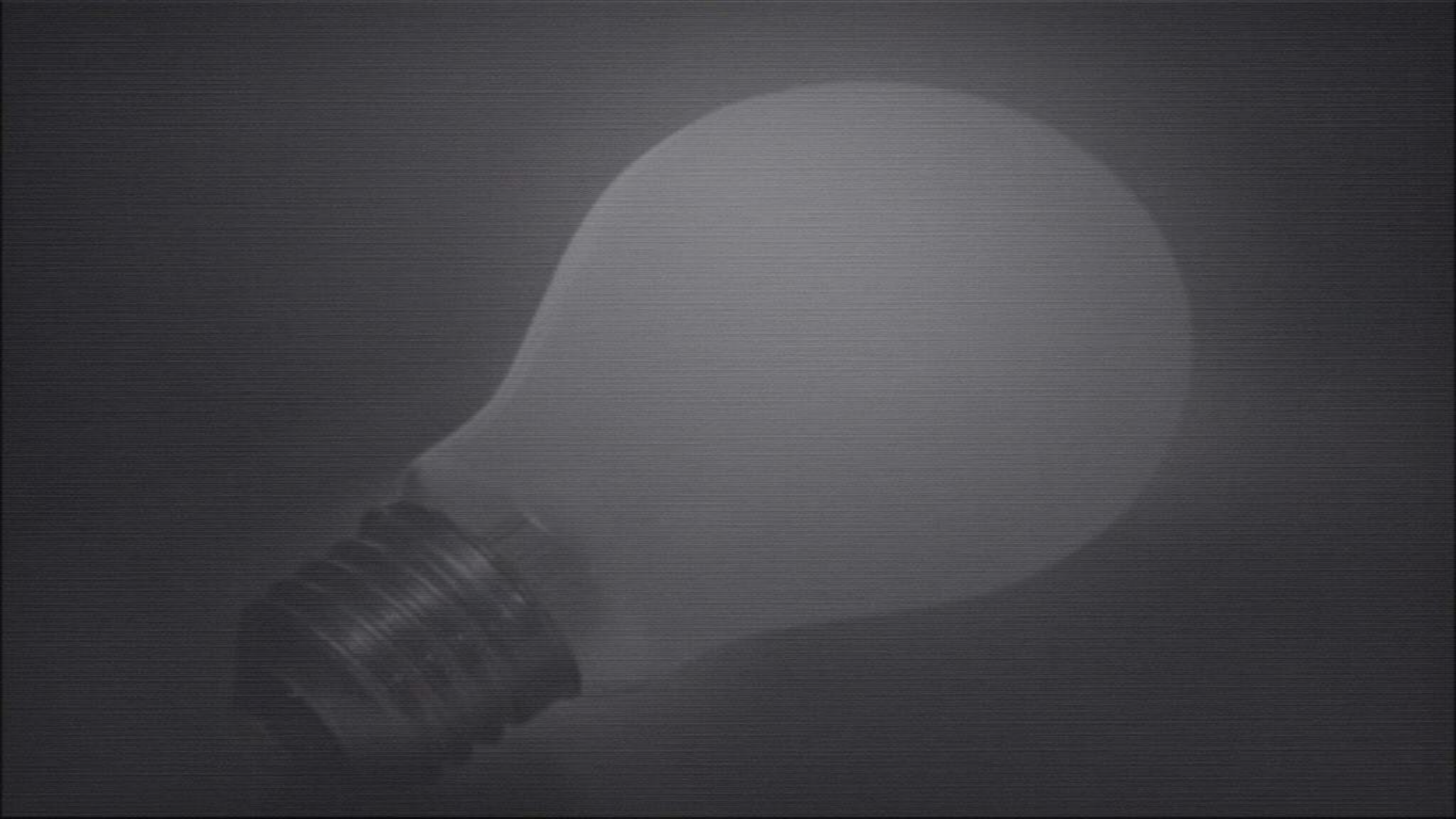


In Markman v Westview (1996), the Supreme Court gave claim construction to judges.

This meant that the Federal Circuit has dominated claim construction:
appellate review has been "de novo" (no deference, a re-do).
This in turn resulted in high rates of reversals and dissatisfaction.

In Teva v Sandoz (2015), the Supreme Court revisited,
and held that review of claim construction was mostly "de novo".


Patentability Analysis
USPTO
Validity Analysis
District Courts
Infringement Analysis
District Courts
Claim Construction
US Court of Appeals for the Federal Circuit



The Interpretive Process of Claim Construction

The Interpretive Process

Phillips v. AWH (2005)

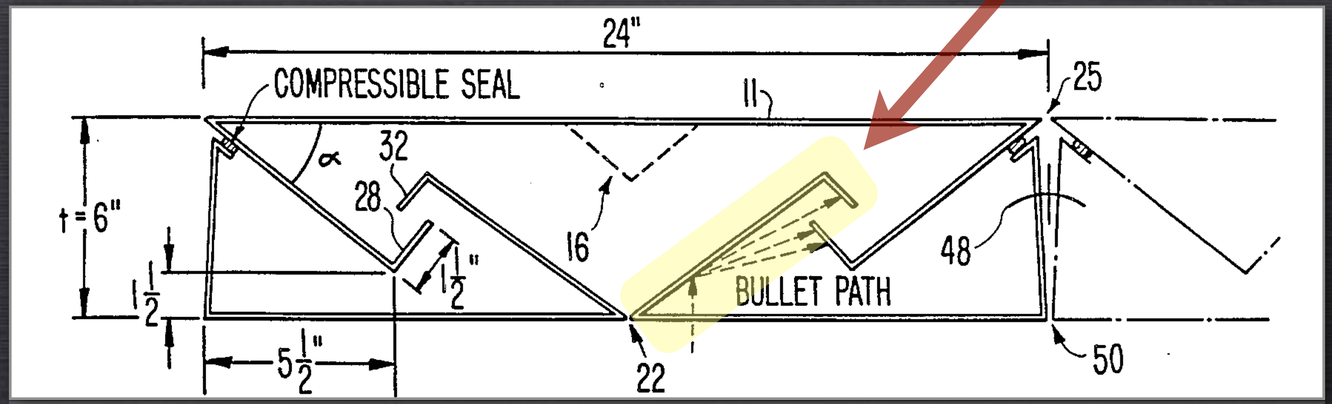
[The basic infringement inquiry is a two step process]

Construction of the claim (issue of law)
Comparison of claim to accused device (issue of fact)

Key issue in Phillips: meaning of the term “baffles”

Phillips v. AWH (2005)

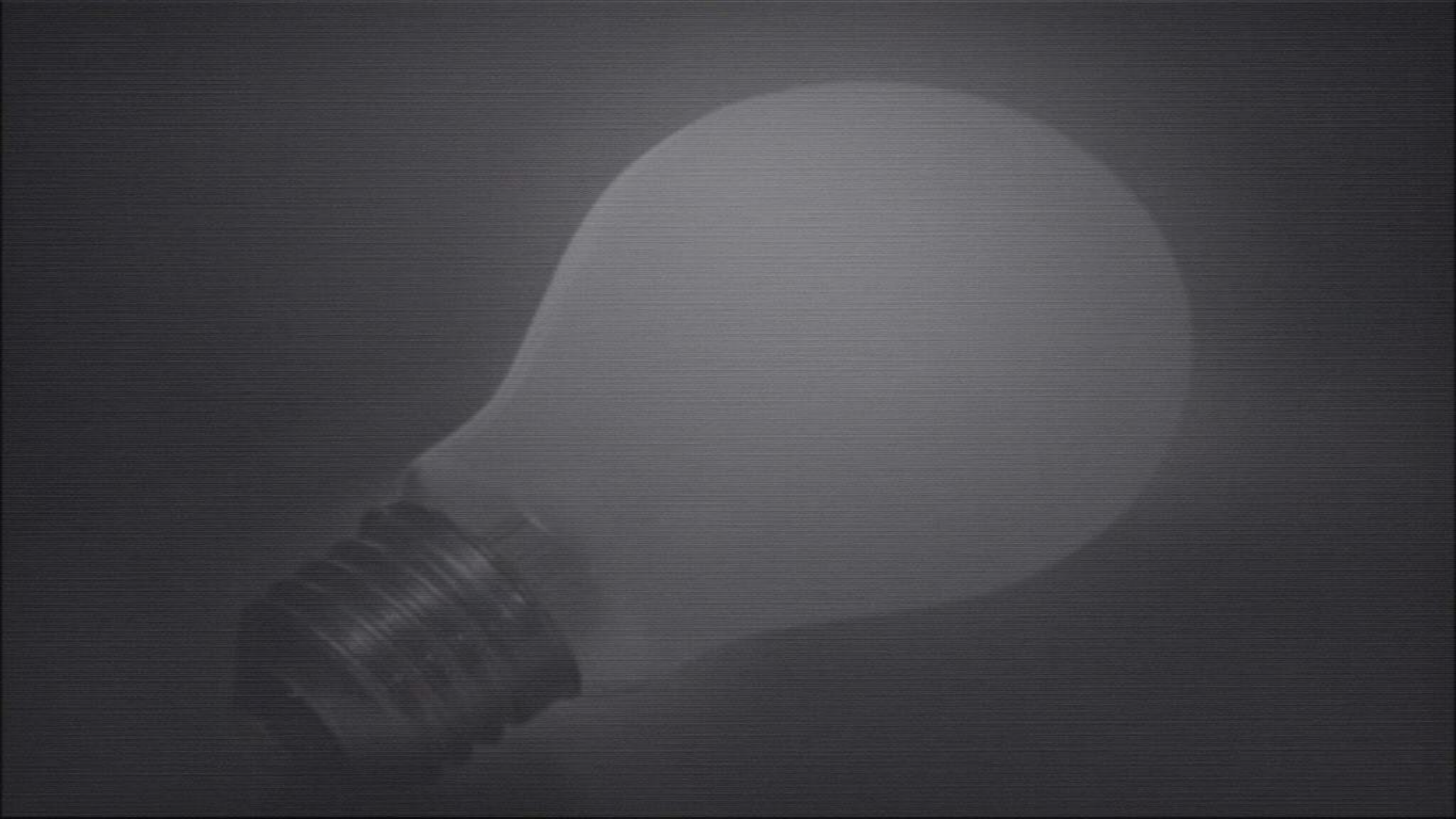
"Means disposed inside the shell for increasing its load bearing capacity comprising internal steel baffles extending inwardly from the steel shell walls."

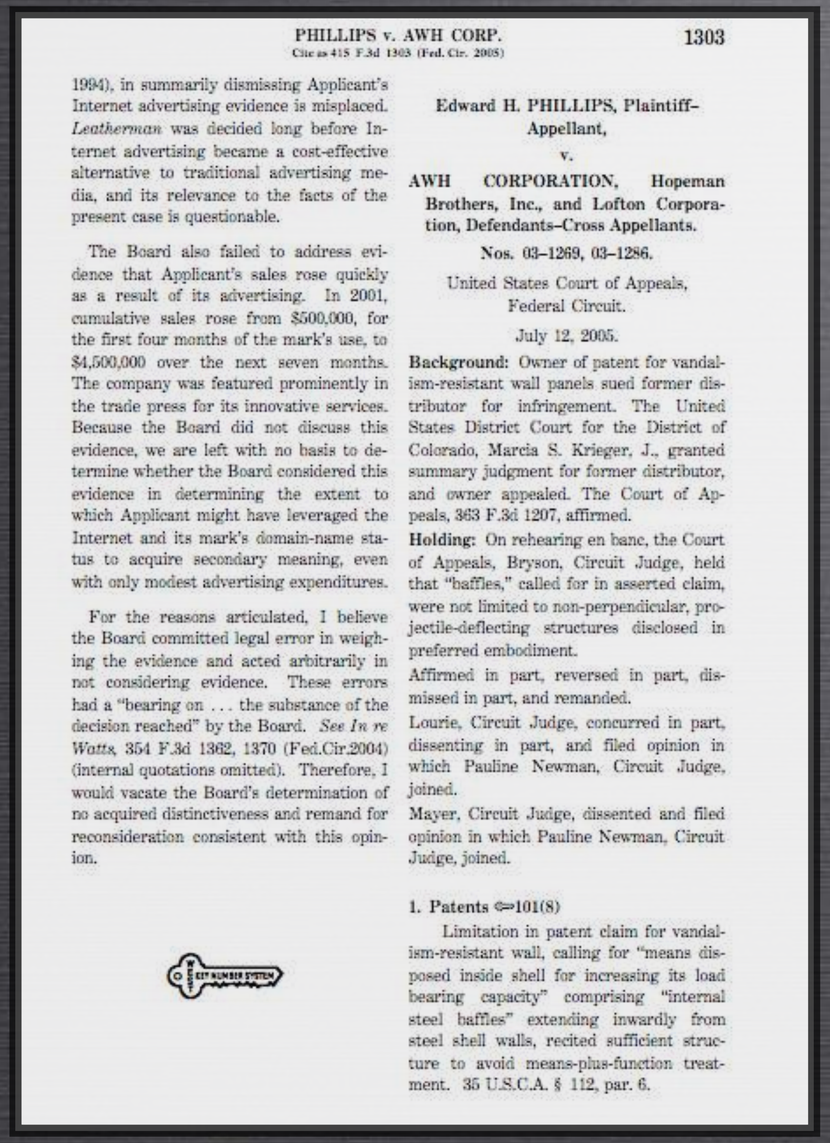


Majority	Dissent
Baffles must be at angles <u>other</u> than 90º to the wall	Baffles can be at any angle
Specification describes <u>deflection</u> as a purpose of the invention; 90º baffles are part of the prior art	Nothing in the claims suggests a specific angular requirement

"Holistic" Methodology	"Procedural" Methodology
Primary focus on 'context' of claim language, via inferences from specification, prosecution history; little interest in dictionaries, 'plain meaning'	Primary focus on 'ordinary meaning' of claim language; specification only useful if it provides a clear definition; typical use of dictionaries, experts for 'ordinary meaning'

“Holistic” Methodology	“Procedural” Methodology
Baffles must be at angles <u>other</u> than 90º to the wall	Baffles can be at any angle
Specification describes <u>deflection</u> as a purpose of the invention; 90º baffles are part of the prior art	Nothing in the claims suggests a specific angular requirement





PHILLIPS v. AWH CORP. 1303
Cite as 415 F.3d 1303 (Fed. Cir. 2005)

1994), in summarily dismissing Applicant's Internet advertising evidence is misplaced. *Leatherman* was decided long before Internet advertising became a cost-effective alternative to traditional advertising media, and its relevance to the facts of the present case is questionable.

The Board also failed to address evidence that Applicant's sales rose quickly as a result of its advertising. In 2001, cumulative sales rose from $500,000, for the first four months of the mark's use, to $4,500,000 over the next seven months. The company was featured prominently in the trade press for its innovative services. Because the Board did not discuss this evidence, we are left with no basis to determine whether the Board considered this evidence in determining the extent to which Applicant might have leveraged the Internet and its mark's domain-name status to acquire secondary meaning, even with only modest advertising expenditures.

For the reasons articulated, I believe the Board committed legal error in weighing the evidence and acted arbitrarily in not considering evidence. These errors had a "bearing on . . . the substance of the decision reached" by the Board. *See In re Watts*, 354 F.3d 1362, 1370 (Fed.Cir.2004) (internal quotations omitted). Therefore, I would vacate the Board's determination of no acquired distinctiveness and remand for reconsideration consistent with this opinion.

Edward H. PHILLIPS, Plaintiff–Appellant,
v.
AWH CORPORATION, Hopeman Brothers, Inc., and Lofton Corporation, Defendants–Cross Appellants.

Nos. 03–1269, 03–1286.

United States Court of Appeals, Federal Circuit.

July 12, 2005.

Background: Owner of patent for vandalism-resistant wall panels sued former distributor for infringement. The United States District Court for the District of Colorado, Marcia S. Krieger, J., granted summary judgment for former distributor, and owner appealed. The Court of Appeals, 363 F.3d 1207, affirmed.

Holding: On rehearing en banc, the Court of Appeals, Bryson, Circuit Judge, held that "baffles," called for in asserted claim, were not limited to non-perpendicular, projectile-deflecting structures disclosed in preferred embodiment.

Affirmed in part, reversed in part, dismissed in part, and remanded.

Lourie, Circuit Judge, concurred in part, dissenting in part, and filed opinion in which Pauline Newman, Circuit Judge, joined.

Mayer, Circuit Judge, dissented and filed opinion in which Pauline Newman, Circuit Judge, joined.

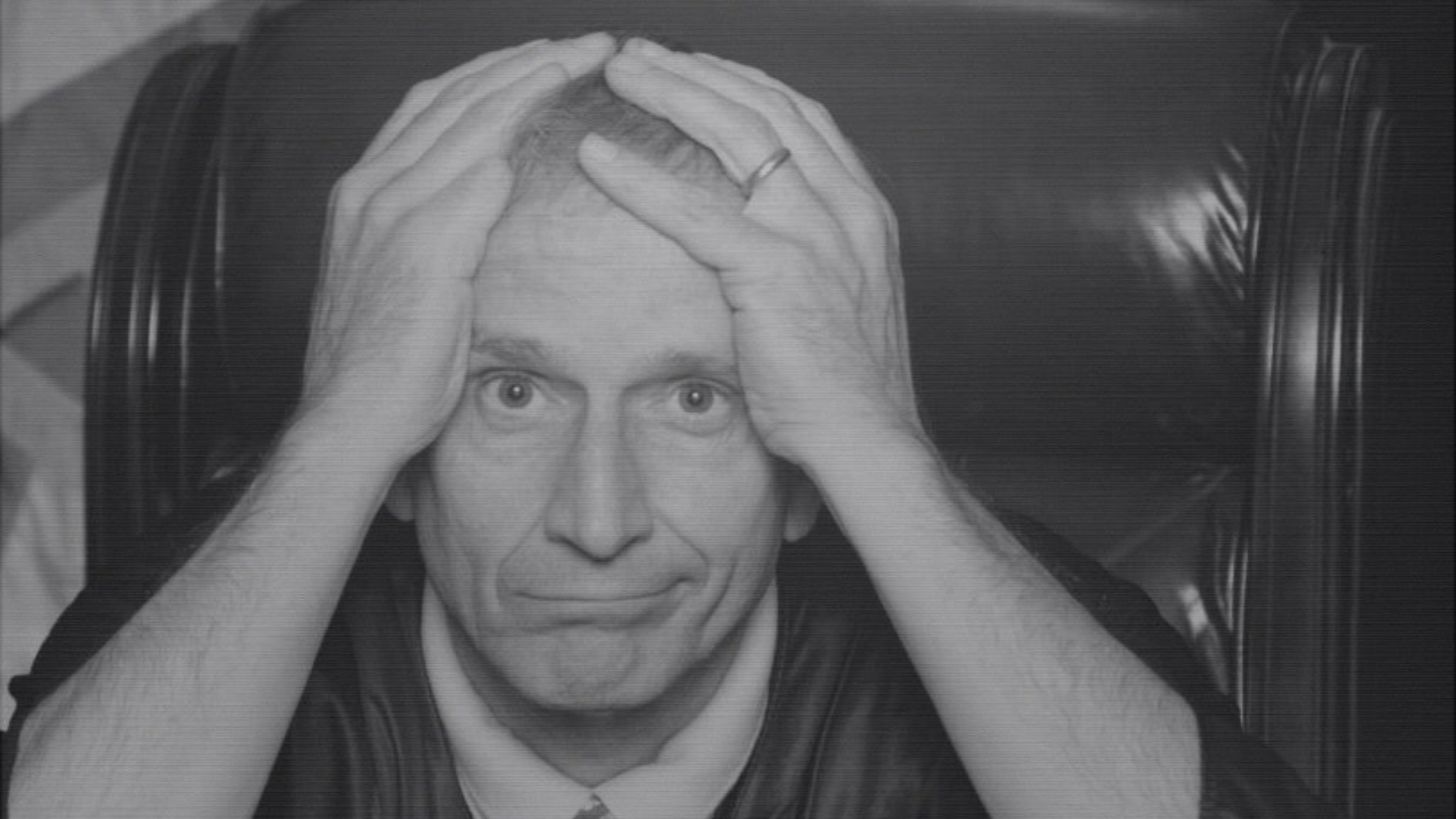
1. Patents ⇐101(8)

Limitation in patent claim for vandalism-resistant wall, calling for "means disposed inside shell for increasing its load bearing capacity" comprising "internal steel baffles" extending inwardly from steel shell walls, recited sufficient structure to avoid means-plus-function treatment. 35 U.S.C.A. § 112, par. 6.

Phillips v. AWH Corp. (Fed. Cir. 2005)

[T]here is no magic formula or catechism for conducting claim construction.....

The sequence of steps used by the judge in consulting various sources is not important; what matters is for the court to attach the appropriate weight to be assigned to those sources in light of the statutes and policies that inform patent law.



claims ordinarily given their ordinary and accustomed meaning	*claims are intended to be read as part of the specification*	*"[E]xtrinsic evidence may be useful to the court, but it is unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence."*
meaning is that which a PHOSITA would ascribe	*"The interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim."*	*patentees can be their own lexicographer*
dictionaries often helpful; terms are often used in their customary manner	*dictionaries often unreliable; patentees often use terms idiosyncratically*	*"[T]he specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor"*

"[W]hat matters is for the court to attach the appropriate weight to be assigned to those sources in light of the statutes and policies that inform patent law."

Non-Phillips Canons of Construction

Claims are intended to be interpreted so as to save their validity.

Claims are construed according to the purpose of the invention.

Different claims are interpreted differently. [Claim differentiation.]

Claims are construed in context with the specification.

Limitations from the specification cannot be imported into the claim.

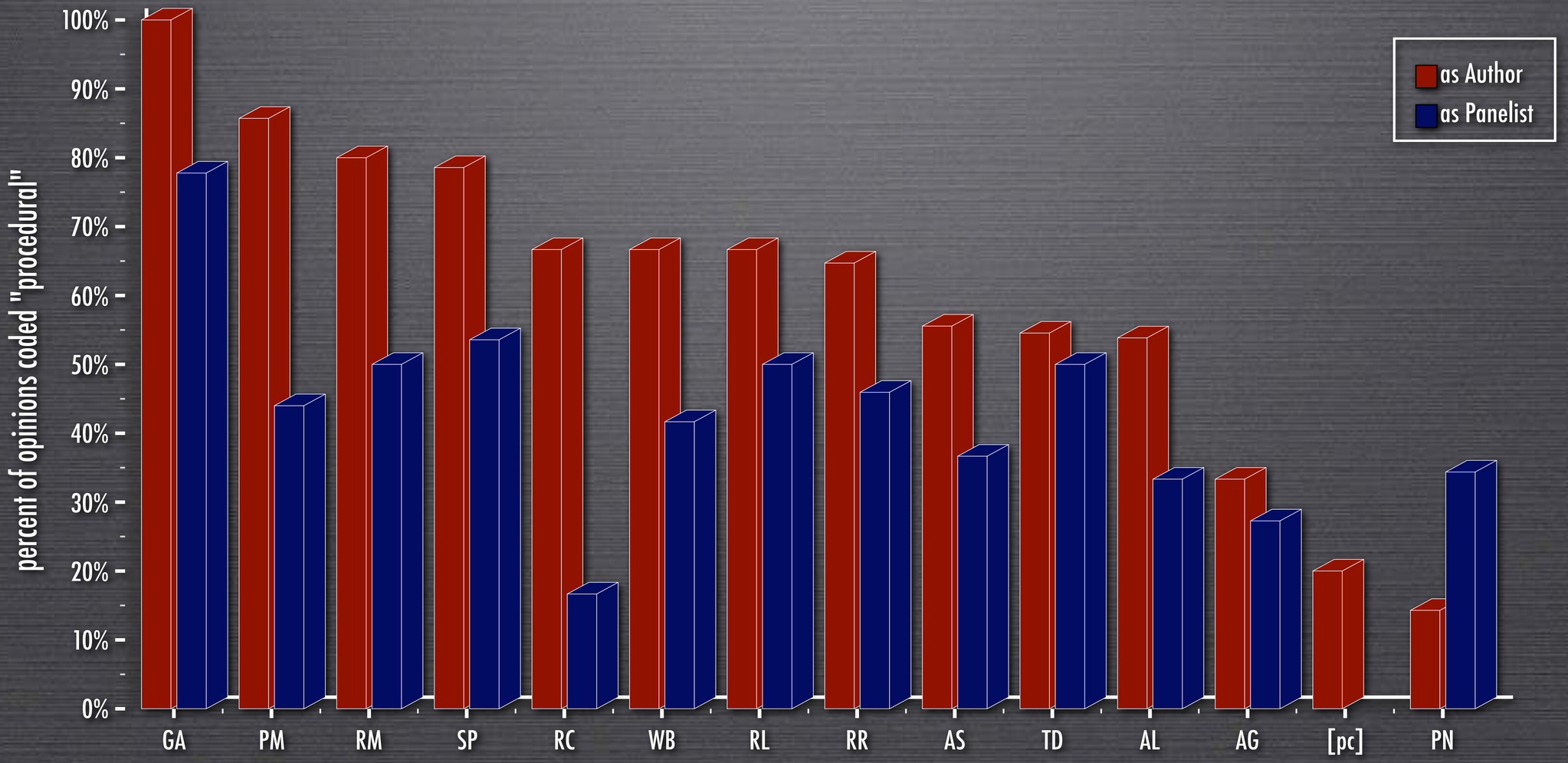
The claim shall be interpreted to cover the preferred embodiment.

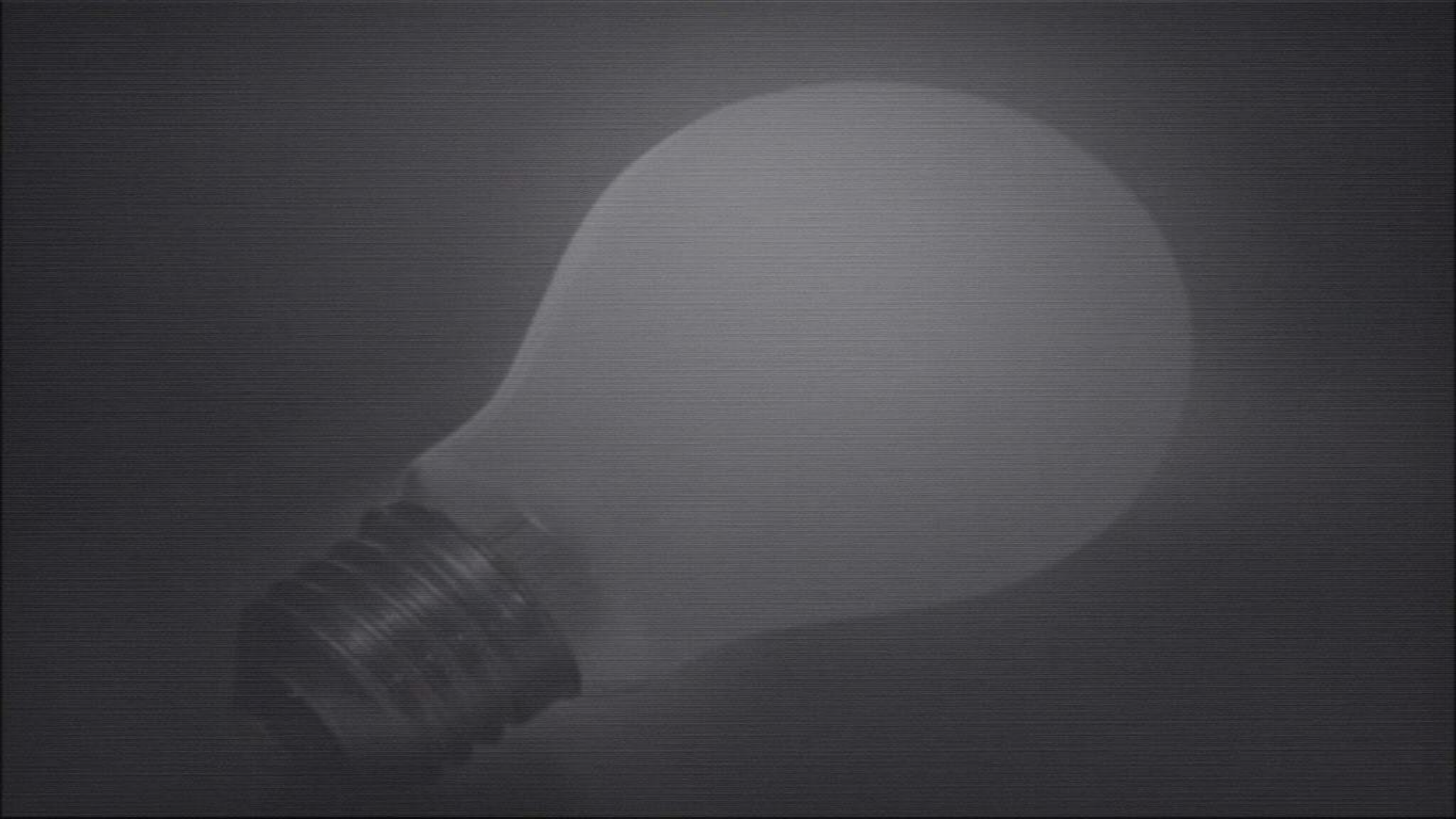
The Federal Circuit is Deeply Divided on How to Do Claim Construction (all Federal Circuit opinions on claim construction, 1996-2012)

		holistic	procedural
Pre-Phillips	n	203	393
	%	34.1%	65.9%
Post-Phillips	n	42	74
	%	36.2%	63.8%

The Federal Circuit is Deeply Divided on How to Do Claim Construction

Judges' Methodological Approaches – Post-Phillips





Basics of Patent Infringement

The patent right:

The right to exclude others from ...

making

using

selling

offering to sell

importing

... within the scope of the claims.

The patent right:

The right to exclude others from ...

making

using

selling

offering to sell

importing

... within the scope of the claims.

The patent right:

The right to exclude others from ...

making

using

selling

offering to sell

importing

... within the scope of the claims.

The patent right:

The right to exclude others from ...

making

using

selling

offering to sell

importing

... within the scope of the claims.

The patent right:

The right to exclude others from ...

making

using

selling

offering to sell

importing

... within the scope of the claims.

The patent right:

The right to exclude others from ...

making

using

selling

offering to sell

importing

... within the scope of the claims.

Categories of Patent Infringement

Direct infringement

[party to suit infringed]

Indirect Infringement

[3rd party infringed, party to suit enabled]

Categories of Patent Infringement

Direct infringement

[party to suit infringed]

Indirect Infringement

[3rd party infringed, party to suit enabled]

Forms of Direct Infringement

Literal Infringement

Infringement via the Doctrine of Equivalents

Forms of Direct Infringement

Literal Infringement

Infringement via the Doctrine of Equivalents

Literal Infringement

1. A writing implement comprising:
   A wooden cylinder with a hollow core
   A cylinder of graphite in the hollow core
   A small cylinder of eraser material attached to one end of the wooden cylinder

Which of the following infringes?

1. A wooden pencil with a small metal clip for shirt-pocket storage
2. A plastic pencil (body made of plastic)
3. A pencil without an eraser

Literal Infringement

1. A writing implement comprising:
   A wooden cylinder with a hollow core
   A cylinder of graphite in the hollow core
   A small cylinder of eraser material attached to one end of the wooden cylinder

Which of the following infringes?

1. A wooden pencil with a small metal clip for shirt-pocket storage
2. A plastic pencil (body made of plastic)
3. A pencil without an eraser

Literal Infringement

1. A writing implement comprising:
   A wooden cylinder with a hollow core
   A cylinder of graphite in the hollow core
   A small cylinder of eraser material attached to one end of the wooden cylinder

Which of the following infringes?

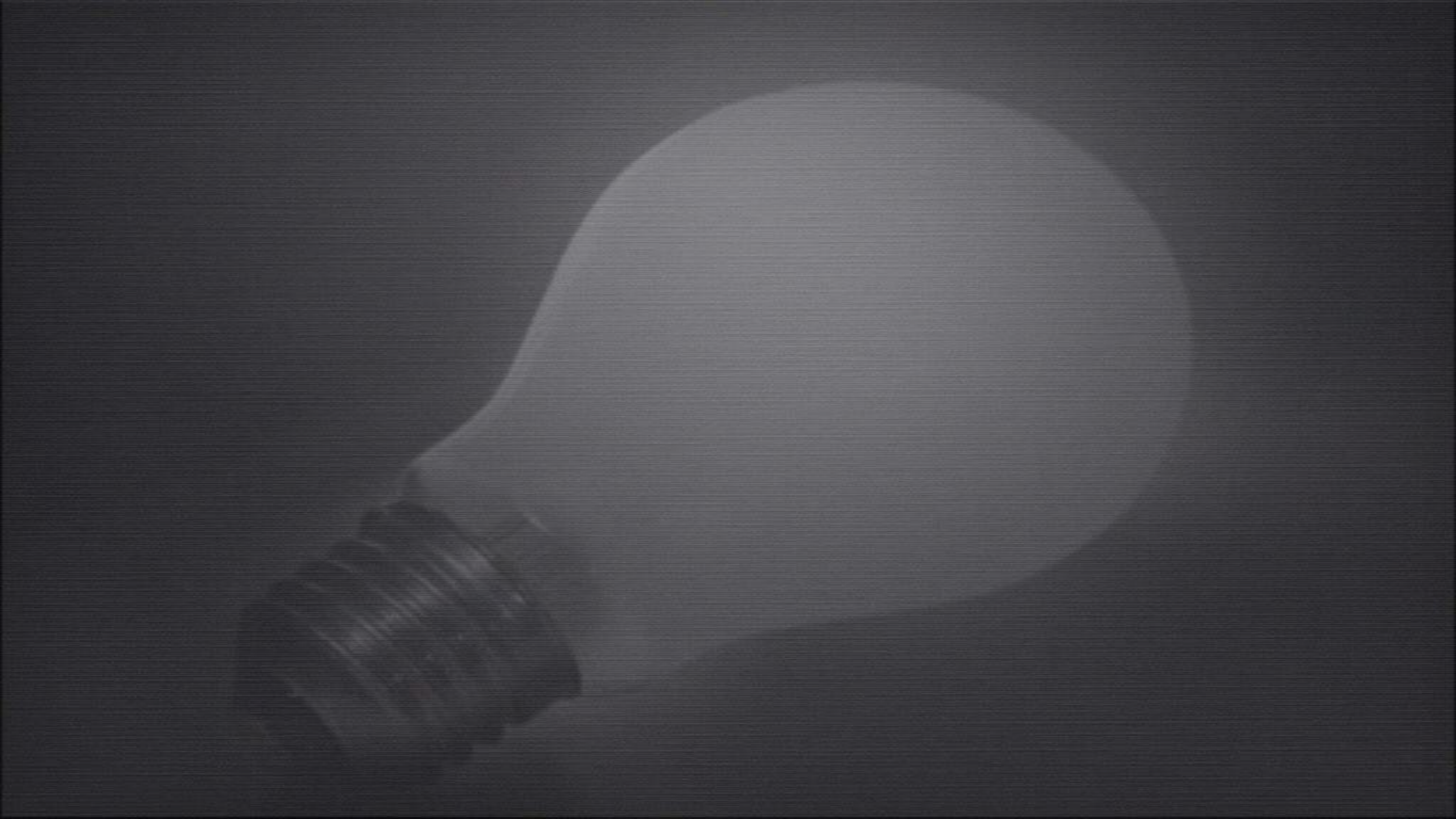
1. A wooden pencil with a small metal clip for shirt-pocket storage
2. A plastic pencil (body made of plastic)
3. A pencil without an eraser

Literal Infringement

1. A writing implement comprising:
   A wooden cylinder with a hollow core
   A cylinder of graphite in the hollow core
   A small cylinder of eraser material attached to one end of the wooden cylinder

Which of the following infringes?

1. A wooden pencil with a small metal clip for shirt-pocket storage
2. A plastic pencil (body made of plastic)
3. A pencil without an eraser



The Doctrine of Equivalents

The Doctrine of Equivalents

- Recall: the basic rule of literal infringement:
  - all elements of the claim must be (identically) present in the accused device
- The Doctrine of Equivalents:
  - Allows elements in an accused device to be "substantially equivalent" and still be 'present' for purposes of infringement
  - Thus, the basic rule of infringement changes to:
    - all elements of the claim must be (identically or equivalently) present in the accused device

The Doctrine of Equivalents

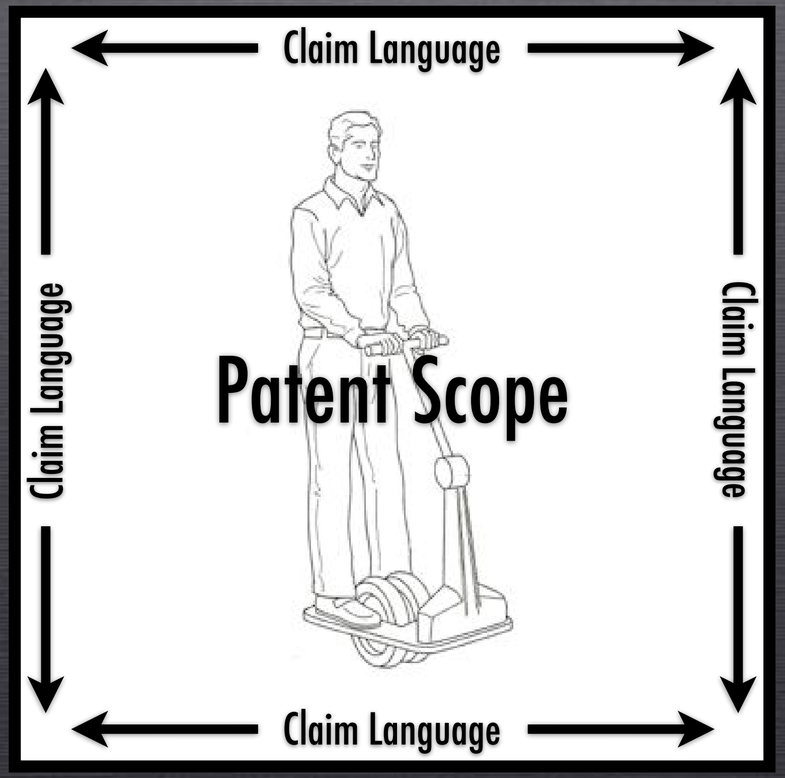
- Recall: the basic rule of literal infringement:
  - all elements of the claim must be (identically) present in the accused device
- The Doctrine of Equivalents:
  - Allows elements in an accused device to be "substantially equivalent" and still be 'present' for purposes of infringement
  - Thus, the basic rule of infringement changes to:
    - all elements of the claim must be (identically or equivalently) present in the accused device

The Policy of the Doctrine of Equivalents

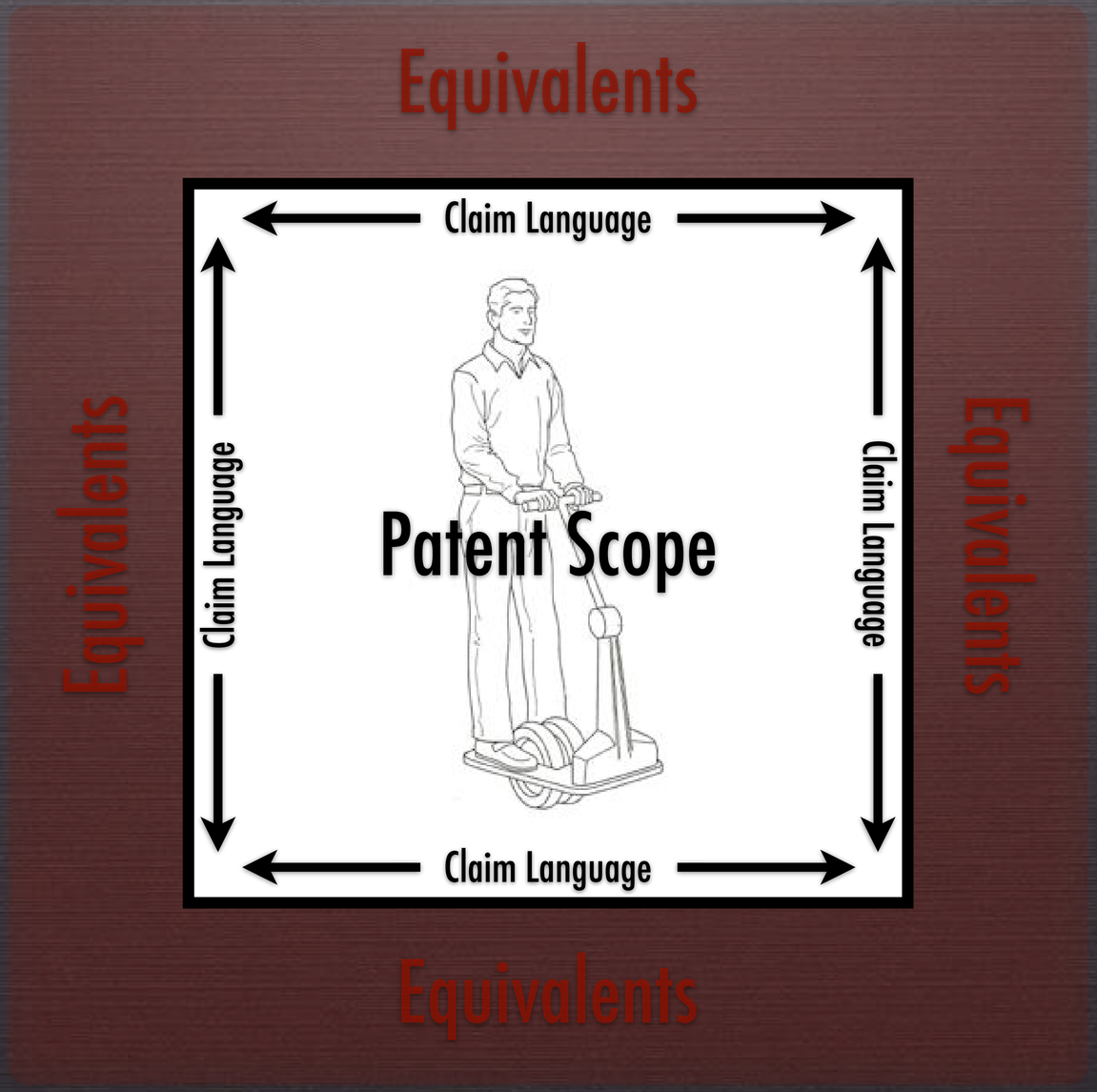
The Patent Law emphasizes
the "public notice" function of patent claims.

Does the Doctrine of Equivalents relate to this goal?

The Policy of the Doctrine of Equivalents



The Policy of the Doctrine of Equivalents



The Case for the DOE

Without equivalents, a patent is a "hollow and useless thing" [Graver Tank]

The DOE furthers the Patent Law's incentive structure. [Graver Tank, Warner-Jenkinson]

Settled expectations: Patentees assume DOE coverage when seeking patents. [Warner-Jenkinson, Festo]

We presume patentees are entitled to all they 'discover', even if not precisely claimed.

The Case for the DOE

Without equivalents, a patent is a "hollow and useless thing" [Graver Tank]

The DOE furthers the Patent Law's incentive structure. [Graver Tank, Warner-Jenkinson]

Settled expectations: Patentees assume DOE coverage when seeking patents. [Warner-Jenkinson, Festo]

We presume patentees are entitled to all they 'discover', even if not precisely claimed.

The Case for the DOE

Without equivalents, a patent is a "hollow and useless thing" [Graver Tank]

The DOE furthers the Patent Law's incentive structure. [Graver Tank, Warner-Jenkinson]

Settled expectations: Patentees assume DOE coverage when seeking patents. [Warner-Jenkinson, Festo]

We presume patentees are entitled to all they 'discover', even if not precisely claimed.

The Case for the DOE

Without equivalents, a patent is a "hollow and useless thing" [Graver Tank]

The DOE furthers the Patent Law's incentive structure. [Graver Tank, Warner-Jenkinson]

Settled expectations: Patentees assume DOE coverage when seeking patents. [Warner-Jenkinson, Festo]

We presume patentees are entitled to all they 'discover', even if not precisely claimed.

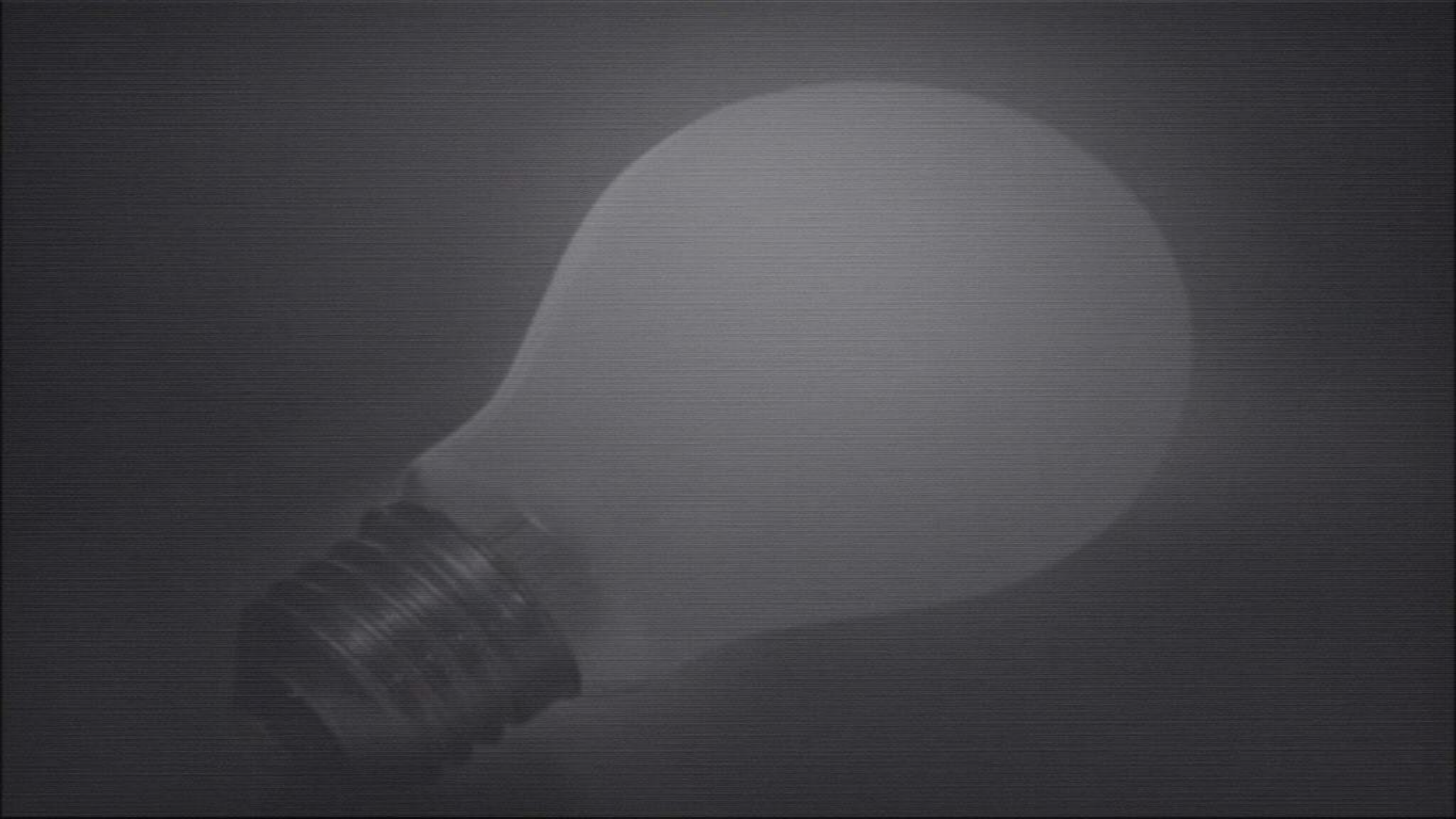
The Case for the DOE

Without equivalents, a patent is a "hollow and useless thing" [Graver Tank]

The DOE furthers the Patent Law's incentive structure. [Graver Tank, Warner-Jenkinson]

Settled expectations: Patentees assume DOE coverage when seeking patents. [Warner-Jenkinson, Festo]

We presume patentees are entitled to all they 'discover', even if not precisely claimed.



Literal Infringement

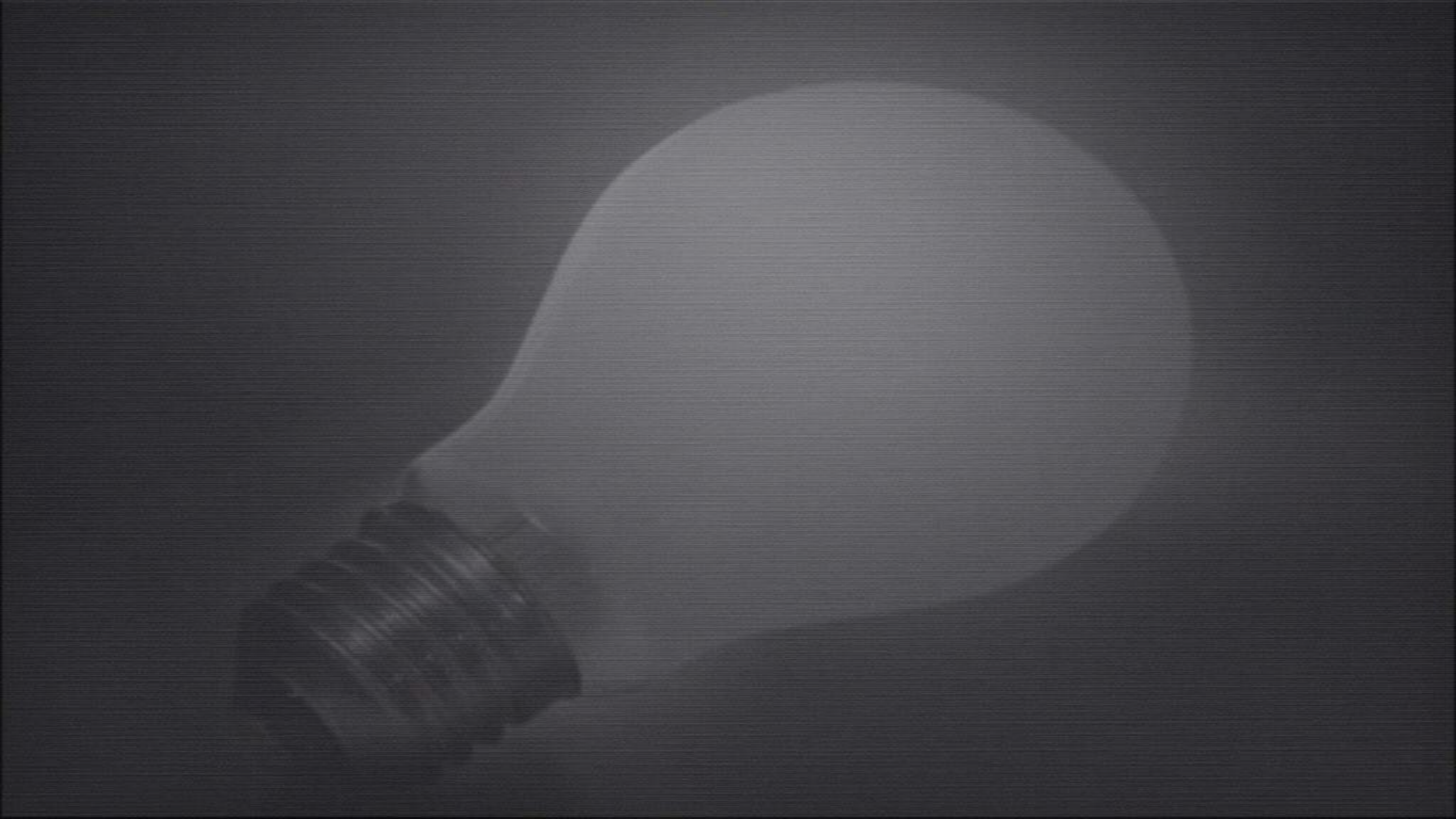
1. A writing implement comprising:
   - A wooden cylinder with a hollow core
   - A cylinder of graphite in said hollow core
   - A small cylinder of eraser material attached to one end of the wooden cylinder

- Which of the following infringes the claim?
  - A wooden pencil with a small metal clip for shirt-pocket storage
  - A plastic pencil (body made of plastic)
  - A pencil without an eraser

DOE Infringement

1. A writing implement comprising:
   - A wooden cylinder with a hollow core
   - A cylinder of graphite in said hollow core
   - A small cylinder of eraser material attached to one end of the wooden cylinder

- Which of the following infringes the claim?
  - A wooden pencil with a small metal clip for shirt-pocket storage
  - A plastic pencil (body made of plastic)
  - A pencil without an eraser



Limits on The Doctrine of Equivalents

Limits on the Doctrine of Equivalents

Limit on DOE	Application	Doctrinal Status
"Vitiation"	where equivalence would 'vitiate' a claim limitation	unclear; see Dolly, Sage, Ethicon
Prior Art	prior art related to equivalents	solid; Wilson Sporting Goods
Disclaimer	where patentee 'disclaims' subject matter	emerging; Gaus, Omega Eng.
Prosecution History Estoppel	amended claim elements	solid; Festo
Public Dedication	where patentee discloses, but does not claim	solid; Johnson & Johnston

Limits on the Doctrine of Equivalents

Limit on DOE	Application	Doctrinal Status
"Vitiation"	where equivalence would 'vitiate' a claim limitation	unclear; see Dolly, Sage, Ethicon
Prior Art	prior art related to equivalents	solid; Wilson Sporting Goods
Disclaimer	where patentee 'disclaims' subject matter	emerging; Gaus, Omega Eng.
Prosecution History Estoppel	amended claim elements	solid; Festo
Disclosed-But-Unclaimed Subject Matter	where patentee discloses, but does not claim	solid; Johnson & Johnston

Prosecution History Estoppel

Patent ‘123 discloses a lighting system,
using colored bulbs; a blue color is given as an example

The prior art contains very similar systems, including those using red colored bulbs.

Scenario 1

Original claim:

1. A lighting system comprising:
... a colored bulb ...

Amended claim:

1. A lighting system comprising:
... a blue light bulb ...

Scenario 2

Original claim:

1. A lighting system comprising:
... a blue light bulb ...

No amendments.

Prosecution History Estoppel

Scenario 1

Original claim:

1. A lighting system comprising:
... a colored bulb ...

Amended claim:

1. A lighting system comprising:
... a blue light bulb ...

Scenario 2

Original claim:

1. A lighting system comprising:
... a blue light bulb ...

No amendments.

Lighting systems with blue bulbs.

Lighting systems with red bulbs.

Lighting systems with green bulbs.

Prosecution History Estoppel

Scenario 1

Original claim:

1. A lighting system comprising:
... a colored bulb ...

Amended claim:

1. A lighting system comprising:
... a blue light bulb ...

Lighting systems with blue bulbs.

~~Lighting systems with red bulbs.~~

~~Lighting systems with green bulbs.~~

Scenario 2

Original claim:

1. A lighting system comprising:
... a blue light bulb ...

No amendments.

Lighting systems with blue bulbs.

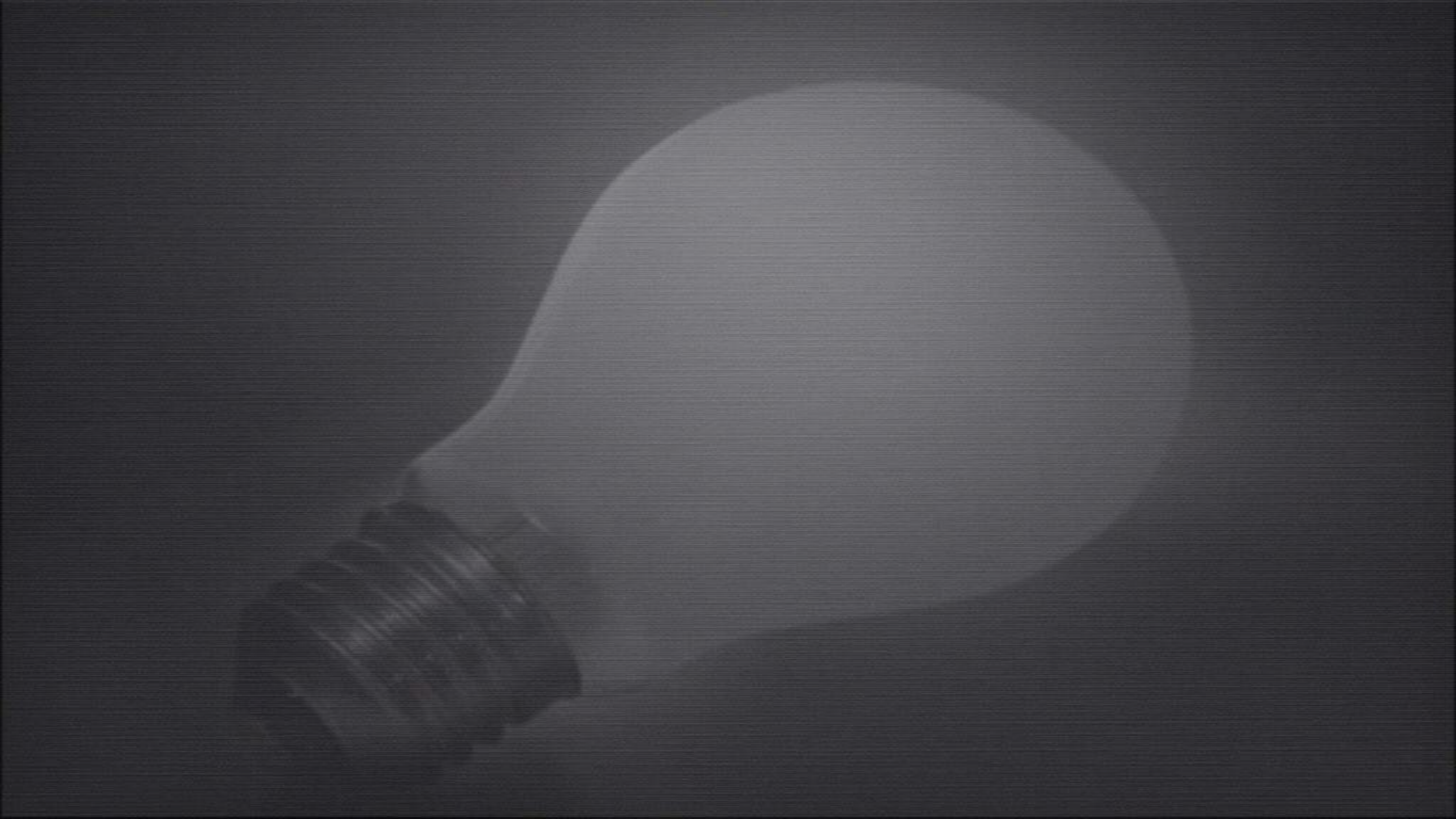
~~Lighting systems with red bulbs.~~

Lighting systems with green bulbs.

Prosecution History Estoppel

The result is that patentees have a (strong) disincentive to amend claims – and thus an incentive to claim correctly right away.

The doctrine helps enforce desirable behavior by patentees.



Recap on Infringement

Infringement analysis is a two-step process

Construction of the claim (for the judge)

Comparison of claim to accused device (for the jury)

Recap on Infringement

Infringement analysis is a two-step process

Construction of the claim (for the judge)

Comparison of claim to accused device (for the jury)

Recap on Infringement

Infringement analysis is a two-step process

Construction of the claim (for the judge)

Comparison of claim to accused device (for the jury)

Recap on Infringement

Infringement analysis requires an element-by-element comparison

Each claim element must be either literally present
or equivalently (under the DOE) present.

The DOE has important limitations.

Recap on Infringement

Infringement analysis requires an element-by-element comparison

Each claim element must be either literally present
or equivalently (under the DOE) present.

The DOE has important limitations.

Recap on Infringement

Infringement analysis requires an element-by-element comparison

Each claim element must be either literally present
or equivalently (under the DOE) present.

The DOE has important limitations.