Claim Construction: Recent Developments

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The basic cases:

- **Cybor Corp. v. FAS Techs., 138 F.3d 1448 (Fed. Cir. 1998) (en banc).**
  - District court claim constructions freely reviewed on appeal.

- **CCS Fitness v. Brunswick, 288 F.3d 1359 (Fed. Cir. 2002).**
  - Claim terms generally given their “ordinary meaning.
  - Departures from “ordinary meaning” can occur (e.g., applicant acts as “own lexicographer”)

- **Phillips v. AWH Corp., 415 F.3d. 1303 (Fed. Cir. 2005) (en banc).**
  - Ordinary meaning primarily determined in context of intrinsic evidence (claims, specification, and prosecution history).
  - Specification generally given more weight than prosecution history.
  - Intrinsic evidence generally given more weight than extrinsic evidence (e.g., dictionaries, articles, expert testimony).
Basic problem when drafting claims.

- Predicting the future is difficult.
  - Hard to know what smart people ten years or more in the future might do when trying to design around the invention, yet come as close as possible.

- “Outright and forthright duplication is a dull and very rare type of infringement.”
Considerable disagreement at the Federal Circuit on:
(1) The role of the specification in construing the claims (Phillips); and
(2) Whether deference should be given to the district court in the claim construction process (Sybor).


But counsel has known of uncertainty issues related to claims for a very long time:
“The stronger a patent the weaker it is and the weaker a patent the stronger it is.”


Still, this equation has changed in recent years.
Retractable Technologies v. Becton, Dickinson & Co., 653 F.3d 1296 (Fed. Cir. 2011)
Claims at issue recited “A hollow syringe body....”

Dependent claim directed to “one-piece body.”

Majority found “body” limited to “one-piece” based on the specification.

- Specification repeatedly recited that “the invention” has a body constructed as a one piece structure.
- Prior art was distinguished in specification based on “one piece.”
- Majority explained that “a construction of ‘body’ that limits the term to a one-piece body is required to tether the claims to what the specifications indicate the inventor actually invented.”
Judge Rader, dissenting, suggested:
  ◦ Doctrine of claim differentiation should yield different result.
  ◦ Specification references to “one piece” did not rise to the level of an “express disclaimer” of claim scope.

What did the specification say, exactly?
  ◦ “The prior art has not recognized that such a structure can be molded as a one piece outer body over a core that can be pulled out….”
    • (US Pat. 7,351,733 at col. 2 lines 34–38).

Implications: Are applicants better off not co-mingling method of making, and product, claims in a single case?
  ◦ Has long been a common scenario for consolidating claims.
Judge Plager, concurring, commented:

- “However much desired by the claim drafters, who want claims that serve as business weapons and litigation threats..., the claims cannot go beyond the actual invention.... For that we look to the written description.... I have written elsewhere about the curse of indefinite and ambiguous claims, divorced from the written description, that we regularly are asked to construe, and the need for more stringent rules to control the curse.”

- Proposing canons of claim destruction?
“The art of law is founded upon and practiced within a set of tensions between aims not simultaneously realizable in full.”

- Charles L. Black, Sterling Professor Emeritus of Law, Yale University.
Accent Packaging v. Leggett & Platt (Fed. Cir. Feb. 4, 2013)

- Claim recited “…operator bodies, with each of the operator bodies being operably coupled with a respective one of said A, B, C, and D…”

- Issue: Does this require:
  - Four operator bodies, each coupled to one and only one of A, B, C, and D (defendant’s and D.Ct. position); or
  - A plurality of operator bodies, each coupled to at least one of A, B, C, and D (patentee’s position).
Court agreed with patentee and reversed in pertinent part.

Noted specification showed a preferred embodiment in which two OBs are coupled to both an A and B.

Observed: “We have held that ‘a claim interpretation that excludes a preferred embodiment from the scope of the claim is rarely, if ever, correct.”

Also noted that indefinite articles such as “a” or “an” in “patent parlance” carry the meaning of “one or more” in open-ended claims unless the patentee has indicated a clear intent otherwise.

- But see North American Vaccines v. American Cyanamid, 7 F.3d 1571, 28 USPQ2d 1333 (Fed. Cir. 1993) (interpreting “a terminal portion” to include “only monofunctionality”) (opinion by Judge Lourie; dissent by Judge Rader).
Saffran v. Johnson & Johnson (Fed. Cir. April 4, 2013)


Fig. 4a

Fig. 8g
Two claim construction issues (We will set aside the “means for” issue, which also went against Saffran).

Claim 8: A method of treating a damaged tissue to promote repair comprising: (a) providing a device including, a layer of flexible material that is minimally porous to macromolecules....

Issue: Should “a device” be construed as limited to a continuous sheet? D.Ct. said no and found J&J drug-eluting stent to infringe. J&J appealed.
Majority found “device” limited to continuous sheet due to a prosecution history disclaimer.

Saffran argued he distinguished the reference on two grounds:
- (a) his invention is a continuous sheet; and
- (b) his invention is not a pre-formed chamber.

Majority emphasized that prosecution history disclaimer can arise even when reference distinguished on alternate grounds.
- While no “I hereby disclaim…” occurred, Dr. Saffran did assert “the device used is a sheet…”
Judge O’Malley, concurring in part, disagreed:
- “In sum, while long-winded and rambling at times, the written description provides a broad disclosure touching upon several medical applications and physical structures. Its primary focus is the treatment of bone fractures with a minimally porous sheet, but....”

Noted prosecution history disclaimer must be “clear and unambiguous.” Observed that:
- “because prosecution history represents an ongoing negotiation...it often lacks the clarity of the specification and thus is less useful for claim construction purposes.” (citing Phillips).

Judges Lourie and O’Malley, but not Judge Moore, agreed on interpretation of “means plus function” clause; Judges Lourie and Moore, but not Judge O’Malley, agreed on interpretation of “device.”
Implications:
- Avoid “means for…” as an expedient (old news).
- Avoid consolidating substantially different devices in a single case under a common theory of operation.
- Avoid under-developing an important embodiment (here, the stent) by combining it with other embodiments of less commercial importance.
  - To the extent this can be foreseen!
  - Also common “post Phillips” wisdom.
- Saffran was a pro se applicant. But the problem of the “long winded and rambling” specification is not limited to pro se applicants!
“A good claim is the perfect balance between breadth, ambiguity and precision.”

- Howard Skaist, Duke Law 1988, Previously Intel Director of Patents, and Founder, Berkeley Law & Technology Group LLP.

During prosecution the examiner acknowledged claims enabled for use of antibody RITUXAN® antibody, but rejected broader claims for lack of enablement in covering “any and all anti-CD20 antibodies, no matter the specificity or affinity for the specific epitope.”

Applicants argued “one of skill in the art could readily identify an antibody that binds to the CD20 with similar affinity and specificity as does RITUXAN® using techniques that are well known.”

Overcame enablement rejection, issued patent, sued GSK over product ARZERRA®

But ARZERRA® binds CD20 at a different epitope (location) than does RITUXAN®
D. Ct. found Biogen’s argument that specification was enabled for “anti-CD20 antibodies with similar affinity and specificity…” resulted in a prosecution history disclaimer for antibodies that bound to epitopes other than that bound by RITUXAN.® Hence found for GSK, and CAFC affirmed.

Judge Plager, dissenting, saw no disclaimer.

- “And when a prosecution argument is subject to more than one reasonable interpretation, it cannot rise to the level of a clear and unmistakable disclaimer.” (citing 01 Communique v. LogMeIn, 687 F.3d 1292, 1297 (Fed. Cir. 2012).
Perhaps Saffran could have better foreseen how a vascular stent might incorporate his invention if he had given more thought to that embodiment while writing his application.

But, could Biogen have foreseen the alternate epitope when negotiating their application?
Nonprecedential.

Claim recited “voltage source means.”

No structure corresponding to “means” contained in specification.

Claim held indefinite under 35 USC §112 ¶6 and then 35 USC §112 ¶2.

Opinion vacated and petition for rehearing *en banc* granted on March 15, 2013, to consider overruling *Cybor*, and whether deference should be given to any aspect of a District Court’s claim construction.

Stay tuned for more....
References and Resources