

RECENT DEVELOPMENTS AFFECTING PATENT CLAIM
STRATEGY

by

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I. USE OF THE SPECIFICATION IN CLAIM INTERPRETATION

A. Cases Using The Historic Analysis — Focusing On The Plain Language Of The Patent Claims, Read In View Of The Specification

Since its inception, the United States Court of Appeals for the Federal Circuit (“Federal Circuit”) has noted that patent claims should be construed in light of the specification. However, the Federal Circuit has cautioned that descriptions appearing in the specification should not be read into claims, which do not recite those limitations.

1. *SRI International v. Matsushita Electric Corporation of America*, 775 F.2d 1107, 227 U.S.P.Q. 577 (Fed. Cir. 1985) (*en banc*),

The Federal Circuit, sitting *en banc*, stated:

When claim construction is required, claims are construable, as above indicated, in light of the specification, yet “[t]hat claims are interpreted in light of the specification does not mean that everything expressed in the specification must be read into all the claims.” If everything in the specification were required to be read into the claims, or if structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims. Nor could an applicant, regardless of the prior art, claim more broadly than that embodiment. Nor would a basis remain for the statutory necessity that an applicant conclude his specification with “claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” It is the *claims* that measure the invention.

Id. at 1121 (internal citations omitted).

2. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 50 U.S.P.Q.2d 1607 (Fed. Cir. 1999).

“[A] court must presume that the terms in the claim mean what they say, and, unless otherwise compelled, give full effect to the ordinary and accustomed meaning of claim terms.” Thus, “claim terms cannot be narrowed by reference to the written description or prosecution history unless the language of the claims invites reference to these sources.”

Based on these guidelines, the Federal Circuit concluded that a claim directed to a steering control apparatus for small outboard motors should not be narrowed to the particular embodiments shown and described in the specification. The Court concluded that the defendant had failed to show that the claim terms were unclear or had been specially defined in the patent specification. Thus, the Court gave the claim terms their ordinary meaning, which was consistent with the specification. Under this claim construction, the accused devices infringed the claim. The Court affirmed summary judgment of infringement.

B. Cases Adopting A Narrow Construction Of The Patent Claims Based On Statements In The Specification Or The Prosecution History

The Federal Circuit has continued to focus on the language of the claims, as read in view of the patent specification. However, in certain recent cases the Federal Circuit has narrowed the scope of the express language of the claims on the ground that the patent specification restricts the permissible scope of the claims.

3. *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 58 U.S.P.Q.2d 1059 (Fed. Cir. 2001).

The claims of the patents at issue related to balloon dilation catheters, and did not specify whether the catheters were dual lumen or coaxial type catheters. Based solely on statements in the patent specification, the Court construed the claims as limited to only coaxial type catheters.

The specification of the patents distinguished the prior art based on the use of dual lumens and pointed out the advantages of dual lumen catheters. The specification also stated that “all of the embodiments of the present invention contemplated and disclosed herein” utilize the coaxial lumen design. The Court found that the specification defined the invention and expressly disclaimed the dual lumen design. The Court stated that “[w]here the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question.”

Because the accused catheters were dual lumen type, they did not literally infringe the claims. The Court also found that there could be no infringement under the doctrine of equivalents because “the patentee cannot be allowed to recapture the excluded subject matter under the doctrine of equivalents without undermining the notice function of the patent.” The Court affirmed summary judgment of noninfringement.

4. *Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 59 U.S.P.Q.2d 1865 (Fed. Cir. 2001).

Although claims terms are given their ordinary and accustomed meaning as a starting point, “a claim term may be clearly redefined without an explicit statement of redefinition.” Because the written description of the preferred embodiments provides guidance as to the meaning of claim terms, “the specification may define claim terms ‘by implication’ such that the meaning may be ‘found in or ascertained by a reading of the patent documents.’”

The claims at issue recited a network having “modes.” While the ordinary meaning of this term was broader than the construction provided by the district court, the Federal Circuit found the term “sufficiently broad and amorphous that the scope of the claim language can be reconciled only with recourse to the written description.” Because the specification and prosecution history used the term “mode” consistently to refer to only particular modes, the Federal Circuit found that the applicant had defined “mode” as limited to those particular modes by implication. This narrow construction also applied to a claim that did not expressly contain the “mode” limitation

because other terms in the claim were defined to have the same definition as “mode.” The Court affirmed summary judgment of noninfringement.

5. *Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 58 U.S.P.Q.2d 1076 (Fed. Cir. 2001).

The claims of the patent were directed to a system for locating and retrieving information on a computer network using aliases. While the claims recited a local server computer, the claims did not recite that the local server computer store a limited set of aliases that was updated from the central registry computer. However, the Federal Circuit construed the claim to require this function of the local server computer based on the patent specification.

Stating that the specification presents “a description of the technologic subject matter of the invention,” the Court noted that the claims cannot “enlarge what is patented beyond what the inventor has described as the invention.” Because the specification described the function of the local server computer, the Court limited the claims to include this function. While the specification described an embodiment in which the local server computer and the central registry computer were on the same computer, the Court determined that the claim still required the functions of the local server computer set forth in the specification. Based on this claim construction, the accused system did not literally infringe, nor did it infringe under the doctrine of equivalents because there was no structure that functioned as the claimed local server computer. The Court affirmed summary judgment of noninfringement.

C. Very Recent Cases Using The Classic Analysis

6. *Interactive Gift Express, Inc. v. CompuServe Inc.*, 256 F.3d 1323, 59 U.S.P.Q.2d 1401 (Fed. Cir. 2001).

“In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves.” “If the claim language is clear on its face, then our consideration of the rest of the intrinsic evidence is restricted to determining if a deviation from the clear language of the claims is specified.” If the claim language is not clear on its face, the remainder of the intrinsic evidence is used to resolve the meaning of the claim terms. The specification is used only to determine the meaning of the claim term as used in the context of the patent, “not merely to limit a claim term.” Here, the Federal Circuit reversed the district court’s construction of several claim limitations as contrary to the ordinary meaning, and for impermissibly importing several limitations from the specification into the claims.

In claim construction, the doctrine of waiver precludes a party from adopting a new claim construction on appeal. However, the doctrine does not prevent a party from clarifying or defending the original scope of its claim construction, “or from supporting its existing claim construction position with new citations to the specification.” “[A]rguments that are based on a specification in evidence and that are in support of an existing claim construction are not barred by the doctrine of waiver for the sole reason that they were not first presented to the trial court.”

7. *Rexnord Corp. v. Laitram Corp.*, --- F.3d ---, 2001 WL 1456191 (Fed. Cir. Nov. 15, 2001).

In construing claims, “all terms in a patent claim are to be given their plain, ordinary and accustomed meaning to one of ordinary skill in the relevant art.” Unless compelled to do otherwise, “a court will give a claim term the full range of its ordinary meaning.” After determining the plain meaning of a disputed claim term, a court must undertake the “confirmatory step” of examining the written description and drawings “to confirm that the patentee’s use of the disputed terms is consistent with the meaning given to it by the court.” This confirmatory step “is necessary to determine whether the patentee has disclaimed subject matter or has otherwise limited the scope of the claims.” The same confirmatory measure must be taken with the prosecution history because statements made during prosecution may also limit the scope of the claims.

“The comprehensive examination of the claims, the specification, and the prosecution history in the claim construction process is not meant to impose an undue burden on the district court, but instead serves to ensure that all pertinent intrinsic evidence is considered in the proper interpretation of a claim.” In this inquiry, a party should present all relevant arguments and point out with specificity all relevant statements in the specification and prosecution history to the court.

Here, the claims related to self-clearing conveyors, and the parties disputed whether the claim term “portion” encompassed only unitary or two-piece structures. Because the dictionary definition of “portion” encompassed both types of structures, the broad ordinary meaning of the claim term covered both structures. Although the specification described unitary structures as a preferred embodiment, the Federal Circuit found that other statements in the specification supported the broad construction of “portion.” The Court, citing *SRI Int’l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 227 U.S.P.Q.2d 577 (Fed. Cir. 1985) (*en banc*), noted that a patentee need not describe every possible embodiment in the specification in order to broadly claim an invention. The Court also concluded that the prosecution history did not limit the plain meaning of the claim term to unitary structures. Thus, the district court erred in limiting the broad ordinary meaning of the claim term as limited to the unitary structure described as a preferred embodiment.

Summary judgment of noninfringement was reversed.

II. DOCTRINE OF EQUIVALENTS AND PROSECUTION HISTORY ESTOPPEL

The Federal Circuit has also narrowed a patentee’s ability to gain patent protection under the doctrine of equivalents by narrowing the available range of equivalents and by enlarging the circumstances under which prosecution history limits the range of equivalents.

8. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 56 U.S.P.Q.2d 1865 (Fed. Cir. 2000) (*en banc*), *cert. granted*, 121 S. Ct. 2519, 150 L. Ed. 2d 692, 69 USLW 3673 (U.S. June 18, 2001).

Following a grant, vacate, and remand order from the Supreme Court in view of *Warner-Jenkinson*, a panel of the Federal Circuit affirmed the district court's judgment of infringement under the doctrine of equivalents. The Federal Circuit then heard the case *en banc* "to resolve certain issues relating to the doctrine of equivalents."

The *en banc* Court determined that "an amendment that narrows the scope of a claim for any reason related to the statutory requirements for a patent will give rise to prosecution history estoppel with respect to the amended claim element." Thus, any narrowing amendment made to address deficiencies under 35 U.S.C. §§ 101, 102, 103 or 112 creates prosecution history estoppel with respect to the amended claim limitation. In determining the reason for an amendment, a patentee cannot rely on evidence extrinsic to the prosecution history. Moreover, adding a new claim in place of an existing claim will not avoid a narrowing amendment if the new claim adds limitations not in the prior claim. However, non-narrowing amendments and amendments "not motivated by patentability concerns" will not give rise to prosecution history estoppel. It is irrelevant whether the amendment was voluntary or required by the Patent Office.

"[W]hen a claim amendment creates prosecution history estoppel, no range of equivalents is available for the amended claim element." The Federal Circuit stated that the Supreme Court has never expressly addressed this issue. While the Federal Circuit had generally followed a flexible bar approach, which allows a limiting effect from zero to a complete bar, the Court had also applied a complete bar approach in some cases. Noting that experience had shown the flexible bar approach to be unworkable, the Court overruled its prior precedent and adopted the complete bar approach. The Court noted that this approach would enforce the disclaimer effect of narrowing amendments and increase certainty by serving the definitional and notice functions of patent claims.

The Supreme Court granted certiorari on two questions:

1. Whether every claim-narrowing amendment designed to comply with any provision of the Patent Act—including those provisions not related to prior art—automatically creates prosecution history estoppel regardless of the reason for the amendment; and
2. Whether the finding of prosecution history estoppel completely bars the application of the doctrine of equivalents.

Oral argument was heard on January 8, 2002.

9. [DWM - Add Sage]

III. WRITTEN DESCRIPTION

Section 112, ¶ 1 of the patent statute provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact

terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor for carrying out his invention.

35 U.S.C. § 112, ¶ 1 (emphasis added).

In addition to limiting the permissible scope of claims based on the specification, the Federal Circuit has also invalidated claims that are broader in scope than the supporting written description. The following cases are illustrative of this treatment.

10. [Add Gentry Gallery later]

11. *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 56 U.S.P.Q.2d 1481 (Fed. Cir. 2000).

During litigation, the patentee added, to a pending patent application claims directed to methods of treating pain in patients by administering an opioid once a day. The patent was allowed after an interview in which the Examiner noted that “the new claims are supported by the (specification)” The patentee asserted the newly issued patent, the claims of which recited that the maximum plasma concentration (C_{max}) is more than twice the plasma concentration 24 hours after administration of the dosage form (C₂₄).

On appeal, the Federal Circuit affirmed the district court’s decision that the specification and originally-filed claims did not support the claimed C_{max}/C₂₄ ratio limitation. The Federal Circuit concluded that the patentee was attempting to pick an unidentified characteristic possessed by two of the many examples in the specification and claim any formulation that possessed that characteristic. The Court rejected this approach finding that the characteristic was not discussed even in passing in the specification and, thus, there was nothing in the specification “that would suggest to one skilled in the art that the C_{max}/C₂₄ ratio is an important defining quality of the formulation.” Because the specification did not clearly disclose the claimed C_{max}/C₂₄ ratio to one of skill in the art, “it is immaterial what range for the C_{max}/C₂₄ ratio can be gleaned from the examples when read in light of the claims.” Thus, the written description failed to support the claims added during prosecution.

The Federal Circuit also rejected the patentee’s argument that the Examiner’s statement that the claims were supported was entitled to deference. In view of the evidence presented, the Federal Circuit determined that the district court properly did not find the Examiner’s statement persuasive.

IV. CONCLUSIONS

There is considerable uncertainty at the present time as to the extent that the Federal Circuit will rely upon the specification to invalidate claims and construe them more narrowly than the ordinary meaning of the claim terms in a specific case. One thing which is certain,

however, is that patent applications must be prepared much more carefully in view of the potential that the claims may be narrowly construed based on the specification. If broad claims are intended, clear support for the broad language should be provided in the specification and prosecution history. All of this will raise the cost of preparing patent applications, but the Federal Circuit has spoken on that point:

Given a choice of imposing the higher costs of careful prosecution on patentees, or imposing the costs of foreclosed business activity on the public at large, this court believes the costs are properly imposed on the group best positioned to determine whether or not a particular invention warrants investment at a higher level, that is, the patentees.

Sage Prods., Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1426, 44 U.S.P.Q.2d 1103 (Fed. Cir. 1997).

As for the doctrine of equivalents and prosecution history estoppel, *Festo* added certainty, although perhaps a harsh certainty. The Supreme Court's review of *Festo*, however, makes the *Festo* decision itself uncertain. No matter how *Festo* is determined, it is apparent that a broad application of the doctrine of equivalents is not in favor at the Federal Circuit, and claims should be carefully drafted to avoid the need for reliance on the doctrine of equivalents to the extent possible.

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