



# Introduction to Patent Infringement Under United States Law

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Dave Conlin, Member



## Patent Infringement (35 U.S.C. § 271)

- Direct Infringement (271 (a)):
  - Whoever without the authority of the patent owner makes, uses, sells, offers to sell, or imports
  - Any patented invention
  - Within the United States
  - During the term of the patent
- Infringes the patent



## Outline of Discussion

- Direct and Indirect Infringement
- Literal Infringement
- Court determination of infringement
- Intrinsic Evidence
- Extrinsic Evidence
- Means Plus Function Claims
- Doctrine of Equivalents
- Markman Hearing Procedures



## Indirect infringement 35 U.S.C. §271 (b, c)

### (b) Infringe by **active inducement** of infringement

– There must be direct infringement. Two recent developments:

1. All steps or elements of the direct infringement must have been committed by or under the control of single entity. (*Limelight v. Akamai*, U.S. Supreme Ct., 6/2/2014)
2. Inducement requires knowledge of the patent and intent to infringe. Good faith belief of non-infringement can negate intent to induce infringement, but good faith belief of invalidity cannot negate such intent. (*Commil USA v. CISCO*, U.S. Supreme Ct., 5/26/2015))

### (c) Infringe by **contributory infringement**

- Sell, offer or import material component of patented invention, especially made or adapted for infringement, not suitable for substantial non-infringing use.
- As in §271 (b), no contributory infringement unless There is direct infringement.



## Other provisions of 35 U.S.C. §271

(d) (Antitrust exemptions)

(e) Infringement of patented pharmaceuticals and veterinary medicines – Hatch-Waxman Act.

(1) Not infringement solely for developing information under federal law regulating drug manufacture or use

(2) Infringement to submit Abbreviated New Drug Application

(f) Infringement by exporting components of patented invention from the United States.

(g) Infringing by importing, selling, offering for sale or using product made outside U.S. by a process patented in the U.S.



## Types of Patent Infringement

- Literal Infringement
- Infringement under the Doctrine of Equivalents (DOE)



## Literal Infringement

- A claim is literally infringed if the accused product or process includes **all elements** **or limitations** of the claim. *Signtech U.S.A. v. Vutek, Inc.* 174 F.3d 1352 (Fed. Cir. 1999); *Builders Concrete, Inc. v. Bremerton Concrete Products*, 757 F.2d 255, 257 (Fed. Cir. 1985).



## Patent Infringement Analysis is a Two Step Process.

- **“Patented invention”** means **invention claimed in an issued patent**
- Infringement determination is **two step** process:
  - **Court** determines the **scope and meaning of disputed claim terms as a matter of law.**
  - **Properly construed claims** are **compared to the accused infringement**, to determine:
    - Literal Infringement, or
    - Infringement under the Doctrine of Equivalents



## Markman Procedure

- Claim construction is the first step in determining infringement of a patent

*Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc),  
aff'd, 517 U.S. 370 (1996).

Meaning of the claim is determined by the court as a matter of law

- Where there are significant disagreements between patentee and accused infringer, the court will hold a “**Markman Hearing**” to determine the proper construction of the claim language



## Claim Construction

- Sources used to construe the meaning and scope of claims:
  - Claims
  - Specification
  - Prosecution history
  - Prior art
  - Other sources

*Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (*en banc*),  
*aff'd*, 517 U.S. 370 (1996)



## Notice Function of Claims

- The Federal Circuit emphasized that the public has a need to have notice of the scope of the patent claims



## Evidence

- Although claim construction is a matter of law, it is rooted in evidentiary underpinnings
  - Evidence can be **intrinsic** or **extrinsic**
- The court must interpret the claim from the perspective of one of ordinary skill in the art
- Remembering the public notice function of claims, **intrinsic** evidence should be considered **first**



## Intrinsic Evidence

- "Intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language" *Vitronics*, 90 F.3d 1576, 1582, (Fed Cir. 1996)
- Intrinsic Evidence:
  - Claims
  - Specification
  - Prosecution History, including cited art
- All intrinsic evidence is not equal



## Intrinsic Evidence – Claim Language

- A patent claim is that "portion of the patent document that defines the scope of the patentee's rights." *Teva v Sandoz* U.S. Supreme Court 1/20/2015
- First "Assess the actual claim language of the patent ."

*Interactive Gift Express, Inc. v. CompuServe Inc.*, 231 F.3d 859, 865 (Fed. Cir. 2001), *withdrawn and superseded on other grounds by*, 256 F.3d 1323 (Fed. Cir. 2001).



## Claims

- Claim terms are presumed to have their accustomed meaning as would be understood by one of ordinary skill in the art at the time of invention of the claimed subject matter

*Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1206 (Fed. Cir. 2002), Cert denied, 123 S. Ct. 2230 (2003); *Dow Chem. Co. v. Sumitomo Chem. Co.*, 257 F.3d 1364, 1372 (Fed. Cir. 2001).



## Claim Terms

- **Ordinary meaning** is presumed, **unless specification contains a definition**, or contains a **disclaimer of scope**
- It is often helpful to consider a particular term in the context of other language in the same claim
- Considering other claims in same patent - "**claim differentiation**"
  - when different words or phrases are used in separate claims, the claims presumably have a significant difference in meaning and scope
- Claim terms should be given consistent meaning



## Claim Preambles

- Introductory phrase: A compound; A method of \_\_\_\_\_, etc.
- Establish background or context for the claim
- Usually does not limit scope of the claim
  - May limit based on circumstances,
  - Can limit if used to define invention if it gives "life, meaning and vitality" to the claim
- But may shed light on the meaning of claim terms
- Jepson claims - preamble presumptively sets forth prior art improved by invention
  - In a method of doing A, B and C, the improvement D



## Transitional Phrases

- "comprising" and "including"
  - open-ended, no restriction
- "consisting of"
  - claim restricted to recited elements
- "consisting essentially of"
  - less limiting than "consisting of"
  - materiality a consideration



## Other Intrinsic Evidence – The Specification

- Assess the actual claim language of the patent
- Read the claim language in light of the patent's specification *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116 (Fed. Cir. 1987)



## Specification

- If the meaning of the claim term is not clear from the claim language, the specification should be consulted
  - Patentee may act as own lexicographer - define claim terms
    - May overcome presumption in favor of ordinary meaning
  - Specification can narrow meaning of claim if ordinary meaning is not clear from claim language
  - Specification can expressly disclaim subject matter or limit invention
  - Generally, limitations found in specification should not be read into the claims
    - It is often difficult to draw line between construing claim in light of the specification and reading a limitation from a preferred embodiment into the claim



## Intrinsic evidence: Prosecution History

- Assess the actual claim language of the patent
- Read the claim language in light of the patent's specification
- Examination of the prosecution history of a patent enables a court to further “shed light on what the applicant meant by its various terms.”

*Laitram Corp. v. Morehouse Indus., Inc.*, 143 F.3d 1456, 1462 (Fed. Cir. 1998)



## Prosecution History

- Arguments made to overcome prior art
- Arguments made to overcome § 112 rejections
- Amendments made to overcome prior art - teaching of prior art cited or relied on in the PTO may shed light on claim terms
- Statements explaining invention - and stating what is not the invention



## Extrinsic Evidence

- In addition to intrinsic evidence the courts can rely on **extrinsic** evidence:
  - Expert testimony
  - Inventor testimony
  - Prior Art Publications
  - Dictionaries and treatises



## Extrinsic Evidence

- Generally, extrinsic evidence should be used only if claims cannot be construed with intrinsic evidence
- Not all extrinsic evidence is treated the same



## Extrinsic Evidence: Expert Testimony

- A court may always consult extrinsic evidence to educate itself about the technology at issue
- A technical tutorial often is used to explain scientific principles, the meaning of technical terms, and terms of art that appear in the patent and prosecution history
- Expert testimony almost always should be available as evidence of the meaning of a claim term to one of ordinary skill in the art



## Extrinsic Evidence: Inventor Testimony

- Less reliable
- Not necessarily evidence of the meaning of a claim term to one of ordinary skill in the art
- May be useful where term is defined in specification, but remains unclear



## Extrinsic Evidence: Prior Art Publications

- Cited prior art vs. uncited prior art
  - Prior art publications, patents etc. which were cited in the PTO or considered by the Examiner are intrinsic evidence, which may have played a role in the prosecution of the patent
  - Prior art which was not cited in the PTO can be evidence of the meaning of terms or the content of the relevant knowledge, but do not carry as much weight as cited prior art



## Extrinsic Evidence: Dictionaries and Treatises

- Once considered a special form of extrinsic evidence - now not considered to be extrinsic evidence
- Always available for consultation as an aid to the court



## Dictionaries and Treatises (cont.)

- In *Texas Digital Sys. Inc. v. Telegenix Inc.*, 308 F.3d 1193 (Fed. Cir. 2002), the court held that:
  - Dictionaries "may be the most meaningful [source] of information" to be used in claim construction because they reflect "the established meanings that would have been attributed to the terms of the claims by those of skill in the art"
- However, since that decision, various panels of the Federal Circuit have warned against over-reliance on dictionaries, favoring instead an approach that considers real world context of the invention and viewpoint of those of ordinary skill in the art



## Dictionaries and Treatises (cont.)

- In *Phillips v. AWH Corp.* (Fed. Cir. Jul. 12, 2005), the court held that:
  - Dictionaries should be used only sparingly in patent trials
  - The “ordinary meaning” of a claim term is its meaning to the ordinary artisan after reading the entire patent
  - “Heavy reliance on the dictionary divorced from the intrinsic evidence risks transforming the meaning of the claim term to the artisan into the meaning of the term in the abstract, out of its particular context, which is the specification.”
  - However, the purpose of *Texas Digital* is still sound – to “avoid the danger of reading limitations from the specification into the claim”



## Dictionaries and Treatises (cont.)

- Dictionaries do not always keep abreast of invention
  - do not keep pace with technology
  - definitions not in context of invention
- Dictionaries are not necessarily authoritative
  - written by English majors not Scientists
  - one should consider what purpose was intended by the dictionary authors
  - one should be skeptical and sophisticated about information in a dictionary just as with information found elsewhere



## Other Factors

- **Construe claims to sustain validity**

- claims are to receive liberal construction and should be interpreted to uphold, not destroy, inventor's right (if possible)

- **Construe claims narrowly**

- when presented with two equally plausible meanings, the court should adopt the narrower meaning in order to promote public notice function - where narrow meaning is clearly supported while broader meaning raises questions of enablement

- **Consideration of Parties' positions**

- court is not limited by positions argued



## Other Factors (cont.)

- Consideration of Parties' positions
  - court is not limited by positions argued



## Federal Circuit Review of District Court Claim Construction

- The Federal Circuit held that claim construction is a question of law exclusively for the court, i.e. for a judge rather than a jury. *Georgia-Pacific Corp. v. U.S. Gypsum Co.*, 195 F.3d 1322, 1327 (Fed. Cir. 1999). This rule was confirmed by the Supreme Court in *Markman*.
- Claim construction **often requires factual findings** by the District Court, e.g., what expert is to be believed, what evidence is to be believed, what is the meaning of technical terms, etc.
- Until recently, Federal Circuit held that it reviewed all aspects of claim construction *de novo*, as if it were taking the place of the District Court in making factual findings, as well as legal conclusions.
- This led to many reversals of District Court claim construction opinions



## Federal Circuit Review of District Court Claim Construction

- In *Teva v. Sandoz*, U.S. Supreme Court, 1/20/15, the Court held that the Federal Circuit approach was wrong, and violated FRCP 52 – appeals court cannot set aside lower court's findings of fact unless they are "clearly erroneous"
- The District Court Judge, who conducts the Markman Hearing is in a better position to determine the correct facts than the appeals court judges
- How applied:
  - If the District Court construes the claims based only on intrinsic evidence, that determination "will amount solely to a determination of law, and the Court of Appeals will review that construction *de novo*."
  - If the District Court considers extrinsic evidence, and resolves a question of fact which helps that court construe the claim, the appellate court can still review the ultimate claim construction *de novo*, but to overturn the District Court's factual findings, the Appellate Court must find that the District Court has made "clear error."



## Practice Tips for the **Patent Owner**

- Show how the specification supports a broad concept of the invention
  - No limitation on technological approach



## Practice Tips for the **Patent Owner** (cont.)

- Show how the specification is not limiting
  - Large number of embodiments



## Practice Tips for the **Patent Owner** (cont.)

- Show how the specification is consistent with as many different dictionary definitions as possible
  - If inventor(s) defined terms in the specification, show how the definitions are consistent with standard or common usage (even if the definitions are not the same as in common usage)



## Practice Tips for the **Accused Infringer**

- Answer the question, “What did the inventor(s) tell the public that he/she/they invented?”
- Show how the patentee's positions are inconsistent with that message



## Practice Tips for the **Accused Infringer** (cont.)

- If there are significant technological differences between the accused device/method and the patent, highlight the technological direction in which the patent leads the ordinarily skilled artisan, away from the accused device



## Practice Tips for the **Accused Infringer** (cont.)

- Show how the specification is limiting
  - Limited number of embodiments
  - Express definitions
    - Implicit definitions may not be good enough
    - Patentee acting uniquely as his/her own lexicographer
    - Inconsistency with dictionary definitions
  - Limited number of embodiments for “means plus function” limitations



## Means-Plus-Function Claims

- “An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material or acts described in the specification and equivalents thereof.”

35 U.S.C. § 112, ¶ 6



## Means-Plus-Function Claims

- If “means-plus-function” language is used, the claim will **not** be interpreted to cover **all** structures
- The claim will cover *only* the “corresponding structure ... described in the specification,” and equivalents thereof



## Means-Plus-Function Claims

- Is a claim limitation in means-plus-function format?
  - A question of law, in which the court consults the same evidence as when construing claims not governed by 35 U.S.C. § 112, ¶ 6
  - Use of “means” within a claim limitation triggers rebuttable presumption that 35 U.S.C. § 112, ¶ 6 governs



## Means-Plus-Function Claims

- Sample claim:
  - A kit for disinfecting a contact lens, comprising:
    - means for containing the lens
    - a disinfection solution; and
    - a neutralizer tablet



## Means-Plus-Function Claims

- How to rebut the presumption that 35 U.S.C. § 112, ¶ 6 governs a claim that recites a "means":

– Demonstrate, by a preponderance of evidence, either:

- The claim element recites no function corresponding to the means, or
- The claim element recites both a function and sufficient structure or material for performing that function

*Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1372 (Fed. Cir. 2003), cert. denied, 124 S. Ct. 922 (2003)



## Means-Plus-Function Claims

- *Altiris, Inc. v. Symantex Corp.*, 318 F.3d 1363, 1376 (Fed. Cir. 2003)
  - In order to rebut the presumption that 35 U.S.C. § 112, ¶ 6 applies, a claim element including the word “means” must recite “a specific physical structure that performs the function”
    - The presumption can be rebutted where “the exact structure used to accomplish the function appears in the claim language”
    - BUT cannot be rebutted if the structure is “described only functionally [such that] one must still look to the specification for an adequate understanding of the structure”



## Means plus function claims

- If a claim does not recite a "means" or a "step", there is a presumption that 35 U.S.C. § 112, ¶ 6 does **not** apply.
- "When a claim term lacks the word "means," the presumption can be overcome and 35 U.S.C. § 112, ¶ 6 will apply if the challenger demonstrates that the claim term fails to 'recite sufficiently definite structure' or else recites 'function without reciting sufficient structure for performing that function.'" *Williamson v. Citrix*, Federal Circuit, 6/16/2105.



## Means-Plus-Function Claims

- When a claim limitation implicates 35 U.S.C. § 112, ¶ 6
  - The court must determine:
    - What the claimed function is, and
    - What structure disclosed in the written description corresponds to the ‘means’ for performing that function *Lockheed Martin Corp. v. Space Sys./Loral, Inc.*, 324 F.3d 1308, 1319 (Fed. Cir. 2003)
    - If no structure for performing that function is adequately described in the specification as filed, the claim is invalid under 35 U.S.C. § 112.



## Means-Plus-Function Equivalents under 35 U.S.C. § 112, ¶ 6

- The court applies a **modified** *Graver Tank* test – do the structures:
  - Perform the **identical** function
  - in substantially the same way
  - to achieve substantially the same result
- Overall structural comparison
  - Not on an element-by-element basis as under DOE
  - Structures with different number of elements may still be equivalent
- An equivalent structure under § 112 ¶ 6 must have been available when the patent issued
  - But “after arising technology” may be an equivalent under DOE



## Types of Patent Infringement

- Literal Infringement
- Infringement under the Doctrine of Equivalents (DOE)



## Literal Infringement

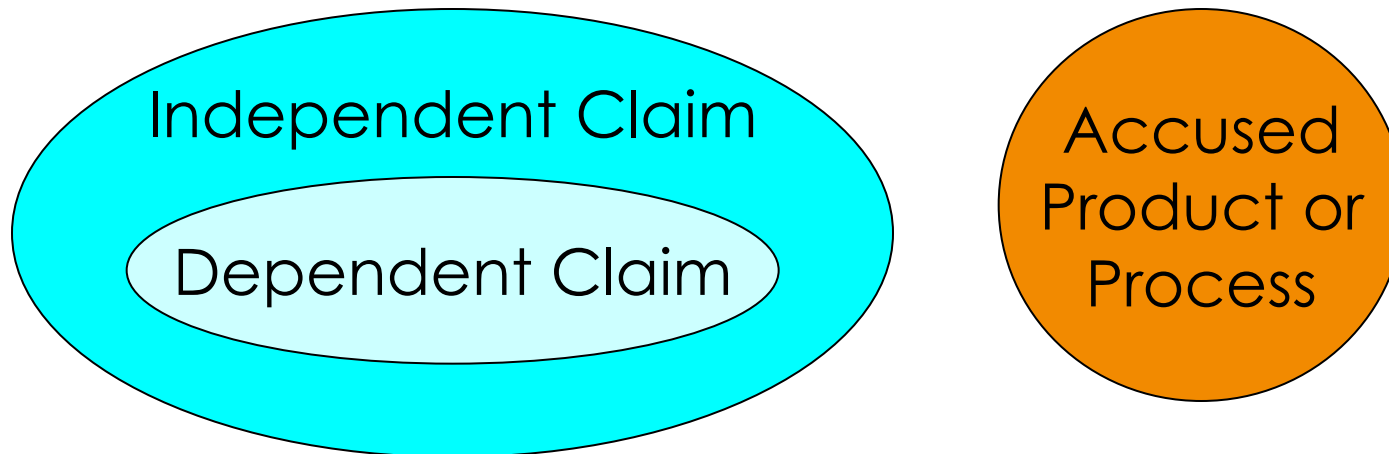
- A claim is literally infringed if the accused product or process includes **all elements** **or limitations** of the claim. *Signtech U.S.A. v. Vutek, Inc.*, 174 F.3d 1352 (Fed. Cir. 1999); *Builders Concrete, Inc. v. Bremerton Concrete Products*, 757 F.2d 255, 257 (Fed. Cir. 1985)



## Literal Infringement (cont.)

- If an independent claim is not literally infringed, each claim that depends from the independent claim also is normally not literally infringed

*Wahpeton Canvas Co. v. Frontier, Inc.*, 870 F.2d 1546, 1553 (Fed. Cir. 1989)





## Literal Infringement (cont.)

- To literally infringe a claim that includes **a means-plus-function term**, the accused product or process must employ means structurally identical or 35 U.S.C. § 112, ¶ 6 equivalent to the means disclosed in the specification to perform the identical function of the claim element

*Pennwalt Corp. v. Durand-Wayland Inc.*, 4 USPQ2d 1737 (Fed. Cir. 1987)



## Infringement under the DOE

- Someone who steals the heart of an invention but avoids the literal language of the claim by making **unimportant and insubstantial changes** could be liable under the doctrine of equivalents

*Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 606 (1950). *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 117 S. Ct. 1040 (S.Ct. 1996)



## Infringement under the DOE (cont.)

- Each element contained in a patent claim is deemed material to defining the scope of the patented invention, and thus the doctrine of equivalents **must be applied to individual elements of the claim, not to the invention as a whole**

*Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997)



## Infringement under the DOE (cont.)

- The test for whether an element in the alleged infringer's product or process is equivalent to a claimed element is **whether the difference between the two are insubstantial** to one of ordinary skill in the art

See, e.g., *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1517 (Fed. Cir. 1995); aff'd sub nom. *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997)



## Infringement under the DOE (cont.)

- One way to determine whether the accused element and the claim element are substantially the same is the **function-way-result test**

*Zelinski v. Brunswick Corp.*, 185 F.3d 1311, 1316-1317 (Fed. Cir. 1999)

- Does the accused element perform substantially the same function in substantially the same way to obtain substantially the same result as the claim element?



## Infringement under the DOE (cont.)

- In addition to this “function-way-result” analysis, courts consider whether one skilled in the art would know of **the interchangeability of the claimed element** with the accused product’s substituted element

*Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1480 (Fed. Cir. 1998)



## Limitations on DOE

- Prosecution History Estoppel
- Disclosure-Dedication Rule



## Disclosure-Dedication Rule

- ***The Toro Company v. White Consolidated Industries, Inc.*, 383 F.3d 1326 (Fed. Cir. 2004)**

- **Procedural History**

- Toro sued White for infringement of USP 4,694,528 directed to a “convertible vacuum-blower” for vacuuming and blowing leaves and yard debris
- On second remand from CAFC, U.S. Dist. Ct. (Minnesota) granted Summary Judgment of non-infringement under DOE
- Toro appealed



## Disclosure-Dedication Rule (cont.)

### • *The Toro Company v. White Consolidated Industries, Inc.*

#### • **FACTS**

- Dist. Ct construed claim 16 (only indep. claim) to cover only a “restriction ring ... permanently affixed to and included as part of the cover”
- Dist. Ct. noted that specification taught that having the ring 76 as part of the cover 50 is advantageous because the operator does not have to insert or remove a replaceable ring



## Disclosure-Dedication Rule (cont.)

### • *The Toro Company v. White Consolidated Industries, Inc.*

#### • **FACTS (cont.)**

- White's vacuum-blower included a restriction ring separate from, and replaceable within the cover
- White argued for non-infringement under DOE because the two piece cover/ring embodiment was disclosed, but not claimed (citing *Johnson & Johnston*, 285 F.3d 1046 (Fed. Cir. 2002) (*en banc*))



## Disclosure-Dedication Rule (cont.)

- ***The Toro Company v. White Consolidated Industries, Inc.***

- **HOLDING**

- CAFC affirmed non-infringement under DOE because patentee failed to claim a feature disclosed in specification and found in accused product ⇒ feature dedicated to public



## Disclosure-Dedication Rule (cont.)

- *The Toro Company v. White Consolidated Industries, Inc.*

- **RATIONALE**

- Disclosure-dedication rule limits DOE in same way as prosecution history estoppel (both preclude DOE based on actions of patentee)
- Johnson & Johnson Rule: if patentee discloses, but does not claim, subject matter, unclaimed subject matter is dedicated to public and cannot be captured with DOE



## Disclosure-Dedication Rule (cont.)

- *The Toro Company v. White Consolidated Industries, Inc.*

- **RATIONALE – INTENT NOT REQUIRED**

- Toro argued that disclosure and failure to claim a cover with a replaceable ring was unintentional and disclosure-dedication rule does not apply
- CAFC confirmed that intent is NOT a part of the disclosure-dedication rule, as clearly set forth in J & J. (“intent is irrelevant”)



## Disclosure-Dedication Rule (cont.)

- *The Toro Company v. White Consolidated Industries, Inc.*

- **RATIONALE – LEVEL OF DISCLOSURE**

- Toro also argued that the level of disclosure required to trigger the disclosure-dedication rule is same as 35 U.S.C. 112, ¶1
- Toro argued that only portion of spec. that discloses White's separate cover/ring is "without having the operator manually insert or remove a replaceable ring"
- CAFC held that 35 U.S.C. 112, ¶1 only applies to claims; if one skilled in the art can identify disclosed & unclaimed subject matter, then subject matter is dedicated to public



## Disclosure-Dedication Rule (cont.)

- *The Toro Company v. White Consolidated Industries, Inc.*

- **LESSONS LEARNED**

- Always claim all disclosed embodiments – no intent required to trigger disclosure-dedication rule
- Even if an alternative is only briefly mentioned, CLAIM IT (but, make sure that 35 U.S.C. § 112, ¶1 is satisfied to support claim)



## Prosecution History Estoppel

- **Amendments** made during the prosecution of the application may limit the scope of equivalents that can be asserted by the patent holder

*Wang Lab., Inc. v. Mitsubishi Elecs. Am., Inc.*, 103 F.3d 1571, 1578 (Fed. Cir. 1997), cert. denied, 118 S.Ct. 69 (1997)

- Prosecution history estoppel may also arise from the patentee's **arguments, assertions, and explanations** made to the Examiner during the course of prosecution of the patent

See, e.g., Chisum, Patents, 18.05[2][c][ii]; *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448, 1460, 46 USPQ2d 1169, 1178 (Fed. Cir. 1998) (*en banc*)



## Prosecution History Estoppel (cont.)

**Q: Can the estoppel be applied to all amendments? No**

- Estoppel can be applied only to the amendments that:
  1. narrow the scope of the original claim **and**
  2. are related to patentability.

*Warner-Jenkins* Presumption



## Prosecution History Estoppel (cont.)

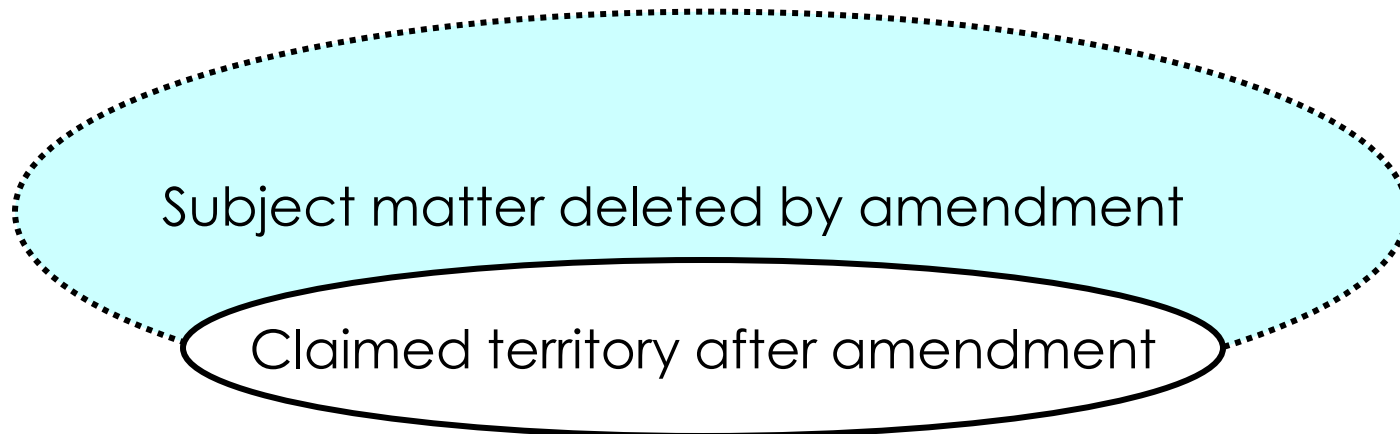
### ***Warner-Jenkinson Co. v. Hilton Davis Chemical Co., 117 S. Ct. 1040 (1996)***

- Narrowing amendments to claims made during prosecution are presumed to be related to patentability
- This presumption can be rebutted if the amendment was not made for a reason related to patentability
- The patentee bears the burden of proof



## Prosecution History Estoppel (cont.)

**Q: Can a patentee allege that the claim scope surrendered by a narrowing amendment during the prosecution is an equivalent to the scope of the amended claim?**



⇒ Complete bar approach vs. Flexible bar approach



## Prosecution History Estoppel (cont.)

***Festo Corp. v. Shoketsu Kinzoku, 234 F.3d 558 (Fed. Cir. 2000) (Festo VI) adopted complete bar approach***

- The doctrine of equivalents protection is not available if the prosecution history shows that a claim was narrowed for **any reason related to any aspect of the requirements for patentability**
- Those reasons were not limited to changes made to establish patentability over prior art



## Prosecution History Estoppel (cont.)

### ***Festo Corp. v. Shoketsu Kinzoku, 535 U.S. 722 (2002), vacating the Federal Circuit's decision, adopted flexible bar approach (Festo VIII)***

- A narrowing amendment is presumed to disclaim the territory between the original claim and the amended claim
- This presumption can be rebutted
- Patentee bears a burden of proof



## Prosecution History Estoppel (cont.)

- **The presumption can be rebutted where:**

- The equivalent was unforeseeable at the time of the application
- The amendment bears no more than a tangential relation to the equivalent; or
- There was some other reason why the patentee could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent



## Prosecution History Estoppel (cont.)

***Festo Corp. v. Shoketsu Kinzoku, 344 F.3d 1359 (Fed. Cir. 2003) provided general guidance regarding the rebuttal criteria*** (Festo X)

- Unforeseeability: Extrinsic evidence allowed
- Tangentialness: Extrinsic evidence not allowed
- Some other Reason: Limited to the prosecution history record. But leave open the possibility whether evidence outside the prosecution history, if any, should be considered



## Prosecution History Estoppel (cont.)

***Festo Corp. v. Shoketsu Kinzoku, Appeal No. 05-1492 (Fed. Cir. July 5, 2007)***  
***determined what is meant by “Unforeseeability” (Festo XIII)***

- Festo claimed the accused structure must have been foreseeable **as an equivalent** (function/way/result) at time of amendment
- Aluminum sleeve unknown to perform magnetic shielding function at time of amendment
- Court: Not necessary to be foreseeable as equivalent
- Non-magnetizable sleeve foreseeable under the broad claim before the amendment, PHE bars DOE



## Prosecution History Estoppel (cont.)

### ***Festo Corp. v. Shoketsu Kinzoku, Appeal No. 05-1492 (Fed. Cir. July 5, 2007)***

#### ***determined what is meant by “Unforeseeability”*** (Festo XIII)

- “An equivalent is foreseeable if one skilled in the art would have known that the alternative existed in the field of art as defined by the original claim scope, even if the suitability of the alternative for the particular purposes defined by the amended claim scope were unknown”
- Non-magnetizable sleeve known as available to perform the magnet-enclosing objectives of claim before amendment
- Judge Newman dissent: “foreseeable” should have been recognizable as equivalent at time of the amendment



## Timing of *Markman* Hearing-Trends

- Early *Markman* hearings are common in the following jurisdictions:
  - N.D. California
  - Delaware
  - Massachusetts
  - Southern District of New York
  - Northern District of Illinois
  - Ohio



## Timing of *Markman* Hearing

- No requirement dictated by law
- Generally, courts have held the *Markman* hearing near the end of discovery
- Often, a *Markman* hearing is combined with arguments on Summary Judgment motions
- However, there is a tendency for courts to hold the *Markman* hearing earlier to shape discovery and the case
- Claim construction often is determinative of the infringement question
- Early *Markman* doesn't work in Hatch-Waxman cases



## Northern District of California

- Northern District of California has adopted mandatory procedures for claim construction
- Initial Case Management Conference addresses:
  - date and time for Claim Construction hearing
  - whether the court will hear live testimony at hearing
  - need for specific limits on discovery relating to claim construction
  - order of presentation at hearing



## Claim Construction Proceedings (N.D. Cal.)

- Exchange of proposed Terms and Claim Elements for Construction
  - simultaneous exchange of lists of claim terms, phrases or clauses for construction by the court
  - meet and confer to finalize list
  - simultaneous exchange of preliminary proposed claim construction of each term identified by either party, along with identification of extrinsic evidence to support claim construction
  - prepare joint claim construction and prehearing statement
  - completion of claim construction discovery
  - claim construction briefs - opening brief by patentee with supporting evidence
    - The Eastern District of Texas has adopted a similar approach and schedule



## Collateral Effect of Claim Construction

- Issue preclusion, or collateral estoppel, bars relitigation of issues that were actually and necessarily determined in an earlier proceeding by a valid and final judgment.
- The determination must be essential to the judgment
- Collateral estoppel does not have to be mutual and, thus, can apply to parties who were not involved in the original litigation
- Collateral estoppel can be held against only those who were parties (or were in privity with those parties) in the prior litigation



Thank you!