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“CARDINAL SIN” – THE PROBLEM (PART I)  
IMPORTING LIMITATIONS IN CLAIM CONSTRUCTION

The “cardinal sin”<sup>1</sup> of claims construction is importing limitations from the specification into the claims. Yet, in virtually every claims construction battle, the alleged infringer is accused of sinning—usually grossly. Resolving the dispute becomes tedious and costly and requires knowledge of intricate and apparently contradictory “canons” of claims construction.

Understanding the context of the problem—and the court-developed ground rules—will set you free and prevent death by minutiae. This month, we review the problem and how it arises. Next month, we identify strategies to avoid or, if you must, cope with this “cardinal sin.”

Dueling Canons of Construction

Two well-recognized canons of claims construction are in play. The first says a claim must be read *in view* of the specification. The second prohibits a court from reading a limitation *into* a claim from the specification.<sup>2</sup>

As every patent litigator knows, courts limit claim terms based on the specification.<sup>3</sup> For example, the specification may contain a “special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess.”<sup>4</sup> Or “the specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor.”<sup>5</sup>

Depending on how your client fared when a trial court adopted a limited definition of a disputed claim term, the limitation was either entirely appropriate in light of the specification or an impermissible importation of a claim limitation.

Obviously, the antagonistic nature of these two axioms creates an “inherent tension”<sup>6</sup> in claims construction for virtually every case. Specifically, what is “reading in view of” vs. “importing from”?

While identifying the tension may be easy, distinguishing between the canons “can be . . .

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1 *Teleflex, Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313, 1324 (Fed. Cir. 2002).

2 *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1370 (Fed. Cir. 2008); see, e.g., *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005), *cert. denied*, 546 U.S. 1170 (2006); *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1117 (Fed. Cir. 2004) (citing *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 904-05 (Fed. Cir.), *cert. denied*, 543 U.S. 925 (2004)).

3 See, e.g., *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1254 (Fed. Cir. 2011) (clear intent to limit the term); *Alloc, Inc. v. ITC*, 342 F.3d 1361, 1370 (Fed. Cir. 2003) (clear from specification that claimed invention is narrower than the claim language) (citing *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1345 (Fed. Cir. 2001)), *cert. denied*, 541 U.S. 1063 (2004).

4 *Phillips*, 415 F.3d at 1316.

5 *Id.* See also *Voda v. Cordis Corp.*, 536 F.3d 1311, 1320 (Fed. Cir. 2008) (citing *Phillips*, 415 F.3d at 1316); *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366, 1374 (Fed. Cir. 2008) (citing *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1343 (Fed. Cir. 2001)).

6 *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 904-05 (Fed. Cir.), *cert. denied*, 543 U.S. 925 (2004).

Claims construction is designed to give the words of the claim the ordinary and customary meaning they would have to a person of ordinary skill in the relevant art at the time of the invention

A two-step process determines infringement. First, the meaning and scope of the relevant claims must be ascertained. Second, the properly construed claims must be compared to the accused device.

The language of the claim frames—and ultimately resolves—all issues of claim interpretation.

difficult . . . to apply in practice<sup>7</sup> and frequently requires the parties and the trial court to walk a “fine line” between reading a claim with the specification as a guide and improperly importing a limitation into the claim.<sup>8</sup>

### The Object of Claims Construction

Claims construction is designed to give the words of the claim the ordinary and customary meaning they would have to a person of ordinary skill in the relevant art at the time of the invention (*i.e.*, the application’s filing date).<sup>9</sup>

Generally, the Federal Circuit indulges in a “heavy presumption” that a claim term carries its ordinary and customary meaning.<sup>10</sup> In other words, claim construction is a straight-forward exercise in interpretation, without flourishes or “creative” definitions.

### Claim Language Is Definitive

As a threshold matter, “the name of the game is the claim.”<sup>11</sup> “It is a ‘bedrock principle’ of patent law that ‘the claims of a patent define the invention to which the patentee is entitled the right to exclude.’”<sup>12</sup> They are the “sole measure of the [patent] grant.”<sup>13</sup>

A two-step process determines infringement. First, the meaning and scope of the relevant claims must be ascertained. Second, the properly construed claims must be compared to the accused device.<sup>14</sup> Not surprisingly, deciding what the claims mean is “nearly always to decide the case.”<sup>15</sup>

### Claim Language Is Paramount

When deciphering the ordinary and customary meaning of disputed terms in a claim, “[t]he claim language itself defines the scope of the claim.”<sup>16</sup> The language of the claim frames—and ultimately resolves—all issues of claim interpretation.<sup>17</sup> Given this, claims are “of primary importance, in the effort to ascertain precisely what it is that is patented,”<sup>18</sup> and the “actual words of the claim are the controlling focus” of the claims construction inquiry.<sup>19</sup>

7 *Voda*, 536 F.3d at 1320 (citing *Phillips*, 415 F.3d at 1323).

8 *Arlington Indus., Inc.*, 632 F.3d at 1255; *see, e.g., Kyocera Wireless Corp. v. ITC*, 545 F.3d 1340, 1347 (Fed. Cir. 2008); *Decisioning.com, Inc. v. Federated Dep’t Stores, Inc.*, 527 F.3d 1300, 1307-08 (Fed. Cir. 2008); *Phillips*, 415 F.3d at 1323; *Comark Commc’ns, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir. 1998) (citation omitted).

9 *See, e.g., Phillips*, 415 F.3d at 1312-13.

10 *Sunrace Roots Enter. Co., Ltd. v. SRAM Corp.*, 336 F.3d 1298, 1302 (Fed. Cir. 2003) (citation omitted); *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002) (citation omitted).

11 *Arlington Indus., Inc.*, 632 F.3d at 1255 n.2 (citing Giles S. Rich, *The Extent of the Protection and Interpretation of Claims—American Perspectives*, 21 *Int’l Rev. Indus. Prop. & Copyright L.*, 497, 499, 501 (1990)).

12 *Phillips*, 415 F.3d at 1312 (citing *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004)); *see, e.g., Netcraft Corp. v. eBay, Inc.*, 549 F.3d 1394, 1396 (Fed. Cir. 2008).

13 *Innova/Pure Water, Inc.*, 381 F.3d at 1115 (citing *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 339 (1961)).

14 *Innova/Pure Water, Inc.*, 381 F.3d at 1115 (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370 (1996)).

15 *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1552 (Fed. Cir. 1997) (citing *Markman*, 52 F.3d at 689) (Mayer, J. concurring)).

16 *Eastman Kodak Co.*, 114 F.3d at 1552 (citation omitted); *see, e.g., Innova/Pure Water, Inc.*, 381 F.3d at 1115; *Vitronics Corp. v. Conception, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

17 *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1324 (Fed. Cir. 2002) (citation omitted).

18 *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005), *cert. denied*, 546 U.S. 1170 (2006) (citation omitted).

19 *Digital Biometrics, Inc. v. Indentix, Inc.*, 149 F.3d 1335, 1344 (Fed. Cir. 1998); *see Innova/Pure Water, Inc.*, 381 F.3d at 1116.

Courts “look primarily to the intrinsic evidence of record, examining the claim language, the written description, and the prosecution history.”

“Intrinsic evidence” is the public record of the patentee’s claim on which the public is entitled to rely. “In other words, competitors are entitled to review the public record, apply the established rules of claim construction, ascertain the scope of the patentee’s claimed invention and, thus, design around the claimed invention.”

Against this backdrop, it is obvious to begin the claim construction analysis with the words of the claim.<sup>20</sup>

Some cases are easy, and “the ordinary meaning of claim language as understood by a person of skill in the art may be readily apparent even to lay judges, . . .”<sup>21</sup> But, unfortunately, many cases require the trial court to examine terms that have a particular meaning in the relevant field of art.<sup>22</sup>

### Claims Must Be Read in Context

To fully understand the meaning of a claim, the trial court must review not just the language of the claim in which the disputed term appears, but also the context of the entire patent, including the specification.<sup>23</sup> Courts “look primarily to the intrinsic evidence of record, examining the claim language, the written description, and the prosecution history.”<sup>24</sup>

“Intrinsic evidence” is the public record of the patentee’s claim on which the public is entitled to rely. “In other words, competitors are entitled to review the public record, apply the established rules of claim construction, ascertain the scope of the patentee’s claimed invention and, thus, design around the claimed invention.”<sup>25</sup> Understandably, the Federal Circuit has specifically stated, “Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language.”<sup>26</sup>

### Claims Must Be Read in Light of Specification

Even if the claim language seems clear on its face, the trial court must consult the specification to determine if the patentee redefined any of the disputed terms.<sup>27</sup> Thus, “Claims **must** be read in view of the specification, of which they are a part.”<sup>28</sup>

The requirements for the patent specification are described in 35 U.S.C. § 112 para. 1 and include the written description, the best mode for carrying out the invention and the claims.<sup>29</sup>

The specification teaches about the problems solved by the claimed invention, the way the claimed invention solves those problems, and the prior art that relates to the invention and thus provides valuable context for understanding the claims.<sup>30</sup> Simply put, “Specifications teach. Claims claim.”<sup>31</sup> As a result, the Federal Circuit has famously concluded, “[T]he specification is always highly relevant to the claim construction analysis. Usually it is dispositive; it is the single best guide to the meaning of a disputed term.”<sup>32</sup>

20 *Teleflex, Inc.*, 299 F.3d at 1324.

21 *Phillips*, 415 F.3d at 1314 (citation omitted).

22 *Id.*

23 *Netcraft Corp. v. eBay, Inc.*, 549 F.3d 1394 (Fed. Cir. 2008) (citing *Phillips*, 415 F.3d at 1313).

24 *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1370 (Fed. Cir. 2008) (citing *Phillips*, 415 F.3d at 1312).

25 *Vitronics Corp.*, 90 F.3d at 1583.

26 *Id.*

27 *Watts v. XL Systems, Inc.*, 232 F.3d 877, 883 (Fed. Cir. 2001).

28 *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (emphasis added).

29 *See id.*

30 *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1554 (Fed. Cir. 1997).

31 *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 n.14 (Fed. Cir. 1985); *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344 (Fed. Cir. 2001).

32 *Vitronics Corp. v. Conception, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (“reaffirmed” by *Phillips*, 415 F.3d at 1312).

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Vol. III, No.9

SEPTEMBER 2011

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### Cannot Import Limitations from the Specification<sup>33</sup>

The Federal Circuit “will not countenance the importation of claim limitations from a few specific statements or figures into the claims.”<sup>34</sup> Thus, the specification does not delimit the right to exclude, but claims do.<sup>35</sup>

The rationale for this rule is clear. As the U.S. Supreme Court said in the 19<sup>th</sup> century, “The difficulty is that, if we once begin to include elements not mentioned in the claim, in order to limit such claim, . . . we should never know where to stop.”<sup>36</sup> Or, as the Federal Circuit said more recently:

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.”<sup>37</sup>

### Broad Claims with Narrow Written Descriptions Cause Problems

Trial courts and litigants struggle with interpreting claims in light of the specification *without importing* limitations.<sup>38</sup> This challenge becomes acute when the written description of the invention in the specification is narrow, but the claim language is sufficiently broad that it can be read to encompass features not described in the written description.<sup>39</sup>

When faced with this situation during the claims construction process, the accused infringer cries “foul” and argues that the patentee is unfairly expanding the appropriate scope of claim coverage. In response, the patent owner says the infringer is committing a cardinal sin by importing limitations from the specification.

Adding fuel to this smoldering fire, Federal Circuit caselaw “allows for after-arising technology to be captured within the literal scope of valid claims that are drafted broadly enough.”<sup>40</sup> And, occasionally, a patent specification may lead one of ordinary skill in the art to interpret a claim more narrowly than the plain meaning suggests.<sup>41</sup> Despite this, courts cannot simply import claim limitations from the specification.<sup>42</sup>

### Next Month . . . “Cardinal Sin” – The Solution (Part II)

Understanding the context of this conundrum is the key to finding workable solutions. Next month, we examine solutions from both sides of the “v.”

33 Claims written in a means-plus-function format under 35 U.S.C. §112 para. 6 receive different treatment and are not discussed here. See *Watts v. XL Sys., Inc.*, 232 F.3d 877, 881 (Fed. Cir. 2001).

34 *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366, 1374 (Fed. Cir. 2008).

35 *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995).

36 *McCarty v. Lehigh Valley R.R. Co.*, 160 U.S. 110, 116 (1895).

37 *SRI Int'l*, 775 F.2d at 1121.

38 *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 904-05 (Fed. Cir. 2004).

39 *Id.* at 905.

40 *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1371-72 (Fed. Cir. 2008) (citation omitted).

41 *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366, 1374 (Fed. Cir. 2008).

42 *Id.*