

Table of Contents

CHAPTER 1. AN INTRODUCTION TO, PREMISES OF, AND PROBLEMS WITH PATENT CLAIM CONSTRUCTION

- § 1:1 Claim construction for courts
- § 1:2 Claim construction for all
- § 1:3 The purpose, history, and objective nature of patent claim construction
- § 1:4 The substance and form of utility patent claims
- § 1:5 Additional considerations that complicate patent claim construction
- § 1:6 The current procedures for patent claim construction
- § 1:7 The current (Phillips) “method” for performing claim construction
- § 1:8 The current “rules” for performing claim construction
- § 1:9 Conclusion

CHAPTER 2. OVERVIEW OF CLAIM CONSTRUCTION PRINCIPLES

I. SUBSTANTIVE INTRODUCTION

- § 2:1 Claim construction defined
- § 2:2 The problematic nature of claim construction
- § 2:3 When claim construction is required
- § 2:4 When claim construction is not required
- § 2:5 Relationship of indefiniteness to claim construction
- § 2:6 Use of public record
- § 2:7 Overview from *Phillips (en banc)*

II. INTRINSIC EVIDENCE

- § 2:8 Preference for intrinsic evidence
- § 2:9 What constitutes intrinsic evidence
- § 2:10 Cases regarding intrinsic evidence—Generally

III. PLAIN MEANING

- § 2:11 Determining the plain (ordinary and customary) meaning

- § 2:12 When the plain meaning is not supported by the written description
- § 2:13 The heavy presumption of ordinary and customary meaning
- § 2:14 Changing the plain meaning
- § 2:15 Patentee as lexicographer

IV. REFERENCE DATE FOR DETERMINING THE CLAIM MEANING

- § 2:16 Conflict resolved in *Phillips*
- § 2:17 Time-dependent terms

V. CONTEXT

- § 2:18 Types of context
- § 2:19 Context of the accused product

VI. TYPES OF PATENT CLAIMS

- § 2:20 Method claims
- § 2:21 Product claims and method limitations
- § 2:22 Product-by-process claims
- § 2:23 Product claims
- § 2:24 Claims in mixed classes of subject matter
- § 2:25 Dependent/independent claims

VII. FOCUS REMAINS ON CLAIM LANGUAGE

- § 2:26 Analytical focus
- § 2:27 A meaning for each word
- § 2:28 Different meanings for different words
- § 2:29 Same meaning for same words (rule of internal consistency)
- § 2:30 Ambiguity and non-ambiguity of claims
- § 2:31 Absurd or nonsensical results
- § 2:32 Claim construction and errors in patents

VIII. OTHER BASES FOR CLAIM CONSTRUCTION

- § 2:33 Impact of PTO examiner constructions on subsequent constructions
- § 2:34 Information disclosure statements
- § 2:35 Continuation-in-part prosecutions

IX. THE ORDINARILY SKILLED ARTISAN

- § 2:36 Historical emphasis

TABLE OF CONTENTS

- § 2:37 Discussion in *Phillips (en banc)*
- § 2:38 Current cases regarding the ordinarily skilled artisan and claim construction

X. INTERPRETING CLAIMS TO SUSTAIN VALIDITY

- § 2:39 General rule against “validity construction”

XI. CONSTRUCTION OF CLAIMS IN THE PATENT AND TRADEMARK OFFICE

- § 2:40 PTAB trials and PTO rule for construction of claims

XII. MISCELLANEOUS

- § 2:41 Printed matter limitations

CHAPTER 3. CLAIM LANGUAGE AND OTHER EVIDENCE

I. PARTS OF THE CLAIM

- § 3:1 Preambles—Historical rule
- § 3:2 Case regarding preambles
- § 3:3 Transition terms—“comprising” and “comprises”
- § 3:4 —“Comprised of”
- § 3:5 —Jepson type: “wherein the improvement comprises”
- § 3:6 —“Consisting essentially of”
- § 3:7 —“Consisting of”
- § 3:8 —Markush groups: “selected from the group consisting of”
- § 3:9 —“Containing”
- § 3:10 —“Having,” “including” or “includes”
- § 3:11 —“Comprising the steps of”
- § 3:12 Use of past participle implies sequence
- § 3:13 Optional (permissive) terms
- § 3:14 Comparative or functional terms
- § 3:15 Alternate terms
- § 3:16 —Distinctness of claim elements (common components)
- § 3:17 —Direct or indirect causation
- § 3:18 Negative limitations
- § 3:19 “Whereby” clauses

II. CLAIM DIFFERENTIATION

- § 3:20 Historical rule and claim differentiation in *Phillips*

- § 3:21 Claim differentiation—Applied
- § 3:22 —Rebutted

III. WRITTEN DESCRIPTION

- § 3:23 Historical background
- § 3:24 General applications
- § 3:25 Written description—Broad interpretation cases
- § 3:26 —Narrow interpretation cases
- § 3:27 —Disclaimers or disavowals
- § 3:28 Reliance upon familial patent specification
- § 3:29 Specification describes the whole invention
- § 3:30 No importation of specification details to avoid
invalidity over prior art
- § 3:31 Advantages and purposes of the invention
- § 3:32 Claiming or excluding the disclosed embodiment
- § 3:33 Cases embracing the preferred embodiment
- § 3:34 Cases excluding the preferred embodiment
- § 3:35 Concordance
- § 3:36 Miscellaneous

IV. PROSECUTION HISTORY

- § 3:37 Discussion in *Phillips*
- § 3:38 Statements by the inventor or representative
- § 3:39 Limiting cases (prosecution disclaimers)
- § 3:40 Nonlimiting cases
- § 3:41 Broadening cases
- § 3:42 Nonbroadening cases
- § 3:43 Statements by the PTO examiner
- § 3:44 Statements in related patent prosecutions
- § 3:45 Miscellaneous prosecution events

V. EXTRINSIC EVIDENCE

- § 3:46 Extrinsic evidence defined
- § 3:47 Development of heavy reliance on dictionaries and
other technical resources
- § 3:48 *Phillips* discussion of dictionaries
- § 3:49 Cases regarding use of dictionaries
- § 3:50 Dictionaries and “means-plus-function” claims
- § 3:51 Extrinsic evidence: other reference works
- § 3:52 Extrinsic evidence: subjective intent and inventor
testimony
- § 3:53 Expert testimony—Generally
- § 3:54 Post-*Markman* development of subjective intent and
expert testimony

TABLE OF CONTENTS

- § 3:55 Expert testimony—Current cases
- § 3:56 Technology tutorials
- § 3:57 Court—appointed experts, technical advisors, and other extrinsic evidence

VI. SECTION 112(F) (FORMERLY SECTION 112, PARAGRAPH 6)

- § 3:58 Statutory framework: “means-plus-function” claims
- § 3:59 Determining whether § 112, ¶ 6 (§ 112(f)) applies
- § 3:60 Whether § 112(f) applies when “means” is not recited in the claim
- § 3:61 Cases when “means” is recited in the claim
- § 3:62 Methodology: when § 112, ¶ 6 (§ 112(f)) applies
- § 3:63 Methodology: determining the claimed function
- § 3:64 Determining the corresponding structure
- § 3:65 Step-plus-function

CHAPTER 4. DESIGN PATENTS

- § 4:1 Statutory framework and characteristics of design patents
- § 4:2 Construction of the design patent claim
- § 4:3 Exception to claim construction requirement
- § 4:4 Limitation on claim scope: functionality doctrine
- § 4:5 Miscellaneous aspects of design patent claim scope

CHAPTER 5. CLAIM INDEFINITENESS

- § 5:1 Statutory framework and background of indefiniteness
- § 5:2 Standards for finding indefiniteness
- § 5:3 Cases finding no indefiniteness
- § 5:4 Cases finding claims indefinite

CHAPTER 6. PROCEDURE AND TIMING

- § 6:1 Duty of litigants regarding claim construction
- § 6:2 Duty of attorneys regarding claim construction
- § 6:3 Duty of courts regarding claim construction
- § 6:4 Masters and magistrates may perform claim constructions
- § 6:5 Hearings not required
- § 6:6 Timing of claim constructions
- § 6:7 “Rolling claim constructions” authorized
- § 6:8 Local procedural rules regarding claim constructions
- § 6:9 Form of claim construction rulings
- § 6:10 Propriety of summary judgment

PATENT CLAIM CONSTRUCTION IN THE FEDERAL CIRCUIT

- § 6:11 Jury issues
- § 6:12 Estoppel issues at the district court
- § 6:13 Estoppel issues—Other
- § 6:14 Jurisdiction—District courts
- § 6:15 —Federal Circuit
- § 6:16 The standard of review
- § 6:17 Scope of review—Generally
- § 6:18 Scope of review:—PTAB decisions
- § 6:19 Scope of review: waiver issues—Generally
- § 6:20 —Futile objection rule
- § 6:21 Estoppel on appeal
- § 6:22 Cross appeals concerning claim interpretation
- § 6:23 Other issues regarding scope
- § 6:24 Interlocutory appeals
- § 6:25 Prior (or other) adjudications
- § 6:26 Law of the case
- § 6:27 Proceedings on remand
- § 6:28 Miscellaneous procedural
- § 6:29 Potential claim construction issues affecting transfer of venue
- § 6:30 Relationship of claim construction to joinder, consolidation, and MDL proceedings
- § 6:31 Stipulations

CHAPTER 7. GLOSSARY—COMMON ARTICLES, PRONOUNS & MODIFIERS

- § 7:1 Introduction
- § 7:2 Common articles and modifiers in the claim body

CHAPTER 8. CASE TABLES, CONCORDANCES & STATISTICAL DATA

- § 8:1 Summary judgments
- § 8:2 Opinion writers
- § 8:3 Topical index/concordance
- § 8:4 Topics addressed in current cases

Table of Cases