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Willkie Farr & Gallagher's *Federal Circuit Review* is a newsletter from the Intellectual Property Department on recent decisions by the Court of Appeals for the Federal Circuit. The *Federal Circuit Review* will present an annual synopsis of the most recent decisions on a particular aspect of the law, and what they mean for today's intellectual-property-focused businesses. This issue will present recent developments and highlights concerning the law on **claim construction**.

The claim construction process is often the single most critical factor in determining which side will win a patent case. But ever since *Markman*, courts and lawyers have wrestled with the proper way to construe the claims of a patent. With the Federal Circuit's 2005 *en banc* decision in *Phillips*, the Court set forth definitive guidance on the claim construction process, reaffirming that the specification was "the single best guide to the meaning of a disputed term."

Since *Phillips*, the Federal Circuit has focused on refining the claim construction principles outlined in *Markman* and *Phillips*. Over the past year, the Federal Circuit issued a noteworthy decision discussing whether simple claim language must be construed, and issued a series of interesting decisions addressing an unresolved tension in the framework set out in *Phillips*: construing claim language in light of the specification without improperly importing limitations into the ordinary meaning of the claims.

SIMPLE CLAIM LANGUAGE MUST BE CONSTRUED IF THERE IS A FUNDAMENTAL DISPUTE OVER THE SCOPE

Since *Markman*, courts have struggled to avoid construing every word in every asserted claim. The trend in years past was toward not requiring construction of terms with simple and clear meanings, as seen in *Biotec Biologische Naturverpackungen GmbH & Co. KG v. Biocorp, Inc.* ("the meaning of 'melting' does not appear to have required 'construction,' or to depart from its ordinary meaning") and *Mentor H/S, Inc. v. Medical Device Alliance, Inc.* (where the jury was properly instructed to use ordinary meanings for "irrigating" and "frictional heat").

Last year, the Federal Circuit placed a limit on that doctrine. In *O2Micro Int'l Ltd. v. Beyond Innovation Tech., Co. Ltd.*, the Federal Circuit vacated a finding of willful infringement for failing to construe the claim term "only if."

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The asserted claim required that a feedback control loop circuit operate in a certain way “*only if* said feedback signal is above a predetermined threshold.” At the *Markman* hearing, the defendants proposed a construction while the plaintiff argued that no construction was necessary for “two simple, plain English words.” However, the infringement dispute concerned whether the “only if” language applied only during normal, steady state operation (as asserted by Plaintiffs), or at all times, including during start-up and during a delay period before the circuit changed operation (as asserted by Defendants). The district court determined that the term “needs no construction” because it “has a well-understood definition, capable of application by both the jury and this court in considering the evidence submitted in support of an infringement or invalidity case.” At trial, a jury found the claims willfully infringed.

On appeal, the Federal Circuit held that *Markman* required the court to construe the term “only if” because the “parties presented a dispute to the district court regarding the scope of the asserted claims,” which is a question of law. The court explained: “A determination that a claim term ‘needs no construction’ or has the ‘plain and ordinary meaning’ may be inadequate when a term has more than one ‘ordinary’ meaning or when reliance on a term’s ‘ordinary’ meaning does not resolve the parties’ dispute.”

Cases cited

O2Micro Int’l Ltd. v. Beyond Innovation Tech., Co. Ltd., 521 F.3d 1351 (Fed. Cir. 2008)

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

Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*)

Biotec Biologische Naturverpackungen GmbH & Co. KG v. Biocorp, Inc., 249 F.3d 1341 (Fed. Cir. 2001)

Mentor H/S, Inc. v. Medical Device Alliance, Inc., 244 F.3d 1365, 1380 (Fed. Cir. 2001)

DECISIONS IN WHICH THE SPECIFICATION TRUMPS THE ORDINARY MEANING

In keeping with the rationale of *Phillips*, many Federal Circuit decisions over the past year have relied heavily on the specification to interpret claims. Some restrict the scope of claims based on the disclosure, some broaden the scope to cover disclosed embodiments, and some use the specification to resolve ambiguities in claim language.

SPECIFICATION RESTRICTS SCOPE OF CLAIMS

In *The Chamberlain Group, Inc. v. Lear Corp.*, the Federal Circuit rejected the ordinary meaning construction of “binary code” in favor of a construction limited by the specification. The patent-in-suit is directed to signaling for garage door openers.

Based on the plain meaning of the term, the district court found that “binary code” is “a code in which each code element may be either of two distinct kinds of values, which code may represent various kinds of letters and numbers including, but not limited to, a representation of a base 2 number.” Thus, the binary-coded trinary numbers (i.e., base 3 number encoded as a base 2 number) used by the accused devices were within the claims as both binary code and trinary code. However, the court clarified on reconsideration that “‘binary code’ cannot encompass trinary code.”

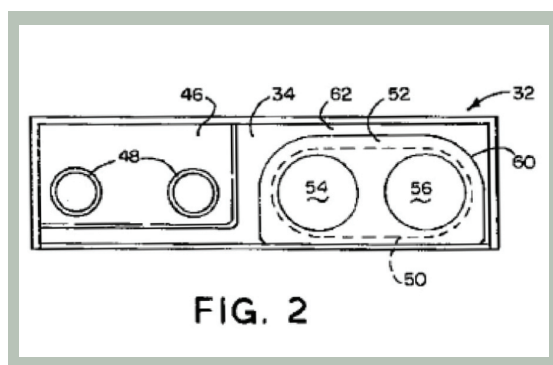
Reviewing the specification, the Federal Circuit agreed with the district court that “binary code” cannot encompass “trinary code,” but it held that the district court’s construction was inconsistent in finding that the “binary-coded trinary numbers” of the accused devices met both the “binary code” and “trinary code” elements of the claims. This is because the district court construed the term “code” inconsistently; when used in “binary code,” it encompassed the form (i.e., the 0s and 1s of binary language), but when used in “trinary code,” it encompassed the meaning or substance (i.e., the three valued or trinary bits described in the specification). Thus, “[t]o resolve this contradiction and preserve the independent meaning of ‘binary code’ as compared to ‘trinary code’ in the ‘544 patent, this court reads ‘binary code’ as limited to binary numbers, and ‘trinary code’ as limited to trinary numbers.”

Similarly, in *Board of Regents of the University of Texas System v. BENQ America Corp.*, the district court construed a “syllabic element” to mean “a one-syllable letter group that either comprises a word or can be combined with other one-syllable letter groups to form a word.” Patentee argued that this construction was improperly narrow, and should be broadened to include multisyllable words.

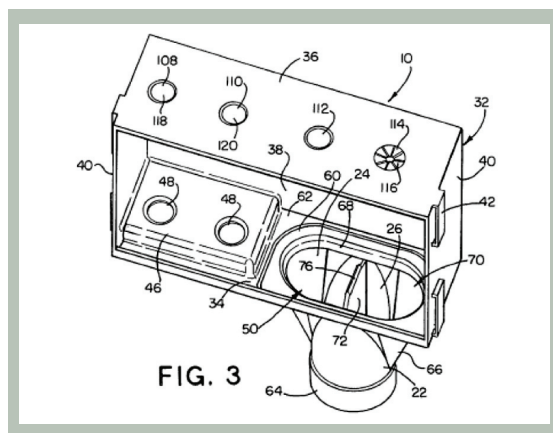
In this case, the claim language “by itself, provided little guidance” for construing the term “syllabic element.” However, the specification “repeatedly distinguishes between a ‘word’ and a ‘syllabic element,’” confirming that the terms “are not coextensive in scope.” The specification also provided an example of a “syllabic element,” which was a one-syllable letter group, and the definition was supported by the prosecution history. Thus, the Federal Circuit affirmed the district court’s construction.

EMBODIMENTS IN THE SPECIFICATION USED TO BROADEN CLAIMS

The disclosure of alternative embodiments served to broaden claim scope in *Oatey Co. v. IPS Corp.* The patent-in-suit was directed to a plumbing outlet box that minimizing the amount of welding required for installation. Claim 1 included the phrase: “*first and second juxtaposed drain ports in said bottom wall.*” The district court construed this to mean “two separate identifiable physical elements that are adjacent or near each other.” As part of this construction, the district court required “that there be two separate physical openings [54,56] in the bottom wall of the outlet box” exemplified in the top-down view of Fig. 2 (top right).



The court found that Claim 1 did *not* encompass the embodiment shown in Fig. 3 (bottom right), where the bottom wall of the outlet box had only a single opening, and a divider (72) in the tailpipe “formed” the two separate drain ports.



Based on this construction, the district court granted summary judgment of noninfringement.

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The Federal Circuit found that the construction should encompass the specification's preferred embodiments, including Fig. 3. "We normally do not interpret claim terms in a way that excludes embodiments disclosed in the specification." Thus, "[a]t least where claims can reasonably [be] interpreted to include a specific embodiment, it is incorrect to construe the claims to exclude the embodiment, absent probative evidence to the contrary." The Federal Circuit also found that "[t]here is no issue in this case of disclaimer or estoppel during prosecution," and rejected arguments that (1) the inclusion of Fig. 3 in the scope of claim 1 would encompass the prior art, and (2) other claims required the scope of claim 1 to be restricted to exclude the Fig. 3 embodiment. Accordingly, it concluded that "the embodiment of Figure 3 was improperly excluded from the scope of claim 1" and vacated and remanded the summary judgment noninfringement.

In *PSN Illinois, LLC v. Ivoclar Vivadent, Inc.*, the Federal Circuit looked to the entire specification to limit the ordinary meaning of the claims. The patent-in-suit concerned a method of fabricating porcelain tooth veneers by forming the veneer on a "statue" or model, and then removing the statue before fitting the veneer to a patient's tooth. The district court construed the claim phrase "ready for mounting" as excluding subsequent finishing steps such as "beveling, shaping and glazing" after the veneer was removed from the statue.

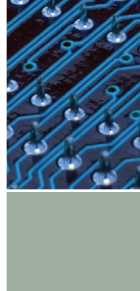
There was no explicit definition for "ready for mounting" in the specification. The description of the preferred embodiment "teaches that finishing steps may be performed while the veneer is still on the statue," but the summary of the invention "teaches that some finishing steps may be performed after the statue is eroded."

The Federal Circuit found "that the district court was incorrect in holding that the description of a preferred embodiment had more bite than the description in the summary of the invention." Rather, both teachings of the specification should have been incorporated, which "would neither exclude nor ignore the preferred embodiment." The Federal Circuit thus construed "ready for mounting" to mean "substantially fabricated such that only final finishing and fitting operations need be performed prior to mounting the veneer on a patient's tooth for which it was custom-made."

SPECIFICATION RESOLVES AMBIGUITY IN CLAIMS

In some cases, the Federal Circuit used the specification to create functional limitations for ambiguous or precise claim language. In *Praxair, Inc. v. ATMI, Inc.*, the district court construed the claim term "flow restrictor" to require a structure that "serve[s] to restrict the rate of flow." The defendant argued on appeal that the claim term required "severe" flow restriction in order to meet the stated goals of the invention.

Adopting its own functional construction, the Federal Circuit concluded that "the term ... requires a restriction of flow sufficient to prevent a hazardous situation." The Court found that "the specification teaches that the flow restriction must be sufficient to achieve the overall object of the invention — that is, to prevent a hazardous release of gas." The court found this requirement to be more than just an element of a preferred embodiment: "[t]he claims of the patent must be read in light of the specification's consistent emphasis on this fundamental feature of the invention."



In contrast, the Court dismissed limitations described in the specification in construing another claim term, “capillary.” The district court construed the term not to require uniformity. The Federal Circuit agreed. Even though multiple parts of the specification described the capillaries as uniform, and “uniform capillary passages” was “one object of the invention,” the Federal Circuit found that “these parts of the specification are not properly construed as limiting the meaning of the claim language.” The Federal Circuit noted that “a number of express statements in the [] specification clearly indicat[e] that uniformity of the capillary tubes is a feature only of certain embodiments, and not of all embodiments.” The Federal Circuit also applied claim differentiation by noting that a dependent claim added the uniformity requirement to the independent claim.

In *Cohesive Techs., Inc. v. Waters Corp.*, the Federal Circuit used the intended function of the invention to interpret the claim language. The patents-in-suit are directed to high-performance liquid chromatography columns. The asserted claims included limitations that the particles in the column have average diameters “greater than about 30 μm ,” while the accused product had particles with an average diameter of 29.01 μm . The district court entered summary judgment of noninfringement and simply construed “greater than about 30 μm ” to exclude 29.01 μm .”

Citing its precedent that the word “about” must be given weight, the Federal Circuit looked to the specification for guidance in defining the range of the “about 30 μm ” limitation. The specification taught that particles have a variance in size of 15.22 percent. The Federal Circuit applied this 15.22 percent variance to 30 μm to define 25.434 μm as the threshold that the patent discloses is sufficiently large to practice the invention. The court also applied this variance to the 20 μm size particles (which the specification identified as too small) to create a lower bound of 23.44 μm that the specification expressly teaches does not create the turbulence necessary for the invention.

This, however, left a gap between 23.44 μm and 25.434 μm that the specification did not address. The Federal Circuit decided, therefore, that it was proper to include a functional limitation to the construction: “we conclude that the proper construction of ‘greater than about 30 μm ’ [in the claim] is: either (1) greater than 25.434 μm , or (2) *both* greater than 23.044 μm *and* of sufficiently large size to assure that the column is capable of attaining turbulence.” The court stated that this “functional approach is necessary and appropriate, because the deliberate imprecision inherent in the word ‘about’ makes it impossible to ‘capture the essence’ of the claimed invention in strict numeric terms.”

Cases cited

The Chamberlain Group, Inc. v. Lear Corp., 516 F.3d 1331 (Fed. Cir. 2008)

Board of Regents of the University of Texas System v. BENQ America Corp., 533 F.3d 1362 (Fed. Cir. 2008)

Oatey Co. v. IPS Corp., 514 F.3d 1271 (Fed. Cir. 2008)

PSN Illinois, LLC v. Ivoclar Vivadent, Inc., 525 F.3d 1159 (Fed. Cir. 2008)

Praxair, Inc. v. ATMI, Inc., 543 F.3d 1306 (Fed. Cir. 2008)

Cohesive Techs., Inc. v. Waters Corp., 543 F.3d 1351 (Fed. Cir. 2008)

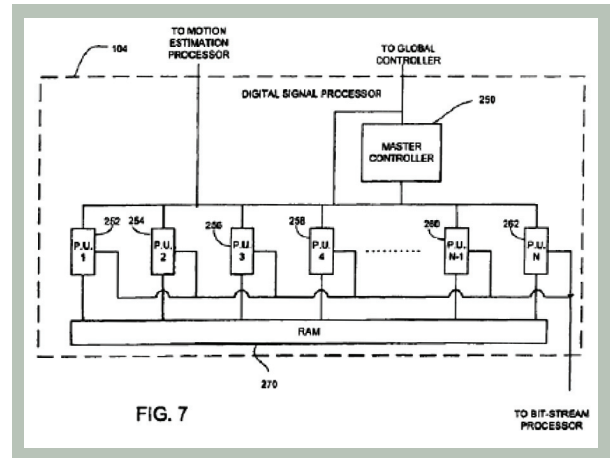
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DECISIONS IN WHICH THE ORDINARY MEANING TRUMPS THE SPECIFICATION

There were several cases in 2008 in which the Federal Circuit relied primarily on the ordinary meaning of the claim language to construe the claim terms, despite efforts to import either limitations (by accused infringers) or additional breadth (by patentee) from the specification.

LIMITATIONS FROM SPECIFICATION REJECTED

In *Broadcom Corp. v. Qualcomm Inc.*, the Federal Circuit rejected the district court’s construction of the claim term “DSP controller controlling said plurality of processing units” as improperly importing a limitation — a global controller — from the specification. The Federal Circuit reviewed the description and figures in the specification, and determined that the DSP need not include a global controller. For example, Fig. 7 (right) shows the global controller to be outside the dotted line depicting the DSP.



The specification describes how the global controller controls the DSP in the broader invention. However, according to the Court, “[t]here is no basis for importing the ‘global controller’ limitation into claim 1” because the claim is directed at a particular feature of the invention (the DSP) instead of the whole. Thus, the Federal Circuit removed the “global controller” limitation from the construction of “DSP controller.”

In *Helmsderfer v. Bobrick Washroom Equip., Inc.*, the Federal Circuit found the claim language itself controlling when construing the term “partially hidden from view” to exclude “totally hidden from view.” The Federal Circuit defended the district court’s reliance on extrinsic instead of intrinsic evidence because the term “partially hidden from view” was never used in the specification. “When the intrinsic evidence is silent as to the plain meaning of a term, it is entirely appropriate for the district court to look to dictionaries or other extrinsic sources for context — to aid in arriving at the plain meaning of a claim term.” It agreed that “there is only one ordinary meaning attributable to the word ‘partially’ and this meaning does not include ‘totally.’” In response to patentee’s argument that the construction excluded all of the illustrated embodiments from the scope of the asserted claims, the Federal Circuit noted that other unasserted claims might cover the disclosed embodiments, and that it was not for courts to “rewrite claim language.”

The Federal Circuit’s decision in *Howmedica Osteonics Corp. v. Wright Medical Tech., Inc.*, may be the most extreme recent example of ordinary meaning trumping the disclosure in the specification. The *Howmedica* decision interpreted a claim directed to a knee prosthesis having “at least one condylar element,” with “the condylar element” having specific geometrical limitations. The district court required that each condylar element in a prosthetic must meet the recited geometric limitations. Every embodiment disclosed in the specification showed both condyles meeting the geometric

requirements, and extrinsic evidence showed that the patent attorney, the examiner, and the inventor all contemplated that same claim scope.

The Federal Circuit reversed this “close case,” holding that the plain language of the claim required that only one of the condylar elements meet the geometric limitations. “If the patentee had intended both condyles in a bicondylar prosthesis to meet these limitations, he could have drafted [the claim] to require that ‘both condylar elements’ do so.” In particular, the Federal Circuit noted that the claim could have been drafted to read “*each* condylar element” (instead of “*the* condylar element”).

BROADER CONSTRUCTION TO ENCOMPASS ALTERNATIVE EMBODIMENTS REJECTED

In *Tip Systems, LLC v. Phillips & Brooks/Gladwin, Inc.*, the Federal Circuit determined that the ordinary meaning of the claims did not encompass alternative embodiments described in the specification. The patents-at-issue are directed to cord-free telephones for use in correctional facilities. The district court construed phrases reciting that the earpiece and mouthpiece “permanently *extend out through* the front wall of the housing” and are “*extending outward* from said housing *through* said aural apertures” to mean “both the earpiece and mouthpiece ... project out from the front wall.”

On appeal, patentees argued that “by adopting a narrower definition of the claim term, the district court excluded the alternative embodiment, wherein neither the earpiece nor the mouthpiece project out from the front wall” relying in part on an alternative embodiment in the specification showing flush earpiece and mouthpiece:

aural communication to earpiece 28 and mouthpiece 30 is afforded through a sound transparent section of housing front wall 20, such as a plurality of small holes

The Federal Circuit rejected the argument, stating that “[t]he most natural reading of the claim language,” that the earpiece and mouthpiece project out from the wall of the housing, was supported by embodiments in the specification and the figures of both patents. “[T]o construe the claim term to encompass the alternative embodiment in this case would contradict the language of the claims. Indeed, read in the context of the specification, the claims of the patent need not encompass all disclosed embodiments.”

The Federal Circuit similarly rejected patentee’s reliance on an alternative embodiment to expand the scope of a second claim term, “said earpiece and said mouthpiece presenting an external *relief* surface...” The Federal Circuit rejected patentee’s proposed construction of the claim term encompassing “raised-surface, recessed-surface, and flush-surface earpiece and mouthpiece configurations, provided the user can identify and access the earpiece and mouthpiece,” finding that in order to “be read consistently with [another] claim term, the only reasonable interpretation of the phrase ... is that the earpiece and mouthpiece present a raised surface above the housing.”

Cases cited

Broadcom Corp. v. Qualcomm Inc., 543 F.3d 683 (Fed. Cir. 2008)
Helmsderfer v. Bobrick Washroom Equip., Inc., 527 F.3d 1379 (Fed. Cir. 2008)
Howmedica Osteonics Corp. v. Wright Medical Tech., Inc., 540 F.3d 1337 (Fed. Cir. 2008)
Tip Systems, LLC v. Phillips & Brooks/Gladwin, Inc., 529 F.3d 1364 (Fed. Cir. 2008)

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