

PATENT LAW

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CLASS 9

Prosecution pt. 1;

Infringement pt. 1;

ST: Interviewing Patent Applications

Prosecution pt. 1

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Overview of Patent Prosecution

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What is Prosecution?

- Negotiation by inventors or their representatives as by patent counsel or patent agent with a patent examiner & other PTO officials administratively in procedures involving the patent application, examination, amendment, continuing procedures and patent grant.

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Prosecution in the United States

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General Prosecution Overview

- Step 0 – Prepare an invention disclosure form
- Step 1 – Identifying person to draft (and likely prosecute) patent application
 - Applicant
 - Patent attorney or agent
- Step 2 – Prior Art search
 - Not required... but highly recommended
- Step 3 – Determine whether an application should be filed
 - Provisional
 - Nonprovisional
- Step 4 – Prepare and file the application
- Step 5 – Prosecution (including possible appeal(s))
- Step 6 – Allowance or Abandonment
- Step 7 – Continuation Applications (prior to issuance or abandonment)?

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Pre-Examination by Administrator at the PTO

- For formal requirements
- Required inventor(s) declaration
- Necessary fees
- All necessary parts & papers
- A description and at least one claim
- Drawings meet specific requirements
 - No drawings sometimes in chemical cases

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Examination of non-provisional applications steps at PTO:

- A patent application is classified and assigned to an art unit
- A SPE from the art unit assigns the patent application to an Examiner
- The assigned patent examiner takes up the application in order from a queue of cases
 - The order in which the application is dependent on a few different factors
- Examiner begins an examination of the application

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Examiner conducts search of the prior art

- Search Locations
 - In classes and subclasses considered pertinent plus key word searchings
 - Patents and patent applications both domestic and foreign
 - Technical publications, journals, and texts available to examiner to a limited degree

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Examiner's review of application

- Examiner considers whether application (with its claims) meets requirements of Patent Laws
- Examiner considers whether claims of application meet certain requirements

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Examiner considers whether claims of application--

- Define patentable inventions (35 USC 101)
- Define inventions that are novel (35 USC 102) over prior art
- Define inventions that are unobvious (35 USC 103) over prior art
- The patent application meets 112 requirements including enablement, written description, and definiteness
- Examiner then writes a summary of the examination called an "Office Action"
- Office Action is mailed (electronically or in paper) to applicant

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Office Action

Summarizes the findings of examiner

- As to each claim specifically
 - each claim is rejected, allowed, objected to indicating allowable if rewritten in independent form
- Any objections to the drawings, specification, title, or abstract are included
- The office action could also include a double patenting rejection

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Office Action date & response

Has a date of mailing and from that date sets a date for response by applicant:

- Typically 3 mo. for substantive rejections or
- Shorter (e.g., 1 or 2 mo.) for informal requirements such as requiring applicant to elect between different species of claimed inventions regarded by examiner as independent (e.g., method and apparatus)

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Response by Applicant to Office Action

- Must address each point of rejection.
- May argue that rejection was improper.
- May present amendments to overcome rejections.
- May amend claims, as by limiting them to avoid prior art.
- Must be submitted within period allowed.
- Extensions (with fees) permitted but with risk of shortening statutory term of patent.

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Further Office Action possible

- Might be a Notice of Allowability.
- Might allow some claims.
- Might apply other rejections or objections, as based on a further search.
- Might be a final rejection.

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Response to Final Rejection

- Could put some other claims into allowable condition.
- Could provide further arguments and/or amendments.
- Cannot add additional claims.
- May not raise new issues.
- Could be valuable even if not successful ("not entered") by opening the possibility of amendments in a continuing application.
- Filing an RCE restarts the process.

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If further response by applicant successful--

- Notice of Allowability and Issue Fee Due will follow
- Issue Fee and Publication Fee will be due and payable by a date certain
- Patent will then issue typically some time (e.g., ~2 mo.) after payment of issue fee.

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Types of Applications

- Provisional Patent Applications
- Nonprovisional Utility Patent Applications
- Design Patent Applications

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Provisional versus Nonprovisional

- | | |
|--|--|
| Provisional | Nonprovisional |
| • Less preparation time | • More preparation time |
| • Can not amend | • Amendments are possible |
| • No claims required | • Must have at least 1 claim |
| • Not examined | • Examined |
| • Informal | • More formal |
| • Valid for only 1 year; must timely file nonprovisional claiming priority | • Application valid until abandoned or patent issued |

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Provisional applications -- steps at PTO

- Application receives a filing date and serial number
- Application is considered only for identification of names and addresses of inventors, and for payment of fee
- Application will not be examined
- Application drawings may be informal
- Application need not include claims
- No substantive prosecution

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Provisional applications -- tips:

- **Suggestion:** include full scope of disclosure even though there is no examination
- Representative claims, broad to narrow, are useful
- **Why?** Application serves as a priority in U.S.
- Provides priority also for foreign applications
- If foreign filing planned, provisional is priority
- **Caution:** Provisional will be scrutinized by opponent if non-provisional results in patent asserted against opponent; don't be shoddy

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Discussion of Example Prosecution

- Select a patent
- Review prosecution in Public Pair

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Continuing Application Practice

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Types of NonProvisional Applications

Five Types of Applications

- Original
- Continuation
- Continuation-in-Part (CIP)
- Divisional

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Transco Products Inc. v. Performance Contracting,
Inc.

- “An applicant may file a continuation, divisional, or a continuation-in-part (CIP) application of a prior application.”
- These are all “continuing” applications under 35 U.S.C. 120.

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Continuation Possibilities

- **Continuation** – might claim other aspects disclosed but not claimed, or claimed in the same way as rejected claims
- **Request for Continuing Examination (RCE)** – removes finality of the office action (e.g., pay to play)

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Other Continuation Possibilities

- **Divisional Application (DIV)**
 - To prosecute claims on independent invention
 - Examiner restricted cls. to independent invention
- **Continuation-in-Part (CIP) Applicant**
 - To add matter not present in earlier application
 - Where part or all of earlier application is present
- **Timing of Filing of Continuation(s)**
 - Before termination of proceedings in parent
 - Before payment of issue fee in parent

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U.S. Patent Appeal and Petition Practice

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Choices other than continuation(s)

- **Petition the Assistant Commissioner of Patents**
 - Petition based on contended examiner error
 - Petition when examiner procedural error in question
 - Further appeal possible to U.S. District Court (District of Virginia after AIA)

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Choices Other Than Continuation(s)

- **Appeal to Patent Trial and Appeal Board (PTAB)**
 - Appeal is statutory (35 USC 134)
 - Issues re examiner's rejection of claims when level of invention &/or interp. of art in question
 - Tribunal is three senior examiners; considers:
 - Applicant's Brief on Appeal
 - Examiner's Brief on Appeal
 - Decides/remands to exam'r for further exam'n
 - Further appeal possible to Fed. Cir. Ct. of Appeals
 - <http://www.uspto.gov/ip/boards/bpai/index.jsp>

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Publication of Pending Applications

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Publication of patent applications

- **18 months** after filing unless applicant requests otherwise upon filing & certifies has not & won't be subject of an application filed in a foreign country
- Provisional rights available to patentees to obtain reasonable royalties if others make, use, sell, or import invention in the period between publication and grant
- Applicant can consider if foreign counterparts will be sought after all, after non-publication request (NPR).
- If applicant then files for foreign patent, must notify PTO in US application within 60 days & withdraw NPR. Application then is published ASAP
- PRIOR ART effect for published applications -- Sec.102(e)
- <http://www.uspto.gov/web/offices/pac/mpep/s1120.html>

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Patent Term

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Term of Patent

- Patent will issue to be in effect 20 years from:
 - **Date of first filing of this or parent application**
 - **Or as limited by delays of applicant during prosecution**
 - **E.g., extensions of time required by applicant**
 - **Or as limited by the lapse of a parent application**
 - **Or where terminal disclaimer was submitted to overcome a double patenting rejection**
- Patent is subject to maintenance fees payable 3.5, 7.5 & 11.5 years after issuance

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Term of Patent

- Continuing applications
 - 20 years from earliest filing date for which a benefit is claimed
- Based off of an international application
 - 20 years from filing date of international application—not the US application (unless priority dates back to original US nonprovisional application)
- Foreign priority
 - Not considered in term
- Provisional application
 - Not considered in term

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Term of Patent

- **35 U.S.C. 154 – Term Guarantees**
- GUARANTEE OF PROMPT PATENT AND TRADEMARK OFFICE RESPONSES
- GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.
- GUARANTEE OR ADJUSTMENTS FOR DELAYS DUE TO INTERFERENCES, SECRECY ORDERS, AND APPEALS.
- <http://www.uspto.gov/web/offices/pac/mpep/mpep-9015-appx-1.html#d0e303482>

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Prosecution Abroad

- Need for foreign counsel
- Deferred examination sometimes possible
- Allows for assignee filing (instead of inventors)

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Inventorship

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Inventorship

- Applications must be filed in the name of the true inventors
- Inventors must sign a declaration or an oath stating that they believe they are the first inventors.
- Joint inventorship of an invention is possible.
- <http://www.uspto.gov/web/offices/pac/mpep/s2137.html>

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Joint Inventorship

- To avoid possible invalidity due to failure to name inventors make sure to name all inventors
- Inventive entities can be different for different claims:
 - A, B & C can have invented claim 1.
 - B & C can be inventors of claims 2 and 3, respectively.
 - A & C can be inventors as to claims 4 & 5, and so forth.

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Important Right of Joint Inventors

- "In the absence of an agreement to the contrary, each of the owners of patent may make, use, offer to sell, or sell the patented invention with the United States, or import [it], **without the consent of and without accounting to the other owners.**" [Section 262 of Patent Statutes (35 U.S.C. 262)]

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Joint Inventors

Recommendation:

In light of Sec. 262, joint inventors:

- Should negotiate & enter into a joint venture or business organization agrmt.
- Should provide for mutual obligations for disposition of rights by any joint owner.
- Should cover sharing of proceeds of exploitation of invention.

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Omitted Inventors

- Inventors sometimes refuse to join in or cannot be found
- By submitting sufficient information, may proceed without the omitted inventor
 - The omitted inventor is still named
 - The omitted inventor may join later

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Noninventors

- Supplies a component used with the invention
- “Hands of the Inventor” but did not conceive the invention
- Validity is compromised by misnomer of a person who is not an inventor

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Joint Inventorship

- How do you become a joint inventor?
 - Contribute to the conception of at least 1 claim

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Ethicon, Inc. v. United States Surgical Corp.

- “A patented invention may be the work of two or more joint inventors. See 35 U.S.C. § 116 (1994). Because “[c]onception is the touchstone of inventorship,” each joint inventor must generally contribute to the conception of the invention. . . . Nevertheless, for the conception of a joint invention, each of the joint inventors need not “make the same type or amount of contribution” to the invention. 35 U.S.C. §116. Rather, each needs to perform only a part of the task which produces the invention. . . . Furthermore, a co-inventor need not make a contribution to every claim of a patent. See 35 U.S.C. § 116. A contribution to one claim is enough. . . . Thus, the critical question for joint conception is who conceived, as that term is used in the patent law, the subject matter of the claims at issue.”

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Ethicon, Inc. v. United States Surgical Corp.

- “[E]ach co-inventor presumptively owns a pro rata undivided interest in the entire patent, no matter what their respective contributions.”
- “[J]oint inventions may become joint property without some express agreement to the contrary.”

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Shukh v. Seagate Technology, LLC

- 2015 Panel Fed. Cir. of Moore, Wallach, and Taranto
- Issue
 - Inventorship related claims

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Shukh v. Seagate Technology, LLC

- “Dr. Shukh’s time at Seagate was undisputedly tumultuous. His performance evaluations indicated that he did not work well with others due to his confrontational style.”

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Shukh v. Seagate Teachnology, LLC

- "This lawsuit stems, in part, from Dr. Shukh's allegations that Seagate has not properly credited him for his inventions. Specifically, Dr. Shukh alleges that during his tenure at Seagate, **Seagate wrongfully omitted him as an inventor** from six patents (U.S. Patent Nos. 7,233,457; 7,684,150; 6,525,902; 6,548,114; 6,738,236; and 7,983,002) and four pending patent applications, all relating to semiconductor technologies. He also claims that Seagate discriminated against him and wrongfully terminated him both on the basis of his national origin and in retaliation for complaining about the discrimination."

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Shukh v. Seagate Teachnology, LLC

- "Today, we hold that **concrete and particularized reputational injury can give rise to Article III standing**. As we noted in Chou, 'being considered an inventor of important subject matter is a mark of success in one's field, comparable to being an author of an important scientific paper.' 254 F.3d at 1359. We reasoned that '[p]ecuniary consequences may well flow from being designated as an inventor.' *Id.* This is particularly true when the claimed inventor is employed or seeks to be employed in the field of his or her claimed invention. For example, if the claimed inventor can show that being named as an inventor on a patent would affect his employment, the alleged reputational injury likely has an economic component sufficient to demonstrate Article III standing."

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Shukh v. Seagate Teachnology, LLC

- "A trier of fact could conclude that Dr. Shukh's omission from the disputed patents had a concrete impact on his reputation in his field. There is significant evidence that the number of patents an inventor is named on influences his reputation in the field of the patents."

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Correction of Inventors' Names

- **35 U.S.C. 256 Correction of named inventor.**
- Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.
- The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.

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Correction of Inventors' Names

- The request to correct inventorship must include:
 - (1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on his or her part;
 - (2) A statement from the current named inventors either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;
 - (3) A statement from all assignees of the parties agreeing to the change of inventorship in the patent; and
 - (4) A fee.

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Double Patenting

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Double Patenting

Sec. 101 of Patent Statutes permits "a"[read "single"] patent for any new and useful invention

- Can arise when multiple patent applications are submitted by same entity on closely related inventions
- Statutory v. Nonstatutory-Type
- <http://www.uspto.gov/web/offices/pac/mpep/s804.html>

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Non-Statutory Double Patenting

In such instances issues of double patenting often overcome by use of terminal disclaimer:

- Term of second patent after expiration of first patent is disclaimed.
- Both patents then expire on the same date.
- Both patents must remain commonly owned.

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Patent Assignments

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35 U.S.C. 261

- Subject to the provisions of this title, patents shall have the attributes of personal property.
- Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.
- A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States... shall be prima facie evidence of the execution of an assignment, grant, or conveyance of a patent or application for patent.
- An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.

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Assignment Basics

- Rights can be assigned from the inventor(s) to an entity
- Must be a patent owner, or an exclusive licensee, to bring suit
- Patent assignments can be recorded with the USPTO
 - Failure to record within 3 months may allow a subsequent purchaser to take rights (Bona Fide Purchaser Rule)

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Infringement pt. 1

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Introduction

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Infringement

- So now you have a patent, what comes next?
- Make money!!!
 - Sell the invention
 - License the invention and let others sell it...
 - Sell the patent
 - Sue others for patent infringement

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Quick Review of the Statute

- 271(a)-(i)

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Infringement

Sec. 271. - Infringement of patent

- (a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States, or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.
- (b) Whoever actively induces infringement of a patent shall be liable as an infringer. [Active Inducement]
- (c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination, or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer. [Contributory Infringement]

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Infringement

- (d) **No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following:**
 - (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent;
 - (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent;
 - (3) sought to enforce his patent rights against infringement or contributory infringement;
 - (4) refused to license or use any rights to the patent; or
 - (5) conditioned the license of any rights to the patent or the sale of the patented product on the acquisition of a license to rights in another patent or purchase of a separate product, unless, in view of the circumstances, the patent owner has market power in the relevant market for the patent or patented product on which the license or sale is conditioned.

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Infringement

- (e)(1) It shall not be an act of infringement to make, use, offer to sell, or sell within the United States or import into the United States a patented invention (other than a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Act of March 4, 1913) which is primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques) solely for uses reasonably related to the development and submission of information under a Federal law which regulates the manufacture, use, or sale of drugs or veterinary biological products.
- (2) It shall be an act of infringement to submit -
 - (A) an application under section 505(i) of the Federal Food, Drug, and Cosmetic Act or described in section 505(b)(2) of such Act for a drug claimed in a patent or the use of which is claimed in a patent, or
 - (B) an application under section 512 of such Act or under the Act of March 4, 1913 (21 U.S.C. 151 - 158) for a drug or veterinary biological product which is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques and which is claimed in a patent or the use of which is claimed in a patent, if the purpose of such submission is to obtain approval under such Act to engage in the commercial manufacture, use, or sale of a drug or veterinary biological product claimed in a patent or the use of which is claimed in a patent before the expiration of such patent.

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Infringement

- (3) In any action for patent infringement brought under this section, no injunctive or other relief may be granted which would prohibit the making, using, offering to sell, or selling within the United States or importing into the United States of a patented invention under paragraph (1).
- (4) For an act of infringement described in paragraph (2)-
- (A) the court shall order the effective date of any approval of the drug or veterinary biological product involved in the infringement to be a date which is not earlier than the date of the expiration of the patent which has been infringed,
- (B) injunctive relief may be granted against an infringer to prevent the commercial manufacture, use, offer to sell, or sale within the United States or importation into the United States of an approved drug or veterinary biological product, and
- (C) damages or other monetary relief may be awarded against an infringer only if there has been commercial manufacture, use, offer to sell, or sale within the United States or importation into the United States of an approved drug or veterinary biological product. The remedies prescribed by subparagraphs (A), (B), and (C) are the only remedies which may be granted by a court for an act of infringement described in paragraph (2), except that a court may award attorney fees under section 285.
- (5) Where a person has filed an application described in paragraph (2) that includes a certification under subsection (b)(2)(A)(v) or (j)(2)(A)(vi)(V) of section 505 of the Federal Food, Drug, and Cosmetic Act (21 U.S.C. 355), and neither the owner of the patent that is the subject of the certification nor the holder of the approved application under subsection (b) of such section for the drug that is claimed by the patent or a use of which is claimed by the patent brought an action for infringement of such patent before the expiration of 45 days after the date on which the notice given under subsection (b)(3) or (j)(2)(B) of such section was received, the courts of the United States shall, to the extent consistent with the Constitution, have subject matter jurisdiction in any action brought by such person under section 2201 of title 28 for a declaratory judgment that such patent is invalid or not infringed.

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Infringement

- (f)
- (1) Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.
- (2) Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

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Infringement

- (g) Whoever without authority imports into the United States or offers to sell, sells, or uses within the United States a product which is made by a process patented in the United States shall be liable as an infringer, if the importation, offer to sell, sale, or use of the product occurs during the term of such process patent. In an action for infringement of a process patent, no remedy may be granted for infringement on account of the noncommercial use or retail sale of a product unless there is no adequate remedy under this title for infringement on account of the importation or other use, offer to sell, or sale of that product. A product which is made by a patented process will, for purposes of this title, not be considered to be so made after -
- (1) it is materially changed by subsequent processes; or
- (2) it becomes a trivial and nonessential component of another product.
- (h) As used in this section, the term "whoever" includes any State, any instrumentality of a State, any officer or employee of a State or instrumentality of a State acting in his official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this title in the same manner and to the same extent as any nongovernmental entity.
- (i) As used in this section, an "offer for sale" or an "offer to sell" by a person other than the patentee or any assignee of the patentee, is that in which the sale will occur before the expiration of the term of the patent.

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Requirements?

- Statute does not require
 - Any proof of access to inventor's work
 - Any intent to infringe
- Courts ultimately required claims to determine patent scope...

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Literal Infringement

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Literal Infringement

- Inquiry - Does a device or method literally infringe one or more claims of a patent?

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Markman v. Westview Instruments, Inc.

- Background
 - Federal Circuit en banc
 - Supreme court unanimously affirms
- Issue:
 - Who determines claim construction—a jury or the court?

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Markman v. Westview Instruments, Inc.

- “To ascertain the meaning of claims, we consider three sources: The claims, the specification, and the prosecution history. ... Expert testimony, including evidence of how those skilled in the art would interpret the claims, may also be used.”

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Markman v. Westview Instruments, Inc.

- “Claims must be read in view of the specification, of which they are apart.”
- “For claim construction purposes, the [specification] may act as a sort of dictionary, which explains the invention and may define terms used in the claims.”
- “... [A] patentee is free to be his own lexicographer ... [but] any special definition must be clearly defined in the specification.”
- Court may also consider:
 - Prosecution history (if in evidence)

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Markman v. Westview Instruments, Inc.

- “Extrinsic evidence may demonstrate the state of the prior art at the time of the invention.”
- “Extrinsic evidence consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises ... and may demonstrate the state of the art at the time of the invention.”

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Markman v. Westview Instruments, Inc.

- “An infringement analysis entails two steps. The first step is determining the meaning and scope of the patent claims asserted to be infringed. The second step is comparing the properly constructed claims to the device accused of infringing.”
- “... [I]n a case tried to a jury, the court has the power and obligation to construe as a matter of law the meaning of language used in the patent claim.”

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Markman v. Westview Instruments, Inc.

- “... [W]e conclude that the interpretation and construction of patent claims, which define the scope of the patentee’s rights under the patent, is a matter of law exclusively for the court.”

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Markman v. Westview Instruments, Inc.

- Supreme Court
 - Judges are better suited to interpret the patents
 - Uniformity of interpretation

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Trial procedure effect of Markman?

- Resolution of meaning of disputed patent terms by use of a Markman hearing and ruling by judge can be binding on litigants and may have effect of a final determination so that a full-blown trial before a jury may never occur.

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Markman v. Westview Instruments, Inc.

- This means JUDGE not JURY will construe the language of claims.
- Can have major effect on the way patent infringement trials are conducted
- Before case is presented to jury, which must decide issues of FACT
- Judge may decide issues of LAW by construing claim language.

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Trial procedure changed by Markman

- Or effect of Markman will leave a clearer set of issues of fact which are to be decided by jury at trial. But ...
- Ultimately the jury factually determines whether there is infringement unless the claims have been so construed by judicial ruling after Markman hearing as to preclude an infringing interpretation. The overall effect of *Markman v. Westview Instruments* has had the practical effect of making patent infringement suits a multistage affair in which the Markman hearing often determines the outcome of the litigation before trial before jury occurs.

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Claim Construction

- Intrinsic
 - Claims
 - Specification
 - Prosecution History
- Extrinsic
 - Inventor testimony
 - Dictionaries
 - Learned treatises

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Additional Claim Interpretation Notes

- “To literally infringe, an accused product or process must include each and every limitation of a claim. Therefore the omission of any limitation is fatal to literal infringement.”
- “... [W]here the patent documents are unambiguous, expert testimony regarding the meaning of a claim is entitled to no weight.”

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How are claims to be construed by a court?

1. Narrow Construction to Save Validity
2. Ordinary vs. Contextual Meaning
3. Contextual Meaning May Trump Ordinary Meaning
4. The “Lexicographer” Rule
5. Disclaimer of Subject Matter
6. Claim Differentiation: Contextual Meaning From Other Claims
7. Purpose or Goal of the Invention

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Narrow Construction to Save Validity

- “[W]hen two interpretations are plausible, choose the one that preserves the validity of the patent — the narrower interpretation.”
- Last resort...

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Ordinary vs. Contextual Meaning

- “Claim interpretation often seems to hinge on disputes about whether to give language an ‘ordinary’ meaning or a special ‘contextual’ meaning derived from particular usage in the patent, but the distinction is not sharp.”

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Contextual Meaning May Trump Ordinary Meaning

- Sometimes more narrow definitions than ordinary meaning may be given to words in the claim based on the specification.

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The “Lexicographer” Rule

- “Courts often say that patentees are free to be their own lexicographers — i.e., to define claim terms in any way they wish. These definitions are typically set forth in the specification. Yet, even when the patentee does define a term, the definition may be ambiguous.”

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Disclaimer of Subject Matter

- “A corollary of the lexicographer rule is that the patentee’s statements in the specification or, more commonly, in the prosecution history may limit or disclaim apparently broad claim language.”

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Claim Differentiation

- Presence of dependent claim that narrows provides support that the claim from which it depends

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Purpose or Goal of the Invention

- Supply meaning to the claim term from a purpose or goal of an invention

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Cybor Corp. v. FAS Technologies, Inc.

- “[W]e conclude that the Supreme Court’s unanimous affirmance in *Markman v. Westview Instruments* [] of our in banc judgment in that case fully supports our conclusion that **claim construction**, as a purely legal issue, **is subject to de novo review on appeal.**”

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Cybor Corp. v. FAS Technologies, Inc.

- “[W]e **review claim construction de novo** on appeal including any allegedly fact- based questions relating to claim construction. Accordingly, we today disavow any language in previous opinions of this court that holds, purports to hold, states, or suggests anything to the contrary.”

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Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

- Supreme Court 2015
- Issue
 - What is the claim construction standard of review when claim construction includes factual underpinnings?

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Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

- “We hold that the appellate court must apply a ‘clear error,’ not a *de novo*, standard of review.”
- What applies to this standard?

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Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

- Invention
 - a drug used to treat multiple sclerosis.
- Issue
 - Indefiniteness
 - “The reason that the phrase is fatally indefinite, Sandoz argued, is that, in the context of this patent claim, the term ‘molecular weight’ might mean any one of three different things.”

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Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

- District Court
 - patent claim was sufficiently definite; patent valid
- Federal Circuit
 - the term “molecular weight” was indefinite; patent invalid

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Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

- “Federal Rule of Civil Procedure 52(a)(6) states that a court of appeals ‘must not . . . set aside’ a district court’s ‘[f]indings of fact’ unless they are ‘clearly erroneous.’ . . . when reviewing the findings of a “district court sitting without a jury, **appellate courts** must constantly have in mind that their function is **not to decide factual issues *de novo***.””

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Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

- “We [] held [in Markman] that claim construction falls ‘exclusively within the province of the court,’ not that of the jury. . . . [W]e concluded that it was proper to treat the ultimate question of the proper construction of the patent as a question of law in the way that we treat document construction as a question of law. [] But this does not imply an exception to Rule 52(a) for underlying factual disputes.”

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Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

- “[S]ometimes, say when a written instrument uses ‘**technical words or phrases not commonly understood**,’ [] those words may give rise to a **factual dispute**. If so, extrinsic evidence may help to ‘establish a usage of trade or locality.’ [] And in that circumstance, the ‘determination of the matter of fact’ will ‘preced[e]’ the ‘function of construction.’ . . . This **factual determination**, like all other factual determinations, **must be reviewed for clear error**.”

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Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

- “[W]e referred to claim construction as a practice with ‘evidentiary underpinnings,’ a practice that ‘falls somewhere between a pristine legal standard and a simple historical fact.’ [] We added that sometimes courts may have to make ‘credibility judgments’ about witnesses. . . . [W]e recognized that courts may have to resolve subsidiary factual disputes. And, as explained above, the Rule requires appellate courts to review all such **subsidiary factual findings** under the ‘**clearly erroneous**’ standard.”

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Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

- “In some cases [] the district court will need to look beyond the patent’s intrinsic evidence and to consult extrinsic evidence in order to understand, for example, the background science or the meaning of a term in the relevant art during the relevant time period. ... In cases where those subsidiary facts are in dispute, courts will need to make subsidiary factual findings about that extrinsic evidence. These are the ‘evidentiary underpinnings’ of claim construction that we discussed in Markman, and this subsidiary factfinding must be reviewed for clear error on appeal.”

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Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

- “The appellate court can still review the district court’s ultimate construction of the claim *de novo*. But, to overturn the judge’s resolution of an underlying factual dispute, the Court of Appeals must find that the judge, in respect to those factual findings, has made a clear error. Fed. Rule Civ. Proc. 52(a)(6).”

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Phillips v. AWH Corporation

- Issue
 - To what extent should the specification be relied on when ascertaining the scope of the claims? How should dictionaries be used in claim interpretation?

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Phillips v. AWH Corporation

- Invention
 - Modular steel panels that are welded together to form walls
 - Specification described baffled deployment at an angle other than 90 degrees to wall face to create interlocking
- D.C. – no infringement b/c at 90 degrees
- Panel – affirmed; baffles at non 90 angle enable deflection of bullets

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Phillips v. AWH Corporation

- Claims
 - define invention to which the patentee is entitled the right to exclude
 - “...the words of a claim ‘are generally given their ordinary and customary meaning.’” ...

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Phillips v. AWH Corporation

- “We have made clear, moreover, that the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.”

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Phillips v. AWH Corporation

- “[T]he person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.”

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Phillips v. AWH Corporation

- Apply well-accepted meaning of commonly understood words
- Examine terms that have a particular meaning in a field of art

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Phillips v. AWH Corporation

- “Quite apart from the written description and the prosecution history, the claims themselves provide substantial guidance as to the meaning of particular claim terms. ...
- “To begin with, the context in which a term is used in the asserted claim can be highly instructive. ...
- “Other claims of the patent in question, both asserted and unasserted, can also be valuable sources of enlightenment as to the meaning of a claim term.”

112

Phillips v. AWH Corporation

- “[T]he presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim.”

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Phillips v. AWH Corporation

- Claims must be read in terms of the specification
- “Our cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor’s lexicography governs. ... In other cases, the specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor. In that instance as well, the inventor has dictated the correct claim scope, and the inventor’s intention, as expressed in the specification, is regarded as dispositive. ...

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Phillips v. AWH Corporation

- Prosecution history
 - evidence of how the PTO and the inventor understood the patent
 - “lacks the clarity of the specification and thus is less useful for claim construction purposes.”

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Phillips v. AWH Corporation

- “[W]e have also authorized district courts to rely on extrinsic evidence, which ‘consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises.’
- “[W]hile extrinsic evidence ‘can shed useful light on the relevant art,’ we have explained that it is “less significant than the intrinsic record in determining ‘the legally operative meaning of claim language.’”

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Phillips v. AWH Corporation

- Extrinsic evidence
 - Less reliable
 - What five reasons did the court give?
 - “unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence”

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Phillips v. AWH Corporation

- What happened in Texas Digital?
 - Too much reliance on dictionaries (and other extrinsic sources)

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Phillips v. AWH Corporation

- “Moreover, we recognize that the distinction between using the specification to interpret the meaning of a claim and importing limitations from the specification into the claim can be a difficult one to apply in practice.”

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Interviewing Patent Applications

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Interviews with the Patent Office

- **§ 1.133 Interviews.**
- (a)(1) Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and R-95 Rev. 8, July 2010 within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director.
- (2) An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application or the examiner determines that such an interview would advance prosecution of the application.

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Interviews with the Patent Office

- (3) The examiner may require that an interview be scheduled in advance.
- (b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office actions as specified in §§ 1.111 and 1.135.

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Interviews Before Final

- What can you do and when can you do it?
 - Pre-examination
 - At Examiner's discretion
 - First Action Interview Pilot Program
 - http://www.uspto.gov/patents/init_events/faip_p_landing.jsp
 - Prior to a final action

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Interviews After Final

- After Final
 - Examiners may grant one interview after final rejection. See MPEP § 713.09.
 - After Final Consideration Pilot 2.0
 - http://www.uspto.gov/patents/init_events/afcp.jsp
 - Post-Prosecution Pilot (P3) Program
 - <https://www.uspto.gov/patent/initiatives/post-prosecution-pilot>

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Interviewing Patent Applications

- How conducted
 - In-Person in Washington, D.C. (or other location)
 - Telephonically
 - Video conference
- Time allotted - 30 or 60 minutes
- Who is present
 - Attorney
 - Examiner that prepared the office action
 - Supervising Examiner?
 - Inventor or client representative?

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**Program
Completed**

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