

Strategic Claim Construction

BY STEVEN R. HANSEN AND LEIGH C. TAGGART,
RADER FISHMAN & GRAUER, PLLC

Steven R. Hansen and Leigh C. Taggart are patent litigation partners with Rader Fishman & Grauer, PLLC, a firm specializing in intellectual property matters. Mr. Hansen can be reached at 248-593-3301 (srh@raderfishman.com) and Mr. Taggart can be reached at 248-593-3315 (lct@raderfishman.com).

The phone rings. Your client has been sued by a competitor for patent infringement. He is certain that the asserted patent is not at all like his product and that he could not possibly infringe it. After studying the claims and the accused product, you see some claim elements that you believe are not present in the product and begin to build an infringement defense.

Now you have some decisions to make. Which claim terms should you ask the Court to construe? What constructions will you seek? If you seek a favorable construction and lose, you may forfeit a non-infringement defense that you would otherwise be able to assert at trial. Even worse, you may find yourself on the losing end of a summary judgment motion. Therefore, these critical and potentially case-dispositive decisions should be carefully considered at the earliest stages of litigation. This article provides strategic guidance for evaluating and making these decisions.

THE NOT-SO "BRIGHT LINE" BETWEEN CLAIM CONSTRUCTION AND INFRINGEMENT

The Federal Circuit has consistently and repeatedly held that adjudicating a claim of patent infringement requires two distinct steps: 1) construing disputed claim language, and 2) applying the construed claims to the accused device to determine whether the device infringes the claims. The court performs the first task, while the jury performs the second task.¹

The 13 years since *Markman*² have proven that this "bright line" between claim construction and infringement is not bright at all.³ Where does the court's task end and the jury's task begin? Many decisions indicate that if there is no dispute regarding the

structure or operation of an accused product, the issue of infringement should collapse into the issue of claim construction, leaving the Court as the ultimate arbiter of the dispute.⁴ In practice, however, the goal of simplifying infringement disputes in this manner has proven elusive for several reasons. First, the so-called "canons" of claim construction often do not resolve the issue of whether an accused device falls within or without the scope of a claim. In these cases, the Federal Circuit has held that the court should provide whatever construction is called for by the canons, and the jury should then decide the dispute as a factual infringement issue.⁵

Second, even after a court issues a claim construction, it can be difficult to determine when a party is offering evidence or argument that is inconsistent with that construction. If so, when should the evidence or argument be excluded as misleading?⁶ For example, if an expert witness offers testimony on the ultimate issue of whether a disputed claim element is present in an accused device, it can be difficult for the court to determine whether the testimony should be excluded because it is necessarily predicated on a claim construction that is at odds with the Court's construction.

Third, judges may be unwilling to construe large numbers of claim terms and may force the parties to narrow their claim construction disputes. Many judges have issued rules requiring plaintiffs to select so-called "paradigm" claims, or which otherwise limit the total number of claims or claim terms the parties may contest. In such cases, a claim construction dispute may ultimately be decided by the jury since no construction is provided.⁷

While much has been written about the canons of claim construction, relatively little has been written about claim construction strategy, i.e., the process of determining which terms to construe and how to construe them. The practicalities discussed above provide an important backdrop for approaching the claim construction process. The following strategic tips are provided from the perspective of an accused infringer attempting to defend against claim of patent infringement. However, they could also be used by a patent holder seeking to avoid the invalidation of its claims.

SELECTING THE CLAIM TERMS ON WHICH THE NON-INFRINGEMENT DEFENSE WILL BE BASED

The first step is to identify those terms in the claim which may provide a basis for establishing non-infringement, i.e., identifying the terms that at least arguably are not present in the accused device. This can be somewhat difficult if the patent holder has not indicated how it is reading the claims on the product. If possible, use the discovery process to obtain claim charts from the plaintiff. Many jurisdictions, such as the Eastern District of Texas and the Northern District of California, have adopted patent local rules requiring the plaintiff to provide infringement contention claim charts without a formal discovery request.

DECIDE WHICH TERMS TO CONSTRUE

This is perhaps the most critical task and one that should be handled carefully, keeping in mind the not-so bright line between construing claims and applying the claims to the accused product. Here we are often reminded of the old curse "Be careful what you wish for!" Once a claim construction issue is raised, there is a possibility that the Court will enter an unfavorable—and dispositive—claim construction. Thus, if an accused infringer raises a claim construction issue and loses, it may be unable to rely on the relevant element to argue non-infringement. In contrast, if the same claim element remains unconstrued, the accused infringer may argue that the element is not present in the accused product—the Court has not defined the claim to preclude such an argument.

As noted, courts sometimes have difficulty policing the evidence and arguments that are offered to determine whether they contradict the court's claim construction. Thus, some attorneys will attempt to repackage a losing claim construction argument as a non-infringement argument. However, the Court or an alert adversary can thwart such a repackaging strategy. In one notable case last year, a patent holder's counsel was sanctioned and forced to pay a portion of the accused infringer's attorney's fees because it offered non-infringement arguments which "direct[ed] the jury to override the court's claim construction."⁸ In that case, the Court held:

Rather than accepting that the claims construction rulings stripped the merits from this case, counsel chose to pursue a strategy of distorting those

rulings, misdirecting the jury to a different reading of the claim language, and blatantly presenting the jury with a product to product comparison contrary to established law and the Court's cautionary instructions.⁹

To determine which claim terms to construe, the canons of claim construction should be considered. If the canons can support a helpful claim construction, then one should probably be proffered to the Court. For example, the following steps may be used to determine if a dispositive or at least helpful construction is likely to be obtained:

- Determine if the construction is consistent with an express or implicit definition of the term (if there is one) in the specification.
- Determine if the construction is consistent with all of the embodiments of the term at issue.
- Determine if the construction is consistent with the arguments made to the Patent Office during prosecution
- Determine if the construction strictly conforms to or is broader than one or more of the embodiments. If the construction closely tracks the embodiments, it may be rejected for "importing" features of the embodiments into the claims.
- Determine if the construction is consistent with accepted dictionary and treatise definitions

If the application of these considerations suggests that there is no helpful construction that is likely to be adopted, it may be best to leave the term unconstrued for the reasons above. Conversely, patent holders should be alert to non-infringement arguments that are based on unsupported claim constructions. If possible, prior to claim construction proceedings, patent holders should push for and scrutinize an accused infringer's non-infringement contentions. Understanding these contentions should reveal the claim constructions on which they are based, and if necessary, the patent holder may seek a favorable construction of those terms. However, in many cases, patent holders seek to avoid construing claim terms to provide them with maximum flexibility in reading the claims on the accused product. When patent holders adopt this approach, the accused infringer will ultimately decide which terms will be construed.

[Home](#) | [Lawsuits](#) | [Tools](#) | [Register](#) | 847-705-7100 | [Register](#) | [Sign In](#) | [Cart \(0\)](#)

RFC Express™ beta

US Federal District Court Recently Filed Cases

Access to over 18,500 cases
229 Lawsuits added in the last 7 days

The Leading Provider of

INTELLECTUAL PROPERTY LAWSUIT INFORMATION

Recent Lawsuits

The most frequently updated, searchable, intellectual property lawsuit information available on the web.

Lawsuit Report

Receive up to three emails a day of recently filed cases within hours after being docketed.

Lawsuit Alarm

Set alarms by entering information which triggers an e-mail of new lawsuits that match your criteria.

Lawsuit Tracker

Proactively track any patent, trademark or copyright lawsuit currently being litigated.

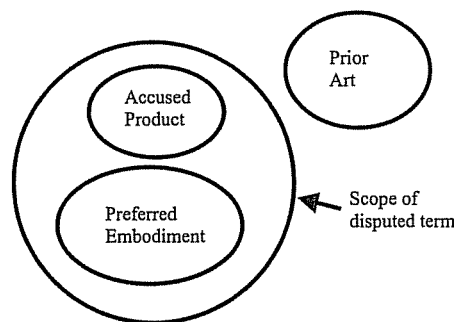
Complaint Download (PDF)

Immediately download available complaints. Why pay PACER when you can get it free from RFC?

Start your **FREE** trial today by visiting www.rfcexpress.com

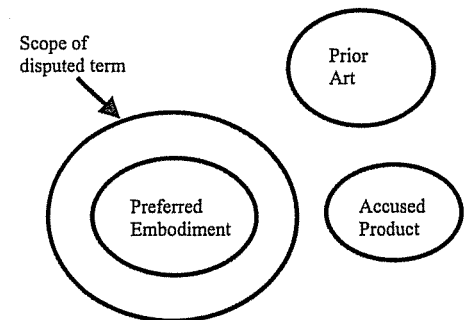
DEVELOPING THE CONSTRUCTIONS

Developing claim constructions is an art and an area where the patent attorney can exercise creative drafting and word-smithing skills. However, the overall claim construction strategies pursued by patent holders and accused infringers are generally predictable. Patent holders generally want to define terms as broadly as is necessary to ensnare the accused product without encroaching on the prior art. This drafting strategy can be represented graphically as follows:



In contrast, accused infringers typically favor a claim construction that excludes the accused product while still covering the preferred embodiment. If the construction can also be crafted to encroach on the prior

art, that is a bonus and will provide a basis for invalidating the patent. However, given the differing burdens and standards of proof for infringement (patent holder's burden, preponderance of evidence standard) and invalidity (accused infringer's burden, clear and convincing evidence standard) it is often better to advocate a narrow construction that excludes the accused device. An accused infringer's typical claim construction strategy may be graphically represented as follows:



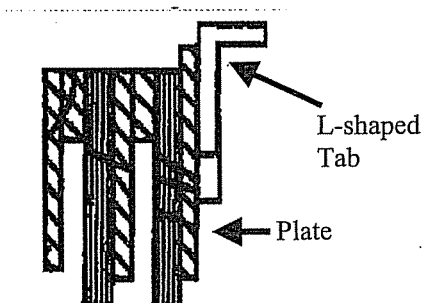
Ideally, an accused infringer's construction would expressly and clearly exclude the accused product. However, courts generally favor affirmative claim definitions, not negative definitions that recite express exclusions. Thus, part of the attorney's task

is to provide an affirmative definition of the disputed term that, to the extent possible, suggests the accused product is outside of the claim.

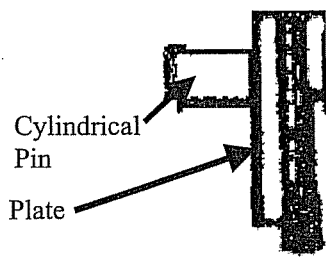
The following brush seal claim example is illustrative of the foregoing. A brush seal is a circular set of bristles with plates on either side of the bristles. The bristles engage a rotating shaft, for example in a turbine engine, to prevent fluids from migrating along the shaft into undesired locations. Assume that an asserted brush seal patent claim reads as follows:

1. A brush seal, comprising:
 - a brush array;
 - a first plate disposed on a first side of the brush array;
 - a second plate disposed on a second side of the brush array; and
 - a tab for engaging a retention structure, wherein the tab is disposed on one selected from the first plate and the second plate.

In this example, the parties are disputing whether an accused brush seal includes the claimed “tab,” which is used to attach the seal to a retaining structure in a turbine engine, for example, to prevent the brush seal from rotating with the shaft. The preferred embodiment and accused product are depicted below:



Preferred Embodiment



Accused Product

In this example, the accused infringer argues that his brush seal does not infringe the claim because the accused product has a “pin” and not a “tab.” If the specification

provides little ammunition for obtaining a favorable construction of “tab,” it may be preferable to leave the term undefined and argue to the jury that the accused product’s pin structure is not “a tab.” However, assuming that it has been decided to seek a construction of “tab,” what are the options for defining the term?

Obviously, the accused infringer would like a construction of “tab” which expressly excludes “pins.” However, such a construction would likely be deemed self-serving and not supported by the specification. In addition, as discussed above, courts generally require an affirmative construction, i.e., a definition that says what a tab *is*, not one that says what a tab *is not*.

One option would be to define “tab” as an L-shaped appendage comprising two rectangular surfaces which is attached to the side of the brush seal. However, this construction runs the risk of being rejected by the Court for improperly importing features from the preferred embodiment into the claims.


A second option would be to define “tab” as a structure having a rectangular projection. This avoids a portion of the preferred embodiment (the “L-shape”) while still distinguishing the accused product’s cylindrical pin.

A third option would be to define “tab” as a structure having a base (i.e., the portion attached to the plate in the preferred embodiment) and a projection that projects in a direction away from the base (or alternatively, a projection that is not coplanar with the base). The benefit of this construction is that it is not limited to rectangular tabs or L-shaped tabs with 90 degree bends. Thus, it does not narrowly conform to the preferred embodiment. Because the accused device has a “pin” that is directly attached to the plate, this construction would also exclude the accused brush seal. This construction would allow the accused infringer to argue that it is not limiting the claim to the preferred embodiment, but rather, that it is merely using the specification to shed light on the proper definition of tab.

As this discussion indicates, several candidate constructions can be generated by abstracting and generalizing the preferred embodiment in different ways. The primary sources of claim construction (i.e., the claim language, specification, file history, cited prior art, technical treatises) will dictate whether one of the proposed claim constructions is more likely to succeed than the others. Use the steps described above to evaluate

the proposed constructions for consistency with the preferred embodiments, implicit or explicit definitions in the specification, etc. As a general rule, accused infringers should seek constructions that broadly encompass the preferred embodiments without covering the accused product.

Also, keep in mind that the canons of claim construction may not provide a basis for a “home run” construction that is dispositive. Nevertheless, it may be possible to obtain a construction that better distinguishes the accused product than the claim term itself. Such helpful but non-dispositive claim constructions may shore up the non-infringement defense for presentation at trial even though they may not be sufficient to win a motion for summary judgment of non-infringement.

Claim construction is a central and frequently outcome determinative part of a patent infringement case. By carefully selecting which terms to construe and crafting appropriate definitions with these points in mind, you can significantly enhance your client’s chances of winning at summary judgment or trial. 

ENDNOTES

1. *Acumed, LLC v. Stryker Corp.*, 483 F.3d 800, 804 (Fed. Cir. 2007)
2. *Markman v. Westview Instruments*, 517 U.S. 370, 116 S. Ct. 1384 (1996).
3. *Union Carbide v. Shell Oil Co.*, 425 F.3d 1366, 1373 (Fed. Cir. 2005) (“Although often difficult to distinguish claim construction and infringement, this court’s case law requires the distinction”)
4. *MyMail, Ltd. v. America Online, Inc.*, 476 F.3d 1372, 1378 (Fed. Cir. 2007); *Rheox v. Entact, Inc.*, 276 F.3d 1319, 1324 (Fed. Cir. 2002).
5. “However, a sound claim construction need not purge every shred of ambiguity. The resolution of some line-drawing problems . . . is properly left to the trier of fact.” *Acumed, LLC v. Stryker Corp.*, 483 F.3d 800, 806 (Fed. Cir. 2007); *PPG Indus. v. Guardian Indus. Corp.*, 156 F.3d 1351, 1355 (Fed. Cir. 1998) (“After the court has defined the claim with whatever specificity and precision is warranted by the language of the claim and the evidence bearing on the proper construction, the task of determining whether the construed claim reads on the accused product is left for the trier of fact”).
6. *See, Sulzer Textil A.G. v. Picanol, N.V.*, 358 F.3d 1356, 1367 (Fed. Cir. 2004) (holding that the “jury must be told that the court has made a claim construction ruling that the jury must follow and cannot be left free to apply its own reading of disputed terms to the facts of the case”).
7. For example, we found one claim construction order from the Eastern District of Texas in which the Court ordered “that the parties shall elect no more than ten (10) disputed claim terms for construction” even though the parties had requested more. Order, dated June 13, 2008, *Hearing Components v. Shure, Inc.*, Case No. 9:07CV104 (J. Clark) (E.D. Texas).
8. Order, dated February 12, 2008, *Medtronic Navigation, Inc. v. Brainlab Medizinische Computersysteme GmbH* (Case No. 98-CV-01072-RPM) (J. Matsch) (D. Colo.) at 16.
9. *Id.* at 10.