

IN SEARCH OF A (NARROWER) MEANING

RECENT DEVELOPMENTS CONCERNING CLAIM CONSTRUCTION

NIKA ALDRICH

OSB Intellectual Property Section

August 3, 2016

A portrait of Nika Aldrich, a bald man with a friendly smile, wearing a dark suit, white shirt, and a purple patterned tie. The background is a dark, textured grey.

Nika Aldrich

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INDUSTRY FOCUS

Healthcare
Technology

- Has litigated patents in high stakes, competitor cases in trials and appeals throughout the country
- Adjunct Professor of Patent Law at Lewis & Clark Law School
- Previously worked at the UN studying intellectual property at WIPO
- Counsel to the Audio Engineering Society

PATENT EXPERIENCE

Medical Devices,
Transducers, Sensors,
MEMS, Computer
Hardware, Computer
Software, Pharmaceuticals,
Apparel, Textiles, Food
Technology

TWO ISSUES

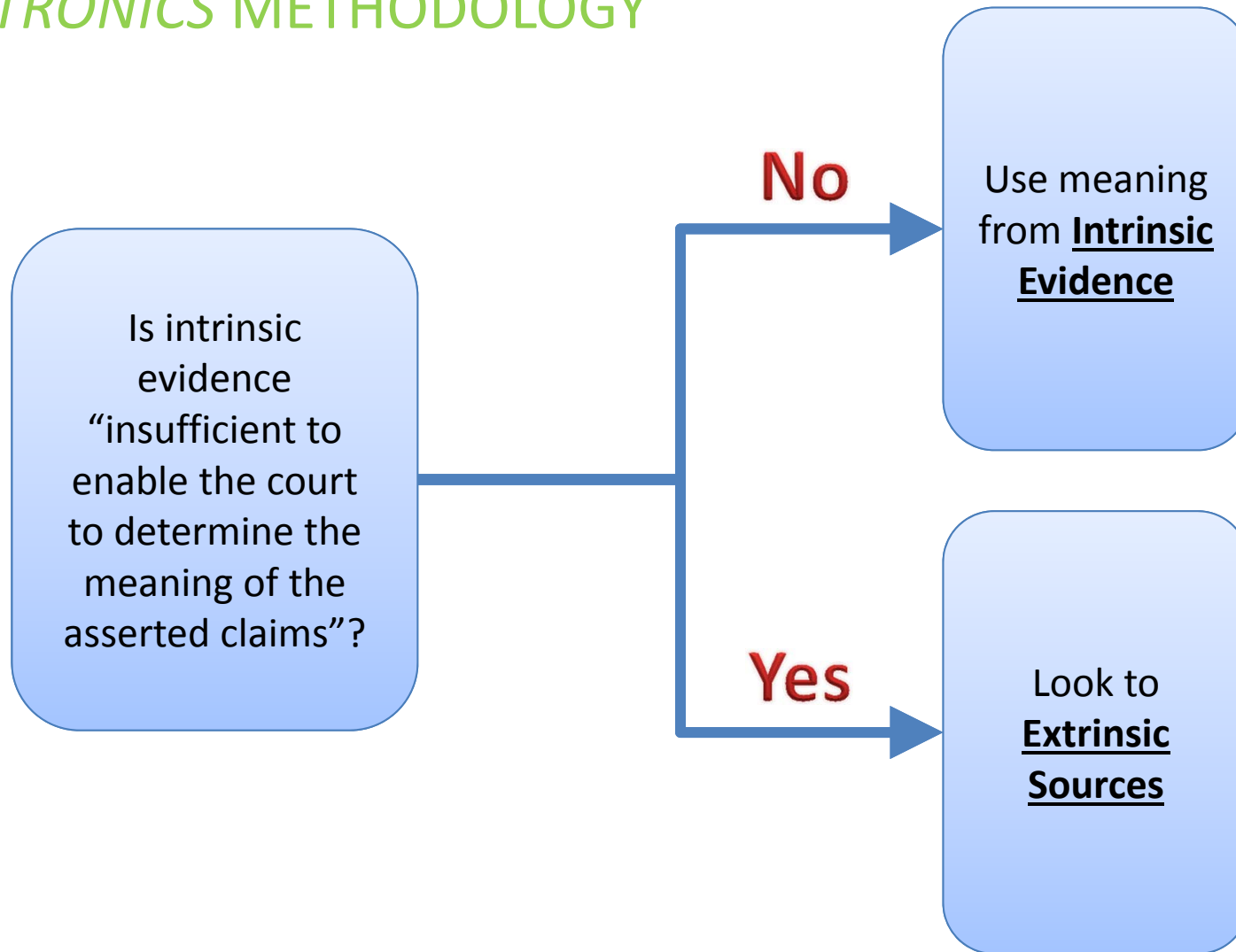
1. Cases on Context
2. “Correct construction” v.
“broadest reasonable
interpretation”

CASES ON CONTEXT – HISTORICAL FRAMEWORK

Vitronics Corp. v. Conceptronic, Inc., 90 F. 3d 1576 (Fed. Cir. 1996)

“the court should look first to the intrinsic evidence of record, i.e., the patent itself, including the claims, the specification and, if in evidence, the prosecution history. . . . Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language.”

VITRONICS METHODOLOGY

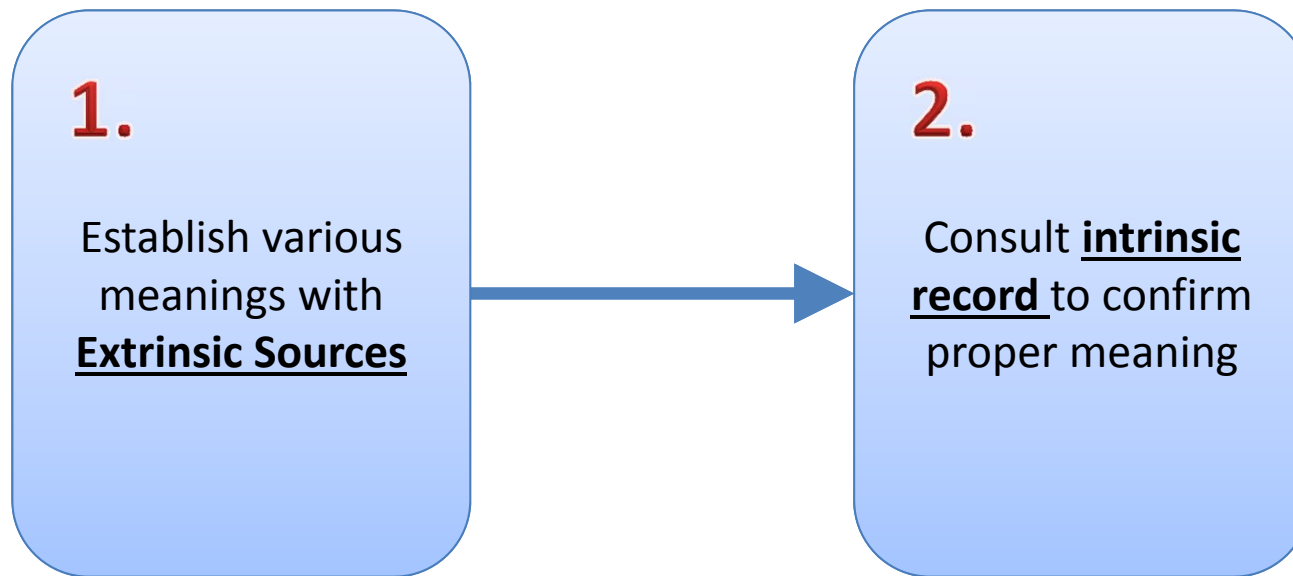


CASES ON CONTEXT – HISTORICAL FRAMEWORK

Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F. 3d 1193 (Fed. Cir. 2002)

“dictionaries, encyclopedias and treatises are particularly useful resources to assist the court in determining the ordinary and customary meanings of claim terms. . . . the intrinsic record must always be consulted to identify which of the different possible dictionary meanings of the claim terms in issue is most consistent with the use of the words by the inventor.”

TEXAS DIGITAL METHODOLOGY



PHILLIPS V. AWH CORP., 415 F.3D 1303 (2005) (EN BANC)

Phillips placed priority on the intrinsic record

“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”

“Importantly, the 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.”

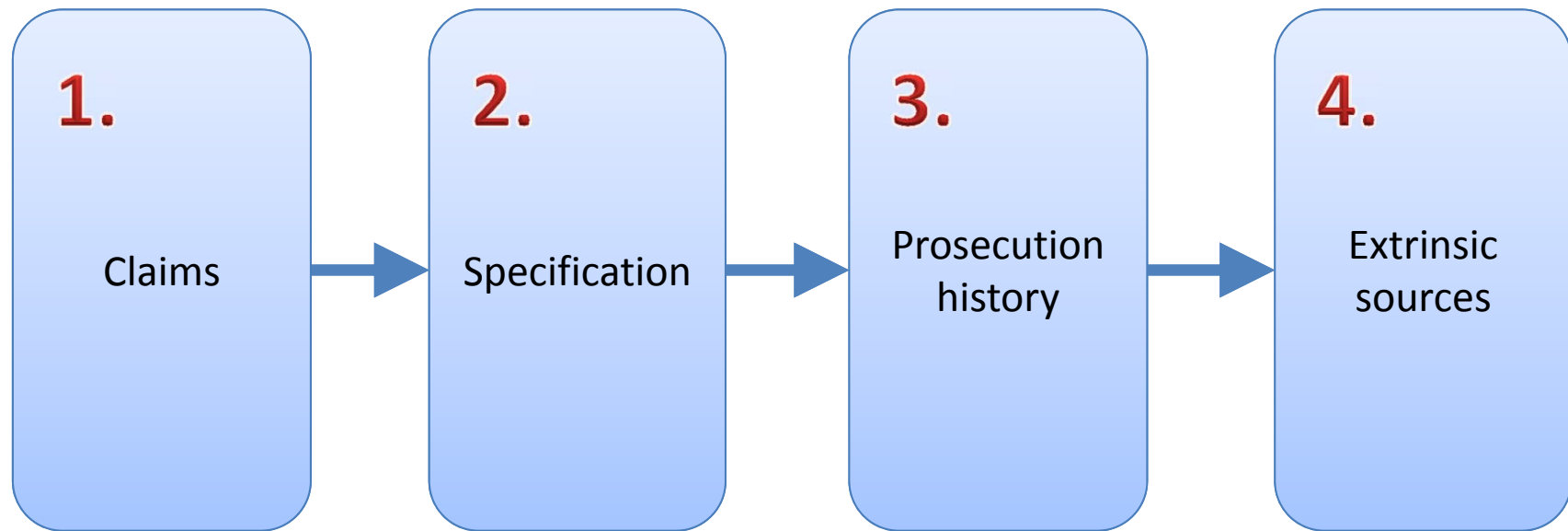
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PHILLIPS V. AWH CORP., 415 F.3D 1303 (2005) (EN BANC)

Phillips placed priority on the intrinsic record

“As we stated in *Vitronics*, the specification "is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term."

PHILLIPS METHODOLOGY



SUBSEQUENT CASES HAVE SHIFTED THE ANALYSIS

“Appellees cannot overcome the plain meaning of claim 1 by pointing to an embodiment disclosed in the specification or prosecution history. . . . It is not enough that the only embodiments, or all of the embodiments, contain a particular limitation. . . . We do not read limitations from the specification into claims.”

Toshiba Corp. v. Imation Corp., 681 F. 3d 1358 (Fed. Cir. 2012).

SUBSEQUENT CASES HAVE SHIFTED THE ANALYSIS

“Absent disclaimer or lexicography, the plain meaning of the claim controls.”

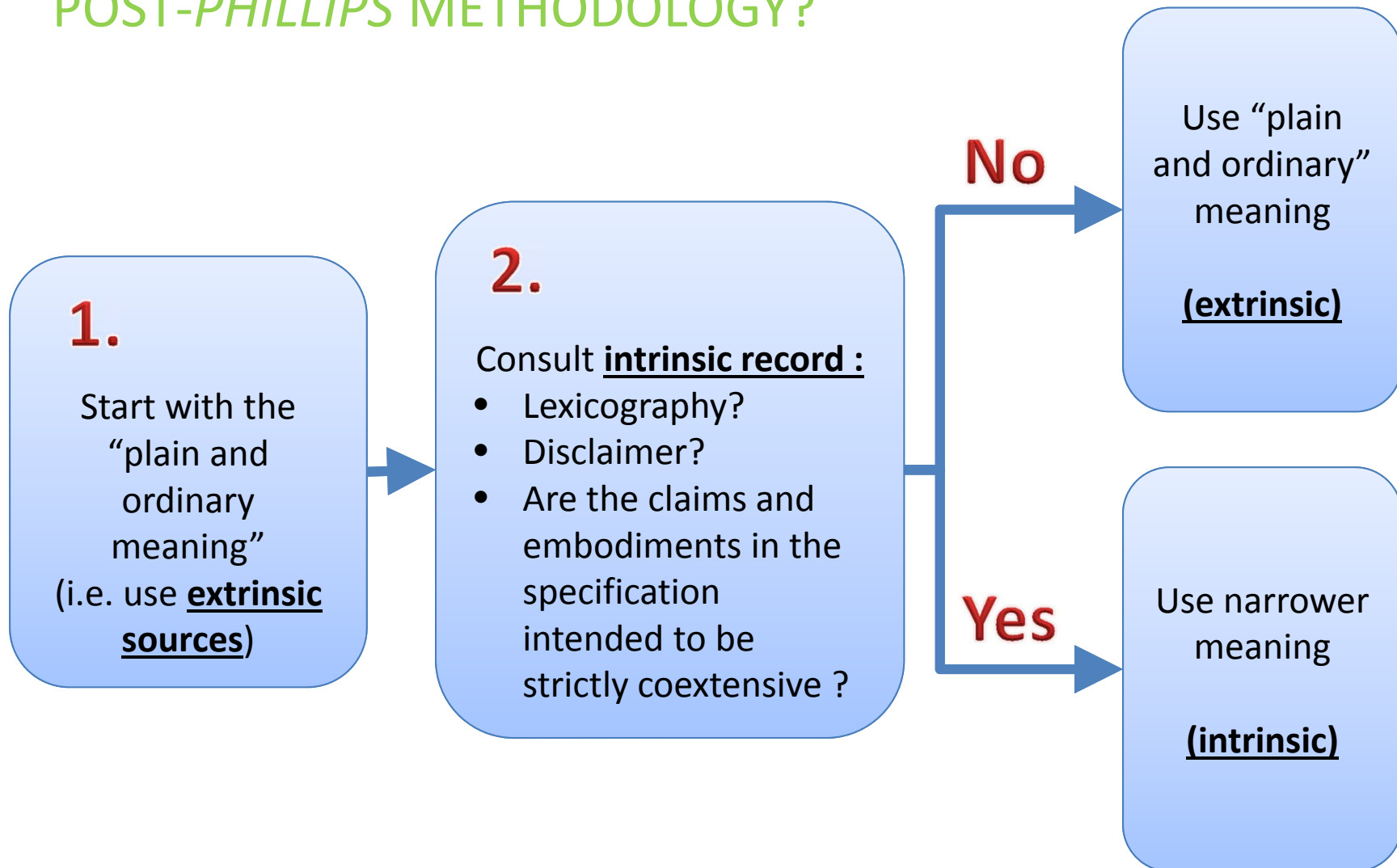
Toshiba Corp. v. Imation Corp., 681 F. 3d 1358 (Fed. Cir. 2012).

SUBSEQUENT CASES HAVE SHIFTED THE ANALYSIS

Courts should not "import limitations into claims from examples or embodiments appearing only in a patent's written description ... unless the specification makes clear that `the patentee... intends for the claims and the embodiments in the specification to be strictly coextensive.'"

Silicon Graphics, Inc. v. ATI Techs., Inc., 607 F.3d 784 (Fed. Cir. 2010)

POST-PHILLIPS METHODOLOGY?



Note: Little consideration of embodiments in the specification

FOUR RECENT CASES POINT TO A DIFFERENT APPROACH

TRUSTEES OF COLUMBIA UNIV. V. SYMANTEC CORP., 811 F.3D 1359 (2016)

- The district court construed "byte sequence feature" to mean a "[f]eature that is a representation of machine code instructions of the executable."
- Columbia disputed that it was limited to machine code instructions.

“Our case law does not require explicit redefinition or disavowal.”

Can *Toshiba* be reconciled?

“Absent disclaimer or lexicography, the plain meaning of the claim controls.”

United States Court of Appeals
for the Federal Circuit

THE TRUSTEES OF COLUMBIA UNIVERSITY IN
THE CITY OF NEW YORK,
Plaintiff-Appellant

v.

SYMANTEC CORPORATION,
Defendant-Appellee

2015-1146

Appeal from the United States District Court for the
Eastern District of Virginia in No. 3:13-cv-00808-JRS,
Senior Judge James R. Spencer.

Decided: February 2, 2016

DAVID ISAAC GINDLER, Irell & Manella LLP, Los
Angeles, CA, argued for plaintiff-appellant. Also represented by RICHARD BIRNHOLZ, JOSEPH M. LIPNER, JASON SHEASBY, GAVIN SNYDER; AARON MARTIN PANNER, Law Office of Aaron M. Panner, PLLC, Washington, DC.

DAVID A. NELSON, Quinn Emanuel Urquhart & Sullivan, LLP, Chicago, IL, argued for defendant-appellee. Also represented by NATHAN HAMSTRA; RICHARD WOLTER

“Phillips rejected an approach ‘in which the specification should be consulted only after a determination is made, whether based on a dictionary, treatise, or other source, as to the ordinary meaning or meanings of the claim term in dispute.’”

United States Court of Appeals
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Office of Aaron M. Panner, PLLC, Washington, DC.

DAVID A. NELSON, Quinn Emanuel Urquhart & Sulli-
van, LLP, Chicago, IL, argued for defendant-appellee.
Also represented by NATHAN HAMSTRA; RICHARD WOLTER

“a claim term may be clearly redefined without an explicit statement of redefinition’ and ‘[e]ven when guidance is not provided in explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents.”

(quoting *Phillips*, 415 F.3d at 13-20-21)

United States Court of Appeals
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TRUSTEES OF COLUMBIA UNIV. V. SYMANTEC CORP., 811
F.3D 1359 (2016)

The court found that Columbia defined “byte sequence feature” to be limited to machine code instructions *by implication*.

EON CORP. IP HOLDINGS LLC V. SILVER SPRING NETWORKS, INC., 815 F.3D 1314 (2016)

- The claims were drawn to two-way interactive communications systems for enabling communications between local subscribers and a base station.
- The claims all recited “mobile” or “portable” devices.
- Eon accused utility meters bolted onto buildings.
- The district court held that “mobile” and “portable” have “their plain and ordinary meaning.” The jury found infringement.

The ordinary meaning of a claim term is not the meaning of the term in the abstract. Instead, the ordinary meaning of a claim term is its meaning to the ordinary artisan after reading the entire patent. . . . A party is, therefore, not entitled to a claim construction divorced from the context of the written description and prosecution history. Ordinary meaning is not something that is determined in a vacuum. To the contrary, a word describing patented technology takes its definition from the context in which it was used by the inventor.

Id. at 1320 (internal quotations and citations omitted).

United States Court of Appeals
for the Federal Circuit

EON CORP. IP HOLDINGS LLC,
Plaintiff-Appellee

v.

SILVER SPRING NETWORKS, INC.,
Defendant-Appellant

2015-1237

Appeal from the United States District Court for the
Eastern District of Texas in No. 6:11-cv-00317-JDL,
Magistrate Judge John D. Love.

Decided: February 29, 2016

DANIEL ROBINSON SCARDINO, Reed & Scardino LLP,
Austin, TX, argued for plaintiff-appellee. Also represented
by CATHERINE BENTLEY HARRIS, JOHN L. HENDRICKS,
RAYMOND WILLIAM MORT, III, JOHN MATTHEW MURRELL.

MARK A. LEMLEY, Durie Tangri LLP, San Francisco,
CA, argued for defendant-appellant. Also represented by
ELIZABETH OFFEN-BROWN KLEIN, ALEXANDRA HELEN
MOSS; BONNIE LAU, Dentons US LLP, San Francisco, CA;
CHARLES GIDEON KORRELL, ROBERT KRAMER, Palo Alto,
CA; ALAN HODES, Silver Spring Networks, Redwood City,
CA.

Eon's position is completely untethered to the context of the invention in this case. Although the terms “portable” and “mobile” might theoretically, in the abstract, be given such a broad meaning, they cannot be construed that way in the context of the [] patents. . . .

United States Court of Appeals
for the Federal Circuit

EON CORP. IP HOLDINGS LLC,
Plaintiff-Appellee

v.

SILVER SPRING NETWORKS, INC.,
Defendant-Appellant

2015-1237

Appeal from the United States District Court for the
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CHARLES GIDEON KORRELL, ROBERT KRAMER, Palo Alto,
CA; ALAN HODES, Silver Spring Networks, Redwood City,
CA.

Read in their appropriate context, the terms “portable” and “mobile” cannot be construed as covering the accused meters in this case.

Id. at 1321 (internal quotations and citations omitted).

United States Court of Appeals
for the Federal Circuit

EON CORP. IP HOLDINGS LLC,
Plaintiff-Appellee

v.

SILVER SPRING NETWORKS, INC.,
Defendant-Appellant

2015-1237

Appeal from the United States District Court for the
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CA; ALAN HODES, Silver Spring Networks, Redwood City,
CA.

RUCKUS WIRELESS, INC. V. INNOVATIVE WIRELESS SOLUTIONS, LLC, ___ F.3D ___ (FED. CIR. MAY 31, 2016)

- The claims all recited a “communication path.”
- Ruckus argued that “communication path” has a plain and ordinary meaning that encompasses wireless communication.
- The district court limited the term to wired communication.
- The Federal Circuit affirmed. . .

First, the title of the . . . patents indicates that they are directed to “Communicating Information Packets *Via Telephone Lines*.”

Second, the specification describes “[t]his invention” as one “particularly concerned” with “two wire lines such as telephone subscriber lines.”

Third, every embodiment described in the specification utilizes a telephone wire . . .

United States Court of Appeals
for the Federal Circuit

RUCKUS WIRELESS, INC., CISCO SYSTEMS, INC.,
Plaintiffs-Appellees

v.

INNOVATIVE WIRELESS SOLUTIONS, LLC,
Defendant-Appellant

2015-1425, 2015-1438

Appeals from the United States District Court for the
Western District of Texas in Nos. 1:13-cv-00492-LY, 1:13-
cv-00504-LY, Judge Lee Yeakel.

Decided: May 31, 2016

MATTHEW YUNGWIRTH, Duane Morris LLP, Atlanta,
GA, argued for plaintiffs-appellees. Also represented by L.
NORWOOD JAMESON; DIANA SANGALLI, Houston, TX.

JONATHAN DANIEL BAKER, Farney Daniels PC, San
Mateo, CA, argued for defendant-appellant. Also repre-
sented by MICHAEL D. SAUNDERS, Georgetown, TX.

Though these statements do not expressly exclude wireless communications from the meaning of “communications path,” they do not include it, and they discourage that understanding.

Slip op. at 7-8.

United States Court of Appeals
for the Federal Circuit

RUCKUS WIRELESS, INC., CISCO SYSTEMS, INC.,
Plaintiffs-Appellees

v.

INNOVATIVE WIRELESS SOLUTIONS, LLC,
Defendant-Appellant

2015-1425, 2015-1438

Appeals from the United States District Court for the
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sented by MICHAEL D. SAUNDERS, Georgetown, TX.

ULTIMATEPOINTER, LLC V. NINTENDO CO., LTD., 816 F.3D
816 (FED. CIR. 2016)

We have cautioned against importing limitations from the specification into the claims when performing claim construction, . . . however, we have also recognized that “repeated derogatory statements” can indicate that the criticized technologies were not intended to be within the scope of the claims . . .

United States Court of Appeals
for the Federal Circuit

ULTIMATEPOINTER, L.L.C.,
Plaintiff-Appellant

v.

NINTENDO CO., LTD.,
NINTENDO OF AMERICA INC.,
Defendants-Appellees

2015-1297

Appeal from the United States District Court for the
Western District of Washington in No. 2:14-cv-00865-
RSL, Judge Robert S. Lasnik.

Decided: March 1, 2016

CHARLES JOHN ROGERS, Conley Rose, P.C., Houston,
TX, argued for plaintiff-appellant. Also represented by
GREGORY LOREN MAAG, THOMAS WARDEN, MICHAEL JAMES
GUTHRIE.

JERRY A. RIEDINGER, Perkins Coie, LLP, Seattle, WA,
argued for defendants-appellees. Also represented by
TYLER C. PETERSON; MARK CHRISTOPHER NELSON, STEVEN
M. GEISZLER, RICHARD SALGADO, Dentons US LLP, Dallas,
TX.

WI-LAN USA, INC. V. APPLE INC., APPEAL NO. 2015-1256, ____
F.3D ____ (FED. CIR. AUG. 1, 2016)

GPNE CORP. V. APPLE, INC., APPEAL NO. 2015-1825, ____ F.3D ____
(FED. CIR. AUG. 1, 2016)

“When a patent repeatedly and consistently characterizes a claim term in a particular way, it is proper to construe the claim term in accordance with that characterization.”

WHERE TO START? EXTRINSIC OR INTRINSIC DEFINITION?

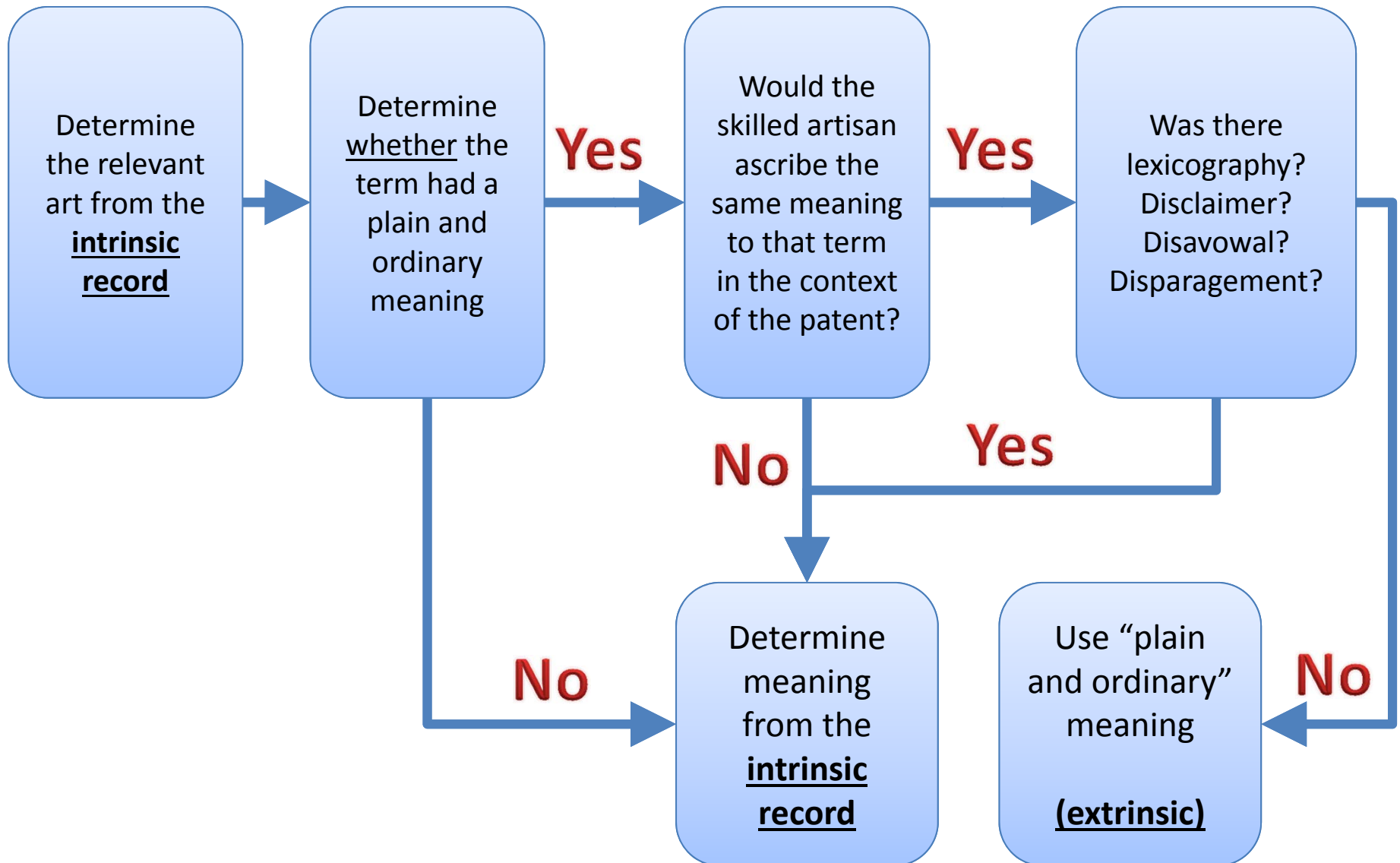
“*Phillips* rejected an approach ‘in which the specification should be consulted only after a determination is made, whether based on a dictionary, treatise, or other source, as to the ordinary meaning or meanings of the claim term in dispute.’”

Trustees of Columbia Univ. v. Symantec Corp., 811 F.3d 1359 (2016)

. . . if a district court . . . makes a factual finding that, in general, a certain term of art had a particular meaning to a person of ordinary skill in the art at the time of the invention, the district court must then conduct a legal analysis: whether a skilled artisan would ascribe that same meaning to that term *in the context of the specific patent claim under review*.

Teva Pharms. USA v. Sandoz, Inc., 135 S. Ct. 831, 841 (2015)

A NEW APPROACH?



A NOTE ABOUT EXPERT OPINIONS

"[e]xperts may be examined to explain terms of art, and the state of the art, at any given time," but they cannot be used to prove "the proper or legal construction of any instrument of writing."

Teva Pharms. USA v. Sandoz, Inc., 135 S. Ct. 831, 841 (2015) (emphasis added)

TWO ISSUES

1. Cases on Context
2. “Correct construction” v.
“broadest reasonable
interpretation”

TWO CLAIM CONSTRUCTION STANDARDS?

“The Court of Appeals held that [35 U. S. C. § 316(a)(4)] gives the Patent Office the legal authority to issue its broadest reasonable construction regulation. We agree.”

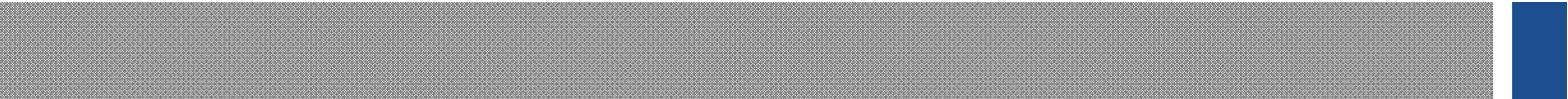
Cuozzo v. Lee, ___ U.S. ___ (June 20, 2016)

TWO CLAIM CONSTRUCTION STANDARDS?

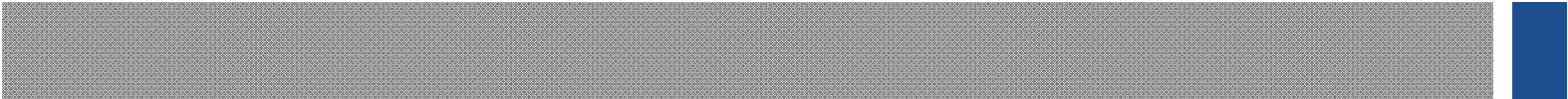
“[C]laim construction in IPRs is not governed by *Phillips*. Under *Cuozzo*, claims are given their broadest reasonable interpretation consistent with the specification, not necessarily the correct construction under the framework laid out in *Phillips*.”

PPC Broadband v. Corning Optical Comms. RF, LLC, 815 F. 3d 734, 742 (Fed. Cir. 2016)

Broadest Reasonable Interpretation	"Correct Construction" under Phillips
Used in:	



Broadest Reasonable Interpretation	“Correct Construction” under Phillips
Scope:	



REASON FOR THE DIFFERENCE

“. . . the applicant and the examiner interact to define the invention so as to distinguish or avoid overlap with prior art.”

“. . . the PTO broadly interprets claims during examination since the applicant may amend his claims to obtain protection commensurate with his actual contribution to the art”

“Giving proposed claims their broadest reasonable interpretation serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.”

“the broadest interpretation is not unfair to applicants, because before a patent is granted the claims are readily amended as part of the examination process”

In re Cuzo Speed Techs., LLC, 793 F.3d 1268, 1286-87 (Fed. Cir. 2015) (Newman, J., dissenting)

SAS INSTITUTE V. COMPLEMENTSOFT, LLC

- Appeal of an IPR
- Applied the broadest reasonable interpretation standard
- Issued 10 days before the Supreme Court decision in *Cuozzo*.

THE MERGER OF BRI AND *PHILLIPS*?

In an IPR proceeding, claims are given their broadest reasonable interpretation in light of the specification. . . .

THE MERGER OF BRI AND *PHILLIPS*?

SAS argues that because the Board's construction is narrow, it cannot be the broadest reasonable interpretation of the claim term. This is not so. . . . [We] take care to not read “reasonable” out of the standard. This is to say that “[e]ven under the broadest reasonable interpretation, the Board's construction cannot be divorced from the specification and the record evidence, and must be consistent with the one that those skilled in the art would reach.”

SAS Institute v. ComplementSoft, LLC, Appeal Nos. 2015-1346, 2015-1347, slip op. at 12 (Fed. Cir. June 10, 2016)

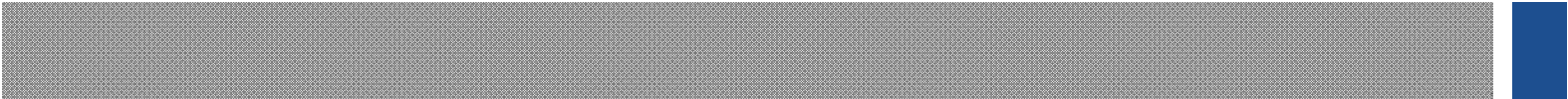
SAS INSTITUTE V. COMPLEMENTSOFT, LLC

- In all, the Court cited *Phillips* six times
- It also relied on four other cases applying the *Phillips* standard:
 - *Omega Eng'g, Inc., v. Raytek Corp.*, 334 F.3d 1314, 1325–26 (Fed. Cir. 2003).
 - *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1359 (Fed. Cir. 2003),
 - *Avid Tech., Inc. v. Harmonic, Inc.*, 812 F.3d 1040, 1045 (Fed. Cir. 2016)
 - *Rheox, Inc. v. Entact, Inc.*, 276 F.3d 1319, 1327 (Fed. Cir. 2002)

OTHER 2016 CASES FINDING BRI TO BE “UNREASONABLE”

- *Dell Inc. v. Acceleron, LLC*, 818 F.3d 1293 (Fed. Cir. Mar. 15, 2016)
- *PPC Broadband, Inc. v. Corning Optical Comms RF, LLC*, 815 F.3d 734 (2016)
- *Cutsforth, Inc. v. MotivePOWER, Inc.*, Appeal No. 2015-1314, 2016 U.S. Appl. LEXIS 6262 (Fed. Cir. Apr. 6, 2016) (nonprecedential)

Broadest Reasonable Interpretation	"Correct Construction" under <i>Phillips</i>
Tools:	



Merger of BRI and *Phillips* analysis makes sense after claims have issued

- The claims are fixed
- The prosecution history has fully developed
- The intrinsic record is closed

“In 9 out of 10 cases, actually, [using BRI or *Phillips* claim construction is] not going to make a difference.”

PTAB Chief Judge Michael Tierney, July 20, 2016

IN SEARCH OF A (NARROWER) MEANING



A PARTNER FOR
LAUNCHING AND
PROTECTING YOUR
TECHNOLOGIES

Schwabe
WILLIAMSON & WYATT