

HOW TO DRAFT A PERSUASIVE MARKMAN BRIEF

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TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	CLAIM CONSTRUCTION CONSIDERATIONS THAT MAY AFFECT THE CHOICE OF FORUM.....	1
	A. Timing and procedural considerations affect the choice of forum.....	1
	1. The timing of the claim construction process and hearing influences both parties’ choice of forum.	1
	2. Procedural considerations that affect the choice of forum.	2
	B. Fast-track, judicial predilections and other considerations.....	3
III.	PREPARE EARLY, PREPARE THOROUGHLY, AND THEN PREPARE SOME MORE TO GAIN AN EARLY ADVANTAGE.	4
	A. Develop an overarching mastery of the facts from both sides’ perspective to identify the key claim construction issues before your opponent.	4
	B. Develop an encyclopedic knowledge of the law.	4
	1. <i>Phillips v. AWH Corp.</i> – the Federal Circuit reexamines claim construction.....	4
	2. Other Claim Construction Cannons.....	6
	3. Means-Plus-Function Claims	7
IV.	CORRECTLY IDENTIFY THE KEY TERMS, PROFFER CONVINCING CASE-WINNING CONSTRUCTIONS, AND OUTMANUEVER YOUR OPPONENT DURING NEGOTIATION.....	8
	A. Correctly identify the key terms and proffer cogent constructions.	8
	B. Secure the advantage during negotiation.....	9
	1. Capitalize on the order of presentation.....	9
	2. Control the paper.	9
	3. Make the most of your superior legal knowledge.....	10
	a. Propose cogent, defensible constructions, which, if adopted, will achieve the desired end result.	10
	b. Eliminate inconsistencies.....	10
	c. Attack opponent’s “vexatious shuffling.”.....	10
	d. Oops! Make last-minute “clarifications” if you need to.	10
V.	USE THE TUTORIAL TO INTRODUCE YOUR CLAIM CONSTRUCTION THEMES.	10
	A. Advance your client’s claim construction position by introducing your claim construction themes.....	11
	B. Teach to your advantage.....	11
VI.	DRAFT THE PERSUASIVE BRIEF.	11
	A. Begin with an outline.	11
	B. Impress the judge with your version of the facts (or work them into the tutorial).	11
	1. Carefully consider which facts to include.	12
	2. Include a narrative of the invention and a summary of the prosecution history.....	12
	a. The description of the invention and the patented technology should be consistent with your major case themes.....	12
	b. A description of the prosecution history is usually valuable to the accused infringer.....	12
	3. Discuss prior art and the accused device when appropriate.	13
	a. “Dead on” prior art	13
	b. The accused device.	13
	C. Create a legal primer that educates the judge and subtly advocates your client’s position.....	14
	D. Fully develop the claim construction arguments that are convincing and will win your case.	14
	1. Frame introductory argument(s) in terms of simple, unifying themes.	14
	2. Focus on the terms that matter.....	14
	3. Organize your individual arguments in an effective manner.....	15
	a. Try to cast each issue as a syllogism.	15
	b. Incorporate dialectic into your individual arguments to effectively deal with counterarguments on your turf.	15
	c. Use signposts to help reduce the judge’s workload.	15
	d. Make the arguments flow.	15

- e. Say something about the cases that are critical to your proposed construction..... 15
- E. Use graphics, figures, and other visual aids to help the judge understand the argument and drive your point home. 16
- F. Other helpful hints..... 16
 - 1. Consider putting case citations in footnotes. 16
 - 2. Make clean copies of exhibits. 16
- VII. CONSIDER SIMULTANEOUSLY FILING A § 112 MOTION TO INDIRECTLY SUPPORT CERTAIN CLAIM CONSTRUCTION POSITIONS..... 16
- VIII. REMEMBER THAT CLAIM CONSTRUCTION DOES NOT NECESSARILY END WITH THE *MARKMAN* RULING. 17
- IX. CONCLUSION 18

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I. INTRODUCTION

The claim construction or *Markman* decision¹ is often case determinative. Claim construction, in fact, is so important that the majority of patent cases settle once the court construes the claims.² It is critical, therefore, that the attorneys involved in the claim construction process conduct that process to produce a winning outcome – a claim construction that advantages their client.

A well written, persuasive claim construction brief is the rock upon which a winning claim construction is built. But, the process of crafting a winning claim construction position begins long before the brief is written. The process begins even before the case is filed. This paper examines the dynamics of building a winning claim construction position beginning with the selection of the forum and continuing through drafting the persuasive claim construction brief. The paper concludes with a brief examination of other strategies that may be utilized to bolster a party's claim construction argument.

II. CLAIM CONSTRUCTION CONSIDERATIONS THAT MAY AFFECT THE CHOICE OF FORUM

The first step to consider in crafting a winning claim construction position is the choice of forum. The choice of forum dictates the timing of the claim construction process, the way in which that process is performed, whether a tutorial and/or expert testimony is permitted, the page limits for briefing, the length and format for the hearing, whether a special master or scientific advisor will be used, and the amount of time until the claim construction decision is rendered.

Ultimately, the best forum is the one that provides your client with the greatest chance of accomplishing

its overall goals. Because obtaining a favorable claim construction is crucial to achieving those goals, it is critical that the claim construction procedures are carefully considered as part of the overall forum-selection strategy.

A. Timing and procedural considerations affect the choice of forum.

1. The timing of the claim construction process and hearing influences both parties' choice of forum.

The Supreme Court's *Markman* decision delegated the role of claim construction to the exclusive province of the court based upon the premise that judges are generally better trained and more disciplined for the task.³ The Court expressed its expectation that judge-based claim construction would lead to greater uniformity and consistency in patent cases. "Otherwise, a 'zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field,' and '[t]he public [would] be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights.'"⁴

As a general rule, patent holders tend to favor not having a claim construction hearing at all, or having the claim construction hearing late in the case near the end of or after the close of discovery. The reasons for this preference are straightforward – the later the claims are construed, the less time the defendant has to adjust to the claim construction ruling, by, for example, taking additional discovery, locating additional prior art, or modifying its defensive strategy. Additionally, because it is difficult to file summary judgment motions, especially invalidity motions based upon prior art, without a claim construction, delaying the claim construction process decreases the odds that the patent holder will be poured out on summary judgment.

Accused infringers, on the other hand, normally push to have the claims construed as early in the case as possible. Again, the reasons for this preference are clear – once the court construes the claims, the defen-

¹ The name *Markman* comes from the case *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996) where the Supreme Court held that claim construction was a matter of law for the court to decide. Throughout this paper the terms "*Markman* brief" and "claim construction brief" are used interchangeably.

² See Kimberly A. Moore, *Forum Shopping in Patent Cases: Does Geographic Choice Affect Innovation*, 79 N.C. L. REV. 889 (2001) (comparing settlement times for cases filed in N.D. Cal. with settlement times for cases filed in Delaware, which often delays claim construction and finding that the cases filed in N.D. Cal. settled earlier); Mark A. Lemley, *Rational Ignorance at the Patent Office*, 95 NW U. L. REV. 1495, 1501 (2001) ("The overwhelming majority of [patent] cases settle or are abandoned before trial.").

³ *Markman*, 517 U.S. at 388-89 ("The construction of written instruments is one of those things that judges often do and are likely to do better than jurors unburdened by training in exegesis. Patent construction in particular 'is a special occupation, requiring, like all others, special training and practice. The judge, from his training and discipline, is more likely to give a proper interpretation to such instruments than a jury; and he is, therefore, more likely to be right, in performing such a duty, than a jury can be expected to be.'") (quoting *Parker v. Hulme*, 18 F. Cas. 1138, 1140 (No. 10, 470) (CC ED. Pa. 1849)).

⁴ *Id.* at 390 (additional citations omitted).

dant can focus its prior-art search, refine its non-infringement defenses, and possibly limit the amount of discovery obtainable by the plaintiff. Moreover, if the ruling is favorable the defendant may be able to obtain summary judgment, or get the plaintiff to stipulate to non-infringement for the purpose of appealing the claim construction to the Federal Circuit, and thereby avoid the cost of protracted discovery altogether.

Support exists for both positions. For example, some commentators support having the *Markman* hearing late in the case because, they reason, holding them too early deprives the plaintiff of the necessary information about the accused product(s) and possibly anticipating art that they need to fully develop their claim construction position.⁵ According to these commentators, “holding *Markman* hearings very early in the course of litigation is undesirable and inefficient, as is holding them any time after opening arguments during the infringement trial.”⁶ Other commentators counter that early claim construction leads to early settlement, thereby avoiding years of potentially expensive and vexing litigation.⁷ Defendants bolster this argument by citing the axiom that since “claim construction is done without regard for the accused device,” permitting such discovery prior to claim construction is inherently wasteful and unnecessary.⁸

For its part, the Federal Circuit does not prescribe any specific timing or procedure for the claim construction. Rather, the Federal Circuit simply requires that the trial courts “exercise [their] discretion to interpret the claims at a time when the parties have presented a full picture of the claimed invention and prior art.”⁹ Indeed, the Federal Circuit, in *Markman*, indi-

cated that the trial court could even wait until it framed the jury charge before construing the claims.¹⁰ The timing of the claim construction hearing, therefore, will likely remain one of the earliest, hotly contested issues in a patent case.

2. Procedural considerations that affect the choice of forum.

The existence of local rules governing patent cases (“Patent Rules”) may affect the choice of forum. One of the most frustrating aspects to conducting patent litigation can be the inability to obtain the information from the other party in time to adequately prepare for claim construction. Plaintiff patent holders often attempt to keep the defendant guessing at their positions by refusing to identify the claims-in-issue and by failing to provide infringement reads with any meaningful detail.

Defendants are often no better. They withhold information about both the accused devices and the prior art in hopes of limiting the scope of the lawsuit to already identified products and luring the plaintiff into adopting claim construction positions that open them up to invalidity and non-infringement attacks.

The courts are catching on to this game. Beginning with the Northern District of California, many courts that routinely hear patent cases have adopted Patent Rules that specifically govern the timing of these necessary disclosures to level the playing field for the claim construction process. These Rules are also designed to foster cooperation by requiring that the parties disclose their proposed claim construction positions in writing and mandating negotiation prior to the briefing to encourage the parties to adopt agreed constructions thereby reducing the burden on both the parties and the court.¹¹

An example of some of the key claim-construction-related provisions from the Patent Rules of the Eastern District of Texas, is provided below:

- **Disclosure of Asserted Claims and Preliminary Infringement Contentions.** No later than 10 days after the Initial Case Management Conference;
- **Disclosure of Preliminary Invalidity Contentions.** No later than 45 days after the service of

⁵ See, e.g., William F. Lee & Anita K. Krug, *Still Adjusting to Markman: A Prescription for the Timing of Claim Construction Hearings*, 13 HARV. J. LAW & TECH. 55 (1999).

⁶ *Id.*; see also Section VIII, *infra*.

⁷ See, e.g., Patricia A. Martone, *Before the Actual Markman Hearing: Timing, Discovery, and Alternatives*, 753 PLI/PAT 91 (2003) (“Early claim construction may also facilitate settlement.”).

⁸ See, e.g., *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1340 (Fed. Cir. 2005).

⁹ *Sofamor Danek Group, Inc. v. DePuy-Motech, Inc.*, 74 F.3d 1216, 1221 (Fed. Cir. 1996); see also Dana D. McDaniel, “Patent Litigation on the Rocket Docket After *Markman v. Westview Instruments, Inc.*,” VIRGINIA LAWYER, at 22 (April 2002) (observing that *Markman* hearings are typically held late in the case, after the close of discovery), available at

<http://www.vsb.org/publications/valawyer/apr02/mcdaniel.pdf> (last visited May 1, 2004).

¹⁰ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 981 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370 (1996).

¹¹ Thus far, at least the Northern and Southern Districts of California, the Eastern District of Texas, the Western District of Pennsylvania, the Northern District of Georgia, and the District of Minnesota have adopted Patent Rules.

the Asserted Claims and Preliminary Infringement Contentions;

- **Exchange of Proposed Terms and Claim Elements for Construction.** No later than 10 days after the service of the Preliminary Invalidity Contentions;
- **Exchange of Preliminary Claim Constructions and Extrinsic Evidence.** No later than 20 days after the exchange of the Proposed Terms and Claim Elements for Construction;
- **Joint Claim Construction and Prehearing Statement.** No later than 60 days after service of the Preliminary Invalidity Contentions;
- **Completion of Claim Construction Discovery.** No later than 30 days after service and filing the Joint Claim Construction Statement;
- **Claim Construction Briefs.** No later than 45 days after serving and filing the Joint Claim Construction Statement the party claiming patent infringement shall serve and file its opening brief; Not later than 14 days after service upon it of an opening brief, each opposing party shall serve and file its responsive brief; Not later than 7 days after service upon it of a responsive brief, the party claiming patent infringement shall serve and file any reply brief;
- **Claim Construction Chart.** At least 10 days before the Claim Construction Hearing, the parties shall jointly submit a claim construction chart on a computer disk in WordPerfect format that identifies the complete language of the disputed claims with disputed terms in bold type and separate columns for each party's proposed construction. The chart may also include a column for AGREED terms; and
- **Claim Construction Hearing.** Subject to the court's calendar, the Claim Construction Hearing shall take place two weeks following the submission of the reply brief.

In sum, if you fear that obtaining disclosure from potential defendants will be difficult, or if you value the scheduling certainty, consider filing in a jurisdiction that has adopted the Patent Rules.

B. Fast-track, judicial predilections and other considerations.

Other claim construction-related considerations may also be important when choosing the forum. For example, where the patents-in-suit are extremely complex, or where a particular judge or special master has previous experience with the specific technology or with the patents to be asserted, it may be important to be in a particular forum. Likewise, there are times where the perceived advantage of the patent holder's (or the declaratory judgment plaintiff's) home turf

trumps possible advantages that come from a fast-track forum, or a forum that has adopted Patent Rules.

But, where settlement or a speedy trial is the ultimate goal, a fast-track forum may be preferred. Heaping intense, relentless pressure on the opponent is a good way to achieve settlement. So-called fast-track forums do not permit the parties a lot of time to conduct discovery, search for prior art, or develop other defenses prior to the claim construction hearing and ruling. As such, they are often the preferred forums in patent cases. Information on mean time to trial may be obtained at <http://www.uscourts.gov>.

Another fast-track forum that hears numerous patent cases is the International Trade Commission ("ITC"). So-called 337 investigations¹² require that (i) an industry exists or is in the process of formation in the U.S. relating to the intellectual property,¹³ (ii) an intellectual property right is valid and infringed, and (iii) the products at issue are imported. The ITC is extremely fast.¹⁴ Thus, there is immediate pressure on the defendant (termed the respondent in ITC parlance) to develop its claim construction positions. Additionally, because the remedy for a violation of Section 1337 is an exclusion order prohibiting importation of the offending product, a complainant obtaining such an order may have tremendous leverage to force a favorable settlement.¹⁵

In sum, when choosing the proper forum, be mindful of claim construction considerations, but choose the forum that gives your client the best chance of achieving its overall goal.

¹² ITC investigations are instituted pursuant to Section 1337 of the Tariff Act of 1930. 19 U.S.C. § 1337.

¹³ The "domestic industry" requirement may be satisfied by certain operations or investment to exploit the patent(s) in the United States, for example, the existence of United States licensees or a licensing program may suffice. 19 U.S.C. § 1337(a)(3).

¹⁴ The ITC usually sets a target date for completing an investigation at twelve months after institution. This means that claim construction may occur within six months of case initiation and trial may occur between six and nine months of case initiation.

¹⁵ The availability of an exclusion order (essentially an injunction) as a remedy may become paramount in light of the Supreme Court's recent ruling in *eBay, Inc. v. Mercexchange, LLC*, 2006 WL 1310670 (May 15, 2006). There, the Supreme Court held that patent cases are to be treated like other cases regarding the propriety of injunctive relief. If this ruling signals a departure from the normal practice of granting injunctions in patent cases, then the availability of an exclusion order from the ITC could become a paramount factor in choosing the proper forum.

III. PREPARE EARLY, PREPARE THOROUGHLY, AND THEN PREPARE SOME MORE TO GAIN AN EARLY ADVANTAGE.

Early and thorough preparation is crucial to achieving a claim construction victory. Understanding both your case and your opponent's case gives you a significant advantage over your opponent by enabling you to identify the key terms that need construction and to propose the constructions for those key terms that are necessary to win your case. A mastery of the law lets you convincingly argue those constructions to the court.

A. Develop an overarching mastery of the facts from both sides' perspective to identify the key claim construction issues before your opponent.

A key element of every persuasive claim construction brief is an overarching knowledge of the facts – from both sides' perspective. A thorough understanding of the technology, the patent and its file history, the accused device, and the prior art permits a party to identify and focus on the “must win” terms. Such knowledge also permits a party to construct a convincing tutorial, create compelling graphics, and to utilize the claim construction principles discussed below in the most forceful fashion to craft a winning claim construction brief. These principles are more fully explored below in Sections IV-VI.

B. Develop an encyclopedic knowledge of the law.

The Federal Circuit's massive, complex, and sometimes seemingly inconsistent body of claim construction jurisprudence enables plaintiffs and defendants alike to set forth strong, contrasting legal arguments in favor of their proposed claim constructions. A litigator that neglects the opportunity to favorably frame the law gives his opponent an even greater opportunity to adversely frame the law. Although this paper is not intended to be a tome on claim construction law, the following summary of the Federal Circuit's most recent en banc claim construction decision as well as some common claim constructions are set forth to provide context for later sections.

1. *Phillips v. AWH Corp.* – the Federal Circuit reexamines claim construction.

Any claim construction brief filed after July 12, 2005 should include reference to the Federal Circuit's en banc *Phillips v. AWH Corp.* decision.¹⁶ In that case, the Federal Circuit reexamined the extent to which it should resort to and rely on the specification to ascertain the proper scope of disputed claim lan-

guage.¹⁷ “It is a ‘bedrock principle’ of patent law, the court began, that ‘the claims of a patent define the invention to which the patentee is entitled the right to exclude.’”¹⁸ Thus, claim construction analysis begins and ends with the words of the claims.¹⁹

The words of a claim are generally given the ordinary and customary meaning that they would have to a person of ordinary skill in the art at the time of the invention (*i.e.*, as of the effective filing date of the patent application).²⁰ In some cases, this ordinary and customary meaning is readily apparent even to lay judges, and claim construction involves little more than the application of the widely accepted meaning of commonly understood words.²¹ In such circumstances, general-purpose dictionaries may be helpful.²² In other cases, however, the ordinary and customary meaning of the claim term is not apparent and must be divined from other sources. Those sources include “the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.”²³

To begin, the context in which a term is used in the asserted claim can be highly instructive. Likewise, differences among claims often provide a useful guide in understanding the meaning of a particular claim term.²⁴ For example, the presence of a dependant claim containing a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim.²⁵

¹⁷ *Id.* at 1312.

¹⁸ *Id.* (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 318 F.3d 1111, 1115 (Fed. Cir. 2004)).

¹⁹ See Hon. Giles S. Rich, *Extent of Protection and Interpretation of Claims – American Perspectives*, 21 INT'L REV. INDUS. PROP. & COPYRIGHT L. 497, 499 (1990) (“The name of the game is the claim.”).

²⁰ *Phillips*, 415 F.3d at 1312.

²¹ *Id.* (citations omitted).

²² *Id.* at 1314.

²³ *Id.* (quoting *Gemstar-TV Guide Int'l, Inc. v. Int'l Trade Comm'n*, 383 F.3d 1352, 1364 (Fed. Cir. 2004) (other citations omitted)).

²⁴ *Id.* at 1314.

²⁵ *Id.* at 1315 (citing *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004)).

¹⁶ 415 F.3d 1303 (Fed. Cir. 2005).

The claims, of course, are not read alone. Rather, the person of ordinary skill in the art is deemed to read the claim terms in the context of the entire patent, including the specification and prosecution history.²⁶ Indeed, the Federal Circuit has long held that the specification “‘is always highly relevant to the claim construction analysis. . . . [I]t is the single best guide to the meaning of a disputed term.’”²⁷ The importance of the specification derives from the statutory mandate that the inventor describe the claimed invention in “‘full, clear, concise, and exact terms.’”²⁸ Thus, a fundamental rule of claim construction is that claims must be construed so as to be consistent with the specification of which they are a part.²⁹ Where, for example, the specification reveals a special definition given to a claim term by the inventor that differs from the meaning it would otherwise possess, the inventor’s lexicography controls.³⁰ Similarly, where the specification reveals an intentional disclaimer, or disavowal, of claim scope by the inventor, the objective evidence of the inventor’s intention is again dispositive.³¹ Ultimately,

the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim. The construction that stays true to the claim language and most naturally aligns with the patent’s description of the invention will be, in the end, the correct construction.³²

When construing the claim “a court ‘should always consider the patent’s prosecution history, if it is in evi-

dence.’”³³ Because the prosecution history is a record created by the patentee to explain his invention to the PTO, it provides evidence of how the PTO and the inventor understood the invention.³⁴ The prosecution, therefore, is often critical because it may demonstrate whether the inventor limited the invention during prosecution, for example, to avoid specific prior art, and thereby narrowed the claim scope.³⁵ But the *Phillips* court cautioned, because the prosecution is the result of “ongoing negotiation” between the applicant and the PTO, rather than a final product of that negotiation, “it often lacks the clarity of the specification and thus is less useful for claim construction purposes.”³⁶

Extrinsic evidence, for example dictionaries and expert testimony, “is less significant than the intrinsic record in determining ‘the legally operative meaning of claim language.’”³⁷ Undue reliance on extrinsic evidence poses the risk that it will be used to change the meaning of claims in derogation of the “‘indisputable public records consisting of the claims, the specification and the prosecution history,’ thereby undermining the public notice function of patents.”³⁸

Turning to the role of dictionaries in claim construction, the *Phillips* court examined its decision in *Texas Digital*³⁹ and then clarified the proper role of dictionaries in the claim construction analysis. In *Texas Digital*, the court began its claim construction analysis by determining the ordinary and customary meaning of the claim term in issue from a relevant dic-

²⁶ *Id.* at 1313. See also *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005) (“We cannot look at the ordinary meaning of the term . . . in a vacuum. Rather we must look at the ordinary meaning in the context of the written description and the prosecution history.”).

²⁷ *Id.* at 1315 (citing *Vitronics*, 90 F.3d at 1582).

²⁸ *Id.* at 1316; 35 U.S.C. § 113, ¶ 1.

²⁹ *Id.* (quoting *Merck & Co. v. Teva Pharms. USA, Inc.*, 347 F.3d 1367, 1371 (Fed. Cir. 2003)).

³⁰ *Id.*; See also *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002).

³¹ *Id.*; See also *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1343-44 (Fed. Cir. 2001).

³² *Id.* (quoting *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998)).

³³ *Id.* at 1317 (citations omitted).

³⁴ *Id.*

³⁵ *Id.*; See also *Chimie v. PPG Indus., Inc.*, 402 F.3d 1371, 1384 (Fed. Cir. 2005) (“The purpose of consulting the prosecution history in construing a claim is to ‘exclude any interpretation that was disclaimed during prosecution.’”) (quoting *ZMI Corp. v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 1580 (Fed. Cir. 1988)).

³⁶ *Id.*; See also *Inverness Med. Switz. GmbH v. Warner Lambert Co.*, 309 F.3d 1373, 1380-82 (Fed. Cir. 2002) (noting that the ambiguity of the prosecution history made it less relevant to claim construction); accord *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1580 (Fed. Cir. 1996).

³⁷ *Id.*

³⁸ *Id.* at 1319 (citing *Southwall Techs.*, 54 F.3d at 1578).

³⁹ *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002).

tionary.⁴⁰ The specification and prosecution were then consulted to ascertain whether the patentee had used the term in a way that was inconsistent with the ordinary and customary meaning set forth in the dictionary.⁴¹ The court concluded that it was improper to consult the specification and prosecution as a threshold step in claim construction before any effort was made to discern the ordinary and customary meaning attributed to the words themselves.⁴²

The *Phillips* court disagreed with this “dictionaries-first” approach. Writing for the court, Judge Bryson observed that the approach used in *Texas Digital* marginalized the role of “the specification in claim construction to serving as a check on the dictionary meaning of a claim term if the specification requires the court to conclude that fewer than all dictionary definitions apply, or if the specification contains a sufficiently specific alternative definition or disavowal.”⁴³ Assigning such a limited role to the specification, however, is inconsistent with the Federal Circuit’s previous rulings. Such an approach improperly focuses the inquiry on the abstract meaning of words rather than on the meaning of the claim terms in the context of the patent.⁴⁴ Such “heavy reliance on the dictionary divorced from the intrinsic evidence risks transforming the meaning of the claim term to the artisan into the meaning of the term in the abstract, out of its particular context. . . .”⁴⁵ This error “will systematically cause the construction of the claim to be unduly expansive.”⁴⁶ Moreover, it is axiomatic, that “[a] claim should not rise or fall based upon the preferences of a particular dictionary editor, or the court’s independent decision, uninformed by the specification, to rely on one dictionary rather than another.”⁴⁷ The proper methodology, therefore, permits judges to rely on dictionaries “to better understand the underlying technology” and to “construe claim terms” so long as “the dictionary defi-

inition does not contradict any definition found in or ascertained by a reading of the patent documents.”⁴⁸

2. Other Claim Construction Cannons.

Although the *Phillips* case provides a good starting point for claim construction analysis, it is not an end point. There are many other claim construction principles/cannons, often which conflict with another, that are useful in drafting a persuasive claim construction brief. Some of these principles – framed from the contrasting perspectives of the plaintiff and defendant – include:

- Plaintiff: The chief objective of claim construction is to give the jury clear guidance.⁴⁹
- Defendant: The claim construction exercise often decides the infringement question thereby facilitating faster resolution of patent infringement disputes.⁵⁰
- Plaintiff: Courts are not required to perfunctorily construe each and every word of a claim.⁵¹
- Defendant: Every word in a claim informs its meaning and scope; claims may not be construed in a manner that renders a claim term meaningless or superfluous.⁵²
- Plaintiff: Patents are to be liberally and pragmatically construed, and “interpreted as to

⁴⁰ *Phillips*, 415 F.3d at 1319.

⁴¹ *Id.*

⁴² *Id.* at 1320 (citing *Texas Digital*, 308 F.3d at 1204).

⁴³ *Id.*

⁴⁴ *Id.* at 1321.

⁴⁵ *Id.*

⁴⁶ *Id.*

⁴⁷ *Id.* at 1322.

⁴⁸ *Id.* at 1322-23.

⁴⁹ *Sulzer Textile A.G. v. Picanol N.V.*, 358 F.3d 1356, 1366 (Fed. Cir. 2004).

⁵⁰ *Rhoex, Inc. v. Entact, Inc.*, 276 F.3d 1319, 1324 (Fed. Cir. 2002); see also *EMI Group N. Am. v. Intel Corp.*, 157 F.3d 887, 891-92 (Fed. Cir. 1998) (“Construction of the claims by the trial court is often conducted upon a preliminary evidentiary hearing This case illustrates the resolution of most of a complex infringement case with no more than a two-day *Markman* hearing.”).

⁵¹ *Ballard Med. Prods. v. Allegiance Healthcare Corp.*, 268 F.3d 1352, 1358 (Fed. Cir. 2001); *Biotec Biologische Naturverpackungen GmbH & Co. v. Biocorp, Inc.*, 249 F.3d 1341 (Fed. Cir. 2001) (rejecting defendant’s contention that the court “failed to discharge under *Markman* by declining to construe the disputed claim term “melting” because it simply carries the ordinary meaning.”).

⁵² *Exxon Chem. Patents, Inc. v. The Lubrizol Corp.*, 64 F.3d 1554, 1557 (Fed. Cir. 1996); *Harris Corp. v. IXYS Corp.*, 114 F.3d 1149, 1152 (Fed. Cir. 1997).

uphold and not to destroy the right of the inventor.”⁵³

- Defendant: Courts cannot rewrite claims to salvage them from drafting errors or to remove limitations the patent holder now regrets; the public notice function of patents mandates that claims be construed exactly as they are written, not as the patent holder wished it had written them.⁵⁴ Because patents are exceptions to strong federal public policy favoring free competition, they are to be strictly construed.⁵⁵
- Plaintiff: It is a “cardinal sin” to import extraneous limitations from the specification into the claims.⁵⁶ Just because the specification discloses only a single embodiment, the claims must not be construed to be limited to that embodiment.⁵⁷
- Defendant: “[O]ne may not read a limitation into a claim from the written description, but [] one may look to the written description to define a term already in a claim limitation.”⁵⁸
- Defendant: A patentee disclaims or disavows subject matter by distinguishing the claimed invention from the prior art; claim terms are not weasel words to be twisted, like a “nose of wax,” to mean one thing during patent prosecution and something else during litigation.⁵⁹
- Plaintiff: Remarks in the prosecution history can narrow the meaning of a claim term only if they

are unequivocal and evidence a clear and unmistakable surrender of subject matter.⁶⁰

- Plaintiff/Defendant: Claims should be construed to preserve their validity.⁶¹ But, claims “can only be construed to preserve their validity where the proposed claim construction is ‘practicable,’ is based upon sound claim construction principles, and does not revise or ignore the explicit language of the claims.”⁶²

Of course, not all of the aforementioned principles are pertinent in every case. An effective *Markman* brief weaves the most pertinent claim principles into the argument. Obviously, the particular claim construction principles that each party will want to emphasize depends on the clarity of the claim language, its relationship to the accused device, the relevance of the prosecution history, the proximity of the prior art, and the differences between the parties’ proposed constructions.

3. Means-Plus-Function Claims

In addition to the principles set forth above, other claim construction principles apply to so-called means-plus-function claims. These principles can be summarized as follows:

- The use of the word “means” creates a presumption that the claim is drafted in a means-plus-function format.⁶³ This presumption collapses, however, if the claim itself recites sufficient structure, material, or acts to perform the claimed function.⁶⁴
- To construe a means-plus-function element, the court must first identify the recited function, and, second, the court must identify the corresponding structure disclosed in the specification that performs that function.⁶⁵

⁵³ *Nazomi Communications, Inc. v. Arm Holdings, PLC*, 403 F.3d 1364, 1368 (Fed. Cir. 2005) (quoting *Turrill v. Mich. S. & S. Ind. R.R.*, 68 U.S. 491, 510 (1863)); see also *Kress Corp. v. Alexander Services, Inc.*, 1998 WL 398819, *6 (Fed. Cir. 1998) (unpublished) (“[W]e do not leave common sense on the side of the road when we construe patent claims.”).

⁵⁴ *Chef Am., Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1374 (Fed. Cir. 2004).

⁵⁵ *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 151 (1989); *Walker Process Equip., Inc. v. Food Mach. & Chem. Corp.*, 382 U.S. 172, 177 (1965).

⁵⁶ *SciMed Life Sys., Inc. v. Adv. Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1340 (Fed. Cir. 2001).

⁵⁷ *Gemstar-TV Guide*, 383 F.3d at 1366.

⁵⁸ *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998).

⁵⁹ *Ecolab, Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1368 (Fed. Cir. 2001); *Southwall Technologies Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995).

⁶⁰ *Superguide Corp. v. DirecTV Enters.*, 358 F.3d 870, 881 (Fed. Cir. 2004).

⁶¹ See *Rhine v. Casio, Inc.*, 183 F.3d 1342, 1345 (Fed. Cir. 1999).

⁶² See *Generation II Orthotics, Inc. v. Med. Tech. Inc.*, 263 F.3d 1356, 1365 (Fed. Cir. 2001).

⁶³ *Callicrate v. Wadsworth Mfg., Inc.*, 427 F.3d 1361, 1368 (Fed. Cir. 2005) (citing *Micro Chem., Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250, 1257 (Fed. Cir. 1999)).

⁶⁴ *Id.*

⁶⁵ See, e.g., *Med. Instrumentation and Diagnostic Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed. Cir. 2003).

- Properly identifying the claimed function is essential because “an error in identification of the function can improperly alter the identification of the structure . . . corresponding to that function.”⁶⁶
- Once the function is identified, the corresponding structure is determined by examining the specification and prosecution history to identify those structures disclosed in the specification that one of ordinary skill in the art would understand are *clearly linked* to the claimed function.⁶⁷
- The corresponding structure “must include all structure that actually performs the recited function.”⁶⁸ Or, stated from the plaintiff’s perspective, the corresponding structure only includes “structure that actually performs the recited function.”⁶⁹

IV. CORRECTLY IDENTIFY THE KEY TERMS, PROFFER CONVINCING CASE-WINNING CONSTRUCTIONS, AND OUTMANUEVER YOUR OPPONENT DURING NEGOTIATION.

Many courts insist that the parties adopt a Scheduling Order that scripts the entire claim construction procedure, or they have Patent Rules that mandate it. Typically, the procedure mandates a negotiation-based approach which requires that the parties identify to one another the terms or phrases that they believe should be construed, propose constructions for those terms, exchange the evidentiary support for their respective proposed constructions, and then negotiate in attempt to reach agreement on as many terms as possible prior to engaging in the briefing process. It is during this process that a party’s preparation pays dividends.

A. Correctly identify the key terms and proffer cogent constructions.

Most patent cases turn on only a handful of claim terms. One of the most difficult tasks for a party – especially a defendant⁷⁰ – is to first correctly identify those terms and second, to proffer a cogent, legally compelling claim construction for them.

⁶⁶ *Generation II Orthotics, Inc. v. Med. Tech. Inc.*, 263 F.3d 1356, 1363 (Fed. Cir. 2001).

⁶⁷ *See, e.g., Elekta AB*, 344 F.3d at 1210-11.

⁶⁸ *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1119 (Fed. Cir. 2002).

⁶⁹ *Id.*

⁷⁰ The defendant typically has not had the benefit of pre-filing investigation to learn details of the patent. In many cases the defendant is not even aware of the patent until it is served with a lawsuit.

Here is where the preparation pays off. The party that knows the case can avoid the common trap of devoting unnecessary time and effort on terms that, although they may ultimately be construed, are not crucial to the outcome of the case. Moreover, the prepared party knows that a court is neither obliged to construe each and every word of a claim⁷¹ nor even every disputed term.⁷²

The case of *Orion IP, LLC v. Staples, Inc.*,⁷³ provides a good example. There, Judge Ward rejected defendant’s request to construe twenty-one claim terms – including words such as “parts,” “equipment,” and “specifications” – because such words were “common words familiar to most English speakers.”⁷⁴ Although

⁷¹ *See Sulzer Textil A.G. v. Picanol N.V.*, 358 F.3d 1356, 1366 (Fed. Cir. 2004) (“The *Markman* decisions, in ruling that claim construction is a matter of law for the court, do not hold that the trial judge in a patent case must repeat or restate every claim term in the court’s jury instructions.”) (citing *United States Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1568 (Fed. Cir. 1997)); *see also Unitherm Food Systems, Inc. v. Swift Eckrich, Inc.*, 375 F.3d 1341, 1350 (Fed. Cir. 2004) (“In the context of jury instructions, we have doubted ‘that *Markman* requires the trial judge to instruct as to an undisputed ‘claim construction’ for every term, by simply parroting the words of the claim.”) (quoting *U.S. Surgical Corp.*, 103 F.3d at 1567)); *Ballard Medical Products v. Allegiance Healthcare Corp.*, 268 F.3d 1352, 1358 (Fed. Cir. 2001) (“If the district court considers one issue to be dispositive, the court may cut to the heart of the matter and need not exhaustively discuss all the other issues presented by the parties.... As long as the trial court construes the claims to the extent necessary to determine whether the accused device infringes, the court may approach the task in any way that it deems best.”).

⁷² *See, e.g., Collegenet, Inc. v. XAP Corp.*, 2004 WL 2429843, *14 (D. Or. 2004) (“[I]f a person of ordinary skill in the art would understand the term in its ordinary, everyday sense, there is no need to construe the term.”); *Zip Dee, Inc. v. Dometic Corp.*, 63 F.Supp.2d 868, 872 (N.D. Ill. 1998) (“[N]o *Markman*-type construction seems to be required that would add a definition beyond the ordinary English language meaning of the term ‘tension.... In short, the ‘172 Patent’s references to ‘tension’ will go to the jury without the interposition of any judicial gloss.”); *Mallinckrodt, Inc. v. Masimo Corp.*, 254 F.Supp.2d 1140, 1151-53 (C.D. Cal. 2003) (holding that 12 disputed claim terms “require[d] no construction”); *Intertac, Inc. v. Nol-Tec Systems, Inc.*, 2005 WL 41627, *5 (D. Minn. 2005) (finding that the words “obtaining,” “data,” and “establish” simply meant what they said and required no construction).

⁷³ 406 F.Supp.2d 717 (E.D. Tex. 2005).

⁷⁴ *Id.* at 738; *see also Gobeli Research Ltd. v. Apple Computer, Inc.*, 384 F.Supp.2d 1016, 1023 (E.D. Tex. 2005) (“The parties dispute nearly every term in claim 11. The

the court recognized that “[d]efendants’ constructions seemed geared to their future non-infringement arguments,” the court concluded that “those issues are best left for summary judgment and jury arguments.”⁷⁵ The Court also noted that it “fully expects the parties and their attorneys to limit the terms they submit to those that might be unfamiliar to the jury, confusing to the jury, or affected by the specification or the prosecution history.”⁷⁶

The prepared party also knows that failure to seek construction of an important claim term or phrase risks waiving any challenge to a verdict of infringement or invalidity hinging on the construction implied by the infringement or invalidity finding.⁷⁷ Thus, to be safe, the prepared defendant party usually seeks construction of more than just the handful of key terms, but spends the majority of time crafting and refining the proposed constructions for the “must win” terms. The prepared plaintiff, however, often strictly limits the terms and phrases that it deems needing construction to situations where construction will be helpful to clarify the issues, or provide helpful, favorable guidance to the jury, for example, the construction of highly technical terms or idiosyncratically-worded claim phrases.

B. Secure the advantage during negotiation.

1. Capitalize on the order of presentation.

Normally, the Scheduling Order or the Patent Rules will dictate the order in which the above-described disclosures and briefing occur. But, where the Scheduling Order and/or Rules are silent, advantage can sometimes be had in the order.

court does not believe that every word in claim 11 requires construction. . . “).

⁷⁵ *Id.*

⁷⁶ *Id.* (citation omitted). There is Federal Circuit support for this approach. See, e.g., *Biotec Biologische Naturverpackungen GmbH & Co. v. Biocorp, Inc.*, 249 F.3d 1341, 1349 (Fed. Cir. 2001) (Federal Circuit rejected defendant’s contention that the court “failed to discharge its duty under *Markman* by declining to construe the disputed claim term ‘melting’” . . . “the meaning of ‘melting’ does not appear to have required ‘construction,’ or to depart from its ordinary meaning” (citing *United States Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1568 (Fed.Cir.1997) (“Claim construction is a matter of resolution of disputed meanings and technical scope, to clarify and when necessary to explain what the patentee covered by the claims, for use in the determination of infringement. It is not an obligatory exercise in redundancy.”)).

⁷⁷ See *Abbott Labs. V. Syntron Bioresearch, Inc.*, 334 F.3d 1343, 1357 (Fed. Cir. 2003); *Genetech, Inc. v. Amgen, Inc.*, 289 F.3d 761, 774 (Fed. Cir. 2002).

Ask ten patent litigators whether they want the first word or the last word and most will tell you – both. There are certain circumstances, however, where it may be a disadvantage to go first. For example, if the plaintiff’s counsel is inexperienced or unprepared, making him take a position by disclosing his list of terms and proposed definitions first can give the defendant’s attorney a strategic advantage. Likewise, plaintiff may seek to make the defendant disclose first in hopes of gaining insight into the defense’s strategy prior to having to take a position. It is these authors’ experience, however, that in lawsuits between large companies, most counsel are aware of these tactics (as are many courts) and the exchange of terms to-be-construed and proposed constructions occurs simultaneously.

There is, however, less uniformity concerning the briefing order. Some attorneys believe that it is disadvantageous to file first where the parties have not previously exchanged their proposed constructions, or the intrinsic and extrinsic support for those proposed constructions. According to these attorneys, the pressure to marshal all available evidence and argument in the opening brief may cause the opening brief to be scattershot. And, because the party going first will not fully know the other side’s arguments ahead of time, the party going first may not be able to launch an effective pre-emptive attack. These attorneys believe that the value of having the last word in the reply brief does not outweigh these disadvantages.

Other attorneys believe that having both the first and last word on a subject outweighs the above-mentioned possible disadvantages. Although a well-written reply brief does not make up for a poorly drafted opening brief, the perceived disadvantages of going first can be muted by thorough preparation, use of dialectic, and clear writing. According to these attorneys, a defendant should accept any offers to reverse the normal plaintiff-defendant-plaintiff briefing order, or at least insist on simultaneous briefing in attempt to get also get the last word -- a reply brief.⁷⁸

2. Control the paper.

The negotiation-type claim construction procedure described above creates a bookkeeping nightmare. Often there are more than 50 terms in dispute, each having two proposed constructions. Additionally, it is the norm that the proposed constructions evolve during the negotiation process as each side posits slightly reworded alternative constructions in attempt to reach

⁷⁸ This argument has a fair chance of success. Claim construction is a matter of law and, therefore, both sides share an equal burden of proof. Thus, the argument goes, it is unfair to give the plaintiff two briefs while limiting the defendant to a single brief.

agreement. During this process it is common for one side to create a master spreadsheet that tracks all the proposals and changes. This spreadsheet is then shared between the parties. Although it requires extra work, volunteer to be the keeper of the spreadsheet. The process of creating and updating the spreadsheet often reveals subtle inconsistencies and/or weaknesses in certain proposed constructions that are never noticed by the party not slaving over the paper. These unknown inconsistencies and weaknesses can be then used to your advantage either during negotiation or during briefing.

3. Make the most of your superior legal knowledge.

- a. Propose cogent, defensible constructions, which, if adopted, will achieve the desired end result.

The drafting of proposed constructions is difficult. On the one hand, a proposed construction that, if adopted, wins the case is useless if it is legally indefensible. Beware of taking positions that cannot be plausibly defended, which lend themselves to mockery, or which erode your credibility with the court. On the other hand, neither you nor your client benefits from a proposed construction that does not advance your overall goal. Thorough preparation will ensure that time is not wasted proposing constructions that either cannot win, or, perhaps worse, that win-or-lose make no difference to the outcome of the case.

- b. Eliminate inconsistencies.

Eliminate proposed claim constructions that require you to advance inconsistent or directly opposing legal theories. A plaintiff that criticizes defendant's proposed construction for one term as impermissibly importing limitations from the specification into the claim will have a difficult time defending a proposed construction for another term that is supposedly impliedly-limited-by-the-specification.

- c. Attack opponent's "vexatious shuffling."

Once a construction is agreed, it is difficult to undo. Indeed, the local patent rules and/or the doctrine of judicial estoppel may prevent the construction from being undone. For example, in *JSR Corp. v. Tokyo Ohka Kogyo Co.*,⁷⁹ the district court rejected a patentee's post-summary judgment disavowal of a stipulated claim construction:

The Court is not inclined to alter a stipulated claim construction that has been operative for nine months simply because [plaintiff] has, upon receipt of [defendant's] summary judgment motion, recognized that its prior at-

tempt to construe the claim scope broadly inevitably leads to a holding of invalidity in view of the prior art.... [Plaintiff] made the strategic decision to agree to a broad construction of the term, and now it essentially asks the Court for permission to renege on its agreement and to amend the Joint Claim Construction Statement to avoid invalidity.⁸⁰

Earlier inconsistent positions may also be held against an opponent. For example, in *Stairmaster Sports/Med. Prods., Inc. v. Groupe Procycle, Inc.*, the court used the patent holder's earlier claim construction charts to reject a later claim construction position.⁸¹ The *Stairmaster* court also held that the patent holder was judicially estopped from withdrawing a prior agreement with the defendant's proposed construction of a claim limitation: "The claim construction phase of this litigation has ended with [plaintiff] conceding and accepting [defendant's] definition.... It now wants to adopt a diametrically opposed position on the same claim language. [Plaintiff] will not be permitted to play fast and loose with the Court."⁸² Other courts characterize such attempts to change or modify claim construction positions as a "vexatious shuffling of positions."⁸³

- d. Oops! Make last-minute "clarifications" if you need to.

Everyone makes mistakes. Sometimes the risks of not clarifying your claim construction position outweigh the risks of leaving it alone. In those instances, it is reassuring to know that reconstruction, modification and clarification of claim construction positions is not altogether uncommon. Revisiting the claim construction is even possible post-*Markman*. See Section VIII, *infra*.

V. USE THE TUTORIAL TO INTRODUCE YOUR CLAIM CONSTRUCTION THEMES.

The technology tutorial, whether presented separately or as part of the *Markman* brief, is another key element to achieving your client's goal – a winning

⁸⁰ *Id.* at *5.

⁸¹ See *Stairmaster Sports/Medical Products, Inc. v. Groupe Procycle, Inc.*, 25 F.Supp.2d 270, 271 (D.Del. 1998).

⁸² *Id.* at 280.

⁸³ *Berger v. Rossignol Ski Co., Inc.*, 2006 WL 1095914, *3 (N.D. Cal. 2006); *Atmel Corp. v. Information Storage Devices Inc.*, 1998 WL 775115, *2 (N.D. Cal. 1998); see also *Tritek Technologies, Inc. v. U.S.*, 63 Fed.Cl. 740, 743 (Fed. Cl. 2005) ("The Claim Chart requirement was designed to prevent a 'shifting sands' approach to patent litigation.").

⁷⁹ 2001 WL 1812378 (N.D. Cal.).

claim construction. To be persuasive a tutorial must accomplish two goals. First, and most importantly, the tutorial must advance your client's claim construction position. And second, the tutorial must educate the judge regarding the technology.

A. Advance your client's claim construction position by introducing your claim construction themes.

The most important purpose of a technology tutorial is to advance your client's claim construction position. That's right – tutorials are advocacy pieces cleverly disguised as objective scientific teaching aids.

Designing an effective tutorial is, therefore, an art, and a lot of work. To be persuasive, the tutorial needs to work seamlessly with the main themes of the party's claim construction position. Indeed, if the tutorial is presented prior to the briefing, it should introduce some of the main claim construction themes and preemptively rebut our opponent's expected themes. But, it must do so in an objective way. For example, if the accused device uses a type of technology that was not available at the time of the invention (*e.g.*, a digital television signal), the defendant may advance a claim construction that seeks to limit the scope of the claims to analog television signals. An important precursor to this argument would be to establish that digital signals were not contemplated at the time of the invention. To do so, the defendant might include in the tutorial a story depicting the evolution of the television signal beginning with its early analog days – including the state of the art at the time of the invention and the invention itself – and concluding with the advent of the digital television signal. The tutorial might continue by describing the accused device as the next technological leap. Although appearing objective, such a tutorial subtly advances one of the main themes of defendant's argument – that the claims should be construed to exclude a digital television signal.

The tutorial can also be used to rebut the expected themes of your opponent. Referring to the previous example, a plaintiff-slanted tutorial might focus on the evolution of the concepts contained in the patent instead of dwelling on the analog/digital distinction. The timeline might highlight the conceptual problem solved by the invention and stress that the same problem exists no matter the signal type. The patent holder could use such a tutorial to carefully, and seemingly objectively, further explain the patent in such a way that it, at least conceptually, appears identical to the accused device, which might remain nameless – the elephant in the room.

Another theme commonly advanced by the plaintiff/inventor is that the invention is pioneering – created by a hero, a true innovator. One persuasive way to preemptively rebut such a theme is to create a tutorial with a timeline depicting the prior art as a series of

minor improvements with the invention being just the next, obvious step in implementing an already well-known concept. This theme also sets the stage for later summary judgment motions.

Finally, the claim construction tutorial is a great place to test out possible demonstrative exhibits to be used at trial. If the judge “gets it” during the claim construction hearing, such demonstrative can then be slightly tweaked to be reused during trial. Conversely, if the judge cannot follow your tutorial, chances are very good that a jury will not be able to follow it later.

B. Teach to your advantage.

The tutorial is also a teaching tool. Once the judge has seen or read a party's tutorial, the judge should understand the case. To that end, the tutorial needs to be clear, understandable, and seemingly objective. To achieve this goal, it is often necessary to employ technical consultants, graphics companies, and even professional voice actors to read the script that corresponds with the graphics. But beware; if the tutorial appears to be an overt piece of advocacy, you risk the judge not giving it any weight, or worse striking it.

VI. DRAFT THE PERSUASIVE BRIEF.

A. Begin with an outline.

Creating an outline is an effective tool for drafting any brief. But, it is especially useful for drafting a *Markman* brief. Outlining facilitates the presentation of complicated technology in a straight forward, understandable way. It also helps the writer group together related claim terms that will be supported by the same or similar arguments.

Your outline should set forth the disputed claim terms along with your proposed constructions in a logical, big-issues-first order. If you plan to include a primer on claim construction law or a technology tutorial, then outline the claim construction principles and technological facts that you plan to discuss. Your outline should help you to cogently frame the case in the most favorable light.

When complete, the outline should be good enough to serve as a table of contents to the brief, which, in turn, should provide a succinct summary of your claim construction positions and primary arguments. Examples of portions of such outlines from a patent holder's brief and a defendant's brief are set forth in the Appendix at the end of this paper.

B. Impress the judge with your version of the facts (or work them into the tutorial).

A patent case, like any other case, is about people. These people may be “clever innovators” or “dishonest copiers” if you represent the patent holder, or “patent parasites” or “pirates” if you represent a defendant company against a so-called patent troll. Either way, a persuasive claim construction brief/tutorial provides

the context, including the moral context, necessary for the judge to adopt your client's claim construction position.

1. Carefully consider which facts to include.

Whether to include certain facts (*e.g.*, the inventor's story, deliberate copying by alleged infringer, that the so-called inventor is really just a patent holding company (*i.e.*, troll), or a description of the accused device) in the claim construction brief is a decision that must be made on a case-by-case basis. Strictly speaking, certain facts, though legally irrelevant, can subtly dispose a judge toward a more favorable result. For example, the fact the patent holder never made any effort to actually create a product, but instead derives its income solely from patent litigation, may subtly encourage the judge to adopt a more narrow construction.⁸⁴ Conversely, if the inventor's story is compelling and admirable, it may be easier to sympathize with the inventor thus encouraging a broader construction.

Some factors to consider in deciding whether to include certain facts are:

- The quality of the evidence. Is the inventor's story especially compelling? Is there strong evidence for deliberate copying, or that the patent holder is a so-called "patent troll"? Is there "dead on" prior art?
- Are the facts necessary to educate the judge? If the judge has already heard numerous motions and thus is familiar with the facts, it is probably a waste of time and precious pages to restate all of them in the claim construction brief. But, if the claim construction brief is the first time the story is told, providing context to the dispute may be persuasive.
- How will the judge react to such facts? Does the judge have any proclivities such that the inclusion of facts having questionable legal relevance might backfire?
- What does local counsel think? Input from local counsel is invaluable in helping you make these judgment calls.

2. Include a narrative of the invention and a summary of the prosecution history.

In most cases, either the claim construction briefing and/or tutorial should include (i) a narrative of the

invention and patented technology, and (ii) a summary of the prosecution history.

- a. The description of the invention and the patented technology should be consistent with your major case themes.

No matter whether you represent the patent holder or the accused infringer, it is important to your case that the judge understands the patented technology. Generally speaking, patent holders should build up the "wow" or "gee whiz" factor of the invention. The brief should also attempt to personalize the inventor, describing the "blood, sweat, and tears" the inventor poured into the inventive vision, or the efforts he made to overcome the resistant skepticism of corporate management, to make the invention a reality. Plaintiffs should emphasize the difficulty of the problem the invention purportedly solved, the scope of effort needed to solve such a difficult problem, and how the invention is radically different than other technology existing at that time (*i.e.*, the prior art). Showcasing evidence of long-felt need, commercial success, positive publicity, and copying by others is also important to rebut allegations of obviousness and to demonstrate that the invention is a pioneering one, meriting a broader construction. Such briefs should not get mired down in the specific details of the invention unless such a discussion is necessary to support a specific claim construction argument.

Defendant's briefs, on the other hand, should strive to depict the invention as "no big deal," the next simple step in the logical progression of technology. To be persuasive, defendant's briefs should also teach the details of the technology to provide the context for the claim construction positions that depend upon such detail – the claim construction positions that distinguish the invention from the accused device. When appropriate, defendant's briefs should also focus on the lack of disclosure in the specification thus setting the stage for possible §112 motions. *See* Section VI, *infra*.

- b. A description of the prosecution history is usually valuable to the accused infringer.

The accused infringer should, when appropriate, include a description of the prosecution history. This description should highlight any language that the accused infringer is relying upon to narrow or otherwise alter the plain and customary meaning of a disputed term. The description should also describe the circumstances surrounding the language to fully illustrate, for example, that the patent holder surrendered part of the claim's scope. If the patent holder knows that statements from the prosecution history will be used against it, the patent holder may want to summarize the prosecution history in its opening brief to frame it in a more favorable light.

⁸⁴ "[S]peculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts . . . embarrass[] the honest pursuit of business." *Atlantic Works v. Brady*, 107 U.S. 192, 200 (1883).

3. Discuss prior art and the accused device when appropriate.

a. “Dead on” prior art

There are several reasons for an accused infringer to make the court aware of “dead on” or 102(b) prior art during the claim construction process. First, the story that the invention is invalid because “someone else did it first” is compelling. The defendant can also snatch the moral high ground if there is evidence that the patent holder knew about the prior art but withheld it from the PTO. Second, there is legal authority to include key prior art because such art is relevant in claim construction.⁸⁵ And finally, describing such prior art serves to counter-balance the patent holder’s story that the invention is pioneering.

But how should one use the prior art during claim construction to get the most punch? One way, as described previously in the tutorial section, is to utilize the prior art to create a technology development timeline that minimizes the contribution of the invention to the technology. In this way, the advances in technology can be depicted incrementally to minimize any “wow” factor associated with the invention.⁸⁶ Conversely, a plaintiff may want to defang the defendant’s potential argument by conceptually distinguishing the invention from the prior art (*see* description of the invention section, *supra*) and thus bolster the “wow” factor of the invention.

Close prior art can also be used to demonstrate that plaintiff’s proposed broad construction would invalidate the patent. As stated previously, one canon of claim construction (although rarely dispositive) is that claims should be construed to uphold their validity in certain circumstances. A defendant can use this canon as a hook to utilize a piece of art to in favor of its proposed narrower construction because plaintiff’s proposed broader construction would invalidate the patent. Additionally, the prior art can be used as evidence of the plain and customary meaning of a disputed term to one of ordinary skill in the art.⁸⁷ Cited prior art, because it can be classified as intrinsic evidence (it is part of the prosecution history), may suggest a presumption that the disputed term from the patent should have the same meaning as that given it in the cited art.⁸⁸

⁸⁵ *Vitronics*, 90 F.3d at 1584; Robert C. Kahrl, *Patent Claim Construction* § 7.05 at 7-18 (2005).

⁸⁶ Such a timeline has added benefits as well. For example, such a timeline can be used to pave the way for later invalidity summary judgment motion(s).

⁸⁷ *Id.*

⁸⁸ Kahrl, § 7.05, at 7-18.

b. The accused device.

Discussing the accused device during claim construction is a tricky proposition. Some of the patent holder’s “best facts” are often defendant’s dishonorable conduct: deliberate copying of the patent holder’s own product, refusal to take a license, violation of a non-disclosure agreement, dishonest dealing with the patent holder, and/or other acts that cast defendant in a negative light. Such facts, when available, may engender sympathy for the patent holder and/or skepticism for the defendant, which, in turn, may subtly influence the judge on claim construction.

But, because the structure and function of the accused device (let alone evidence of these other issues) is legally irrelevant to claim construction, a plaintiff wanting to utilize this type of evidence during claim construction faces a high hurdle.⁸⁹ Discussing the accused device could backfire if it is seen by the judge as a naked attempt by the plaintiff to rewrite the claim to read on the accused device. Describing the accused device, however, can also expose a defendant’s attempt to read limitations into the claims to avoid infringement. Thus, a discussion of the accused device may be worth the risk depending upon the circumstances.

If it is decided that the risk is worth taking, the party attempting to describe the accused device during the claim construction briefing needs justification for doing so. Fortunately, the Federal Circuit recognizes that knowledge of the accused device is often necessary to provide context for claim construction: “knowledge of [the accused device] provides meaningful context for the first step in the infringement analysis, claim construction.”⁹⁰ Indeed, while “claims may not be construed with reference to the accused device,”⁹¹ that rule “does not forbid any glimpse of the accused product or process during or before claim construction.”⁹² Thus, a party attempting to introduce accused device evidence should frame such evidence as providing context to the dispute. As described previously, the tutorial provides a good, defensible op-

⁸⁹ It is black letter law that “a court must construe claims without considering the implications of covering a particular product or process.” *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1340 (Fed. Cir. 2005).

⁹⁰ *See Wilson Sporting Goods Co. v. Hillerich & Bradsby Co.*, 442 F.3d 1322, 1326-27 (Fed. Cir. 2006).

⁹¹ *Id.* at 1330 (quoting *NeoMagic Corp. v. Trident Microsystems, Inc.*, 287 F.3d 1062, 1074 (Fed. Cir. 2002)).

⁹² *Id.* at 1331.

portunity to educate the court about the accused device. Likewise, the brief itself can explain that the purpose of its description of the accused device is to highlight the relevance of a particular claim construction dispute.⁹³

C. Create a legal primer that educates the judge and subtly advocates your client's position.

Some litigators create their legal primers by cutting and pasting boilerplate language from one brief to another. This is a mistake. These litigators miss a critical opportunity to lay a persuasive legal groundwork for their proposed claim constructions.

A diligent patent litigator realizes that, to be persuasive, the legal primer must be tailored to the specific claim construction issues present in each particular case. It should not only set forth the law, but the law selected should specifically support your client's arguments and not merely recite the general principles of claim construction.

As set forth previously, there are numerous canons of claim construction, many of which conflict with one another. A carefully crafted legal primer will make use of these canons in a way that supports the drafter's client's overall argument. Notice the contrast between the pro-plaintiff and pro-defendant version of the claim construction principles for construing means-plus-function claims set forth below:⁹⁴

- To be considered "corresponding structure," the structure must be *clearly linked* to the claimed function⁹⁵ and actually perform the claimed function: corresponding structure is limited to "structure that *actually performs* the recited function."⁹⁶
- The corresponding structure "must include *all* structure that actually performs the recited function."⁹⁷

⁹³ *Id.* (complaining that the lack of any description of the accused product in the record left it "puzzled by the relevance of [the term] 'rigid' in the claim construction analysis").

⁹⁴ See also Section III.B.2, *supra*, and the Appendix, *infra*.

⁹⁵ *Elekta AB*, 344 F.3d at 1210-11 (emphasis added)

⁹⁶ *Cardiac*, 296 F.3d at 1119. (emphasis added)

⁹⁷ *Id.* (emphasis added).

D. Fully develop the claim construction arguments that are convincing and will win your case.

"Simple English is no one's mother tongue. It has to be worked for."⁹⁸ This truth is especially applicable to patent lawyers. Perhaps it is the complexity of the subject matter, or perhaps it is because many patent lawyers are also engineers and thus steered clear of college English courses. Whatever the reason, the most persuasive arguments are those stated clearly, cohesively, and concisely.

1. Frame introductory argument(s) in terms of simple, unifying themes.

"Every brief should make its primary point within 90 seconds."⁹⁹ Too often, claim construction briefs fail to make a primary point at all, let alone to do it in 90 seconds. The reason for this failure is unclear. It may be that patent attorneys get so caught up in the minutia of arguing each individual claim term that they forget about the bigger picture. To be persuasive, however, a claim construction brief, like any brief, must be clear and cohesive. It needs a central theme or themes that glue the respective arguments together and provide an overall reason why the court should adopt your side's position.

In claim construction briefs, these themes may be legal. Compare, for example, these themes relating to the use of the specification:

- Ignoring both the specification and the plain and ordinary meaning plaintiff time and again proposes overly broad constructions in a blatant attempt to ensnare the accused device, or
- Defendant, not surprisingly, attempts to read-in non-existent limitations from the specification at every opportunity in hopes of avoiding infringement.

Or, these themes may be technical as described previously in the analog/digital television signal example. Either way, establishing and maintaining clear and cohesive themes is necessary both to hold the brief together and to provide the judge with the legal and moral authority to decide the claim construction issues in your client's favor.

2. Focus on the terms that matter.

As stated previously, most patent cases turn on the construction of a handful of terms. But there may be

⁹⁸ Bryan A. Garner, *THE WINNING BRIEF* at 175 (Oxford 2004) ("Garner") (quoting Jacques Barzun, *Teacher in America* 47 (1945)).

⁹⁹ Garner at 55.

50 or more terms in dispute and only a limited amount of briefing space. Spend your precious pages on the case dispositive terms.

3. Organize your individual arguments in an effective manner.

a. Try to cast each issue as a syllogism.

“There are essentially two types of issue statements: analytical and persuasive.”¹⁰⁰ The persuasive issue is subtly tilted toward a desired answer.¹⁰¹ Considering the following syllogism:

All dogs are mammals. [Major premise]

Spot is a dog. [Minor premise]

Spot is a mammal. [Conclusion]¹⁰²

Now consider that syllogism applied to a claim construction issue:

Claim constructions that import limitations from the specification into the claims are legally incorrect. [Major premise]

Defendant’s proposed construction for “widget” imports the limitation that the widget is made of steel from the specification. Nothing in the claim requires that the widget be made of steel. Nor does the plain and customary meaning of the term “widget” delimit that it be made of steel, or of any specific material. Indeed, even defendant’s cited evidence fails because the portions of the specification relied upon by defendant relates only to the preferred embodiment. [Minor premise]

Defendant’s proposed construction should not be adopted because it is legally incorrect. [Conclusion]

As can be seen, incorporating syllogism into your arguments provides structure to the argument. It also serves to make sure that your conclusion flows logically from your major and minor premises.

b. Incorporate dialectic into your individual arguments to effectively deal with counterarguments on your turf.

One advantage of the negotiation-type claim construction process described in Section IV is that both sides understand one another’s position prior to the *Markman* briefing. Use this understanding to your advantage.

If you represent the patent holder, you are most likely briefing first. In addition to making your arguments, raise and rebut the strongest of defendant’s expected counterarguments. By doing so, you not only blunt defendant’s sword, but you also get to do so on a battle ground of your choosing. Even if you are the defendant, you can still recast your opponent’s arguments in a manner more favorable to your position and then rebut. You can also confute arguments likely to be raised in the reply brief.

Utilizing a dialectical structure has other advantages as well. It helps focus the court on the genuine dispute between the parties, and the meat of one another’s respective arguments. The dialectical structure enlivens an otherwise relatively dry subject, claim construction. And, it promotes clear thinking, which, in turn, promotes clear writing.

c. Use signposts to help reduce the judge’s workload.

The use of signposts (i.e., defendant’s proposed construction should not be adopted for three reasons . . . first, . . . second, . . . and finally) helps the reader understand where the brief is going and makes the brief easier to read. And, a brief that is easier to read is more persuasive than one that is difficult to read.

d. Make the arguments flow.

Try to draft the first sentence of each paragraph as if the rest of the text of the paragraph was hidden. Imagine the reader skimming through your brief, reading only the first sentence of each paragraph. Does the first sentence of each paragraph capture the thought of the paragraph? Does the first sentence of the next paragraph flow naturally from the thought contained in the previous paragraph and thus succinctly weave your arguments together to form a cohesive whole? If not, consider reworking the brief to accomplish this goal.

e. Say something about the cases that are critical to your proposed construction.

To be truly persuasive the brief must seamlessly weave in the main case themes and correctly and forcefully apply the legal principles to the appropriate facts in a way that can only lead to one outcome – the judge adopting your claim construction position. Thus, for the “must win” terms, find cases that both factually and legally support the position you are advancing. And, once you find these case(s), explain how the facts and

¹⁰⁰ Garner, at 86.

¹⁰¹ *Id.* at 87.

¹⁰² *Id.* (using a similar syllogism involving Socrates and men).

holding of the case(s) apply to your proposed construction.¹⁰³

E. Use graphics, figures, and other visual aids to help the judge understand the argument and drive your point home.

A picture may be worth a thousand words, but it could also be worth millions of dollars. Nothing helps one to understand complicated technology or concepts like a picture. Patent litigation is hard – electrical engineering or biotechnological principles developed by Ph.D.’s must be simplified and re-simplified to focus the dispute in an understandable manner. The bottom line – use color graphics, figures, animations, and other visual aids to help make your arguments more persuasive. Also, if you intend to use “John Madden” graphics (i.e., the type where the lawyer can draw in color, move things around on the screen, etc.) during the *Markman* hearing, make sure you understand how to use the equipment. Fumbling around with the technology in the court at best costs you time and at worst makes the judge lose confidence in you and thus in your client’s position.

F. Other helpful hints.

1. Consider putting case citations in footnotes.

Cite your supporting cases with footnotes, rather than in text, and avoid string cites. There are many pros to putting case citations in footnotes, including: (i) shorter, more clear sentences, (ii) more coherent and forceful paragraphs, (iii) less distractions, (iv) poor thinking is more easily exposed, (v) the case law is more thoroughly discussed because it is not contained in a bracketed parenthetical, and (vi) ideas are more efficiently conveyed.¹⁰⁴

2. Make clean copies of exhibits.

This point is obvious, but can be overlooked in the madness that often accompanies meeting a filing deadline. An argument loses steam if the exhibit that supports it is unreadable. An argument also loses its force if the judge cannot find the small portion of text you are relying upon for support that is contained in a larger document. Hence, highlight the portion of text you are relying on for your argument. For example, if you are relying upon a dictionary definition or small portion of text from an entire single spaced page, highlight the important portion. The judge will appreciate it.

VII. CONSIDER SIMULTANEOUSLY FILING A § 112 MOTION TO INDIRECTLY SUPPORT CERTAIN CLAIM CONSTRUCTION POSITIONS.

Many times the defendant believes that one or more claim terms or phrases cannot or should not be construed because they are indefinite. Once the plaintiff proffers a construction for these terms and/or phrases during claim construction, the defendant faces a hard choice, either (i) proffer no construction and argue no construction is possible because the term is indefinite, or (ii) proffer a construction, but state in a footnote that defendant maintains its position that the term is invalid. This choice is made more difficult because the defendant’s very proposal of a construction undermines its indefiniteness argument: “[o]nly when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite.”¹⁰⁵

Consider the following example from a recent case where the patents-in-suit related sending high-speed data over standard wireless connections. Many of the patents’ claims contained the phrase “wherein the data rate is much less than the nominal data rate.” The parties disputed the terms “data rate,” “nominal data rate,” and “much less than.” The defendant also maintained that claims containing the phrase “much less than” were invalid because that phrase was indefinite. The specification did not contain any specific definition of the phrase “much less than,” nor did it otherwise indirectly define the phrase. But the specification did describe dividing the available bandwidth into 64 subchannels.

The plaintiff, in its opening brief, took the position that the phrase “much less than” did not need to be defined because it had a well understood plain and customary meaning. But, in case the court disagreed, the plaintiff offered a broad construction that, if adopted, would have taken away a case-deciding non-infringement argument.

Defendant, therefore, was faced with two choices: (i) stand on its invalidity argument and risk the court’s adopting plaintiff’s position for the lack of an alternative, or (ii) offer a proposed construction (one which, if adopted, would rule out infringement) while at the same time maintaining that the claim was invalid, a seemingly inconsistent position.

Defendant did neither; and it did both. The defendant argued for a claim construction where “‘much less than’ the nominal data rate” meant “not more than 1/64th the nominal data rate” based upon the only support existing in the specification, while, at the same

¹⁰³ Garner, at 165.

¹⁰⁴ Garner, at 142 (also discussing the cons).

¹⁰⁵ *Metabolite Labs., Inc. v. Laboratory Corp. of Am. Holdings*, 370 F.3d 1354, 1366 (Fed. Cir. 2004) (citation omitted).

time, filing a summary judgment motion that the claim was invalid.¹⁰⁶ This strategy provided several advantages. First, the defendant could fully explain its invalidity position without using up valuable pages of its claim construction brief. By fully explaining its invalidity position, the defendant was also able to subtly undercut both the plaintiff's position that "much less than" had a commonly understood plain and customary meaning to one of skill in the relevant art, and the plaintiff's alternative claim construction position. Second, defendant was able to use its fully developed summary judgment position to its advantage in its claim construction brief by arguing in that brief that the defendant's proposed construction must be adopted since it is the only possible construction that upholds the patent's validity. And finally, because plaintiff's response to the summary judgment motion was due at approximately the same time as its claim construction reply brief, the summary judgment motion had the additional benefit of costing the plaintiff precious manpower at a critical time thereby increasing the likelihood that the plaintiff would make a mistake.

VIII. REMEMBER THAT CLAIM CONSTRUCTION DOES NOT NECESSARILY END WITH THE *MARKMAN* RULING.

Claim construction is an ongoing process. The Federal Circuit encourages trial courts to correct, amend, and refine ambiguous claim constructions before trial. For example, in *Jack Guttman, Inc. v. Kopykake Enterprises, Inc.*,¹⁰⁷ the court held that "[d]istrict courts may engage in a rolling claim construction, in which the court revisits and alters its interpretation of the claim terms as its understanding of the technology evolves." Likewise, in *Utah Medical Products, Inc. v. Graphic Controls Corp.*,¹⁰⁸ the court specifically praised the district court for revisiting the claim construction issue: "Recognizing the shortcomings of its original attempt to define the scope of the

claims, the district court admirably amended its construction to supply a better definition before trial."¹⁰⁹

If you are unhappy with the claim construction, look for opportunities to revisit it. For example, revisiting the claim construction may be warranted when defendant injects a new defense into the case.¹¹⁰ Indeed, some courts have revisited the claim construction when the case is at a very late stage. For example, in *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*,¹¹¹ the defendant asked the district court to construe a newly disputed claim term *after* the court had already held one *Markman* hearing and *after* the case had already had one trip to the Federal Circuit and back. The plaintiff argued that the court should not permit the defendant to raise the claim construction issue at such a late stage. The district court rejected the plaintiff's waiver argument, noting that the newly disputed issue "determine[d] the entire analytic framework for analyzing whether [Defendant's] process infringes this part of the patent."¹¹²

Finally, it may be appropriate to revisit the construction of a claim term if the parties dispute the meaning of the construction itself:

In this case ... the parties have a finite and well-defined dispute over the meaning of *what they thought was an agreed construction*. In reality, the parties have not agreed upon a construction of the terms ... that the Court can present to the trier of fact in a way that satisfies the law under *Markman*.¹¹³

Ultimately, the question of infringement should turn on the finally determined meaning of the original claim language, not on the contested meaning of an ambiguous claim construction.

¹⁰⁶ Note, claim construction is the proper time for the court to decide this issue: "A determination that a patent claim is invalid for failure to meet the definiteness requirement of 35 U.S.C. § 112, ¶ 2 is a conclusion 'that is drawn from the court's performance of its duty as the construer of patent claims.'" *Bancorp. Services, L.L.C. v. Hartford Life Ins.*, 359 F.3d 1367, 1371 (Fed. Cir. 2004). In fact, it may be dangerous to wait until after claim construction to propose an indefiniteness-type argument. See *Metabolite*, 370 F.3d at 1366 (rejecting an indefiniteness contention because the claims had already been construed).

¹⁰⁷ 302 F.3d 1352, 1361 (Fed. Cir. 2002).

¹⁰⁸ 350 F.3d 1376, 1382 (Fed. Cir. 2003).

¹⁰⁹ *Id.*

¹¹⁰ *Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc.*, 348 F.Supp.2d 713, 721 (N.D.W.Va. 2004) ("The Court now recognizes that its prior construction suffered from several infirmities that need to be corrected.... [T]he Court's perspective on the claims has been sharpened by Mylan's injection of new defenses. Accordingly, the Court finds it necessary to amend its claim construction.")

¹¹¹ 339 F.Supp.2d 202, 255 (D. Mass. 2004).

¹¹² *Id.*

¹¹³ *Civix-DDI, LLC v. Cellco Partnership*, 2005 WL 831307, *8 (N.D. Ill. 2005) (emphasis added).

IX. CONCLUSION

Winning the claim construction often wins the case. The preparation for the claim construction process, therefore, must begin early and be thorough. Carefully identify the key claim construction issues, propose cogent, defensible, constructions and outwit your opponent during the negotiation process. If a tutorial is permitted, use it to your advantage by educating the judge to your key construction themes and rebutting your opponent's key themes. Craft a well organized brief that emphasizes your themes, frames the law in a way that supports these themes, and then applies that law to the evidence in a forceful, straight-forward manner. And, finally, in the event that you receive an unfavorable construction of a key term, look for opportunities to revisit that construction.

APPENDIX A – SAMPLE *MARKMAN* BRIEF OUTLINES

FROM A PLAINTIFF’S PERSPECTIVE

I. Background 1
 A. The birth of the invention 1
 B. Plaintiffs begin selling a product 2
 C. Trampling on Plaintiff’s patent rights and reaping where they did not sow, Defendant copied Plaintiff’s product and used its dominance to capture the market for the patented product 3
 D. Defendant’s infringement cost over 100 Texans their jobs 4

II. Fundamental claim construction principles 4
 A. A proper approach to claim construction is both liberal and pragmatic 4
 B. The chief objective of claim construction is to provide jurors clear, understandable instructions 5
 C. Courts are not required to perfunctorily construe each and every word of a claim 5
 D. There is a heavy presumption in favor of giving claims the ordinary meaning, as supported by the words of the claim and the written description, that persons of ordinary skill in the art would attribute to them 6
 E. Claim terms should be construed in the context of surrounding claim terms 7
 F. Claims should be construed broadly in light of the specification to encompass the many preferred embodiments; but it is a “cardinal sin” of patent law to import extraneous limitations from the specification into the claims 7
 G. Prosecution history remarks do not narrow the meaning of a term unless they are unequivocal and evince a clear and unmistakable surrender of subject matter 9
 H. Courts may consult extrinsic sources, such as dictionaries and treatises, but may not use dictionaries to substitute broad claim terms with narrow dictionary definitions 10

III. Plaintiffs’ proposed claim constructions 10
 A. “Lateral strength” refers to “the strength of connected pipe which resists forces exerted on the pipe in a direction perpendicular to the length of the pipe” 11
 B. This phrase “slightly larger in diameter” is plain and ordinary on its face and does not need to be construed 13

* * *

FROM A DEFENDANT’S PERSPECTIVE

I. Background 1
 A. Plaintiff’s business is to watch the advancing wave of Internet technologies, and gather its foam in the form of patented monopolies. 1
 B. Plaintiff does not make any products, does no research and development, and contributes nothing to the advancement of technology 2
 C. The claims in Plaintiff’s patent, moreover, are critically limited to analog circuits 3

II. Fundamental claim construction principles 4
 A. Claims alone define the patent right; and only claims can be infringed 4
 B. Claim construction, the first step of both the infringement and validity analyses, is a task that belongs, exclusively, to the court 5
 C. The chief objective of claim construction is to facilitate summary judgment resolution of patent infringement claims. 5
 D. Because patents are exceptions to strong federal public policy favoring free competition, patent claims are strictly construed 6
 E. Every word in a claim informs its meaning and scope; claims may not be construed in a manner that renders a claim term meaningless or superfluous. 7
 F. Claims must be construed in accordance with ordinary principles of English grammar; courts do not rewrite claims to salvage them from drafting errors or to remove limitations the patent holder now regrets; the public notice function of patents mandates that claims be construed exactly as they are written, not as the patent holder wished it had written them 7
 G. Claim terms must be construed in light of, and may be limited by, the specification; claims cannot be construed to encompass that which the inventor did not invent or adequately disclose in the specification 9
 H. A patentee disclaims or disavows subject matter by distinguishing the claimed invention from the prior art; claim terms are not weasel words to be twisted, like a “nose of wax,” to mean one thing during patent prosecution and something else during litigation... 10
 I. The Federal Circuit strongly disfavors reliance on general purpose dictionaries and treatises to construe claims 11

* * *