



Claim Construction & Repair
20th Annual Intellectual Property
Law & Policy Conference
Bruce Wexler, Paul Hastings LLP
April 13, 2012

Origins of Modern Claim Construction: *Markman v. Westview*, 52 F.3d 967 (Fed. Cir. 1995) (*en banc*)

- **Basic premise of *Markman*:**

- “The patent is a fully integrated written instrument. ... It follows therefore from the general rule applicable to written instruments that a patent is uniquely suited for having its meaning and scope determined entirely by a court as a matter of law.” *Markman*, 52 F.3d at 978.
- “[T]he court is looking to the extrinsic evidence to assist in its construction of the written document, a task it is required to perform. The district court's claim construction, enlightened by such extrinsic evidence as may be helpful, is still based upon the patent and prosecution history.” *Id.* at 981.
- “Because claim construction is a matter of law, the construction given the claims is reviewed *de novo* on appeal.” *Id.* at 979.

- **After *Markman*, claim interpretation became**

- A matter solely to be decided by a judge;
- A threshold inquiry before infringement or validity analysis;
- Based upon a hierarchy of evidence;
- Subject to *de novo* review by appellate courts.

Tools of Claim Construction: Canons of Construction

Some Canons of Construction:

- Terms are read with the understanding of a person of ordinary skill in the art.
- Terms are presumed to carry their customary meaning *unless*
 - The terms have no generally accepted meaning;
 - The inventor “acted as his own lexicographer” in defining the term, *see Teleflex, Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313 (Fed. Cir. 2002); or
 - The inventor expressly disavowed some portion of the term’s meaning.
- Absent such express disavowals, limitations may not be read into claims from other areas of the patent. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1320-23 (Fed. Cir. 2005).

Hierarchy of evidence established in *Markman*:

- Intrinsic (patent claims, specification, and prosecution history)
- Extrinsic (all other evidence, including dictionaries, articles, prior art, inventor testimony, and expert testimony)
 - “[D]ictionaries, encyclopedias and treatises are particularly useful resources to assist the court in determining the ordinary and customary meanings of claim terms.” *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002).
- Extrinsic evidence is “unlikely to result in a reliable interpretation ... unless considered in the context of the intrinsic evidence.” *Phillips*, 415 F.3d at 1319.
- Ultimately, a court is free to select and consider sources as it sees fit, “as long as those sources are not used to contradict claim meaning that is unambiguous in light of the intrinsic evidence.” *Phillips*, 415 F.3d at 1324.

- Recent Federal Circuit case highlighting the current tensions in claim construction methodology.
 - How can the specification be used to interpret claim terms without improperly importing limitations into the claim?
 - Claim construction may include findings of fact by the court. Does this warrant the more deferential clear error standard of review?

- **Issue presented:** What was the meaning of the term “body” in the claim phrase “a hollow syringe **body** comprising a barrel and having a front end portion and a back end portion”?
- The Majority construed the term “body” as a “one-piece body,” relying almost exclusively on language in the specification.
- The specification limited the term by:
 - Distinguishing the invention from prior art based on a one-piece body;
 - Disclosing only embodiments with a one-piece body; and
 - Reciting the invention as having a one-piece body.
- “In reviewing the intrinsic record ..., we strive to capture the scope of the actual invention, rather than ... become divorced from what the specification conveys is the invention.”

Retractable, 653 F.3d at 1305.

- Judge Rader contended that the majority’s opinion contravened the “bedrock principle of patent law’ that the claims themselves, not the ... specification, defined the patented invention.”
- The plain meaning of “body” controlled without limitation because:
 - There was no special, technical meaning in the field of art; and
 - There was no evidence that the patentee intended to expressly limit the term.

Retractable, 653 F.3d at 1312-13.

Retractable Technologies v. Becton:
Dissenting Opinion on Denial of *En Banc* (Moore)

- **Judge Moore, joined by Judge Rader, in a dissent from the court’s denial of *en banc* review:**
 - Majority’s alteration of the claim to fit their own conception of the invention “illustrates a fundamental split within the court as to the meaning of *Phillips* and *Markman*.”

- **Judge Moore continued in her dissent:**

“The majority’s approach to claim construction ... is virtually identical to the analysis performed under § 112’s written description requirement, which is an entirely factual analysis. ... [Should the court choose this approach] we must acknowledge the factual underpinnings of this analysis and there should be deference [to the lower court’s finding of fact].”

Retractable Techs., 659 F.3d at 1373

▪ **Judge O'Malley dissented separately:**

- Stated generally that “the majority adhered to the broad principles of claim construction set forth in *Phillip v. AWH Corp.*”
- Emphasized that district courts should receive deference in claim construction:

“An exercise that requires review of often extensive documentary evidence and ... expert evidence for purposes of ‘capturing the scope of the actual invention’ sounds telling likely a factual inquiry ... Where, as here, there is fair debate about the scope of the invention after application of *Phillip’s* principle, we should defer to reasoned district court choices.”

Retractable Techs., 659 F.3d at 1375-76.

***Retractable Technologies* and Supreme Court Review**

- Petition for cert filed March 26th
- **Questions presented:**
 - “Whether a court may depart from the plain and ordinary meaning of a term in a patent claim based on language in the patent specification, where the patentee has neither expressly disavowed the plain meaning of the claim term nor expressly defined the term in a way that differs from its plain meaning.”
 - “Whether claim construction, including underlying factual issues that are integral to claim construction, is a purely legal question subject to de novo review on appeal.”

Federal Circuit Responds to Perception of Conflict (*MySpace, Inc. v. Graphon Corp.*)

- Upheld district court's broad and invalidating construction of the term "database," including both hierarchical and relational database structures.
- Although *de novo* review, the appeals court "weigh[s] carefully the guidance provided by the trial court."
- Term at issue was ambiguous, so court looked to the specification:
 - "Summary of the Invention," "Background of the Invention," and "Detailed Description of the Preferred Embodiments" all had characteristics common to both relational and hierarchical systems, or were closely associated with hierarchical systems.
- Construction encompassing both kinds of databases was appropriate.

Myspace, Inc. v. Graphon Corp., 2012 U.S. App. LEXIS 4375 (Fed. Cir. 2012).

Federal Circuit Responds to Perception of Conflict (*MySpace, Inc. v. Graphon Corp.*)

- **Judge Plager examined the conflict highlighted in *Retractable*:**

“It has been suggested that a reading of this court’s claim construction cases indicates that outcomes depend on the judges’ predilection for one of two approaches. One approach is to focus on the invention disclosed in the patent: [t]ry to understand what the inventor has invented ... and then choose the claim meaning that best fits the invention. The other is to focus on the words ... used to craft the claims and then apply legal rules of construction to divine the meaning of the claim.”

- **Judge Plager went on to characterize the two views as “complementary”:**

“[I]n construing a claim there are two limiting factors—what was invented, and what exactly was claimed. To determine the former ... we look at the entire patent, with particular focus on the specification ... To determine the latter ... the focus is on the precise words of the particular claims or claims at issue ... [P]roper claim construction requires that we understand what the invention encompasses as well as how the claims are stated.”

Federal Circuit Cases in the Wake of *Retractable Tech.*

- The “two approaches” continue to be evident in recent Federal Circuit opinions:
 - Compare:

*Digital-Vending Services International, LLC v.
The University of Phoenix, Inc.* (J. Rader)

with

*Marine Polymer Technologies, Inc. v. Hemcon,
Inc.* (J. Lourie)

Federal Circuit Cases in the Wake of *Retractable Tech. (Digital-Vending Servs.)*

- District court adopted construction different from both parties. Plaintiff argued for new construction on appeal, different from all prior constructions and narrower than its original proposed construction.
 - Federal Circuit refused to consider new construction on appeal
- Overturned district court’s construction of “registration server” as too narrow in requiring that the server be free of managed content
 - Claim language in context and claim differentiation formed centerpiece of analysis
 - Specification did not clearly contradict broad claim interpretation
- Judge Moore dissented, arguing that the specification reflected a clear disavowal of broad claim scope

Digital-Vending Services Int’l v. University of Phoenix, 2012 U.S. App. LEXIS 4753 (Fed. Cir. 2012)

Federal Circuit Cases in the Wake of *Retractable Tech. (Marine Polymer)*

- District court's construction differed from the proposals of both parties
- Federal Circuit upheld narrow construction of "biocompatible" as meaning "low variability, high purity, and ***no detectable*** biological reactivity as determined by biocompatibility tests"
 - Portion of the specification demonstrated "the high biocompatibility" of the claimed invention by reference to a series of tests showing zero bio-reactivity
 - Conflicted with dependent claims allowing some detectable reactivity, but court held that "claim differentiation is not a hard and fast rule and will be overcome by contrary construction dictated by the written description"
- Judge Dyk in dissent argued that construction unduly narrow

Marine Polymer Technologies, Inc. v. Hemcon, Inc. 2012 U.S. App. LEXIS 5567 (Fed. Cir. 2012)

Federal Circuit Cases in the Wake of *Retractable Tech. (Thorner v. Sony)*

- Vacates summary judgment of noninfringement based on erroneously narrow claim constructions
- Claims must always be given their ordinary and customary meaning with only two exceptions: (1) a definition in the specification; or (2) a disavowal in the specification or prosecution history.
- “We do not read limitations from the specification into the claims; we do not redefine words. Only the patentee can do that.”
- Disavowal is an “exacting” requirement. Requires “clear and unmistakable” language manifesting a “clear intent.” The following is *not* enough:
 - a particular embodiment encompassed within the plain meaning of a claim term is criticized
 - the only embodiment or even all the embodiments of the patent contain a limitation
 - simply referring to terms in the alternative

Thorner v. Sony Computer Entertainment Am.,
669 F.3d 1362 (Fed. Cir. 2012)

Federal Circuit Cases in the Wake of *Retractable Tech. (Aventis v. Hospira)*

- Affirms broad construction of “perfusion” as “an injectable solution containing the active pharmaceutical ingredient and an aqueous solution”
 - Broad construction resulted in patent invalidity and unenforceability
- Cites *Thorner* to emphasize the “stringent standard” required to redefine a term or disavow claim scope through the specification
 - Definition or disavowal need not appear *in haec verba* in specification and instead “may be inferred from clear limiting descriptions”
 - Repeated references in the specification to perfusions with certain stability limitations were not sufficient to meet the *Thorner* requirements
- District court has discretion to take extrinsic evidence, even if intrinsic evidence supports a particular construction; extrinsic evidence must be consistent with intrinsic evidence

Aventis Pharma S.A. v. Hospira, Inc., 2012 U.S. App.
LEXIS 7095 (Fed. Cir. 2012)

“A method of treating a patient ... comprising administering ... a nebulized dose of a **budesonide composition** ... not more than once per day”

Plaintiff’s construction:

Budesonide dispersed in a solvent
in the form of a solution or
suspension, excluding the form in
which it is enclosed in a liposome

Defendant’s construction:

Budesonide dispersed in a solvent
in the form of a solution or
suspension, including the form in
which it is enclosed in a liposome

▪ **Factors relied upon the court for its decision:**

- In the “Summary of the Invention,” “Detailed Description,” and “Example” sections of the specification, the budesonide composition is repeatedly described as being administered in a suspension or solution. *Astrazeneca*, 633 F.3d at 1052.
- While the specification also describes co-administration of liposomes and budesonide, all of the examples reference liposome as an excipient that exists separately from budesonide in solution. *Id.*
- Astrazeneca’s expert testified that the claim’s once daily dosage regime required budesonide to have a “depot effect” (i.e., it forms inactive compounds with fatty acids which act as reservoirs over the course of the day). To obtain the “depot effect,” the budesonide must be in contact with solution. Enclosure in a liposome would prevent such contact. *Id.* at 1052.

“A **pharmaceutical composition for injection**, comprising: [argatroban] and/or its salt together with ethanol, water and a saccharide.”

District Court’s construction:

“a composition that is suitable for
treating medical conditions by injection”

Defendant’s construction:

“a medicinal drug composition
that can be administered by
injection” where “medicinal” only
modifies “drug” (i.e., argatroban)

▪ **Factors relied upon the court for its decision:**

- Barr was incorrect in arguing that because “medicinal” only modifies “drug,” the composition as a whole need not be therapeutic. *Mistubishi*, 435 Fed.Appx. at 934.
- While Barr was correct in arguing that “pharmaceutical” is construed as “medicinal drug,” the term applied to the entire “preparation” claimed. *Id.*
- The specification states that the entire solution constitutes the “pharmaceutical composition,” meaning as a whole it must be therapeutic. *Id.*
- Barr’s construction would allow for the addition of toxic compounds into the composition. *Id.* at 935.

“A modified release product having two portions, wherein a first portion comprises a first quantity of guaifenesin in an ***immediate release form which becomes fully bioavailable in the subject’s stomach...***”

Plaintiff’s construction:

“a form intended to rapidly release in the stomach substantially all of the active pharmaceutical ingredients for absorption”

Defendant’s construction:

“bioavailable” encompasses both the release and absorption of active pharmaceutical ingredients

▪ **Factors relied upon the court for its decision:**

- While both constructions of “bioavailable” were “reasonable ... in the abstract,” only plaintiff’s construction was consistent with the use of the term in the specification. *Adams*, 616 F.3d at 1290.
- Although the specification never defines “bioavailable,” it only uses the term when describing availability and release of the drug. *Id.*
- The specification never mentions absorption in the stomach. Only absorption in the small intestines is discussed. *Id.*
- Defendant’s construction would therefore exclude the preferred embodiment. Any construction that does not cover the preferred embodiment requires “highly persuasive evidentiary support,” which was lacking in this case. *Id.*

“**Crystalline** 7-[2-(2-aminothiazol-4-yl)-2-hydroxyiminoacetamido]-3-vinyl-3-cephem-4-carboxylic acid (syn isomer)”

Plaintiff’s construction:

“Both Crystal A and Crystal B” (as disclosed in the specification)

Defendant’s construction:

“Crystal A” (as disclosed in the specification)

▪ **Factors relied upon the court for its decision:**

- The patentee acted as his own lexicographer by equating “any crystal” of the compound to any crystal exhibiting the same powder x-ray diffraction peaks as Crystal A as disclosed in the specification. *Abbott Labs.*, 566 F.3d at 1289.
- The patent-in-suit claimed priority from a foreign patent application. The foreign patent application disclosed both Crystal A and Crystal B. The absence of Crystal B from the subsequently prosecuted patent-in-suit is sufficient evidence that patentee intentionally disclaimed Crystal B. *Id.*

**“Optically pure cis-oxalato (trans-1-1, 2 cyclohexanediamine) Pt(II)
having a general formula [as disclosed in the patent]”**

Plaintiff’s construction:

“Optically pure oxaliplatin purified
by any process”

Defendant’s construction:

“Optically pure oxaliplatin purified
by the high-performance liquid
chromatography process [HPLC]”

▪ **Factors relied upon the court for its decision:**

- Patentee had not clearly disavowed other purification processes during prosecution. *Sanofi-Aventis*, 345 Fed.Appx. at 598.
- Use of the process in the “Comparative Example” section of the specification does not rise to the level of a “clear disavowal of other processes. *Id.* at 597.
- The specification characterizes HPLC merely as an “illustrative method” and a “representative process by which the claimed compound “may be prepared.” Moreover, the specification does not define optical purity by reference to the HPLC process itself. *Id.* at 598.

Claim Construction in Practice: Trends and Observations

- Parties attempting a broad construction should ensure that intrinsic evidence does not disclaim subject matter falling within their proposed construction.
- Parties attempting a narrow construction should carefully consider the specification's description and embodiments. Narrow constructions have been defeated by minor aspects of an embodiment falling outside of a party's proposed construction.
- Attempting to define a claim based solely on pointing to the patent's preferred embodiments is disfavored.
- Courts often favor constructions based on unambiguous definitions derived from dictionaries or technical treatises. In practice, such definitions may be difficult to establish due to conflicting secondary definitions and expert testimony.
- Ordinary meaning is often overcome by showing inventors acted as their own lexicographers or disavowed a term's ordinary meaning.
 - A specification's verbal cues may suggest an idiosyncratic meaning (e.g., listing a term's qualities or using a definite article to indicate a closed list).
 - A disavowal is viewed more favorably when the disavowal still permits other embodiments within a given class.
- Claim construction is specific to the context of each patent. Aside from basic or common terms (e.g., "a" or "characterized by"), constructions of other patents do not necessarily serve as binding precedent.
- "No generalization is worth a damn, including this one." – Oliver Wendell Holmes

Bruce M. Wexler



Bruce M. Wexler

Partner, Litigation Department
75 East 55th Street
New York, NY 10022-3205

T: (212) 318-6020
brucewexler@paulhastings.com

- **Bruce M. Wexler** is a trial lawyer with extensive experience litigating patent cases, representing clients as lead counsel in cases involving multi-million and multi-billion dollar products. Recent representations include:
 - Argued and won a Federal Circuit appeal for client Boehringer Ingelheim. Mr. Wexler was hired to handle the appeal and obtained a reversal of a district court judgment of patent invalidity.
 - Won dismissals of declaratory judgment actions asserting noninfringement of several patents owned by client Eisai.
 - Argued and won a preliminary injunction preventing Sandoz from launching a generic version of Mirapex®, a leading drug for the treatment of Parkinson's Disease.
 - Obtained a preliminary injunction against Teva's threatened launch a generic version of the market leading Alzheimer's Disease drug, Aricept®, having U.S. sales of almost \$2 billion per year.
 - Successfully tried a case for Pfizer defending its patent on Accupril®, an ACE inhibitor.
 - Successfully tried a case for Eisai covering its patent for Aciphex®, an acid reflux drug with annual US sales in excess of \$1 billion. Mr. Wexler previously won summary judgment for Eisai of patent validity.
- *Chambers USA* calls Mr. Wexler a "litigation and trial expert at the firm," also noting his ability to "explain complex situations clearly to enable informed decision-making," and his "exceptional writing skills and strong technical ability." The Financial Times awarded his successful defense of the Aricept® drug franchise "standout" notice for innovative lawyering. He has been recognized in the *IAM250* leading NY IP litigators report and in *The Legal 500 US*, featured as a NY "Super Lawyer," and awarded the Burton Award for Legal Achievement in legal writing.
- Mr. Wexler is also a former judicial law clerk of the U.S. Court of Appeals for the Federal Circuit, where he served under Chief Judge Glenn L. Archer, Jr.
- Mr. Wexler received his J.D. *magna cum laude* from New York University (Order of the Coif) and his B.S. in Physics, *summa cum laude*, from Rensselaer Polytechnic Institute, where he was a member of Sigma Pi Sigma honor society.



NORTH AMERICA

- Atlanta
- Chicago
- Houston
- Los Angeles
- New York
- Orange County
- Palo Alto
- San Diego
- San Francisco
- Washington, D.C.

EUROPE

- Brussels
- Frankfurt
- London
- Milan
- Paris

ASIA

- Beijing
- Hong Kong
- Shanghai
- Tokyo

19 offices across Asia, Europe, and the U.S.
1 legal team to integrate with the strategic goals of your business

Our Offices

PAUL
HASTINGS

NORTH AMERICA

Atlanta

600 Peachtree Street, N.E.
Twenty-Fourth Floor
Atlanta, GA 30308
t: +1.404.815.2400
f: +1.404.815.2424

Chicago

191 N. Wacker Drive
Thirtieth Floor
Chicago, IL 60606
t: +1.312.499.6000
f: +1.312.499.6100

Houston

1000 Louisiana Street
Suite 5400
Houston, Texas 77002
t: +1.713.860.7300
f: +1.713.353.0111

Los Angeles

515 South Flower Street
Twenty-Fifth Floor
Los Angeles, CA 90071
t: +1.213.683.6000
f: +1.213.627.0705

New York

75 East 55th Street
New York, NY 10022
t: +1.212.318.6000
f: +1.212.319.4090

Orange County

695 Town Center Drive
Seventeenth Floor
Costa Mesa, CA 92626
t: +1.714.668.6200
f: +1.714.979.1921

Palo Alto

1117 S. California Avenue
Palo Alto, CA 94304
t: +1.650.320.1800
f: +1.650.320.1900

San Diego

4747 Executive Drive
Twelfth Floor
San Diego, CA 92121
t: +1.858.458.3000
f: +1.858.458.3005

San Francisco

55 Second Street
Twenty-Fourth Floor
San Francisco, CA 94105
t: +1.415.856.7000
f: +1.415.856.7100

Washington, D.C.

875 15th Street, N.W.
Washington, DC 20005
t: +1.202.551.1700
f: +1.202.551.1705

ASIA

Beijing

19/F Yintai Center Office Tower
2 Jianguomenwai Avenue
Chaoyang District
Beijing 100022, PRC
t: +86.10.8567.5300
f: +86.10.8567.5400

Hong Kong

21-22/F Bank of China Tower
1 Garden Road
Hong Kong
t: +852.2867.1288
f: +852.2526.2119

Shanghai

35/F Park Place
1601 Nanjing West Road
Shanghai 200040, PRC
t: +86.21.6103.2900
f: +86.21.6103.2990

Tokyo

34F Ark Mori Building
1-12-32 Akasaka
Minato-ku, Tokyo 107-6034 Japan
t: +81.3.6229.6100
f: +81.3.6229.7100

EUROPE

Brussels

Avenue Louise 480
1050 Brussels
Belgium
t: +32.2.641.7460
f: +32.2.641.7461

Frankfurt

Siesmayerstrasse 21
D-60323 Frankfurt am Main
Germany
t: +49.69.907485.0
f: +49.69.907485.499

London

Ten Bishops Square
Eighth Floor
London E1 6EG
United Kingdom
t: +44.20.3023.5100
f: +44.20.3023.5109

Milan

Via Rovello, 1
20121 Milano, Italy
t: +39.02.30414.000
f: +39.02.30414.005

Paris

96, boulevard Haussmann
75008 Paris, France
t: +33.1.42.99.04.50
f: +33.1.45.63.91.49

For further information, you may visit our home page at www.paulhastings.com or email us at info@paulhastings.com