Morgan Lewis | Webinar Series

PATENT LITIGATION SERIES

BETTER SAFE THAN SORRY

004 Claim Construction

May 27 | Jitsuro Morishita

Morgan Lewis

CLAIM CONSTRUCTION

Morgan Lewis

ORDINARY MEANING

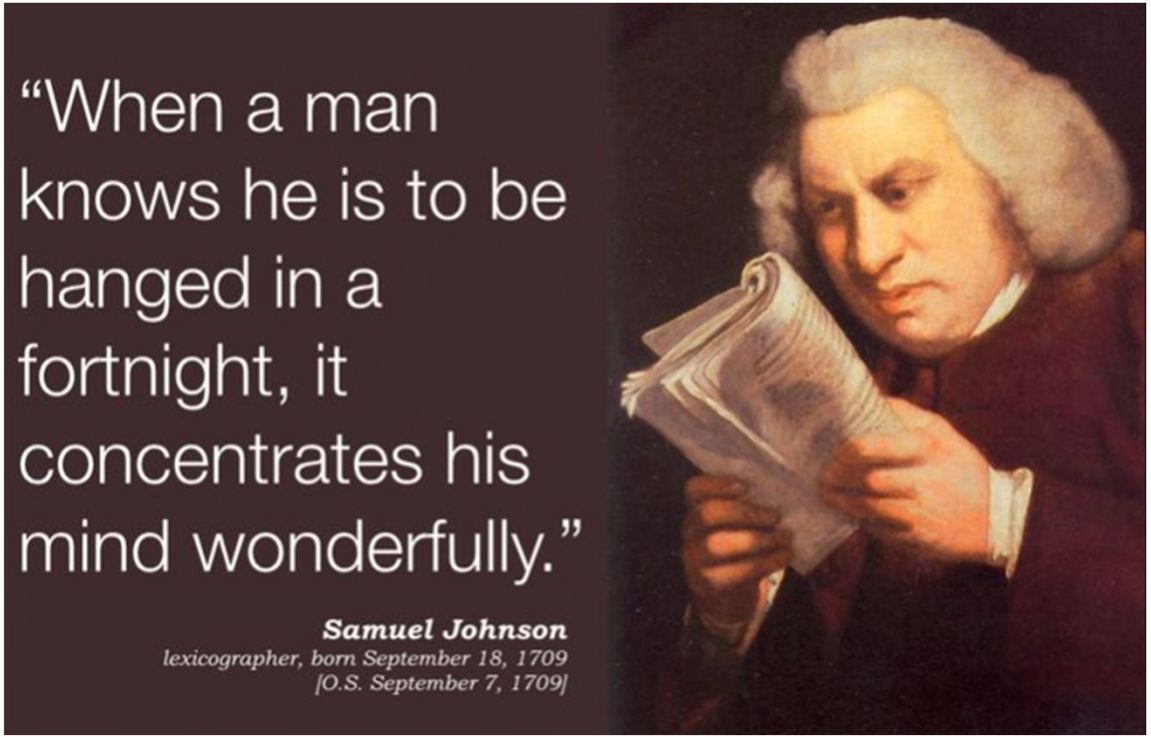
Ordinary Meaning

The meaning that a person of ordinary skill in the art would give to claim language at the effective filing date of the patent application, having considered the intrinsic and extrinsic evidence, is the "ordinary and accustomed meaning" of the claim terms, which is considered to be the "objective baseline" for claim construction

Factors Considered in Case of Deviation from Ordinary Meaning

- Inventors may expressly define terms differently than ordinary meaning
- Consistent usage of claim terms in patent and prosecution history
- Surrendering claim scope during prosecution
- Ambiguity in claim term (may limit claim scope to preferred embodiment)

Lexicographer Rule



Ordinary Meaning

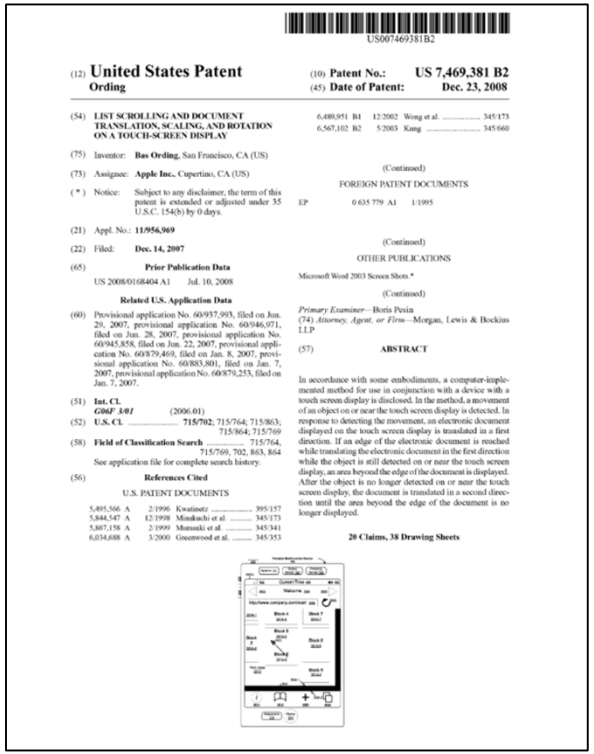
Inventors may expressly define terms differently than ordinary meaning

Lexicographer Rule

An inventor may expressly (i.e. clearly and unambiguously) define claim terms, even defining terms inconsistently with the ordinary meaning of the term known to those of ordinary skill in the art.

- "When a patentee acts as his own lexicographer in redefining the meaning of particular claim terms away from their ordinary meaning, he must clearly express that intent in the written description." *Merck & Co. v. Teva Pharms. USA*, 395 F.3d 1364, 1370 (Fed. Cir. 2005).

Intrinsic v. Extrinsic Evidence



US007469381B2

(12) **United States Patent**
Ording

(10) **Patent No.: US 7,469,381 B2**
(45) **Date of Patent: Dec. 23, 2008**

(54) **LIST SCROLLING AND DOCUMENT TRANSLATION, SCALING, AND ROTATION ON A TOUCH-SCREEN DISPLAY**

(75) Inventor: **Bas Ording**, San Francisco, CA (US)

(73) Assignee: **Apple Inc.**, Cupertino, CA (US)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

(21) Appl. No.: **11/956,969**

(22) Filed: **Dec. 14, 2007**

(65) **Prior Publication Data**

US 2008/0168404 A1 Jul. 10, 2008

Related U.S. Application Data

(60) Provisional application No. 60/937,993, filed on Jun. 29, 2007, provisional application No. 60/946,971, filed on Jun. 28, 2007, provisional application No. 60/945,858, filed on Jun. 22, 2007, provisional application No. 60/879,469, filed on Jan. 8, 2007, provisional application No. 60/883,801, filed on Jan. 7, 2007, provisional application No. 60/879,253, filed on Jan. 7, 2007.

(51) **Int. Cl.**
G06F 3/01 (2006.01)

(52) **U.S. Cl.** **715/702**; 715/764; 715/863; 715/864; 715/769

(58) **Field of Classification Search** 715/764, 715/769, 702, 863, 864

See application file for complete search history.

(56) **References Cited**

U.S. PATENT DOCUMENTS

5,495,566	A	2/1996	Kwatinetz	395/157
5,844,547	A	12/1998	Minakuchi et al.	345/173
5,867,158	A	2/1999	Murasaki et al.	345/341
6,034,688	A	3/2000	Greenwood et al.	345/353
6,480,951	B1	12/2002	Wong et al.	345/173
6,567,102	B2	5/2003	Kung	345/660

(Continued)

FOREIGN PATENT DOCUMENTS

EP 0 635 779 A1 1/1995

(Continued)

OTHER PUBLICATIONS

Microsoft Word 2003 Screen Shots.*

(Continued)

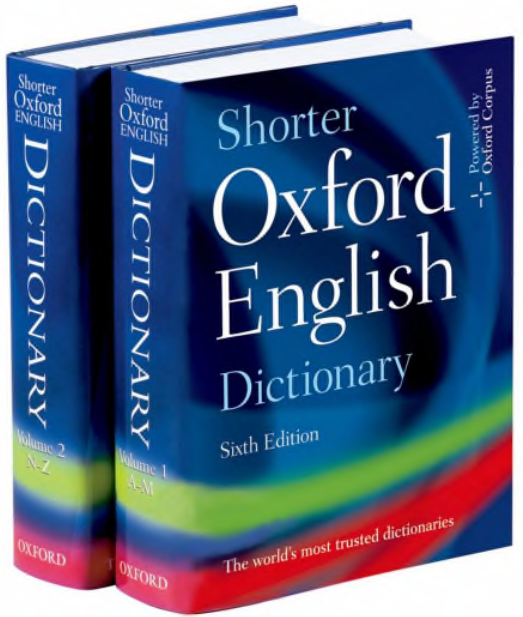
Primary Examiner—Boris Pesin
(74) *Attorney, Agent, or Firm*—Morgan, Lewis & Bockius LLP

(57) **ABSTRACT**

In accordance with some embodiments, a computer-implemented method for use in conjunction with a device with a touch screen display is disclosed. In the method, a movement of an object on or near the touch screen display is detected. In response to detecting the movement, an electronic document displayed on the touch screen display is translated in a first direction. If an edge of the electronic document is reached while translating the electronic document in the first direction while the object is still detected on or near the touch screen display, an area beyond the edge of the document is displayed. After the object is no longer detected on or near the touch screen display, the document is translated in a second direction until the area beyond the edge of the document is no longer displayed.

20 Claims, 38 Drawing Sheets

v.



Ordinary Meaning

- **Consistent usage of claim terms in patent and prosecution history**
  - Inference made as to the inventor's intention for claim construction
  - Go search for claim terms by same inventor/assignee
- **Surrendering claim scope during prosecution**
  - Estoppel applies to claim construction as well
  - Statements made in family applications may be inferred
- **Ambiguity in claim term**
  - Using ambiguous claim term may limit the claim scope to the preferred embodiment or make the claim invalid as indefinite

CLAIM DIFFERENTIATION

Claim Differentiation

- The doctrine of "claim differentiation" provides that "each claim in a patent is presumptively different in scope."
- Claim differentiation gives rise to a rebuttable presumption for claim construction purposes, especially when comparing the scope of an independent claim in view of its dependent claims. If there is no meaningful difference between an independent claim and its dependent claim, the dependent claim becomes "superfluous."

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

  See Phillips v. AWH Corp., 415 F.3d 1303, 1315 (Fed. Cir. 2005)

Realtime Data, LLC v. Iancu (Fed. Cir. 2018)

US6,597,812

1. A method for compressing input data comprising a plurality of data blocks, the method comprising the steps of: ...

maintaining a dictionary comprising a plurality of code words, wherein each code word in the dictionary is associated with a unique data block string; … and

outputting the code word representing the built data block string.

5. The method of claim 4, wherein the step of maintaining the dictionary **further comprises** the step of **initializing the dictionary if the number of code words exceeds a predetermined threshold**.

Claim Differentiation

"Claim differentiation is a guide, not a rigid rule"

See Laitram Corp. v. Rexnord, Inc., 939 F.2d 1533, 1538 (Fed. Cir. 1991)

- Cannot broaden claims beyond their correct scope
- Written description and prosecution history may overcome any presumption arising from the doctrine of claim differentiation
  - patentee cannot attempt to recapture the subject matter disclaimed through prosecution

Morgan Lewis

CLAIM DISAVOWAL

Disavowal/Disclaimer

"The Invention" or "The Present Invention"

Descriptive embodiments used in connection with terms such as "the invention" or "the present invention" may be used to define the scope of the claim.

> Claim term "**fuel injection system component**" was limited to a "**fuel filter**" since only "fuel filters" were disclosed as the embodiment and the specification repeatedly described the fuel filter as "this invention" and "the present invention." The Federal Circuit noted that given the repeated descriptions in the patent specification of "the invention," the "**public is entitled to take the patentee at his word** and the word was that the invention is a fuel filter."
>
> *See Honeywell Int'l Inc. v. ITT Indus., Inc.*, 452 F.3d 1312 (Fed.Cir. 2006)

Disavowal/Disclaimer

"Objects of the present invention" stated "it is a principal object of the present invention to provide a computer-implemented, network-based system having a networked server, database, client computer, and input/output device for use by individuals engaged in repetitive motion activities . . . ."

"Those and other objects and features of the present invention are accomplished … by a repetitive motion pacing system that includes…a data storage and playback device adapted to producing the **sensible tempo**."

See Pacing Techs. v. Garmin International (Fed. Cir. 2015)

DYSFUNCTIONAL CLAIMS

Dysfunctional Claims

The district court can correct an error in the claim, but may not redraft, only if the error is evident from the **face of the patent**.

Two Requirements for Court Correction

(1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification

(2) the prosecution history does not suggest a different interpretation of the claims

"heating the resulting batter-coated dough **to** a temperature in the range of about 400°F to 850°F"

Heating the dough "**at**" that temperature range results in the desirable product described in the specification. Even though it would be nonsensical to require heating the dough "to" 400°F, the court refused to construe the claims otherwise, and the Federal Circuit affirmed, which rendered the claims non-infringed.

See Chef Am., Inc. v. Lamb-Weston, Inc (Fed. Cir. 2004)

Dysfunctional Claims

Administrative Errors by the Patent Office

Federal Circuit ruled that the district court could have fixed an error in patent claim numbering that left a dependent claim without a reference to its independent claim, where the appropriate reference was easily determined by reference to the prosecution history.

See Hoffer v. Microsoft Corp., 405 F.3d 1326 (Fed. Cir. 2005).

When a district court construes a patent claim to correct an error, that construction generally has a **retroactive effect**, whereas corrections by the Patent Office are **prospective**. Thus, litigants have a strong incentive to fix errors through judicial construction as opposed to petitioning the Patent Office for a certificate of correction.

Morgan Lewis

SPECIFIC TERMS

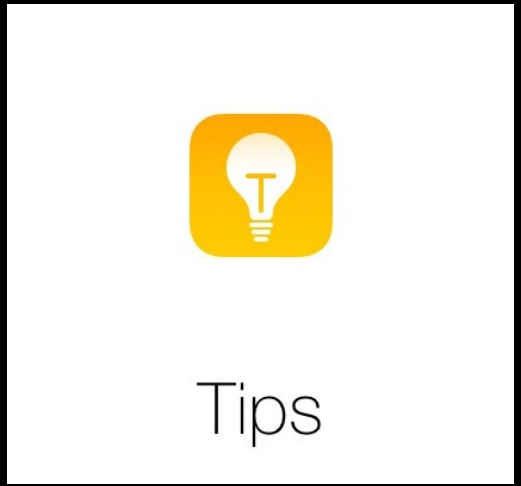
Specific Terms

a, an	One or more
about	Avoids a strict numerical boundary. Same as essentially "About" not indefinite as used in limitation 'stretching … at a rate exceeding about 10% per second' W.L. Gore & Associates, Inc. v. Garlock, Inc., (Fed. Cir. 1983) "Less than about 2%," was insolubly ambiguous since a competitor would not know the bounds of the limitation where the specification provide no guidance as to how much above 2% would qualify as "about 2%" *Synthes v. Smith & Nephew, Inc.* (E.D. Pa. 2008)
adjoining	Touching
approximately	Serves only to expand the scope of literal infringement, not to enable application of the doctrine of equivalents
in, between, within; within	Not required to be completely or continuously in, between or between may be satisfied even if extension beyond boundaries

Specific Terms

mixture	Open ended and does not exclude additional, unnamed ingredients
surround	To encircle on all sides simultaneously
standard, normal, conventional, traditional	Time-dependent terms that are limited to technologies existing at the time of the invention
up to about	May include or exclude the endpoint, depending on the context. Where the endpoint is numeric (e.g., up to about 10%), the endpoint may be included; whereas, where the endpoint is physical (e.g., painting the wall up to about the door), the endpoint may be excluded

PRACTICAL TIPS



Continuation/Reissue

- ALWAYS consider applying for **continuation application** for important patents
- Any deficiencies in the claims that may arise during negotiation or litigation with 3rd party may be cured through the conitunation application
- The fact that the continuation application is pending puts immense pressure on the 3rd party engaged in negotiation or litigation
- Consider applying for **broadening reissue**, if the patent with deficiencies in the claim was issued less than 2 years ago
- Be aware of **intervening rights** in case of filing a reissue

Means Claim

- **Use Claim Differentiation**
  Include a claim reciting a "**means for**" performing the functions mentioned in the other claims. This would allow the argument that by choosing "means for" in one claim, **there was no intent to invoke MPF term in another** under the claim differentiation theory.

  The added dependent claim including "means for" elements would also **safeguard the addition of structural support** to the specification.

Diverse Claim Portfolio

- Same inventive concept claim in various ways makes the claims difficult to invalidate
- Make sure to consider including apparatus, method, and system claims
- **Picture claims** and **Multiple Claims** are effective to avoid invalidty arguments
- Method claims are useful in order to avoide **patent marking obligations**

Diverse Claim Structure

- Study various types of claim structure and determine which type of claim structure best claims the invention
- Focus the study on claims in the same technical field that went through US patent litigation or survived an IPR
- Create a claim encyclopedia that can be shared and updated amongst the IP division
- Create a translation chart for various claim terms used in the past specifications

Technical Discussion

- Technical discussion is a very effective training method to understand how the claims may be attacked and defended
- Participating in technical discussion not only improves how to attack and defend patent claims, but helps to increase the skills for prosecuting patents by understanding the important issues that would come up in the future

Jitsuro Morishita
Partner
Tokyo: 03-4578-2530
Mobile: 070-1498-0066
jitsuro.morishita@morganlewis.com

Jitsuro Morishita devotes his practice to resolving complex global disputes in the areas of intellectual property, antitrust, governmental investigations, environmental issues, and labor.

Early in his career, he worked in-house for two global technology companies, Pioneer Corporation and Fujifilm Corporation, bringing unique expertise to advocate using profound understanding of Japanese company cultures.

Jitsuro is devoted to bringing his clients (i) easy communication using excellent communication skills, (ii) pleasant surprises from creative and out-of-the-box ways of thinking, and (iii) deep satisfaction through great results and client-friendly experiences.

Our Global Footprint

30 OFFICES
ACROSS 17 TIME ZONES

700 PARTNERS

150+ SENIOR LAWYERS

1000+ ASSOCIATES & OTHER LAWYERS

400 LEGAL PROFESSIONALS