



Presentation to: United States Patent and Trademark Office

Claim Construction and Doctrine of Equivalents: A Review

Presented by Henry C. Su

*March 29, 2022 Biotechnology, Chemical, and Pharmaceutical
Partnership Meeting*

Infringement of a U.S. Patent

- 35 U.S.C. § 271(a) – Infringement
 - Unauthorized
 - Manufacture, use, offer for sale, or sale / importation
 - Within the United States / into the United States
 - **Patented invention**
 - During the patent term
- 35 U.S.C. § 281 – Bring an action for infringement
 - Accuse product or process of practicing the **patented invention**
- 35 U.S.C. § 282(b) – One defense is noninfringement
 - Accused product or process is **not** practicing the **patented invention**

Does the Accused Product or Process Practice the Patented Invention?

- Direct infringement –
 - Accused product or process practices the **patented invention**, as set forth in any **asserted claim**
 - *Grober v. Mako Products, Inc.*, 686 F.3d 1335, 1344 (Fed. Cir. 2012) (“a patent is infringed if a single claim is infringed”)
- All Elements Rule –
 - **Each and every element or limitation** of an **asserted claim**—or its **equivalent**—must be present into accused product or process
 - *V-Formation, Inc. v. Benetton Group SpA*, 401 F.3d 1307, 1312 (Fed. Cir. 2005) (“Literal infringement requires that each and every limitation set forth in a claim appear in an accused product.”)
- Not applicable to design patents

Two-Step Inquiry for Infringement

- Step 1: **Construe** the terms of each asserted claim to determine its meaning and scope.
 - Question of **law** for the court to decide
- Step 2: **Compare** the accused product or process to the asserted claim, as properly construed, on an element-by-element basis.
 - Question of **fact** for the jury to decide (or judge in a bench trial)
- *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996)

Claim Construction Is Step 1

- Procedure usually involves a hearing during which the court receives evidence relevant to the meaning and scope of disputed terms – this is known as a **Markman hearing**
 - Only **disputed** terms are construed; presumably these are the claim terms and claim elements or limitations that are contested by the parties
 - The court may receive **documents** (e.g., patent, prosecution history, treatises) and **testimony** (e.g., inventor, experts), as well as **briefs** containing the parties' analyses and arguments
 - There may also be scientific **tutorial** that precedes the evidence and argument

Two Types of Evidence

- **Intrinsic** evidence
 - **Starting point** for any claim construction
 - “Highly fact and case-specific” – *Emerson Elec. Co. v. SIPCO, LLC*, 826 F. App’x 904, 914 (Fed. Cir. 2020)
 - Usage of terms may vary from patent to patent, and from one technical field to another
- **Extrinsic** evidence
 - **Consulted only if** intrinsic evidence fails to provide clear meaning and scope
 - Generally involves evidence concerning relevant scientific principles, widely accepted meaning of technical terms, and the state of the art

Intrinsic Evidence

- **Intrinsic** evidence refers to the **claims**, the **specification**, and the **prosecution history** – *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314–17 (Fed. Cir. 2005) (en banc)
- Goal of claim construction is to construe the disputed terms as a **person of ordinary skill in the art** (POSITA) would, when reading the patent
 - Such a person would read the disputed terms in the context of the claims in which they appear, and in light of the patent as a whole, including the specification

Claims

- Disputed claim terms are generally given their **ordinary and customary meaning**, which is how a POSITA would construe them
- Additionally:
 - **Context** matters – construe disputed terms in the context of the claims in which they appear
 - **Placement** may make a difference – consider where in the claim a disputed term appears (i.e., preamble, transitional phrase, elements/limitations)
 - Doctrine of **claim differentiation** may create a rebuttable presumption that disputed terms appearing in different claims may have different meanings and scope

Specification

- The specification is **always highly relevant** to claim construction
- Basic premise is that a claim, when properly construed, should **naturally align with** what the specification describes as the claimed invention
- A specification therefore can be particularly helpful to construction when:
 - It describes the **preferred or sole embodiment** of the claimed invention, or it **excludes** certain embodiments (but claims should not be limited to, or be divorced from, what is in the specification)
 - It **distinguishes** the claimed invention from the prior art
 - It **defines** certain terms (the patentee may be his or her own lexicographer if that is made clear)

Prosecution History

- The prosecution history is considered **less helpful** than the specification because it reflects a **back-and-forth** and **give-and-take** between the applicant and the examiner
 - It therefore may not have the specification's clarity and finality as a document that speaks to the public
- That said, it can be helpful in determining claim scope if the applicant has **disclaimed** certain interpretations to overcome rejections based on prior art
- Basic idea is that a patentee **cannot take inconsistent positions** with respect to meaning and scope to obtain allowance and to accuse infringement

Extrinsic Evidence

- **Extrinsic** evidence refers to anything outside of the patent or its prosecution history, *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317–18 (Fed. Cir. 2005) (en banc)
- It can include:
 - Dictionaries
 - Treatises
 - Expert testimony
- The court does not have to consider extrinsic evidence, and it may not use extrinsic evidence **to vary or contradict** the intrinsic evidence
 - Basic idea here is that the court is not at liberty to rewrite the patent

Dictionaries and Treatises

- Generally speaking, dictionaries and treatises are given **more weight** than other outside sources because these references directly speak to meaning and understanding
- But these references must be able to provide the meaning and understanding from the **time of the invention** because that is the meaning and understanding that would be ascribed by POSITA

Expert Testimony

- Expert witnesses may assist in the court in a variety of ways:
 - Provide the **necessary scientific or technical background**
 - Explain **how the claimed invention works**
 - Ensure that the court's understanding of the patent's scientific or technical aspects is **consistent with that of POSITA**
 - Establish that a particular term in the patent or the prior art has a **particular meaning in the relevant technical field**
- Generally speaking, expert witnesses do not define disputed claim terms for the court; the court should consult the intrinsic evidence first

Output

- End result of claim construction is typically a **court order and opinion** construing the disputed claim terms and providing appropriate citations to the intrinsic evidence (and, if warranted, the extrinsic evidence)
- The parties in an infringement action can appeal this ruling, like any other court ruling in the case, to the United States Court of Appeals for the Federal Circuit, which will undertake its own claim construction exercise (called **de novo review**)

Doctrine of Equivalents Is Part of Step 2

- Once the disputed claim terms have been properly construed, the second step is to **compare** the accused product or process to each asserted claim
- **Literal** infringement is established as a factual matter if the accused product or process practices **each and every element or limitation** of an asserted claim
- If the accused product or process does not infringe literally, it may still infringe under the **doctrine of equivalents** if it practices the **equivalent** of any element or limitation of an asserted claim
 - *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 21 (1997)

Analysis of Equivalence

- **Insubstantial differences test** –
 - An accused product or process's feature is equivalent to a claim element or limitation if the differences between them would be regarded as **insubstantial** by a POSITA
 - *Catalina Marketing International, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 813 (Fed. Cir. 2002)
- **Function-way-result test** –
 - An accused product or process's feature is equivalent to a claim element or limitation if it performs substantially the same function in substantially the same way to produce substantially the same result
 - *Crown Packaging Tech., Inc. v. Rexam Beverage Can Co.*, 559 F.3d 1308, 1312 (Fed. Cir. 2009)

Prosecution History Estoppel

- A patent's prosecution history may **limit or even extinguish** a claim of infringement under the doctrine of equivalents
- Specifically, a patentee may, by **amending** a claim to overcome a rejection based on prior art, surrender subject matter that cannot later be recaptured using the doctrine of equivalents
- **Arguments and representations** that do not involve amendments can also lead to estoppel if they are clear and unmistakable
 - Even representations made to foreign patent offices may give rise to estoppel if the claims are identical
- Estoppel may also attach from amendments and arguments made for one claim to other claims in the same patent or subsequent, related patents

Overcoming Estoppel

- The patentee bears the burden of proving that an amendment was **not** made for a reason that would give rise to estoppel
 - **Silence** with respect to an amendment is especially difficult to overcome; a patentee is presumed to surrender all subject matter between the broader and the narrower language
- The patentee bears the burden of showing that an amendment does **not** surrender the particular equivalent in question
 - Perhaps the equivalent in question could not reasonably be **foreseen**, or there is some other reason why the patentee could not have been reasonably expected to draft claims covering the equivalent in question

Questions?



Henry C. Su
Trial Lawyer

Washington, DC
hsu@bradley.com
202.719.8242