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Tips For Winning More Defenses In Markman

Law360, New York (July 10, 2009) -- Win cases in Markman by moving from old-school Markman to Markman 2.0.

Old-School Markman:

Create a mini-dictionary defining selected claim terms. Defendant proposes narrow statements of what claim terms must include to set up noninfringement or resists such constructions to set up prior-art invalidity. That's it.

Markman 2.0:

Construe claim as a whole. Identify claim portions having no patentable weight. Seek "Must Not," "Need Not," and "May" as well as "Must" constructions to win up to 10 defenses in Markman.

Tips For Making Yours a Markman 2.0 Proceeding

1) Construe Claim as a Recipe: Claimed "Invention" NEED NOT Have/MUST NOT Have/MAY Have These Ingredients

Property rights are the legal consequence of a patent claim, but the claim itself does not define a property boundary. It defines a class of things or methods, including, perhaps, structures, functions and steps. This is similar to a recipe. This distinction affects claim construction.

A property line is one dimensional. A recipe has more dimensions; it defines not only what the dish must include, but also (coupled with the chef's common sense) what the dish must not include, and may include, and need not include.

E.g., construe claim to "Vegan Veggie Tofu Stir Fry" as follows:

- MUST be/include/have ... Tofu, plant-based Oil, Vegetable, combined over a Heat Source
- NEED NOT be/include/have ... any Particular Vegetable
- MUST NOT be/include/have ... Meat (or Meat broth), Dairy, on Fire
- MAY be/include/have ... Spices, Wine

2) *Construe Claim As a Whole*

Where strategic, seek constructions of the scope of the claim as a whole, not just individual claim terms in isolation.

See, e.g., *Power Mosfet Technologies LLC v. Siemens AG*, 378 F.3d 1396, 1404 (Fed. Cir. 2004) (“The terms in the Special Master Report were construed in isolation, and at no other time did the district court or the Special Master construe the claims as a whole.”); *id.* at 1410 (This “limited construction left substantial ambiguity as to the meaning of the claims as a whole.”); *id.* at 1412 (“A construction of the claims as a whole would have been beneficial to the litigants.”).

3) *Win Sec. 101 Defense in Markman*

Seek construction that the claim as a whole NEED NOT require a particular machine and NEED NOT require a particular transformation of a particular article.

Seek construction that claimed process MAY be performed entirely in one’s mind or by two people communicating aided by pencil and paper, etc.

4) *Construe Which Claim Language Lacks Patentable Weight*

Some claim language has no patentable weight. E.g., a statement of intended use, some language in a preamble or whereby or thereby clause, language constituting or analogous to “printed matter” (e.g., information (e.g., software code) having insufficient relationship to a physical substrate), nonstatutory subject matter and functional language implying no structure.

Seek construction that certain identified language has no patentable weight and cannot be used to distinguish prior art.

5) *Construe Claims in Context of Invalidating Prior Art*

“[W]hile a claim is not to be construed in light of the accused device, in an infringement case, it must inevitably be construed in context of the accused device.” *Wilson Sporting Goods Co. v. Hillerich & Bradsby Co.*, 442 F.3d 1322, 1327 (Fed. Cir. 2006); accord *Lava Trading Inc. v. Sonic Trading Mgm’t LLC*, 445 F.3d 1348, 1350 (Fed. Cir. 2006).

Apply this same logic to your prior-art anticipation defense. If strategic, explain your lead prior art and tell court that person of ordinary skill in the art would have read claims in context of that art. In your claim construction, use terminology from that prior art.

6) Avoid “Experimental” Use/Sale Defeating Public Use/On Sale Defense

If you’re concerned about “experimental use” defeating your “public use” or “on sale” defense, seek constructions that claim NEED NOT include features or uses that were subject of the testing.

7) Defeat Early “Date of Invention”

Study the evidence of alleged actual reduction to practice and — if you want to urge a later reduction to practice date than being sought by the patent owner — then consider adding to MUST constructions items missing from the alleged reduction to practice, and/or adding to MUST NOT constructions items present in the alleged reduction to practice.

8) Win “Written Description” Defense in Markman

Where disclosed invention is narrower than the claim (e.g., discloses a species of the claimed genus), consider a NEED NOT claim construction.

E.g., if (1) the application appears to require something as a “nonoptional” element, (2) the claim is open to being construed as not requiring that element, and (3) the accused technology (including reasonable redesigns) include that element, then consider adding this feature to a NEED NOT construction.

9) Prevent Claims Being Backdated to Ancestor Application

Claims Cover New Embodiments: If you spot something in final application in the family chain that is missing from earlier application(s), consider including that as part of a MUST or MAY construction.

E.g., parent disclosed user/customer interface only on vending machine. CIP added embodiments where user interface was on customer’s laptop. Claim construed in view of CIP’s disclosure to mean customer interface covered either location.

As a result, claims not entitled to original application filing date and on summary judgment were invalid for anticipation. *PowerOasis Inc. v. T-Mobile USA Inc.*, 522 F.3d 1299 (Fed. Cir. 2008).

10) Build Up Materiality Prong of Inequitable Conduct Defense

Seek construction with eye toward proving materiality of withheld or misstated information. E.g., if applicants withheld a prior art reference, use language of that reference as part of your proposed MUST or MAY constructions, where appropriate.

If applicants promised superior performance and withheld test results undermining those promises, consider including those promised results as part of a MUST construction.

If a withheld reference is lacking something described in the patent but possibly not required by the claims, consider identifying that feature in a NEED NOT construction.

11) Bolster Double Patenting and Section 135(b) Defenses

If you've found a promising Sec. 135(b) prior "interfering" patent/publication candidate or promising Sec. 101 "double patenting" patent, consider using the language of the prior claims in your construction of the challenged claim, to further cement the overlap between the "interfering" claims.

12) Avoid Sec. 121 Defeating Double Patenting Defense

Section 121 protects divisional applications from double patenting invalidity, but only to extent divisional's claims were required to be claimed in the divisional, rather than in the original application, by a PTO restriction requirement. E.g., include the restriction required by the Examiner as part of a NEED NOT construction, to bolster argument that the divisional claims are not consonant with that requirement.

13) Advance Matter-of-Law Restrictions on Doctrine of Equivalents (DOE)

When choosing what claim language to construe and what constructions to seek, have these matter-of-law restrictions on DOE in mind:

- 1) DOE may not effectively eliminate (vitate) any claim element in its entirety;
- 2) DOE may not recapture subject matter disavowed in the written description;
- 3) DOE may not encompass subject matter disavowed in the prosecution history to obtain the patent; and
- 4) DOE may not encompass embodiments disclosed in the specification but not claimed.

14) Don't Stop at the Issued Claims of the Asserted Patents

Seek construction of application-pending claims that did not issue but whose scope affects a defense, such as the materiality prong of an inequitable conduct defense.

Seek construction of claims in earlier patents supporting a “double patenting” or Sec. 135(b) defense. The scope of such claims is as much a question of law as the scope of the asserted issued patent claims.

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