

# LITIGATORS CORNER:

## Markman Hearings: Some Guidelines



BY JOSEPH N. HOSTENY,  
OF NIRO, SCAVONE,  
HALLER & NIRO

*Regular IP Today columnist Joseph N. Hosteny is an intellectual property litigation attorney*

*with the Chicago law firm of Niro, Scavone, Haller & Niro. A Registered Professional Engineer and former Assistant US Attorney, his articles have also appeared in Corporate Counsel Magazine, The Docket (American Corporate Counsel Association), American Medical News, Inventors' Digest, Litigation Magazine and Assembly Engineering Magazine. Mr. Hosteny is on the Board of Editors of Patent Strategy & Management (a monthly publication of American Lawyer Media), for which he writes periodic guest columns. Mr. Hosteny can be reached at (312) 236-0733, or by e-mail at [jhosteny@hosteny.com](mailto:jhosteny@hosteny.com), or by visiting his web site at <http://www.hosteny.com>.*

**M**arkman hearings. They are up there with death and taxes: undesirable, but unavoidable. So what are the ground rules? What should you think about before writing a *Markman* brief, or conducting a hearing on claim construction? Here are some of the ways we mark the safe water in the channel.

First, point out the purpose of claim construction; its goal is simplicity: to provide a finder of fact — a jury of real people — with reasonable and sensible instructions for deciding whether a claim is infringed. Clarity is paramount, so don't get lost in word-smithing. Don't provide or accept circular definitions that repeat the terms being defined. Don't use definitions that add words but no meaning, making a jury's analysis more complicated and prolonged. Above all, don't accept new limitations to claims, which would confuse a jury and wrongly increase the burden of proving infringement. Everyone recognizes that

patents are intended for special audiences that don't include judges or lawyers, but ironically, judges and lawyers are often the only people in the room when a claim is being interpreted. A little dose of reality doesn't hurt. Clearly address the invention and the advance it represents.

I like to point out what the typical accused infringer is really doing in claim construction, especially when it occurs early in a case. At that juncture, the defendants have better access to evidence about the accused device or method than does the plaintiff or the court. This evidence is not extrinsic, and defendants should not use it, but they do. Claim construction is supposed to occur in a spotless "clean room," uncontaminated by external sources. One contaminant is the accused product or method, which is not to be used or referred to in construing the claims. *Young Dental Mfg. Co. v. Q3 Special Products, Inc.*, 112 F.3d 1137, 1141 (Fed. Cir. 1997) says, "First, the claim scope is determined without regard for the accused device.", citing *General Mills, Inc. v. Hunt-Wesson, Inc.*, 103 F.3d 978, 981 (Fed. Cir. 1997).

While this principle of law is most often applied to the plaintiff, it is not so limited. No one is supposed to refer to the accused product. But, in the real world, that is exactly what defendants do. They look at their own accused process or apparatus, and ask themselves: How can the claims be interpreted — or twisted — so that they do not read on the accused product? In other words, they use extrinsic evidence as a secret way to shape claim interpretation. We tell courts that the defendants plant a minefield, hoping we will step on one of the many mines. One is all it takes to lose.

You need to illuminate the legal principles that govern claim construction. The level of detail, however, has to be considered. Some federal courts hear a patent suit only once in a while. Or you may have a new judge. If so, you may want to spend more time and pages in your brief elucidating these basic guidelines. In other courts — such as one in Chicago where we

recently finished a second claim construction before the same judge — there is no point in telling the court what it already knows. Our opening claim construction brief included only ten cases. We were able to shorten our brief, keeping it a brief brief, as it were. Too many lawyers equate length and many citations with clearer thinking and more effective argument. Usually the opposite is achieved by that foggy approach. Remember that you are writing jury instructions. It doesn't hurt to say so: real people will have to read and use any definitions you provide.

Start with the claim. When a word or a phrase is to be interpreted, the court should look first to the claim itself to see how the word or phrase is used. This should be obvious, but many defendants are so eager to interpret a claim in light of the specification or the file history that the starting point is easily obscured. In our most recent claim construction hearing, we were debating the meaning of "fabrication sequence" in the claim. The parties debated the issue, and our court stayed with the claim, which said "fabrication sequences consisting of process steps." The court found the meaning right in the claim itself, where the contested phrase was used. So stick with the claim.

Look at other claims, both independent and dependent. Compare the claim containing the phrase of interest with other claims. In our case, "fabrication sequence" was used in more than one claim. A later claim said the "fabrication sequence" had additional features. The parties disagreed over the meaning of "fabrication sequence." We used the difference between the two claims to argue that "fabrication sequence" could not be defined always to include the additional features recited only in the later claim.

We did the same in another case where the dispute involved whether "pixels," a short-hand term for picture elements in an electronic image, were the smallest possible element of the image. We argued that there were even smaller elements, called "sub-pixels." Some claims referred to pixels. Another claim referred to a portion of a pixel. We argued successfully that the two types of claims meant that there could be sub-pixels as well as pixels. The parties disagreed whether another term, "image element," encompassed both pixels and sub-pixels. Again, one independent claim

referred to image elements, and another dependent claim described the image elements as pixels. Accepting the defendants' argument would have meant that two related claims — one independent and one dependent — using different words would be interpreted to have the same scope and mean the same. The court held that “image elements” could mean a pixel or a sub-pixel.

Of course, dictionaries can be overused, as the CAFC said in *Philips v. AWH*, 415 F.3d 1303 (Fed. Cir. 2005). Nevertheless, it is worth checking to see what dictionaries or other sources may have to say about a word's definition. In the above-mentioned case, we used a technical dictionary or two, as well as a computer science text, to show that the meanings we proposed for terms in the patent were not special, and were consistent with the knowledge of persons of ordinary skill in the art.

Another rule is not to import limitations from the specification into the claim. I believe that many defendants start by looking through the wrong end of the telescope. They read the specification to see how the invention is described, and then make an unwarranted mental leap to conclude that a claim has to describe a complete invention. It does not. As I wrote in my September, 2005 column, *A Claim Does Not Describe an Invention*, a claim need not recite everything in the specification, even if the thing described is an element of the invention. I cited the inventions of the Wright Brothers, Henry Ford, and Chester Carlson as examples. This mistake leads to adding limitations to claims. As the CAFC has recognized, there's a fine line between interpreting a claim in light of a specification, and adding limitations to a claim. So I suggest saying something about it.

Are there multiple embodiments in the specification? If your patent includes more than one embodiment, use that fact to prevent the opposing party from narrowing the claims. Many patents written after *Markman* probably have multiple embodiments, the better to avoid an argument that a claim in a patent with one embodiment gets limited to the features of that embodiment. In light of the statutory and case law that says an inventor needs to describe only one embodiment of his invention, it should be clear as a matter of English usage that choosing to describe one workable version

[www.ConflictChecker.com](http://www.ConflictChecker.com)

**Conflict**  **Checker**

Instant Online Conflict Checks

IP Intelligence on Companies and Law Firms

of an invention does not exclude other workable versions of the invention. A document implies more than it expressly states. After all, the patent specification is supposed to be exemplary, not exhaustive, and need not state every embodiment. The principle of using a preferred or single embodiment to limit the claims is a bad one, but you must live with it.

Don't fail to provide a proposed meaning for a phrase whose meaning is disputed. In one of our cases, our client's previous attorney had not provided an interpretation for a claim limitation, if the limitation was construed to be in means-plus-function form. He simply argued that the element was not in that form. His argument failed. Not having any proposed meaning from him, the court adopted the opposing party's interpretation. In a second case, the court asked me why we had proposed meanings even though our brief said that a number of terms were plain and ordinary, and didn't require further definition. Remembering what had happened in the first case, I said we didn't want to be left high and dry if the court decided a definition was desirable. The result? Our court felt definitions were preferable, and adopted most of our proposals. Had we not provided definitions, the court would have had to formulate its own or adopt our adversary's definitions.

Means-plus-function requires that you be careful. Everyone can get easily confused. Identify the function. Then identify the structure that carries it out. The structure might be very general. In one of our cases, the structure for “tuner means” is a rectangle containing the word “tuner.” We pointed to numerous texts and other patents showing that tuners are well known to those of skill in the art. Thus, a detailed description was not necessary in that case.

The dual and confusing concepts of equivalents — as in the doctrine of equivalents and in interpretation of means-plus-function claims — can cause even the experienced court trouble, so deal with it carefully. We have a problem in claim construction in one case because the court erred. Because our client said it wasn't pursuing infringement under the doctrine of equivalents, the court incorrectly assumed that a means-plus-function limitation could not be literally found in a structure performing the identical function, and equivalent to structures described in the specification. It failed to understand that infringement of a means-plus-function claim by something equivalent to what is described in the specification is literal infringement, not infringement under the doctrine of equivalents. You have to describe this carefully if the issue exists in your case.

Start with the claims themselves. Use the claim in question, and other claims, both dependent and independent. Consider how much background on the legal principles your court may need. Don't hesitate to praise the invention, or to point out what the accused infringer is really after. The goal of claim construction is simplicity: to provide a finder of fact — a jury of real people — reasonable and sensible instructions for deciding whether a claim is infringed. Clarity is paramount. Live by Strunk and White's *Elements of Style*: short, short, short. Don't provide or accept circular definitions that repeat the terms being defined. Don't use definitions that add words but no meaning, making a jury's analysis more complicated and prolonged. Above all, don't accept new limitations to claims, which would confuse a jury and wrongly increase the burden of proving infringement. **IPT**