

A New Way To Win Patent Claim Construction

Law360, New York (August 9, 2011) -- Negative claim construction is an often overlooked arrow in the patent attorney's quiver. Defining the uniqueness of an invention has always been a central element in patent law. As a profession, we have become fixated on finding positive definitions of claim terms. By crafting the definition itself in negative terms, you are able to marshal more arguments and streamline the infringement analysis.

One major advantage to negative claim construction is that you have far greater flexibility to constrain a patent. A classic example of negative claim construction is prosecution history estoppel. Prosecution history estoppel, however, requires the disavowal of claim scope "to be both clear and unmistakable." *Omega Engineering Inc v. Raytek Corp.*, 334 F. 3d 1314, 1325-1326 (Fed. Cir. 2003). Similarly, in the classic case *Gentry Gallery Inc. v. Berkline Corp.*, the Federal Circuit held that the specification could limit the scope of claims where it has "unambiguously limited" the claim element. *Gentry Gallery Inc. v. Berkline Corp.*, 134 F. 3d 1473, 1480 (Fed. Cir. 2003).

So how do we make use of all of the statements in the disclosure and prosecution history where there is a strong suggestion, or even a hint, that a claim term should exclude something? By proposing the exclusion as the definition, e.g., during the Markman hearing.

If the proposal is made during the Markman hearing, on some level it only needs to be more persuasive than your opponent's definition. With an opinion letter, the standard is that of a reasonable court, which is lower than "unmistakable" or "unambiguous." By proposing the negative claim construction as the definition of the claim term, at the beginning, you are free to draw on all manner of inference, characterization and interpretative guides such as "the express mention of one thing excludes all others."

If you have to defend a park bench from infringing a patent claim to a chair, all you need is to define "chair" as something for no more than one person. There is no need to understand anything more about chairs.

To successfully defend against concerns of infringement, either in litigation or an opinion letter, you only need to find a single element (including equivalents) that your client's offering does not meet. We routinely look for definitional statements in patents and their prosecution histories. But finding positive definitions is hard because patent prosecutors are raised to never refer to "the invention" and speak only in nonlimiting examples.

We can expand our clients' opportunities for success by also looking for negative statements, such as declaratory statements ("The invention/component is distinct in that ..."), a stray "only" or an item described separately from the claim term. Such a statement may also block doctrine of equivalents arguments by the patent holder.

Patent prosecution is about differentiating the claimed invention from the prior art. These differentiating statements and examples can be used for negative claim construction in many cases, sometimes even when the statements may not be applicable to traditional positive constructions.

If a patent discloses a chair, it follows that it would reference things like houses, furniture, perhaps even other examples of furniture. If you point out that the patent provides examples of chairs, and references tables without identifying them as chairs, there's a solid argument that a table cannot be a chair.

Even if you are not defending a table, you can propose a definition of chair that negatively differentiates between a chair and a table. If the patent doesn't disclose a specific example of a table being encompassed by the term "chair," the patentee may be cornered without a counterexample. Negative claim construction is valuable here because while these distinctions may be sufficient to win a Markman hearing, they may not rise to standard of Gentry Gallery.

Here the differentiating statements in the patent's prosecution history can be used to support your interpretation of what the claimed "chair" isn't, as taken in the context of the patent, and the patentee is left to find a positive statement among their nonlimiting examples. By leveraging just one distinction to justify a negative construction, you can turn the tables on the patentee and their nonlimiting statements.

Judges should encourage parties to submit negative claim constructions because negative constructions require less context from the accused offering to understand, and negative claim constructions can lead smoothly to summary judgments. A negative claim construction is likely to provide the parties with clearer guidance on the likely outcome of the case. Where both parties submit positive claim constructions, there may not be a clear clash. Rebutting with negative constructions can give you the upper hand by letting you define the disagreements at the heart of the dispute.

Patent prosecutors should be aware of defensive techniques to prevent negative claim constructions. *Phillips v. AWH* turned on whether "baffles" excluded members extending from a wall at a right angle, a clever use of a negative claim construction. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005).

In *Phillips*, the Federal Circuit found that advantages of the invention, even when written in a nonlimiting fashion, can be used to prevent exclusionary interpretations. "Baffles" did not exclude structures extending at right angles, because such structures are useful for load-bearing, among other objectives. *Phillips*, 415 F.3d at 1324, 27. Adding qualifying language to exclusionary statements can be just as helpful as adding it to positive statements.

Another technique is to avoid direct comparisons in your patent prosecution. For example, instead of stating that an element cited from the prior art is not an instance of a claim element, you could recite the claim element, and then in a separate sentence explain that one advantage of certain embodiments of your claim is (blank), and why the cited art can not achieve this. You've differentiated the cited art, but without the direct admission. The implicit nature of the admission makes it harder for litigators to use it against you.

The next time you need to show that a patent doesn't cover something, the easiest thing to do may be to define it that way.

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