



Patent Resources Group

Patent Claim Interpretation Course Syllabus

I. INTRODUCTION

- A. What Is Patent Claim Interpretation/Construction?

II. LEADING MODERN CASES

- A. *Markman*
- B. *Vitronics* – 20 Rules
- C. *Phillips*

III. GENERAL RULES

- A. Intrinsic Evidence Is Preferred to Extrinsic Evidence
 - 1. What Constitutes It
- B. Reference Date for Claim Construction
- C. Context
 - 1. Context of the Accused Product
 - 2. Context of Language in the Claim
 - 3. Context of Other Claims
 - 4. Context of the Specification
- D. Focus on Claim Language
 - 1. A Meaning for Each Word
 - 2. Different Meanings for Different Words
 - 3. Same Meaning for Same Words (Rule of Internal Consistency)
- E. Role of the Ordinarily Skilled Artisan

IV. CLAIM LANGUAGE AND OTHER INTRINSIC EVIDENCE

- A. Construing Preambles
- B. Construing Transition Phrases
- C. Common Articles and Modifiers
 - 1. Some Surprising Constructions
- D. Optional Terms
- E. Alternate Terms
- F. Types of Claims
 - 1. Method Claims
 - 2. Product Claims and Method Limitations
 - 3. Product-by-Process Claims
 - 4. Claims Mixing Classes of Subject Matter
 - 5. Whether a Claim Is Independent or Dependent
- G. Claim Differentiation
 - 1. Discussion in *Phillips*



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- 2. Subsequent Cases
- H. The Written Description
 - 1. Historical Background
 - 2. General Applications
 - 3. Broad or Narrow Construction
 - 4. Specification Disclaimers-Disavowals
 - 5. Affirmations (What the Invention Comprises)
 - 6. Ambiguity
 - 7. Specification Describes the Whole Invention
 - 8. Validity Construction
 - 9. Advantages or Purposes of the Invention
 - 10. Preferred/Disclosed Embodiment(s)
- I. The Prosecution History
 - 1. Discussion in *Phillips*
 - 2. File History Disclaimers-Disavowals
 - 3. Examples of Broad/Narrow Construction Caselaw
 - 4. Related Prosecutions
- V. EXTRINSIC EVIDENCE**
 - A. Extrinsic Evidence Defined
 - B. Effect of *Phillips*
 - C. Current Law re Dictionaries
 - 1. Dictionaries and 112-6 Claims
 - D. Other Reference Works
 - E. Inventor Testimony
 - F. Technical Experts in Claim Construction
- VI. SECTION 112-6**
 - A. The Statute
 - B. Whether 112-6 Applies
 - 1. Presumptions
 - 2. Presumptions Rebutted
 - C. Methodology When 112-6 Applies
 - D. The Required Sequence of Claim Interpretation
 - 1. Determining the Claimed Function
 - 2. Determining the Corresponding Structure
- VII. INDEFINITENESS**
 - A. Statute



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B. Standards for Indefiniteness

C. Recent Caselaw

VIII. SELECTED PROCEDURAL ASPECTS OF CLAIM INTERPRETATION

A. Broad Discretion in District Court

1. Timing of Claim Construction
2. Rolling Claim Construction
3. Hearings Not Required
4. Form of Rulings Not Prescribed

B. District Court Issues

1. Jury Issues
2. Estoppel at the District Court

C. Appeals

1. Standard of Review
2. Scope of Review
3. Waiver
 - a. Futile Objection Rule
4. Estoppel on Appeal

IX. THE CLAIM CONSTRUCTION GAME™ (REVIEW)