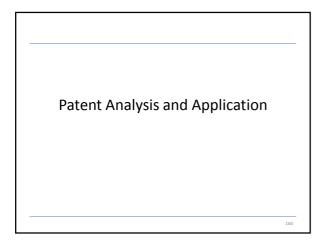
161



Two Key Questions

- Is a patent (claim) valid?
- Does technology X infringe a particular claim?

 Substantial overlap between these questions: the test for validity and infringement both start with <u>claim</u> <u>construction</u>

- Infringement: interpret the claims, apply the claims to the target
- Validity: interpret the claims, apply the claims to the prior art

The Tension

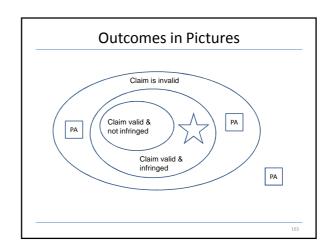
 Patent holders always urge a broad interpretation of their claims in order to ensnare more infringers
The Didu table actest holders are broad to enable

- The Risk: If the patent holder goes too broad, they also risk ensnaring prior art, invalidating the claim
- Would-be infringers generally urge a narrow interpretation of claims in order to escape infringement

 The Risk: If the claims are narrowly construed, they are more likely to be valid

162

164



Claim Construction

- "Claim construction" = the process of interpreting or assigning meaning to the claims
- Claim terms are given their ordinary and customary meaning from one skilled in the art at the time of invention
 - A persons skilled in the art is deemed to read a term in the context of the rest of the claim and the entire patent

Intrinsic Evidence

- Intrinsic evidence forms the primary basis for claim construction, includes everything else that is part of the patent:
 - Rest of claim
 - Other claims: e.g., claim differentiation
- Patent specification: a patentee may be his own lexicographer
 - Prosecution history

165

167

Claim Differentiation

- 1. An apparatus comprising: ... a memory ...
- 2. The apparatus of claim 1 wherein the memory is a fixed disk drive.
- Claim 1 is by definition broader than claim 2, thus "memory" includes fixed disks <u>and</u> other storage devices.

166

168

170

Claim Differentiation 1. A method of packing a lunch, comprising: selecting a fruit; making a sandwich; and packing the fruit and sandwich in a container.

2. The method of claim 1 wherein selecting the fruit includes picking a fruit from a tree.

Prosecution History

- Statements made during prosecution can and will be used during claim construction
- Estoppel: The patentee cannot urge one interpretation (usually a narrow one) to obtain a patent, and then urge another interpretation (usually a broad one) during enforcement
- Example: "the term 'mobile device' does not include laptop computer"
 - Patentee cannot later claim that "mobile device" includes laptops...

Extrinsic Evidence

- Less significant than intrinsic evidence
 - Dictionaries
 - Treatises
 - Expert testimony

Infringement Analysis

- Interpret claims
- Read claims in light of technology
- If a parent claim is not infringed, then by definition its dependent claims cannot be infringed
 - If the independent claim is not infringed, then none of its children are
- Infringement must be shown by a preponderance of the evidence

Different Types of Infringement

Literal infringement

 Accused device literally performs/includes each and every aspect of the claim

- Non-literal infringement (Doctrine of Equivalents) may still infringe if there are "insubstantial differences"
 - Differences are insubstantial if the accused device performs substantially the same function, in substantially the same way, to achieve substantially the same result

171

Direct/Indirect

- Direct infringement
 - E.g., Accused performs each step of the a method
- Indirect infringement
 - Contributory infringement: selling an article that does not by itself infringe, but (1) infringes in combination with other parts, (2) accused knows article to be especially adapted for infringement, and (3) is not a staple article of commerce having substantial non-infringing uses
 - Induced infringement: knowingly causing direct infringement by another
- "Joint infringement"
 - Cannot occur without control by one party

Basis for invalidity

- Bases for invalidity, in decreasing order of value...
 - Anticipation with "killer" 102(b) prior art a single reference teaches all of the claim limitations
 - Anticipation with other prior art
 - Obviousness using 102(b) prior art multiple combined references teach all of the claim limitations
 - Obviousness with other prior art
 - Subject matter the claims are not directed to patentable subject matter
 - Indefiniteness we cannot ascertain the boundaries of the claim

Prior Art Invalidity Analysis

- Interpret claims
- Read claims in light of one or more prior art references
- If a parent claim is not valid, its dependent claim may still be valid (because they are narrower)
- Invalidity must be shown by clear and convincing evidence

Invalidity: A process

- Process:
 - Interpret claims (read patent, file history, etc.)
 - Determine effective filing date of claimed subject matter: wade through priority chain
 - Determine the "critical date" = one year before effective filing date
 - Search for prior art
 - Read claims on the prior art

Invalidity: Claim charts Claim Aspect Citation 1. A computer-implemented method for Ref X, p. 1 sorting data, comprising: receiving an indication of an array of Ref X, p. 2 values; partitioning the array; Ref X, p. 2 recursively sorting the array Ref X, p. 2 2. The method of claim 1, further comprising: iteratively sorting the array Ref Y. p. 7 when it is shorter than a specified size 176

