



**Monday, October 19**  
**2:30 pm–4:00 pm**

## **1003 Anatomy of a Patent**

**John W. Hogan Jr.**  
*Patent Counsel, International*  
Wyeth

**Wab Kadaba**  
*Partner*  
Kilpatrick Stockton

**Alex Sousa**  
*Counsel*  
Innovalight, Inc.

## Faculty Biographies

### **John W. Hogan Jr.**

Patent Counsel, International  
Wyeth

John W. Hogan Jr. is patent counsel for Wyeth in Madison, New Jersey. His responsibilities include varied aspects of US and international patent practice concentrating on prosecution, opinion, licensing and counseling in the pharmaceutical area.

He was senior patent attorney for American Cyanamid Company prior to its merger with American Home Products Corporation, working with the agricultural group.

He is a past chair of the Intellectual Property Committee for ACC and is a member of ACC, American Intellectual Property Law Association (AIPLA) and New Jersey Intellectual Property Law Association (NJIPLA). He was also a member of the board of directors for the National Inventors Hall of Fame Foundation.

### **Wab Kadaba**

Partner  
Kilpatrick Stockton

### **Alex Sousa**

Counsel  
Innovalight, Inc.

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## Agenda

- Parts of a Patent
  - John Hogan
- Parts of an Office Action
  - Alex Sousa
- Claim Interpretation
  - Wab Kadaba

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## Case Study

- Congratulations! You have been made General Counsel for Cue-Tips, Inc., a manufacturer of consumer products for ear health.
- Cue-Tips, Inc. has developed a revolutionary cotton swab product that is about to be launched.
- Today a very agitated CEO comes to you saying she just got a letter informing her of the existence of US Patent 6,080,126, which she hands to you.
- You confidently tell her, "No problem. I'll handle it."
- After she leaves, you swallow hard and take a drink from the bottle of wine you've been meaning to take home since last year's Holiday Party.
- Now what?

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## Parts of a Patent

### John W. Hogan

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### What is a Patent?

- Patent – Generally
  - A patent gives its owner the right to exclude others from making, using, importing, selling, or offering to sell the invention covered by the patent.
  - A patent does not give the owner the right to practice the invention; it basically gives the owner the right to sue others for patent infringement.
    - Case Study - Even though your product is patented, you may still infringe US 6,080,126

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### Parts of a Patent

- Front Page
- Description of the Invention
- Claims

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### Parts of a Patent – Front Page

The image shows the front page of a patent document. At the top, it says 'United States Patent' followed by a barcode and the patent number '6,080,126'. Below this, there is a table with columns for 'CLASSIFICATION', 'INVENTOR', 'ATTORNEY', 'TITLE', 'ABSTRACT', and 'REFERENCES CITED'. The title is 'METHOD FOR DETERMINING THE STABILITY OF A PROTEIN'. Below the text, there are two diagrams: one showing a protein structure with various parts labeled (1-10) and another showing a similar structure with different labels (11-15).

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### Parts of a Patent – Front Page

- Many important items can be found on the front page
  - Patent Number
  - Abstract
  - Inventors
  - Assignee
  - Important Dates
  - References Cited

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### Parts of a Patent – Front Page

- One important thing to recognize is whether it is, in fact, a patent or is it a published patent application
  - U.S.
  - PCT
  - European

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### Parts of a Patent – Front Page

- Patent Number:
  - A unique number assigned to each patent
  - In the United States, the Patent Number is a 7-digit number, e.g. 6,080,126.
  - In other countries, other formats are used.

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### Abstract

A swab is described formed of a paper stick having opposite ends of less paper density than the rest of the stick. An absorbent covering such as cotton is placed around the ends. The stick is obtained by rolling a paper having left and right edges harmonically cut with at least two amplitude maxima and at least one amplitude minima. Softer stick ends are achieved through this structural arrangement. A cut paper used for forming the swab stick and a manufacturing process are also described.

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### Abstract

- "Summary" of the invention
  - Can be a convenient way to get the gist of the invention
- Don't get fooled
  - Abstract has little or no legal significance
  - The claims define the invention. Often there may be differences between the abstract and the claimed invention.

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### Inventor(s) – one or more people



United States Patent [19] [11] Patent Number: 6,080,126  
Zygmunt et al. [49] Date of Patent: Jun. 27, 2000

[54] COTTON SWABS WITH SOFT TIPS 4,718,889 4/1980 Heine, Jr. et al.  
4,828,226 4/1980 Bevan ..... 0043

[57] Inventors: Joseph Frank Zygmunt, Kilmegonah, 5,177,848 12/1993 Schreier, Jr.  
William Howard Schmitt, Braintree, 5,183,032 10/1993 Peng et al.  
5,183,275 12/1996 Bevan  
5,293,001 12/1996 Bevan

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### Inventor(s)

- **INVENTOR(s):** may be one or more people; first named inventor is listed at the top of the patent.
  - Joseph Frank Zygmont and William Howard Schmitt
  - If the patent has more than one inventor, then inventors are written as "Zygmont et al." at the top of the patent.
  - Order of inventors is not legally significant, but you may get complaints from inventors not listed first.

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### Assignee

- **Assignee**
  - The owner of the patent (at least at the date of grant)
  - Under U.S. law, the INVENTOR(s) own the rights to his/her invention, but typically assigns all rights in the patent to his or her corporate employer, thus making the employer the ASSIGNEE.
    - Practice Tip: Make sure your company has agreements for inventors to assign inventions
  - Example: patent has Assignee as "Chesebrough-Ponds USA Co., division of Conopco, Inc."
  - Assignee can be an individual / investor / corporation / et al.

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### Important Dates of Patent

- **"Date of Patent"**
  - This means the issue date or grant date, i.e., the date the patent was granted. This is the first day a patentee can file suit for patent infringement.
- **Filing Date**
  - Filing Date is, as it says, the date the patent application was filed.
  - Effective filing date is a bit more complicated, but basically refers to the earliest filing date of any related US non-provisional applications.

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### Important Date NOT on Patent

- Expiration Date
  - Typically 20 years from Effective Filing Date
    - Case Study - Expiration date is August 14, 2018
  - Exceptions
    - U.S. Patent applications filed prior to June 8, 1995
    - Terminal Disclaimers
    - Patent Term Adjustment
    - Maintenance Fees

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### References Cited:

The "prior art" which the APPLICANT had to overcome to get the patent

United States Patent 6,680,126  
Zygan et al. Date of Patent: Jun. 27, 2009

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### Parts of a Patent

- Front Page
- Description of the Invention
- Claims

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**Drawing:**  
not required, but often present;  
must numerically label the parts

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**Description of Drawing**

- FIG. 1 is a plan perspective view of the swab according to the present invention;
- FIG. 2 is a top plan view of a first embodiment of a die-cut paper forming a stem for the swab described in FIG. 1;
- FIG. 3 is a highly schematic view of the process for preparing swab sticks of the present invention;
- FIG. 4 is a top plan view of a second embodiment of a die-cut paper forming a stem for the swab described in FIG. 1; and
- FIG. 5 is a side elevational view of the rolled stem formed from the die-cut paper of FIG. 4.

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**Specification**  
**Background of the Invention**

BACKGROUND OF THE INVENTION

1. Field of the Invention  
The invention relates to cotton swabs useful in cleaning the ear or applying cosmetics.

2. The Related Art  
Swabs having an absorbent covering on the tip and an elongated stem are well known. Cotton is generally used as the absorbent tip covering material. Stem materials are often of wood, rolled paper or plastic. Conventional swabs are typically constructed by applying the absorbent covering directly to the ends of the stem. An adhesive may be used to more firmly hold the absorbent covering in place upon the swab.

Cost and performance problems have long been associated with traditional swabs. U.S. Pat. No. 5,127,899 (Schmense, Jr.) raises the issue of eardrum damage when swabs are improperly applied to clean the outer ear. The patent suggests that injuries may be avoided by positioning a flat disc at each of the distal ends of the swab beneath the cotton coverings. This disc is sized to prevent entry of the swab into the human ear canal. Although a useful improvement, the flat disc increases the rigidity of the cotton covered tips rendering them harder. There are also manufacturing difficulties with providing a flat disc to the ends of the swab stem. . . [continued]

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### Parts of a Patent

- Front Page
- Description of the Invention
- Claims

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### Claims – define the invention

What is claimed is:

1. A swab comprising:  
 an elongate stem with first and second ends opposite one another,  
 the stem being formed from a rolled paper with left and right edges harmonically cut with each edge having at least two amplitude maxima and at least one amplitude minima,  
 the left and right edges when rolled forming the respective first and second ends; and  
 an absorbent covering surrounding each of the first and second ends.

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### How to Quickly Read a Patent

Infringement Context

1. Read Front Page
  - Look at Assignee/Inventors
    - Do we have a license? Can we get a license?
      - Later confirm assignee.
  - Determine Expiration Date
    - Is the patent still in force?
      - Later check whether maintenance fees are paid.
  - Read Abstract
    - Get a sense of the invention
2. Read Claim 1
  - Typically, this is the broadest claim
  - If this doesn't cover your product, read all independent claims.

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## How to Quickly Read a Patent

Patentability Context

- 1. Read Front Page**
  - Look at Filing Date and Grant Date (or publication date)
    - Is this prior art?
  - Read Abstract
    - Get a sense of this invention; is it analogous art?
- 2. Read entire specification, including drawings, if any, and claims**
  - Start with any particular part Examiner has cited (or searchers/inventors have mentioned)
  - Not really a "quick" process.

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## Parts of an Office Action

### Alex Sousa

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## Why Is This Important?

- The aggregate of all the correspondence (including office actions and amendments) between the applicant and the USPTO during the prosecution of an invention is called the file wrapper.
- During prosecution, claim scope is usually narrowed by the prosecutor in order to overcome prior art.
- During litigation, a court may review the file wrapper in order to interpret (and potentially limit) the scope of the claims.

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### The Patent Process In a Nutshell

One Patent Application Fee = One Invention = One Non-Final OA = One Final OA

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### The Patent Process In a (Bigger) Nutshell

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### Genus: Patent Examiner

- Examiners are **NOT** attorneys
- Examiners are civil servants with technical degrees that review patent applications.
- Patent examination is 100% rule based:
  - 35 U.S.C (United States Code)
  - 37 C.F.R.(Code of Federal Regulations)
  - M.P.E.P. (Manual of Patent Examining Procedure)

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### Office Action (OA)

- A document written by a patent examiner to the inventor/prosecutor in response to a patent application
- Common types of office actions:
  - Restriction/Election Requirement
    - Two or more independent and distinct inventions may not be claimed in one national application (37 CFR 1.141)
    - For example, claiming both a cotton swab (apparatus) and a method of making a cotton swab.
  - Non-Final / Final
    - Enablement (35 U.S.C. §112),
    - Novelty (35 U.S.C. §102)
    - Non-obviousness (35 U.S.C. §103)

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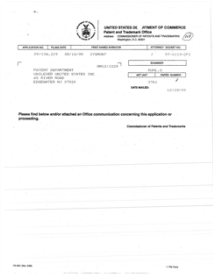
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### Cover Page



- Application No.
- Filing Date
- First Named Inventor
- Attorney Docket No.
- Confirmation No.
- Address of Record
- Examiner
- Art Unit
- Paper Number
- Date Mailed

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### Cover Page (con't)

Application No. Assigned upon filing  
 • 60/XXX,XXX = Provisional  
 • 1X/XXX,XXX = Utility

Filing Date Date the application was:  
 • electronically filed  
 • received at the USPTO  
 • date stamped by USPS for First Class Mail

First Named Inventor First inventor listed on the patent application (Irrelevant to USPTO but can be sensitive to inventors)

Attorney Docket No. Arbitrary number

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### Cover Page (con't)

Confirmation No.	Used to avoid misidentification of an application due to a transposition error in the application number
Address	Applicant Correspondence Address
Examiner	Primary Examiner
Art Unit	Department of USPTO responsible for technology area
Paper Number	Not Used
Date Mailed	Date office action was mailed Starts clock for fees and abandonment

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### Office Action Summary



- Status
- Disposition of Claims
- Application Papers
- Priority under 35 U.S.C. §119

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### Status

- Identifies applicant communication to which OA is responsive
- Identifies OA as:
  - Non-final; or
  - Final
- Identifies if application is in condition for allowance

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### Disposition of Claims

- Pending
- Allowed
- Rejected
  - Enablement (35 U.S.C. §112),
  - Novelty (35 U.S.C. §102)
  - Non-obviousness (35 U.S.C. §103)
- Objected To
  - Typos
  - Format Problems
  - Etc.

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### Papers / Priority

- Application Papers
  - Specification Problems
  - Drawings Problems
  - Oath or Declaration Problems
- Priority under 35 U.S.C. §119
  - a non-provisional application can benefit from the filing date of an earlier-filed provisional application.

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### Detailed Action

Application/Control Number: 09130429 Page 3  
April 29, 2010

1. Claim 4 (12A)(1) is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 4 (12A)(1), the examiner does not understand what the recited and recited edges are. What are they? What is meant by "respective opposite corners" and/or "respective opposite edges"? This claim does not appear to be a multiple-type claim for the purpose of being rejected under 35 U.S.C. 112(b). The scope of claim 4 and 5 are not clear and no prior art will be applied. In re Deuel, 367 F.2d 896, 898, 134 USPQ 292, 294 (CCPA, 1962).

With respect to claim 11, is the recitation of "the leading edge" referring to the edges of the paper to be ruled or are there other edges? This is not clear.

With respect to claim 21, does it recite a basis for "the leading edge". What does this refer to? The leading edge has been claimed. What is the recitation of "other end" refer to? This could have been claimed. The scope of the claim is not clear and no prior art will be applied. In re Deuel, 367 F.2d 896, 898, 134 USPQ 292, 294 (CCPA, 1962).

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 103 that form the basis for the rejections under this section made by this Office action:

It can be seen by reference to the prior art that the invention claimed in this application is not novel over the prior art as claimed in the claims herein.

#### Claim Rejections

- 35 U.S.C. §112
- 35 U.S.C. §102
- 35 U.S.C. §103

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### Claim Rejection Cheat Sheet

- §112 2<sup>nd</sup> Paragraph** • Indefinite claim language
- §102 (a, b, e, and/or g)** • Invention (claim) found in a single patent or printed publication; or  
• Invention publically known or used
- §103** • Invention (claim) would have been obvious to a person of ordinary skill in the art

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### Claim Rejections – 35 U.S.C. §112, 2<sup>nd</sup> Paragraph

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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### §112 Rejection (Zygmont)

1. Claims 4-11,14,15,21 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 4-9,11,14,15, the examiner does not understand what the leading and trailing edges are. What are they? What is meant by "respective amplitude minima" and/or "respective amplitude maxima"? This is not clear.....

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**Claim Rejections – 35 U.S.C. §102**

A person shall be entitled to a patent unless—

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

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**Claim Rejections – 35 U.S.C. §102 (con't)**

A person shall be entitled to a patent unless—

- (e) the invention was described in
  - (1) an application for patent...by another filed in the United States before the invention by the applicant for patent or
  - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, ...

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**Claim Rejections – 35 U.S.C. §102 (con't)**

A person shall be entitled to a patent unless—

- (g) (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it.

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### §102 Rejection (Zygmont)

3. Claims 1,2,10,12,16,19,20,22, are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett (5531671).  
 Bennett discloses a swab and the method of making the swab. The swab has a stem 2 with ends 4,6, and absorbent (cotton) 12. The stem is made from rolled paper as shown in figure 4. Figure 4 shows on amplitude minima at the uppermost part of the figure, an amplitude maxima at 18a and also at the lowermost part of the figure where the paper begins to curve outward.

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### Claim Rejections - 35 U.S.C. §103

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title [35 USC §102], if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

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### §103 Rejection (Zygmont)

5. Claims 3,13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (5531671). Bennett discloses the invention substantially as claimed. Bennett does not disclose 3 to 5 amplitude maxima for the paper. It would have been obvious to one of ordinary skill in the art at the time the invention was made to simply roll a longer length of paper than that of figure 4 (with 3 to 5 amplitude maxima) to form a more rigid or stronger stem. Providing more material strengthens the stem. These claims are claiming a longer piece of paper than that of Bennett and this is considered to involve only routine skill in the art and is considered obvious.

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# Claim Interpretation

KILPATRICK STOCKTON LLP  
Wab Kadaba

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## The Anatomy of a Patent

- What are claims?
- How do you read claims?
- How do you construe claims?

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## What Are Claims?



- Claims are the numbered paragraphs at the end of a patent.

What is claimed is:  
 1. A swab comprising:  
 an elongate stem with first and second ends opposite one another, the stem being formed from a rolled paper with left and right edges harmonically cut with each edge having at least two amplitude maxima and at least one amplitude minima, the left and right edges when rolled forming the respective first and second ends; and  
 an absorbent covering surrounding each of the first and second ends.  
 2. A swab according to claim 1 wherein the absorbent covering is cotton.  
 3. The swab according to claim 1 wherein there are from 3 to 5 amplitude maxima on each of the left and right edges of the paper.

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### What Are Claims?

- Claims establish the “metes and bounds” of a patent. They define the scope of the invention. <sup>1</sup>
  - Systems or methods that are within the claims infringe.
  - Systems or methods that are outside the claims do not infringe.

<sup>1</sup> Phillips v. AWH Corp., 415 F.3d 1303, 1312 (Fed. Cir. 2005).

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### What Are Claims?

- Independent v. Dependent Claims

- Claim 1 is an “independent claim.” It stands alone.
- Claims 2 and 3 are “dependent claims.” because they depend from Claim 1.

What is claimed is:  
 1. A swab comprising: an elongate stem with first and second ends opposite one another, the stem being formed from a rolled paper with left and right edges harmonically cut with each edge having at least two amplitude maxima and at least one amplitude minima, the left and right edges when rolled forming the respective first and second ends; and an absorbent covering surrounding each of the first and second ends.  
 2. A swab according to claim 1 wherein the absorbent covering is cotton.  
 3. The swab according to claim 1 wherein there are from 3 to 5 amplitude maxima on each of the left and right edges of the paper.

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### How Do You Read Claims?

- Preamble: The preamble is meant to generally introduce the claim. In general, the preamble does not define the scope of the claims.
  - “A swab comprising.”
- Elements: The elements are the building blocks that define the scope of the claims.<sup>x</sup>
  - “an elongate stem”
  - “an absorbent covering.”

What is claimed is:  
 1. A swab comprising: an elongate stem with first and second ends opposite one another, the stem being formed from a rolled paper with left and right edges harmonically cut with each edge having at least two amplitude maxima and at least one amplitude minima, the left and right edges when rolled forming the respective first and second ends; and an absorbent covering surrounding each of the first and second ends.

<sup>x</sup> Phillips, 415 F.3d at 1312.

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### The Canons Of Claim Construction

- The claims are construed by the Court, not the jury.
  - The Court construes the claims in a "Markman hearing."
  - Both parties submit proposed constructions, and the Court issues an order construing the claims.
- "The canons of claim construction" are:
  1. Language of the claims
  2. Specification is king
  3. Prosecution history
  4. Extrinsic evidence



Judge Ward  
Eastern District of Texas



Judge Crabb  
Western District of Wisconsin

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### The Canons Of Claim Construction

1. Language of the claims
  - A claim should be construed according to the "plain import of its terms." x
  - "Words of a claim are given their ordinary and customary meaning," which is "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." x

\* Phillips, 415 F.3d at 1312.  
\* *Id.* at 1312-13.

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### The Canons Of Claim Construction

1. Language of the claims
 

What is claimed is:

  1. A swab comprising:  
an elongate stem with first and second ends opposite one another, the stem being formed from a rolled paper with left and right edges harmonically cut with each edge having at least two amplitude maxima and at least one amplitude minima, the left and right edges when rolled forming the respective first and second ends; and an absorbent covering surrounding each of the first and second ends.
  - Term: "comprising"
    - open ended
    - not limited to only the described elements
  - "Consisting of"
    - closed term
    - limited to only described elements

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### The Canons Of Claim Construction

1. Language of the claims

What is claimed is:  
 1. A swab comprising:  
 an elongate stem with first and second ends opposite one another, the stem being formed from a rolled paper with left and right edges harmonically cut with each edge having at least two amplitude maxima and at least one amplitude minima, the left and right edges when rolled forming the respective first and second ends; and  
 an absorbent covering surrounding each of the first and second ends.

- Term: "elongate stem"
  - first and second ends
  - formed from rolled paper
    - harmonically cut
    - two amplitude maxima
    - one amplitude minima

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### The Canons Of Claim Construction

1. Language of the claims

rolled paper

amplitude maxima  
amplitude minima

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### The Canons Of Claim Construction

- Specification
  - The specification is usually dispositive – "it is the single best guide to the meaning of a disputed term."<sup>x</sup>
  - "Claims must be construed so as to be consistent with the specification."<sup>x</sup>
  - If the specification specifically defines a term, then that definition controls.<sup>x</sup>
  - On the other hand, if the specification disclaims subject matter, then the subject matter is excluded.<sup>x</sup>

<sup>x</sup> Phillips, 415 F.3d at 1315.  
<sup>y</sup> Id. at 1316.  
<sup>z</sup> Id.  
<sup>w</sup> Id.

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### The Canons Of Claim Construction

2. Specification



- "Harmonic for purposes of this invention is defined as alternating protrusions and valleys along edges."<sup>x</sup>
  - This is a specific definition.
- "A serrated or square-toothed pattern with up to 90 degree angles . . . is less preferred than rounded or greater than 90 degree angled patterns."<sup>x</sup>
  - This is disclaimer of subject matter.

\* Col. 2, ll. 4-6; Col. 2, ll. 8-11

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### The Canons Of Claim Construction

- Specification
  - The specification describes various embodiments of terms.
  - Example: If the term is "Russian Doll," then different embodiments might have different sizes, colors, or shapes.

preferred embodiment

alternate embodiments



- It is improper to merely adopt the preferred embodiment as the final construction.<sup>x</sup>
- Instead, the construction must account for all the embodiments.

\* Comark Commcns, Inc. v. Harris Corp., 156 F.3d 1182, 1186-87 (Fed. Cir. 1998).

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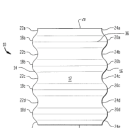
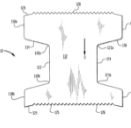
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### The Canons Of Claim Construction

2. Specification



- "In a first embodiment, the harmonic cut is a sinusoidal curved pattern."<sup>x</sup>
- "In a second embodiment, the harmonic cut is a toothed pattern with flat amplitude."<sup>x</sup>
  - The proper construction must encompass both embodiments, not just the preferred sinusoidal embodiment.

\* Col. 2, ll. 13-15; Col. 2, ll. 22-23

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- Prosecution History
  - Definition: The proceedings before the Patent and Trademark Office (PTO) that were created in obtaining the patent. Includes Office Actions, responses, and amendments.
  - Publicly available on the PTO's website.



PTO

Office Actions



Amendments

Responses

Inventor

\* Phillips, 415 F.3d at 1317

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### 3. Prosecution History

- Rejection from an Office Action
  3. Claims 1,2,10,12,16,19,20,22, are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett (5531671).
- Response from the inventor

The cross-hatched paper area has on its left and right edges 18a and 18b only a single amplitude maxima. By contrast, applicants' independent claims 1, 12 and 22 require at least two amplitude maxima. For this reason there can be no anticipation.

The unobvious advantage of multiple amplitude maxima is that more material is left at the very tip of the ends to strengthen them.

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- Prosecution History
  - Prosecution history might result in "prosecution history estoppel."
    - Occurs when the inventor limits claim scope during prosecution to achieve allowance of a claim. X
    - The "claims require **at least two** amplitude maxima...the advantage is that more material is left ...to strengthen" the stem
    - The inventor is "estopped" from arguing that a stem with only one amplitude maxima infringes.
      - only one amplitude maxima

\* Phillips, 415 F.3d at 1317

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- Extrinsic evidence
  - Definition: Any sources that are not a part of the patent or the prosecution history.
    - Examples: Expert and inventor testimony, scientific articles, technical treatises, and dictionaries.

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### The Canons Of Claim Construction

- Extrinsic evidence
  - When the ordinary meaning of a claim is “readily apparent,” a Court may use a general purpose dictionary to construe the claim. <sup>x</sup>
  - Otherwise, extrinsic evidence is less favored than intrinsic evidence because it is less reliable and prone to manipulation by the parties. <sup>x</sup>

<sup>1</sup> Phillips, 415 F.3d at 1314.  
<sup>2</sup> Id. at 1317.

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### The Competing Canons Of Claim Construction

“Claims are to be interpreted in light of the specification,” but...	“limitations from the specification may not be read into the claims.” <sup>x</sup>
A Court should consider the prosecution history in construing claims, but...	the prosecution history “often lacks the clarity of the specification and thus is less useful for claim construction purposes.” <sup>x</sup>
A Court can use extrinsic evidence to help understand the technological field, but...	extrinsic evidence is unreliable and you cannot rely on it extensively. <sup>x</sup>

<sup>1</sup> Comark Comm’ns, 156 F.3d at 1186-87.  
<sup>2</sup> Phillips, 415 F.3d 1317.  
<sup>3</sup> Id. at 1318-19.

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
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- Conclusion
  - Claim construction involves careful balance of the terms, specification, prosecution history, and extrinsic evidence.
  - Questions?

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## ACC Extras

Supplemental resources available on [www.acc.com](http://www.acc.com)

Ethics and Privilege: The Work-Product Doctrine and Patent Practice.

ACC Docket. September 2009

<http://www.acc.com/legalresources/resource.cfm?show=517108>

Best Practices in Patent Litigation.

Program Material. October 2008

<http://www.acc.com/legalresources/resource.cfm?show=161217>

Strategic Implications of Patent Office Reexamination in Patent Litigation.

InfoPak. August 2008

<http://www.acc.com/legalresources/resource.cfm?show=77488>

Please note, these additional resources are provided by the Association of Corporate Counsel and not by the faculty of this session.