

Patent Infringement- the Basics

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I. Interpreting Patent Claims - The Fundamentals

Whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States, or imports into the United States any patented invention during the term of the patent is guilty of patent infringement.¹ Recall that a patent usually contains one or more claims. The claims of the patent define the patentee's invention. Hence, infringement of any one claim is considered infringement of the patent. In order for infringement to exist every element or limitation of the claim must exist in the accused product or process. For example, assume you own a patent ostensibly covering a motorcycle. The first claim reads:

A vehicle comprising:

an engine;

two wheels;

a transmission connected to the engine and linked to at least one wheel; the transmission adapted to convert energy output from the engine so as to impart rotational movement to the at least one wheel.

Would this cover a moped? Let's check. The best way to do this is with a claim chart

Patent Claim Element	Is Claim Element Present in the Accused Device (Moped)?
A vehicle comprising	Yes
an engine	Yes
two wheels	Yes
a transmission connected to the engine and linked to at least one wheel	Yes
The transmission adapted to convert energy output from the engine so as to impart rotational movement to the at least one wheel.	Yes

In the chart above we can see that every claim element is present in the moped and therefore our patent claim, ostensibly designed to capture a motorcycle, is broad enough to capture a moped. This example shows you the importance of thoughtful claim drafting.

¹ 35 U.S.C. § 271(a)

If you have ever seen a few patents, you have probably noticed that most have a large number of claims; usually at least 10, sometimes extending into the hundreds. Obviously, undertaking an infringement analysis of all of those claims would be daunting. However, you need not feel overwhelmed. Remember a dependent claim includes each limitation contained in the claims from which it depends. Therefore, if a product does not infringe an independent claim, it cannot infringe a dependent claim. This means that for purposes of infringement analysis, only the independent claims need be analyzed.

a. Claim Construction is a Two-Step Process.

Courts use a two-step process to determine whether a claim is infringed. The first step is determining what the claims mean. This is the job of a judge. After the claim terms have been construed, the next step is to determine if the claim describes the accused product or process. This is the job of the finder of fact, which can be either a judge or jury.

b. Claims May be Infringed Two Ways.

There are two ways in which claims may be infringed under United States patent law. The first type of infringement is called "literal infringement." The claim chart analysis above for the moped is an example of literal infringement. Literal infringement occurs when each properly construed claim element is found in the accused device. That the accused device may have more features than what is required by a claim does not matter for purposes of determining literal infringement. Hence, the fact that our moped might have a headlight, bell and fancy leather seat would make no difference in deciding whether it infringed the outlined patent claim. The second type of infringement recognized by U.S. patent law is called infringement under the "doctrine of equivalents." The principles regarding doctrine of equivalents infringement are far more complicated than those of literal infringement. With the doctrine of equivalents, the accused device does not literally infringe the claim. Instead, equivalent infringement occurs when the accused device:

- i. avoids literal infringement by virtue of an insubstantial difference; and
- ii. performs substantially the same function, in substantially the same way, to achieve substantially the same result as the claimed invention.

II. Interpreting Patent Claims - The Formal Process

The determination as to whether a specific product infringes a patent generally does not allow for quick and easy answers. To the contrary, a proper analysis is lengthy and detailed,

with the bulk of the work being directed to interpreting claim terms. In some cases, patents may have a large amount of claim terms that need to be construed. Each term will require a multi-step analysis.

For those interested readers, the case of *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*), provides guidance on how to interpret claim terms. The step-by-step approach countenanced by this case is as follows:

a. Start with the Claims.

1. Claim construction begins with the words of the claim itself.
2. The words of a claim should be given their ordinary and customary meaning as understood by a person of ordinary skill in the art in question at the time of the invention.
3. The claims themselves should be read to provide substantial guidance as to the meaning of particular claim terms. This means that all claims should be consulted to understand the ordinary meaning found in one claim.

b. Review the Rest of the Patent.

4. Claims and their terms are not interpreted in isolation, but in context of a fully integrated written instrument.
5. Claim terms must be read in view of the specification, of which they are a part.
6. The specification is deemed the single best guide to the meaning of a disputed term.
7. The specification may indicate a definition to be given to a claim term by the patentee that differs from the word's ordinary meaning.
8. The specification should be reviewed to determine if it includes any intentional disclaimer, or disavowal, of claim scope by the inventor. If so, the inventor has dictated the correct claim scope, and the inventor's invention, as expressed in the specification, is regarded as dispositive.
9. The fact that the specification includes limited and specific embodiments is insufficient to define a term implicitly, and it is improper to confine the scope of the claims to the embodiments of the specification.

10. The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the claim construction.
 11. Be careful not to import limitations from the specification into the claim.
 12. There is a "fine line" between using the specification to interpret the meaning of a claim and importing limitations from the specification into the claim. To avoid erring in this regard the focus should be on understanding how a person of ordinary skill in the art would understand the claim terms.
 13. Determine whether the patentee is setting out specific examples of the invention to accomplish those goals, or whether the patentee instead intends for the claims and the embodiments in the specification to be strictly coextensive. (In other words, determine whether a person of skill in the art would understand the embodiments to define the outer limits of the claim term or merely to be exemplary in nature.)
- c. Consult the Patent's Prosecution History.**
14. The prosecution history may evidence how the PTO and the inventor understood the patent.
- d. Consult Extrinsic Evidence.**
15. Extrinsic evidence such as expert and inventor testimony, dictionaries and learned treatises may aid in the interpretation of terms. These have all been recognized as tools that can assist in determining the meaning of particular terminology. Extrinsic evidence may be helpful in understanding the technology and educating oneself about the invention. Technical dictionaries collect accepted meanings for terms in various scientific and technical fields, and can be useful in claim construction by providing a better understanding of the underlying technology and the way in which one skilled in the art might use the claim terms.
 16. Conclusory, unsupported assertions by experts as to the definition of a claim term are not useful.

17. Extrinsic evidence is less reliable than intrinsic evidence in determining the construction of claim terms, and therefore the court should discount any expert evidence that is at odds with the intrinsic evidence.
18. An inventor's understanding of his invention does not equate to an understanding of the patent claims. An inventor's testimony as to the inventor's subjective intent is irrelevant to the issue of claim construction.

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