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Understanding Patent Infringement Opinions and The Scope of Patent Protection

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Patents, copyright, trademark, trade secret, unfair competition and related areas of the law

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Understanding Patent Infringement Opinions and The Scope of Patent Protection

- I. WHY OPINIONS ARE WRITTEN THE WAY THEY ARE
 - A. Purpose of opinions
 1. To inform the client
 - a. Offensive (client's patent being infringed)
 - b. Defensive (client is accused of potentially infringing another's patent)

2. To protect the client
 - a. From possible sanctions (Rule 11-
“inquiry reasonable under the
circumstances”)
 - i. Opponent’s attorney fees
 - b. From willful infringement decision
 - i. Treble damages
 - ii. Opponent’s attorney fees

B. The audiences

1. The client before court action (plain English)
2. The client if the court action is lost (blame)
3. The court (case law)
4. Opposing counsel (weaknesses, e.g., technical inaccuracies)
5. Banks (basis for loans)

- C. What you should expect from an opinion
1. Reasoned technical and legal analysis
 - a. Infringement issues
 - b. Validity issues
 2. Review of the prosecution history (usually)
 3. Help in assessing the risks of litigation
 - a. Explaining issues
 - b. Chances of winning/losing on each issue

- D. What you should **not** expect from an opinion
1. A conclusory opinion with a cursory analysis
 2. Definite pronouncements
 - a. Read v. Portec: “honest opinion is more likely to speak in probabilities than certainties”
 3. A guarantee
- E. What you should be able to do with an opinion
1. Understand it
 2. Show reasonable reliance upon it

- F. Client's role in obtaining opinion
1. Selecting attorney to write opinion
 - a. Competence/experience
 - b. Willingness/ability to communicate as a witness
 - c. Objectivity
 2. Information control
 - a. Accurate, up-to-date technical information
 - i. Review drafts of opinion (occasionally)

- b. Avoid potentially damaging statements
 - i. Double meanings, sarcasm, embarrassing statements
 - ii. Assume privilege will be waived for all communications

II. THE SCOPE OF PATENT PROTECTION

- A. The infringement analysis
 - 1. Every claim limitation must be satisfied
 - a. Literally – exactly
 - b. Equivalently – only insubstantial differences (one test - function-way-result)

2. Sample claim

A table comprising:

- (a) a relatively flat top surface;
- (b) four legs affixed to said top surface;
- (c) at least one brace member positioned between two of said legs; and
- (d) at least two nails,
- (e) wherein each nail extends through one of said legs and into said brace.

3. Legal limits on patent infringement

a. Exclusionary language

Language in specification, but not in claims, that limits invention - “all embodiments must have...” - “system does not include...”

b. Arguments and other statements can limit the scope of the claims

c. Prior art

d. Described but unclaimed embodiments in the patent

B. Literal infringement issues

1. Claim interpretation

a. Broad/narrow words

- b. Definitions of words
 - i. Specification
 - ii. Dictionary
- 2. The prosecution history in a literal infringement analysis
- 3. Equivalents issues in a literal infringement analysis
- 4. What is means plus function language?

“An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” Sec. 112(6)

- a. Example: means for affixing
- b. What does it mean?
- c. What is/is not an equivalent under the means plus function statute?
- d. How do we perform the analysis?
 - i. Element as a whole
 - ii. Example

Odetics, Inc. v. Storage Technology Corp., 51 USPQ2d 1225 (Fed. Cir. 1999) (By Judge Gajarsa, joined by Judge Clevenger; dissent by Judge Lourie).

Patent: Tape cassette handling system

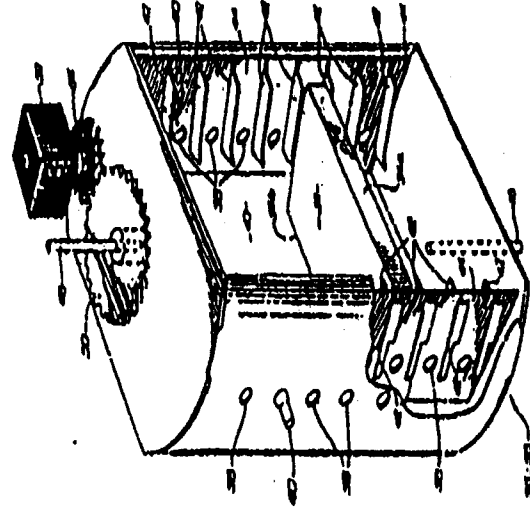


Fig. 3, U.S. Patent No. 4,779,151

Important Claim Language:

a rotary means rotatably mounted within the library adjacent the access opening for providing access to the storage library, the rotary means having

one or more holding bins each having an opening for receiving a cassette, wherein the rotary means is rotatable from a first position in which the opening of at least one holding bin is accessible from outside of the housing to a second position in which the opening of at least one holding bin is accessible from inside of the housing;. . . .

Issue:

Whether the bins, rod and pins/cam follower used by the defendants were equivalent to the bins, rod and gear disclosed in the patent.

Jury:

Infringement.

Trial Court:

No infringement, based on *Chiuminatta*.

Federal Circuit:

Trial court reversed and jury verdict of infringement reinstated. A component-by-component analysis is inappropriate when considering equivalents with respect to a Sec. 112(6) claim element. Thus, structures with different numbers of parts may still be equivalent under Sec. 112(6) thereby meeting the claim limitation. Odetics' theory of equivalents was to point out the parallels between the claimed and accused structures, noting that rotation is accomplished in the '151 patent by exerting force against the teeth of the gear, thereby turning the bin about the rod, and that rotation is accomplished in the accused device by exerting force against the cam followers, also turning the bin about the rod.

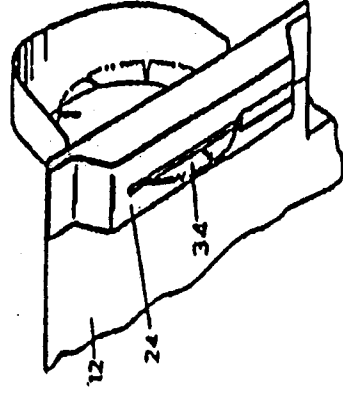
- C. Doctrine of equivalents issues
 - 1. All elements rule
 - 2. Prosecution history estoppel
 - 3. Prior Art
 - 4. Described but unclaimed embodiments

- D. The range of available equivalents
 - 1. Cases where equivalents under the doctrine of equivalents and/or the means plus function statute) were and were not found, where there were no legal limitations on the range of equivalents

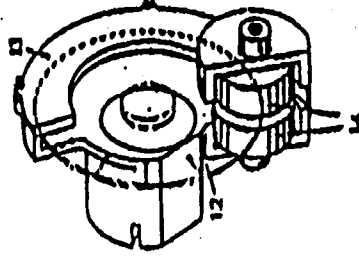
Chiuminatta Concrete Concepts, Inc. v. cardinal Industries, Inc.,
145 F.3d 1303, 46 USPQ2d 1752 (Fed. Cir. 1998) (By Judge
Lourie, joined by judges Michel and Plager).

Patent: Rotary Saw

AN EMBODIMENT OF THE INVENTION



THE ACCUSED DEVICE



Important Claim Language:

Means connected to the saw for supporting the surface of the concrete adjacent the leading edge of the cutting blade to inhibit chipping, palling, or cracking of the concrete surface during cutting;

Issue:

Whether the defendant's two wheels were equivalent to the skid plate disclosed in the patent. The wheels flattened in use.

Trial Court:

Infringement, because both the structure in the patent and the wheels of the accused device consist of flat planes on either side of the saw blade which hold the concrete in place.

Federal Circuit:

Summary judgment of infringement reversed. The assertedly equivalent structures are wheels, and the differences between the wheels and a skid plate are not insubstantial. The wheels support the surface of the concrete by rolling over the concrete while the plate skids. The wheels are soft, compressible and round; the plate is hard and predominantly flat (albeit with rounded edges to prevent gouging of the concrete). Additionally, the wheels rotate as opposed to skid as the saw moves across the concrete and thus have a different impact on the concrete. Since the wheels and the skid plate are substantially different from each other, they cannot be equivalent, and no reasonable jury could so find.