

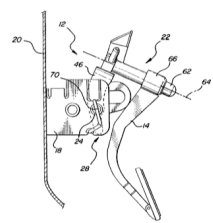
Class 8: Claim Construction And Literal Infringement

Administrative

- Next Time: Skim 159-164; Read 263-80
 - Probably the most complex doctrine you'll face all year. So read and reread. The doctrine has been described as an exception to an exception to an exception from the standard rule of infringement. What does Festo's three scenarios where an absolute bar should not apply mean?
 - Make sure you follow why this is.
- Next Monday: Keep your eye on Frontier Flight 721 from DCA to Denver
 - Scheduled ETA: 10:50am. If it arrives later than 11:30am, probably no class. Also Monday: Survey.
- 10th Circuit Oral Arg on Wednesday (partly during our class):
 - Judicial clerkship talk at Noon.
 - Argument from 1 to 3pm
 - Reception at 4pm.

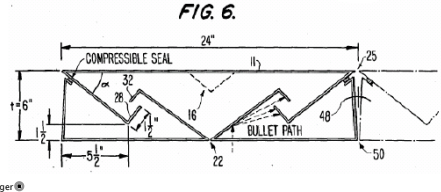
Last Time

- Obviousness
 - Key: Hindsight
 - "At the time the invention was made"
 - Especially a problem with less complex invention.
 - TSM Test
 - Rule: requirement for a showing of a teaching, suggestion, or motivation to combine.
 - flow from prior art itself
 - Knowledge of one skilled in the art
 - Or from the NATURE OF THE PROBLEM TO BE SOLVED.
 - Must be clear and particular --> conclusory statements aren't enough.
 - Does the Fed Circuit Rule make sense?
- KSR v. Teleflex
 - Invention
 - Adjustable Accelerator Pedals
 - Electronic control for reading the angle of pivot
 - Problem: If you mount it to the moving part of the pedal, wire wear, more size, more complexity.
 - Solution/Invention: Mount it to the fixed support surface instead.
- Finished Five Requirements for Patentability
 - 1. Patentable Subject Matter
 - 2. Utility
 - 3. Enablement / Written Description
 - 4. Novelty / No Statutory Bars
 - 5. Non-Obviousness



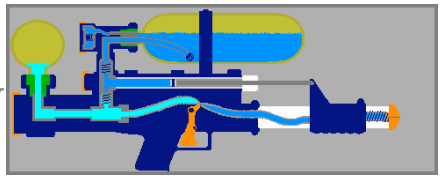
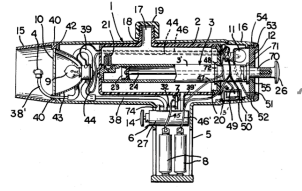
Claim Construction

- Role of Judge and Jury
 - Markman
 - Question of Law for Judge, not Question of Fact for Jury
 - Cyber Corp v. FAS
 - Fed Circuit reviews de novo.
 - Ramifications
 - "Markman" hearings.
 - Significant Reversal Rate (241): 37.5% reversal
 - Judge Mayer's stinging dissent in Phillips
- Phillips: How to construct claims.
 - Road map for construction
 - Intrinsic Evidence
 - Basic Rule
 - Ordinary and customary PHOSITA at the time of invention.
 - Means: Claims, Spec, Prosecution History
 - Claims: "substantial guidance".
 - Specification
 - Prosecution History
 - Extrinsic Evidence
 - Means: Experts and Dictionaries
 - Generally: Risk of changing the meaning from the indisputable public records (intrinsic evidence)
 - Dictionaries
 - Expert Testimony



Literal Infringement

- The All-Elements Rule
 - Step One: Identify the various "elements" or "limitations" of the claim.
 - To infringe, the device must contain every single element/limitation.
- Claim 1: "A toy comprising an elongated housing having a chamber therein for a liquid, a pump including a piston having an exposed rod and extending rearwardly of said toy facilitating manual operation for building up an appreciable amount of pressure in said chamber for ejecting a stream of liquid therefrom an appreciable distance substantially forward of said toy, and means for controlling the ejection."
- Key language: "an elongated housing having a chamber therein for a liquid"
- Claim 2 (Hypo): A gun as in Claim 1, having lights and whistles.



Held (E.D. Penn.)
Question: ?