

# Claim Construction Timing

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A recent order, issued in the middle of a patent trial in *Impinj, Inc. v. NXP USA, Inc.*, No. 4:19-cv-03161 (N.D. Cal.), serves as a reminder that a *Markman* hearing is not a litigant's last opportunity to convince a court to construe patent claim terms.

Claim construction, the review and interpretation of a patent claim's meaning, usually takes place fairly early in a patent case. Plaintiffs and defendants propose both terms to be construed and meanings that they would have the court ascribe to those terms. There is usually extensive briefing of the issues and a hearing held, a so-called *Markman* hearing, named after the case in which the Supreme Court held that the meaning of patent terms is for the judge, and not the jury, to decide: "the construction of a patent, including terms of art within its claim, is exclusively within the province of the court."

The importance of claim construction in a patent case cannot be overstated. Cases are frequently won or lost depending on whether the court agrees with the meaning proposed by the patentee or that of the accused infringer. There may be no more important issues in any given patent case. Defendants typically want terms to be construed narrowly. Patentees, on the other hand, usually counter that a claim term should be construed more broadly—even that it should be afforded its plain or ordinary meaning, without specifying what that plain meaning is. In *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351 (Fed. Cir. 2008), the Federal Circuit made clear that not only is the scope of claims within the province of the court, but the court also has an affirmative duty to resolve disputes over claim scope when they arise.

In *Impinj, Inc. v. NXP*, the issue of the meaning of the patent term "stage" arose during the trial of a patent directed to radio frequency identification tracking technology. Impinj had not proposed that "stage" be construed during the claim construction process. However, days into trial, Impinj requested that the term be construed because "NXP now argues, for the first time, that if its engineers happened to use the word 'stage' to refer to some collection of components in their schematics, and that collection is different from what the claims require a 'stage' to be, then NXP has avoided infringement." Both parties argued that

“stage” had its plain and ordinary meaning, but each had a different view of the dictates of plain meaning. Plaintiff Impinj proposed broad, in the court’s word, “flexible” construction: “a section or portion of the circuit.” Unsurprisingly, defendant NPX offered a more narrow construction, proposing that a “stage” is the “smallest unit of circuit components that” performs a particular function. While the court did not agree with the plaintiff’s very broad construction, it “agree[d] that ‘boxes’ on a schematic are not dispositive” and that there was “insufficient evidence to support the inclusion of the word ‘smallest.’”

Four days after “stage” was construed more broadly than the defendant had requested, the jury found the patent in question valid and infringed.

The case illustrates only one facet of the potential flexibility of courts regarding this central issue of the meaning of patent claims. Litigants should not assume that the traditional path is the only one. Do you think the construction of a single term or phrase could either dictate or obviate infringement and facilitate summary judgment? Consider asking the court to decide that single issue at the earliest stage of the case. Does your jurisdiction have patent local rules that limit the number of terms you can offer for construction to a number that is insufficient? Consider asking the court to expand those limits—but be prepared to articulate well the basis for your request and make clear that the parties dispute the meaning. And if it becomes clear—even on the eve of or during trial—that construction of an additional term is warranted, *O2 Micro* dictates that the court resolve the dispute. “When the parties raise an actual dispute regarding the proper scope of these claims, the court, not the jury, must resolve that dispute. . . . When the parties present a fundamental dispute regarding the scope of a claim term, it is the court’s duty to resolve it.” *O2 Micro*, 521 F.3d at 1360, 1362.

When it comes to the potentially case-dispositive issue of the meaning of patent terms, it may not be too early, too many, or too late.

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