

This is your Release #7 (July 2020)

Patent Claim Construction and *Markman* Hearings

By Thomas L. Creel

In this latest release, author Thomas Creel updates your book with important developments in claim construction in the courts and in the Patent and Trademark Office. Topics discussed include the following:

Disclaimer by disparagement. The Federal Circuit explained, in *Indivior Inc. v. Dr. Reddy's Laboratories, S.A.*, that “a specification may disclaim an embodiment by repeatedly disparaging it.” See § 2:2.1[B][1].

Inter partes review estoppel. In *Novartis Pharmaceutical Corp. v. Par Pharmaceuticals Inc.*, the Delaware district court held that it makes no difference as to estoppel whether the PTO finding of non-obviousness occurs before or after a court proceeding is instituted; nor even after a court trial. See § 3:4.3 and note 35.2.1.

Expert testimony on claim construction. The Federal Circuit warned in *Aten International Co. v. Uniclass Technology Co.* that “[i]t is beyond dispute that claim construction issues are to be decided by the court. It is thus improper for an expert witness to testify before the jury regarding claim construction.” However, unless objection is made when such testimony is given, the impropriety is waived. See § 4:5 and note 14.1.

“Whereby” and “wherein” clauses. Claims will often conclude with a clause describing the intended result of the claimed invention. These are known as “whereby” clauses. Generally, such clauses are not important in claim construction except “when the ‘whereby’ clause states a condition that is material to patentability.” The Federal Circuit treats “whereby” and “wherein” clauses the same. See § 2:2.1[B][1][c] and note 55.1.

For this release, the **Table of Authorities** and the **Index** have been updated.

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FILING INSTRUCTIONS

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**REMOVE OLD PAGES
NUMBERED:**

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- 6-1 to 7-21
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**INSERT NEW PAGES
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