

*This is your Release #9 (May 2022)*

# 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:

**All Elements Rule:** Revisions to section 2:2.1[A] cover *Eli Lilly & Co. v. Teva Pharmaceuticals International GmbH*, in which the Federal Circuit drew a distinction as to limitation between preamble language stating the purpose or intended use of an invention in method of use claims and apparatus and compositions of matter claims, and *SIMO Holdings v. Hong Kong uCloudlink Network*, in which the Federal Circuit found that language following the word “comprising” was not part of the preamble but part of the body of the claim.

**Means plus function claims:** Revisions to section 2:2.1[C][1] take note of the Federal Circuit’s holding in *Qualcomm Inc. v. Intel Corp.* that the algorithm requirement of *WMS Gaming* does not apply when the structure disclosed is circuitry rather than a general-purpose computer.

**Apparatus claims:** New section 2:2.1[C][8] cites *Bio-Rad Laboratories, Inc. v. International Trade Commission* and points out that, while the general claim construction rule is that apparatus claims cover what the apparatus is, not what it does, the words actually used by the inventor(s) are determinative in any claim construction.

**Estoppels and disclaimers:** Revisions note that an applicant’s statement in prosecution can create a disclaimer even if the statement was not needed to overcome the examiner’s rejection (see section 2:2.2[B]).

**Written description:** Revisions to section 2:4.1[C] discuss the Federal Circuit’s recent decision in *Novartis Pharmaceuticals Corp. v. Accord Healthcare, Inc.*, the latest precedential opinion addressing written description issues associated with claimed dosages and dosage ranges.

**Stare decisis:** Updates to section 3:3.1 explore *Traxcell Technologies, LLC v. Sprint Communications Co. LP*, which notes that, when the parties have stipulated to a particular claim construction, that stipulated

*(continued on reverse)*

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1177 Avenue of the Americas  
New York, NY 10036  
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meaning may take precedence over the claim construction by a court in a previous, related case involving the same claim term in the same patent.

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

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# Patent Claim Construction and *Markman* Hearings

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