

## REDEFINING THE COMPLEXITIES UNDERLYING CLAIM CONSTRUCTION - A PRE & POST MARKMAN ANALYSIS

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*An invention, to be patentable, must be novel, must have an inventive step and must be capable of being industrially applicable. A patentable invention must be much more than a mere workshop improvement and must be claimed in a manner that exhibits a departure from the claims made in the prior art. Thus, drafting the patent claims and their appropriate interpretation by the Courts play a crucial role in the grant of patent and litigating a suit for infringement. The outcome of a patent infringement suit depends upon judicial interpretation of the claims of the alleged infringers' product with that of the patentee to determine whether the former falls within the scope of the limitations of the latter. In case the same is proved, infringement stands proved beyond doubt. Conversely, in cases where the defendant makes use of the defence of invalidity against the said patent, the courts shall again determine the validity of the patent in question by construing the claims made in the said patent with those claimed in the prior art. Hence, the claim construction plays a crucial role in determining the validity of a patent and its continued existence. The Markman hearing is one such patent claim interpretation form that the courts generally employ in almost every patent infringement suit. It is a clear and doubtless understanding of the claim format that helps in understanding and successfully interpreting the claims, which mere 'training and discipline' of the judges can't give. In order to be successful, a Markman hearing claim construction must be conducted by the Jury or scientific advisers and experts, versed with the techno-legal terms of claims.*

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## I. INTRODUCTION

An invention, to be patentable, must be novel, must have an inventive step and must be capable of being industrially applicable and it should be possible to distinguish the said invention from any prior art. To be patentable the invention must be much more than a mere workshop improvement and must be claimed in a manner that exhibits a departure from the claims made in the prior art. Thus, drafting the patent claims and their appropriate interpretation by the Court plays a crucial role in the grant of patent. A patent application may stand rejected merely on the grounds that the claims and the specifications have not been drafted properly, or an infringement may be upheld where the claims made by the infringing product or process fall under the suspicion and limitations of the patent in question. Claim construction refers to the task of construing, or interpreting, the words of patent claims to establish the metes and bounds of a patent.<sup>2</sup> Theoretically, the task of claim construction serves to operationalize the concept of “invention”; that lies at the heart of Patent regimes across different jurisdictions.

The Markman hearing<sup>3</sup> is an important development in the patent claim construction history that made clear that the claims at issue should be decided at a hearing separate from the rest of the litigation to determine its meaning. It sought to settle the long dispute as to who should determine what claims mean— judges or juries. The Seventh Amendment to the U.S. Constitution preserves the right to a trial by jury that guarantees a patentee that the jury will decide the ultimate question of infringement. Deciding in favour of the claim construction being a matter of law and hence to be tried by the judges and not the jury, the Federal Circuit, set at rest all the confusion regarding adjudication of matters involving claim construction. Therefore, today the decision a trial court reaches on the issue of claim construction is generally known as a Markman decision, and the process the court uses to reach that decision is often called a Markman hearing, even when a formal hearing is not involved.<sup>4</sup>

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<sup>2</sup> Section 10, The Patents Act, 1970.

<sup>3</sup> Markman v. Westview Instruments, Inc., 52 F.3d 967, 976 (Fed. Cir. 1995).

<sup>4</sup> THE SEDONA CONFERENCE WORKING GROUP, SERIES REPORT ON MARKMAN PROCESS, PUBLIC COMMENT VERSION, JUNE 2006, available at [https://thesedonaconference.org/.../6\\_06WG5pubcomment\\_0.pdf](https://thesedonaconference.org/.../6_06WG5pubcomment_0.pdf).

The present paper seeks to study the Markman hearing in detail, the pros and cons following it and the possible procedures that may be adopted in patent jurisprudence to eliminate any ambiguity with regard to its application. The paper shall also discuss the course adopted in India, which follows the British purposive construction policy, such that claim construction rules may be harmonised and streamlined internationally.

## II. MEANING AND IMPORTANCE OF CLAIM CONSTRUCTION

*Meaning:* Claims define the boundaries of legal protection sought by the patentee and form a protective fence around the invention which is defined by the words and phrases in the claims. It is the statement of technical facts expressed in legal terms defining the scope of the invention sought to be protected. The objective of a claim is to define the scope of the invention to obtain the widest possible protection. Each claim is evaluated on its own merit and, therefore, if one of the claims is objected, it does not mean that the rest of the claims are invalid.

*Claims in Infringement Suits:* A suit for infringement necessarily involves adjudication by the courts to the effect that the alleged infringing product or process falls under the limitation and suspicion of the claims and specifications made by the patentee in his patent application. Similarly, a defence that attacks the validity of the patent is pleaded on the grounds that the claims in the patent in issue fall within the limits of the scope of the claims made in the prior art. If a patent application's claims have been literally infringed or if a purposive construction<sup>5</sup> of the claims can establish infringement, only then would a suit for infringement be successful. This process of interpreting the claims to prove infringement is called 'claim construction.' When there is no literal infringement but the non-essential elements are substituted for closely related elements the same shall still be a case of infringement due to the prevalence of the 'doctrine of equivalents', which allows for successful claims of infringement on the basis of 'substantial similarity' in elements such as 'functionality, way and result.'<sup>6</sup> It is a succinct, purposive and contextual construction of the language and the wordings of the claims that fulfil the enablement requirement of the said product or process as per

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<sup>5</sup> Adelman Martin J and Francione Gry L, *The doctrine of Equivalents in Patent Law : Questions that Pennwalt did not answer*, UNIVERSITY OF PENNSYLVANIA LAW REVIEW, 137 (1989) 673.

<sup>6</sup> *Graver Tank & Mfg. Co. v. Linde Air Prods.Co.*, 399 US 605 (1950).

the PHOSITA standard. The language and the wordings of the claim are inventor-centric<sup>7</sup> and the courts are bound to give such interpretation that serves better the objective with which the inventor presumed and intended its construction and interpretation.

### III. JURISPRUDENTIAL DEVELOPMENT OF CLAIM CONSTRUCTION IN THE PRE-MARKMAN ERA

Since 1996, the Markman hearing has taken the centre stage in procedural trials and the adjudication through summary judgements and expert reports. In the initial stages of patent history in America, jury trials were commonplace in patent infringement cases.<sup>8</sup> The strategic shift in the Supreme Court decisions by 1961 usurped the jury of its Seventh Amendment powers and jurisdiction. Finally, the Congress then passed the Federal Court Improvement Act, 1982 vesting the exclusive jurisdiction in patent related cases in the U.S. Court of Appeals for the Federal Circuit. Notably, the factors that culminated into the formal process of claim construction by judges were: the emergence of patent claiming in the early 19<sup>th</sup> century; the shift from central claiming to peripheral claiming in the mid-19<sup>th</sup> century wherein, the widest claim was made in the first place thus, making up the central claim which was followed up with subordinate claims that are dependent on the widest ones and worded in narrower fashion;<sup>9</sup> the shift in infringement jurisprudence to determine the same through claim boundaries; the resurgence of patent trials by jury after 1970's. For the very first time in 1869, the Court in *Bischoff v. Wethered*<sup>10</sup> held that while documentary evidences were to be construed by the courts, patent infringement required interpretation through extrinsic evidences necessarily by the jury.

Thereafter, the Patent Act, 1870 gave statutory recognition to patent claims and some of the first published decisions indicated that the Patent Office sought more detailed and clear articulation of patent claims. *In Ex parte Rubens*<sup>11</sup> it was stated that the claims

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<sup>7</sup> Free World Trust v. Électro Santé Inc. et al., (2001) 9 C.P.R. (4th) 168 (S.C.C. per Binnie, J.), para. 51.

<sup>8</sup> J. Jonas Anderson, Peter S. Menell, *Informal Deference: A Historical, Empirical, and Normative Analysis of Patent Claim Construction*, NORTHWESTERN UNIVERSITY LAW REVIEW, Vol.108 P.8 To 24, (available at <https://www.law.northwestern.edu/.../n1/1/LR108n1AndersonMenell.pdf>).

<sup>9</sup> Parkinson v. Simon [1894] 11 RPC 493.

<sup>10</sup> *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812 (1869).

<sup>11</sup> 1869 Dec. Comm'r Pat. 107.

should state all the elements in the combination intended to be patented. With the Supreme Court's decision in *Winans v. Denmead*<sup>12</sup> which applied the doctrine of equivalents, the court focused on the substance of the invention: the "new mode of operation". Later with decisions in *Merrill v. Yeomans*<sup>13</sup> and *Keystone Bridge Co. v. Phoenix Iron Co.*,<sup>14</sup> the scope of patent protection came to be linked with the metes and bounds set forth in patent claims thereby making claim construction an essential step in infringement analysis. In *Singer manufacturing Co. v. Cramer*<sup>15</sup> it was again held that patent infringement doesn't require construing extrinsic evidences to explain the terms of art therein being a matter of law for the courts.

In *Structural Rubber Products v. Park Rubber Co.*<sup>16</sup> the Federal Circuit stated that although claim interpretation was a matter of law for the courts, claim construction being depended upon in a factual dispute is a question triable by the jury. Another very important jury trial was in *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H.*,<sup>17</sup> where the testimony of the engineers of both the sides was taken to clarify the disputed terms' meaning. On appeal it was held that *'when the meaning of a term in a patent claim is unclear, subject to varying interpretations, or ambiguous, the jury may interpret the term en route to deciding the issue of infringement.'* The jury's verdict of non-infringement is reviewed in accordance with the rules governing the review of jury determinations, to ascertain whether reasonable jurors could have interpreted the claim in a way that supports the verdict.<sup>18</sup>

#### IV. MARKMAN V. WESTVIEW INSTRUMENTS INC. - CASE ANALYSIS

This case relates to a patent infringement suit filed by the plaintiff Markman against Westview and Anthon Enterprises in a patent obtained by the former for a computerised inventory control and reporting system for use in the clothes in dry

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<sup>12</sup> *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1853).

<sup>13</sup> *Merrill v. Yeomans*, 94 U.S. 568, 573-74 (1876).

<sup>14</sup> *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 278 (1877).

<sup>15</sup> *Singer Mfg Co. v. Cramer*, 192 U.S. 265 (Feb 1, 1904).

<sup>16</sup> *Structural Rubber Prod. v. Park Rubber Co.*, 749 F.2d 707 (Nov. 9, 1984); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666 (April 27, 1984).

<sup>17</sup> *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H.*, 945 F.2d 1546 (Fed.Cir. Sept. 26, 1991).

<sup>18</sup> *Id.* note 26 at p. 42 to 44.

cleaning industry. The Markman system consisted of a keyboard and data processor to generate written records for each transaction, including a bar-code readable by optical detectors operated by employees, who logged the progress of clothing through the dry-cleaning process. Respondent Westview's product also included a keyboard and processor, and it listed charges for the dry-cleaning services on bar-coded tickets that could be read by portable optical detectors. Markman alleged an infringement of three claims made by him and manufacture and sale of a competing device by Westview that similarly utilised bar-codes technology to track invoices through a dry-cleaning business. Westview argued that their system was different because it "*merely recorded an inventory of receivables by tracking invoices and transaction totals rather than to record and track an inventory of articles of clothing.*" Westview was tracking money and invoices, not clothes. The question involved the interpretation by the jury of the term 'inventory' used in independent Claim 1 of the patent application by Markman. Markman stated that it meant that the product can "maintain an inventory total" and "detect and localize spurious additions to inventory." The jury found for Markman and held infringement in Claim 1 and dependant claim 10. The District Court nevertheless granted Westview's deferred motion for judgment as a matter of law, one of its reasons being that the term 'inventory' in Markman's patent encompasses "*both cash inventory and the actual physical inventory of articles of clothing*" basing their reasoning on the fact that Westview's system would not infringe on Marksman's patent because the word 'inventory' in Marksman's patent is to be construed to mean 'clothes' and not things like money or invoices. Hence, it would not infringe unless the product was capable of tracking articles of clothing throughout the cleaning process and generating reports about their status and location.

On appeal to the Federal Court, the questions that came for consideration were-

- 1) Whether the interpretation of the claims and the patent document that defines the scope of the patentee's rights, is a matter of law reserved entirely for the court, or subject to a Seventh Amendment guarantee that a jury will determine the meaning of any disputed term of art about which expert testimony is offered?
- 2) Whether the district court acted properly by construing the term 'inventory' as a matter of law?

3) Whether the term ‘inventory’ requires as part of its meaning ‘articles of clothing?’

The court ruled that claim construction involves a question of law. Justice Souter of the Supreme Court observed that for claim construction there are *three intrinsic sources*: the claims, the specification and the prosecution history. Apart from this, experts and inventors’ testimony, including evidence of how those skilled in the art would interpret the claims, dictionaries, and learned treatises are *extrinsic evidences*. These extrinsic evidences shall aid the court in arriving at the true meaning of the language employed to the patent. Extrinsic evidence is to be used for the court's understanding of the patent, not for the purpose of varying or contradicting the terms of the claims. The Court emphasised that claims must be read in view of the specification, of which they are a part. The specification is a written description which acts as a dictionary for the invention and the claim terms used therein. The claim language may also be construed with the help of prosecution history.

With regard to the affirming and establishing consistency of the decision of the Federal Circuit with that of the Seventh Amendment the court applied the ‘historical test’ and held that historically all infringement actions have been tried at law but didn’t decide that it was purely a legal matter. Upholding the validity of a *de novo* review of claim construction, being matters of law, the SC admitted that ‘inventory’ in claim 1 includes within its meaning ‘articles of clothing’ and that Westview’s device is not infringing as it doesn’t and cannot track articles of clothing. The court also held that the duty of construing claims lies with the judge and not the jury. The construction of a patent, including terms of art within its claim, was held to be exclusively within the province of the court.<sup>19</sup>

## V. POST-MARKMAN JURISPRUDENCE

In the post-Markman phase, the failures committed by Markman were carried on for a long time<sup>20</sup> and there was no definite or set jurisprudence for administering and adjudication the claim construction in patents. This may be understood by categorising

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<sup>19</sup> *Id.* note 2 at p. 376-391.

<sup>20</sup> See *Cybor Corp v. FAS Tech.*, 138 F.3d 1448 (Fed. Cir. March 25, 1998) (en banc).

the different trends that came to be followed by the courts while determining the question of infringement through claim construction in to the following approaches:

A. *Specification Based Approach*

In *Markman*, the Federal Circuit in its opinion emphasised that claims must be read in view of the specification, of which they are a part and that it is the written description that acts as a dictionary while explaining the invention and the terms used in the claims.<sup>21</sup>

1. Following this specification centred approach, the Federal Court decided the dispute in *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*<sup>22</sup> the court ruled that failure to mention the claims in the specification waived the right of the plaintiff to claim upon the other type of the configuration which were claimed by the defendant.
2. In *Vitronics Corp. v. Conceptoronic, Inc.*,<sup>23</sup> the Court further expanded the analytical approach of *Markman* by ruling that the claims are to be read in the specification by implication and for this the *Vitronics* court established a hierarchy of evidences that may be used to construe claims. The court gave primacy to the intrinsic evidence over and against the extrinsic ones. First, the language of the claims must be read to define the scope of the invention. Second, the specifications must be reviewed to see if claim terms inconsistent with the ordinary meaning have been used as specification is the best guide to the meaning of a disputed term. Third, reference may be made to the prosecution history of the invention. Also, the court cautioned that if intrinsic evidence resolves the dispute then extrinsic evidences may not be referred further.

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<sup>21</sup> Ehab M. Samuel, *Phillips v. AWH Corp., Inc.: A Baffling Claim Construction Methodology*, FORDHAM INTELLECTUAL PROPERTY, MEDIA AND ENTERTAINMENT LAW JOURNAL, VOL. 16, ISSUE 2, p.6 TO 9 available at <http://ir.lawnet.fordham.edu/cgi/viewcontent.cgi?article=1345&context=iplj>) 2005.

<sup>22</sup> *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.* 242 F.3d 1337 (Fed.Cir. March 14, 2001).

<sup>23</sup> *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582–83 (Fed. Cir. July 25, 1996).

3. Further in *Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc.*<sup>24</sup> the Court strengthened the construction of claims through implication by noting that the specification clearly defines the claim without explicit definition of the term. It is the written description that defines claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents and the meaning of that terms remains same and consistent throughout, in every reference made in that regard.
4. Finally, in *Phillip v. AWH Corp.*,<sup>25</sup> the Court set at rest the tension between specification based and claim based approach. The Court emphasised that the claim terms are to be given an ordinary and customary meaning attributed by the PHOSITA and the latter shall interpret the same in the context it is used as well as is used in the specification. It concluded that patent specification is the best source for determining the meaning of the claim terms.

#### *B. Claim Based Approach*

This was a trend followed by certain courts that gave importance to the ordinary and the accustomed meaning and hence favoured the claim-based approach.<sup>26</sup>

1. The first among these cases was *CCS Fitness, Inc. v. Brunswick Corp.*,<sup>27</sup> that involved a patent directed to a stationary exercise device known as the elliptical trainer and the issue revolved around the meaning of ‘reciprocating member’. The court laid reliance upon the presumption that the words used the claims bear their ordinary and accustomed meaning and that the meaning in the dictionaries may assist in establishing a claim terms ordinary meaning except when the patentee is himself the lexicographer, or if the term is such that deprives the claim of clarity.

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<sup>24</sup> *Bell Atlantic Network Services, Inc. v. Covad Commc’n Group, Inc.*, 262 F.3d 1258 (Fed. Cir. August 27, 2001).

<sup>25</sup> *Phillip v. AWH Corp.*, 363 F.3d 1207 (Fed. Cir. April 8, 2004).

<sup>26</sup> *Id.* at p. 12 to 23.

<sup>27</sup> *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359 (Fed. Cir. May 30, 2002).

2. In *Texas Digital Systems, Inc. v. Telegenix*,<sup>28</sup> the court analysed the language of the claims themselves because it was such which the patentee chose to particularly point out and ‘distinctly claim’ in the subject matter of his invention. The court pointed out that dictionaries and encyclopedia are objective and reliable sources that attribute the meaning to the terms in the claims as done by a PHOSITA. Referring these sources as the most meaningful sources the court emphasised its reference at any time in the trial and the court cautioned that consulting the specification or prosecution history before discerning the ordinary and customary meanings is violation of the precedent for importing limitations into the claims. The court in *Brook Hill-Wilk 1, LLC v. Intuitive surgical Inc.*<sup>29</sup> ruled the consulting a dictionary is “*simply a first step in the claim construction analysis*” and “*resort must always be made to the surrounding text of the claims in question, the other claims, the written description, and the prosecution history.*”
3. In *Storage Tech. Corp. v. Cisco Systems Inc.*,<sup>30</sup> with regard to the disputed terms ‘caching policy identification information’ and ‘network policy,’ the court concluded that an applicant’s erroneous or “*inaccurate statement cannot override the claim language itself, which controls the bounds of the claim.*”

### C. *The Suggestion Test in Claim Construction*

With the increasing application of the claim-based approach the courts then started to incline towards the ‘suggestion test’ as a justification for interpreting claims. This test postulates that if the patentee intends to limit the scope of the claim terms by attributing several different dictionary meanings then he has to specify the same in the claim specifications also. If the same has not been done then the courts shall not be bound to restrict themselves to the single connotation as mentioned in the specifications.<sup>31</sup>

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<sup>28</sup> *Texas Dig. Sys., Inc. v. Telegenix*, 308 F.3d 1193 (Fed. Cir. Oct. 16, 2002).

<sup>29</sup> *Brook Hill-Wilk 1, LLC v. Intuitive Surgical Inc.*, 326 F.3d 1215 (Fed. Cir. Apr. 11, 2003); *Merck & Co. v. Teva Pharm. USA, Inc.*, 395 F.3d 1364, 1366 (Fed. Cir. Jan. 28, 2005).

<sup>30</sup> *Storage Tech. Corp. v. Cisco Sys., Inc.*, 329 F.3d 823, 832 (Fed. Cir. May 13, 2003).

<sup>31</sup> *Id.* note 25 at p. 24 to 27.

1. The controversy regarding the rigidity of the application of the suggestion test came for consideration before the Federal Circuit in *Teleflex, Inc. v. Ficos North America Corp* that involved a patent on a device that would attach shift cable to the automated transmission vehicle and ‘clip’ was at issue. The suggestion test seemed too restrictive in nature and the court held that although the specification referred to only one single meaning of the term, there was nothing else in the specification to suggest that its meaning was limited.
2. In *Sunrace Roots Enter. Co., Ltd. v. SRAM Corp*,<sup>32</sup> the specifications enumerated a number of other connotations to the term in dispute and so the court rejected the claim of the infringer that it should be only limited to one specific meaning as nothing in the specification explicitly stated that it should be construed in a limited sense.
3. In *Pfizer Inc. v. Teva Pharmaceuticals*,<sup>33</sup> the Federal circuit upheld the grant of a preliminary injunction in favour of Pfizer for the pharmaceutical composition of Quinapril. In doing so, the court addressed several claim construction issues raised by Ranbaxy and showed a reluctance to base a narrow construction on a single isolated passage in the specification.<sup>34</sup>

A major drawback of the judgement in Markman was that it failed to clearly specify the timings of when and how to hold a Markman hearing. As such, different Courts applied the Markman hearing at different times. There were instances when the Markman hearing was held in a separate proceeding, and at other times the Courts interpreted the claim terms before or during the trial thereby paving way for a lot of confusion regarding the procedural technicalities to be followed resulting in uncertainty and unpredictability about the application of the Markman hearing.<sup>35</sup>

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<sup>32</sup> *Sunrace Roots Enter. Co., Ltd. v. SRAM Corp.*, 336 F.3d 1298, 1299 (Fed. Cir. Jul. 17, 2003).

<sup>33</sup> *Pfizer Inc. v. Teva Pharm.*, (Fed. Cir. Feb. 6, 2014).

<sup>34</sup> *Id.* note 25 at p.12.

<sup>35</sup> *Elf Atochem North America, Inc. v. Libbey-Owens-Ford Co., Inc.*, 894 F. Supp. 844, 37 U.S.P.Q.2d (BNA) 1065 (D. Del. Aug. 4, 1995) (Here, the court preferred the adoption of either of the three options for deciding the disputes of the claim terms- resolution through paper record, or hearing, or else the court shall wait); *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 42 U.S.P.Q.2d (BNA) 1737 (Fed. Cir. Jul. 2, 1997) (Here, the Markman decision came down during the trial itself and the court interpreted the patent based on the trial testimony and instructed the jury as to the

### *Purposive Claim Construction in India*

The Indian Act much like its counterpart, USA, doesn't stipulate any set guidelines for claim construction. The provision under S. 10 (4) (c) of the Patents Act, 1970, specifically states that the complete specification shall end with the claim(s) that define the scope of the invention for which protection is claimed and this indicates the relevance of claims in so far as an understanding of the invention is concerned. Hence, their interpretation must be meaningful and in relation to the context in which the same is used. India has inherited its patent law system from the British common law patent practices and moreover patent litigation was rare before 2005<sup>36</sup> and hence, India generally follows the patent interpretation process as under the British system. *Catnic Components Ltd. v. Hill & Smith Ltd.*<sup>37</sup> is a leading case on claim construction decided by the House of Lords that held that a patent must be read in a 'purposive' manner that focuses on the essential features of the patent. The Court in *Bajaj Auto case*<sup>38</sup> while referring to this case emphasised that the determination of the pith and marrow of an invention required a purposive construction of the claims. Particularly, the court in this case laid down the guidelines for patent infringement determination and inter alia mentioned about the claim construction that the Courts ought to look at the case as a whole. The construction of the patent claims that makes them valid should be preferred. The patent specification should be read by a person skilled in the relevant art, but the 'construction is enjoined upon the Courts who have to be informed about the necessary meaning of the technical words and phrases and according to what is right as per the common general knowledge i.e. 'notion of the skilled man in that specific art'.<sup>39</sup>

Purposive construction<sup>40</sup> implies reading the words chosen by the inventor "in the sense the inventor is presumed to have intended, and in a way that is sympathetic to

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meaning of the claim terms); *American Bank Note Holographics, Inc. v. Upper Deck Co.*, 934 F. Supp. 630 (S.D.N.Y. Aug. 8, 1996) (Here, the timings of the summary judgement were unclear).

<sup>36</sup> Edward D. Manzo, *Interpreting Patent Claims Around the World – a Comparative View*, p.40, 2013, available at [http://doritkorine.livecity.me/image/users/256043/ftp/myfiles/Presentations/Manzo\\_pdf-1.pdf?id=13904540z](http://doritkorine.livecity.me/image/users/256043/ftp/myfiles/Presentations/Manzo_pdf-1.pdf?id=13904540z).

<sup>37</sup> *Catnic Components Ltd. v. Hill & Smith Ltd.*, [1982] R.P.C. 183.

<sup>38</sup> *Bajaj Auto Ltd. v. TVS Motor Co. Ltd.*, (2008) ILLJ 726 Mad.

<sup>39</sup> Reiterated in *Ten Xc Wireless Inc. v. Mobi Antenna Tech.* (CS (OS) 1989/2010).

<sup>40</sup> *Id.* note 53 at p. 23 to 25.

accomplishment of the inventor's purpose expressed or implicit in the text of the claims. The key to purposive construction is the identification of the particular words or phrases in the claims that describe what the inventor considered to be the 'essential' elements of his invention. It asks whether persons trained in the field would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed, even though it could have no material effect upon the way the invention worked.

The Indian Patent Act, 1970, under Section 115 provides for appointment of 'Scientific Advisers' who are to assist the Courts and report them on any matter of fact or of opinion, except any question involving any interpretation of law. This may be inferred as being a guiding factor in claim construction and it is deductible that in India the claims are considered as matters of fact for which advice and opinion of scientific advisers is considered relevant in determining the claim term meaning along with admissibility of extrinsic evidences.<sup>41</sup>

In *Raj Prakash v. Mangat Ram*,<sup>42</sup> the court pointed out that the words in the claims and specifications should be given their ordinary meaning, but where necessary they must be construed in the sense in which they are used in a particular trade or sphere in which the invention is sought to have been made and should not be involved in the detailed specification made by the parties.<sup>43</sup> Similarly, in *Bishwanath Prasad v. Hindustan Metal Industries*<sup>44</sup> the court indicated that the right way to construe the specification and claims is to first read the entire description of the invention such that the mind may be prepared as to what is being claimed and the context in which the term is being used in the claim.

In *F. Hoffmann-La Roche Ltd. v. Cipla Limited*,<sup>45</sup> the infringement action brought by Roche against Cipla and Cipla's counterclaim for Roche's patent invalidity were both

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<sup>41</sup> *Id.* note 48.

<sup>42</sup> *Raj Prakash v. Mangat Ram*, AIR 1978 Delhi 1.

<sup>43</sup> The Patent Office, India, Draft Manual of Patent Practice and Procedure, 2008.

<sup>44</sup> *Bishwanath Prasad v. Hindustan Metal Indus.*, AIR 1989 SC 1444.

<sup>45</sup> *F. Hoffmann-La Roche Ltd. v. Cipla Ltd.*, 148 (2008) DLT 598.

dismissed and while construing the disputed claim in question the court relied upon the expert testimony adduced by Cipla to give a purposive construction to the claim in question so as to give effect to the real purpose for which the patent was invented. “Such test appears to be correct so far as it relates to simpliciter infringement cases where the impugned product is straightaway subsumed in the claimed portion of the invention without anything else in the said product.” However, it was noted that there may arise certain cases where the product which is alleged to be infringing does not completely corresponds to what has been claimed in the patented invention of the product or the product may substantially be containing the patented product but with some parts or variants. For such cases, the courts developed a different rule of construction of the patent claim and specification, which is the rule of the purposive construction of the patent claim. This is so that in the cases wherever the need be, the claim in the invention is not construed too narrowly, which was never the intention of the inventor, and not the purpose of the said invention so that the maximum benefit should be given to the inventor.<sup>46</sup>

In *Lallubhai Chakkubhai v. Chimanlal & Co.*,<sup>47</sup> the issue of infringement arose over the patent process for treating dried fruits, which the plaintiffs’ alleged have been infringed as defendants have been using the same process. The court however, after expert testimony and reports of expert witnesses on behalf of the defendants dismissed the suit and found in favour of the defendants, stating that there was no infringement. While determining the question of infringement, the court made a thorough reference to the entire written statement and the specification ‘as a whole’ and observed that nothing in the written statement suggested that the process similar to the one used by the plaintiffs’ was being employed by the defendants also.

In *Ajay Industrial Corp. v. Shiro Kanao of Ibaraki City*,<sup>48</sup> while considering a plea for patent revocation, the Delhi High Court reasoned that the real purpose of the patent needs to be seen, which in this case was to claim monopoly in respect of method of manufacture and not the end product.

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<sup>46</sup> *Id.* at para. 230.

<sup>47</sup> *Lallubhai Chakkubhai v. Chimanlal & Co.*, AIR 1936 Bom 99.

<sup>48</sup> *Ajay Indus. Corp. v. Shiro Kanao of Ibaraki City*, AIR 1983 Del 496.

Hence, all these cases are illustrative of the fact that in the Indian courts have been generally inclined at construing the claims and the meaning of the disputed claim terms as per the intent with which it has been used, the context, the inventors' intent and read the invention as a whole in relation to the claims and the specification, thereby applying the purposive construction doctrine for claim construction.

## VI. CONCLUSION

The above analysis distinctly points out the importance of claim construction in patents and the determination of the disputed claim terms in any infringement suit for both the parties. Very recently in *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*,<sup>49</sup> popularly called the Copaxone Story of India and US, the Supreme court put forward a new standard for the review of district courts' claim construction as established since *Markman*. The Court held that when reviewing a district court's resolution of subsidiary factual matters made in the course of its construction of a patent claim, the Federal Circuit must apply a 'clear error,' not a *de novo*, standard of review. The Supreme Court ruled that a *de novo* standard alone is improper and the Federal Circuit must apply a 'clear error' standard of review on 'subsidiary factual disputes' resolved by district courts in construing a patent's claims. This means that although claim construction is a matter of law, fact finding may become necessary at times and where a district court is forced to look beyond the patent's intrinsic evidence and consider extrinsic evidence in constructing a patent's claims the clear error standard must apply. This is probably just the beginning to the change in standards set by *Markman* since 1996 and further urges major steps by the courts in future to streamline the propositions of *Markman* such that claim construction may be relieved of every ambiguity that surrounds it as of now.

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<sup>49</sup> *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 574 U.S. \_\_\_\_ (2015).