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Words Matter

The Overlooked Statements Behind Claim Construction

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Your own words are the record

THE COURT'S LINE

“Just as the echo matches the shout, Azurity’s repeated, sweeping statements—endorsed by the examiner—return an equally sweeping disclaimer.”

Azurity v. Alkem ★ (Fed. Cir. 2025)

WHAT AZURITY SAID

Its oral vancomycin liquid had **no propylene glycol.**

WHAT IT COST

The statement later excluded propylene glycol **even inside a flavoring agent.**

The rule, and how unevenly it is applied

Phillips

Fed. Cir. 2005 (en banc)

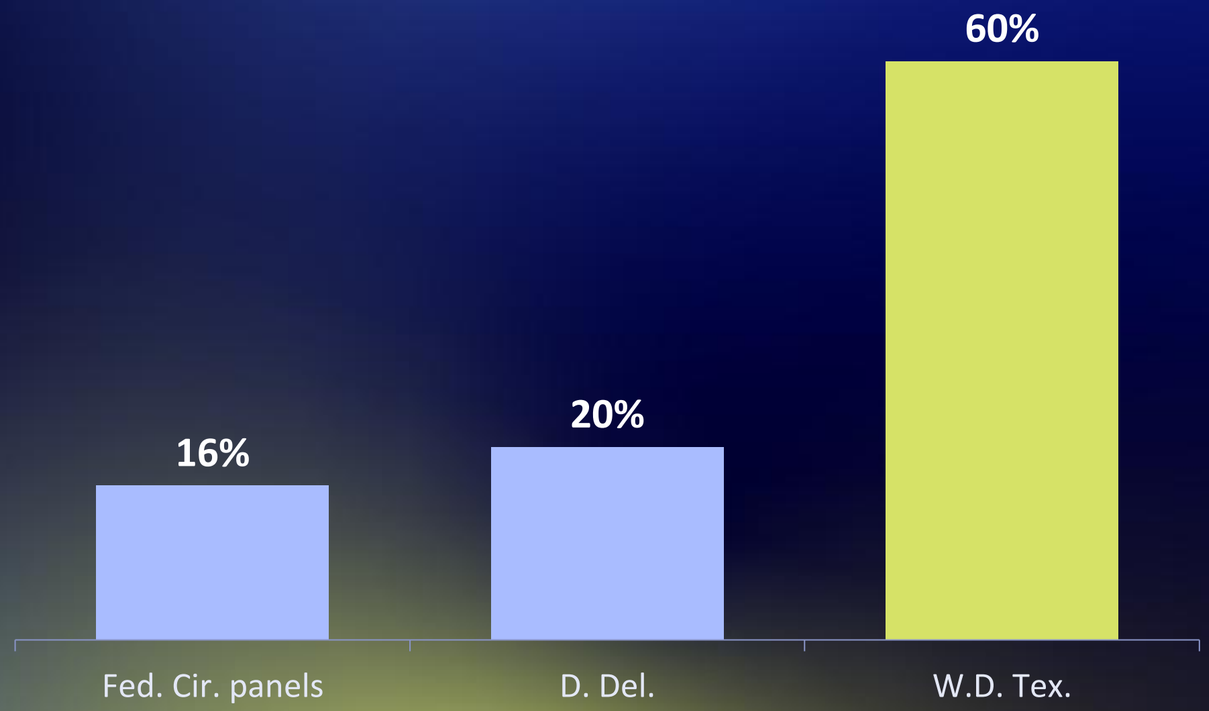
The claims, specification and prosecution history carry the most weight – context matters

Thorner

Fed. Cir. 2012

Depart from plain meaning only for lexicography or disavowal – strict reading of the claims

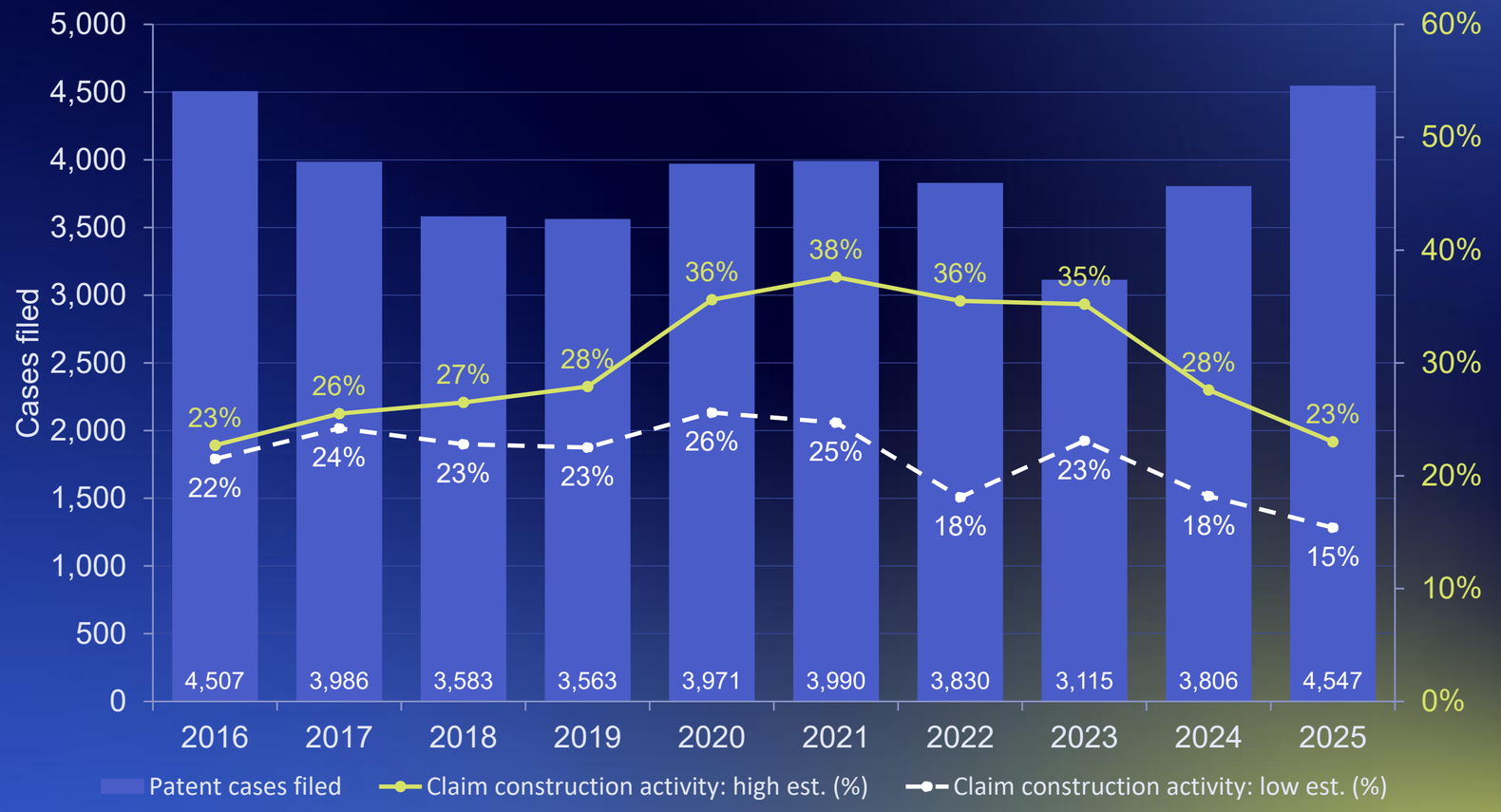
HOW OFTEN THORNER IS CITED



Share of decisions citing Thorner, mid-2022 to mid-2023; W.D. Tex. is 60%+. Source: Law360, "Claim Construction Split."

Claim construction shapes a large share of patent suits

U.S. district court patent cases filed per year, and share showing claim construction activity on the docket



~23–29%

of patent suits filed 2016–2023 show claim construction scheduling, briefing, a hearing, or a ruling on the docket

~1 in 10

actually reach a Markman hearing (1,094 of 10,128 non-ANDA cases terminated 2022–24, per Lex Machina)

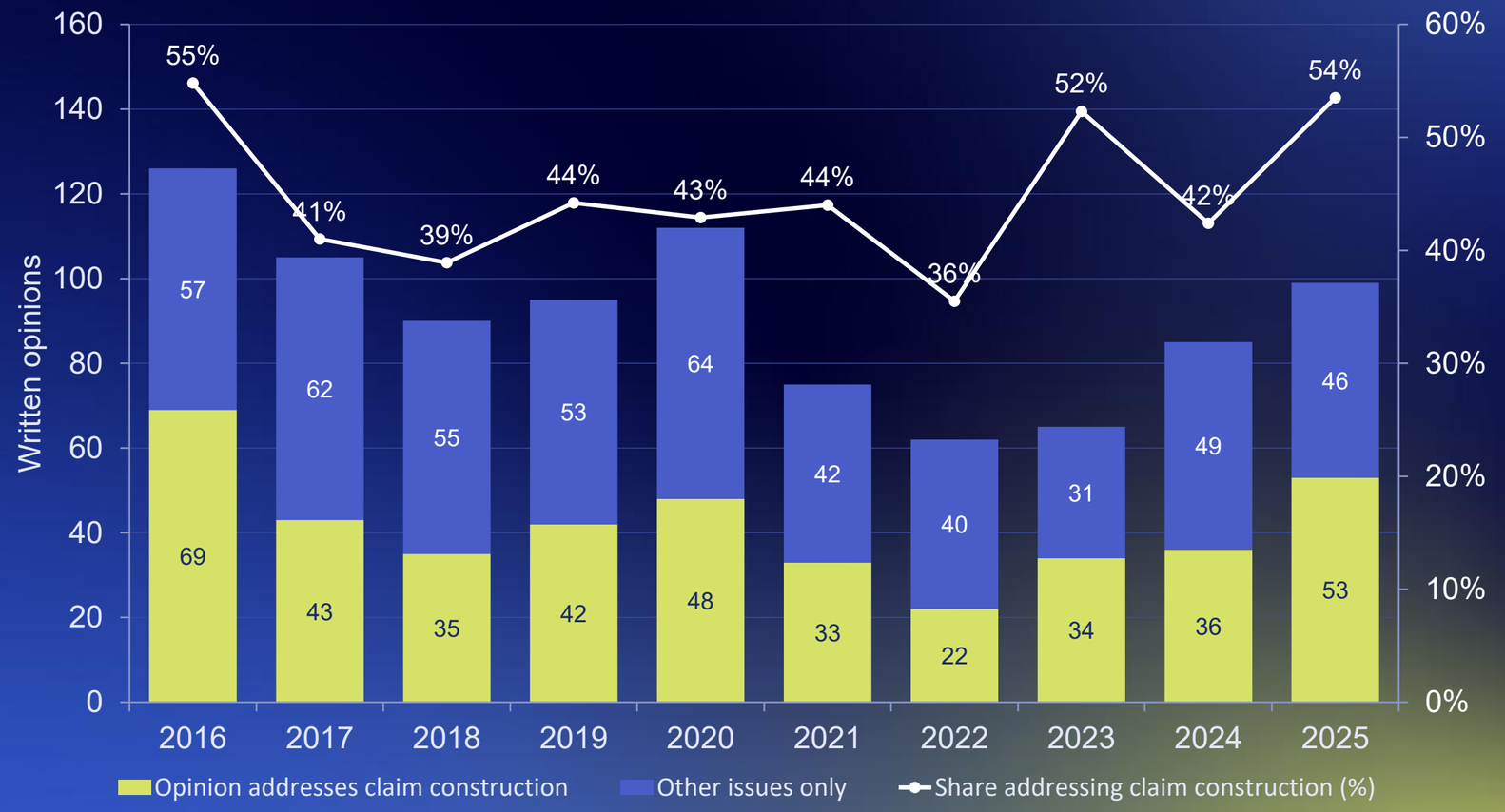
~90%

of cases settle or end on procedure, often before or soon after claim construction (Lex Machina, 2022–24)

Sources: Lex Machina Patent Litigation Reports 2025 & 2026 (case counts; Markman-hearing benchmark); CourtListener/RECAP docket search, patent NOS 830 (claim construction share). Range = RECAP hits ÷ RECAP dockets vs. ÷ total filings. 2024–25 cases are still pending, so their shares will rise. Estimates, not a census; see notes.

On appeal: claim construction in ~45% of opinions

Federal Circuit written opinions in patent appeals from district courts, by year of decision



45%

of 914 written Federal Circuit opinions in district-court patent appeals (2016–2025) substantively address claim construction

36%

reversal rate (in whole or in part) for district-court patent appeals decided on the merits, 2022–24 (Lex Machina)

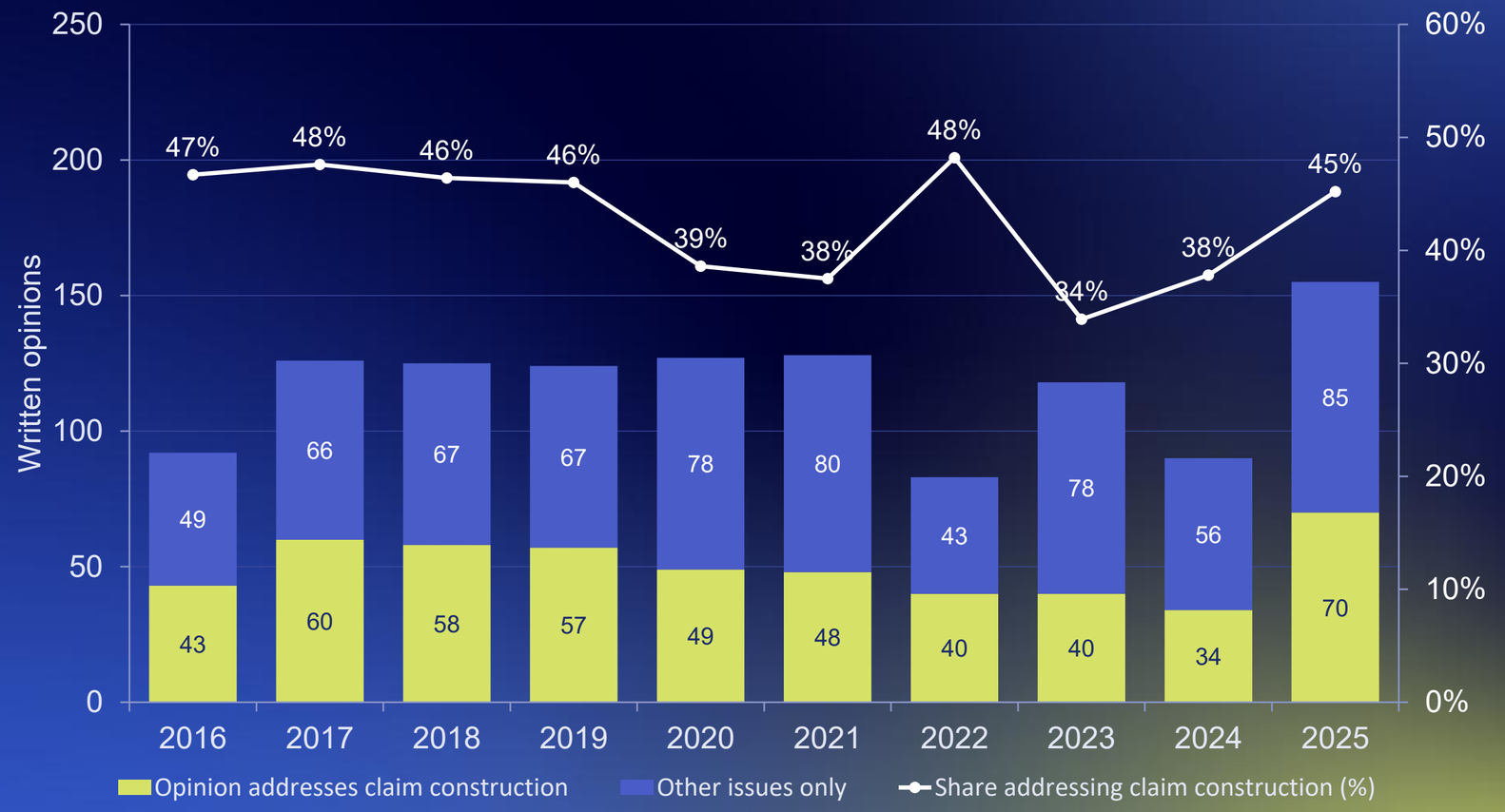
~280–490

district-court patent appeals docketed each year; many end by settlement, dismissal, or Rule 36 without an opinion

Sources: Federal Circuit Opinions & Orders database (origin = district court; full text of every written opinion reviewed by keyword and spot-checked); Lex Machina Patent Litigation Reports 2023 & 2025 (docketed appeals; reversal rate). Excludes Rule 36 summary affirmances, which state no issues. Proxy measure; see notes.

From the PTAB and ITC: claim construction in ~43% of opinions

Federal Circuit written opinions in patent appeals from the PTO (PTAB), ITC and Court of Federal Claims, by year of decision



43%

of 1,168 written opinions in patent appeals from the PTO, ITC and Court of Federal Claims (2016–2025) address claim construction

49%

of IPR, PGR and CBM appeals (413 of 850), the largest group, and 47% of ITC Section 337 appeals (21 of 45)

13% vs. 41%

ex parte appeals from examiner rejections (21 of 163) vs. reexamination appeals (39 of 94)

Source: Federal Circuit Opinions & Orders database (origin = PTO, ITC or CFC; full text of every written opinion reviewed by keyword and spot-checked). Trademark (TTAB) and non-patent appeals excluded. "Broadest reasonable interpretation" counted as claim construction. Excludes about 860 PTO and ITC Rule 36 summary affirmances, which state no issues. Proxy measure; see notes.

Two ways your words cost you, from four sources

TWO WAYS TO LOSE SCOPE

Literal scope

Lexicography and disclaimer

Doctrine of equivalents

Prosecution history estoppel under Festo (III.B)

★ = *chemistry or pharma case* *(nonprec.) = nonprecedential*

FOUR SOURCES OF HARMFUL STATEMENTS

1. **The specification**
   Before anyone is arguing
2. **US prosecution**
   Arguments are amendments
3. **Foreign prosecution**
   The family speaks for you
4. **Litigation and IPR**
   Statements made while fighting

These statements are rarely in the claims, and rarely noticed **until an accused infringer finds them.**

SECTION II

The Specification

Statements made before anyone is arguing

Lexicography: when you are the dictionary

Alnylam v. Moderna ★

Fed. Cir. 2025 — the flagship lexicography case

- A formal **“Definitions”** section defined **“branched alkyl”** which was included in the claims
- Used **quotation marks** and **“refer to”** language
- Qualified by **“unless otherwise specified”**

- **An ambiguous prosecution history will not override a clear definition in the specification.**

HOLDING

- The definition **excluded Moderna’s SM-102 lipid**
- Non-infringement **affirmed**

LESSON

Choose deliberately between “includes” and “refers to.” A definitions section is not boilerplate.

An example inside a definition becomes the definition

Sinorgchem v. ITC ★ Fed. Cir. 2007 · 4-ADPA chemistry

"A 'controlled amount' of protic material **is** an amount up to that which inhibits the reaction…, **e.g., up to about 4% H_2O…"** US'063 at col 4:48-52.

HOLDING

- The "e.g." clause was **part of the definition**
- About 4% water became a **hard ceiling**
- That excluded the patent's **own example (about 10% water)**; no literal infringement (equivalents remanded)

DISSENT (NEWMAN)

"e.g." signals **an example**, not a limit

LESSON

An example placed inside the same sentence that uses "is" and quotation marks can become the definition.

“About”: defined too loosely, or too tightly

DEFINITION FAILED

Merck v. Teva ★

Fed. Cir. 2005 · alendronate

- Merck tried to define **“about 70 mg” as exactly 70 mg**, and failed
- “About” took its **ordinary meaning**
- Claims **obvious** over 40/80 mg weekly doses

VS

DEFINITION TOO TIGHT

General Hospital v. Sienna ★

Fed. Cir. 2018

- The spec’s own definition **capped “about” at ±10%**
- **No disclosed value** fell within it
- Claims **failed written description**

LESSON

Treat “about” as a drafting decision: define it, and test your disclosed values against the definition.

“i.e.” defines, and boilerplate cuts both ways

“I.E.” IS DEFINITIONAL

TF3 v. Tre Milano

2018

- Courts read **“i.e.”** as defining the term

“I.E.” NARROWS

Edwards v. Cook

2009

- **“malleable… ie not resilient”** narrowed the claims

BOILERPLATE BROADENS

ABS Global v. Cytonome

2023 · IPR

- **“a/an means one or more”** broadened the claim **straight into anticipation**

LINKED DEFINITIONS

Kaken v. Iancu ★

2020

- “Nail” includes **surrounding tissue**, so “onychomycosis” almost covered **skin infections**
- The patentee’s **prosecution statement** saved its construction

“The present invention” caps your scope

Forest Labs v. Sigmapharm ★

Fed. Cir. 2019 · asenapine (Saphris)

- Field of invention: it **“relates to a sublingual or buccal pharmaceutical composition”**
- Claim 1 said **nothing** about sublingual or buccal delivery
- Claim 1 was **limited to those formulations anyway**
- Claim read in light of the spec’s “invention relates to” statement.

HOLDING

- Here the limitation **helped the patentee**
- The generics wanted the **broad reading** to support **invalidity**

LESSON

“Present invention” language cuts both ways: it can preserve validity, but it caps infringement scope.

Describing “the invention” narrowly

SciMed

Fed. Cir. 2001 · foundational

- “**All embodiments of the present invention**”
- Disclaimed dual lumens **and barred DOE**

Baxter v. HQ Specialty ★

D.N.J. 2015 · esmolol

- **One** “present invention” sentence
- Limited “osmotic adjusting agent” to **tonicity-adjusting** agents

Techtronic v. ITC; Chewy v. IBM

2019; 2024

- A narrow description of the invention **overrode claim differentiation** (and, in Techtronic, **parent-patent claims**)

Brita v. ITC

2025

- Spec called carbon blocks **“unique”** and disparaged other media
- Became the **invalidity** case against a functional genus claim

Words to avoid: “patent profanity”

“critical” **“necessary”** **“solely”** **“must”**

Source: Finnegan, “Patent Profanity”

Pharmacia & Upjohn v. Mylan ★

1999

- Calling spray-dried lactose **“critical” barred DOE**

Atofina (2006) ★

- **“Solely chromium”** disclaimed mixed catalysts

COUNTERPOINT

Continental Circuits v. Intel

2019

- Permissive wording (**“one technique,” “a way”**) kept the claims broad

Actelion v. Mylan ★: one pH value, two appeals

1 Prosecution

Amendments: **>11** → **>12** → **13**; the last one overcame an **obviousness rejection**

2 2023 appeal

Does “pH of 13 or higher” include **12.5**? Spec used “13” and “13.0” **inconsistently**; “rounding” construction **vacated**

3 2026 appeal

No. 2024-1641 (May 13, 2026). No measurement temperature in spec; **USP default** → pH at **25±2°C**. Mylan **did not infringe**

And equivalents were barred on **two independent grounds** →

Actelion ★: two independent bars to equivalents

BAR 1

Prosecution history estoppel

- The amendment to **“13 or higher”** overcame an **obviousness rejection**
- Lower pH values were **surrendered**

+

BAR 2

Disclosure-dedication

- Spec’s **“preferably”** ranges (**>12; 12.5–13.5**) were disclosed but **never claimed**
- Disclosed alternatives **need not be mutually exclusive** to be dedicated to the public

LESSON

State the measurement conditions, and claim the fallback ranges you disclose.

Drafting numbers: three recommendations

1

Use “about” consistently, and define it

Inconsistent precision invites a construction fight (Actelion)

2

Say whether endpoints are included and excursions tolerated

Otherwise the range may have to be met continuously (Biofer)

3

Define the measure

Mw / Mn / Mp; temperature; method. See Teva v. Sandoz (III.E)

Sources: Goodwin; Finnegan on endpoints

Advantages you tout become claim boundaries

HZNP v. Actavis ★

2019 · Pennsaid

- Under **“consisting essentially of,”** the touted **“better drying time”** was a **basic and novel property**
- The basic and novel properties are limitations that are imported from the specification into the claims.
- The spec’s **two drying tests** gave **inconsistent results** → claims **indefinite**

PPG v. Guardian

1998 · glass chemistry

- Spec never defined a **“material” effect**; jury found iron sulfide’s small **color shift** was material
- **No infringement**

LESSON

Give each touted property one clear test, or avoid “consisting essentially of.”

Separately listed ingredients and steps

Regeneron v. Mylan/Amgen ★

2025 · Eylea

- **“VEGF antagonist”** and **“buffer”** listed **separately** → presumed **distinct components**
- Amgen’s **self-buffering** formulation likely does not infringe; **PI denied**

+

Amgen v. Sandoz ★

2019

- Separate **“washing”** and **“eluting”** steps
- A **one-step, one-solution** process **did not infringe**

LESSON

Say expressly when one ingredient or step can serve two claimed roles.

Silence, “optionally,” and boilerplate

Novartis v. Accord ★

2022 · Gilenya

- Spec **never mentioned a loading dose**
- Negative limitation **failed written description**
- First panel reversed on rehearing

Upsher-Smith v. Pamlab ★

2005

- Art that **“optionally includes”** antioxidants **anticipated** “essentially free of”

Alcon v. Padagis ★

D. Del. 2025

- **“Is generally known”** background statements **bind on obviousness** (see III.B)

CareDx v. Natera ★

D. Del. 2021

- Boilerplate calling techniques **“conventional”** became a **§101 admission**

Pfizer v. Ranbaxy ★

2006 · Lipitor

- Claim 6: **hemicalcium salt** of claim 2’s compound; claim 2 covered **only the acid**
- Invalid under **§112 ¶4**. Carry “**or salts thereof**” through the chain

Edits and translations are part of the record

PROVISIONAL → NONPROVISIONAL DELETIONS

DDR v. Priceline

2024

- Removing **“services”** limited the claim to **goods**
- Incorporation by reference to the Provisional did not save it.

FMC v. Sharda ★

2025 · bifenthrin

- Drafter **deleted the “stability” language**
- Claims could not be limited to stable compositions → PI vacated; **anticipation remanded**

TRANSLATIONS

IBSA v. Teva ★

2020 · Tirosint

- **“Half-liquid,”** a literal rendering of the Italian **“semiliquido,”** was chosen over **“semi-liquid”**
- Claims **indefinite**

SECTION III

US Prosecution

Arguments are amendments

Azurity ★: how a disclaimer is built

Argument

Propylene glycol was **absent**

Declaration

Said **the same**

Reasons for allowance

The examiner **agreed**

RESULT

- A **clear disclaimer** of propylene glycol
- It **bound the continuation**

ATTEMPTED FIX

A later **“for the record” retraction** filed in **another application** had **no effect** (compare Hakim, III.D)

Distinguishing prior art creates disclaimer

Rheox v. Entact ★

Fed. Cir. 2002 · calcium orthophosphate

- After a **final rejection**, cancelled claims reciting **monocalcium orthophosphate** and **TSP**
- And argued its compound was **“substantially water-insoluble”**
- **Both species disclaimed**, even though TSP was a **preferred embodiment**
- Summary judgment of **non-infringement affirmed**

SpeedTrack; Elkay

2021; 1999

- Arguments with **detailed examples** mapped the disclaimed scope, **Elkay: with no amendment**

Genuine Enabling v. Nintendo

2022

- Disclaimer reaches only as far as it is **clear and unmistakable**
- Accused infringers **will try to stretch it**

Festo: amendments and the doctrine of equivalents

Festo v. Shoketsu Kinzoku · U.S. 2002, unanimous

SCOPE

Any narrowing amendment **related to patentability**, including **§112** amendments, can create estoppel

FLEXIBLE BAR

- Complete bar **rejected** (Fed. Cir.)
- Narrowing **presumed to surrender** the territory between original and amended claim

TO REBUT, THE PATENTEE MUST SHOW ONE OF:

1. **Unforeseeable**
   The equivalent was unforeseeable when the amendment was made
2. **Tangential**
   The reason for the amendment was no more than tangential to the equivalent
3. **Other reason**
   Some other reason the patentee could not reasonably have described the substitute

Where the burden came from: Warner-Jenkinson

Warner-Jenkinson v. Hilton Davis

U.S. 1997 · chemistry case cited in Festo

- Applicant added a **pH range of 6.0–9.0** to a **dye-purification** claim
- The file **never recorded why the 6.0 floor was added**
- Saying nothing can also be held against you

HOLDING

- If the reason for an amendment is **not established**, it is **presumed made for patentability**
- The file history is **read against the patentee**

LESSON

Record the reason for each amendment, and keep it narrow so tangentiality stays available.

Equivalents lost during prosecution

Actelion ★

2026

- Amendment to **“pH 13 or higher”** overcame an **obviousness** rejection
- **Tangentiality failed** → lower pH values surrendered

Colibri

2025

- **Cancelling a related claim** was treated as a **narrowing amendment**

Tanabe ★

1997

- No estoppel (pre-Festo), but statements and claim choices left **almost no room** for equivalents

Even **without** estoppel, the specification defines the equivalents test →

Claim a specific reagent, fight uphill on equivalents

Mylan Institutional v. Aurobindo ★ Fed. Cir. 2017 · 857 F.3d 858 · isosulfan blue

CLAIMED

Silver oxide

vs

ACCUSED

Manganese dioxide

HOLDING

- Equivalence based on **“function” alone reversed**
- **“Way”** never analyzed: oxidizing strengths differ; MnO_2 **needs an acid**
- Court suggested **insubstantial differences** may suit chemistry better than FWR (aspirin vs. ibuprofen)

LESSON

When you claim a specific reagent, equivalents are an uphill fight. Claim the genus if the spec supports it.

Equivalents: drafting and prosecution lessons

1

Every narrowing amendment is a surrender

Amend no more than necessary

2

Record a narrow reason for each amendment

Keeps tangentiality available (Warner-Jenkinson)

3

Consider a continuation instead of amending

Pursue broader claims there (Sanofi v. Watson, III.D)

4

Describe each component’s role broadly

And check no working example undercuts that role (Alcon)

Criticality arguments win allowance, then lose the case

ASTRAZENECA v. MYLAN ★ · 2021 · SYMBICORT

Deleted “about”; argued the **“criticality of 0.001% PVP”**

THE CLAIM SHRANK TO

0.00095–0.00104%

Infringement judgment **vacated**. The argument that won allowance later **defeated the infringement case.**

Tanabe Seiyaku v. ITC ★

1997 · diltiazem

- Claimed **only acetone**; told USPTO and foreign offices its **“specific base-solvent combinations”** gave unexpected yields
- **Butanone**, a close homolog, **not equivalent**

Actelion ★

2026

- Unexpected results found **only at pH 13** → amendment → **Festo estoppel**

Rejected arguments, and how to undo a disclaimer

REJECTED, STILL BINDING

Barrette v. Fortress

2025

- Examiner **unpersuaded**; claims cancelled and refiled
- Disclaimer **still applied across the family**

HOW TO RESCIND

Hakim v. Cannon Avent

Fed. Cir. 2007

- Broadening “slit” to “opening” plus a letter: **not enough**
- Tell the examiner the **disclaimer and the art it avoided** may need to be **revisited**

WHAT WORKS

Sanofi v. Watson ★

Fed. Cir. 2017 · dronedarone (Multaq)

- Parent’s proviso (**“no polysorbate surfactant”**) did **not** carry into the continuation
- Sanofi narrowed **by amendment**, not by characterizing the invention

Lesson: narrow with express claim limitations, not characterizations of “the invention.”

Teva v. Sandoz ★: two definitions, one family

’847 PATENT

Weight-average (Mw)

- Defined during an **indefiniteness** rejection
- A **scientifically wrong** argument

≠

’539 PATENT

Peak molecular weight (Mp)

- Defined during an **indefiniteness** rejection
- A **different** measure for the **same** term

HOLDING

The spec never said which measure it meant. Claim 1 of the ’808 patent was held **indefinite**; statements made to win allowance bind **even when scientifically wrong**.

Statements travel across the family, even after issuance

Microsoft v. Multi-Tech; Verizon v. Vonage

2004; 2007

- A **sibling's prosecution** narrowed **already-issued** patents

Immunex v. Sanofi ★

2020

- "Human antibody" **included humanized**
- Spec: "partially human… **preferably** fully human"; family used both terms
- Never corrected the **examiner's statement that "human" and "humanized" were the same.**

Biogen Idec v. GSK ★

Fed. Cir. 2013 · anti-CD20

- Argued **within** the examiner's Rituxan-epitope frame → limited to the **same epitope**
- No need to **"parrot back"** the examiner to be bound by their statements.

THE LIMIT

Maquet v. Abiomed

2025

- Generally applies only to **shared** claim limitations
- **Silence** on reasons for allowance is **not** disclaimer

Procedural traps

SeaChange	2005	One **representative claim** imported its limitation into the **whole group**
Chewy	2024	An appeal brief's **"Summary of Claimed Subject Matter"** supported a narrow reading
Medicines Co. ★	2017	A **Petition to Make Special** helped narrow the claims by defining "the present invention."
Colibri v. Medtronic	2025	Cancelling a related sibling claim → estoppel → **$106M verdict reversed**
SIPCO v. Jasco (W.D. Okla.)	2024	A **one-digit error** in a terminal disclaimer → **unenforceable**

When your words help

UMass v. L’Oréal ★
2022

- Amendment remarks **resolved an ambiguity** in the claims

Kaken ★
2020

- The patentee’s **narrowing argument** rescued its construction **on IPR appeal**

Personalized Media
2020

- **Repeated, consistent** statements defined a term and **reversed the Board’s construction**

Deliberate, consistent statements are a **tool**, not just a risk.

SECTION IV

Foreign Prosecution

The family speaks for you in any language

Foreign statements: considered, but not always relevant

CONSIDERED

Tanabe Seiyaku v. ITC ★

1997 · builds on Caterpillar v. Berco (1983)

- Statements to the **EPO, Finland and Israel**, backed by **comparative data**, “should be considered”
- **Not estoppel**, but they showed butanone was **not interchangeable** with acetone → **no DOE**

VS

NOT RELEVANT

Pfizer v. Ranbaxy ★

2006 · Lipitor

- Foreign statements read “trans” as **“trans-(±)”**
- Irrelevant: they answered **“patentability requirements unique to Danish and European law”**

Foreign statements in practice

Apple v. Motorola

2014 · modern restatement

- **Japan Patent Office** statements narrowed the US claim
- Same spec, **identical claims**; made **after** the US patent issued

Baxter v. HQ Specialty ★

2015

- Patentee's own scientist told the **EPO** "tonicity agent" is **synonymous** with "osmotic-adjusting agent"
- **Used against it** in the US

BOTH DIRECTIONS

Gillette v. Energizer

2005

- The **accused infringer's** EPO argument was a **"blatant admission"** that helped the patentee

New EPO statements, and which ones are dangerous

G 1/24 and G 1/25 (Enlarged Board)

EPO 2025; 2026

- EPO must **always consult the description**; definitions will always be considered
- G 1/25 (2026): adapt the description only for a **real inconsistency**; each adaptation is a **fresh record**

Purpose-limited method claims

T 1931/14; Genentech EP ’302, T 2605/22 ★

- Opposition arguments on whether **a purpose statement limits** the claim and becomes **available in the US**

COORDINATE FOREIGN ASSOCIATES

MOST DANGEROUS

Unexpected-results data and **“specific combination”** arguments (Tanabe)

REVIEW CLOSELY

Substantive statements on a counterpart with the **same spec and claims** (Apple)

LEAST DANGEROUS

Statements forced by **foreign-law formalities** (Pfizer)

SECTION V

Litigation and IPR

Statements made while fighting

IPR statements are prosecution history

Aylus v. Apple

Fed. Cir. 2017 — the foundation

- Statements in an IPR, **including a pre-institution preliminary response**, can create **prosecution disclaimer**
- …then **sank its infringement case**
- “Extending the prosecution disclaimer doctrine to IPR proceedings will ensure that claims are not argued one way in order to maintain their patentability and in a different way against accused infringers.”

THE ASYMMETRY

- **Cupp v. Trend Micro** (2022): disclaimer does **not bind the Board** in the same IPR
- But it **binds later proceedings**

LESSON

You might argue your way out of the prior art in the IPR, but the argument stays on the record.

Limits on IPR disclaimer, and why not to rely on them

Galderma v. Amneal ★

2020 · nonprec. · doxycycline

- IPR statements were **narrow** and limiting
- **No disclaimer**: the Board had **expressly rejected** them
- Disclaimer runs with the patent, not the patent owner.

CONTRAST

Barrette

2025 (III.D)

- Arguments **rejected in prosecution still counted**

Maquet v. Abiomed

2025

- Preliminary-response statements **can** support disclaimer
- These were **too vague**

Don’t rely on Galderma: it is nonprecedential, and Aylus does not require the Board to agree.

Positions carry across proceedings

Sherwin-Williams v. PPG ★

2024 · nonprec. · coatings

- Won a **reexam** argument that prior-art **Perez was BPA-free**
- Created **judicial estoppel** on the **continuation** patents
- Estoppel applied **despite vacatur** of the reexam (not contested)

+

SharkNinja v. iRobot

IPR2020-00863 · PTAB 2021

- iRobot's **Markman slides**, **tech tutorial**, and **continuation claims** contradicted its **IPR position**

LESSON

Every forum's record is available in every other forum. Keep one construction across all of them.

Commitments, experts, and positions that bind you

LITIGATION COMMITMENTS

- **Finjan v. SonicWall** (2023): a **stipulated construction**
- **Biofer** ★ (2026, nonprec.): **forfeiture** after arguing the opposite below

YOUR OWN EXPERTS

- **DyStar** ★ (dye chemistry): expert's **skill-level** testimony
- **Magnolia** (2026): expert's description made a term **means-plus-function**

BROAD FOR INFRINGEMENT, NARROW FOR VALIDITY

- **In re Entresto** ★ (2025; cert. denied): **PTE** and litigation positions argued a broad "administer in combination" for the API.
- Triggered a **§112 fight**; Novartis **won on appeal**

PETITIONERS TOO

- PTAB denies institution under **Rule 42.104(b)(3)** when a petitioner's positions **conflict with its district-court constructions**

SECTION VI

Takeaways

Drafting and prosecution checklist

Checklist: the specification

Spec

- Define key terms deliberately (**“includes” vs. “refers to”**); keep **“e.g.”** out of definitions
- Avoid **“the present invention,” “critical,” “unique”**
- Give **several embodiments** of every key process term; describe any **exclusion** you may need

Numbers

- Consistent precision; define **“about,” endpoints, excursions**
- State **measurement conditions** (temperature, method, Mw/Mn/Mp)
- **Claim the fallback ranges** you disclose, or they may be dedicated

Formulations

- Say when one ingredient can serve **two claimed roles**
- Carry **“or salts thereof”** through dependent claims
- Avoid **“consisting essentially of”** unless each touted property has **one clear test**

Checklist: prosecution, family, and litigation

Prosecution

- Every narrowing amendment is a **Festo surrender**: amend minimally, record a **narrow reason**
- Distinguish art narrowly; prefer **express amendments** to characterizing “the invention”
- **Argue claims separately**
- **Dispute** examiner characterizations; **rebut** reasons for allowance
- Weigh **criticality** arguments against infringement scope

Family and foreign

- **One definition** of each term across every family member
- Review **foreign responses** as if they were US arguments
- **Rescind disclaimers expressly** (the Hakim statement)

Litigation and IPR

- Treat every IPR paper, **including the preliminary response**, as prosecution history
- Keep **one construction** across all forums

The four sources are not the whole list

Post-grant USPTO proceedings

- **Reexam, reissue, and supplemental exam** statements are prosecution history (Krippelz v. Ford, 2012)
- **Interference and derivation** arguments about the count

Other forums and prior rulings

- **Earlier constructions** can bind through issue preclusion (e.Digital v. Futurewei, 2014)
- **ITC 337** positions, and **judicial estoppel** from any earlier case

Regulatory filings ★

- **FDA submissions, labeling, and Orange Book** listings that describe what the patent covers
- **EPA, FCC, and other agency** filings about the product

Standards and licensing

- **SEP declarations** and standards-body submissions
- **Notice letters, licensing talks,** and infringement contentions

Marketing and the inventor

- **Product literature, press releases,** websites, and investor statements
- **Inventor papers, talks, and testimony**: discoverable; inventor testimony gets little weight (Howmedica, 2008)

The record you didn’t write

- **Prior art cited on the patent** is intrinsic evidence (V-Formation v. Benetton, 2005)
- **Dictionaries, treatises, and industry usage** (Phillips)

The words that will hurt you are seldom in the claims.

slwip.com

Thank you

Questions and discussion

Schwegman Lundberg & Woessner