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## *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.:* Confirmation That Claim Construction Is the Duty of the Court

IN *O2 MICRO INTERNATIONAL LTD. V. BEYOND INNOVATION TECHNOLOGY CO.*,<sup>1</sup> the Court of Appeals for the Federal Circuit clarified when a court is required to construe seemingly ordinary patent claim terms.<sup>2</sup> The *O2 Micro* district court had refused to interpret the terms “only if” and instead allowed the terms to go to the jury without any instruction from the court. The jury found that the defendant had infringed, and the judge issued an injunction.<sup>3</sup> The Federal Circuit held that the district court erred because a court is required to construe terms when either: 1) the terms have more than one ordinary meaning; or 2) failure to define the terms does not settle the parties’ dispute.<sup>4</sup> The Federal Circuit reversed the district court’s decision and remanded the case so that the terms “only if” could be construed before being presented before a jury.<sup>5</sup> In doing so, the Federal Circuit properly reaffirmed the court’s duty to construe terms, even if they are seemingly ordinary terms.<sup>6</sup> Although the issue of district courts’ local rules was not addressed by the Federal Circuit, this decision should ensure that local rules meant to reduce the number of terms construed are not merely arbitrary decisions, and that the lower courts construe terms in a manner that properly protects the patentee’s rights.<sup>7</sup>

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1. 521 F.3d 1351 (Fed. Cir. 2008).
2. *Id.*; see also *infra* Part III.
3. *O2 Micro*, 521 F.3d at 1358.
4. *Id.* at 1361.
5. *Id.* at 1366.
6. See *infra* Part IV.
7. See *infra* Part IV.C.

## I. THE CASE

O2 Micro owned three patents<sup>8</sup> directed to inverter controllers (“ICs”).<sup>9</sup> ICs convert low voltage direct current (“DC”) to high voltage alternating current (“AC”).<sup>10</sup> ICs are often used to convert a laptop battery’s DC current to AC for lamps that back-light laptop screens.<sup>11</sup> During prosecution of the patents, O2 Micro added the words “only if” to many of their claims to overcome a rejection by the United States Patent and Trademark Office (“PTO”).<sup>12</sup> Thus, the claims that were finally patented stated that O2 Micro claimed ICs comprising a feedback loop that controls the circuit’s switches “‘only if said feedback signal is above a predetermined threshold.’”<sup>13</sup>

Beyond Innovation Technologies (“BiTEK”) produced and sold four types of ICs accused of infringing O2 Micro’s patents.<sup>14</sup> The feedback loops on all four of BiTEK’s devices controlled the circuit while the lamp was powering up and before the feedback signal had reached the predetermined threshold.<sup>15</sup> Additionally, one of BiTEK’s ICs also had a feedback loop that controlled the circuit if the power dropped below the threshold level for less than thirty-two microseconds.<sup>16</sup>

O2 Micro filed suit against BiTEK in the U.S. District Court for the Eastern District of Texas, Judge Ward presiding, accusing BiTEK’s devices of infringing on O2 Micro’s patents.<sup>17</sup> The construction of the terms “only if” was the main dispute in the lower court.<sup>18</sup> O2 Micro, advocating a liberal interpretation of “only if,” argued that a person of ordinary skill in the art would know that “only if” only applied to steady state operation, so BiTEK’s devices infringed.<sup>19</sup> The defendants, attempting to convince the court to adopt a strict interpretation of the terms, argued that “only if” should be construed by the court to mean “exclusively or solely

8. O2 Micro owns U.S. Patent No. 6,259,615 (filed Nov. 9, 1999); U.S. Patent No. 6,396,822 (filed July 13, 1998); and U.S. Patent No. 6,804,129 (filed Feb. 11, 2004). *O2 Micro*, 521 F.3d at 1354. All patents can be found using the U.S. Patent and Trademark Office’s Patent Information Retrieval System, available at <http://portal.uspto.gov/external/portal/pair>.

9. *O2 Micro*, 521 F.3d at 1354.

10. *Id.*

11. *Id.*

12. *Id.* at 1355–56; *see also infra* note 108 (discussing the significance of this addition).

13. *O2 Micro*, 521 F.3d at 1356; *see also infra* note 108 (discussing the significance of this addition).

14. *O2 Micro*, 521 F.3d at 1356.

15. *Id.* at 1356–57.

16. *Id.* at 1357.

17. *Id.* at 1354, 1356.

18. *See infra* Part III; *see also infra* notes 106–08 (discussing the other issues reviewed by the Federal Circuit).

19. *O2 Micro*, 521 F.3d at 1360.

in the event that”<sup>20</sup> or “never except when.”<sup>21</sup> BiTEK argued that since the feedback loops in its devices operated at other times, its devices did not infringe.<sup>22</sup>

At the *Markman* hearing,<sup>23</sup> the district court did not agree with either interpretation of the words “only if,” finding that the words did not need construction because they had “‘a well-understood definition, capable of application by . . . the jury.’”<sup>24</sup> The jury instructions allowed the jurors to construe “only if” for themselves, without objection from BiTEK.<sup>25</sup> The jury was further instructed that they could find BiTEK either directly infringed, or infringed under the doctrine of equivalents.<sup>26</sup> The jury found BiTEK was infringing, and Judge Ward granted O2 Micro a permanent injunction against BiTEK.<sup>27</sup> BiTEK appealed the decision to the Federal Circuit, Judges Lourie, Clevenger, and Prost presiding.<sup>28</sup>

## II. LEGAL BACKGROUND

### A. *A Primer on Patent Litigation*

The Framers included patents in the Constitution in order to encourage inventors to share their inventions with the world.<sup>29</sup> In return, the patentee is granted the right to exclude others from using his invention for 20 years.<sup>30</sup> A patentee files an

20. *Id.* at 1357. Using this construction, the patents cover only circuits with feedback loops that would exclusively operate the circuit when the threshold power level is met or that would operate the circuit solely in the event that the threshold power level is met. *Id.* at 1356–57.

21. *Id.* at 1357. BiTEK’s co-defendant, SPI/FSP, proposed this construction, which would mean that the patents covered only circuits with feedback loops that would never operate the circuit except when the threshold power level is met. *Id.* at 1356–57.

22. *Id.*

23. A *Markman* hearing is held in a patent case before the jury instructions go to the jury to construe disputed terms. *See infra* text accompanying notes 39–45 (providing an explanation of *Markman* hearings).

24. *O2 Micro*, 521 F.3d at 1357.

25. *Id.* at 1357–58; *see also infra* note 106 (discussing the importance of BiTEK’s failure to object).

26. *O2 Micro*, 521 F.3d at 1358; *see also infra* note 108 (discussing the importance of the decision to allow the jury to consider infringement under the doctrine of equivalents).

27. *O2 Micro*, 521 F.3d at 1354.

28. *Id.*

29. The Constitution originally recognized the power of patents “[t]o promote the Progress of Science and useful Arts.” U.S. CONST. art. I, § 8, cl. 8. In the past several decades, the Supreme Court has reiterated many times the philosophy that a patent is “a reward, an inducement, to bring forth new knowledge.” *See Graham v. John Deere Co.*, 383 U.S. 1, 9 (1966); *see also Bonito Boats, Inc. v. Thunder Craft Boats, Inc.* 489 U.S. 141, 146 (1989) (“The Patent Clause itself reflects a balance between the need to encourage innovation and the avoidance of monopolies . . . [to promote] the ‘Progress of Science and useful Arts.’”); *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979) (“[P]atent law seeks to foster and reward invention; . . . promotes disclosure of inventions . . . [and] the stringent requirements for patent protection seek to assure that ideas in the public domain remain there for the free use of the public.”); *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480 (1974) (“The patent laws . . . have a positive effect on society through the introduction of new products and processes of manufacture into the economy.”); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 229–31 (1964) (indicating that patents are meant to encourage invention by rewarding the inventor with the right “to exclude others from the use of his invention” for a time using uniform federal standards “to promote invention while at the same time preserving free competition”).

30. 35 U.S.C. § 154(a)(1–2) (2006) (“Every patent shall contain . . . a grant to the patentee . . . of the right to exclude others from making, using, offering for sale, or selling the invention. . . . [S]uch grant shall be for a

application with the PTO describing his new invention and listing what the patentee is actually claiming.<sup>31</sup> A PTO examiner reviews the application to ensure that every listed claim is useful, novel, and non-obvious.<sup>32</sup> The examiner often rejects some or all of the claims.<sup>33</sup> The patentee can then amend the claims to avoid rejection by disclaiming some part of the original claim so that the amended claim is entirely useful, novel, and non-obvious.<sup>34</sup> A patent is then issued only for those final claims.<sup>35</sup>

Once a patent is issued, if the patentee finds that someone else is practicing his patent, the patentee can sue that person for infringement.<sup>36</sup> The suit is filed in a federal district court, seeking an injunction, monetary damages, or both.<sup>37</sup> An infringement dispute often turns on the definition of certain terms used in the claims; if a term is defined the plaintiff's way, the claim covers the device and the defendant is infringing; if defined the defendant's way, the claimed invention and the device are two separate devices, and the defendant is not infringing.<sup>38</sup> To define terms, the district court will hold a *Markman* hearing,<sup>39</sup> usually before the start of the trial.<sup>40</sup> All term construction must be completed before the jury receives its instructions.<sup>41</sup> Local rules determine the form of the *Markman* hearing.<sup>42</sup> Several courts have instituted different ways to limit the number of terms they will con-

term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed . . . .").

31. 35 U.S.C. §§ 2, 101.

32. CRAIG ALLEN NARD, *THE LAW OF PATENTS* 38 (2008); see also 35 U.S.C. § 131.

33. NARD, *supra* note 32, at 38; see also 35 U.S.C. § 132(a).

34. See generally Rajiv P. Patel, *An Introduction to U.S. Patent Prosecution*, in *FUNDAMENTALS PAT. PROSECUTION* 2007, at 161, 170–72 (PLI Pat., Copyrights, Trademarks, and Literary Prop., Course Handbook Series No. 11260, 2007) (describing the possible rejections patent examiners can give a patent application).

35. 35 U.S.C. § 151.

36. *Id.* § 281.

37. NARD, *supra* note 32, at 787; see also *id.* § 281.

38. See Cheryl Lee Johnson, *The Continuing Inability of Judges to Pass Their Markman Tests: Why the Broken System Leaves Judges Behind, Confused and Demoralized*, in *MARKMAN HEARINGS & CLAIM CONSTR. IN PATENT LITIG.* 2008, at 65, 75–76, 126–27 (PLI Intellectual Prop., Course Handbook Series No. G-941, 2008) (explaining why claim construction, defining the scope of what the patentee deems as his invention, is so important in patent law cases and also noting that once claim construction has taken place, many cases can be decided by summary judgment).

39. See generally Johnson, *supra* note 38 (explaining the recent history of claim construction and how the Supreme Court's decision in *Markman* led to the requirement of a *Markman* hearing).

40. *Id.* at 125 ("A 2002 survey of the ABA's Intellectual Property Law section found claim construction in 78% of cases was performed after discovery but before trial . . . . Three years earlier, another ABA survey found most claim construction rulings (58%) occur after discovery but before trial . . . ."); see also Julie A. Petruzzelli, *Before the Markman Hearing—Discovery, Timing, Alternatives and Challenges in Multi-Party Cases*, in *HOW TO PREPARE & CONDUCT MARKMAN HEARINGS* 2007, at 77, 90–91 (PLI Intellectual Prop., Course Handbook Series No. G-907, 2007) ("[C]ourts may choose to construe the claims: (1) before the close of fact discovery; (2) in the context of a motion for a preliminary injunction; (3) at the end of all discovery; (4) in the context of summary judgment; or (5) following trial, prior to jury instructions. . . . Of course, local rules or practices may limit the options which are available.").

41. Johnson, *supra* note 38, at 124–25 & n.294.

42. Petruzzelli, *supra* note 40, at 90–91.

strue, including straightforward numerical limitations and less obvious time limitations on the *Markman* hearing.<sup>43</sup>

Once the terms are construed, the case can move forward and the jury receives instructions that include the court's construction of the terms.<sup>44</sup> All appeals of the verdict are heard by the Court of Appeals for the Federal Circuit.<sup>45</sup> The Federal Circuit's decision is normally the final decision.<sup>46</sup>

Prior to *O2 Micro*, two competing doctrines existed regarding the construction of claim terms.<sup>47</sup> The *Markman* doctrine held that construction is a matter of law and so judges must construe all terms for the jury.<sup>48</sup> The *Phillips* doctrine held that ordinary terms need no special construction.<sup>49</sup> The line that divided claim terms into ordinary and non-ordinary was not clearly drawn, so many courts had difficulty determining which terms needed to be construed and which did not.<sup>50</sup> A brief review of the *Markman* and *Phillips*, and *Elekta Instrument*<sup>51</sup>—relied on by the district court—cases illuminates the reasoning behind each of these doctrines.<sup>52</sup>

43. Johnson, *supra* note 38, at 125. (“[S]ome individual judges have increasingly refused to construe more than a handful of terms and/or have set strict time limits on the hearings. . . . Whether these judicial practices are lawful or deny due process has not been thoroughly vetted.” (footnote omitted)). Some district courts’ local rules also incorporate time constraints or limits on the number of terms the court will review. *See, e.g.*, N.D. CAL. PAT. R. 4-1(b), 4-3(c), available at <http://www.cand.uscourts.gov>, (follow “Local Rules Changes—Effective 12/01/09” hyperlink; then follow “Local Rules 12-09.pdf” hyperlink) (requiring the parties to limit the *Markman* hearing to “the 10 terms likely to be most significant to resolving the parties’ dispute”); *see also* Johnson, *supra* note 38, at 106 n.207 (listing courts with similar local rules).

44. *See* Johnson, *supra* note 38, at 124 n.294 (noting that the only deadline for the construction of terms is that it occur before the jury receives its instructions because the jury must be told what the claims mean).

45. 28 U.S.C. § 1295 (2006) (noting the Federal Circuit’s exclusive jurisdiction over patent appeals). Congress granted it jurisdiction to hear patent appeals originally to create uniformity in patent decisions. Robert P. Taylor, *Patent Law in Flux: Echoes of the Supreme Court*, in 14TH ANNUAL INST. ON INTELLECTUAL PROP. LAW, at 93, 98–99 (PLI Intellectual Prop., Course Handbook Series No. G-947, 2008) (“Congress established the Federal Circuit in 1982 to effect a widely perceived need for more consistent application of federal patent law. At the time, the regional circuit courts of appeals varied widely in their handling of patent disputes, often leading to a race to the courthouse in important cases.” (footnote omitted)).

46. Until recently, the Supreme Court rarely reviewed patent cases. *See* Robin L. McGrath, *Recent Developments in Patent Law and Its Impact on Patent Litigation*, in PATENT LITIG. 2008, at 95, 99 (PLI Intellectual Prop., Course Handbook Series No. 14977, 2008) (“Without question, the Supreme Court has been much more active lately in the patent arena, addressing no less than five patent-related decisions in the last three terms alone. In each of these instances, the Supreme Court has reversed the Federal Circuit, in some cases overruling long standing Federal Circuit doctrines.”).

47. *See infra* Parts II.B–C.

48. *See infra* Part II.B; *see also* *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996).

49. 415 F.3d 1303, 1314 (Fed. Cir. 2005); *see also infra* Part II.C.

50. *See, e.g., infra* notes 85–86.

51. *Elekta Instrument S.A. v. O.U.R. Scientific Int’l, Inc.*, 214 F.3d 1302 (Fed. Cir. 2000); *see also infra* Part II.D.

52. *See infra* Parts II.B–D.

## B. Markman: Claim Construction Is a Matter of Law

In *Markman v. Westview Instruments, Inc.*,<sup>53</sup> the Supreme Court of the United States reviewed a case between Markman, the holder of reissue patent 33,054<sup>54</sup> claiming a method of inventory control for a dry-cleaning business, and Westview Instruments ("Westview"), which used an inventory control method accused of infringing Markman's patent.<sup>55</sup> Markman's system would tag dry-cleaning items with barcodes, and then employees could scan the articles of clothing, called "inventory" in the patent, with a scanner as the clothes went through the process of being dry-cleaned.<sup>56</sup> Westview's system maintained an inventory of receivables by tracking and recording invoices and transaction totals.<sup>57</sup> Markman argued that "inventory" could mean both "cash inventory and actually physical inventory of articles of clothing."<sup>58</sup> Westview argued that "inventory" as Markman used it only referred to articles of clothing, so their device, which tracked invoices and could not track clothing, did not infringe.<sup>59</sup> The case was submitted to the jury without judicial construction of the term "inventory," and the jury found for Markman.<sup>60</sup> However, the district court entered a directed verdict and found for Westview.<sup>61</sup>

Markman appealed, arguing that the directed verdict was an improper substitution of the court's construction of the term over the jury's construction of the term.<sup>62</sup> The Federal Circuit reviewed Markman's Seventh Amendment right to a trial by jury and held that "the interpretation of claim terms [is] . . . the exclusive province of the court and the Seventh Amendment [is] consistent with that conclusion."<sup>63</sup>

The Supreme Court granted certiorari and applied several different tests before affirming the Federal Circuit's decision.<sup>64</sup> Because patent cases had traditionally been tried before a jury, the drafters of the Seventh Amendment may have intended to extend the right to a trial by jury to patent cases as a whole.<sup>65</sup> However, the Supreme Court needed to take the analysis a step further to determine if every part of a patent case had to go to the jury or if particular issues within a patent case

53. 517 U.S. 370 (1996).

54. U.S. Reissue Patent No. 33,054 (filed Aug. 28, 1987).

55. *Markman*, 517 U.S. at 374-75.

56. *Id.* at 374.

57. *Id.* at 375.

58. *Id.* (quoting *Markman v. Westview Instruments, Inc.*, 772 F. Supp. 1535, 1537-38 (E.D. Pa. 1991)).

59. *Id.*

60. *Id.*

61. *Id.*

62. *Id.* at 376 ("The Seventh Amendment provides that '[i]n Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved . . .'" (citing U.S. CONST. amend. VII)).

63. *Id.* (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995)).

64. *Id.* at 376, 384, 388-90 (describing the analysis the Court applied).

65. *Id.* at 376-77.

could be decided by the court.<sup>66</sup> The Court reasoned that a portion of a patent law case must be tried by a jury if: 1) historically, a jury decided claim construction in order “to preserve the ‘substance of the common-law right of trial by jury;’”<sup>67</sup> 2) the question is one of fact, which is the province of the jury;<sup>68</sup> or, 3) functional considerations indicate that a jury would be better suited to determining the meaning of claim terms.<sup>69</sup>

Regarding the common-law right to a trial by jury, at the time that the Seventh Amendment was passed, claims as they are today did not exist.<sup>70</sup> When the Seventh Amendment was passed, the patentee only submitted a specification explaining what he believed was his invention and did not include a separate list of claims.<sup>71</sup> Additionally, very few cases from that period dealt with patent law in general, much less the issue of whether a patentee had a right to jury construction of terms.<sup>72</sup> Therefore, the historical record was too paltry to support the notion that patentees had a common-law right to jury-construction of terms.<sup>73</sup>

Regarding the question of fact, the Court determined that claim construction was a question of law and was rightfully decided by the judge for several reasons.<sup>74</sup> First, the Court had consistently ruled that construing the claims as written in the patent was the province of the court; the court’s role did not remove the role of the jury because the jury would still determine the character of the thing invented as compared to what was claimed on the patent.<sup>75</sup> Second, a patent is a legal instrument, and as such, the duty of interpreting it falls to the court.<sup>76</sup> Therefore, the question of fact analysis also indicated that patentees did not have a right to claim construction by juries.<sup>77</sup>

Finally, regarding the functional considerations, the court found several more reasons why a judge would be better suited to construe claims than a jury.<sup>78</sup> First, a judge is more familiar with construing written instruments, so he is presumably better at understanding legal documents than jurors.<sup>79</sup> Second, more specifically, a judge is more familiar with construing patent terms, which are often very technical, and the training judges gain by virtue of their jobs would make them better pre-

66. *Id.* at 377.

67. *Id.* (quoting *Tull v. United States*, 481 U.S. 412, 426 (1987)).

68. *Id.* at 384–85.

69. *Id.* at 388.

70. *Id.* at 378–79.

71. *Id.* at 379. A patent’s specification is the “full description of the invention and its operation which would show the scope of the patent.” NARD, *supra* note 32, at 13 (footnote omitted).

72. *Markman*, 517 U.S. at 379–80.

73. *Id.* at 381–82.

74. *Id.* at 384–88.

75. *Id.* at 386–87.

76. *Id.* at 388.

77. *Id.* at 384–88.

78. *Id.* at 388–91.

79. *Id.* at 388.



pared than jury members to construe claims properly.<sup>80</sup> Third, allowing judges to construe terms can lead to uniformity in treatment that cannot be obtained using juries.<sup>81</sup> Considering these reasons, the Court found that functional considerations did not indicate that juries should be in charge of claim term construction.<sup>82</sup>

Therefore, the Supreme Court agreed that claim construction is a matter of law, which is rightfully the province of the court.<sup>83</sup> The *Markman* case led to a change in patent law litigation; after *Markman*, courts began having *Markman* hearings to construe terms before the decision was sent to the jury.<sup>84</sup> Many courts began construing seemingly ordinary terms to comply with the *Markman* rule.<sup>85</sup>

### C. Phillips Decision: Ordinary Terms Need No Construction

Even though *Markman* required judges to construe terms, some courts still refused to construe every single term before them.<sup>86</sup> These courts often relied on the reasoning behind *Phillips v. AWH Corp.*,<sup>87</sup> a later case where the Federal Circuit stated that “[i]n some cases, the ordinary meaning of claim language . . . may be readily apparent even to lay judges, and claim construction in such cases involves little more than the application of the widely accepted meaning of commonly understood words.”<sup>88</sup>

In *Phillips*, Edward Phillips owned patent 4,677,798,<sup>89</sup> which covered steel-shell panels with baffles that would make a very strong wall when welded together.<sup>90</sup> Phillips originally entered into a deal with AWH to sell the panels, but after that deal ended in 1990, Phillips accused AWH of continuing to practice his patent without his permission.<sup>91</sup> AWH said they were not infringing on Phillips’ patent because the baffles on their panels were all perpendicular to the panels, and the baffles in Phillips’ patent were at angles other than 90°. <sup>92</sup> The patent claims all stated merely the word “baffles” without any further angular restrictions, and no

80. *Id.* at 388–89.

81. *Id.* at 390–91.

82. *Id.* at 391.

83. *Id.*

84. See Johnson, *supra* note 38, at 126.

85. See, e.g., *Nystrom v. TREX Co.*, 424 F.3d 1136, 1141–46 (Fed. Cir. 2005) (affirming the lower court’s construction of the term “board”); *Unitherm Food Sys., Inc. v. Swift-Eckrich, Inc.*, 375 F.3d 1341, 1350–52 (Fed. Cir. 2004) (affirming the lower court’s construction of “golden-brown”), *rev’d on other grounds*, 546 U.S. 394 (2006).

86. See, e.g., *Biotec Biologische Naturverpackungen GmbH & Co. KG v. Biocorp, Inc.*, 249 F.3d 1341, 1349 (Fed. Cir. 2001) (finding that “melting” needs no construction); *Mentor H/S, Inc. v. Med. Device Alliance, Inc.*, 244 F.3d 1365, 1380 (Fed. Cir. 2001) (finding that the district court did not need to construe “irrigating” and “frictional heat”).

87. 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

88. *Id.* at 1314.

89. U.S. Patent No. 4,677,798 (filed Apr. 14, 1986).

90. *Phillips*, 415 F.3d at 1309.

91. *Id.*

92. *Id.* at 1310.

special angle for “baffles” was expressed in the rest of the specification.<sup>93</sup> Therefore, the court needed to define the term “baffles” using its common and ordinary meaning and not construe it in the way urged by AWH.<sup>94</sup> Using the plain and ordinary meaning of baffles, which does not have an angular restriction, the Federal Circuit reversed summary judgment and remanded for further proceedings consistent with the proper construction of “baffles.”<sup>95</sup> Thus, judges began relying on *Phillips* and its progeny in order to forego construing terms when their plain and ordinary meanings were sufficient to understanding what the patentee has claimed, despite the holding in *Markman*.<sup>96</sup>

#### D. *Elekta Decision: Courts Do Not Have to Construe Ordinary Terms*

The Federal Circuit in *Elekta Instrument v. O.U.R. Scientific International, Inc.*<sup>97</sup> went even further to say that if a patentee wanted to be his own lexicographer, the patent’s specification must clearly redefine the term; however, “[a]bsent an express intent to impart a novel meaning, claim terms take on their ordinary meaning.”<sup>98</sup>

Elekta Instrument owned patent 4,780,898 for a machine used to treat patients with brain cancer by focusing gamma radiation on their tumors and destroying the malignant growths.<sup>99</sup> Their claims included the limitation that the radiation beam channels would be placed on the machine “only within a zone extending between latitudes 30°–45°.”<sup>100</sup> O.U.R. Scientific said that they were not infringing on Elekta’s patent because their machine had the radiation beam channels within a zone that ranged from 14°–43°.<sup>101</sup> They further argued that because the Elekta patent’s machine “only” had beam channels between 30°–45°, their machine was not covered by the Elekta patent and they were not infringing.<sup>102</sup> The Federal Circuit agreed that “only” had an ordinary meaning of “solely” or “exclusively,” and, without any clear indication in the patent that the term “only” had a special meaning, the court was required to apply the plain and ordinary meaning of “only.”<sup>103</sup> Therefore, the dis-

93. *Id.* at 1324–28.

94. *Id.* at 1328.

95. *Id.*

96. See, e.g., *supra* note 85 and accompanying text; see also, e.g., *Appelra Corp. v. MicrosMass, UK Ltd.*, 186 F. Supp. 2d 487, 524, 526 (D. Del. 2002) (finding that “maintain,” “maintaining,” and “whereby” did not need to be construed because their meanings were “self-evident”); *Multimedia Patent Trust v. Microsoft Corp.*, 2008 WL 4975873, at \*1 (S.D. Cal. July 23, 2008) (*Markman* order holding that “encoder,” “encoder output signals,” “applied next frame signals,” and several other terms did not need to be construed, even when the two parties disagreed on the meaning of those terms); *Vision Advancement, L.L.C. v. Vistakon*, 2007 WL 275572, at \*13 (E.D. Tex. Jan. 26, 2007) (finding that “continuously” needed no construction because the term could be given its “plain and ordinary [meaning]”).

97. 214 F.3d 1302 (Fed. Cir. 2000).

98. *Id.* at 1307.

99. *Id.* at 1304.

100. *Id.*

101. *Id.*

102. *Id.* at 1306.

103. *Id.* at 1307.

strict court erred by granting Elekta's summary judgment motion for infringement and the case was remanded for further proceedings, a decision the Federal Circuit described as tantamount to granting O.U.R. Scientific's motion for summary judgment for non-infringement.<sup>104</sup>

### III. THE COURT'S REASONING

The main issue considered by the Federal Circuit in *O2 Micro* was whether the lower court erred in failing to construe the terms "only if."<sup>105</sup> The Federal Circuit considered three other issues, finding that: 1) if an issue has been fully litigated earlier in the trial, a party does not need to continue to object throughout the rest of the trial to preserve the issue for appeal;<sup>106</sup> 2) arguments can be added at the appellate level if they refer to the same claim construction dispute;<sup>107</sup> and, 3) a jury cannot consider infringement under the Doctrine of Equivalents when a patentee has not rebutted the *Festo* presumption.<sup>108</sup> However, these other three issues are relatively straightforward applications of already-existing standards;<sup>109</sup> only the court's decision involving claim construction of ordinary terms created new law.<sup>110</sup>

Regarding the claims construction issue, the Federal Circuit found the lower court's refusal to construe the terms to be in error because, although "*Elekta Instrument* may not require the court to construe ["only if,"] *Markman* does."<sup>111</sup> The Federal Circuit noted that claim construction is an attempt to define the scope of the patent and, because it is a matter of law, it should be decided by the court.<sup>112</sup> The court will generally give terms their "ordinary and customary" meaning as

104. *Id.* at 1309.

105. *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1360–63 (Fed. Cir. 2008).

106. *Id.* at 1358–59. BiTEK's failure to object to the jury instruction did not fail to preserve their right to appeal the issue to the Federal Circuit. *Id.* Since the claim construction had been fully litigated at the *Markman* hearing and the lower court had given no indication that it would deviate from that decision, BiTEK did not need to present further objections to preserve the issue for appeal. *Id.* at 1359.

107. *Id.* at 1359–60. BiTEK was allowed to present a new construction of the terms "only if" to the Federal Circuit because this was not a precluded new issue. *Id.* Because the new construction was merely a new argument in support of the same construction issue and the opposing party had adequate notice of the argument, the Federal Circuit agreed to entertain BiTEK's new construction proposal. *Id.*

108. *Id.* at 1363–66. The Federal Circuit found that the lower court erred in allowing the jury to consider infringement under the doctrine of equivalents. *Id.* at 1566. *O2 Micro* added "only if" during prosecution to overcome a rejection based on prior art. *Id.* This led to the presumption that the terms "only if" disclaimed circuits that had limitations similar to the prior art it was attempting to overcome. *Id.* Since *O2 Micro* did not overcome that presumption, the judge erred in allowing the jury to consider the doctrine of equivalents to find infringement. *Id.*

109. See *id.*; see also *supra* notes 106–08.

110. Previously, there had been no clear standard as to when courts needed to construe ordinary terms. See, e.g., *infra* notes 115–16. The *O2 Micro* case is an attempt to clarify the standard. See *O2 Micro*, 521 F.3d at 1361 (clarifying that while the Federal Circuit's previous case *Elekta Instrument* did not require construction, its *Markman* decision did require the court to construe the terms "only if").

111. *O2 Micro*, 521 F.3d at 1361.

112. *Id.* at 1360 (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996)).

determined by a person of ordinary skill in the art who has reviewed the intrinsic record.<sup>113</sup> In an attempt to avoid the flood of disputed terms that would come in future cases, the Federal Circuit did note that sometimes terms are so ordinary that the term needs no special construction by the court.<sup>114</sup> In addition, the Federal Circuit noted that there were many cases that have construed seemingly obvious claim terms,<sup>115</sup> but there were also many other cases that show that a court does not need to “parse the meaning of every word in the asserted claims.”<sup>116</sup> The issue before the Federal Circuit in *O2 Micro* was how to tell the two types of cases apart—how a judge is supposed to know when a term is ordinary but still needs construction.<sup>117</sup>

The Federal Circuit held that even if a term has an ordinary meaning, the court may still need to construe that term if it has “more than one ‘ordinary’ meaning or when reliance on a term’s ‘ordinary’ meaning does not resolve the parties’ dispute.”<sup>118</sup> In the instant case, the Federal Circuit held that *O2 Micro* and *BiTEK* were not arguing over the “meaning” of the terms “only if,” but instead were arguing over the scope of the claim when the ordinary meaning of “only if” was applied to the claims.<sup>119</sup> Since reliance on the term’s ‘ordinary’ meaning did not resolve the parties’ dispute because the parties still argued over the scope of the claims, and since claim scope is a matter of law, the district court in *O2 Micro* erred by not construing the claims for the jury.<sup>120</sup> The Federal Circuit vacated both the jury decision and the subsequent injunction against *BiTEK*, remanding the case for further construction of the terms “only if.”<sup>121</sup>

#### IV. ANALYSIS

In *O2 Micro International Ltd. v. Beyond Innovation Technology*, the Federal Circuit held that courts must construe ordinary terms when the parties are actually arguing over the scope of the claim and not just the meaning of the term.<sup>122</sup> To help lower courts determine when the argument is actually about scope, the Federal Circuit suggested that the courts consider whether the term has more than one

113. *Id.*

114. *Id.* at 1362.

115. See, e.g., *Nystrom v. TREX Co.*, 424 F.3d 1136, 1141–46 (Fed. Cir. 2005) (“board” needs construction); *Unitherm Food Sys., Inc. v. Swift-Eckrich, Inc.*, 375 F.3d 1341, 1350–52 (Fed. Cir. 2004) (“golden-brown” needs construction), *rev’d on other grounds*, 546 U.S. 394 (2006).

116. *O2 Micro*, 521 F.3d at 1360; see, e.g., *Biotec Biologische Naturverpackungen GmbH & Co. KG v. Biocorp, Inc.*, 249 F.3d 1341, 1349 (Fed. Cir. 2001) (“melting” needs no construction); *Mentor H/S, Inc. v. Med. Device Alliance, Inc.*, 244 F.3d 1365, 1380 (Fed. Cir. 2001) (finding that the district court did not need to construe “irrigating” and “frictional heat”).

117. *O2 Micro*, 521 F.3d at 1361.

118. *Id.*

119. *Id.*

120. *Id.*

121. *Id.* at 1363.

122. *Id.* at 1361.

ordinary meaning or if failure to construe the term fails to resolve the dispute.<sup>123</sup> This decision was correct because, in addition to the reasons cited by the Federal Circuit, the lower court's interpretation of *Elekta Instrument* and *Phillips* was mistaken.<sup>124</sup> Additionally, though not considered by the Federal Circuit, refusal to construe terms that are central to the parties' dispute is a violation of due process,<sup>125</sup> and this decision will help counter the disturbing trend of arbitrary cut-offs in claim construction cases.<sup>126</sup>

#### A. *The Federal Circuit Was Correct in Its Interpretations of Markman, Phillips, and Elekta Instruments*

The Federal Circuit was correct in its reasoning in *O2 Micro*.<sup>127</sup> The way the lower court interpreted *Elekta Instrument* and *Phillips* placed them in direct conflict with *Markman*.<sup>128</sup> In essence, the lower court interpreted *Phillips* and *Elekta Instrument* to mean<sup>129</sup> that once a term was deemed ordinary, construction of that term was prohibited, and such terms were best left to jury interpretation.<sup>130</sup> However, *Markman* says that construction of disputed terms was required and should be done by the court, not the jury.<sup>131</sup> Thus, the lower court's interpretation turned a potential legal conflict into a true legal conflict.<sup>132</sup>

123. *Id.*

124. *See infra* Part IV.A.

125. The due process clause is part of the Fifth Amendment. U.S. CONST. amend. V ("No person shall be . . . deprived of life, liberty, or property, without due process of law . . .") (emphasis added).

126. *See infra* Part IV.B.

127. *See supra* Part III.

128. *See supra* notes 110–11 and accompanying text.

129. Although not addressed by the Federal Circuit, this interpretation of *Elekta Instrument* was mistaken. *See infra* Part IV.B.

130. Even after acknowledging that the terms "only if" were the central cause of the dispute between the two parties, the district court still chose to let the jury decide the outcome because the terms were ordinary. *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008).

131. *See supra* Part II.B.

132. *See* Carlos E. Gonzalez, *The Logic of Legal Conflict: The Perplexing Combination of Formalism and Anti-Formalism in Adjudication of Conflicting Legal Norms*, 80 OR. L. REV. 447, 458 (2001).

The key distinction between true and potential legal conflict centers on the interpreted meanings attributed to the legal norms in question. Where two legal norms, *as interpreted*, demand mutually exclusive outcomes, we have an instance of true legal conflict. When, in contrast, two legal norms would demand mutually exclusive outcomes if one or both norms were interpreted broadly, but in fact do not demand mutually exclusive outcomes because one or both norms are given narrow interpretations, we have an instance of potential legal conflict.

Thus, a true conflict between legal norms is present when one norm, *as interpreted*, requires or permits what another norm prohibits, or vice versa. In such cases, enforcement of one norm necessarily means the non-enforcement, or even the nullification, of another. The two norms in question, in other words, demand mutually exclusive outcomes. Return to the hypothetical case in which legal norm A requires or permits X, while legal norm B could plausibly be interpreted to prohibit X (or require not-X). Were norm B so interpreted, norm B would stand in a posture of true legal conflict with norm A.

*Id.*

The Federal Circuit employed proper legal interpretation by determining that *Markman* required construction of “only if” even if *Elekta Instrument* did not.<sup>133</sup> The lower court, in error,<sup>134</sup> believed *Elekta Instrument* could be interpreted in two ways, and it chose to interpret it in the broadest way.<sup>135</sup> The broadest interpretation is that ordinary terms should *never* be construed by the court.<sup>136</sup> A narrower interpretation is that ordinary terms *sometimes* do not need construction by the court, but construction is not prohibited.<sup>137</sup> The Federal Circuit, perhaps realizing that the narrow interpretation would allow *Elekta Instrument* and *Phillips* and *Markman* to work harmoniously together, overruled the lower court’s interpretation.<sup>138</sup> Although it is within judicial discretion to determine whether a broad or narrow interpretation is appropriate, there is a strong tendency for the courts to use a narrow interpretation to avoid a true legal conflict.<sup>139</sup> Given the relative impact the *Markman* and *Phillips* decisions have had on patent law,<sup>140</sup> the Federal Circuit was right to reconcile their tenets with the relatively minor holding in *Elekta Instruments*.

Therefore, by finding a way to reconcile *Markman* and *Phillips* with *Elekta Instruments*, the Federal Circuit properly decided *O2 Micro*.

#### B. *The Lower Court’s Misinterpretation of Elekta*

Although overlooked by the Federal Circuit, the District Court erred in its interpretation of *Elekta Instrument*.<sup>141</sup> Because the Federal Circuit focused on the requirements of *Markman* in making their decision, the Federal Circuit never clarified whether the district court in *O2 Micro* interpreted *Elekta Instrument* incorrectly.<sup>142</sup> The lower court’s interpretation of *Elekta Instrument* was wrong because *Elekta Instrument* does not free the court from construing terms at all; it only states that courts are not forced to construe them in a special manner when the patentee has not clearly indicated that he wishes to be his own lexicographer.<sup>143</sup> In *Elekta Instrument*, the patentee wanted the court to apply a special meaning to the disputed term “only,” and the accused infringer wanted the court to construe the term in its

133. See *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1361 (Fed. Cir. 2008).

134. See *infra* Part IV.B.

135. *O2 Micro*, 521 F.3d at 1361. Although this appears to be what the lower court believed, the lower court’s interpretation of *Elekta Instruments* suffered a second error, which is discussed in Part IV.B.

136. Thus, a disputed ordinary term would still be left unconstrued for the jury. *Id.*

137. *O2 Micro*, 521 F.3d at 1361.

138. *Id.*

139. Gonzalez, *supra* note 132, at 470.

140. See Johnson, *supra* note 38 (discussing the invention of the *Markman* hearing in response to the *Markman* decision); Holly L. Bonar, *Is Something Amiss? A Commentary on the Aftermath of Phillips v. AWH Corp.*, 88 J. PAT. & TRADEMARK OFF. SOC’Y 513, 513 (2006) (noting that *Phillips* had not led to as expansive changes as first expected, but acknowledging that *Phillips* has become a heavily cited case).

141. *Elekta Instrument S.A. v. O.U.R. Scientific Int’l, Inc.*, 214 F.3d 1302 (Fed. Cir. 2000).

142. *O2 Micro*, 521 F.3d at 1361.

143. *Elekta Instrument*, 214 F.3d at 1307–08.

ordinary manner.<sup>144</sup> The court decided to construe the term in its ordinary manner because nothing in the patent indicated that “only” had any other special meaning.<sup>145</sup> This is an important distinction from the *O2 Micro* district court’s reading of the case. The district court in *O2 Micro* used *Elekta* to stand for the prospect that the court does not need to construe ordinary terms.<sup>146</sup> In actuality, the *Elekta* court did take the time to construe the disputed terms before sending it to the jury; even if the court merely decided to use the term’s ordinary meaning, it still construed the term.<sup>147</sup> The *Elekta* court used a dictionary to find that “only” had the ordinary meaning of “solely” or “exclusively” and applied that construction to the claims.<sup>148</sup> Therefore, in *Elekta Instrument*, the court did not refuse to construe the term; it chose to construe the term to have its ordinary meaning.<sup>149</sup>

Furthermore, the landmark *Phillips* case articulates that courts must construe disputed terms.<sup>150</sup> The Federal Circuit in *Phillips* stated that courts are welcome to apply the ordinary meaning of a term and even to use nothing else to help them construe the word than their own general knowledge.<sup>151</sup> However, they never indicated that courts could flatly refuse to construe a word at all if it is the center of the parties’ dispute.<sup>152</sup> The important point is that the previous decisions have allowed judges to give very little reasoning and do very little work in researching the ordinary meaning of a term, but the court must at least construe the term using its ordinary definition before submitting it to the jury.<sup>153</sup>

Therefore, because the lower court in *O2 Micro* erred in its interpretation of *Elekta Instrument*, the Federal Circuit was correct in reversing its decision and remanding the case for construction of the terms “only if.”

### C. The Impact of the *O2 Micro* Decision

In making its decision in *O2 Micro*, the Federal Circuit may have also inadvertently effected a stop to the growing trend of district courts enacting local rules to reduce their patent caseload.<sup>154</sup> Some district courts that deal with patents frequently have created time limits for *Markman* hearings and have even limited the number of terms they are willing to construe in a *Markman* hearing.<sup>155</sup> However, the Constitu-

144. *Id.* at 1306–07.

145. *Id.* at 1307.

146. *O2 Micro*, 521 F.3d at 1361.

147. *Elekta Instrument*, 214 F.3d at 1307.

148. *Id.*

149. *Id.* at 1307–09.

150. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

151. *Id.* at 1314 (“In some cases, the ordinary meaning of claim language . . . may be readily apparent even to lay judges, and claim construction in such cases involves little more than [but still requires] the application of the widely accepted meaning of commonly understood words.”).

152. *Id.*

153. *See id.*

154. *See supra* note 43 and accompanying text.

155. *See supra* note 43 and accompanying text.

tion forbids property from being taken without due process of the law.<sup>156</sup> Because patents are a form of property,<sup>157</sup> and because the Supreme Court has already indicated that the due process for determining the boundaries of that property is a court's determination of the meaning of the patent's disputed terms,<sup>158</sup> a court's arbitrary refusal to construe terms and settle the parties' dispute violates the patentee's right to due process.<sup>159</sup> Therefore, this Federal Circuit decision upholds the tenets of due process.<sup>160</sup> Furthermore, because the Federal Circuit is often the final word in determining patent law,<sup>161</sup> the *O2 Micro* decision will force district courts to construe all disputed terms, even if only taking the time to construe them using their ordinary meanings, instead of arbitrarily capping the number of terms they will review.<sup>162</sup>

## V. CONCLUSION

In *O2 Micro International Ltd. v. Beyond Innovations Technology*, the Federal Circuit properly held that the lower court erred in failing to construe the terms "only if" because seemingly ordinary terms must be construed when there is more than one definition for the term or when failure to construe the term does not solve the parties' dispute.<sup>163</sup> However, the Federal Circuit failed to also note that the lower

156. See *supra* note 125.

157. See, e.g., *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 730 (2002) (indicating that a patent right "is a property right"); *Florida Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627, 642 (1999) ("[Patents] are surely included within the 'property' of which no person may be deprived by a State without due process of law."); *United States v. Dubilier Condenser Corp.*, 289 U.S. 178, 187 (1933) (indicating that "[a] patent is property"); *Consol. Fruit-Jar Co. v. Wright*, 94 U.S. 92, 96 (1876) (indicating that "[a] patent for an invention is as much property as a patent for land").

158. See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996).

159. See *Florida Prepaid Postsecondary Educ.*, 527 U.S. at 642 ("[Patents] are surely included within the 'property' of which no person may be deprived by a State without due process of law.").

160. The assertion is best understood with an illustration. Suppose that Peter has a patent on a "blue" machine. Peter finds out that Ingrid is using a "teal" machine. Peter thinks Ingrid's machine is so similar to his patented blue machine that Ingrid may be infringing on his patent. Peter then takes Ingrid to court arguing that "blue" means "all hues between green and violet" and thus a "teal" machine is covered by his patent. Ingrid says she is not infringing because "blue" means "colors on the RGB scale that only use blue and do not contain red or green." With this definition, Ingrid says she is not infringing. In this scenario, the term "blue" is a seemingly ordinary word, but each party has a definition of "blue" that changes the scope of the claim.

If the court finds that "blue" does in fact mean "teal," then Peter's property, the patent, is protected because Peter was afforded due process in court. If the court finds that "blue" does not mean "teal," then Ingrid's property is not taken away from her because the court properly afforded Ingrid the judicial process due to her in determining that Peter did not own the intellectual property that she is practicing.

However, if the court decides to do nothing because "blue" is an ordinary term that needs no construction, due process is not served. As stated in *Markman*, the meaning of claim terms is a matter of law, and by refusing to construe a term, a court inappropriately allowed a question of law to go to the jury. *Markman*, 517 U.S. at 372. This is not the proper process for protecting either Peter's or Ingrid's property. If the jury decides the 'wrong' way, then either Peter's or Ingrid's Fifth Amendment right would be violated.

161. See *supra* note 46 and accompanying text.

162. See, e.g., *supra* note 43 and accompanying text.

163. *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1361 (Fed. Cir. 2008).



court erred in its interpretation of *Elekta Instrument v. O.U.R. Scientific International, Inc.*<sup>164</sup> Nevertheless, this case was appropriately decided and the ruling should encourage courts to protect the due process rights of parties in patent suits.<sup>165</sup>

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164. See *supra* Part IV.A.

165. See *supra* Part IV.B.