

## O2 Micro Decision Sorts 'Scope' From 'Meaning'

*Monday, Jun 09, 2008* --- Ten years ago in *Markman*, the Supreme Court ruled that the “scope and meaning” of a patent’s claims — that is, the boundaries of the invention — were a matter of law to be determined by district courts, not juries. Against such a judge-laid framework, the jury would then assess infringement by determining whether the accused product fell within those district court-defined boundaries.

With its ruling, the Supreme Court sought to take the question of how broad or narrow a patent was out of the jury’s hands, and place them squarely in the district court judge’s.

This was a change. Pre-*Markman*, juries often decided not only the infringement issue, but also the claim scope of the patent. At trial, lawyers routinely argued how broad or narrow the invention was, with the jury then determining scope and meaning as part of its infringement analysis. *Markman* purported to end that approach.

But it hasn’t quite worked out that way. In the 10 years since *Markman*, district court claim construction has evolved into a definitional exercise — at a *Markman* hearing, a court typically “defines” claim terms and instructs the juries on those definitions. While this may meet the Supreme Court’s mandate to construe the “meaning” of the claims, it often leaves the jury uninformed on the question of “scope.”

This is because scope is often best described not by a dictionary definition of words, but instead what falls within or outside a particular claim. But lawyers are loath to ask a court at the *Markman* stage to determine what falls within or outside a claim — that it sounds too much like an infringement analysis. When judges are asked to instruct a jury that a certain feature is required or excluded by a claim, judges often refuse, saying “that’s an infringement issue,” and stick to simply defining the meaning of claim terms.

But those definitions then turn into fodder for attorney argument before the jury, with each side arguing what boundaries — or “scope” — the court-supplied “meanings” encompass. So even when the court defines claim terms – or the terms of the claims are clear on their face — it is still often left to the jury to determine the actual scope of the patent claims.

### *But Determining “Meaning” May Not Resolve “Scope”*

The Federal Circuit recently addressed the difference between “scope” and “meaning” in *O2 Micro v. Beyond Innovation*, ultimately concluding a district court must meet both of the Supreme Court’s mandates, determining not only

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the “meaning” but also the “scope” of the patent claims.

In *O2 Micro*, the term at issue was straightforward: “only if” – a circuit would operate “only if” a certain threshold was met. The parties agreed — as did the district judge — that the term “only if” had a clear meaning on its face. The dispute instead was whether “only if” allowed for exceptions to the rule — that is, the parties disputed the scope of the claims.

The district court acknowledged the actual dispute over scope, but declined to construe the term because “only if,” as it said, “has a well understood definition.” The parties then argued to the jury whether the claim allowed for exceptions to the rule — that is, they argued whether the “scope” of the claim was broad enough to encompass exceptions. The patentee won.

On appeal, the Federal Circuit found that while the meaning of “only if” was undisputed, the district court was still obliged to determine the scope. By refusing to determine whether the claim’s scope encompassed exceptions, the parties were left to argue those scope issues to the jury. This was an error.

As the Federal Circuit put it, “When the parties present a fundamental dispute over the scope, even when the meaning is clear, it is the court’s duty to resolve that dispute.”

#### *Potentially Clearer Markman Rulings — And More Summary Judgments?*

*O2 Micro*’s directive to resolve scope may lead to more clearer, scope-defining constructions. Rather than provide the usual definition-style constructions that simply replace one set of words with another — and that often provide a great deal of factual wiggle room for the infringement question — judges may be forced to confront the harder question of which products would fall within the claims and which would not.

And such constructions have the potential to yield more summary judgment rulings. What an accused product is or does is often undisputed — with the question of whether such an undisputed product falls within the scope of the claim answered at *Markman*, there would be no question of fact on infringement left for the jury.

Under *O2 Micro*, a party can frame a claim construction issue in the context of what the accused product is or does — does a particular feature fall within the claim, or does it not? Pointing to *O2 Micro*, it would then be incumbent upon a judge to decide that issue — which would also decide the factual question of infringement.

The actual impact of *O2 Micro* may be less stark. Often, neither party will want a precise claim boundary drawn at *Markman* — both sides will want at least some freedom to argue infringement questions to a jury.

Further, asking a judge to clearly resolve scope involves its own risk — an

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adverse ruling could yield a summary judgment against the very party seeking the boundary-defining construction. From a litigation strategy perspective, this falls into the “be careful what you ask for” category.

It also remains to be seen just how literally *O2 Micro* will be applied going forward. Certain claim terms are only susceptible to so much construction. Qualitative terms such as “flexible” can only be construed so far — at a certain point, one has to ask the jury whether or not an accused product is, in fact, “flexible.”

Likewise, claims including the word “about” or “approximately” leave qualitative room for the jury to determine whether an accused product meets such limitations. For such terms, at the end of the day it would seem an infringement question remains as to whether such limitations are met.

Nevertheless, *O2 Micro* does give ammunition to parties to propose boundary-defining claim constructions that clearly establish what features are within or outside of a claim, rather than simply offering a definition for the jury to noodle over. If a party chooses to do so, it will be hard for a judge to hide behind the “needs no construction” or “that’s an infringement issue” mantras.

It will be interesting to see whether district courts and the Federal Circuit will expand on *O2 Micro*’s directive to determine “scope” despite a clear or known “meaning,” or instead simply leave this as an interesting Federal Circuit decision lying in the dust.

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