

Welcome to Hauptman Ham, LLP's Case Law Review, a summary of recent important intellectual property decisions.

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EXCEPTIONS TO A CLEAR DEFINITION MUST ALSO BE CLEAR

[Alnylam Pharms., Inc. v. Moderna, Inc.](#)

Appeal No. 2023-2173 (Fed. Cir. June 4, 2025, Taranto, Chen, Hughes, precedential)

Author: [Adam Langley](#)

Key Points:

- Where a patentee attempts to cover exceptions to a clear definition of a claim term provided in the specification of the patent, the specification must be equally clear about describing the exceptions.
- 特許明細書において提供されているクレーム用語の明確な定義の例外を包含しようとする場合、その明細書がその例外についても同程度に明確に記載していなければならない。
- 특허 명세서에서 특정 용어에 대해 명확한 정의를 제시한 경우, 출원인이 그 정의의 예외를 청구항으로 포함하려고 한다면, 명세서 역시 그 예외를 동등한 수준으로 명확하게 설명하고 있어야 한다.
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Background:

Alnylam Pharmaceuticals, Inc. (“Alnylam”) sued various affiliates of Moderna, Inc. (“Moderna”) alleging Moderna’s COVID-19 vaccine infringed U.S. Patent Nos. 11,246,933 and 11,82,979. The case turned on construction of the claim term “branched alkyl.” Alnylam asked the court to construe the term according to its plain and ordinary meaning. Moderna requested a construction based on a passage in the specification defining “branched alkyl” as a molecule having a carbon atom bound to at least three other carbon atoms. The

district court adopted Moderna’s proposed construction. After the parties stipulated to non-infringement, Alnylam appealed the claim construction adopted by the district court.

Holding:

Reviewing the district court’s claim construction without deference, the Court of Appeals for the Federal Circuit held that the patentee had acted as lexicographer in defining the disputed term in the specification, and affirmed the district court.

Discussion:

On appeal, Alnylam argued that the intrinsic record shows no intent to limit the meaning of “branched alkyl” in the claims, and that the district court’s construction excludes disclosed embodiments. Alnylam also argued, in the alternative, that even if the passage relied upon by the district court is definitional, that passage stated “[u]nless otherwise specified,” so the type of branching found in Moderna’s product, having a secondary carbon at the alpha position, is fairly covered by the term “branched alkyl.” The Federal Circuit examined the specification and prosecution history of the patent and, following *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996), concluded that the passage at issue serves as a definition. The reviewing court also concluded that the “unless otherwise specified” clause is insufficient to support Alnylam’s broad construction.

The Federal Circuit found that the passage in dispute contains numerous lexical hallmarks of definitional intent. The reviewing court also found nothing in the claims, specification, or prosecution history that specifies otherwise to justify invoking the “unless otherwise specified” clause. Noting that the specification also described one molecular structure showing a carbon atom bonded to only two other carbon atoms as a “branched alkyl,” the Federal Circuit explained that this example, coupled with equivocal arguments at the district court, do not present a specific exception that can clearly invoke the “unless otherwise specified” exception clause of the definition passage. Following *Boss Control, Inc. v. Bombardier Inc.*, 410 F.3d 1372, 1378 (Fed. Cir. 2005), the reviewing court also found the prosecution history insufficiently clear and specific to invoke the exception clause, explaining that the public notice function of patent claims requires clarity.

FUNCTIONAL DATA MANIPULATION CLAIM NOT PATENTABLE

United Servs. Auto. Ass’n v. PNC Bank N.A.

Appeals Nos. 2023-1639 (Fed. Cir., June 12, 2025, Dyk, Clevenger, Hughes, precedential)

Author: [Kien Le](#)

Key Points:

- A patent claim that recites using a mobile device to deposit checks, but does not recite any improvement in technology needed to deposit the checks, is ineligible for patenting under 35 U.S.C. 101.
- 小切手を入金するためのモバイル装置の使用を要件としてはいるがその小切手を入金する際に必要な技術の改良について何ら要件としていない特許クレームは、米国特許法第 101 条下での特許適格性を有していない。
- 수표를 입금하기 위해 모바일 기기를 사용하는 것을 기재하고 있지만, 그러한 입금을 가능하게 하는 기술적 개선 사항을 전혀 포함하지 않는 특허 청구항은 미국특허법 제 35 조 제 101 항에 따라 특허부적격(patent-ineligible)으로 판단된다.

- 一项权利要求如果仅记载使用移动设备存入支票，而未记载为实现该存款所需的任何技术改进，则根据美国法典第 35 编第 101 条，该权利要求不具备专利适格性。

Background:

This case concerns a claim directed to a system configured to allow a customer to deposit a check using a handheld mobile device. The claim recites various operations, such as instructing and assisting a customer to take a photo of the check, wirelessly transmitting a copy of the photo, checking for errors, and updating the customer's account. The District Court held that the asserted patent claim is directed to subject matter eligible for patenting. On appeal, the U.S. Court of Appeals for the Federal Circuit (“CAFC”) reversed.

The CAFC applied the two-step analysis under *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208 (2014). At Step One (corresponding to the USPTO's Step 2A), it is determined whether the claim is directed to a patent-ineligible concept. Regarding Step One, CAFC has previously held that claims directed to collecting information, analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, and presenting the results fall within the realm of abstract ideas. At Step Two (corresponding to the USPTO's Step 2B), it is determined whether the elements of the claim contain an inventive concept sufficient to transform the abstract idea into a patent-eligible application. Regarding Step Two, CAFC has previously held that invoking a computer merely as a tool to improve a fundamental practice or abstract process does not make an otherwise abstract claim non-abstract, nor does limiting the claim to a particular field of use or technological environment.

Holding:

At Step One, CAFC found that the claim is directed to the abstract idea of depositing a check, because it merely recites routine data collection and analysis steps that have been traditionally performed by banks and people depositing checks. The addition of a handheld mobile device to carry out these routine steps does not make the claim any less abstract. Although the claim is directed to improving the user’s experience of depositing a check by allowing the use of familiar and easily acquired electronics, the claimed steps do not improve the way in which the handheld mobile device functions; the device is merely a tool to perform the conventional steps.

At Step Two, CAFC found that there is no inventive concept that would support patent eligibility. CAFC's precedent is clear that computer-mediated implementation of routine or conventional activity is not enough to provide an inventive concept. USAA argued that the claim contains an inventive concept because it solves the technological problem of accurate detection and extraction of information from digital images of checks implanted on general purpose mobile devices instead of a specialized check scanner. CAFC disagreed, because the claim recites nothing more than routine image capture, OCR, and data processing steps — all of which were well-known and routine. CAFC further found the alleged "improvement" of using non-obvious algorithms implemented on a customer’s mobile device instead of a specialized check scanner not inventive, because limiting the claim to a particular technological environment does not involve an inventive concept — the claim merely contains the implementation of routine activities using a generic device and does not mention any inventive algorithms.

Because the claim is directed to an abstract idea under Step One and contains no inventive concept under Step Two, CAFC concluded that the claim is patent-ineligible under 35 U.S.C. 101, and reversed the District Court's holding.

DEFENDANT ENTITLED TO SEPARATE ANSWER FROM JURY FOR EACH CLAIM OF PATENT INFRINGEMENT

Optis Cellular Tech., LLC v. Apple Inc.

Appeal No. 2022-1904 (Fed. Cir., June 16, 2025, Prost, Reyna, and Stark, precedential)

Author: *Daiki Ohno*

Key Points:

- A patent defendant is entitled to have each claim of infringement made by the plaintiff separately answered by a jury.
- 特許（訴訟における）被告は、原告により侵害とされた各クレームについて陪審により別個に回答を受ける権利を有する。
- 특허 피고인은 원고가 주장하는 각 청구항별 침해 주장에 대해 배심원이 개별적으로 판단하도록 요구할 권리가 있다.
- 专利被告有权要求陪审团对原告指控的每一项侵权主张分别作出裁决。

Background:

Optis Cellular Tech., LLC (“Optis”) sued Apple Inc. (“Apple”) in the District Court for the Eastern District of Texas for infringement of five standard essential patents (SEP) covering technology essential to the LTE wireless standard. A jury initially awarded Optis \$506.2 million as reasonable royalty after finding Apple infringed certain claims. Apple sought a new trial, citing lack of evidence regarding Optis' obligation to license the patents on fair, reasonable, and nondiscriminatory (“FRAND”) terms. The court agreed, and a new trial reduced damages to \$300 million. Once its post-judgment motions were denied, Apple appealed to the Federal Circuit.

Holding:

Finding some asserted claims ineligible for patenting, some asserted claims misconstrued by the district court, and certain abuses of discretion by the district court, the Court of Appeals for the Federal Circuit (CAFC) vacated the infringement and damages judgments and remanded the case for a new trial.

Discussion:

On appeal, Apple challenged the propriety of the verdict form used by the district court, which asked only a single infringement question in a trial of several asserted claims. Apple also challenged patent eligibility of claims 6 and 7 of U.S. Patent No. 8,019,332 (the ‘332 patent), the district court’s construction of claim 8 of U.S. Patent No. 8,102,833 (the ‘333 patent), definiteness of claim 1 of U.S. Patent No. 8,411,557 (the ‘557 patent), the jury’s infringement verdict, and certain damages evidence admitted by the district court. The reviewing court held that using a single infringement question for all asserted claims on the verdict form violated Apple’s right to a unanimous verdict because it required only one answer, whether Apple infringed any claim, where jurors might not agree which claims were infringed. Both parties had proposed multiple infringement questions, but the district court abused its discretion in rejecting all such proposals. The CAFC vacated the infringement verdict, and thus necessarily vacated the damages result based on the infringement verdict, and ordered a new trial.

For the sake of judicial efficiency, the CAFC proceeded to consider Apple’s other arguments. Finding claims 6 and 7 of the ‘332 patent directed to using an equation to calculate the start position from which a user device will begin searching for information on a cellular network, the reviewing court was not convinced that any alleged technological improvement made the claims non-abstract, as argued by Optis. The CAFC remanded the question for consideration of Alice Step Two regarding claims 6 and 7.

The CAFC affirmed construction of claim 8 of the ‘333 patent as following a prior construction by another district court, finding no error in that construction. The reviewing court then turned to indefiniteness of the phrase “selecting unit” in claim 1 of the ‘557 patent under 35 U.S.C. § 112 ¶ 6 (pre-AIA), and found the claim lacked recitation of any structure to perform the “selecting” function, the word “unit” being merely a nonce term similar to “means,” and remanded the question of indefiniteness.

Finally, finding a settlement agreement, entered by the district court as damages evidence, of minimal probative value due to vast difference in legal, monetary, and geographic scope between the settlement agreement and the instant claims, the CAFC directed the district court to exclude the settlement agreement from damages proceedings on remand.

PROSECUTION HISTORY CAN NARROW MEANING OF STANDARD PATENT TERMS

Eye Therapies, LLC, v. Slayback Pharma, LLC

Appeal No. 2023-2173 (Fed. Cir., June 30, 2025, Taranto, Stoll, Scarsi¹, precedential)

Author: Chang Yang

Key Points:

- In patent claims, the standard legal meaning of terms like “consisting essentially of” can be narrowed by applicant statements made during patent prosecution, even if such narrowing operates to exclude subject matter disclosed in the specification.
- 特許クレームにおける”consisting essentially of”のような用語の標準的な法的意味が、たとえその減縮化が明細書に開示された主題を排除するよう作用したとしても、特許審査中に出願人によりなされた意見書により狭められる可能性がある。
- 특허청구항에서 “consisting essentially of”와 같은 용어의 통상적인 법적 의미는, 비록 그로 인해 명세서에 개시된 일부 내용을 제외하는 결과가 발생하더라도, 출원 과정 중 출원인이 한 진술에 의해 한정될 수 있다.
- 在专利权利要求中，诸如“本质上由……组成（consisting essentially of）”等术语的标准法律含义可以通过申请人在专利审查过程中作出的声明加以缩窄，即使这种缩窄会排除说明书中披露的主题。

Background:

Eye Therapies, LLC (“Eye Therapies”) owns U.S. Patent No. 8,293,742 (“the ‘742 patent”) which claims a method of reducing eye redness by administering brimonidine at low concentrations. During prosecution, Eye Therapies amended the claims to change “comprising administering brimonidine” to “consisting essentially of administering brimonidine.” Eye Therapies argued that “consisting essentially of”

¹ C.D.Ca., sitting by designation.

limits the claim to embodiments that “do not include administering other active agents” to overcome prior U.S. Patent No. 6,242,442 (“Dean”), which discloses the administration of brimonidine and brinzolamide. The Examiner allowed the claims based on Eye Therapies’ explanation. Slayback petitioned for Inter Partes Review (IPR), arguing that the claims of the ‘742 patent are obvious over prior art disclosing brimonidine in combination with other active agents. The Patent Trial and Appeals Board (“PTAB”) of the United States Patent and Trademark Office (“USPTO”) construed “consisting essentially of” as allowing “unlisted ingredients that do not materially affect the invention,” and found all claims obvious over prior art. Eye Therapies appealed.

Holding:

The Court of Appeals for the Federal Circuit (“CAFC”) reversed the PTAB’s construction of “consisting essentially of” as erroneous, and held that the term should be narrowly construed to exclude other active ingredients based on prosecution history of the ‘742 patent. The CAFC accordingly vacated the PTAB’s obviousness decision and remanded for further proceedings.

Discussion:

Generally, “consisting of” has the meaning adopted by the PTAB. The court explained, however, that during prosecution an applicant can narrow the meaning of claim terms, and “consisting of” is no exception. In this case, the applicant stated that the claimed “methods “do not require the use of any other active ingredients” to distinguish over the prior art and used a definitional term, “i.e.” to equate its claimed “methods consisting essentially of administering brimonidine” with “methods which do not include administering other active agents.” The court found these statements dispositive as strongly supporting a narrower meaning. The court further explained that, although some formulations in the specification included additional active ingredients, claims need not cover all embodiments described in the specification. Accordingly, the court reversed the PTAB’s construction and read the transition phrase “consisting essentially of” to exclude use of active ingredients other than brimonidine.

Because the PTAB’s obviousness analysis relied on its erroneous claim construction and the cited prior art involved additional active agents other than brimonidine, the court found the references insufficient to demonstrate obviousness. The court vacated the PTAB’s obviousness determination and remanded for further consideration.

ADDITIONAL INFORMATION

2318 Mill Road, Suite 1400
Alexandria, VA 22314 USA

Tel: +1 (703) 684-1111
Fax: +1 (703) 518-5499

Chiyoda Kaikan Bldg. 6F
1-6-17 Kudan Minami, Chiyoda-Ku,
Tokyo 102-0074 Japan

Tel: +81 3 6256-8970
Fax: +81 3 6717-2845

Room B565, No. 5 building
Huayangnian Meinian International Square
Nanshan District, Shenzhen, China, 518067

H-Business Park D 314, 26
Beobwon-ro 9-gil, Songpa-gu
Seoul, Korea

Tel: +82 (0)2 6412-0626
Fax : +82 (0)2 6412-0627

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