

Australia – Mock Trial Judgment

Justice John Nicholas
Federal Court of Australia



Patent Construction

- The relevant principles of construction are:
 - A patent specification should be read in light of the common general knowledge in the art as it stood at the priority date. It should be given a purposive rather than a purely literal or abstract construction. It should also be read in a practical and common sense way.
 - The words used in a patent specification are to be given the meaning which a person skilled in the art would give them having regard to the common general knowledge as at the priority date and what is disclosed in the specification when read as a whole.
 - The claims define the scope of the patentee's monopoly. While they are to be construed in light of the patent specification as a whole, it is not legitimate to narrow or expand the boundaries of the patentee's monopoly as fixed by the words of a claim by adding to or subtracting from the meaning of those words based on glosses drawn from other parts of the specification.
 - In particular, it is not permissible to read down clear and unambiguous language of a claim by reference to the description of a preferred or exemplary embodiment described in the body of the specification. However, it is permissible to resolve ambiguity in the claims by reference to the body of the specification.

- The proper construction of a patent specification is a matter of law. While experts can give evidence as to the common general knowledge and the meaning of technical or scientific terms in the patent specification, the meaning of the claim is ultimately a matter for the Court to determine.
- Since a patent specification must describe the invention fully, including the best method known to the inventor of performing the invention, a patent specification will usually contain a detailed description of at least one embodiment of the invention around which the claims are drawn.
- Provided a claim is fairly based upon matter disclosed in the specification, it may define the invention more broadly than the embodiment that is described in the body of the specification. Equally, the claim may define the invention more narrowly than the embodiment that is described in the specification.
- A limitation in a claim cannot be ignored simply because the embodiment disclosed in the specification is more broadly described or because a valid claim could have been drawn without the same limitation. Further, the fact that a particular integer is a necessary feature of the best method of performing the invention does not require that it be imported into the claim.

Issue 1

Whether claim 1 requires that all of the features of the method for controlling the car navigation system referred to in claim 1 be installed in the vehicle?

The words “car navigation system” are clear and unambiguous and are not limited to systems having any particular design or configuration. There is nothing in the specification that requires that all of the features of the method for controlling the car navigation system referred to in claim 1 be installed in the vehicle. In particular, claim 1 does not require that either the first memory means or the second memory means to be located inside the vehicle.

Issue 2

Whether the “first memory means” referred to in claim 1 must be a portable storage medium (eg. a CD-ROM) that can be installed in the vehicle?

There is nothing in claim 1 which requires that the first memory means be a portable storage medium that can be installed in the vehicle. The relevant language (ie. “memory means”) is deliberately broad and should be given full effect. It encompasses any memory means capable of performing the function attributed to it in the claim regardless of whether or not such means takes the form of a portable storage medium. The fact that the embodiment described in the specification utilises a portable storage device (ie. a CD-ROM) does not provide a sufficient basis for importing any such requirement into claim 1.

Issue 3

Whether claim 1 requires that there be a separate “second memory means” for storing and reading coordinate data as registered user data?

- The language of claim 1 refers to a “first memory means” and a “second memory means” (rather than just “memory means” or “one or more memory means”) which suggests that the facility data and coordinate data are stored in two separate memory means. However, the language may also be understood as extending to a first and second memory means that may be provided by a single memory device serving two distinct memory functions.
- Claim 1 is ambiguous in that it is not clear from the language used whether the first memory means and the second memory means are necessarily separate components of the car navigation system. Since the claim is in this respect ambiguous it is permissible to have regard to the description in the specification and the views of the expert witnesses for the purpose of seeking to resolve the ambiguity.
- In my opinion, claim 1 is to be understood as requiring that there be two separate memory means in the form of two separate devices. This interpretation of claim 1 finds support in the language of the claim (referring to a first and a second memory means) and in the description of the invention which also distinguishes between the first memory means (the CD-ROM) and the second memory means (re-writable RAM). Each of these is a separate component with its own distinct function to perform in the method of the invention.

Ruling on Evidence

Exclusion of the written opinion

- During the course of the hearing, Donkey sought to tender in evidence a written opinion filed by Pony during the course of the prosecution of the application for the Patent in which Pony explained why it disagreed with the Examiner's interpretation of certain prior art. It was submitted by Donkey that the written opinion was relevant to the proper construction of the Patent.
- The written opinion was excluded from evidence on the ground that it is not relevant to the proper construction of the Patent and is therefore inadmissible. This is because the Patent is to be construed in accordance with the principles of construction previously discussed which do not usually permit the Court to receive opinion evidence as to the meaning and effect of the claims or the prior art except by way of admissible evidence from an expert witness qualified as a person skilled in the relevant art.

Conclusion

- Claim 1 requires that the method for controlling the car navigation system utilise a first memory means and a second memory means constituted by two separate memory devices. The D system utilises a single memory device that performs the functions of both the first memory means and the second memory means. It follows that the D system does not infringe claim 1.