

**In The
Supreme Court of the United States**

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IZUMI PRODUCTIONS COMPANY,
Petitioner,

v.

KONINKLIJKE PHILIPS ELECTRONICS N.V.;
PHILIPS ELECTRONICS NORTH AMERICA CORPORATION
AND PHILIPS DOMESTIC APPLIANCE
AND PERSONAL CARE B.V.,
Respondents.

—————◆—————
ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

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AMICUS CURIAE BRIEF OF
CONEJO VALLEY BAR ASSOCIATION
IN SUPPORT OF NEITHER PARTY

—————◆—————
Mark Andrew Goldstein
Counsel of Record
SOCAL IP LAW GROUP LLP
310 N. Westlake Boulevard
Suite 120
Westlake Village, CA 91362
(805) 230-1350
mgoldstein@socalip.com

Counsel for Amicus Curiae
Conejo Valley Bar Association

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**Brief Of *Amicus Curiae*
Conejo Valley Bar Association
In Support Of Neither Party¹**

INTEREST OF THE *AMICUS CURIAE*

Based in the heart of Southern California's 101 Technology Corridor, the Conejo Valley Bar Association draws its membership from local law firms and in-house attorneys serving small, mid-market and large companies. Our members' clients are predominantly high tech, high growth companies in fields such as software, biotech, computer networking, telecommunications and semiconductors. Our members' clients are innovators who vend in some of the world's most competitive markets.

The Conejo Valley Bar Association has participated as *amicus curiae* in two recent patent cases decided *en banc* by the Court of Appeals for the Federal Circuit on issues affecting public policies of the patent system, namely *Phillips v. AWH Corp.* and *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*

¹ Pursuant to Supreme Court Rule 37.6, Amicus states that no counsel for a party authorized this brief in whole or in part and that no person or entity other than Amicus, its members, and its counsel contributed monetarily to the preparation or submission of this brief. With the consent of the parties, the Conejo Valley Bar Association submits this brief *amicus curiae* in support of neither party. Copies of the letters of consent are filed with the Clerk of the Court herewith. Originals will be provided in due course.

Amicus curiae writes in *pro bono publico*, rather than in support of either party. We are unconcerned with the outcome of the case, though decidedly concerned about the issues. We wish to see the American public benefit from innovation, from technical disclosure, and from competition in product and service markets. In short, we support the purpose of the patent system. The Conejo Valley Bar Association believes that the patent laws should be interpreted in ways that best serve these important public policies.

The Conejo Valley Bar Association takes an interest in this case because of the potential implications of this Court's ruling on the method of patent claim interpretation.

INTRODUCTION AND SUMMARY OF ARGUMENT

In its petition for writ of certiorari, petitioner frames the question presented and presents arguments that we believe have been sufficiently answered by the rules set forth in *Philips v. AWH Corp.* and other Federal Circuit Court opinions. When patents and their claims do not lend themselves to ready and easy interpretation, reasonable skilled minds will differ on the interpretation of those claims, regardless of the rules provided. When a patent is poorly drafted, it burdens the public – both competitors and the courts – who must discern the claimed patent rights. As such, the controlling theme of controversy in patent cases is not the deficiency of available rules available to interpret patent claims, but the deficiencies in the patents themselves. The Federal Circuit has provided patent counsel with sufficient guidance and rules to allow for claim interpretation in the majority of patents.

ARGUMENT

I. The Federal Circuit Provided Sufficient Claim Interpretation Guidance in *Phillips v. AWH Corp.*

In *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*). 11 of 12 Federal Circuit Court judges agreed on the methodology for claim interpretation. The guidance provided in *Phillips* was neither new nor surprising. The Federal Circuit maintained and reiterated longstanding rules of patent claim interpretation, stating that the claims of a patent do not stand alone and recognizing “the importance of the specification in claim construction.” *Phillips*, 415 F.3d at 1315.² The Federal Circuit also took the long-needed step of rejecting some methodologies which had long stood on the periphery of the jurisprudence of claim interpretation. *Id.* at 1320 (“Although the concern expressed by the court in *Texas Digital* was valid, the methodology it adopted placed too much reliance on extrinsic sources such as dictionaries, treatises, and encyclopedias and too little on intrinsic sources, in particular the specification and prosecution history.”).

² The petitioner uses the term “disclosure” in its petition. For consistency, we use the term “disclosure” herein. However, much of the case law on the subject uses the term “specification.” As such, quotations from cases and analysis of cases use the term “specification.” The terms “disclosure” and “specification” are to be interpreted synonymously herein.

The petition for certiorari attempts to fashion from whole cloth a dramatic distinction between two parts of a patent: the claims and the disclosure. The petitioner argues for a blanket rule that the disclosure of a patent should not be used to interpret the patent's claims if the plain meaning can be unambiguously discerned. Petitioner's Brief, p. 25, 2nd para.

Although the petitioner argues that the disclosure of a patent should not be used to interpret the patent's claims, petitioner's own arguments affirm that the disclosure must necessarily be considered to evaluate whether explicit definitions of claim terms are provided. Petitioner's Brief, p. 13, 1st para and p. 25, 2nd para. Therefore, it can only be concluded that the disclosure must necessarily always be considered when interpreting claims to at least evaluate whether explicit definitions of claim terms are made.

The petitioner proffers a polar analysis that ignores the prosecution history and extrinsic evidence in their entirety, limiting claim interpretation to either the claims on their face or the claims in view of the disclosure when explicit definitions are included in the disclosure. Petitioner's Brief, p. 13, 1st para and p. 25, 2nd para. Wholly absent from the petitioner's brief is a discussion of the distinction between intrinsic evidence and extrinsic evidence. The entirety of available intrinsic and extrinsic evidence should be used to interpret patent claims. *Phillips*, 415 F.3d at 1314 citing *Gemstar-TV Guide Int'l, Inc. v. ITC*, 383 F.3d 1352, 1364 (Fed. Cir. 2004); *Vitronics Corp.*

v. Conceptronic, Inc., 90 F.3d 1576, 1582-83 (Fed. Cir. 1996); and *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979-80 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370, 134 L. Ed. 2d 577, 116 S. Ct. 1384 (1996). In limiting its argument to patent claims and limited use of the disclosure, petitioner ignores substantial pertinent case law, including *Phillips v. AWH*.

Intrinsic evidence includes the disclosure as well as the prosecution history, abstract, summary of the invention and claims as originally filed. The claims themselves and the disclosure are the best and primary source for interpreting claims. See *Phillips*, 415 F.3d at 1315. There are several reasons to review the patent's disclosure. Most importantly, the disclosure must be reviewed for explicit definitions. When a claim or claim term is unclear, the disclosure may also be reviewed for implicit definitions. In some situations, the limitations from the disclosure may be imported into the claim when a claim term is unclear.

Along with the disclosure and other constituent parts of the patent application, the prosecution history must always be reviewed to learn whether any statements were made during prosecution which limit, refine or define any claim terms. *E.g.*, *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005) ("We cannot look at the ordinary meaning of the term . . . in a vacuum. Rather, we must look at the ordinary meaning in the context of the written description and the prosecution history."). There is a long-accepted rule that the prosecution history should be reviewed to

evaluate whether claimed terms have been defined, limited or otherwise given a special meaning by the applicant during prosecution of the patent. *Phillips*, 415 F.3d at 1317 citing *Vitronics*, 90 F.3d at 1582-83 and *Chimie v. PPG Indus., Inc.*, 402 F.3d 1371, 1384 (Fed. Cir. 2005). The prosecution history should be reviewed in all situations, but particularly to evaluate a claim term that is unclear. The prosecution history may include an express disclaimer of the scope of a claim or claim term. See *Phillips*, 415 F.3d at 1317. The prosecution history should also be reviewed to evaluate whether equivalents to claim terms are available.

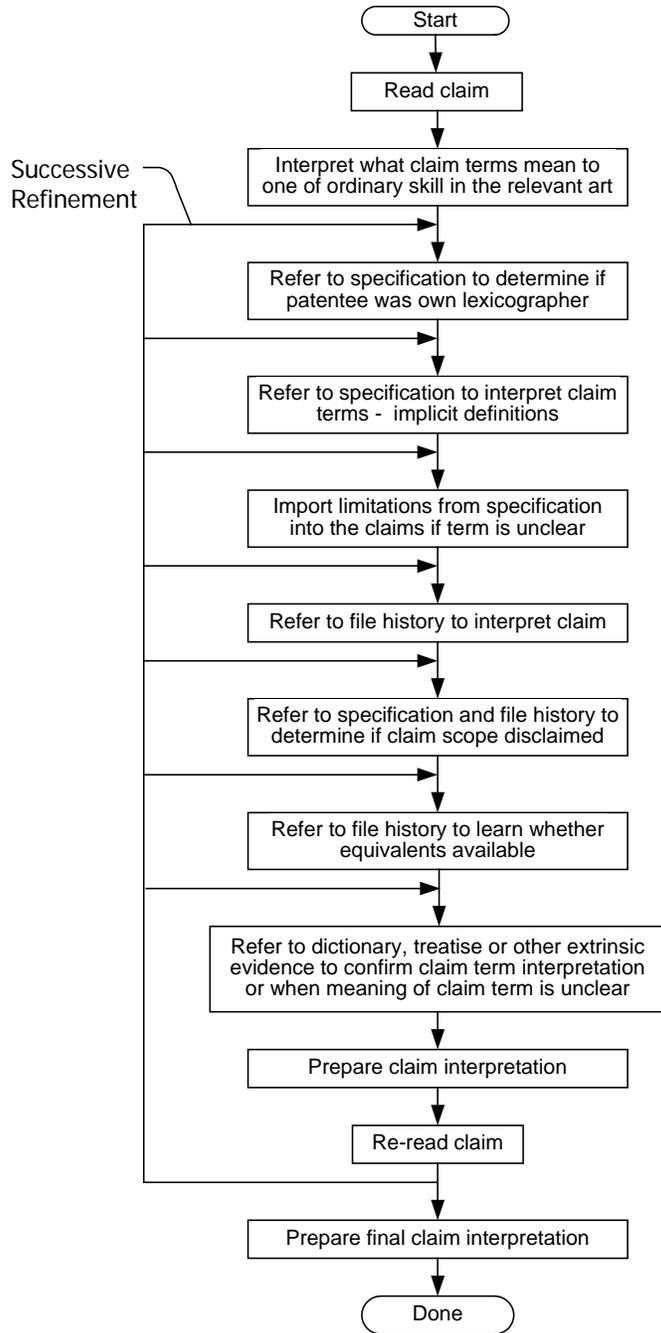
Extrinsic evidence may also be used when evaluating claims, particularly in those cases where no clear interpretation of the claims can be made. Extrinsic evidence in the form of dictionaries, treatises, and other works in publication as of the filing date of the patent should be considered to learn how one skilled in the relevant art at the time the patent was filed would interpret or understand claim terms. See *Phillips*, 415 F.3d at 1318, 1322. Extrinsic evidence may be used to verify or confirm the meaning of claim terms, and may also be used to interpret unclear claim terms when the intrinsic evidence did not yield a clear result.

The petitioner-recommended analysis is untenable in view of the long history of consultation of both the prosecution history and extrinsic sources in claim interpretation.

We maintain the recommendation we provided in our *amicus* brief in *Phillips v. AWH* in which we suggested an iterative approach that takes into consideration available patent rules. As we explained in that *amicus* brief, rarely is claim construction readily discernable upon an initial read of the disclosure and claims on the one hand or a quick resort to dictionaries and treatises on the other. Claim interpretation typically requires careful analysis of the whole of the intrinsic and extrinsic evidence.

Certainty of claim scope may be enhanced by a successive refinement of claim analysis based on review of the intrinsic evidence and the extrinsic evidence. For example, the patent's disclosure may provide only examples, a dictionary may provide several definitions, and the prosecution history may provide indicia of which definitions are apt. The goal should be not to follow a rigid guideline, but to achieve the desired end result – a claim interpretation commensurate with the breadth of the invention set forth by the inventor in the disclosure as of the earliest priority date.

The successive refinement approach is set forth in the following drawing.



When a patent is drafted in view of the totality of available rules, the skilled patent practitioner will include definitions of key claim terms in the disclosure. In this way, the skilled practitioner can attempt to control or even pre-ordain any future claim construction.

It is only when less than perfect patents fail to define claim terms or when claim terms that are not typically used by those skilled in the relevant art are included in the claims that a court must resort to grasping at straws in an attempt to discern a meaning of claim terms. It is with these less than perfectly drafted patents that grey areas of interpretation are entered. This is referred to herein as the grey zone and grey zone patents. For example, the “definition by implication” rule has been created to resolve such ambiguities. When in the grey zone, skilled minds will arrive at differing claim interpretations regardless of the clarity of rules of interpretation. Clear rules can not rescue a grey zone patent from the sea of uncertainty.

The controlling theme of controversy in patent cases is not the deficiency of available rules available to interpret patent claims, but the deficiencies in the patents themselves. It’s not the patent case law that leads to inconsistent interpretation, it’s the vagueness in patents themselves. No changes are in patent case law will reduce the amount of litigation caused by grey zone patents.

Should this Court grant certiorari in this case, we submit that it should be only to clarify and reiterate the rules set forth in *Phillips v. AWH*. However, as stated above, when a patent is in the grey zone, even the clearest rules will not yield a universally agreeable claim construction.

II. There is no Intracircuit Split Among Judges of the Federal Circuit

The petitioner attempts to paint a picture of division among the justices of the Federal Circuit Court. However, in *Phillips v. AWH*, 11 of 12 of the judges sitting *en banc* agreed with the claim construction rules stated by the majority. *Phillips*, 415 F.3d 1303. In an opinion which concurs in part and dissents in part, Judge Lourie recognized the harmony of the justices of the Federal Circuit when he stated:

I fully join the portion of the court's opinion resolving the relative weights of specification and dictionaries in interpreting patent claims, in favor of the specification. I could elaborate more expansively on that topic, but Judge Bryson's opinion for the majority says it so well, there is little reason for me to repeat its truths. I also agree with the court that claims need not necessarily be limited to specific or preferred embodiments in the specification, although they are limited to what is contained in the overall disclosure of the specification.

Phillips, 415 F.3d at 1328-1329. Nonetheless, application of the rules can be difficult and cause divergent outcomes. This is seen in the two cases cited by the petitioner in asserting that there is a division of claim interpretation rules used by the Federal Circuit. In arguing that there is a split among judges of the Federal Circuit, the petitioner cites cases that merely exemplify the difficulty in applying patent rules. There is general agreement as to the rules, but there is often disagreement in the application of the rules when the patent at issue is in the grey zone mentioned above.

For example, in *Free Motion v. Cybex*, the dissent merely takes issue with how the applicable patent rule was applied by the majority, not whether an appropriate rule existed for the judges to use to evaluate the claim at issue. *Free Motion Fitness, Inc. v. Cybex Int'l, Inc.*, 423 F.3d 1343 (Fed. Cir. 2005). The majority in *Free Motion* stated that under *Phillips v. AWH*, when determining the ordinary meaning of a claim term, the claim will *not* presumptively receive its broadest dictionary definition; rather the intrinsic evidence will be scrutinized to determine the most appropriate definition of the claim term. *Id.* at 1348-1349. The *Free Motion* dissent actually agrees with the majority when it accuses the majority of taking “the broadest available abstract meaning of a claim term.” *Id.* at 1355. The dissent merely accuses the majority of not following the rule it stated it would apply. Conflicting approaches to patent law do not exist between the majority and dissent in *Free Motion*, merely a difference in factual interpretation is presented.

Similarly, in *Dorel Juvenile v. Graco*, the dissent did not disagree with the claim construction rules used by the majority, but disagreed with the interpretation of the facts of the case using the available claim construction rules. *Dorel Juvenile Group, Inc. v. Graco Children's Prods., Inc.*, 429 F.3d 1043 (Fed. Cir. 2005). In *Dorel Juvenile*, the dissent criticized the majority for failing to properly interpret the claims in the context of the specification. *Id.* at 1050. However, the majority in *Dorel Juvenile* reviewed the specification, found it lacking, and used its skill to interpret the claims according to their view of the specification. *Id.* at 1046 (“The specifications of the patents in suit are mainly directed to the claimed cup holder feature of the inventions, and there is little reference to the concept of the removability of the seat from the base.”). As with *Free Motion*, in *Dorel Juvenile* conflicting claim interpretation approaches do not exist between the majority and dissent, but, rather, there is divergent application of available rules driven by the facts of the case.

These two cases exemplify what happens when learned judges analyze facts to interpret a grey zone patent – they arrive at different results.

It is the patentee who can best ordain the outcome of patent claim interpretation of a patent by using definitions in patents. The definitions provide lawyers and judges the tools with which to ascertain the breadth and scope of a claimed invention.

That claim interpretation is a difficult task was recognized by the majority opinion in *Phillips v. AWH*,

[T]here will still remain some cases in which it will be hard to determine whether a person of skill in the art would understand the embodiments to define the outer limits of the claim term or merely to be exemplary in nature. While that task may present difficulties in some cases, we nonetheless believe that attempting to resolve that problem in the context of the particular patent is likely to capture the scope of the actual invention more accurately than either strictly limiting the scope of the claims to the embodiments disclosed in the specification or divorcing the claim language from the specification.

Phillips, 415 F.3d at 1323-1324. When patents are drafted clearly, there are sufficient rules to interpret them. When the bounds of a patent are unclear, courts and lawyers can only use the tools at hand to best attempt to obtain an understanding of the patent rights. Although the goal of consistency of patent claim interpretation is one that all can agree on, attempting to create a new rule to achieve this idyllic consistency in the wake of grey zone patents is legal hubris.

CONCLUSION

For the foregoing reasons, we, the Conejo Valley Bar Association, urge the Court to either grant the petition for writ of certiorari to affirm and possibly refine the rules set out in *Philips v. AWH*, or deny the petition for writ of certiorari with an affirmative statement that the rules set out in *Philips v. AWH*, other case law, and the patent laws and rules themselves provide sufficient guidance for claim interpretation.

Respectfully submitted,

Mark Andrew Goldstein
SoCal IP Law Group LLP
310 N Westlake Blvd., Ste. 120
Westlake Village, CA 91362
(805) 230-1350
mgoldstein@socalip.com

COUNSEL FOR AMICUS CURIAE CONEJO VALLEY BAR
ASSOCIATION

March 6, 2006