

# Defining your terms

**Dennis Crouch, McDonnell Boehnen Hulbert & Berghoff, reviews the briefs filed in the *en banc* hearing in *Phillips v AWH Corporation***

Patent rights rise and fall according to the scope and meaning assigned to claim language. A narrow interpretation of claim terms can allow an accused violator to avoid patent infringement liability. On the other hand, a patent is more likely to be found invalid under a broad construction. Virtually every patent case involves some level of claim interpretation. Over the past several years, however, claim construction opinions in the United States courts, have been criticised as both inconsistent and confusing. Now, the Court of Appeals for the Federal Circuit (CAFC) has chosen the case of *Phillips v AWH Corporation* as its vehicle for setting the record straight.

In its decision to allow an *en banc* review of *Phillips*, the Court requested *amicus* briefs from interested parties<sup>1</sup>. As it turns out, many are interested. In addition to the party briefs, well over thirty non-party briefs were filed in the rehearing.

The one brief specifically requested by the CAFC came from the United States Patent & Trademark Office (USPTO). The court had asked the USPTO to submit its position on whether the primary source for claim construction should be extrinsic evidence from dictionaries and other sources or intrinsic evidence from the patent documents. The USPTO complied by submitting a joint government brief along with the Department of Justice, and the International Trade Commission.

The government brief neatly divides the questions asked by the court into three categories: (1) how should various types of evidence, particularly dictionaries and the specification, be relied on for claim construction; (2) how should the specification be used to interpret claims without impermissibly importing limitations into the claims; and (3) what deference, if any, should the appeals court give to a district court's claim construction.

## Dictionaries v the specification

A dictionary often provides a broad general definition or "ordinary meaning" of a term. Conversely, the patent specification may only describe the term in a particular way or for a particular function. The recent case of *Nystrom v Trex* provides an illustration of the tension between these sources<sup>2</sup>. In *Nystrom*, a controversy arose around whether a "board" for the floor of a veranda could be made of any rigid material (dictionary definition) or was limited to a wooden construction (examples in specification). In this case, the Court sided with the ordinary meaning

by holding that a "board" could be non-wooden. Yet, the dissent in *Nystrom* illustrates that cases continue to be decided on both sides of the fence.

In a move away from ordinary meaning, the government brief outlined the position that dictionaries should not be primary references for claim construction, in part because dictionaries are not used by patent examiners during prosecution. Citing the CAFC's own legal precedent in *Markman*<sup>3</sup>, the government argued that a "patent is a fully integrated written instrument," and should be treated as such. The government's position was supported by a majority of the *amicus* briefs, albeit for

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different reasons. The Intellectual Property Owners Association (IPO), for example, argued that the specification and prosecution history, as public documents, provide the best available source of claim meaning. In addition, the IPO highlighted the uncertainty associated with extrinsic sources "depending upon which dictionary, treatise, reference, or witness was deemed most convincing to a court." In its brief, the Intellectual Property Law Association of Chicago (IPLAC) noted that when executing their patents, few inventors would expect "that the scope of any claim of a resultant patent will be determined by a dictionary – be it general or technical."

Professors Joseph Miller and Polk Wagner showed their fondness for dictionary definitions. In their view, unless the patent document provides a clear, specific, and objective definition of a term, there should be a heavy presumption in terms of ordinary meaning and dictionary definitions. According to Mr Miller & Mr Wagner, "[d]ictionaries are not a panacea, but they offer the best opportunity to provide a term's ordinary meaning with clarity, certainty, and predictability."

Standing precedent states that claims should be read in light of the specification, and that limitations in the specification should not be read into the claims<sup>4</sup>. These "twin axioms"

of claim construction provide the backdrop for the question of how to use meanings that are derived from the specification.

The government argued that courts should not "infer a more narrow definition of a disputed claim term from the specification" if the term is used in an "exemplary" or non-essential fashion. However, the government added that the specification should limit the claims if the specification, "as a whole suggests that the very character of the invention requires the limitation."<sup>5</sup>

A solution proposed by the American Intellectual Property Law Association (AIPLA) is to look first to the specification for contextual understanding. However, according to AIPLA, the court should not use the specification to limit claim terms merely because: "(1) there is only one disclosed embodiment, and the meaning causes the claim to cover more than that embodiment; (2) all disclosed embodiments have a common attribute, and the meaning causes the claim to cover embodiments both with the common attribute and without it; or (3) the meaning causes the claims to define subject matter which achieves only some of several objectives or purposes for the invention set forth in the specification." (Citations omitted).

In a combined brief, Cingular and RIM focused on a narrow construction of claim terms. They recommended that any claim construction be directly supported by the specification and consistent with any intrinsic evidence and that "ambiguous claim terms should be construed narrowly against the patentee."

Many briefs opined on when, if ever, claims should be construed in order to avoid invalidity. A full gamut of positions were submitted, ranging from never (BIO) to whenever practicable (Parus Holdings). Intermediate positions offered several specific instances when claims should be narrowly construed. For example, AIPLA suggested that the claims should only be narrowly construed if the applicant and examiner would have been aware of the basis for invalidity. Similarly, Cingular and RIM indicated that claims should be narrowly construed to avoid prior art expressly applied by the patent examiner during prosecution and to avoid written description and enablement §112 violations.

In their policy argument, the Public Patent Foundation (PPF) argued that focusing on invalidity during claim construction chills innovation and encourages the user of ambiguous claim language. Falling in line

with their non-profit cousin, the Electronic Frontier Foundation (EFF) advised that the court should strictly enforce §112 by invalidating all ambiguous claims.

Claim construction, like statutory construction, is a matter of law that is reviewed *de novo* on appeal<sup>6</sup>. However, the government brief took the position that a district court is better situated than the CAFC to judge certain aspects of the task of claim construction. In addition, the government argued that the high reversal rate due to *de novo* consideration has led to an unappealing level of uncertainty in the courts.

Several briefs, including that submitted by the American Bar Association (ABA), argued that the CAFC should defer to the trial court on factual issues in claim construction. On the other side was the Houston IP Law Association (HIPLA) who noted that precedent is clear – claim construction is a matter of law. HIPLA acknowledged the policy arguments in favour of a more nuanced review of trial court decisions, but argued that such a decision from the *en banc* panel could not come without revisiting *Cybor Corp.*<sup>7</sup>.

The use of scientific expert testimony has been proposed as a way to uncover the “ordinary meaning” of claim terms. For example, IPLAC noted that expert testimony has a proper and potentially important role in helping a judge to understand the scope of an invention. However, as cautioned by the ABA, expert testimony should not be allowed to

contradict ordinary meaning of claim terms that are discernable from primary sources.

Several briefs took a more narrow view of expert testimony. For example, BIO argued that expert testimony should only be used to establish the appropriateness of the user of a particular extrinsic written source as evidence. BIO's words of caution stemmed from the perceived bias of expert testimony.

At the extreme, the Conejo Valley Bar Association proposed that expert testimony play no role in determining ordinary meaning of a claim term. Rather, if dictionaries are unavailable, Conejo proposed that written documents such as trade journals and proposed standards be used because of the unwavering nature of the written word. In the brief, they note that excluding expert testimony provides an added benefit of saving the high costs associated with expert witnesses.

Claims define a patent's area of exclusion. As such, understanding the meaning of claim

terms is central to an understanding of the scope and coverage of the claims. The outcome of *Phillips* is likely to change how claims are interpreted, and thus how they are both litigated and prosecuted. However, only time will tell whether the changes will lead to more or less clarity and consistency.

Oral arguments are expected to be scheduled for early spring 2005. ☺

#### Notes

- 1 *Phillips v AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004).
- 2 71 U.S.P.Q.2d 1241 (Fed. Cir. 2004).
- 3 *Markman v Westview Inst.*, 52 F.3d 967, 978 (Fed. Cir. 1995).
- 4 *Liebel-Flarsheim Co. v Medrad, Inc.*, 358 F.3d 898, 904-905 (Fed. Cir. 2004).
- 5 *Quoting Sunrace Roots Enter. Co. v SRAM Corp.*, 336 F.3d 1297, 1305 (Fed. Cir. 2004).
- 6 *Cybor Corp v FAS Technologies, Inc.*, 138 F.3d 1448, 1456 (Fed. Cir. 1998) (en banc).
- 7 *Id.*

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