

*Oral Arguments in Phillips v. A.W.H. were held on February 8, 2005 at the Federal Circuit Courthouse in Washington D.C. The following is a transcript of the arguments. – Dennis Crouch.*

Manthie (counsel for Phillips): The term "baffle" is described in the specification as having many different purposes, such as for containing sound; for repelling bullets; for load-bearing purposes; and for containing heat. Only one of the disclosed baffles is the preferred embodiment. Figures 4 and 7 of the patent show different types of baffles.

Lourie: Doesn't the specification define the word "baffle?" The only baffles disclosed in the specification are those that are numbered in the figures and show an angle less than 90 degrees?

A: Figure 7 shows a piece that is a baffle, which is described in col. 2 as "baffle construction." So, not all baffles are numbered in the figures.

Lourie: Are you saying we should rely on a dictionary?

A: No, you should read the specification first, then the claims. If the claims are broader than the specification, then you should rely on the (broader) claims. The purpose of the specification is to provide written description and enablement, not to narrow the claims. There are 3 types of terms: (1) ordinary terms – not a term of art – rely on general usage, such as in a dictionary; (2) terms of art, for which a technical dictionary or treatise should be consulted; and (3) [cut off]

Linn: Should the ordinary meaning in a claim term govern, or should the specification control the scope of a claim term?

A: The claims should control, not the specification. Only if there is a clear disavowal of scope in the specification or a clear definition should a narrower claim scope be adopted.

Dyk: If the claims are broader than the specification, doesn't that create a problem?

A: No, the specification is written to satisfy the written description, enablement, and best mode requirements, not to define the scope of the claims.

Gajarsa: Don't you always start by reading the patent?

A: Yes, you read the patent, then the claims.

Gajarsa: When do you use a dictionary?

A: If it's an ordinary term, then you can rely on a dictionary to see if there is a definition that fits with the specification.

Gajarsa: If baffle has different functions in the patent, how do we resolve which one controls?

A: An ordinary person would know that the main function of the baffle in the patent is its load bearing function. The patent never says that the baffles are "bullet proof." Item 16 [in the figure?] is described as possibly deflecting a bullet if one is fired. But you could have different shapes and it would still deflect a bullet.

Lourie: If you use different shapes, then isn't that a different invention?

A: These are not the only possible configurations – it merely shows that there are at least

4 configurations. Figure 7 shows baffles at a 90-degree angle. There is no reason for the main function (load bearing) to be limited to a certain angle.

Bryson: So the specification can be limiting if there is a clear definition, but what about an implicit narrowing, as in Vitronics? Can the specification limit by implication?

A: No, that's where the problem arises. Different people have different interpretations of the specification. It's like the famous Supreme Court case – you know pornography when you see it. The devil is in the details of "implicit." Judge Krieger [district judge in this case] said that "baffle" required both an angle limitation and an interlocking limitation. The prior panel decision in this case said that only the angle was required by the specification. Judge Dyk in dissent said the specification required neither limitation. There are just too many possibilities. Nothing in the claim mentions the function of deflecting bullets.

Fischer (counsel for AWH): The Supreme Court long ago said in the Adams case that claims must be interpreted in light of the specification – the court must ascertain what is the invention?

Michel: Focus on where you disagree with Mr. Manthie. What did he say that you disagree with?

A: The court should read the specification first, not a dictionary first.

Michel: What does "primary" mean?

A: It is the touchstone – the source against which all other definitions are assessed.

Linn: Where in the specification is there a definition of "baffle?"

A: It is not expressly defined, but the specification at col. 6 lines 10-17 states that several advantages are obtained, including thermal isolation and protection from bullets. That tells us what the invention is.

Lourie: What about the 6 numbers in the specification?

A: Those identified the versions of baffles.

Lourie: You mean embodiments?

A: Yes, embodiments of the baffle. The only ones. The baffles are discussed in column 2 at lines 11-15 (formed interlocking baffles).

Clevenger: Are there baffles shown in Fig. 7?

A: Yes. They extend and form an intermediate barrier.

Lourie: Isn't that really a support for the baffles, rather than a baffle?

A: It's not clear in the specification. The specification says that the baffles are for the purpose of deflecting bullets.

Clevenger: If you shoot a bullet through the wall, would it be deflected?

A: Yes.

Clevenger: So that piece must also be a baffle? It meets the definition of baffle?

A: yes, but you must ascertain the invention. It must be other than 90 degrees to deflect.

Clevenger: But we are looking at the process – what is your position on “implicit narrowing” based on the specification? Should we require an explicit narrowing in order to narrow a claim term?

A: Implicit narrowing is proper.

Clevenger: How can we tell if something has been “implicitly narrowed?”

A: If an element is described as essential to the invention, and there are no other examples given, then it is implicitly narrowed.

Clevenger: Should we rely on the “purposes” of the invention? Must it be unequivocally expressed? What if it’s a “multi-purpose patent?”

A: [none]

Dyk: Where does the patent say that acute angles are essential to the invention?

A: The patent lists various advantages: modular and bullet resistance; modules, and acoustic isolation.

Rader: Is something a “baffle” if it meets only two of the purposes? What if it meets three of the four “purposes?”

A: The only function of the baffles is being bullet proof. There is nothing in the patent regarding heat or sound isolation.

Rader: But column 4 says baffles are load bearing? The patent also discusses thermal buffering? How is the judge to decide among these 4?

A: You must look at the meaning of baffle. A baffle is modified by load supporting. The load supporting function is not part of the word “baffle.”

Rader: Must a baffle perform all 4 functions?

A: No, but a baffle must at least deflect bullets.

Michel: Is it clear that only angled baffles can deflect bullets? It seems to me that even a parallel baffle would deflect bullets?

A: It must be other than 90 degrees to deflect bullets.

Bryson: What if you fired a bullet at it and the baffle was at other than 90 degrees?

A: There are 2 essential elements for a baffle: (1) it must be other than 90 degrees; and (2) it must be a barrier within the module.

Gajarsa: There is nothing in the specification regarding the angle of any particular degree? How do we get to that?

A: The claims cover a broad range of angles, including figures 6-7. It includes 45 degrees, bent, and multiple angles.

Gajarsa: So where does the non-90 degree requirement come from?

A: A substantial portion of the baffle must be at an angle other than 90 degrees.

Dyk: What about claim differentiation? Dependent claims recite angles?

A: Claims 1-2: claim 1 covers a large range of angles; it must project inwardly. Claim 1 corresponds to figures 6-7. Claim 2 is limited to figure 6, where there is an angle alpha incident.

Dyk: But claim 2 adds an angled baffle that was not present in claim 1?

A: Both claims have baffles. Claim 2 is different in scope – it deals with the angle.

Clevenger: Claim 2 was not asserted against you? Why can't claim 1 include 90 degrees? You agree that a 90 degree angle could deflect a bullet?

A: The baffles must be both 90 degrees and ---

Clevenger: So you agree that claim 1 includes right angles?

A: The baffle must form an intermediate barrier to deflect. Claim 7 –

Newman: There was a concession by the plaintiff, that if the claims are limited by the specification, then there is no infringement? One way of reading a patent is to say that the claims are part of the specification. So if you just look at the specification, the weight of the specification has a baffle with limitations. But what about the broader disclosure in the claims, which are not limited in the way the specification is?

A: The claims are part of the specification. It is wrong policy to allow the claims to be broader than what is taught by the specification.

Michel: Is this dispute over whether an implicit definition is permissible?

A: Yes, but the briefs suggested that dictionaries were the dispute.

Rader: What about complex biotech or electrical inventions? Should the Federal Circuit defer to the district court?

A: Yes.

Rader: On what basis?

A: Yes, but the case law of this court says no.

Mayer: What deference should be accorded?

A: We advocate a middle standard – findings of fact would be subject to Rule 52 – parts of claim interpretation.

Clevenger: Can you give some examples?

A: The nature of the art; the nature of the person of skill in the art; determining what resource is used by a person skill (dictionaries); and credibility of experts.

Clevenger: What about the ordinary meaning of customary terms? Is that a fact?

A: --

Manthei (rebuttal): We only conceded summary judgment based on all the findings, so if there are any changes, there should be a remand. A person of ordinary skill in the art would see that the load bearing feature – must have a flange or bend. Also spaced together.

Mayer: Are these facts?

A: Yes, from a treatise, the district judge found these. As to deference, we agree on deference as to "pure" facts, but not mixed facts.

Gajarsa: Do we need a dictionary in this case?

A: No, there was a stipulated definition, but we agree on the dictionary.

Prost: So there is no dispute on the facts?

A: Judge Krieger –

Dyk: There was no testimony regarding the meaning of "baffle?"

A: No, we argued it was not a term of art.

Linn: If we use the dictionary, then which one, and what meaning(s) from that dictionary?

A: The parties should get deference. The patent owner might propose multiple definitions, and the defendant would propose narrower definitions. Then the court should narrow it down to two competing definitions. Then we can run those through the specification. If they are both plausible, then OK.

Lourie: ---

A: Any dictionary for common terms, and a treatise for technical terms.

Newman: What if it's not in litigation? Persons read patents for technical information. We can't impose an elaborate structure on these people? You read the specification as a whole and figure out what was claimed? Don't you begin with the specification? What about priority of sources?

A: The invention is defined by the claims. If the claims are broader than the specification, then it's OK unless there is an explicit narrowing.

Newman: What about enablement?

A: That's not at issue here. The specification doesn't indicate breadth. That's the purpose of the claims.

Lourie: Mustn't the specification enable the full scope of the claims?

A: Yes.

Michel: If we agree with you about restricting implicit redefinitions, what about our prior

case law such as Bell Atlantic?

A: The reason this court went en banc was to set some guidelines. Maybe it can be implicit if it is very clear.

Whealan (representing the U.S. government): --

Rader: The PTO relies on "broadest reasonable interpretation" which is different than courts?

A: Yes, the applicant has the opportunity to amend or clarify the scope at the PTO.

Rader: Would it help if the PTO relied on the same scope as courts? Doesn't that create a problem?

A: No, we would keep it as is. The PTO performs a gatekeeper function. If the scope is unclear, let the applicant amend around it.

Dyk: What is the basis for saying that examiners don't use dictionaries?

A: It's a training issue – they typically don't use them.

Dyk: But doesn't the MPEP say to use dictionaries?

A: Yes, but as a practical matter they are not used.

Clevenger: Don't the examiners carry dictionaries in their heads?

A: Yes, but they all have different dictionaries. Examiners have specialized knowledge. They start with the specification, not dictionaries. As to the "battle of the dictionaries" problem, just to clarify, we suggest starting with the specification, not a dictionary. The Superguide concurrence – start with the ordinary meaning to a person of skill in the art as used in the art. Don't start with a dictionary.

Clevenger: What if it's a technical term? Is it OK to use an EE dictionary that the parties agree on?

A: It's irrelevant what you read first. The key is: what weight should be given to it?

Clevenger: Is it OK to rely on a dictionary? Is it error to use a regular dictionary if it's a technical term?

A: If you are dealing with sequencing, that word means something different in electronics and biotech.

Prost: You are saying who cares about the order? The PTO doesn't start with the dictionary?

A: There is nothing wrong with the order.

Clevenger: Should we overrule our prior cases?

A: It should be clarified that the starting point is not the dictionary.

Clevenger: But it's OK to read it first?

A: What one reads first is irrelevant – what one relies on first is critical. It's like legislative history analysis. It's OK to gather evidence in any form, but you start with the specification for reliance. Don't start with the dictionary.

Dyk: The Supreme Court in statutory construction says to start with the dictionary?

A: But the dictionary doesn't reflect one skilled in the art. The place to start is the specification.

Dyk: What if there is nothing explicit in the specification?

A: Yes, it's OK to rely on implicit definitions or meanings from the specification. The Novartis case – not all terms were expressly defined. The next point is – when does the specification narrow a claim term? Look at the Bard and Astrazeneca cases. A detailed analysis of the specification and prosecution history. In Brookhill, the same analysis was applied – "remote" was not limited by the specification or prosecution history. So broader is fair. The Brookhill and Bard cases are instructive.

Rader: Should there be deference to the district court on fact-finding?

A: The court has not taken that issue en banc. The government has no position on that.

Rader: Answer the question. What fact components would have deference?

A: 499 U.S. 225: The Supreme Court has said that even if something is de novo, you don't start from scratch. You see if the lower court was persuasive. See Judge Bryson's concurrence in Cybor.

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