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## Phillips v. AWH Corp., Inc.: A Baffling Claim Construction Methodology

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## Phillips v. AWH Corp., Inc.: A Baffling Claim Construction Methodology

Cover Page Footnote

Jack Barufka

# PHILLIPS v. AWH CORP., INC.: A BAFFLING CLAIM CONSTRUCTION METHODOLOGY

Ehab M. Samuel\*

INTRODUCTION .....	520
I. IDEOLOGY OF THE TWO APPROACHES TO CLAIM CONSTRUCTION .....	521
A. <i>CONTEXT AS PRIMARY SOURCE OF CLAIM CONSTRUCTION</i> .....	523
B. <i>DEFINING CLAIMS IN THE SPECIFICATION BY IMPLICATION</i> .....	526
C. <i>THE PRESUMPTION OF ORDINARY AND ACCUSTOMED MEANING AND THE COURT’S INCREASED RELIANCE ON DICTIONARIES</i> .....	529
D. <i>OVERCOMING THE “HEAVY PRESUMPTION” OF A CLAIM TERM’S ORDINARY MEANING</i> .....	533
E. <i>LINGUISTIC ANALYSIS OF CLAIMS</i> .....	539
F. <i>THE RISE OF THE SUGGESTION TEST IN CLAIM CONSTRUCTION</i> .....	541
G. <i>INHERENT PROBLEMS ASSOCIATED WITH SPECIFICATION- BASED AND CLAIM-BASED APPROACHES</i> .....	545
II. THE ROLE OF EXTRINSIC EVIDENCE IN CLAIM CONSTRUCTION .....	549

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520	<i>FORDHAM INTELL. PROP. MEDIA &amp; ENT. L.J.</i> [Vol. 16:519]	
III. OVERLAPPING CLAIM CONSTRUCTION WITH VALIDITY ANALYSIS.....		552
IV. PHILLIPS: AN ATTEMPT TO RESOLVE THE TENSION BETWEEN SPECIFICATION-BASED AND CLAIM-BASED APPROACHES.....		555
A. <i>THE TRIAL COURT AND FEDERAL CIRCUIT PANEL DECISIONS</i> .....		555
B. <i>THE EN BANC DECISION</i> .....		557
CONCLUSION.....		566

## INTRODUCTION

Construing patent claims has been a daunting task for judges, litigators, and competitors because of the ideological split between Federal Circuit judges. Some Federal Circuit judges follow a “specification-based approach” by relying on the written description and the prosecution history to limit the scope of the claims to what was disclosed. Other Federal Circuit judges follow a “claim-based approach” by referring to dictionaries to determine the ordinary meaning of a disputed claim term. This continuing debate has prompted the Federal Circuit to grant a petition to rehear *en banc* the case of *Phillips v. AWH Corp.*<sup>1</sup>

To appreciate the consequences of this decision, this Note explores the advantages and disadvantages of the claim-based and specification-based approaches. The Note emphasizes that courts should not get distracted with determining a concretized meaning of disputed claim words using dictionaries alone. “A word is not a crystal, transparent and unchanged; it is the skin of a living thought and may vary greatly in color and content according to the circumstances and the time in which it is used.”<sup>2</sup> Relying on dictionaries alone encourages superficial claim construction with

<sup>1</sup> *Phillips v. AWH Corp.*, 363 F.3d 1207 (Fed. Cir. 2004), *reh’g en banc granted*, 376 F.3d 1382 (Fed. Cir. 2004).

<sup>2</sup> Jennifer R. Johnson, *Out of Context: Texas Digital, the Indefiniteness of Language, and the Search for Ordinary Meaning*, 44 IDEA 521, 532 (2004) (quoting Towne v. Eisner, 245 U.S. 418, 425 (1918)).

inadequate technical understanding of the invention. By reviewing the specification and the prosecution history with an eye to a person skilled in the pertinent art, only then can a judge ascertain the proper meaning of a claim term.<sup>3</sup> But the question still lingers, even past the *Phillips en banc* decision, on what constitutes an improper narrowing of a claim caused by importing a limitation from the specification into the claim, and what constitutes a proper reading of a claim in light of the specification.

Part I of this Note presents the analytical framework of the specification-based and claim-based approaches.<sup>4</sup> It examines the methods by which one can overcome the “heavy presumption” that a claim term carries its ordinary and customary meaning. Part I also points out that the Federal Circuit, in employing the claim-based approach, refused to narrow multiple dictionary definitions based on a rising threshold, referred to in this Note as the Suggestion Test.<sup>5</sup> Part II explores the role of extrinsic evidence in claim construction<sup>6</sup> and Part III evaluates the Federal Circuit’s controversial commingling of claim validity analysis with claim construction.<sup>7</sup> Finally, Part IV demonstrates how the two approaches to claim construction conflict in *Phillips v. AWH Corp.*, and presents the eagerly anticipated *en banc* decision that provided little guidance to the patent community.<sup>8</sup>

## I. IDEOLOGY OF THE TWO APPROACHES TO CLAIM CONSTRUCTION

Since the inception of the Federal Circuit in 1982, the underlying principles of claim construction have changed. In the past, the Federal Circuit applied the “specification-based approach” by relying on the context of a claim term used in the written description and the prosecution history to determine its

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<sup>3</sup> See *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998) (“the patent disclosure serves to point away from the improper meanings and toward the proper meaning.”).

<sup>4</sup> See *infra* notes 9–219 and accompanying text

<sup>5</sup> See *infra* notes 158–86 and accompanying text

<sup>6</sup> See *infra* notes 220–41 and accompanying text

<sup>7</sup> See *infra* notes 242–58 and accompanying text

<sup>8</sup> See *infra* notes 259–345 and accompanying text

meaning.<sup>9</sup> However, today, some Federal Circuit judges prefer dictionaries as the primary source for determining the ordinary meaning of the claims.<sup>10</sup> This disparity is due to the application of the twin canons of claim construction: (1) “one may not read a limitation into a claim from the written description”, but (2) “one may look to the written description to define a term already in a claim limitation, for a claim must be read in view of the specification which it is a part.”<sup>11</sup>

These canons provide competing principles in claim construction. While the first canon prohibits importing a limitation from the specification into the claims, the second canon permits defining a claim term based on what is disclosed in the specification, which inevitably leads to importing the definition from the specification into the claims.<sup>12</sup> The Federal Circuit recognized that “there is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification.”<sup>13</sup> However, the court did not explain to what extent its reading “in view of” the written description constitutes importing a limitation into the claim.

Typically, proponents of the specification-based approach characterize their narrow interpretation of claims as being “read in light of the specification.”<sup>14</sup> They justify their claim construction by suggesting that “[c]laims are not interpreted in a vacuum, but are part of . . . the specification.”<sup>15</sup> Conversely, proponents of the claim-based approach interpret the claims broadly so that

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<sup>9</sup> *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976–88 (Fed. Cir. 1995) (en banc).

<sup>10</sup> *Texas Digital Sys. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002).

<sup>11</sup> *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998).

<sup>12</sup> *See id.*

<sup>13</sup> *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir. 1998).

<sup>14</sup> *Phillips v. AWH Corp.*, 363 F.3d 1207, 1213 (Fed. Cir. 2004), *reh'g en banc granted*, 376 F.3d 1382 (Fed. Cir. 2004).

<sup>15</sup> *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001) (quoting *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116 (Fed. Cir. 1987)).

limitations “are not to be read into the claim.”<sup>16</sup> They emphasize that “while . . . claims are to be interpreted in light of the specification and with a view to ascertaining the invention, it does not follow that limitations from the specification may be read into the claims.”<sup>17</sup> These diverging views in applying the twin canons of claim construction have been the subject of debate for many years.

#### *A. Context As Primary Source Of Claim Construction*

One of the early cases that applied the specification-based approach was the *Markman en banc* decision.<sup>18</sup> The patent was directed to a dry-cleaning inventory-control system for tracking the progress of clothing items.<sup>19</sup> At issue was the meaning of the claim term “inventory.”<sup>20</sup> The patentee argued that inventory meant articles of clothing or dollars, while the accused infringer alleged that the claim term referred only to clothing.<sup>21</sup>

To determine the meaning of the disputed claim term, the Federal Circuit considered three sources: the claims, the specification, and the prosecution history.<sup>22</sup> The court emphasized that “[c]laims must be read in view of the specification, of which they are a part.”<sup>23</sup> Further, the court explained that the written

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<sup>16</sup> *Comark*, 156 F.3d at 1186 (quoting *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed. Cir. 1988)).

<sup>17</sup> *Id.* (quoting *Sjolund v. Musland*, 847 F.2d 1573, 1581 (Fed. Cir. 1988)).

<sup>18</sup> *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976–88 (Fed. Cir. 1995) (en banc). Aside from applying the specification-based approach, the Federal Circuit addressed whether claim interpretation is an issue of law or fact, which was ultimately resolved by the Supreme Court. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388–89 (1996) (suggesting that claim construction is a “special occupation” that requires “special training and practice,” and that judges are “more likely to be right, in performing such a duty, than a jury can be expected to be.”). For the sake of “uniformity,” the Supreme Court allocated all issues of claim construction to the court. *Id.* at 390. *See also Cyber Corp. v. FAS Techs., Inc.*, 138 F.3d 1446, 1454–57 (Fed. Cir. 1998) (en banc) (confirming that claim construction is a matter of law, that the Federal Circuit reviews *de novo* on appeal).

<sup>19</sup> *Markman* (en banc), 52 F.3d at 971.

<sup>20</sup> *Id.* at 973.

<sup>21</sup> *Id.* at 974–75.

<sup>22</sup> *Id.* at 979–80. Collectively, these three sources (the claims, the specification, and the prosecution history) are referred to as the intrinsic record.

<sup>23</sup> *Id.* at 979.

description “may act as a sort of dictionary, which explains the invention and may define terms used in the claims,”<sup>24</sup> and that the prosecution history should also be considered if it is in evidence.<sup>25</sup>

In addition to the intrinsic record, the Federal Circuit noted that extrinsic evidence can “be used for the court’s understanding of the patent, [and] not for the purpose of varying or contradicting the terms of the claims.”<sup>26</sup> It “may be helpful to explain scientific principles, the meaning of technical terms, and terms of art that appear in the patent and prosecution history.”<sup>27</sup> The court identified extrinsic evidence as “all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises.”<sup>28</sup>

Applying its analytical framework to the facts of the case, the Federal Circuit concluded that the disputed claim term “inventory” refers to articles of clothing.<sup>29</sup> While the disputed claim term could mean cash or money, the court focused on the *context* in which the term was used in the claim, the specification, and the prosecution history.<sup>30</sup> The court noted that the specification “is pervasive in using the term ‘inventory’ to consist of ‘articles of clothing’” and that the prosecution history supported its claim construction.<sup>31</sup>

In another Federal Circuit opinion, the court applied the specification-based approach to construe the disputed claim term.<sup>32</sup> The patent was directed to balloon dilation catheters used in coronary angioplasty procedures for removing restrictions in the coronary arteries.<sup>33</sup> The patentee argued that the disputed claim

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<sup>24</sup> *Id.* at 980 (“The caveat is that any special definition given to a word must be clearly defined in the specification.”).

<sup>25</sup> *Id.*

<sup>26</sup> *Id.* at 981.

<sup>27</sup> *Id.*

<sup>28</sup> *Id.* at 980. Note that dictionaries were considered extrinsic evidence, and accordingly, may not vary or contradict the terms of the claims.

<sup>29</sup> *Id.* at 982–83.

<sup>30</sup> *Id.*

<sup>31</sup> *Id.* at 982.

<sup>32</sup> *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337 (Fed. Cir. 2001).

<sup>33</sup> *Id.* at 1339.



term, “lumen,” included two types of catheter configurations: a dual lumen configuration and a coaxial lumen configuration.<sup>34</sup> The accused infringer argued that the specification limited the scope of the claim term to coaxial lumen catheters.<sup>35</sup>

Relying on the specification, the *Scimed* court determined that the patentee disclaimed the dual lumen configuration.<sup>36</sup> Although the patentee suggested that the lower court had committed “one of the cardinal sins of patent law—reading a limitation from the written description into the claims,” the Federal Circuit disagreed and noted that the claims were properly “read in view of the specification, of which they are a part.”<sup>37</sup> The court emphasized that:

Where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question.<sup>38</sup>

Turning to the facts of the case, the Federal Circuit noted that the patentee overcame prior art by describing advantages of the invention’s coaxial lumen configuration over the prior art dual lumen catheters.<sup>39</sup> Furthermore, the patentee described in the

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<sup>34</sup> *Id.*

<sup>35</sup> *Id.*

<sup>36</sup> *Id.* at 1340. Like *Markman*, the *Scimed* court spent virtually no time analyzing the language of the claims, and instead, defined the scope of the claims by way of the written description itself. See John Josef Molenda, *Understanding The Federal Circuit’s Internal Debate and Its Decision to Rehear Phillips v. AWH Corp. En Banc*, 86 J. Pat. & Trademark Off. Soc’y 911, 919–20 (2004).

<sup>37</sup> *Id.* at 1340–41 (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976–88 (Fed. Cir. 1995) (en banc)); see *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116 (Fed. Cir. 1987) (“Claims are not interpreted in a vacuum, but are part of and are read in light of the specification”). See also *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186–87 (Fed. Cir. 1998) (noting that “there is a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification.”).

<sup>38</sup> *Id.* at 1341.

<sup>39</sup> *Id.* at 1342–43. *But see* *Northrop Grumman Corp. v. Intel Corp.*, 325 F.3d 1346 (Fed. Cir. 2003) (holding that the written description did not suggest that the invention must always be used in a manner that achieves the advantage recited). The *Northrop*

written description that the coaxial lumen configuration was “the basic sleeve structure for all embodiments of the present invention contemplated and disclosed herein.”<sup>40</sup> Because the patentee identified, criticized, and disclaimed the dual lumen configuration, the scope of the disputed claim term was limited to the coaxial lumen configuration.<sup>41</sup>

Both *Markman* and *Scimed* illustrate that reliance on the specification was necessary in determining the meaning of the disputed claims. If the context by which the term was used in the claim, specification, and prosecution history was not taken into consideration, a different outcome would likely have occurred. Relying on the context for construing claims allows judges and the public to understand what the patentee’s invention is. It is the patentee’s expression of these terms in the intrinsic record that shed light as to what the patentee meant in his claims. However, as explained earlier, relying on the specification may run afoul of the claim construction canon against reading limitations from the written description into the claims.

#### *B. Defining Claims In The Specification By Implication*

In *Vitronics*, the Federal Circuit expanded on *Markman*’s analytical framework to claim construction.<sup>42</sup> In doing so, the court established a hierarchy of evidence that can be used to construe claims.<sup>43</sup> The court required that intrinsic evidence of record, i.e., the claims, the specification, and the prosecution history, should be consulted before relying on extrinsic evidence.<sup>44</sup>

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case, discussed *infra* notes 180–86 and accompanying text, is one example that shows how the specification-based approach as applied in *Scimed* is different from the claim-based approach.

<sup>40</sup> *Id.* at 1343. Therefore, if a patentee stated in the specification that all embodiments contain a specific feature of the invention, the claim will be limited to that feature; however, if the patentee did not make such a statement, that feature of the invention contained in all the embodiments disclosed will not be read as a limitation into the claims. See *Comark*, 156 F.3d at 1187 (suggesting that “particular embodiments and examples appearing in the specification will not generally be read into the claims.”).

<sup>41</sup> *Id.*

<sup>42</sup> *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582–83 (Fed. Cir. 1996).

<sup>43</sup> *Id.* at 1582 .

<sup>44</sup> *Id.*

“Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language.”<sup>45</sup>

First, the court looked at the “ordinary and customary meaning” of the claim language itself to define the scope of the patented invention.<sup>46</sup> Second, the court reviewed the specification “to determine whether the inventor has used the claim terms inconsistent with their ordinary meaning.”<sup>47</sup> The *Vitronics* court emphasized that the “specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication.”<sup>48</sup> The specification is “the single best guide to the meaning of the disputed term.”<sup>49</sup> Third, the court analyzed the prosecution history of the patent because often it is of “critical significance in determining the meaning of the claims.”<sup>50</sup>

Next, the court indicated that it is improper to rely on extrinsic evidence when an analysis of the intrinsic record alone resolves any ambiguities in a disputed claim term.<sup>51</sup> Extrinsic evidence “may be used only to help the court come to the proper understanding of the claims,” but cannot be used to “vary or

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<sup>45</sup> *Id.*

<sup>46</sup> *Id.* The *Vitronics* court noted that “[a]lthough words in a claim are generally given their ordinary and customary meaning, a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification.” *Id.* This case was among the first to highlight the concept of a claim term’s “ordinary meaning,” that may be altered by the specification explicitly or implicitly. See Michael S. Conner & John A. Wasleff, *Where Do We Go from Here? A Critical Examination of Existing Claim Construction Doctrine*, 86 J. Pat. & Trademark Off. Soc’y 878, 882–83 (2004).

<sup>47</sup> *Id.*

<sup>48</sup> *Id.* (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976–88 (Fed. Cir. 1995) (en banc)). This case marked the evolution of defining a claim term “by implication.” The court did not explain how one can interpret or define a claim term “by implication.” Consequently, this decision gives little guidance for competitors, practitioners and district courts on how to use the specification to define or interpret a claim.

<sup>49</sup> *Vitronics*, 90 F.3d at 1582.

<sup>50</sup> *Id.*

<sup>51</sup> *Id.* The Federal Circuit was concerned that the public notice function of the patent would be rendered meaningless if it could be altered by extrinsic evidence. While that is a legitimate concern, the end result is that district court judges are burdened with an unrealistic task of construing claims from the intrinsic evidence based on what a person skilled in the art would understand from the claim terms, even though the judges are not skilled in the art. See Conner & Wasleff, *supra* note 46 at 882.

contradict the claim . . . or other parts of the patent language.”<sup>52</sup> The court went on to define extrinsic evidence as “evidence which is external to the patent and file history, such as expert testimony, inventor testimony, dictionaries, and technical treatises and articles.”<sup>53</sup> Since dictionaries were considered extrinsic evidence, dictionary definitions could not “contradict any definition found in or ascertained by reading the patent documents.”<sup>54</sup>

The doctrine of defining a claim “by implication” was further developed in *Bell Atlantic*.<sup>55</sup> Relying on the analytic framework of *Vitronics*, the Federal Circuit started with the claims, and then moved on to the specification followed by the prosecution history.<sup>56</sup> The court noted that the specification may clearly define a claim term without an explicit statement of definition.<sup>57</sup> For instance, the “written description of the preferred embodiments ‘can provide guidance as to the meaning of the claims, thereby dictating the manner in which the claims are to be construed, even if the guidance is not provided in explicit definitional format.’”<sup>58</sup> Stated differently, the written description “may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents.”<sup>59</sup> Hence, “when a patentee uses a claim throughout the entire patent specification, in a manner consistent with only a single meaning, he has defined that term by implication.”<sup>60</sup>

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<sup>52</sup> *Id.* at 1584.

<sup>53</sup> *Id.* In a footnote, the *Vitronics* court noted that technical treatises and dictionaries are special extrinsic evidence, which judges are “free to consult” at any time in order to better understand the underlying technology and to construe disputed claim terms. *Id.* n.6.

<sup>54</sup> *Id.*

<sup>55</sup> *Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc. et al.*, 262 F.3d 1258 (Fed. Cir. 2001).

<sup>56</sup> *Id.* at 1267–69.

<sup>57</sup> *Id.* at 1268.

<sup>58</sup> *Id.* (quoting *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337 (Fed. Cir. 2001)).

<sup>59</sup> *Id.* (internal quotations omitted).

<sup>60</sup> *Id.* at 1271. *But see* Suggestion Test *infra* notes 158–86 and accompanying text. The Suggestion Test employed through the claim-based approach requires that the specification suggest that a claim term with multiple dictionary meanings was limited to the one meaning used in the embodiments. For instance, if the patentee uses a claim term, throughout the entire patent specification, in a manner consistent with only a single meaning and without explicitly suggesting that the claim term was limited to that

Both, *Vitronics* and *Bell Atlantic*, have suggested that dictionaries and technical treatises hold a “special place” among extrinsic evidence and may be consulted at any time along with the intrinsic evidence.<sup>61</sup> Despite the Federal Circuit’s special treatment of dictionaries, neither *Vitronics* nor *Bell Atlantic* has cited a dictionary definition or relied on a technical treatise to determine the meaning of the disputed claim terms.

Interestingly, the evolution of defining a claim “by implication” has coincided with the court’s shifting focus from the specification to the claims. As the claim term’s “ordinary meaning” began to have a central role in claim construction, some Federal Circuit judges became less dependent on the specification for determining the meaning of the claim. Those judges became heavily dependent on dictionary definitions by employing the claim-based approach, while others have maintained their focus on the specification to determine an express or implicit definition of the disputed claim terms.<sup>62</sup>

*C. The Presumption of Ordinary and Accustomed Meaning and the Court’s Increased Reliance on Dictionaries*

The *CCS Fitness* decision was one of the earlier cases that applied the claim-based approach to claim construction.<sup>63</sup> That case involved a patent directed to a stationary exercise device known as the elliptical trainer.<sup>64</sup> At issue was the meaning of the claim term “reciprocating member.”<sup>65</sup> The patentee argued that reciprocating member includes a curved, multi-component structure used in the accused device, while the accused infringer

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meaning, the Federal Circuit would broaden the scope of that claim term to encompass other dictionary definitions so as to give the claim term the full breadth of its meaning. Consequently, the Suggestion Test is in conflict with defining a claim “by implication.”

<sup>61</sup> *Id.* at 1267.

<sup>62</sup> See R. Polk Wagner & Lee Petherbridge, *Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance*, 152 U. Pa. L. Rev. 1105 (2004). The article suggests that the Federal Circuit panel can be categorized into three groups: Proceduralists (those who prefer the claim-based approach), Holistics (those who prefer the specification-based approach), and the Swing Judges.

<sup>63</sup> *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359 (Fed. Cir. 2002).

<sup>64</sup> *Id.* at 1362–63.

<sup>65</sup> *Id.* at 1362.

alleged that the claim term referred only to a single-component, straight bar as disclosed in the patent drawings.<sup>66</sup>

The court began its claim-based approach with the language of the claims.<sup>67</sup> The court suggested that it will “indulge a ‘heavy presumption’ that a claim term carries its ordinary and customary meaning.”<sup>68</sup> Moreover, the court noted that its “precedents show that dictionary definitions may establish a claim term’s ordinary meaning.”<sup>69</sup> To overcome this “heavy presumption” of a claim term’s ordinary meaning, the court suggested four ways: (1) if the patentee acted as his own lexicographer by clearly defining the disputed claim term in the specification or prosecution history, (2) if the patentee expressly disclaimed subject matter or described a particular embodiment as important to the invention, (3) if the term chosen by the patentee so deprives the claim of clarity, and (4) if the claim term is limited under 35 U.S.C. § 112 ¶6.<sup>70</sup>

Turning to the facts of the case, the *CCS Fitness* court relied on a dictionary to determine the ordinary meaning of the term “member.”<sup>71</sup> The term “reciprocating” was agreed by both parties to mean the “back and forth” movement of the “member.”<sup>72</sup> Based on these definitions, the court concluded that the “reciprocating

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<sup>66</sup> *Id.* at 1364.

<sup>67</sup> *Id.* at 1366.

<sup>68</sup> *Id.* (citing *Johnson Worldwide Associates, Inc. v. Brunswick Corp.*, 175 F.3d 985, 989 (Fed. Cir. 1999)). The significance of the *Johnson Worldwide* opinion is that it contributed to the claim-based approach by creating a “heavy presumption” in favor of the ordinary meaning of a claim term. 175 F.3d at 989. The opinion also stands for the proposition that “[v]aried use of a disputed term in the written description demonstrates the breadth of the term rather than providing a limited definition.” *Id.* at 991. *But see* *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1581 (Fed. Cir. 1996) (“Where there is an equal choice between a broader and a narrower meaning of a claim, and there is an enabling disclosure that indicates that the applicant is at least entitled to a claim having the narrower meaning, we consider the notice function of the claim to be best served by adopting the narrower meaning.”). The *Athletic Alternatives* case is another example that shows how the claim-based approach as applied in *Johnson Worldwide* is different from the specification-based approach.

<sup>69</sup> *CCS Fitness*, 288 F.3d at 1366. (citing *Rexnod Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344 (Fed. Cir. 2001)).

<sup>70</sup> *CCS Fitness*, 288 F.3d at 1366–67.

<sup>71</sup> *Id.* at 1367. The definition of “member” was a “structural unit such as a . . . beam or tie, or a combination of these.” *Id.* (citing *MCGRAW-HILL DICTIONARY OF SCIENTIFIC AND TECHNICAL TERMS* 1237 (5th ed. 1994)).

<sup>72</sup> *CCS Fitness*, 288 F.3d at 1367.

member” encompasses the multi-component, curved structure used in the accused device.”<sup>73</sup> The court determined that there was nothing in the specification or prosecution history that overcame the “heavy presumption” of the claim term’s ordinary meaning.<sup>74</sup> Specifically, the court explained that there was nothing in the specification that required a certain shape or a certain number of components, and the patentee did not disclaim subject matter nor describe a single-component straight bar “member” as important to the invention.<sup>75</sup>

In *Texas Digital*, the Federal Circuit expanded on *CCS*’s claim-based approach to claim construction.<sup>76</sup> Like *CCS Fitness*, the court began its analysis with the language of the claims themselves because it was that “language that the patentee chose to particularly point out and distinctly claim the subject matter which the patentee regards as his invention.”<sup>77</sup> The court noted that there is a “heavy presumption” that claim terms “mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.”<sup>78</sup> In search for the ordinary meaning of the disputed claim terms, the court relied heavily on dictionaries, encyclopedias, and treatises.<sup>79</sup>

The Federal Circuit suggested that it had “long recognized” that “dictionaries, encyclopedias and treatises are particularly useful resources to assist the court in determining the ordinary and customary meanings of claim terms.”<sup>80</sup> The court praised dictionaries, encyclopedias and treatises, and referred to them as “objective resources that serve as reliable sources of information on the established meanings that would have been attributed to the

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<sup>73</sup> *Id.* at 1367–69.

<sup>74</sup> *Id.* at 1367.

<sup>75</sup> *Id.* at 1367–69.

<sup>76</sup> *Texas Digital Systems, Inc. v. Telegenix*, 308 F.3d 1193 (Fed. Cir. 2002).

<sup>77</sup> *Id.* at 1201–02 (citing 35 U.S.C. § 112, ¶2) (internal quotations omitted).

<sup>78</sup> *Id.* (citing *CCS Fitness*, 288 F.3d at 1366).

<sup>79</sup> *Id.* at 1202.

<sup>80</sup> *Id.*; *But see* Jennifer R. Johnson, *Out of Context: Texas Digital, the Indefiniteness of Language, and the Search for Ordinary Meaning*, 44 *IDEA* 521, 531 (2004) (noting that the *Texas Digital* court cited “five cases, supporting the notion of ‘long recognized in our precedent;’ yet four of the five cases cited are very recent—hardly indicative of a long precedent”—and the fifth case was an *ex parte* opinion from the Board of Appeals of the Patent Office.).

terms of the claims by those of skill in the art.”<sup>81</sup> The court explained that these “references are unbiased reflections of common understanding not influenced by expert testimony or events subsequent to the fixing of the intrinsic record by the grant of the patent, not colored by the motives of the parties, and not inspired by litigation.”<sup>82</sup>

While *Vitronics* regarded all the intrinsic evidence as the “most significant source of the legally operative meaning of disputed claim language,”<sup>83</sup> the *Texas Digital* court regarded dictionaries, encyclopedias and treatises as the “most meaningful sources of information to aid judges in better understanding both the technology and the terminology used by those skilled in the art.”<sup>84</sup> The court further noted that “it is entirely proper for both trial and appellate judges to consult these materials at any stage of a litigation, regardless of whether they have been offered by a party in evidence or not.”<sup>85</sup> Due to the heightened significance of these resource materials, the court emphasized that “categorizing them as ‘extrinsic evidence’ or even a ‘special form of extrinsic evidence’ is misplaced and does not inform the analysis.”<sup>86</sup>

Finally, the court cautioned that consulting the specification or prosecution history before discerning the ordinary and customary meanings, “invites a violation of our precedent counseling against importing limitations into the claims.”<sup>87</sup> Hence, by examining resource materials first, “the full breadth of the limitations intended by the inventor will be more accurately determined and improper

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<sup>81</sup> *Texas Digital*, 308 F.3d at 1203. *But see* Conner & Wasleff, *supra* note 46 at 886 (suggesting that any expectation that reference materials available to a court will be unbiased by litigation is unrealistic because there is a “selection bias that is at least as real as the bias of a testifying advocate, but perhaps less obvious.”).

<sup>82</sup> *Texas Digital*, 308 F.3d at 1203.

<sup>83</sup> *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

<sup>84</sup> *Texas Digital*, 308 F.3d at 1203.

<sup>85</sup> *Id.*; *But see* Br. Of The American Bar Association As Amicus Curiae Supporting Neither Party at 10–11, *Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004) (Nos. 03-1269, 03-1286) (requesting that the court would rely on dictionaries only when made part of the record and parties were given the opportunity to address, challenge, or rebut that material).

<sup>86</sup> *Texas Digital*, 308 F.3d at 1203.

<sup>87</sup> *Id.* at 1204.



importation of unintended limitations from the written description into the claims will be more easily avoided.”<sup>88</sup>

This opinion evinces the Federal Circuit’s increasing dependence on dictionaries for claim construction. In order to avoid reading limitations into the claims, a common criticism of the specification-based approach, the *Texas Digital* court disfavored the use of the specification and prosecution history in claim construction. However, by discounting the value of the intrinsic record in claim interpretation, the court has failed to account for the *context* by which the term was used in the specification and the prosecution history. As explained earlier, such context provides the patentee’s expression and intent on what he meant in his claims.<sup>89</sup>

#### *D. Overcoming the “Heavy Presumption” of a Claim Term’s Ordinary Meaning*

There is a “heavy presumption” that a claim term carries its ordinary and customary meaning.<sup>90</sup> This section explores the four ways that the *CCS Fitness* court outlined for overcoming this “heavy presumption.”

##### 1. Patentee Acted As His Own Lexicographer

One way to overcome the “heavy presumption” that a claim term carries its ordinary and customary meaning is if the “patentee acted as his own lexicographer and clearly set forth a definition of the disputed claim term in either the specification or prosecution history.”<sup>91</sup> The definition must be made with “reasonable clarity, deliberateness, and precision.”<sup>92</sup>

Expressly defining a disputed claim term in the specification was addressed in *Durel Corp. v. Osram Sylvania, Inc.*<sup>93</sup> The patent-in-suit was related to encapsulated electron-luminescent

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<sup>88</sup> *Id.* at 1205.

<sup>89</sup> *See supra* notes 18–41 and accompanying text.

<sup>90</sup> *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002).

<sup>91</sup> *Id.* at 1366.

<sup>92</sup> *Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1370 (Fed. Cir. 2005) (quoting *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994)).

<sup>93</sup> *Durel Corp. v. Osram Sylvania, Inc.*, 256 F.3d 1298 (Fed. Cir. 2001).

phosphor particles used in illuminating watch faces and other instrument panels.<sup>94</sup> At issue was the meaning of the claim term “oxide coating” that encapsulated the phosphor particles.<sup>95</sup> Since the specification expressly defined the “oxide coating,”<sup>96</sup> the court adopted that definition for its claim interpretation.<sup>97</sup> However, because the parties disputed the interpretation of that definition, the court relied on dictionaries to support its understanding of the disputed claim term.<sup>98</sup> The court emphasized that it is free to consult the dictionary “so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent document.”<sup>99</sup>

While this rule seems straightforward, Federal Circuit judges, employing the claim-based approach, are not always comfortable in using the specification as the primary source for construing disputed claim terms. For instance, in *Merck & Co. v. Teva Pharms. USA, Inc.*, the majority decision disregarded the patentee’s express definition of a claim phrase in the specification in favor of a dictionary definition.<sup>100</sup> The patent-in-suit was directed to a method of treating and preventing osteoporosis through the administration of a chemical compound.<sup>101</sup> Even though the patentee included the entire claim phrase in the specification, enclosed it with quotation marks, and unambiguously defined its meaning, the majority opinion abstracted the claim term out of its context, and instead, adopted its ordinary dictionary meaning.<sup>102</sup>

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<sup>94</sup> *Id.* at 1300.

<sup>95</sup> *Id.*

<sup>96</sup> The term “oxide coating” was defined as a “material made up primarily of metallic ions and oxygen, but which may contain minor amounts of other elements and compounds originating in the precursor materials or phosphor particles.”

<sup>97</sup> *Id.* at 1303–04.

<sup>98</sup> *Id.* at 1304.

<sup>99</sup> *Id.* (citing *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1584, n.6 (Fed. Cir. 1996)).

<sup>100</sup> *Merck v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1366 (Fed. Cir. 2005) (construing the claim phrase “about 70 mg of alendronate monosodium trihydrate, on an alendronic acid basis.”)

<sup>101</sup> *Id.* at 1366–67.

<sup>102</sup> *Id.* at 1380 (Rader, J., dissenting).

This prompted the dissent to accuse the majority for “paying only lip service to the often-cited, but rarely followed lexicographer rule.”<sup>103</sup> The dissent emphasized that because the majority failed to honor patentee’s express definition, the majority decision effectively rewrote the specification.<sup>104</sup> In essence, the majority’s claim construction resulted in importing limitations from the dictionary into the claims, wholly aside from what the patentee has chosen.<sup>105</sup> While the goal of the claim-based approach is to avoid importing limitations into the claims, the *Merck* case demonstrates that liberal dictionary use can run afoul of this objective.

## 2. Patentee Disclaimed Subject Matter

When a patentee describes what a claim term means, he acts as a lexicographer, and when he describes what a claim term does not mean, he disclaims that subject matter.<sup>106</sup> Unlike the lexicographer rule, disclaimer of subject matter can result from express or implied statements made in the specification or the prosecution history.<sup>107</sup> For instance, in *Scimed*, the court noted that the patentee distinguished the dual lumen catheters by highlighting its disadvantages in comparison to the coaxial lumen configuration.<sup>108</sup> Accordingly, the court held that the dual lumen configuration was disclaimed in the specification and the patentee could not broaden the claims to encompass that configuration.<sup>109</sup>

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<sup>103</sup> *Id.* at 1377.

<sup>104</sup> *Id.*

<sup>105</sup> *Id.*

<sup>106</sup> Joseph Yang et al., *Navigating The Federal Circuit’s Markman Jurisprudence*, 795 PLI/Pat 733, 758–59 (2004).

<sup>107</sup> *Astrazeneca AB v. Mutual Pharm. Co.*, 384 F.3d 1333, 1340–41 (Fed. Cir. 2004) (emphasizing that clear disavowal of subject matter does not have to be express, but can be implied from the written description); *see Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001) (holding that the patentee criticized and disclaimed a particular feature in the specification, thereby limiting the claim scope); *see Hockerson-Halberstadt, Inc. v. Avia Group Int’l, Inc.*, 222 F.3d 951, 956–57 (Fed. Cir. 2000) (holding that an inventor disclaimed a particular feature during prosecution, thereby modifying the term’s ordinary meaning).

<sup>108</sup> *Scimed*, 242 F.3d at 1342–43; *see supra* notes 32–41 and accompanying text.

<sup>109</sup> *Id.*

One example where the patentee disclaimed subject matter in the prosecution history is illustrated in *Omega Eng., Inc. v. Raytek Corp.*<sup>110</sup> The court explained that the doctrine of prosecution disclaimer precludes the “patentees from recapturing through claim interpretation specific meanings disclaimed during prosecution.”<sup>111</sup> The rationale behind the doctrine is that it “promotes the public notice function of the intrinsic evidence and protects the public’s reliance on definitive statements made during prosecution.”<sup>112</sup> To constitute a disclaimer or disavowal of claim scope, the prosecution statements must not be too vague or ambiguous; rather, it must be effected with “reasonable clarity and deliberateness.”<sup>113</sup> Hence, for prosecution disclaimer to attach, “the alleged disavowing actions or statements made during prosecution [must] be both clear and unmistakable.”<sup>114</sup> Turning to the facts of the case, the court determined that the patentee made a clear and unmistakable prosecution disclaimer, thereby limiting the scope of the disputed claim term.<sup>115</sup>

Another example where the patentee disclaimed subject matter in the prosecution history is provided in *Springs Window Fashions LP v. Novo Indus., L.P.*<sup>116</sup> Highlighting the public notice function of a patent and its prosecution history, the court emphasized that “[a] patentee may not state during prosecution that the claims do not cover a particular device and then change position and later sue a party who makes that same device for infringement.”<sup>117</sup> If the court adopts the patentee’s position, it “would undercut the public reliance on a statement that was in the public record and upon which reasonable competitors formed their business strategies.”<sup>118</sup> The Federal Circuit noted that if the patentee disclaimed coverage

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<sup>110</sup> *Omega Eng., Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323–25 (Fed. Cir. 2003).

<sup>111</sup> *Id.* at 1323.

<sup>112</sup> *Id.* at 1324.

<sup>113</sup> *Id.* at 1325 (citing *Northern Telecom. Ltd. v. Samsung Elecs. Co.*, 215 F.3d 1281, 1294–95 (Fed. Cir. 2000)).

<sup>114</sup> *Id.* at 1325–26.

<sup>115</sup> *Id.* at 1226.

<sup>116</sup> *Springs Window Fashions LP v. Novo Indus., L.P.*, 323 F.3d 989, 994–96 (Fed. Cir. 2003).

<sup>117</sup> *Id.* at 995.

<sup>118</sup> *Id.* (citing *Hockerson-Halberstadt, Inc. v. Avia Group Int’l, Inc.*, 222 F.3d 951, 957 (Fed. Cir. 2000)).

of the claimed invention by mistake, he “should have amended the file to reflect the error, as the applicant is the party in the best position to do so.”<sup>119</sup> Since the patentee did not retract any statements made during prosecution, the court narrowed the claim scope to exclude the disclaimed subject matter.<sup>120</sup>

### 3. Claim Lacks Clarity

Another way to overcome the “heavy presumption” that a claim term carries its ordinary and customary meaning is if the term “chosen by the patentee so deprive[s] the claim of clarity that there is no means by which the scope of the claim may be ascertained from the language used.”<sup>121</sup> When such circumstances occur, reference to other intrinsic evidence, or in some cases, to extrinsic evidence is proper.<sup>122</sup> If the specification and prosecution history sheds light to the meaning of the “unclear” claim term, then referring to extrinsic evidence is not permitted.<sup>123</sup>

By way of example, in *CCS*, the accused infringer argued that the disputed claim term “reciprocating member” had no ordinary and customary meaning to one of ordinary skill in the art.<sup>124</sup> To support its argument, the accused infringer presented expert testimony to establish that the disputed claim term lacks clear meaning.<sup>125</sup> The court rejected the use of expert testimony, and noted that the ordinary meaning of the claim term can be resolved by referring to the intrinsic evidence and dictionary.<sup>126</sup>

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<sup>119</sup> *Id.*

<sup>120</sup> *Id.* For more on disclaimers, see Nagendra Setty & David S. Kerven, *From Dictionaries To Disclaimers: Following The Federal Circuit From Texas To Disneyland*, 795 PLI/Pat 427 (2004).

<sup>121</sup> *Johnson Worldwide Associates, Inc. v. Brunswick Corp.*, 175 F.3d 985, 990 (Fed. Cir. 1999).

<sup>122</sup> *Id.* (citing *J.T. Eaton & Co. v. Atlantic Paste & Glue Co.*, 106 F.3d 1563, 1568 (Fed. Cir. 1997), *North Am. Vaccine, Inc. v. Am. Cyanamid Co.*, 7 F.3d 1571, 1576 (Fed. Cir. 1993), *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1187 (Fed. Cir. 1998) and *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996)).

<sup>123</sup> *Id.*

<sup>124</sup> *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1365–67 (Fed. Cir. 2002).

<sup>125</sup> *Id.*

<sup>126</sup> *Id.* at 1368–69.

Accordingly, the accused infringer failed to overcome the “heavy presumption.”<sup>127</sup>

In *Key Pharms. v. Hercon Labs. Corp.*, the accused infringer also presented expert testimony to clarify the meaning of the claim term “pharmaceutically effective amount.”<sup>128</sup> The court determined that the intrinsic evidence did not clarify the meaning of the disputed claim term, and therefore, relied on extrinsic evidence.<sup>129</sup> Based on that evidence, the court held that a person of ordinary skill in the art would understand the claim term to mean an amount sufficient to provide a patient with 2.5 to 15mg/day.<sup>130</sup>

#### 4. Claim Construction Limited Under 35 U.S.C. §112, ¶6

The final method that the Federal Circuit has suggested in overcoming the “heavy presumption” is if the patentee drafted the claim pursuant to 35 U.S.C. § 112, ¶ 6.<sup>131</sup> The patent statute provides that:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material or acts described in the specification and equivalents thereof.<sup>132</sup>

Technically, this statute does not overcome the presumption; rather, it prevents the Federal Circuit from employing the claim-based approach because the statute mandates the use of the specification in interpreting a claim element.<sup>133</sup> The statute allows a patent applicant to claim an invention using functional language instead of structural language.<sup>134</sup> A court interpreting this functional claim language must ascertain the corresponding

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<sup>127</sup> *Id.* at 1367.

<sup>128</sup> *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 709, 713–15 (Fed. Cir. 1998).

<sup>129</sup> *Id.* at 716–718.

<sup>130</sup> *Id.* at 718.

<sup>131</sup> *CCS Fitness*, 288 F.3d at 1367.

<sup>132</sup> 35 U.S.C. § 112, ¶ 6.

<sup>133</sup> *Id.*

<sup>134</sup> *Id.*

structure from the written description rather than rely on the ordinary meaning of the claim term.<sup>135</sup>

### *E. Linguistic Analysis Of Claims*

One of the key features of the claim-based approach is the linguistic analysis of claims. Federal Circuit judges that employ the claim-based approach spend a considerable amount of their opinion on the claim language used.<sup>136</sup> This linguistic analysis focuses more on the English language used and less on the claimed invention.<sup>137</sup> In most cases, the alleged infringer seeks to alter the language of the claim term to what was disclosed in the specification or argued during patent prosecution.<sup>138</sup> However, in a claim-based approach, it is the language of the claims themselves that control.<sup>139</sup>

Application of the linguistic analysis to claim construction is illustrated in *Process Control Corp. v. HydReclaim Corp.*<sup>140</sup> At issue was the meaning of the claim term “discharge rate” that appeared twice in the claim.<sup>141</sup> Relying on the specification, the accused infringer asserted that the first occurrence of the disputed claim term should carry a different meaning from the second occurrence.<sup>142</sup> The Federal Circuit rejected that argument and noted that the term “a discharge rate” in the first occurrence refers to the same rate as the term “the discharge rate” in the second occurrence.<sup>143</sup> The court explained that such interpretation “avoids any lack of antecedent basis problem for the [second] occurrence of ‘the discharge rate.’”<sup>144</sup>

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<sup>135</sup> See *Mirco Chem., Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250, 1258 (Fed. Cir. 1998).

<sup>136</sup> *Elekta Instrument S.A. v. O.U.R. Scientific Int’l, Inc.*, 214 F.3d 1302, 1306–09 (Fed. Cir. 2000).

<sup>137</sup> *Id.*

<sup>138</sup> *Id.*

<sup>139</sup> *Storage Tech. Corp. v. Cisco Systems, Inc.*, 329 F.3d 823, 831–32 (Fed. Cir. 2003).

<sup>140</sup> *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350 (Fed. Cir. 1999).

<sup>141</sup> *Id.* at 1354–55.

<sup>142</sup> *Id.* at 1355–57.

<sup>143</sup> *Id.* at 1356.

<sup>144</sup> *Id.* at 1356–57. The court suggested that both occurrences refer to “the rate (in units of weight per unit of time) that material is discharged from the common hopper to the material processing machine.” *Id.* at 1356. The court also explained that this was not a

Similarly, in *Elekta Instrument S.A. v. O.U.R. Scientific Int'l, Inc.*, the ordinary meaning of the disputed claim term conflicted with what was disclosed in the specification.<sup>145</sup> The claim recites a range “only within a zone extending between latitudes 30 degrees [to] 45 degrees.”<sup>146</sup> Meanwhile, the preferred embodiment disclosed a range between 0 degrees to 45 degrees.<sup>147</sup> The patentee claimed less than what was initially disclosed in the specification because he had to narrow his claim to overcome the prior art.<sup>148</sup> Analyzing the language of the claims, the Federal Circuit explained that “the terms ‘only’ and ‘extending between’ unambiguously limit claim 1 to . . . a zone stretching exclusively in the space separating the latitudes 30 degrees and 45 degrees.”<sup>149</sup> The court emphasized that the “unambiguous language of the amended claim controls over any contradictory language in the written description.”<sup>150</sup> This is true even if such claim construction would exclude the preferred and only embodiment disclosed in the specification.<sup>151</sup>

Because the linguistic approach focuses on the language of the claims themselves, even inconsistent statements made during patent prosecution were disregarded by the Federal Circuit over the plain language of the claims.<sup>152</sup> In *Storage Technology Corp. v. Cisco Systems, Inc.*, the disputed claim terms were “caching policy

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situation where the patentee acted as his own lexicographer to warrant circumvention of the claim term’s ordinary meaning. *Id.*

<sup>145</sup> *Elekta Instrument S.A. v. O.U.R. Scientific Int'l, Inc.*, 214 F.3d 1302, 1304–07 (Fed. Cir. 2000).

<sup>146</sup> *Id.* at 1306.

<sup>147</sup> *Id.* at 1306–09.

<sup>148</sup> *See id.* at 1308.

<sup>149</sup> *Id.* at 1307.

<sup>150</sup> *Id.* at 1308.

<sup>151</sup> *Id.* This is a case where the patentee’s disclaimer of subject matter is reflected in the ordinary meaning of the claim term. Although prosecution disclaimer is used to rebut the “heavy presumption” that a claim term carries its ordinary meaning, the *Elekta* court did not address this issue because the amended claim term was narrowly drafted and not susceptible to a broader ordinary meaning. *See also supra* notes 110–20 and accompanying text (illustrating how prosecution disclaimers can limit the scope of disputed claim terms).

<sup>152</sup> *Storage Tech. Corp. v. Cisco Systems, Inc.*, 329 F.3d 823, 832 (Fed. Cir. 2003).



identification information” and “network policy”<sup>153</sup> The accused infringer argued that the meaning of the claim was narrowed during prosecution.<sup>154</sup> Specifically, the patentees stated that the network policy and the policy identification information are both cached.<sup>155</sup> While the court acknowledged that this statement appears to limit the claim scope, it suggested that “it cannot do so absent some claim language referring to the caching of the instance of network policy.”<sup>156</sup> Hence, the court concluded that an applicant’s erroneous or “inaccurate statement cannot override the claim language itself, which controls the bounds of the claim.”<sup>157</sup>

#### *F. The Rise Of The Suggestion Test In Claim Construction*

Ever since the claim-based approach has surfaced as an alternate method to claim construction, the Federal Circuit has increasingly applied a “Suggestion Test” to justify broad interpretation of disputed claim terms.<sup>158</sup> The Suggestion Test is premised on the assumption that if a patentee intended to narrow a claim term with multiple dictionary definitions, he would have specifically suggested that in the specification.<sup>159</sup> This assumption has created an undue burden on accused infringers because they are required to prove a patentee’s intent to deviate from a claim term’s multiple meanings even if the patentee has only used one meaning consistently throughout the patent.<sup>160</sup>

Although the United States patent system requires patent applicants to claim what the invention is, as opposed to what it is

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<sup>153</sup> *Id.* at 830–31. In computers, a cache is a “small fast memory holding recently accessed data, designed to speed up subsequent access to the same data.” *The Free On-Line Dictionary Of Computing*, at <http://wombat.doc.ic.ac.uk/foldoc/foldoc.cgi?query=cache> (last modified June 25, 1997).

<sup>154</sup> *Storage Tech Corp.* 329 F.3d. at 830.

<sup>155</sup> *Id.*

<sup>156</sup> *Id.* at 832.

<sup>157</sup> *Id.* *But see supra* prosecution disclaimer notes 110–20 and accompanying text.

<sup>158</sup> *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 134–48 (Fed. Cir. 2001); *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1327–28 (Fed. Cir. 2002); *Sunrace Roots Enter. Co., Ltd. v. SRAM Corp.*, 336 F.3d 1298, 1305 (Fed. Cir. 2003).

<sup>159</sup> *See Texas Digital Sys. v. Telegenix, Inc.*, 308 F.3d 1193, 1206 (Fed. Cir. 2002) (“there is nothing in the record to suggest that ‘activating’ means other than what its dictionary definition would suggest”).

<sup>160</sup> *See Teleflex*, 299 F.3d at 1327–1328.

not, the court's rationale behind the Suggestion Test suggests otherwise. The court's analysis focuses more on whether any of a claim term's multiple dictionary definitions were excluded or disclaimed, rather than on whether the patentee used that claim term in the specification to connote more than one meaning.<sup>161</sup> Consequently, if a patent applicant uses a claim term in a manner consistent with only a single meaning, and without explicitly suggesting that the claim term was limited to that meaning, the Federal Circuit would broaden the scope to include other dictionary meanings.<sup>162</sup> This indicates that the court's Suggestion Test to claim construction mandates a central form of definition that is in conflict with our patent system's peripheral form.<sup>163</sup>

Even when the specification touts an advantage of the invention consistent with only one meaning to the disputed claim term, the Federal Circuit would refuse to narrow that claim term's ordinary meaning.<sup>164</sup> Typically, the court's justification is based on the fact that the written description does not suggest the

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<sup>161</sup> *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371 (Fed. Cir. 2003). Although it appears that the Suggestion Test is similar to the disclaimer doctrine, it is different in many respects. First, the disclaimer doctrine analyzes statements made in the specification or prosecution history, while the Suggestion Test states in the abstract that there are no statements made in the specification or prosecution history. Second, the disclaimer doctrine is used to narrow the scope of the disputed claim term, while the Suggestion Test is used to broaden the scope of that claim term. Third, and more importantly, the disclaimer doctrine has a lower mens rea requirement than the Suggestion Test. An accused infringer may prove disclaimer through statements made by mistake; however, to satisfy the Suggestion Test, the accused infringer must prove that the patentee intended to deviate from a claim term's multiple meanings.

<sup>162</sup> See *Teleflex*, 299 F.3d at 1327–28. As emphasized earlier, the Suggestion Test is in conflict with defining a claim “by implication.” See *supra* notes 42–62 and accompanying text.

<sup>163</sup> “Central definition involves the drafting of a narrow claim setting forth a typical embodiment coupled with broad interpretation by the courts to include all equivalent constructions. Peripheral definition involves marking out the periphery . . . area covered by the claim and holding as infringements only such constructions as lie within that area.” *Id.* See also *Ex Parte Fressola*, 27 U.S.P.Q.2d 1608, 1609–1610 (Bd.Pat.App & Interf. 1993) (noting that the method of claiming has shifted from the central definition to the peripheral definition); Martin J. Adelman et al., *Cases And Materials on Patent Law*, 634–642 (American Casebook Series 1998).

<sup>164</sup> *Northrop Grumman Corp. v. Intel Corp.*, 325 F.3d 1346, 1355 (Fed. Cir. 2003); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1301 (Fed. Cir. 2003). But see *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001).

invention must be used only in a manner that achieves the recited advantage.<sup>165</sup> Likewise, if the specification did not suggest that the patent limits the claims to the disclosed embodiments, the court would refuse to narrow the ordinary meaning of a claim term described in the context of these embodiments.<sup>166</sup> Consequently, the Federal Circuit would broaden the scope of a claim term unless the patentee explicitly suggested in the specification, and not in the context of the embodiments, that any of the claim term's multiple dictionary definitions were either excluded or disclaimed.<sup>167</sup>

The controversial nature of the Suggestion Test is best illustrated in *Teleflex, Inc. v. Ficosa North America Corp.*<sup>168</sup> The patent was directed to a device that allows attachment of a shift cable to an automatic transmission vehicle.<sup>169</sup> At issue was the meaning of the claim term "clip."<sup>170</sup> The court noted that the specification described only one embodiment of "clip" as having a "single pair of legs."<sup>171</sup> Nevertheless, the court concluded that the term "clip" is not limited to "single pair of legs."<sup>172</sup> Instead of determining whether the patentee used the term "clip" in the specification to connote more than one meaning, the court determined that there was nothing in the specification that suggested the claim term was limited to the disclosed

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<sup>165</sup> *Northrop*, 325 F.3d at 1355 (holding that a recited advantage of the invention consistent with only one meaning of the disputed claim term was one of several objectives, and the specification did "not suggest that the invention must always be used in a manner that achieves that objective."); *Brookhill-Wilk.*, 334 F.3d at 1301 ("The objective described is merely one of several objectives that can be achieved through the use of the invention; the written description does not suggest that the invention must be used only in a manner to attain that objective.").

<sup>166</sup> *Teleflex*, 299 F.3d at 1327–28 ("an accused infringer cannot overcome the 'heavy presumption' that a claim term takes on its ordinary meaning simply by pointing to the preferred embodiment or other structures or steps disclosed in the specification or prosecution history."); *Sunrace Roots Enter. Co. Ltd. v. SRAM Corp.*, 336 F.3d 1298, 1305 (Fed. Cir. 2003) ("while it is clear that the patentee was primarily focused on an embodiment of his invention using a cam, nothing in the patent limits the claims to that embodiment.")

<sup>167</sup> *See Altiris*, 318 F.3d at 1371.

<sup>168</sup> *Teleflex*, 299 F.3d at 1327–28.

<sup>169</sup> *Id.* at 1318.

<sup>170</sup> *Id.* at 1327–28.

<sup>171</sup> *Id.*

<sup>172</sup> *Id.* at 1328.

embodiment.<sup>173</sup> Accordingly, the *Teleflex* court expanded the meaning of “clip” beyond what was disclosed in the specification.

Similarly, in *Sunrace Roots Enter. Co., Ltd. v. SRAM Corp.*, the court applied the Suggestion Test to broaden the scope of the disputed claim term.<sup>174</sup> The parties disputed the meaning of the term “shift actuator,” a component used in a bicycle gear-shifting system.<sup>175</sup> The court determined that the ordinary meaning of “shift actuator” is a “mechanism that controls the changing of gears.”<sup>176</sup> Based on a number of statements made in the specification, the accused infringer argued that the “shift actuator” must be limited to a device containing a cam structure.<sup>177</sup> One statement in the specification described the cam member as the “heart” of the shift actuator.<sup>178</sup> Even with such a clear and unambiguous statement, the court concluded that “nothing in the written description indicates that the invention is exclusively directed toward cams or suggests that systems not employing cams are outside the scope of the invention.”<sup>179</sup>

Another case that employed the Suggestion Test is *Northrop Grumman Corp. v. Intel Corp.*<sup>180</sup> At issue was the meaning of the term “bus interface unit.”<sup>181</sup> The ordinary meaning of that term was determined to be a “unit for interfacing with a serial data bus.”<sup>182</sup> The patentee conceived that the invention “would be used principally, if not exclusively, in a ‘command/response’ environment.”<sup>183</sup> Despite the fact that the specification referred repeatedly to advantages of the invention in the context of a

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<sup>173</sup> *Id.*

<sup>174</sup> *Sunrace Roots Enter. Co. Ltd. V. SRAM Corp.*, 336 F.3d 1298, 1299 (Fed. Cir. 2003).

<sup>175</sup> *Id.*

<sup>176</sup> *Id.* at 1302.

<sup>177</sup> *Id.* at 1304.

<sup>178</sup> *Id.*

<sup>179</sup> *Id.* at 1305; *but see* *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001) (“when the preferred embodiment is described as the invention itself, the claims are not entitled to a broader scope than that embodiment”) (internal quotations omitted).

<sup>180</sup> *Northrop Grumman Corp. v. Intel Corp.*, 325 F.3d 1346, 1354 (Fed. Cir. 2003).

<sup>181</sup> *Id.*

<sup>182</sup> *Id.*

<sup>183</sup> *Id.* at 1355.

“command/response” environment, the court refused to limit the scope of the disputed claim term.<sup>184</sup> The court explained that nothing in the specification “suggests that the invention must always be used in a manner that achieves that objective.”<sup>185</sup> Once again the court improperly expanded the scope of the claim term even when the patentee used the term in the specification consistent with only one meaning.<sup>186</sup>

*G. Inherent Problems Associated With Specification-Based And Claim-Based Approaches*

Opponents of the specification-based approach have criticized this approach for importing extraneous limitations from the written description into the claims.<sup>187</sup> They contend that there is no “need” to use these limitations in interpreting the claims.<sup>188</sup> They exaggerate that “[i]f we once begin to include elements not mentioned in the claim in order to limit such claim . . . , we should never know where to stop.”<sup>189</sup> They do, however, correctly point out that “[i]f everything in the specification were required to be read into the claims, or if structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims.”<sup>190</sup> Also, there would be no need, “regardless of the prior art, [to] claim more broadly than that embodiment.”<sup>191</sup> Likewise, there would be no need for the patent applicant to conclude his written description with “claims particularly pointing out and distinctly

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<sup>184</sup> *Id.*

<sup>185</sup> *Id.*

<sup>186</sup> *Id.*; *but see* *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998) (“where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.”)

<sup>187</sup> *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1434 (Fed. Cir. 1988) (explaining that “extraneous” limitation means a “limitation read into a claim from the specification wholly apart from any need to interpret what the patentee meant by particular words or phrases in the claim.”)

<sup>188</sup> *Id.*

<sup>189</sup> *Johnson Worldwide Assoc., Inc. v. Zebco Corp.*, 175 F.3d 985, 990 (Fed. Cir. 1999).

<sup>190</sup> *See Teleflex, Inc. v. Ficosa North America Corp. et al.*, 299 F.3d 1313, 1326 (Fed. Cir. 2002).

<sup>191</sup> *Id.*

claiming the subject matter which the applicant regards as his invention.”<sup>192</sup> As a result, opponents to the specification-based approach prefer to focus solely on the language of the claims. Their claim construction inquiry “begins and ends in all cases with the actual words of the claim.”<sup>193</sup>

Like the specification-based approach, the claim-based approach is not free of criticism. Proponents of the claim-based approach are often accused of ignoring the purpose or object that the patent seeks to accomplish.<sup>194</sup> Courts employing the claim-based approach have made a “fortress out of the dictionary,”<sup>195</sup> converting their extrinsic nature into “technical terms of art having legal . . . significance.”<sup>196</sup> These courts always rely on dictionaries to determine the “ordinary and customary meaning” of a disputed claim term.<sup>197</sup> However, their reliance on dictionaries for increased clarity of claim terms “results from a misplaced faith in the efficacy of that process. The result is that more words are added, with the outcome being only the substitution of one uncertainty for another.”<sup>198</sup> This problem is compounded when

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<sup>192</sup> *Id.* (quoting 35 U.S.C. § 112).

<sup>193</sup> *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998); *see Intellectual Property Dev., Inc. v. UA Columbia Cablevision of Westchester, Inc.*, 336 F.3d 1308, 1314 (Fed. Cir. 2003) (“In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to ‘particularly point[ ] out and distinctly claim[ ] the subject matter which the patentee regards as his invention.’”).

<sup>194</sup> *See* Michael S. Conner & John A. Wasleff, *Where Do We Go From Here? A Critical Examination Of Existing Claim Construction Doctrine*, 86 J. Pat. & Trademark Off. Soc’y 878, 879 (2004).

<sup>195</sup> *Id.*

<sup>196</sup> *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1478 (Fed. Cir. 1998) (“Courts must exercise caution lest dictionary definitions, usually the least controversial source of extrinsic evidence, be converted into technical terms of art having legal, not linguistic, significance. The best source for understanding a technical term is the specification from which it arose, informed, as needed, by the prosecution history.”)

<sup>197</sup> *Id.*

<sup>198</sup> Jennifer R. Johnson, *Out of Context: Texas Digital, The Indefiniteness of Language, and the Search for Ordinary Meaning*, 44 IDEA 521, 533 (2004) (internal quotations omitted). *See* *Schumer v. Lab. Computer Sys., Inc.*, 308 F.3d 1304, 1311 (Fed. Cir. 2002) (unnecessarily relying on a dictionary to construe the claim term “or”).

courts rely on more than one dictionary to define the meaning of the disputed claim term.<sup>199</sup>

Proponents of the claim-based approach characterize dictionaries as “unbiased reflections of common understanding not influenced by expert testimony . . . , not colored by the motives of the parties, and not inspired by litigation.”<sup>200</sup> However, they fail to recognize that “[t]here is a selection bias that is at least as real as the bias of a testifying advocate, but perhaps less obvious.”<sup>201</sup> Parties supplying the dictionary definitions are “usually quite capable of finding references to furnish at least a colorable argument supporting their respective positions.”<sup>202</sup> Therefore, any expectation that the dictionary definition is unbiased or uninspired by litigation is “unrealistic.”<sup>203</sup>

One of the shortcomings of the claim-based approach is that it has no standard for determining the resource materials used in construing claims. The Federal Circuit did not indicate the type of resource materials it prefers, and the pertinent date for selecting these materials. Their “decisions have not always been consistent as to whether the pertinent date is the filing date of the application or the issue date of the patent.”<sup>204</sup> Some cases have suggested that the pertinent date is the issue date of the patent.<sup>205</sup> This is problematic because these sources were not available to the patent applicant for access at the time he or she has filed the patent application.<sup>206</sup> Even if the court identified the version and edition

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<sup>199</sup> *Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1373–75 (Fed. Cir. 2003) (relying on three dictionaries to determine the meaning of the disputed term).

<sup>200</sup> *Texas Digital Sys. v. Telegenix, Inc.*, 308 F.3d 1193, 1203 (Fed. Cir. 2002).

<sup>201</sup> Michael S. Conner & John A. Wasleff, *Where Do We Go From Here? A Critical Examination Of Existing Claim Construction Doctrine*, 86 J. PAT. & TRADEMARK OFF. SOC'Y 878, 886 (2004).

<sup>202</sup> *Id.*

<sup>203</sup> *Id.*

<sup>204</sup> *Inverness Medical Switzerland GmbH v. Warner Lambert Co.*, 309 F.3d 1373, 1378 n.2 (Fed. Cir. 2002).

<sup>205</sup> *Id.* (noting that dictionary definitions must be as of the date the patents issued). *See also Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1299 (Fed. Cir. 2003) (rejecting references that were dated well after the issue date of the patent).

<sup>206</sup> Jennifer R. Johnson, *Out Of Context: Texas Digital, The Indefiniteness Of Language, And The Search For Ordinary Meaning*, 44 IDEA 521, 536 (2004) (suggesting that the “group of dictionaries that the court considers proper may well include sources that the applicant not only did not have access to but also those he could not have had access to

of a universal dictionary that it prefers, it would be difficult for competitors to locate this resource material, which could date back a decade or two.<sup>207</sup>

In the name of efficiency and predictability, many commentators champion the use of the claim-based approach.<sup>208</sup> They suggest that this formalistic approach promotes the public notice function because it “emphasizes the meanings of claims within the four corners of a patent.”<sup>209</sup> In reality, the claim-based approach is not predictable because competitors cannot determine in advance what reference dictionary the court will rely on in interpreting the claims. Since the court has endorsed the consultation of dictionaries “at any stage of a litigation, regardless of whether they have been offered by a party in evidence or not,”<sup>210</sup> even the parties to the litigation do not get an advance notice and an opportunity to address, challenge, or rebut the court’s dictionary definition.<sup>211</sup> Therefore, it seems unlikely that the claim-based approach promotes the public notice function.

Ideally, courts should construe claims consistent with the method used by the Patent and Trademark Office (“PTO”). However, when courts employ the claim-based approach, their claim construction differs. Under PTO practice, “the meaning of the terms in the claims may be ascertainable by reference to the [written] description.”<sup>212</sup> PTO examiners rarely depend on dictionaries for interpreting claim terms; rather, they “frequently

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because they may have become ‘publicly available’ between the time he submitted his application and its issue.”).

<sup>207</sup> Daniel S. Matthews, *Baffled: Phillips v. AWH Corp. And The Reexamination Of Dictionary Use In Patent Claim Interpretation*, 6 N.C.J.L. & Tech. 153, 162 (2004).

<sup>208</sup> Ruoyu Roy Wang, *Texas Digital Systems v. Telegenix, Inc.: Toward A More Formalistic Patent Claim Construction Model*, 19 BERKELEY TECH. L. J. 153, 167–173 (2004); Anthony R. Zeuli & Rachel Clark Hughey, *Avoiding Patent Claim Construction Errors: Determining The Ordinary And Customary Meaning Before Reading The Written Description*, 51 Fed. Law. 29, 29–30 (June 2004).

<sup>209</sup> See Ruoyu Roy Wang, *supra* note 208 at 169–71.

<sup>210</sup> *Texas Digital Sys. v. Telegenix, Inc.*, 308 F.3d 1193, 1203 (Fed. Cir. 2002).

<sup>211</sup> See Br. Of The American Bar Association As Amicus Curiae Supporting Neither Party at 10–11; *Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004) (Nos. 03-1269, 03-1286).

<sup>212</sup> Br. For The United States As Amicus Curiae at 10–12; *Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004) (Nos. 03-1269, 03-1286) (quoting 37 C.F.R. § 1.175(d)(1)).



rely on their own understanding” of the terms and the “context” by which these terms are used in the specification.<sup>213</sup> Consequently, PTO examiners interpret claims in the broadest *reasonable* sense and not the broadest sense *possible*.<sup>214</sup> When courts apply the claim-based approach, they run the risk that their claim interpretation is “at odds with the PTO’s interpretation in issuing the patent.”<sup>215</sup>

The advantage of the claim-based approach is the ease by which courts can rely on dictionaries to construe claims.<sup>216</sup> However, this ease encourages superficial claim construction with inadequate technical understanding of the invention. Judges focus more on the “ordinary meaning” of claims and less on how a person skilled in the art would understand the claims.<sup>217</sup> This is true because judges attribute more evidentiary weight to dictionaries and devalue the role of expert testimony.<sup>218</sup> As a result, more and more decisions employing the claim-based approach have imported “extraneous limitations” from the dictionary into the claims.<sup>219</sup>

## II. THE ROLE OF EXTRINSIC EVIDENCE IN CLAIM CONSTRUCTION

“Extrinsic evidence is that evidence which is external to the patent and file history, such as expert testimony, inventor testimony, dictionaries, and technical treatises and articles.”<sup>220</sup> It is at the lower end of the hierarchy of evidence that can be used to

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<sup>213</sup> *Id.*

<sup>214</sup> *Id.*

<sup>215</sup> *Id.*

<sup>216</sup> See Ruoyu Roy Wang, *supra* note 208 at 168–69.

<sup>217</sup> Michael S. Conner & John A. Wasleff, *Where Do We Go From Here? A Critical Examination Of Existing Claim Construction Doctrine*, 86 J. Pat. & Trademark Off. Soc’y 878, 879–80 (2004).

<sup>218</sup> *Id.*

<sup>219</sup> Merck & Co. v. Teva Pharms. USA, Inc., 395 F.3d 1364 (Fed. Cir. 2005).

<sup>220</sup> Vitronics Corp. v. Conceptoric, Inc., 90 F.3d 1576, 1584 (Fed. Cir. 1996). Note that the *Texas Digital* court emphasized that “categorizing [dictionaries] as ‘extrinsic evidence’ or even a ‘special form of extrinsic evidence’ is misplaced and does not inform the analysis.” *Texas Digital Sys. v. Telegenix, Inc.*, 308 F.3d 1193, 1203 (Fed. Cir. 2002).

construe claims.<sup>221</sup> Generally speaking, extrinsic evidence cannot change the meaning of a claim term discernible from the intrinsic record.<sup>222</sup> Extrinsic evidence “may be used only to help the court come to the proper understanding of the claims; it may not be used to vary or contradict the claim language.”<sup>223</sup>

In most cases, an analysis of the intrinsic record, i.e., the claims, the specification, and the prosecution history, will suffice in resolving any ambiguity in a disputed claim term.<sup>224</sup> In these circumstances, extrinsic evidence “is entitled to no weight” and reliance on such evidence is improper.<sup>225</sup> However, if after considering all the intrinsic evidence there is still some ambiguity, a trial court may rely on extrinsic evidence to determine the meaning of the disputed claim term.<sup>226</sup> “Such instances will rarely, if ever, occur.”<sup>227</sup>

Even when the patent documents are unambiguous, “it is entirely appropriate, perhaps even preferable, for a court to consult trustworthy extrinsic evidence to ensure that the claim construction it is tending to from the patent file is not inconsistent with clearly expressed, plainly apposite, and widely held understandings in the pertinent technical field.”<sup>228</sup> Indeed, using extrinsic evidence to guide the court in understanding the technology ensures the prospects of proper claim construction that is not “at variance with the understanding of one skilled in the art.”<sup>229</sup>

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<sup>221</sup> *Vitronics*, 90 F.3d at 1582–84.

<sup>222</sup> *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1308 (Fed. Cir. 1999).

<sup>223</sup> *Vitronics*, 90 F.3d at 1582–84.

<sup>224</sup> *Id.* at 1583. (“In most situations, an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term.”)

<sup>225</sup> *Id.* at 1584.

<sup>226</sup> *Id.*; *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 709, 716 (Fed. Cir. 1998) (“[A] trial court is quite correct in hearing and relying on expert testimony on an ultimate claim construction question in cases in which the intrinsic evidence . . . [] does not answer the question.”)

<sup>227</sup> *Vitronics*, 90 F.3d at 1584.

<sup>228</sup> *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309 (Fed. Cir. 1999); *see also* *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 709, 716 (Fed. Cir. 1998); *see also* *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371 (Fed. Cir. 2003).

<sup>229</sup> *Pitney Bowes*, 182 F.3d at 1309; *see* Br. Of The American Bar Association As Amicus Curiae Supporting Neither Party at 6–8, *Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004) (Nos. 03-1269, 03-1286) (advocating that a court should “‘always’ consult secondary sources for education on the technology.”)

It is also appropriate to consider inventor testimony “to provide background information, including explanation of the problems that existed at the time the invention was made and the inventor’s solution to these problems.”<sup>230</sup> Although the subjective intent of the inventor has “no probative weight in determining the scope of a claim, this statement does not disqualify the inventor as a witness, or overrule the large body of precedent that recognizes the value of the inventor’s testimony.”<sup>231</sup> The inventor is a competent witness who is experienced in the field of the invention.<sup>232</sup> Inventor testimony may be used to explain the invention, but it may not be used to vary or contradict the scope of the claims.<sup>233</sup>

These guidelines for using extrinsic evidence allow competitors to rely on “the public record, apply the established rules of claim construction, ascertain the scope of the patentee’s claimed invention and, thus, design around the claimed invention.”<sup>234</sup> The guidelines prevent the patentee from altering the scope of the claims at trial to read on an accused device.<sup>235</sup> Moreover, the guidelines preclude accused infringers from varying or contradicting the ordinary meaning of a disputed claim term.<sup>236</sup>

While some extrinsic evidence, such as expert or inventor testimony, may be biased reflections of common understanding, colored by motives of the parties, and inspired by litigation,<sup>237</sup> admissibility of such evidence is safeguarded through a trial court’s “gate keeping” duties.<sup>238</sup> Trial judges are likely to admit

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<sup>230</sup> *Voice Techs., Group, Inc. v. VMC Sys., Inc.*, 164 F.3d 605, 615 (Fed. Cir. 1999).

<sup>231</sup> *Id.* (internal quotations omitted).

<sup>232</sup> *Id.*

<sup>233</sup> *Id.*; *but see* *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372 (Fed. Cir. 2000) (noting that a trial judge should not consider inventor testimony when trying to determine what invention was disclosed in the specification.).

<sup>234</sup> *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996).

<sup>235</sup> *Id.*

<sup>236</sup> *Id.* at 1582–83.

<sup>237</sup> *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1203 (Fed. Cir. 2002) (implying that dictionaries are better than expert testimony because they are unbiased sources of information).

<sup>238</sup> *See* *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579, 589 (1993) (discussing a trial judge’s role under Fed. R. Evid. 702 in admitting expert testimony based on scientific knowledge); *Kumho Tire Co., Ltd. v. Carmichael*, 526 U.S. 137, 147 (1999) (extending the gate keeping requirement from scientific to all expert testimony).

expert or inventor testimony only when it is relevant and reliable.<sup>239</sup> If the district court distrusts this testimony, the court has the authority to appoint an expert or a technical advisor.<sup>240</sup> This provides the trial court the ability to ascertain the meaning of a disputed claim term consistently with the understanding of one skilled in the art. Despite the valuable educational role of extrinsic evidence, some courts are confused on whether to consider the evidence when the patent documents are unambiguous.<sup>241</sup>

### III. OVERLAPPING CLAIM CONSTRUCTION WITH VALIDITY ANALYSIS

At the district court level, claim construction occurs during a Markman hearing, while a validity analysis occurs during the trial. At the Federal Circuit level, typically both issues are addressed separately in the opinion.<sup>242</sup> However, occasionally some Federal Circuit judges commingle their validity analysis with claim construction.<sup>243</sup> They require that “[c]laims amenable to more than one construction should, when it is reasonably possible to do so, be construed to preserve their validity.”<sup>244</sup> However, this does not mean that courts are permitted to redraft claims to maintain their

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<sup>239</sup> *Daubert*, 509 U.S. at 589.

<sup>240</sup> See *TechSearch, L.L.C. v. Intel Corp.*, 286 F.3d 1360, 1377–78 (Fed. Cir. 2002) (allowing trial judges to appoint technical advisors); Fed. R. Evid. 706 (allowing trial judges to appoint expert witnesses).

<sup>241</sup> See Br. Of The American Bar Association As Amicus Curiae Supporting Neither Party at 6–8, *Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004) (Nos. 03-1269, 03-1286) (suggesting that lower courts are confused about the proper role of extrinsic evidence).

<sup>242</sup> *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473 (Fed. Cir. 1998); *Mas-Hamilton Group v. LaGard, Inc.*, 156 F.3d 1206 (Fed. Cir. 1998); *Key Pharms. v. Herconn Labs. Corp.*, 161 F.3d 709 (1998).

<sup>243</sup> *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1434 (Fed. Cir. 1988) (using expert testimony and extrinsic evidence to determine “a pharmaceutically effective amount” that would maintain the validity of the claim phrase); *Modine Mfg. Co. v. U.S. Int’l Trade Comm’n*, 75 F.3d 1545, 1557 (Fed. Cir. 1996) (importing the range 0.015–0.040 from the specification into the claims to maintain the validity of the claim term “relatively small”).

<sup>244</sup> *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1384 (Fed. Cir. 2001).

validity.<sup>245</sup> “Where the only claim construction that is consistent with the claim’s language and the written description renders the claim invalid, then the axiom does not apply and the claim is simply invalid.”<sup>246</sup> Hence, after employing all the tools to claim construction, if the claim is ambiguous or rendered invalid under §§ 102, 103, or 112, the Federal Circuit will not “save” the claim from invalidity by reading extraneous limitations into it.<sup>247</sup>

Safeguarding the validity of claims during claim construction invites a patent holder to present exceedingly broad interpretation of claims to read on an accused device,<sup>248</sup> or in the alternative, present narrow interpretation of claims to avoid the prior art.<sup>249</sup> In the event that a broad interpretation renders the claims invalid, the court would narrow the scope of the claims to maintain the validity of the patent.<sup>250</sup> This encourages patentees to abuse the legal system because, in many instances, they seek to alter the scope of the claims beyond what they could have secured from the PTO.<sup>251</sup>

The consequences of claiming broadly in the PTO should equally apply in the federal courts. If the patentee presents broad claim construction that, for instance, reads on the prior art or is unsupported by the written description, he should be penalized by invalidating that claim.<sup>252</sup> This hard lined approach discourages

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<sup>245</sup> *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 911 (Fed. Cir. 2004) (emphasizing that when proper construction of claims is clear and unambiguous, the questions of priority and validity must be addressed separately from claim construction).

<sup>246</sup> *Apple Computer, Inc. v. Articulate Sys., Inc.*, 234 F.3d 14, 24 (Fed. Cir. 2000) (internal quotations omitted) (invalidating broadly construed claims because they read on the prior art); *see also* *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1434 (Fed. Cir. 1988) (emphasizing that claims are not “to be ‘saved’ from invalidity by reading extraneous limitations into them”).

<sup>247</sup> *See Liebel-Flarsheim*, 358 F.3d at 911; *Karsten*, 242 F.3d at 1384; *E.I. du Pont*, 849 F.2d at 1434.

<sup>248</sup> *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003).

<sup>249</sup> *See Karsten*, 242 F.3d at 1384.

<sup>250</sup> *See id.* This is true only when the claims are amenable to more than one construction. However, if the claims are amenable to only one possible construction that would render the claims invalid, courts will not rewrite the claims to sustain their validity.

<sup>251</sup> *Apple Computer*, 234 F.3d at 24; *E.I. du Pont*, 849 F.2d at 1434.

<sup>252</sup> It is not unusual to penalize a patentee during litigation. In fact, Congress has enacted a statute that penalizes patentees whose claim was invalidated during litigation by denying them recovery of legal fees. *See* 35 U.S.C. § 288.

patentees from broadening the scope of their claims during litigation and promotes judicial efficiency in construing disputed claim terms. Patentees will no longer seek to confuse the court with overly broad interpretation of claims in fear of getting their claims invalidated. This approach should only apply to patentee's proposed claim construction, and should not be applied dogmatically by the accused infringer to invalidate the patent.<sup>253</sup>

Protecting the validity of claims during claim construction, not only encourages a patentee from presenting very broad interpretation, but also violates the public notice function of patents and conflicts with the right to a jury trial on invalidity.<sup>254</sup> It violates the public notice function because some information may not be available to the public until well into the discovery phase of the case.<sup>255</sup> Consequently, it would be unfair to hold the public on notice of this information. Furthermore, taking validity into account does conflict with the right to a jury trial on invalidity.<sup>256</sup> Because invalidity often requires resolution of factual disputes, it is the prerogative of the jury and not the judge to resolve these issues.<sup>257</sup> Allowing a trial judge to address these issues during claim construction would impair the patentee's right to a jury trial.<sup>258</sup> Hence, considering validity during claim construction is improper and courts should analyze them separately.

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<sup>253</sup> See Michael S. Conner & John A. Wasleff, *Where Do We Go From Here? A Critical Examination Of Existing Claim Construction Doctrine*, 86 J. PAT. & TRADEMARK OFF. SOC'Y 878, 907 (2004) (noting that "an approach that dogmatically insists that the claim be construed to the full reach of a word definition, and then immediately invalidates the patent when it reads on prior art, is [ ] destructive of the presumption of validity . . ." of the claims).

<sup>254</sup> See Br. Of The American Bar Association As Amicus Curiae Supporting Neither Party at 14–16, *Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004) (Nos. 03-1269, 03-1286).

<sup>255</sup> *Id.* (noting that "secret" prior art under §§ 102(e) and (g) is not available to the public to determine the meaning of the claims).

<sup>256</sup> *Id.*

<sup>257</sup> *Id.*

<sup>258</sup> *Id.*

#### IV. PHILLIPS: AN ATTEMPT TO RESOLVE THE TENSION BETWEEN SPECIFICATION-BASED AND CLAIM-BASED APPROACHES

Because the specification-based approach conflicts with the claim-based approach, tension between these two methods of claim construction has slowly brewed over the past decade. Finally, in *Phillips v. AWH Corp.*, these two methods of claim construction have come face-to-face in a challenge that would determine their vitality.<sup>259</sup>

##### *A. The Trial Court And Federal Circuit Panel Decisions*

In *Phillips*, the patent was directed to vandalism-resistant building panels used in prison construction.<sup>260</sup> At issue was the meaning of the claim phrase “*means disposed inside the shell for increasing its load bearing capacity comprising steel baffles . . .*”<sup>261</sup> The patentee, Phillips, argued that the phrase is not a means-plus-function claim because the word “baffle” recites sufficient structure.<sup>262</sup> To broaden the scope of the claim, the patentee suggested that the term “baffle” must be construed in accordance with its ordinary and customary meaning as a “means for obstructing, impeding, or checking the flow of something.”<sup>263</sup> The accused infringer, AWH Corp., maintained that the specification limited the scope of “baffle” to a configuration “positioned at an acute or obtuse angle to wall faces.”<sup>264</sup> Specifically, the accused infringer contended that the written description did not describe a baffle configuration oriented at 90 degrees to the wall faces, and therefore, the accused panels fall outside the scope of the claims.<sup>265</sup>

The district court erroneously interpreted the disputed claim phrase as a means-plus-function limitation, and relied on the structures disclosed in the specification for its claim

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<sup>259</sup> *Phillips v. AWH Corp.*, 363 F.3d 1207 (Fed. Cir. 2004), *aff'd in part, rev'd in part, dis'd in part, and rem'd*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

<sup>260</sup> *Phillips*, 363 F.3d at 1209.

<sup>261</sup> *Id.* at 1210 (emphasis added).

<sup>262</sup> *Id.* at 1211.

<sup>263</sup> *Id.* at 1210–11.

<sup>264</sup> *Id.* at 1211.

<sup>265</sup> *Id.*

construction.<sup>266</sup> Based on the undisputed facts of the case, the lower court granted the accused infringer's motion for summary judgment of non-infringement, and the patentee timely appealed to the Federal Circuit.<sup>267</sup>

While the majority and the dissenting Federal Circuit judges agreed that the disputed claim phrase was not a means-plus-function limitation, they disagreed on the approach for construing the claim term "baffle."<sup>268</sup> The majority, while citing cases that applied the claim-based approach,<sup>269</sup> mimicked its specification-based analysis to that of *Scimed* and *Bell Atlantic*.<sup>270</sup> The majority explained that "[i]nspection of the patent shows that baffles angled at other than 90 degrees is the *only* embodiment disclosed in the patent; it is the invention."<sup>271</sup> Furthermore, the majority noted that "[i]t is impossible to derive anything else from the specification."<sup>272</sup> Because the majority's claim construction achieved the same result to that if section 112, paragraph 6 was invoked, the majority affirmed the lower court's claim construction order.<sup>273</sup>

Dissenting Judge Dyk accused the majority for "attempt[ing] to work a major and unfortunate change in our recent claim construction jurisprudence" because they effectively limited the scope of the claim to the preferred embodiment.<sup>274</sup> The judge

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<sup>266</sup> *Id.* at 1210.

<sup>267</sup> *Id.* at 1210–11.

<sup>268</sup> *Id.* at 1212–1219.

<sup>269</sup> *Id.* at 1213 (citing *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366–67 (Fed. Cir. 2002); *Comark Communications Inc. v. Harris Corp.*, 156 F.3d 1182, 1187 (Fed. Cir. 1998)).

<sup>270</sup> *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337 (Fed. Cir. 2001); *Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc. et al.*, 262 F.3d 1258 (Fed. Cir. 2001).

<sup>271</sup> *Phillips v. AWH Corp.*, 363 F.3d 1207, 1224 (Fed. Cir. 2004).

<sup>272</sup> *Id.* at 1213. Note that the majority's approach to claim construction is similar to *Bell Atlantic*. While the majority opinion suggested that the patentee has used the claim term throughout the patent specification consistent with only a single meaning, that is a baffle configuration positioned at an acute or obtuse angle to wall faces, the majority fell short in concluding that the term was defined "by implication."

<sup>273</sup> *Id.* at 1214.

<sup>274</sup> *Id.* at 1216. Apparently, Judge Dyk assumed that there is only one line of Federal Circuit jurisprudence on claim construction. As explained in this article, there are at least



emphasized that the Federal Circuit has “expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment.”<sup>275</sup> Employing the Suggestion Test to claim construction, the dissenting judge noted that “ ‘the specification here does not suggest that [baffles oriented at angles other than 90 degrees] are an essential component of the invention . . . .’ ”<sup>276</sup> Moreover, the judge maintained that the specification touts impact resistance as one of several objectives, and therefore, the claim should not be limited to achieve that objective.<sup>277</sup> Consequently, the judge interpreted the term “baffle” consistent with its dictionary definition.<sup>278</sup>

Dissatisfied with the panel decision, the patentee filed a combined petition for panel rehearing and rehearing *en banc*.<sup>279</sup> In view of the rising conflict between the specification-based approach and the claim-based approach, the Federal Circuit granted the petition to rehear the appeal *en banc*.<sup>280</sup> The Federal Circuit requested the parties to address seven issues and invited amicus curiae briefings from bar associations, trade or industry associations, government entities, and other interested parties.<sup>281</sup> After hearing the oral arguments, the Federal Circuit issued its highly anticipated decision on July 12, 2005.<sup>282</sup>

### *B. The En Banc Decision*

Nine out of the twelve Federal Circuit judges joined the entire opinion in favoring the specification-based approach over the

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two approaches to claim construction: the specification-based approach and the claim-based approach.

<sup>275</sup> *Id.* at 1217 (quoting *Liebel-Flarheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004)).

<sup>276</sup> *Phillips*, 363 F.3d at 1217.

<sup>277</sup> *Id.* at 1217–18.

<sup>278</sup> *Id.*

<sup>279</sup> *Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004).

<sup>280</sup> *Id.*

<sup>281</sup> *Id.* at 1382–84.

<sup>282</sup> *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

claim-based approach.<sup>283</sup> Judge Bryson wrote the majority opinion for the *en banc* court.<sup>284</sup> Despite the basic agreement for using the specification-based approach, Judges Lourie and Newman would have applied the facts differently from the majority.<sup>285</sup> Only Judges Mayer and Newman dissented for the majority's continued persistence to give no deference for trial court's claim construction rulings.<sup>286</sup>

The seven issues under *en banc* review are analyzed below:

*Question 1: "Is the public notice function of patent claims better served by referencing primarily to technical and general purpose dictionaries and similar sources to interpret a claim term or by looking primarily to the patentee's use of the term in the specification? If both sources are to be consulted, in what order?"*<sup>287</sup>

The court began its analysis by emphasizing that (1) claim terms "are generally given their ordinary and customary meaning"; (2) "the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art"; and (3) "the person skilled in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification."<sup>288</sup> The court cited numerous cases for the proposition that the "best source" for claim construction is the "patent specification."<sup>289</sup> The court further noted that the PTO ascertains claim scope by giving the claim its broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art."<sup>290</sup> Consequently, the *Phillips* court concluded that it is "entirely appropriate for a court, when

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<sup>283</sup> *Id.* at 1308–09. Ironically, Judge Dyk, who dissented in the 3 panel decision, also joined the majority opinion in favoring the specification-based approach to claim construction..

<sup>284</sup> *Id.*

<sup>285</sup> *Id.* at 1328–30 (Lourie, J. & Newman, J., concurring in part, dissenting in part).

<sup>286</sup> *Id.* at 1330–35 (Mayer, J. & Newman, J., dissenting).

<sup>287</sup> *Phillips v. AWH Corp.*, 376 F.3d 1382, 1382–84 (Fed. Cir. 2004).

<sup>288</sup> *Phillips*, 415 F.3d at 1312–13.

<sup>289</sup> *Id.* at 1315.

<sup>290</sup> *Id.* at 1316–17.

conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims.”<sup>291</sup>

Although extrinsic evidence, including dictionaries and learned treatises, are useful in educating the judge on the technology, the court considered such evidence as “less reliable.”<sup>292</sup> The court explained that extrinsic evidence (1) “by definition is not part of the patent”; (2) “may not reflect the understanding of a skilled artisan in the field of the patent”; (3) “can suffer from bias”, such as in the case of expert report and testimony; and (4) may be an “unbounded universe” having “some marginal relevance”.<sup>293</sup> As a result, undue reliance on dictionaries, divorced from the intrinsic record, would undermine the public notice function of patent claims.<sup>294</sup>

In sum, the court attributed greater evidentiary weight to the specification than dictionaries, but encouraged district courts to use both types of evidence so that the public notice function of patent claims would be best served. “The sequence of steps used by the judge in consulting various sources is not important; what matters is for the court to attach the appropriate weight to be assigned to those sources. . . .”<sup>295</sup>

*Question 2: “If dictionaries should serve as the primary source for claim interpretation, should the specification limit the full scope of claim language (as defined by the dictionaries) only when the patentee has acted as his own lexicographer or when the specification reflects a clear disclaimer of claim scope? If so, what language in the specification will satisfy those conditions? What use should be made of general as opposed to technical dictionaries? How does the concept of ordinary meaning apply if there are multiple dictionary definitions of the same term? If the dictionary provides multiple potentially applicable definitions for a term, is it appropriate to look to the specification to determine what definition or definitions should apply?”*<sup>296</sup>

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<sup>291</sup> *Id.* at 1317.

<sup>292</sup> *Id.* at 1318.

<sup>293</sup> *Id.*

<sup>294</sup> *Id.*

<sup>295</sup> *Id.* at 1324.

<sup>296</sup> *Phillips v. AWH Corp.*, 376 F.3d 1382, 1383 (Fed. Cir. 2004).

The *Phillips* court criticized the claim-based approach, adopted in *Texas Digital*, because the approach “placed too much reliance on extrinsic sources such as dictionaries . . . and too little on intrinsic sources, in particular the specification and prosecution history.”<sup>297</sup> It allowed courts to consult the specification only after determining a claim term’s ordinary meaning based on a dictionary definition.<sup>298</sup> Typically, the specification was used to (1) exclude one of the meanings determined from the dictionary; (2) determine if the patentee has disavowed any claim scope; or (3) determine if the patentee acted as his or her own lexicographer.<sup>299</sup>

The court emphasized that the claim-based approach “improperly restricts the role of the specification in claim construction” and allows an “unduly expansive” interpretation of claims beyond what the inventor secured from the PTO.<sup>300</sup> The court noted that both general and technical dictionaries provide “expansive array of definitions,” but there is no assurance that these dictionaries used the term in the same manner as the patentee have in the specification.<sup>301</sup> If a district court begins its analysis with a “broad dictionary definition in every case and fails to fully appreciate how the specification implicitly limits that definition, the error will systematically cause the construction of the claim to be unduly expansive.”<sup>302</sup> Accordingly, the *Phillips* court explained that this “risk of systematic overbreadth is greatly reduced if the court instead focuses at the outset on how the patentee used the claim term in the claims, specification, and prosecution history, rather than starting with a broad definition and whittling it down.”<sup>303</sup>

*Question 3: “If the primary source for claim construction should be the specification, what use should be made of dictionaries? Should the range of the ordinary meaning of claim language be limited to the scope of the invention disclosed in the*

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<sup>297</sup> *Phillips v. AWH Corp.*, 415 F.3d 1303, 1320 (Fed. Cir. 2005) (en banc).

<sup>298</sup> *Id.*

<sup>299</sup> *Id.*

<sup>300</sup> *Id.* at 1321.

<sup>301</sup> *Id.*

<sup>302</sup> *Id.*

<sup>303</sup> *Id.*

*specification, for example, when only a single embodiment is disclosed and no other indications of breadth are disclosed?”*<sup>304</sup>

The *Phillips* court attributed a secondary role to dictionaries, outweighed by the specification and the prosecution history. It rejected the claim-based approach, but failed to adequately address the underlying concern of *Texas Digita*—to avoid importing limitations from the specification into the claims.<sup>305</sup> “[T]here is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification.”<sup>306</sup> The court explained that this line “can be discerned with reasonable certainty and predictability if the court’s focus remains on understanding how a person of ordinary skill in the art would understand the claim terms.”<sup>307</sup>

Unfortunately, the court’s explanation on this key issue provides neither “clarity” nor “predictability.” If we are to focus on how a person skilled in the art would understand the claim terms, we would probably need extrinsic evidence, such as expert testimony. Ironically, expert testimony has a subordinate role in claim construction because it is readily viewed as biased opinion.<sup>308</sup> So, how can we rely on subordinate evidence to determine the role of the specification, the primary evidence for claim construction?

The *Phillips en banc* court also warned against limiting claims to specific embodiments in the specification, even if the patent described only a single embodiment.<sup>309</sup> The court maintained that reading the specification, with the understanding that its specific purpose is to teach, enable, and provide the best mode for practicing the invention, would in most instances clarify whether the patentee merely provided some examples or intended to limit the claims to the embodiments.<sup>310</sup> The court acknowledged that in

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<sup>304</sup> *Phillips v. AWH Corp.*, 376 F.3d 1382, 1383 (Fed. Cir. 2004).

<sup>305</sup> *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc).

<sup>306</sup> *Id.* (citing *Comark Comms., Inc. v. Harris Corp.*, 156 F.3d 1182, 1186–87 (Fed. Cir. 1998)).

<sup>307</sup> *Id.* at 1323.

<sup>308</sup> *Id.* at 1318.

<sup>309</sup> *Id.* at 1323 (citing *Gemstar-TV Guide Int’l, Inc. v. International Trade Comm’n*, 383 F.3d 1352, 1366 (Fed. Cir. 2004)).

<sup>310</sup> *Id.* at 1323.

some instances “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.”<sup>311</sup> Nevertheless, the court refrained from devising a “magic formula or catechism for conducting claim construction” and preferred to address this issue in the context of a specific patent.<sup>312</sup>

This decision leaves the door open for inconsistent judicial claim interpretation, as illustrated by how Judges Lourie and Newman construed the term “baffle” different from the majority.<sup>313</sup> The majority emphasized that the specification does not require all the advantages of the claim term to be accomplished; rather, any one advantage would suffice.<sup>314</sup> Consequently, the term “baffle” should not be limited to acute or obtuse angles, but can also be oriented at a right angle.<sup>315</sup> Disagreeing with the majority’s claim construction, Judges Lourie and Newman pointed out that the specification does not contain any disclosures of baffles with right angles, and so must be limited to acute or obtuse angles.<sup>316</sup> This demonstrates that even when the Federal Circuit agrees on using a unified claim construction approach, the outcome of the case is still dependent on the judge’s personal interpretation of claims.

*Question 4: “Instead of viewing the claim construction methodologies in the majority and dissent of the now-vacated panel decision as alternative, conflicting approaches, should the two approaches be treated as complementary methodologies such that there is a dual restriction on claim scope, and a patentee must satisfy both limiting methodologies in order to establish the claim coverage it seeks?”*<sup>317</sup>

The *Phillips* court did not consider the two approaches complementary; instead, it favored the specification-based

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<sup>311</sup> *Id.*

<sup>312</sup> *Id.* at 1324.

<sup>313</sup> *Id.* at 1329 (Lourie, J. & Newman, J., concurring in part, dissenting in part).

<sup>314</sup> *Id.* at 1326–27.

<sup>315</sup> *Id.* at 1327.

<sup>316</sup> *Id.* at 1329–30 (Lourie, J. & Newman, J., concurring in part, dissenting in part).

<sup>317</sup> *Phillips v. AWH Corp.*, 376 F.3d 1382, 1383 (Fed. Cir. 2004).

approach over the claim-based approach.<sup>318</sup> Like *Vitronics*, the court permitted the use of dictionaries and treatises, only to the extent that they do not “contradict claim meaning that is unambiguous in light of the intrinsic evidence.”<sup>319</sup> It did not provide a “rigid algorithm for claim construction.”<sup>320</sup> Instead, the court encouraged district court judges to consider all evidence, in any sequence, and attribute more evidentiary weight to intrinsic evidence.<sup>321</sup>

*Question 5: “When, if ever, should claim language be narrowly construed for the sole purpose of avoiding invalidity under, e.g., 35 U.S.C. §§ 102, 103 and 112?”*<sup>322</sup>

The Federal Circuit continued its controversial practice of narrowly construing claims to preserve their validity.<sup>323</sup> While the court did not endorse a validity analysis as a regular component of claim construction, it limited such analysis only when “the court concludes, after applying all the available tools of claim construction, that the claim is still ambiguous.”<sup>324</sup> Since the court considered the term “baffle” as unambiguous, it refused to apply the “doctrine of construing claims to preserve their validity.”<sup>325</sup>

Although the *Phillips* court permitted the commingling of validity analysis with claim construction, it misapplied the doctrine.<sup>326</sup> The doctrine requires that “[c]laims amenable to more than one construction should, when it is reasonably possible to do so, be construed to preserve their validity.”<sup>327</sup> However, if after employing all the tools to claim construction, the claim is ambiguous or rendered invalid, the Federal Circuit should not “save” the claim from invalidity by reading extraneous limitations

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<sup>318</sup> See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1325–27 (Fed. Cir. 2005) (en banc).

<sup>319</sup> *Id.* at 1324; see *Intel Corp. v. VIA Techs. Inc.*, 319 F.3d 1357, 1367 (Fed. Cir. 2003).

<sup>320</sup> *Phillips*, 415 F.3d at 1324.

<sup>321</sup> *Id.* (citing *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)).

<sup>322</sup> *Id.* at 1382.

<sup>323</sup> *Id.* at 1327–28.

<sup>324</sup> *Id.* at 1327 (quoting *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 911 (Fed. Cir. 2004)).

<sup>325</sup> *Id.* at 1327–28.

<sup>326</sup> See *id.*

<sup>327</sup> *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1384 (Fed. Cir. 2001).

into it.<sup>328</sup> Hence, the court should invoke the doctrine when a claim term is susceptible to more than one meaning, and not if the term is ambiguous, as the *Phillips* court has suggested.<sup>329</sup> Moreover, if the claim term is ambiguous, the court should refrain from “saving” the term from invalidity, rather than indulge in an effort to preserve its validity.

*Question 6: “What role should prosecution history and expert testimony by one of ordinary skill in the art play in determining the meaning of the disputed claim terms?”*<sup>330</sup>

The prosecution history is part of the intrinsic record; therefore, it should be considered in determining the meaning of a disputed claim term, and must be attributed more evidentiary weight than any extrinsic evidence.<sup>331</sup> It contains a “complete record of the proceeding before the PTO,” including any explanations made by the patentee to obtain the patent.<sup>332</sup> However, “it often lacks the clarity of the specification and thus is less useful for claim construction purposes” because it only “represents an ongoing negotiation” between the patent applicant and the PTO.<sup>333</sup> Nevertheless, the prosecution history can be useful in claim construction by indicating “how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be.”<sup>334</sup>

Extrinsic evidence in the form of expert testimony is considered “less significant” and “less reliable” than the intrinsic evidence.<sup>335</sup> This is because expert testimony is “generated at the time of and for the purpose of litigation and thus can suffer from bias that is not present in intrinsic evidence.”<sup>336</sup> However, it can have a constructive role in claim construction by (1) educating the court on the relevant technology; (2) explaining how the invention

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<sup>328</sup> See *Liebel-Flarsheim*, 358 F.3d at 911; *Karsten*, 242 F.3d at 1384.

<sup>329</sup> See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1327 (Fed. Cir. 2005) (en banc).

<sup>330</sup> *Phillips v. AWH Corp.*, 376 F.3d 1382, 1382–84 (Fed. Cir. 2004).

<sup>331</sup> *Phillips*, 415 F.3d at 1317.

<sup>332</sup> *Id.* (citing *Autogiro Co of America v. U.S.*, 384 F.2d 391, 399 (Ct. Cl. 1967)).

<sup>333</sup> *Id.*

<sup>334</sup> *Id.*

<sup>335</sup> *Id.* at 1317–19.

<sup>336</sup> *Id.* at 1318.



works; (3) ensuring the court's understanding of the technology is consistent with that of a person of ordinary skill in the art; and (4) establishing a particular term's special meaning in the pertinent field.<sup>337</sup> Hence, expert testimony is useful, but must be considered in the context of and attributed less evidentiary weight than the intrinsic record.<sup>338</sup>

*Question 7: "Consistent with the Supreme Court's decision in Markman v. Westview Instruments, Inc., 517 U.S. 370 . . . (1996), and our en banc decision in Cybor Corp. v. FAS Technologies, Inc., 138 F.3d 1448 (Fed.Cir.1998), is it appropriate for this court to accord any deference to any aspect of trial court claim construction rulings? If so, on what aspects, in what circumstances, and to what extent?"*<sup>339</sup>

The *Phillips* court decided not to change the *de novo* review of a trial court's claim construction ruling.<sup>340</sup> While many were hoping that the Federal Circuit would give some deference to a trial court's claim construction, the *en banc* court declined to address this issue in the present case.<sup>341</sup> This decision drew criticism from Judges Mayer and Newman.<sup>342</sup> They were disappointed that the majority did not say anything new, "but merely restate what has become the practice over the last ten years – that [the Federal Circuit] will decide cases according to whatever mode or method results in the outcome [it] desire[s]."<sup>343</sup> Using "dictionaries first, dictionaries second, never dictionaries, etc., etc, etc." are among the many alternative modes that the Federal Circuit has employed.<sup>344</sup> The dissenting judges emphasized that "there can be no workable standards by which this court will interpret claims so long as we are blind to the factual component of the task."<sup>345</sup> Since the Federal Circuit has maintained status quo, this debate on the standard of review will continue unresolved.

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<sup>337</sup> *Id.* 1318–19.

<sup>338</sup> *Id.* at 1317.

<sup>339</sup> *Phillips v. AWH Corp.*, 376 F.3d 1382, 1382 (Fed. Cir. 2004).

<sup>340</sup> *Phillips v. AWH Corp.*, 415 F.3d 1303, 1328 (Fed. Cir. 2005) (en banc).

<sup>341</sup> *Id.* at 1328.

<sup>342</sup> *See id.* at 1330–35 (Mayer, J. & Newman, J., dissenting).

<sup>343</sup> *Id.* at 1330.

<sup>344</sup> *Id.*

<sup>345</sup> *Id.* at 1331.

## CONCLUSION

Embarking on a quest to provide a unified claim construction approach, the *Phillips en banc* case could undoubtedly have had a greater impact on the legal and business professions. This Note presented the ideological underpinnings of the two approaches to claim construction, and examined their advantages and disadvantages. The *Phillips* court may have relieved the tension between the two approaches by choosing the specification-based approach over the claim-based approach, but it failed to adequately address the disadvantage of using the specification-based approach. The court did not explain how one can distinguish between “reading limitations from the specification into the claim”<sup>346</sup> and “interpreting patent claims [in light] of the specification.”<sup>347</sup> Accordingly, the role of the specification remains obscure. While it is unlikely that this case will be the last word on claim construction, it is hoped that this Note will contribute some constructive ideas to the court’s future examination of its claim construction methodology.

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<sup>346</sup> *Id.* at 1323.

<sup>347</sup> *Id.* at 1329.