

PHILLIPS V. AWH: CHANGING THE NAME OF THE GAME¹

I. INTRODUCTION

Like many other forms of intellectual property protection, a patent creates a limited property right – specifically, the right to exclude others from making, using, selling, offering to sell, or importing the claimed invention.² In today’s marketplace, a well-informed patent holder can use a patent both offensively and defensively.³ When used offensively, a patent can generate new revenues via licensing agreements or civil suits.⁴ When used

1. Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (rehearing en banc), 376 F.3d 1382 (Fed. Cir. 2004) (order of the Court of Appeals for the Federal Circuit ordering the previous judgment vacated and certifying seven questions for review). Amicus briefs were submitted on September 24, 2004, and oral arguments were heard on February 8, 2004. Judge Giles S. Rich is often quoted for the statement: “To coin a phrase, the name of the game is the claim.” Giles S. Rich, *Extent of Protection and Interpretation of Claims - American Perspectives*, 21 INT’L REV. INDUS. PROP. & COPYRIGHT L. 497, 499 (1990). In *Phillips*, the Federal Circuit has taken the opportunity to reevaluate the methodology courts use to interpret patent claims. See *infra* note 86 (listing the seven questions heard in the en banc rehearing in *Phillips*).

2. 35 U.S.C. § 271(a) (2003) (“Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefore, infringes the patent.”).

3. See Cynthia A. Lock, *Patent Licensing and Litigation Strategies*, in PATENT LICENSING AND LITIGATION STRATEGIES 2004, at 643, 647-53 (PLI Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series, 2004). See also John Carson et al., *How to Effectively Build and Protect Business Assets with a Strategic Patent Portfolio*, 9 NO. 1 INTELL. PROP. L. BULL. 1, 2 (2004) (“Strategic reasons for building a patent portfolio can be categorized as offensive, defensive, or both.”).

4. See 35 U.S.C. § 284 (2000) (providing courts with the power to grant monetary damages that are “adequate to compensate for the infringement, but in no event less than a reasonable royalty” and also providing for treble damages); see also 35 U.S.C. § 285 (2005) (giving courts the power to grant attorney fees in “exceptional cases”); see also Carson, *supra* note 3, at 1 (“A company can license its patented technology to competitors and generate revenue without incurring production or sales costs.”). Pamela Banner Krupka detailed an interesting case study involving how Ronald Katz utilized patent licensing to his benefit:

Katz holds dozens of United States patents, covering a wide range of interactive technology including automated forms of customer service, securities trading, merchandising, prepaid services, [and many others]. Katz has obtained numerous licenses for financial services call processing patents, wherein customer service is

defensively, a patent can enjoin others from entering the market⁵ or provide a shield against potential patents being issued to a company's competitors.⁶ This dual-nature of patents has led to billion dollar licenses, multi-million dollar infringement verdicts, and unprecedented sales figures.⁷

For a relatively nominal cost, a patent attorney or patent agent will draft a patent application for an inventor.⁸ A patent

provided to consumer and business accounts are delivered through automatic systems as well as the combination of automated systems and live agents. Apparently suggesting that any company with a call center must be using his patents, Katz has successfully licensed his portfolio in the financial services and banking industry. Observers indicate that Katz has generated millions of dollars licensing these patents alone.

Pamela Banner Krupka, *Patent Licensing as a Source of Revenue*, in PATENTS IN THE FINANCIAL SERVICES INDUSTRY: WHAT YOU NEED TO KNOW, at 235, 243 (PLI Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series, 2004).

5. 35 U.S.C. § 283. See also Lock, *supra* note 3, at 653; Carson, *supra* note 3, at 1 (“A patent portfolio can be the most effective way a business protects its assets and investments. By carving out an exclusive market space for products and creating barriers to entry for competitors, an effective patent portfolio can help deter competition in the marketplace.”).

6. Carson, *supra* note 3, at 2. When a new patent application is filed, the United States Patent and Trademark Office searches prior patents and prior publications in the field (prior art) to determine if the new application meets the requirements for patentability. Thus, a company's issued patents and other publications may preclude competitors from obtaining a patent, even if the publication never becomes a patent. *Id.*

7. See, e.g., Gregory D. Hopp, *IT Perspective: Questionable Claims Finding Some Success in Court*, BUS. INS., June 18, 2001, at G12 (noting that the largest verdicts in 2000 “included a \$324 million verdict in a patent infringement claim”). Legal newspapers have also reported on the major patent infringement cases. See, e.g., *Verdicts and Settlements: Plastics Firm Bags \$102.38M Patent Infringement Award*, NAT'L L.J., Dec. 9, 1996, at A9; *Verdicts and Settlement: GE Hit with \$111M Award in MRI Infringement Suit*, NAT'L L.J., Jun. 19, 1995, at A13. See also *Polaroid Corp. v. Eastman Kodak Co.*, 17 U.S.P.Q.2d 1711 (D. Mass. 1991) (finding damages of \$873 million). *Polaroid* was settled in July 1991 for \$925 million, terminating the 15-year feud over the patent rights regarding instant cameras and film. *Kodak Settles with Polaroid*, N.Y. TIMES, July 16, 1991, at D8. See also *Top 100 Verdicts of 2003*, NAT'L L. J., Feb. 9, 2004, at S5 (listing top 100 jury awards for 2003).

8. An objective source for determining the cost of a patent comes from the American Intellectual Property Law Association (AIPLA), whose most recent biennial survey of patent prosecution costs states that the national median costs of preparing and filing provisional applications were as follows: \$2,993 for a provisional patent application; \$10,001 for a “relatively complex biotechnology/chemical” utility application; \$9,995 for a “relatively complex electrical computer” utility application; and \$8,001 for a “relatively complex mechanical” utility application, AM. INTELLECTUAL PROP. LAW ASS'N., REPORT OF THE ECONOMIC SURVEY 2003, 88 tbl.21 (2003). As of the newest fee schedule, the \$700 issue fee for a *pro se* applicant will typically be the single largest expenditure assuming the applicant qualifies for “small entity” status. (A *pro se* applicant is one who files the patent application without the help of a patent agent or patent attorney). See 37 C.F.R. § 1.16 (2005), 37 C.F.R. § 1.17 (2005), and 37 C.F.R. § 1.18 (2005) (listing fees required in filing a patent application in the Patent and Trademark Office). Other authorities suggest that if an inventor retains a patent attorney or patent agent, “it is common for a patent application to cost \$2,000-\$3000 at the low end of the scale, or \$10,000 to \$15,000 for a complex application.” Center for Business Planning, *What a Patent Costs*, available at

application typically has three parts: a specification,⁹ drawings,¹⁰ and a set of claims.¹¹ It is the claims that define the patent owner's property right – the right to exclude.¹² These claims are merely words that the patent attorney has chosen to describe the invention.¹³ Because our language is imprecise, courts must interpret the exact meaning of the claims to determine specifically what a patent protects.¹⁴

<http://www.businessplans.org/topic82.html> (last visited Feb. 18, 2005). On the high end of the scale for estimating the cost of a patent, other scholars have opined that prosecuting a patent application averages from \$10,000 to \$30,000. Kimberly Moore, *Xenophobia in American Courts*, 97 NW. U. L. REV. 1497, 1544-55 (2003). Professor Moore states that “the bulk of the expenses are spent drafting and prosecuting the claims, so more claims will raise prosecution fees.” *Id.*

9. United States Patent and Trademark Office, *General Information Concerning Patents*, <http://www.uspto.gov/web/offices/pac/doc/general/index.html#spec> (last modified Jan. 2005). The specification portion of the application is a detailed description of the invention and the manner and process for making it. *Id.* The specification must be in such full, clear, concise, and exact terms to enable one skilled in the art to make and use the invention. 35 U.S.C. § 112 (2005).

10. United States Patent and Trademark Office, *General Information Concerning Patents*, <http://www.uspto.gov/web/offices/pac/docgeneral/#drawing> (last modified June 16, 2004). A drawing is required whenever the nature of the case requires a drawing to understand the invention. 35 U.S.C. § 113 (2005).

11. United States Patent and Trademark Office. *General Information Concerning Patents*, available at <http://www.uspto.gov/web/offices/pac/doc/general/#spec> (last modified June 16, 2004) (declaring that the claims are an important part of the application, because they define “the scope of the protection afforded by the patent and which questions of infringement are judged by the courts”).

12. *See, e.g., Zenith Lab. Inc. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1424 (Fed. Cir. 1994) (“It is the claim that sets the metes and bounds of the invention entitled to the protection of the patent system.”).

13. MARTIN J. ADELMAN ET AL., *CASES AND MATERIALS ON PATENT LAW* 525 (2d ed. 2003). Generally, the particular words of a claim define a patent owner's right to exclude others. *Id.* However, a patent owner may also choose to incorporate the specification and drawings into the claims by way of functional claiming. 35 U.S.C. § 112 (2003). The relevant portion of the statute reads:

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 act in support thereof, and such claim shall be construed to cover the corresponding structure, material or acts described in the specification and equivalents thereof.

Id. This type of claiming is known as “functional claiming.” ADELMAN ET AL., *supra*, at 555-57. By using the word “means” in a patent claim, an applicant establishes a presumption of means-plus-function (i.e., functional) claiming. *Id.* Claims in this format will be limited to the embodiment described in the specification and shown in the drawings. *Id.* Thus, functional claiming is one example where the express language of 35 U.S.C. § 112 dictates that the specification and drawings must limit the scope of a patent's claims. In *Re Donaldson Co.*, 16 F.3d 1189 (Fed. Cir. 1994). This is an exception to the general rule that the language of the claims defines the bounds of the right to exclude.

14. In referring to statutory interpretation, Justice Frankfurter commented on the inexactness of words:

Anything that is written may present a problem of meaning. . . . The problem derives from the very nature of words. They are symbols of meaning. But unlike mathematical symbols, the phrasing of a document, especially a complicated enactment, seldom attains

Courts interpret patent claims in pre-trial hearings commonly referred to as *Markman* hearings.¹⁵ By giving the parties an early and definitive claim interpretation, these hearings inform the parties of the scope of the patent so the parties are in a better position to proceed with settlement.¹⁶ Ultimately, early settlements help the parties avoid full-blown patent litigation and its associated costs, which are typically several million dollars.¹⁷

Recently, a split of authority concerning how courts carry out these *Markman* hearings has arisen in the Court of Appeals for the Federal Circuit (Federal Circuit).¹⁸ One line of cases adheres to the view that courts should interpret a patent's claims according to the ordinary meaning of the claim language.¹⁹ The opposing view

more than approximate precision. If individual words are inexact symbols, with shifting variables, their configuration can hardly achieve invariant meaning or assured definiteness.

Felix Frankfurter, *Some Reflections on the Readings of Statutes*, 47 COLUM. L. REV. 527, 528 (1947). See also Felix Frankfurter, *A Re-Evaluation of the Use of Legislative History in the Federal Courts*, 52 COLUM. L. REV. 125 (1952).

15. E.g., Patricia Martone, *Before the Actual Markman Hearing – Timing, Discovery, and Alternatives*, in HOW TO PREPARE & CONDUCT MARKMAN HEARINGS 2003, at 91, 97 (PLI Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series, 2003).

16. *Id.* (“Conventional wisdom suggests that early claim construction promotes settlement.”). But see *id.* (“Magistrate Judge Thyng . . . stated that while claim construction had a role in a couple of mediations she conducted, the magistrate judge was unable to identify a consistent pattern of claim construction impact on settlement.”).

17. See AM. INTELLECTUAL PROP. L. ASS'N, REPORT OF ECONOMIC SURVEY 22 (2003). Patent infringement suits are expensive. See *id.* Based on the dollar amount at risk in the patent infringement suit, this survey categorized patent infringement suits into three categories: less than \$1 million at risk, \$1-\$25 million at risk, and more than \$25 million at risk. *Id.* at 21. For these suits, the total average cost per side was \$500,000, \$2,000,000, and \$3,995,000, respectively. *Id.* at 22. The average cost per side at the end of discovery was \$290,000, \$1,001,000, and \$2,500,000, respectively. *Id.* These costs include “outside legal counsel and paralegal services, local counsel, associates, paralegals, travel and living expenses, fees and costs for court reporters, photocopies, courier services, exhibit preparation, analytical testing, expert witnesses, translators, surveys, jury advisors, and similar expenses.” *Id.* at 7. Thus, if courts can encourage parties to settle prior to discovery, the parties could be spared significant litigation expenses. See *id.* at 22.

18. Craig A. Nard, *A Theory of Claim Interpretation*, 14 HARV. J.L. & TECH 1, 4-5 (2000) (describing two claim construction approaches as “hypertextualism” and “pragmatic textualism,” respectively). See also R. Polk Wagner & Lee Petherbridge, *Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance*, 152 U. PA.L.REV. 1105, 1111 (2004) (deeming the two approaches “holistic” and “procedural” and undertaking a qualitative analysis of the Federal Circuit’s claim construction methodology).

19. See Nard, *supra* note 18, at 4-5. Nard deems this approach “hypertextualist” approach, and notes that it “stresses textual fidelity and internal textual coherence,” but eschews extrinsic evidence as an interpretive tool, portraying its use as “rarely, if ever, ‘proper.’” *Id.* at 5 (quoting *Vitronics Corp. v. Cenceptronic Inc.*, 90 F.3d 1576, 1585 (Fed. Cir. 1996). A “hypertextualist” judge rarely finds the claims, written description, and prosecution history ambiguous, and as such rarely relies on expert testimony. *Id.* Wagner refers to this approach as the “procedural” approach

favors looking to the written description and drawings to interpret the claims.²⁰ Because the Federal Circuit has almost exclusive jurisdiction over patent appeals,²¹ this split of authority within the Federal Circuit has made it difficult, if not impossible, for practitioners to advise their clients on precisely what a given patent protects.²² Thus, in patent law, there is no issue more important than claim construction.²³ The fortunes of industry rise and fall on such rulings.²⁴

The Federal Circuit granted an *en banc* hearing of *Phillips v. AWH Corp.*²⁵ to address the dichotomy existing in the Circuit's jurisprudence.²⁶ Because of the impact of claim construction on every litigated patent, *Phillips* has been deemed one of the most important cases in patent law since the landmark case of *Markman v. Westview Instruments Inc.* in the mid-1990s.²⁷

In order to help the reader understand the implications of the case, the remainder of this Note is divided into four sections. Section II

and notes that it is characterized by adherence to a relatively strict rules-based hierarchy of interpretive source, with a particular emphasis on the ordinary meaning of disputed patent claim language. See Wagner & Petherbridge, *supra* note 18, at 1111 n.19.

20. See Wagner & Petherbridge, *supra* note 18, at 1111 n. 19. Wagner refers to this approach as the "holistic" approach and notes that it is a far less structured analysis. *Id.* Nard refers to this approach as the "pragmatic textualist" approach and emphasizes that this approach considers the relevance of extrinsic context and industry custom, while at the same time embracing the importance of textual fidelity and internal coherence. Nard, *supra* note 18, at 5.

21. Matt Jamison, Comment, *The On-Sale Bar and the New UCC Article 2: Arguments for Defining a Commercial Offer for Sale Pursuant to the United Nations Convention on Contracts for the International Sale of Goods*, 5 N.C. J.L. & TECH 351, 353 (2004). Following the creation of the Federal Circuit in 1982, the Supreme Court has granted certiorari in only three cases dealing with substantive patent issues. See Mark D. Janis, *Patent Law in the Age of the Invisible Supreme Court*, 2001 U. ILL. L. REV. 387, 388 n.2 (2001).

22. Christine Hines, *A Defining Moment for Patent Law: Court Mulls the Best Way to Interpret Patent Claims*, LEGAL TIMES, Aug. 9, 2004 (quoting Scott Doyle, a partner in the office of Morrison & Foerster).

23. Brief for American Bar Ass'n as Amicus Curiae Supporting Neither Party at 2, *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (Nos. 03-1269,-1286) [hereinafter ABA Amicus Brief].

24. *Id.*

25. *Phillips v. AWH*, 363 F.3d 1207, (Fed. Cir. 2004), *en banc reh'g granted*, 376 F.3d 1382 (Fed. Cir. 2004).

26. See generally *infra* notes 90-134 and accompanying text (referring to the section of this note entitled "Statement of the Case").

27. Hines, *supra* note 22, at 1 ("Phillips may be the most significant case to tackle the issue of interpreting patent claims since the U.S. Supreme Court's 1996 ruling in *Markman v. Westview Instruments*, which held that judges, not juries, should determine the meaning of patent."). "The decision has the potential not only to provide clarity for lawyers and their clients, but also to save clients money and enhance predictability in the patent system." *Id.* "This is the battleground on which patent litigation is fought and won," said William Rooklidge, president-elect of the American Intellectual Property Law Association (AIPLA) and a partner at [Washington's] Howrey Simon Arnold & White." *Id.* (quoting William Rooklidge).

details the history and development of claim construction.²⁸ Section III discusses the *Phillips* case, including the relevant facts and procedural history.²⁹ Section IV analyzes the positions of the amicus briefs and urges the Federal Circuit to adopt a balanced approach that looks to both dictionaries as well as to the specification.³⁰ Lastly, Section V provides a conclusion.

II. BACKGROUND

A. Historical Background

Modern inventors typically hire patent attorneys to submit a patent application³¹ to the United States Patent and Trademark Office (USPTO).³² If, after thorough examination, the USPTO believes that the invention meets the statutory requirements,³³ it will grant the inventor a patent that is enforceable for a period of twenty years from the original date of filing.³⁴

Historically, in determining the scope of a patentee's property

28. See generally *infra* notes 31-82 and accompanying text (referring to the section of this note entitled "Background").

29. See generally *infra* notes 90-134 and accompanying text (referring to the section of this note entitled "Statement of the Case").

30. See *infra* notes 135-225 and accompanying text (referring to the section of this note entitled "Analysis").

31. In this Note, the use of the term "patent application" (or "application") is concerned with only non-provisional utility patent applications. The term does not refer to provisional patent applications, which are not required to include claims. 35 U.S.C. § 111(b)(2).

32. See *supra* note 8 (describing common costs associated with hiring patent agents and patent attorneys to file patent applications).

33. To obtain a patent, a patent application must meet the five basic requirements of patentability:

1. The invention must fall within patentable subject matter of 35 U.S.C. § 101;
2. The invention must be useful under 35 U.S.C. § 101;
3. The invention must be new or novel under 35 U.S.C. § 102;
4. The invention must be nonobvious under 35 U.S.C. § 103; and
5. The application must meet the formal requirements of 35 U.S.C. § 112.

BRENT A. OLSON, BUSINESS LAW DESKBOOK, FORMATION AND OPERATION OF BUSINESSES § 17.3.01 (2004). See also 35 U.S.C. § 101 (2003) ("Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title."); 35 U.S.C. § 102 (2003) (entitled "Conditions for patentability; novelty and loss of right to patent"); 35 U.S.C. § 103 (2003) (entitled "Conditions for patentability; non-obvious subject matter"); 35 U.S.C. § 112 (2003) (entitled "Specification").

34. 35 U.S.C. § 154 (2002) ("Term.—subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the dates on which the application for the patent was filed.").

right, courts have given different weight to the various portions of the patent.³⁵ Patent claims, as we currently understand them, “did not exist until the early 1800s, did not receive formal legal recognition until 1836, and were not required of all patentees until 1870.”³⁶ Thus, early courts turned to the specification to interpret the metes and bounds of the invention.³⁷ More recently with the Patent Act of 1952, Congress mandated that the “specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter. . . [of] the invention.”³⁸ Courts have interpreted this language to indicate that the claims of a patent define the patentee’s property right.³⁹

Typically in patent litigation, interpreting a patent’s claims and determining whether a product infringes upon those interpreted claims has been a factual determination for the fact-finder.⁴⁰ From the perspective of a person of ordinary skill in the art, the fact-finder interpreted the meaning of the claims using the specification and drawings in the patent.⁴¹ Then the fact-finder decided whether or not the allegedly infringing product did, in fact, infringe on the patent.⁴² Because of the complex scientific and legal issues involved, claim interpretation was particularly difficult for lay juries.⁴³ Accordingly,

35. See *infra* notes 36-44, and accompanying text (giving a brief historical overview of how courts discerned the property right that a patent defines).

36. Wagner & Petherbridge, *supra* note 18, at 1120. Patent claims did not exist in the modern sense until the early 1800s. See William Redin Woodward, *Definiteness and Particularity in Patent Claims*, 46 MICH. L. REV. 755, 758 (1948). As a historical matter, Robert Fulton’s patent on the steamboat is generally credited with the “first example of real patent claims in the modern sense.” *Id.* at 758. See also *id.* (opining on a humorous note that “Fulton might more properly be credited with the invention of the ‘claim’ than of the steamboat”); Karl B. Lutz, *Evolution of the Claims of U. S. Patents*, 20 J. PAT. OFF. SOC’Y 134, 136 (1938) (naming Fulton’s patent as “the first real ‘claim,’ in the modern patent meaning”). Claims did not gain formal recognition until 1836. Wagner & Petherbridge, *supra* note 18, at 1120 (citing the Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117, 119). Claims were not required in patent applications until 1870. *Id.* (citing the Act of July 8, 1870, ch. 230, § 26, 16 Stat. 198, 201).

37. Wagner & Petherbridge, *supra* note 18, at 1120. Interestingly enough, the *Phillips* decision may ultimately shift weight from the inventor’s claims towards the language in the specification. See *infra* note 86 (listing the questions for rehearing in *Phillips*). As such, *Phillips* may signal the start of the pendulum swinging back towards an era of patent law in which the language of the claims is given less weight. See *id.*

38. 35 U.S.C. § 112 (2003).

39. See, e.g., MILLS, JOHN GLADSTONE, ET AL., PATENT LAW BASICS § 14.2 (analogizing the claims of a patent to a real property deed that stakes out the owner’s property right).

40. See ADELMAN ET AL., *supra* note 13, at 749.

41. *Markman v. Westview Instruments Inc.*, 517 U.S. 370, 373 (1996).

42. *Id.*

43. ADELMAN ET AL., *supra* note 13, at 749. See generally Marvin J. Garbis, *Some American and Australian Judicial Approaches to Scientific and Technological Issues*, 22 AM. L. INST.-AM. B. ASS’N 429 (2004). Speaking on the difficulty of such evidence for judges as well as juries,

jury trials were somewhat rare before Congress established the Federal Circuit.⁴⁴

B. *Markman Creates a Framework*

The lack of procedural rigor in the previous two-hundred years set the stage for the monumental case of *Markman v. Westview Instruments*.⁴⁵ In *Markman*, the Federal Circuit adopted a two-step process for determining patent infringement: (1) the judge determines the scope and meaning of the patent's claims, and (2) the fact finder compares the allegedly infringing device to these judicially construed claims.⁴⁶ In the first step, the "claim construction step," the interpretation of the patent claims is a matter of law for the judge to decide,⁴⁷ and is reviewed *de novo* on appeal.⁴⁸ In the second step, the fact finder, either a jury or the judge, compares these judicially

Justice G.L. Davies of the Court of Appeal, Queensland, Australia, said:

Scientific and technical evidence has increased dramatically [since the 1960's] both in its frequency and its complexity; and the difficulty of a trier of fact, whether judge or jury, in understanding and consequently in assessing the reliability of such evidence, though not a new problem, has now become a critical one [T]here is now a good deal of such evidence that is quite beyond the capacity of most judges to understand. And in many cases in which a judge has some capacity to understand the evidence he or she will lack the capacity to decide between competing opinions. Nevertheless, here and elsewhere, judges continue to decide such questions on the apparent assumption that they have the capacity to do so.

Justice G. L. Davies, *The Changing Face of Litigation*, 6 J. OF JUD. ADMIN. 179, 188 (1997). *But see* *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1464 (Fed. Cir. 1998) (en banc) (Mayer, C.J., concurring in judgment) (noting that juries routinely render verdicts in civil and criminal cases involving complex scientific evidence of equal or greater complexity than seen in patent cases).

44. ADELMAN ET AL., *supra* note 13.

45. *Markman v. Westview Instruments Inc.*, 517 U.S. 370 (1996).

46. *Cybor*, 138 F.3d at 1454.

47. *Markman*, 517 U.S. at 390. This first step was deemed necessary because a judge typically has more experience in interpreting legal instruments than a lay jury. *Id.* at 388-89. *Cf. supra* note 43 (discussing various authorities' opinions on the difficulties that technical evidence presents for judges and juries).

48. *Cybor*, 138 F.3d at 1456 ("[W]e therefore reaffirm that, as a purely legal question, we review claim construction *de novo* on appeal . . ."). However, even the Supreme Court has noted the difficult distinctions between legal and factual issues. *Cooter & Gell v. Hartmarx Corp.*, 496 U.S. 384, 401 (1990) (noting the difficult distinction between legal and factual issues). Some scholars have criticized this aspect of *Cybor's* holding. See John F. Duffy, *On Improving the Legal Process of Claim Interpretation: Administrative Alternatives*, 2 WASH. U. J.L. & POL'Y 109, 122-23, 166 nn.51-53 (2000) (opining that *Cybor's* choice between standards of review "cannot be made on the basis of metaphysical distinctions between fact and law"). Even the *Markman* decision suggests that *Cybor's* result may be flawed. See *Markman*, 517 U.S. at 378 ("[T]he sounder course, when available, is to classify a mongrel practice [like claim construction] by using the historical method. . ."); see also *id.* at 384 (noting the difficulty of drawing the fact/law distinction in claim construction).

constructed claims to the allegedly infringing device.⁴⁹ To find infringement, the fact-finder must determine that every element of a claim or its equivalent exists in the allegedly infringing device.⁵⁰

Markman's innovation rested in its first step.⁵¹ This first step, known as a "*Markman* hearing," was to be carried out in a full-blown trial.⁵² The hope was that parties would be more likely to settle once they had a definitive claim construction ruling in hand,⁵³ and would thereby avoid the enormous costs associated with patent litigation.⁵⁴ Concerning this critical "claim construction" step, the *Markman* court declared that, "claims must be read in view of the specification, of which they are a part."⁵⁵ The court further stated, "The written description part of the specification does not delimit the right to exclude. That is the purpose and function of claims."⁵⁶ Put more simply, *Markman* states that a judge cannot read limitations from the specification into the claims when performing claim construction.⁵⁷

49. *Bai v. L & L Wings, Inc.*, 160 F.3d 1350, 1353 (1998).

50. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29 (1997).

51. *See Markman*, 517 U.S. at 370. This step is known more commonly as a "*Markman* hearing." *Wagner & Petherbridge*, *supra* note 18, at 1118. *Markman* hearings (i.e., claim construction rulings) are issued before trial because the Federal Circuit hoped that this would lead to more settlements once parties had a firm claim interpretation in hand. *ADELMAN ET AL.*, *supra* note 13, at 757. The goal was to reduce the number of cases culminating in expensive trials. *Id.* For more information on *Markman* hearings, *see, e.g.* William F. Lee & Anita K. Krug, *Still Adjusting to Markman: A Prescription for the Timing of Claim Construction Hearings*, 13 HARV. J.L. & TECH. 55, 59 (1999).

52. *See supra* note 15 (referring to *Markman* hearings).

53. *See supra* note 16 (noting that there are contrasting views on whether claim construction actually accomplishes this goal).

54. *See supra* note 17 (detailing the enormous costs associated with patent litigation, which can typically average in excess of \$2 million dollars per side).

55. *ADELMAN ET AL.*, *supra* note 13, at 774 (quoting *Markman v. Westview Instruments Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996)).

56. *Markman*, 52 F.3d at 979. *See also* *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) ("[I]t is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning.") Pre-*Markman* cases also reiterate this theme. *See* *Hoganas AB v. Dresser Industries*, 9 F.3d 948, 950 (Fed. Cir. 1993) ("It is improper for a court to add 'extraneous' limitations to a claim, that is, limitations added 'wholly apart from any need to interpret what the patentee meant by particular words or phrases in a claim.'") (quoting *E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed. Cir. 1988); *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 957 (Fed. Cir. 1983) ("That claims are interpreted in light of the specification does not mean that everything expressed in the specification must be read into all the claims."); *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 699 (Fed. Cir. 1983) ("The claim, not the specification, measures the invention. Environmental's argument that claim 1 must include a limitation found in the specification is thus legally unsound.") (citation omitted).

57. *ADELMAN ET AL.*, *supra* note 13, at 774 ("In *Markman*, the Federal Circuit reiterated the standard doctrine that '[c]laims must be read in view of the specification, of which they are a part.'")

Although this rule appeared simple on its face, post-*Markman* decisions would soon show it to be anything but straightforward.⁵⁸

C. Post-*Markman* Jurisprudence

In the decisions following *Markman*, the Federal Circuit tried to develop its claim construction doctrine to aid practitioners.⁵⁹ Ultimately, the post-*Markman* decisions revealed that *Markman*'s rule that "a judge cannot read limitations from the specification into the claims" was at odds with other rules to which the court adhered.⁶⁰ This contradiction led to courts using seemingly inconsistent methods of claim construction, causing unpredictable results.⁶¹ Indeed, in recent years lawyers and academics have found the Federal Circuit's reversal rate for these district court decisions surprisingly high.⁶² Practitioners have complained that these contradictions make "it difficult to provide your client clear guidance in terms of what their patent claims actually mean."⁶³

1. Canons of Construction

After *Markman*, a number of canons largely governed claim

(quoting *Markman* 52 F.3d at 979)).

58. See generally *infra* notes 59-89 (referring to the section of this note entitled "Post *Markman* Jurisprudence").

59. See *infra* notes 60-76 (discussing some of these post-*Markman* decisions). Note that many scholars believe that the court has failed to sufficiently aid practitioners in this arena. See *infra* notes 61-62 (discussing the high reversal rates that make it nearly impossible to tell a client what a particular patent's claim means).

60. See *infra* notes 64-65 (listing this and several other canons of claim construction, and then noting that there is even a canon to avoid the use of canons).

61. See, e.g., Christian A. Chu, *Empirical Analysis of the Federal Circuit's Claim Construction Trend*, 16 BERKLEY TECH., L.J. 1075, 1090 (2001) (finding that the Federal Circuit overturned district court constructions in nearly 40% of cases); Kimberly A. Moore, *Are District Court Judges Equipped to Resolve Patent Cases?*, 15 HARV. J. L. & TECH. 1, 1 (2001) (finding the Federal Circuit overturned district court claim constructions in 33% of cases); Hines, *supra* note 22, at 1 (stating "about 40 percent of claim construction cases are reversed by the Federal Circuit").

62. See *supra* note 61 (discussing various studies showing high reversal rates in claim construction rulings). Many scholars have suggested innovations in claim interpretation that might solve these problems. See Craig Allen Nard, *Process Considerations in the Age of Markman and Mantras*, 2001 U. ILL. L. REV. 355, 357 (2001) (opining that the Federal Circuit should accept interlocutory appeals of claim construction rulings in order to promote certainty and efficiency); Arti K. Rai, *Engaging Fact and Policy: A Multi-Institutional Approach to Patent System Reform*, 103 COLUM. L. REV. 1035, 1040 (2003) (surmising that the Federal Circuit has engaged in fact finding to the detriment of the patent system).

63. Hines, *supra* note 22, at 1 (quoting Scott Doyle, a partner in the office of Morrison & Foerster).

construction analysis.⁶⁴ However, as the Federal Circuit itself has noted, many, if not all, of these canons are contradictory and not especially useful.⁶⁵

2. A More Rigorous Framework

In *Vitronics Corp. v. Conceptronic, Inc.*, the Federal Circuit developed a more rigorous claim construction framework to supplement the well-established canons of construction.⁶⁶ The general framework consisted of first focusing on the intrinsic evidence,⁶⁷ then looking to extrinsic evidence⁶⁸ to the extent that the intrinsic evidence is

64. See, e.g., *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1341-48 (Fed. Cir. 2001) (discussing the canons of construction the Federal Circuit utilizes in claim construction). Five of the more frequently invoked canons are listed below:

1. If possible, claims should be construed in a manner that preserves their validity. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984).
2. If two plausible constructions exist, a court should choose the narrower as a penalty for the patentee's drafting ambiguity. Vicki S. Veenker, *Claim Construction, the Current Structure of Legal Analysis*, in *PATENT LITIGATION 2004*, at 11, 37 (PLI Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series, 2004).
3. Courts should not import limitations from the specification into the claims. *Markman v. Westview Instruments Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996).
4. A patentee may act as his own lexicographer and create new words or assign a special meaning to a word. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). If a patentee acts as his own lexicographer, he or she must describe the word's special meaning with reasonable clarity and precision. *Apple Computer, Inc. v. Articulate Sys.*, 234 F.3d 14, 21 n.5 (Fed. Cir. 2000) ("For words with ordinary meaning, it may be necessary for the applicant to clearly point out how the term in the patent differs from conventional understanding.").
5. Courts presume that each claim of a patent has a different scope. *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1326 (Fed. Cir. 2003).

See generally Veenker, *supra*, at 33-41 (citing these and several other canons of claim construction).

65. See *Wagner & Petherbridge*, *supra* note 18, at 1119 n.49 (citing *Autogiro Co. of Am. v. United States*, 384 F.2d 391, 397 (Ct. Cl. 1967), for the proposition that the patent law features canons to avoid the use of canons).

66. *Vitronics*, 90 F.3d at 1576. In *Vitronics*, the patentee brought an action against the competitor, alleging infringement of its patented method of soldering devices to printed circuit boards. *Id.* at 1579. Ultimately, the Federal Circuit held that (1) within the meaning of the patent, the term "solder reflow temperature" meant "peak reflow temperature" rather than "liquidus temperature," and (2) the trial court erred in relying on expert testimony in interpreting the claim. *Id.* at 1579-80, 1585.

67. Intrinsic evidence was defined as the patent, including the claims, the specification, and, if in evidence, the prosecution history. *Id.* at 1582.

68. Extrinsic evidence is external to the patent and prosecution history; it may include expert and inventor testimony, dictionaries, and technical treatises and articles. Cheryl L. Johnson, *Was Markman Wrong in Tasking Judges with Claim Construction? The Promises and the Reality*, in *HOW TO PREPARE & CONDUCT MARKMAN HEARINGS 2004*, at 9, 29-30 (PLI Patents, Copyrights,

ambiguous.⁶⁹ Procedurally, the steps of claim construction are often recited as follows: courts always begin with the language of the claims,⁷⁰ then look to intrinsic evidence to make sure it is consistent with the claims,⁷¹ then consider extrinsic evidence to verify that it is

Trademarks, and Literary Property Course Handbook Series, 2004). However, “whether dictionaries are treated as intrinsic or extrinsic evidence is subject of much debate and conflicting holdings.” *Id.* at n.54. Some cases treat the dictionary as intrinsic evidence. *See Hill-Rom Co. v. Kinetic Concepts, Inc.*, 209 F.3d 1337, 1340-41 (Fed. Cir. 2000) (the first reason for upholding the trial court’s interpretation of the term “cushion” was that the interpretation was consistent with the dictionary meaning); *Karlin Tech., Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971 (Fed. Cir. 1999) (using dictionary definitions to determine claim meaning). However, the weight of authorities for a period of time treated dictionaries as extrinsic evidence. *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299-1300 (Fed. Cir. 1999) (“Dictionaries are useful additional sources, as is the guidance of technical/scientific experts and other relevant evidence.”); *Digital Biometrics, Inc. v. Indentix, Inc.*, 149 F.3d 1335, 1346 (Fed. Cir. 1998) (refusing to give weight to an inconsistent dictionary definition because the intrinsic record is clear); *see also* Lawrence Pretty, *Developments in Markman Jurisprudence*, in *PLI’S SIXTH ANNUAL INSTITUTE FOR INTELLECTUAL PROPERTY LAW*, at 371, 395-96, (PLI Patent, Copyrights, Trademarks, and Literary Property Course Handbook Series, 2000) (discussing the status of dictionary definitions and the patent abstract as intrinsic evidence). However, in *Teleflex, Inc. v. Ficosa N. Am.*, the Federal Circuit held dictionaries and treatises were not extrinsic evidence, but were to be consulted as aids to the court. *Teleflex, Inc. v. Ficosa N. Am.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002).

69. *Vitronics*, 90 F.3d at 1582-83. Specifically the *Vitronics* court stated:

It is well-settled that, in interpreting an asserted claim, the court should first look to intrinsic evidence of record, i.e., the patent itself, including the claims, the specification and, if in evidence, the prosecution history. . . . Extrinsic evidence may also be considered, if needed to assist in determining the meaning or scope of technical terms in the claims.

Id.

70. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed. Cir. 1999). First and foremost, courts should give the words of a claim the full range of their ordinary meaning. *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002). Dictionaries may establish this ordinary meaning, so long as the definition does not “fly in the face” of the patent disclosure. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). Accordingly, courts should use dictionaries as a starting point for claim construction. Furthermore, the ordinary meaning of the claim’s terms should be viewed from the perspective of one skilled in the relevant art at the time the claim was filed. Brief for American Intellectual Property Ass’n as Amici Curiae Supporting Neither Party at 2, *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (Nos. 03-1269, -1286) [hereinafter *AIPLA Amicus Brief*]. Given this premise, technical dictionaries should be preferred over general dictionaries, because they more closely approximate the ordinary meaning that one skilled in the art would associate with the term. *Id.* at 12. Moreover, the dictionaries that a court uses should be the edition published at the time of the filed application to accurately reflect the knowledge of one skilled in the art at the time the claim was filed. *Id.*

71. *CCS Fitness*, 288 F.3d at 1366-67 (noting that after pinning down the relevant starting point for claim construction by the use of dictionaries, the court should examine the intrinsic evidence in the patent instrument to make sure it is consistent with the ordinary meaning construction). Well-known exam study guides for law students adhere to the simple rule that limitations from the specification should not be read into the claims. *See* STEPHEN M. MCJOHN, *EXAMPLES AND EXPLANATIONS: INTELLECTUAL PROPERTY* 173 (Chemerinsky et al. eds., 2003). This book sets forth the rule as follows:

consistent with the claims,⁷² and finally, review other statutory requirements.⁷³

Despite this more structural framework, tension still existed between two of the generally accepted “canons” of claim construction: “(1) that claims should be read in light of the specification of which they are a part; and (2) that the meaning of the claims may not be altered by importing or reading-in changes from outside the claims.”⁷⁴ To resolve this tension, in *Johnson Worldwide Associates v. Zebco Corp.*, the Federal Circuit mandated a “heavy presumption” in favor of the ordinary meaning of a patent’s terms.⁷⁵ The court further stated that such ordinary meaning will not be overcome unless there is clear evidence of a contrary meaning in the written description.⁷⁶

[After looking at the claims], [t]he court next looks to the written description, the drawings, and anything else in the patent. Because the claims define the invention, courts try to avoid redefining them by using the rest of the patent. In particular, there is a widely noted tension between interpreting the claims by using the written description (allowed) and reading limitations from the description into the claims (not allowed).

Id. The distinction between interpreting the claims by using the written description and reading limitations from the description into the claims, however, is a fine line to draw. ADELMAN ET AL., *supra* note 13, at 774-75 (“The distinction between ‘reading claim terms in light of the specification’ and the prohibited practice of ‘importing limitations from the specification into the claims,’ is not easy to draw.”) (citation omitted).

72. If the applicant amended his claims in the prosecution history, then the amended claims must be construed narrowly and are limited to the embodiment shown in the specification and drawings of the patent. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd.*, 535 U.S. 722, 739-40 (2002) (holding that a presumption exists that amended claims are to be construed narrowly).

73. See *Veenker*, *supra* note 64, at 23-28 (discussing a general claim construction methodology).

74. *Wagner & Petherbridge*, *supra* note 18, at 1133.

75. 175 F.3d at 989 (Fed. Cir. 1999). The court noted:

We begin, as with all claim interpretation analyses, with the language of the claims. The general rule is, of course, that terms in the claim are to be given their ordinary and accustomed meaning. General descriptive terms will ordinarily be given their full meaning; modifiers will not be added to broad terms standing alone. In short, a court must presume that the terms in the claim mean what they say, and, unless otherwise compelled, give full effect to the ordinary and accustomed meaning of claim terms. In order to overcome this heavy presumption in favor of the ordinary meaning of the claim language . . . there must be a textual reference in the actual language of the claim with which to associate a proffered claim construction.

Id. at 989-90 (citations omitted).

76. *Id.* at 990. *Johnson* specifically lists two situations where a term will be given a definition other than its ordinary and accustomed meaning. *Id.* The first instance is when the patentee has chosen to be his or her “own lexicographer by clearly setting forth an explicit definition for a claim term. The second is where the term or terms chosen by the patentee so deprive the claim of clarity that there is no means by which the scope of the claims may be ascertained from the language used. In these two circumstances, a term or terms used in the claim invites - or indeed, requires - reference to intrinsic, or in some cases, extrinsic evidence to

3. A Split of Authority Appears

Despite this “heavy presumption” that *Johnson Worldwide Associates* afforded the ordinary meaning of claim language, a noticeable rift appeared in Federal Circuit claim construction jurisprudence.⁷⁷ This divide was created while the courts were trying to resolve a pair of canons of claim construction: (a) that claims are to be interpreted in light of the specification or prosecution history, and (b) that claims may not be modified beyond their actual language by reference to the specification or prosecution history.⁷⁸ Professor Polk Wagner opines that resolution of these canons ultimately resulted in two distinct claim construction approaches: the “holistic” approach and the “procedural” approach.⁷⁹

The “holistic” line of cases states that claim terms must be read in view of the patent specification of which they are a part.⁸⁰ “[This] approach . . . moves away from the abstract ‘ordinary meaning’ of a term in favor of a more localized understanding” taken from the entire instrument.⁸¹

The “procedural” approach (also known as the “ordinary meaning” approach) begins “with a general presumption in favor of the ordinarily

determine the scope of the claim language.” *Id.* (citations omitted).

77. Wagner & Petherbridge, *supra* note 18, at 1133.

78. *Id.* *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337 (Fed. Cir. 2001), similarly dealt with a conflict between these two conflicting canons of interpretation. David J.F. Gross & Theodore M. Budd, “*We Have a Split Decision*”: *Analyzing the Internal Conflicts Within the Federal Circuit on the Issue of Claim Construction*, in *PATENT LITIGATION 2004*, at 55, 69 (PLI Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series, 2004). In *SciMed*, the Federal Circuit held that the district court had properly interpreted the claim in light of the specification because numerous statements in the patentee’s specification disclaimed a broader interpretation of the claims. *See id.* at 69. As such, *SciMed* seems to fall into the “holistic” methodology. *See infra* notes 80-81 and accompanying text (discussing the “holistic” approach).

79. Wagner & Petherbridge, *supra* note 18, at 1119, 1136. The Federal Circuit generally reviews appeals in three-judge panels. Gary D. Krugman, *Review of the Board’s Decision—Appealing to the U.S. Court of Appeals for the Federal Circuit*, *TRADEMARK TRIAL AND APPEAL BOARD PRACTICE AND PROCEDURE* § 2:50 (2003), *TTABPP* § 2:50 (Westlaw). Professor Wagner undertook a quantitative study of how the panels of the Federal Circuit ruled on claim construction causes. Wagner & Petherbridge, *supra* note 18, at 1111. Ultimately, Professor Wagner found that the various panels of the Federal Circuit used distinctly different methodologies that depended on which judges sat on the panel. *Id.* at 1111-12.

80. Wagner & Petherbridge, *supra* note 18, at 1133. The holistic approach “adopts a distinctly more free-form approach, seeking the correct meaning according to the particular circumstances presented. . . .” *Id.* at 1134. This methodology moves away from the “ordinary meaning” of a term in favor of a more localized understanding. *Id.*

81. Gross & Budd, *supra* note 78, at 61. Gross and Budd deem this approach the “*SciMed*” approach. *Id.*

understood meaning of the claim language, which is ascertained from dictionaries and encyclopedias.”⁸² One who wants to challenge the ordinary meaning must establish such deviation with *significant* evidence from the intrinsic record.⁸³

4. *Phillips* Attempted Promises to Resolve this Quagmire

In *Phillips*, the Federal Circuit attempted to settle this jurisprudential rift by utilizing a consistent method of claim construction.⁸⁴ Accordingly, this decision will serve as a benchmark for all future claim construction rulings.⁸⁵ In *Phillips*, the Federal Circuit certified seven questions for appeal.⁸⁶ These questions address what evidence a court

82. *Id.* at 61-62. The procedural methodology starts with a general presumption in favor of the ordinary meaning that follows a predetermined path of analysis wherein any suggested alteration from the common meaning requires significant proof that such any alteration is required under the circumstances. *Id.* *Johnson Worldwide Assocs. v. Zebco Corp.* provides an excellent example of this approach:

We begin, as with all claim interpretation analyses, with the language of the claims. The general rule is, of course, that terms in the claim are to be given their ordinary and accustomed meaning. General descriptive terms will ordinarily be given their full meaning; modifiers will not be added to broad terms standing alone In order to overcome this heavy presumption in favor of the ordinary meaning of claim language . . . there must be a textual reference in the actual language of the claim with which to associate a proffered claim construction.

175 F.3d 985, 989-90 (Fed. Cir. 1999).

83. *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1204 (Fed. Cir. 2002).

84. *Gross & Budd*, *supra* note 78, at 117.

85. *See Hines*, *supra* note 22, at 1 (“*Phillips* may be the most significant case to tackle the issue of interpreting patent claims since the U.S. Supreme Court’s 1996 ruling in *Markman v. Westview Instruments*, which held that judges, not juries, should determine the meaning of patent.”). The *Phillips* decision has the potential to provide clarity for lawyers and their clients, but more importantly it may save clients money and enhance predictability in the patent system. *Id.* ““This is the battleground on which patent litigation is fought and won,” said William Rooklidge, President-elect of the American Intellectual Property Law Association (AIPLA) and a partner at Washington’s Howrey Simon Arnold & White.” *Id.*

86. 376 F.3d 1382, 1383 (Fed. Cir. 2004) (Order of the Court of Appeals for the Federal Circuit dated July 21, 2004). These seven questions are as follows:

1. When constructing patent claims, is public notice better served by looking to definitions in technical dictionaries, general-purpose dictionaries, and other similar sources, or by looking to the patentee’s use of the term in the specification? If both sources are to be consulted, in what order should a court consult them?
2. If dictionaries should serve as the primary tool for claim interpretation, should the specification limit the full scope of claim language (as defined by dictionaries) only when the patentee has acted as his own lexicographer or when the specification reflects a clear disclaimer of claim scope?
3. If the primary source for claim construction should be the specification, what use should be made of dictionaries?
4. Should courts treat the two approaches as complementary methodologies such that there is a dual restriction on claim scope, and a patentee must satisfy both limiting

should look to in construing patent terms.⁸⁷ For example, should courts look to dictionaries (extrinsic evidence) or only to the specification and drawings (intrinsic evidence)?⁸⁸ While courts seem to disagree about a precise methodology in this arena, practitioners have suggested that the best claim construction analysis will strike the proper balance between providing fair coverage for applicants and adequate notice to the public of the patent's limits.⁸⁹

III. STATEMENT OF THE CASE

A. Facts

Edward Phillips is the inventor and owner of U.S. Patent No. 4,677,798 (the '798 patent) relating to modular wall panels for prisons.⁹⁰ "In 1989, [he] entered into an agreement with AWH Corporation, Hopeman Brothers, Inc., and Lofton Corporation (collectively "AWH") [whereby AWH would] market and sell Phillips' invention."⁹¹ The agreement ended in 1990, and in early 1991, Phillips became convinced that AWH had introduced a new product that "continu[ed] to use Phillips' technology without his consent."⁹²

Throughout the specification, drawings, and claims of the '798 patent, Phillips describes his modular wall panels as having essentially two components: (1) an outer steel shell, and (2) inwardly-extending steel barriers similar to trusses on a bridge.⁹³ When several of these

methodologies in order to establish the claim coverage it seeks?

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?

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?

7. Is it appropriate for an appellate court to accord any deference to any aspect of trial court claim construction rulings?

Id.

87. *See id.*

88. *See supra* note 86 (stating the seven questions certified by the court).

89. AIPLA Amicus Brief, *supra* note 70, at 11.

90. U.S. Patent No. 4,677,798 (filed April 14, 1986) (issued July 7, 1987). The specification portion of the patent refers to the panels' heat, sound, and fire resistant properties, as well as their propensity for projectile deflection. *Id.* Phillips suggests the invention is most useful in prison walls. *Id.*

91. Phillips v. AWH, 363 F.3d 1207, 1210 (Fed. Cir. 2004), *vacated and reh'g en banc granted*, 376 F.3d 1382 (2004).

92. Phillips, 363 F.3d at 1210.

93. *See generally* U.S. Patent No. 4,677,798.

modular wall panels are pieced together to form a wall, the outer steel shells adjoin to form the face of the wall and the inwardly-extending steel barriers buttress the outer shells to increase the wall's load bearing capacities.⁹⁴

The claims of the '798 patent refer to the internal steel barriers as "baffles."⁹⁵ The patent's specification describes only "baffles" that meet the steel walls at angles *less than* ninety degrees.⁹⁶ Similarly, each and every drawing of the '798 patent shows that the steel barriers meet the steel shell at angles *less than* ninety degrees.⁹⁷ However, while the specification and drawings show only steel barriers intersecting with the shell at angles of less than ninety degrees, the claims of the patent recite no such limitation.⁹⁸ The claims merely mention that the modules contain "steel baffles extending inwardly from the steel shell walls."⁹⁹

B. District Court Decision

In February 1997, Phillips brought an action against AWH, contending that AWH had infringed several claims of his '798 patent with its new product and had misappropriated Phillips' trade secrets.¹⁰⁰ On the issue of misappropriation, the court disposed of Phillips' complaint and held that his claim was barred by Colorado's three-year statute of limitations.¹⁰¹ However, it proved more difficult to dispose of the patent infringement claim.

94. *Id.*

95. *Id.* Claim 1 of the patent typifies the use of the word "baffle" and reads as follows:

1. Building modules adapted to fit together for construction of fire, sound and impact resistant security barriers and rooms for use in securing records and persons, comprising in combination, an outer shell of substantially parallel piped shaped with two outer steel plate panel sections of greater surface area serving as inner and outer walls for a structure when a plurality of the modules are fitted together, sealant means spacing the two panel sections from steel to steel contact with each other by a thermal-acoustical barrier material, and *further means disposed of inside the shell for increasing its load bearing capacity comprising internal steel baffles extending inwardly from the steel shell walls.*

Id. (emphasis added).

96. *Phillips*, 363 F.3d at 1210.

97. *Id.*

98. *See supra* notes 95-97 and accompanying text (quoting the specific claim language and discussing the written description and drawings of the '798 patent).

99. *See supra* note 98 (quoting the exact language of the claims of the '798 patent). A plain reading of this language implies this claim could include baffles which extend from the walls at angles *equal to* ninety degrees. *See* U.S. Patent No. 4,677,798.

100. *Phillips*, 363 F.3d at 1210.

101. *Id.*

In determining whether infringement had occurred, the court undertook an examination of AWH's allegedly infringing modular panels. This examination revealed that the AWH panels also had "baffles," but that AWH's baffles extended inwardly from steel shell walls at angles *equal to* ninety degrees.¹⁰² Therefore, in determining whether infringement occurred, a key issue was the meaning of the word "baffle" as used in the claims of Phillips' patent.¹⁰³ The district court found that Phillips's claims were in "means-plus-function format"¹⁰⁴ and accordingly reasoned that the word "baffle" should be limited to its structure in the specification.¹⁰⁵ Therefore, the court construed the term "baffle" in the claims of the patent to cover only steel structures that extended inwardly from steel shell walls at angles less than ninety degrees.¹⁰⁶ Consequently, the court's focus on the specification led it to conclude that AWH's product did not infringe Phillips' patent.¹⁰⁷ Phillips appealed the decision.¹⁰⁸

C. Appellate Panel Reviews Decision

On appeal, the three-judge panel¹⁰⁹ reviewed the district court's decision *de novo*.¹¹⁰ The majority first reasoned that the claims were not in means-plus-function format,¹¹¹ and thus disregarded the district court's decision.¹¹² Citing *Webster's Dictionary*,¹¹³ the majority then noted that the ordinary meaning of the word "baffle" is "something for deflecting, checking, or otherwise regulating flow."¹¹⁴ This ordinary

102. *Id.* at 1214.

103. *See id.* at 1215. If the court interpreted the claims of the '798 patent broadly (i.e., the claims encompassed baffles extending inwardly at angles *equal to* ninety degrees), then AWH would infringe the '798 patent. However, if the court read limitations into the claims from the specification and drawings (i.e., the claims only encompassed baffles extending inwardly at angles of *less than* ninety degrees), then no infringement would occur. *Compare id.* at 1207, with *id.* at 1216 (Dyk, J., dissenting in part).

104. *See supra* note 13 (describing means-plus-function format).

105. *Phillips*, 363 F.3d at 1210.

106. *Id.*

107. *Id.*

108. *Phillips*, 363 F.3d at 1210-11.

109. *Id.* at 1209 (Circuit judges Newman, Lourie, and Dyk comprised the three-judge panel).

110. *Id.* at 1211 (citing *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1315 (Fed. Cir. 1998)).

111. *See supra* note 13 (describing means-plus-function format).

112. *Phillips*, 363 F.3d at 1212.

113. *Id.* (citing WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 162 (1993)).

114. *Id.* At oral argument on Feb. 9, 2005, the court questioned which dictionary should be used as follows:

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

meaning encompasses baffles extending inwardly from steel shell walls at angles equal to ninety degrees, and hence there was a possibility for infringement.¹¹⁵ The majority then examined the specification and noted that the specification showed baffles exclusively at angles of *less than* ninety degrees.¹¹⁶ Because the specification showed baffles only at angles of less than ninety degrees, the majority discounted the ordinary meaning of “baffle” and reasoned that Phillips’ patent did not extend to baffles of ninety degrees.¹¹⁷ Therefore, the panel concluded that AWH’s product did not infringe Phillips’ patent.¹¹⁸

However, a powerful dissent focused on the fact that the ordinary, dictionary meaning of the word “baffle” did not exclude a structure that met the sidewall exactly at an angle of ninety degrees.¹¹⁹ The dissent felt that the court should interpret Phillips’ claim broadly to be consistent with the ordinary meaning of the word “baffle.”¹²⁰ Accordingly, the dissent reasoned that the district court’s grant of summary judgment should be vacated because it was based on an erroneous construction.¹²¹ Finally, the dissent cautioned that the majority’s decision effectively limited the claims to the preferred embodiment, contrary to established precedent.¹²²

dictionary?

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

Transcript of Oral Argument at 5, Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (Nos. 03-1269, -1286) *available at* <http://ip-updates.blogspot.com/2005/02/phillips-v-awh-transcript.html> (last visited on Feb 18, 2005) [hereinafter Oral Argument Transcript].

115. See *Phillips*, 363 F.3d at 1216-17 (Dyk, J., dissenting in part).

116. *Id.* at 1214 (majority). See also Oral Argument Transcript, *supra* note 114, at 1, where Judge Lourie states: “The only baffles disclosed in the specification are those that are numbered in the figures and show an angle less than 90 degrees[.]”

117. See *Phillips*, 363 F.3d at 1213-14.

118. *Id.* at 1214.

119. *Id.* 1216-17 (Dyk, J., dissenting).

120. *Id.* See also *supra* note 113 (quoting the court’s inquiry as to which dictionary to use).

121. *Id.* at 1219.

122. *Id.* at 1217 (citing *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 907-08 (Fed. Cir. 2004)). Another case that illustrates the principle that claims should not be limited to the preferred embodiment is *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366-67 (Fed. Cir. 2002). In *CCS Fitness*, Brunswick had patents relating to an elliptical exercise trainer. *Id.* at 1362. In using the trainer, a user placed his feet on two footpads, each of which is at the end of a “foot member” that connected to the vertical frame of the machine. *Id.* The claim of the patent was such that the determination of infringement rested on whether “foot member” was made up of one part or two parts. *Id.* The drawings and the specification showed only one part, however the claims of the patent could reasonably be interpreted to include one or two parts. *Id.* Claims 1 and 2 of the

Thus, the outcome of this case hinged on how courts should interpret the words of a patent claim.¹²³ If courts focus on the diagrams and language of the specification, the patent claims of inventors will be construed narrowly and inventors will own a more limited property right.¹²⁴ However, if courts look at a broad dictionary definition of words in a patent claim, inventors will be entitled to a broader, more encompassing property right.¹²⁵

D. *En Banc Rehearing*

On July 21, 2004, the Federal Circuit granted a petition to rehear the appeal *en banc* to resolve issues concerning the construction of patent claims.¹²⁶ The court certified seven questions for appeal.¹²⁷ In July of 2005, the Federal Circuit rendered its decision.¹²⁸

In short, the Federal Circuit settled on a balanced approach in the

5,938,567 patent are representative:

1. An apparatus for exercising comprising: a frame having a base portion adapted to be supported by a floor; first and second *reciprocating members*, each reciprocating member having a rear support and a front end [;]
2. The exercise apparatus according to claim 1 wherein said rear support comprises a roller attached to each *reciprocating member* and adapted to rollably [sic] engage the base portion of said frame.

U.S. Patent No. 5,938,567 (filed Oct. 23, 1997) (issued Aug. 19, 1999) (emphasis added). The *CCS Fitness* court held that the specification could not limit the scope of the claims. *See CCS Fitness*, 288 F.3d at 1366. Therefore, the court reasoned that the claim should be given the broadest interpretation that would be consistent with the claim. *Id.* If an apparatus claim recites a general structure without limiting that structure to a specific subset of structures, courts will generally construe the term to cover known types of that structure that the patent disclosure supports. *Id.* The holding in *Phillips* is diametrically opposed to this rule. *See Phillips* 363 F.3d at 1214.

123. *See supra* notes 115-22 and accompanying text (discussing the majority opinion and the dissent's view as to which method of claim construction should apply to the case, respectively).

124. *See Astrazeneca AB v. Mut. Pharm. Co., Inc.*, 384 F.3d 1333, 1337-38 (Fed. Cir. 2004) (noting that the parties agreed that the extrinsic meaning of the term (as determined by treatises and dictionaries) is broad). In *Astrazeneca*, the court eventually went on to hold that the patent's intrinsic evidence clearly limited Astrazeneca to a narrower definition of a claim than the extrinsic evidence would support. *Id.* at 1338. Note that *Astrazeneca* explicitly remarked that it did not resolve the issue of which approach is proper as a matter of law. *Id.* at 1338 n.3 (suggesting that the *en banc* rehearing in *Phillips* may resolve this question). *See infra* note 125 (opining that if the court looks to the specification, it will result generally in a narrower claim for the patentee).

125. If looking to a dictionary definition results in a broad meaning, then looking to the specification must lead to a more narrow meaning. *Cf. supra* note 124 (discussing how the *Astrazeneca* court looked to the specification to narrow a patent's claims).

126. *Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004). Amicus briefs were due on September 24, 2004 and oral arguments occurred on February 8, 2005.

127. *See supra* note 86 (quoting the seven questions certified for review).

128. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*).

claim construction context.¹²⁹ On the one hand, the court favored looking to the specification and the prosecution history to define the terms of the claim.¹³⁰ On the other hand, the court still allowed for the use of dictionaries in claim construction; however, the court discounted the importance of dictionaries by noting, “[I]n Texas Digital . . . the methodology [that the court] adopted placed too much reliance on extrinsic sources such as dictionaries. . . .”¹³¹ Conversely, if the court leans in favor of the specification defining the terms of the claim, claims will generally be construed more narrowly.¹³² As a patent portfolio is a major asset of most large domestic and international corporations,¹³³ this decision has a direct bearing on the assets of these companies. Moreover, time may tell whether the court’s ruling in *Phillips* furthers the mandate of injecting predictability and consistency into patent law.¹³⁴

IV. ANALYSIS

This section answers the first question presented in the *Phillips en banc* review, namely, “When constructing patent claims, is public notice better served by looking to definitions in technical dictionaries, general purpose dictionaries, and other similar sources, or by looking

129. *See generally, id.* Interestingly, when construing the patent’s claims, the court’s first step started with claim differentiation, under each claim is given a meaning so as not to render any other claim meaningless. *See id.*, at 1324-25 (where the first two paragraphs in section IV compare and contrast the various claims).

130. *See id.* at 1314-17. Specifically, the court noted that when the meaning of a claim term is not “immediately apparent” to one of ordinary skill in the art, courts look to “those sources available to the public that show what a person of skill in the art would have understood the disputed claim language to mean.” *Id.* at 1314. The sources include the words of the claims themselves, the specification, the prosecution history, and the extrinsic evidence. *Id.*

131. *Id.* at 1320.

132. *See supra* note 124. If looking to a dictionary definition results in a broad meaning, then looking to the specification must lead to a more narrow meaning. *Cf. supra* note 125 (where the *Astrazeneca* court looked to the specification to narrow a patent’s claims).

133. *See* John R. Allison et al, *Valuable Patents*, 92 GEO. L.J. 435, 436 (2004) (noting that patent owners spend \$4.33 billion per year to obtain patents). IBM reportedly generated over \$500 million in 1999 in patent licensing fees. *See* LICENSING PRODS, & SERVS. GROUP, MARKET TREND (2005), available at http://www.informationholdings.com/lps_files/market.html (last visited May 14, 2006). However, valuable patents (or more precisely, those that are litigated) come “disproportionately from certain industries.” Allison et al., *supra*, at 438. For instance, patents in the semiconductor and chemical industries are much less likely to be litigated than those in the mechanical, computer and medical device industries. *Id.*

134. *See* Wagner & Petherbridge, *supra* note 18, at 1108-09 (questioning the Federal Circuit’s role of almost exclusive jurisdiction over patent law: “Has [it] resulted in clearer, more consistent, more coherent rules surrounding patents?”).

to the patentee's use of the term in the specification?"¹³⁵

Nearly forty amicus curiae filed briefs in the *Phillips* case.¹³⁶ Part A of this section briefly summarizes the positions of the amicus briefs on the first *Phillips* question.¹³⁷ Parts B and C present the positions most commonly advanced by amicus curiae (identified as the "holistic" and "procedural" approaches, respectively)¹³⁸ and then discusses their shortcomings.¹³⁹ Lastly, after weighing the realistic concerns of the amicus curiae, Part D suggests a methodology by which the court should have to resolve this first *Phillips* question.¹⁴⁰

A. Summary of the Amicus Briefs

Law firms, corporations, and professional organizations have

135. *Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004) (vacating the previous judgment and certifying seven questions for review by the Federal Circuit).

136. See *infra* notes 141-49 and accompanying text (referring to the section of this Note entitled "Summary of the Amicus Briefs").

137. See *infra* notes 141-49 and accompanying text (referring to the section of this Note entitled "Summary of the Amicus Briefs"). The recent Federal Circuit decision of *Astrazeneca* discusses the very crux of the issue in *Phillips* as follows:

It is axiomatic that the claims mark the outer boundaries of the patent right to exclude. The critical challenge is to determine the meaning of the claims, i.e., their scope. A long line of cases indicates that evidence intrinsic to the patent - particularly the patent's specification, including the inventors' statutorily-required written description of the invention - is the primary source for determining claim meaning. We have embraced this proposition frequently. Indeed, that proposition has been accepted doctrine in patent law for many years. See, e.g., *Autogiro of Am. v. United States*, 384 F.2d 391, 397-98 (Ct. Cl. 1967) ("The use of the specification as a concordance for the claim is accepted by almost every court and is a basic concept of patent law. Most courts have simply stated that the specification is to be used to explain the claims; others have stated the proposition in different terms, but with the same effect."); *Musher Found. v. Alba Trading Co.*, 150 F.2d 885, 888 (2d. Cir. 1945) (Hand, J.) ("As in the case of any other claim, a product claim may, and indeed must, be read upon the specifications: its terms are no more than a shorthand from the fuller explanation which the specification should contain."). On this view, the patent is an integrated document, with the claims "pointing out and distinctly claiming" the invention described in the rest of the specification and the goal of claim construction is to determine what an ordinary artisan would deem the invention claimed by the patent, taking the claims together with the rest of the specification.

384 F.3d 1333,1336-37 (footnote and most citations omitted).

138. See *supra* notes 18-20 (describing the "holistic" and "procedural" methodologies, respectively, as outlined by Professor Wagner; as well as the "hypertextualist" and "pragmatic textualist" approaches as urged by Professor Nard).

139. See *infra* notes 150-84 and accompanying text (referring to the section of this note entitled "B. Minority - A Heavy Presumption in Favor of Dictionaries Provides the Best Notice") and notes 186-212 (referring to the section of this note entitled "C. Majority - Look to the Specification").

140. See *infra* notes 212-25 and accompanying text (referring to the section of this note entitled "D. Suggestion - Include Dictionaries As Intrinsic Evidence").

cumulatively submitted thirty-four amicus briefs.¹⁴¹ Of course, Edward Phillips and AWH Corp. have also filed briefs in the case.¹⁴² Of the thirty-six briefs, twenty-five favored the “holistic” approach (69.5 percent)¹⁴³ and five preferred the “procedural” approach (13.9 percent).¹⁴⁴

141. See *infra* notes 143-146 (listing the individual briefs and categorizing them).

142. A total of thirty-six briefs were filed. Faegre & Benson, L.L.P., available at http://www.faegre.com/custom/page_2185.aspx (last visited Oct. 23, 2005).

143. The following twenty-five briefs favor the “holistic” approach: (1) Brief for The Intellectual Property Law Ass’n of Chicago as Amicus Curiae Supporting Neither Party at 2-3, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“[D]ictionaries should in general be subordinate to the patent specification and other intrinsic evidence when determining what is meant objectively by challenged claim terms.”); (2) Brief for United States as Amicus Curiae at 9, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“[R]eliance on the intrinsic evidence as the starting point for interpreting claims preserves established doctrines of patent law, does not upset settled expectations, and achieves a reading of patent claims that serves the public notice function of claiming while remaining fair to the patentee.”); (3) AIPLA Amicus Brief, *supra* note 70, at 2, 5 (applying a “balanced approach,” but ultimately determining that “materials in the intrinsic record must, throughout the inquiry be the ‘primary’ source for claim construction”); (4) Defendants-Cross Appellants’ Additional Brief for Rehearing *En Banc* at 4, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“Reference to the patentee’s use of the term in the specification, rather than to dictionaries, best serves the public notice function of patent claims.”); (5) Brief for Ad Hoc Committee of Patent Owners in the Wireless Industry as Amicus Curiae Supporting Neither Party at 2, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286), (“[P]resumptively construe claims to cover those specific embodiments reasonably disclosed in the specification”); see also Intellectual Property Law Ass’n of Chicago, available at http://iplac.org/Briefs/Summary_of_Positions.pdf at 3 (last visited January 20, 2005) (“Patentee has burden of public notice function”) [hereinafter IPLAC Webpage]; (6) Brief for Ass’n of Corp. Council on Rehearing *En Banc* as Amicus Curiae Supporting Neither Side at 2, *Phillips*, 415 F.3d 1303 (Nos. 03-1269,-1286) (“Public notice is best served by first looking to the intrinsic evidence, including the claims, the specification, and the prosecution history. *Dictionaries and other extrinsic evidence are to be used only if the intrinsic evidence does not determine the meaning of the claim.*”) (emphasis added); (7) Brief for The Ass’n of the Bar of the City of New York as Amicus Curiae Supporting Neither Party at 5, *Phillips*, 415 F.3d 1303 (Nos. 03-1269,-1286) (“The public notice function of patent claims is better served by construing the claims with reference to the patent specification, including the drawings, as well as the file history.”); (8) Brief of Biotechnology Industry Organization as Amicus Curiae Supporting Neither Party at 5, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“This public notice function is better served if claim construction proceeds first by inspecting the specification. In those instances when the specification affirmatively establishes the construction of a claim, the claim construction task is at an end.”); (9) Brief of Boston Patent Law Ass’n as Amicus Curiae Supporting Plaintiff-Appellant at 11-12, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“[A] dictionary . . . defines a term in the abstract, outside its context. . . . The necessary context for the claimed invention can be found in the first instance in the specification and prosecution history.”); (10) Brief for Charles W. Bradley, Esq. as Amicus Curiae at 1, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“The mode of analysis that best serves the public notice function of patent claims clearly includes an analysis of the specification and prosecution history of the patent at issue.”) [hereinafter Bradley Amicus Brief]; (11) Brief of Conejo Valley Bar Ass’n as Amicus Curiae Supporting Neither Party at 3, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“Only after a review of the intrinsic record, the overall claim language, the specification and prosecution history, should a court define the words in a claim using extrinsic evidence, such as a dictionary or learned treatise.”); (12) Brief of Connecticut Intellectual Property Law Ass’n as Amicus Curiae Regarding the Issue of Claim Construction at 3, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286)

(“The public notice function of patent claims is better served by referencing initially to the patentee’s use of the term in the specification.”); (13) Brief of Federation Internationale des Conseils en Propriete Industrielle as Amicus Curiae Supporting Neither Party at 4, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“[T]he ordinary meaning of the claim term to one of ordinary skill in the art as used in the context of the patent shall apply [as a general rule]. . . .”); (14) Brief of Houston Intellectual Property Law Ass’n as Amicus Curiae in Response to the Court’s Order Inviting Briefs at 2, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“[T]he intrinsic record - the claims, specification, and prosecution history (if in evidence) - should be referenced first.”); (15) Brief of Infineon Technologies North America Corp. as Amicus Curiae at 3, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (suggesting an approach that “looks first and foremost to the specification to construe disputed claim terms”); *see also* IPLAC Webpage, *supra*, at 7 (“Look first and foremost to spec’n [sic]; no role for dictionaries in defining claim terms; claim terms are defined either explicitly or implicitly in spec’n [sic].”); (16) Brief for Intel Corp., IBM Corp. et al. as Amici Curiae. at 3, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“The more reasonable and predictable course is to rely in the first instance on the specification and the prosecution history.”) [hereinafter IBM Amicus Brief]; (17) Brief of Intellectual Property Owners Ass’n as Amicus Curiae at 2, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“The primary evidence of claim meaning is found in the patent specification and prosecution history, and no other evidence should be considered if the claims can be construed properly from those sources alone.”); (18) Brief for Medrad, Inc. to Address the Questions Presented in this Court’s July 21 2004 Order as Amicus Curiae Supporting Neither Party at 2, *Phillips*, 415 F.3d 1303 (“Claim construction should be based upon the intrinsic evidence, including the specification, drawings, prior art, and prosecution history.”); *see also* IPLAC Webpage, *supra*, at 8 (“The spec’n [sic] and filed history should be used first.”); (19) Brief for New York Intellectual Property Law Ass’n Regarding the Issue of Claim Construction, in which the Tennessee Bar Ass’n, State Bar Michigan Law Section, & Los Angeles Intellectual Property Law Ass’n Join as Amici Curiae at 3, *Phillips*, 415 F.3d 1303 (Nos. 03-1269,-1286) (“[T]he primary source of claim construction should be the intrinsic evidence — namely the patent claims, patent specification and, if in evidence, the patent prosecution history.”); *see also* IPLAC Webpage, *supra*, at 9 (stating “Spec’n [sic] first.”); (20) Brief for Novartis Pharmaceuticals Corp. et al as Amici Curie at 2, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“[D]ictionaries are not preeminent, and should be used only as, and to the extent that, the skilled person would use them. . . .”); (21) Brief for Oregon Patent Law Ass’n as Amicus Curiae Answering the Additional Questions Set Forth by the Court and by Circuit Judge Rader at 2, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“When construing claim terms, the patent statutes require courts to look primarily at a patentee’s use of the term, thus requiring the courts to examine the context of the use of the claim term and not just isolated, generalized dictionary definitions.”); (22) Brief for San Diego Intellectual Property Law Ass’n as Amicus Curiae at 2, *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (Nos. 03-1269,-1286) (“The review of the intrinsic evidence starts with the specification which is the best source for determining the proper context for claim terms.”); (23) Brief for Sughrue Mion, PLLC as Amicus Curiae at 11-12, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“The patent document provides notice of a claim term’s meaning. . . . [O]nly the patent specification and prosecution history can illustrate what the claimed invention is *not*; whether because of disclaimer, disavowal or estoppel. A dictionary cannot.”) [hereinafter Mion Amicus Brief]; (24) Brief for Visa U.S.A. & Mental, Inc. as Amici Curiae Supporting Judgment at 6, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“The public notice function is better served by looking primarily to the patentee’s use of the term in the context of the claims, the specification, and the prosecution history.”); (25) Brief for Wisconsin Alumni Research Foundation., et al. as Amici Curiae at 3, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“The starting point for . . . claim construction . . . should be the second paragraph of 35 U.S.C. § 112, which sets forth the requirement that ‘[t]he specification shall conclude with one or more claims. . . .’”) (emphasis added).

144. The following five briefs favor the “procedural” approach: (1) En Banc Brief of

Three briefs suggested that the court look to both the specification and to dictionaries (8.3 percent).¹⁴⁵ The remaining three briefs did not address the question (8.3 percent).¹⁴⁶ Although the amicus curiae may agree on some matters,¹⁴⁷ this note focuses on two incongruous positions taken by

Plaintiff-Appellant Edward H. Phillips at 7, *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (Nos. 03-1269, -1286) (stating quite predictably that “claims . . . should be read first, incorporating the parties’ stipulated definitions when they exist, definitions from authoritative written sources for terms of art, and standard dictionary definitions for all other terms.”) (emphasis added); (2) Brief for Ass’n of Patent Law Firms as Amicus Curiae, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286); see IPLAC Webpage, *supra* note 143, at 3 (“Dictionaries (technical and general) should be primary source to identify ordinary meaning, then go to spec’n [sic.]”); (3) Brief & Appendix for McShea Tecce, P.C., et al. as Amici Curiae Supporting Reversal at 2, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (proposing a method that “first determines the full range of possible definitions from standard English dictionaries or, if applicable, recognized technical publications”) [hereinafter McShea Tecce Amici Brief]; (4) Brief for Parus Holdings Inc. as Amicus Curiae at 3, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“The dictionary approach to claim construction inherently provides uniformity and predictability because dictionaries provide only a few possible meanings for any given claim term.”) [hereinafter Parus Holdings Amicus Brief]; (5) Brief for Patent Law Professors R. Polk Wagner & Joseph Scott Miller as Amici Curiae at 1, *Phillips*, 415 F.3d 1303 (Nos. 03-1269, -1286) (“The Public Notice Function of Claims Requires a Focus on, and a presumption in favor of the ordinary meaning of claim language.”) [hereinafter Wagner & Miller Amici Brief].

145. Three amicus briefs favored looking to both the specification as well as dictionaries: (1) ABA Amicus Brief, *supra* note 23, at 2 (“Regarding the dictionary-versus-specification dispute, the ABA supports a middle ground, whereby neither has primacy and both must be considered.”); (2) Brief for Federal Circuit Bar Ass’n as Amicus Curiae at 2, *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (Nos. 03-1269.-1286) (“We respectfully suggest that both sources may be consulted, along with other intrinsic or extrinsic evidence that may be helpful, but the court should not require [them] to be consulted in any particular order.”); (3) Brief for International Trade Commission Trial Lawyers Ass’n as Amicus Curiae Supporting Neither Party and Supporting Neither Reversal nor Affirmance at 3, *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (Nos. 03-1269 - 86) (“The public notice function of patent claims is better served by, whenever possible, looking to the patentee’s use of the term in the specification, relevant technical dictionaries and similar sources, and to general purpose dictionaries. . . .”) [hereinafter ITCTLA Amicus Brief].

146. Three of the thirty-six briefs filed in the case did not address this issue. See generally (1) Brief for Bar Ass’n of The District of Columbia - Patent, Trademark & Copyright Section as Amicus Curiae Supporting Neither Party at i, *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (Nos. 03-1269, -1286); (2) Brief for Consumers Union, Electronic Frontier Foundation, and Public Knowledge as Amici Curiae Supporting Defendants-Cross-Appellants at 1, *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (Nos. 03-1269, -1286); (3) Brief for Public Patent Foundation as Amicus Curiae Supporting Defendants-Cross Appellants at i, *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (Nos. 03-1269,-1286).

147. While the amici curiae may not agree on the ultimate resolution of the first question, they do seem to agree on at least four key points. First, when performing claim construction, the courts must always begin and remain centered on the language of the claims. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed. Cir. 1999). See also Jonathon R. Spivey, *The Federal Circuit’s Markman Jurisprudence – Patchwork Quilt or Jigsaw Puzzle? Is There Really Panel-Dependency and Unpredictability in Federal Circuit Opinions?*, in HOW TO PREPARE & CONDUCT MARKMAN HEARINGS 2004, at 709, 715 (PLI Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series, 2004). Second, public notice hinges

the amici curiae: (1) a heavy presumption in favor of the ordinary meaning providing the best public notice,¹⁴⁸ and (2) by looking first to the specification, courts will reduce the amount of vexatious litigation.¹⁴⁹

B. A Heavy Presumption in Favor of Dictionaries Provides the Best Public Notice

A minority of amici curiae believes that public notice is best served when courts look to dictionaries to construe patent claims.¹⁵⁰ Interestingly enough, Professor Polk Wagner, one of the individuals who originally chronicled the split of authority, is in this minority that favors the procedural approach.¹⁵¹ He recommends that if the patent does not provide “clear, specific, and objective evidence of the meaning of claim language,”¹⁵² then the court should adopt a heavy presumption in favor of the ordinary meaning of claim language.¹⁵³

on the uniformity and predictability of claim construction. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996) (stating that uniformity and certainty are necessary elements of the public notice function); *see also* Parus Holdings Amicus Brief, *supra* note 144, at 2. Third, public notice is best served when no litigation is required to interpret a patent’s terms. *Wagner & Miller Amici Brief*, *supra* note 144, at 2 (“There can be no dispute that the public notice function is best served when the meaning of claim language is readily apparent to patent readers.”). And fourth, the patent document itself is the primary meaning for claim terms, specifically when the patentee acts as his own lexicographer and defines a term used in the claims. *Id.*

148. *See generally infra* notes 150-184 and accompanying text (referring to the section entitled “A Heavy Presumption in Favor of Dictionaries Provides the Best Notice”).

149. *See generally infra* notes 185-211 and accompanying text (referring to the Section entitled “Look to the Specification”).

150. *See supra*, note 144 (listing four amicus briefs favoring the “procedural” approach).

151. *See* *Wagner & Miller Amici Brief*, *supra* note 144. However, note that although these authors “concentrate their research . . . on legal and policy issues of the U.S. Patent Law,” they are also “full-time academics” and likely have less day-to-day experience with patent prosecution and litigation than authors of most of the other amicus briefs. *See id.* at v.

152. *Wagner & Miller Amici Brief*, *supra* note 144, at 3. Specifically, a definitional statement such as “as used herein, the term X is understood to mean Y,” would be a clearly stated meaning of the term “X,” and there would be no need to look to dictionaries. *Id.* at 3.

153. *See* *Wagner & Miller Amici Brief*, *supra* note 144, at 4-5 (stating, “Indeed, the court should continue with its established trend of adopting a heavy presumption in favor of the ordinary meaning of claim language”); *see also* Parus Holdings Amicus Brief, *supra* note 144, at 4 (“[U]nless a patentee has acted as his or her own lexicographer or has expressly disavowed the scope of the claim during prosecution, using dictionaries to ascertain all possible meanings and then using the specification to select the proper meaning(s) will result in better predictability”); *cf.* *Cabnell v. Markham*, 148 F.2d 737, 739 (2d Cir. 1945) (Hand, J., commenting in the statutory context) (“It is one of the surest indexes of a mature and developed jurisprudence not to make a fortress out of the dictionary; but to remember that statutes always have some purpose or object to accomplish, whose sympathetic and imaginative discovery is the surest guide to their meaning.”). The purpose of patents is to disclose the invention. Michael S. Connor & John A. Waslef, *Where Do We Go From Here? A Critical Examination of Existing Claim Construction Doctrine*, 86 J. PAT. & TRADEMARK OFF. SOC’Y 878, 879 (2004).

1. Supreme Court Precedent and Dictionaries

To understand how the Federal Circuit should engage in claim construction, it is useful to look at how recent Supreme Court precedent deals with dictionaries and apply that reasoning to claim construction in the Federal Circuit.¹⁵⁴ To that end, seven majority opinions of the October 2003 term of the Supreme Court used one or more dictionaries to interpret language.¹⁵⁵ Four of those opinions involved statutory construction,¹⁵⁶ one involved a constitutional provision,¹⁵⁷ and the two others were some other binding legal text.¹⁵⁸ Indeed, scholars have noted that there has been a 37.2 percent increase in the use of dictionaries in the court system from 1994 to 2003.¹⁵⁹ As modern courts

154. For an excellent discussion of the use of dictionaries at the patent office and the courts, see Joseph Scott Miller & James A. Hilsenteger, *The Proven Key: Roles & Rules for Dictionaries at the Patent Office and the Courts*, 54 AM. U. L. REV. 829. The U.S. Supreme Court often quotes from both law dictionaries and general purpose English dictionaries in its opinions. *Id.* at 831. Just less than ten-percent (9.6%) of the Supreme Court's decisions in its October 2003 term utilized one or more dictionaries to interpret language of various legal instruments. *Id.* "The most comprehensive study of the Supreme Court's reliance on dictionaries . . . is the magisterial Samuel A. Thumma & Jeffrey Kirchmeier, *The Lexicon Has Become a Fortress: The United States Supreme Court's Use of Dictionaries*, 47 BUFF. L. REV. 227 (1999)." *Id.* at 832. The "existing literature on the deeper normative question - is it sound to use dictionaries to help establish a word's ordinary meaning? - is substantial." *Id.* at 836 n.24. See, e.g., Ellen P. Aprill, *The Law of the Word: Dictionary Shopping in the Supreme Court*, 30 ARIZ. ST. L.J. 275 (1998); Clark D. Cunningham et al., *Plain Meaning and Hard Cases*, 103 YALE L.J. 1561 (1994); Craig Hoffman, *Parse the Sentence First: Curbing the Urge to Resort to the Dictionary When Interpreting Legal Texts*, 6 N.Y.U. J. LEGIS. & PUB. POL'Y 401 (2003); Gary L. McDowell, *The Politics of Meaning: Law Dictionaries and the Liberal Tradition of Interpretation*, 44 AM. J. LEGAL HIST. 257 (2000); Aaron J. Rynd, *Dictionaries and the Interpretation of Words: A Summary of Difficulties*, 29 ALBERTA L. REV. 712 (1991); and Lawrence M. Solan, *Learning our Limits: The Decline of Textualism in Statutory Cases*, 1997 WIS. L.REV. 235.

155. Miller & Hilsenteger, *supra* note 154, at 831.

156. *Hibbs v. Winn*, 542 U.S. 88, 100 & n.3 (2004) (citing BLACK'S LAW DICTIONARY 117 (7th ed. 1999) in interpreting the term "assessment"); *Jones v. R.R. Donnelly & Sons Co.*, 541 U.S. 369, 383 & nn.15-16 (2004) (citing AMERICAN HERITAGE DICTIONARY 96 (4th ed. 2000), BLACK'S LAW DICTIONARY 138 (revised 4th ed. 1968), and OXFORD ENGLISH DICTIONARY 629 (2d.ed 1989) in interpreting "arising under"); *Engine Mfrs. Ass'n v. South Coast Air Quality Mgmt. Dist.*, 541 U.S. 246, 252-53 (2004); *United States v. Galletti*, 542 U.S. 114, 122 (2004) (citing BLACK'S LAW DICTIONARY 111 (7th ed. 1999) in interpreting the term "assessment").

157. *Crawford v. Washington*, 541 U.S. 36, 50-51 (2004).

158. *Olympic Airways v. Husain*, 540 U.S. 644, 651 & n.6 (2004) (citing AMERICAN HERITAGE DICTIONARY 10 (4th ed. 2000), BLACK'S LAW DICTIONARY 15 (6th ed. 1990), and WEBSTER'S NEW WORLD COLLEGE DICTIONARY 8 (4th ed. 1999) in support of its construction of the term "accident"); *Virginia v. Maryland*, 540 U.S. 56, 62 n.2 (2003) (utilizing BLACK'S LAW DICTIONARY 1586 (7th ed. 1999) to define "low-water mark").

159. Miller & Hilsenteger, *supra* note 154, at 832. The authors arrived at this increase by performing a search (specifically using the search term "dictionary /6 ("webster's" or "american heritage" or "random house" or college or collegiate or concise or unabridged or oxford") in Westlaw's allfeds database, and recording the number of hits annually. *Id.* at n.9. In 1994, 537

favor dictionaries in other cases of statutory construction,¹⁶⁰ a threshold question is whether principles of statutory construction should guide claim construction in patent cases.

Some scholars suggest that the quid pro quo involved in obtaining a patent does not lend itself to principles of statutory construction, but rather to principles of contract law.¹⁶¹ These scholars might argue, by analogy, that courts should construe any ambiguous language in a patent's claims against the patentee.¹⁶² However, others contend that interpreting a patent's claims is more analogous to statutory construction.¹⁶³ In so doing, the court should try to determine the intent of the drafters and can consider the internal consistency of the document as a whole.¹⁶⁴

hits were recorded. *Id.* In 2003 there were 737 hits. *Id.*

160. See *supra* notes 154-60 and accompanying text (discussing the use of dictionaries in the modern court system).

161. One scholar who suggests that courts should use contract principles to interpret patent claims is M. Aminthe Broussard. See M. Aminthe Broussard, *Ambivalence in Equivalents: Problems and Solutions for Patent Law's Doctrine of Equivalents*, 64 LA. L. REV. 119, 136-37. "A patent is a contract, so courts should interpret it using the traditional common law rules of contract interpretation." *Id.* at 136. Broussard suggests that "[non-technical] words in patent claims should be given their ordinary, common meaning[,] and technical words [should be given] their technical meaning." *Id.* She feels that because patent claims are analogous to contract terms, courts should adhere to the notion that ambiguous terms in a patent's claim should be construed against the drafter. *Id.* Charlie Lisherness has further noted that from a historical perspective, the U.S. patent system is based on an analogy to contract theory. Charlie Lisherness, Notes and Comments, *Patent Reissue Genus Claims: Harmful Evolution*, 26 T. JEFFERSON L. REV. 85, 91 (2003).

162. See Broussard, *supra* note 161, at 136 (noting that contracts are generally construed against the drafter).

163. One scholar advocating a statutory-construction-type methodology is Gretchen Ann Bender. See Gretchen Bender, *Uncertainty and Unpredictability in Patent Litigation: The Time is Ripe For a Consistent Claim Construction Methodology*, 8 J. INTELL. PROP. L. 175 (2001). Bender notes that the Federal Circuit has rejected the theory that a patent is similar to a contract. *Id.* at 196 (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 985). She goes on to note that the majority in *Markman* analogized claim interpretation to statutory construction, which is a matter of law strictly for the court. *Id.* (citing *Markman*, 52 F.3d at 985). Patents, like statutes, are enforceable against the public, unlike private agreements between contracting parties. *Id.* As such, the patentee's subjective intent as to the meaning of the claims is not at issue and the focus is on what a person of ordinary skill in the art at the time of the invention would have understood the term to mean. *Id.* Claim construction based on principles of statutory construction is the currently preferred theory. *Markman*, 52 F.3d at 987.

164. Wilson R. Huhn, *Teaching Legal Analysis Using a Pluralistic Model of Law*, 36 GONZ. L. REV. 433, 441 (2001). "Textual analysis looks to the language used in the legal document under review, whether it is a constitution, a statute, a regulation, a contract, or a will." *Id.* "Intratextual arguments are . . . a powerful technique for interpreting statutes." *Id.* at n.37. In this technique, one part of the document is used to give meaning to another part. *Id.* at 442. *E.g.*, *McCulloch v. Maryland*, 17 U.S. (1 Wheaton) 316, 414-15 (1819); *Dunnigan v. First Bank*, 585 A.2d 659, 663 (Conn. 1991).

The statutory approach has won out in the modern claim construction context.¹⁶⁵ Moreover, some scholars have suggested that recent Federal Circuit rulings could find support for adopting a procedural approach that favors dictionaries.¹⁶⁶ Indeed, at least one Federal Circuit judge has reiterated the fact that the Supreme Court has arguably stated that dictionaries are *the* place to start in statutory construction.¹⁶⁷

If courts continue to look to dictionary definitions when no explicit definition is set forth in the patent instrument and hold steadfastly to those definitions, the claims themselves may provide better public notice.¹⁶⁸ Such a position seems strongly rooted in the Supreme Court's statutory construction methodology, and the Federal Circuit should give it serious consideration in determining whether to look to dictionaries or the specification in claim construction.

2. Shortcomings

If the court had followed this procedural approach, perhaps the biggest obstacle would have been setting forth a methodology to

165. *Markman*, 52 F.3d at 985 (rejecting the theory that a patent is similar to a contract).

166. *See* Miller & Hilsenteger, *supra* note 154, at app. b, tbl.6. The Federal Circuit has relied on general purpose dictionaries more than twice as often as more technical or specialized reference works. *Id.* The claim construction reference work cited most often by the Federal Circuit is *Webster's Third New International Dictionary*. *Id.* *Webster's Third New International Dictionary* accounts for twenty-five percent of all citations in claim construction rulings at the Federal Circuit. *Id.* Moreover, on his website devoted to patent claim construction, Professor R. Polk Wagner notes the following trend after the decision to rehear *Phillips*:

1. Since the Phillips en banc order was issued on July 21, 2004, the court has decided 87% of claim construction cases using the procedural methodology. Compare this to the overall 65% procedural average. Note that the 'n' here is just 23 opinions, so it may well be an anomaly. Nonetheless, it will be interesting to see whether this is a harbinger of the resolution of the issues in Phillips.
2. Thus far in 2004, the court has issued 85 claim construction opinions, with 75% of them being procedural in nature.
3. Note that almost 30% of the claim construction cases at the Federal Circuit in 2004 have contained an "alternative" opinion - a concurrence or dissent.

Claimconstruction.com: A Research Project on the Interpretation of Patent Language, *available at* <http://www.claimconstruction.com/> (last visited on January 20, 2005).

167. Oral Argument Transcript, *supra* note 114, at 7 (where a judge queried, "The Supreme Court in statutory construction says to start with the dictionary?").

168. Wagner & Miller Amici Brief, *supra* note 144, at 2; *see* Ruoyu Roy Wang, Texas Digital Systems v. Telegenix, Inc.: *Toward a More Formalistic Patent Claim Construction Model*, 19 BERKELEY TECH. L.J. 153, 170-71 (2004) ("[Formalism] gradually reduces courts' interpretive burdens and mistakes, increases interpretive accuracy and predictability, and encourages a norm formation for patent drafting."); *see also id.* at 169-70 ("Formalism . . . advances the public notice function more because it predictably emphasizes the meanings of claims within the four corners of a patent.").

determine which dictionary definition should govern.¹⁶⁹ In looking to dictionary definitions, one source of confusion is the various definitions available for any given word.¹⁷⁰ The multiple definitions makes it impossible to predict with any confidence which meaning a court will choose for a given term in a patent's claims.¹⁷¹

Another possible shortcoming would have been the USPTO examiners' infrequent use of dictionaries.¹⁷² Although the Manual of Patent Examining Procedure (MPEP) promotes the use of dictionaries,¹⁷³ examiners do not use them as practical matter.¹⁷⁴ Thus, if courts adopt a

169. See, e.g., Paul Katz & Robert Riddle, *Designing Around a United States Patent*, 45 S. TEX. L. REV. 647, 654 (2004) (“[W]ords often have multiple dictionary definitions, some of which have no relation to the claimed invention, the intrinsic record must *always* be consulted to identify which of the different possible dictionary meanings of the claim terms in issue is most consistent with the use of the words by the inventor.”) (citing *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 326 F.3d 1215,1221 (Fed. Cir. 2003), *reh’g granted in part*, 334 F.3d 1294 (Fed. Cir. 2003); *Dow Chem. Co. v. Sumitomo Chem. Co.*, 257 F.3d 1364, 1372-73 (Fed. Cir. 2001); *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1478 (Fed. Cir. 1998)). This suggests that if more than one dictionary definition is consistent with the use of the words in the intrinsic record, the claim terms may be construed to encompass all such consistent meanings. *Id.*

170. See AlphaDictionary.com, available at <http://www.alphadictionary.com/index.shtml> (last visited May 14, 2006) (allowing users to search 992 on-line dictionaries); OneLook Dictionary Search, available at <http://www.onelook.com> (last visited May 14, 2006) (also searching 992 online dictionaries and 186 on-line *technical* dictionaries).

171. IBM Amicus Brief, *supra* note 143, at 3. However, other scholars have suggested that trends do exist and as such, it is more likely that the Federal Circuit will look to some dictionaries more than others. See Miller & Hilsenteger, *supra* note 154, at app. b tbl.6. The Federal Circuit has relied on general purpose dictionaries more than twice as often as it has relied on more technical or specialized reference works. *Id.* Moreover, the Federal Circuit does have a dictionary that it cites more often than any other, *Webster’s Third New International Dictionary*. *Id.* *Webster’s Third New International Dictionary* accounts for twenty-five percent of all citations in claim construction rulings at the Federal Circuit. *Id.*

172. See Oral Argument Transcript, *supra* note 114, at 6.

173. See U.S. PATENT & TRADEMARK OFFICE, DEPT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE §§ 1605, ¶ 16.10 (8th ed. Rev 2, 2004) (“Where color is a distinctive feature of the plant, the color should be positively identified in the specification by reference to a designated color as given by a recognized color *dictionary* or color chart”) (emphasis added) [hereinafter MPEP]; *id.* at § 2105 (“[T]his Court has read the term ‘manufacture’ in § 101 in accordance with its dictionary definition”) (quoting *Diamond v. Chakrabarty* 447 U.S. 303, 308 (1980)); *id.* at § 2106 (yielding to THE NEW IEEE STANDARD DICTIONARY OF ELECTRICAL AND ELECTRONICS TERMS 308 (5th ed. 1993)); *id.* at § 2106 (referring to the COMPUTER DICTIONARY 210 (Microsoft Press, 2d ed. 1994)); *id.* at § 2111.01 (repeatedly referring to dictionaries and plain meaning); *id.* at § 2173.05(a) (“It is appropriate to compare the meaning of terms given in technical dictionaries in order to ascertain the accepted meaning of a term in the art.”). Note, however, that the MPEP does not have the force of law or the force of the rules in Title 37 of the Code of Federal Regulations. *Id.* at Foreword (“This manual is published to provide . . . (USPTO) patent examiners, applicants, attorneys, agents, and representatives of applicants with a reference work on . . . the prosecution of patent applications before the USPTO[;]. . . [it] does not have the force of law. . .”).

174. See Oral Argument Transcript, *supra* note 114, at 6 (“It’s a training issue, typically [patent

methodology favoring dictionaries in claim construction, this might conflict with current real-world practices of the USPTO (or vice-versa).¹⁷⁵

3. Conclusion as to the Minority Position

Because uncertainty is inherent in the judiciary choosing a dictionary, and because the USPTO fails to use consistent definitions in the patent prosecution process, a presumption in favor of dictionaries might have led to a patent's claims becoming overly broad. There are two replies to this contention.

First, patentees should have to specify which dictionary governs.¹⁷⁶ Such a solution arguably makes sense from an economic perspective.¹⁷⁷ However, this solution fails to address how to deal with

examiners] don't use [dictionaries].").

175. It's unclear, however, whether this distinction between USPTO practice and realities of litigation would cause real world concern. One possible counterargument is that if the court did adopt such a methodology, the USPTO should simply conform its procedures to be in accordance with the decision. *See* Miller & Hilsenteger, *supra* note 154, at 847-48 (opining that the Patent Commissioner has the power to promulgate dictionaries if such a rule is procedural). Thus, to the extent that declaring a dictionary is a procedural methodology, the Patent Commission should have the power to require every practitioner to state on the face of the application what publicly available general purpose and specialized dictionaries she wants the office to use in the event it needs help to construe her claims. *Id.* at 886. Since the MPEP as a whole is only persuasive authority, this is a plausible outcome. *See* MPEP, *supra* note 173, at Foreword (stating that the MPEP does not have the force of law).

176. Miller & Hilsenteger, *supra* note 154, at 887 (proposing the Patent Office require "patentees to provide controlling express definitions for any claim terms in the body of the patent"). Such a solution would provide clarity in constructing terms, but what would courts do with patents that are currently issued and do not specify which dictionary to look to?

177. *See id.* at 897. In the article, the authors assume that requiring patent attorneys to look to dictionaries would increase the time associated with preparing a patent application. *Id.* at 897. These costs would then be passed onto the client. *Id.* They then assume that selecting a proper dictionary (or other reference source) will increase the average preparation cost of the patent by 1%, or \$93.32 per application. *Id.* at 898. Ultimately, they find that the total cost (given the fact that the PTO receives just over 330,000 utility patent applications a year) due to a patent attorney having to consult a dictionary, would be \$22,172,832. *Id.* at 899. Miller and Hilsenteger then contend that such added costs make financial sense. *Id.* Their argument for this cost-effectiveness goes as follows: (1) the national median cost of a full patent trial is \$4 million, (2) given that 1,600 utility patent infringement cases are filed a year, and (3) that 95 of those are fully tried, (4) it seems likely that six of those trials would be avoided and thus the money saved (more than \$24 million) would be greater than the money spent in the extra prosecution. *See id.* However, one might argue that such a system shifts the added cost of litigation from the government (i.e., taxpayers) to individual clients. *See* Jennifer Gordon, *Preparing and Prosecuting a Patent that Holds Up in Litigation*, in PATENT LITIGATION 2004, at 991, 1043 (PLI Patent, Copyrights, Trademarks, & Literary Property Course Handbook Series, 2004). In the somewhat analogous situation of claim amendments in light of *Festo Corp. v. Shoketsu Kinsoku Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000), scholars have urged that the additional prosecution

patents that have already issued and that do not designate a dictionary in the specification.¹⁷⁸ The courts should accordingly rely on dictionary experts to specify which dictionaries a court should consider in construing a patent's claims.

Second, three statutory provisions of the Patent Act prevent claims from being broader than what the inventor is entitled to claim.¹⁷⁹ Section 102 limits the claims of the present invention from encompassing that which already exists in the prior art.¹⁸⁰ Similarly, section 103 only allows the claims of the present invention to include subject matter that is non-obvious in light of the prior art.¹⁸¹ Lastly, and

costs of "carefully laying out exactly what was surrendered and/or what was not surrendered by amendment" is worth the added cost. *See id.*

178. *See supra* notes 154-60 (discussing the various dictionaries that courts have used in interpreting language, whether that language be statutory, constitutional, claim construction related, or something else altogether). Note that although courts may favor certain dictionaries, courts have not selected an "official" dictionary. *See id.* Moreover, various technical dictionaries are used in construing a patent's claims, and these dictionaries are specific to the subject matter of the claimed invention. *See MPEP, supra* note 173, at § 2106 (referring examiners to both *The New IEEE Standard Dictionary of Electrical and Electronics Terms* as well as the *Computer Dictionary*). It seems that if a court were to choose one dictionary, it would categorically exclude all other technical dictionaries.

179. 35 U.S.C. § 102 (2003); 35 U.S.C. § 103 (2003); and 35 U.S.C. § 112 (2003).

180. 35 U.S.C. § 102(a) ("A person shall be entitled to a patent unless—(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or foreign country, before the invention thereof by the applicant."). Accordingly, if the applicant's claims are anticipated by a prior art reference, the USPTO will deny the applicant a patent. *See id.*

181. 35 U.S.C. § 103. The relevant portion reads as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. § 103(a). The Supreme Court further defined this statutory provision in the classic case of *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Under *Graham*, four factual inquiries are used as a background for determining obviousness as follows: (1) determining the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the art; and (4) evaluating evidence of secondary considerations. *MPEP, supra* note 173, at § 2100-120. Furthermore, in *Hodosh v. Block Drug Co., Inc.*, the Federal Circuit went on to hold that the following tenets must also be adhered to: (1) "the claimed invention must be considered as a whole"; (2) "the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;" (3) "the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention"; and (4) reasonable expectation of success is the standard with which obviousness is determined. 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986). Furthermore, an examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. *MPEP, supra* note 173, at § 2100-122. In determining what is analogous prior art, the court has found "the similarities and differences in structure and function of the

perhaps most significantly, section 112 requires that the specification must be enabling of the subject matter in the claims and that it must disclose the best mode of the invention.¹⁸² For example, if the patentee does not sufficiently disclose the claimed invention in the specification to enable a person of ordinary skill in the art to make and use the invention, then the court will strike down those claims as void.¹⁸³ Moreover, the court could adopt a rule stating that if two plausible constructions exist, “the narrower should be chosen as a penalty for the patentee’s drafting ambiguity.”¹⁸⁴ As such, these requirements should keep an inventor from claiming more than he or she has actually invented.

C. Look to the Specification

1. Specification Should Govern

The majority of amici curiae favor the “holistic” approach because they feel that looking to dictionaries will confuse claim interpretations. They argue that reading the claims in the context of the specification better serves the public notice function because “it gives both the patentee and competitors a single source to look to in order to understand the scope of the invention.”¹⁸⁵ Moreover, “[t]he specification and

invention to carry far greater weight.” *In re Ellis*, 476 F.2d 1370, 1372 (C.C.P.A. 1973).

182. 35 U.S.C. § 112 (2005). The relevant portion reads:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most closely connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Id.

183. See *In re Edwards*, 568 F.2d 1349, 1351 (C.C.P.A. 1978) (“The function of the requirement is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him.”). This section “seeks to guard against unreasonable advantages to the patentee and disadvantage to others arising from uncertainty as to their rights.” *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 232 (1942).

184. Veenker, *supra* note 64, at 37.

185. IBM Amicus Brief, *supra* note 143, at 12. While this is true for issued patents and published applications, the same does not hold true for pending applications that are not published. See 35 U.S.C. § 122 (2000) (entitled “Confidential status of applications; publication of patent applications”). Under these statutory provisions, pending applications are kept in confidence by the Patent and Trademark Office, and no information concerning the application status can be given without authority of the applicant unless disclosure is necessary to carry out the provisions of an Act of Congress or in special circumstances, as determined by the Director of the PTO. § 122(a). Applications for patents are generally published promptly after 18 months from the earliest filing date, unless the applicant abandons the application, or certifies that the invention will not be the

prosecution history are a public record available to all without the need for litigation.”¹⁸⁶ Furthermore, the holistic approach is consistent with statutory provisions¹⁸⁷ and may be more consistent with principles of statutory construction.¹⁸⁸

2. Shortcomings

At first, it appears difficult to reconcile the majority’s viewpoint with the oft-stated proposition that it is the claims that delineate the “metes and bounds” of the invention. One might argue that the proper claim construction methodology should focus on the *terms* of a patent’s claims, thus implying that courts should focus on the *definitions* of those terms.¹⁸⁹ Indeed, if claim construction is analogous to statutory construction,¹⁹⁰ one might argue that ignoring the language of the claims is analogous to interpreting a statutory provision such that it is without effect. That is a position that courts repeatedly eschew.¹⁹¹

subject of an application filed in another country. § 122(b).

186. IBM Amicus Brief, *supra* note 143, at 3. Because current patents do not require the drafter to specify a particular dictionary definition, litigation may be required to find out exactly which dictionary would be used to construe the claims. *Cf. supra* notes 175-76 and accompanying text (suggesting that patentees should specify which dictionary a court should use to construe its claims).

187. *See* 37 C.F.R. § 1.75(d)(1). That provision states:

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

Id. (emphasis added).

188. *Cf. infra* note 191 (arguing that ignoring the language of the specification is analogous to interpreting a statute to render its provisions without effect).

189. *See* MCJOHN, *supra* note 71, at 173-74 (opining that “in particular, there is a widely noted tension between interpreting the claims by using the written description (allowed) and reading limitations from the description into the claims (not allowed)”). Some Federal Circuit panels have gone so far as to hold explicitly that courts should give the words of a claim the full range of their ordinary meaning. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed. Cir. 1999). In *CCS Fitness, Inc. v. Brunswick Corp.*, the court noted that if an apparatus claim recites a general structure without limiting that structure to a specific subset of structures, a court will generally construe the term to cover *all* known types of that structure that the patent disclosure supports. 288 F.3d 1359, 1366 (Fed. Cir. 2002) (citing *Renishaw PLC v. Marposs Societa’ Per Azioni* 158 F.3d 1243, 1250). The court held that dictionaries may establish ordinary meaning, so long as the definition does not “fly in the face” of the patent disclosure. *Id.*

190. Claim construction is analogous to statutory construction under the modern school of thought. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 985 (rejecting the theory that a patent is similar to a contract).

191. *See, e.g., Merrill Lynch, Pierce, Fenner and Smith, Inc. v. Devon Bank*, 832 F.2d 1005, 1008 (7th Cir. 1987) (“It is not beyond belief that statutes contain meaningless provisions, but a court should treat statutory words as dross only when there is no alternative.”). In the analogous arena of constitutional interpretation, John Marshall noted, “It cannot be presumed that any clause

Nonetheless, the *Phillips* court is not, in reality, contemplating such a drastic approach. Rather it is seeking only to *interpret the terms* of the claims. While the court may give weight to the specification in interpreting such terms, it will clearly not go so far as to state that the specification defines the property right.¹⁹²

3. A New Policy-Based Argument

Because large corporations own the majority of patents,¹⁹³ one might intuitively think that they would want broader claims (i.e., favor looking to dictionaries)¹⁹⁴ because such claims would provide them a greater property right. However, the majority of the amici curiae seem to take the opposite approach.¹⁹⁵ Corporations in particular are requesting *narrower* claims.¹⁹⁶

In attempting to understand why large corporations might be requesting narrower claims, it is interesting to first note that studies have shown that large companies (particularly in specific industries) are less likely to enforce patents through litigation.¹⁹⁷ Typically, as large

in the constitution is intended to be without effect. . . .” *Marbury v. Madison*, 5 U.S. (1 Cranch) 137, 174 (1803).

192. See *Johnson Worldwide*, 175 F.3d at 989 (determining that when performing claim construction, the courts must always begin and remain centered on the language of the claims); see also Spivey, *supra* note 147, at 989 (discussing this proposition in more detail).

193. John R. Allison and Mark A. Lemley, *Who’s Patenting What? An Empirical Exploration of Patent Prosecution*, 53 VAND L. REV. 2099, 2117 (2000). A study of 1,000 random patents issued by the USPTO across all fields of invention between mid-1996 and mid-1998 showed that small businesses (500 employees or fewer) owned 10.7 percent of patents. John R. Allison & Emerson H. Tiller, *Internet Business Method Patents*, available at http://utopia.utexas.edu/articles/tbr/business_patents.html (last visited January 30, 2005). Comparatively, large entities owned 70.7 percent of patents. *Id.*

194. See *supra* notes 124-25 (discussing how looking to dictionary definitions may lead to broader claims).

195. See *supra* note 143 (suggesting that twenty-five of the thirty-six briefs filed do not favor looking to the dictionary, but instead favor looking to the specification).

196. Compare *supra* note 143 (illustrating that the following corporate entities favored the “holistic approach”: Association of Corporate Council; Biotechnology Industry Organization; Infineon; Intel, IBM, Google, Micron, and Microsoft; Medrad, Inc.; Novartis Pharmaceuticals; and Visa USA, Mentat, Inc.) with *supra* notes 124-25 (detailing how dictionary definitions may yield a broader claim interpretation).

197. Allison et al., *supra* note 133, at 438. Moreover, ninety-nine percent of patent owners do not file suit to enforce their rights. Mark A. Lemley, *Rational Ignorance at the Patent Office*, 95 NW.U. L. REV. 1495, 1501 (2001). Based on the fact that specific industries are more likely to enforce patents through litigation, some scholars have urged that patents in specific industries are far more likely to be valuable than patents in other industries. Allison et al., *supra* note 133, at 474. For example, drug, medicine, computer, and communication patents are much more likely to be litigated than mechanical, chemical, electrical, and electronic patents. *Id.* at 472. In a more detailed study, it was found that medical devices, computer-related inventions, software,

companies in well-established industries grow, they build large patent portfolios.¹⁹⁸ Eventually, as the final consumer product grows in complexity, each company owns numerous patents relating to the ultimate consumer product.¹⁹⁹ These patents are known as “blocking patents.”²⁰⁰ Such “blocking patents” often divide the ownership rights in the ultimate product to such an extent that they force the competing corporations to agree to royalty-free cross licenses.²⁰¹ This keeps firms without large patent portfolios from entering the market.²⁰² As such, large companies in established fields have little to gain from entering patent litigation, because competing firms have similar patents that they would assert in counterclaims.²⁰³ Thus, generally speaking, a very small number of patents actually have value for large corporations.²⁰⁴

electronics, and mechanical patents are significantly more likely to be litigated than the average of all patents. *Id.* Therefore, these more litigated patents are more valuable. *See id.* at 474 & n.163. Perhaps unsurprisingly, many companies who have these “valuable patents” have filed amicus briefs in this case. *See supra* note 143 (noting that IBM, Infineon, Novartis Pharmaceuticals, as well as several other large corporations have filed amicus briefs). These large companies with “valuable patents” prefer looking to the specification and as such prefer a narrower claim construction. *See supra* note 143 (noting the above corporations feel the specification should be the primary source of claim construction).

198. *See* Top 10 Private Sector Patent Recipients for 2004, available at <http://www.uspto.gov/web/offices/com/speeches/05-03.htm> (last visited January 30, 2005). The following ten large corporations in established industries had the most patents in 2004 (numbers in brackets are preliminary number of patents in 2004): (1) IBM, Corp [3,248]; (2) Matsushita Electrical Industrial Co, Ltd [1,934]; (3) Canon Kabushiki Kaisha [1,805]; (4) Hewlett-Packard Development, Co. [1,775]; (5) Micron Technology, Inc. [1,760]; (6) Samsung Electronics Co., Ltd. [1,604]; Intel Corp. [1,601]; Hitachi, Ltd [1,514]; Toshiba Corp [1,310]; Sony Corp. [1,305]. *Id.*

199. *See* Allison et al, *supra* note 133, at 468-69.

200. *See generally* Robert Merges, *Intellectual Property Rights and Bargaining Breakdown: The Case of Blocking Patents*, 62 TENN. L. REV. 75 (1994) (discussing blocking patents and focusing on their impact on the reverse doctrine of equivalents); *see also* Richard J. Gilbert, *The Road Less Traveled: Arbitrating Antitrust Claim Special Feature: Development in International Competition Law: Converging Doctrines? U.S. and EU Antitrust Policy for the Licensing of Intellectual Property*, 19 ANTITRUST 51, 54 (Fall 2004) (discussing blocking patents in the context of the microprocessor industry, where more than 24,000 patents have issued since 1976).

201. Allison et al, *supra* note 133, at 468-69.

202. *See* Gilbert, *supra* note 200, at 54 (opining that unless a firm in the microprocessor industry can obtain a large patent portfolio, it is unable to enter (or stay in) the microprocessor market because of the plethora of patents covering the technology).

203. *See* Allison et al, *supra* note 133, at 468-69 (referring to such litigation as “mutually assured destruction”).

204. For example, IBM performed an internal patent study a few years ago and determined that of 10,000 patents that it studied, only 40 had “real value.” James E. White, *The U.S. First-to-Invent System, the Mossinghoff Conclusion, . . . and Statistics*, 85 J. PAT. & TRADEMARK OFF. SOC’Y 357, 362 (2003). However, those few patents that do have “real value” generate phenomenal revenues. *Id.* at 362-63 (noting that the revenue from the forty patents with “real value” was in excess of \$1.6 billion, while the cost to obtain the patents was “in the mere millions”).

While large corporations may not have much to gain from broader claims, they have plenty to lose. As stated above, if broader claims ensue, large companies are not likely to enforce those patent claims on smaller companies or independent inventors. However, the opposite does not hold true. Small companies and individual inventors are more likely to enforce patents than large companies are. These individual inventors and small companies are often non-manufacturing shops that do not produce products.²⁰⁵ Because these small entities do not manufacture products, large companies cannot assert their patents against them because there is no infringement. If *Phillips* would have determined that dictionaries are the primary source for claim interpretation, broader claims would have ensued, leaving individuals and small companies more room to assert broad claims. Thus, these small companies would have been more likely to initiate litigation with the larger, more successful corporations. This would have rewarded the unsuccessful firms in the marketplace, because they are the ones without products of their own against which others could assert patents.²⁰⁶ The *Phillips* court widely side-stepped this result by keeping the primary focus of claim construction on the intrinsic evidence.²⁰⁷

The corporations that submitted amicus briefs have deep pockets and may fear smaller corporations initiating vexatious litigation.²⁰⁸

205. Allison et al, *supra* note 133, at 469. Indeed, one current business strategy is that large companies may transfer their patents to holding companies, permitting the holding company (which does not sell or produce product, and as such cannot infringe another's patent) to license or enforce the patents while insulating the large company from infringement counterclaims. *Id.* at 469. Coincidentally (or perhaps not), one of the amicus briefs that favors looking to the dictionary is from a holding company. See Parus Holdings Amicus Brief, *supra* note 144. Parus Holdings, Inc. is a "small research-oriented company" that seeks to assert its patents on other companies via litigation, license its patents, and otherwise raise funds from its patent portfolio. *See id.* at 1. Another amicus curiae that suggests looking to the dictionary is McShea Tecce & Duffy & Keenam. See McShea Tecce Amici Brief, *supra* note 144. This amicus curiae identifies itself as "dedicated to the representation of individuals and small entities in connection with IP-rights." *Id.* at iv. When these briefs are looked at together, they arguably add credence to the amici curiae who favor looking to the specification: if the court looks to dictionaries as a primary source of claim interpretation, then small companies (who own patents but produce few or no products) will seek to enforce their patents against large companies that are successful in the marketplace.

206. Infringement of a patent generally requires that an unauthorized party "makes, uses, offers to sell or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefore . . ." 35 U.S.C. § 271(a) (2003). Accordingly, in a case where a small, research based firm holds patents but does not make, use, sell or import products, the firm cannot be held to infringe a patent. *See id.*

207. *Phillips*, 415 F.3d at 1317-18 (subrogating dictionaries to a role that is "less significant than the intrinsic record," which includes the language of the claims, the specification, and the prosecution history).

208. *E.g.*, IBM Corp. has a market capitalization of \$131.66 billion; Google has a market capitalization of \$64.96 billion; Micron Technology, Inc. has a market capitalization of \$7.81

Nonetheless, if the previous interpretation is correct, it suggests that courts and scholars must rethink the traditional understanding that patents are a means for inventors to exclude competitors.²⁰⁹ Under such a view, patents owned by large corporations look like a socially wasteful expense made only because other large corporations also invest in such patents.²¹⁰

4. Conclusion as to Majority Opinion

While the majority's viewpoint has some merit, in many cases, such an approach does not give sufficient deference to dictionaries.²¹¹ As such, it cannot carry the day and the court must find a better solution.

D. Suggestion - Include Dictionaries as Intrinsic Evidence

Although the first *Phillips* question is phrased as an "either-or" proposition,²¹² the court's ultimate ruling was correct in not limiting its final holding.²¹³ To resolve the tension in *Phillips*, the Federal Circuit wisely allowed courts to look to dictionaries and to the specification in order to construe claims accurately.²¹⁴

This can be accomplished by looking to the dictionary in the context of the specification.²¹⁵ Such a balanced approach provides patent holders a presumption that their claims have a broad plain

billion; and Microsoft Corp. has a market capitalization of \$264.14 billion. New York Stock Exchange, available at <http://www.nyse.com> (last visited on October 23, 2005).

209. Allison et al, *supra* note 133, at 469.

210. *Id.* Cf. Teresa Riordan, *Patents: Some Pharmaceutical Companies Pay \$25 Million for Nonexclusive Rights to the New AIDS Drugs*, N.Y. TIMES, July 22, 1996, at 2 (reporting an extremely broad (and valuable) patent that had not issued yet: Vertex Pharmaceuticals and Glaxo Wellcome jointly paid \$25 million to G.D. Searle for a non-exclusive license to what the company contended would be a broad patent, because the patent related to a new type of drug that showed considerable promise in fighting AIDS).

211. *See infra* notes 212-225 (offering that courts should look to dictionaries in the context of the specification).

212. *See supra* note 86 (listing the seven questions certified for rehearing in *Phillips*).

213. *See, e.g.*, Bradley Amicus Brief, *supra* note 143, at 4 ("Ordaining either dictionaries or patent specifications to be controlling authorities in all situations is to impose a straightjacket on the mind's eye."); Mion Amicus Brief, *supra* note 143, at 3 ("A patent, its prosecution history, and general and technical dictionaries are *all* sources for claim construction.") (emphasis added).

214. *See Phillips*, 415 F.3d at 1322, 1315 (stating "we do not intend to preclude the appropriate use of dictionaries", and "[t]he best source for understanding a technical term is the specification from which it arose, informed, as needed, by the prosecution history," respectively). ABA Amicus Brief, *supra* note 23, at 2 (supporting a "middle ground"); *see also* ITCTLA Amicus Brief, *supra* note 145, at 3 (favoring looking to both the specification and dictionaries).

215. *See supra* note 213.

meaning.²¹⁶ Because a person of ordinary skill in the art would read the claims with the dictionary they “carry in their heads,” a dictionary definition is a natural starting point for claim construction.²¹⁷ However, it would be “misguided and self-contradictory” to detach that meaning from the context of the patent instrument itself.²¹⁸ In effect, courts should look both to dictionaries and to the specification in construing claims.²¹⁹

Court cases indicate that the Federal Circuit may be elevating the use of dictionaries to the level of intrinsic evidence, or perhaps to an even more fundamental level.²²⁰ By raising dictionaries to the level of intrinsic evidence, the Federal Circuit could leave the existing claim construction methodology in place,²²¹ and at the same time find a way to allow patentees to argue that the claims are entitled to broad protection.

A court should refuse to give the patentee the full scope of his claims in four cases. The first two limitations are based on intrinsic evidence: (1) if the specification does enable the full scope of the claims, the court should strike down each non-enabled claim under 35 U.S.C §

216. *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002) (“The terms used in the claims bear a ‘heavy presumption’ that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.”).

217. Oral Argument Transcript, *supra* note 114, at 6. The full exchange at oral arguments was as follows: “Clevenger: Don’t the examiners [who are people of ordinary skill in the art] carry dictionaries in their heads? [Whealan (representing the U.S. government)] A: Yes, but they all have different dictionaries. Examiners have specialized knowledge. . . .” *Id.*

218. *Nard*, *supra* note 18, at 82 (“[T]his overly formalistic approach and acontextual approach is misguided and self-contradictory.”). A purely procedural view “proclaims to read the claim language as a person of ordinary skill in the art would, but . . . eschews the use of extrinsic evidence, thus distancing itself” from the parties that its interpretation will ultimately affect. *Id.* If courts put too much of their own judgment in choosing the relevant dictionary (or if they fail to look at extrinsic evidence), the incentives to improve or design around a claim will disappear because the claim’s boundaries are not commonly understood. *Id.*

219. *See supra* notes 213-214.

220. *See Bilstad v. Wakalopoulos*, 386 F.3d 1116, 1122 (2004). In *Bilstad*, the Federal Circuit upheld the Board’s construction of the term “plurality.” *Id.* In agreeing with the Board’s construction, the court agreed with the Board’s methodology, which is as follows: (1) look to a dictionary to determine the ordinary meaning of the term, (2) then look to the written description for context in ascertaining the meaning the term, (3) determine if the disclosure is consistent with the dictionary definition, (4) and construe the term to encompass all consistent definitions. *Id.* In such a methodology, courts look to dictionaries before looking to the written description. *See id.* As such, dictionaries cannot be considered extrinsic evidence, which is considered only after looking at the claims and all intrinsic evidence. *See id.* Accordingly, dictionaries must be either intrinsic evidence or must be indicative of a more fundamental aspect of patent claims. *See id.*

221. *See supra* notes 66-69 (discussing how *Vitronics* set forth a general claim construction analysis). Note that if dictionaries are moved from extrinsic evidence to intrinsic evidence, the basic doctrine does not need to change. *See supra* notes 66-69.

112,²²² and (2) the patentee can explicitly limit the scope of the claims by the written description portion of the specification by acting as his own lexicographer.²²³ The third and fourth limitations are based on extrinsic evidence: (3) the claim can be limited by the scope of the prior art,²²⁴ and (4) experts should be allowed to testify as to the meaning that a person of ordinary skill in the art would ascribe to the claims.²²⁵

V. CONCLUSION

Because industry fortunes rise and fall on how courts interpret patent claims, there is no more important issue in patent law than claim construction. *Phillips* will no doubt change the landscape of

222. *Bristol-Myers Squibb Company v. Andrx Pharm., Inc.*, 343 F.Supp.2d 1124, 1145 n.20 (S.D. Fla., 2004). *See also In re Cortright*, 165 F.3d 1353, 1356 (Fed. Cir. 1999); *Nat'l Recovery Techs., Inc. v. Magnetic Separation Sys.*, 166 F.3d 1190, 1196-97 (Fed. Cir. 1999).

223. *See, e.g., Merck & Co., Inc. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1370 (Fed. Cir. 2005) ("When a patentee acts as his own lexicographer in redefining the meaning of particular claim terms away from their ordinary meaning, he must clearly express that intent in the written description."); *see also Bell Atlanta Network Servs. v. Covad Commc'ns Group, Inc.*, 262 F.3d 1258, 1268 (Fed. Cir. 2001). The statement in the written description must have sufficient clarity to put a person of ordinary skill in the art on notice that the inventor intended to redefine the claim term. *See Merck* 395 F.3d at 1370; *see also Elekta Instrument S.A. v. O.U.R. Sci. Int'l, Inc.*, 214 F.3d 1302, 1307 (Fed. Cir. 2000) ("Absent an express intent to impart a novel meaning, claim terms take on their ordinary meaning."); *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 ("The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim."); *Union Carbide Chems. & Plastics Tech. Corp. v. Shell Oil Co.*, 308 F.3d 1167, 1177 (Fed. Cir. 2002) ("This 'heavy presumption' in favor of the claim term's ordinary meaning is overcome, however, if a different meaning is clearly and deliberately set forth in the intrinsic evidence.").

224. Patents are presumptively valid. 35 U.S.C. § 282 (2005). This presumption of validity is largely to "protect the inventive contribution of patentees, even when the drafting of their patents has been less than ideal." *Exxon Research and Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001). The "presumption of validity under 35 U.S.C. § 282 carries with it a presumption that the patent examiner did his duty and knew what claims he was allowing." *Intervet America, Inc. v. Kee-Vet Labs, Inc.*, 887 F.2d 1050, 1054 (Fed. Cir. 1989). Thus, a party challenging the validity of a patent has an especially large burden when the prior art was before the examiner during the prosecution of the application. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1467 (Fed. Cir. 1990).

225. *Schutt Mfg. Co. v. Riddell, Inc.*, 673 F.2d 202, 205 (7th Cir. 1982). The skill of a person of ordinary skill in the art is a factual question. *Chore-Time Equip., Inc. v. Cumberland Corp.*, 713 F.2d 774, 779 (Fed. Cir. 1983)

We hold only that an invention may be held to have been either obvious (or nonobvious) without a specific finding of a particular level of skill or the reception of expert testimony on the level of skill, where, as here, the prior art itself reflects an appropriate level and need for such expert testimony has not been shown.

Id. at n.2. Ordinarily, the level of skill in the art is established through expert testimony of those familiar with the art and the patent at issue. *Id.* *But see Markman v. Lehman*, 987 F.Supp. 36 (D.D.C. 1997) *aff'd*, 178 F.3d 1306 (Fed. Cir. 1998) (holding that expert testimony regarding the level of skill is unnecessary because the prior art itself reflects the level of skill).

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claim construction in patent law and have a direct impact on every United States patent. Although the amicus briefs show a significant preference for favoring the specification over dictionary definitions, the question that they address was written as an “either-or” proposition. When the Federal Circuit addressed this matter, it wisely ignored its own “either-or” proposition, and adopted a balanced approach. This solution yields to the realities of how a person of ordinary skill in the art would understand a patent’s claims.

David Potashnik