



From Left to Right: Peter Thurlow, Esq., John Whealan, Esq., Bruce Wexler, Esq. And Richard Rainey, Esq.

John Whealan, Solicitor, U.S. Patent and Trademark Office; Bruce M. Wexler, partner, Fitzpatrick, Cella, Harper and Scinto; and Richard L. Rainey, partner, Fish & Neave, were members of a panel that discussed “Patent Claim Construction in view of Phillips v. AWH Corp.” at the CLE luncheon program held at the Harvard Club on September 29, 2004.

Mr. Whealan co-authored the amicus brief that was submitted to the Court of Appeals for the Federal Circuit (CAFC) on behalf of the U.S. Department of Justice, U.S. Federal Trade Commission and U.S. Patent and Trademark Office. Mr. Wexler authored the amicus brief that was submitted to the CAFC on behalf of the New York Intellectual Property Law Association, in which the Tennessee Bar Association and its IP Law section, State Bar of Michigan IP Law Section and Los Angeles Intellectual Property Law Association joined. Mr. Rainey co-authored the amicus brief that was submitted to the CAFC on behalf of the American Bar Association.

Each one of the speakers discussed the process of preparing the amicus briefs and obtaining the required approvals to submit the amicus brief on behalf of the government or respective bar association. Mr. Whealan noted, for example, that the Solicitor General must approve the government’s participation in the case and also approve what the amicus brief says. A number of government agencies including the Patent Office, anti-trust division of the Department of Justice and Federal Trade Commission, to name just a few, provided input regarding the content of the amicus brief.

Each one of the speakers also discussed the substance of the amicus briefs, in particular, the sources of claim construction. Mr. Wexler noted that the NYIPLA took the position that the primary source of claim construction should be the intrinsic evidence, namely the patent claims, patent specification and, if in evidence, the patent prosecution history. Extrinsic evidence, including dictionaries, expert testimony and prior art, Mr. Wexler noted, should be considered after or at the same time as the reading of the patent as an aid to the court's understanding of the patent and prosecution history. Mr. Whealan noted that the government took a position similar to the NYIPLA, namely that the primary source of claim construction should be the intrinsic evidence, not the extrinsic evidence. Mr. Rainey pointed out that the ABA rejected a hierarchical approach to claim construction and noted that both intrinsic and extrinsic evidence are important sources of information that should be considered when construing claims.