

Appeal Nos. 03-1269, -1286

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In the  
**United States Court of Appeals**  
*for the*  
**Federal Circuit**

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EDWARD H. PHILLIPS,

*Plaintiff-Appellant,*

- v. -

AWH CORPORATION,  
HOPEMAN BROTHERS, INC., AND LOFTON CORPORATION,

*Defendants-Cross Appellants,*

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Appeal from the United States District Court for the District of  
Colorado in Case No. 97-CV-212, Judge Marcia S. Krieger

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**BRIEF OF *AMICUS CURIAE* NEW YORK INTELLECTUAL  
PROPERTY LAW ASSOCIATION REGARDING THE ISSUE OF  
CLAIM CONSTRUCTION, 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 JOIN**

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SEPTEMBER 20, 2004

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**CERTIFICATE OF INTEREST**

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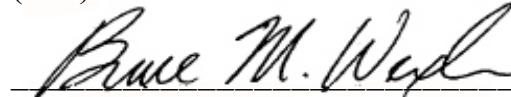
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2. The party represented by me as *amicus curiae* is the real party  
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3. The parent companies, subsidiaries (except wholly owned  
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**STATEMENT OF INTEREST OF *AMICUS CURIAE***

This brief is submitted on behalf of the New York Intellectual Property Law Association (the “NYIPLA” or the “Association”), a professional association of more than 1,300 attorneys whose interests and practices lie in the area of patent, copyright, trademark, trade secret and other intellectual property law. The Association’s members include in-house attorneys working for businesses owning patents or having to deal with the patents of third-parties, as well as attorneys in private practice who represent both patent owners and accused infringers. NYIPLA members represent both plaintiffs and defendants and also regularly participate in proceedings before the United States Patent and Trademark Office (“PTO”), including representation of interference parties and *ex parte* applicants for patents.

Claim construction is an area that is of the utmost importance to a substantial percentage of NYIPLA members. In order to best serve the needs of their clients, these members need to know how to advise about claim construction, including the tools that may be utilized and their order and weight. Since claim construction is often case dispositive, it is crucial that the public receive clear guidance in this area of the law.

Since its founding in 1922, the NYIPLA has been committed to maintaining the integrity of United States patent law, and to the proper interpretation and application of that law. Because of the practical experience of its members, and its non-partisan status, the NYIPLA believes that its views will aid this Court in the resolution of the issues raised in this appeal concerning the rules governing claim construction.

The Tennessee Bar Association and its Intellectual Property Law Section, State Bar of Michigan Intellectual Property Law Section, and Los Angeles Intellectual Property Law Association have reviewed and join in the arguments made in this brief.

### **ARGUMENT**

The NYIPLA's argument is delineated in response to the specific questions set forth by the Court in its July 21, 2004 Order granting the *en banc* hearing:

**I. IS THE PUBLIC NOTICE FUNCTION OF PATENT CLAIMS BETTER SERVED BY REFERENCING PRIMARILY TO TECHNICAL AND GENERAL PURPOSE DICTIONARIES AND SIMILAR SOURCES TO INTERPRET A CLAIM TERM OR BY LOOKING PRIMARILY TO THE PATENTEE'S USE OF THE TERM IN THE SPECIFICATION? IF BOTH SOURCES ARE TO BE CONSULTED, IN WHAT ORDER?**

As discussed further below, 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. These sources, as they would be understood by one of ordinary skill in the art at the time of the invention, control the claim construction process and should be consulted first in determining what the claimed invention is. In doing so, the court should apply well-established canons of construction, developed through years of precedent. Further, extrinsic evidence, including dictionaries, technical treatises and expert testimony may also be considered, not as a disembodied dissertation into the meaning of language, but as an aid to and in conjunction with the court's understanding of the patent and prosecution history, as appropriate on the facts of each case. In this way, the extrinsic evidence may be considered after or in conjunction with the reading and understanding of the intrinsic evidence, as the court finds appropriate.

The public notice function is not, however, well-served if the court construes claims by reading just the claim language and then immediately turning to various dictionary definitions of words appearing in the claims. Indeed, any patent practitioner confronted with a patent who is trying to understand the patented invention would naturally read the entire patent to do so. He or she would not simply read the claims and then start pulling dictionaries. Nor is the public-notice function well-served if, on appeal, the court were to apply dictionary definitions or other extrinsic evidence that was not of record in the trial court or at least fully briefed by the parties in the appeal.

This Court has succinctly stated the principles above in *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998)

(internal citations omitted):

“Ultimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim. The construction that stays true to the claim language and most naturally aligns with the patent’s description of the invention will be, in the end, the correct construction. A claim construction is persuasive, not because it follows a certain rule, but because it defines terms in the context of the whole patent.”

*See also Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996) (referring to “the necessarily sophisticated analysis of the whole document, ***required by the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole.***”) (emphasis added).

The use of dictionaries and technical treatises is, of course, nothing new in the construction of patent claims. This Court used such resources largely without controversy early in its history and before the *Markman* ruling, in conjunction with an examination of the intrinsic evidence and other extrinsic evidence such as expert testimony. *E.g.*, *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 1569-71 (Fed. Cir. 1983); *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986-88 (Fed. Cir. 1988); *Senmed, Inc. v. Richard-Allan Med. Indus., Inc.*, 888 F.2d 815, 818-20 (Fed. Cir. 1989).

The Court confirmed in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (*en banc*), that the intrinsic evidence consisting of “three sources” -- the claims, the specification and patent prosecution history -- is considered to ascertain the meaning of claims. *Accord Markman*, 517 U.S. at 384. The extrinsic evidence, expressly including dictionaries and learned treatises, may be considered with other extrinsic evidence such as expert

testimony and prior art when helpful to understand the language used in the patent. *Markman*, 52 F. 3d at 980.

The controversy over the use of dictionaries stems from their elevation to such a high regard that they began to trump or make virtually unimportant the intrinsic evidence as well as the other extrinsic evidence such as expert testimony. The source of this controversy can be traced to *Vitronics Corp. v. Conceptronics, Inc.*, 90 F.3d 1576, 1582, 1584 n.6 (Fed. Cir. 1996), which, although making clear that the court “should look first to the intrinsic evidence of record,” commented in a footnote that dictionaries and technical treatises were “worthy of special note” as being objective. The Court further denigrated testimony by an expert or artisan in the field of the technology, even though *Markman* had expressly noted its potential usefulness. *Id.* at 1585; *see Markman*, 52 F.3d at 980-81. This language became routinely cited in the Court’s subsequent development of a “heavy presumption of ordinary meaning,” ascertained from isolated dictionaries, to drive claim construction. At perhaps the high-point in its elevation of dictionaries, the Court suggested that it would be legal error to consult the patent specification before first reading various

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

The problem with this approach is that random dictionaries and technical treatises are not necessarily “neutral” or “objective” statements of what words mean as they appear in a patent, and they are certainly not a statement of a patented invention. “In judicial ‘claim construction’ the court must achieve the same understanding of the patent, as a document whose meaning and scope have legal consequences, as would a person experienced in the technology of the invention. Such a person would not rely solely on a dictionary of general linguistic usage, but would understand the claims in light of the specification and the prior art, guided by the prosecution history and experience in the technologic field.” *Toro Co. v. White Consolidated Indus.*, 199 F.3d 1295, 1299 (Fed. Cir. 1999); *Ferguson Beauregard/Logic Controls v. Mega Systems, LLC*, 350 F.3d 1327, 1338 (Fed. Cir. 2003) (“Dictionary definitions, while reflective of the ordinary meanings of words, do not always associate those meanings with context or reflect the customary usage of words by those skilled in a particular art.”).

Indeed, practical experience shows that in cases involving technical terms, expert or inventor testimony explaining the usage of these terms by those of

ordinary skill in the art or the usage of the terms in the context of the patented invention, may be more helpful than a disembodied dictionary definition, particularly where that testimony is backed by and consistent with documentary evidence such as the usage in the patent, the prior art, technical treatises or dictionary definitions. It would be highly inappropriate, for example, to disregard expert testimony proffered by a credible witness, supported for example by technical treatises and dictionaries or prior art or a cogent explanation of usage in the context of the technology of the patent, in favor of a stand-alone dictionary definition which the court pulls from a shelf. Yet such a result is possible when dictionary definitions are elevated to sit beside the patent claim and patent construction is made to turn on them.<sup>1/</sup>

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<sup>1/</sup> An invention is more than just an arbitrary combination of structural elements, which can then be defined by a discussion of dictionary definitions entirely divorced from the description of what the invention is. As explained by Curtis in his treatise on patents over 100 years ago, “the act of invention . . . embraces more than the new arrangement of particles of matter in new relations. The purpose of such new arrangements is to produce some new effect or result, by calling into activity some latent law, or force, or property, by means of which, in a new application, the new effect or result may be accomplished.” G. Curtis, *A Treatise on the Law of Patents for Useful Inventions* at xxiii-xxv (4th ed. 1873), *quoted in In re Alappat*, 33 F.3d 1526, 1551-52 (Fed. Cir. 1994) (Archer, J., *dissenting on other grounds*). To stay true to the “invention,” the court must understand what that invention is, as explained in the patent itself.



In considering the intrinsic evidence, the court is not adrift at sea.

The court may be guided by the usage of the claim language in the context of the claim and the language appearing in the claim. *E.g.*, *Markman*, 52 F.3d at 982 (rejecting the patentee’s claim construction where the Court found that a surrounding claim phrase “does not make sense” using that construction). The court also may be guided by the language of the other claims in the patent. Similarly, the patent specification explains the invention, and may also define claim terms. The court should also apply when appropriate any of the numerous well-established canons of construction. These are general principles which may or may not apply depending on the facts of the case, and include, by way of example and without limitation:

- Claim limitations may not be imported from the patent specification or from preferred embodiments into the claim (*e.g.*, *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 987 (Fed. Cir. 1988); *Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855, 865 (Fed. Cir. 1988));
- A claim construction which excludes a disclosed embodiment is rarely if ever correct (*e.g.*, *Johns Hopkins Univ. v. CellPro, Inc.*, 152 F.3d 1342, 1355 (Fed. Cir. 1998));
- Words appearing in the specification should have the same meaning when used in the claims (*e.g.*, *McGill, Inc. v. John Zinc Co.*, 736 F.2d 666, 674 (Fed. Cir. 1984));

- A construction which results in making claim language superfluous, nonsensical or redundant should be avoided (*e.g.*, *Markman*, 52 F.3d at 982);
- Claims should generally be construed consistent with the basic purposes of the invention (*e.g.*, *Apple Computer, Inc. v. Articulate Sys., Inc.*, 234 F.3d 14, 25 (Fed. Cir. 2000));
- Different words or phrases used in separate claims are generally presumed to indicate that the claims have different meanings and scope (*e.g.*, *Karlin Technology Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971-72 (Fed. Cir. 1999));
- As per the doctrine of claim differentiation, limitations from dependent claims should not be read into the claims from which they depend (*e.g.*, *id.*);
- Patents should be construed without unnecessary restriction to accord to the inventor the full scope of his or her invention (*e.g.*, *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1325 (Fed. Cir. 2003)).

Finally, the court may consider extrinsic evidence, including expert testimony, prior art, dictionaries and technical treatises in order to understand the usage of that language in the patent.

One argument that has been expressed in support of the use of dictionary definitions as the primary source for claim construction, is that it prevents the courts from improperly importing claim limitations from the specification into the claims. When a court reads limitations from the specification into the claims, that of course is improper. We do not believe,

however, that the Court should rectify this problem by creating an unsound rule of claim construction that elevates dictionaries so as to essentially make the specification of little importance. Rather, the Court should directly confront this problem by carefully refraining from limiting claims to the preferred embodiments in the patent specification or from reading claim limitations from the specification into the claims and ensuring that the district courts do the same.<sup>2/</sup>

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<sup>2/</sup> For example, in the now-vacated panel decision, the Court found that “baffles” as used in both the intrinsic and extrinsic evidence are structures which “check, impede, and obstruct heat, sound, and projectiles such as bullets and bombs.” 363 F.3d at 1212. The Court could have applied this construction in determining the issue of infringement. Nonetheless, the Court went further and held that the baffle must also be oriented at an angle other than 90 degrees, based on the description in the specification. *Id.* at 1213-14. Without importing a limitation from the specification into the claim, it is hard to understand how a specific angle of orientation for a “baffle,” can be part of the meaning of “baffle.”

**II. IF DICTIONARIES SHOULD SERVE AS THE PRIMARY SOURCE FOR CLAIM INTERPRETATION, SHOULD THE SPECIFICATION LIMIT THE FULL SCOPE OF CLAIM LANGUAGE (AS DEFINED BY THE DICTIONARIES) ONLY WHEN THE PATENTEE HAS ACTED AS HIS OWN LEXICOGRAPHER OR WHEN THE SPECIFICATION REFLECTS A CLEAR DISCLAIMER OF CLAIM SCOPE? IF SO, WHAT LANGUAGE IN THE SPECIFICATION WILL SATISFY THOSE CONDITIONS? WHAT USE SHOULD BE MADE OF GENERAL AS OPPOSED TO TECHNICAL DICTIONARIES? HOW DOES THE CONCEPT OF ORDINARY MEANING APPLY IF THERE ARE MULTIPLE DICTIONARY DEFINITIONS OF THE SAME TERM? IF THE DICTIONARY PROVIDES MULTIPLE POTENTIALLY APPLICABLE DEFINITIONS FOR A TERM, IS IT APPROPRIATE TO LOOK TO THE SPECIFICATION TO DETERMINE WHAT DEFINITION OR DEFINITIONS SHOULD APPLY?**

For the reasons discussed above, dictionaries should not be used as the primary source of claim construction. The claimed invention, as understood by one skilled in the art at the time of the invention in view of the patent and its prosecution history, should control the claim construction inquiry. The fact that the patentee has only one embodiment in the specification should not necessarily limit the claim to that embodiment, since it is the language of the claims that controls. *E.g., Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996) (“The claim ‘define[s] the scope of a patent grant.”). Whether a general or technical dictionary is used, or for that matter whether both are used, or which one or many of multiple definitions is used, will depend on the dictionary(ies) or

definition(s) that one of skill in the art would find appropriate after reading the patent specification and prosecution history.

**III. IF THE PRIMARY SOURCE FOR CLAIM CONSTRUCTION SHOULD BE THE SPECIFICATION, WHAT USE SHOULD BE MADE OF DICTIONARIES? SHOULD THE RANGE OF THE ORDINARY MEANING OF CLAIM LANGUAGE BE LIMITED TO THE SCOPE OF THE INVENTION DISCLOSED IN THE SPECIFICATION, FOR EXAMPLE, WHEN ONLY A SINGLE EMBODIMENT IS DISCLOSED AND NO OTHER INDICATIONS OF BREADTH ARE DISCLOSED?**

The answer to this question is contained in the answers to questions 1 and 2. There should be no *per se* rule limiting patents to preferred embodiments, even if only one such embodiment is disclosed. As discussed above, the claims and not the written description ultimately set forth the scope of the invention.

**IV. INSTEAD OF VIEWING THE CLAIM CONSTRUCTION METHODOLOGIES IN THE MAJORITY AND DISSENT OF THE NOW-VACATED PANEL DECISION AS ALTERNATIVE, CONFLICTING APPROACHES, SHOULD THE TWO APPROACHES BE TREATED AS COMPLEMENTARY METHODOLOGIES SUCH THAT THERE IS A DUAL RESTRICTION ON CLAIM SCOPE, AND A PATENTEE MUST SATISFY BOTH LIMITING METHODOLOGIES IN ORDER TO ESTABLISH THE CLAIM COVERAGE IT SEEKS?**

There should be no dual restriction on claim scope. The claim construction methodologies of the majority and dissent should be viewed as complementary in that both the intrinsic evidence and the extrinsic evidence may

be considered in arriving at the true construction of the claim language. This is elaborated above.

**V. 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?**

The Court should retain this canon of construction. If there are two equally plausible and conflicting constructions of a claim term, the more persuasive definition is the one which maintains the validity of the patent. *Rhine v. Casio, Inc.*, 183 F.3d 1342, 1345 (Fed. Cir. 1999); *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 911 (Fed. Cir. 2004); see *Rubber Co. v. Goodyear*, 76 U.S. 788, 795 (1869) (“A patent should be construed in a liberal spirit, to sustain the just claims of the inventor. This principle is not to be carried so far as to exclude what is in it, or to interpolate anything which it does not contain. But liberality, rather than strictness, should prevail where the fate of the patent is involved, and the question to be decided is whether the inventor shall hold or lose the fruits of his genius and labors.”).

**VI. 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?**

As set forth above, a great deal of weight should be given to the prosecution history in understanding the invention and the meaning of the words to one of ordinary skill in the art, but care must be taken not to read limitations from the prosecution history into the claims. *See Markman*, 52 F.3d at 980 (the prosecution history, when in evidence, is of “primary significance” in understanding the claims). Expert testimony by a credible witness, particularly when supported by documentary evidence as discussed above, may be highly persuasive.

**VII. CONSISTENT WITH THE SUPREME COURT'S DECISION IN *MARKMAN v. WESTVIEW INSTRUMENTS, INC.*, 517 U.S. 370 (1996), AND OUR *EN BANC* DECISION IN *CYBOR CORP. v. FAS TECHNOLOGIES, INC.*, 138 F.3D 1448 (FED. CIR. 1998), IS IT APPROPRIATE FOR THIS COURT TO ACCORD ANY DEFERENCE TO ANY ASPECT OF TRIAL COURT CLAIM CONSTRUCTION RULINGS? IF SO, ON WHAT ASPECTS, IN WHAT CIRCUMSTANCES, AND TO WHAT EXTENT?**

There are several issues of law, such as enablement, on which the court or jury makes subsidiary findings of fact that are accorded deference. The Supreme Court in *Markman* recognized that “credibility judgments have to be

made about the experts who testify in patent cases.” *Markman*, 517 U.S. at 389. The Court also recognized that construction of terms of art have “evidentiary underpinnings” and that the district court ultimately must “ascertain whether an expert’s proposed definition fully comports with the specification and claims and so will preserve the patent’s internal coherence.” *Id.* at 390. Nonetheless, the Court found that even if claim construction involves mixed questions of law and fact, the resolution of these questions is entirely for the court and not the jury. *Id.* at 387-91.

It is therefore possible that findings made in the course of claim construction would involve questions of fact which are entitled to deferential review. It is difficult to generalize which findings are factual and not legal and thus entitled to deference, and rules should be developed in the context of specific cases raising these issues. Nevertheless, as discussed above, claim construction may involve consideration of expert testimony concerning the meanings of words as they would have been understood by those of ordinary skill in the art at the time of the invention. Thus, a finding based on extrinsic evidence as to what the meaning of a word was to those of ordinary skill in the art at the time of the invention should, in essence, be a finding of fact. As such, it would be appropriate to accord the finding deference under a clearly erroneous standard of



review. Fed. R. Civ. P. 52(a). However, the ultimate construction of the patent document, including for example application of canons of construction, an analysis of the structure of the language used in the patent documents, and the determination of which extrinsic evidence is most congruent with the intrinsic evidence, would remain issues of law subject to *de novo* review.

**VIII. IS CLAIM CONSTRUCTION AMENABLE TO RESOLUTION BY STRICTLY ALGORITHMIC RULES, *E.G.*, SPECIFICATION FIRST, DICTIONARIES FIRST, ETC.? OR IS CLAIM CONSTRUCTION BETTER ACHIEVED BY USING THE ORDER OF TOOLS RELEVANT IN EACH CASE TO DISCERN THE MEANING OF TERMS ACCORDING TO THE UNDERSTANDING OF ONE OF ORDINARY SKILL IN THE ART AT THE TIME OF THE INVENTION, THUS ENTRUSTING TRIAL COURTS TO INTERPRET CLAIMS AS A CONTRACT OR STATUTE?**

For the reasons set forth above, strictly algorithmic rules of the kind implied by some of the numbered questions should not be used. Claim construction is no more subject to strict algorithmic rules than would be other legal determinations. Rather, courts should begin with the intrinsic evidence, as understood by one skilled in the art at the time of the invention, and the claims should be interpreted by the court, based on this understanding, as informed by any other relevant and material extrinsic evidence or established canons of

construction. Isolated dictionaries and technical treatises are not always to be regarded as *per se* more persuasive on the issue of claim construction than is all other extrinsic evidence.

**CONCLUSION**


For the foregoing reasons, *amicus curiae* New York Intellectual Property Law Association requests that this Court maintain the above-discussed principles of claim construction.

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Dated: September 20, 2004

  
\_\_\_\_\_  
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**CERTIFICATE OF COMPLIANCE WITH *EN BANC* ORDER**  
**AND FEDERAL RULES OF APPELLATE PROCEDURE 29**  
**AND FEDERAL CIRCUIT RULE 29**

I hereby certify that this brief was produced using Times New Roman  
14 point typeface and contains 3739 words.

A handwritten signature in black ink, reading "Bruce M. Wexler". The signature is written in a cursive style with a horizontal line underneath.

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**PROOF OF SERVICE**

The undersigned hereby certifies that two copies of the foregoing  
BRIEF OF *AMICUS CURIAE* NEW YORK INTELLECTUAL PROPERTY  
LAW ASSOCIATION REGARDING THE ISSUE OF CLAIM  
CONSTRUCTION, 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  
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