

**THE PHILLIPS DECISION:
AFTER A FRENZY OF EXPECTATION, NOTHING NEW**

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On 12 July 2005, the much awaited opinion, *Phillips v. AWH Corp.*, ___ F.3d ___ (Fed. Cir. 2005), by the U.S. Court of Appeals for the Federal Circuit (Federal Circuit) issued. The *en banc* rehearing of *Phillips v. AWH Corp.*, 363 F.3d 1207 (Fed. Cir. 2004) resulted in over thirty *amici curiae* briefs and anxious patent practitioners and patentees. Many expected that the Federal Circuit would establish standards for construing claim terms including the extent to which intrinsic evidence, such as the patent specification, should be applied and if and when extrinsic evidence, such as dictionary definitions, should be used. After the “frenzy of expectation”, Judge Mayer noted in his dissent that the majority opinion in the Phillips Decision provides “nothing new, but merely restate[s] what has become the practice over the last ten years” for claim construction.

In the Phillips Decision, the Federal Circuit stated that the role of the specification in claim interpretation was discussed at length in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979-81 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996) and summarized in *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996) and *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, 381 F.3d 1111 (Fed. Cir. 2004). Nevertheless, and perhaps because of all the “frenzy”, the Federal Circuit stated, “What we said in those cases bears restating, for the basic principles of claim construction outlined there are still applicable, and we reaffirm them today.”

With respect to the use of dictionaries in claim construction, the Federal Circuit stated that their decisions warranted clarification. The following first provides a summary of the

basic principles of claim construction as restated by the Federal Circuit, then a summary of the Federal Circuit’s clarification on the use of dictionaries, and last a summary of the Federal Circuit’s claim construction of the claim terms at issue in the Phillips cases:

1. SUMMARY OF BASIC PRINCIPLES OF CLAIM CONSTRUCTION

A. It is “entirely appropriate for a court ... to rely heavily” on the specification.

- The claims of a patent define the invention to which the patentee has the right to exclude.
- Claim terms are generally given their ordinary and customary meaning.
- The ordinary and customary meaning is one which a person of ordinary skill in the art would understand at the effective filing date of the invention in context with the intrinsic evidence, e.g. the claims, the specification and prosecution history.
- The claims themselves and the context in which a term is used may be used to construe the scope and meaning of the claims.
- Other claims in the patent and differences among the claims may be used in claim construction (doctrine of claim differentiation).
- Claims must be interpreted in view of the specification.
- The specification is the primary basis for construing the claims.
- Special definitions given to a claim term, intentional disclaimers and disavowal of claim scope by the inventor evidenced by the specification may be used to give a term a meaning different from its ordinary and customary meaning.

B. The prosecution history should also be considered.

- The prosecution history may be used to evidence how the patent office and the inventor understood the patent.
- The prosecution history may be ambiguous and less useful for claim construction purposes.
- The prosecution history may be used to construe a claim to exclude any interpretation that was disclaimed during prosecution (doctrine of prosecution history estoppel).

C. Extrinsic evidence is less significant than intrinsic evidence, but may be used.

- Dictionaries and treatises may be used in claim interpretation.
- Expert testimony may be used to interpret claims.
- Conclusory, unsupported assertions by experts and expert testimony that contradicts the intrinsic evidence should be discounted.
- Extrinsic evidence are viewed as less reliable than intrinsic evidence when interpreting claims.

2. CLARIFICATION ON DICTIONARY USAGE

The Federal Circuit noted that the leading case which places more emphasis on dictionary definitions and less emphasis on intrinsic evidence is *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002) and then clarified the role of dictionary definitions as follows:

A. Placing emphasis on dictionaries and limiting the role of a specification is improper.

- The claim construction methodology in *Texas Digital* placed too much reliance on extrinsic sources, such as dictionaries, and too little on the specification and prosecution history.
- Limiting the role of the specification to serving as a check on the dictionary

definition of a claim term is improperly restrictive in claim construction.

- Assigning a limited role to the specification or requiring that any definition of claim language in the specification be express is inconsistent with case law.

B. Dictionary definitions can result in the absurd rather than a proper “ordinary meaning”.

- Dictionary definitions are problematic as the inquiry is focused on the abstract meanings of words rather than the meaning of claim terms in context as the proper view of the “ordinary meaning” of a claim term is that of the ordinary person skilled in the art after reading the entire patent.
- A general dictionary cannot overcome art-specific evidence of a claim term meaning.
- Even technical dictionaries and treatises are problematic because a dictionary editor has different goals than those of the inventor.
- Often inventions are novel such that words do not exist to describe it and dictionaries cannot keep abreast of inventors.
- Use of dictionaries and treatises can result in definitions that do not reflect the inventor’s requirement to distinctly set forth the invention as an ordinary artisan would understand.

C. Appropriate use of dictionaries is not precluded.

- Dictionary definitions may be used where they do not contradict with intrinsic evidence.
- Dictionary definitions may help to avoid reading limitations from the specification into the claim.

3. SUMMARY OF CLAIM CONSTRUCTION AS APPLIED IN THE PHILLIPS DECISION

The term “baffles” was at issue and claim 1 of U.S. Patent No. 4,677,798 (‘798 patent), which

is representative of the use of the term in the asserted claims, reads as follows:

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 . . . , sealant means . . . and further means disposed inside the shell for increasing its load bearing capacity comprising internal steel baffles extending inwardly from the steel shell walls.

The Federal Circuit agreed with the prior decision that the term “baffles” is not means-plus-function language since the claim specifically identifies “internal steel baffles as performing the recited function, and therefore agreed that “baffles” should not be limited to corresponding structures in the specification. The Federal Circuit then proceeded to construe the scope and meaning of “baffles”.

A. Examination of the critical claim language.

- The Federal Circuit examined the critical language of claim 1 of the ‘798 patent and noted that it imposes three requirements: (1) the baffles must be made of steel, (2) the baffles must be part of the load-bearing means for the wall section, and (3) the baffles must be pointed inward from the walls.

B. Use of Intrinsic Evidence to Confirm Stipulated Dictionary Definition.

- The parties stipulated that “baffles” refers to objects that check, impede, or obstruct the flow of something and the Federal Circuit looked to the intrinsic evidence to confirm that a person of skill in the art would understand this meaning as used in the ‘798 patent.
- The Federal Circuit then looked to the other claims in the ‘798 patent and used the doctrine of claim differentiation to conclude that “baffles” as provided in

claim 1, is not limited to baffles having the specific orientations specifically provided for in claim 2 and that doing such would result in claims directed to redundant subject matter.

- The Federal Circuit found that the specification supported the meaning of “baffles” as load-bearing objects that serve to check, impede, or obstruct flow.
- Since each claim need not be construed to achieve all the objectives recited in the patent, the Federal Circuit concluded that a skilled artisan would not understand the specification and claims of the ‘798 patent such that a “baffle” is only a structure extending inward from one of the wall faces at acute or obtuse angles, but not a “baffle” if the structure is at a right angle.
- With respect to the doctrine that claims should be construed to be valid, the Federal Circuit noted that the doctrine does not apply because the doctrine is invoked when the claim term is ambiguous and the term “baffles” is not ambiguous.

Since the Federal Circuit disagreed with the district court’s restrictive definition of “baffles”, it reversed the summary judgment of noninfringement and remanded the claims of infringement.

The Federal Circuit decided not to address whether the Federal Circuit should give deference to any aspect of a trial court’s claim construction, and if so, on what aspects, in what circumstances, and to what extent. Judge Mayer in his dissent, which Judge Newman joined, indicated that “adhering to the falsehood that claim construction is a matter of law devoid of any factual component” and that reviewing a trial court’s claim construction without any deference is absurd.

Thus, the possibility of another frenzy of expectation exists.



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