

INTELLECTUAL PROPERTY

Federal Circuit stresses ordinary meaning

In recent cases, the court has limited the narrowing of claims, often benefiting patent owners.

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"A PERFECT JUDGE WILL read each work of wit/With the same spirit that its author writ"—from *An Essay on Criticism*, Part II, by Alexander Pope.

Most people think that patent litigation is all about technology. It is not. Patent litigation is really about poetry. Patent litigation turns not on cogs, sprockets and gears, but rather on words. The poetry in patent litigation lies in the patent claim, which defines the protected invention. Like a poem, the claim often balances on just one word. Take out or add a word, and the meaning of the claim—and thus the scope of the protected invention—changes.

Over the last year, however, the U.S. Court of Appeals for the Federal Circuit, which hears all appeals of patent infringement cases and thus has a leading hand in shaping patent law, has issued rulings that, in effect, remove some of the poetry from patent litigation. Many of these rulings benefit patent owners by weakening typical defense tactics designed to narrow claim scope. These rulings also stop the use of poetic license to expand or contract the scope of patent claims. The Federal Circuit, perhaps trying to restore some of the technology and precision to patent litigation, is now attempting to give district court judges and litigants firmer, almost scientific, rules for construing claims.

The crux of patent litigation is claim construction. Claim construction is the process of interpreting the words of a claim to determine the scope of the legally protected invention. Often, litigants fight over the meaning of just one word. And that word may be a simple one that everyone thinks he understands. For

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example, in *Inverness Medical Switzerland GmbH v. Warner Lambert Co.*, 309 F.3d 1373 (Fed. Cir. 2002), the case turned on the disputed meaning of the preposition "on."

Specifically, the parties disputed whether a claimed chemical reagent could be found "on" a test strip used in home pregnancy tests even though the reagent did not lie on top of the strip but, naturally, soaked into the fiber of the test strip. The trial court had narrowly construed "on" to mean "in contact with the top or outer surface of said test strip." The Federal Circuit reversed, finding that "on" could also mean that the reagent was impregnated within the strip. *Id.* at 1377, 1379. Such dispute over simple English words takes patent litigation out of the world of Thomas Edison and into the world of the lexicographer Samuel Johnson.

Patent litigation is open to such seemingly absurd semantic disputes because, as the U.S. Supreme Court recently observed, "[t]hings are not made for the sake of words, but words for things." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002) (quoting *Autogiro Co. of America v. United States*, 384 F.2d 391, 397 (Ct. Cl. 1967)). That is, words lag behind invention and thus may not fully capture the inventor's fresh concepts. Also, words, unlike engineering tolerances or chemical formulae, are imprecise. Litigants seize on the imprecision of language to twist the scope of claims to their advantage.

The 'Markman' ruling

The Federal Circuit first attempted to instill more certainty into claim construction in 1995, when it held that claim construction is for the judge alone. *Markman v. Westview Instruments Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996). Before then, claim construction more closely resembled contract interpretation in which juries settled

the meaning of ambiguous terms based on after-the-fact testimony.

But many feel that *Markman* has not yet led to the hoped-for certainty in claim construction. Indeed, Federal Circuit Judge Randall Rader noted that in the three years after *Markman*, the Federal Circuit reversed 40% of district court claim constructions. To Rader, that high reversal rate reflected the Federal Circuit's dissatisfaction with claim construction battles in the district courts and showed there was still little certainty in the claim-construction process. See *Cybor Corp. v. FAS Techs. Inc.*, 138 F.3d 1448, 1476 (Fed. Cir. 1998) (Rader, J., dissenting in part).

Some of this uncertainty may result from seemingly inconsistent guidelines on claim construction. For example, in *Markman*, the Federal Circuit stated that one should read a claim in light of the patent specification, which

serves as a sort of dictionary to define the claim wording. But the court has also cautioned that one cannot read limitations into the claims from the specification.

Comark Communications Inc. v. Harris Corp., 156 F.3d 1182 (Fed. Cir. 1998).

Starting in the spring of 2002, however, the Federal Circuit has begun reconciling these conflicting guidelines by spelling out exactly when and how claims may be confined to embodiments in the specification or prosecution history. See *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359 (Fed. Cir. 2002), and *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313 (Fed. Cir. 2002).

Limited narrowing

First, in trying to make claim construction more science and less art, the Federal Circuit established a "heavy presumption" that a claim term has its ordinary meaning to those of ordinary skill in the art. Thus, if the disputed claim term does not include a narrowing modifier, a court cannot add one. *CCS Fitness*,

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Ordinary meaning of terms will prevail.

288 F.3d at 1366, 1367.

In *CCS Fitness*, the litigants disputed the term “reciprocating member,” as used in a patent for an elliptical trainer exercise device. The defendant argued that because the specification’s single illustration showed a straight, one-piece member, the term must be confined to straight, one-piece members. The defendant’s accused elliptical trainer had a curved member made from two pieces. Because the claim did not include words specifying whether the member must be straight or curved, one piece or two, and because the ordinary meaning of “member” permitted both interpretations, the court would not narrow the ordinary meaning, and thus reversed summary judgment of noninfringement. *Id.*

The Federal Circuit then clarified when one can use the specification to narrow the claim. An accused infringer can overcome the “heavy presumption” and rely on the specification to narrow a term’s ordinary meaning in only four instances. The first instance is when the inventor acts as his own lexicographer and expressly and clearly defines a term. The specification must state, for example, “As used in this patent, the term ‘widget’ means...”

The second instance is when the specification or prosecution history contains an express disclaimer of claim scope. In other words, the inventor states in the specification or prosecution history that this invention does not cover a certain embodiment, that a particular embodiment is important to his invention or that there is only one way to build the patented invention.

Third, if the term deprives its claim of a clear meaning, then one can resort to the specification for clarification.

Fourth, use of a so-called means-plus-function term (e.g., “a means for attaching said cog to said sprocket”) confines the term to the corresponding structure described in the specification and its equivalents. See 35 U.S.C. 112, ¶ 6.

Ordinary meaning standard

In *Teleflex*, the Federal Circuit made this presumption of ordinary meaning even heavier. The *Teleflex* court held that a claim term keeps its ordinary meaning unless the specification or prosecution history shows that the inventor intended to depart from that ordinary meaning by “using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.” *Teleflex*, 299 F.3d

at 1327.

The Federal Circuit has echoed and reinforced *CCS Fitness* and *Teleflex* in a number of decisions over the last year. See, e.g., *Apex Inc. v. Raritan Computer Inc.*, 325 F.3d 1364, 1377 (Fed. Cir. 2003) (claim terms not limited to only embodiment shown in specification because the patent contained no express words of manifest exclusion or restriction); *Beckson Marine Inc. v. NFM Inc.*, 292 F.3d 718, 724 (Fed. Cir. 2002) (term not limited to specific shape or dimensions shown in patent drawings). These cases make it more difficult for accused infringers to argue, as they often do, that material in the specification or prosecution history limits the scope of the claims.

Most recently, the Federal Circuit extended *CCS Fitness* and *Teleflex* when it emphasized that an inventor’s statements during patent prosecution disclaim the ordinary meaning of a disputed term only if the disclaimer is “clear and unmistakable.” *Omega Eng’g Inc. v. Raytek Corp.*, 334 F.3d 1314, 1325-26 (Fed. Cir. 2003). In that case, the inventor clearly and unmistakably narrowed the claim to distinguish prior art raised by the patent examiner. But the disclaimer was not so broad as the accused infringer wanted and thus did not help it escape infringement. Thus, to benefit an accused infringer, the alleged disclaimer must not only clearly disclaim the ordinary meaning of a disputed term, but it must also disclaim the particular accused embodiment.

Reference books

As the *CCS Fitness/Teleflex* line of cases shows, the Federal Circuit will no longer tolerate litigation-inspired attempts to limit the ordinary meaning of claim words. But how to get at that ordinary meaning? That’s where dictionaries come in. More and more, the Federal Circuit is encouraging district court judges to consult dictionaries to learn the ordinary meaning of disputed words.

Dictionaries, along with encyclopedias and treatises that were publicly available when the patent issued, reliably and objectively inform the ordinary meaning of claim words. *Texas Digital Sys. Inc. v. Telegenix Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002). Indeed, such reference works “may be the most meaningful sources of information to aid judges” in understanding the patented technology. One startling aspect of the *Texas Digital* decision was the statement that a dictionary is not extrinsic evidence and is not really evidence at all. Rather, a court may

consult a dictionary to learn the ordinary meaning even if neither litigant offers the dictionary definition into evidence.

Moreover, as the Federal Circuit recently emphasized, a court may consult a dictionary at any stage of the litigation and at any stage of the claim-construction process, even before consulting the specification and prosecution history. *Intellectual Property Development Inc. v. UA-Columbia Cablevision of Westchester Inc.*, 336 F.3d 1308 (Fed. Cir. 2003).

But what kind of dictionary to use? A consensus is forming now that courts and litigants should consult English language dictionaries for plain English words—like “on” in the *Inverness* case—and technical dictionaries for technical jargon used in claims. See, e.g., *Inverness Med. Switzerland GmbH v. Princeton Biomeditech Corp.*, 309 F.3d 1365, 1369 (Fed. Cir. 2002) (standard English dictionary will give the proper definition in most cases); *Transclean Corp. v. Bridgewood Services Inc.*, 290 F.3d 1364, 1375 (Fed. Cir. 2002) (technical dictionary is better when the term is used in a technical context).

Since *Texas Digital*, the Federal Circuit has relied on dictionary definitions in almost every new reported decision. This reliance on dictionaries may be the Federal Circuit’s attempt to introduce more objective evidence into claim-construction fights and to halt the litigants’ word games before they start. Furthermore, use of technical dictionaries helps restore technology to patent litigation.

But resort to dictionaries may actually open the door to more poetry and less science. As the Supreme Court noted, the “dictionary does not always keep abreast of the inventor.” *Festo Corp.*, 535 U.S. at 731. Perhaps recognizing that dictionaries may not always lend precision to claim construction, the Federal Circuit cautioned that resort to a dictionary is merely the first step in the process. When it comes down to it, nothing beats a close analysis of the claim wording, the surrounding text, the specification and the prosecution history. *Brookhill-Wilk I LLC v. Intuitive Surgical Inc.*, 334 F.3d 1294, 1300 (Fed. Cir. 2003). Of course, close analysis of text is a job for poets. **NLU**

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Judges are urged to consult a dictionary.