

Can Patents Overcome Their Defining Problem?

Federal Circuit plans to clarify role of dictionaries vs. intrinsic evidence in claim construction.

By David M. Farnum

The concept of consulting a dictionary to define a word in a patent claim is simple. The practice of consulting a dictionary—and thereby determining a definition—is not.

In an effort to clarify this area of claim construction, the U.S. Court of Appeals for

them as the primary source for the interpretation of claims.

LOOK IT UP, PLEASE

The court's decision two years ago in *Texas Digital Systems Inc. v. Telegenix Inc.* (2002) stands out as a landmark. While previous decisions had recognized that dictionaries could be used to construe claims, *Texas Digital* went much further. In particular, it rejected the view that dictionaries should be characterized as mere extrinsic evidence, indicated a presumption in favor of using a dictionary to discern the ordinary meaning of claim terms, and suggested that consulting intrinsic evidence prior to consulting a dictionary "invites a violation of our precedent counseling against importing limitations into the claims." Not surprisingly, these pronouncements led both litigants and courts to place a new emphasis on the use of dictionaries.

But *Texas Digital* raised as many, if not more, questions than it answered. Less than a year later, another Federal Circuit panel, including two of the same three judges, sought to clarify *Texas Digital* by noting that consulting "abstract dictionary

definitions" alone is not sufficient. The court in *Brookhill-Wilk 1, LLC v. Intuitive Surgical Inc.* (2003) ruled that consulting a dictionary is "simply a first step in the claim construction analysis" and "resort must always be made to the surrounding text of the claims in question, the other claims, the written description, and the prosecution history."

Despite *Brookhill*, the proper relationship between dictionaries and intrinsic evidence in claim construction remains far from clear. Already this year, two Federal Circuit cases have reached strikingly different results. First, on April 2, in *Novartis Pharmaceuticals Corp. v. Eon Labs Manufacturing Inc.*, a divided panel held that when dictionary definitions disclose a range of possible meanings, intrinsic evidence should be consulted to determine which relevant meaning to rely on. But in *Nystrom v. Trex Co.*, another divided panel ruled on June 28 that where competing dictionary definitions exist, *Texas Digital* requires use of the broadest definition that is not inconsistent with the intrinsic evidence.

A BAFFLING CASE

Yet, as demonstrated by the April 8

Final Judgment

the Federal Circuit will soon consider *en banc* the use of both technical and general purpose dictionaries in the case of *Phillips v. AWH Corp.*

Since its *en banc* decision in *Markman v. Westview Instruments Inc.* (1995), declaring that dictionaries are forms of extrinsic evidence that may be used to aid "the court's understanding of the patent," there has been a notable shift in the Federal Circuit's position on dictionaries. Increasingly, the court has come to rely on

panel decision in *Phillips*, determining what the intrinsic evidence indicates about a given dictionary definition is not always easy. In *Phillips*, the court wrestled with the interpretation of the term “baffle” as used in a claim for vandalism-resistant modular wall panels.

After relying on Webster’s Third New International Dictionary to rule that the ordinary meaning of “baffle” is “something for deflecting, checking, or otherwise regulating flow,” the majority determined that the intrinsic evidence required that “baffle” be construed to refer only to baffles oriented at an angle other than 90 degrees to the wall face. The majority’s imposition of this additional limitation rested upon its belief that the stated purpose of the invention and clear descriptions in the patent all required baffles oriented at an angle other than 90 degrees. In contrast, the dissent strongly argued that the intrinsic evidence did not support deviating from the plain and ordinary meaning of “baffle” as agreed upon by the parties and defined in Webster’s.

DICTIONARY POWER

While a number of amici, including the Patent and Trademark Office, have argued for a very limited role for dictionaries, it is not clear that the Federal Circuit, given the recent trend in its decisions to rely heavily on dictionaries, will use its *en banc* reconsideration of *Phillips* to diminish their use significantly. Indeed, none of the judges appears to be a vociferous opponent of dictionaries playing a major role. The judicial differences focus more on the relationship between dictionary definitions and intrinsic evidence as sources for claim construction.

To some extent, this issue represents a recasting of the long-standing quandary of how to interpret claim terms without impermissibly importing limitations not present in the claims. Relying on dictio-

nary definitions to determine the ordinary meaning of terms, though, provides an arguably firmer ground for not deviating from that meaning.

If the Federal Circuit resolves the relationship between dictionaries and intrinsic evidence by emphasizing the latter, much case law already addresses the difficulties of using intrinsic evidence as the primary source for claim construction. But if dictionaries are emphasized, given that the Federal Circuit has only recently focused on them as primary sources, courts and litigants can expect a whole new range of issues.

For example, although dictionaries may appear to provide certainty and authority, the fact is that they often contain multiple definitions of a term, and different dictionaries may provide different definitions. The choice of which dictionary to use as the primary source can significantly affect the outcome of a case. Indeed, in the *Novartis* decision earlier this year, the dissent contended that had the majority simply used a different dictionary as its starting point, it could not have pursued the reasoning of its claim construction argument.

Further complicating this issue is that courts have not been restricted to relying only on dictionaries that have already been made part of the record in the case. As such, litigants do not necessarily have the opportunity to offer their views on differing definitions.

MULTIPLE CHOICE

The Federal Circuit has also not drawn a strong distinction between general purpose dictionaries and technical treatises. While in some cases, clearly relevant definitions may appear only in technical sources, in other cases, a term’s meaning can be found in both a general purpose and a technical dictionary.

Moreover, the choice of which technical

treatise is an appropriate reference depends on the “field of the invention.” While a determination of that field is routinely made in patent cases, it is not always an unambiguous decision. Even once the field is determined, the question remains as to which technical sources are the primary, respected sources in that field.

A final potential issue concerns the effect of a patentee’s use of a particular dictionary to define terms during prosecution of the patent application. For example, should there be a presumption in favor of using a particular dictionary if the patentee relied on it to describe one or more terms in prosecution? Although this argument is facially appealing, it may not be a good idea to require patentees during prosecution to identify a single dictionary, or even multiple dictionaries, as *the* source for interpreting their claims. For common, nontechnical terms, the patentee may not even be able to find a single source that provides all proper definitions.

Further, as claims often change substantially during prosecution, patentees could find themselves encumbered with meanings they did not intend. A requirement that patentees be constantly vigilant during prosecution to update dictionary sources may be unduly cumbersome and inefficient.

As these questions demonstrate, the outcome of *Phillips* may signify only the beginning of a new round of debate over how to construe patent claims. While more guidance regarding claim construction principles is needed, the decision to emphasize either dictionaries or intrinsic evidence is unlikely to put an end to the uncertainty that inherently bedevils claim construction. ■

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