
In a highly-anticipated recent en banc decision, Phillips v. AWH Corp., the Federal Circuit addressed a variety of issues relating to how courts should interpret patent claims. The court had requested briefing on no less than seven distinct issues relating to claim interpretation, and received over 30 amicus briefs on those issues. While the court’s decision is not groundbreaking, the opinion confirms the court’s prior guidance on claim construction set forth in its previous Markman, Vitronics, and Innova decisions. Of particular note, the en banc Phillips decision clarifies the court’s prior Texas Digital opinion by rejecting the position that dictionary definitions may take primacy over the description of an invention in patent’s specification. In general, while recognizing that claim construction may be based on both intrinsic evidence (a patent’s claims, specification and prosecution history) and extrinsic evidence (such as dictionaries and treatises), the court clarified that intrinsic evidence, especially the description of an invention in a patent’s specification, is the “primary basis” and “best source” for understanding a claim term. As such, extrinsic evidence should only be considered in the context of the intrinsic evidence. However, the Federal Circuit declined “to provide a rigid algorithm for claim construction,” but instead, “simply attempted to explain why, in general, certain types of evidence are more valuable than others.”

The Federal Circuit started its decision with the "bedrock principle" that "the claims of a patent define the invention to which the patentee is entitled the right to exclude.” It went on to explain that "[i]n some cases,
the ordinary meaning of claim language as understood by a person of skill in the art may be readily apparent even to lay judges, and claim construction in such cases involves little more than the application of the widely accepted meaning of commonly understood words." In those cases, "general purpose dictionaries may be helpful." However, where the meaning "requires examination of terms that have a particular meaning in a field of art," courts may have to review sources such as the "words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art."

The Federal Circuit explained that all of the various forms of intrinsic evidence -- the language of the claim in question, the language of other claims, the written description of the invention in the specification, and the prosecution history -- may have relevance to claim construction. For instance, the court stated that it is "entirely appropriate" for a lower court to "rely heavily" on the written description for guidance as to the meaning of claim terms. However, the court noted that "because the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the specification and thus is less useful for claim construction purposes."

The court also explained that extrinsic evidence -- "which consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises" -- may also be relied upon in the analysis. For example, the court stated that expert testimony may be useful for a variety of purposes. These include "to provide background on the technology at issue, to explain how an invention works, [and] to ensure that the court’s understanding of the technical aspects of the patent is consistent with that of a person of skill in the art.” Of particular note, the court recognized that expert testimony may be used “to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field.”
Although the court cautioned that “conclusory, unsupported assertions by experts as to the definition of a claim term are not useful to a court,” this recognition clarifies that expert testimony is not limited solely to providing a technical background, but may take the form of a direct opinion on the meaning of a claim term.

However, the court cautioned that in general extrinsic evidence is "less significant than the intrinsic record in determining the legally operative meaning of claim language." As the court explained, extrinsic evidence is generally "less reliable than the patent and its prosecution history in determining how to read claim terms." First, it is not created at the time of the patent. Second, extrinsic publications may not be written by or for skilled artisans. Third, expert reports and testimony is generated for litigation and may be biased. Fourth, there is a "virtually unbounded universe" of potential extrinsic evidence requiring the court to filter through the materials. Fifth, undue reliance on extrinsic evidence poses the risk that it will be used to change the meaning of claims. In sum, "extrinsic evidence may be useful to the court, but it is unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence." Hence, the court admonished lower courts to "keep in mind the flaws inherent in each type of evidence and assess that evidence accordingly."

In that context, the court explained that the Texas Digital case "placed too much reliance on extrinsic sources such as dictionaries, treatises, and encyclopedias and too little on intrinsic sources, in particular the specification and prosecution history." In particular, the court faulted the Texas Digital decision for suggesting a methodology whereby the specification is consulted "only after" a determination is made as to the meaning of disputed claim terms based on extrinsic evidence. It explained that such an approach improperly "limits the role of the specification in claim construction to serving as a check on the dictionary meaning of a claim" rather than serving as the focus "at the outset" of the analysis.

This update is published by members of the Patent Prosecution Group of Venable LLP. Venable publications are not intended to provide legal advice or opinion. Such advice may only be given when related to specific fact situations. © Copyright by Venable LLP 2005.
Applying these principles, the court reversed the lower court's claim construction of the claim term “baffle” and sent the case back for further proceedings. In addition, despite requesting briefing on the question of whether it is appropriate to accord any deference to any aspect of a trial court's claim construction rulings, the court ultimately declined to address that issue "at this time."

In a blistering dissent, Judge Mayer, joined by Judge Newman, denounced the "absurdity of [the] court's persistence in adhering to the falsehood that claim construction is a matter of law devoid of any factual component." According to Judge Mayer, "[w]hat we have wrought...is the substitution of a black box, as it so pejoratively has been said of the jury, with the black hole of this court." "[W]e say nothing new, but merely restate what has become the practice over the last ten years -- that we will decide cases according to whatever mode or method results in the outcome we desire, or at least allows us a seemingly plausible way out of the case." By treating claim construction entirely as a question of law (rather than a question of law based on underlying factual questions), Judge Mayer continued, the proceedings before the district court are "merely a tryout on the road." According to Judge Mayer, under that regime, it would be less "wasteful" to simply file patent cases directly with the Federal Circuit to decide claim construction issues.

While Phillips does provide some needed clarity regarding the role of certain types of evidence in claim construction, especially that of dictionaries, whether the decision will bring greater certainty to claim construction remains to be seen. Indeed, as acknowledged by Judge Lourie in a partial dissent, the en banc majority reversed the claim interpretation of the underlying panel decision, even though the majority of that panel had “implicitly decided the case based on the priorities that the en banc court has now reaffirmed, [including] interpret[ing] the claims in light of the specification.”
For further information please contact David Farnum (202.344.4650 or dmfarnum@venable.com) or Martin Saad (202.344.4345 or mlsaad@venable.com). Mr. Farnum is an associate in Venable’s Intellectual Property Group. He focuses on intellectual property litigation and is a member of Connecticut and District of Columbia bars. Mr. Saad also practices intellectual property litigation, as well as antitrust, advertising, and general commercial matters. He is an associate in Venable’s Copyright and Unfair Trade Practice Group and a member of the bar of District of Columbia, Illinois, the U.S. Court of Appeals for the Federal Circuit, and the U.S. Supreme Court.