

Federal Circuit Clarifies the Methodology for Performing Claim Construction

Phillips v. AWH Corp.
Federal Circuit (*en banc*) (July 12, 2005)

In a much anticipated *en banc* decision, the Court of Appeals for the Federal Circuit has clarified the procedure for performing claim construction. The court reaffirmed its *Markman* and *Vitronics* decisions and held that the specification is the “single best guide” to claim construction. The Court also rejected several of its prior holdings that the claim construction inquiry must begin with the broadest possible dictionary definition.

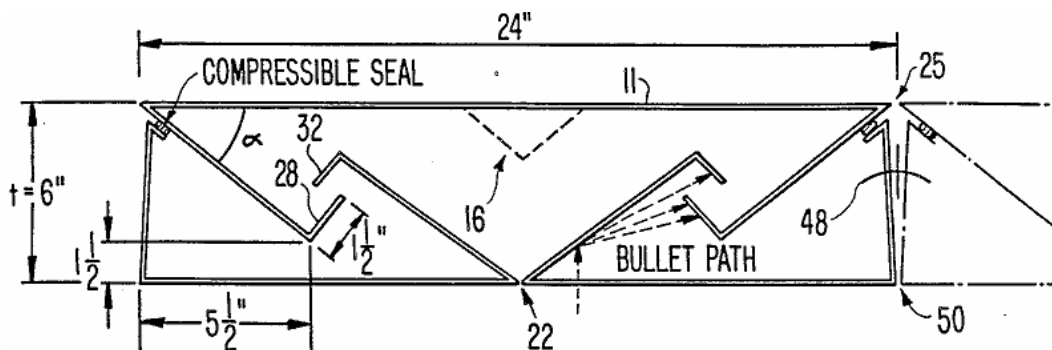
Background of Claim Construction

In 1995, the Federal Circuit held that claim construction “is a matter of law exclusively for the court.” *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 977 (Fed. Cir. 1995) (*en banc*). In the following year, the Court held that claim terms are construed from the viewpoint of one of ordinary skill in the art “on a reading of the patent documents” and that the patent specification “is the single best guide to the meaning of a disputed term.” *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1582-85 (Fed. Cir. 1996).

In 2002, the Federal Circuit seemed to take a contrary view, holding that “dictionaries . . . may be the most meaningful sources of information.” *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202-03 (Fed. Cir. 2002). The court set forth a methodology for construing claim terms that involved starting with the broadest possible dictionary definition and limiting that definition only if the specification revealed a special definition or an express disclaimer of claim scope. *Id.* at 1203. The court explained that consulting the intrinsic evidence first “invites violation of our precedent counseling against importing limitations into claims.” *Id.* at 1204.

The Phillips Panel Decision

In 1997, Phillips sued AWH Corporation in the District of Colorado for patent infringement. The patent-in-suit involved vandalism-resistant walls for use in prison facilities. As shown below, the walls comprised two steel panels that contained baffles angled so as to deflect projectiles such as bullets from reaching the second panel.



Claim 1 recited “[b]uilding modules . . . comprising . . . internal steel baffles extending inwardly from the steel shell walls.” Although the parties agreed that the dictionary definition of baffles was “something for obstructing, impeding, or checking the flow,” AWH contended the baffles must be angled so as to deflect projectiles such as bullets. The district court agreed with AWH and entered summary judgment of non-infringement in its favor.

On appeal to the Federal Circuit, a panel consisting of Judges Lourie, Newman, and Dyk held that the specification’s repeated recital that the baffles are angled so as to deflect bullets was controlling and affirmed the district court’s claim construction. Judge Dyk dissented, explaining that he would have accepted the parties stipulated dictionary definition and believed that the majority improperly read limitations from the specification into the claim. On July 21, 2004, the Federal Circuit decided to rehear the case *en banc* and asked the parties and amici to brief the following seven questions:

1. 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?
2. If dictionaries should serve as the primary source for claim interpretation, should the specification limit the full scope of the 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 or 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?
3. 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?
4. 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?
5. 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?
6. 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?

7. Consistent with the Supreme Court’s decision in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 134 L. Ed. 2d 577, 116 S. Ct. 1384 (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?

Phillips v. AWH Corp., 376 F.3d 1382, 1383 (Fed. Cir. 2004). Oral argument was held on February 6, 2005.

The En Banc’s Court’s Approach to Claim Construction

On July 12, 2005, the Federal Circuit issued the opinion of the *en banc* court. *Phillips v. AWH Corp.*, No. 03-1269, -1286 (Fed. Cir. July 12, 2005) (*en banc*). Although the court had initially asked the parties and amici to brief seven questions, the question it presented in its opinion was: “[t]o what extent should we resort to and rely on a patent’s specification in seeking to ascertain the proper scope of claims?” Slip Op. at 7. It quickly answered that question by referring to its prior decisions in *Markman* and *Vitronics*: courts must give claims terms the meaning they would have to one of ordinary skill in the art after reading the claim term “in the context of the entire patent, including the specification.” *Id.* The court further held that a claim is given its ordinary meaning “at the time of the invention, i.e., as of the effective filing date of the patent application.” *Id.* at 9. The court also held that all sources of evidence showing a term’s ordinary meaning should be considered including the claims, specification, prosecution history, and extrinsic evidence. *Id.* at 11.

The Claims

The Federal Circuit first addressed the role of the claims. *Id.* at 12-13. It held that courts must look to the asserted claim as well as other asserted and unasserted claims. *Id.* at 12. As an example, the court noted that the asserted claim at issue calls for “steel baffles.” *Id.* Thus, the term baffles is not limited to something made of steel. Otherwise, the modifier “steel” would not be necessary. The court also reaffirmed the doctrine of claim differentiation, noting that an additional limitation in a dependent claim gives rise to a “presumption” that that limitation is not present in the independent claim. *Id.* at 12-13.

The Specification

The court next reaffirmed the role of the specification as set forth in its prior decision in *Vitronics*, stating “the specification ‘is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.’” *Id.* at 13. The court noted that the importance of the specification derives from the statutory requirement that the specification describe the invention in “full, clear, concise, and exact terms.” *Id.* at 15. The court also reaffirmed that the specification may reveal a special definition (*CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002)) or an intentional disclaimer or disavowal (*SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d

1337, 1343-44 (Fed. Cir. 2001)). *Id.* at 16. In sum, the court stated: “It is therefore entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims.” *Id.*

Prosecution History

The court also held that the prosecution history, including any cited prior art, may be evidence of how the patent office examiner and the inventor understood the patent. *Id.* at 17. However, the court held that because the prosecution history is an on-going negotiation, it is less useful than the specification for claim construction purposes. *Id.*

Extrinsic Evidence

The court next addressed the role extrinsic evidence, including dictionaries and expert testimony, plays in claim construction. *Id.* at 18-21. The court explained that extrinsic evidence may be admitted and considered, but that any weight given to extrinsic evidence must recognize its inherent flaws that make such evidence “less reliable” than intrinsic evidence:

- 1) it is not part of the patent, nor is it created at time of prosecution;
- 2) it may not be written by or for one of skill in the art;
- 3) it is often litigation driven;
- 4) it is unlimited, making it difficult to separate the fluff from the useful; and
- 5) there is a risk it will be used to change a claim’s meaning and thereby undermine the public notice function of the patent.

Id. at 20. As the court explained, “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.” *Id.* at 21.

Addressing The Court’s Prior Inconsistent Holdings

The court next discussed its decision in *Texas Digital* and similar cases that had adopted a presumption in favor of the broadest dictionary definition. *Id.* at 21-23. The court rejected that mode of analysis explaining that such an approach would “improperly restrict the role of the specification in claim construction.” *Id.* at 24. The court further held that the proper inquiry is not the abstract meaning of words, but the meaning of claim terms within the context of the patent. *Id.* at 25. While approving of *Texas Digital*’s goal of avoiding reading limitations from embodiments in the specification into the claims, *id.* at 28, the court held that the *Texas Digital* requirement that any definition in the specification be express is inconsistent with its prior rulings that the specification may define terms expressly or by implication, *id.* at 24.

The Role of Validity In Claim Construction

The court also held that the maxim that claim terms should be construed so as to preserve their validity is of limited utility. *Id.* at 36. The court noted that a claim’s validity is only considered when the meaning of a term is still ambiguous after consulting all available sources.

Id. Even then, validity considerations are only applicable to the extent a Patent Office Examiner would have recognized that one claim interpretation would have rendered the claim invalid or unallowable. *Id.* at 36-37. In other words, the validity argument must involve an issue within the knowledge of the Examiner, such as cited prior art or compliance with the enablement and definiteness requirements of section 112.

The Majority Decision

Based on the foregoing analysis, the *en banc* court held that the claim term “baffles” should be construed in accordance with the parties’ stipulated dictionary definition: “something for obstructing, impeding, or checking the flow.” *Id.* at 31. In particular, the court observed that dependent Claim 2 contains the additional limitation that the baffles are “disposed at angles for deflecting projectiles such as bullets able to penetrate the steel plates.” *Id.* at 32. Relying on the doctrine of claim differentiation, the court held that it would be improper to construe Claim 1 to require the additional limitation expressly set forth in Claim 2. *Id.* Recognizing that the specification discusses baffles angled to deflect bullets, the court explained that those discussions referred to Claim 2 and other claims that required that the baffles deflect bullets. *Id.* at 33. The court held that not every claim must meet every objective set forth in the specification, especially where, as here, there are multiple objectives set forth in the specification. *Id.* at 35. Finally, the court held that the validity maxim did not apply because there is no ambiguity in the meaning of baffles. *Id.* at 37. Thus, the court reversed the panel’s and the district court’s claim construction and remanded for proceedings consistent with its claim construction. *Id.*

The *en banc* court explained that it did not intend to address Question 7, which related to whether the district court was entitled to deference in its claim construction. *Id.* at 38.

The Dissents:

Judges Lourie and Newman, the original majority panelists, joined the portion of the court’s opinion resolving the relative weights of the specification and dictionaries in favor of the specification, but dissented from the court’s decision to reverse the district court’s claim construction. Lourie Dissent at 1. Judge Lourie explained that, in his view, the specification’s repeated reference to angled baffles that deflect bullets should have been controlling. *Id.* at 3. Judge Lourie stated that reasonable minds could differ on the applicability of claim differentiation in this case and that the court should have affirmed the district court’s claim construction in the absence of a strong conviction of error. *Id.* at 2-3.

In a strongly worded dissent, Judges Mayer and Newman attacked the majority’s decision not to overturn its *en banc* decision in *Cybor* that claim construction is a matter of law devoid of any factual component. Judge Mayer concluded that “any attempt to fashion a coherent standard under this regime is pointless.” Mayer Dissent at 1.

Future Considerations

Only time will tell whether the court’s *Phillips* decision will improve the consistency in claim constructions across the district courts, or reduce the perception that the Federal Circuit’s

claim constructions are panel-dependent. However, it is clear that the Federal Circuit's recent approval of presumptively adopting the broadest dictionary definition absent an express disclaimer is no longer appropriate. Thus, without such a presumption in favor of dictionary definitions, claims may be construed more narrowly than they would have been pre-*Phillips*.

Patentees can, of course, avoid any uncertainty by defining important terms in the specification. The Federal Circuit's *Phillips* decision also places a premium on the careful drafting of the specification because terms may also be defined (and limited) unwittingly by implication. Given the court's renewed reliance on claim differentiation, it is also important to claim non-essential limitations in dependent claims in order to show the breadth of the independent claims. As always, patentees would be well-served to keep continuations alive.

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