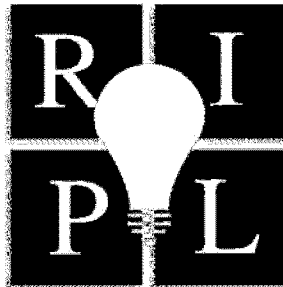


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PONDERING A “BAFFLING” SITUATION: THE “RECONSTRUCTION” OF CLAIM CONSTRUCTION

KAREN C. MITCH

ABSTRACT

Through an iterative use of the ordinary dictionary, claim construction would be more simple, cost effective and efficient in serving the public notice function of the claim. Since the decision in *Markman*, two divergent methods of claim construction have emerged; one referring to dictionary definitions first, the other referring to parts of the patent such as the specification first. Due to the confusion and differing outcomes the two methods bring about, there came a call by the United States Court of Appeals for the Federal Circuit for clarification. The recent en banc decision in *Phillips* reverted claim interpretation back to the method as set forth in *Markman*. However, a more efficient outcome of combining the two methods would have been desirable. This comment proposes an iterative process using a combination of both methods previously used in claim interpretation.

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PONDERING A “BAFFLING” SITUATION: THE “RECONSTRUCTION” OF CLAIM CONSTRUCTION*

KAREN C. MITCH**

INTRODUCTION

“It is a fundamental principle of . . . language itself . . . that the meaning of a word cannot be determined in isolation, but must be drawn from the context in which it is used.”¹

When the United States Supreme Court affirmed the United States Court of Appeals for the Federal Circuit’s (“CAFC”) decision in *Markman v. Westview Instruments, Inc.*, claim interpretation was put in the hands of the judiciary.² The standards for interpretation were left to the discretion of the court, requiring the court to set forth guidelines that would provide uniformity.³ As cases were decided, the standards began shifting until two different methods emerged.⁴ This created confusion among the courts, attorneys and patent holders.⁵

In the last decade, there has been little consistency in claim interpretation.⁶ The only thing that has been consistent is the CAFC’s reversal rate, which ranges

* George J. Awad & George A. Frank, *Fed Circuit Construction Project: Hard Hats Required*, THE LEGAL INTELLIGENCER, Aug. 25, 2004, at 5 (noting that in hearing the *Phillips* case en banc, the Federal Circuit is “seeking to bring some clarity to the claim construction confusion” through “a reconstruction of . . . the existing methodology”).

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¹ *Deal v. United States*, 508 U.S. 129, 132 (1993).

² 52 F.3d 967, 978, 979 (Fed. Cir. 1995) (concluding that claim interpretation is a matter of law for the court to decide, not for the jury), *aff’d*, 517 U.S. 370 (1996).

³ *Markman*, 517 U.S. 370, 390–91 (1996).

⁴ See Jennifer R. Johnson, Texas Digital, *the Indefiniteness of Language, and the Search for Ordinary Meaning*, 44 IDEA 521, 522–24, 527–29 (2004). But see Ruoyu Roy Wang, Texas Digital Systems v. Telegenix, Inc.: *Toward a More Formalistic Patent Claim Construction Model*, 19 BERKELEY TECH. L.J. 153, 153–54 (2004).

⁵ Johnson, *supra* note 4, at 521–22. Earlier cases concerning claim construction emphasized intrinsic evidence, whereas more recent cases have emphasized the use of extrinsic evidence to determine the ordinary meaning of claim terms. *Id.*

⁶ Brenda Sandburg, *Court Set to Enter Defining Conflict for Patent Bar*, THE RECORDER, July 22, 2004, at 1. Michael Barclay, a partner at Wilson, Sonsini, Goodrich & Rosati said that with regard to reading patent claims “[a]ll district judges and practitioners have been tearing their hair out The problem is that three-judge panel cases have been all over the map. There have been no consistent guidelines.” *Id.* Conflicting opinions by the court seem to be at the heart of the problem. *Id.* Many hope the decision in *Phillips* will answer the question of when and if a dictionary should be used in claim interpretation. *Id.*

between thirty and forty percent.⁷ Since *Markman*, a decade ago, the CAFC has applied two diverging standards to claim interpretation.⁸ One line of cases holds that the claim specification should be referenced to determine the meaning of terms in dispute, resorting to dictionaries only if ambiguities remain.⁹ The other line of cases holds that claim terms should be interpreted by their ordinary meaning as found in a relevant trade dictionary and only then should the language within the specification itself be referenced for guidance.¹⁰

Without a settled precedent for claim interpretation, district courts and attorneys alike had no clear methodology for interpreting or drafting the claims respectively.¹¹ As such, the public notice function of the patent system became ineffective and in turn failed to prevent infringement.¹²

A new standard for claim construction was thought to sit on the not so distant horizon when the CAFC ordered that the matter of claim interpretation be settled once and for all.¹³ The CAFC was searching for an answer to a problem that had muddled patent litigation for the last decade: How does a court properly interpret the claim language in a patent?¹⁴ In the matter of *Phillips v. AWH Corp.*, the CAFC

⁷ See Christine Hines, *Court Mulls Way to Interpret Patent Terms; Phillips' May Be Biggest Claims Interpretation Case Since Markman*, NAT'L L. J., Aug. 16, 2004, at 10 (stating that between thirty and forty percent of all claim construction cases are reversed by the CAFC); see also Brenda Sandburg, *Federal Circuit Tackles How to Define Patent Terms*, FULTON COUNTY DAILY REP., July 26, 2004, at 1 (quoting Michael Barclay that there is a fifty percent reversal rate of district court claim construction decisions).

⁸ See, e.g., Hines, *supra* note 7, at 10.

Different panels of the Federal Circuit have split on how to approach the issue. One line of cases says that courts should rely primarily on dictionaries to define the terms of a patent unless the written description in the patent changes the "ordinary meaning" of the terms. Another line of cases takes the opposite approach and says the terms of a patent should be primarily defined by the inventor's written description and claims.

Id.

⁹ *Novartis Pharms. Corp. v. Abbott Labs.*, 375 F.3d 1328, 1334–35 (Fed. Cir. 2004); *accord Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582–85 (Fed. Cir. 1996).

¹⁰ *Honeywell Int'l, Inc. v. ITT Indus., Inc.*, 330 F. Supp. 2d 865, 876 (E.D. Mich. 2004) (implying that determination of the ordinary meaning of a word should be the start of the analysis); *accord Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989–90 (Fed. Cir. 1999); *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002); *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002); *Novartis Pharms. Corp. v. Eon Labs Mfg.*, 363 F.3d 1306, 1308 (Fed. Cir. 2004).

¹¹ Sandburg, *supra* note 6, at 1.

¹² See generally *SmithKline Beecham Corp. v. Apotex Corp.*, 365 F.3d 1306, 1328 (Fed. Cir. 2004) (Gajarsa, J., concurring). Judge Gajarsa noted in his concurring opinion that:

[u]nder normal circumstances, one of ordinary skill in the art should be able to read a patent, to discern which matter is disclosed and discussed in the written description, and to recognize which matter has been claimed. The ability to discern both what has been disclosed and what has been claimed is the essence of public notice. It tells the public which products or processes would infringe the patent and which would not.

Id.

¹³ Awad, *supra* note *, at 5 (noting that the decision in *Phillips* would result in providing judges, patent practitioners and patentees with "long-awaited insight" into this confusing practice).

¹⁴ See *id.*

declared it wanted to hear from trade organizations and other interested parties as to how to properly interpret a claim.¹⁵ The CAFC then decided the case en banc to determine the applicable standard for claim interpretation.¹⁶

This comment focuses on the problems confounding courts and attorneys alike in claim construction. The Background section will explore *Markman* and its progeny,¹⁷ leading up to the call for clarity and ultimate decision in *Phillips*.¹⁸ The claim

¹⁵ *Phillips v. AWH Corp.*, 376 F.3d 1382, 1383 (Fed. Cir. 2004). In the court’s order granting an en banc hearing, the court invited submission of amicus curiae briefs with respect to different issues, including in pertinent part:

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 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 of 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?

Id. The concurring judge also questioned if:

[c]laim construction [is] amenable to resolution by resort to strictly algorithmic rules, e.g., specification first, dictionaries first, etc.? Or is claim construction better achieved by using the order or tools relevant in each case to discern the meaning of terms according to the understanding of one of ordinary skill in the art at the time of the invention, thus entrusting trial courts to interpret claims as a contract or statute?

Id. at 1384.

¹⁶ See Steve Pollinger, *A Battle for Definitional Supremacy in Patent Language Disputes*, TEX. LAW., Sept. 27, 2004. See also Harold C. Wegner, DEVELOPMENTS IN PATENT LAW 2004, 4 J. MARSHALL REV. OF INTELL. PROP. L. 1, 3 (2004).

¹⁷ See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 975 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370 (1996); *Vitronics*, 90 F.3d at 1581–82; *Johnson*, 175 F.3d at 990; *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed. Cir. 2001); *CCS Fitness*, 288 F.3d at 1365–66; *Telegenix*, 308 F.3d at 1201–02, 1205; *Honeywell*, 330 F. Supp. 2d at 875; *Eon Labs*, 363 F.3d at 1308; *Phillips v. AWH Corp.*, 363 F.3d 1207, 1211 (Fed. Cir. 2004), *vacated*, 376 F.3d 1382 (Fed. Cir. 2004).

¹⁸ *Phillips v. AWH Corp.*, 376 F.3d 1382, 1383 (Fed. Cir. 2004); *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954, at *15 (Fed. Cir. July 12, 2005).

interpretation process as set out in *Markman* is reviewed, laying out the specific rules of interpretation that were declared therein. The Analysis section will discuss the two divergent lines of cases following the *Markman* decision, identifying the problems inherent in each line.

Finally, this comment will propose that in order for claim interpretation to be meaningful, the CAFC must unite these differing lines of cases. The CAFC must lay out rules that offer a clear roadmap which provides attorneys and judges alike with direction when interpreting claims. This solution assures consistency and serves to both uphold and clarify the public notice function of the patent system.

I. BACKGROUND

A. *Markman v. Westview Instruments, Inc.: Obtaining Landmark Status*

In 1996, in the *Markman* case, the United States Supreme Court declared that “the construction of a patent, including the terms of art within its claim, is exclusively within the province of the court.”¹⁹ The case has since become the landmark case in claim construction.²⁰

As *Markman* explains, one of a patent’s functions is to serve as notice to the public of the invention.²¹ This function is required by statute.²² If the patent does not include enough information to put the public on notice of the invention, it risks infringement without repercussion.²³ Since the patent is written from the position of a person having ordinary skill in the art (“PHOSITA”),²⁴ judges are required to interpret the language from that perspective.²⁵

Furthermore, a patent is required to contain precise terms that will allow a PHOSITA to make and use the invented product or method.²⁶ When confusion

¹⁹ *Markman*, 517 U.S. at 372 (affirming the Federal Circuit’s holding that interpretation of claim language is a question of law to be determined by the courts).

²⁰ The vast majority of cases since the decision in *Markman*, declaring the interpretation of claim language as a process for the court, have followed the interpretation standards set forth in that opinion. See, e.g., *Vitronics*, 90 F.3d at 1581–82; *Johnson*, 175 F.3d at 990; *Rexnord*, 274 F.3d at 1343–44; *CCS Fitness*, 288 F.3d at 1365–66; *Telegenix*, 308 F.3d at 1201–02, 1205; *Honeywell*, 330 F. Supp. 2d at 875; *Eon Labs*, 363 F.3d at 1308; *Phillips*, 363 F.3d at 1211.

²¹ See *Markman*, 517 U.S. at 373.

²² 35 U.S.C. § 112 (2000).

²³ 35 U.S.C. § 154(d)(1)(B) (2000) (stating that a patent holder is entitled to royalties from an infringer who had notice of the patent).

²⁴ See JANICE M. MUELLER, AN INTRODUCTION TO PATENT LAW 41 (2003). PHOSITA is an acronym commonly used to designate the hypothetical person having ordinary skill in the art. *Id.*

²⁵ *Id.*

²⁶ 35 U.S.C. § 112 (2000). In relevant part, the statute sets forth that:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support

results about the scope of the patent, and a court proceeding ensues, the terms set forth in the patent claim necessarily require interpretation.²⁷

In *Markman*, there was a claim dispute arising from the interpretation of the word “inventory.”²⁸ The CAFC declared that claim construction, which includes interpretation of the meaning and extent of disputed terms, is the first step in an infringement analysis.²⁹

The CAFC determined that in order to properly interpret a claim, the intrinsic record should be considered first.³⁰ This requires consulting the specification to determine if the meaning of terms may be deduced from the specification language.³¹ If clarity cannot be achieved through the language of the specification alone, then the court may consider outside sources, including dictionaries, to provide insight into the meaning of a term.³² Through this process, the meaning of a claim may be properly and objectively determined.³³

B. Diverging Views: The Decomposition of Claim Construction

As early as *Markman*, the CAFC raised concern over the need for consistency in interpretation of patent claims.³⁴ The CAFC’s concern was not unwarranted. As three-judge panels heard cases following what was considered to be the landmark case for claim interpretation, two divergent methods of interpretation unfolded.³⁵ The main dispute between these two methods concerned the use of extrinsic evidence, specifically dictionaries.³⁶

thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Id.

²⁷ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 974–75 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370 (1996).

²⁸ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 975 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370 (1996).

²⁹ *Id.* at 976 (stating that an infringement analysis entails two steps, the first being to determine the meaning and scope of the patent claims asserted to be infringed).

³⁰ See MUELLER, *supra* note 24, at 231. Intrinsic evidence is the part of the patent that is public record. *Id.* It includes the prosecution history and the patent itself. *Id.* It is important because this information is available as soon as the patent is issued. *Id.*; see also *Markman*, 52 F.3d at 979 (stating that in order to ascertain the meaning of claims, the court considers three sources: (1) the claims; (2) the specification; and (3) the prosecution history).

³¹ See *Markman*, 52 F.3d at 979. The case states that claims should be read “in view of the specification of which they are a part.” *Id.* The specification should necessarily contain a written description of the invention that enables a PHOSITA to make and use the invention. *Id.* “For claim construction purposes, the description may act as a . . . dictionary, which explains the invention” and defines terms. *Id.* The implication of this is that the specification language should be looked at first to interpret the meaning of a term. See *id.*

³² *Id.* at 981. However, the court noted extrinsic evidence is used only to enhance the court’s understanding of the patent itself, not to vary or contradict the terms found in the claims. *Id.*

³³ *Id.* at 986.

³⁴ *Id.* at 979.

³⁵ See Johnson, *supra* note 4, at 522–23; see also Sandburg, *supra* note 6, at 1.

³⁶ See MUELLER, *supra* note 24, at 231. Extrinsic evidence is defined as evidence that is not included in the claim itself. *Id.*; see also *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980

1. *Finding Meaning Within the Architecture*

The line of cases following the first method of how to deal with claim construction considers the specification language first in determining the meaning of disputed terms.³⁷ Under this method, the importance of the language itself is emphasized because it is specifically chosen by the patentee and the surrounding language can color the terms of the claim.³⁸ As such, this method attempts to reduce the need for any other sources outside the patent.³⁹

In *Vitronics v. Conceptoronic*, the CAFC was able to determine the intended meaning of the claim term from the specification, thus avoiding the use of any outside sources.⁴⁰ The CAFC noted that although there was no need to consider sources beyond the language of the specification in the case, it would have been acceptable to refer to extrinsic evidence, including dictionaries, if the meaning was not independently discernable from the patent.⁴¹ However, the CAFC stressed that the use of extrinsic evidence should be a last resort to define the meaning of the claim terms and should not be used for any purpose other than to provide an understanding of the language as used within the claim.⁴² In other words, a dictionary should not be used to define the meaning of a term unless absolutely necessary.⁴³

2. *Determining Meaning from a Dictionary (or Other Extrinsic Sources)*

The method of consulting the claim specification first, and only to extrinsic evidence if there is still ambiguity, has been repeated numerous times over the last

(Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996). However, the court states that “[e]xtrinsic evidence consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises. This evidence may be helpful to explain scientific principles, the meaning of technical terms, and terms of art that appear in the patent and prosecution history.” *Markman*, 52 F.3d at 980.

³⁷ *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Following *Markman*, *Vitronics* established another line of cases that has been consistently followed and propounds the idea that the intrinsic record should be looked at first to determine the scope of the claim language. *Id.* Only after the specification is exhausted should a dictionary be turned to, if at all, to aid in ridding the terms of any ambiguity. *Id.* at 1583.

³⁸ *Id.* at 1582 (stating that a patentee may define his own terms in any manner he chooses, whether they conform to the ordinary meaning or not).

³⁹ *Id.* at 1583 (reasoning that if the intrinsic record is able to resolve any ambiguity, then not only is there no reason to look to extrinsic evidence, but it is improper to do so).

⁴⁰ *Id.* at 1584 (concluding that when taken in the context of the patent specification, the term “solder reflow temperature” was unambiguous and no ambiguities remained; therefore, the trial court should have ended its analysis).

⁴¹ *Id.* at 1583 (“In construing the claims we look to the language of the claims, the specification and the prosecution history. Extrinsic evidence may also be considered, *if needed* to assist in determining the meaning or scope of technical terms in the claims.”).

⁴² *Id.* (reasoning that when there is no ambiguity in the public record, and the scope of the invention is fully described, the court should not look at extrinsic evidence to determine the meaning of a term).

⁴³ *See id.*

decade.⁴⁴ However, even with the procedures set forth in applicable case law, there has been some confusion in its application.⁴⁵ For instance, *Nystrom v. Trex Co.* required interpretation of the word “board”.⁴⁶ Although the majority opinion set out the governing rules for interpretation and stressed the need to consult the specification for the meaning of the term, the court did not follow those rules.⁴⁷ Instead, the majority went directly to the dictionary to determine the plain and ordinary meaning of the term.⁴⁸

This method of referring to a dictionary at the outset of the interpretation

⁴⁴ See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996) (claim language should be the foremost tool used for interpretation); see also *Vitronics*, 90 F.3d at 1582 (putting emphasis on drawing meaning of disputed terms from the claim specification); *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1341–42 (Fed. Cir. 2001) (advocating that the claim language should be investigated first, and if ambiguities still exist, dictionaries may be used to aid in interpretation); *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1201 (Fed. Cir. 2002) (claim construction should be the focus of interpretation); *Novartis Pharms. Corp. v. Abbott Labs*, 375 F.3d 1328, 1334 (Fed. Cir. 2004) (stating that claim language is the first place to look to determine the intended meaning of a term).

⁴⁵ Awad, *supra* note *, at 5 (“Although seemingly straightforward, the application of this methodology can be confusing Sometimes the Federal Circuit has accorded more weight to dictionary definitions than the patent specification and vice versa.”).

⁴⁶ *Nystrom v. Trex Co.*, 374 F.3d 1105, 1107 (Fed. Cir. 2004). In *Nystrom*, the patent specification described the invention as:

an exterior wood flooring board shaped to shed water from its upper surface while at the same time providing a surface on which it is comfortable to walk and stand [The] decking board . . . also yields a superior product when cut from a log, reducing the amount of scrap in the outermost boards cut from a log.

Id. The court proceeded to look to the dictionary for the definition of the term “board” and determined that a “board” is “an elongated, flat piece of wood or other rigid material.” *Id.* at 1112–14.

⁴⁷ *Id.* at 1111. The court stated:

We begin our claim construction analysis with the words of the claim In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves In the absence of an express intent to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning The ordinary meaning must be determined from the standpoint of a person of ordinary skill in the relevant art The ordinary and customary meaning may be determined by reviewing a variety of sources, including the claims themselves; dictionaries and treatises The ordinary and customary definition will be overcome if the patentee has acted as his or her own lexicographer in explicitly setting forth a definition of a claim term distinct from its ordinary meaning.

Id. The court strayed from these rules, however, in that they began by defining the term “board” through the use of a dictionary and then turned to the claim to make the dictionary definition fit.

Id. As the dissent argues, the consultation of the claim first to determine if the meaning of the term is ascertainable by the language within the claim is proper because “the description may act as a sort of dictionary.” *Nystrom*, 374 F.3d at 1123 (Gajarsa, J., dissenting).

⁴⁸ *Nystrom*, 374 F.3d at 1120 (Gajarsa, J., dissenting) (stating that the predicament in this case is that the majority stated the proper interpretation rules; however, instead of following the rules, the majority referred to the dictionary for the meaning of the word “board”). *Contra, Id.* at 1111 n.1 (declaring that the dissent is downplaying the statutory requirement of focusing on the words of the claims by stressing the importance of the written description and prosecution history).

process provides its own unique problems.⁴⁹ These include confusion when there are multiple definitions for a single term,⁵⁰ misinterpretation if the incorrect dictionary is used and a possible change away from intended meaning of the term that would be illustrated if the specification were referenced first.⁵¹ In addition, the ordinary meaning as provided by a dictionary may not be adequate to encompass the special meaning the patent requires.⁵² Thus, it may be improper to consult to dictionaries first.⁵³

C. Reconstruction Required

Patent statutes call for claim language to be clear and precise so that a PHOSITA can discern the correct meaning of terms within the claim.⁵⁴ The claim language not only serves to define the metes and bounds of the patent, but is also

⁴⁹ See Brenda Sandburg, *Pedantic Patent Reviews Panned*, THE RECORDER, Sept. 22, 2004, at 1. The amicus curiae brief filed by the U.S. Patent and Trademark Office (“PTO”) outlines the many problems with the court relying on dictionary definitions. *Id.*

⁵⁰ Dictionaries provide multiple definitions for the word “board”:

board n. 1. A long flat slab of sawed lumber; a plank. 2. A flat piece of wood or similarly rigid material adapted for a special use. 3. *Games* A flat surface on which a game is played. 4. The hard cover of a book. 5. boards A theater stage. 6a. A table, especially one set for serving food. b. Food or meals considered as a whole: *board and lodging*. 7. A table at which official meetings are held; a council table. 8. An organized body of administrators or investigators: *a board of trustees; a board of directors*. 9. An electrical–equipment panel. 10. *Computer Science* A circuit board. 11. *Sports* a. A scoreboard. b. A tote board. c. boards The wooden structure enclosing an ice hockey rink. d. A diving board. e. A surfboard. f. A snowboard. 12. *Basketball* a. A backboard. b. A rebound. 13. *Nautical* a. The side of a ship. b. A leeboard. c. A centerboard. 14. *Obsolete* A border or an edge. 15. A usually large, vertically positioned flat surface used for writing or posting, especially: a. A blackboard. b. A bulletin board . . .

THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 203 (4th ed. 2000).

board /bawrd/ *n. & v.* 1 a flat thin piece of sawn lumber, usu. long and narrow. b a piece of material resembling this, made from compressed fibers. c a thin slab of wood or a similar substance, often with a covering, used for any of various purposes (*chessboard, ironing board*). d thick stiff cardboard used in bookbinding. 2 the provision of regular meals, usu. with accommodation, for payment. 3 *archaic* a table spread for a meal. 4 the directors of a company, any other specially constituted administrative body, e.g., a committee or group of councilors, examiners, etc. . . .

THE OXFORD AMERICAN DICTIONARY AND LANGUAGE GUIDE 100 (1999).

⁵¹ Sandburg, *supra* note 6, at 1 (quoting PTO General Counsel James Toupin stating that “[t]he increased reliance on dictionary definitions as a foundation for claim meaning has generated inconsistent and unpredictable results”). Generally, since there are so many dictionaries to choose from, the concern raised with dictionary use is that there are too many different definitions, thus the chosen definition may be too broad, or it may be too narrow. *Id.*

⁵² *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1203 (Fed. Cir. 2002) (reiterating that since dictionaries provide multiple definitions for words, some which are unrelated to the invention, intrinsic evidence must be considered to determine which of the dictionary definitions are consistent with the inventor’s intended definition).

⁵³ See *Telegenix*, 308 F.3d at 1203.

⁵⁴ *Id.*

where the problems begin.⁵⁵ Following *Markman*, the two differing methods that emerged to interpret claims showed a lack of concurrence on how to proceed with claim interpretation.⁵⁶ This made compliance with the public notice function of the statute difficult to achieve. Without one procedure for interpretation, the public will not know whether a court will consult the specification first to derive the meaning of terms or first refer to the ordinary meaning of the term via a dictionary. Hence, the public will be unsure of the viability of possible new inventions it wishes to create. Because the panels of the CAFC could not agree as to which came first, using a dictionary to ascertain the ordinary meaning of a word or consulting the language in the specification for clarification of ambiguous terms, there was uncertainty in the laws of claim construction.⁵⁷

Some of the underlying difficulties arise because it is unclear whether a dictionary is intrinsic or extrinsic evidence.⁵⁸ If dictionaries are extrinsic, they should only be consulted after considering the specification.⁵⁹ If they are not extrinsic, they can be an invaluable tool for the judge when determining how a PHOSITA might interpret the terms before referring to the specification, if at all.⁶⁰

Uncertainty in claim interpretation causes attorneys to spend extra time creating the claim language, costing their clients more money.⁶¹ The excess cost

⁵⁵ See MUELLER, *supra* note 24, at 14. Metes and bounds mark the boundaries of the statutory right to exclude others from making, using, selling, offering to sell, or importing the patented invention in the United States during the term of the patent. *Id.*

⁵⁶ See generally *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996) (claim language should be the foremost tool used for interpretation). Compare *Vitronics Corp. v. Conceptronc, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 2004) (putting emphasis on drawing the meaning of disputed terms from the claim specification), and *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed. Cir. 1999) (stating there is a heavy presumption that claim terms carry their ordinary and accustomed meaning, which is typically found in a dictionary), and *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1341 (Fed. Cir. 2001) (advocating that the claim language should be investigated first, and if ambiguities still exist, dictionaries may be used to aid in interpretation), and *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366–67 (Fed. Cir. 2002) (differentiating when the dictionary meaning results in the ordinary meaning and when the claim should be examined first), with *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1201, 1204 (Fed. Cir. 2002) (declaring claim construction should be the focus of interpretation; however, the terms of the claim carry the burden of a heavy presumption of the ordinary meaning), and *Honeywell Int'l, Inc. v. ITT Indus., Inc.*, 330 F. Supp. 2d 865, 876 (E.D. Mich. 2004) (stating that for analysis, dictionaries should be consulted prior to sifting through the claim language), and *Novartis Pharms. Corp. v. Eon Labs Mfg.*, 363 F.3d 1306, 1308 (Fed. Cir. 2004) (advocating the dictionary is the first place to look to determine the ordinary meaning of a term), and *Phillips v. AWH Corp.*, 376 F.3d 1382, 1382–83 (Fed. Cir. 2004) (calling for briefs to determine which interpretation approach is best).

⁵⁷ Sandburg, *supra* note 6, at 1.

⁵⁸ See MUELLER, *supra* note 24, at 231. Although dictionaries are literally extrinsic to the record, dictionaries might sometimes properly reflect the ordinary use of the information contained in the record. *Id.* This has led the courts to begin accepting use of dictionaries to aid judges in determining how a PHOSITA would interpret claim language. *Id.*

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ See AM. INTELL. PROP. L. ASS'N. 2003 Report of the Economic Survey 20, 22 (2003) [hereinafter AIPLA Report]. The tables on page 20 show the average charge for services range from \$200 for a maintenance fee to as much as \$10,001 for the original application of a relatively complex biotech/chemical patent. *Id.* at 20. The initial novelty search costs an average of \$1,500, with the

occurs in creating language that would satisfy both methods of interpretation.⁶² This, as well as confusion on the proper application of dictionaries to claim interpretation, led the CAFC to inquire what the proper methodology for claim interpretation should be in *Phillips*.⁶³

II. ANALYSIS

This section will discuss the two differing methods of claim interpretation that have emerged since *Markman*. It will closely analyze the how the methods prescribed in *Vitronics Corp. v. Conceptoronic, Inc.* (“*Vitronics*”) and *Texas Digital Systems, Inc. v. Telegenix, Inc.* (“*Telegenix*”) differ in the way the specification and dictionaries are applied in claim interpretation. Finally, the recent en banc decision in *Phillips* will be discussed.

A. *Specification as the Controlling Instrument for Claim Construction: Vitronics Corp. v. Conceptoronic, Inc.*

One year after *Markman*, the CAFC made a ruling in *Vitronics* that further established one method of claim interpretation.⁶⁴

In *Vitronics*, the CAFC considered the issue of claim interpretation in a patent infringement context.⁶⁵ The dispute was over the meaning of a “solder reflow temperature” limitation as used in describing the process of using ovens to solder electrical devices to printed circuit boards.⁶⁶ Vitronics Corporation (“Vitronics”) manufactured these ovens and owned U.S. Patent No. 4,654,502 (“the ’502 patent”).⁶⁷ The ’502 patent covered the method for soldering the devices to the boards.⁶⁸ Conceptoronic, Inc. (“Conceptoronic”), the alleged infringer, sold a similar

total cost of a non-provisional application for an invention that is minimally complex being \$5,504. *Id.* The tables on page 22 show the average expenses for patent litigation to range from \$500,000 for a suit involving less than \$1 Million at risk to \$3,995,000 for a suit involving more than \$25 Million at risk. *Id.* at 22.

⁶² See Hines, *supra* note 7, at 10. The author states that not only will this decision provide a clear and uniform method for interpretation, but that this will lead to a more cost effective way to construe and interpret patents. *Id.* From this, it is logical to deduce that the current system for claim interpretation is a labor intensive process, resulting in excessive attorney’s fees and inconsistent analysis. *See id.*

⁶³ *Phillips v. AWH Corp.*, 376 F.3d 1382, 1382 (Fed. Cir. 2004).

⁶⁴ See generally *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1585 (Fed. Cir. 1996).

⁶⁵ *Id.* at 1581–82.

⁶⁶ *Id.* at 1579. The patented process uses ovens to solder electrical devices such as capacitors, resistors and electrical devices to the circuit boards as they pass through on a conveyor belt. *Id.* at 1578–79.

⁶⁷ *Id.* at 1578.

⁶⁸ *Id.* at 1579. The pertinent part of the claim in dispute is as follows:

1. . . . moving said board through a third zone and in close proximity to a third emitting surface of at least one nonfocused infrared panel emitter, said third surface being at a third panel temperature higher than said second panel

line of ovens.⁶⁹ The issue discussed in this case was whether Conceptronic’s line of ovens infringed the ’502 patent.⁷⁰

Vitronics supplied the jury instructions at the trial level, which included a definition of the disputed term.⁷¹ While Vitronics asserted that the “solder reflow temperature” was the peak reflow temperature, Conceptronic asserted that the “solder reflow temperature” was 183 degrees Celsius (the liquidus temperature of a particular type of solder).⁷² Vitronics supported its arguments with the language of the specification.⁷³ Conceptronic derived its interpretation of the term through a memorandum obtained from Vitronics.⁷⁴

In determining the process for interpretation of the disputed terms, the CAFC relied on *Markman*, concluding that intrinsic evidence should be considered first since not only is the scope of the invention defined with it, but the specification, part of the intrinsic evidence, provides the best source for ascertaining the intended meaning of the disputed term.⁷⁵ Since a patentee may act as his own lexicographer, it is appropriate to consult the patent first to see if he has employed his own

temperature, said third emitting surface heating said board and said solder to a *solder reflow temperature* for a period of time sufficient to cause said solder to reflow and solder said devices to said board while maintaining the temperature of said devices below *said solder reflow temperature*.

Id.

⁶⁹ *Id.*

⁷⁰ *Id.*

⁷¹ *Id.* at 1579–80. The instruction given to the jury included the definition as being “the temperature reached by the solder during the period it is reflowing during the final stages of the soldering process, sometimes referred to as the ‘peak solder reflow temperature.’ It does not mean the ‘liquidus temperature,’ the temperature at which the solder first begins to melt.” *Id.*

⁷² *Id.* The type of solder Conceptronic referred to in obtaining this temperature is 63/37 (Sn/Pb) solder. *Id.*

⁷³ *Id.* at 1580–81. The part of the specification Vitronics referred to stated, in pertinent part: The solder may be, for example, 60/40 (Sn/Pb), 63/37 (Sn/Pb), or 62/36/2 (Sn/Pb/Ag), all which have a liquidus temperature (i.e. begin to melt) of about 190 degrees C. and a peak reflow temperature of about 210 degrees–218 degrees C. Thus, to effect reflow soldering without damaging the board, the solder must be allowed to reach a temperature of at least 210 degrees C., but the board cannot reach a temperature of 225 degrees C.

...
The board is then sent into a fifth zone 5 to bring the temperature of approximately 210 degrees C., the devices up to approximately 195 degrees C., and the solder up to approximately 210 degrees C. for a period of time of from about 10 to 20 seconds to cause the solder to flow. Because the devices are cooler than the board, the solder flows up the devices The board spends approximately 60 seconds in the fifth zone, but only about 10 to 20 seconds at 210 degrees C. Thus, the board is at the solder reflow temperature for only a short period of time and the devices never reach the solder reflow temperature.

Id. at 1580–81.

⁷⁴ *Id.* at 1581. This memorandum was used by Conceptronic because it referred to the “liquidus” and “reflow” temperature as being the same. *Id.* The court did not agree with this argument because the statement was in the background section of the memorandum and was defined differently later within the same document. *Id.*

⁷⁵ *Id.* at 1581–82.

definition, either explicitly or implicitly.⁷⁶ The statutory requirements⁷⁷ of the specification make it “highly relevant to the claim construction analysis.”⁷⁸ Ambiguities will usually be resolved by referring to the intrinsic evidence, negating the need for referring to extrinsic evidence.⁷⁹ The CAFC determined that if there are no remaining ambiguities in the language, it is improper to consult extrinsic evidence.⁸⁰

The underlying policy behind this method of interpretation is that claims must serve as notice to the public of the invention.⁸¹ The claims should therefore be interpreted as intended by the patentee, as indicated in the specification; otherwise, the meanings of the claims indiscriminately change, making the public notice function ineffective.⁸²

The CAFC held the term “solder reflow temperature” to mean the “peak flow temperature” rather than the “liquidus temperature” because it was distinctly defined as such within the specification.⁸³ By construing the term in this way, the public notice function was served because the language came directly from the patent itself; any other interpretation might have defeated the notice function.⁸⁴

The CAFC stressed that when ambiguities are resolved by consulting the intrinsic evidence, the analysis should stop there.⁸⁵ Extrinsic evidence should only be relied upon when ambiguities remain after consideration of the intrinsic evidence.⁸⁶ Furthermore, even when extrinsic evidence is used, it should only serve to aid in understanding the terms, not to refute or alter the claim language.⁸⁷ Such a method preserves the public notice function because an individual reading the patent would read only the patent documents, not extrinsic sources, to understand the patent.⁸⁸ The problem with extrinsic evidence is that when it is used for interpretation by the court, the public may not have access to the same sources the court uses.⁸⁹

⁷⁶ *Id.* at 1582 (stating that “a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification”).

⁷⁷ 35 U.S.C. § 112 (2000).

⁷⁸ *Vitronics*, 90 F.3d at 1582.

⁷⁹ *Id.* at 1583.

⁸⁰ *Id.* (stating that where the description of the scope of the patented invention in the public record is unambiguous, the intrinsic record should be referred to because that is what the public relies on).

⁸¹ *Id.* The definition of terms within the specification cannot be altered because it would defeat the public notice function. *Id.*

⁸² *Id.* (stating that “[a]llowing the public record to be altered or changed by extrinsic evidence introduced at trial, such as expert testimony, would make this right meaningless”).

⁸³ *Id.* at 1584.

⁸⁴ *Id.*

⁸⁵ *Id.* at 1583.

⁸⁶ *Id.* at 1584 (stating that “only if there were still some genuine ambiguity in the claims, after consideration of all available intrinsic evidence, should the trial court have resorted to extrinsic evidence”).

⁸⁷ *Id.* The court emphasized that “extrinsic evidence in general . . . may be used only to help the court come to the proper understanding of the claims; it may not be used to vary or contradict the claim language.” *Id.*

⁸⁸ *Id.* (declaring that another rule “would be unfair to competitors who must be able to rely on the patent documents themselves . . . in ascertaining the scope of a patentee’s right to exclude”).

⁸⁹ *Id.*

The decision of the trial court, which relied on extrinsic evidence to aid in determining an unambiguous term, was reversed by the CAFC.⁹⁰ This method was followed by the CAFC for six years until *Telegenix*, which viewed extrinsic evidence as a way to interpret a term before referring to the specification and determining the full scope of that term.⁹¹

B. Presumption in Favor of the Ordinary Meaning: Texas Digital Systems, Inc. v. Telegenix, Inc.

Unlike *Vitronics*, the *Telegenix* court began its interpretation by consulting a dictionary for the ordinary meaning of the term.⁹² Though the language of the specification was deemed to be important because it functions to specify the subject matter that is patented, the CAFC determined the claim term should be given the ordinary meaning of the word.⁹³ It also stated that one useful resource for determining the ordinary meaning of a claim term is the dictionary⁹⁴ because it provides an unbiased definition of terms.⁹⁵ More importantly, dictionaries provide the judge with information that can further his understanding of the terms as used for the applicable technology.⁹⁶

The CAFC found it acceptable to use sources such as dictionaries at any stage of the suit to aid in understanding claim terms.⁹⁷ It reasoned, however, that because dictionaries often provide multiple definitions for one term, intrinsic evidence still has significant value.⁹⁸ Only when taken in context can the true meaning be ascertained.⁹⁹ In yet another contradiction, however, the court stated if more than one definition is applicable, the terms may be construed as encompassing all of the definitions.¹⁰⁰

⁹⁰ *Id.* at 1585 (concluding that because the term in dispute was “clearly and unambiguously defined” within the specification, it was unnecessary for the lower court to rely on extrinsic evidence to aid in defining the term).

⁹¹ See *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002).

⁹² *Id.* at 1206, 1209. The terms “repeatedly substantially simultaneously activating”, “display areas” and “background area” were determined by first looking at the definitions in the relevant trade dictionary. *Id.* The CAFC then looked to the specification to determine if the dictionary definitions were proper. *Id.*

⁹³ *Id.* at 1201–02 (stating that although claim construction analysis must focus on the language of the claims, the terms used bear a “heavy presumption” that they have the meaning a PHOSITA would ordinarily attribute to the terms).

⁹⁴ *Id.* at 1202. Other useful resources include encyclopedias and treatises which aid the court to determine the “ordinary and customary meanings of claim terms.” *Id.*

⁹⁵ *Id.* at 1203. Extrinsic evidence, which includes dictionaries, is unbiased because it has not been subjected to outside influences such as expert testimony or motives of the parties. *Id.*

⁹⁶ *Id.*

⁹⁷ See *id.*; see also Wang, *supra* note 4, at 158. Wang states that “[d]espite, and perhaps in light of, the past confusion over dictionaries’ significance and exact role in claim construction, the *Telegenix* panel firmly and enthusiastically approved the use of dictionaries in claim construction.” *Id.*

⁹⁸ *Telegenix*, 308 F.3d at 1203.

⁹⁹ *Id.*

¹⁰⁰ *Id.*

The intrinsic record is also used to determine if the ordinary meaning of the word is rebutted.¹⁰¹ If the definition within the specification is inconsistent with the dictionary meaning, the meaning supported in the specification prevails and the dictionary meaning is disregarded.¹⁰² However, turning to the specification for the definition of a term first may import limitations into the claim, and the definition might be improperly constricted.¹⁰³ In addition, the dictionaries considered should be those that would have been relevant to the inventor.¹⁰⁴

For example, in *Telegenix*, to determine the ordinary meaning of the word “activating,” the CAFC began by consulting the Modern Dictionary of Electronics.¹⁰⁵ Because the specification did not rebut this definition, the dictionary meaning was applied.¹⁰⁶ Similarly, the CAFC used the Illustrated Dictionary of Electronics to determine that the terms “display” and “background” are not interchangeable when the ordinary meaning is considered.¹⁰⁷ The intrinsic record was consistent with this interpretation.¹⁰⁸

After the *Telegenix* decision, there has been no continuity in the way the CAFC has interpreted claim language.

C. Phillips v. AWH

Phillips v. AWH was the vehicle through which the CAFC hoped to put to rest the uncertainty regarding the proper interpretation method for claims.¹⁰⁹ In *Phillips*, the dispute was over the interpretation of the term “baffle.”¹¹⁰ In the initial case, the U.S. District Court for the District of Colorado (“District Court”) ignored the parties stipulated dictionary definition of “baffle.”¹¹¹ Finding that the term was ambiguous,

¹⁰¹ *Id.* at 1204. The ordinary and customary meaning of a term will be rejected when it is clear from the specification that the intended meaning of the term is different.

¹⁰² *Id.*; see also Wegner, *supra* note 16, at 7.

¹⁰³ *Telegenix*, 308 F.3d at 1204.

¹⁰⁴ *Id.* at 1205.

¹⁰⁵ *Id.* at 1206. The term “activating” is defined in the Modern Dictionary of Electronics 20 (6th ed. 1984) as “to start an operation, usually by application of an appropriate enabling signal.” *Id.*

¹⁰⁶ *Id.* at 1208. “We presume that the word used in a claim carries this ordinary meaning, but this presumption may be rebutted.” *Id.* at 1206.

¹⁰⁷ *Id.* at 1209.

¹⁰⁸ *Id.*

¹⁰⁹ See *Phillips v. AWH Corp.*, 376 F.3d 1382, 1382 (Fed. Cir. 2004).

¹¹⁰ *Phillips v. AWH Corp.*, 363 F.3d 1207, 1209 (Fed. Cir. 2004), *vacated*, 376 F.3d 1382 (Fed. Cir. 2004). The issue in this case was over the use of the term “baffle” as applied within Claim 1, which 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.

Id. at 1209–10.

¹¹¹ *Phillips v. AWH Corp.*, No. 97–MK–212 (CBS), 2002 U.S. Dist. LEXIS 27298, at *33 (D. Colo. Nov. 22, 2002) (stipulating the definition of the term “baffle” as “a means for obstructing, impeding or checking the flow of something”).

the District Court reviewed the specification which contained both text and diagrams that implied that “baffle[s]” were to be at any angle except ninety degrees.¹¹² Based on the implications of the specification, the District Court interpreted the term to include only the steel panels that were “at an oblique or acute angle to the face wall.”¹¹³

Phillips appealed, believing that the claim was not limited by the specification because the claim was not means-plus-function language.¹¹⁴ Although the CAFC agreed that the claim using the term “baffle” was not means-plus-function language, the court ultimately found the definition of the term should have been derived from the specification.¹¹⁵ When the term is defined within the language of the specification, explicitly or implicitly, its ordinary meaning is discounted.¹¹⁶ Since the specification of the patent contained ample evidence to define the term, the CAFC determined that “baffle[s]” were not at ninety degrees to the face of the wall.¹¹⁷ The CAFC further determined that nothing within the specification indicated that a “baffle” could be oriented at ninety degrees.¹¹⁸ This determination was made by consulting at the specification and the drawings within the patent claim.¹¹⁹ The majority did not attempt to determine to the plain meaning of the word in making this decision.¹²⁰ The CAFC argued that if the term was defined any other way, the public notice function of the specification would be defeated.¹²¹ However, the dissent argued that ordinary meaning should be given credence because the patentee did not define the term within the specification.¹²² If the “baffle[s]” were oriented at ninety

¹¹² *Id.* at *35.

¹¹³ *Id.*

¹¹⁴ *See Phillips*, 363 F.3d at 1210; *see also* MUELLER, *supra* note 24, at 52. 35 U.S.C. § 112 ¶ 6 governs means-plus-function claiming. *Id.*

The statute provides that “[a]n element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and . . . shall be construed to cover the corresponding structure, material, or acts described in the specification” 35 U.S.C. § 112 ¶ 6 (2000). There must be more than one element in a claim expressed in means-plus-function terms for this to be allowed. MUELLER, *supra* note 24, at 54. This allows an element in a claim to “be claimed in terms of what the element *does*, rather than what its structure is.” *Id.* at 52. *But see* Wegner, *supra* note 16, at 6 (“the default should be to *never* use a ‘means’ term in a claim”).

¹¹⁵ *Phillips*, 363 F.3d at 1212–13.

¹¹⁶ *Id.* at 1213.

¹¹⁷ *Id.* The conclusion of the court, looking only to the language within the patent, was that “the patentee regarded his invention as panels providing impact or projectile resistance and that the baffles must be oriented at angles other than ninety degrees. Baffles directed at ninety degrees cannot deflect projectiles as described” *Id.*

¹¹⁸ *Id.* at 1213–14.

¹¹⁹ *Id.* at 1214. The court looked to the language in the specification which in part “states that the baffles are ‘disposed at such angles that bullets which might penetrate the outer steel panels are deflected.’” *Id.* (citation omitted). It also looked at drawings contained within the specifications which showed the baffles at angles, not at ninety degrees to the panels. *Id.*

¹²⁰ *See id.*

¹²¹ *Id.*

¹²² *Phillips*, 363 F.3d at 1217 (Dyk, J., dissenting). The dissent felt that the limitation was “contrary to the plain meaning, and there is no suggestion that the patentee, acting as his own lexicographer, gave a special meaning to the term baffles.” *Id.*

degrees, they would fulfill part of the load bearing function of the wall.¹²³ Thus, since they would still perform a function, “baffle” should be interpreted as including those at a ninety degree angle to the walls.¹²⁴ Phillips disagreed with the majority opinion and petitioned for a rehearing of the case.¹²⁵

Phillips again appealed to the CAFC. The CAFC denied a panel hearing, but decided to hear the case en banc in order to resolve contradictory views concerning claim interpretation.¹²⁶ Indeed, *Phillips* is a prime example of a case where applying the two distinct methods of interpretation would yield dissimilar results.¹²⁷ Had the definition been determined by referring to the ordinary meaning of the term as defined in the dictionary, a “baffle” could be set at any angle, including ninety degrees.¹²⁸ In allowing interested parties to file amicus curiae briefs, the CAFC entertained multiple views to hopefully settle on a method for claim interpretation.¹²⁹

D. The Amicus Briefs

Pursuant to the CAFC’s request, more than thirty amicus curiae briefs were filed.¹³⁰ The majority of the briefs support the position that the specification should be consulted first to determine the definition of terms.¹³¹ These briefs reiterate the

¹²³ *Id.* The dissent states that “the specification . . . merely identifies impact resistance as one of several objectives of the invention. The patent also identifies other objectives including ‘high load bearing strength’ using ‘thinner guage [sic] steel panels,’ . . . and ‘thermal and acoustical isolation of two spaced walls.’” *Id.*

¹²⁴ *Id.* at 1218.

¹²⁵ *Phillips v. AWH Corp.*, 376 F.3d 1382, 1382 (Fed. Cir. 2004).

¹²⁶ *Id.*

¹²⁷ *Compare Phillips*, 363 F.3d at 1213, with *Phillips v. AWH Corp.*, No. 97–MK–212 (CBS), 2002 U.S. Dist. LEXIS 27298, at *33 (D. Colo. Nov. 22, 2002).

¹²⁸ Examples of relevant dictionary definitions of the term “baffle” are as follows: “. . . 2. To impede the force or movement of. n. 1. A usually static device that regulates the flow of a fluid or light” THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 133 (4th ed. 2000); “. . . 2 a frustrate or hinder (plans, etc.). b restrain or regulate the progress of (fluids, sounds, etc.). n. a device used to restrain or deflect the flow of fluid, gas, sound, etc.,” THE OXFORD AMERICAN DICTIONARY AND LANGUAGE GUIDE 65 (1999).

¹²⁹ *Phillips*, 376 F.3d at 1383–84 (inviting interested parties to submit amicus curiae briefs discussing the different methods of claim construction, which method is preferred, and the process that should be followed in constructing claims).

¹³⁰ *See Id.*; see also Posting of Dennis Crouch to Patently-O: Patent Law Blog, http://www.patentlyobviousblog.com/2004/09/phillips_.html (Sept. 23, 2004) (containing links to amicus curiae briefs submitted to the CAFC on the issue of claim construction); *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954, at *75 (Fed. Cir. July 12, 2005).

¹³¹ *See generally* Brief of Amicus Curiae New York Intellectual Property Law Association regarding the issue of claim construction et al., *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954 (Fed. Cir. July 12, 2005); Brief for Amicus Curiae American Intellectual Property Law Association in Support of Neither Party, *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954 (Fed. Cir. July 12, 2005); Brief of Amicus Curiae Federal Circuit Bar Association, *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954 (Fed. Cir. July 12, 2005); Brief of Amicus Curiae, The Intellectual Property Law Association of Chicago (in Support of Neither Party), *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954 (Fed. Cir. July 12, 2005); Brief for the United States as Amicus Curiae, *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954 (Fed. Cir. July 12, 2005) (United States Patent and Trademark Office) [hereinafter Amicus Curiae

argument that only when the term is ambiguous after consulting the specification should extrinsic evidence, such as dictionaries, be turned to.¹³² The authors of these briefs believe that turning first to the dictionary definition of a term severs the necessary relationship a term has to the PHOSITA.¹³³ The heavy presumption in favor of the ordinary meaning of a term defeats the public notice function of the patent claims as well as expands the scope of the term beyond its function in the patent.¹³⁴

Very few of the amici submitted briefs supporting the use of dictionaries at the outset. However, those submitted proclaim the ultimate goal of the public notice function is uniformity and predictability in claim construction.¹³⁵ Dictionaries aid in this regard because there is a limited array of definitions that might be adhered to, and because dictionaries are publicly available sources of information.¹³⁶

The majority of interested parties prefer the established method for interpretation as set forth in *Markman*. However, the trend in recent decisions clearly shows that the use of dictionaries is taking on a more important role in interpretation.¹³⁷

E. Phillips: The Answer at Last?

Briefs]. More than twenty-five amicus curiae briefs were filed with the CAFC on this matter. *See generally* Posting of Dennis Crouch to Patently-O: Patent Law Blog, http://www.patentlyobviousblog.com/2004/09/phillips_.html (Sept. 23, 2004) (comprehensive list of amicus curiae briefs). Only a few are listed here.

¹³² *Phillips*, 363 F.3d at 1213 (stating that a patentee may overcome the presumption that a claim term carries its ordinary meaning by distinguishing it "from prior art on the basis of a particular embodiment, expressly disclaim[ing] subject matter, or describ[ing] a particular embodiment as important to the invention").

¹³³ *See generally* Amicus Curiae Briefs, *supra* note 131.

¹³⁴ MUELLER, *supra* note 24, at 41. A PHOSITA should be able to determine what the terms mean from the claim language. *Id.*

¹³⁵ Brief for Amicus Curiae Parus Holdings, Inc., *Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004) (Nos. 03-1269, -1286); Brief of the American Bar Association as Amicus Curiae Supporting Neither Party, *Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004) (Nos. 03-1269, -1286); Brief of Amicus Curiae Patent Law Professors R. Polk Wagner & Joseph Scott Miller, *Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004) (Nos. 03-1269, -1286); Brief of Amicus Curiae International Trade Commission Trial Lawyers Association in Support of Neither Party and Supporting Neither Reversal Nor Affirmance, *Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004) (Nos. 03-1269, -1286).

¹³⁶ Brief for Amicus Curiae Parus Holdings, Inc., *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954 (Fed. Cir. July 12, 2005); Brief of the American Bar Association as Amicus Curiae Supporting Neither Party, *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954 (Fed. Cir. July 12, 2005). In its brief, the American Bar Association states that dictionaries, as "publicly available sources carry special significance in arriving at a proper contextual meaning of a claim term and best serve the public notice function." Brief of the American Bar Association as Amicus Curiae Supporting Neither Party at 4, *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954 (Fed. Cir. July 12, 2005).

¹³⁷ Wang, *supra* note 4, at 153. *Telegenix* firmly established the use of dictionaries in claim construction and "evinces the Federal Circuit's increasing preference toward a more formalistic interpretive model of claim construction." *Id.*

Recently, the CAFC handed down the long awaited en banc opinion in *Phillips v. AWH*.¹³⁸ The decision, which was expected to decide on one of the two claim interpretation standards, only re-states established principles.¹³⁹ However the CAFC is leaning toward the method established in *Markman*, furthered in *Vitronics*.¹⁴⁰ The *Phillips* court stressed that the public notice function of patent claims is essential,¹⁴¹ and the ordinary and customary meaning of terms should be determined from the viewpoint of a PHOSITA.¹⁴² However, it may be difficult to determine exactly who a PHOSITA is if a patent encompasses multiple scientific fields. The decision also presumes a court will understand the terms used in the same way a PHOSITA would.¹⁴³ Focusing on the central importance of the claim terms and their meaning in light of the specification,¹⁴⁴ the CAFC determined that the use of dictionaries is acceptable to help determine the true meaning of the claim terms and to aid the court in understanding the technology at issue.¹⁴⁵ The court, however, stressed that this sort of extrinsic evidence is less reliable than the patent itself.¹⁴⁶

The CAFC articulated that the main problem with the method in the *Telegenix* line of cases is that the use of the dictionary meaning of a term limits the role the specification plays in claim construction.¹⁴⁷ When the dictionary definition is not used in conjunction with the specification, the risk is that the term will be taken out of context and the court will depart from the intended meaning.¹⁴⁸ However, the

¹³⁸ No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954 (Fed. Cir. July 12, 2005).

¹³⁹ *Id.* at *75–76 (Mayer, J., dissenting).

¹⁴⁰ *Id.* at *19–20 (declaring that even though this method has been firmly established in both *Markman* and *Vitronics*, the basic principles will be outlined again and reaffirmed).

¹⁴¹ *Id.* at *21 (stating that the court must interpret the invention as it is defined by the patentee in the claims or risk defeating the public notice function).

¹⁴² *Id.* at *23 (declaring that claim interpretation begins with the “well-settled understanding that inventors are typically persons skilled in the field of the invention and that patents are addressed to and intended to be read by others of skill in the pertinent art.”).

¹⁴³ *Id.* at *24–25 (asserting “[t]he inventor’s words . . . must be understood and interpreted by the court as they would be understood and interpreted by a person in that field of technology.”).

¹⁴⁴ *Id.* at *28–29 (emphasizing that because the claims are part of the specification, they “must be read in view of the specification, of which they are a part.”).

¹⁴⁵ *Id.* at *38–39.

¹⁴⁶ *Id.* at *40. The CAFC then outlined numerous reasons why extrinsic evidence is less reliable:

First, extrinsic evidence by definition is not part of the patent and does not have the specification’s virtue of being created at the time of patent prosecution for the purpose of explaining the patent’s scope and meaning. Second, while claims are construed as they would be understood by a hypothetical person of skill in the art, extrinsic publications may not be written by or for skilled artisans and therefore may not reflect the understanding of a skilled artisan in the field of the patent. . . . Finally, undue reliance on extrinsic evidence poses the risk that it will be used to change the meaning of claims in derogation of the “indisputable public records consisting of the claims, the specification and the prosecution history,” thereby undermining the public notice function of patents.

Id. at *40–41. The CAFC further stressed that even though it may be useful, extrinsic evidence is “unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence.” *Id.* at *41–42.

¹⁴⁷ *Id.* at *46–47.

¹⁴⁸ *Id.* at *49.

CAFC then accepted the use of dictionaries for courts’ understanding of terms because it is an unbiased source, as long as the dictionary definition does not contradict the definition as understood from the patent documents.¹⁴⁹ Ultimately, the CAFC decided not to provide a clear method for claim construction, but only a reason why some types of evidence should be weighed more heavily than others.¹⁵⁰

Only after reiterating the process for claim interpretation did the court turn to the infringement issue. The CAFC reversed the decision on the infringement issue because it determined that a PHOSITA would not exclude ninety degree angles from the term “baffle” and remanded the issue to the district court.¹⁵¹

IV. PROPOSED SOLUTION

A. *Considering the Amici*

Although the proposal laid out below is supported only by a minority of the *Phillips* amici,¹⁵² it will provide more structured guidelines than the majority’s suggestion of following an interpretation method based on consulting the specification to define terms, only referencing a dictionary when the meaning of a term is not completely contradicted.¹⁵³ The majority argues that the language of the specification is the most effective place to find the definition of a term. The problem inherent in this method is that interpretations of the language vary. As such, this method can still provide uncertainty in claim interpretation.

The other point the amici and the CAFC tend to ignore is that since the *Telegenix* case, the CAFC itself began to rely on dictionaries first to get a better understanding of the terms within the specification. This suggests that the method

¹⁴⁹ *Id.* at *53–54. The CAFC further declared that “a judge who encounters a claim term while reading a patent might consult a general purpose or specialized dictionary to begin to understand the meaning of the term, before reviewing the remainder of the patent to determine how the patentee has used the term.” *Id.* at *58.

¹⁵⁰ *Id.* at *59.

¹⁵¹ *Id.* at *64, *68.

¹⁵² Brief for Amicus Curiae Parus Holdings, Inc., *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954 (Fed. Cir. July 12, 2005); Brief of the American Bar Association as Amicus Curiae Supporting Neither Party, *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954 (Fed. Cir. July 12, 2005); Brief of Amicus Curiae Patent Law Professors R. Polk Wagner & Joseph Scott Miller, *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954 (Fed. Cir. July 12, 2005); Brief of Amicus Curiae International Trade Commission Trial Lawyers Association in Support of Neither Party and Supporting Neither Reversal Nor Affirmance, *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954 (Fed. Cir. July 12, 2005).

¹⁵³ See Amicus Curiae Briefs, *supra* note 131. In general, the majority of the amici would like the court to revert back to the *Markman* method of analysis, looking at the language of the specification first. They feel that only when there are unresolved ambiguities should the court be allowed to look to extrinsic evidence, such as dictionaries, to try to help determine the meaning. *Id.*; see also *Novartis Pharms. Corp. v. Abbott Labs.*, 375 F.3d 1328, 1334–35 (Fed. Cir. 2004); *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1582–85 (1996). The method the court prefers in the latest *Phillips* decision. *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954, at *19–20 (Fed. Cir. July 12, 2005) (stating that the basic principles for claim construction are set out in *Markman*).

established in *Markman* is no longer an effective tool for the courts. This could stem from multiple factors, among them an increase in patent litigation or the increasing technical difficulty of patents. The trend of the court toward a reliance on dictionaries for the ordinary meaning of a term before interpreting the specification itself suggests that the *Markman* method is no longer wholly viable and is producing inconsistent results, a consideration that is overlooked in the recent *Phillips* decision.

B. Methodology to Incorporate Dictionaries

The most efficient method for incorporating the use of dictionaries into the interpretation process is an iterative one.¹⁵⁴ Initially, the court should examine the specification. If the court finds that the patentee has acted as his own lexicographer and the term has already been defined within the specification, the analysis should stop and the definition within the specification should be used. Likewise, if the term is not defined within the specification but a specific dictionary is cited for referencing the meaning of a term, that dictionary should be used, and further interpretation should cease.

If neither, the next step will be to refer to a standard dictionary for the ordinary meaning of the term. The court should then consult the specification again to determine if the dictionary definition fits within the specification. If the dictionary definition is still practical, it may be used.

Ultimately, it is important that the burden be placed on the patentee to clearly define the terms of his claim, not the court. Because the patentee is the one who has the most specific knowledge of the patented invention, he will be better able to define the terms of the claim. If the patentee does not define the terms, he risks the court narrowly interpreting the term and finding no infringement.

C. Use of a Standard Dictionary

The recent trend in claim interpretation points to a more formalistic approach.¹⁵⁵ Rather than using the relevant trade dictionary, a standard dictionary should be used to determine the ordinary meaning of uncertain terms.¹⁵⁶

¹⁵⁴ See generally Brief for Amicus Curiae Parus Holdings, Inc., *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954 (Fed. Cir. July 12, 2005); Brief of the American Bar Association as Amicus Curiae Supporting Neither Party, *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954 (Fed. Cir. July 12, 2005) [hereinafter *Minority Amicus Curiae Briefs*]. The general theme running through the minority briefs is that the ordinary meaning should be first determined from a dictionary, then the specification should be examined to determine if the patentee has specified a different meaning within the language. *Id.* If there is no clear rebuttal from within the language of the specification, the ordinary term prevails. *Id.*

¹⁵⁵ Johnson, *supra* note 4, at 521–22. Since *Telegenix*, the trend in claim interpretation has been to focus on the ordinary meaning of the term through the use of a dictionary. *Id.*; see also Wang *supra* note 4, at 153. Wang discusses the CAFC's movement toward a more formalistic approach to claim construction. *Id.* He goes on to discuss how the more formalistic approach will create more predictable, efficient outcomes. *Id.* at 171; see also Wegner, *supra* note 16, at 3. “The

A patentee should have the option available, at the time of filing, to specify a particular dictionary for use in defining uncertain terms within the specification. Even though the definitions within standard dictionaries will vary slightly between the dictionaries, there is less chance for confusion than if the wrong trade dictionary is selected.¹⁵⁷ Also, reliance on technical dictionaries might cause confusion because there may be cross-over between the different fields of science (e.g., mechanical and electrical aspects of a design), and the court might not consult the proper dictionary.¹⁵⁸ In such an instance, it will be difficult for the courts, and attorneys, to

trend of the past several years toward a strict construction of claims against a careless patentee will continue." *Id.*

¹⁵⁶ A relevant trade dictionary is a technical dictionary which may aid a judge in understanding the technology within a claim. *Vitronics*, 90 F.3d 1576, 1584 n.6 (Fed. Cir. 1996). As long as the definition in a technical dictionary is not contradicted by the claim, the dictionary definition may be used. *Id.*

Examples of technical dictionaries include *Modern Dictionary of Electronics: Engineering Encyclopedia: A Condensed Encyclopedia and Mechanical Dictionary for Engineers, Mechanics, Technical Schools, Industrial Plants, and Public Libraries, Giving the Most Essential Facts about 4500 Important Engineering Subjects.*

A non-technical dictionary is a standard English dictionary (i.e. *The Merriam-Webster Dictionary, The Oxford American Dictionary and Language Guide, and The American Heritage Dictionary of the English Language*).

¹⁵⁷ See *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1209. In a technical dictionary, "display" is defined as:

[a] visually observable presentation of information" *Illustrated Dictionary of Electronics* 147 (3rd ed. 1985). Background is defined as: "[the] context or supporting area of a picture" Thus, the ordinary meaning of "display area," as reflected in these dictionary definitions, is an area designated to portray information. Background is ordinarily understood to provide the context or contrasting reference against which the displayed information is presented. The ordinary meaning of these limitations does not indicate that the display and background areas are interchangeable.

Id. (citations omitted).

The definition for "display" from standard dictionaries includes: "1 the act or an instance of displaying. 2 an exhibition or show. 3 ostentation; flashiness . . . 5a the presentation of signals or data on a visual display unit, etc. b the information so presented." *THE OXFORD AMERICAN DICTIONARY AND LANGUAGE GUIDE* 275 (1999). "Display" is also defined as:

8. an act or instance of displaying; exhibition. 9.a. the giving of prominence to particular words, sentences, etc., by the choice of types and position, as in an advertisement, headline, or news story. b. printed matter thus displayed. . . 11.a. the visual representation of the output of an electronic device. b. the portion of the device, as a screen, that shows this representation.

RANDOM HOUSE WEBSTER'S COLLEGE DICTIONARY 387 (1992).

The standard definition for "background" in the same dictionaries is: "1 part of a scene, picture, or description that serves as a setting to the chief figures or objects and foreground. 2 an inconspicuous or obscure position . . . 6 *Electronics* unwanted signals, such as noise in the reception or recording of a sound." *THE OXFORD AMERICAN DICTIONARY AND LANGUAGE GUIDE* 64 (1999); "1. the ground or parts, as of a scene, situated in the rear (opposed to *foreground*). 5. the set of conditions against which an occurrence is perceived . . . 6. b. intrusive sound or radiation that tends to interfere with the transmission or reception of electronic signals." *RANDOM HOUSE WEBSTER'S COLLEGE DICTIONARY* 101 (1992).

¹⁵⁸ See *supra* note 157. The word "demagnetizer" offers an example of a term that is trade dependent. In the field of electronics, a demagnetizer is a "device that removes residual magnetism from recording or playback tape heads. This magnetism, if not removed, can introduce noise on

select the relevant trade dictionary since both an electrical and a mechanical trade specific dictionary may both provide relevant, yet competing, definitions that are unable to be distinguished within the specification.¹⁵⁹

Consulting a standard dictionary will make the language more basic and comprehensive, forcing patentees to provide their own definitions if they intend the meaning to be something different from the ordinary usage of the word.¹⁶⁰ Use of a standard, non-technical dictionary would make the claims generic enough that the general public would understand the meaning of the claimed invention. This in turn would fulfill the public notice function of the patent.¹⁶¹ Furthermore, use of a non-technical dictionary would ensure that anyone trying to ascertain the definition of a term would have access to the same reference materials as judges.¹⁶²

If a word is a term of art, the patentee should either specify the dictionary from which to draw the definition or act as his own lexicographer, so that the terms are clearly defined within the specification itself. In the absence of a specified definition or dictionary, the ordinary, relevant, dictionary meaning of the term should be used.¹⁶³

D. The Patentee as His Own Lexicographer

While it will not always be clear to the patentee or patent attorney which terms need to be defined, it is best to take a “better safe than sorry” approach. To avoid possible ambiguities, any term of art should be defined within the specification itself.¹⁶⁴ This will eliminate confusion regarding the intended definition of a term and will disallow a potential infringer from claiming he interpreted the term to mean

recordings and cause high-frequency loss.” MODERN DICTIONARY OF ELECTRONICS 185 (7th ed. 1999). However, in the mechanical field, a demagnetizer is described as “[h]ardened tool-steel parts that have been held on a magnetic chuck become permanently magnetized This residual magnetism is objectionable for some classes of work, and a device known as a ‘demagnetizer’ is used for removing it.” ENGINEERING ENCYCLOPEDIA: A CONDENSED ENCYCLOPEDIA AND MECHANICAL DICTIONARY FOR ENGINEERS, MECHANICS, TECHNICAL SCHOOLS, INDUSTRIAL PLANTS, AND PUBLIC LIBRARIES, GIVING THE MOST ESSENTIAL FACTS ABOUT 4500 IMPORTANT ENGINEERING SUBJECTS 346 (3d ed. 1963).

The difference in the electronic and mechanical definition of the word “demagnetizer” illustrates the problem created if the improper trade dictionary is chosen.

¹⁵⁹ See *supra* note 158.

¹⁶⁰ See *Telegenix*, 308 F.3d at 1204 (stating that unless the patentee acts as his own lexicographer, the presumption is in favor of the ordinary definition of the term as found in the dictionary).

¹⁶¹ *SmithKline Beecham Corp. v. Apotex Corp.*, 365 F.3d 1306, 1328 (Fed. Cir. 2004) (Gajarsa, J., concurring). The clear definition of terms will further the public notice function of the specification because the public will also be able to understand the terms. *Id.*

¹⁶² See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996). Uniformity in the treatment of a patent is essential to serve the public notice function; therefore, it is also essential that the public have access to the same reference materials that judges use. *Id.*

¹⁶³ *Telegenix*, 308 F.3d at 1204.

¹⁶⁴ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 986 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996) (stating that ideally, extrinsic evidence would not have to be looked at because there would be no ambiguities in the claim language).

something entirely different from the patentee's intended meaning. Acting as his own lexicographer will also ensure that a patentee's patent is understood as intended.

While this extra step might be more costly during the initial patent preparation process because the patentee and his attorney will have to pay more attention to detailing all aspects of the patent, this extra step may function to save the patentee significantly more money by avoiding an infringement lawsuit later.¹⁶⁵

V. CONCLUSION

The highly anticipated decision in the *Phillips* case could have been one of the most important decisions by the CAFC regarding claim interpretation since *Markman*.¹⁶⁶ The fact that there had previously been no consensus amongst the judges of the CAFC on the matter of claim interpretation demonstrates the long overdue need for rigid guidelines to direct the courts, attorneys, and patentees in claim construction. The trend has been toward making the dictionary the primary tool used in claim interpretation.¹⁶⁷ This most likely arose from a need to clarify terms before trying to discern their meaning from confusing specification language. The CAFC, however, disregarded this trend and used this opportunity to revert to the method set forth in *Markman*.¹⁶⁸ The likely result from this will continue to be inconsistently decided cases as the courts again attempt to apply the rules for claim interpretation.

The more stringent approach to interpretation, proposed above, forces the parties involved to be more diligent when writing the specifications, ensuring that all terms are unambiguous and well defined. The writer has two options: Specify which dictionary to refer to for the definition of the term or act as his own lexicographer. This will help to eliminate the confusion that comes from uncertain terms in the language and makes for a more stable patent system.

¹⁶⁵ See AIPLA Report, *supra* note 61, at 20. The average fee charged for an original patent application of minimal complexity is \$5,504 compared to an original application for a complex invention which ranges from \$8,000 to \$10,000. *Id.*

¹⁶⁶ Pollinger, *supra* note 16, at 30. Pollinger discusses the import of the *Phillips* case stating that it would likely be the next landmark decision in claim interpretation. *Id.*

¹⁶⁷ Johnson, *supra* note 4, at 521–22. Since *Telegenix*, the trend in claim interpretation has been to focus on the ordinary meaning of the term through the use of a dictionary. *Id.*

¹⁶⁸ *Phillips v. AWH*, No. 03-1269, -1286, 2005 U.S. App. LEXIS 13954, at *19–20 (Fed. Cir. July 12, 2005).

