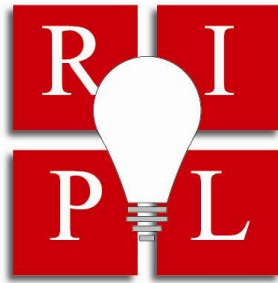


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ON MEASURING THE EXPERTISE OF PATENT-PILOT JUDGES: ENCOURAGING ENHANCEMENT OF CLAIM-CONSTRUCTION UNIFORMITY

ETAN S. CHATLYNNE

ABSTRACT

A Pilot Program to “encourage enhancement of expertise” in patent cases among district judges recently got underway in the federal courts. The program is designed to funnel patent cases to judges who volunteer to become “pilot judges.” The idea is that as these judges hear more patent cases and become more familiar with patent law, they will be able to craft claim constructions and opinions that are increasingly likely to survive the scrutiny of the Court of Appeals for the Federal Circuit. Unfortunately, the Federal Circuit’s jurisprudence may itself encumber these efforts because of a split among the Federal Circuit judges concerning the correct approach to interpreting patent claims. This Article explores that split and its potential to undermine the pilot judges’ efforts to make the program a success.

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ETAN S. CHATLYNNE*

INTRODUCTION

A Pilot Program to “encourage enhancement of expertise” in patent cases among the federal judiciary¹ recently commenced in United States district courts.² One important goal of the Pilot Program is to increase efficiency in patent litigation by reducing the reversal rate of district judges’ patent claim constructions.³ The program’s structure resembles a scientific experiment whereby claim-construction reversal rates may be correlated with judicial expertise.⁴ In other words, Congress has hypothesized that increasing judicial experience with patent cases should cause a drop in claim-construction reversal rates.⁵

Unfortunately, testing the hypothesis may prove difficult. Beyond the general vagaries of litigation, enhancing judicial expertise in patent law may not necessarily cause a meaningful decrease in the reversal rate of claim constructions.⁶ One obstacle to reducing the reversal rate is that the United States Court of Appeals for the Federal Circuit seems to have “developed two distinct approaches to claim construction, and utilize[s these approaches] interchangeably.”⁷ Because cases are assigned to Federal Circuit judges after all appeal briefs have been filed,⁸ even the most experienced district judges are left to guess which of these two approaches the

* © Etan S. Chatlynnne 2013. Etan Chatlynnne is an Associate at Stroock & Stroock & Lavan LLP. The author thanks Matthew Siegal for his support and advice. Views expressed in this article are not necessarily the views of Stroock & Stroock & Lavan or its clients.

¹ Patent Pilot Program Act, Pub. L. No. 111-349, 124 Stat. 3674 (2011).

² See *District Courts Selected for Patent Pilot Program*, U.S. CTS. (June 7, 2011), http://www.uscourts.gov/News/NewsView/11-06-07/District_Courts_Selected_for_Patent_Pilot_Program.aspx.

³ See Patent Pilot Program Act § 1(e)(1), 124 Stat. at 3675–76.

⁴ See *id.*

⁵ See 156 CONG. REC. H8537 (daily ed. Dec. 16, 2010) (statement of Rep. Ted Poe) (“The premise underlying H.R. 628 is, succinctly stated, practice makes perfect, or at least better. Judges who focus more attention on patent cases will be expected to be better prepared to make decisions that can withstand appellate scrutiny.”).

⁶ See David L. Schwartz, *Practice Makes Perfect? An Empirical Study of Claim Construction Reversal Rates in Patent Cases*, 107 MICH. L. REV. 223, 261–62 (2008); David L. Schwartz, *Courting Specialization: An Empirical Study of Claim Construction Comparing Patent Litigation Before Federal District Courts and the International Trade Commission*, 50 WM. & MARY L. REV. 1699, 1731–32 (2009) (“[T]o the extent that the Patent Pilot Program is designed to reduce claim construction errors, it appears unlikely on its own to be effective.”).

⁷ R. Polk Wagner & Lee Petherbridge, *Did Phillips Change Anything? Empirical Analysis of the Federal Circuit’s Claim Construction Jurisprudence*, in INTELLECTUAL PROPERTY AND THE COMMON LAW (S. Balganesch ed., forthcoming 2013) (manuscript at 8), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1909028; *accord* *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 659 F.3d 1369, 1370 (Fed. Cir. 2011) (Moore, J., dissenting from the denial of the petition for rehearing en banc) (explaining that the Federal Circuit’s rules are “inconsistently applied, even by us”).

⁸ See U.S. COURT OF APPEALS FOR THE FED. CIRCUIT, INTERNAL OPERATING PROCEDURES 11 (2008), available at <http://www.cafc.uscourts.gov/images/stories/rules-of-practice/IOPsMaster.pdf>.

Federal Circuit may apply on appeal. This potential source of uncertainty may indicate that the Pilot Program could be an inaccurate tool for testing Congress's hypothesis that increasing judicial experience with patent cases will cause a drop in reversal rates. However, if the uncertainty can be reduced, perhaps by the Supreme Court determining that only one of the Federal Circuit's two approaches is correct, the Pilot Program may become a useful tool for testing the hypothesis.

I. PATENT CLAIMS AND CLAIM CONSTRUCTION

By statute, every patent must contain a specification that ends with "one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor . . . regards as the invention."⁹ Many specifications explain the invention by describing exemplary embodiments of the invention. And, many specifications conclude with multiple claims that differ in scope and terminology.

Patent litigation occurs when a patent owner accuses a defendant, in court, of infringing at least one patent claim. In turn, the accused infringer ordinarily denies the infringement and argues that the asserted claims are invalid. In order to determine who is right and who is wrong, the court typically must interpret several claim terms having definitions that the parties dispute. This interpretive exercise is known as claim construction.¹⁰

The Federal Circuit has explained that "the words of a claim 'are generally given their ordinary and customary meaning,'"¹¹ which is "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention."¹² Critically, this hypothetical person of ordinary skill in the art understands the term in question "not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent."¹³

In many patent cases, claim construction can be a dispositive issue because winning turns on whether patent claims are infringed, and, usually, whether the claims survive the likely validity challenge.¹⁴ To borrow a phrase from Judge Giles S. Rich, one of the principal contributors of the 1952 Patent Act, "the name of the game is the claim."¹⁵

Despite its importance, claim interpretation is often unpredictable.¹⁶ By various measures, the Federal Circuit reverses district court claim constructions at a high

⁹ 35 U.S.C. § 112(b) (2012).

¹⁰ See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (en banc).

¹¹ *Id.* at 1312 (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)).

¹² *Id.* at 1313.

¹³ *Id.*

¹⁴ *Wagner & Petherbridge*, *supra* note 7, (manuscript at 4).

¹⁵ Giles S. Rich, *The Extent of the Protection and Interpretation of Claims—American Perspectives*, 21 INT'L REV. INDUS. PROP. & COPYRIGHT L. 497, 499 (1990).

¹⁶ *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 659 F.3d 1369, 1370 (Fed. Cir. 2011) (Moore, J., dissenting from the denial of the petition for rehearing en banc); Lauren Maida, *Patent Claim Construction: It's Not a Pure Matter of Law, So Why Isn't the Federal Circuit Giving the District Courts the Deference They Deserve?*, 30 CARDOZO L. REV. 1773, 1790–93 (2009).

rate,¹⁷ suggesting to some that the “claim game” has become a game of chance. Indeed, the situation prompted Judge Ronald H. Whyte of the District Court for the Northern District of California to quip that if “the reversal rate is as high as some claim, the easiest thing to do is figure out what your decision is and then write the opposite.”¹⁸

Congress took note. It determined that a potential cause of the problem may be that district judges lack sufficient experience in patent cases to reach proper results.¹⁹ Thus, Congress reasoned that increasing judicial expertise in patent cases should enable judges to achieve better results and lower the rate at which the Federal Circuit reverses their claim constructions.²⁰ As a result, Congress created the Pilot Program.

II. THE PILOT PROGRAM

The Pilot Program will be implemented over a ten-year period in fourteen pilot courts across the country.²¹ Some of the pilot courts are district courts in which a large number of patent cases are filed each year.²² Other pilot courts are district courts that hear fewer patent cases, but that have signaled their desire to hear more through the adoption of local rules specific to patents.²³ Judges in the pilot courts may ask their chief judge to designate them as pilot judges.²⁴ Judges not participating in the program may decline to hear any patent cases assigned to them.²⁵ These cases are then reassigned to the pilot judges.²⁶ By one count, there were eighty-five pilot judges and sixteen pilot magistrate judges.²⁷

In theory, as patent cases funnel to the pilot judges, these judges will hear more patent cases, which will increase their familiarity with patent law, potentially

¹⁷ See Maida, *supra* note 16, at 1790 & n.115 (citing various studies that provide a cumulative range of twenty-five to seventy-one percent reversal rate and that suggest the rate may be increasing); 156 CONG. REC. H8537 (daily ed. Dec. 16, 2010) (statement of Rep. Judy Chu) (“[T]he reversal rate of district court decisions is high, hovering around 50 percent.”).

¹⁸ *The Law, Technology and the Arts Symposium: The Past, Present and Future of the Federal Circuit: A Panel Discussion: Claim Construction from the Perspective of the District Judge*, 54 CASE W. RES. L. REV. 671, 680 (2004).

¹⁹ See 156 CONG. REC. H8537 (daily ed. Dec. 16, 2010) (statement of Rep. Judy Chu).

²⁰ See *id.* (daily ed. Dec. 16, 2010) (statement of Rep. Ted Poe).

²¹ Patent Pilot Program Act, Pub. L. No. 111-349, § 1(c), 124 Stat. 3674, 3675 (2011). The pilot courts are the Eastern District of New York, the Southern District of New York, the Western District of Pennsylvania, the District of New Jersey, the District of Maryland, the Northern District of Illinois, the Southern District of Florida, the District of Nevada, the Eastern District of Texas, the Northern District of Texas, the Western District of Tennessee, the Central District of California, the Northern District of California, and the Southern District of California. See *District Courts Selected for Patent Pilot Program*, U.S. CTS. (June 7, 2011), http://www.uscourts.gov/News/NewsView/11-06-07/District_Courts_Selected_for_Patent_Pilot_Program.aspx.

²² See Patent Pilot Program Act § 1(b)(2)(A)(i), 124 Stat. at 3674–75.

²³ See *id.* § 1(b)(2)(A)(ii).

²⁴ *Id.* § 1(a)(1)(A), 124 Stat. at 3674.

²⁵ *Id.* § 1(a)(1)(C).

²⁶ *Id.* § 1(a)(1)(D).

²⁷ See Steven Gray, *The Designated Judges for the New Specialized Patent Pilot Program for U.S. Courts*, IP BASICS (Feb. 9, 2012), <http://patentmyinvention.blogspot.com/2012/02/new-specialized-patent-pilot-program.html>.

resulting in higher quality opinions more likely to “withstand appellate scrutiny.”²⁸ The Director of the Administrative Office of the United States Courts, in consultation with the chief judge of each of the pilot courts and the Director of the Federal Judicial Center, will monitor the experiment and prepare progress reports for the Committee on the Judiciary of the House of Representatives and its counterpart in the Senate.²⁹ Among other things, these reports will include an “analysis of the extent to which the program has improved the efficiency of the courts” and comparisons of the relative rates at which pilot judges and non-pilot judges are reversed on the issues of claim construction and substantive patent law.³⁰

Implicit in the statute and the legislative history is the hypothesis that reversal rates will decrease with increased judicial expertise, such that improvements in judicial expertise may be assessed from corresponding reductions in reversal rates.³¹ With respect to claim-construction reversals, testing the hypothesis may prove difficult, in part because the Pilot Program’s design does not account for a divide among Federal Circuit judges concerning the correct approach for interpreting claims.

III. THE FEDERAL CIRCUIT’S DIVERGENT APPROACHES TO CLAIM CONSTRUCTION

In *Phillips v. AWH Corp.*, the en banc Federal Circuit explained that “the words of a claim ‘are generally given their ordinary and customary meaning,’”³² which “is the meaning that the term would have to a person of ordinary skill in the art.”³³ In clarifying the types of evidence a judge should rely on to determine what the meaning would be to a person having ordinary skill in the art, the Federal Circuit explained that intrinsic evidence (i.e., the claims, specification, and prosecution history) should generally be preferred over extrinsic evidence (e.g., dictionaries, encyclopedias, and expert testimony).³⁴ Nonetheless, since *Phillips*, a single approach for determining how a judge should enter the hypothetical person’s frame of reference has not emerged.³⁵ Instead, some have concluded that the Federal Circuit has developed at least “two distinct approaches to claim construction, and utilize[s these approaches] interchangeably.”³⁶

²⁸ 156 CONG. REC. H8537 (daily ed. Dec. 16, 2010) (statement of Rep. Ted Poe).

²⁹ Patent Pilot Program Act, Pub. L. No. 111-349, § 1(e)(1), 124 Stat. 3674, 3675–76 (2011).

³⁰ *Id.* § 1(e)(1)(B), (C), 124 Stat. at 3675.

³¹ *See* 156 CONG. REC. H8537 (daily ed. Dec. 16, 2010) (statement of Rep. Ted Poe).

³² *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Vitronics Corp. v. Conception, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)).

³³ *Id.* at 1313.

³⁴ *See id.* at 1317.

³⁵ *See* Harold C. Wegner, *Arlington Indus. v. Bridgeport Fittings: The 20 Year Claim Construction Debate*, IP FRONTLINE (Jan. 24, 2011), <http://www.ipfrontline.com/depts/article.aspx?id=24829&deptid=7>.

³⁶ *See* Wagner & Petherbridge, *supra* note 7, (manuscript at 8).

A. The Holistic and Procedural Approaches

Professors R. Polk Wagner and Lee Petherbridge refer to the two approaches as “Procedural” and “Holistic.”³⁷ Under the Procedural approach, judges give primary “weight to the claim language (and the ordinary meaning thereof, often derived from dictionaries).”³⁸ Under the Holistic approach, patent claims are interpreted “via an all-encompassing, open-ended reading of the claim language, patent disclosure, prosecution history, relevant dictionaries, and on-point expert testimony.”³⁹ These definitions do not indicate whether intrinsic evidence should be favored over extrinsic evidence.

Professors Wagner and Petherbridge have performed two empirical studies concerning the rates at which the Federal Circuit judges apply the two approaches. In the first study, conducted before *Phillips*, they concluded that the Federal Circuit applied the Procedural and Holistic approaches interchangeably.⁴⁰ In the second study, they revisited the first study, but incorporated post-*Phillips* cases to determine whether *Phillips* affected the rates at which the two approaches have been applied.⁴¹ The professors explained that, because *Phillips* represented the Federal Circuit’s “attempt[] to clarify the divergent methodological approaches,” that case “provide[d] an excellent opportunity to observe the success—or lack thereof—of this effort.”⁴² They concluded from their data that *Phillips* “has not yielded any significant observable effects on the claim construction jurisprudence of the Federal Circuit.”⁴³ The professors found that this result was “puzzling”⁴⁴ because they understood that *Phillips* “clearly suggests that the Holistic approach is likely to be the better one.”⁴⁵ One reason why their study may not have indicated observable effects is because, as the professors concede, the language of *Phillips* is “open-ended” and “allows both methodological approaches to exist.”⁴⁶ That is, *Phillips* may not have disfavored the Procedural approach at all.⁴⁷ Rather, it may have condoned both approaches, while simply disfavoring the use of extrinsic evidence in both.

In *Phillips*, the issue was whether the claim term “baffles” could be interpreted as including baffles oriented at right angles.⁴⁸ Parts II and III of the majority opinion set forth the law of claim construction.⁴⁹ Appearing rather Holistic in nature, the majority explained that it is “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.”⁵⁰ The majority borrowed much from *Vitronics Corp. v.*

³⁷ *Id.* (manuscript at 7).

³⁸ *Id.*

³⁹ *Id.*

⁴⁰ *Id.* (manuscript at 8).

⁴¹ *Id.* (manuscript at 13–14).

⁴² *Id.* (manuscript at 10).

⁴³ *Id.* (manuscript at 23).

⁴⁴ *Id.* (manuscript at 20).

⁴⁵ *Id.* (manuscript at 9).

⁴⁶ *Id.* (manuscript at 21).

⁴⁷ *Id.*

⁴⁸ See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1310 (Fed. Cir. 2005) (en banc).

⁴⁹ *Id.* at 1311–24.

⁵⁰ *Id.* at 1317.

Conceptronic, Inc.,⁵¹ a panel opinion in which claim scope was “holistically” matched to the specification’s disclosure.⁵² Quoting *Vitronics*, the majority explained that “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.’”⁵³ And quoting Judge Rich, the majority further explained that the “descriptive part of the specification aids in ascertaining the scope and meaning of the claims inasmuch as the words of the claims must be based on the description. The specification is, thus, the primary basis for construing the claims.”⁵⁴

Based on this “holistic” language, and because the “specification ma[de] clear that the ‘baffles’ in this invention are angled,”⁵⁵ a first-time reader of *Phillips* may have been inclined to expect that the “baffles” in the claims should exclude baffles oriented at right angles. If so, this reader would likely have been surprised by Part IV, where the majority concluded that the term “baffles” included baffles oriented at right angles.⁵⁶ To reach this conclusion, the majority engaged in a technique known as “claim differentiation.”⁵⁷ “Under the doctrine of claim differentiation, ‘each claim in a patent is presumptively different in scope.’”⁵⁸ The doctrine is most often applied in “the presence of a dependent claim that adds a particular limitation [to] give[] rise to a presumption that the limitation in question is not present in the independent claim.”⁵⁹ Independent claim 1 did not specify the orientation of the claimed “baffles.”⁶⁰ However, because the dependent claims did specify orientations, independent claim 1 was construed as covering at least all of those orientations.⁶¹ For example, dependent claim 2 stated that the baffles may be “oriented with the panel sections disposed at angles for deflecting projectiles.”⁶² Because claim 2 specified baffles oriented at non-right angles, the majority determined that claim 1 must be understood as including baffles oriented at both right and non-right angles.⁶³ Otherwise, claim 2 would be redundant.⁶⁴ Thus, the majority reversed the district court’s summary judgment of noninfringement and remanded for further proceedings.⁶⁵

This critical portion of the majority opinion appears more Procedural than Holistic because it treated the claim language as having significantly more weight than the rest of the specification or the prosecution history. However, following this

⁵¹ *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996).

⁵² *Id.* at 1582–83.

⁵³ *Phillips*, 415 F.3d at 1315 (quoting *Vitronics*, 90 F.3d at 1582).

⁵⁴ *Id.* (quoting *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985) (Rich, C.J.)).

⁵⁵ *Id.* at 1329 (Lourie, J., concurring in part and dissenting in part).

⁵⁶ *Id.* at 1328.

⁵⁷ *Id.* at 1329 (Lourie, J., concurring in part and dissenting in part).

⁵⁸ *Ecolab, Inc. v. Paraclipse, Inc.*, 285 F.3d 1362, 1375 (Fed. Cir. 2002).

⁵⁹ *Phillips v. AWH Corp.* 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc) (citing *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004)).

⁶⁰ *Id.* at 1324.

⁶¹ *Id.*

⁶² *Id.*

⁶³ *Id.*

⁶⁴ *Id.* (citing *Dow Chem. Co. v. United States*, 226 F.3d 1334, 1341–42 (Fed. Cir. 2000)).

⁶⁵ *Id.* at 1328.

portion of the opinion, the majority discussed the specification for several paragraphs,⁶⁶ diverging back to a Holistic approach.

Judge Alan D. Lourie, who joined Parts II and III, but dissented from Part IV, criticized the majority for interpreting the claim as covering more than what the inventor explained he had invented.⁶⁷ In “simply point[ing] out that the specification contains no disclosure of baffles at right angles,”⁶⁸ Judge Lourie signaled his preference for the Holistic approach, particularly one that resists expansion of the claims beyond the limits of the disclosure. He would have affirmed the district court’s summary judgment of noninfringement.⁶⁹

Viewing *Phillips* in this fashion, it may be that the case did not favor the Holistic approach over the Procedural approach at all. Instead, it may have simply caused the approaches to become harder to distinguish. If so, this may help explain why the two professors’ empirical research could not uncover an observable change in the rates at which the Federal Circuit has applied the two approaches before and after *Phillips*.

B. The Post-Phillips Debate

Since at least *Phillips*, Judge Lourie and now-Chief Judge Randall R. Rader (who joined the *Phillips* majority in full) seem to have been debating the proper approach to claim construction through their opinions.⁷⁰ Contrasting these opinions suggests a way, post-*Phillips*, to distinguish the Federal Circuit’s divergent approaches to claim construction. Also, contrasting these opinions indicates that the two approaches often lead to interpretations that are substantially different in scope.

Judge Lourie has explained that “[t]he bottom line of claim construction should be that the claims should not mean more than what the specification indicates, in one way or another, the inventors invented.”⁷¹ He has written that a preferred way to determine “what the inventors invented” includes reviewing the specification to glean the extents of “what they disclosed.”⁷² At least sometimes, this means what the inventors *explicitly* disclosed.⁷³ Consequently, Judge Lourie treats claim differentiation as “not a hard and fast rule [that] will be overcome by a contrary construction dictated by the written description or prosecution history.”⁷⁴

⁶⁶ *Id.* at 1325–27.

⁶⁷ *Id.* at 1329 (Lourie, J., dissenting).

⁶⁸ *Id.*

⁶⁹ *Id.* at 1329–30 (Lourie, J. dissenting).

⁷⁰ See Wegner, *supra* note 35.

⁷¹ *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1258 (Fed. Cir. 2011) (Lourie, J., dissenting).

⁷² *Id.* at 1257 (“In colloquial terms, ‘you should get what you disclose.’”).

⁷³ See *Marine Polymer Techs., Inc. v. HemCon, Inc.*, 672 F.3d 1350, 1369 (Fed. Cir. 2012) (en banc) (Dyk, J., dissenting) (noting that Judge Lourie’s opinion incorrectly ignored that the two explicit recitations “of the invention” are examples); *Arlington Indus.*, 632 F.3d at 1258 (Lourie, J., dissenting) (explaining that the accused infringer should not be prevented from doing what the specification did not explicitly disclose, i.e., making an adapter without a split).

⁷⁴ *Seachange Int’l, Inc. v. C-COR, Inc.*, 413 F.3d 1361, 1369 (Fed. Cir. 2005); accord *Arlington Indus.*, 632 F.3d at 1258 (Lourie, J. dissenting) (“[C]laim differentiation should not enlarge claims beyond what the specification tells us the inventors contemplated as their invention.”).

Application of Judge Lourie's technique sometimes includes a routine search of the specification for what he often considers to be key phrases of limitation, such as "the invention" or "the present invention."⁷⁵ If the specification states what "the invention" or the "present invention" is, then under this approach, the patent is considered to have described "what the inventor invented," and this description may be used to adjust the scope of the claims.⁷⁶

On the other hand, according to Chief Judge Rader, "terms in a claim must be given their ordinary meaning unless it is apparent that the inventor used them differently in the patent."⁷⁷ Thus, he seems to require a more explicit statement of limitation than does Judge Lourie before he will conclude that the specification limits the claims. Where such a statement does not exist, the Chief Judge often uses claim differentiation to determine the ordinary meaning of the claim terms. As noted above, "[u]nder the doctrine of claim differentiation, 'each claim in a patent is presumptively different in scope.'"⁷⁸ Recently, the Chief Judge explained that the presumption created from differentiating claims is "especially strong when the limitation in dispute is the only meaningful difference between an independent and dependent claim."⁷⁹ Thus, claim differentiation may be used to broaden claim constructions in order to capture concepts and embodiments not explicitly disclosed in the specification.⁸⁰

In 2011, Chief Judge Rader and Judge Lourie seemingly aired their debate in *Arlington Industries, Inc. v. Bridgeport Fittings, Inc.*,⁸¹ and *Retractable Technologies, Inc. v. Becton, Dickinson & Co.*⁸² In *Arlington Industries*, the Chief Judge wrote the majority opinion and Judge Lourie dissented.⁸³ In *Retractable Technologies*, their roles were reversed.⁸⁴ Although the facts were different in the two cases, the ostensible reason for the change was a different third judge on the two panels.

The patent in *Arlington Industries* related to fittings used to connect electrical cables to junction boxes.⁸⁵ The claimed fitting included a "spring metal adaptor."⁸⁶ The issue was whether this "spring metal adaptor" must be a "split" spring metal adaptor that does not form a complete circle.⁸⁷ Applying claim differentiation to two independent claims, Chief Judge Rader determined that the adaptor in one of the claims need not be split.⁸⁸ He explained that "[c]laim 1 recites a 'spring metal

⁷⁵ See *Marine Polymer*, 672 F.3d at 1359.

⁷⁶ *Id.*

⁷⁷ *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1302 (Fed. Cir. 1999) (Rader, C.J., dissenting).

⁷⁸ *Ecolab, Inc. v. Paraclipse, Inc.*, 285 F.3d 1362, 1375 (Fed. Cir. 2002).

⁷⁹ *Retractable Techs. Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1312 (Fed. Cir. 2011) (quoting *SunRace Roots Enter. Co., Ltd. v. SRAM Corp.*, 336 F.3d 1298, 1303 (Fed. Cir. 2003)).

⁸⁰ See, e.g., *Phillips v. AWH Corp.*, 415 F.3d 1303, 1310 (Fed. Cir. 2005) (en banc) (interpreting the claim to include baffles at right angles even though "nowhere in the patent [wa]s there any disclosure of a baffle projecting from the wall at a right angle").

⁸¹ *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246 (Fed. Cir. 2011).

⁸² *Retractable Techs, Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296 (Fed. Cir. 2011).

⁸³ See *Arlington Indus.*, 632 F.3d at 1248, 1257.

⁸⁴ See *Retractable Techs.*, 653 F.3d at 1298, 1311.

⁸⁵ See *Arlington Indus.*, 632 F.3d at 1249–50.

⁸⁶ *Id.* at 1249.

⁸⁷ *Id.* at 1253.

⁸⁸ *Id.* at 1254.

adaptor being less than a complete circle,' while claim 8 omits the less than a complete circle modifier."⁸⁹ Therefore, he concluded that the term "adaptor" could not include an implicit "split" limitation because an implicit "split" limitation would render the explicit recitation of a split circle in claim 1 "superfluous."⁹⁰ Thus, the court vacated the district court's grant of summary judgment of noninfringement.⁹¹

Judge Lourie dissented.⁹² He reviewed the specification and determined that "the inventors made clear in the specification . . . that the spring metal adapters in their invention have an opening that prevents the adapters from forming a complete circle."⁹³ Judge Lourie would have affirmed the summary judgment of noninfringement because, otherwise, the appellee "might be held to be an infringer of a patent that clearly indicates that there is a split in the adaptor, by making or selling an adaptor lacking such a split."⁹⁴

In *Retractable Technologies*, the patents were directed to a syringe that automatically retracts its needle after use.⁹⁵ The claimed syringe included a "body."⁹⁶ The issue was whether this "body" could include more than one piece, or whether it must be only a single piece.⁹⁷ Judge Lourie determined that "body" should mean a single piece body, explaining that the specification expressly recited that "the invention" had a one-piece body.⁹⁸ Under this construction, the majority found that the accused two-piece syringe did not infringe.⁹⁹

The Chief Judge dissented.¹⁰⁰ He explained that differentiating the claims with respect to the term "body" created an "especially strong" presumption that a "body" could include more than one piece.¹⁰¹ For example, because claim 1 included a "body" and claim 14 "claim[ed] [t]he syringe of claim 1 comprising a one-piece barrel,"¹⁰² the Chief Judge concluded that the "body" of claim 1 must cover "bodies" having more than one piece.¹⁰³ Otherwise, the Chief Judge reasoned, claim 14 would be nullified.¹⁰⁴ Under this construction, the accused two-piece syringe would have infringed.¹⁰⁵

Retractable Technologies and *Arlington Industries*, together, indicate two distinct approaches that arguably fall under Professor Polk's and Professor Wagner's Procedural and Holistic umbrellas. And, following the recent case of *Marine Polymer*

⁸⁹ *Id.*

⁹⁰ *Id.* at 1254–55.

⁹¹ *Id.* at 1256.

⁹² *Id.* at 1257 (Lourie, J., dissenting).

⁹³ *Id.* at 1258.

⁹⁴ *Id.*

⁹⁵ *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1298 (Fed. Cir. 2011).

⁹⁶ *Id.* at 1299.

⁹⁷ *Id.* at 1304–05.

⁹⁸ *Id.* at 1305, 1307.

⁹⁹ *Id.* at 1311.

¹⁰⁰ *Id.* (Rader, C.J., dissenting).

¹⁰¹ *Id.* at 1312.

¹⁰² *Id.* (quoting U.S. Patent No. 7,351,224 col. 19 l. 47 (filed July 17, 2000)).

¹⁰³ *Id.*

¹⁰⁴ *Id.*

¹⁰⁵ *Id.* at 1313.

Technologies, Inc. v. HemCon, Inc., it appears that the Federal Circuit judges are evenly divided over which approach is preferred.¹⁰⁶

In *Marine Polymer*, the issue was whether a claimed “biocompatible” substance could exhibit some amount of biological reactivity or whether it could not exhibit any biological reactivity.¹⁰⁷ Independent claim 6, for example, did not specify what was meant by biocompatible.¹⁰⁸ However, three dependent claims did—they differed from independent claim 6 only by specifying the amount of biological reactivity permitted under a certain kind of test.¹⁰⁹ Specifically, claim 12 required that the material exhibit no biological reactivity, claim 13 allowed slight biological reactivity, and claim 14 allowed mild biological reactivity.¹¹⁰ After reviewing the record, the district judge determined that the “biocompatible” substance could not exhibit any biological reactivity.¹¹¹

On appeal, an equally divided en banc panel could not agree whether this construction was correct.¹¹² The judges who agreed with the district judge found a description of “the invention” in the specification, which indicated to them that there could be “no biological reactivity.”¹¹³ The other half of the judges relied on claim differentiation to find that “[i]f ‘biocompatible’ requires that there be no reactivity, but these dependent claims require slight or mild reactivity, they are nullified and become utterly meaningless.”¹¹⁴

Unsurprisingly, Judge Lourie wrote the present-invention opinion.¹¹⁵ Surprisingly, Chief Judge Rader joined that opinion.¹¹⁶ Whatever his reason, the Chief Judge must have identified some factor strong enough to override what should have been—at least according to his opinion in *Retractable Technologies*—an “especially strong” presumption¹¹⁷ that the “biocompatible” substance could exhibit some biological reactivity. And, whatever this reason, it was not strong enough to overcome the “especially strong” presumption for the other half of the judges.

Phillips, Arlington Industries, Retractable Technologies, and Marine Polymer each demonstrate that the meaning of a claim term depends heavily on which of the two techniques is used. And, because claim construction is often dispositive, it follows that the choice of approach may also be dispositive.¹¹⁸ Although both techniques have merit,¹¹⁹ at least one commentator has noted that “[n]o matter which side is correct . . . , the more important point is that the debate should be . . . settled,

¹⁰⁶ *Marine Polymer Techs., Inc. v. HemCon, Inc.*, 672 F.3d 1350 (Fed. Cir. 2012) (en banc).

¹⁰⁷ *Id.* at 1355–56.

¹⁰⁸ *Id.* at 1355.

¹⁰⁹ *Id.* at 1368 (Dyk, J., dissenting).

¹¹⁰ See U.S. Patent No. 6,864,245 col. 72 ll. 33–41 (filed July 11, 2003).

¹¹¹ See *Marine Polymer*, 672 F.3d at 1355–56.

¹¹² *Id.* at 1372.

¹¹³ *Id.* at 1358.

¹¹⁴ *Id.* at 1368 (Dyk, J., dissenting).

¹¹⁵ *Id.* at 1354.

¹¹⁶ *Id.*

¹¹⁷ See *supra* note 79.

¹¹⁸ See *supra* note 14 and accompanying text.

¹¹⁹ See Jason Rantanen, *Arlington Industries v. Bridgeport Fittings: “The Specification is the Heart of the Patent,”* PATENTLY-O (Jan. 25, 2011), <http://www.patentlyo.com/patent/2011/01/arlington-industries-v-bridgeport-fittings-the-specification-is-the-heart-of-the-patent.html>.

one way or the other, for the sake of providing the trial courts a clear scheme for patent claim construction.”¹²⁰

IV. CLAIM CONSTRUCTION REVERSAL RATES MAY ERRONEOUSLY INDICATE SUCCESS

Until the debate is settled, the Pilot Program may not help district judges lower their claim-construction reversal rates.¹²¹ In any given patent case, parties typically dispute the meaning of certain claim terms, seeking definitions that will be helpful to their infringement and invalidity positions.¹²² In other words, for each disputed term, one party argues for a definition that is broad in scope, and the other party argues for a definition that is narrow in scope. A district judge must determine the meaning and scope of these disputed terms under the spectre of the Federal Circuit’s two divergent methodologies. On appeal, using *Marine Polymer* as an indicator, it appears that the Federal Circuit may apply the same approach as the district judge about half of the time. Because choice of approach is largely outcome determinative,¹²³ the rate of reversal may be correspondingly high—an observation that various empirical studies tend to support.¹²⁴ This result likely depends more on the judges who hear the appeal than on the district judge’s experience.

Viewed in this light, the dual-framework divide at the Federal Circuit may impart a systematic error into the Pilot Program experiment. Insofar as one of the two frameworks may be regarded as being “incorrect,” this framework can be considered a source of bias that leads to erroneous reversals and affirmances.¹²⁵ Thus, in the current dual-framework regime, claim-construction reversals may be an imprecise measure of claim-construction quality, and any correlation between these reversals and judicial experience may also lack pragmatic significance. Worse, if increased judicial expertise with patent law were to actually result in improved claim-construction quality, it would likely be difficult to reliably conclude this result from the reversal rate.

Recently, the Supreme Court passed over an opportunity to resolve the debate when it denied a petition for certiorari in *Retractable Technologies*.¹²⁶ Still, future opportunities for the Supreme Court to weigh in may arise.¹²⁷ For example, *Marine Polymer*, which remains mired at the Federal Circuit, stayed by a bankruptcy

¹²⁰ Wegner, *supra* note 35; accord Wagner & Petherbridge, *supra* note 7, (manuscript at 30). Professors Polk and Wagner put a finer point on it: “[T]hese problems, although real, pale in comparison to the damage wrought by the pervasive uncertainty, perverse incentives, and technological amateurishness created by . . . *Phillips*.” Wagner & Petherbridge, *supra* note 7, (manuscript at 30).

¹²¹ See *supra* note 30 and accompanying text.

¹²² See Edward D. Manzo, *How to Improve Patent Claim Interpretations*, 22 FED. CIR. B.J. 203, 205 (2012).

¹²³ See *supra* note 17 and accompanying text.

¹²⁴ See *supra* note 17 and accompanying text.

¹²⁵ See Schwartz, *Courting Specialization*, *supra* note 6, at 1731–32.

¹²⁶ *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296 (Fed. Cir. 2011), *cert. denied*, 81 U.S.L.W. 3364 (U.S. Jan. 7, 2013) (No. 11-1154).

¹²⁷ See Ryan Davis, *Top Court’s Denial Won’t Be Last Word on Claim Construction*, LAW360 (Jan. 7, 2013, 7:56 PM), http://www.law360.com/ip/articles/405077?nl_pk=237395db-b119-4061-bf20-e44144ac10b9&utm_source=newsletter&utm_medium=email&utm_campaign=ip.

petition, may become one opportunity.¹²⁸ If the Supreme Court were to grant certiorari in such a case and choose one of the Federal Circuit's two approaches, it could help increase the likelihood that the Pilot Program will be a success.

CONCLUSION

For the Pilot Program to be successful according to its own measures, district judges must decrease their reversal rates, particularly for their claim constructions. Currently, however, it appears that claim-construction reversal rates may be an erroneous indicator of success because a district judge cannot know which of the Federal Circuit's two claim-construction frameworks will be applied on appeal. Because a uniform approach to claim construction is better than a claim-game of chance, the Supreme Court could grant a writ of certiorari in a future case, such as, perhaps, *Marine Polymer*, and choose a single framework. Under a single framework, the claim-construction reversal rate may become a meaningful indicator of the Pilot Program's success.

¹²⁸ See Letter to All Counsel Regarding Bankruptcy Petition and Staying of Case, *Marine Polymer v. Hemcon*, No. 2010-1548 (Fed. Cir. May 4, 2012), ECF No. 105; Defendant-Appellant Hemcon, Inc.'s Petition for Rehearing En Banc at 1 & n.1, *Marine Polymer v. Hemcon*, No. 2010-1548 (Fed. Cir. Apr. 16, 2012), ECF No. 99 (noting that "it is unusual to request rehearing of an *en banc* decision," but that the request was filed "out of an overabundance of caution" in light of the bankruptcy stay); Erik Siemers, *HemCon Tests Patent Law*, PORTLAND BUS. J. (Apr. 27, 2012, 3:00 AM), <http://www.bizjournals.com/portland/print-edition/2012/04/27/hemcon-tests-patent-law.html?page=3>.