

PHILLIPS V. AWH CORP: WHICH WAY IS THE WIND BLOWING?

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Today the U.S. Court of Appeals for the Federal Circuit reheard en banc the claim interpretation case of Phillips v. AWH Corp., 363 F.3d 1207 (Fed. Cir. 2004). In that case, the court had previously ruled that the word “baffle” as used in the patent claims was limited to a baffle that was formed at an angle other than 90 degrees. Although the dictionary definition for “baffle” was broad, the Federal Circuit concluded that the specification disclosed only an embodiment having baffles with an angle other than 90 degrees, which was required to deflect bullets. Judge Dyk dissented, noting that the narrow interpretation was contrary to the plain meaning in the dictionary. The Federal Circuit later vacated the panel decision and ordered rehearing en banc, 376 F.3d 1382 (Fed. Cir. 2004), including briefing and argument on the following questions:

- (1) Is the public notice function of patent claims better served by referencing primarily to technical and general purpose dictionaries and similar sources to interpret a claim term or by looking primarily to the patentee’s use of the term in the specification? If both sources are to be consulted, in what order?
- (2) If dictionaries should serve as the primary source for claim interpretation, should the specification limit the full scope of claim language (as defined by 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?
- (6) What role should prosecution history and expert testimony by one of ordinary skill in the art play in determining the meaning of the disputed claim terms?
- (7) Consistent with the Supreme Court’s decision in Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996), and our en banc decision in Cybor Corp. v. FAS Technologies, Inc., 138 F.3d 1448 (Fed. Cir. 1998), is it appropriate for this court to accord any deference to any aspect of trial court claim construction rulings? If so, on what aspects, in what circumstances, and to what extent?

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(8) [Separate concurring opinion by Judge Rader only]: Is claim construction 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?

Today's rehearing before all 12 active Federal Circuit judges afforded the court an opportunity to consider these and other issues. Following my observations below is a summary of the oral argument as it occurred.

It is always risky to predict the outcome of a particular case. It is even more risky to predict how the Federal Circuit will change the law of claim interpretation based on the facts of this one case. Nevertheless, I have set forth below my observations and thoughts as to which way the wind is blowing in this field of the law. Keeping in mind that a majority of the full court voted to rehear this case en banc, suggesting that the prior panel reached the wrong result or at least articulated the wrong reasoning for reaching that result, here are my predictions.

First, I think that Phillips (the patent owner) will win. The most likely outcome is that the Federal Circuit will reverse outright based on the meaning of the word "baffle" as evidenced by the dictionary meaning, which is consistent with (not contradicted by) the specification or prosecution history. The defendant will be unable to point to anything else that would provide a basis for a narrow definition of "baffle" requiring bullet resistance or specific angles.

Second, many of the judges seemed to agree with the proposition that blind reliance on dictionaries to interpret the words of a claim does not represent a correct analysis. It seemed that some of the language in Texas Digital to the contrary may be overruled or at least distinguished, and the court may issue cautionary language to the effect that it is erroneous to blindly rely on dictionaries to define claim terms.

Third, it seemed that many of the judges agreed with the proposition that it was entirely appropriate to start with a dictionary definition (as opposed to other sources of interpretation, such as the specification, or a technical treatise or testimony of one skilled in the art) as long as the dictionary definition did not receive any primacy over the other sources. As Judge Clevenger stated during argument, it makes no difference in the information gathering phase which of the many sources one begins with, as long as the importance of the dictionary source is not elevated above other sources when applying the various sources to discerning the meaning of a word or claim term. So, reliance on dictionaries and/or technical treatises will likely continue, as long as such reliance does not trump consideration of the patent specification, prosecution history, and any other evidence (e.g., testimony regarding what one of ordinary skill in the art would understand a disputed term to mean).

Fourth, based on the questioning, I suspect that the Federal Circuit will emphasize the importance of the patent specification and prosecution history for primacy in claim interpretation. However, I suspect that the court will require a higher standard before importing statements or drawing features from the specification into the claims. I believe the court will require either (a) a reasonably clear explicit definition for a term in the specification or prosecution history; (b) a clear disavowal of meaning in the specification or prosecution history; or (c) implicit yet strongly-worded meanings regarding claim scope that are something other than mere statements of invention objectives or mere existence of a single embodiment described in the specification. It seems to me that the latter category has caused the most problems, and this is where the court may tighten things up a bit. This may require distinguishing or overruling cases like Bell Atlantic, where terms were defined "by implication." As Solicitor Whealan pointed out during argument, recent cases like Bard and Astrazeneca – where implicit meanings were held to restrict the claims – can be harmonized with Brookhill, where nothing was found in the specification or prosecution history to limit the meaning of "remote."

Fifth, it seems to me that where a patent recites multiple purposes and objectives, none of those will be read into the claims, unless there is a "clear disavowal" or reasonably clear definition tied to a claim term. Several of the judges appeared to have difficulty with determining which of the various competing objectives stated in the

specification should limit the scope of the claims. As Phillips convincingly pointed out, different sets of judges relied on different objectives in the patent in this case, thus giving rise to many of the difficulties in claim construction.

Sixth, it seemed to me that none of the judges challenged Phillips's argument that ordinary terms could be understood by relying on an ordinary dictionary, whereas terms of art could be understood by relying on a technical treatise or dictionary. After all, specifications may not define simple words such as "at" or "on," or may rely on technical terms such as "transistor" without defining what is meant by such a term. I would not be surprised to see some language along these lines in a majority opinion. There was not much discussion about picking among multiple dictionary definitions. I predict that any dictionary definition consistent with the usage in the specification and prosecution history will be permitted.

Seventh, it is possible that the Federal Circuit will change its mind and decide to give deference to a lower court's claim interpretation rulings to the extent that such rulings are based on credibility determinations. For example, if a district court accepts testimony from two witnesses regarding what a person of ordinary skill in the art would understand a disputed claim term to mean, to the extent the lower court rejected testimony from one over the other based on credibility, the Federal Circuit might grant deference as to that rejection. This seems to run counter to the principles of Cybor and other cases, but it is possible that a compromise could emerge.

As for dissents and concurring opinions, I predict that Judge Lourie will dissent, concluding that the specification in this case had enough suggestions regarding bullet-deflecting properties as to become a limitation of the claims. I predict that Judge Mayer will concur, writing that Cybor and Markman have gone too far. (Note his dissenting opinion in the en banc rehearing order). Judges Rader and Newman, who also favor deference generally, may join that opinion. I suspect that all remaining judges will join the majority opinion, with a few concurring opinions.

Finally, I predict that the U.S. Supreme Court will grant certiorari in this case in view of the morass of case law involving claim interpretation. The Supremes haven't taken a patent case in a few years, and it's time for another one.

How will this decision impact companies that own patents or are accused of infringing a patent? Hopefully it will make the process more predictable – and thus less costly -- for both plaintiffs and defendants. The process of interpreting a patent claim is the single most important phase of a lawsuit and any later appeal. As demonstrated by recent cases, it usually means the difference between a patent being infringed or not infringed. Recent cases have turned on the meaning of such mundane words as "to," "on," and "at." I think the Federal Circuit has heard the message, propounded through recent articles and studies showing a high claim reversal rate and panel-dependent outcomes, that claim interpretation is killing us.

Detailed Notes From En Banc Rehearing on February 8, 2005

Manthie (counsel for Phillips): The term “baffle” is described in the specification as having many different purposes, such as for containing sound; for repelling bullets; for load-bearing purposes; and for containing heat. Only one of the disclosed baffles is the preferred embodiment. Figures 4 and 7 of the patent show different types of baffles.

Lourie: Doesn’t the specification define the word “baffle?” The only baffles disclosed in the specification are those that are numbered in the figures and show an angle less than 90 degrees?

A: Figure 7 shows a piece that is a baffle, which is described in col. 2 as “baffle construction.” So, not all baffles are numbered in the figures.

L: Are you saying we should rely on a dictionary?

A: No, you should read the specification first, then the claims. If the claims are broader than the specification, then you should rely on the (broader) claims. The purpose of the specification is to provide written description and enablement, not to narrow the claims. There are 3 types of terms: (1) ordinary terms – not a term of art – rely on general usage, such as in a dictionary; (2) terms of art, for which a technical dictionary or treatise should be consulted; and (3) [cut off]

Linn: Should the ordinary meaning in a claim term govern, or should the specification control the scope of a claim term?

A: The claims should control, not the specification. Only if there is a clear disavowal of scope in the specification or a clear definition should a narrower claim scope be adopted.

Dyk: If the claims are broader than the specification, doesn’t that create a problem?

A: No, the specification is written to satisfy the written description, enablement, and best mode requirements, not to define the scope of the claims.

Gajarsa: Don’t you always start by reading the patent?

A: Yes, you read the patent, then the claims.

G: When do you use a dictionary?

A: If it’s an ordinary term, then you can rely on a dictionary to see if there is a definition that fits with the specification.

G: If baffle has different functions in the patent, how do we resolve which one controls?

A: An ordinary person would know that the main function of the baffle in the patent is its load bearing function. The patent never says that the baffles are “bullet proof.” Item 16 [in the figure?] is described as possibly deflecting a bullet if one is fired. But you could have different shapes and it would still deflect a bullet.

Lourie: If you use different shapes, then isn’t that a different invention?

A: These are not the only possible configurations – it merely shows that there are at least 4 configurations. Figure 7 shows baffles at a 90-degree angle. There is no reason for the main function (load bearing) to be limited to a certain angle.

Bryson: So the specification can be limiting if there is a clear definition, but what about an implicit narrowing, as in Vitronics? Can the specification limit by implication?

A: No, that's where the problem arises. Different people have different interpretations of the specification. It's like the famous Supreme Court case – you know pornography when you see it. The devil is in the details of "implicit." Judge Krieger [district judge in this case] said that "baffle" required both an angle limitation and an interlocking limitation. The prior panel decision in this case said that only the angle was required by the specification. Judge Dyk in dissent said the specification required neither limitation. There are just too many possibilities. Nothing in the claim mentions the function of deflecting bullets.

Fischer (counsel for AWH): The Supreme Court long ago said in the Adams case that claims must be interpreted in light of the specification – the court must ascertain what is the invention?

Michel: Focus on where you disagree with Mr. Manthie. What did he say that you disagree with?

A: The court should read the specification first, not a dictionary first.

M: What does "primary" mean?

A: It is the touchstone – the source against which all other definitions are assessed.

Linn: Where in the specification is there a definition of "baffle"?

A: It is not expressly defined, but the specification at col. 6 lines 10-17 states that several advantages are obtained, including thermal isolation and protection from bullets. That tells us what the invention is.

Lourie: What about the 6 numbers in the specification?

A: Those identified the versions of baffles.

L: You mean embodiments?

A: Yes, embodiments of the baffle. The only ones. The baffles are discussed in column 2 at lines 11-15 (formed interlocking baffles).

Clevenger: Are there baffles shown in Fig. 7?

A: Yes. They extend and form an intermediate barrier.

Lourie: Isn't that really a support for the baffles, rather than a baffle?

A: It's not clear in the specification. The specification says that the baffles are for the purpose of deflecting bullets.

Clevenger: If you shoot a bullet through the wall, would it be deflected?

A: Yes.

C: So that piece must also be a baffle? It meets the definition of baffle?

A: yes, but you must ascertain the invention. It must be other than 90 degrees to deflect.

C: But we are looking at the process – what is your position on “implicit narrowing” based on the specification? Should we require an explicit narrowing in order to narrow a claim term?

A: Implicit narrowing is proper.

C: How can we tell if something has been “implicitly narrowed?”

A: If an element is described as essential to the invention, and there are no other examples given, then it is implicitly narrowed.

C: Should we rely on the “purposes” of the invention? Must it be unequivocally expressed? What if it’s a “multi-purpose patent?”

A: [none]

Dyk: Where does the patent say that acute angles are essential to the invention?

A: The patent lists various advantages: modular and bullet resistance; modules, and acoustic isolation.

Rader: Is something a “baffle” if it meets only two of the purposes? What if it meets three of the four “purposes?”

A: The only function of the baffles is being bullet proof. There is nothing in the patent regarding heat or sound isolation.

Rader: But column 4 says baffles are load bearing? The patent also discusses thermal buffering? How is the judge to decide among these 4?

A: You must look at the meaning of baffle. A baffle is modified by load supporting. The load supporting function is not part of the word “baffle.”

Rader: Must a baffle perform all 4 functions?

A: No, but a baffle must at least deflect bullets.

Michel: Is it clear that only angled baffles can deflect bullets? It seems to me that even a parallel baffle would deflect bullets?

A: It must be other than 90 degrees to deflect bullets.

Bryson: What if you fired a bullet at it and the baffle was at other than 90 degrees?

A: There are 2 essential elements for a baffle: (1) it must be other than 90 degrees; and (2) it must be a barrier within the module.

Gajarsa: There is nothing in the specification regarding the angle of any particular degree? How do we get to that?

A: The claims cover a broad range of angles, including figures 6-7. It includes 45 degrees, bent, and multiple angles.

G: So where does the non-90 degree requirement come from?

A: A substantial portion of the baffle must be at an angle other than 90 degrees.

Dyk: What about claim differentiation? Dependent claims recite angles?

A: Claims 1-2: claim 1 covers a large range of angles; it must project inwardly. Claim 1 corresponds to figures 6-7. Claim 2 is limited to figure 6, where there is an angle alpha incident.

D: But claim 2 adds an angled baffle that was not present in claim 1?

A: Both claims have baffles. Claim 2 is different in scope – it deals with the angle.

Clevenger: Claim 2 was not asserted against you? Why can't claim 1 include 90 degrees? You agree that a 90 degree angle could deflect a bullet?

A: The baffles must be both 90 degrees and ---

C: So you agree that claim 1 includes right angles?

A: The baffle must form an intermediate barrier to deflect. Claim 7 –

Newman: There was a concession by the plaintiff, that if the claims are limited by the specification, then there is no infringement? One way of reading a patent is to say that the claims are part of the specification. So if you just look at the specification, the weight of the specification has a baffle with limitations. But what about the broader disclosure in the claims, which are not limited in the way the specification is?

A: The claims are part of the specification. It is wrong policy to allow the claims to be broader than what is taught by the specification.

Michel: Is this dispute over whether an implicit definition is permissible?

A: Yes, but the briefs suggested that dictionaries were the dispute.

Rader: What about complex biotech or electrical inventions? Should the Federal Circuit defer to the district court?

A: Yes.

R: On what basis?

A: Yes, but the case law of this court says no.

Mayer: What deference should be accorded?

A: We advocate a middle standard – findings of fact would be subject to Rule 52 – parts of claim interpretation.

Clevenger: Can you give some examples?

A: The nature of the art; the nature of the person of skill in the art; determining what resource is used by a person skill (dictionaries); and credibility of experts.

C: What about the ordinary meaning of customary terms? Is that a fact?

A: --

Manthei (rebuttal): We only conceded summary judgment based on all the findings, so if there are any changes, there should be a remand. A person of ordinary skill in the art would see that the load bearing feature – must have a flange or bend. Also spaced together.

Mayer: Are these facts?

A: Yes, from a treatise, the district judge found these. As to deference, we agree on deference as to “pure” facts, but not mixed facts.

Gajarsa: Do we need a dictionary in this case?

A: No, there was a stipulated definition, but we agree on the dictionary.

Prost: So there is no dispute on the facts?

A: Judge Krieger –

Dyk: There was no testimony regarding the meaning of “baffle?”

A: No, we argued it was not a term of art.

Linn: If we use the dictionary, then which one, and what meaning(s) from that dictionary?

A: The parties should get deference. The patent owner might propose multiple definitions, and the defendant would propose narrower definitions. Then the court should narrow it down to two competing definitions. Then we can run those through the specification. If they are both plausible, then OK.

L: ---

A: Any dictionary for common terms, and a treatise for technical terms.

Newman: What if it’s not in litigation? Persons read patents for technical information. We can’t impose an elaborate structure on these people? You read the specification as a whole and figure out what was claimed? Don’t you begin with the specification? What about priority of sources?

A: The invention is defined by the claims. If the claims are broader than the specification, then it’s OK unless there is an explicit narrowing.

N: What about enablement?

A: That’s not at issue here. The specification doesn’t indicate breadth. That’s the purpose of the claims.

Lourie: Mustn’t the specification enable the full scope of the claims?

A: Yes.

Michel: If we agree with you about restricting implicit redefinitions, what about our prior case law such as Bell Atlantic?

A: The reason this court went en banc was to set some guidelines. Maybe it can be implicit if it is very clear.

Whealan (representing the U.S. government): --

Rader: The PTO relies on “broadest reasonable interpretation” which is different than courts?

A: Yes, the applicant has the opportunity to amend or clarify the scope at the PTO.

R: Would it help if the PTO relied on the same scope as courts? Doesn’t that create a problem?

A: No, we would keep it as is. The PTO performs a gatekeeper function. If the scope is unclear, let the applicant amend around it.

Dyk: What is the basis for saying that examiners don’t use dictionaries?

A: It’s a training issue – they typically don’t use them.

D: But doesn’t the MPEP say to use dictionaries?

A: Yes, but as a practical matter they are not used.

Clev: Don’t the examiners carry dictionaries in their heads?

A: Yes, but they all have different dictionaries. Examiners have specialized knowledge. They start with the specification, not dictionaries. As to the “battle of the dictionaries” problem, just to clarify, we suggest starting with the specification, not a dictionary. The Superguide concurrence – start with the ordinary meaning to a person of skill in the art as used in the art. Don’t start with a dictionary.

C: What if it’s a technical term? Is it OK to use an EE dictionary that the parties agree on?

A: It’s irrelevant what you read first. The key is: what weight should be given to it?

C: Is it OK to rely on a dictionary? Is it error to use a regular dictionary if it’s a technical term?

A: If you are dealing with sequencing, that word means something different in electronics and biotech.

Prost: You are saying who cares about the order? The PTO doesn’t start with the dictionary?

A: There is nothing wrong with the order.

Clevenger: Should we overrule our prior cases?

A: It should be clarified that the starting point is not the dictionary.

C: But it’s OK to read it first?

A: What one reads first is irrelevant – what one relies on first is critical. It’s like legislative history analysis. It’s OK to gather evidence in any form, but you start with the specification for reliance. Don’t start with the dictionary.

Dyk: The Supreme Court in statutory construction says to start with the dictionary?

A: But the dictionary doesn’t reflect one skilled in the art. The place to start is the specification.

D: What if there is nothing explicit in the specification?

A: Yes, it’s OK to rely on implicit definitions or meanings from the specification. The Novartis case – not all terms were expressly defined. The next point is – when does the specification narrow a claim term? Look at the Bard and

Astrazeneca cases. A detailed analysis of the specification and prosecution history. In Brookhill, the same analysis was applied – “remote” was not limited by the specification or prosecution history. So broader is fair. The Brookhill and Bard cases are instructive.

Rader: Should there be deference to the district court on fact-finding?

A: The court has not taken that issue en banc. The government has no position on that.

R: Answer the question. What fact components would have deference?

A: 499 U.S. 225: The Supreme Court has said that even if something is de novo, you don’t start from scratch. You see if the lower court was persuasive. See Judge Bryson’s concurrence in Cybor.

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