

# **Claim Construction Update: *Phillips and Beyond***

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# Background: The *Phillips* Decision

# The Landscape Before *Phillips*: Acknowledged Confusion

- “This case again illustrates the **conflict** generated in the court’s recent jurisprudence of claim construction.” *Housey Pharmaceuticals, Inc. v. Astrazeneca UK Ltd.*, 366 F.3d 1348, 1357 (Fed. Cir. 2004) (Newman, J., dissenting).

# The Landscape Before *Phillips*: What Was Considered First?

- A dictionary definition? “It is well settled that under our precedent in *Texas Digital Sys., Inc. v. Telegenix, Inc.*, . . . we look first to the dictionary definition of a contested term.” *Kumar v. Ovonic Battery Co., Inc.*, 351 F.3d 1364, 1367 (Fed. Cir. 2003)
- Or the specification and other intrinsic sources? “It is well-settled that, in interpreting an asserted claim, the court should look first to the intrinsic evidence of record, i.e., the patent itself, including the claims, the specification and, if in evidence, the prosecution history.” *Liquid Dynamics Corp. v. Vaughan Co., Inc.*, 355 F.3d 1361, 1367 (Fed. Cir. 2004)

# The Landscape Before *Phillips*: Was Extrinsic Evidence Appropriate?

- Only when the intrinsic evidence was ambiguous? “Resort to extrinsic evidence is appropriate only when an **ambiguity** remains after consulting the intrinsic evidence of record.” *Storage Tech. Corp. v. Cisco Systems, Inc.*, 329 F.3d 823, 831 (Fed. Cir. 2003).
- Or in all cases? “[F]ailure to take into account the testimony of persons of reasonable skill in the art may constitute reversible error.” *AFG Indust. Inc., v. Cardinal IG Co.*, 239 F.3d 1239, 1249 (Fed. Cir. 2001).

# The Landscape Before *Phillips*: What Dictionary Definitions?

- All definitions unless the intrinsic record clearly rebuts? “[A] word that has an ordinary meaning encompassing two relevant alternatives may be construed to encompass both alternatives.... However, before finally concluding that the term encompasses both meanings, we must determine whether the specification or prosecution history clearly demonstrates that only one of the multiple meanings was intended.”

*Inverness Medical Switzerland GmbH v. Princeton Biomeditech Corporation*, 309 F.3d 1365, 1379 (Fed. Cir. 2002).

# The Landscape Before *Phillips*: What Dictionary Definitions?

- Or only some dictionary definitions (or none of them?) “In construing claim terms, the general meanings gleaned from reference sources, such as dictionaries, must always be compared against the use of the terms in context, and the intrinsic record must always be consulted to identify which of the different possible dictionary meanings is most consistent with the use of the words by the inventor.”

*Brookhill-Wilk 1 v. Intuitive Surgical, Inc.*, 334 F.3d  
1294, 1300 (Fed. Cir. 2003)



# The Landscape Before *Phillips*: What Was the Specification's Role?

- Simply to overcome dictionary definitions? “The *Texas Digital* court suggests that when construing the words of a claim, the court should first determine the ordinary and accustomed meanings of disputed claim words through an examination of relevant dictionaries, encyclopedias, or treatises. This determination will reveal the broadest definition of those terms as understood by one of skill in the art. Having made that determination, the court must next examine the written description and prosecution history to determine whether . . . that scope has necessarily been limited as a result of the patentee clearly setting forth an inconsistent definition of the disputed term or otherwise disavowing or disclaiming the full scope of the term's meaning.”

*Tulip Computers, Intern. B.V. v. Dell Computer Corp.*, 236 F. Supp. 2d 364 (D. Del. 2002).

# The Landscape Before *Phillips*: What Was the Specification's Role?

- Or as the principal source of meaning? “In most cases, the best source for discerning the proper context of claim terms is the patent specification wherein the patent applicant describes the invention. . . . Therefore, the primary aids to supply the context for interpretation of disputed claim terms are in the intrinsic record.”

*Metabolite Laboratories, Inc. v. Laboratory Corp. of America Holdings*, 370 F.3d 1354, 1360 (Fed. Cir. 2004).

# *Phillips*: The Role of the Specification

- In *Phillips*, the Federal Circuit, sitting en banc, addressed the “principal question” of “the extent to which we should resort to and rely on a patent’s specification in seeking to ascertain the proper scope of its claims.”

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

# Section 112 Frames the Inquiry

- “The first two paragraphs of section 112 frame the issue of claim interpretation for us. The second paragraph requires us to look to the language of the claims to determine what ‘the applicant regards as his invention.’ On the other hand, the first paragraph requires that the specification describe the invention set forth in the claims.”

*Phillips*, 415 F.3d at 1312.

# The Focus Is Still on the “Ordinary Meaning”...

- “We have frequently stated that the words of a claim ‘are generally given their ordinary and customary meaning.’”

*Phillips*, 415 F.3d at 1312 (citing, among others, *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998)).

## ...At the Time of the Invention

- “We have made clear, moreover, that the ordinary and customary meaning of a claim term 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.**”

*Phillips*, 415 F.3d at 1313.

# The Purpose of “Ordinary Meaning”: To Provide an Objective Baseline

- “The inquiry into how a **person of ordinary skill in the art** understands a claim term provides an objective baseline from which to begin claim interpretation.”

*Phillips*, 415 F.3d at 1312.

# Context Is Key

- The key to claim construction is proper context:  
“Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.”

*Phillips*, 415 F.3d at 1313.



# Interpretative Tools: The Claim Language Begins the Inquiry

- “To begin with, the context in which a term is used **in the asserted claim** can be highly instructive.”
- Hence “the use of a term **within the claim** provides a firm basis for construing the term.”
- “**Other claims** of the patent in question ... can also be valuable sources of enlightenment ... .”

*Phillips*, 415 F.3d at 1314.

## . . . but the Specification Often Ends It . . .

- Claims “do not stand alone. Rather, they are part of ‘a fully integrated written instrument, consisting principally of a **specification** that concludes with the claims.’”

*Phillips*, 415 F.3d at 1315 (citations omitted).

- Thus “the specification ‘is always highly relevant to the claim construction analysis. **Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.**”

*Id.* (citations omitted).

## . . . Because the Claim Terms and Specification Are Inextricably Linked

- The claims are based on the specification: The specification is the single best guide to a disputed term's meaning because “the words of the claims must be based on the description. **The specification is, thus, the primary basis for construing the claims.**’ On numerous occasions . . . , we have reaffirmed that point, stating that ‘[t]he best source for understanding a technical term is the specification from which it arose . . . .’”

*Phillips*, 415 F.3d at 1315 (citations omitted).

# An Easy Case: When The Specification Acts As a Dictionary

- Specification can act as a dictionary: “the specification “acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication.”

*Phillips*, 415 F.3d at 1321.

# Role of Prosecution History

- Discounted usefulness slightly: “[B]ecause the prosecution history represents an **ongoing negotiation** between the PTO and the applicant, rather than the final product of that negotiation, it often **lacks the clarity** of the specification and thus is **less useful for claim construction purposes.**”

*Phillips*, 415 F.3d at 1317.

## Extrinsic Evidence—Admissible, but Limited

- Extrinsic evidence has its limits: While extrinsic evidence “can shed useful light on the relevant art,” we have explained that it is “**less significant** than the intrinsic record in determining ‘the legally operative meaning of claim language.’”

*Phillips*, 415 F.3d at 1321.

- But courts retain discretion to consider it: “[B]ecause extrinsic evidence **can help educate the court** regarding the field of the invention and can help the court determine what a person of ordinary skill in the art would understand claim terms to mean, it is permissible for the district court in its **sound discretion** to admit and use such evidence.”

*Id.* at 1319.

# Expert Testimony and its Limits

- Expert testimony has its limits: “[E]xtrinsic evidence consisting of expert reports and testimony is generated at the time of and for the purpose of litigation and thus **can suffer from bias** that is not present in intrinsic evidence. The effect of that bias can be exacerbated if the expert is not one of skill in the relevant art or if the expert’s opinion is offered in a form that is not subject to cross-examination.”

*Phillips*, 415 F.3d at 1318.

# Problems With Dictionaries . . .

- “The main problem with elevating the dictionary to such prominence is that it focuses the inquiry on the **abstract meaning of words** rather than on the meaning of claim terms within the **context of the patent.**”

*Phillips*, 415 F.3d at 1321.



## . . . Even Technical Dictionaries

- “Even technical dictionaries or treatises, under certain circumstances, may suffer from some of these deficiencies. **There is no guarantee that a term is used in the same way in a treatise as it would be by the patentee.** In fact, discrepancies between the patent and treatises are apt to be common because the patent by its nature describes something novel.”

*Phillips*, 413 F.3d at 1322.

# Dictionaries Still Have A (Limited) Role . . .

- “[J]udges are free to consult dictionaries and technical treatises ‘at any time in order to better understand the underlying technology and may also rely on dictionary definitions when construing claim terms, so long as the dictionary definition **does not contradict** any definition found in or ascertained by a reading of the patent documents.’”

*Phillips*, 413 F.3d at 1322-23.

## . . . But Are Not a Primary Source Merely Kept in Check by the Specification

- “In effect, the *Texas Digital* approach limits the role of the specification in claim construction to serving as a check on the dictionary meaning of a claim term if the specification requires the court to conclude that fewer than all the dictionary definitions apply, or if the specification contains a sufficiently specific alternative definition or disavowal. . . . That approach, in our view, improperly restricts the role of the specification in claim construction.”

*Phillips*, 413 F.3d at 1320.

# Bottom Line: No Formulaic Approach

- “The sequence of steps used by the judge in consulting various sources is not important; what matters is for the court to attach the **appropriate weight** to be assigned to those sources in light of the statutes and policies that inform patent law.”

*Phillips*, 415 F.3d at 1324.

# Final Point: *Cybor* Undisturbed

- Still no deference to district court claim construction rulings: “After consideration of the matter, we have decided not to address that issue at this time. **We therefore leave undisturbed our prior en banc decision in *Cybor*.**”

*Phillips*, 415 F.3d at 1328.

# Panel Discussion Points

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- Contextual Role of Specification and Claims
  - Claims then Specification
  - Differentiation
  - “Patent Profanity”
- What of Extrinsic Evidence?
- Prosecution History: Clarity and Disclaimer
- “Validity Preserving” Constructions

# Contextual Role of Specification & Claims



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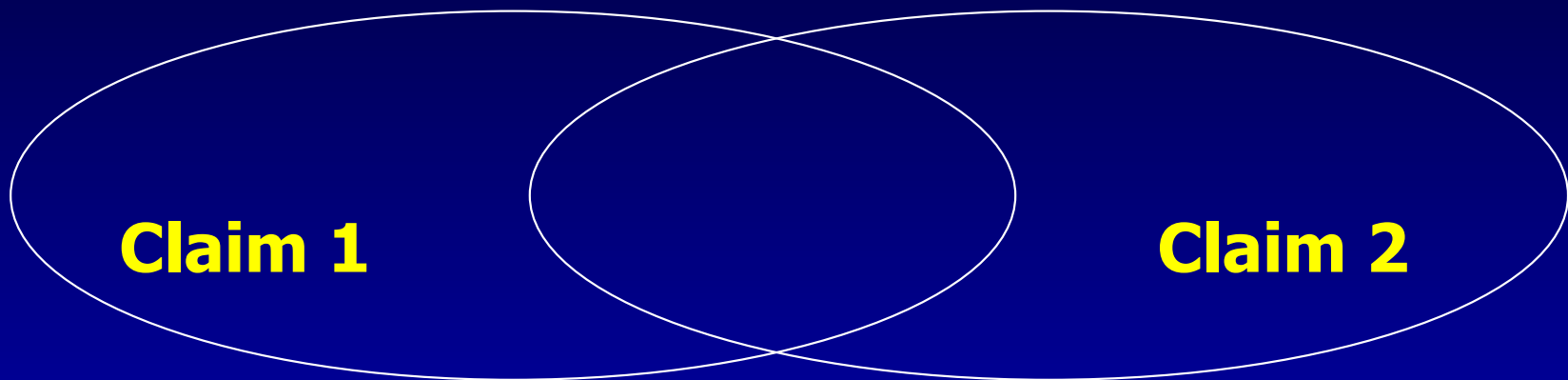
- “To begin with, the context in which a term is used **in the asserted claim** can be highly instructive. ... **Other claims** of the patent in question, both asserted and unasserted, can also be valuable sources of enlightenment as to the meaning of a claim term.”

*Phillips*, 415 F.3d at 1314 (citations omitted).

- “[T]he specification ‘is always highly relevant to the claim construction analysis. **Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.**’”

*Id.* at 1315 (citations omitted).

# A Consistent Construction of Claim Terms May Itself Dictate Outcome



- Same term appearing in two claims can require a construction that is logically consistent in the context of both claims even if it would exclude a disclosed embodiment.

*See Schoenhaus v. Genesco.*, 440 F.3d 1354, 1357  
(Fed. Cir. 2006)

# Even If Embodiment Not Covered

- [P]laintiffs urge ... a claim construction that allows **other parts of the shoe**—not just the insert or immovable insert portion—to meet claim limitations. In support of this argument, plaintiffs point to language in the specification that states that their ‘invention’ is both an **insert** and a ‘**shoe [ ] built to have the shape of the interior of the insert**’. Plaintiffs’ contention regarding the invention as disclosed is correct; however, the term ‘orthotic device’, as used in the claims, has a specific meaning which must be determined from the intrinsic evidence.

*Schoenhaus*, 440 F.3d at 1356 (citations omitted).

## ... but Specification can Support Broad Construction

- District court erred in interpretation of claim limitations in a way that “conflict[ed] with the plain meaning of [the] claim” and “exclude[d] embodiments disclosed in the specification.”

*Lava Trading, Inc. v. Sonic Trading Mgmt., LLC*,  
2006 U.S. App. LEXIS 9708, 12-13 (slip op. at 10)  
(Fed. Cir. April 19, 2006).

## ... or May Define an Outer Boundary

- In *On Demand Mach. Corp. v. Ingram Indus.*, the Federal Circuit noted that claim construction proceedings in 2002-03 took place, “at a time when **conflicting Federal Circuit panel opinions** were producing uncertainty as to the law of claim construction.” 442 F.3d 1331, 1337 (Fed. Cir. 2006).
- “[T]he court in Phillips, **resolving conflict**, stressed the **dominance of the specification** in understanding the scope and defining the limits of the terms used in the claim.” *Id.* at 1337-38.
- “In general, the scope and **outer boundary** of claims is set by the patentee’s description of his invention.” *Id.* at 1338 (citing *Phillips*).

# Construction of Terms by the District Court

- **Customer:** “The word ‘customer’ is ‘one who buys goods or services’ and, is **not limited to a retail customer.**” 442 F.3d at 1339 (quoting jury instruction).
- **Printing on Paper Pages:** “This clause requires the printing of one or more books. The term ‘paper pages’ **does not require the text to be printed on sheets of paper,** as opposed to being printed on continuous rolls or any other of a variety of forms of paper ... .” *Id.* at 1342 (quoting jury instruction).

# Specification Limited Customer to “Retail Customer”

- “In Phillips, the *en banc* court explained that the role of the specification is to describe and enable the invention. In turn, the **claims cannot be of broader scope than the invention that is set forth in the specification**. Although we agree with the district court that the Ross invention does not concern itself with whether the “customer” reads the book or obtains it for resale, the focus of the Ross patent is immediate single-copy printing and binding initiated by the customer and conducted at the customer's site. The **district court's definition of “customer” cannot eliminate these constraints** in order to embrace the remote large-scale production of books for publishers and retailers.

442 F.3d at 1340 (emphasis added, citations omitted)

# Printing on Paper Pages Limited to “Printing on Individual Pages”

- The Court noted “[t]he specification states that the patented invention is the printing of individual copies of books at the customer site rather than in a ‘factory setting,’ ... and illustrates a ‘page printer 26,’ which prints a ‘stack of paper text pages,’ ... showing page-size paper. 442 F.3d at 1342 (citations omitted).
- The Court concluded “[t]he Ross invention, and the claims, are directed to the on-site printing and binding of a single copy, for which printing on large webs and the requirement of cutting to page size would require equipment and procedures inimical to the substance of the Ross invention. *Id.* at 1342-43 (citations omitted).



# The Intrinsic Record Establishes the Ordinary Meaning

- “What *Phillips* now counsels is that in the absence of something in the written description and/or prosecution history to provide explicit or implicit notice to the public – i.e., to those of ordinary skill in the art – that the inventor intended a disputed term to cover more than the ordinary and customary meaning revealed by the context of the intrinsic record, **it is improper to read the term to encompass a broader definition simply because it may be found in a dictionary, treatise, or other extrinsic source.**”

*Nystrom v. Trex Co.*, 424 F.3d 1136, 1145 (Fed. Cir. 2005)

# The Specification Can Establish an Ordinary Meaning Without an Explicit Definition

- Construed “fiberfill batting” (a form of insulation) to require synthetic fibers because (a) the written description “describ[es] numerous examples of commercial grade fiberfill, **all of which are comprised entirely of synthetic materials,**” (b) none of the **incorporated patents** discuss the possibility of using natural fibers as commercial fiberfill batting, and (c) most – not all – of the cited **dictionary definitions** and other extrinsic evidence limited fiberfill batting to synthetic fibers.

*Aquatex Indus., Inc. v. Techniche Solutions*, 419 F.3d 1374, 1381 (Fed. Cir. 2005).

# Claim Differentiation

# Differentiation May Apply ... or Not

- “[T]wo considerations generally govern ... claim construction ... when applied to two independent claims: (1) claim differentiation takes on relevance in the context of a claim construction that would render additional, or different, language in another claim superfluous; and (2) **claim differentiation ‘cannot broaden claims beyond their correct scope.’** In this case, both of those considerations weigh against the district court's construction of ‘adjustable.’”

*Curtiss-Wright Flow Control Corp. v. Velan, Inc.*, 438 F.3d 1374, 1381 (Fed. Cir. 2006) (citations omitted; emphasis supplied)

# **“Patent Profanity”**

# Patent Profanity

- The FCC has defined profanity as “including language **so grossly offensive** to members of the public who actually hear it as to amount to a **nuisance.**”
- FCC prohibits profane speech between the hours of 6 a.m. and 10 p.m.
- Avoid **patent profanity** at all hours in all specifications and/or responses to office actions.

# Profane Words in a Specification

- “Critical”
- “Essential”
- “Important,” or more profane: “Very Important”
- “Always”
- “Never”
- “Must”

...you get the drift.

## Example: “Very Important”

- In *Inpro II Licensing S.A.R.L. v. T-Mobile USA, Inc.*, No. 05-1233 (Fed. Cir. May 11, 2006), the Federal Circuit limited the meaning of term “host interface” to a direct parallel bus interface, in part, relying on the profane term “**very important.**”
- Patent at issue relates to a personal digital assistant (PDA) including a host interface for connection to a host computer (such as, a PC).



# Profanity in the “Background of the Invention” Section

A very important feature of the  $\mu$ PDA in an aspect of the present invention is a direct parallel bus interface with a connector allowing the unit to be docked by plugging it into a docking bay in a host unit. Moreover, when the  $\mu$ PDA is docked in the host, there needs to be a means to effectively disable the CPU in the  $\mu$ PDA and to provide direct access to both the  $\mu$ PDA software and data storage by the host CPU. This direct access would provide immediate ability to communicate in the fastest available fashion between the  $\mu$ PDA and the host, and would also facilitate additional important features to be described below.

Col. 2, lines 30-40 (emphases added).

# Court's Analysis

- The Federal Circuit stated “[t]he district court correctly observed that the only host interface described in the specification is a direct parallel bus interface, and that *the specification emphasizes the importance of a parallel connection in solving the problems of the previously used serial connection.*”

Slip op. at 6 (emphasis added).

- Note that the Court also relied on the **prosecution history** in further support for its narrow interpretation of the term “host interface.”

## Example: “Critical”

- In *Curtiss-Wright Flow Control Corp. v. Velan, Inc.*, No. 05-1373 (Fed. Cir. February 15, 2006), the Federal Circuit reversed the district court’s construction of the term “adjustable.”
- The **district court** had construed “**adjustable**” to mean “capable of making a change to something or capable of being changed” by looking to the **plain meaning** of the term adjustable and by relying on **claim differentiation**.
- Relying, in part, on a profane word—“**critical**”—the Federal Circuit **reversed** the district court.

# Subject Matter at Issue: De-heading of a coke drum

- Traditional de-heading involves manually removing large metal plates known as “heads” that seal the drum’s openings in order to remove the solid coke (byproduct of refining process) from the drum.

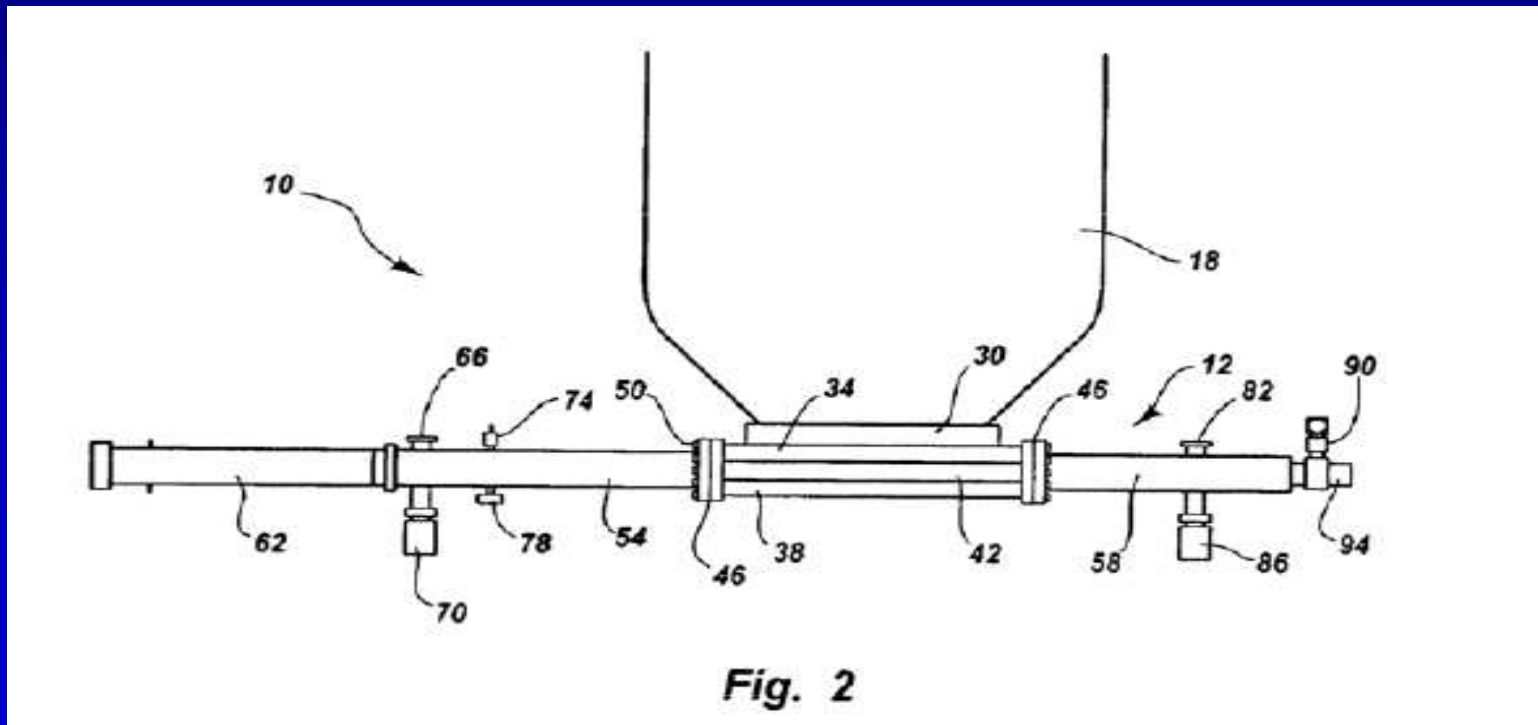
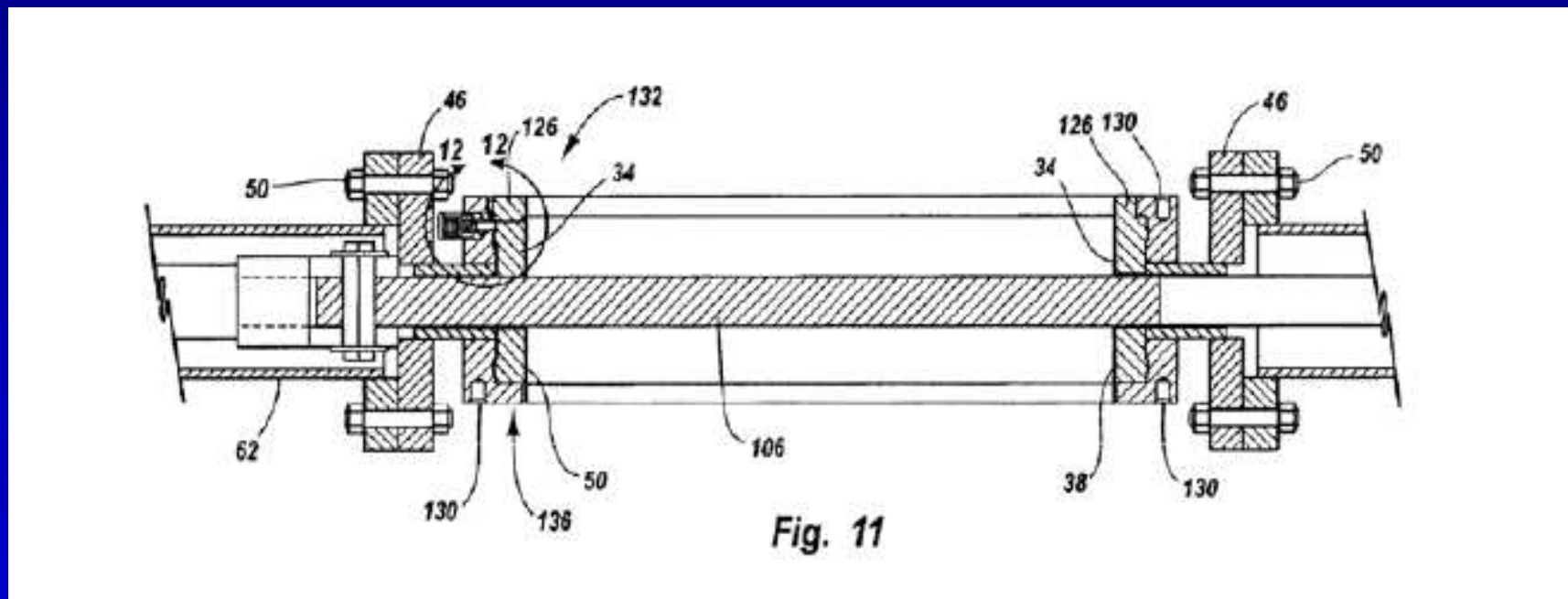


Fig. 2

# The '714 Patent Relates to De-heading Without Manually Removing the Heads

- A “de-header valve” with an adjustment mechanism is used to de-head the system without manual involvement.



## Example: “Critical” cont’d

- In the “Summary and Objects of the Invention” section, the ‘714 patent notes “[a]nother critical aspect of the present invention is the ability to de-head the coke drum without having to remove the head unit, and to do so at a remote location with little or no manual requirements.” Col. 4, ll. 13-17.
- The Federal Circuit in its analysis noted that “[t]he ‘714 patent then associates the adjustability of the live loaded seat with the critical aspect of the invention. In other words, the patent stresses that adjustment occurs during operation and without removal of the head unit.” Slip op. at 8.

## Example: “Critical” cont’d

- The Federal Circuit concluded: “[T]he specification of the '714 patent **consistently, and without exception**, describes adjustment that occurs during operation of the de-header system. The district court's construction of ‘adjustable,’ which includes a structure that requires dismantling of the valve to perform the adjustment, finds no support in the overall context of the '714 patent specification.”

Slip op. at 9.

# What of Extrinsic Evidence?



## Dictionaries: Down...

- “Our en banc decision in *Phillips* clarified the appropriate use of dictionaries in claim construction, rejecting the view that dictionary definitions govern unless contradicted by intrinsic evidence.”

*Free Motion Fitness, Inc. v. Cybex Int’l, Inc.*, 423 F.3d 1343, 1348 (Fed. Cir. 2005).

- “[I]n those circumstances where reference to dictionaries is appropriate, the task is to scrutinize the intrinsic evidence in order to determine the most appropriate definition.”

*Id.* at 1349.

## ... But Not Out

- While intrinsic evidence is dominant, neither the claims nor the specification may indicate, explicitly or implicitly, that the inventor intended to impart particular meaning to a claim term.

*See Wilson Sporting Goods Co. v. Hillerich & Bradsby Co.* 442 F.3d 1322, 1330 (Fed. Cir. 2006) (approving resort to dictionary to ascertain ordinary and customary meaning of claim term “insert”).

# Extrinsic Evidence at Odds with Intrinsic

- “As we recently reaffirmed in *Phillips*, ‘conclusory, unsupported assertions by experts as to the definition of a claim term are **not useful** to a court.’ Here [the expert] does not support his conclusion with any references to industry publications or other independent sources. **Moreover, expert testimony at odds with the intrinsic evidence must be disregarded.**”

*Network Commerce, Inc. v. Microsoft Corp.*, 422 F.3d 1353, 1361 (Fed. Cir. 2005)

# **Role of Prosecution History**

# Prosecution History: Unclear or Narrowing?

- “[B]ecause the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, it often **lacks the clarity of the specification** and thus is **less useful** for claim construction purposes.”

*Phillips*, 415 F.3d at 1317

- “Nonetheless, the prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and **whether the inventor limited the invention** in the course of prosecution, making the claim scope narrower than it would otherwise be.”

*Id.*

# **“Validity Preserving” Claim Constructions**

# Construe Claims To Preserve Validity Only Where Ambiguity Exists

- In *Phillips*, the Federal Circuit admonished that this maxim should be invoked only when, “after applying all other available tools of claim construction,” the court concludes that “the claim is still **ambiguous**.”

*Phillips*, 415 F.3d at 1327

- In such cases, the court may look “to whether it is reasonable to infer that the PTO would not have issued an invalid patent, and that the **ambiguity in the claim language should therefore be resolved in a manner that would preserve the patent’s validity**.”

*Id.*

# Construe Claims To Preserve Validity Only Where Ambiguity Exists

- In the absence of such an ambiguity, “courts may not redraft claims, whether to make them operable or to sustain their validity,” even to avoid a “nonsensical result.”

*Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371 (Fed. Cir. 2004).

- Rather, where claims “are susceptible to only one reasonable interpretation and that interpretation results in a nonsensical construction of the claim as a whole, the claim must be invalidated.”

*Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357 (Fed. Cir. 1999).



# Conclusion...