

**Keywords:** claim interpretation; dictionaries

*Edward H. Phillips v. AWH Corporation, Hopeman Brothers, Inc., and Lofton Corp.*

United States Court of Appeals for the Federal Circuit

Decided July 12, 2005

**I. Facts**

Edward Phillips invented modular, steel-shell panels that can be welded together to form vandalism-resistant walls. These panels are especially useful in building prisons, because they are load-bearing and impact-resistant, *e.g.*, bullet-resistant, while also insulating against fire and noise. Mr. Phillips obtained U.S. Pat. No. 4,677,798 on this invention, and he subsequently entered into an arrangement with AWH Corporation and others to market and sell the panels. After the arrangement ended in 1990, Mr. Phillips discovered that AWH was continuing to use this technology without his consent and, ultimately, in 1997, Mr. Phillips sued AWH for, *inter alia*, infringement of the '798 patent.

In regard to the infringement of claim 1, the district court construed the recitation of "means disposed inside the shell for increasing its load-bearing capacity comprising internal steel baffles extending inwardly from the steel shell walls" as a "means plus function" recitation governed by 35 U.S.C. § 112, paragraph 6. Looking to the specification of the '798 patent, the court noted that the only baffles described or illustrated were deployed at angles other than 90 degrees. Accordingly, the court ruled that the claimed baffle must "extend inward from the steel shell walls at an oblique or acute angle to the wall face." Because Mr. Phillips could not prove infringement under that claim construction, the district court granted summary judgment of non-infringement.

On appeal to the Federal Circuit, a panel affirmed the district court's summary judgment of non-infringement. The panel determined that the district court erred by construing the term "baffles" under 35 U.S.C. § 112, paragraph 6, because the "means plus function" recitation contains sufficient structure to remove it from the restrictions of 35 U.S.C. § 112, paragraph 6. Nevertheless, the panel concluded that the patent uses the term "baffles" in a restrictive manner and, based on the patent's written description, the panel held that the term "baffles" excludes structures that extend at a 90 degree angle from the walls. However, the dissenting judge on the panel argued that the claims had been improperly limited to a particular embodiment of the invention disclosed in the specification and that the panel should have adopted the "plain meaning" of the term "baffles."

Shrewdly sensing an almost imperceptible rift in the Federal Circuit between those judges that desperately cling to long-standing precedent requiring the use of the specification in determining the meaning of terms used in the claims and those judges boldly forging into uncharted waters by relying on Noah Webster to elucidate the meaning of terms used in the claims, the Federal Circuit agreed to rehear the appeal *en banc* and vacated the judgment of the panel. On rehearing, the Federal Circuit agreed with the panel that the term "baffles" does not invoke the restrictions of 35 U.S.C. § 112, paragraph 6. With that preliminary matter decided, the Federal Circuit was then faced with the task of determining "the correct construction of the structural term 'baffles'." In this regard, the Federal Circuit first noted that 35 U.S.C. § 112, paragraph 2, requires a court to look to the language of the claims to determine what the Applicant regards as his invention. On the other hand, the Federal Circuit noted that 35 U.S.C. § 112, paragraph 1, requires that the specification describe the invention set forth in the claims. Hence, the Federal Circuit framed the principle question presented in this case as "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."

Wisely, the Federal Circuit noted that this is “hardly a new question.” Indeed, the role of the specification in claim construction has been deemed important in patent law decisions for nearly two centuries. The Federal Circuit first relied upon its discussion of the relationship between the specification and the claims as set forth in the *Markman* and *Vitronics* decisions, as well as its more recent *Innova* decision, and stated that the basic principles of claim construction outlined in these decisions are still applicable and that they should be reaffirmed by the present decision. Not surprisingly, the Federal Circuit also stated that their previous decisions regarding the use of dictionaries in claim construction require clarification.

The Federal Circuit’s detailed discussion of the importance of the role of the specification in claim construction is well-written and well-organized. In summary, the Federal Circuit noted 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 at the time of the invention. A 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 also in the context of the entire patent, including the specification. The Federal Circuit specifically noted that the ordinary meaning of a claim term cannot be considered in a vacuum. Relying upon the methodology of claim construction espoused *Markman* and *Vitronics*, the Federal Circuit stated that one must look to the claims themselves, the specification, the prosecution history, extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art in order to determine how one of ordinary skill in the art would interpret a claim term.

Beginning with the claims themselves, the Federal Circuit noted that the context in which a term is used in the asserted claim can be highly instructive. Further, 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. Specifically, the Federal Circuit reaffirmed the viability of the doctrine of claim differentiation, in which the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim.

In regard to the role of the specification, the Federal Circuit noted that the claims do not stand alone and that they must be read in view of the specification of which they are a part. Again relying upon *Vitronics*, the Federal Circuit noted that the specification is always highly relevant to claim construction, usually dispositive, and the single best guide to the meaning of a disputed term. As if finally donning a new set of glasses, the Federal Circuit recognized that the Federal Circuit, its predecessors, and, indeed, even the Supreme Court, have “long emphasized the importance of the specification in claim construction.” In possibly the best summary of the importance of the specification, the Federal Circuit relied upon the *Renishaw* decision, which states:

Ultimately, the interpretation to be given a term can only be determined and confirmed with full understanding of what the inventors actually invented and intended to envelop with the claim. The construction that stays true to the claim language and most naturally aligns with the patent’s description of the invention will be, in the end, the correct construction.

In regard to the role of the prosecution history, the Federal Circuit again reaffirmed its *Markman* decision and stated that the prosecution history provides evidence of how the PTO and the inventor understood the patent. Specifically, the Federal Circuit noted that the prosecution history can often provide an understanding of 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.

Finally turning to the use of extrinsic evidence, the Federal Circuit again reaffirmed its holdings in *Markman* and *Vitronics* by stating that, although extrinsic evidence can be useful in determining the meaning of claim terms, it is less significant than the intrinsic record. The Federal Circuit noted that dictionaries, and especially technical dictionaries, may be useful resources in determining the meaning of particular terminology as understood by those of ordinary skill in the art. The Federal Circuit also noted that expert testimony can be useful for a variety of purposes, but warned that conclusory and unsupported assertions by experts are not useful and that a court should discount any expert testimony that is clearly at odds with the claim construction “mandated by the claims themselves, the written description, and the prosecution history.” Finally, the Federal Circuit listed five reasons why extrinsic evidence is generally less reliable than intrinsic evidence: (1) extrinsic evidence, by definition, is not part of the patent and was not created for the purpose of explaining the patent’s scope and meaning; (2) while claims are construed as they would be understood by a hypothetical person of ordinary skill in the art, extrinsic publications may not be written by or for skilled artisans and may not reflect the understanding of a person of ordinary skill in the art; (3) extrinsic evidence, particularly evidence generated at the time of and for the purpose of litigation, can suffer from bias that is not present in intrinsic evidence; (4) because extrinsic evidence is typically varied and unbounded, each party in a litigation will naturally choose only those pieces of extrinsic evidence most favorable to its cause; and (5) undue reliance on extrinsic evidence poses the risk that it will be used to change the meaning of claims in derogation of the “indisputable public records consisting of the claims, the specification and the prosecution history,” thereby undermining the public notice function of patents. Nevertheless, the Federal Circuit noted that extrinsic evidence does have its place, and stated that it is permissible for the district court “in its sound discretion” to admit and use such evidence.

“Although the principles outlined above have been articulated on numerous occasions, some of this court’s cases have suggested a somewhat different approach to claim construction, in which the court has given greater emphasis to dictionary definitions of claim terms and has assigned a less prominent role to the specification and the prosecution history. The leading case in this line is *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002).” With this introductory understatement, the Federal Circuit embarked on a discussion of the *Texas Digital* case and its progeny. The Federal Circuit discussed the claim interpretation methodology set forth in *Texas Digital*--a methodology that is clearly at odds with the methodology set forth in the *Markman* case and the two centuries of precedent that preceded it--and explained that the *Texas Digital* court advanced the methodology in an effort to combat “one of the cardinal sins of patent law--reading a limitation from the written description into the claims.” The Federal Circuit noted that, although the concern expressed by the *Texas Digital* court was valid, the methodology it adopted placed too much reliance on extrinsic sources and too little reliance on intrinsic sources. Without specifically overturning the *Texas Digital* case, the Federal Circuit noted that the *Texas Digital* approach improperly restricts the role of the specification in claim construction. The main problem with elevating a 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. Too often the *Texas Digital* line of cases has improperly relied upon a dictionary definition entirely divorced from the context of the written description. Further, a dictionary does not always keep abreast of the inventor and, indeed, it cannot.

Accordingly, the Federal Circuit, returning to long-standing rules of claim interpretation, stated that the line between construing claims and importing limitations can be discerned with reasonable certainty and predictability if the court’s focus remains on understanding how a person of ordinary skill in the art would understand the claim terms. The Federal Circuit again warned against confining the claims to exemplary embodiments, and stated that persons of ordinary skill in the art rarely would confine their definitions of claim terms to the exact representations depicted in the embodiments.

Finally, the Federal Circuit stated that “there is no magic formula or catechism for conducting claim construction.”

Having so wonderfully clarified the manner in which claims should and should not be construed, the Federal Circuit turned its attention to the specific case at hand. Based on the language of claim 1 itself, the Federal Circuit noted that the baffles must be made of steel, part of the load-bearing means for the wall section, and pointed inward from the walls. Looking to other claims, the Federal Circuit noted that certain dependent claims further defined the baffles as being disposed at angles for deflecting projectiles, and, thus, noted that such limitations would be unnecessary if persons of ordinary skill in the art understood that the baffles inherently serve such a function. In reliance on the specification, the Federal Circuit noted that the baffles were described in a manner such that they could perform several different functions in certain circumstances, and yet not in a manner such that they must perform all such functions in every circumstance. Hence, the Federal Circuit concluded that a person of ordinary skill in the art would not interpret the term “baffle” to be limited to an acute or obtuse angle, but not a right angle. The court further noted that such an interpretation could render the claim invalid, but reaffirmed that the principle that “claims must be construed to uphold their validity, if possible” only pertains to situations where the disputed claim term is ambiguous and where two reasonable interpretations are possible.

The Federal Circuit ended its decision by stating that, although it requested the parties to brief the question of whether it is appropriate for the Federal Circuit to accord any deference to any aspect of trial court claim construction, “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*.” While the *en banc* panel may have determined that the question did not need to be answered, the dissent written by Judges Mayer and Newman certainly thought it was high time to answer the question. Using terms such as “futility,” “absurdity,” “interpretive necromancy,” “blind,” “delusion,” and “intake clerk,” the dissent artfully and vehemently argued that claim construction is a matter of law with underlying factual determinations. Indeed, the dissent likened claim interpretation to a determination of the *Graham* requirements under Section 103. The dissent chastised the Federal Circuit’s treatment of district courts and finally suggested that all patent cases should be filed with the Federal Circuit so that the Federal Circuit could determine the meaning of the claims and, for those few cases in which claim construction is not dispositive, such cases can be remanded to the district court for trial. The dissent ended by stating:

Eloquent words can mask much mischief. The court’s opinion today is akin to rearranging the deck chairs on the Titanic--the orchestra is playing as if nothing is amiss, but the ship is still heading for Davey Jones’ locker.