

IN THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Edward H. Phillips,

Plaintiff-Appellant,

v.

**AWH Corporation,
Hopeman Brothers, Inc., and Lofton Corporation,**

Defendants-Cross Appellants.

Appeal from the United States District Court
for the District of Colorado in Case No. 97-212,
Judge Marcia S. Krieger

**BRIEF FOR AMICUS CURIAE
AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION
IN SUPPORT OF NEITHER PARTY**

RICK D. NYDEGGER, *President*
AMERICAN INTELLECTUAL
PROPERTY LAW ASSOCIATION
2001 Jefferson Davis Hwy, Suite 203
Arlington, VA 22202
(703) 415-0780

DAVID R. TODD
WORKMAN NYDEGGER
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111
(801) 533-9800

DENISE W. DEFRANCO
FOLEY HOAG LLP
Seaport World Trade Center West
155 Seaport Boulevard
Boston, MA 02210
(617) 832-1000

JOSEPH R. RE
JOSEPH S. CIANFRANI
KNOBBE MARTENS OLSON & BEAR
2040 Main Street, 14th Floor
Irvine, CA 92614
(949) 760-0404

September 17, 2004

Attorneys for Amicus Curiae

CERTIFICATE OF INTEREST

Counsel for *Amicus Curiae* American Intellectual Property Law Association certifies the following:

1. The full name of every party represented by the undersigned is:

American Intellectual Property Law Association

2. The real party in interest represented by the undersigned is:

American Intellectual Property Law Association

3. All parent companies and any publicly held companies that own 10 percent or more of the stock of the party represented by me are:

None

4. The names of all law firms and the partners or associates that appeared for the party now represented by the undersigned in the trial court or are expected to appear in this court are:

RICK D. NYDEGGER
DAVID R. TODD
WORKMAN NYDEGGER
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111
(801) 533-9800

DENISE W. DEFRANCO
FOLEY HOAG LLP
Seaport World Trade Center West
155 Seaport Boulevard
Boston, MA 02210
(617) 832-1000

JOSEPH R. RE
JOSEPH S. CIANFRANI
KNOBBE MARTENS OLSON & BEAR
2040 Main Street, 14th Floor
Irvine, CA 92614
(949) 760-0404

RICK D. NYDEGGER

TABLE OF CONTENTS

	<u>Page(s)</u>
CERTIFICATE OF INTEREST	ii
TABLE OF CONTENTS	iii
TABLE OF AUTHORITIES	iv
STATEMENT OF INTEREST OF <i>AMICUS CURIAE</i>	1
INTRODUCTION	2
ARGUMENT	3
I. Answers to <i>En Banc</i> Questions 1-3 and 6.....	3
A. This Court Should First Address The Fundamental Standard Governing Claim Construction.....	3
B. The Fundamental Standard Reveals The Relative Importance of Intrinsic Evidence and Evidence of “Ordinary Meaning”	4
C. Logical Corollaries To The Fundamental Standard Guide Proper Responses To The Court’s Questions.....	6
D. The Fundamental Standard Establishes The Proper Role for Dictionaries, Expert Testimony, and Other Extrinsic Evidence.....	11
E. The Order of Consulting Relevant Sources Is Insignificant In Relation To The Principles Used In Analyzing Those Sources	14
II. Answer to <i>En Banc</i> Question 4.....	16
III. Answer to <i>En Banc</i> Question 5.....	16
IV. Answer to <i>En Banc</i> Question 7.....	18
CONCLUSION.....	23

TABLE OF AUTHORITIES

	<u>Page(s)</u>
<u>CASES</u>	
<i>Al-Site Corp. v. VSI Int'l Inc.</i> , 174 F.3d 1308 (Fed. Cir. 1999)	3
<i>American Hoist & Derrick Co. v. Sowa & Sons, Inc.</i> , 725 F.2d 1350 (Fed. Cir. 1984)	17
<i>Amgen Inc. v. Hoechst Marion Roussel</i> , 314 F.3d 1313 (Fed. Cir. 2003)	20
<i>Arlington Indus. v. Bridgeport Fittings, Inc.</i> , 345 F.3d 1318 (Fed. Cir. 2003)	3
<i>Athletic Alternatives, Inc. v. Prince Mfg., Inc.</i> , 73 F.3d 1573 (Fed. Cir. 1996)	17
<i>Boehringer Ingelheim Vetmedica v. Schering-Plough</i> , 320 F.3d 1339 (Fed. Cir. 2003)	15
<i>City Nat'l Bank v. Unique Structures, Inc.</i> , 49 F.3d 1330 (8th Cir. 1994)	21
<i>Cunningham v. Laser Golf Corp.</i> , 222 F.3d 943 (Fed. Cir. 2000)	20
<i>Cybor Corp. v. FAS Technologies, Inc.</i> , 138 F.3d 1448 (Fed. Cir. 1998) (en banc)	21
<i>Exhibit Supply Co. v. Ace Patents Corp.</i> , 315 U.S. 126 (1942)	13
<i>First Options of Chicago, Inc. v. Kaplan</i> , 514 U.S. 938 (1995)	22
<i>Golight, Inc. v. Wal-Mart Stores, Inc.</i> , 355 F.3d 1327 (Fed. Cir. 2004)	20

<i>Graham v. James</i> , 144 F.3d 229 (2d Cir. 1998)	21
<i>Hockerson-Halberstadt, Inc. v. Avia Group Int'l</i> , 222 F.3d 951 (Fed. Cir. 2000)	9
<i>International Rectifier Corp. v. Ixys</i> , 361 F.3d 1363 (Fed. Cir. 2004)	8
<i>Johns Hopkins Univ. v. Cellpro, Inc.</i> , 152 F.3d 1342 (Fed. Cir. 1998)	9
<i>Karsten Mfg. Corp. v. Cleveland Golf Co.</i> , 242 F.3d 1376 (Fed. Cir. 2001)	18
<i>Leibel-Flarsheim Co. v. Medrad, Inc.</i> , 358 F.3d 898 (Fed. Cir. 2004)	10
<i>Markman v. Westview Instruments, Inc.</i> , 517 U.S. 370 (1996)	11, 19, 21
<i>Medichem, S.A. v. Rolabo, S.L.</i> , 353 F.3d 928 (Fed. Cir. 2003)	20
<i>Meridien Bank v. Alten</i> , 958 F.2d 1226 (3d Cir. 1992)	21
<i>Nelson-Salabes, Inc. v. Morningside Dev., LLC</i> , 284 F.3d 505 (4th Cir. 2002)	21
<i>Ornelas v. United States</i> , 517 U.S. 690 (1996)	21
<i>Pebble Beach Co. v. Tour 18 I, Ltd.</i> , 155 F.3d 526 (5th Cir. 1998)	20
<i>Reebok Int'l Ltd. v. McLaughlin</i> , 49 F.3d 1387 (9th Cir. 1995)	21
<i>Renishaw PLC v. Marposs Società per Azioni</i> , 158 F.3d 1243 (Fed. Cir. 1998)	7, 9

<i>Salve Regina College v. Russell</i> , 499 U.S. 225 (1991)	22
<i>SRI Int'l v. Matsushita Elec. Corp.</i> , 775 F.2d 1107 (Fed. Cir. 1985) (en banc)	10
<i>Surface Technology, Inc. v. United States Int'l Trade Comm'n</i> , 801 F.2d 1336 (Fed. Cir. 1986)	9
<i>Texas Digital Systems, Inc. v. Telegenix</i> , 308 F.3d 1193 (Fed. Cir. 2002)	14, 15
<i>United Carbon Co. v. Binney & Smith Co.</i> , 317 U.S. 228 (1942)	14
<i>Vitronics Corp. v. Conceptronic, Inc.</i> , 90 F.3d 1576 (Fed. Cir. 1996)	10
<i>Wright Medical Technology, Inc. v. Osteonics Corp.</i> , 122 F.3d 1440 (Fed. Cir. 1997)	9

OTHER AUTHORITIES

Comment, M. Reed Staheli, <i>Deserved Deference: Reconsidering the De Novo Standard of Review for Claim Construction</i> , 3 MARQ. INTELL. PROP. L. REV. 181 (1999)	23
ROBERT L. HARMON, PATENTS AND THE FEDERAL CIRCUIT (Supp. 2004)	22

STATEMENT OF INTEREST OF AMICUS CURIAE

The American Intellectual Property Law Association (AIPLA) is a national association of more than 15,000 members interested in all areas of intellectual property law. AIPLA members include attorneys employed in private practice and by corporations, universities, and government. AIPLA members represent both owners and users of intellectual property.

The AIPLA has no stake in any of the parties to this litigation or the result of this case, other than its interest in seeking correct and consistent interpretation of the patent law.¹

The filing of this brief is authorized by the Court's July 21, 2004 Order stating that "*Amicus curiae* briefs may be filed by bar associations . . . and other interested parties."

¹ After reasonable investigation, AIPLA believes that (a) no member of its Board or Amicus Committee who voted to prepare this brief, or any attorney in the law firm or corporation of such a member, represents a party to this litigation, (b) no representative of any party to this litigation participated in the authorship of this brief, and (c) no one other than the AIPLA, or its members who authored this brief and their law firms or employers, made a monetary contribution to the preparation or submission of this brief. Some committee members or attorneys in their respective law firms or corporations may represent entities which have an interest in other matters which may be affected by the outcome of this litigation.

INTRODUCTION

AIPLA advocates a balanced approach to the issues raised by the Court's *en banc* questions in this case. Some of the Court's questions suggest that the Court believes it must make a choice among extremes. The best approach is a balanced one that flows from fundamental principles.

Indeed, before addressing its specific *en banc* questions, this Court must first settle the most fundamental question, namely: What is the ultimate inquiry to be answered in performing the claim construction process? The fundamental standard that should govern claim construction is that a claim term must be construed from the perspective of a person of ordinary skill in the relevant art at the time the patent issued seeking to understand the term's meaning from a study of the entire intrinsic record.

Several corollaries logically flow from this fundamental standard and guide responses to the more specific issues raised by the Court's questions. Those responses are stated below.

ARGUMENT

I. Answers to *En Banc* Questions 1-3 and 6

A. *This Court Should First Address The Fundamental Standard Governing Claim Construction*

Questions 1-3 and 6 inquire about what sources should be consulted during the claim construction process and how that process should proceed. As a predicate to answering those questions, this Court should first confront a more fundamental question, namely: What is the ultimate inquiry to be answered when construing a claim?

The claim is the measure of the patent grant, and claim construction is the process of determining the legally operative meaning of the words in a claim. The legally operative meaning of a claim term must result from the perspective of a person of ordinary skill in the art at the time the patent issued² seeking to understand the term's meaning from a study of the entire intrinsic record. This

² The literal meaning of a claim is fixed upon the issuance of the patent containing that claim. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 1320 (Fed. Cir. 1999); *see also Arlington Indus. v. Bridgeport Fittings, Inc.*, 345 F.3d 1318, 1330 (Fed. Cir. 2003) (“[A claim construction analysis] must be based primarily on the record established at the time the patent was granted.”).

standard is an objective one that envisions a person of ordinary skill in the relevant art at the time the patent issued attempting to objectively discern from the intrinsic record the meaning of a claim term.

Various aspects of this ultimate inquiry are reflected in past pronouncements of this Court, but no single formulation of the fundamental standard has emerged. Therefore, before the Court answers its *en banc* questions, it should identify the fundamental standard.

B. The Fundamental Standard Reveals The Relative Importance of Intrinsic Evidence and Evidence of “Ordinary Meaning”

The fundamental standard identified above strikes the proper balance between providing fair coverage for the language an applicant has chosen and adequate notice to the public of its limits. The standard also establishes which materials can and should be consulted in a claim construction analysis, as well as their relative importance.

Under this standard, a court engaged in claim construction should *always* review relevant portions of the intrinsic record, and

will *often* need to make an intermediate inquiry as to the ordinary and accustomed meanings of the term to a person of ordinary skill in the art at the time the patent issued. The reason that a court must review the intrinsic record springs from a statement of the ultimate objective: to identify the meaning that a person of ordinary skill in the art would objectively understand *from a study of the entire intrinsic record*. A court should also inquire into the ordinary meaning (or meanings) because these are the *background meanings* which the person of ordinary skill would employ in studying the intrinsic record.

Employing the fundamental standard clarifies that materials in the intrinsic record must, throughout the inquiry, be the “primary” source for claim construction, not because they will usually be sufficient to resolve the claim construction question, but because they govern in the event of any conflict with an ordinary meaning. The intrinsic record is specific to the patent, whereas evidence of the ordinary meaning is general to the art. Evidence that is more specific should control over that which is more general. If nothing appears in the intrinsic record to lead the person of ordinary skill to conclude

otherwise, he would understand the term to have an ordinary meaning general to the art. On the other hand, if the intrinsic record reflects one ordinary meaning instead of another (or some other meaning), then the person of ordinary skill studying such a record would understand that there is a patent-specific meaning.

*C. Logical Corollaries To The Fundamental Standard Guide
Proper Responses To The Court's Questions*

From the fundamental standard follow corollaries that answer the issues raised by the Court's *en banc* questions:

1. An express definition of a claim term set forth in the intrinsic evidence governs, regardless of any ordinary meaning. In this instance, the only objective conclusion the person of ordinary skill could draw from a study of the intrinsic evidence is that the term has the express definition stated in the intrinsic evidence.

2. An express disavowal for a claim term governs, regardless of any ordinary meaning.

3. Absent an express definition or disavowal, a person of ordinary skill in the art studying the intrinsic record would understand a claim term to have an ordinary and accustomed

meaning of the term that is “consistent” with the intrinsic record, if this is possible.

The last corollary reconciles the two fundamental claim interpretation canons: (1) a claim should be read in light of the specification; and (2) limitations should not be read from the specification into the claims. *See Renishaw PLC v. Marposs Società per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998). The corollary reconciles these canons. By rejecting one (or more) of many ordinary meanings when they are inconsistent with the intrinsic record, the claim is “read in light of the specification” (indeed, in light of the entire intrinsic record). At the same time, limitations are not being read from the intrinsic record into the claims because at least one ordinary meaning is adopted.

In the event multiple ordinary meanings are consistent with the intrinsic evidence, the person of ordinary skill would adopt the ordinary meaning that “most naturally aligns” or that is “the most consistent” with the intrinsic evidence. *Renishaw*, 158 F.3d at 1250. In other words, one of several ordinary meanings might be rejected, even though it is not strictly inconsistent with the intrinsic evidence,

if another ordinary meaning aligns more naturally with the applicant's description of the invention.

Conversely, if there is no express definition or disavowal and there is no ordinary meaning that is consistent with the intrinsic evidence, then the court should adopt a meaning as close as possible to the ordinary meaning but altered so as to “naturally align” with the intrinsic evidence. *See International Rectifier Corp. v. Ixys*, 361 F.3d 1363, 1372-73 (Fed. Cir. 2004) (interpreting the term “annular” in this fashion).

It would be too limiting to disqualify an ordinary meaning “only when the patentee has acted as his lexicographer or when the specification reflects a clear disclaimer of claim scope,” as suggested by the *en banc* questions. A court should not reject an ordinary meaning only when there is “a clear disclaimer.” It should reject an ordinary meaning anytime the intrinsic evidence is inconsistent with that meaning or when the intrinsic evidence is more consistent with a different ordinary meaning.

A meaning can be “inconsistent” with the intrinsic evidence in ways too varied to be identified. Some examples illustrate the point.

An ordinary meaning is usually inconsistent with the intrinsic evidence if that ordinary meaning: (1) causes the claim to fail to read on any disclosed embodiment;³ (2) renders language in the claim at issue or in other claims surplusage;⁴ (3) is inconsistent with the context in which the disputed claim term appears;⁵ (4) is inconsistent with the usage of the term in the specification or prosecution history;⁶ or (5) is inconsistent with positions taken during the prosecution history.⁷

Although a “clear disclaimer” should not be a necessary predicate for rejecting an ordinary meaning, a court should not reject an ordinary meaning unless it truly is “inconsistent” with the intrinsic evidence. For example, an ordinary meaning is not

³ See *Johns Hopkins Univ. v. Cellpro, Inc.*, 152 F.3d 1342, 1355 (Fed. Cir. 1998).

⁴ See *Wright Medical Technology, Inc. v. Osteonics Corp.*, 122 F.3d 1440, 1444 (Fed. Cir. 1997). The well-known canon of claim differentiation is a specific application of this principle.

⁵ See *Renishaw*, 158 F.3d at 1251 (“[T]he claim itself precludes us from viewing ‘when’ as requiring signaling at the precise moment of contact . . .”).

⁶ See *Surface Technology, Inc. v. United States Int’l Trade Comm’n*, 801 F.2d 1336, 1341 (Fed. Cir. 1986).

⁷ See *Hockerson-Halberstadt, Inc. v. Avia Group Int’l*, 222 F.3d 951, 956-57 (Fed. Cir. 2000).

inconsistent with the intrinsic evidence merely because: (1) there is only one disclosed embodiment, and the meaning causes the claim to cover more than that embodiment;⁸ (2) all disclosed embodiments have a common attribute, and the meaning causes the claim to cover embodiments both with the common attribute and without it;⁹ or (3) the meaning causes the claim to define subject matter which achieves only some of several objectives or purposes for the invention set forth in the specification.¹⁰ A person of ordinary skill in the art would not infer from these circumstances a reason to depart from the ordinary meaning. It is only when the intrinsic record contains something truly “inconsistent” with an ordinary meaning that the person of ordinary skill would infer a different meaning. The “consistency” standard has appeared in a number of this Court’s opinions, although it may not have been considered with a view towards the fundamental standard proposed above. *See, e.g., Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (“[I]t is always

⁸ *SRI Int’l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 n.14 (Fed. Cir. 1985) (en banc).

⁹ *Leibel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 905-06 (Fed. Cir. 2004).

¹⁰ *Id.* at 908-09.

necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning.”).

The “consistency” standard is also suggested by the Supreme Court’s decision in *Markman*, which states that the process of claim construction seeks a meaning that is “consistent with a patent’s internal logic,” “comports with the instrument as a whole,” and “preserve[s] the patent’s internal coherence.” *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389-90 (1996).

D. The Fundamental Standard Establishes The Proper Role for Dictionaries, Expert Testimony, and Other Extrinsic Evidence

Given the fundamental standard, a court may often need to make an intermediate inquiry as to the ordinary and accustomed meaning of the claim term at issue. As noted above, ordinary and accustomed meanings are the background meanings with which the person of ordinary skill would study the intrinsic record. Dictionaries, both general and technical, may be relevant to claim construction because they may tend to objectively establish the ordinary meaning.

But a court should use dictionary definitions only with the clear recognition that such definitions are at least two steps removed from the ultimate inquiry. First, a particular dictionary definition may or may not reflect the ordinary meaning in the relevant art and it may or may not reflect the ordinary meaning at the relevant time. A technical dictionary is more likely to reflect the ordinary meaning in the relevant art than a general purpose dictionary. A dictionary published near the time the patent issued is more likely to reflect the ordinary meaning at the relevant time than a contemporary dictionary, especially in quickly evolving arts. A court should not presume that a single, isolated dictionary definition constitutes an ordinary meaning in the art. A court should rely on a dictionary definition as providing an ordinary meaning only insofar that it can assure itself that the definition is probative of the ordinary and accustomed meaning of the claim term in the relevant art and at the relevant time.

Second, dictionary definitions are not drafted with the context of the patent in mind. Therefore, even if they reflect an ordinary meaning in the relevant art at the relevant time, they may not reflect

the meaning that is ultimately relevant, which requires an understanding of the term within the context of the intrinsic record. Thus, as with any extrinsic evidence, a court may rely on a dictionary definition evidencing ordinary meaning only when it is consistent with the intrinsic evidence. *See Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 134-35 (1942) (using two dictionary definitions and performing an “examination of the drawings and specifications” to determine “that the claim was not intended to be limited” to a narrow meaning).

Like dictionary definitions, expert testimony may also be relevant to claim construction. Nevertheless, a court must recognize that expert testimony suffers from its own limitations in comparison to dictionaries. Although a properly selected dictionary definition can be unbiased and publicly available before litigation, it speaks out of context. Whereas a party’s experts can provide helpful context, they often speak from the perspective of the litigant who hired them and their testimony is not publicly available until litigation. Thus, the usefulness of expert testimony is limited by the extent to which it is biased or based on distant memory. *See Texas Digital Systems, Inc.*

v. Telegenix, 308 F.3d 1193, 1203 (Fed. Cir. 2002) (preferring “unbiased reflections of common understanding not influenced by expert testimony or events subsequent to the fixing of the intrinsic record . . . , not colored by the motives of the parties, and not inspired by litigation”). A court should rely on expert testimony as probative of an ordinary meaning only insofar as it can assure itself that the testimony is objective, relevant, and consistent with the intrinsic evidence. *See United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 233 (1942) (relying on unimpeached and uncontradicted cross-examination testimony, corroborated by “other witnesses,” as “[t]he clearest exposition of the significance which the terms employed in the claims had for those skilled in the art”).

E. The Order of Consulting Relevant Sources Is Insignificant In Relation To The Principles Used In Analyzing Those Sources

Finally, the Court’s *en banc* questions ask about the order in which the sources relevant to claim construction should be consulted. In some opinions, this Court has explained that “[t]he first step in claim construction is to determine the ordinary and customary meaning, if any, that would be attributed to the term by those skilled

in the art.” *Boehringer Ingelheim Vetmedica v. Schering-Plough*, 320 F.3d 1339, 1346 (Fed. Cir. 2003). The rationale for this approach is sound: to avoid importing limitations from the intrinsic evidence into the claims. *Texas Digital*, 308 F.3d at 1204.

Because of the continuing primacy of the intrinsic evidence, however, there may be occasions when there is no need to ascertain the ordinary meaning. When the intrinsic evidence contains an express definition or an express disavowal, it is not necessary to discern the ordinary meaning at all. Similarly, when there is a dispute about the ordinary meaning of a claim term, a resolution of that dispute is not necessary if one proposed meaning is inconsistent with the intrinsic evidence.

In reality, the process of analyzing the proper meaning of a claim term is likely to be an iterative one, in which a court consults one set of sources, then another, and then revisits sources already considered. Therefore, as a practical matter, the order in which a court consults all of the relevant sources is insignificant in relation to the principles the court uses to synthesize from those sources an answer to the ultimate inquiry. As long as the court’s analysis is true

to the fundamental standard and the corollaries identified above, the order in which the sources are consulted should not affect the outcome.

II. Answer to *En Banc* Question 4

Question 4 asks whether there should be a dual restriction on claim scope such that a patentee must satisfy two limiting methodologies in order to establish the claim coverage it seeks. The answer to this question flows directly from the fundamental standard. The patentee should not have to “satisfy” any “limiting methodology” to “establish the claim coverage it seeks.” The goal of claim construction is not to “limit” or “restrict” claim scope, but to determine the meaning of a claim term that a person of ordinary skill in the art at the time the patent issued would have objectively discerned from a study of the intrinsic record.

III. Answer to *En Banc* Question 5

Question 5 asks when, if ever, claim language should be narrowly construed for the sole purpose of avoiding invalidity under, *e.g.*, 35 U.S.C. §§ 102, 103 and 112. The appropriate approach is to construe a claim to preserve its validity only where there are two

equally appropriate interpretations, and one of those interpretations would render the claim invalid based on the record before the examiner whereas the other would not. *Cf. Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1581 (Fed. Cir. 1996) (adopting the narrower of two equally plausible constructions).

This approach would appropriately recognize the deference owed to a qualified government agency presumed to have properly done its job, *see American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359 (Fed. Cir. 1984), and would comport with the fundamental standard and its corollaries. Applying the validity axiom to the record before the patent examiner is an additional way to test a meaning for consistency with the intrinsic evidence, of which the record before the patent examiner is a part.

A patent examiner presumably would not have allowed (and the applicant would not have submitted) a claim that is invalid based on the materials of record. Thus, if one construction would cause a claim to be invalid based on the materials of record, whereas an equally plausible narrower construction would not, it is fair to assume that both the applicant and the examiner accepted the

narrower meaning during prosecution. The broader construction would be “inconsistent” with the intrinsic record.

That assumption, however, does not hold where neither the applicant nor the examiner would have been aware of the alleged basis for invalidity. It is therefore appropriate to adopt the narrower meaning to preserve a claim’s validity only where the materials of record during prosecution make it reasonable to believe that the applicant and the examiner used the narrower meaning in submitting and allowing the claim. This Court has already recognized this principle. *See Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1384 (Fed. Cir. 2001) (“The claims can not be rewritten by the court to avoid the impact of newly discovered prior art, for the role of ‘claim construction’ is to describe the claim scope as it was intended when examined and obtained by the applicant, not as it might have been limited upon a different record of prosecution and prior art.”).

IV. Answer to *En Banc* Question 7

As demonstrated above, sometimes claims can be construed without reference to extrinsic evidence, especially where the patentee expressly defined terms or disavowed claim scope. The fundamental

standard, however, requires a court to view the intrinsic record from the perspective of a person of ordinary skill in the art at the time the patent issued. Therefore, a court lacking necessary technical knowledge must rely on additional evidence to arrive at this legally operative meaning. Analysis of this evidence may turn on fact issues such as the appropriate level of skill in the art at the relevant time, or the scope of a term used in a specialized field. Conflicting expert testimony may require a district court to resolve the issue in part by judging the weight to be given to each expert's views. Under *Markman*, these decisions are “subsumed within the necessarily sophisticated analysis of the whole document.” 517 U.S. at 389. But such underlying questions are inescapably factual, not legal, and an appellate court should defer to the district court's findings.

In other areas of patent law, this Court routinely defers to factual assessments underlying legal determinations, while reviewing the determinations themselves de novo. When considering obviousness, for example, this Court “review[s] for clear error the district court's determination of the factual inquiries underlying obviousness, whereas we review de novo the legal conclusion of

whether a claim is invalid as obvious.” *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1336 (Fed. Cir. 2004) (Prost, J.); *see Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (Gajarsa, J.) (same). The same is true of enablement. *Amgen Inc. v. Hoechst Marion Roussel*, 314 F.3d 1313, 1334 (Fed. Cir. 2003) (Michel, J.) (“[W]e . . . review the trial court’s determination de novo, deferring to its assessment of subsidiary facts underlying the legal question unless clearly erroneous.”).

A two-tiered standard of review also applies to other areas of intellectual property law, such as the evaluation of likelihood of confusion in trademark cases. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir. 2000) (Linn, J.) (reviewing likelihood of confusion determination by Trademark Trial and Appeal Board as “a legal conclusion based on underlying facts. This court reviews the legal conclusion without deference and the underlying factual findings for substantial evidence”).¹¹ In areas of the law beyond

¹¹ *See also Pebble Beach Co. v. Tour 18 I, Ltd.*, 155 F.3d 526, 537 (5th Cir. 1998) (likelihood of confusion). The same is true of various copyright issues. *See, e.g., Nelson-Salabes, Inc. v. Morningside Dev.*,

intellectual property, the combination of deference to underlying factual assessments and de novo review of legal conclusions is also familiar. *See Ornelas v. United States*, 517 U.S. 690, 699 (1996) (holding that appellate courts should review determinations of reasonable suspicion and probable cause de novo and findings of historical fact for clear error).¹² Similarly, this Court should afford deference to district courts' inferences or findings about factual issues encountered in claim construction.¹³

LLC, 284 F.3d 505, 512 (4th Cir. 2002) (implied license); *Graham v. James*, 144 F.3d 229, 235 (2d Cir. 1998) (work for hire).

¹² *See also, e.g., Reebok Int'l Ltd. v. McLaughlin*, 49 F.3d 1387, 1390 (9th Cir. 1995) (personal jurisdiction); *City Nat'l Bank v. Unique Structures, Inc.*, 49 F.3d 1330, 1333 (8th Cir. 1994) (commercial reasonableness); *Meridien Bank v. Alten*, 958 F.2d 1226, 1229-30 & n.2 (3d Cir. 1992) (bankruptcy).

¹³ This approach is consistent with the Supreme Court's opinion in *Markman*, 517 U.S. at 389-90, and not completely divorced from the de novo review applied in *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998) (en banc). In *Markman*, the Supreme Court apportioned responsibilities between judges and juries under the Seventh Amendment, not between district and appellate courts. Moreover, as Judge Bryson explained when *Cybor* was decided, "simply because a particular issue is denominated a question of law does not mean that the reviewing court will attach no weight to the conclusion reached by the tribunal it reviews." *Id.* at 1463 (Bryson, J., concurring).

Deference on the limited basis urged here supports two important policies. First, district courts are well-positioned to explore factual circumstances from which an accurate claim construction may be derived. They have access to live testimony and time to compile and master a full factual record. Particularly in the situation of conflicting expert testimony, a district court's judgments cannot be duplicated by reading a cold record. As the Supreme Court has warned, "the reviewing attitude that a court of appeals takes toward a district court decision should depend upon 'the respective institutional advantages of trial and appellate courts.'" *First Options of Chicago, Inc. v. Kaplan*, 514 U.S. 938, 948 (1995) (quoting *Salve Regina College v. Russell*, 499 U.S. 225, 231-33 (1991)). District courts have "institutional advantages" when evaluating facts to reach the legal conclusion of claim construction.

Second, a completely nondeferential standard of review undermines predictability in patent law. The Federal Circuit presently reverses a significant proportion of the claim construction cases it reviews. *See, e.g.*, ROBERT L. HARMON, PATENTS AND THE FEDERAL CIRCUIT (Supp. 2004), pp. 36-37 (analyzing recent claim

construction reversal rates). Instead of providing early closure on claim construction issues that can affect every other aspect of litigation, the lack of deference and high reversal rate encourage dissatisfied litigants to contest every issue in the case and then pursue an appeal, hoping for a more favorable claim construction. See Comment, M. Reed Staheli, *Deserved Deference: Reconsidering the De Novo Standard of Review for Claim Construction*, 3 MARQ. INTELL. PROP. L. REV. 181, 198-99 (1999).

CONCLUSION

The appropriate answers to the Court's *en banc* questions flow from the fundamental standard identified in this brief: a court should construe a claim term from the perspective of a person of ordinary skill in the relevant art at the time the patent issued seeking to understand the term's meaning from a study of the entire intrinsic record. Under this approach a court should not adopt a dual restriction on claim scope and should not construe claims solely to preserve validity. Finally, this Court should defer to the district courts when they have decided subsidiary questions of fact.

Respectfully submitted,

RICK D. NYDEGGER, *President*
AMERICAN INTELLECTUAL
PROPERTY LAW ASSOCIATION
2001 Jefferson Davis Highway
Arlington, VA 22202
(703) 415-0780

DAVID R. TODD
WORKMAN NYDEGGER
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111
(801) 533-9800

DENISE W. DEFRANCO
FOLEY HOAG LLP
Seaport World Trade Center West
155 Seaport Boulevard
Boston, MA 02210
(617) 832-1000

JOSEPH R. RE
JOSEPH S. CIANFRANI
KNOBBE MARTENS OLSON & BEAR
2040 Main Street, 14th Floor
Irvine, CA 92614
(949) 760-0404

Attorneys for Amicus Curiae
September 17, 2004

CERTIFICATE OF SERVICE

I hereby certify that on September 17, 2004, I caused the foregoing BRIEF FOR *AMICUS CURIAE* AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF NEITHER PARTY to be served by next-business-day delivery to:

CARL F. MANTHEI (2 copies)
1205 Seventeenth Street
Boulder, CO 80302
Attorney for Plaintiff-Appellant

MARK W. FISCHER (2 copies)
FAEGRE & BENSON LLP
1900 Fifteenth Street
Boulder, CO 80302
Attorney for Defendants-Cross Appellants

Clerk (orig. + 30 copies)
U.S. Court of Appeals for the Federal Circuit
Howard T. Markey National Courts Building
717 Madison Place, N.W.
Washington, D.C. 20439

CERTIFICATE OF COMPLIANCE

Pursuant to Fed. R. App. P. 32(a)(7)(C), I certify that according to the word-processing system used in preparing it, the foregoing BRIEF FOR *AMICUS CURIAE* AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF NEITHER PARTY, in relevant part, is 4,474 words in length and therefore complies with the 5,000 word limitation imposed by this Court's July 21, 2004 Order.

DAVID R. TODD