

NOS. 03-1269, 03-1286

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

ON APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF COLORADO
IN 97-MK-212
JUDGE MARCIA S. KRIEGER

BRIEF OF *AMICUS CURIAE* BOSTON PATENT LAW ASSOCIATION IN
SUPPORT OF PLAINTIFF-APPELLANT EDWARD H. PHILLIPS IN THE
EN BANC REHEARING

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**UNITED STATES COURT OF APPEALS FOR THE FEDERAL
CIRCUIT**

Phillips v. AWH Corporation
No. 03-1269, -1286

CERTIFICATE OF INTEREST

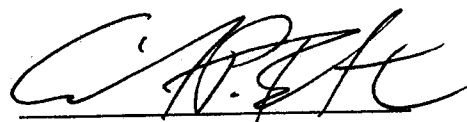
Counsel for the Amicus, Boston Patent Law Association, certifies the following:

1. The full name of every party or amicus represented by me is:
Boston Patent Law Association
2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:
None
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:
None
4. ☐ There is no such corporation as listed in paragraph 3.
5. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

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INTEREST OF AMICUS CURIAE

This brief is submitted by the Boston Patent Law Association, an intellectual property association that provides educational programs and a forum for the interchange of ideas and information concerning patent, trademark, copyright, and other intellectual property rights. Amicus is concerned that that any decision regarding the role of dictionaries in claim construction will affect the practice of patent prosecution and litigation.¹

ARGUMENT

I. DICTIONARIES SHOULD NOT BE THE PRIMARY SOURCE OF CLAIM CONSTRUCTION

This Court's decision in *Texas Digital* held that dictionaries "may be the most meaningful [source] of information" to be used in claim construction because they reflect "the established meanings that would have been attributed to the terms of the claims by those of skill in the art." *Texas Digital Sys. Inc. v. Telegenix Inc.*, 308 F.3d 1193, 1203 (Fed. Cir. 2002).

¹ The Amicus Committee of the Boston Patent Law Association thanks the contributions of Bromberg and Sunstein LLP and of Courtney Quish and Debra Koker, members of the Bromberg and Sunstein 2004 summer associate class.

Since *Texas Digital*, however, other panels of this Court have cautioned against over-reliance on dictionaries, favoring instead an approach that considers the real-world context of the invention and the viewpoint of those of ordinary skill in the art. See, e.g., *Brookhill-Wilk I, LLC v. Intuitive Surgical, Inc.*, 326 F.3d 1215, 1221 (Fed. Cir. 2003) (noting that prior case law on “the use of dictionaries should not be read to suggest that abstract dictionary definitions are alone determinative”); *Alloc, Inc. v. International Trade Comm’n*, 342 F.3d 1361, 1368 (Fed. Cir. 2003) (“a court must resist relying on [dictionaries and other reference materials] in a vacuum” lest they ignore other evidence on how “one of skill in the art at the time of invention” would have read the disputed claims).

The question, therefore, is how to resolve the tension between the *Texas Digital* line of decisions placing dictionaries in the forefront, and the competing line of cases crediting a wider array of evidence. As seen below, the Boston Patent Law Association (BPLA) argues against reliance on dictionaries (whether general or technical) in the first instance. Rather, the BPLA sees no need to depart from the order of claim construction outlined in *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1585 (Fed. Cir. 1996), in which a dictionary may be consulted, but only at the end of the process, after

proper consideration of the claims, intrinsic record, and other sources of interpretation. Nor should a court place too much emphasis on any one source of interpretation, other than the claim itself, which is primary and usually offers its own clues to interpretation.

A. Dictionaries Do Not Keep Abreast Of Invention

Invention takes place in the lab. Or in the factory, amidst the hum and clank of machinery. Or even in the weekend inventor's garage workshop, sawdust and oil stains on the floor. Invention involves beakers, soldering irons, lathes, drill presses, microscopes and, nowadays, CAD/CAM computer design software. Invention does not necessarily take place in a hushed library, with Webster's Dictionary perched on the reading table.

Correspondingly, the primary audience for a patent includes the inventor's competitors or fellow artisans--*e.g.*, the white-coated chemist, surrounded by test tubes and Bunsen burners; the machine shop foreman, blueprints spread out before him on the workbench; or even the grease-stained mechanic, wrench and socket in hand. That intended audience is not the tweed-jacketed editorial staff of the *OED*.

That is, a patent is meant to be read and understood by a person of ordinary skill in the art (what we will call the "POSITA"). Because the patent is as much a technical document as a legal one, a judge should view it through the eyes of a POSITA. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309 (Fed. Cir. 1999).

A dictionary does not always reflect the understanding of the POSITA, however. As the United States Supreme Court recently observed, the "dictionary does not always keep abreast of the inventor." *Festo Corp. v. Shoketsu Kinzoku Kogoyo Kabushiki Co., Ltd.*, 535 U.S. 722, 731 (2002). Indeed, "[t]hings are not made for the sake of words, but words for things." *Id.* (quoting *Autogiro Co. of America v. United States*, 384 F.2d 391, 397 (Ct. Cl. 1967)).

Unlike the POSITA, who is working in the field and using the terms of art in his or her professional capacity each day, the dictionary does not keep up with the pace of technology:

new words are constantly being coined to name or describe new inventions or innovations, or to better identify aspects of our rapidly changing world. Constraints of time, money, and staff would make it impossible for any dictionary, no matter how large, to capture a fully comprehensive account of all the words in the language. And even if such a leviathan reference was somehow fashioned, the dictionary would be obsolete the instant

it was published as speakers and writers continued generating new terms to meet their constantly changing needs.

If A Word Is Not In The Dictionary, Does That Mean It Isn't A Real Word?

http://www.m-w.com/help/faq/real_words.htm (Sept. 14, 2004).

Scientists, engineers, mechanics, university professors, and others who work or teach every day in the field of invention typically keep current on advances in technology. They read the latest technical journals. They keep one eye on their competitors' products (and, perhaps, reverse engineer those products). They get under the car with a wrench and take apart the transmission, so to speak. Accordingly, because these artisans spend each working day in the field of invention, they likely do not have to consult dictionaries to understand the meaning of words used in patent claims. *Multiform Desiccants, Inc. v. Medzam, Inc.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998) (POSITA "is deemed to read the words used in the patent documents with an understanding of their meaning in the field, and to have knowledge of any special meaning and usage in the field").

Even PTO examiners, who review and allow the claims, read other patents, patent applications, and technical literature in the field of invention every day and thus do not need to consult dictionaries to understand the scope of the claims they allow (and often rewrite). *American Hoist & Derrick Co. v.*

Sowa & Sons, Inc., 725 F.2d 1350, 1359 (Fed. Cir. 1984) (examiners are presumed “to be familiar from their work with the level of skill in the art”).

Thus, the POSITA is better positioned than a dictionary to assist a court in interpreting disputed claim wording.

B. Dictionaries Are Not Necessarily Authoritative

In *Texas Digital*, this Court suggested that dictionaries reflect the established meaning of terms at the time of invention. 308 F.3d at 1202. But do dictionaries really provide established definitions that would be relied upon by a POSITA? The BPLA questions that assumption.

A recent essay in the “On Language” column in the New York Times Magazine cautioned against regarding dictionaries as monolithic, unimpeachable authorities on meaning. Rather, to use a dictionary properly, one must first “understand what jobs the makers of a particular dictionary intended it for . . . and to be as skeptical and sophisticated about the information in a dictionary as we are about information found elsewhere.” Barbara Wallraff, *Dictionaries: Just because they say it doesn’t make it so*, N. Y. Times, Sept 5, 2004 (Magazine) at 18.

There are 72,785 English dictionaries on sale now at Amazon.com. This number does not account for the entire collection of English dictionaries. These dictionaries do not share content: the definition assigned by one dictionary can be distinct from the definition assigned by another. For example, in the recent case *Nystrom v. Trex Co., Inc.*, the parties disagreed as to the ordinary meaning of “board.” In a dispute over whether “board” confined the claim to only wood material, each party identified an appropriately supportive yet contrasting definition of the word. 374 F.3d 1105 (Fed. Cir. 2004). One dictionary defined board as “a piece of sawed lumber of little thickness but considerable surface area.” *Id.* at 112 (*citing* Webster’s Third International Dictionary 243 (2002)). Another dictionary, however, defined the word as a “flat piece of wood or similarly rigid material,” *Id.* (*citing* American Heritage Dictionary of the English Language 203 (4th ed. 2000)) (emphasis added). The competing dictionaries themselves gave no clues for preferring one meaning over another. Resort to the understanding of a POSITA would have helped the choice.

Likewise, in *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, this Court acknowledged that the dictionary entry for “remote” “has several definitions that all have facial relevance to the claimed invention.” 334 F.3d 1294, 1299

(2003). In that case, each party had presented a dictionary definition that suited that party's argument. The dictionary definitions proved inadequate because each was equally likely to apply to the facts of the case. The *Brookhill-Wilk I* panel avoided a war between dictionaries by concluding that "the correct meaning of a word or phrase is informed only by considering the surrounding text." *Id.* at 1300 Words cannot function alone. But by isolating specific terms in a dictionary, a court rips the word from its context of skilled art and thus misses the engineer's perspective.

Dictionaries are problematic for other reasons. For a word to be included in, for example, a Merriam-Webster Dictionary, "it must have enough citations to show that it is widely used. But, having a lot of citations is not enough. . . . a word must be used in a substantial number of citations that come from a wide range of publications over a considerable period of time." *How does a word get into a Merriam Webster Dictionary?* http://www.m-w.com/help/faq/words_in.htm (Sept. 15, 2004). Thus, a dictionary definition may or may not reflect the meaning of a term at the time of invention.

To determine which words belong in the Merriam-Webster Dictionary, editors read a cross-section of published material to see which words are used most often and how they are used. Once entered into a citation file, a term is

reviewed by an editor, who will decide if it has enough citations from diverse sources. How long it takes from citation until publication depends upon the stage of dictionary publication at the time the term is coined. Therefore, the length of time taken in each stage of lexicography--identifying a term, recognizing the term in common usage, gathering diverse meanings, and submitting for publication--can take an indefinite amount of time and will differ for each new word. For example, the phrase 'information technology' is a new entry in the 2004 Merriam-Webster's Collegiate Dictionary, Eleventh Edition, even though the term was coined in 1978. *2004 Copyright New Words and Senses Sampler* http://www.webster.com/info/new_words.htm (July 27, 2004). The term 'MP3' has also been added to the same 2004 edition despite its use in the art since 1996 or earlier. *Id.* The words in a dictionary have no certainty of time. Thus, a dictionary available at the time the inventor files his or her patent application will not necessarily reflect the meaning the inventor (and the PTO examiner) understood the technical terms to have.

Moreover, a general dictionary cannot assist with the understanding of a technical word when there is no requirement that the word have a meaning in every technical field. Indeed, "a word may be rejected ... if all of its citations come from a single source or if they are all from highly specialized

publications that reflect the jargon of experts within a single field.”
http://www.webster.com/help/faq/words_in.htm (July 27, 2004). Even Merriam-Webster appreciates the difference between a technical term used in the art and a term sufficient for entry into a general dictionary.

Accordingly, dictionaries are no more reliable than other sources of meaning. Moreover, dictionaries cannot be cross-examined to determine which contrasting definition is more reliable. That is not to say that a dictionary should never be consulted when construing a claim. But other sources of meaning should be given equal or greater consideration.

A court should not accept a dictionary definition (or other extrinsic document) in a vacuum. As seen above, dictionaries do not necessarily speak for themselves but rather require an understanding of how the definitions in it get there. Accordingly, before accepting a dictionary definition, a court could require, for example, expert testimony that a POSITA would have consulted the particular reference at the time the claims were written, that those in the field considered the source to be authoritative, that the source was peer-reviewed, or some other testimony showing why one particular extrinsic reference should be credited over other sources. A dictionary or other

reference could serve to corroborate an expert's testimony, but it should not replace expert testimony or other sources of meaning.

C. Meaning Is Not Always Found in Books

This Court has likened claim construction to statutory construction. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 987 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996). But that analogy does not confine construction to any one particular source. Rather, it encourages reference to the real world of invention and technology: “judicial construction ought not to be torn from its wider, non-legal context.” Felix Frankfurter, *Some Reflections on the Reading of Statutes*, 47 Colum. L. Rev. 527, 528 (1947). Thus, as Justice Frankfurter wrote, “to understand or at least get the feeling of great painting, one does not go to books on the art of painting. One goes to the great masters.” *Id.* at 530. Likewise, to understand the patented technology, one must go to artisans in the field of invention. Whether a statute or a patent, if it is “addressed to the specialist, [it] must be read by judges with the minds of the specialist.” *Id.* at 536.

Further, by definition, a dictionary, even a highly technical dictionary, defines a term in the abstract, outside its context. But, “words of art bring

their art with them. They bear the meaning of their habitat whether it be a phrase of technical significance in the scientific or business world.” *Id.* at 537. To isolate a word from its real world, technological context strips the term of all relevant meaning.

The necessary context for the claimed invention can be found in the first instance in the specification and prosecution history. It can also be found in the testimony of a POSITA (*i.e.*, an expert qualified to speak on behalf of the hypothetical POSITA) discussing the state of the art, the problem the invention solved, and how the disputed terms were being used by others in the real world of invention.

In contrast to a dictionary, the mechanic or scientist offers a breathing, sweating, life-size explanation of a term. The expert provides the court with access to the POSITA’s toolbox. The expert’s experience in the relevant art insures that he or she is using the same tools of interpretation as those available to the intended audience of fellow engineers. The dictionary is not typically found in the mechanic’s toolbox of interpretation.

Although litigation has prompted the battle of competing experts, the variance in expert testimony in a given case does not match that of dictionaries. First, an expert is questioned under oath and is therefore bound

to keep his testimony within true parameters of the art. Second, unlike dictionaries, experts can be cross-examined. The opposing party has the opportunity to explore the nature of the expert's experience and inquire into his knowledge in the field to ensure that the expert is indeed a person of skill in the specific art. Further, cross-examination requires explanation of why a term should be construed in a particular way and why such a person of ordinary skill would understand the term to meet the asserted definition.

As Justice Frankfurter noted, "Words in statutes are not unlike words in a foreign language in that they too have 'associations, echoes, and overtones.' Judges must retain the associations, hear the echoes, and capture the overtones." Frankfurter, *Id.* at 533. Correspondingly, in his role as translator of technical jargon into English, as a tutor on complex technology, an engineer or workman allows the trial judge to understand the associations, echoes, and overtones that the POSITA understands inherently.

The POSITA provides a context for the words based on his or her experience. The POSITA's translation of the terms are essential because the claim wording "is not addressed to lawyers, or even to the public generally" but to the hard-hat engineer on the shop floor. *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 437, (1902). Thus, a court will most strongly satisfy

the notice function of a patent by defining terms as they would be used in the real world. In order to do so, a court must step out of the library and into the lab or onto the shop floor.

II. THE ROLE OF THE CLAIM, SPECIFICATION, AND OTHER SOURCES OF INTERPRETATION IN CLAIM CONSTRUCTION

In *Vitronics*, this Court outlined an order and methodology for claim construction. 90 F.3d at 1582. The BPLA sees no reason to depart from that order and no reason to elevate dictionaries above claims and other intrinsic evidence. As this Court held in *Vitronics*, a court begins and ends its construction with the words of the claims themselves. *Id.* After reading the claims, a court may consult the specification and prosecution history. Then, and only then, comes extrinsic evidence, such as expert testimony, dictionaries, technical journals, prior art, treatises, and the like. *Id.*

The claim alone defines the scope of the patented invention. *Markman*, 52 F.3d at 970. Thus, one starts the construction process by reading the words of the claim itself. One should give the disputed term its plain, unadorned meaning. One should not restrict a particular claim word unless that word follows, or is followed by, an adjective or adverb in the claim. Thus, in a

claim for exercise equipment, the term “member” may be either a straight, one-piece member or a curved, two-piece member, or of any other configuration, unless the claim includes the appropriate modifiers. *CCS Fitness v. Brunswick Corp.*, 288 F.3d 1359, 1367 (Fed. Cir. 2002). Accordingly, the claim itself usually gives clues to its proper scope.

Neighboring claims may also inform and confirm the initial reading of the disputed claim. If, for example, a dependent claim requires a “one-piece member,” it would be unreasonable under the doctrine of claim differentiation to interpret the lone, unmodified term “member” in the independent claim as requiring that same configuration. *See, e.g., Clearstream Wastewater Sys., Inc. v. Hydro-Action, Inc.*, 206 F.3d 1440, 1446 (Fed. Cir. 2000) (holding that a dependent claim should not be construed as a limitation on the broader independent claim).

Next one consults the specification. Again, the claimed “member” or other disputed term should not be restricted to one embodiment unless the patent’s author has so defined the term. But that definition must be express—*i.e.*, something to the effect of “As used in this patent, the term ‘widget’ means only a three-piece widget” or “a three-piece widget is important to the invention, which could not work otherwise.” *See, e.g., CCS Fitness*, 288 F.3d

at 1367; *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1328 (Fed. Cir. 2002).

Even if the specification discloses but one embodiment, the claimed invention should not be confined to that embodiment, unless the patent's author has expressly disclaimed other embodiments. So long as the patent shows that the single disclosed embodiment is merely the "preferred" or "best" mode, then that single embodiment should not limit the claim. *Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855, 865 (Fed. Cir. 1988); *CCS Fitness*, 288 F.3d at 1366 (inventor not required to state all conceivable embodiments).

A court may also analyze the prosecution history. The prosecution history may indicate an express request by the PTO to limit a claim to a specific embodiment and an express acquiescence in that request by the inventor. But the public notice function is best served by enforcing only explicit disclaimers. If the prosecution history is silent on the issue, the claim cannot be limited. *York Prods. Inc. v. Central Tractor Farm & Family Center*, 99 F.3d 1568, 1575 (Fed. Cir. 1996) (prosecution history does not limit a claim unless there has been an express disavowal or other clear surrender of subject matter).

Finally, and particularly when a court is not familiar with the technology and technical jargon used in the patent, a court should hear testimony on the viewpoint of a POSITA. In that instance, the POSITA does not replace the court as arbiter of meaning but rather serves as a translator of the technical jargon and, ideally, tutors the court in the technology. *See Vitronics*, 90 F.3d at 1584. *Pitney-Bowes*, 182 F.3d at 1308. The expert may choose to invoke dictionaries and other reference materials to corroborate his or her testimony. But these references do not necessarily speak for themselves and should require testimony to support their use in claim construction.

III. VALIDITY AND CLAIM CONSTRUCTION SHOULD BE KEPT SEPARATE

Validity and claim construction involve separate inquiries, addressed to different arbiters, carrying different presumptions. While claim construction is a matter for a court to decide, many validity challenges—such as the anticipation and written description inquiries—present questions of fact for a jury. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351 (Fed. Cir. 2001) (what prior art discloses is a question of fact); *Union Oil Co. v. Atlantic Richfield Co.*, 208 F.3d 989, 996 (Fed. Cir. 2000) (written description inquiry is factual). Moreover, while a claim is not presumed to be infringed, it

is presumed to be valid and requires clear and convincing evidence to upset that presumption. 35 U.S.C. § 282; *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 941 (Fed. Cir. 1990) (claims are presumed to be fully supported by the specification and hence valid). Accordingly, a court should construe a claim without regard to whether that construction would be valid. To do otherwise would be to allow the accused infringer to avoid the presumption of validity or confuse the validity and infringement determinations. See *Tate Access Floors, Inc. v. Interface Architectural Resources, Inc.*, 279 F.3d 1357, 1367 (Fed. Cir. 2002) (a defendant is “not free to flout the requirement of proving invalidity by clear and convincing evidence” by sneaking a validity issue into the infringement analysis).

After construing a claim, a court may then send the question of validity to the jury, giving the claim the presumption of validity it deserves. If a jury decides that a claim as construed is invalid, so be it. But a court should not take that decision from the jury by construing a claim to preserve its validity.

IV. THE JUDGMENT OF NON-INFRINGEMENT SHOULD BE REVERSED

Infringement of United States Patent No. 4,677,798 (“the ‘798 patent”) centers on the term “baffle,” as found in Claim 1. Claim 1 requires “means

disposed inside the shell for increasing its load bearing capacity comprising internal steel baffles extending inwardly from the steel shell walls.” Nothing in this claim requires that the baffles be angled at other than 90° to deflect bullets. Claim 1 requires only that the baffles be made of steel, that they extend inwardly, and, presumably, that they contribute to the load bearing capacity of the shell.

In contrast dependent Claim 2 expressly requires that the baffles be “disposed at angles for deflecting projectiles such as bullets.” One must give this difference in wording proper consideration. *See, e.g., Clearstream Wastewater Sys.*, 206 F.3d at 1446 (under doctrine of claim differentiation, terms only appearing in one claim cannot be read into others).

Accordingly, unlike the baffle of Claim 2, the baffle of Claim 1 is unadorned by any restrictions or modifiers requiring projectile deflection. The claim itself, read in the context of neighboring claims, provides its own clues to proper construction. Thus, like the “member” of *CCS Fitness*, the baffle cannot be confined in the first instance to a particular angle or configuration.

Moreover, nothing in the specification restricts the baffle to one that is angled for bullet deflection. The specification does not state, for example, that

“baffles must be positioned at acute angles so as to successfully deflect bullets.” If a limitation is not express, it should not be read into the claim.

The district court found that “every textual reference in the Specification and its diagrams show baffle deployment at an angle other than 90 degrees to the wall faces.” *Phillips v. AWH Corporation*, 363 F.3d 1207, 1210 (Fed. Cir. 2004). But in relying on that happenstance, the court really was limiting the claim to the preferred or single embodiment disclosed. An inventor, however, is not required to disclose all conceivable embodiments. *SRI Int’l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121 n. 14 (Fed. Cir. 1985) (“That a specification describes only one embodiment does not require that each claim be limited to that one embodiment”).

In any event, the specification suggests that baffles may be positioned so as to deflect bullets, but it does not go so far as to expressly require the limitation. Indeed, the *Phillips* court relied on Figure 6 of the patent to limit the baffles to the particular angle for bullet deflection. 363 F.3d at 1214. But the specification states that Figure 6 shows merely the “preferred dimensions” of the construction. ‘798 patent, col. 5, ll. 6-7 (emphasis added). The specification also states that “the module characteristics may be easily custom tailored for the specific needs of each installation.” *Id.* at col. 5, ll. 36-38.

Such permissive statements in the specification show that the claims are not limited to the preferred embodiments. *See Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1345 (Fed. Cir. 2001).

Phillips presented evidence that a prison would not need bullet deflection properties because inmates, hopefully, do not have guns or bombs. Bullet deflection may be useful in other types of buildings, but not in a prison. In other words, given that the baffle configuration may be customized for the particular need, not every embodiment would require the bullet deflection configuration.

Phillips' expert also relied on the so-called "BOCA" building code to corroborate his testimony on the ordinary meaning of various terms in the claims. He testified that the definitions found in BOCA represented the meanings to one skilled in the art of security construction. A308-309, A490. That testimony stands to reason. Certainly a building contractor or construction engineer would need to consult a building code to ensure that the building complies with standards. In that sense, the BOCA code is not really an abstract dictionary in that it has real-world applications. Unaccompanied by such testimony, the BOCA source would have little value. But the combination of testimony and corroborating evidence helps shed light on how

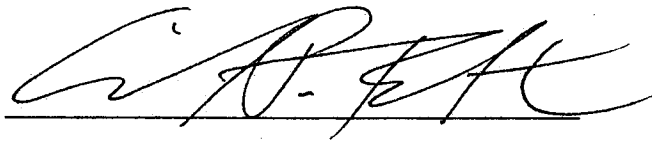
the POSITA—in this case, a building contractor or engineer experienced with security construction—would understand the problem and read the patent.

Accordingly, because the claim in the first instance does not require a particular angle for bullet deflection, because neighboring claims support that reading, because the specification does not expressly require that configuration, and because extrinsic evidence also supports the intrinsic record, this Court should reverse the narrower claim construction. It may be that, on remand, the claim as more broadly construed is or is not valid. But that question should be resolved by a jury.

CONCLUSION

The claim construction issues raised in the Court's order of July 21, 2004, should be resolved in favor of intrinsic evidence; namely claims, specifications, and prosecution history, as opposed to dictionaries. In particular, courts should adhere to the *Vitronics* order of interpretation. Courts should place the most emphasis on the claims themselves. If the scope of a claim is not clear, a court may consult the specification and prosecution history to look for express definitions or disavowals of meaning. This practice will best serve the public notice function of patents. Experts may be consulted as translators to clarify terms and explain the technology. Indeed, experts help

place the patented invention in context and allow courts to step onto the machine shop floor, so to speak. Finally, dictionaries should be used only after proper consideration of the intrinsic record and only to supplement or corroborate the intrinsic record. In light of these recommendations, this Court should reverse its judgment of non-infringement and remand for further proceedings.



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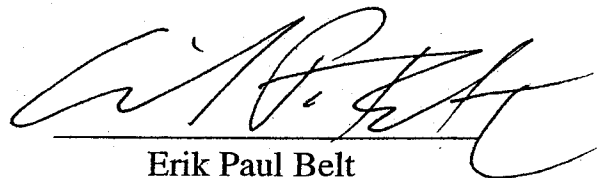
*Attorneys For Boston Patent Law
Association*

CERTIFICATE OF SERVICE

I certify that, on September 17, 2004, I served two true copies of the foregoing *Brief of Amicus Curiae Boston Patent Law Association in Support of Plaintiff-Appellant Edward H. Phillips in the En Banc Rehearing* on the defendant-cross appellants' counsel, Mark W. Fischer, Faegre & Benson LLP, 1900 15th Street, Boulder, Colorado 80302, by sending him the copies via Federal Express priority overnight delivery.

I certify that, on the same day, I sent two true copies of the foregoing *Brief of Amicus Curiae Boston Patent Law Association in Support of Plaintiff-Appellant Edward H. Phillips in the En Banc Rehearing* on the plaintiff-appellant's counsel, Carl F. Manthei, at 1205 17th Street, Boulder, Colorado 80302 by sending him the copy via Federal Express priority overnight delivery

I also certify that, on the same day, I sent an original and thirty copies of the foregoing *Brief of Amicus Curiae Boston Patent Law Association in Support of Plaintiff-Appellant Edward H. Phillips in the En Banc Rehearing* to the Clerk of the United States Court of Appeals for the Federal Circuit by Federal Express priority overnight delivery.

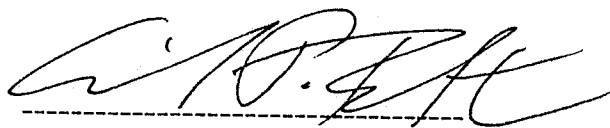
A handwritten signature in black ink, appearing to read 'Erik Paul Belt', is written over a horizontal line.

Erik Paul Belt

CERTIFICATE OF COMPLIANCE

I certify that this brief complies with the type volume limitation of Fed. R. App. P. 32(a)(7)(B). According to the word-count program of the word processing system used in preparing this brief (Microsoft Word 2002), this brief contains **4,742** words, excluding the parts of the brief exempted by Fed. R. App. P. 32(a)(7)(B)(iii).

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Erik Paul Belt

Co-Chair of the Boston Patent
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September 17, 2004