

03-1269, -1286

**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.**

**Appeals from the United States District Court
for the District of Colorado in case no. 97-CV-212,
Judge Marcia S. Krieger.**

**BRIEF OF AMICUS CURIAE
FEDERAL CIRCUIT BAR ASSOCIATION**

Of Counsel:

Charles F. Schill
PRESIDENT
FEDERAL CIRCUIT BAR ASSOCIATION
1300 I Street, N.W. Suite 700
Washington, D.C. 20005
(202) 408-4000

Counsel of Record:

Michael P. Dougherty
MORGAN & FINNEGAN, L.L.P.
Three World Financial Center
New York, New York 10281-2101
(212) 415-8700
Counsel for Amicus Curiae
Federal Circuit Bar Association

CERTIFICATE OF INTEREST

Counsel for Amicus, the Federal Circuit Bar Association, certifies the following:

1. The full name of every party or amicus represented by me is the Federal Circuit Bar Association.

2. The name of the real party in interest represented by me is the Federal Circuit Bar Association.

3. The 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. The names of all law firms and the partners or associates that appeared for the amicus now represented by me in the trial court or agency or are expected to appear in this Court are: Michael P. Dougherty of Morgan & Finnegan LLP and Charles F. Schill of the Federal Circuit Bar Association.

September 20, 2004

Michael P. Dougherty

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STATEMENT OF INTEREST OF AMICUS CURIAE

The Federal Circuit Bar Association (“FCBA”) is a national bar organization with over 2,600 members from all geographic areas of the country, all of whom practice before or have an interest in the decisions of the Court of Appeals for the Federal Circuit. The FCBA offers a forum for discussion of common concerns between bar and Court, litigator and corporate counsel. One of the FCBA’s purposes is to render assistance to the Court in appropriate instances, both in procedural and substantive practice areas, whenever the FCBA or the Court believes a contribution can be made.

The FCBA submits this brief in response to the Court’s order of July 21, 2004, which invited interested bar associations to participate as amici curiae in the rehearing en banc of this appeal. The FCBA takes no position with respect to the ultimate merits of this case. Rather, its members desire only to express their views on the issues of patent claim construction raised in the order granting en banc review.

ARGUMENT

I. COURTS SHOULD NOT BE REQUIRED TO CONSULT SOURCES OF INFORMATION RELEVANT TO THE MEANING OF DISPUTED CLAIM TERMS IN ANY PARTICULAR ORDER

Question No. 1 of the order granting en banc review asks whether dictionaries or the patent specification should be the primary focus of the claim construction analysis. The Question also asks, “If both sources are to be consulted,

in what order?” We respectfully suggest that both sources may be consulted, along with other intrinsic or extrinsic evidence that may be helpful, but that the Court should not require any of the tools of claim construction to be consulted in any particular order. Rather, the trial court should be free to use the tools of claim construction in whatever order is appropriate in a given case.

A mechanical approach of “dictionaries first, then the specification,” or *vice versa*, is impractical given the variability in the claim construction issues facing trial courts. Moreover, placing undue weight on either of those sources can lead to unfortunate results. We respectfully submit that the vacated majority opinion in this case, Phillips v. AWH Corp., 363 F.3d 1207 (Fed. Cir. 2004), relied too heavily on the patent specification and thereby imposed a limitation on the claims that their language does not support. An example of the other extreme is Novartis Pharmaceuticals v. Eon Labs., 363 F.3d 1306 (Fed. Cir. 2004), in which the Court found an ambiguity in the claim term “hydrosol” only after consulting the definitions of the words “sol,” “solution,” “medicinal,” “medicine,” and finally “preparation,” none of which appeared in the claims.

II. DICTIONARIES SHOULD NOT BE THE PRIMARY FOCUS OF CLAIM CONSTRUCTION

The dictionary-centered approach to claim construction exemplified in some of this Court’s recent opinions is premised on the assumption that there is an “ordinary meaning” for almost every claim term and that courts can find that

meaning through dictionaries. One undesirable consequence of this approach is that the claim construction adopted by the Court can turn on which dictionary is consulted. See, e.g., Novartis, 363 F.3d at 1314 (Clevenger, J. dissenting) (pointing out that a critical step of the majority’s chain of reasoning would have disappeared if the majority had relied on a different dictionary for the term “sol”); see also Joseph S. Miller & James A. Hilsenteger, The Proven Key: Roles and Rules for Dictionaries in the Patent Office and the Courts (Aug. 16, 2004), <http://ssrn.com/abstract=577262>, 38-40 (discussing International Rectifier Corp. v. IXYS Corp., 361 F.3d 1363 (Fed. Cir. 2004), which construed the claim term “adjoining” on the basis of a “usage note” for the word “adjacent” in Webster’s Third International Dictionary, and pointing out that the result would have been different if other widely-used dictionaries had been consulted); see also id. at 33 (discussing four cases in which this Court relied on a different dictionary from the trial court with no explanation of why it was doing so).

Another undesirable consequence of the dictionary-centered approach is that it can result in terms being given meanings far removed from what the inventor had in mind at the time the application was filed. For example, recent decisions have held that “claim terms may be construed to encompass all dictionary definitions not inconsistent with the intrinsic record.” Nystrom v. Trex Co., 374 F.3d 1105, 1112 n.2 (Fed. Cir. 2004) (emphasis in original) (citing cases).

To determine whether a given definition is inconsistent with the intrinsic record, the Court asks “if ‘the inventor has disavowed or disclaimed scope of coverage, by using words or expression of manifest exclusion or restriction, representing a clear disavowal of claim scope.’” Id. at 1111 (quoting Texas Digital Sys. v. Telegenix, Inc., 308 F.3d 1193, 1204 (Fed. Cir. 2002)). Thus, the construction turns not on how the inventor used the term in the patent documents, but on whether the inventor happened to expressly disclaim meanings that he or she may not even have contemplated. We respectfully suggest that a better approach would abandon the assumption that claim terms embrace all relevant dictionary definitions unless expressly disclaimed, and place far more emphasis on the context of the inventor’s use of the disputed term in the specification and prosecution history. In the following paragraphs, we propose how such an analysis might be carried out.

Recognizing that a claim term may have several plausible ordinary meanings, we suggest that the first step of the claim construction process should be for the trial court to familiarize itself with all of the available evidence regarding the meaning of the term in dispute. This evidence should include the claims themselves, the specification, and the prosecution history (if in evidence). It may also include treatises and dictionaries to the extent the trial court, in its discretion, finds them helpful. Because the goal of this stage of the claim construction process is to identify the full range of plausible meanings of the term, the issue of technical

versus general purpose dictionaries does not arise; both types of dictionaries can be consulted, as appropriate. Expert testimony should also be permitted to the extent the trial court believes it may be useful.¹ The only restriction on this phase of the inquiry is that courts should focus on interpretations identified by the parties; they should generally not propose meanings that the parties never advocated without giving the parties opportunity for further briefing. Further, where there is undisputed expert testimony on the meaning of a term to persons of skill in the art, dictionary definitions that are inconsistent with such testimony should be accorded no weight.

Once the range of plausible meanings for the disputed term is identified, the court should proceed to the second part of the claim construction process: a thorough study of the intrinsic evidence to determine which subset of the plausible meanings is most consistent with how the patentee used the term. This is the aspect of the FCBA's proposed approach that differs most significantly from this Court's recent cases adopting an "ordinary meaning" approach to claim

¹ It is not uncommon to confront a claim term for which there is no plausible dictionary definition and for which the patent specification and prosecution history provide no useful guidance as to its meaning. In such circumstances, expert testimony may be the only practical way of ascertaining the term's meaning(s) to a person of skill in the art. In view of this reality, we respectfully suggest that the en banc Court address the language in Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583, 1584 (Fed. Cir. 1996), that discourages trial courts from looking beyond the intrinsic evidence and state clearly that expert testimony is generally permissible to contextualize the intrinsic evidence.

construction. As noted previously, those cases determine the “ordinary meaning” of the term from dictionaries, treatises and the like, then turn to the specification and prosecution history only to ascertain whether the patentee has acted as his own lexicographer or has otherwise made a clear disclaimer of claim scope. We suggest that the investigation should not be so limited. Rather, as just noted, we suggest that the court should carefully analyze the specification and prosecution history to determine which of the plausible meanings of the term in question is most consistent with the patentee’s use of the term. The inquiry should not be limited to express definitions or disclaimers. Rather, any disclosure tending to point toward or away from any given meaning should be considered.

In the absence of an express definition or express disclaimer of claim scope, the ultimate construction of the disputed term should be consistent with the patentee’s use of the term in the specification and prosecution history, but not limited to it. Thus, we would answer “no” to Question No. 3, which asks whether claim language should be limited to the scope of the invention disclosed in the specification when, for example, only a single embodiment is disclosed and the specification contains no other indications of breadth. We respectfully disagree with the approach of the vacated majority opinion in this case, which limited the term “baffle” to baffles “oriented at angles other than 90^o” because that was the only orientation disclosed in the specification and because a non-90^o orientation

was deemed essential for providing one (but not all) of the objectives of the invention. 363 F.3d at 1213.

Finally, it is the FCBA's view that issues of patent validity under 35 U.S.C. §§ 102 and 103 ordinarily should not be considered in connection with claim construction. In practice, the "familiar axiom that claims should be so construed, if possible, as to sustain their validity," Rhine v. Casio, Inc., 183 F.3d 1342, 1345 (Fed. Cir. 1999), adds uncertainty to the claim construction process and encourages issues of patent validity to be decided in the context of Markman hearings, where the protections of 35 U.S.C. § 282 do not apply. Thus, we suggest that claims should be construed without regard to their validity over the prior art. If the claims as so construed are invalid, then so be it. But the challenger should not be relieved of the burden of proving invalidity by clear and convincing evidence.

III. CLAIM CONSTRUCTION MAY REQUIRE FINDINGS OF FACT, WHICH SHOULD BE REVIEWED FOR CLEAR ERROR

Question No. 7 of the order granting en banc review asks whether, "Consistent with . . . Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996) [Markman II], and . . . Cybor Corp. v. FAS Technologies, Inc., 138 F.3d 1448 (Fed. Cir. 1998), is it appropriate for this Court to accord any deference to any aspect of trial court claim construction rulings? If so, on what aspects . . .?" The FCBA respectfully submits that this Court should indeed defer to certain aspects of

the trial court's claim construction, but that doing so will require the Court to reconsider its holdings in Cybor and Markman v. Westview Instruments, Inc., 52 F.3d 897, 981 (Fed. Cir. 1995) (en banc) ("Markman I"), that all aspects of claim construction are subject to de novo review. This in turn will require the Court to reconsider the theoretical justification for that standard, namely, the notion that "by using certain extrinsic evidence . . . and rejecting other evidence. . . , and resolving disputes en route to pronouncing the meaning of claim language. . . the court is not crediting certain evidence over other evidence or making factual evidentiary findings." Markman I, 52 F.3d at 981.

This Court is well aware of the frustration expressed by many district courts over the legal fiction that they are not weighing evidence or making credibility determinations when they credit the views of one expert over another on the meaning of a technical term, or when they reach a conclusion on the meaning of a term to a person of skill in the art after a thorough review of the documentary evidence. See Cybor, 138 F.3d at 1475 (Rader, J., dissenting) (quoting district courts). Moreover, nearly ten years of experience has shown that the de novo standard of Markman I and Cybor has not promoted uniformity and predictability in patent litigation. To the contrary, it causes uncertainty and discourages settlement of patent cases because there is a substantial probability that the trial court's construction will be rejected on appeal.

With these concerns in mind, we respectfully suggest that the en banc Court acknowledge that claim construction can and often does require a trial court to make findings of fact. When such findings are made, they should be treated on appeal like any other findings of the trial court, i.e., they should be reviewed under the “clearly erroneous” standard of Fed. R. Civ. P. 52(a). Reviewing the trial court’s factual findings for clear error is consistent with the Supreme Court’s opinion in Markman II, since that opinion addressed only the involvement of juries in claim construction, not the standard of appellate review. Moreover, the Federal Circuit has successfully applied this approach for years in its review of trial courts’ judgments on inequitable conduct, another subject unique to patent law for which there is no right to a jury.

CONCLUSION

We respectfully suggest that the construction of patent claims should be a two-step process. First, a trial court should determine the full range of plausible meanings for a disputed term, consulting any intrinsic or extrinsic evidence that the court finds helpful, including expert testimony and dictionaries, in whatever order is appropriate under the circumstances of a given case. Second, the court should conduct a careful review of the intrinsic evidence to determine which subset of the plausible meanings so identified is most consistent with the

patentee's use of the term. Findings of fact made by the trial court in this process should be reviewed on appeal for clear error.

Respectfully submitted,

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Michael P. Dougherty
MORGAN & FINNEGAN, LLP
Three World Financial Center
New York, NY 10281-2101
(212) 415-8700
Counsel for Amicus Curiae
Federal Circuit Bar Association

Of Counsel:

Charles F. Schill

PRESIDENT

FEDERAL CIRCUIT BAR ASSOCIATION

1300 I Street, N.W. Suite 700

Washington, D.C. 20005

(202) 408-4000

CERTIFICATE OF SERVICE

I certify that I caused the foregoing Brief of Amicus Curiae Federal Circuit Bar Association to be served as follows on September 20, 2004:

Counsel for Plaintiff-Appellant

Carl F. Manthei, Esq.
1205 17th Street
Boulder, CO 80302-6315

By Federal Express (next day delivery)

Counsel for Defendants-Cross Appellants

Mark W. Fischer, Esq.
Faegre & Benson LLP
1900 Fifteenth Street
Boulder, CO 80302-5414

By Federal Express (next day delivery)

Michael P. Dougherty