

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 97-MK-212,
Judge Marcia S. Krieger**

**BRIEF OF AMICUS CURIAE PATENT LAW PROFESSORS
R. POLK WAGNER & JOSEPH SCOTT MILLER**

R. POLK WAGNER
University of Pennsylvania Law School
3400 Chestnut Street
Philadelphia, PA 19104-6204
(215) 898-4356

September 20, 2004

Attorney for Amicus Curiae

CERTIFICATE OF INTEREST

Counsel for amicus curiae Patent Law Professors R. Polk Wagner and Joseph Scott Miller certifies the following:

1. The full name of every party of amicus represented by me is:

R. Polk Wagner and Joseph Scott Miller

2. The name of the real party in interest represented by me is:

R. Polk Wagner and Joseph Scott Miller

3. All parent corporations 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 of amicus now represented by me in the trial court or agency or are expected to appear in this court are:

R. Polk Wagner
University of Pennsylvania Law School
3400 Chestnut Street
Philadelphia, PA 19104-6204
(215) 898-4356
polk@law.upenn.edu

TABLE OF CONTENTS

STATEMENT OF INTEREST OF AMICUS CURIAE	v
ARGUMENT.....	1
I. The Public Notice Function of Claims Requires a Focus on, and a Presumption in Favor of, the Ordinary Meaning of Claim Language..	1
<i>A. The Patent Document is the Primary and Preferred Source of Claim Meaning—As Long as It is Clear, Specific, and Objective.....</i>	<i>2</i>
<i>B. Where the Patent Document does not Specify a Clear Definition, a Heavy Presumption in Favor of the Ordinary Meaning of a Disputed Term is Required by the Public Notice Function of Claims.</i>	<i>4</i>
<i>C. The Presumptive-Ordinary-Meaning (POM) Approach Best Supports the Integrity of the Patent Document.....</i>	<i>9</i>
II. The Ordinary Meaning of Claim Language is Best Determined by Reference to Publicly-Available, Objective Evidence, Especially Including Dictionaries.....	12
<i>A. Because Sources Such as Dictionaries are Widely-Available, Objective References Codifying the Ordinary Meaning of Language, they are Excellent Resources for Claim Construction.....</i>	<i>13</i>
<i>B. While the use of Objective Reference Sources Requires Appropriate Judgment, These Sources are Far Superior to any Reasonable Alternative.</i>	<i>15</i>
<i>C. The “Multiple Reference Problem” is Easily Manageable and can be Minimized Over Time.</i>	<i>17</i>
<i>D. Dictionaries are not a Panacea, but Offer the Court the Best Opportunity to Provide Clarity, Certainty, and Predictability to the Consumers of Claim Construction Jurisprudence.....</i>	<i>20</i>
III. Conclusion	22

TABLE OF AUTHORITIES

CASES

<i>Intellectual Property Development, Inc. v. UA-Columbia Cablevision of Westchester, Inc.</i> , 336 F.3d 1308 (Fed. Cir. 2003)	19
<i>Nix v. Hedden</i> , 149 U.S. 304 (1893)	14
<i>Nystrom v. TREX Co.</i> , 374 F.3d 1105 (Fed. Cir. 2004).....	19

OTHER AUTHORITIES

Ronald Coase, <i>The Problem of Social Cost</i> , 3 J. LAW & ECON. 1 (1960).....	2
PAUL GRICE, <i>STUDIES IN THE WAY OF WORDS</i> (1989)	8
Bruce L. Hay & Kathryn E. Spier, <i>Settlement of Litigation</i> , in 3 NEW PALGRAVE DICTIONARY OF ECONOMICS AND THE LAW 442 (Peter Newman ed., 1998)	3
Geoffrey P. Miller, <i>Pragmatics and the Maxims of Statutory Interpretation</i> , 1990 WIS. L. REV. 1179	8
Joseph Scott Miller & James A. Hilsenteger, <i>The Proven Key: Roles & Rules for Dictionaries at the Patent Office and the Courts</i> (SSRN Electronic Library, Working Paper, Aug. 16, 2004) available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=577262	<i>passim</i>
Kimberly A. Moore, <i>Forum Shopping in Patent Cases: Does Geographic Choice Affect Innovation</i> , 79 N.C. L. REV. 889, 928 (2001)	2
George L. Priest & Benjamin Klein, <i>The Selection of Disputes for Litigation</i> , 13 J. LEGAL STUD. 1, 16 (1984).....	3
Giles S. Rich, <i>Extent of Protection and Interpretation of Claims—American Perspectives</i> , 21 INT’L REV. INDUS. PROP. & COPYRIGHT L. 497 (1990).....	1

M.B.W. Sinclair, <i>Law and Language: The Role of Pragmatics in Statutory Interpretation</i> , 46 U. PITT. L. REV. 373 (1985)	8
Samuel A. Thumma & Jeffrey Kirchmeier, <i>The Lexicon Remains a Fortress: An Update</i> , 5 GREEN BAG 2D 51 (2001)	14
Samuel A. Thumma & Jeffrey Kirchmeier, <i>The Lexicon Has Become a Fortress: The United States Supreme Court's Use of Dictionaries</i> , 47 BUFF. L. REV. 227 (1999)	14
R. Polk Wagner, CLAIMCONSTRUCTION.COM, at http://www.claimconstruction.com/	5, 10
R. Polk Wagner & Lee Petherbridge, <i>Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance</i> , 152 U. PA. L. REV. 1105 (2004).....	<i>passim</i>
R. Polk Wagner, <i>Reconsidering Estoppel: Prosecution History and the Failure of Festo</i> , 151 U. PA. L. REV. 159 (2003).....	2, 6
R. Polk Wagner, <i>Of Patents and Path-Dependency: A Comment on Burk and Lemley</i> , 18 BERKELEY TECH. L. J. 1, 18-20 (2003)	2

STATEMENT OF INTEREST OF AMICUS CURIAE

R. Polk Wagner and Joseph Scott Miller are Assistant Professors of Law at the University of Pennsylvania and the Lewis and Clark Law School, respectively. As full-time academics, they concentrate their research and teaching on the legal and policy issues of the U.S. Patent Law, and are presently engaged in research and writing involving many of the issues involved in this court's *en banc* Order. See, e.g., R. Polk Wagner & Lee Petherbridge, *Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance*, 152 U. PA. L. REV. 1105 (2004); R. Polk Wagner, CLAIMCONSTRUCTION.COM (ongoing research project) at <http://www.claimconstruction.com/>; Joseph Scott Miller & James A. Hilsenteger, *The Proven Key: Roles & Rules for Dictionaries at the Patent Office and the Courts* (Social Science Research Network Electronic Library, Working Paper, Aug. 16, 2004), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=577262.

Neither R. Polk Wagner nor Joseph Scott Miller has any stake in any of the parties to this litigation or the result of this case, other than an interest in seeking correct and consistent development of the patent law jurisprudence.

ARGUMENT

In its order of July 21, 2004, the court asked the parties and amici to address several related questions. *See Phillips v AWH Corp.*, No. 03-1269 (July 21, 2004) (Order). The following constitutes our responses to the issues raised in that Order.

I. The Public Notice Function of Claims Requires a Focus on, and a Presumption in Favor of, the Ordinary Meaning of Claim Language.

The public notice function of patent claims, at its most basic, requires that the claim language convey clear and useful information about the scope of the patent grant. This aspect of patent claims—as the ultimate definition of the metes and bounds of a patentee’s rights—is a fundamental tenet of the modern patent system, and must be respected.¹ In economic terms, patent claims seek to resolve an information cost problem with respect to publicly conferred rights to exclude others from the marketplace: by delineating the borders between protected and unprotected subject matter, claim language addresses what would otherwise be a paralyzing information-cost problem, namely, uncertainty and

¹ Giles S. Rich, *Extent of Protection and Interpretation of Claims—American Perspectives*, 21 INT’L REV. INDUS. PROP. & COPYRIGHT L. 497, 499 (1990) (“To coin a phrase, *the name of the game is the claim.*”)

unpredictability about the scope and location of patent rights.² Put more simply, absent clarity and predictability, the public notice function of patent claims cannot be achieved.

A. The Patent Document is the Primary and Preferred Source of Claim Meaning—As Long as It is Clear, Specific, and Objective.

We start from first principles. There can be no dispute that the public notice function of claims is best served when the meaning of claim language is readily apparent to patent readers. Conversely, the public notice function is worst served when litigation is required to interpret even the most banal of claim terms. This case presents the opportunity for this court to firmly establish a jurisprudence that yields the former at the expense of the latter.

Without a doubt, the patent document itself is the primary, and preferred, source of meaning for claim terms. From a public notice perspective, the ideal

² See generally R. Coase, *The Problem of Social Cost*, 3 J. LAW & ECON. 1 (1960) (discussing uncertainty about the boundaries of rights as an impediment to socially-desirable transactions). See also R. Polk Wagner, *Reconsidering Estoppel: Prosecution History and the Failure of Festo*, 151 U. PA. L. REV. 159, 222-225 (discussing information-cost problems in patent law); R. Polk Wagner, *Of Patents and Path-Dependency: A Comment on Burk and Lemley*, 18 BERKELEY TECH. L. J. 1, 18-20 (noting the benefits of clarity in patent rights); Kimberly A. Moore, *Forum Shopping in Patent Cases: Does Geographic Choice Affect Innovation*, 79 N.C. L. REV. 889, 928 (2001) (discussing costs attending unpredictability and uncertainty about patent claim scope).

scenario is where the patent itself provides clear, specific, and objective evidence of the meaning of claim language with, for example, a definitional statement using words such as “as used herein, the term X is understood to mean Y.” Indeed, in the instant case, if the patentee had clearly stated the meaning of the contested term “baffle,” this dispute would not exist.

Unfortunately, in most cases that come before the courts today, such clear, specific, and objective evidence of claim meaning is not available in the public record of the patent.³ Thus, there is a need for jurisprudential rules addressing circumstances where the specification or other elements of the public record do not clearly and specifically set forth the meaning of a disputed claim term.

³ This is no coincidence. First, and most obviously, the court is likely to see that set of cases where the meaning of claim language is most uncertain (*i.e.*, subject to divergent and yet plausible definitions), thereby making settlement less likely. *See generally* Bruce L. Hay & Kathryn E. Spier, *Settlement of Litigation*, in 3 NEW PALGRAVE DICTIONARY OF ECONOMICS AND THE LAW 442, 443 (Peter Newman ed., 1998); George L. Priest & Benjamin Klein, *The Selection of Disputes for Litigation*, 13 J. LEGAL STUD. 1, 16 (1984). Second, under one line of recent Federal Circuit precedent, many patentees are likely to view vagueness in claim meaning as a strategic advantage—allowing the possibility that claim scope can shift over time, via litigation-based “contextual” meanings that will necessarily vary according to the circumstances. *See generally* R. Polk Wagner & Lee Petherbridge, *Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance*, 152 U. PA. L. REV. 1105 (2004) (identifying the “holistic” methodological approach as one of two competing lines of Federal Circuit jurisprudence). As we argue in more detail below, the court’s choice of claim construction rule will affect these strategic considerations.

B. Where the Patent Document does not Specify a Clear Definition, a Heavy Presumption in Favor of the Ordinary Meaning of a Disputed Term is Required by the Public Notice Function of Claims.

In our view, the touchstone of an appropriate claim construction jurisprudence must remain the public notice function of claims. For that reason, we suggest that the court specify that only clear, specific, and objective evidence of claim meaning has interpretive weight. For the public notice goal of claim construction is not to divine what the patentee “intends” to claim, but rather to set forth what the patentee **actually claims**. That is, from a public notice perspective, it matters little if the patentee in the instant case intended to claim “acutely-angled” baffles; what matters is what others objectively understand the claim to mean. And, except in cases where the patentee has clearly specified a meaning,⁴ this understanding will be the ordinary meaning of claim language.

A focus on ordinary meaning, we suggest, is overwhelmingly the best tool for a claim construction approach that is respectful of the public notice function of patents. Indeed, the court should continue with its established trend of adopting a heavy presumption in favor of the ordinary meaning of claim

⁴ We specify the parameters of this circumstance below.

language⁵; we denote this, the presumptive ordinary meaning approach, or “POM”. The POM approach offers the following advantages:

First, a presumptive ordinary meaning (POM) approach ensures that decision-makers focus on what the relevant public (here, persons having ordinary skill in the art, PHOSITAs) would understand the claims to mean, rather than on what the parties—or, more to the point, the parties’ lawyers—would have one infer from the vagueness inherent in all language. The alternative approach, which suggests that claim language must be given varying meanings according to nonspecific inferences drawn from the case-specific “context” surrounding a given dispute, eviscerates the concept of public notice by shifting the relevant analytic framework from the objective understanding of the relevant public to the necessarily subjective understanding of the particular (judicial) decision-maker.⁶

⁵ See Wagner & Petherbridge, *supra* note 3, at 1148-56 (empirically documenting that the court has been increasingly adopting the “procedural” approach during the past several years). See also R. Polk Wagner, CLAIMCONSTRUCTION.COM (reporting current data) at <http://www.claimconstruction.com/>; Joseph Scott Miller & James A. Hilsenteger, *The Proven Key: Roles & Rules for Dictionaries at the Patent Office and the Courts* 9-10 & n.44 (SSRN Electronic Library, Working Paper, Aug. 16, 2004) (collecting cases), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=577262.

⁶ A fuller treatment, including citations to several example cases, of the distinction between the POM (or “procedural”) approach and the alternative (“holistic”) approach can be found in Wagner & Petherbridge, *supra* note 3, at 1133-39.

Second, an ordinary meaning approach best utilizes the skills of both the technologists (PHOSITAs) and the non-technologist decision-makers (such as judges). Patent documents are written for a technical audience, and as such the focus must remain on what the relevant technologists would understand the language to mean. The drawing of subjective inferences by parsing the often-complex language of a patent specification, for example, is a task that—while uniquely lawyerly in nature—seems a relatively poor fit for judges in the modern patent environment. By contrast, the POM approach leverages the skills of courts in implementing and enunciating clear rules based on the available clear, specific, and objective evidence of the meaning of language. Under the POM approach, the knowledge of technologists determines the meaning (presumptively, the ‘ordinary meaning’), while the lawyers and judges implement and execute the interpretive procedure.

Third, and perhaps most importantly, the POM approach properly informs the public of the interpretive rules, and encourages behavior that comports well with the public notice function of claim language. There is no question that the patentee, at the time of drafting, is in the best position to understand the claim language, and to reduce or eliminate ambiguities.⁷ A judicial focus on the

⁷ See Wagner, *Reconsidering Estoppel*, *supra* note 2, at 213-14.

ordinary meaning of claim terms allows patentees to know, *ex ante*, the way claim language will be interpreted, and act accordingly. That is, a patentee who wishes to use a claim term according to its ordinary meaning can be assured that, absent specific instructions otherwise, the courts will accord that meaning to the term. Indeed, the patentee can even verify such a meaning by consulting objective reference sources—the very same references sources that a court will later use to construe a disputed claim term.⁸ Alternatively, a patentee who wishes to ensure that a particularistic meaning be attributed to a claim term will also know **exactly** what to do: set forth that definition clearly and explicitly in the patent document or, alternatively, the prosecution history. And, obviously, the readers of patents will similarly understand these rules, thus enabling relative certainty when they seek the meaning of claim language.

Fourth, and relatedly, the POM approach we advocate here comports with the basic mechanics of successful written communication:

⁸ Indeed, one of us has suggested that the PTO should affirmatively require patentees to specify one or more reference sources during the prosecution process, a choice which would then be respected by courts. Miller & Hilsenteger, *supra* note 5, at 5-6, 43-60. But even without this requirement, a patentee concerned about the choice of reference materials need only insert a suitable reference in the public record of the patent. We discuss the use of objective reference materials, such as dictionaries, in Part I.B below.

1. **It facilitates cooperation, not strategic behavior.** A competent reader of a language, *e.g.*, standard American English, knows the ordinary meanings of words and phrases in the language and reads a text by reference to those ordinary meanings. A writer who hopes to communicate a particular message, knowing this fact about competent readers, will draft the text accordingly.⁹ Claim construction rules should facilitate this cooperative communication, not introduce opportunities for strategic behavior.

⁹ Paul Grice, whose 1967 William James Lectures at Harvard University spawned the branch of linguistics known as pragmatics (*i.e.*, the study of natural language understanding, and how context affects meaning), described the basic framework we use when interpreting statements in an exchange in which “[t]he participants have some common immediate end.” PAUL GRICE, *STUDIES IN THE WAY OF WORDS* 29 (1989). In the claim construction context, that common end is the successful communication, by the patentee to the world, of the scope of the patentee’s right to exclude. According to Grice, communicants interpret each other’s statements by assuming mutual adherence to a “Cooperative Principle”—namely, “Make your conversational contribution such as is required, at the stage at which it occurs, by the accepted purpose or direction of the talk exchange in which you are engaged.” *Id.* at 26. Grice formulates four “maxims,” or conventions, that implement the Cooperative Principle, and the fourth of these—styled “Manner”—demands that one “[a]void obscurity of expression,” “[a]void ambiguity,” “[b]e brief,” and “[b]e orderly.” *Id.* at 27. As Professors Miller and Sinclair each demonstrated, Grice’s “Manner” maxim readily explains the strong default in favor of ordinary meaning in statutory interpretation. See Geoffrey P. Miller, *Pragmatics and the Maxims of Statutory Interpretation*, 1990 WIS. L. REV. 1179, 1220-24; M.B.W. Sinclair, *Law and Language: The Role of Pragmatics in Statutory Interpretation*, 46 U. PITT. L. REV. 373, 391-92 (1985). Ordinary meaning is no less a linchpin for successful communication in claim construction than in statutory interpretation.

2. Readers can approach patents in the way they approach other texts.

All words that appear in a typical patent (apart from new words that a drafter creates, and defines, herself) have an ordinary meaning to people of skill in the art. The customary approach when reading texts of all kinds is to presumptively attribute the known ordinary meaning to the words found therein, altering that understanding only upon good evidence to the contrary. Using the POM approach makes claim construction follow naturally from our basic communicative habits.

3. It adapts easily to both technical and non-technical language. People of

skill in an art communicate with each other using a mix of both specialized and generic words. As a result, for many claim terms, the ordinary meaning of the term to a person of skill in an art will be the same as the ordinary meaning of the term to a lay person without any skill in the art. The POM approach reflects, and embraces, this fact.

C. The Presumptive-Ordinary-Meaning (POM) Approach Best Supports the Integrity of the Patent Document.

It is important to recognize that it is **only** the POM approach that truly respects the primacy of the patent document, and recognizes its as the definitive communication between the patentee and the public. By properly allocating

incentives—encouraging patentees to draft clearly, by either using terms in their ordinary sense or by establishing clear and specific alternative definitions—the POM approach ensures that the patent document remains the single best source for understanding the scope of the patented invention. The alternative approach—where dispute-specific “contextual” meanings of claim terms are divined *ex post* to fit the subjective understandings of the lawyers and judges involved—fatally undermines the integrity of the patent document, because it means that the patentee’s carefully-chosen words describing her invention to the public are just the barest of starting points for an unpredictable, open-ended interpretive scheme. Indeed, a far-ranging “holistic” approach to claim construction encourages patentees to draft claims ever-more vaguely and provide far less substantive disclosure, lest an adverse inference be “revealed” to a judicial decision-maker at some point in the future. This, we suggest, is not supportive of the public notice function of claims.

For the reasons noted above, we suggest that the court firmly and finally adopt¹⁰ the claim construction framework that best responds to the public notice function of claim language, as follows:

¹⁰ While the exact phrasing may be our own, we suggest that adopting our proposal will do little more than coalesce the jurisprudence behind what is the now-dominant interpretive methodology. As one of us has empirically verified,

1. Claim language will presumptively be given its ordinary meaning, as understood by one of ordinary skill in the relevant art. Specialized terms will be defined with reference to the typical usage in the technical field; non-specialized terms will be defined with reference to the typical usage of standard written English.
2. This presumption of ordinary meaning will be rebutted by clear, explicit, and unambiguous definitional statements in the public record of the patent (i.e., the specification or prosecution history). In order to qualify as rebutting, such statements must be objectively definitional; that is, they must contain language such as “term X is understood to mean Y”, or “the definition of X is Y.”¹¹ Unmistakable definitional statements phrased in the negative—i.e., “term X does not include Y”—will also qualify as rebutting statements, and alter the meaning of

this basic approach (denoted “proceduralism”) has been used in at least 65 percent of Federal Circuit claim construction opinions since *Markman II*. See Wagner, CLAIMCONSTRUCTION.COM, *supra* note 5; see also Wagner & Petherbridge, *supra* note 3.

¹¹ In our view, it is crucial that the court expressly mandate the use of objectively definitional words to rebut the presumption. As we have argued at length above, the public notice function of claims requires that the interpretive process be transparent, objective, and predictable. Patentees, their competitors, the public, the PTO and the courts all need to know what words will—and will not—overcome the heavy presumption in favor of ordinary meaning.

claim terms accordingly.¹² By sharp contrast, inferences gleaned from examples, embodiments, or the lack thereof, are insufficient to overcome the presumption.

We suggest that this framework, by supporting the fundamental public notice function of claims, generating incentives for patentees to draft and define terms clearly, and by respecting the supremacy of the public record of the patent, is plainly the best methodological approach to claim construction available to this court.

II. The Ordinary Meaning of Claim Language is Best Determined by Reference to Publicly-Available, Objective Evidence, Especially Including Dictionaries.

Having established the ordinary meaning of claim language as the locus of claim construction methodology, the obvious question presents itself: how is this ordinary meaning to be determined? The answer to this question follows directly from the considerations noted above.

¹² Some recent cases refer to this as a “clear and unmistakable surrender” of claim scope.

A. Because Sources Such as Dictionaries are Widely-Available, Objective References Codifying the Ordinary Meaning of Language, they are Excellent Resources for Claim Construction.

We again start with the public notice function of patent claims. Any meaningful implementation of this purpose will require clear, specific, and objective evidence of the ordinary meaning of language. In our view, dictionaries and other widely-available, rigorously-prepared objective reference sources are an excellent, though perhaps not the sole, reference for the ordinary meaning of language. All terms (save for newly-coined words, which must be otherwise defined) have ordinary meanings to people of skill in the art, whether those meanings are specialized in the art or identical to the ordinary meanings they have to laypersons. These ordinary meanings are recorded in objective reference sources, such as dictionaries—making these resources well-suited to the basic claim construction inquiry. In particular, we note the following strengths of dictionaries in the claim construction context.

First, they are uniquely appropriate to the task. Dictionaries and other objective references sources are directed to the precise undertaking required of them in the claim construction analysis outlined above: they are explicitly intended to help people determine the ordinary meaning of language. As the Supreme Court has noted, the great strength of dictionaries is that they tell us

what we already know.¹³ Indeed, the commercial success of such reference books hinges upon their success in providing clear, correct, and definitive explanations of ordinary meaning; their authors have every incentive to base their work on copious evidence of actual word usage (in the case of general purpose dictionaries) and the considered views of accomplished experts in the field (in the case of encyclopedias, treatises, and specialized dictionaries).¹⁴

Second, and as importantly, such works are objective evidence of ordinary meaning, wholly disconnected from the patent, the dispute, and the parties involved. The professional lexicographers and treatise writers who prepare these reference sources do not have any interest in the way a particular future legal dispute would be resolved. Indeed, to appear partisan in this way would be self-defeating, because it would drive away reference book consumers who are looking for reliable, professionally prepared materials.¹⁵

¹³ *Nix v. Hedden*, 149 U.S. 304, 306-07 (1893) (“Of that [ordinary] meaning the court is bound to take judicial notice, as it does in regard to all words in our own tongue; and upon such a question dictionaries are admitted, not as evidence, but only as aids to the memory and understanding of the court.”). For a comprehensive discussion of the Supreme Court’s use of dictionaries throughout its history, see Samuel A. Thumma & Jeffrey Kirchmeier, *The Lexicon Has Become a Fortress: The United States Supreme Court’s Use of Dictionaries*, 47 BUFF. L. REV. 227 (1999), and Samuel A. Thumma & Jeffrey Kirchmeier, *The Lexicon Remains a Fortress: An Update*, 5 GREEN BAG 2D 51 (2001).

¹⁴ See Miller & Hilsenteger, *supra* note 5, at 35.

¹⁵ *Id.* at 22 n.78.

Third, these objective reference sources provide an enduring written record. Because claim language must be understood as of the time of filing, contemporaneous dictionaries, etc., provide a publicly-accessible reference that is available throughout the life of the patent. The printed pages of these reference sources, unlike human memories, do not fade or change with time. And whereas the hindsight bias is a well-understood problem in the patent law, the use of contemporaneous objective reference sources is perhaps the best way to prevent this problem in the claim construction context.

B. While the use of Objective Reference Sources Requires Appropriate Judgment, These Sources are Far Superior to any Reasonable Alternative.

It is beyond question that, although dictionaries, treatises and the like are the best source for clear, definitive, and objective information about the ordinary meaning of claim language, the application of general definitions to particular language will typically require human judgment. For this reason, even the use of such resources will not eliminate all uncertainty. Yet, a uniform reliance on such resources as a basic component of the claim construction process offers far more

predictability and transparency than apparent alternative resources for ordinary meaning.¹⁶

One possible alternative approach is to rely on purely personal introspection for the meaning of claim language. That is, the person who wants to know what a claim term means—whether a patentee, an examiner, a competitor, or a judge—simply relies on what she can remember about a word’s ordinary meaning from personal experience. This approach, which requires blinding oneself to readily available, contemporaneous reference sources, is unquestionably less predictable than the use of objective reference sources: personal experience will vary by decision-maker, as will the ability to recall that personal experience accurately.

A second possibility is to augment personal introspection with testimony from expert witnesses. This method shares some of the weaknesses of personal introspection by the decision-maker: expert witnesses will differ in both experiences and recall, and thus be less predictable than the use of dictionaries and other reference sources. Further, a reliance on experts who report their personal experiences or understanding diminishes the objectivity and independence of the ordinary meaning inquiry, because of the widely-

¹⁶ See Miller & Hilsenteger, *supra* note 5, at 44.

acknowledged tendency of experts to advocate.¹⁷ For both reasons, this alternative is far less predictable and transparent than the reliance on, e.g. dictionaries.¹⁸

C. *The “Multiple Reference Problem” is Easily Manageable and can be Minimized Over Time.*

As the court alludes to in Question 2, one potential problem with dictionaries and other objective reference sources is “the multiple reference problem”: the fact that in some cases, differing references (e.g. different dictionaries) will offer somewhat varying definitions of disputed claim language, thus raising a question regarding the appropriate understanding of ordinary meaning. In our view, this concern, while valid, does not undermine the value of dictionaries and other objective references in the claim construction context.

¹⁷ See Miller & Hilsenteger, *supra* note 5, at 20, 22 n.78.

¹⁸ We note, however, two roles for expert testimony in the claim construction process. First, experts might be useful in providing background information (*i.e.*, a tutorial) about complex technologies, thus allowing the courts to better understand the objective reference materials. Second, on rare occasions, a disputed term might not be found in relevant reference works (*i.e.*, it might be particularly esoteric, or of exceedingly recent origin in the particular field). In this circumstance, resort to the personal understandings of experts may be the best available, albeit far from ideal, option.

1. The court can (and should) take steps to minimize the multiple reference problem.

It is important to recognize that the most direct and effective way that the court can resolve the multiple reference problem is by simply stating a clear decisional rule that applies in the limited circumstances where multiple, relevant, objective resources offer varying definitions that can affect the outcome of the dispute. (We suggest one such rule below.) That is, by merely stating the rule to be followed, the court can foster predictability, transparency, and objectivity in this inquiry. Once a rule is established, relevant parties will take steps accordingly, whether in drafting new patent claims or interpreting existing ones. As long as the rule is clear and predictable, the multiple reference problem should diminish.

Second, the court can reduce or eliminate the multiple reference problem by uniformly respecting reference materials noted in the public record of the patent-at-issue. That is, to the extent that patentees specify preferred references in the patent record, the court should use those references as the authoritative source of ordinary meaning. Doing so will not only resolve the multiple reference problem in the specific case, but provide substantial incentives for future patentees to specify preferred references as well—thus, over time, essentially eliminating the multiple reference problem.

2. Where the multiple references offer varying definitions for disputed terms, courts should implement the full scope of the definitions.

Within the past year, the court has approached the problem of multiple reference sources in two different ways. In the earlier of these two cases, *Intellectual Property Development, Inc. v. UA-Columbia Cablevision of Westchester, Inc.*, 336 F.3d 1308 (Fed. Cir. 2003), the court distilled from somewhat divergent definitions a common core of meaning. This ‘common core’ effectively eliminated from the ordinary meaning of the term the material that was in some, but not all, the reference sources. In the later of these two cases, *Nystrom v. TREX Co.*, 374 F.3d 1105 (Fed. Cir. 2004), the court took the contrary approach: Looking to multiple sources with different definitions for the term in dispute, the court took as the term’s ordinary meaning the combined material from the differing sources.¹⁹

In our view, the *Nystrom* approach better comports with the incentives created by the presumption in favor of ordinary meaning. As noted above, all objective reference sources are designed to capture—as well as their authors can—the ordinary meanings of the words in a language or field. When reference

¹⁹ See Miller & Hilsenteger, *supra* note 5, at 41-43 (discussing *UA-Columbia* and *Nystrom* cases).

sources differ, the authors likely had some evidence-based reasons for reaching their differing judgments; in other words, the varying definitions characterize the breadth of the ordinary understanding of the language at issue. The cumulative scope of the definitions, then, best represents the full range of the term’s ordinary meaning. It is therefore reasonable to presume that—absent clear evidence to the contrary—the patentee intended to invoke the full range of the term’s ordinary meaning, i.e., the cumulative content of varied reference sources. Of course, a patentee who wishes to focus the definition of the claim term more narrowly is free to do so: by either expressly setting forth a special definition in the body of the patent, or simply noting a singular reference source as authoritative.

D. Dictionaries are not a Panacea, but Offer the Court the Best Opportunity to Provide Clarity, Certainty, and Predictability to the Consumers of Claim Construction Jurisprudence.

Finally, we want to make clear that we do not suggest that the integration of objective reference sources such as dictionaries into the claim construction process is a panacea. The “multiple reference problem” we discuss above is an example of the complications involving dictionaries.

And yet, in our view, it is important to recognize three things. First, as we suggested above, the analysis faced by the court is deeply **comparative** in nature, and the use of dictionaries to establish the ordinary meaning of claim

language clearly dominates any reasonable alternative approach. Second, this approach will generate desirable incentives: patentees will be encouraged to draft claims either by using terms in their ordinary, dictionary-verifiable, sense, or by clearly and specifically providing an alternative definition.

Third, and most significantly, by firmly, clearly, and finally establishing the presumptive-ordinary-meaning approach and the role of dictionaries in the interpretive process, this court can put in place a transparent, predictable legal framework that all the parties who engage in claim construction can start using immediately: patent drafters, the PTO, competitors and the general public, and, perhaps most importantly, the courts. Understanding the rules of the game—that only clear, specific, and objective definitions of claim terms will be utilized, that claim language will presumptively be given its full ordinary meaning, and that dictionaries or similar objective reference sources will be used to determine the presumptive ordinary meaning—will allow all of these consumers of this court’s claim construction jurisprudence to take steps with a full and certain awareness of the consequences. Patent drafters will know, with certainty, how the words they write will be interpreted. PTO Examiners will know, with certainty, what the claim language they are evaluating really means. Competitors and other readers of patents will know, with certainty, what the true scope of a patent really is. And the courts, when faced with a dispute, will know, with certainty, what

procedure should be followed in resolving interpretive questions. And it is this effect, we suggest, that will ensure that the public notice function of claims is a fundamental characteristic of the modern patent system.

III. Conclusion

For the reasons stated above, we suggest that the court hold that:

1. The presumptive-ordinary-meaning (POM) framework for interpreting claim language outlined above and established in the court's recent jurisprudence is mandatory and binding; and,
2. that dictionaries or similar objective reference sources will be used to determine the ordinary meaning of claim language.

Dated: September 20, 2004

Respectfully submitted,



R. Polk Wagner
University of Pennsylvania Law School
3400 Chestnut Street
Philadelphia, PA 19104-6204

*Attorney for Amicus Curiae
R. Polk Wagner and Joseph Scott Miller*

CERTIFICATE OF SERVICE

I hereby certify that on September 20, 2004, two true and correct copies of the foregoing brief for Amicus Curiae R. Polk Wagner and Joseph Scott Miller were served by overnight delivery to:

Carl F. Manthei PC
1205 17th Street
Boulder, CO 80302-6315
phone 303-442-5496

Mark W. Fischer, Esq.
Faegre & Benson LLP
1900 15th Street
Boulder, CO 80302
phone 303-447-7700



CERTIFICATE OF COMPLIANCE

I certify that the foregoing Brief for Amicus Curiae R. Polk Wagner and Joseph Scott Miller contains 4,942 words, excluding the parts of the brief exempted by FRAP 32(a)(7)(B)(iii), as measured by the word processing software used to prepare this brief.

Dated: September 20, 2004

Respectfully submitted,



R. Polk Wagner
University of Pennsylvania Law School
3400 Chestnut Street
Philadelphia, PA 19104-6204

*Attorney for Amicus Curiae
R. Polk Wagner and Joseph Scott Miller*