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**United States Court of Appeals**  
*for the*  
**Federal Circuit**

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EDWARD H. PHILLIPS,

*Plaintiff-Appellant,*

v.

AWH CORPORATION,  
HOPEMAN BROTHERS, INC. and LOFTON CORPORATION,

*Defendants-Cross Appellants.*

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

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**BRIEF FOR *AMICUS CURIAE* THE ASSOCIATION  
OF THE BAR OF THE CITY OF NEW YORK IN  
SUPPORT OF NEITHER PARTY**

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SEPTEMBER 20, 2004

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

The Association of the Bar of the City of New York

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:

The Association of the Bar of the City of New York

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

None

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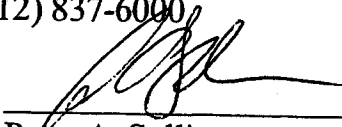
  
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## **I. STATEMENT OF THE ISSUES**

1. Is the public notice function of patent claims better served by referencing primarily to technical and general purpose dictionaries and similar sources to interpret a claim term or by looking primarily to the patentee's use of the term in the specification? If both sources are to be consulted, in what order?
2. If dictionaries should serve as the primary source for claim interpretation, should the specification limit the full scope of claim language (as defined by the dictionaries) only when the patentee has acted as its own lexicographer or when the specification reflects a clear disclaimer of claim scope? If so, what language in the specification will satisfy those conditions? What use should be made of general as opposed to technical dictionaries? How does the concept of ordinary meaning apply if there are multiple dictionary definitions of the same term? If the dictionary provides multiple potentially applicable definitions for a term, is it appropriate to look to the specification to determine what definition or definitions should apply?
3. If the primary source for claim construction should be the specification, what use should be made of dictionaries? Should the range of the ordinary meaning of claim language be limited to the scope of the invention disclosed in the specification, for example, when only a single embodiment is disclosed and no other indications of breadth are disclosed?

4. Instead of viewing the claim construction methodologies in the majority and dissent of the now-vacated panel decision as alternative, conflicting approaches, should the two approaches be treated as complementary methodologies such that there is a dual restriction on claim scope, and a patentee must satisfy both limiting methodologies in order to establish the claim coverage it seeks?
5. When, if ever, should claim language be narrowly construed for the sole purpose of avoiding invalidity under, *e.g.*, Sections 103 and 112?
6. What role should prosecution history and expert testimony by one of ordinary skill in the art play in determining the meaning of the disputed claim terms?
7. Consistent with the Supreme Court's decision in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), and the Federal Circuit's *en banc* decision in *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998), is it appropriate for the Federal Circuit to accord any deference to any aspect of trial court claim construction rulings? If so, on what aspects, in what circumstances, and to what extent?

## II. STATEMENT OF INTEREST OF AMICUS CURIAE

The Association of the Bar of the City of New York (the "Association"), through its Committee on Patents, submits this *amicus curiae* brief in response to

the Court's July 21, 2004 Order, which invites bar associations and others to submit *amicus curiae* briefs on the issues listed above. The Association submits this brief by leave of the Court in accordance with Fed. R. App. Proc. Rule 29(a), and has notified both parties of its submission. The Association submits this brief independent of the position of either party.

The Association is a private, non-profit organization of more than 22,000 attorneys, judges and law professors who are professionally involved in a broad range of law-related activities. Founded in 1870, the Association is one of the oldest bar associations in the United States. The Association seeks to promote legal reform and to improve the administration of justice at the local, state, federal and international levels through its more than 180 standing and special committees. The Committee on Patents (the "Committee") is a long-established standing committee of the Association, and its membership reflects a wide range of corporate, private practice and academic experience in patent law. In considering the questions posed by the Court, the Association sought input from all its members known to be interested in patent law. The Committee considered these responses in preparing this submission.



### III. BACKGROUND

In a judgment entered on April 8, 2004, the panel in *Phillips v. AWH Corp.* affirmed a summary judgment of non-infringement of United States Patent No. 4,677,798 (“the ’798 patent”). The opinion was published at 363 F.3d 1207.

The ’798 patent describes vandalism-resistant building modules consisting of modular wall panels. A key issue in construing the claims was the meaning of the term “baffle.” The claims include the following language: “means disposed inside the shell for increasing its load bearing capacity comprising internal steel baffles extending inwardly from the steel shell walls.” The majority rejected the district court’s means-plus-function treatment of the claim term “baffle,” but found that the specification required a construction of the term to include only baffles that are positioned at a 90° angle to the wall faces. 363 F.3d at 1213-14. The dissent criticized the majority for impermissibly importing the 90° limitation from the specification into the claims just because that was the configuration of the only disclosed embodiment. 363 F.3d at 1217.

Phillips filed a combined petition for panel rehearing and rehearing *en banc*. In an Order dated July 21, 2004, the Court denied the petition for panel rehearing, granted the petition to hear the appeal *en banc*, vacated the Court’s April 8, 2004 judgment and withdrew the accompanying opinion reported at 363 F.3d 1207. The Order states that the Court has determined to hear this case *en*

*banc* in order to resolve issues concerning the construction of patent claims raised by the panel majority and dissenting opinions. The Order provides that *amicus curiae* briefs may be filed by bar associations and others.

#### IV. SUMMARY OF ARGUMENT

This brief addresses Questions 1, 3, 4, 5, 6 and 7. Question 2 is not addressed because the Association takes the position that dictionaries should not serve as the primary source for claim interpretation.

The public notice function of patent claims is better served by construing the claims with reference to the patent specification, including the drawings, as well as the file history. General purpose and technical dictionaries, treatises and the like should be consulted as needed to help elucidate the ordinary meaning of claim terms to one skilled in the art. While dictionaries are potentially useful tools for construing the meaning of claim terms, they should not trump the understanding of the term by skilled artisans. The approach to construction should be multi-factored rather than hierarchical.

The reasonable expectation of inventors must also be taken into account. Patents have not been prosecuted with the expectation that dictionary definitions will constitute an additional restriction on claim coverage. Subjecting the inventing community to a new rule of claim construction may unfairly restrict the property rights of patent holders post-issuance.

Since patents are presumed to be valid, claims should be construed to preserve the validity of the patent, provided that the claim construction is still consistent with the language of the claims.

Where testimony from expert witnesses may inform the court in understanding the meaning of claim terms by skilled artisans, the court should hear it. Evaluating expert testimony in patent cases is no more difficult than in other cases. The fact that expert witnesses are advocating views that are consonant with the parties' theories of the case does not justify eschewing these opinions in favor of dictionary definitions.

The Committee questions the propriety of creating a deferential standard of appellate review. While some members believe that the Supreme Court's decision in *Markman* mandates that all issues pertaining to claim construction be reviewed *de novo*, and other members would argue that *Markman* does not go so far as to hold that the factual underpinnings of claim construction are only for the court to determine, the Committee is unanimous in viewing the *en banc* ruling in *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448, as constraining this court to review claim construction *de novo*. Beyond the obstacle raised by *stare decisis*, some members of the Committee question the wisdom and ramifications of identifying aspects of claim construction as a fact-finding process.

## V. ARGUMENT

### A. Dictionary Definitions Should Not Be Adopted As The Primary Source Of Meaning For Claim Terms Or As A Separate Restriction On Claim Coverage.

In *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389-90 (1996), the Supreme Court endorsed the “standard construction rule that a term can be defined only in a way that comports with the instrument as a whole,” and agreed with the necessity of maintaining “the patent’s internal coherence” when construing the claims. See also *United States v. Adams*, 383 U.S. 39, 49 (1966) (“[I]t is fundamental that the claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention.”).

The hierarchical approach taken recently by panels of this Court in cases such as *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002), conflicts with the decisions of the Supreme Court with respect to the primacy of the patent document as a source of meaning for claim terms. *Texas Digital* prohibits any reference to the specification until dictionary definitions of disputed claim terms have been considered, and then only when (i) the specification explicitly defines a disputed claim term or clearly disavows certain claim coverage, or (ii) multiple conflicting dictionary definitions of the term exist.

Under *Texas Digital*, the dictionary definition becomes the primary document for construing claim terms. Of course, the parties to the negotiation

giving rise to the patent, the examiner and the inventor, may know nothing at the time of prosecution of the dictionary definitions that *Texas Digital* now requires because dictionary definitions rarely, if ever, form part of the prosecution history. Nor does the public know of these definitions. The public must now consult technical dictionaries, and indeed guess as to the “correct” dictionaries because one cannot foretell which dictionary definition will carry the day. The Supreme Court has repeatedly warned against the manifest unfairness of adopting new rules of claim construction that may retroactively restrict patent holders’ property rights. *See Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 28 (1997); *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 739 (2002). *Texas Digital* flies in the face of this admonition.

The Committee is of the view that the court should be free to employ all available relevant evidence to construe the claims, for the words in the claims are but a proxy for what the invention truly is: “Things are not made for the sake of words, but words for things.” *Autogiro Co. of America v. United States*, 384 F.2d 391, 397 (Ct. Cl. 1967). While inventions must be described in words in order to obtain patent protection, the Supreme Court recognized that “an invention exists most importantly as a tangible structure or a series of drawings.” *Festo*, 535 U.S. at 731 (quoting *Autogiro*, 384 F.2d at 397). The relevant information may include technical dictionaries, references that may provide contextual definitions of claim

terms in analogous arts, the specification, drawings, the prosecution history and the testimony of people having skill in the art. Expert witnesses also should be employed to understand the art and the level of ordinary skill, even if there are partisan limitations to their testimony.

Claims are construed from the perspective and understanding of one of ordinary skill in the art, not from the perspective of a judge or a patent attorney, and certainly not from the perspective and understanding of those who write dictionaries. The overriding concern in claim construction is, and should be, to construe the claim using the meaning that would be attributed by those skilled in the art. Dictionary definitions are just one tool out of several that should be used to perform that task. *Cf. Knorr-Bremse Sys. Fuer Nutzfahrzeuge GMBH v. Dana Corp.*, Nos. 01-1357, 01-1376, 02-1221, 02-1256 (Fed. Cir. Sept. 13, 2004) (endorsing a multi-factored approach to willfulness analysis because of its greater flexibility).

Relying on dictionaries at the expense of other sources will engender well-understood shortcomings. For one, “the dictionary does not always keep abreast of the inventor.” *Festo*, 535 U.S. at 731, quoting *Autogiro*, 384 F.2d at 397. Nor do dictionaries necessarily reflect current usage even for common words, which is readily apparent from the existence of publications such as *The Oxford Dictionary of New Words*. Staleness may be particularly acute with technical dictionaries,

which are marketed to a smaller specialized group of people and may not be updated as often as general purpose dictionaries. Even technical dictionaries or treatises may be unreliable sources for words used in highly specialized, hybrid or rapidly developing technologies.

The *Texas Digital* approach may prohibit resort to the specification when only one dictionary definition for the disputed claim term can be found. This includes not just situations where several dictionaries provide a single similar definition but also situations where only a single specialized dictionary defines the term. But the use of a single uncorroborated dictionary definition alone to restrict claim coverage may deprive the inventor of the full scope of his invention, particularly if the context in which the word is used in the patent suggests a different or broader meaning. This can lead to unjust results.

An approach to claim construction that takes into account all relevant sources of meaning to construe claim terms may result in more certainty to litigants in predicting likely claim constructions, more confidence by trial courts in their claim construction decision-making and ultimately more reliability in constructions themselves.<sup>1</sup>

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<sup>1</sup> The Association recognizes that the task of interpreting the claims in the context of the specification without unnecessarily importing limitations from the written description into the claims can be difficult. We do not advocate abandoning the

**B. Claims Should Be Construed In Such A Way That The Validity Of The Patent Is Maintained Provided That The Construction Is Consistent With The Language Of The Claims**

A patent is presumed to be valid, 35 U.S.C. § 282, and this presumption can be overcome only by clear and convincing evidence to the contrary. *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1355 (Fed. Cir. 1999). It follows from this statutory presumption that a claim should be construed narrowly if necessary to maintain the validity of the patent, provided that the narrower claim construction is still consistent with the patent specification and the claim language. “The court should proceed in a liberal spirit, so as to sustain the patent and the construction

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long-established rule prohibiting the importation of limitations from the written description into the claims. *See McCarty v. Lehigh Valley R. Co.*, 160 U.S. 110, 116 (1895) (“The difficulty is that if we once begin to include elements not mentioned in the claim in order to limit such claim ... we should never know where to stop.”). Patents have long been prosecuted with the understanding that the inventor does not have to disclose all possible embodiments of his invention, and this expectation should not be disturbed. But where the written description indicates that the claims are limited in a way that would result in the claims being no broader than the disclosed embodiment, they should not be construed more broadly.



claimed by the patentee himself, if this can be done consistently with the language which he has employed.” *Klein v. Russell*, 86 U.S. 433, 466 (1874).

This axiom is a qualified one. The validity-preserving interpretation must be viable in light of the patent specification and file history. For example, a limitation from the written description should not be read into the claim simply to ensure that the patent is not held invalid. *See McCarty v. Lehigh Valley R. Co.*, 160 U.S. at 116 (“It is suggested... that this feature may be read into the claims for the purpose of sustaining the patent... [W]e know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement.”); *see also A.K. Steel Corp. v. Sollac*, 344 F.3d 1234, 1245 (Fed. Cir. 2003) (holding that the validity-preserving interpretation cannot be correct if it is counter to the ordinary meaning of the claims as well as to the prosecution history).

Nor should a claim be construed narrowly to avoid invalidating prior art that was not of record before the examiner. The canon of construction that a patent should be construed to preserve validity rests on the presumption that the examiner understood the prior art of record and would not knowingly allow an invalid claim when considering that prior art. This presumption is clearly not in play when the invalidating prior art is not of record. In this case, no policy is served by reading

the claim narrowly to fit the prior art, and the canon of construction should not be employed to save the claim.

**C. The Prosecution History Should Be Considered Along With The Specification.**

The Supreme Court has long held that “an invention is construed not only in the light of the claims but also with reference to the file wrapper or prosecution history in the Patent Office.” *Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966). Thus the claims should be construed not only in the context of the specification but also in the context of the prosecution history. The prosecution history does not always add substantially to the context already provided by the patent specification but it may be particularly important in those instances where there were amendments to the claims or amendments to the written description or the drawings. Any arguments that the inventor made to differentiate his invention from the prior art may also elucidate the meaning and scope of claim terms or may constitute a clear disavowal of claim coverage.

**D. Testimony From Technical Experts Can Inform The Court On The Skill Level And Understanding Of Persons Of Ordinary Skill In The Art.**

Testimony from technical experts should be used to assist the court in ruling on the important underpinnings of claim construction in those cases in which such underpinnings are disputed. These underpinnings include the identification of the pertinent art, the level of ordinary skill in the art and the

understanding of the claim terms by one of ordinary skill in the art. In cases where disputed claim terms have multiple dictionary definitions, the court may find useful testimony about which dictionary definition better reflects the understanding of one of ordinary skill.

While concern has been expressed that expert witnesses are, by definition, not unbiased sources of information on the meaning of claim terms, trial courts are well equipped to weigh the testimony of expert witnesses and to make determinations about the reliability of such testimony based on the trial court's experience and judgment as to witness credibility, as well as the compatibility of the expert's opinion with the intrinsic evidence, *i.e.*, the patent specification and the file history. Expert testimony on technical issues is not unique to patent cases and there is no reason to treat expert testimony in patent cases as inherently more unreliable or biased than expert testimony in other cases, or to elevate dictionaries as sources of meaning for claim terms above the opinions of experts skilled in the art.

**E. There Are Procedural And Practical Obstacles To Giving Deference To The Trial Court's Claim Construction Findings.**

The Committee is divided on Question 7. Some members believe that the Supreme Court's decision in *Markman* mandates that all issues pertaining to claim construction, including underlying determinations that may be characterized as "fact determinations" – identification of the pertinent art, the level of ordinary skill

in the art, the scope and content of the prior art – are for the court to decide. They note that *Markman* expressly referred to expert testimony in holding that claim construction is for the court to decide, quoting with approval this passage from

*Walker on Patents*:

“Questions of construction are questions of law for the judge, not questions of fact for the jury. As it cannot be expected, however, that judges will always possess the requisite knowledge of the meaning of the terms of art or science used in letters patent, it often becomes necessary that they should avail themselves of the light furnished by experts relevant to the significance of such words and phrases. The judges are not, however, obliged to blindly follow such testimony.”

*Markman*, 517 U.S. at 387 (quoting A. Walker, *Patent Laws* § 189, at 173 (3d ed. 1985)). This passage suggests that the Court was aware that this construction would entail making expert witness credibility findings normally reserved for the jury when it stated that claim construction is for the trial court to determine.

Other members argue that it is not necessarily inconsistent with *Markman* to accord deference to the trial court’s findings on the factual underpinnings of claim construction because the Court did not have a situation where fact finding was taking place; to the extent the Court spoke to the issue, it was dictum. See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 983 (Fed. Cir. 1995) (“[T]he testimony of Markman and his patent attorney on the proper construction of the claims is entitled to no deference.... [B]oth testified as to how the patent should be construed based on the text of the patent. This testimony ... amounts to no more

than legal opinion.”). Moreover, the Supreme Court in *Markman* did not hold that there were never any factual issues underlying claim construction:

“In the main, we expect, any credibility determinations will be subsumed within the necessarily sophisticated analysis of the whole document. . . .”

*Markman v. Westview Instruments, Inc.*, 517 U.S. at 389. (Emphasis added.)

The Committee members who advocate this view believe that it is difficult, if not impossible, to classify most of these issues as anything other than factual. Indeed, some of these same issues have been classified as “factual” by the Supreme Court in the context of patent validity. *See Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809, 810-11 (1986) (“While the ultimate question of patent validity is one of law, . . . the § 103 condition [that is, nonobviousness] . . . lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.”) (Emphasis added).

The Committee members agree, however, that the *en banc* decision in *Cybor Corporation v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998), presents a significant precedential obstacle to the Court’s revisiting of its appellate review standard. *Cybor* clearly states that claim construction is reviewed *de novo* on appeal “including any allegedly fact-based questions relating to claim

construction.” *Id.* at 1456. Revisiting the *Cybor* decision, an *en banc* ruling issued in 1998, does a grave disservice to the principles of *stare decisis*. This Court, in *Knorr-Bremse*, acknowledged that “judicial departure from *stare decisis* always requires ‘special justification.’” Slip op. at 12 (quoting *Arizona v. Rumsey*, 467 U.S. 203, 212 (1984).) Nothing has changed in the six years since the Court decided *Cybor* to justify this departure.

It should be understood that a Court with so broad a mandate over patent law will need some latitude to define the contours of that law, especially given the relative youth of this Court in relation to our courts of general federal appellate jurisdiction. This Court has only had twenty-two years in which to lay out a coherent legal framework, which is a very short time jurisprudentially. Nevertheless, revisiting recently decided *en banc* opinions will erode the certainty in law upon which the patent community relies.

As to the merits of such a decision, there certainly would be a salutary effect to giving deference to aspects of the claim construction adopted in the district court. Trial courts would have more leverage in which to obtain settlements, knowing that parties would not simply be able to go over the head of the trial court to reverse a claim construction ruling. According deference to the trial court’s claim construction fact finding may also help impart some degree of

finality to the trial court's rulings and possibly reduce the length and cost of litigation.

But some Committee members question whether there are potential negative effects to such a decision. Defining the claim construction findings as "factual determinations" may require a jury to make them. Arguably, the Supreme Court in *Markman* did not address this particular issue. If juries were required to make these determinations, it may significantly impact summary judgment practice. Because of these uncertainties, some Committee members suggest that the Court not upset the apple cart.

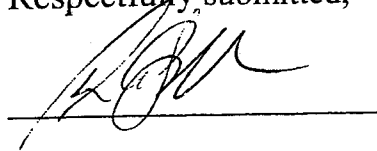
## VI. CONCLUSION

The Association respectfully suggests that the Court take a multi-factored approach to claim construction, and further submits its views on the propriety of revisiting the appellate standard of review for claim construction.

Dated: September 20, 2004

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that I have this day caused to be served two (2) true copies of the foregoing Brief of Amicus Curiae The Association of the Bar of the City of New York by overnight courier, on:

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Dated: September 20, 2004



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

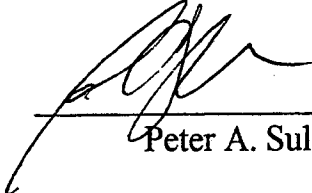
**Edward H. Phillips v. AWH Corporation, Hopeman Brothers, Inc.  
and Lofton Corporation**

**03-1269, -1286**

**CERTIFICATE OF COMPLIANCE**

Counsel for The Association of the Bar of the City of New York certifies that, pursuant to Fed. R. App. P. Rule 32(a)(7)(C), the attached brief complies with the type and volume limitations set forth at Federal Circuit Local Rule 32(a)(7)(B) because the brief (excluding Certificate of Interest, Table of Contents and Table of Authorities), contains 3980 words, as established by an automated word processing program.

Dated: September 20, 2004

  
\_\_\_\_\_  
Peter A. Sullivan