

**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**  
**SUGHRUE MION, PLLC**

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SEPTEMBER 20, 2004

## CERTIFICATE OF INTEREST

Counsel for Amicus, Sughrue Mion, PLLC, certifies the following:

1. The full name of every party or amicus represented by me is Sughrue Mion, PLLC.
2. The name of the real party in interest represented by me is Sughrue Mion, PLLC.
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 appear for the amicus now represented by me in the trial court or agency or are expected to appear in this Court are: Michael R. Dzwonczyk, Frank L. Bernstein and Brandon M. White of Sughrue Mion, PLLC.

September 20, 2004

  
Michael R. Dzwonczyk

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## STATEMENT OF INTEREST OF AMICUS CURIAE

Sughrue Mion, PLLC is a law firm based in Washington, D.C. having approximately 90 lawyers who specialize in all aspects of intellectual property law. Sughrue represents a worldwide client base whose interests are and have been both as patent holders and as entities whose goal is to avoid or defend against accusations of patent infringement. Sughrue's interest in this brief is not on behalf of any of its clients, but in furtherance of a systematic approach to claim construction useful in predictably advising its clients.

Sughrue expressly declines to take any position on behalf of any party in this matter. Instead, as invited by the Court, Sughrue submits this brief in response to the Court's Order dated July 21, 2004.

## ARGUMENT

### I. AN OVERVIEW OF CLAIM INTERPRETATION

#### A. The Patent is Directed to Those of Ordinary Skill in the Art

A patent's claims are directed to those of ordinary skill in the art. They are not directed to lawyers, juries or laymen. *Searfoss v. Pioneer Consolidated Corp.*, 374 F.3d 1142, 1149 (Fed. Cir. 2004). This principle is fundamental to claim interpretation, for it is from the perspective of a person of ordinary skill that claims are to be understood. Thus, a preliminary inquiry in claim interpretation should focus on how the ordinarily skilled artisan would seek to define a claim term in a patent.

Court decisions since *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002), that have adopted a general definition of a word or phrase (*e.g.*, WEBSTER'S, OXFORD ENGLISH, etc.) as probative of its "ordinary meaning," have assumed *sub silentio* that: (1) a person of ordinary skill in the relevant field would turn to a general dictionary to understand the definition of the claimed word or phrase; and (2) general plain-language dictionaries are directed to persons of ordinary skill. Both assumptions should be reconsidered.

Plain language dictionaries are directed to the general public, *e.g.*, laypersons -- from grade school children to tenured professors. The definitions they convey provide the plain and ordinary meaning of words to the general public,

not to persons of ordinary skill in a particular field of endeavor. Specialists consult specialized dictionaries in their fields. Such a dichotomy belies any notion that ordinarily skilled artisans consult WEBSTER'S or the OXFORD ENGLISH DICTIONARY to decide the meaning of technical terms.

#### **B. Claims Are Interpreted at the Time of Filing or Earlier**

Some panels of this court have held that claims are interpreted at the time a patent issues<sup>1</sup> while others have stated clearly that claims are interpreted at the time of invention.<sup>2</sup> One panel has stated: “[o]ur decisions have not always been consistent as to whether the pertinent date is the filing date of the application or the issue date of the patent.” *Inverness Med. Switz. GmbH v. Princeton Biomeditech Corp.*, 309 F.3d 1365, 1378 n.2 (Fed. Cir. 2002). The debate has been more academic than practical thus far, because the authors are aware of no matter whose disposition was predicated on a claim term definition that differed between the time of application and the time of issuance. Notwithstanding, we

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<sup>1</sup> *Texas Digital*, 308 F.3d at 1202-03 (“Dictionaries, encyclopedias and treatises, *publicly available at the time the patent is issued*, are objective resources that serve as reliable sources of information on the established meanings that would have been attributed to the terms of the claims by those of skill in the art.”) (emphasis added).

<sup>2</sup> *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1555 (Fed. Cir. 1997) (“As a general rule, the construing court interprets words in a claim as one of skill in the art *at the time of invention* would understand them.”) (emphasis added).

respectfully submit the proper date should be the actual or effective filing date or earlier if the time of invention is earlier..

The patentability of claims under Section 112 is based on the disclosure of the patent application as of the filing date. Prior art under Sections 102 and 103 is measured as of the filing date or earlier. Therefore, the meaning of claim terms should be determined as of the earliest effective filing date, rather than the issue date or thereafter. Otherwise, a claim term whose ordinary definition changes between application and issuance will be neither supported by, nor consistent with, the specification of which it is a part, when construed by a court using a post-filing date dictionary.

## **II. A PATENT, ITS PROSECUTION HISTORY, AND GENERAL AND TECHNICAL DICTIONARIES ARE ALL SOURCES FOR CLAIM CONSTRUCTION**

For well over 150 years, the Supreme Court has recognized the importance of the patent specification and prosecution history in interpreting patent claims. In *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880), the Court stated “[t]his construction of the patent is confirmed by the avowed understanding of the patentee, expressed by him . . . when his application for the original patent

was pending.”<sup>3</sup> From its inception, the Federal Circuit has embraced this principle as well.<sup>4</sup> Accordingly, precedent requires consideration of these materials as part of a general methodology.

But this court and one of its predecessors *also* have a long tradition of reliance on dictionaries as aids to claim construction, based on the settled notion that claim terms are given their ordinary meaning. *See, e.g., In re Markert*, 396 F.2d 477, 480 (C.C.P.A. 1968) (defining “compact jet”); *In re Wesseler*, 367 F.2d 838, 851 (C.C.P.A. 1966) (defining “tubular member”). Therefore, claim

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<sup>3</sup> *See also Hogg v. Emerson*, 52 U.S. 587, 606 (1850) (“The court did right, too, in holding to the propriety of looking to the whole specification, and also to the drawings, for explanation of any thing obscure. . . . because, after all, it is the specification which governs, and the drawings merely illustrate.”); *Crawford v. Heysinger*, 123 U.S. 589, 602 (1887) (“The file-wrapper and contents in the matter of the reissue are part of the evidence in the case, and throw light upon what should be the proper construction of claims 1 and 2.”); *Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966) (“It is, of course, well settled 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.”); Judge Learned Hand said more than 50 years ago in *Royal Typewriter Co. v. Remington Rand, Inc.*, 168 F.2d 691, 692 (2d Cir. 1948), “we [ ] first [ ] interpret the claims in the light of disclosure; and both the claims and the disclosure in the setting of the prior art. In these respects, a patent is like any other legal instrument.”

<sup>4</sup> *See ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984).

construction methodologies using each source must *necessarily* be viewed as *complementary* rather than *alternative*.<sup>5</sup>

**A. Harmonizing Dictionaries, the Specification and the Prosecution History: A Return to a More Apt Wisdom**

Some panels of the court have advocated the primacy of dictionaries as a claim construction tool,<sup>6</sup> while others have reasoned that claim interpretation begins with the specification and prosecution history.<sup>7</sup> For example, *Texas Digital* and its progeny place dictionaries in the forefront of claim interpretation, relegating the specification and prosecution history to rebuttal evidence in the event of a “clear disavowal” of a broader meaning. In contrast, court panels relying primarily on *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996),

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<sup>5</sup> See, e.g., Question No. 4 certified for *en banc* consideration in this matter.

<sup>6</sup> *Novartis Pharms. Corp. v. Eon Labs Mfg., Inc.*, 363 F.3d 1306, 1308 (Fed. Cir. 2004) (“[U]nder our precedent, we *begin* claim construction with an examination of *general purpose dictionary definitions*.”) (emphasis added); *Texas Digital*, 308 F.3d at 1204; *Kumar v. Ovonic Battery Co., Inc.*, 351 F.3d 1364, 1367 (Fed. Cir. 2003) (emphasis added) (“we look first to the dictionary definition of a contested term”); see also *Superguide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004).

<sup>7</sup> *Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1371 (Fed. Cir. 2003); *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369 (Fed. Cir. 2003) (“When construing the claims, we *begin* with an examination of the intrinsic evidence, i.e., the claims, the other portions of the specification, and the prosecution history....”) (emphasis added); *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002); *W.E. Hall Co., Inc. v. Atlanta Corrugating, LLC*, 370 F.3d 1343, 1350 (Fed. Cir. 2004).

and *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996), regard as “well-settled” that a court should look *first* to the intrinsic evidence of record as “the most significant source of the legally operative meaning of disputed claim language.” *Vitronics*, 90 F.3d at 1582.

Not surprisingly, the diverging views of court members have resulted in panel-dependent outcomes.

### **B. The Primacy of Contextual Meaning**

Claims must be read in light of the specification, for it is the specification that contains a written description of the invention that “may act as a sort of dictionary, which explains the invention and may define terms used in the claims.” *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (*en banc*), *aff’d*, 517 U.S. 370 (1996). For decades, both the Supreme Court and the C.C.P.A. looked both to dictionaries as well as the specification and prosecution history in construing claim terms. Repeatedly, primacy was given to the *contextual* meaning of a term *as set forth by the patentee*, when present, and thereafter to a dictionary definition for an understanding of ordinary meaning.

Resorting only to a claim term’s contextual meaning (including the prosecution history), the Supreme Court in *Weber Electric Co. v. E. H. Freeman Electric Co.*, held that where the inventor so clearly disclosed that rotary

movement was not required for the socket of the claimed invention, "*it [was] not necessary to consider the dictionary definitions of the words used*, upon which the Circuit Court of Appeals, with sound reason, relied in reaching this same conclusion." 256 U.S. 668, 678 (1921). Again in *United States v. Adams*, the Court cited the importance of the specification in understanding the claims: "[I]t is *fundamental* that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention." 383 U.S. 39, 49 (1966) (emphasis added and citations omitted).

In *In re Mahony*, the court turned to the specification as the primary source for claim interpretation stating:

Thus, the art speaks of clipping, clamping, chopping, rectifying, filtering, and so on, with reference to electrical signals. [footnote omitted]. *No one in the art would give these terms their general colloquial meaning when discussing technical matters with other persons skilled in the art. To do so would be absurd.* Similarly here, once we know that "bit stream" in the art means a sequence of electrical signals or pulses, it would be absurd to say that the claims reasonably read on a mentally implemented process.

421 F.2d 742, 746 (C.C.P.A. 1970) (emphasis added).

Confronted with the choice of affirming an examiner's broad claim construction based on a WEBSTER's dictionary definition of "source of polyvalent anions" or reversing in view of the patentee's description as set forth in the specification, the C.C.P.A. looked to the patentee's description, stating: "[W]e



must look *not* to the dictionary but rather to the art or technology to which the claimed subject matter pertains.” *In re Salem*, 553 F.2d 676, 683 (C.C.P.A. 1977)

(emphasis added). The court reasoned:

Indiscriminate reliance on definitions found in dictionaries can often produce absurd results. \* \* \* *One need not arbitrarily pick and choose from the various accepted definitions of a word to decide which meaning was intended as the word is used in a given claim.* The subject matter, the context, etc., will more often than not lead to the correct conclusion.

*Id.* at 682 (emphasis added).<sup>8</sup> The *Salem* court cited to the reasoning in *Liebscher*

*v. Boothroyd*, 258 F.2d 948, 951 (C.C.P.A. 1958), wherein the C.C.P.A. stated:

Words are used in many senses and often have diametrically opposed meanings, depending upon the sense in which they are used. One searching for the dictionary definitions of “effectively” or “effect” will find among the numerous definitions listed many which are indisputably inapplicable to the instant use of the word “effectively.” But the words in which a claim is couched may not be read in a vacuum. . . . The subject matter, the context, etc., will more often than not lead to the correct conclusion.

In *In re Barr*, 444 F.2d 588, 597 (C.C.P.A. 1971), Judge Rich looked *first* to the specification for the definition of “a phenyl radical,” and finding none, was

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<sup>8</sup> The C.C.P.A.’s reasoning in *Salem* contrasts with more recent pronouncements of the court that “[i]f more than one dictionary definition is consistent with the use of the words in the intrinsic record, the claim terms may be construed to encompass all consistent meanings.” *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1300 (Fed. Cir. 2003).

compelled to presume the phrase was used in its commonly accepted technical sense.<sup>9</sup>

Earlier, in *McCutchen v. Oliver*, the C.C.P.A. defined the term "reference surfaces" solely by relying on the applicant's disclosure. 367 F.2d 609, 615-16 (C.C.P.A. 1966). Judge Rich, concurring, considered the term ambiguous and stated: "Once that conclusion has been reached, then we must *follow the rule and look to the specification in which it originated and take the meaning there ascribed to it.*" *Id.* at 618. (emphasis added).

Rejecting a dictionary definition in favor of an applicant's disclosure, the C.C.P.A. stated in *Rajchman v. Herbert*, 312 F.2d 926, 928 (C.C.P.A. 1963):

In support of its interpretation of the count and the significance attributed to "cluster," the board resorted to dictionary definition of that word. We do not deem it necessary to launch upon a detailed discussion of the reasoning advanced by the board productive of its conclusion. Suffice it to say, we do not ascribe to the term "clusters" that "unique significance" accorded to it by the board, thus rendering irrelevant, in our judgment, the pursuit of lexicographical discussion. The count defines a "cluster" as "comprising a central hole and an array of equally spaced holes surrounding the central hole." It seems clear to us that appellant's disclosure shows this.

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<sup>9</sup> *In re Barr*, 444 F.2d at 597 ("The specification in this case attempts no definition of the claim language 'a phenyl radical.' Accordingly, we must presume that the phrase was used in its commonly accepted technical sense. Appellants apparently concede as much arguing that their 'use of "phenyl" in claim 25 is similar to referring to "hydroxyphenyl",' which they assert is 'standard practice' citing HACKH'S CHEMICAL DICTIONARY (3d ed. 1944).").

Other courts have reasoned similarly.<sup>10</sup>

The C.C.P.A.'s rich tradition of primary resort to contextual interpretation is borne of both precedent and pragmatism, and the wisdom of its jurisprudence cannot be gainsaid: words that are separated from a claim and removed from the specification in order to divine their "ordinary meaning" through dictionaries may well be accorded a definition "absurd" in the context of the patent. *Salem*, 553 F.2d at 682-83. This court has said: "claims are directed to the invention that is described in the specification; they *do not have meaning removed from the context from which they arose.*" *Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1352 (Fed. Cir 2001) (emphasis added). That is, "divorced from context, words lose their ordinary and accustomed meanings." *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1370 (Fed. Cir. 1999) (Rader, J., dissenting).<sup>11</sup> That is the very danger

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<sup>10</sup> The Fifth Circuit in *Harrington Mfg. Co. v. White* stated "[c]laims are *best* construed in connection with the other parts of the patent instrument and with the circumstances surrounding the inception of the patent application." 475 F.2d 788, 797 n.5 (5th Cir. 1973) (emphasis added) (citing *Autogiro Co. v. U.S.*, 384 F.2d 391, 397 (Ct. Cl. 1967)). The court cited as "the proper test for infringement" the approach of "interpreting patent claims *in accordance with the purpose and intent of the patentee rather than the common denotations of his choice of words.*" *Id.* at 797, n.5 (emphasis added) (citing 7 WALKER ON PATENTS (2d ed. Deller 1972) § 531 at 307).

<sup>11</sup> Acknowledging the results when claim terms are defined out of context, Judge Rader stated that: "'Permanent' in the context of mountain ranges can mean millennia; 'permanent' in the context of hair treatments can mean until the next

courts face when resorting to dictionaries in the first instance to discern a term's ordinary meaning.

Use of a contextual claim interpretation approach imparts a reasoned predictability to the claim interpretation process and better serves the public notice function of patent claims more reliably than primary resort to dictionary definitions. "Predictability" in this sense does not mean that a given word or term will have the same definition in one patent as it will in a wholly unrelated patent in a different art, or even that the same word will have the same definition from one judicial decision to a next unrelated one. Nor should it. Predictability refers to the *process* of claim interpretation, a process that patent owners and the patent bar can reliably use in assessing claim scope for purposes of infringement and validity. *That* is the essence of notice.

***1. The patent document provides notice of a claim term's meaning***

Notice begins with the language of the claims. It is the patent document that sets forth the claims and also contains a written description, examples, and even

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rain storm; 'permanent' in the context of creased pants can mean until the next long airline trip in coach class; 'permanent' in the context of genetic combinations can mean until the next mutation." *K-2 Corp.*, 191 F.3d at 1370 (Rader, J., dissenting).

illustrations of the invention(s) claimed. Next, the patent disclosure is directed to persons of ordinary skill in the art -- the audience to whom and the backdrop against which the claims are to be understood. Finally, only the patent specification and prosecution history can illustrate what the claimed invention is *not*, whether because of disclaimer, disavowal or estoppel. A dictionary cannot.

2. ***Dictionaries are less reliable at providing notice of a claim term's meaning***

Dictionary definitions may or may not make sense in the context of a patent. Members of the general public who do not possess the dictionary or dictionaries this court may ultimately use to construe a claim term can hardly be said to be "on notice" of a claim term's meaning, especially when patentees are not confined to normal dictionary meanings:

[t]he dictionary does not always keep abreast of the inventor. It cannot. Things are not made for the sake of words but words for things. To overcome this lag, patent law allows the inventor to be his own lexicographer.

*Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 1569 (Fed. Cir. 1983) (citing *Autogiro*, 384 F.2d at 397)).

Moreover, plain-language dictionaries that are directed to laypersons may not, *ab initio*, convey the plain and ordinary meaning of a claim term *as a person of ordinary skill in the art would understand it*. Justice Holmes has admonished that "[a] word is not a crystal, transparent and unchanged, it is the skin of a living

thought and may vary greatly in color and content according to the circumstances and the time in which it is used.” *Towne v. Eisner*, 245 U.S. 418, 425 (1918).

Perhaps for this reason, both this court and the C.C.P.A. have preferred technical dictionaries rather than “ordinary” dictionaries. *See, e.g., In re Jones*, 149 F.2d 501, 503 (C.C.P.A. 1945); *Hoechst Celanese Corp. v. BP Chems., Ltd.*, 78 F.3d 1575, 1580 (Fed. Cir. 1996) (“[A] general dictionary definition is secondary to the specific meaning of a technical term as it is used and understood in a particular technical field.”); *AFG Indus., Inc. v. Cardinal IG Co., Inc.*, 239 F.3d 1239, 1247 (Fed. Cir. 2001) (“This court has repeatedly cautioned against using non-scientific dictionaries for defining technical words.”).<sup>12</sup>

Dictionaries have their place in claim construction. Certainly, this court, its predecessor, and the Supreme Court have relied on dictionaries in construing terms in statutes, contracts, documents, patents, etc. The C.C.P.A. has used dictionaries to define claim terms where there was no definition set forth in the specification, *Barr*, 444 F.2d at 597, or where the parties offered dictionary definitions of art-recognized terms, *In re Yocum*, 314 F.2d 548, 551 (C.C.P.A. 1963). But their use

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<sup>12</sup> Of course, the court has also said the opposite is true. *Novartis Pharms.*, 363 F.3d at 1308 (“we *begin* claim construction with an examination of *general purpose dictionary definitions*”).

in defining claim terms *in the first instance* has resulted in controversial dispositions.<sup>13</sup>

### C. Balancing the roles of dictionary and specification

The specification provides the primary source of the contextual understanding of a claim term as described by the patentee. However, this does *not* mean a claim term *must* be limited because of a narrow specification, for importing limitations into claims violates a history of sound precedent to the contrary.<sup>14</sup> *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898 (Fed. Cir. 2004). Nor does it mean a claim term can be *broadened* because of a comprehensive specification.

Both bench and bar have wrestled with the “twin axioms” of claim construction (reading the claims in light of the specification of which they are a part, but not importing limitations into the claims). *Liebel-Flarsheim*, 358 F.3d at

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<sup>13</sup> See, e.g., *Novartis Pharms.*, 363 F.3d at 1314-16 (Clevenger, J., dissenting) (in defining “hydrosol,” 4 dictionaries used in a “several degrees of separation analysis” requiring consideration of the definitions of the words “sol,” “solution,” “medicinal,” “medicine,” and “preparation”).

<sup>14</sup> *McCarty v. Lehigh Valley R.R. Co.*, 160 U.S. 110, 116 (1895) (“[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. The difficulty is that, if we once begin to include elements not mentioned in the claim, in order to limit such claim, and avoid a defense of anticipation, we should never know where to stop.”)

904-05. Viewed as pitfalls on either side of a single path, the traveler who strays but a little risks violating one axiom or the other. No bright line rules have emerged to guide the claim construction sojourner through the twin axioms in all cases, because -- *perhaps* -- no single rule applies in all cases. But that does not mean there is no guidance.

The specification is the primary source of claim term definition and claim support. It is axiomatic that full disclosure, sufficient to notify the public of the precise scope of the monopoly asserted, is given by the patentee in exchange for that monopoly. A patent having a more substantial and open-ended disclosure may well support a broader claim scope *when it provides more context for understanding the definition of a particular claim term*. A patent having a less substantial and/or closed-ended disclosure may support a narrower scope of the very same term *where a person of ordinary skill would not understand the patent to support a broader definition*. In either event, and *importantly*, the patent document itself provides a basis for discrimination between the two. A dictionary does not.

Dictionaries provide the same claim term definitions regardless of the patent. WEBSTER'S neither knows nor cares how much patent disclosure defines or supports a claim term, and provides no basis for determining which of multiple



definitions are appropriately directed to a person of ordinary skill in a particular field.

By looking first to the patent for contextual meaning and thereafter to dictionaries for any ambiguities that remain, a claim term definition and scope will be more nearly commensurate with the inventor's contribution to the art.

### **III. DEFERENCE SHOULD BE ACCORDED TO A TRIAL COURT'S FACTUAL FINDINGS UNDERLYING CLAIM CONSTRUCTION**

Judicial efficiency, sound policy and the reasoned positions of several court members suggest that deference be accorded to a district court's factual findings underlying claim construction. The testimony of those skilled in the art and a district court's findings with respect to "ordinary" and "common" meaning should be factual determinations under Rule 52(a) reviewed under a clearly erroneous standard, with "due regard" given to the "trial court['s ability] to judge [ ]the credibility of the witnesses." FED. R. CIV. P. 52(a) (2004). The Supreme Court's decision in *Markman* does not require otherwise.

In *Markman*, the Supreme Court stated that the "construction of a patent, including terms of art within its claim, is exclusively within the province of the court." 517 U.S. at 372. The Supreme Court did not hold that factual findings underlying claim construction are necessarily questions of law subject to *de novo* appellate review. Following *Markman*, the Federal Circuit's *en banc* decision in

*Cybor Corp. v. FAS Techs. Inc.*, 138 F.3d 1448, 1456 (Fed. Cir. 1998) (*en banc*), held that no deference should be accorded to a district court's claim construction ruling on appeal.

Yet several members of this Court have expressed doubt as to the reasoning of *Cybor*. Dissenting from a denial of a petition for rehearing *en banc* in *CVI/Beta Ventures, Inc. v. Tura LP*, 120 F.3d 1260, 1261-62 (Fed. Cir. 1997) (Mayer, J., dissenting), Chief Judge Mayer emphasized that the Supreme Court's decision in *Markman* left intact the roles of trial-level fact-finding and appellate level review, and that factual findings underlying a question of law are entitled to receive their proper measure of deference on appeal. *Id.*; see also *Fromson v. Anitec Printing Plates, Inc.* 132 F.3d 1437, 1447-48 (Fed. Cir. 1997) (Mayer, J., concurring).

Judge Plager's concurrence in *Cybor* stated the Federal Circuit *will* accord weight to the trial judge's views even under a *de novo* review, based on "the care ... with which th[e] view [on claim construction] was developed, and the information on which it is based." *Cybor*, 138 F.3d at 1462 (Plager, J., concurring). Similarly, Judge Bryson explained that the holding of *Cybor* "does not mean that we intend to disregard the work done by district courts in claim construction or that we will give no weight to a district court's conclusion as to claim construction, no matter how the court may have reached that conclusion."

*Id.* at 1463 (Bryson, J., concurring) (citing *Propper v. Clark*, 337 U.S. 472, 486-87 (1949)). He explained that in cases such as *Markman*, “it would be entirely appropriate . . . to factor into our legal analysis the district court’s superior access to one of the pertinent tools of construction. . . . as to those aspects we should be cautious about substituting our judgment for that of the district court.” *Id.*

Commentators have observed that this court’s role is not to consider *evidence de novo* -- fairness to litigants weighs against reconsideration of the facts at the appellate level.<sup>15</sup> They add that appellate fact-finding as endorsed in *Cybor* undermines the district court’s role, increases the number of appeals by encouraging litigants to retry cases at the appellate level,<sup>16</sup> and -- as stated in the Federal Rules -- needlessly reallocates judicial authority.<sup>17</sup>

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<sup>15</sup> See Rooklidge, W. & Weil, M., *Judicial Hyperactivity: The Federal Circuit’s Discomfort with its Appellate Role*, 15 BERKELEY TECH. L.J. 725, 739 (2000).

<sup>16</sup> “[D]e novo review has promoted more appeals to the Federal Circuit and has resulted in the unintended lengthening of patent actions.” Lane, J. & Pepe, C., *Living Before, Through, and with Markman: Claim Construction as a Matter of Law*, 1 BUFF. INTELL. PROP. L.J. 59, 75 (2001).

<sup>17</sup> See FED. R. CIV. P. 52(a) Advisory Committee’s note on 1985 Amendment (“To permit courts of appeals to share more actively in the fact-finding function would tend to undermine the legitimacy of the district courts in the eyes of litigants, multiply appeals by encouraging appellate retrial of some factual issues, and needlessly reallocate judicial authority.”); see also Rooklidge, *supra* at note 15.

Finally, judicial efficiency and certainty support deference to a district court's factual findings on claim construction. Litigants invest significant sums of money and resources preparing for claim construction hearings, providing evidence on how the ordinarily skilled artisan construes contested claim terms. A district court judge then reviews the voluminous record created for purposes of claim construction, considers the evidence and renders a decision. If the claim construction ruling is reviewed without deference,<sup>18</sup> all of this effort at the district court level becomes merely a prequel for this court's *de novo* review.

#### IV. CONCLUSION

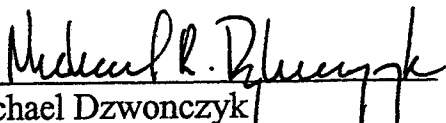
In interpreting patent claims, the context and breadth that the patentee's own disclosure and prosecution history provide should be the first place to look for meaning. To the extent that that intrinsic evidence is inconclusive, it is appropriate to look to technical dictionaries for technical terms, and if necessary, general dictionaries for non-technical terms.

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<sup>18</sup> See Lee, T. & Evans, M., *The Charade: Trying a Patent Case to All "Three" Juries*, 8 TEX. INTELL. PROP. L.J. 1, 4, 11-20 (1999) (arguing that the Federal Circuit "became a second jury by substituting its opinion for the jury verdict"); Salyers, D. *The Paper Side of Jury Litigation in Patent Cases - Don't Become Just Another Statistic in The Federal Circuit*, 572 PLI/PAT 557, 566-88 (1999).

Dated: September 20, 2004

Respectfully submitted,  
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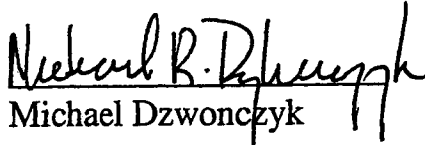
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## CERTIFICATE OF COMPLIANCE

Pursuant to Federal Rule of Appellate Procedure 32(a)(7), the undersigned hereby certifies that this AMICUS BRIEF ON BEHALF OF SUGHRUE MION, PLLC complies with the type-volume limitations of Fed. R. App. Proc. and this Court's Order of July 21, 2004 limiting briefs to 5,000 words. This AMICUS BRIEF ON BEHALF OF SUGHRUE MION, PLLC contains 4,882 words as calculated by the word processing program.

Dated: September 20, 2004

  
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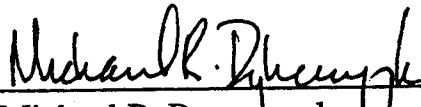
## CERTIFICATE OF SERVICE

I hereby certify that on September 20, 2004, two copies of the Brief of Amicus Curiae Sughrue Mion, PLLC were served by third party commercial courier for overnight delivery on:

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