

ENDING THE FEDERAL CIRCUIT CRAPSHOOT: EMPHASIZING PLAIN MEANING IN PATENT CLAIM INTERPRETATION

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INTRODUCTION

Recent Court of Appeals for the Federal Circuit (“Federal Circuit”) cases manifest a palpable inter-panel tension regarding the role of plain meaning in patent claim interpretation. On the one hand, certain panels appear to ignore the plain meaning of disputed claim terms by reasoning that if the description of the “invention” in the specification fails to expressly contemplate a certain embodiment, then that embodiment cannot be covered by the claims. On the other hand, certain panels emphasize the presumption in favor of plain meaning in claim interpretation. The tension between these camps, which is driven by competing canons of claim construction, results in uncertainty for litigants and wasted judicial resources.

For example, in a recent case the defendant’s accused system clearly fell within the plain language of the claims.¹ So clear was literal infringement that the district court issued a preliminary injunction.² Normally, this would lead to a speedy settlement. The defendant, however, rolled the dice on claim construction and took its case to the Federal Circuit.³

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¹ *Transonic Sys., Inc. v. Non-Invasive Med. Tech. Corp.*, 127 F. Supp. 2d 1315, 1319 (D. Utah 2000).

² *Id.* at 1322.

³ “Appeal” is defined as “In law, to put the dice into the box for another throw.” Ambrose Bierce, *The Devil’s Dictionary* 9 (Oxford University Press 1999). This definition is particularly appropriate in the patent claim interpretation context where the reversal rate

Rather than applying the plain meaning of terms such as “calculating” and “determining,” the Federal Circuit held that these terms require the use of specific formulas disclosed in the written description.⁴ The plaintiff then faced a remanded case with a narrow claim construction and no chance of a speedy resolution. As an isolated case, the decision is unremarkable. The problem that bears addressing, however, is that a different panel would likely have employed the presumption in favor of plain meaning and decided the case differently. Such a disparity in panel approaches truly gives litigants no more certainty than a roll of the dice.

The Federal Circuit continues to issue panel-specific contradictory decisions regarding the respective roles of the plain meaning of patent claim terms and the written description in patent claim interpretation.⁵ The resulting uncertainty encourages wasteful litigation and saps judicial resources. The solution is not an innovative new bright-line rule. Instead, the effective solution is uniform application of the oft-stated (but not consistently followed) presumption in favor of plain meaning in interpreting patent claims. This presumption breathes life into the notice function of patent claims and removes a great degree of uncertainty from the claim interpretation process. This article examines the paramount role played by claims in our patent system, the recent inconsistent positions taken by certain Federal Circuit panels (which do not square with this paramount role) and the need for uniform application of the presumption in favor of plain meaning in patent claim interpretation.

I. THE PARAMOUNT ROLE OF CLAIMS IN OUR PATENT SYSTEM

A. *Defining the Invention*

The words of a patent claim define what the inventor regards as the invention. Section 112 of 35 U.S.C. expressly states: “The specification

in nearly forty percent. *Cybor Corp. v. FAS Tech., Inc.*, 138 F.3d 1448, 1476 n.4, 46 U.S.P.Q. 2d 1169, 1192 n.4 (Fed. Cir. 1998).

⁴ *Transonic Sys., Inc. v. Non-Invasive Med. Tech. Corp.*, WL 585143, *5 (Fed. Cir. May 29, 2001).

⁵ Recently, Judge Lourie recognized that the Federal Circuit does have some “superficially conflicting rules” of claim construction. Text of Judge Alan D. Lourie’s June 12, 2000 Speech to PTC Section of D.C. Bar, 60 *Patent, Trademark & Copyright J.* 147 (2000). He, however, went on to maintain that the claim construction rules are not really in conflict and that “[o]bjective counsel should be able to discern which rule applied in a given case.” *Id.* As explained in this article, the conflict is more than superficial.

shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”⁶ The claims of the patent set forth the subject matter which others, during the term of the patent, are excluded from making, using, selling or offering to sell in, or importing into, the United States.⁷ Thus, the scope of the patent right is contained within the limitations of the claims-making the words chosen for the patent claims of paramount importance because they set forth the metes and bounds of the patentee’s right to exclude.⁸ Fairness dictates that the patentee notify the public of these metes and bounds so that infringement can be avoided.⁹ A patent applicant provides such notice through the words chosen in the claims.¹⁰

1. Historical Evolution of Patent Claims

Section 112’s edict that a patent’s specification shall conclude with claims setting forth what the patentee views as his invention did not always exist in its present form. The original Patent Act (“Act”), which our first Congress created in its second session, did not impose any such

⁶ 35 U.S.C. § 112 ¶ 2 (1994).

⁷ 35 U.S.C. § 271(a) (Supp. 1995).

⁸ *Burke, Inc. v. Bruno Indep. Living Aids, Inc.*, 183 F.3d 1334, 1340, 51 U.S.P.Q. 2d 1295, 1299 (Fed. Cir. 1999) (citing *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 U.S.P.Q. 2d 1962, 1966-67 (Fed. Cir. 1989)).

⁹ *See Athletic Alternatives v. Prince Mfg.*, 73 F.3d 1573, 1581, 37 U.S.P.Q. 2d 1365, 1372 (Fed. Cir. 1996).

¹⁰ The axiom that claim terms should be construed in light of the claim language, specification and prosecution history is somewhat of a fiction divorced from reality. In reality, courts interpreting claims are faced with two competing claim constructions zealously advocated by litigants. The courts seldom, if ever, come up with a claim construction divined from the intrinsic evidence. Instead, they choose one of two plausible constructions put forth by the advocates, which emphasize and de-emphasize various aspects of the intrinsic record. A company investigating whether or not its new product may infringe on the rights of others, however, does not have the luxury of choosing from two sets of well-reasoned briefs. Instead, it must rely more heavily on the plain meaning of the claim terms and any express definitions offered in the public record. For an excellent treatment of the litigation reality of claim construction, *see* Douglas Y’Barbo, *Interpreting Words in a Patent*, 1 J. Intell. Prop. 191 (2001). Especially keen is Mr. Y’Barbo’s observation that the “true meaning” of a claim term is never the focus in patent claim construction.

requirement.¹¹ The Act merely required that the patentee provide a written specification describing the invention (with drafts, models, etc.) sufficiently to distinguish it from prior art and to enable a person skilled in the art to utilize the invention.¹² The Act's replacement, promulgated by Congress in 1793, contained similar language.¹³ In pertinent part, it stated that a patentee "shall deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear and exact terms, as to distinguish the same from all other things known, and to enable any person skilled in the art" to utilize the invention.¹⁴

Though the language in these acts did not address the need for claims *per se*, subsequent case law made clear the necessity for language that particularly points out the subject matter that the applicant views as his invention. For example, in *Evans v. Eaton*,¹⁵ the 1822 United States Supreme Court considered a patent directed to a Hopperboy—a machine used in the manufacture of flour.¹⁶ The plaintiff contended that the patent was directed to a new Hopperboy and alternatively that the patent was directed to an improvement for an existing Hopperboy design.¹⁷

The Court rejected the plaintiff's first argument and determined that the inventor had no right to a patent on a new Hopperboy design.¹⁸ After so doing, the *Evans* Court tackled the plaintiff's contention that the patent was directed to an improvement on an existing Hopperboy design.¹⁹ It concluded that the patent holder was not entitled to any recovery because the patent's specification was defective in not specifying the improvement.²⁰

In reaching its holding, the *Evans* Court stressed that the Patent Act required the specification to describe the invention so as to "distinguish [it] from all other things before known."²¹ In other words, the Supreme Court

¹¹ The Act was titled "An Act to Promote the Progress of Useful Arts." Ch. 7, § 2, 1 Stat. 109 (1790).

¹² *Id.* at 110.

¹³ Ch. 11, § 3, 1 Stat. 318, 321-22 (1793).

¹⁴ *Id.* at 321.

¹⁵ 20 U.S. 356 (1822).

¹⁶ *Id.* at 357.

¹⁷ *Id.* at 427.

¹⁸ *Id.* at 431. At trial, the jury found that the patentee was not the inventor of the Hopperboy design as a whole. *Id.* The Supreme Court found no reason to disturb this finding. *Id.*

¹⁹ *Id.* at 432.

²⁰ *Id.* at 435.

²¹ *Id.* at 434 (emphasis added).

found a requirement for applicants to particularly point out the subject matter of the invention. The Court also wondered how the specification for an improvement on a machine could be sufficient when it “does not distinguish what the improvement is, nor state in what it consists, nor how far the invention extends.”²² It went on to say that a patentee “ought to describe what his own improvement is, and . . . limit his patent to such improvement.”²³

In probable reaction to sentiments such as those expressed by the *Evans* Court, Congress drafted the 1836 Patent Act to include language stating that an applicant must “particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery.”²⁴ Since then, the term “claims” has been used to indicate that portion of the patent which specifically defines that which the applicant believes is worthy of the patent monopoly.²⁵ This common use of the term “claim” is clearly evidenced in the Patent Act of 1870, which required that the “specification and *claim* . . . be signed by the inventor.”²⁶

In 1952, Congress updated the patent laws to further emphasize the vital role played by a patent’s claims.²⁷ Congress manifested the importance of the claims by separating the clause dealing with claims into its own paragraph and by modifying the language of that clause.²⁸ After modification, the clause stated: “The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”²⁹

That clause has remained unchanged for almost fifty years and can still be found at 35 U.S.C. Section 112 paragraph 2. Thus, the property right granted by a patent is measured by, and limited to, the words of the claims.³⁰

²² *Id.*

²³ *Id.* at 435.

²⁴ Ch. 357, § 6, 5 Stat. 117, 119 (1836).

²⁵ Robert L. Harmon, *Patents and the Federal Circuit*, § 5.4, 216 (5th ed., BNA Books 2001).

²⁶ Ch. 230, § 26, 16 Stat. 198, 201 (1870) (emphasis added).

²⁷ According to the revision notes, the “clause relating to the claim [was] made a separate paragraph to emphasize the distinction between the description and the claim or definition.” 1952 U.S.C.C.A.N. 2411, 2412.

²⁸ *Id.*

²⁹ Pub. L. No. 593, § 112, 66 Stat. 798, 798 (1952).

³⁰ See *A.B. Dick Co. v. Burroughs Corp.*, 713 F.2d 700, 702, 218 U.S.P.Q. 965, 967 (Fed. Cir. 1983).

Hence, generally, the patent figures and written description should not limit or broaden the scope of the claimed invention.³¹

2. Application of Patent Claims in Litigation

Patent infringement is determined by comparing the accused device or method to the claims-not the written description.³² Thus, generally, a patent claim may be broader than the specific embodiment shown in the specification as long as the claim is enabled.³³ The distinct claiming requirement³⁴ set forth in the Patent Statute is therefore driven by the need for the public to be aware of the metes and bounds of the patent. The applicant must, therefore, carefully choose the words of the claims so that they distinctly describe the scope of the invention worthy of protection. The patent examination process ensures, in principle, that the allowed claims are clear, concise and unambiguous.

Often, unsophisticated clients (and unfortunately some advocates and courts) misapprehend the role of the patent's written description. This misapprehension leads to the following faulty logic: "My system looks very different from the one disclosed in the patent; therefore, I do not infringe." But that is not the law.³⁵ A detailed embodiment set forth in the written

³¹ *Kraft Foods, Inc. v. Int'l Trading Co.*, 203 F.3d 1362, 1366, 53 U.S.P.Q. 2d 1814, 1817 (Fed. Cir. 2000).

³² *Wenger Mfg., Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1231, 57 U.S.P.Q. 2d 1679, 1683 (Fed. Cir. 2001); *Laitram Corp. v. NEC Corp.*, 163 F.3d 1342, 1347, 49 U.S.P.Q. 2d 1199, 1203 (Fed. Cir. 1998).

³³ *Dow Chem. Co. v. U.S.*, 226 F.3d 1334, 1342, 56 U.S.P.Q.2d 1014, 1020 (Fed. Cir. 2000); *Wang Laboratories, Inc. v. America Online, Inc.*, 197 F.3d 1377, 1382-83, 53 U.S.P.Q.2d 1161, 1165 (Fed. Cir. 1999).

³⁴ The "distinctly claiming" requirement in 35 U.S.C. § 112, means that the applicant must set forth the claims so that they have a clear and definite meaning when interpreted in the context of the patent document. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 874-75, 27 U.S.P.Q.2d 1123, 1126 (Fed. Cir. 1993).

³⁵ Though such reliance on the *system* disclosed in a patent is misplaced, the *principle* behind the system may preclude infringement under the so-called "reverse doctrine of equivalents." Under this doctrine, a finding of non-infringement may be appropriate where, despite the fact that a claim literally reads on an accused device, the accused product is so far changed *in principle* from the patented invention that it performs the same or similar function in a substantially different way. *SRI Int'l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1123, 227 U.S.P.Q. 577, 582 (Fed. Cir. 1985) (citing *Graver Tank & Mfg. Co., Inc. v. Linde Air Prods. Co., Inc.*, 339 U.S. 605, 608-09, 85 U.S.P.Q. 328, 330 (1950)). This infringement defense, however, is rarely offered because

description should embody the claimed invention, but only the claims provide the right to exclude. In essence, the written description is generally irrelevant to an infringement analysis except for aiding in understanding the claims. Accordingly, even if key elements of a competitor's system correspond directly to the figures and system shown in the patent's written description, the competitor's system does not infringe the patent unless it meets every limitation of one or more of the patent's claims.³⁶

Another manifestation of confusion occurs by viewing the system or process set forth in the written description as "the invention." This is wholly contrary to the concept that every claim in a patent represents a distinct invention.³⁷ By treating the embodiment disclosed in the written description as "the invention," the entire purpose of claims and the prosecution process is thwarted.³⁸ Perhaps the source of this confusion is the obligation imposed on an inventor of setting forth the best mode contemplated for practicing his invention. This may lead some to believe that the "true" invention is the embodiment set forth in the written description.

Although an applicant must set forth the best mode, there is no requirement that every mode be set forth.³⁹ Thus, the claimed invention may

products that read on a patent's claims usually perform the same function, in the same way, to achieve the same result. *Id.*

³⁶ See *Charles Greiner & Co. v. Mari-Med Mfg., Inc.*, 962 F.2d 1031,1034, 22 U.S.P.Q.2d 1526, 1528 (Fed. Cir. 1992); *Elektra Instrument S.A. v. O.U.R. Sci. Int'l, Inc.*, 214 F.3d 1302, 1306, 54 U.S.P.Q.2d 1910, 1912 (Fed. Cir. 2000); *Kraft Foods*, *supra* n. 31 at 1370, 53 U.S.P.Q.2d at 1820.

³⁷ *Jones v. Hardy*, 727 F.2d 1524, 1528, 220 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (referring to 35 U.S.C. § 282 (2001)).

³⁸ The prosecution process requires the testing of each claim in the application against the prior art. 37 C.F.R. § 1.104(c)(1) (2001). The claims do not stand or fall together in that process. *Id.* Hence, applicants are often given the choice to resubmit dependent claims as independent claims for allowance, even though the original independent claims are not allowable over the prior art. U.S. Dept. of Commerce, *Manual of Patent Examining Procedure*, § 608.01(n)(II), 600-67 (7th ed., West 2000).

³⁹ The original Patent Act of 1790 required an enabling disclosure. The reason is clear: In exchange for the patent monopoly, the patentee must teach the public how to make and use the invention. See Robert L. Harmon, *Patents and the Federal Circuit*, § 5.2(a), 197-98 (5th ed., BNA Books 2001). In other words, an enabling disclosure must put the subject matter of the claims in the possession of the public so that the public may use the invention once the patent term expires. *Id.* Thus, the present Patent Statute still requires an enabling disclosure in the written description. Notably, however, in some instances, an applicant "need not include in her specification a specific working example in order to comply with the enablement requirement." Donald S. Chisum, *Chisum on Patents*, vol. 3, § 7.05[3], 7-256 (LexisNexis 2001). The level of disclosure required varies depending upon what is necessary to teach the public how to make and use the invention without

not only encompass the mode set forth in the written description, but many other modes as well.⁴⁰ When one reads the embodiment set forth in the specification as “the invention,” the words chosen for the claims lose their paramount importance. Rather than being the carefully chosen metes and bounds of the invention, which they were intended to be, they become hollow molds to be injected with meaning and limitations from the written description. Invariably, this leads to a narrowing of the scope of the claimed invention.

In sum, a patent’s claims define the protected invention. The written description, while enabling the public to practice the invention, generally should not limit or expand the scope of the property right granted by the patent.

B. Canons and Presumptions

Claim construction begins and ends with the language of the claims.⁴¹ The Federal Circuit has admonished courts in construing claims to look first to the language of the claims.⁴² Indeed, claims should be given their plain and ordinary meaning, unless the inventor used terms differently, and that difference is clearly expressed in the patent’s specification or prosecution history.⁴³ What that really means in practice, however, is debatable.

A competing canon of claim construction, recently emphasized by some Federal Circuit panels, holds that claims do not “enlarge what is patented beyond what the inventor has described as the invention.”⁴⁴ Because the plain meaning of claim terms will often capture alternate

any undue experimentation. *PPG Indus. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1564, 37 U.S.P.Q.2d 1618, 1623 (Fed. Cir. 1996).

⁴⁰ *See Zygo Corp. v. Wyko Corp.*, 79 F.3d 1563, 1567-68, 38 U.S.P.Q.2d 1281, 1284 (Fed. Cir. 1996).

⁴¹ *See Bell Commun. Research, Inc. v. Vitalink Commun. Corp.*, 55 F.3d 615, 619-20, 34 U.S.P.Q.2d 1816, 1819 (Fed. Cir. 1995) (stating “the language of the claim defines the scope of the protected invention” and “resort must be had in the first instance to the words of the claim”).

⁴² *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 243 F.3d 1316, 1327, 58 U.S.P.Q.2d 1030, 1039 (Fed. Cir. 2001) (citing *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582, 39 U.S.P.Q.2d 1573, 1576 (Fed. Cir. 1996)).

⁴³ *Nike, Inc. v. Wolverine World Wide, Inc.*, 43 F.3d 644, 646, 33 U.S.P.Q.2d 1038, 1039 (Fed. Cir. 1994).

⁴⁴ *Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1352, 58 U.S.P.Q.2d 1076, 1079 (Fed. Cir. 2001).

embodiments of an invention, this canon seems at odds with the presumption in favor of plain meaning for patent claim terms.

The presumption in favor of the plain meaning of a claim term is well-established.⁴⁵ This non-fact-specific presumption is the long-standing, general rule.⁴⁶ The Federal Circuit recognizes a few exceptions to this general rule: (1) where a “patentee has chosen to be his or her own lexicographer by clearly setting forth an explicit definition” for the disputed term and (2) “where the [claim] term or terms chosen by the patentee so deprive the claim of clarity that there is no means by which the scope of the claim may be ascertained from the language used.”⁴⁷ In addition, the definition of a claim term may also deviate from its ordinary meaning where the patentee has disclaimed or relinquished a broader claim construction in the specification or prosecution history.⁴⁸

Other canons of claim construction also impact the application of plain meaning to patent claim terms. The canon in favor of selecting the narrower of two plausible claim constructions has been used in recent cases to shy away from plain meaning.⁴⁹ For example, in *Multiform Dessicants, Inc. v. Medzam Ltd.*,⁵⁰ the Federal Circuit⁵¹ refused to apply the ordinary meaning of “degradable” and instead chose the narrower of the two constructions proffered by the litigants.⁵² In doing so, the *Multiform* court

⁴⁵ *Johnson Worldwide Assoc. v. Zebco Corp.*, 175 F.3d 985, 989, 50 U.S.P.Q.2d 1607, 1610 (Fed. Cir. 1999).

⁴⁶ *Id.* at 989, 50 U.S.P.Q.2d at 1610; *Renishaw PLC v. Marposs Societa' Per Azioni*, 158 F.3d 1243, 1249, 48 U.S.P.Q.2d 1117, 1121 (Fed. Cir. 1998); *Virginia Panel Corp. v. MAC Panel Co.*, 133 F.3d 860, 864, 45 U.S.P.Q.2d 1225, 1228 (Fed. Cir. 1997); *York Prods., Inc. v. Central Tractor Farm & Fam. Ctr.*, 99 F.3d 1568, 1572, 40 U.S.P.Q.2d 1619, 1622 (Fed. Cir. 1996); *Nike*, 43 F.3d at 646, 33 U.S.P.Q.2d at 1039; *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753, 759, 221 U.S.P.Q.2d 473, 477 (Fed. Cir. 1984).

⁴⁷ *Johnson Worldwide*, 175 F.3d at 990, 50 U.S.P.Q.2d at 1610.

⁴⁸ *See Watts v. XL Sys., Inc.*, 232 F.3d 877, 882, 56 U.S.P.Q.2d 1836, 1839 (Fed. Cir. 2000); *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 979, 52 U.S.P.Q.2d 1109, 1113 (Fed. Cir. 1999).

⁴⁹ *See* Y'Barbo, *supra* n. 10, at 207. Mr. Y'Barbo calls this claim construction approach the “Multiform model” after *Multiform Dessicants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 45 U.S.P.Q.2d 1429 (Fed. Cir. 1998). *See also* Y'Barbo, *supra* n. 10, at 206-207. In this model, the patent owner urges a plain meaning definition from a dictionary only to have the court apply a narrower definition also supported by the specification. *Id.* at 207. Mr. Y'Barbo notes that the “Multiform model may be driven by the Federal Circuit’s growing impatience with poor claim drafting . . . as well as with patent owners” who urge constructions never contemplated at the time of claim prosecution. *Id.* at 212.

⁵⁰ 133 F.3d 1473, 45 U.S.P.Q.2d 1429 (Fed. Cir. 1998).

⁵¹ The *Multiform* panel comprised Judges Newman, Clevenger and Schall.

⁵² *See Multiform*, 133 F.3d at 1478-80, 45 U.S.P.Q.2d at 1433-34.

broke with another canon by referring to the accused product.⁵³ Several other panels have followed the model of applying the narrower of two supported constructions.⁵⁴

Of course, the oft-stated axiom that limitations should not be read in the claims from the embodiments in the specification impacts the application of plain meaning. As explained below, some panels struggle with this rule of construction. The Federal Circuit's guidance is clear: courts may turn to the specification for aid in interpreting claims, but language appearing in the specification may not be read into the claims as limitations.⁵⁵ Nevertheless, as explained below, some panels seem to ignore this rule or create exceptions to it in an apparent effort to get past the plain language and limit the claims to the embodiments disclosed in the written description.

The doctrine of claim differentiation is another claim construction canon, which is often invoked by patentees arguing for a broader meaning to claim terms. The doctrine of claim differentiation holds that a broader scope should be given to a claim that uses a more general term than a dependent claim using a more specific term.⁵⁶ Otherwise, such a dependant claim would be superfluous.⁵⁷

*Dow Chem. Co. v. U.S.*⁵⁸ illustrates the operation of the doctrine of claim differentiation. In *Dow*, the patent-at-issue concerned an improved method for filling abandoned mines in order to prevent the collapse of the overlying land.⁵⁹ Independent claim one recited, *inter alia*, the injection of a mixture "at an injection rate which is sufficiently low,"⁶⁰ and dependent claim four specified the formula by which a minimum injection rate could be

⁵³ See *id.*, 45 U.S.P.Q.2d at 1433-34. Claim construction should be made without reference to the accused product. *Jurgens v. Mckasy*, 927 F.2d 1552, 1560, 18 U.S.P.Q.2d 1031, 1037 (Fed. Cir. 1991).

⁵⁴ See e.g. *O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576, 1584, 42 U.S.P.Q.2d 1777, 1782-83 (Fed. Cir. 1997) (Rich, Mayer & Lourie, JJ.); *Mantech Envtl. Corp. v. Hudson Envtl. Servs., Inc.*, 152 F.3d 1368, 1375, 47 U.S.P.Q.2d 1732, 1738 (Fed. Cir. 1998) (Michel, Clevenger & Schall, JJ.).

⁵⁵ *Renishaw*, 158 F.3d at 1248, 48 U.S.P.Q.2d at 1120; *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 U.S.P.Q.2d 1845, 1850 (Fed. Cir. 1994); *Intervet Am., Inc. v. Kee-Vet Laboratories, Inc.*, 887 F.2d 1050, 1053, 12 U.S.P.Q.2d 1474, 1476 (Fed. Cir. 1989); *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 699, 218 U.S.P.Q.2d 865, 871 (Fed. Cir. 1983).

⁵⁶ See *Dow Chem. Co. v. U.S.*, 226 F.3d 1334, 1341, 56 U.S.P.Q.2d 1014, 1019 (Fed. Cir. 2000).

⁵⁷ *Id.* at 1342, 56 U.S.P.Q.2d at 1020.

⁵⁸ 226 F.3d 1334, 56 U.S.P.Q.2d 1014 (Fed. Cir. 2000).

⁵⁹ *Id.* at 1336, 56 U.S.P.Q.2d at 1016.

⁶⁰ *Id.* at 1338, 56 U.S.P.Q.2d at 1017.

calculated.⁶¹ Applying the doctrine of claim differentiation, the Federal Circuit refused to limit claim one to the formula disclosed in claim 4 and thereby avoided rendering dependent claim four redundant.⁶²

The doctrine of claim differentiation has limited application.⁶³ It is not a “hard and fast” rule of claim construction.⁶⁴ The doctrine only creates a rebuttable presumption that each claim in a patent has a different scope,⁶⁵ and it “cannot be used to overcome the plain language of the claims themselves.”⁶⁶ Indeed, the courts have recognized that “[i]t is not unusual that separate claims may define the invention using different terminology,” especially when the claims in question are independent claims.⁶⁷

II. THE PROPER ROLE OF THE WRITTEN DESCRIPTION IN INTERPRETING CLAIMS

As explained above, the primary role of the written description is to enable the public to practice the invention without undue experimentation.⁶⁸ In addition, the written description should always be consulted when construing claims in order to determine whether the patentee has used claim terms in an idiosyncratic way. This is driven by the oft-cited canon that a patentee may be his own lexicographer.⁶⁹ That is, a patent applicant is entitled to define the terms used in the claims in any manner wished.⁷⁰ The patentee, however, is limited to that definition moving forward.⁷¹

⁶¹ *Id.* at 1339 n. 7, 56 U.S.P.Q.2d at 1017 n. 7.

⁶² *Id.* at 1342, 56 U.S.P.Q.2d at 1019-1020.

⁶³ *Id.* at 1341, 56 U.S.P.Q.2d at 1019 (citing *Multiform*, 133 F.3d at 1480, 45 U.S.P.Q.2d at 1434).

⁶⁴ *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1376, 58 U.S.P.Q.2d 1508, 1513 (Fed. Cir. 2001).

⁶⁵ *Id.*, 58 U.S.P.Q.2d at 1513.

⁶⁶ *Mycogen*, 243 F.3d at 1329, 58 U.S.P.Q.2d at 1040.

⁶⁷ *Id.*, 58 U.S.P.Q.2d at 1040.

⁶⁸ See 35 U.S.C. § 112 (1994); *Enzo Biochem, Inc. v. Calgene, Inc.*, 188 F.3d 1362, 1369, 52 U.S.P.Q.2d 1129, 1134 (Fed. Cir. 1999) (citing *In re Wands*, 858 F.2d 731, 8 U.S.P.Q.2d 1400 (Fed. Cir. 1988)).

⁶⁹ *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582, 39 U.S.P.Q.2d 1573, 1577 (Fed. Cir. 1996).

⁷⁰ *Id.*, 39 U.S.P.Q.2d at 1577.

⁷¹ See *Holman v. Telular Corp.*, 111 F.3d 1578, 1582 (Fed. Cir. 1997) (“The inventors’ definition and explanation of the meaning of [a word], as evidenced by the specification, controls the interpretation of that claim term”).

Moreover, patentees must be careful to avoid providing unintended definitions by implication. One line of Federal Circuit cases has resorted to implied meanings based upon consistent use in the written description. For example, in *Bell Atlantic Network Servs., Inc. v. Covad Commun. Group, Inc.*,⁷² the Federal Circuit⁷³ held that the word “mode” should not be given its ordinary meaning because “mode” was only used in one specific way in the written description.⁷⁴ Although the Federal Circuit paid homage to the “heavy presumption” in favor of ordinary meaning, it found that the patentee’s consistent use of the word “mode” rose to a definition by implication.⁷⁵ This would seem to fly in the face of previous cases holding that the intrinsic evidence must clearly set forth or “clearly redefine a claim term ‘so as to put . . . one reasonably skilled in the art on notice that the patentee intended to . . . redefine the claim term.’”⁷⁶ The *Bell Atlantic* decision also appears at odds with previous decisions holding that the specification must exhibit an “‘express intent to impart a novel’ meaning to the claim term.”⁷⁷

Interestingly, the *Bell Atlantic* court failed to recognize that the manner in which the patentee used the word “mode” was consistent with its ordinary meaning.⁷⁸ Instead, the court limited the meaning of “mode” to a

⁷² 262 F.3d 1258, 59 U.S.P.Q.2d 1865 (Fed. Cir. 2001).

⁷³ The *Bell Atlantic* panel comprised Louri, Plager, and Gajarsa.

⁷⁴ *Id.* at 1273, 59 U.S.P.Q.2d at 1874.

⁷⁵ *Id.* at 1273, 59 U.S.P.Q.2d at 1874.

⁷⁶ *Elektra Instrument S.A. v. O.U.R. Sci. Int’l, Inc.*, 214 F.3d 1302, 1307, 54 U.S.P.Q.2d 1910, 1913 (Fed. Cir. 2000).

⁷⁷ *Schering Corp. v. Amgen, Inc.*, 222 F.3d 1347, 1353, 55 U.S.P.Q.2d 1650, 1654 (Fed. Cir. 2000) (quoting *York Prods., Inc. v. Central Tractor Farm & Fam. Ctr.*, 99 F.3d 1568, 1572, 40 U.S.P.Q.2d 1619, 1622 (Fed. Cir. 1996)); *Optical Disc Corp. v. Del Mar Avionics*, 208 F.3d 1324, 1334, 54 U.S.P.Q.2d 1289, 1295 (Fed. Cir. 2000). The Federal Circuit overcame this seemingly weighty test by holding that “a claim term may be clearly redefined without an explicit statement of redefinition” if the patentee redefines the term by implication. *Bell Atlantic*, 262 F.3d at 1268, 59 U.S.P.Q.2d at 1870.

⁷⁸ *Bell Atlantic* argued that “mode” meant an “operational state.” *Bell Atlantic*, 262 F.3d at 1268, 59 U.S.P.Q.2d at 1871. Under *Bell Atlantic*’s definition, a claim directed to a “plurality of different modes” would encompass a system using a plurality of different data rates. *Id.* at 1269, 59 U.S.P.Q.2d at 1871. The Federal Circuit recognized that the ordinary meaning of “mode” was broad enough to encompass this definition, but went on to state that “the ordinary meaning of the non-technical term ‘mode’ is sufficiently broad and amorphous that the scope of the claim language can be reconciled only with recourse to the written description.” *Id.* at 1269-1270, 59 U.S.P.Q.2d at 1872. The Federal Circuit then found that the patentee used “rate” and “mode” in a mutually exclusive manner throughout the patent, thereby precluding an operational state with a different data rate from being a different mode. *Id.* at 1272, 59 U.S.P.Q.2d at 1874.

narrower meaning that would appear to fall within the boundaries of the ordinary meaning.⁷⁹

A patent's written description can also aid a court in understanding the technology and the invention as a whole.⁸⁰ Indeed, the written description is the primary aid outside of the claim language for ascertaining the invention.⁸¹ As explained above, courts may turn to the specification for aid in interpreting claims, but language appearing in the specification may not be read into the claims as limitations.⁸² Claims, however, are not to be limited to the embodiments described in the specification.⁸³ Moreover, if a preferred embodiment is set forth in a patent, the claims should not be construed to cover only the preferred embodiment.⁸⁴

*S3, Inc. v. nVIDIA Corp.*⁸⁵ provides a good example of how a written description can assist a court in interpreting claims by providing insight into the invention. In *S3*, the Federal Circuit considered a patent directed to an integrated circuit for use in controlling computer video displays.⁸⁶ The invention includes a video controller that emits two kinds of information, one of which goes directly to a digital-to-analog converter (“DAC”) for display (“video display information”) and one of which goes to look up table before proceeding to the DAC (“video information data”).⁸⁷ At issue was whether

⁷⁹ See *id.*, 59 U.S.P.Q.2d at 1874. This case appears to be another example of a panel erroneously bypassing the plain meaning doctrine and masquerading it as a “patentee as his own lexicographer” case.

⁸⁰ *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 1380, 54 U.S.P.Q.2d 1086, 1089 (Fed. Cir. 2000).

⁸¹ See *Vitronics*, 90 F.3d at 1582, 39 U.S.P.Q.2d at 1577.

⁸² *Renishaw PLC v. Marposs Societa' Per Azioni*, 158 F.3d 1243, 1248, 48 U.S.P.Q.2d 1117, 1120 (Fed. Cir. 1998); *In re Donaldson*, 16 F.3d at 1195, 29 U.S.P.Q.2d at 1850; *Intervet Am., Inc. v. Kee-Vet Laboratoires, Inc.*, 887 F.2d 1050, 1053, 12 U.S.P.Q.2d 1474, 1476; *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 699, 218 U.S.P.Q.2d 865, 871 (Fed. Cir. 1983).

⁸³ See *Sjolund v. Musland*, 847 F.2d 1573, 1582, 6 U.S.P.Q.2d 2020, 2027 (Fed. Cir. 1988) (“[T]he general principle is that limitations from the specification are not to be read into the claims”); Donald S. Chisum, *Chisum on Patents* vol. 5A, §18.04[1][a][i] (Matthew Bender, Inc. 1999) (“[T]he scope of the claim is not to be limited to the specific embodiment or ‘best mode’ described by the patentee”). However, as will be explained *infra* a claim may be limited to the *invention* disclosed in the patent so long as the limitation does not conflict with the plain meaning of the claims. See *Rhine v. Casio, Inc.*, 183 F.3d 1342, 1345, 51 U.S.P.Q.2d 1377, 1379 (Fed. Cir. 1999) (emphasis added).

⁸⁴ *Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855, 865, 9 U.S.P.Q.2d 1289, 1299 (Fed. Cir. 1988).

⁸⁵ 259 F.3d 1364, 59 U.S.P.Q.2d 1745 (Fed. Cir. 2001).

⁸⁶ *Id.* at 1366, 59 U.S.P.Q.2d at 1745.

⁸⁷ *Id.* at 1366, 59 U.S.P.Q.2d at 1746.

the claim terms “video information data stream” and “video display information data stream” rendered certain claims indefinite.⁸⁸ The District Court for the Northern District of California construed the claims to be indefinite under section 112 paragraph 2⁸⁹ because “it [was] not apparent [from the claim itself] whether a particular ‘video information stream’ would contain ‘video information,’ ‘video display information,’ or both.”⁹⁰

However, the Federal Circuit elucidated that the “purpose of [the] claims is not to explain the technology or how it works, but to state the legal boundaries of the patent grant.”⁹¹ The *S3* court also stated that claims must be “read in conjunction with the rest of the specification” when determining whether they comport with section 112.⁹² Accordingly, when the Federal Circuit concluded that “a person skilled in the art would understand the meaning and scope of the data streams as set forth in the claims” based on the disclosure in the written description, it reversed the district court’s holding.⁹³

*Wang Laboratories, Inc. v. America Online, Inc.*⁹⁴ illustrates how claim validity can be preserved with the aid of the written description. *Wang* dealt with a patent directed to an apparatus for retrieving “frames” of information from a network database and processing those frames locally.⁹⁵ At issue was whether the claimed inventions included “frames” processed by bit-mapped protocols as well as those processed by character-based protocols.⁹⁶

At trial, the District Court for the Eastern District of Virginia found that only those systems with “frames” that are processed by character-based protocols fell within the claims.⁹⁷ The Federal Circuit agreed.⁹⁸ In order to justify its narrow construction of “frames,” the Federal Circuit relied in part upon the principle that claims should be interpreted to preserve their validity when reasonably amenable to more than one construction.⁹⁹ The Federal

⁸⁸ *Id.* at 1368, 59 U.S.P.Q.2d at 1747.

⁸⁹ *Id.* at 1367, 59 U.S.P.Q.2d at 1746.

⁹⁰ *Id.* at 1368, 59 U.S.P.Q.2d at 1747.

⁹¹ *Id.* at 1369, 59 U.S.P.Q.2d at 1748.

⁹² *Id.* at 1367, 59 U.S.P.Q.2d at 1747.

⁹³ *Id.* at 1370-71, 59 U.S.P.Q.2d at 1749.

⁹⁴ 197 F.3d 1377, 53 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

⁹⁵ *Id.* at 1379, 53 U.S.P.Q.2d at 1162.

⁹⁶ *Id.* at 1380, 53 U.S.P.Q.2d at 1163.

⁹⁷ *Id.*, 53 U.S.P.Q.2d at 1163.

⁹⁸ *Id.* at 1381, 53 U.S.P.Q.2d at 1163.

⁹⁹ *Id.* at 1383, 53 U.S.P.Q.2d at 1165.

Circuit subsequently turned to the embodiment in the written description to craft a narrower meaning that preserved validity—unfortunately for Wang, however, the narrower meaning precluded infringement.¹⁰⁰

The *Wang* case, though illustrative of a valid principle, *i.e.*, that claims should be construed to preserve their validity when possible, also seems to show how a rule can be stretched too far. In *Wang*, the Federal Circuit appears to ignore that this doctrine should not be used to overcome the plain meaning of the claims.¹⁰¹ Indeed, the Federal Circuit employed this “preservation of validity” argument despite the fact that it all but admitted that the plain meaning of the term “frame” encompasses bit-mapped systems as well as character based systems.¹⁰² As explained below, this case, like *Bell Atlantic*, serves as yet another example of a panel improperly evading the plain meaning rule.¹⁰³

III. PANEL-SPECIFIC FEDERAL CIRCUIT INCONSISTENCIES

Recent Federal Circuit cases show a manifest disregard for the presumption in favor of plain meaning or a misapplication of that presumption. The cases discussed below highlight the problem.

A. Cases Ignoring the Plain Meaning

1. *Toro v. White Consolidated Indus., Inc.*

In *Toro Co. v. White Consolidated Indus.*,¹⁰⁴ the Federal Circuit¹⁰⁵ reversed the District Court for the District of Minnesota’s grant of summary judgment of literal infringement¹⁰⁶ based on the interpretation of the word “including.”¹⁰⁷ The technology at issue in *Toro* was a multi-purpose device

¹⁰⁰ *Id.* at 1386, 53 U.S.P.Q.2d at 1167.

¹⁰¹ *See Rhine*, 183 F.3d at 1345, 51 U.S.P.Q.2d at 1379.

¹⁰² *Wang*, 197 F.3d at 1383, 53 U.S.P.Q.2d at 1165.

¹⁰³ The *Wang* holding relied only in part upon the “preservation of validity” principle. *Id.* at 1383, 53 U.S.P.Q.2d at 1165. The same holding could have been reached on alternative grounds, *e.g.* prosecution history estoppel.

¹⁰⁴ 199 F.3d 1295, 53 U.S.P.Q.2d 1065 (Fed. Cir. 1999).

¹⁰⁵ The *Toro* panel comprised Judges Newman, Friedman and Rader, who dissented.

¹⁰⁶ *Id.* at 1297, 53 U.S.P.Q.2d at 1066.

¹⁰⁷ *Id.* at 1302, 53 U.S.P.Q.2d at 1070.

that could be used as a blower and a vacuum.¹⁰⁸ In the device claimed in Toro's patent, air velocity is adjusted by a cover fitted with a ring that restricts the size of the air inlet in the blower mode, thereby increasing the air pressure.¹⁰⁹ In the embodiment shown in the written description, the restriction ring is permanently attached to a cover, which the user can place over the air inlet while operating in the blower mode.¹¹⁰

The *Toro* defendant argued that the accused device did not infringe because its cover and restriction ring were two separate pieces.¹¹¹ The claim limitation at issue was "said cover including means for increasing the pressure" developed by the blower.¹¹² The district court determined that "the term 'including,' correctly construed, 'suggests the containment of something as a component or subordinate part of a larger whole,' and comprehends a separate restriction ring that is not part of the cover but is separately inserted and removed."¹¹³

On appeal, despite reciting the rule that "words in a patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning,"¹¹⁴ the *Toro* court failed to apply the plain meaning of the word "including," even after recognizing that the written description did not attribute a special meaning to that word.¹¹⁵ Instead, the *Toro* court focused on the written description and concluded that the only embodiment shown was a cover having a restriction ring permanently attached.¹¹⁶

Had the *Toro* court faithfully applied the presumption in favor of plain meaning and followed the rule that it recited, the district court's decision would have been affirmed. Indeed, Judge Rader takes issue with the majority decision in his dissent by arguing that "[i]t is axiomatic that terms in a claim must be given their ordinary meaning unless it is apparent that the inventor used them differently in the patent."¹¹⁷ In Judge Rader's view, "the court's interpretation of 'including' cannot be justified by

¹⁰⁸ *Id.* at 1297, 53 U.S.P.Q.2d at 1066.

¹⁰⁹ *Id.* at 1297-98, 53 U.S.P.Q.2d at 1066.

¹¹⁰ *Id.* at 1297-98, 53 U.S.P.Q.2d at 1066.

¹¹¹ *Id.* at 1300, 53 U.S.P.Q.2d at 1068-69.

¹¹² *Id.* at 1298, 53 U.S.P.Q.2d at 1067.

¹¹³ *Id.* at 1300, 53 U.S.P.Q.2d at 1069.

¹¹⁴ *Id.* at 1299, 53 U.S.P.Q.2d at 1067 (citing *Multiform*, 133 F.3d at 1477, 45 U.S.P.Q.2d at 1432).

¹¹⁵ *Id.* at 1302, 53 U.S.P.Q.2d at 1070.

¹¹⁶ *Id.* at 1303, 53 U.S.P.Q.2d at 1071 (Rader, J., dissenting).

¹¹⁷ *Id.* at 1302, 53 U.S.P.Q.2d at 1070 (Rader, J., dissenting).

examination of the ordinary meaning of that word or of its accepted use in patent claims, or, especially, by a careful reading of [U.S. Patent No. 4,694,528 assigned to Toro].”¹¹⁸

2. *Wang Laboratories, Inc. v. America Online, Inc.*

In *Wang Laboratories, Inc. v. America Online, Inc.*,¹¹⁹ the plaintiff alleged that the defendants’ on-line systems infringed its patent because they used a bit-mapped protocol to provide data frames for display on user computer terminals.¹²⁰ Considering the plain meaning of the word “frame,” the systems of defendants AOL and Netscape could be found to literally infringe the asserted claims. The District Court for the Eastern District of Virginia, however, interpreted the word “frame” to be limited to a frame of data comprised of data in a character-based protocol¹²¹ as opposed to a bit-mapped frame, even though the parties agreed that “frame” can be applied to bit-mapped as well as character-based protocol systems in general usage.¹²²

On appeal, Wang argued that the narrow definition of the word “frame” adopted by the district court was not warranted by the specification or prosecution history.¹²³ Indeed, the agreement of the parties regarding the general definition of “frame” would suggest that the broader definition is exactly how one skilled in the art would understand the term. The Federal Circuit,¹²⁴ however, affirmed the district court’s narrow definition by agreeing that the “only system that is described and enabled in the . . . specification and drawings uses a character-based protocol.”¹²⁵ The *Wang* court found that a broader interpretation would render the claims invalid for

¹¹⁸ One commentator observes that the majority failed to appreciate the specification by misunderstanding the patent’s description of the advantageous nature of having the ring automatically removed and inserted by virtue of attachment to the cover. C. Douglas Thomas, *The Toro Company v. White Consolidated Industries, Inc.*, 16 Santa Clara Computer & High Tech. L.J. 479, 485-86 (2000). The actual language of the patent uses the word “also” to set off this advantage, which is often used by practitioners to indicate that the feature is optional and not mandatory to the invention. *Id.*

¹¹⁹ 197 F.3d 1377, 53 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

¹²⁰ *Wang*, 197 F.3d at 1379, 53 U.S.P.Q.2d at 1162.

¹²¹ *Id.* at 1381, 53 U.S.P.Q.2d at 1163.

¹²² *Id.*, 53 U.S.P.Q.2d at 1163.

¹²³ *Id.*, 53 U.S.P.Q.2d at 1163.

¹²⁴ The *Wang* panel comprised Judges Newman, Mayer and Gajarsa.

¹²⁵ *Wang*, 197 F.3d at 1382, 53 U.S.P.Q.2d at 1164.

failure to comply with the requirements of 35 U.S.C. Section 112.¹²⁶ The court's reasoning on this point seems directly at odds with previous pronouncements that the doctrine of "preserving the validity" should not be used to overcome the plain meaning of claims.¹²⁷

Even more troubling is the *Wang* court's recognition that the state of the art included bit-mapped protocols as evidenced by references to such protocols in the specification.¹²⁸ If the enablement requirement only requires one illustrative embodiment to be given in the written description,¹²⁹ how then can a claim be rendered invalid for lack of enablement if it is construed to include well-known protocols specifically mentioned in the written description?

3. *Netword, LLC v. Centraal Corp.*

In *Netword, LLC v. Centraal Corp.*,¹³⁰ the patent at issue claimed a system for locating and retrieving information on a distributed system or network, such as the Internet, using "aliases" to denote resources whose retrieval is sought.¹³¹ Netword asserted claim one of their U.S. Patent No. 5,764,906 against Centraal.¹³² The specific claim language at issue was the phrase "one or more local server computers." The District Court for the Eastern District of Virginia construed the phrase to be directed to a system wherein "the local server computer maintains a 'cache' or limited database of aliases, and 'pulls' information when needed from the central registry computer."¹³³ Netword argued that the district court impermissibly imported limitations into claim one from the specification, and that the functions of "caching" and "pulling" by the local server are not required.¹³⁴

The Federal Circuit¹³⁵ affirmed the district court's construction¹³⁶ despite the fact that, as pointed out in Judge Clevenger's dissent, the claim at

¹²⁶ *Id.* at 1383, 53 U.S.P.Q.2d at 1165.

¹²⁷ *Rhine*, 183 F.3d at 1345, 51 U.S.P.Q.2d at 1379.

¹²⁸ *Wang*, 197 F.3d at 1382, 53 U.S.P.Q.2d at 1164.

¹²⁹ Harmon, *supra* n. 39, at 171.

¹³⁰ 242 F.3d 1347, 58 U.S.P.Q.2d 1076 (Fed. Cir. 2001).

¹³¹ *Netword*, 242 F.3d at 1351, 58 U.S.P.Q.2d at 1078.

¹³² *Id.* at 1350, 58 U.S.P.Q.2d at 1077.

¹³³ *Id.* at 1351, 58 U.S.P.Q.2d at 1078.

¹³⁴ *Id.*, 58 U.S.P.Q.2d at 1078.

¹³⁵ The *Netword* panel comprised Judges Newman, Archer and Clevenger, dissenting.

¹³⁶ *Netword*, 242 F.3d at 1353, 58 U.S.P.Q.2d at 1080.

issue “on its face does not restrict a local server computer to a limited database of aliases, and which does not specify the manner in which a local server receives the database of aliases that it maintains”¹³⁷ and “nothing in the specification or the file history . . . requires [the limitations imposed by the majority].”¹³⁸ Instead of relying on the plain meaning of the claim language, the *Netword* court relied heavily on language found in the specification and prosecution history to support the district court’s narrow construction.¹³⁹ Indeed, the *Netword* court failed to even acknowledge the existence of a presumption in favor of the plain meaning and ruled that “[t]he 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.”¹⁴⁰ The court went on to essentially read the preferred embodiment into the claims without any discussion of the plain meaning of the disputed claim terms. This appears to be a judicial retreat to the original Patent Act’s reliance on the written description for definition of the patent monopoly.¹⁴¹ Moreover, this logic contradicts the *Netword* court’s own recognition that “the specification need not present every embodiment or permutation of the invention and the claims are not limited to the preferred embodiment of the invention.”¹⁴²

B. Recent Cases Employing the Presumption in Favor of Plain Meaning

1. Interactive Gift Express, Inc. v. Compuserve, Inc.

In *Interactive Gift Express, Inc. v. Compuserve, Inc.*,¹⁴³ the patent at issue concerned a system directed toward reproducing information in material objects, e.g., tapes, compact disks, books, etc., at point of sale locations, as opposed to at central manufacturing facilities.¹⁴⁴ At issue in *Interactive Gift Express* (“IGE”) were five claim limitations: “point of sale

¹³⁷ *Id.* at 1357, 58 U.S.P.Q.2d at 1083.

¹³⁸ *Id.* at 1357, 58 U.S.P.Q.2d at 1083 (emphasis in original).

¹³⁹ *Id.* at 1352, 58 U.S.P.Q.2d at 1079.

¹⁴⁰ *Id.*, 58 U.S.P.Q.2d at 1079.

¹⁴¹ See *supra* pt. I(A)(1).

¹⁴² *Netword*, 242 F.3d at 1352, 58 U.S.P.Q.2d at 1079.

¹⁴³ 256 F.3d 1323, 59 U.S.P.Q.2d 1401 (Fed. Cir. 2001).

¹⁴⁴ *IGE*, 256 F.3d at 1327, 59 U.S.P.Q.2d 1404.

location,” “material object,” “information manufacturing machine,” “authorization code,” and “real-time transactions.”¹⁴⁵ Upon review of IGE’s binding claim construction report and the parties’ claim construction briefs, the District Court for the Southern District of California rendered an opinion and order construing the disputed claim terms.¹⁴⁶ As a result, the parties entered into a Stipulated Order and Judgment, in which IGE conceded non-infringement of its claims as construed by the district court.¹⁴⁷

On appeal, the Federal Circuit¹⁴⁸ evaluated each disputed claim term by analyzing the claim language itself.¹⁴⁹ In recognition of the presumption in favor of plain meaning, the *IGE* court noted that “[i]f the claim language is clear on its face, then . . . consideration of the rest of the intrinsic evidence is restricted to determining if a deviation from the clear language of the claims is specified.”¹⁵⁰ The *IGE* court also noted, however, that reviewing the specification to determine if such a deviation has occurred is necessary even if the language of the claims is plain.¹⁵¹

With these rules in mind, the *IGE* court vacated and remanded the district court’s order because it found that the district court had erred in construing at least one aspect of each of the disputed claim limitations.¹⁵² More particularly, the *IGE* court determined that the district court had, in many instances, impermissibly imported limitations from the written description that were not required by the claim language and not dictated by the specification or prosecution.¹⁵³

¹⁴⁵ *Id.* at 1329, 59 U.S.P.Q.2d at 1405.

¹⁴⁶ *Id.* at 1330, 59 U.S.P.Q.2d at 1406.

¹⁴⁷ *Id.*, 59 U.S.P.Q.2d at 1406.

¹⁴⁸ The *IGE* panel comprised Judges Mayer, Newman, Michel, Lourie, Rader, Schall, Bryson, Gajarsa and Linn.

¹⁴⁹ *IGE*, 256 F.3d at 1331, 59 U.S.P.Q.2d 1406-07.

¹⁵⁰ *Id.*, 59 U.S.P.Q.2d 1407.

¹⁵¹ *Id.*, 59 U.S.P.Q.2d 1407.

¹⁵² *Id.* at 1349, 59 U.S.P.Q.2d at 1421.

¹⁵³ For example, the district court held that certain components of the information manufacturing machine must contain certain detailed attributes. *Id.* at 1340, 59 U.S.P.Q.2d at 1413. The *IGE* court, however, found no support for these limitations in the independent claims or the specification. Accordingly, the *IGE* court determined that the district court erred by impermissibly reading limitations into the claims. *Id.*, 59 U.S.P.Q.2d at 1413-14.

2. *Gart v. Logitech, Inc.*

In *Gart v. Logitech, Inc.*,¹⁵⁴ the technology of the asserted claim concerned a computer mouse that is ergonomically shaped to reduce muscle fatigue.¹⁵⁵ The claim calls for, *inter alia*, an “angular medial surface” that supports three fingers (the middle, ring, and little fingers) in a wrapped configuration.¹⁵⁶ The District Court for the Central District of California construed an “angular medial surface” to require the presence of an angular “ledge” and a surface over that ledge supporting the three fingers in an enclosed position.¹⁵⁷ Though somewhat unclear, the district court may have also required that the “ledge” include a concave depression or curved undercut area.¹⁵⁸

In support of the district court’s construction, the defendant argued that the court should look to the patent’s drawings, written description, and file history to properly interpret the structure defined by the claim.¹⁵⁹ The Federal Circuit¹⁶⁰ acknowledged that the specification and prosecution history should be consulted to construe the claims “to determine if the patentee has chosen to be his own lexicographer . . . or when the language itself lacks sufficient clarity such that there is no means by which the scope of the claim may be ascertained from the language used.”¹⁶¹ The *Gart* court further noted, however, that “when the foregoing circumstances are not present, we follow the general rule that terms in the claim are to be given their ordinary and accustomed meaning.”¹⁶² Stated differently, “a court must presume that the terms in the claim mean what they say, and, unless otherwise compelled, give full effect to the ordinary and accustomed meaning of the claim terms.”¹⁶³

Implementing this general rule, the *Gart* court determined that the patent did “not attribute a special meaning to the phrase ‘angular medial surface,’ and [that] there were no express representations made in obtaining

¹⁵⁴ 254 F.3d 1334, 59 U.S.P.Q.2d 1290 (Fed. Cir. 2001).

¹⁵⁵ *Gart*, 254 F.3d at 1337, 59 U.S.P.Q.2d at 1291.

¹⁵⁶ *Id.*, 59 U.S.P.Q.2d at 1291.

¹⁵⁷ *Id.* at 1340, 59 U.S.P.Q.2d at 1294.

¹⁵⁸ *Id.* at 1340, 59 U.S.P.Q.2d at 1294.

¹⁵⁹ *Id.* at 1340-41, 59 U.S.P.Q.2d at 1294.

¹⁶⁰ The *Gart* panel comprised Judges Lourie, Rader and Linn.

¹⁶¹ *Gart*, 254 F.3d at 1341, 59 U.S.P.Q.2d at 1294-95.

¹⁶² *Id.*, 59 U.S.P.Q.2d at 1295.

¹⁶³ *Id.*, 59 U.S.P.Q.2d at 1295.

the patent regarding the scope and meaning of the claim terms.¹⁶⁴ Accordingly, having found that the claim's scope could "be ascertained from the plain language of that claim,"¹⁶⁵ the *Gart* court concluded that the claim construction used by the district court would "improperly add a limitation appearing in the specification and the drawings, but not appearing in the unambiguous language of the claim."¹⁶⁶

IV. GETTING IT RIGHT—PRESERVING AND APPLYING THE PRESUMPTION IN FAVOR OF PLAIN MEANING

Because patent claims provide public notice and further define the metes and bounds of the rights available through the patent grant, claim language should be given paramount importance. Refusing to apply the plain and ordinary meaning to simple terms such as "mode," "calculating," and "including" is at odds with this fundamental principle.

Uniform application of the test articulated in *Johnson Worldwide Assoc. v. Zebco Corp.*¹⁶⁷ would protect the paramount role of patent claims.¹⁶⁸ In *Johnson Worldwide*, the Federal Circuit began their analysis with the general rule that "terms in the claim are to be given their ordinary and accustomed meaning."¹⁶⁹ The court found, however, that the presumption of ordinary meaning could be overcome if two conditions were present.¹⁷⁰ First, if the patentee has chosen to be his own lexicographer.¹⁷¹ Second, if application of the ordinary meaning of a term deprives the claim of clarity such that the claim scope cannot be ascertained from the language used.¹⁷²

Under the first exception, the plain and ordinary meaning of a term would be trumped if the patentee provides a different definition in the intrinsic record. It is only fair to hold the patentee to express definitions provided. It is dangerous, however, for courts to read into the claims an "implied" definition from the written description, especially where it is

¹⁶⁴ *Id.* at 1342, 59 U.S.P.Q.2d at 1296.

¹⁶⁵ *Id.*, 59 U.S.P.Q.2d at 1296.

¹⁶⁶ *Id.* at 1342-43, 59 U.S.P.Q.2d at 1296.

¹⁶⁷ 175 F.3d 985, 50 U.S.P.Q.2d 1607 (Fed. Cir. 1999).

¹⁶⁸ Of course, if the applicant disavowed the plain meaning of a term during prosecution, then applicant will be estopped from subsequently asserting that disavowed meaning regardless of whether it is plain.

¹⁶⁹ *Johnson Worldwide*, 175 F.3d at 989, 50 U.S.P.Q.2d at 1610.

¹⁷⁰ *Id.* at 990, 50 U.S.P.Q.2d at 1610.

¹⁷¹ *Id.*, 50 U.S.P.Q.2d at 1610.

¹⁷² *Id.*, 50 U.S.P.Q.2d at 1610.

merely a narrower definition that is subsumed within the ordinary meaning.¹⁷³ In other words, in order for this exception to apply, the patentee must “express [an] intent to impart a novel meaning.”¹⁷⁴ This should be more than an “implied” intent. Otherwise, a patentee’s consistent use of a word in the written description may be taken as a redefinition even though no such redefinition was intended. For example, suppose a patent uses the word “connection” in its claims. What if the written description only uses the word “connection” in conjunction with describing hard-wired connections between various parts of a device? Should “connection” be construed to exclude logic connections such as those made by software? No. The pernicious result of applying the “implied meaning” logic of cases like *Bell Atlantic* is reading unintended limitations into the claims from the written description. Thus, this logic runs afoul of long-standing Federal Circuit claim construction principles.

Under the second exception, the plain meaning is trumped if the claim term deprives the claim of clarity such that there is no means by which the scope of the claim may be ascertained from the language used.¹⁷⁵ Under this exception, a court should look past the claim language if the claim language is unclear.¹⁷⁶ Stated alternatively, this exception applies where a claim term does not have a meaning to one of skill in the art.¹⁷⁷ Thus, the second exception really poses the question whether there is a plain and ordinary meaning to begin with. Had the *Wang* court followed the parameters of this exception, it likely would have applied the plain meaning of “frame.”

The second exception seems better suited for claims containing technical terms where the plain meaning is not readily ascertainable. For

¹⁷³ For example, the *Bell Atlantic* court’s decision to limit “mode” to exclude “rate” was not a decision to apply a meaning that contradicts the ordinary meaning. Indeed, the *Bell Atlantic* court recognized that under its definition “mode” would encompass different communication protocols. *Bell Atlantic Network Servs., Inc. v. Covad Commun. Group, Inc.*, 262 F.3d 1258, 1272-73, 59 U.S.P.Q.2d 1865, 1873 (Fed. Cir. 2001).

¹⁷⁴ *Optical Disc Corp. v. Del Mar Avionics*, 208 F.3d 1324, 1334, 54 U.S.P.Q.2d 1289, 1295 (Fed. Cir. 2000).

¹⁷⁵ *Johnson Worldwide*, 175 F.3d at 990, 50 U.S.P.Q.2d at 1610.

¹⁷⁶ *Id.*, 50 U.S.P.Q.2d at 1610 (citing *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1554, 42 U.S.P.Q.2d 1737, 1741 (Fed. Cir. 1997), *overruled on other grounds*, *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 46 U.S.P.Q.2d 1169 (Fed. Cir. 1998) (en banc)).

¹⁷⁷ *J.T. Eaton & Co., Inc. v. Atlantic Paste & Glue Co.*, 106 F.3d 1563, 1568, 41 U.S.P.Q.2d 1641, 1645 (Fed. Cir. 1997) (meaning of a term with no previous meaning to those of ordinary skill in the art must be found elsewhere in the patent).

example, in *North American Vaccine, Inc. v. American Cyanamid Co.*,¹⁷⁸ the Federal Circuit found that “linkage to a terminal portion of the polysaccharide” did not convey a plain meaning.¹⁷⁹ The court focused on the usage of “linkage” and “terminal” in conjunction with “polysaccharide” in the written description to determine that this claim limitation could only be referring to a single terminal.¹⁸⁰ In other words, in absence of plain meaning, the court sought other intrinsic evidence to determine the meaning of the recited claim language. Because no readily apparent plain meaning to the combination of technical terms used was apparent, the Federal Circuit’s reliance on the written description was the only proper course. Thus, the second exception appears particularly well suited for complex technical terms.

The second exception, however, can be misapplied. For instance, in the *Transonic Sys., Inc. v. Non-Invasive Medical Techs. Corp.*,¹⁸¹ the terms “determining” and “calculating” appear to have a plain meaning. Nevertheless, the Federal Circuit held that “determining” and “calculating” were limited to the specific formulas shown in the written description.¹⁸² Rather than defining a term that did not have a plain meaning, the *Transonic* court appears to have simply limited well-known terms to the specific embodiments shown in the written description because it concluded that there was no plain meaning in the context of the claims. In short, a court can invoke the second exception by finding that a claim term does not have a plain meaning in the context of the claim. Thus, the potential misapplication of the second exception lies in the quasi-factual dispute it raises over the existence of a plain meaning for a term. The potential misapplication of the second exception, however, does not warrant narrowing or discarding of the exception. As explained above, the second exception is far too valuable in the context of complex technical terms.

CONCLUSION

This article recommends that all Federal Circuit panels uniformly apply presumptions in favor of plain meaning to patent claims and resist finding exceptions where none are warranted. Uniform application of the presumption in favor of plain meaning preserves the paramount role of patent

¹⁷⁸ 7 F.3d 1571, 28 U.S.P.Q.2d 1333 (Fed. Cir. 1993).

¹⁷⁹ *North American Vaccine*, 7 F.3d at 1576, 28 U.S.P.Q.2d at 1336.

¹⁸⁰ *Id.* at 1577, 28 U.S.P.Q.2d at 1337-38.

¹⁸¹ 2001 WL 585143 (Fed. Cir. 2001).

¹⁸² *Transonic Systems*, 2001 WL 585143 at **5-6.

claims in our system and better effectuates the Patent Act. Such uniform application reaffirms the notice function of patent claims and removes a great degree of uncertainty from the claim interpretation process.