CONSTRUING CLAIMS BEFORE AND AFTER *PHILLIPS*: WHAT'S OLD IS NEW AGAIN

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{***Note:** The materials in this packet have been extensively edited and reformatted, and punctuation has been added throughout. Some citations and footnotes have been removed without notice. Other deletions are indicated by ellipses. Judges who heard the cases are indicated, with the opinion's author underlined. All **bold** emphasis is my own. My comments are italicized and in brackets.—MAP*}

STATUTES

35 U.S.C. § 112 ¶¶ 1 & 2, (1952)

{*The relationship between these two paragraphs is the essence of the debate on claim construction. The key to the debate, is the proper weight to give to the first paragraph's mention of the written description of "the invention." - MAP*}.

The specification
shall contain
a written description
of the **invention**, and
of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art
to which it pertains, or
with which it is most nearly connected,
to make and use the same …

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**.

VITRONICS: THE "CLASSIC" FORMULATION

***Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996)** (Michel, Lourie, and Friedman)

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In determining the proper construction of a claim, the court has numerous sources that it may properly utilize for guidance. These sources have been detailed in our previous opinions, as discussed below, and include both

- intrinsic evidence (e.g., the patent specification and file history) and
- extrinsic evidence (e.g., expert testimony).

[Intrinsic Evidence]

It is well-settled that, in interpreting an asserted claim, the court should look first to the **intrinsic** evidence of record, i.e., the patent itself, including the claims, the specification and, if in evidence, the prosecution history. *See Markman* [*v. Westview Instruments*], 52 F.3d [967,] 979, [(Fed Cir. 1995) (en banc)]. Such intrinsic evidence is the **most significant source** of the legally operative meaning of disputed claim language.

First, we look to the words of the **claims** themselves, both asserted and nonasserted, to define the scope of the patented invention. Although words in a claim are generally given their ordinary and customary meaning, a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history.

Thus, **second**, it is always necessary to review the **specification** to determine whether the inventor has used any terms in a manner **inconsistent** with their ordinary meaning**.** The specification acts as a dictionary when

- it **expressly** defines terms used in the claims or
- when it defines terms by **implication**.

As we have repeatedly stated,

"[c]laims must be read in view of the specification, of which they are a part."

Markman, 52 F.3d at 967. The specification contains a written description of the invention which must be clear and complete enough to enable those of ordinary skill in the art to make and use it. Thus, the specification is always highly relevant to the claim construction analysis. Usually, it is **dispositive**; it is the single best guide to the meaning of a disputed term.

Third, the court may also consider the **prosecution history** of the patent, if in evidence. This history contains the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims. As such, the record before the Patent and Trademark Office is often of critical significance in determining the meaning of the claims. Included within an analysis of the file history may be an examination of the prior art cited therein.

[Extrinsic Evidence: When Considered]

In most situations, an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term. In such circumstances, it is improper to rely on extrinsic evidence. In those cases where the public record **unambiguously** describes the scope of the patented invention, reliance on any extrinsic evidence is **improper.** The claims, specification, and file history, rather than extrinsic evidence, constitute the public record of the

patentee's claim, a record on which the public is entitled to rely. In other words, competitors are entitled

- to review the public record,
- apply the established rules of claim construction,
- ascertain the scope of the patentee's claimed invention and, thus,
- design around the claimed invention.

Allowing the public record to be altered or changed by extrinsic evidence introduced at trial, such as expert testimony, would make this right meaningless. The same holds true whether it is the patentee or the alleged infringer who seeks to alter the scope of the claims….

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Here, the trial judge considered not only the specification, but also expert testimony and other extrinsic evidence, such as the paper written by the former Vitronics employee. No doubt there will be instances in which intrinsic evidence is insufficient to enable the court to determine the meaning of the asserted claims, and in those instances, extrinsic evidence, such as that relied on by the district court, may also properly be relied on to understand the technology and to construe the claims. Extrinsic evidence is that evidence which is external to the patent and file history, such as

- expert testimony,
- inventor testimony,
- dictionaries, and
- technical treatises and articles. [FN 6]

[FN 6] Although technical treatises and **dictionaries** fall within the category of extrinsic evidence, as they do not form a part of an integrated patent document, they are worthy of special note. Judges are **free to consult** such resources at **any** time in order to better understand the underlying technology and may also rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents.

However, as we have recently re-emphasized, extrinsic evidence in general, and expert testimony in particular, may be used only to help the court come to the proper understanding of the claims; it may not be used to **vary or contradict** the claim language. Nor may it contradict the import of other parts of the specification. Indeed, where the patent documents are unambiguous, expert testimony regarding the meaning of a claim is entitled to no weight.

> "Any other rule would be unfair to competitors who must be able to rely on the patent documents themselves, without consideration of expert opinion that then does not even exist, in ascertaining the scope of a patentee's right to exclude."

Southwall Tech. v. Cardinal IG, 54 F.3d 1570, 1578 (Fed Cir. 1995). Nor may the inventor's subjective intent as to claim scope, when unexpressed in the patent documents, have any effect. Such testimony cannot guide the court to a proper interpretation when the patent documents themselves do so clearly.

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TEXAS DIGITAL: THE NEW DICTIONARY PRESUMPTION

***Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002)**
(Michel, Schall, and Linn)

{*N.B. – Michel joins this opinion after authoring* Vitronics. - *MAP*}

I. The Contours of Claim Construction

> "In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to 'particularly point[ ] out and distinctly claim[ ] the subject matter which the patentee regards as his invention.' 35 U.S.C. § 112, ¶ 2."

Interactive Gift Express v. Compuserve, 256 F.3d 1323, 1331 (Fed. Cir. 2001) (Schall, Plager, Linn) *{Not included in packet - MAP}*. The terms used in the claims bear a "heavy presumption" that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art. Moreover, unless compelled otherwise, a court will give a claim term **the full range of its ordinary meaning** as understood by persons skilled in the relevant art.

***.

Dictionaries are always available to the court to aid in the task of determining meanings that would have been attributed by those of skill in the relevant art to any disputed terms used by the inventor in the claims. *See Vitronics v. Conceptronic*, 90 F.3d 1576, 1584 n. 6 (Fed. Cir. 1996) *{MAP-3:34-42}*.

> ("[T]echnical treatises and dictionaries ... are worthy of special note. Judges are free to consult such resources at any time ... and may also rely on dictionary definitions when construing claim terms....").

…**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. Such references are **unbiased reflections** of common understanding not influenced by

- expert testimony or
- events subsequent to the fixing of the intrinsic record by the grant of the patent,
- not colored by the motives of the parties, and
- not inspired by litigation.

Indeed, these materials may be **the most meaningful sources** of information to aid judges in better understanding both the technology and the terminology used by those skilled in the art to describe the technology**.**

These materials serve as important resources to assist courts in many ways. For example, they are often used to aid in the interpretation of **statutes** and **regulations** and in the interpretation of terms used in **contracts**. These materials deserve no less fealty in the context of claim construction.

As resources and references to inform and aid courts and judges in the understanding of technology and terminology, it is entirely proper for both trial and appellate judges to consult these materials at **any** stage of a litigation**,** regardless of whether they have been offered by a party in evidence or not**.** Thus, categorizing them as "extrinsic evidence" or even a "special form of extrinsic evidence" is misplaced and does not inform the analysis.

Because words often have multiple dictionary definitions, some having no relation to the claimed invention, the intrinsic record must always be consulted to identify which of the different possible dictionary meanings of the claim terms in issue is most consistent with the use of the words by the inventor. If 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 such consistent meanings.** The objective and contemporaneous record provided by the intrinsic evidence is the **most reliable** guide to help the court determine which of the possible **meanings** of the terms in question was **intended** by the inventor to particularly point out and distinctly claim the invention.

Moreover, the intrinsic record also must be examined in every case to determine whether the presumption of ordinary and customary meaning is **rebutted**. Indeed, the intrinsic record may show that the specification uses the words in a manner **clearly inconsistent** with the ordinary meaning reflected, for example, in a dictionary definition. In such a case, the inconsistent dictionary definition must be rejected. *See Liebscher v. Boothroyd*, 258 F.2d 948, 951, (CCPA 1958)

("Indiscriminate reliance on definitions found in dictionaries can often produce absurd results."). In short, the presumption in favor of a dictionary definition will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth an **explicit** definition of the term different from its ordinary meaning**.** Further, the presumption also will be rebutted if the inventor has **disavowed or disclaimed** scope of coverage, by using words or expressions of **manifest** exclusion or restriction, representing a clear disavowal of claim scope.

Consulting the written description and prosecution history as a **threshold** step in the claim construction process … invites a **violation** of our precedent counseling against importing limitations into the claims. For example, if an invention is disclosed in the written description in only one exemplary form or in only one embodiment, the risk of starting with the intrinsic record is that the single form or embodiment so disclosed will be read to require that the claim terms be limited to that single form or embodiment. Indeed, one can easily be misled to believe that this is precisely what our precedent requires when it informs that disputed claim terms should be construed in light of the intrinsic record. But if the meaning of the words themselves would not have been understood to persons of skill in the art to be limited only to the examples or embodiments described in the specification, reading the words in such a confined way would mandate the wrong result and would violate our proscription of not reading limitations from the specification into the claims.

By examining relevant dictionaries, encyclopedias and treatises to ascertain possible meanings that would have been attributed to the words of the claims by those skilled in the art, and by further utilizing the intrinsic record to select from those possible meanings the one or ones most consistent with the use of the words by the inventor, the full breadth of the limitations intended by the inventor will be **more accurately** determined and the **improper** importation of unintended limitations from the written description into the claims will be more easily avoided.

THE *PHILLIPS* DECISION

TIMELINE OF LITIGATION

Date	Author	Event
Jul 7, 1987		Phillips issued US Pat No. 4,677,798
Feb 3, 1997		Phillips brings claims of patent infringement and misappropriation of trade secrets in D. Colo.
Jan 22, 2003	District Court (D. Colo)	-Construes claim term as means plus function; uses specification to limit claim scope under § 112 ¶ 6 -Grants summary judgment of noninfringement
Apr 08, 2004	Fed Cir. Panel [Newman, Lourie, Dyk]; Dyk dissenting	-Sustain Dist Ct's finding of summary judgment for noninfringement, but -Alter the claim construction, finding not means plus function, but is limited by implicit definition of baffles in specification. -Dissent - use dictionary and give claim term ordinary meaning.
Jul 21, 2004	Fed. Cir. Per Curiam	-Vacate panel judgment, -Grant en banc review, and -Call for amicus briefs on seven certified questions
Jul 12, 2005	Fed Cir. en banc	-Affirm method of claim construction of panel majority (primacy of intrinsic evidence) -Reverse claim construction of panel majority (improperly limited to preferred embodiment) -Reverse summary judgment of noninfringement -Remand to Dist Ct for infringement proceedings.
Nov 9, 2005		Petition for certiorari filed with Supreme Court.

CERTIFIED QUESTIONS

***Phillips v. AWH Corp.*, 376 F.3d 1382**
(Fed. Cir. July 21, 2004) (per curiam)

[There were seven questions, but this packet only deals with the first four. The remaining questions addressed

- construing claims to preserve their validity,
- the proper role of expert testimony, and
- revisiting *Cybor*'s rule to review all claim constructions de novo. – MAP]

1. Is the public notice function of patent claims better served
   - by referencing primarily to technical and general purpose dictionaries and similar sources to interpret a claim term or
   - by looking primarily to the patentee's use of the term in the specification?

If both sources are to be consulted, in what **order**?

2. If dictionaries should serve as the primary source for claim interpretation, should the specification limit the full scope of claim language (as defined by the dictionaries)
   - only when the patentee has acted as his own lexicographer or
   - when the specification reflects a clear disclaimer of claim scope?

If so, what language in the specification will satisfy those conditions? What use should be made of **general** as opposed to **technical** dictionaries? How does the concept of **ordinary meaning** apply if there are multiple dictionary definitions of the same term? If the dictionary provides multiple potentially applicable definitions for a term, is it appropriate to look to the specification to determine what definition or definitions should apply?

3. If the primary source for claim construction should be the specification, what use should be made of **dictionaries**? …

4. Instead of viewing the claim construction methodologies in the majority and dissent of the now-vacated panel decision as alternative, conflicting approaches, should the two approaches be treated as **complementary methodologies** such that there is a dual restriction on claim scope, and a patentee must satisfy both limiting methodologies in order to establish the claim coverage it seeks?

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AMICUS BRIEFS

{*36 amicus briefs were filed after the Fed Circuit requested them. I have selected three and have indicated both authors of note and the organizations for whom they wrote - MAP.*}

Amicus Brief of Intel, IBM, Google, Micron, and Microsoft

Author: Mark Lemley (Law Prof., Stanford; graduated Boalt Hall 1991) for Keker & VanNess

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Freed from the bounds of the specification and prosecution history, parties construing patent claims, including litigants on both sides, often seek to characterize the "plain meaning" of the patent claims as something very different [from] what the patentee invented. Because dictionaries are so varied and malleable, each side can normally present an impeccable lexicographical pedigree for its "plain meaning." Yet this so-called "plain meaning" may be entirely divorced from the specification and file history, and thus from the intent of the patentee….

… For all their **supposed objectivity,** relying on the "plain meaning" of claim terms found in dictionaries provides **insufficient notice** of the scope of those claims, substantially impeding licensing or business decisions**.** Because there is no way for the parties to know which definition will prevail, even for simple terms like "a," "or," "to," "including," and "through," to name a few, patentees, accused infringers, and others having an interest in the technology are left in an atmosphere of uncertainty, unable to resolve their plausible but opposing interpretations at least until the district court's *Markman* hearing, and often until appeal.

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Dictionaries may be useful where ambiguity remains **after** due consideration of the specification and the prosecution history. **Domain-specific** dictionaries and treatises (e.g., technical dictionaries for technical terms, business dictionaries for business terms in business method patents) in particular may be evidence of how the person having ordinary skill in the art would understand a **technical** term. However, they are merely **secondary aids** to understanding what the patentee has invented, and **not the primary source** of the meaning of patent claims. Where the specification and file history leave ambiguity remaining, and a clear definition is not ascertainable from dictionaries and treatises, protection of the public (the intended beneficiaries of the patent system) requires that a suitable narrowing presumption be adopted.

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Amicus Brief of Int'l Trade Comm'n Trial Lawyers Assn. (ITCTLA)

Author: Alice Kipel (Partner, Steptoe & Johnson) for ITCTLA; Graduated Georgetown 1982

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Relevant technical dictionaries should have a rebuttable preference over general purpose dictionaries. Under 35 U.S.C. § 112 (1), the specification is directed to one of skill in the art. Under 35 U.S.C. § 112 (2), the specification concludes with the claims. Therefore, the claims must also be directed to one of skill in the art. One of skill in the art is a person who is trying to learn from and/or apply that art, not an expert attempting to justify a position of a party. Thus, one of skill in the art would interpret a **technical** term in accordance with his **experience** and/or the **standards in the appropriate field or endeavor.** One of skill in the art would not interpret a claim term in accordance with a general purpose dictionary which could possibly and probably have irrelevant, inconsistent, insufficient, slang, and/or excessive interpretations…. It will almost always be necessary to resort to the specification to determine the nature of the invention and, once that is determined, definitions from a technical dictionary will generally be more appropriate than the definitions from a general purpose dictionary.

General purpose dictionaries may be used for common, non-technical terms, i.e., terms which are neither defined nor suggested by the specification, nor which have an appropriate definition in relevant technical dictionaries.

The concept of ordinary meaning applies to the intended reader: one of skill in the art. Such a person as a result of training and experience, inherently **separates** the words in a sentence into **technical** terms and **non-technical** terms. Technical terms carry their ordinary technical meaning or meanings unless the specification or file history indicates otherwise; non-technical terms carry their ordinary,

common, everyday meaning or meanings as used by the general public. It should be noted that there is no hard and fast rule as to whether a term is technical or not; that must be determined by the nature of the invention and the context and structure of the claim.

If there are multiple dictionary definitions of the same term, then only the potentially appropriate definitions should be considered, after first determining whether the term is intended to be a technical term or a non-technical term.

Amicus Brief of R. Polk Wagner and Joseph Scott Miller

Authors:

- R. Polk Wagner (Prof., U. Penn. Law; graduated Stanford Law 1998)
- Joseph Scott Miller (Law Prof., Lewis & Clark Law School; graduated Northwestern Law 1994)

{Brief was filed on their own behalf, and not on behalf of any organization or client - MAP}

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First, a presumptive ordinary meaning (POM) approach ensures that decision-makers focus on what the **relevant public** (here, persons having ordinary skill in the art, PHOSITAs) would understand the claims to mean, rather than on what the parties—or, more to the point, the parties' lawyers—would have one infer from the vagueness inherent in all language.…

Second, an ordinary meaning approach best utilizes the skills of both the technologists (PHOSITAs) and the non-technologist decision-makers (such as judges). Patent documents are written for a technical audience, and as such the focus must remain on what the relevant technologists would understand the language to mean.… [T]he POM approach leverages the skills of courts in implementing and enunciating **clear rules** based on the available clear, specific, and **objective** evidence of the meaning of language**.** Under the POM approach, the knowledge of technologists determines the meaning (presumptively, the 'ordinary meaning'), while the lawyers and judges implement and execute the interpretive procedure.

Third, and perhaps most importantly, the POM approach properly informs the public of the interpretive rules, and encourages behavior that comports well with the public notice function of claim language.… That is, a patentee who wishes to use a claim term according to its ordinary meaning can be assured that, absent specific instructions otherwise, the courts will accord that meaning to the term. Indeed, the patentee can even verify such a meaning by consulting objective reference sources—the very same references sources that a court will later use to construe a disputed claim term. {*A footnote then indicates a belief of Prof. Miller that a reference source should be elected in the prosecution process and put in the patent public record to define all terms - MAP*}….

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

> 1. <u>It facilitates cooperation, not strategic behavior</u>. A competent reader of a language … knows the ordinary meanings of words and phrases in the language and reads a text by reference to those ordinary meanings….
>
> 2. <u>Readers can approach patents in the way they approach other texts</u>…. The customary approach when reading texts of all kinds is to presumptively attribute the known ordinary meaning to the words found therein, altering that understanding only upon good evidence to the contrary….
>
> 3. <u>It adapts easily to both technical and non-technical language</u>.

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[Failing to follow this approach] fatally undermines the integrity of the patent document**,** because it means that the **patentee's** carefully-chosen words describing **her** invention to the public are just the barest of **starting points** for an unpredictable, open-ended interpretive scheme**.** Indeed, a far-ranging "holistic" approach to claim construction encourages patentees to draft claims ever-more vaguely and provide far less substantive disclosure, lest an adverse inference be "revealed" to a judicial decision-maker at some point in the future. This, we suggest, is not supportive of the public notice function of claims.

THE *EN BANC* DECISION

***Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. July 12, 2005) (en banc)**

[Before: Michel, Newman, Mayer, Lourie, Clevenger, Rader, Schall, Bryson, Gajarsa, Linn, Dyk, Prost.

- Lourie concurs in part and in judgment with Newman
- Mayer dissents with Newman – MAP]

Edward H. Phillips invented modular, steel-shell panels that can be welded together to form vandalism-resistant walls. The panels are especially useful in building prisons because they are load-bearing and impact-resistant, while also insulating against fire and noise. *{See Figs. 2 and 6 from patent below*:

FIG. 2.

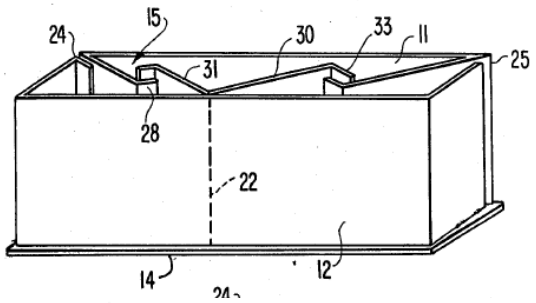
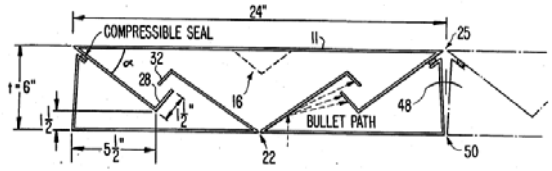


FIG. 6.



Parts 30 and 31 of Fig. 2 are baffles, Parts 11 and 12 are the shell walls - MAP}

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With regard to the patent infringement issue, the district court focused on the language of claim 1, which recites

> "further means disposed inside the shell for increasing its load bearing capacity comprising internal steel baffles extending inwardly from the steel shell walls…."

Looking to the specification of the '798 patent, the court noted that

> "every textual reference in the Specification and its diagrams show baffle deployment **at an angle other than 90** to the wall faces"

and that

> "placement of the baffles at such angles creates an intermediate interlocking, but not solid, internal barrier."

The district court therefore ruled that, for purposes of the '798 patent, a baffle must

> "extend inward from the steel shell walls at an oblique or acute angle to the wall face"

and must form part of an interlocking barrier in the interior of the wall module.

Mr. Phillips appealed with respect to both the trade secret and patent infringement claims. A panel of this court [Newman, Lourie, Dyk] affirmed on both issues…. As to the patent infringement claims, the panel was divided. The majority [Lourie and Newman] sustained the district court's summary judgment of noninfringement, although on different grounds. The dissenting judge [Dyk] would have reversed the summary judgment of noninfringement.

…. Based on the patent's written description, the panel held that the claim term "baffles" excludes structures that extend at a 90 degree angle from the walls. The panel noted that the specification repeatedly refers to the ability of the claimed baffles to deflect projectiles and that it describes the baffles as being

> "disposed at **such angles** that bullets which might penetrate the outer steel panels are **deflected**."

In addition, the panel observed that nowhere in the patent is there any disclosure of a baffle projecting from the wall at a right angle and that baffles oriented at 90 degrees to the wall were found in the prior art. Based on "the specification's explicit descriptions," the panel concluded

> "that the patentee regarded his invention as panels providing impact or projectile resistance and that the baffles must be oriented at angles **other than 90**."

The panel added that the patent **specification**

> "is intended to support and inform the claims, and here it makes it **unmistakably clear** that the invention involves baffles angled at **other** than 90."

The **panel** therefore **upheld** the district court's summary judgment of **noninfringement**.

The dissenting judge argued that the panel had improperly limited the claims to the particular embodiment of the invention disclosed in the specification, rather than adopting the "plain meaning" of the term "baffles." The dissenting judge

noted that the parties had stipulated that "baffles" are a

> "means for obstructing, impeding, **or** checking the flow of something,"

and that the panel majority had agreed that the ordinary meaning of baffles is

> "something for deflecting, checking, or otherwise regulating flow."

In the dissent's view, **nothing** in the specification **redefined** the term "baffles" or constituted a disclaimer specifically limiting the term to less than the **full** scope of its ordinary meaning. Instead, the dissenting judge contended, the specification

> "merely identifies impact resistance as **one of several** objectives of the invention.… "

This court agreed to rehear the appeal *en banc* and vacated the judgment of the panel. We now … **reverse** the portion of the court's judgment addressed to the issue of **infringement**.

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II [Overview of Claim Construction]

[The first] two paragraphs of section 112 frame the issue of claim interpretation for us. *{See MAP 2:11-28}*. The second paragraph requires us to look to the **language of the claims** to determine what "the applicant regards as his invention." On the other hand, **the first paragraph** requires that the specification **describe the invention** set forth in the claims**.** The principal question that this case presents to us is the extent to which we should resort to and rely on a patent's specification in seeking to ascertain the proper scope of its claims.

This is hardly a new question. The role of the specification in claim construction has been an issue in patent law decisions in this country for nearly two centuries. We addressed the relationship between the specification and the claims at some length in our en banc opinion in *Markman v. Westview Instruments, Inc*, 52 F.3d 967, 979-81 (Fed. Cir. 1995) (en banc) {*Archer, C.J. authored, Mayer concurred in judgment, Rader concurred in judgment, Newman dissented - MAP*}. We again summarized the applicable principles in *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996) {*See MAP 2:30-3:63*}, and more recently *in Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc*., 381 F.3d 1111 (Fed. Cir. 2004) *{Clevenger, Rader, Linn - Not included in this packet - MAP}*. What we said in those cases bears restating, for the **basic** principles of claim construction outlined there **are still applicable**, and we reaffirm them today. We have also previously considered the use of dictionaries in claim construction. What we have said in that regard requires clarification.

A [Ordinary Meaning of the Claim Language]

> It is a "bedrock principle" of patent law that "the claims of a patent define the invention to which the patentee is entitled the right to exclude."

Innova, 381 F.3d at 1115. That principle has been recognized since at least 1836, when Congress first required that the specification include a portion in which the inventor

> "shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery."

[Patent Act of 1836]. In the following years, the Supreme Court made clear that the claims are

> "of primary importance, in the effort to ascertain precisely what it is that is patented."

Merrill v. Yeomans, 94 U.S. 568 (1876). Because the patentee is required to "define precisely what his invention is," the Court explained, it is

> "unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."

White v. Dunbar, 119 U.S. 47, 52 (1886).

We have frequently stated that the words of a claim

> "are generally given their ordinary and customary meaning."

Vitronics, 90 F.3d at 1582 {*See MAP 2:61-62*}. We have made clear, moreover, that the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question **at the time of the invention**, i.e., as of the effective **filing date** of the patent application. {*Compare MAP 4:1-6*}

The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation. That starting point is based on the well-settled understanding that inventors are typically persons skilled in the field of the invention and that patents are addressed to and intended to be read by others of skill in the pertinent art.

Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the **particular** claim in which the disputed term appears, but in the context of **the entire patent,**

including the specification. This court explained that point well in *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998):

> It is the person of ordinary skill in the field of the invention through whose eyes the claims are construed**.** Such person is deemed to read the words used in the patent documents with an understanding of their **meaning in the field**, and to have knowledge of any special meaning and usage in the field. The inventor's words that are used to describe the invention--the inventor's lexicography--must be understood and interpreted by the court as they would be understood and interpreted by a person in that field of technology. Thus the court starts the decisionmaking process by reviewing the same resources as would that person, viz., the patent specification and the prosecution history.

B [Analysis of Intrinsic Evidence]

In some cases, the ordinary meaning of claim language as understood by a person of skill in the art may be readily apparent even to lay judges, and claim construction in such cases involves little more than the application of the widely accepted meaning of **commonly understood** words. In such circumstances, general purpose dictionaries may be helpful. In many cases that give rise to litigation, however, determining the ordinary and customary meaning of the claim requires examination of terms that have a particular meaning in a field of art. Because the meaning of a claim term as understood by persons of skill in the art is often not immediately apparent, and because patentees frequently use terms idiosyncratically, the court looks to

> "those sources available to the public that show what a person of skill in the art would have understood disputed claim language to mean."

Those sources include

- "the words of the claims themselves,
- the remainder of the specification,
- the prosecution history, and
- extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art."

1 [Claim Term in Context of Claims]

Quite apart from the written description and the prosecution history, the claims themselves provide substantial guidance as to the meaning of particular claim terms.

To begin with, the context in which a term is used in the asserted claim can be highly instructive. To take a simple example, the claim in this case refers to "steel baffles," which strongly implies that the term "baffles" does not inherently mean objects made of steel….

Other claims of the patent in question, both asserted and unasserted, can also be valuable sources of enlightenment as to the meaning of a claim term. Because claim terms are normally used **consistently** throughout the patent**,** the usage of a term in one claim can often illuminate the meaning of the same term in other claims**.** Differences among claims can also be a useful guide in understanding the meaning of particular claim terms. For example, the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim.

2 [Claim Term in Context of the Specification]

The claims, of course, do not stand alone. Rather, they are part of "a fully integrated written instrument," consisting principally of a specification that concludes with the claims. For that reason, claims "must be read in view of the specification, of which they are a part." [Cites to *MAP 2:83-85*]

This court and its predecessors have long emphasized the importance of the specification in claim construction.…

Shortly after the creation of this court, Judge Rich wrote that

> "[t]he descriptive part of the specification aids in ascertaining the scope and meaning of the claims inasmuch as the words of the claims must be based on the description. The specification is, thus, the primary basis for construing the claims."

Standard Oil v. Amer. Cyanamid, 774 F.2d 448, 452 (Fed. Cir. 1985).

On numerous occasions since then, we have reaffirmed that point, stating that

> "[t]he best source for understanding a technical term is the specification from which it arose, informed, as needed, by the prosecution history."

Multiform Desiccants, 133 F.3d at 1478.

That principle has a long pedigree in Supreme Court decisions as well. [String cite of 5 Supreme Court cases ranging from 1848-1966 – MAP].

The importance of the specification in claim construction derives from its statutory role. The close kinship between the written description and the claims is enforced by the statutory requirement that the specification describe the claimed invention in "full, clear, concise, and exact terms." 35 U.S.C. § 112, para. 1; *see also Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996)

> ("[A claim] term can be defined only in a way that comports with the instrument as a whole.").

In light of the statutory directive that the inventor provide a "full" and "exact" description of the claimed invention, the specification **necessarily** informs the proper construction of the claims. In *Renishaw* [*v. Marposs Societa per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998)], this court summarized that point succinctly:

> Ultimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually **invented and intended** to envelop with the claim. The construction that **stays true** to the claim language and **most naturally aligns** with the patent's description of the invention will be, in the end, the correct construction.

Consistent with that general principle, our cases recognize that the specification may reveal a **special** definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs. In other cases, the specification may reveal an **intentional disclaimer, or disavowal,** of claim scope by the inventor. In that instance as well, the inventor has dictated the correct claim scope, and the inventor's intention, as expressed in the specification, is regarded as dispositive.

The pertinence of the specification to claim construction is reinforced by the manner in which a patent is issued. The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction

> "in light of the specification as it would be interpreted by one of ordinary skill in the art."

Indeed, the rules of the PTO require that application claims must

> "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description."

37 C.F.R. § 1.75(d)(1). It is therefore entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims.

3 [Claim Term in Context of Prosecution History]

In addition to consulting the specification, we have held that a court

> "should also consider the patent's prosecution history, if it is in evidence."

Markman, 52 F.3d at 980.

[Prosecution History is good evidence because it

- provides evidence of PTO's and inventor's understanding of the patent,
- was created by the patentee trying to "explain and obtain the patent," and
- may expressly limit claim scope

It is less helpful than the specification because it lacks the clarity of a final product, but is still helpful].

C [Analysis of Extrinsic Evidence]

Although we have emphasized the importance of intrinsic evidence in claim construction, we have also authorized district courts to rely on extrinsic evidence, which

> "consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises."

Markman, 52 F.3d at 980. However, while extrinsic evidence "can shed useful light on the relevant art," we have explained that it is

> "**less significant** than the intrinsic record in determining 'the legally operative meaning of claim language.' "

C.R. Bard v. U.S. Surgical, 388 F.3d 858, 862 (Fed. Cir. 2004) {*not included in packet – MAP*}.

Within the class of extrinsic evidence, the court has observed that dictionaries and treatises can be useful in claim construction. We have especially noted the help that **technical** dictionaries may provide to a court "to better understand the underlying technology" and the way in which **one of skill in the art** might use the claim terms. Because dictionaries, and especially technical dictionaries, endeavor to collect the accepted meanings of terms used in various fields of science and technology,

those resources [can help the court determine] the meaning of particular terminology to those of skill in the art of the invention. Such evidence, we have held, may be considered if the court deems it helpful in determining "the true meaning of language used in the patent claims."

[Expert testimony can also be helpful to educate the court, but the court should not rely on unsupported assertions from the expert]. Similarly, a court should discount any expert testimony

> "that is clearly at odds with the claim construction mandated by the claims themselves, the written description, and the prosecution history, in other words, with the written record of the patent."

Key Pharms. v. Hercon Labs, 161 F.3d 709, 716 (Fed. Cir. 1998).

[Why Extrinsic Evidence is Suspect]

We have viewed **extrinsic evidence** in general as less reliable than the patent and its prosecution history in determining how to read claim terms, for several reasons.

- **First**, extrinsic evidence by definition is **not part of the patent** and does not have the specification's virtue of being created at the time of patent prosecution for the purpose of explaining the patent's scope and meaning.
- **Second**, while claims are construed as they would be understood by a hypothetical person of skill in the art, extrinsic publications **may not be written by or for skilled artisans** and therefore may not reflect the understanding of a skilled artisan in the field of the patent.
- **Third**, extrinsic evidence consisting of expert reports and testimony is generated at the time of and for the purpose of litigation and thus can suffer from **bias** that is not present in intrinsic evidence. The effect of that bias can be exacerbated if the expert is not one of skill in the relevant art or if the expert's opinion is offered in a form that is not subject to cross-examination.
- **Fourth**, there is a **virtually unbounded** universe of potential extrinsic evidence of some marginal relevance that could be brought to bear on any claim construction question. In the course of litigation, each party will naturally choose the pieces of extrinsic evidence most favorable to its cause, leaving the court with the considerable task of filtering the useful extrinsic evidence from the fluff.
- **Finally**, undue reliance on extrinsic evidence poses the risk that it will be used to **change** the meaning of claims in derogation of the "indisputable public records consisting of the claims, the specification and the prosecution history," thereby undermining the public notice function of patents.

In sum, extrinsic evidence may be useful to the court, but it is unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence. Nonetheless, because extrinsic evidence can help educate the court regarding the field of the invention and can help the court determine what a person of ordinary skill in the art would understand claim terms to mean, it is permissible for the district court **in its sound discretion** to admit and use such evidence. In exercising that discretion, and in weighing all the evidence bearing on claim construction, the court should keep in mind the flaws inherent in each type of evidence and assess that evidence accordingly.

III [Repudiation of *Texas Digital*]

Although the principles outlined above have been articulated on numerous occasions, some of this court's cases have suggested a somewhat different approach to claim construction, in which the court has given greater emphasis to dictionary definitions of claim terms and has assigned a less prominent role to the specification and the prosecution history. The leading case in this line is [*Texas Digital*] *{See MAP 3:67-4:110}*.

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B – [The Problems with *Texas Digital*]

Although the concern *{See MAP 4:76-97}* expressed by the court in *Texas Digital* was valid, the methodology it adopted placed **too much reliance on extrinsic sources** such as dictionaries, treatises, and encyclopedias and too little on intrinsic sources, in particular the specification and prosecution history. While the court noted that the specification must be consulted in every case, it suggested a methodology for claim interpretation in which the specification should be consulted **only after** a determination is made, whether based on a dictionary, treatise, or other source, as to the **ordinary meaning or meanings** of the claim term in **dispute**. Even then, recourse to the specification is limited to determining

- whether the specification excludes one of the meanings derived from the dictionary,

- whether the presumption in favor of the dictionary definition of the claim term has been overcome by "an explicit definition of the term different from its ordinary meaning," or
- whether the inventor "has disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope."

Texas Digital, 308 F.3d at 1204. *{See MAP 4:54-74}*. In effect, the *Texas Digital* approach limits the role of the specification in claim construction to **serving as a check** on the dictionary meaning of a claim term if the specification requires the court to conclude that fewer than all the dictionary definitions apply, or if the specification contains a sufficiently specific alternative definition or disavowal. That approach, in our view, **improperly restricts** the role of the specification in claim construction.

Assigning such a limited role to the specification, and in particular requiring that any definition of claim language in the specification be express, is inconsistent with our rulings

- that the specification is "the single best guide to the meaning of a disputed term," and
- that the specification "acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication."

Vitronics, 90 F.3d at 1582. *{See MAP 2:68-85}*.

The main problem with elevating the dictionary to such prominence is that it focuses the inquiry on the abstract meaning of words rather than on the meaning of claim terms within the context of the patent. Properly viewed, the "**ordinary meaning**" of a claim term is its **meaning** to the ordinary artisan **after** reading **the entire patent**. Yet heavy reliance on the dictionary divorced from the intrinsic evidence risks transforming the meaning of the claim term to the artisan into the meaning of the term in the abstract, out of its particular context, which is the specification.… Thus, there may be a [gap] between the patentee's **responsibility to describe and claim** his invention, and the dictionary editors' **objective of aggregating** all possible definitions for particular words.

Although the *Texas Digital* line of cases permit the dictionary definition to be narrowed in some circumstances even when there is not an explicit disclaimer or redefinition in the specification, **too often** that line of cases has been improperly relied upon to condone the adoption of a dictionary definition **entirely divorced** from the context of the written description. *{N.B. – no citation is given here – MAP}*. The problem is that if the district court starts with the broad dictionary definition in every case and fails to fully appreciate how the specification implicitly limits that definition**, the** error will **systematically** cause the construction of the claim to be **unduly expansive**. The risk of systematic overbreadth is greatly reduced if the court instead focuses at the outset on how the patentee used the claim term in the claims, specification, and prosecution history, rather than starting with a broad definition and whittling it down.

Dictionaries, by their nature, provide an expansive array of definitions. General dictionaries, in particular, strive to collect all uses of particular words, from the common to the obscure. By design, general dictionaries collect the definitions of a term as used not only in a particular art field, but in many different settings…. Thus, the use of the dictionary may extend patent protection beyond what should properly be afforded by the inventor's patent. For that reason, we have stated that "a general-usage dictionary cannot overcome art-specific evidence of the meaning" of a claim term.

Even technical dictionaries or treatises, under certain circumstances, may suffer from some of these deficiencies. There is no guarantee that a term is used in the same way in a treatise as it would be by the patentee. In fact, discrepancies between the patent and treatises are apt to be common because the patent by its nature describes something **novel**. *See Autogiro* [*v. United States*], 384 F.2d [391,] 397 [(Ct. Cl. 1967)].

> ("Often the invention is novel and words do not exist to describe it. The dictionary does not always keep abreast of the inventor. It cannot.").

Moreover, different dictionaries may contain somewhat different sets of definitions for the same words. A claim should not rise or fall based upon the preferences of a particular dictionary **editor**, or the **court**'s independent decision, uninformed by the **specification**, to rely on one dictionary rather than another**….**

As we have noted above, however, we do not intend to preclude the **appropriate** use of dictionaries. Dictionaries or comparable sources are often useful to **assist** in understanding the **commonly understood meaning** of words and have been used both by our court and the Supreme Court in claim interpretation…. As we said in *Vitronics {See MAP 2:34-42}*, judges are free to consult dictionaries and

technical treatises at any time in order to better understand the underlying technology and may also rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents.

We also acknowledge that the purpose underlying the *Texas Digital* line of cases--to avoid the danger of reading limitations from the specification into the claim--is sound. Moreover, we recognize that the distinction between using the specification to interpret the meaning of a claim and importing limitations from the specification into the claim can be a difficult one to apply in practice. However, the line between construing terms and importing limitations can be discerned with reasonable certainty and predictability if the court's focus remains on understanding how a person of ordinary skill in the art **would understand** the claim terms. For instance, although the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments. In particular, we have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment. That is not just because section 112 of the Patent Act requires that the claims themselves set forth the limits of the patent grant, but also because persons of ordinary skill in the art **rarely** would confine their definitions of terms to the **exact representations** depicted in the embodiments.

To avoid importing limitations from the specification into the claims, it is important to keep in mind that the purposes of the specification are

- to **teach** and **enable** those of skill in the art to make and use the invention and
- to provide a **best mode** for doing so.

{N.B. – Only two purposes found in § 112 ¶ 1 - MAP}. One of the best ways to teach a person of ordinary skill in the art how to make and use the invention is to provide an example of how to practice the invention in a particular case. Much of the time, upon reading the specification in that context, it will become clear

- whether the patentee is setting out specific examples of the invention to accomplish those goals, or
- whether the patentee instead intends for the claims and the embodiments in the specification to be strictly coextensive.

The manner in which the patentee uses a term within the specification and claims usually will make the distinction apparent.

In the end, there will still remain some cases in which it will be hard to determine whether a person of skill in the art would understand the embodiments to define the outer limits of the claim term or merely to be exemplary in nature. While that task may present difficulties in some cases, we nonetheless believe that attempting to resolve that problem in the context of the particular patent is likely to capture the scope of the actual invention more accurately than either strictly limiting the scope of the claims to the embodiments disclosed in the specification or divorcing the claim language from the specification.

In *Vitronics*, this court grappled with the same problem and set forth guidelines for reaching the correct claim construction and not imposing improper limitations on claims. The underlying goal of our decision in *Vitronics* was to increase the likelihood that a court will comprehend how a person of ordinary skill in the art would understand the claim terms. In that process, we recognized that there is **no magic formula or catechism** for conducting claim construction. Nor is the court barred from considering any particular sources or required to analyze sources in any specific sequence, as long as those sources are not used to contradict claim meaning that is unambiguous in light of the intrinsic evidence. For example, a judge who encounters a claim term while reading a patent might consult a general purpose or specialized dictionary to begin to understand the meaning of the term, before reviewing the remainder of the patent to determine how the patentee has used the term. The **sequence** of steps used by the judge in consulting various sources is **not important;** what matters is for the court to attach the **appropriate weight** to be assigned to those sources in light of the statutes and policies that inform patent law. *{Cites Vitronics, which gave a **numbered** list for evidence; See MAP 2:58-97 - MAP}*. In *Vitronics*, we did not attempt to provide a rigid algorithm for claim construction, but simply attempted to explain why, in general, certain types of evidence are more valuable than others. Today, we adhere to that approach and reaffirm the approach to claim construction outlined in that case, in *Markman*, and in *Innova*. We now turn to the application of those principles to the case at bar.

IV [Applying the Principles]
A [Studying the Language of the Claims]

The critical language of claim 1 of the '798 patent—

> "further means disposed inside the shell for increasing its load bearing capacity comprising internal steel baffles extending inwardly from the steel shell walls"

—imposes three clear requirements with respect to the baffles.

- First, the baffles must be made of steel.
- Second, they must be part of the load-bearing means for the wall section.
- Third, they must be pointed inward from the walls.

Both parties, stipulating to a dictionary definition, also conceded that the term "baffles" refers to objects that check, impede, or obstruct the flow of something. The intrinsic evidence confirms that a person of skill in the art would understand that the term "baffles," as used in the '798 patent, would have that generic meaning.

The other claims of the '798 patent specify particular functions to be served by the baffles. For example, dependent claim 2 states that the baffles may be

> "**oriented** with the panel sections disposed **at angles** for deflecting projectiles such as bullets able to penetrate the steel plates."

The inclusion of such a specific limitation on the term "baffles" in claim 2 makes it likely that the patentee did not contemplate that the term "baffles" **already contained** that limitation. *See Dow Chem. Co. v. United States*, 226 F.3d 1334, 1341- 42 (Fed.Cir.2000) (concluding that an independent claim should be given broader scope than a dependent claim to avoid rendering the dependent claim redundant). Independent claim 17 further supports that proposition. It states that baffles are placed

> "projecting inwardly from the outer shell at angles tending to deflect projectiles that penetrate the outer shell."

That limitation would be unnecessary if persons of skill in the art understood that the baffles inherently served such a function. Dependent claim 6 provides an additional requirement for the baffles, stating that

> "the internal baffles of both outer panel sections overlap and interlock at angles providing deflector panels extending from one end of the module to the other."

If the baffles recited in claim 1 were inherently placed at specific angles, or interlocked to form an intermediate barrier, claim 6 would be redundant.

The specification further supports the conclusion that persons of ordinary skill in the art would understand the baffles recited in the '798 patent to be load-bearing objects that serve to check, impede, or obstruct flow. At several points, the specification discusses positioning the baffles so as to deflect projectiles. The patent states that **one** advantage of the invention over the prior art is that

> "[t]here have not been effective ways of dealing with these powerful impact weapons with inexpensive housing."

Id., col. 3, ll. 28-30. While that statement makes clear the invention envisions baffles that serve that function, it does not imply that in order to qualify as baffles within the meaning of the claims, the internal support structures must serve the projectile-deflecting function in **all** the embodiments of **all** the claims. The specification must teach and enable all the claims, and the section of the written description discussing the use of baffles to deflect projectiles serves that purpose for claims 2, 6, 17, and 23, which specifically claim baffles that deflect projectiles.

[The Court indicates two other functions the baffles are to perform, namely

- "providing structural support," and
- "produc[ing] an intermediate barrier wall"]

The fact that the written description of the '798 patent sets forth **multiple** objectives to be served by the baffles recited in the claims confirms that the term "baffles" should not be read restrictively to require that the baffles in each case serve all of the recited functions. We have held that

> "[t]he fact that a patent asserts that an invention achieves several objectives does not require that each of the claims be construed as limited to structures that are capable of achieving all of the objectives."

Liebel-Flarsheim [*v. Medrad*], 358 F.3d [898,] 908 [(Fed. Cir. 2004) (Lourie, Bryson, Dyk)]. *{N.B. – Bryson is also author of this* Phillips *en banc opinion - MAP}*. Although deflecting projectiles is **one** of the advantages of the baffles of the '798 patent, the patent does not require that the inward extending structures always be capable of performing that function. Accordingly, we conclude that a person of skill in the art would not interpret the disclosure and claims of the '798 patent to mean that a structure extending inward from one of the wall faces is a "baffle" if it is at an acute or obtuse angle, but is not a "baffle" if it is disposed at a right angle.

B [Interpreting Narrowly to Preserve Validity]

… AWH argues that the term "baffles" should be given a restrictive meaning because if the term is not construed restrictively, the asserted claims would be invalid.

While we have acknowledged the maxim that claims should be construed to preserve their validity, we have not applied that principle broadly, and we have certainly not endorsed a regime in which validity analysis is a regular component of claim construction. Instead, we have limited the maxim to cases in which

> "the court concludes, after applying all the available tools of claim construction, that the claim is still ambiguous."

Liebel-Flarsheim, 358 F.3d at 911. In such cases, we have looked to

- whether it is reasonable to infer that the PTO would not have issued an invalid patent, and
- that the ambiguity in the claim language should therefore be resolved in a manner that would preserve the patent's validity.

[The Court cites *Klein v. Russell*, 86 U.S. 433 (1873), for the limited applicability of this rationale.]

In this case, unlike in … other cases in which the doctrine of construing claims to preserve their validity has been invoked, the claim term at issue is not ambiguous. Thus, it can be construed without the need to consider whether one possible construction would render the claim invalid while the other would not. The doctrine of construing claims to preserve their validity, a doctrine of limited utility in any event, therefore has no applicability here.

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[The Court then notes that though it certified a question regarding the continued viability of *Cybor v. FAS Techs.*, 138 F.3d 1448 (Fed. Cir. 1998) (en banc), and received amicus briefing on it, it declines to address the issue at this time].

[Conclusion]

In sum, we **reject** AWH's arguments in favor of a **restrictive definition** of the term "baffles." Because we disagree with the district court's claim construction, we **reverse** the summary judgment of **noninfringement**. In light of our decision on claim construction, it is necessary to **remand** the infringement claims to the district court for further proceedings.

AFFIRMED IN PART, REVERSED IN PART, DISMISSED IN PART, and REMANDED.

LOURIE, Circuit Judge, concurring in part and dissenting in part, with whom PAULINE NEWMAN, Circuit Judge, joins.

I fully join the portion of the court's opinion resolving the relative weights of specification and dictionaries in interpreting patent claims, in favor of the specification….

However, I do dissent from the court's decision to reverse and remand the district court's decision. The **original panel** decision of this court, which implicitly decided the case based on the priorities that the en banc court has now **reaffirmed**, interpreted the claims in light of the specification and found that the defendant did not infringe the claims. We affirmed the district court, which had arrived at a similar conclusion. The dissent from the panel decision relied on the "dictionaries first" procedure, which the court now has decided not to follow. Thus, while the claim construction issue had to be decided by the en banc court, [there is no reason to remand].

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I will simply point out that the specification contains **no disclosure** of baffles at right angles. Moreover, as the majority correctly states, a patent specification is intended to describe one's invention, and it is essential to read a specification in order to interpret the meaning of the claims. This specification makes clear that the "baffles" in this invention are angled. There is **no reference** to baffles that show them to be **other than angled**. The abstract refers to "bullet deflecting ... baffles." Only angled baffles can deflect. It then mentions "internal baffles at angles for deflecting bullets." That could not be clearer. The specification then refers several times to baffles, often to figures in the drawings, all of which are to angled baffles. A compelling point is that the only numbered references to baffles (15, 16, 26, 27, 30, and 31) all show angled baffles…. *{Compare MAP 15:99-102*; *and figs at 8:20}*.

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MAYER, Circuit Judge, with whom PAULINE NEWMAN, Circuit Judge, joins, dissenting.

Now more than ever I am convinced of the futility, indeed the absurdity, of this court's persistence in adhering to the falsehood that claim construction is a matter of law devoid of any factual component. Because any attempt to fashion a coherent standard under [a rule reviewing claim constructions *de novo*] is pointless, as illustrated by our many failed attempts to do so, I dissent.

This court was created for the purpose of bringing consistency to the patent field. *See* H.R.Rep. No. 312, 97th Cong., 1st Sess. 20-23 (1981). Instead, we have taken this noble mandate, to reinvigorate the patent and introduce predictability to the field, and focused **inappropriate power** in this court. In our quest to elevate our importance, we have, however, disregarded our role as an **appellate** court; the resulting mayhem has seriously undermined the legitimacy of the process, if not the integrity of the institution.

***

Again today we vainly attempt to establish standards by which this court will interpret claims. But after proposing no fewer than seven questions, receiving more than thirty amici curiae briefs, and whipping the bar into a frenzy of expectation, we say nothing new, but merely restate what has become the practice over the last ten years--that we will decide cases according to whatever mode or method results in the outcome we desire, or at least allows us a seemingly plausible way out of the case. I am not surprised by this. Indeed, there can be no workable standards by which this court will interpret claims so long as we are blind to the factual component of the task.

[The petition for certiorari filed with the Supreme Court on November 9, 2005, was based upon Judge Mayer's dissent, principly arguing that *de novo* review violates an appellate court's duty to give deference to findings of fact of lower courts.]

CLAIM CONSTRUCTION AFTER *PHILLIPS*

***Aspex Eyewear, Inc. v. Altair Eyewear, Inc.*, 386 F. Supp.2d 526 (S.D.N.Y. Sep 9, 2005)**

Robinson, J.

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Claim 1:
An eyeglass device comprising:
a primary (respectively auxiliary) spectacle frame for supporting (respectively auxiliary) primary lenses therein,
said primary (respectively auxiliary) spectacle **frame including**
a middle bridge portion,
a first magnetic member secured in said middle bridge portion of said primary spectacle frame,
an auxiliary spectacle frame for supporting auxiliary lenses therein,
said auxiliary spectacle frame including
a middle bridge portion having a projection extended therefrom
for extending over
and
for engaging with said middle bridge portion of said primary spectacle frame,
and
a second magnetic member secured to said projection of said auxiliary spectacle frame
for engaging with said first magnetic member of said primary spectacle frame and
for allowing said auxiliary spectacle frame to be attached to said primary spectacle frame with only one hand by a user."

ii. [Construction of] Frame

… [PO] insist[s] that the term "frame" should be read to encompass both rimmed and rimless eyeglasses, such that a frame made up only of pins or screws is as much a "frame" as one taking the form of a rim around the lenses. The [AI], on the other hand, argues that a "frame" is an eyeglass device that includes, at least, a bridge and rims. [AI] insist[s] that the rims have to at least partially surround the lenses and, if the rims do not completely encircle the lenses, the frame must include some sort of rim wire to hold the lenses in place.

[AI's] argument, which focuses on the language of the claim itself, is more faithful to the principles of claim construction outlined in *Phillips*, and is more persuasive to this court. As [AI] points out, the relevant claim describes the frame as supporting

lenses "therein" and "including" a middle bridge portion. Because the claim discloses a frame that supports lenses "therein," the frame must be capable of supporting the lenses in the frame, and only a frame with rims is capable of supporting lenses in the frame. In addition, the claim language requires that the frame "**includ[e]**" a middle bridge portion, which indicates that the frame **must also have other components**, i.e. rims. Therefore, considering the term "frame" in the context in which the term is used in the asserted claims, which the Federal Circuit instructed district courts to do at the outset of their claim construction analysis, *see Phillips {MAP 10:55-60}* strongly compels the finding that the term "frame" includes some kind of rim surrounding the lenses.

This conclusion is supported by an analysis of the specification. Specifically, the Patents-in-Suit are devoid of any language disclosing any kind of "frames" other than those containing rims. On the contrary, the specification of the '054 Patent discloses

> "an eyeglass device in accordance with the present invention comprises a primary spectacle frame 10 for supporting primary lenses therein,"

and explains that

> "an auxiliary spectacle frame 20 is provided for supporting the auxiliary lenses therein,"

crucially, the primary spectacle frame 10 in Figures 1 and 2 and the auxiliary spectacle frame 20 in Figures 1-3 of the '054 Patent all include rims. In fact, each of the over thirty diagrams and figures in the Patents-in-Suit disclose eyeglass devices that clearly include rims. [PO] respond[s] by pointing to a series of generalized disclaimers explaining that the specifications provided in the Patents-in-Suit are not intended to foreclose other variations that are within the scope of the claims. [The court quotes the specification stating the embodiment in the specification is for **example only**]. Although this court is mindful of the Federal Circuit's repeated admonition to avoid "reading limitations from the specification into the claim. [FN 2]

> [FN 2] That said, this court agrees with the Federal Circuit that the distinction between using the specification to interpret the meaning of a claim and importing limitations from the specification into the claim can be a **difficult one** to apply in practice**.**

{See MAP 14:58-69 (Cross ref to Phillips language) - MAP}

[PO's] generalized statements are nevertheless unpersuasive, for several reasons.

First, [PO has] pointed to various places in the Patents-in-Suit in which the patentee described specific ways in which the disclosed inventions could be changed. [FN 3]

> [FN 3] Admittedly, two of the Patents-in-Suit also contain language explaining that, "different types of auxiliary frames and different forms of primary frames, individually, is also a different embodiment of the present invention." But this language simply **begs the question of whether "frames" can be rimless.** It says nothing about the ways in which frames can differ from each other, and can easily be read as allowing for frames with rims made up of different materials.

The **absence** of any specific statement about the possibility of frames with or without rims **argues against** construing the term "frames" to include rimless frames. Generalized disclaimers provide no guidance in defining which variations are within the scope of claim language and which are not…. Therefore, the court finds that the specifications in the '054 Patent and the other Patents-in-Suit clearly suggest that "frames" include rims.

In addition, [PO] argue[s] that this court should be persuaded by other district courts that have rejected many, if not all, of [AI]'s arguments and adopted [PO's] interpretation of the term "frame" in the '054 Patent and in related patents. [The court cites D. Nev. and C.D Cal. decisions regarding construction of "frame" in this patent]. Although this court has reviewed these decisions, the court is not persuaded by them.

First, these decisions were made before the Federal Circuit clarified the principles of claim construction in *Phillips*. Second, **the unwillingness** of the Federal Circuit to itself give **any deference** to the claim construction findings of District Courts further dissuades this court from giving significant precedential value to judgments of its colleagues. *See Cybor* [*v. FAS Techs.*, 138 F.3d 1448 (Fed. Cir. 1998) (en banc)] (the Supreme Court [stated] this court's role in providing national uniformity to the construction of a patent claim … would be impeded if … deference to a trial judge's asserted factual determinations incident to claim construction [was required]). Evidently, the Federal Circuit believes that it is its responsibility -- not the collective responsibility of federal courts -- to ensure uniformity of claim construction, and the Federal Circuit will likely have the opportunity … in this case.

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{This case is presently in summary judgment proceedings. We will have to wait and see if the prediction of Federal Circuit review proves prophetic - MAP}.