

Intellectual Property Litigation

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YOU DON'T SAY

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What follows is a lightly edited version of a talk that I gave at the September 2003 Association of Patent Law Firms Roundtable on Markman Hearings. I was asked to talk about the use of the file history in Markman. As you will see, I devoted most of the talk to discussing the language versus the thing-in-itself dichotomy that underlies patent claim construction . . .

The Role of Words Versus The Invention

I have an idea that I want to focus on today. It is a small insight into Markman and, indeed, claim construction even predating Markman. It is an insight that is useful and can help to organize our thinking about Markman and claim construction. It is an insight that will be obvious to those of you who are sophisticated about patents. But even for sophisticates, I think it is useful — and for those of you who are a little less sophisticated, I think it can be a powerful insight. Let's look at figure 1.

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DICHOTOMY

- Look at the invention. What did the inventor invent? Let that determine the claim scope.
- Look at the words used to describe the invention. Let the words determine the claim scope.

Figure 1

The insight is this. There are two very different ways of construing claims. They are not mutually exclusive as we will see, but they are very, very different. The first approach is to look at the invention, discern what the inventor invented and let that determine the claim scope.

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The second approach is to look at the words that are used to describe the invention and let the words determine the claim scope.

This dichotomy is key to understanding what the courts do in claim construction.

Now, I know what some of you are thinking. You are thinking to yourself that this dichotomy, this problem, is the same problem that Plato wrestled with in his famous allegory of the cave. You are right. It is a new take on the same old problem. If there is time at the end, I'll have another thought about that. But let's push on and keep talking about claim construction. Let's look at figure 2.

LOOK AT THE INVENTION

- » Emphasis on technology and invention
- » Give inventor claim scope co-extensive with his invention
- » Intuitive to the non-lawyer public
- » Criticism – May not serve the public notice function very well

Figure 2

If you are in the school of thought that wants to emphasize the invention for purposes of determining the claim scope, you are going to behave a little differently than if you are in the school that emphasizes the words. If you are an invention person, you are going to place the emphasis on the technology and the invention itself. I think of this as the thing-in-itself. You will try to give the inventor claim scope that is coextensive with the thing that he actually invented. Now, this is the intuitive way of doing claim construction to non-lawyers. That is what non-lawyers think patents are. They think the coverage that one receives in a patent is exactly the same as the thing that the inventor invented. We lawyers know that is not quite right.

In fact, we know that often inventors are arguing for claim coverage that goes beyond and is broader than the thing that they actually invented. That is very common, in fact. Indeed, a good argument for construing claims by focusing on the invention is that this approach accords with the public's common sense view of what a patent ought to cover.

Perhaps, ironically, the main criticism of doing claim construction based on the invention — the thing in itself — is that this approach may not serve the public

notice function very well. The public is represented by patent lawyers. Patent lawyers look at the claim language. In this way, the public relies on the words that are used in the claim. In some cases, the public is engineering around those words, in reliance on those words. If the court were to minimize the importance of those words, and base the claim scope upon the actual invention, then it is possible that people who rely on the words in the claim would find themselves in a position of being an infringer. That is not very fair. This is the principal criticism of focusing on the invention to determine claim scope. Let's look at the figure 3.

LOOK AT THE WORDS IN THE CLAIM

- » Minimizes the technology and invention
- » Court is a linguist and uses the tools of a linguist to determine claim scope
- » Claim meaning serves the public notice function
- » Criticism – May end up with a claim meaning that does not fit the invention

Figure 3

If, on the other hand, you are in the camp that wants to emphasize the words of the claim, then you will minimize the technology in the invention to some degree. The technology will not be your focus. Instead, you are going to act like a linguist. You are going to use the tools of a linguist to determine the claim scope.

Let's think about that a bit. I don't mean to turn claim construction into a liberal arts exercise. Almost all my colleagues at my firm are trained in one area of technology or another. But I am not. I was trained in math and philosophy. Because I am not an engineer, my colleagues sometimes accuse me of litigating some of these difficult patent issues by turning them into liberal arts exercises. Let me be clear that I don't advocate that. Even acting as a linguist, which is essentially a liberal arts activity, you must have a command of the technology. So much of language takes its meaning from context. And the linguistic context of most patents will be the technology and the language used in talking about that technology in the relevant field of art. So, although the court acts as a linguist, the claim construction exercise is still very much an exercise in technology, but more so the language of technology.

The main benefit of emphasizing the words as the principal way of developing the claim meaning is that this is the approach that serves the public notice function the

best. This approach allows people to read the claim, to understand the claim and to rely on that understanding based on the words that are used. Often, the public will rely on the claim language so as to develop new technology free of infringement. That is of value to the public and that value is optimized by the approach that focuses on claim language.

The principal criticism of this approach is that sometimes we wind up with claim meanings that really don't fit the invention very well. As I said earlier, and as most people here today probably know, often patent litigation is all about making the claim mean something other than what was invented in the first place. Arguably, that is not socially useful. And, arguably, to the extent that we emphasize the words over the invention, we allow patent cases to be made out in situations where there is a lack of fairness because the claim has taken on a meaning far removed from the invention that gave rise to the patent in the first place. Let's look at the next figure.

PROCESS IF EMPHASIZING THE INVENTION

If the court focuses on the invention, then:

- Claim construction is a wide open exercise
- All information that bears upon 'what is this invention'
- Distinction between intrinsic and extrinsic evidence is not important
- No type of evidence is favored over any other type of evidence

Figure 4

Let's think about how the claim construction process will be different if you are an invention person vs. a words person. If you are a person who emphasizes the invention, then the claim construction process for you will be different than if you emphasize the words. If your focus is on the invention, then the Markman process is going to be a wide open exercise. You are going to want to receive into evidence all of the information available that will help you to understand what was invented. What did this inventor invent? Distinctions like the distinction between intrinsic and extrinsic evidence are not going to be very important. You are not going to favor one kind of evidence over any other kind of evidence because you will consider all the evidence that is probative and you will assign it the weight it deserves based on the circumstances. You will not have preconceived ideas about what sort of evidence you might receive or not receive. That is, if you are emphasizing the invention. Next figure.

PROCESS IF EMPHASIZING THE WORDS USED IN THE CLAIM

If the Court focuses on the claim language, then:

- Develop 'rules of construction' for resolving ambiguities
- Certain kinds of evidence will be favored
- Intrinsic/Extrinsic distinction will be meaningful
- Rules of construction may be hierarchical ala' UCC § 2-202

Figure 5

On the other hand, if you emphasize the words that are used in the claim and not the invention, then you probably will use a different process. You will develop rules of construction for resolving ambiguities. That is what linguists do. You will favor certain kinds of evidence over other kinds of evidence and the intrinsic/extrinsic distinction may become meaningful if you are a words person vs. an invention person. I note in the last bullet point in this figure that your rules of construction, if you take the linguistic approach, may well become hierarchical.

That is what happens in other areas of the law. Consider the UCC Section 202. Some of you will recall that Section 202 is the rule that addresses what the court should do when there is an ambiguity in a contract governed by Article 2 of the UCC. The rule there, I will paraphrase — and I apologize if I don't get this exactly right because it has been 26 years since I studied the UCC in law school — if there is an ambiguity in the contract, you look first within the four corners of the document. If the language within the four corners of the document does not resolve the ambiguity, then you proceed through a hierarchy of evidence. You look next at the course of performance of the contract in question by the parties. If that doesn't resolve the ambiguity, you then look at the course of dealing between the parties. In other words, you consider things that that parties have done together over the years that are not necessarily specific to the contract. If that does not resolve the ambiguity, then you look at usages of trade. If that does not resolve the ambiguity, then you consider parole evidence, but the parole evidence can only be consistent with the terms. It cannot contradict the terms. As the court, you can consider parole evidence to explain the terms. So, under the UCC, you go through this hierarchy. Similarly, if you are a words person in the context of Markman, then you may well develop a similar hierarchy of rules of construction that you will use to interpret claims in a patent. Let's look at the next figure.

EARLY – PENDULUM SWINGS TOWARDS CLAIM LANGUAGE

- *Vitronics v. Conceptorics*, 90 F.2d 1576 (1996) – intrinsic v. extrinsic; court turns to extrinsic only when intrinsic is insufficient to establish the clear meaning
- Plain language – use of dictionaries
- Inventor testimony disfavored
- Expert testimony disfavored

Figure 6

Early on after *Markman*, the Federal Circuit very strongly indicated a preference for emphasizing the words. The *Vitronics* case is, perhaps, the trumpet call for emphasizing the words in a claim over the invention. The *Vitronics* case firmly established the dichotomy between intrinsic and extrinsic evidence. And the court firmly expressed a preference for intrinsic evidence in *Vitronics* over extrinsic evidence. In fact, the court said, you are to look at the extrinsic evidence only if the intrinsic evidence is not sufficient alone to establish a clear meaning. Thus, *Vitronics* established the beginnings of a hierarchy of proofs similar to the example I gave from the UCC.

Following *Vitronics*, there are a whole number of cases that talk about giving claims the meaning of their plain language. These cases fall right in line with *Vitronics*. They say that we are to look at the plain language of the claim. We're going to look within the four corners of the document, if you will, and only within the four corners. Thus, if you are a claims language person, then you are not going to be very interested in what the inventor has to say. Nor are you going to be very interested in what experts have to say. Such extrinsic evidence is strongly disfavored in many of the cases following the logic of *Vitronics*. Let's look at the next figure.

PENDULUM MAY BE SWINGING BACK A BIT

- Recent cases open the door for more expert testimony
- Unclear whether expert testimony is received for the purpose of informing the court about the invention or about the use of language in the field of art

Figure 7

Lately, the pendulum may be swinging back a bit from the hard line *Vitronics* approach. I am not confident of this, to be candid, but I am aware that there are recent cases that open the door for more expert testimony. Some district courts have been reversed or criticized for not receiving expert testimony. The reason why it is not completely clear that the pendulum is swinging back on this word vs. invention dichotomy is because it is not clear yet whether the reason for encouraging courts to receive expert testimony is for the purpose of informing the court about the invention or for the purpose of informing the court about the words and how the words are used in the relevant field of art. If it is the latter, then the focus is still on the words, not the technology. In the latter case, the pendulum has not moved because the law is not moving in the direction of talking about and emphasizing the invention. Next figure.

WHAT ABOUT THE USE OF FILE HISTORIES?

- Both approaches favor use of file history
- File history always relevant and always in evidence
- If you are in the 'look at the invention' camp, you will tend to use the file history for the purpose of understanding the invention
- If you are in the 'look at the claim language' camp, then you will use the file history more like a dictionary to see how words were used during prosecution

Figure 8

What about the use of file histories? What role do they play in claim construction? Both approaches favor the use of the file history. The file history is always relevant. It is always going to be in evidence. It is always something that must be considered. Whether you emphasize the invention or the claim language, you want to look at the file history. But you may use the file history differently depending upon whether you are in the invention or the claim language camp. If you are in the invention camp, then you will look at the file history to try to understand what the inventor invented. In contrast, if you are a claim language person, you will look at the file history as a dictionary. You will focus on how the inventor used words when he was communicating about his invention to the Patent Office. Look, please, at the next figure.

HOW HAS THE FEDERAL CIRCUIT USED FILE HISTORIES?

- Most often, the court has used the file history to understand the invention
 - ┆ Disclaimer of scope to distinguish the invention from prior art may affect the scope of the claim. *Rexnord v. Laitram*, 274 F.3d 1336 (Fed. Cir. 2001).
 - ┆ Must be clear and unmistakable to deviate from plain meaning of claim. *Omega v. Raytek*, 394 F.3d 1314 (Fed. Cir. 2003).
 - ┆ Examples:
 - *Bionx v. Linvatec*, 299 F.3d 1378 (Fed. Cir. 2002)
 - *Fantasy Sports v. Sportsline.com*, 287 F.3d 1108 (Fed. Cir. 2002)
- Sometimes like a dictionary. Check the usage in prosecution.
 - ┆ Examples:
 - *Gutman v. KopyKake*, 302 F.3d 1352 (Fed. Cir. 2002)
 - *Compare Boehinger v. Schering-Plough*, 320 F.3d 1339 (Fed. Cir. 2003) (Patentee does not renounce the ordinary meaning merely by submitting a reference that employs a different meaning. Patentee limits meaning only if he relies on the narrower meaning.)

Figure 9

Now we are getting down to the nitty gritty. How has the Federal Circuit used file histories? I looked at about 50 cases. Many of them were in summary form, but I looked at the entire opinion in a number of cases -- maybe 17 or 18 opinions. These opinions were all rendered in the last 2½ years. Based on my review, I conclude that to the extent that you can quantify what's going on, I would say that most often the Federal Circuit is looking at the file history to understand the invention. I think what is happening is that the court is focusing on and emphasizing plain meaning as the way to get to the correct construction, but as a double check, a sanity check if you will, the court looks at the file history to see what the inventor said about the invention to determine if there is a conflict between what the inventor says he invented in the file history vs. the plain meaning of the words that were used to claim the invention.

There is a tension here. For example, in the *Rexnord* case, a noteworthy case, the court said that disclaimer of scope to distinguish the invention from prior art may affect the scope of the claims. But, in the *Omega* case, the court said that the disclaimer must be clear and unmistakable to deviate from plain meaning of claim.

This contrast is an excellent example of the tension between claim language and the invention. The court tells us to look at the plain meaning. We do that and try to understand the plain meaning, but then we look at the

file history to see if there is something in the file history that might tell us that the plain meaning is not the correct meaning. In other words, we're going to do a sanity check by looking at what happened during the prosecution of the claims.

I offer some examples in figure 9. If there had been time I would have changed figure 9 a bit. I think the *Bionx* case is a fair example, but it requires interpretation because what the court says makes the opinion confusing. So, let me put *Bionx* aside for a moment because it is a little muddled. I'll come back to it in a second.

The *Fantasy Sports* case is a very good example of where the file history leads to a meaning that is more restrictive and narrow than what the plain meaning of the words used in the claim. Unfortunately, I am running short of time and I'm not going to be able to go into the facts of that case as I had hoped to. But, read that case and you will see where the court comes out -- plain meaning means *x*, but the plain meaning cannot be the claim meaning when looked at in view of the prosecution history. The prosecution history requires that the claim must be narrowed.

In contrast, sometimes the court looks at the file history to see if it can be used as a dictionary. An example of that is *Gutman v. KopyKake*.

As I said, the *Bionx* case is interesting. I think the court is looking at the invention to arrive at a construction narrower than the plain meaning, but the opinion is muddled because the Court says that it is just using the file history as a lexicon. The court says in the opinion that the prosecution history provides an explicit definition of the contested claim language. The court then characterizes how the inventor talked about the claim language during the course of prosecuting the claims and adopts that definition. Of course, the reason why the inventor was talking about the meaning of the claim was to distinguish it over prior art. So I think what the inventor did was not to define a term so much as to simply tell the examiner, hey, that's not my invention. But you should look at the opinion and decide for yourself. Perhaps, it is a case that straddles both the invention and the claim language approach to claim interpretation.

Please look at the next figure.

PRACTICAL THOUGHTS

- Good Resource – IPLAC annual survey of claim construction cases
- File history is intrinsic – Admissible and available for unlimited use in Markman.
- File history very valuable for cross-examining technical experts (or even an inventor if he should testify)
- Be careful not to characterize the prosecution history too aggressively.
- Art considered by the examiner is also intrinsic. *Tate Access v. Interface Architectural Resources*, 279 F.3d 1357 (Fed. Cir. 2002)
- Art not considered by the examiner is extrinsic. *Tate Access*. But see *Zodiac Pool Care v. Hoffinger Industries*, 206 F.3d 1408 (2000) dicta (cited art is intrinsic; but leaves open whether art cited by the applicant, but not considered, is extrinsic.)
- Constructions that exclude disclosed embodiments “are, rarely if ever correct.” *Abbott Labs v. TorPharm*, 300 F.3d 1367 (Fed. Cir. 2002)
- Rule in *Eastman Kodak v. Goodyear*, 114 F.3d 1547, 1556 (Fed. Cir. 1997) (the court “seeks to interpret claims to preserve, rather than defeat, their validity”) is just a “tie-breaker” rule.

Figure 10

Let me explain. These thoughts are not presented in any organized way, but I think they are things that should be said. I will begin by saying that if you have access to the Intellectual Property Law Association of Chicago annual survey of the claim construction opinions of the Federal Circuit, then this is a terrific resource. It is marvelous and if you can get your hands on it, you should. It is excellent and very useful.

Second, there is no debate about the fact that the file history is always intrinsic. Everybody agrees on that. It is always available for unlimited use in Markman. It can be cited in briefs, it can be used to examine witnesses, it can be argued from and so forth. So you must study and know the file history. It is a treasure trove of information. I will offer one piece of cautionary advice. Be careful not to characterize the prosecution history too aggressively. I see this all too often. Lawyers characterize what happened in the file history, but when the court reads it, it turns out that what actually happened is not as clear as represented. Often there is an innocuous explanation of what happened in prosecution that is at odds with how the accused infringer has characterized it. You have to set up your argument characterizing the file history through depositions or it will not stick in the Markman hearing.

Another important point to remember is that art considered by the Examiner is intrinsic, but art cited but not considered by the Examiner may be extrinsic. The cases

have not fully resolved the latter question. If there is an information disclosure statement that cites art, the fact that the IDS is in the file history may not make all cited art intrinsic.

Next, I note that a claim construction that excludes a disclosed embodiment will rarely be correct. This is another example of how courts use the inventor’s statement — here’s what I invented — as a reality check against the plain meaning of the claims. If the plain meaning of the claim reads in such a way that it excludes disclosed embodiments, then there may be something wrong with the plain meaning and you have to reevaluate the construction.

I note *Eastman Kodak*. This is the old salt stating that the court is to construe a claim to preserve its validity. That requires some explanation. The freedom of the court to construe to preserve validity is not unlimited. When you see a claim construction case where the court reviews the file history and looks at what the inventor said about his invention in order to distinguish prior art, there is a limit to what the court can do in terms of construing the claim to avoid that art. A good case on that point is *Tate Access v. Interface Architectural Resources*, 279 F.3d 1357 (Fed. Cir. 2002). There, the court said “where claim language is clear we must accord it full breadth even if the result is a claim that is clearly invalid.” The court does not have unlimited authority to strain to construe claims in such a way as to avoid prior art — if the plain meaning renders the claim invalid — no matter what the inventor said during prosecution.

To end, I said that I would offer a thought about Plato’s allegory of the cave. There is a useful point here. People have struggled with the distinction between the thing in itself and the words that are used to represent the thing for more than 2,000 years. Smart people have wrestled with this issue throughout our intellectual history, including Plato. I think we need to be patient with the Federal Circuit as the judges there wrestle with it too. They are working it out. I think that what the court is doing, though sometimes a little confused, for the most part makes good sense. And, I think it is helpful to think about claim construction by referring to the dichotomy between the thing-in-itself and the words used to describe the invention.

With that, I thank you for your attention.

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