Methodology of Claim Construction after *Phillips v AWH Corp*: The Need for an Alternative Approach

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Patents are considered as one of the most important and critical intellectual properties. This is so not just because patents serve to develop scientific temper and thereby result in scientific progress, which is very critical for any civilization to develop. This is also because, economically, patents are the most reaping. The emergence of the TRIPS regime has only served to underscore its significance.

Given that patents are of much significance, patent claims, which define the area of the patentee’s monopoly – play the most important role. Despite their significance, the author feels that patent claims have not received as much importance as they deserve. This is especially so with reference to principles of claim construction. World over, courts and patent offices seem to be meandering and wavering in their approaches towards claim construction and the USA is no exception. This article attempts to critically analyse the recent *en banc* decision of the Federal Circuit in *Phillips v AWH Corp* and trace the evolution of principles of claim construction as applied in the USA. The implications, ramifications and faults with the approach in the *Phillips* case are observed and the author has proposed an alternative approach to construe and interpret claims.

**Keywords:** Claim construction, patent, Phillips, Texas Digital, intrinsic sources, extrinsic sources

“*[T]he name of the game is the claim.*”¹

The Section 10 of the Patents Act, 1970 mandates that complete specification ends with one or more claims defining the scope of the invention. From a practical point of view, claims are the most crucial aspect of a patent and the process of defining claims or terms used in claims to resolve this ‘scope of invention’ is termed as claim construction or interpretation.² Claims identify the metes and bounds of an inventor’s monopoly and the essential step in the process of adjudicating any infringement action in patent law is to verify if the claim scope covers the infringing technology. The first step in this process is to interpret the claim to decipher its scope. In other words, claims maintain their significance throughout the life of a patent and serve to protect the rights of the patent owner.

Unfortunately, despite the functional and economic value of claims, claim construction has remained largely underdeveloped and unsettled, even in a nation like the USA where patent law is considered to be in a more developed state than what it is in India. In an area which serves as a classic illustration of multi-disciplinary approach, the synergy between science and law seems to make claim construction a complex question. There is neither a statutorily encoded principle nor has there been any settled position of law laid down by the judiciary, as to the principles applicable in claim construction. Instead, courts have been vacillating between two extreme standards. It is in this context that the *en banc* decision of the Federal Circuit in *Phillips v AWH Corp* becomes very important since the decision has made an effort to clarify an apparent conflict in previous decisions in the USA.

A step-by-step analysis of the entire course of proceedings of the *Phillips* case, throwing light on the history, facts, decision and reasons given at various levels of the judiciary followed by a critical appraisal of the ratio of the *en banc* panel has been made. The author has made an endeavour to generally highlight few fallacies and problems with the principles laid down in that case. Specific issues have been dealt with in detail as and when necessary. In the end, the author has provided an alternative approach to claim construction which is argued to solve various problems and difficulties highlighted with the existing approach after the *Phillips* case.

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The article’s scope is limited to principles of law applied in the USA; discussion of the position of law in the EU / UK is not considered due to two reasons, the first being the primary and fundamental one: (1) in the EU, claim construction is regulated by Article 69 of the European Patent Convention, which is further supplemented by a ‘Protocol on the Interpretation of Article 69,’ adopted at the Munich Diplomatic Conference for the setting up of a European System for the Grant of Patents on 5 October 1973. Currently, UK courts follow Article 69 and the Protocol of the EPC for claim interpretation and Section 125 of the UK Patent Act, 1977 provides the basis of that. Although controversies have arisen as regards the interpretation and application of these provisions, but these provisions provide the basic parameters on claim construction.

The Indian statute on the other hand, similar to its counterpart in the USA, has no such stipulations on claim construction, leaving it completely open for the judiciary to play its hand. However, patent litigation in India and as a result, judicial action, let alone activeness in this area, is restricted. Neither the Indian statute nor any judicial decision specifically deals with the question of patent claim construction with sufficient clarity. Following the case-law trend in the USA, where claim construction principles have been developed in its entirety by the judiciary, would prove useful in this regard, especially in the context of litigation dynamics. As a result, decisions in the USA provide a much more in-depth approach towards claim construction.

The decisions in the USA may, therefore, provide a better platform to witness the consequences, advantages and disadvantages of taking any given principle of claim construction to its extremities. What one may learn from the experience in the USA would definitely contribute in the development of law in India. By looking at the disadvantages of various approaches of claim construction in the USA, the author has proposed his own method to interpret claims, which may provide a template for courts in India.

The second reason being, the paper would otherwise become extremely long and tedious to cover. A second limitation is that the author presumes the reader not to be a novice in patent law and thus familiar with the basics of claim interpretation, including various intrinsic and extrinsic evidences.

**The Phillips Case**

**Factual Background**

The case arose out of a patent infringement suit, among others, by the patent owner (Phillips) against the defendant (AWH Corporation), an ex-licensee, whose contract with the plaintiff to market and sell his patented product had terminated by efflux of time. The patent was titled ‘Steel shell modules for prisoner detention facilities’ (hereinafter ‘the Phillips patent’), which was in essence steel modular panels that could be easily added / welded to detention areas for jails or other similar facilities when the main facility overflows. The walls of these panels were double layered steel. The alleged inventive step claimed was that in between these outer and inner steel walls, were placed ‘internally directed’ steel ‘baffles’ such that apart from providing structural support to the walls, it also provided ‘impact resistance’ - bullet-deflecting capabilities.

In the course of proceedings in the District Court, the Court concluded that infringement depended upon what the term ‘baffles’ meant in the below mentioned claim 1 of the Phillips patent. That is, if claim 1 required the baffles to be disposed at angles other than ninety degrees (either acute or obtuse), then infringement is not established; else if the baffles could be disposed at all angles including ninety degrees, then infringement is established. Note however that claim 1 was devoid of any reference to the angle at which the baffles must be placed.

The District Court concluded from its claim construction analysis of claim 1 that the baffles were not required to be disposed at perpendicular angles and granted the defendant’s motion for summary judgment of non-infringement. On appeal, the Federal Panel (Phillips I) affirmed the decision of the District Court on other grounds, which was later vacated by way of the order of the Federal Circuit to rehear the appeal en banc so as to resolve seven questions framed by the Court concerning the construction of patent claims (Phillips II). Briefly speaking, the questions dealt with the relevance and role of dictionaries, specification, other intrinsic & extrinsic evidence and their hierarchy, if any, in interpreting patent claims.

**Majority in Phillips I**

The majority in Phillips I construed the claim term ‘baffles’ to exclude structures that extend at a 90 degree angle from the walls. At the first stage, the
The panel analysed and concluded that the relevant claim was in ‘means-plus function format’. Therefore, the panel reasoned that the patent specification is intended to support and inform the claims, and the specification in question was rife with references to the property of the building material to be impact-resistant. And this property of impact-resistance arose only when the baffles were angled and were not perpendicular. Further, all the diagrams indicated baffles disposed at such angles so as to deflect projectiles like bullets. The panel thus concluded that the specification made it unmistakably clear that the invention involves baffles angled at other than 90 degrees and as a general rule regarding means-plus function claims, the claim is to be restricted to only structure disclosed in the specification. Clearly, majority in Phillips I favoured the specification as the predominant intrinsic factor in construing claims.

Minority in Phillips I

The dissenting opinion by Judge Dyk criticized heavy influence placed on the specification. Taking an approach that was in complete contrast to that of the majority, the dissent first considered an ‘ordinary meaning’ of the term ‘baffles’ as adapted from the Webster’s Dictionary to mean ‘something for deflecting, checking, or otherwise regulating flow’. Then the Court considered if the patentee, ‘acting as his own lexicographer, gave a special meaning to the term baffles’. Answering this question in the negative, the dissent concluded that there was nothing anywhere in the claim itself or the prosecution history that indicated the patentee’s intention to limit the ordinary meaning.

With reference to the specification mentioning only those baffles at angles other than 90, the dissent held that nothing in precedents indicated that the claim scope is to be restricted to merely single embodiment in the specification. Harping on the lack of any disclaimers in the specification or prosecution history and that no argument was raised that one of skill in the art would ascribe a specialized meaning to the term baffles, ordinary meaning of the term as from dictionaries would apply. Clearly this approach accords external sources (specifically dictionaries) a much higher status in construing claims and finding the ‘ordinary meaning’ of a claim term; specification used at a later stage only to the extent to verify for disclaimers against such an ordinary meaning.

The en banc Decision (Phillips III)

Before proceeding to the claim construction analysis, the Court first clarified that the claim did not belong to the category of ‘means-plus-function’. Re-iterating settled principles, the Court opined that since patents are addressed typically to those skilled in the field of invention, claim terms must be defined according to their ordinary and customary meaning as would be understood by a person of ordinary skill in the art. That being the case, the Court concluded that such persons would refer to the claims without losing sight of the background technology that is clearly embodied in the specification.

From such a presumption, the Court reasoned that firstly, meaning of claim terms must be sought from ‘intrinsic evidence’, which refers: (a) context and usage of the disputed claim and other claims; (b) specification; (c) prosecution history. In terms of hierarchy among these sources, the Court seems to indicate that the use of specification is ‘dispositive’ and therefore emphasized on the probative value of the specification over other sources. Although the Court did indicate relevance of prosecution history as an afterthought, the Court cautioned against its value since it merely represented ‘ongoing negotiations’ rather than the final product and thus lacks the clarity of the specification.

Proceeding further, the Court dealt with the role of ‘extrinsic evidence’ in the process of claim construction, and held that dictionaries, encyclopaedias, treatises and expert testimony can familiarize the judge with the technical terminology and understand the underlying technology of a patented invention and the prior art, but not be part of interpreting claims as such. However, the tenor of the Court, while holding that such evidence is ‘less significant’ and therefore less reliable compared to intrinsic evidences, indicates caution. The Court provides four reasons for such suspicion: (a) they do not have the advantage of being simultaneous in time with the claim as the specification is; (b) they may have been tendered by unskilled persons; (c) they have not been tendered to specifically define the scope and meaning of terms in the invention; and (d) it increases the burden on the Court to filter out relevant evidence since each party may choose many such extrinsic evidences to support their contention.

But while applying the above principles to claim 1 of the Phillips patent, the Court actually never did apply them to the facts! The Court noted:
(a) The language of claim 1 does not *per se* indicate any limitation as to the angling of the baffles,15 which was consistent with the dictionary meaning of the term.18

(b) The fact that defendant claims 219 and 620 and other claims have expressly mentioned the requirement of angling, its absence in claim 1 indicates that such a limitation was not intended by the patent holder.21

(c) Independent claim 1722 that dealt with the baffles being placed at angles to deflect projectile, buttresses the view that it would be unnecessary if persons of skill in the art understood that the baffles inherently (without any limitation as to the angle) served such a function.15

Therefore, though throughout the specification, the diagrams always indicate baffles that are angled; the patent involved multiple objectives apart from just having the ability of deflecting projectiles23 that may be achieved even without angling the baffles. The function of deflecting projectiles was expressly mentioned only in claims 2, 6, 17, and 23, which would necessitate such angling (apart from 90 degrees).24 The Court thus held that reading the patent in its entirety, claim 1 cannot be restricted to any particular angle and includes perpendicular baffles as well. To further complicate things, both previous courts had concluded that if claim 1 included baffles at ninety degrees, then it would invalidate the claim over the existing prior art. Nonetheless, the Court declined to entertain the argument that claim 1 must be interpreted narrowly for this reason on the grounds that the principle of interpreting claims to preserve their validity did not apply to claims that are unambiguous,25 such as the one in this instant case. The case was thus remanded to the district court to re-examine the matter based on this finding.15

**Analysis of Phillips Case**

**Analysis**

Before turning to an in-depth analysis of the panel decision in *Phillips III*, there are a few preliminary points to be highlighted:

First, similar to the approach in *Phillips I*, the panel in *Phillips III* re-iterated the specification approach, but interestingly came to the opposite conclusion. The *en banc* reversed the panel finding that actually used the same approach, but disagreed on the conclusion. The Court’s decision as to the meaning and scope of the term ‘baffles’ was indeed baffling! If one reads the above analysis closely, it would be apparent that though, in theory, the specification was given a primary position by the panel in *Phillips III*, in practice, this hierarchy was lost. With reference to the Phillips patent, the panel decided the case completely on the basis of the entirety of the claims and context of the claim in terms of other claims. Although this was also based on claim context, which is also intrinsic evidence, this was given more importance than the specification.

Second and on a more important note, the *Phillips III* panel overrules the *Texas Digital* series of cases, thereby diluting the use of dictionaries and emphasizing the importance of the specification, claims, and prosecution history in determining the meaning of the words in the claims.26

Therefore, in terms of the *ratio decidendi* of the decision, the principle of law laid down by the panel could play a decisive role in future cases, especially from the perspective of the District courts, considering the fact that the decision is an *en banc* one.27

**Apparent Issues with the Phillips III Decision**

**Means-Plus-Function Claims vs Other Claims**

Firstly, the decision in *Phillips III* has blurred the distinction between ‘means-plus-function’ claims and other formats. This will require some explanation. A ‘means-plus-function’ claim or a ‘means’ claim in short, conveniently uses functional language at the exact point of novelty without actually describing the invention.28 32 U.S.C. § 112, paragraph 6, makes a legislative mandate (use of the word ‘shall’) that the claims be interpreted to cover the corresponding structure, material, or acts described by the specification. In other words, the effect of a ‘means’ claim is to incorporate into the elements and limitations of the claim the embodiment disclosed in the specification.10, 26

The history of means claims would show that they occupy a special position. Originally rejected for being ambiguous and indefinite. As an illustration, the following was part of the claim in the patent in dispute in the *Halliburton Oil Well Cementing Co* case:

…means associated with said pressure responsive device for tuning said receiving means to the frequency of echoes from the tubing collars of said tubing sections to clearly distinguish the echoes from said couplings from each other.
In disallowing this claim, the US Supreme Court held that the scope became too broad and indefinite since any device that performed the function was arguably covered within the scope. Means claims' saving grace came by way of a legislative addition of § 112, paragraph 6, which thereby legislatively overruled the US Supreme Court's decision. However, as a matter of caution, to make such claims more definite and certain, this mandate required that the claim scope be restricted to structure described in the specification. In other words, restricting the scope of means claims to the structure in the specification was a deliberate policy lever to overcome doubts of ambiguity and indefiniteness in such claim formats.

Post the en banc decision in In re: Donaldson Co, this special feature of means claims has made all the difference between plain language claims and means claims. It has always been considered by scholars and judges alike that the use of means claims thereby narrows the claim to the particular structure in the specification, a limitation that plain language claims do not suffer from. But after the ratio in Phillips III, this is no more a distinction. Even in plain language claims, specification becomes primary document for defining the claims. This belittles the distinction between means claims and other claim formats. It is to be remembered that the means claim is a statutory claim format, which specifically mandates the use of specification. Whereas, in terms of other claim formats, there is no such statutory mandate.

Role of Specification

This criticism follows directly from the point made above. In the words of the Texas Digital court, it has always been considered as one of the ‘cardinal sins of patent law’ to read a limitation from the written description into the claims. Interestingly, the Phillips court specifically recognizes this concern in the course of its judgement, but disagreed with the approach taken by the court in Texas Digital, on the basis that it restricts the role of the specification in claim construction.

To the Phillips III panel, though limitations must not be read into claims from the specification, a claim must be interpreted in the light of the specification. The Court even attempts to make a distinction between the two and this is where the reasoning of the Court is murky. The panel in Phillips III reasoned that the distinction between reading a claim in light of specification and reading a limitation from the specification is a fine one. The panel concluded that when the specification is read in the context of a person skilled in the art, it apparently becomes directly clear whether the patentee is setting out specific examples of the invention in the specification (in which case the specification does not limit the claims), or whether the patentee instead intends for the claims and embodiments in the specification to be strictly coextensive (in which case the specification limits the claims)! If what the author understood is correct, the Court seems to have opined that the Court will know the difference when it sees it!

With all due respect, the answer begs the question. Not only does this solution seem nebulous and uncertain, the Court has created a further confusion in enunciating this position. The Court has held that this distinction is to be viewed from the context of a person skilled in the art. This would again necessitate the use of extrinsic evidence, specifically expert testimony. The author does not see any other method for getting the perspective of those skilled in the art. The Court cannot deem itself to be this skilled person and just decide since the judge is actually no such skilled person. Moving further, the Court had earlier stated that extrinsic evidence is not to be trusted due to the presence of bias. Then, in a given factual matrix, the presence of two contradictory opinions would place the Court in an unsolvable situation since the Court does not have a test to proceed further. In that case, the Court would then be making arbitrary choices; a situation which everyone would agree is to be avoided.

To deviate a little, one may wonder as to why the above question (difference between interpreting a claim in light of the specification and borrowing limitations from the specification) is to be answered. The reason lies in the scheme, object and purpose of patent law. Under patent law, every patent application must consist of the specification followed by the claims. The specification shall contain a written description of the invention in full, clear, concise, and exact terms as to enable understanding and use of the invention. Whereas, the claims particularly point out and distinctly claim the subject-matter which the applicant regards as his invention. That is, the specification is to make others use the invention and the claims is meant to delineate the specific area of monopoly.
The more the specification is used in interpreting the claims, more the functions are being intermixed since then, the claim terms are treated as recitations of the invention itself. The more the specification limits the claims’ scope, the lesser is the option of the patentee to frame broad claims. Originally, the common practice in the USA was to follow a system of ‘central claiming.’ Speaking roughly, the words of the patent claim serve as devices to point out those parts of the patent disclosure that pertain to the invention proper. A good example would be: “The before-described medicine for curing bronchitis, sore throat, asthma, croup, whooping-cough, and dyspepsia.”

For the first time in the § 6 of the 1836 Patent Act of the USA, it was stated that the inventor particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery. This is what is known as the ‘peripheral definition system’, wherein the claim describes the metes and bounds of the invention. Under the peripheral definition system, the words of the patent claim are assumed to set out the scope of the patent right directly, by means of their lingual meanings. Their inter-dependence cannot be overlooked and it is conceded that the specification must play some role in claim construction; but not to the extent that the shift to a peripheral claiming system is reversed. This balance between the two extremes is exactly what the answer that is being sought by asking the above question.

Thus, the ratio in Phillips III whereby the specification is given a dispositive role in the hierarchy of sources for claim construction, suffers from the defect that in the garb of reading the claim in the light of specification, it actually limits the scope of the claim to merely embodiment(s) in the specification. Therefore, hierarchy in the claim construction process may result in a claim of an unduly narrow scope. This is not to state that it will not result in a claim of unduly broader scope. The following example illustrates this possibility. The case of Amgen Inc v Hoechst Marion Roussel Inc involved several patents that cover the production of erythropoietin (EPO), a naturally-occurring hormone that regulates red blood cell (RBC) production. In a suit for infringement against the defendant, the case boiled down to the meaning of the term ‘therapeutically effective amount’ in the claim of the plaintiff’s patent. The District Court construed ‘therapeutically effective amount’ as a quantity that produces a result in and of itself helps to heal or cure a certain class of patients, that being the increase in the RBCs since the product patented was meant as a drug for patients suffering from anaemia.

In overturning the decision of the District Court, the Federal Court relied upon Phillips III principles and noted that specification had mentioned stimulation of reticulocyte response, development of ferrokinetic effects (such as plasma iron turnover effects and marrow transit time effects), erythrocyte mass changes, stimulation of haemoglobin C synthesis as the therapeutic effects of the drug apart from the increase in RBCs and therefore concluded that the term ‘therapeutically effective’ did not require the claimed EPO to increase RBCs or cure disease, but simply to elicit one or more of these effects. However, the panel seems to have been cherry-picking words from the specification, since as was correctly noted by the Chief Judge Michel, all those effects noted in the specification were part of the process that led to the increase in RBC levels.

Thus a dispositive role given to the specification will generally result in unduly narrowing claim scopes and may at times result in unduly broadening them as well. Note that the author uses the word ‘unduly’ here; it indicates a tenor whereby the actual claim scope deserves something more or less than what it actually gets. The author wishes to clarify his point: it is not suggested that one should favour or disfavour a methodology of claim construction solely on the basis that it results in a narrow or a broad claim scope. Every time a court takes a conscious decision to apply a given methodology on this basis, it is impliedly choosing a particular patent law policy as to the extent of patent protection. If courts compare methodologies on the basis of claim scope, they are making substantive decisions on what they consider as optimal patent protection. In any given case, the Court
would thus become more interested in upholding its own policy and deciding a case purely on the basis of what they believe the claim scope ought to be rather than what actually is.

Secondly, one must look at the institutional limitation of courts to use claim construction methodologies as ‘policy levers’. The extent of patent protection ‘as it ought to be’ is a policy decision; it is dependant on variable and subjective factors, including the industry effects of patents, the extent to which a given patent will affect subsequent improvements or developments of technology. Not only would this involve complete access to market information, but also subjectively evaluating this information. As an institution that goes *functus officio* at the end of a given dispute and constrained by its own limited set of facts, the judiciary is definitely in no position to take such a policy decision.

**Extrinsic Evidence and the Role of Person Skilled in the Art**

Under the *Phillips III* approach, extrinsic evidence, including dictionaries, encyclopaedias and expert testimony are relegated to a subordinate level. But the problem with, for example, using dictionaries at the second stage would imply its function to be limited to merely verifying a pre-decided meaning. Rather than serving as an inquiry to define a word, verification is ultimately nothing but a result-driven no-holds-barred mission to justify and rationalize the chosen meaning for a term. To restate in lay man’s language, it is equivalent to putting the cart before the horse; the judge predetermines a meaning to be accorded to the claim term and later chooses a definition from the multifarious meanings in various dictionaries to justify his interpretation of the claim. But that’s equivalent to giving no weight at all to extrinsic evidence.

The author in the above cited article (Kristen Osenga) has cited examples as to how the courts have made arbitrary decisions in choosing between: (a) various dictionaries; and (b) among various meanings from a given dictionary, with almost no particular basis. The above choices were exercised at the later stage of the process of interpretation, by which time the court had already made an opinion as to what the claim term meant. The choices as to dictionaries and particular meanings from a given dictionary were made solely to justify and lend support to the judge’s view.

Secondly, the Federal Circuit has repeatedly stated that claim terms should be given the meanings they would have had to a personal skilled in the art. This necessarily requires the Court to consider extrinsic evidence. A court cannot know the ‘ordinary and accustomed meaning’ of technical terms as understood by technicians in the relevant art, without consideration of extrinsic evidence. The Supreme Court has stated: “…it is permissible, and often necessary, to receive expert evidence to ascertain the meaning of a technical or scientific term or term of art so that the court may be aided in understanding . . . what [the instruments] actually say.”

But under the analysis of *Phillips*, it is apparent that the person skilled in the art actually has no role to play; there is very little actual reference to such a person. But then how else does one get the opinion and understanding of a person skilled in the art, without actually referring to extrinsic evidence? As stated earlier, under the *Phillips III* decision, extrinsic evidence, including encyclopaedias and expert testimony are the least relevant and seemingly occupy the last ladder in the scale of hierarchy. For obvious reasons, the question of interpretation arises only because every phrase or word would have multiple meanings. To leave it to the judge to pick one of those meanings as he concludes to suit the context, does not make sense, if ultimately the claim term is meant for those skilled in the art.

On the other hand, reasoning in *Phillips III* places a lot of reliance on the patentee’s intent by way of copious reference to the specification. Logically speaking, when the function of the claim is to provide public notice to those skilled in the art, there is no need to engage in methodologies that tend to search out the true intent and purpose of the patentee.

**Conflicting Canons**

In Section II 2.2, there is a conflict between two canons: Reading a claim in the light of specification and not borrowing limitations from the specification. The decision on merits in *Phillips III* has unwittingly highlighted another conflict in the canons of the claim construction. One canon is that claims should be construed, if possible, to preserve their validity. A second canon is that of claim differentiation, which states that claims should not be interpreted so as to make another claim identical in scope, i.e., redundant. The *Phillips III* panel’s decision
highlights the possible conflicts between such canons of claim construction, specifically the two canons noted above.

In this case of Phillips, the Federal Circuit had previously come to a factual finding that ‘baffles’ directed at 90 angle were already disclosed in the prior art.5 And yet the panel in Phillips III rejected a contention based on the cannon of claim construction that claims should be construed to sustain their validity.15 But as was shown previously in this article, the Phillips III panel noted that dependant claims have used baffles along with specified angling requirements and therefore the independent claim ought to be broader to prevent redundancy of the dependant claims.19 Clearly, on facts, two accepted claim construction cannons resulted in a conflict and the Court chose one (claim differentiation) over the other, apparently on the basis that the other canon applied only for ambiguous words. The Court seemed to have concluded that the word ‘baffles’ was not ambiguous, despite the fact that there was acknowledged confusion over the scope of the term by the panel itself! If ambiguity does not mean existence of multiple meanings applicable to a given claim term, then the author fails to understand as to what else it could mean.45

Continuing Ambiguity

The conflicting opinions of the Federal Circuit lead to an en banc sitting in Phillips III. The decision was meant to clear ambiguity in claim construction methodology. However, the principle of law enunciated by the Court in Phillips III and its decision on merits brings in a dilemma to the arena of claim construction. As was stated earlier, although the Court laid emphasis on relative importance of specification, the entire case was decided on the context of the claims. Therefore, there is continuing uncertainty whether more weight generally should be assigned to the claim itself or to the specification.

Second, the panel completely missed a very important reference in the specification, which was specifically highlighted by the Federal Circuit in Phillips I. The specification expressly stated: “[I]n secured facilities, and protective barriers, it is feasible that projectiles may be encountered, such as bullets from high powered guns or bomb fragments” and that “[t]here have not been effective ways of dealing with these powerful impact weapons with inexpensive housing in the prior art.”5 The patentee had concluded in his specification that the “invention has advanced the art by providing modular buildings and modules of high strength [and] bullet resistance,” adding that “[u]niquely the advantages of steel shell modules are combined with thermal and acoustical isolation of two spaced walls and protection against bullet penetration of the walls.”5 Unfortunately, for all its plentiful statements as to the importance and weight to be attached to the specification to construe claims, the panel in Phillips III turning a blind eye to these above representations in the specification has confused one and all.

Adding to the quagmire is the fact that ultimately, the panel itself seemed to be a little more cautious with its approach when it stated that there exists “no magic formula or catechism for conducting claim construction.” If the principles of claim construction become a fact-suited endeavour, then they remain principles of law no more. At one point, the panel even stated that at times, the judge may even consult extrinsic evidence before reviewing the patent itself for the meaning of the claims terms – an approach similar to the one in Texas Digital.46

Further, the panel did not articulate as to when prosecution history and other intrinsic evidence can be applied or as to when they shall prevail over the specification. Adding further to the complications, the status of extrinsic sources like dictionary definitions is completely left hanging – as to when they would become relevant and when they would be given more weight are issues that have not been dealt with in either Phillips I or Phillips III. In other words, the relative weight or importance to be attached to other intrinsic evidence and external sources is lacking in the decision of the panel.

In fact, the previously cited case of Amgen Inc v Hoechst Marion Roussel Inc39 itself provides a case where the prosecution history probably could have changed the very scope of the claim. The dissenting Chief Judge Michel argued as to how the words ‘therapeutically effective’ was limited to doses that cured anaemia by highlighting the prosecution history, where the patentee differentiated the claimed EPO from the prior art by pointing to its ability to treat patients, since prior art included use of EPO for all the biological reactions mentioned in the specification, but for that of treating an ailment.39

Simply put, there is continuing ambiguity in claim construction. Consistency and certainty is very
important in claim construction. It must be recalled that claims place the boundary over the patentee’s monopoly and provide sufficient notice of that monopoly to allow public to avoid infringing the patent and work around it. This implies that so long as there is ambiguity in the process of claim interpretation, there is ambiguity in the patent scope, which would obviously have enormous economic implications.\textsuperscript{36} The post-Phillips III arena has therefore come to become as fractured as ever in the approach that is to be taken in claim construction. As stated earlier, few decisions have taken rather narrow approaches in defining not just technical, but also general purpose terms in claims to be limited to those embodiments in the specification.\textsuperscript{44,48} At the same time, the Federal Circuit has still followed the Texas Digital approach, resorting to dictionary meanings as well.\textsuperscript{49}

Specific Issues – A Re-iteration

What does Phillips III indicate?...A Result-oriented Jurisprudence?

In a blistering dissent in Phillips III, Justice Mayer ended his opinion with a damming prediction:\textsuperscript{15}

“Eloquent words can mask much mischief. The Court’s opinion today is akin to rearranging the deck chairs on the Titanic—the orchestra is playing as if nothing is amiss, but the ship is still heading for Davey Jones’ locker.”

In the course of his dissent, Justice Mayer seemed to be in no loss for words in identifying the approach taken by the majority.\textsuperscript{15}

“But after proposing no fewer than seven questions, receiving more than thirty amicus 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.”

This criticism does not seem unjustified considering the fact that the Phillips III panel gave a judgement that adopted everyone’s view: siding with one side on the principle of law and siding with the other side on the actual merits of the case. As seen above, it is not as if this approach is an isolated incident; there are quite a few cases where the Phillips III approach has been followed. This trend only indicates increasing role the judge plays in deciding the meaning of a claim term. This case is representative of the fact that the area of claim construction is largely at the whims and fancies of the judges. Clearly, the fractured approach of the judiciary to construe claims in various cases indicates a result-oriented jurisprudence. It is as if, irrespective of the principles of law, the Court pre-judges the meaning of the claim term and then merely takes an approach in hindsight to suit their ends.

One may at times wonder as to why such a result-oriented jurisprudence is to be faulted. Ultimately, if the judge is deciding the issue on a case-to-case basis, such an approach provides the flexibility to the Court to be fair and equitable to the parties. In fact, in the under-noted article, the author (Andrew B Dzeguze) has made an attempt to show as to how in the various cases where the Court has taken different approaches, when viewed from a broader perspective, the results obtained from such approaches have an intrinsic appeal.\textsuperscript{50} He has further cited cases of the Federal Circuit which have expressly or impliedly admitted this.\textsuperscript{50} But as that author concedes, certainty and predictability in the law is sacrificed in this process: “...although the results do not seem consistent with the orderly application of clear rules as a matter of law..., and certainly lack the predictability...”\textsuperscript{50}

Although the above author may have been right in proving the situation as is, it is not a situation as it ought to be. Time and again, it has been seen courts all over the world suggesting that the claims are important guideposts in providing notice of the exacting contours of the invention to potential infringers. There has been a repeated emphasis on the public notice function of claims and this is statutorily incorporated as well. What good is a public notice function, when potential infringers cannot reasonably predict the area covered by a patent?

Judge Newman once wrote:\textsuperscript{51}

“Patent law is practiced mainly through legal advice and counseling over the course of the commitment of creative and capital resources, to manage legal risk in the already risky business of industrial innovation. Like all commercial law, the cost of guessing wrong about the law and its application is rarely recoverable.”

The perceived boundaries of the exclusive property rights in a patent (the claim), may alter competitors’ business strategies; competitors frequently must
choose between licenses and design-abouts.\textsuperscript{52} Without there being predictability and certainty over claim scope, which is almost impossible with a result-oriented approach, it is impossible for business houses to engage in \textit{ex ante} planning. In terms of IP profiling and management, negotiation of licensing agreements and IP purchase agreements, clients expect certainty with what they are dealing with. The lack of a crystallized mechanism to claim interpretation, therefore places the entire business cycle in jeopardy, and may therefore also retard further innovation.

**Specific Issues**

After concluding that there is a need for a more certain claim construction methodology, it is important to recapitulate what was mentioned earlier – as to why there is a problem with the \textit{Phillips III} approach:

- Maintaining the difference between the interpretations to be accorded to means claims as opposed to other claims. This distinction has to be maintained as a matter of policy in patent law keeping in mind the history of means claims.
- A necessary dividing line between reading the specification as a tool for interpreting claims as opposed to drawing limitations from the specification into claims, both being accepted canons of claim construction.
- As a matter of logic and statutory emphasis, the only way of viewing a claim as a person skilled in the art lies in the use of external evidence and thus, if the artisan is assumed to be at the centre of claim construction, the role and position of extrinsic evidence has to be significant than it is under the \textit{Phillips III} approach.
- As a continuation of the previous point, if extrinsic evidence is placed at the last rung of the hierarchy, then the very object of using it is lost, since instead of acting as guideposts for interpretation, they become mere tools in the hands of judges to cherry-pick the meanings that they desire, in hindsight.
- Although claim differentiation is an accepted canon of claim construction, it cannot be an absolute rule and limits have to be placed for its use. As a related point, the hierarchy in its use as against intrinsic and / or intrinsic evidence must be defined.

With the above summarization, the author now wishes to explain the first point in further detail: the relationship between the specification and claims. This special emphasis is in view of the fact that the case of \textit{Phillips} is most important for its opinion on this point.

**Claim-Specification Relationship**

At this juncture, it is to be accepted as \textit{apriori} that the description cannot be completely removed from the equation. Nonetheless, the rule of thumb remains that one cannot bring forth a limitation from the specification into the claims. Once we have moved towards a system of \textit{peripheral claiming} as opposed to \textit{central claiming}, that in itself is an indication that as to how specification must not be used in an overbroad manner. Although the author concedes to the fact that a person skilled in the art would logically first refer to the specification to understand a claim term, especially technical terms, what if the specification is actually not defining it? As in the Phillips patent, the specification never actually defined the word ‘baffles’. It only gave illustrations of baffles at acute or obtuse angles.

The author suggests that one possible criterion to balance the two canons of claim construction\textsuperscript{53} is to verify if the specification itself actually defines the claim term. This distinction that the author is emphasizing has also been brought out by the Federal Circuit in \textit{Teleflex Inc v Ficosa N Am Corp}\textsuperscript{54} The District Court in that case had limited the scope of the claim term ‘clip’ to merely a clip with a single pair of legs based on the description of a single embodiment only. In overturning this decision, the Federal Circuit held that the word ‘clip’ is actually never defined in the written description and thus without the inventor “\textit{using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope},” the mere single embodiment in the specification cannot therefore restrict the scope.\textsuperscript{55} This approach to the use of specification makes logical sense.

Second, one of the most important reasons as to why the Federal Circuit seems to have retained an increasing role to the specification is that it is a fundamental principle of patent law that one cannot claim more than what he/she has invented.\textsuperscript{56} The question then arises is, if the patentee has only described one/few embodiments in the description, as in the case cited above and in the \textit{Phillips} case, is not the inventor’s invention restricted to merely such
embodiments? The answer to this question must logically lie only in the arena of non-obviousness.

That is, if the other embodiments that are being claimed as part of claim scope, but not mentioned in the description, are obvious to a person skilled in the art, then it logically must be part of the claim scope, even if not mentioned in the description. Conversely, if the claimed embodiment is not described in the specification and is also not an obvious embodiment from the perspective of a person skilled in the art, then it is outside the scope of the invention and therefore outside the claim scope as well. Thus a second guidepost in dealing with the claim-description relationship is that of the test of 'obviousness'. This is in complete conformity with the basic tenets of patent law. No person can claim an invention that is obvious from prior art. Therefore impliedly, this area of obvious inventions falls within the domain of the prior inventor(s).

If a given case does not fall within the above instances, then one must conclude that the specification is not conclusive in defining the claim term. When the situation falls within the above two rules, then specification is used to read and interpret the claim; if the case is not covered in the above rules, then use of the specification will result in reading limitations from the specification into the claims. The author believes that these rules clearly and in a reasoned manner harmonize the apparent conflict between the two canons of claim construction discussed earlier. Further, these rules also take care of the first two criticisms highlighted earlier.

The Alternative Approach

The Basic – Use of Extrinsic Source as the First Stage

Briefly speaking, the approach provided in Texas Digital consists of the following steps: the first step was to consult the dictionary, or a dictionary-like source such as a treatise, to determine the meaning of the claims. The patent’s specification and prosecution history would be consulted as a second step, only to determine whether the specification excluded one of the dictionary definitions or whether the patentee had used the words of the claim in a manner clearly inconsistent with the dictionary definition. The Court identified two such circumstances where such inconsistency may be proved.

- 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; or
- 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.

This methodology has significant advantages over the approach in Phillips III. For one, no limitation from the specification is brought into the claim directly. Second, by increasing the weight given to extrinsic evidence, the person skilled in the art is brought back into the scheme. Third, this approach does not in anyway make claim construction non-contextual by completely removing intrinsic evidence. As per Texas Digital, the examination of the intrinsic record is mandatory in every case to check for rebuttals of the presumption of ordinary meanings. Whereas, the Phillips III approach completely neglects extrinsic sources, the Texas Digital approach allows both extrinsic and intrinsic sources to play a role. And because intrinsic evidence is also referred, doctrines like that of claim differentiation and contextual interpretation of claims are also observed.

As was noted earlier, the use of extrinsic sources becomes futile when referred to at a later stage, since it then becomes a matter of cherry-picking to suit the ends of the interpreter. However, unlike this problem inherently associated with extrinsic evidence, it is absent in the case of intrinsic evidence and thus even if the intrinsic record is relegated to the second step, its vitality is not lost. Ultimately, the meaning taken from the extrinsic source has to fit the context of the claim. Only that meaning as taken from the external source that fits within its context is considered as the final meaning of the claim.

At this juncture, it is important to distinguish this approach from what is or was popularly called as ‘pragmatic textualism’. That phrase covers the approach wherein both intrinsic and extrinsic evidence will be taken into consideration while arriving at the meaning of a claim term. It does not have a per se rule of hierarchy. Whereas, the Texas Digital necessarily implies a hierarchy keeping extrinsic evidence one step ahead of intrinsic evidence.
Certainty with Dictionaries?

Proceeding further, this is not to state that this approach would lead to more certainty. As many commentators have highlighted, determining which dictionaries were publicly available at the time of issue or application of the patent and subsequently locating those dictionaries may be an impossible task in some cases. Some commentators also argue that dictionaries and other extrinsic evidence are too subjective and do not focus the claim construction inquiry on the meaning of the claims in the context of the entire patent. Definitions also may vary between dictionaries, as they differ in their citation sources. In the under-noted article, the author (Ellen P Aprill) has made a thorough analysis of how definitions in dictionaries are created and the particular problems associated with them. To directly quote the commentator:

In sum, no dictionary has a monopoly on the truth. Dictionaries include common meanings of words. They do not, however, include all meanings. They may well exclude meanings that are quite ordinary although less common. Furthermore, dictionary definitions may fail to include a particular definition of a word either because the meaning was not among those included in the citation file or because the meaning was sacrificed to constraints of abstraction and of space...Moreover, dictionaries differ in the words they use for definitions because of differences in citation files, differences in the style of the dictionary, and differences in the style of the individual definer...Their definitions are not right or wrong in any absolute, objective sense.

Although it is conceded that few of the definitions may be intuitively rejected based on the context of the terms, multiple definitions to a word is a definite possibility and there is no objectivity actually involved; choosing one definition over the other boils down to the subjective opinion of the panel. The classic example of this would be the case of Novartis Pharmaceuticals v Eon Labs Manufacturing, wherein the Court sought a definition of the term ‘hydrosol’ in a prescription drug case. The Court began by looking first in Webster’s Third New International Dictionary, then turned to the Oxford English Dictionary, and finally to various medical dictionaries to come up with two possible definitions of the term hydrosol. One definition was largely based on the Webster's Dictionary and the other on the Oxford English Dictionary and medical dictionaries. Ultimately, the Court's choice of which dictionary definition to apply was crucial to the outcome of the case and this was decided on a completely arbitrary basis. There is thus a mere illusion of certainty.

But here again, one must remember that dictionaries are not the sole extrinsic source; it is supplemented by expert testimony as well. That way, the judge / court would have another guiding light to narrow down the specific meanings that would be considered and opined by experts. Secondly, one must understand that the bedrock of our justice system is the adversarial process. This also implies that the Court, at the very first instance, need not try and locate any particular dictionary or scientific treatise and worry about which dictionary or treatise among the many hundreds must be chosen. Instead, the Court must limit itself to only those treatises or dictionaries that have been relied upon by both parties. If we thus modify the Texas Digital approach to this extent, the apparent illusory uncertainty is mellowed down to a large extent. Thus the parties themselves, along with their expert testimony would bring about that certainty.

Nonetheless, this is a certainty that is brought about only at the stage of adjudication of a dispute relating to a patent. There is still issue of certainty ex ante, which is very essential for business houses to plan, organize and structure their businesses. One may feel that the use of extrinsic sources that is restricted to only those actually relied on the parties to the dispute, would only make ex ante planning uncertain. But this misses the actual point; the true measure of certainty in terms of ex ante planning is from the point of view of courts adopting a single methodology for claim construction and not vacillate the method at the whims and fancies of the judiciary. In the present methodology that is being proposed, this discretion left with the court is minimized to a great extent. Once it is known prior to the patentee as well as the related business houses that the current methodology is being adopted, the market would be responsive enough to adjust their practices to the required position. This way, the patents would be drafted using the help of extrinsic sources with the broadest definition and make sure that their intrinsic evidence is framed to suit a given scope.
Use of Intrinsic Sources as the Second Stage

Of course, the problem does not end there. Ultimately the Court may be left with more than one definition to choose from and Texas Digital does not provide the courts with any particular methodology to decide on the same. The author’s suggestion is that once the Court is faced with two or more possible meanings taken from extrinsic sources, at the second stage, they are to be matched with the context of the claim, i.e., the intrinsic sources. Thus the Court is to verify whether each of the contended meanings is not clearly disavowed either in the specification, or in the prosecution history. Of course, the intrinsic sources also include the claim’s context and thus the Court is also to verify if possible meanings fit the context in terms of language, structure of the claim etc. The author wishes to clarify that the Court is to verify both (or more than two, if applicable) possible meanings with reference to the intrinsic sources.

That is, the acontextual definitions available for a term would be matched with the context of the claim term to find which of the proposed ordinary meanings would fit the context in the light of the accepted canons of interpretation. This would readily narrow down the scope of the available and possible meanings of a claim term. At this stage, it must be remembered that the context of the claim includes specification, claims themselves and also the prosecution history. Thus, if the patentee has clarified during the prosecution of the patent that the words used indicate a narrower scope, then that particular ordinary meaning would only apply. One aspect of this would automatically imply that unless the specification is clearly, unambiguously and specifically indicating towards one of the meanings, the specification will not be controlling. Thus, in the absence of such a clear disavowal or the satisfaction of the tests, the specification would be of no help in choosing among alternative meanings of the claim term as derived from the extrinsic evidence. This rule of clear and unambiguous disavowal would apply for the rest of the intrinsic sources such as prosecution history as well.

Use of Canons of Claim Construction as Default Rules

The second stage of applying the intrinsic sources would also subsequently involve the use of the standard canons of interpretation like that of claim differentiation, interpret to preserve validity etc., which would apply as default rules in choosing one meaning over the other. But should there be any given hierarchy in applying these canons of claims construction? It has been seen as to how two well-established canons came into conflict in the Phillips III case. And the only way to resolve such conflicts would be to have hierarchy between them, such that the hierarchy would come into play only when they conflict with one another.

Once this premise is accepted, then the question arises as to what this hierarchy should be. At this stage, one must note that these canons of claim construction arose out of logical necessity. Let us take the instance of claim differentiation. Herein, the Court presumes that no two claims in the same patent have the same scope, since it would lead to redundancy and no reasonable patentee would waste resources on writing two different claims with the exact same scope. Similarly is the case with the rule as to preserving a patent’s validity. Once the patent has been sanctioned by the patent office, which has thoroughly examined the patent and it has been prosecuted through the maze of various objections and replies, it is reasonable that its validity be preserved, if possible.

Once this is accepted, the author believes that setting the hierarchy between two given canons in a given case would be dependant upon a ‘rule of reason’. Although, it may sound as an open-ended expression, any decision based on the rule of reason can be subject to complete review since reason and logic can be challenged and argued upon; it is an objective assessment and not at the whims and fancies of the judge, who may arbitrarily choose one over another. And even if chosen based on so-called ambiguity rules, as was done in the Phillips III case, the situation is no better since what amounts to ambiguity in an arbitrary decision.

To illustrate this rule of reason, take the example of Phillips III. To recollect, there were two possibilities: (a) if the independent claims were to include baffles at ninety degrees, then the claims would read into prior art and thus be invalidated; or (b) if the independent claim were not interpreted to include baffles at ninety degrees, then it would make a few dependant claims redundant. In the latter instance, it would only make the dependant claims useless; but in the former case, the independent claim loses it validity as a whole and as a result, all the dependant claims fall through like a pack of dominos. If we were to apply the rule of reason, the former instance, i.e., case (a), fits within the framework of logic and reason.
The Last Stage

But what if despite all these steps, we are unable to pin down on any one particular meaning to a claim term, i.e., if more than one interpretation is plausible? In such a scenario, the author believes that interpretation which is against the patentee must be preferred. This follows as a logical corollary to the fact that the patentee is in the best position to clarify any ambiguity when he is drafting the patent. Therefore, the patentee should bear the risk of ambiguity. The patentee has control over the terms he chooses and has every opportunity to choose precise terms and may even expressly define it. An analogy can be drawn from the rule of contra proferentum in contracts - ambiguity is 'construed against the drafter who is solely responsible for the contract’s terms’. Considering the public notice function of claims, it makes all the more sense to take such an approach. In fact, based on a similar logic, Federal Circuit has held that when the choice exists, one has to take a narrower meaning to claim term.\(^64\)

One may argue that this rule, created in and for the realm of contract law is not appropriate for patent law. Let us examine this a little further. The term contra proferentum means 'against the offer'.\(^65\) The applicability of this doctrine is logically based on two assumptions: (a) the contract at hand is a standard form of contract or contracts drafted by only one party such that the terms are non-negotiable by the other party; and (b) the other party to the contract is a ‘weaker’ party with a relatively weaker bargaining power.\(^66\) The doctrine of contra proferentum is intended to place the risk of poor or unclear drafting on the party responsible for drafting; it was designed to protect the interests of the party not responsible for drafting. As Richard Posner argues the rules of contra proferentum is a sensible tie-breaker in contract cases, on the ground that the party who drafted the contract was probably in better position to avoid ambiguities.\(^67\)

If these premises’ are accepted then the principle can be argued to apply to the cases of patent law with more vehemence. This is simply because of the fact that the patent document (specification and claims) are drafted completely by the patent holder or his agents / representatives. Of course, unlike contracts there is no particular second party in whose favour the term is being interpreted. One must remember that through a patent, the patent holder, directly or indirectly, binds the public to the extent of not interfering with his monopoly, at least for a limited time period. And the public is not part of the process of drafting the said patent and in this sense the public document (patent) that now binds their conduct in some form, is non-negotiable from their perspective. In fact, the rule of contra proferentum, under contract law, is argued by many to be inapplicable since the other party has expressly consented to it and blindly signed the contract. Even this is inapplicable in patents since the public does not have any say in drafting and prosecution of a patent. Thus if there is any ambiguity at the final stage, it only seems sensible and fair to make the patentee bear the consequences of his poor drafting skill.

However, unlike a contract, which involves the rule being applied in personam, in patents, the rule would apply in rem. And many may thus question the appropriateness of the rule for claim construction. However, we have just seen that the premise or the assumption based on which the rule applies is that of the document being drafted by just one party; and not how many are parties to it. Under these circumstances, there is nothing unreasonable or inappropriate to apply the rule merely because it is being applied in rem. The second aspect of the objection is the contention that it would open the doors too wide open. In simpler words, the contention holds that merely because someone in the public proposes a different meaning and claims ambiguity would not mean that what was clearly, specifically intended and was thought to be very clear by the patentee becomes ambiguous. However, this objection is not on the applicability of the rule per se, but rather aimed at the rigour with which the rule is to be applied. To this extent, the author completely concedes to this objection and thus the rule of contra proferentum is to be only applied at the very last stage and as the last resort, where none of the above steps and the canons of the claim construction give a definite answer. Once the rule is being applied as a last resort, it only seems reasonable and logical that the patentee must suffer for his inadequate way of expressing his monopoly.

A Final Conundrum

There is one final difficulty that one must face in this quest for an alternative approach to claim construction. All along, the author has worked on the assumption that one of the definitions given by the parties would fulfill the tests and thus be used to define the claim term. But what if all the definitions
proposed by the parties fail the test at one stage or the other? The likelihood of such a situation arising is rather slim, considering the dynamics of litigation and thoroughness of the research done prior to it. And it is also highly unlikely that either party would propose a definition that would be easily defeated at a particular stage since neither party would want to take the risk of the other party’s definition being accepted by the court. Moreover, as a matter of judicial process, further opportunities would be granted to the party / parties to propose other definitions.

Conclusion

In this article, an attempt has been made to take an inductive approach towards a methodology of claim construction. The Phillips case is the latest decision to provide a framework for claim construction. The author has made an attempt to critically analyse the decision in Phillips case, and tried to find loopholes and criticisms in that approach of the panel in the Phillips case. It has been seen as to how the en banc decision in Phillips III, which was meant to clarify prior inconsistent holdings of the Federal Circuit, has created further dilemmas. As the foregoing discussion indicates, it has created a number of issues in claim construction as well as a huge ambiguity in claim scope. This would result in lack of certainty and predictability in infringement cases and also in IP management. In view of the above criticism of the Phillips III approach, the author concluded that the courts seem to be taking a result-oriented approach for claim construction. The author then made an attempt to re-establish a modified form of the Texas Digital approach, giving hierarchical approach to extrinsic and intrinsic evidence.

The proposed methodology combines both formalistic method, in terms of a fixed hierarchy and steps and at the same time also retains a substantive approach by making the entire process subject to the context. By making extrinsic sources as part of the main evidence in claim construction, the role of the person skilled in the art is increased and at the same time, by limiting the type, amount and burden in terms of these extrinsic sources, a sufficient amount of certainty is introduced in the process. Further, the proposed approach has made sure that the accepted and well-established canons of claim construction are given equal importance. The author strongly believes that certainty and accuracy are to be the sole guiding factors in deciding claim construction and that the approach suggested would achieve this result.

References

1. In re Hiniker Co, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).
2. For the purposes of this article, claim construction and claim interpretation are used interchangeably.
4. Building modules adapted to fit together for construction of fire, sound and impact resistant security barriers and rooms for use in securing records and persons, comprising in combination, an outer shell of substantially parallel piped shaped with two outer steel plate panel sections of greater surface area serving as inner and outer walls for a structure when a plurality of the modules are fitted together, sealant means spacing the two panel sections from steel to steel contact with each other by a thermal-acoustical barrier material, and further means disposed inside the shell for increasing its load bearing capacity comprising internal steel baffles extending inwardly from the steel shell walls(Emphasis Supplied).
9. Phillips v AWH Corp, 363 F.3d 1207, at 1209. Briefly speaking, in means-plus-function claims, the claim is written by only expressing the function of an element of the invention without reciting the actual structure, which is the general rule. This format is statutorily encoded in 35 U.S. § 112, paragraph 6:

   An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

10. In re Donaldson Co, 16 F.3d 1189 (Fed. Cir. 1994) (en banc).
11. Phillips v AWH Corp, 415 F.3d 1303, 1311 (C.A. Fed. (Colo.), 2005). Whether this is a correct decision or not is not covered in this article.
12. Phillips v AWH Corp, 415 F.3d 1303, 1312-1313 (C.A. Fed. (Colo.), 2005); Innova/Pure Water, Inc v Safari Water Filtration Systems Inc, 381 F.3d 1111, 1116 (Fed.Cir.2004) (“A court construing a patent claim seeks to accord a claim the meaning it would have to a person of ordinary skill in the art at the time of the invention.”); In re Nelson, 47 C.C.P.A. 1031, 280 F.2d 172, 181 (1960) (“The descriptions in patents are not addressed to the public generally, to lawyers or to judges, but, as section 112 says, to those skilled in the art to which the invention pertains or with which it is most nearly connected.”).
13. Phillips v AWH Corp, 415 F.3d 1303, 1312-1313 (C.A. Fed. (Colo.), 2005); Multiform Desiccants, Inc v Medcam, Ltd, 133 F.3d 1473, 1477 (Fed.Cir.1998) (“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.”; but see M. Reed Staheli, Deserved Deference: Reconsidering the De Novo Standard of Review for Claim Construction, Marquette Intellectual Property Law Review, 3 (1999) 181-202, at 189 (‘Patents consist of legal language commingled with technical verbiage…”).

14 Phillips v AWH Corp, 415 F.3d 1303, 1314 (C.A. Fed. (Colo.), 2005). For 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.


16 It was defined to consists of the ‘complete record of the proceedings before the PTO and includes the prior art cited during the examination of the patent.’ Phillips v AWH Corp., 415 F.3d 1303, 1315 (C.A. Fed. (Colo.), 2005).


18 Parties had accepted that the generic meaning of the term baffles was ‘means for obstructing, impeding or checking the flow of something.’

19 Modules as defined in claim 1 wherein the steel baffles are oriented with the panel sections disposed at angles for deflecting projectiles such as bullets able to penetrate the steel plates (Emphasis supplied).

20 Modules as defined in claim 5 wherein 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 for changing the direction of projectiles that might penetrate the outer wall (Emphasis supplied).

21 Phillips v AWH Corp, 415 F.3d 1303, 1325 (C.A. Fed. (Colo.), 2005). Since otherwise, the dependant claims would become redundant, citing Dow Chem Co v United States, 226 F.3d 1333, 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). This is the doctrine of claim differentiation.

22 Projectile resistant building modules for fitting together to form steel wall surfaces in construction of jail cells and the like comprising a steel plate outer shell, inner steel baffles projecting inwardly from the outer shell at angles tending to deflect projectiles that penetrate the outer shell and internal packing material that significantly resists the travel of a moving projectile (Emphasis supplied).

23 The Court specifically noted the following objectives of baffles: structural support to the walls, creation of compartments in the inter-wall area for filling any material at the choice of the customer. Phillips v AWH Corp, 415 F.3d 1303, 1326-27 (C.A. Fed. (Colo.), 2005).

24 It is pertinent to note that such angling of baffles is necessary to deflect projectiles as a matter of physics, since otherwise, projectiles could easily go between baffles perpendicular to the wall face - Phillips v AWH Corp, 363 F.3d 1207, at 1213 (Fed. Cir. 2004).


26 Phillips v AWH Corp, 415 F.3d 1303, 1318 & 1320-23 (C.A. Fed. (Colo.), 2005). To summarize, as per the mandate of the Federal Circuit in Vitronics Corp v Conceptronic Inc, 90 F.3d 1576, 1582-84 (Fed.Cir.1996), because of the clarity and completeness in specifications, the specification was to be the ‘single best guide’ to the meaning of a disputed term. The court might use prosecution history, both for its prior art references and any disclaimer of claim scope. The court should only use extrinsic evidence when the term was ambiguous in light of the intrinsic evidence. But going by the decision in Texas Digital Sys Inc v Telegenix Inc, 308 F.3d 1193, 1202-05 (Fed. Cir. 2002) (hereinafter ‘Texas Digital’), the hierarchy was reversed and it was held that dictionaries and like sources being created by unbiased third parties and available equally to the courts and the parties, they were superior forms of evidence for use in claim construction. The differences in these two approaches can be clearly seen in the approach of the majority in Phillips I & III and the dissent in Phillips I.

27 Decisions after Phillips III indicate that the approach in Phillips III is being followed, Nystrom v Tex Co Inc (Nystrom II), 424 F.3d 1136 (Fed. Cir. 2005), where upon rehearing, the unanimous Federal Circuit held that the term ‘board’ was limited to boards made of only wood, on the basis of the consistent (but not exclusive) use of wood as the building material throughout the specification; Ocean Innovations, Inc v Archer, 145 Fed. Appx. 366 (Fed. Cir. 2005), where it was held that floating drive-on dry dock are to only be ‘hollow’ since the patent’s abstract, specification and the preferred embodiment states that all of the units are hollow.

28 Halliburton Oil Well Cementing Co v Walker, 329 US 1, 8 (1946). Ironically, this decision prohibited the use of means claims, which was legislatively overruled by the Congress by adding 35 U.S.C § 112, paragraph 6.

29 Maier Gregory J, Lytle Bradley D, The strategic use of means-plus-function claims, Journal of the Patent and Trademark Office Society, 80 (1998) 241-250, where the authors have gone on to make submissions as to how to strategically use means claims with this distinguishing feature of means claims as their sole premise.

30 It must be remembered that the panel expressly held that the claims in the Phillips patent were not means-plus-function claims – see Phillips v AWH Corp, 415 F.3d 1303, 1311 (C.A. Fed. (Colo.), 2005).

31 Specialty Composites v Cabot Corp, 845 F.2d 981, 987, 6 USPQ2d 1601, 1604 (Fed.Cir.1988) (“’[P]articular embodiments appearing in the specification will not generally be read into the claims.... What is patented is not restricted to the examples, but is defined by the words in the claims.’); see also SciMed Life Sys Inc v Advanced Cardiovascular Sys Inc, 242 F.3d 1337, 1340 (Fed.Cir.2001); Texas Digital Sys Inc v Telegenix Inc, 308 F.3d 1193, 1204 (Fed. Cir. 2002); Houssey Pharms Inc v Astrazeneca UK Ltd., 366 F.3d 1348, 1355 (Fed. Cir. 2004); Burke, Inc v Bruno Indep. Living AIDS Inc, 183 F.3d 1334, 1340 (Fed. Cir. 1999).
32 35 U.S.C. § 112, paragraph 1. This is commonly known as the teaching or the enabling requirement. The corresponding Indian provision, Section 10 (4)(a), Patents Act reads:
Every complete specification shall-
1. fully and particularly describe the invention and its operation or use and the method by which it is to be performed;
... ... ... ...
33 35 U.S.C. § 112, paragraph 2. The corresponding Indian provision, Section 10 (4)(c), Patents Act reads:
Every complete specification shall-
... ... ... ...
3. end with a claim or claims defining the scope of the invention for which protection is claimed.
This is commonly known as the public-notice function – it gives notice to the public of the limits of the patent monopoly: see Warner-Jenkinson Company, Inc., v. Hilton Davis Chemical Co., 520 U.S. 17 (1997).

34 US Pat No 2,282.
36 457 F.3d 1293 (Fed. Cir. 2006).
37 Claim 1 of the relevant patent read: A pharmaceutical composition comprising a therapeutically effective amount of human erythropoietin and a pharmaceutically acceptable diluent, adjuvant or carrier, wherein said erythropoietin is purified from mammalian cells grown in culture.
39 Angen Inc v Hoechst Marion Roussel Inc, 457 F.3d 1293, 1302-03 (Fed. Cir. 2006).
40 For a rather eloquent analysis of this perspective, Osenga Kristen, Linguistics and patent claim construction, Rutgers Law Journal, 38 (2006) 92-97. The author has analysed various illustrations to indicate as to how courts have predominantly used dictionaries only to verify rather than to define.
41 Phillips v AWH Corp, 415 F.3d 1303, 1313 (C.A. Fed. (Colo.), 2005); Vitronics Corp v Conceptronic Corp, 90 F.3d 1576, 1582 (Fed.Cir.1996); Multiform Desiccants, Inc v Medcam, Ltd, 133 F.3d 1473, 1477 (Fed. Cir. 1998).
43 Karsten Mfg Corp v Cleveland Golf Co, 242 F.3d 1376, 1384 (Fed. Cir. 2001) ("Claims amenable to more than one construction should, when it is reasonably possible to do so, be construed to preserve their validity."); Rhine v Casio Inc, 183 F.3d 1342, 1345 (Fed.Cir.1999); Generation II Orthotics Inc v Med. Tech Inc, 263 F.3d 1356, 1365 (Fed. Cir. 2001).
44 Inpro II Licensing SARL v T-Mobile USA Inc, 450 F.3d 1350, 1354 (Fed. Cir. 2006) ("[T]he doctrine of claim differentiation means that different claims are presumed to be of different scope...").
45 The above cited definition of ambiguity is drawn from cases involving interpretation of contracts, International Multifoods Corporation v Commercial Union Ins Co, 309 F.3d 76 (2d Cir. 2002). This definition is also accepted in the context of statutory interpretation. Nelson Motis v Union of India, AIR 1992 SC (1981); Nathi Devi v Radha Devi Gupta, AIR 2005 SC 648.
46 Phillips v AWH Corp, 415 F.3d 1303, 1324 (C.A. Fed. (Colo.), 2005). The Phillips III panel believed that this was in conformity with the approach in Vitronics.
47 Cotropia Christopher A, Patent claim interpretation methodologies and their claim scope paradigms, William & Mary Law Review, 47 (2005) 99 ("The discretion left to the courts when approaching claim construction creates an uncertainty itself. Because no statute describes exactly how courts should interpret claims, observers must look to the courts for guidance on interpretation issues. Without clear direction from the courts in the form of a single methodology, one cannot predict a claim's meaning because of the uncertainty about which methodology will be used.").
48 Research Plastics Inc v Federal Packaging Corp, 421 F.3d 1290 (Fed. Cir. 2005) (the term ‘rear end’ in the context of a tube of sealant or caulk was restricted to merely the rear-most edge of the tube by way of the references in the specification).
49 Free Motion Fitness Inc v Cybex International Inc, 423 F.3d 1343 (Fed. Cir. 2005) (relying completely upon the dictionary meaning of the term ‘adjacent’ to simply mean ‘not distant’ on the basis that the specification does not disclaim such a meaning).
53 The author here is referring to the following canons: ‘one may not read a limitation into a claim from the written description.’ The second cannon is that ‘one may look to the written description to define a term already in a claim limitation, for a claim must be read in view of the specification of which it is a part.’
54 299 F.3d 1313 (Fed. Cir. 2002).
55 Teleflex Inc v Ficosa N’Am Corp, 299 F.3d 1313, 1327-1328 (Fed. Cir. 2002).
56 O’Reilly v Morse, (1853) 56 U.S. (15 How.) 62.
57 Texas Digital Sys Inc v Telegenix Inc, 308 F.3d 1193, 1201-02 (Fed. Cir. 2002).
58 Brief for Amici Curiae Intel Corp et al., at 7-11, Phillips, 415 F.3d 1303 (Nos. 03-1269, -1286).
61 363 F.3d 1306 (Fed. Cir. 2004).
62 Novartis Pharmaceuticals v Eon Labs Manufacturing, 363 F.3d 1306, 1308-1310 (Fed. Cir. 2004).
63 Markman v Westview Instruments Inc, 52 F.3d 967, 1008 (Fed. Cir. 1995).
64 Athletic Alternatives Inc v Prince Mfg Inc, 73 F.3d 1573, 1581 (Fed. Cir. 1996); Housey Pharms Inc v Astrazeneca UK Ltd., 366 F.3d 1348, 1356 (Fed. Cir. 2004).