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**UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**

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Edward H. Phillips

*Plaintiff-Appellant,*

v.

AWH Corporation, Hopeman Brothers, Inc. and Lofton Corporation,

*Defendants-Cross-Appellants.*

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Appeals from the United States District Court for the District of Colorado,  
97-CV-212, Judge Marcia S. Krieger

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**BRIEF OF *AMICUS CURIAE*, THE INTELLECTUAL  
PROPERTY LAW ASSOCIATION OF CHICAGO (IN  
SUPPORT OF NEITHER PARTY)**

**FOR REHEARING *EN BANC***

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## Certificate of Interest

Pursuant to Circuit R. 47.4, the undersigned states as follows:

1. The full name of every party or amicus represented by the below-listed attorneys is The Intellectual Property Law Association of Chicago (referred to hereafter as “IPLAC.”)

2. IPLAC submits this brief as *amicus curiae* and has no interest in the outcome of the case.

3. IPLAC has no parent corporation. No publicly-traded entity owns 10% or more of IPLAC.

4. The names of all law firms and partners and associates who have appeared or who will appear on behalf of IPLAC are listed below:

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## **INTEREST OF THE AMICUS**

The Intellectual Property Law Association of Chicago (“IPLAC”) was founded in 1884 and, on belief, is the oldest intellectual property law association in the nation. Its over 800 members include law firm attorneys, sole practitioners, corporate attorneys, law school professors, and law students.

IPLAC is a not-for-profit organization dedicated to maintaining a high standard of professional ethics in the practice of patent, trademark, copyright, trade secret, and associated fields of law. A principal aim is to aid in the development and administration of these laws and the manner by which they are applied by the courts and by the United States Patent and Trademark Office (PTO). IPLAC is further dedicated to providing a medium for the exchange of views on intellectual property law between those practicing in the field and to educating the public at large.

IPLAC has a continuing interest in the law being developed by this Court on patent claim interpretation. Indeed, its Litigation Committee prepares an annual review of this Court’s cases on the subject and publishes each such review on the Association’s website at <http://IPLAC.org> on the “Articles & Resources” pages.

Consistent with its stated mission, IPLAC writes to assist this Court in response to the ruling of this Court on July 21, 2004.

## SUMMARY OF ARGUMENT

In this appeal, the Court has the opportunity to clarify the role of dictionary definitions in the interpretation of patent claims coming before courts in patent litigation. IPLAC in general submits that dictionaries are useful reference works, but they must not supplant the actual evidence of what the inventor objectively presented to and obtained from the Patent and Trademark Office as the metes and bounds of the invention.

Decades of authority by the Supreme Court and by this Court sitting *en banc* establish beyond question that patent *claims* determine the scope of patent protection,<sup>1</sup> and IPLAC does not in any way suggest otherwise. IPLAC fully concurs with the numerous cases of the Supreme Court and this Court confirming that the claims are to be understood from the vantage point of the ordinarily skilled artisan in the relevant field. The claims give notice to the public of the scope of the patent, indicating at once what subject matter is reserved to the patent holder for a limited time, and what the patent does *not* exclude from the public.

IPLAC also concurs that courts may look to the plain meaning of claim terms but asserts that dictionaries should in general be subordinate to the patent specification and other intrinsic evidence when determining what is meant

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<sup>1</sup> See *Johnson & Johnston Associates Inc. v. R.E. Service Co., Inc.*, 285 F.3d 1046, 1052 (Fed. Cir. 2002) (*en banc*) and cases cited therein.

objectively by challenged claim terms. Dictionaries may be considered, but the guiding light must be what the hypothetical ordinarily skilled artisan would have understood by the claim terms – not in a vacuum, and not armed with only a technical or general purpose dictionary, but also with the full panoply of intrinsic evidence. Courts may receive expert witness testimony on this determination.

## **ARGUMENT**

**Question 1. Is the public notice function of patent claims better served by referencing primarily to technical and general purpose dictionaries and similar sources to interpret a claim term or by looking primarily to the patentee’s use of the term in the specification? If both sources are to be consulted, in what order?**

Question 1 as phrased seems to presuppose that claim interpretation is conducted to promote a public notice function. IPLAC considers that the public notice function is important, consistent with the constitutionally mandated purpose

(“To promote the Progress of Science and useful Arts...” U.S. CONST., Article I, Section 8), which is paramount.<sup>2 3</sup>

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<sup>2</sup> If the Court meant to limit Question 1 to the public notice function, apart from questions of how claims ought to be construed from the perspective of the Constitutional mandate, then IPLAC answers that the public notice function is *not* better served by reference to dictionaries in preference to the specification, but instead is better served by looking to the intrinsic and extrinsic evidence bearing on the meaning of the disputed term to the ordinarily skilled artisan at the relevant time. Both the specification and dictionaries may be consulted in whatever order a court pleases, but for reasons explained in the main text, the specification meaning should dominate over a dictionary meaning.

Some IPLAC members think that the public notice function is best served by limiting claim scope to what was actually invented, while others think that the claims should be interpreted in the same way that the claims are examined in the PTO, *i.e.*, the broadest reasonable construction that preserves validity over the art of record. The latter group asks these questions: if the examiner did not require a narrow definition of a claim limitation such as a “baffle” to find the claim patentable, why should the court give the term a more narrow meaning? How is the public placed on notice that a claim limitation such as “baffle” will be interpreted to mean a “baffle at an angle other than 90 degrees,” as the panel majority found in this case? The latter IPLAC group’s conclusion is that the claims should be interpreted to preserve validity over the art of record, without otherwise narrowing their scope in the absence of a surrender of subject matter. The public is protected from overly broad claims by the reverse doctrine of equivalents. *See, Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608-09, 94 L. Ed. 1097, 1102, 70 S. Ct. 854 (1950).

<sup>3</sup> IPLAC also does not concur with the implicit proposition that resort to dictionaries as the primary interpretive tool would promote the public notice function. Multiple dictionary definitions often exist, and one would have to select from among them. Further, the problem can be compounded by resort to definitions of terms within definitions. Hence, the use of dictionaries does not always promote certainty.

Inventions result from the work of engineers and scientists, not grammarians and wordsmiths. The Supreme Court in *Festo*<sup>4</sup> noted these words of one predecessor of the Federal Circuit:

“A verbal portrayal is usually an afterthought written to satisfy the requirements of patent law. \*\*\* Often ... words do not exist to describe it. The dictionary does not always keep abreast of the inventor. It cannot. Things are not made for the sake of words, but words for the sake of things.”<sup>5</sup>

IPLAC doubts that engineers and scientists execute patent applications with the expectation that the scope of any claim of a resultant patent will be determined by a dictionary – be it general or technical. Instead, the more reasonable expectation is that the scope of the patent is to be delimited by the words of the claims, as they would be understood by persons who understand the invention and the way that claims are written. “[T]he focus is on the objective test of what one of ordinary skill in the art at the time of the invention would have understood the term to mean.” *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 986 (Fed. Cir. 1995) (*en banc*).<sup>6</sup>

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<sup>4</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 152 L.Ed.2d 944 (2002).

<sup>5</sup> *Id.*, 535 U.S. at 731, 152 L.Ed.2d at 955 (2002) citing *Autogiro Co. of America v. United States*, 384 F.2d 391, 397, 181 Ct. Cl. 55 (Ct. Cl. 1967).

<sup>6</sup> See generally, *Home Diagnostics, Inc. v. Lifescan, Inc.*, \_\_\_ F.3d \_\_\_, appeal 03-1370, slip opinion at 4-6 (Fed. Cir. Aug. 31, 2004).

The sources courts should use in determining the meaning of disputed claim language should be *evidence* as to what the ordinarily skilled artisan would understand the claim to mean,<sup>7</sup> primarily in light of their common understanding of technical terms, the patent specification, and the context of words relative to the invention.<sup>8</sup>

A recent panel decision of this Court reflects what IPLAC believes is the proper approach to claim construction. This Court looked to what a person of ordinary skill in the art would understand the claims to mean in light of the intrinsic evidence. In that particular instance, the dictionary was of no help. The Court noted that while extrinsic evidence could “shed useful light on the relevant art – and thus better allow a court to place itself in the shoes of a person of ordinary skill in the art – the ‘intrinsic evidence is the most significant source of the legally operative meaning of a disputed claim language’” (citing *Vitronics*)<sup>9</sup>. The Court explained the role of general usage dictionaries:

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<sup>7</sup> What an ordinarily skilled artisan would understand a term to mean will frequently require expert testimony. The ordinarily skilled artisan, unlike the reasonable person found in tort law, will generally need to be explained in the particular technical area for each individual case, since that legal fiction is not something easily understood by lay persons.

<sup>8</sup> “... [I]t is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention.” *United States v. Adams*, 383 U.S. 39, 49, 15 L.Ed.2d 572, 579, 86 S.Ct. 708 (1966) citing, *inter alia*, *Seymour v. Osborne*, 11 Wall., 516, 547, 20 L.Ed. 33, 39 (1871).

<sup>9</sup> *Vitronics Corporation v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996).

To the extent that [an] artisan would understand a claim term to have the same meaning in the art as that term has in common, lay usage, a general-usage dictionary can be a helpful aid to claim construction. But where evidence – such as expert testimony credited by the fact finder, or technical dictionaries – demonstrates that artisans would attach a special meaning to a claim term, or, as here, would attach no meaning at all to that claim term (independent of the specification), general-usage dictionaries are rendered irrelevant with respect to that term; a general-usage dictionary cannot overcome credible art-specific evidence of the meaning or lack of meaning of a claim term.

*Vanderlande Industries Nederland BV v. International Trade Commission et al.*, 366 F.3d 1311 (Fed. Cir. 2004).

Further, IPLAC agrees that the understanding of the artisan in the relevant field of the invention at the relevant time, not the English-language dictionary, must apply. Such a determination may be made, for example, in the context of a *Markman* hearing.

IPLAC agrees completely with the statement of the law by the panel in *Glaxo Group v. Apotex*, 376 F.3d 1339, 2004 U.S. App. LEXIS 15489 at \*15 (Fed. Cir. 2004):

To properly construe a claim term, a court first considers the intrinsic evidence, starting with the language of the claims. *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Claim terms should be construed consistently with their ordinary and customary meanings, as determined by those of ordinary skill in the art. *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003). In construing the terms of a patent, the court must also examine the specification to determine whether the patentee used the claim term consistent with its ordinary meaning or acted as his

own lexicographer in defining the term. *See, e.g., Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1988); *Brookhill-Wilk*, 334 F.3d at 1299.

In the event that an inventor uses terms in a way outside what a person of ordinary skill would understand, the meaning must be clear from the specification. Whenever an inventor has been his own lexicographer and defined a claim term, that meaning should apply. Also, when the specification or the prosecution history includes a disclaimer or disavowal of subject matter, that also should restrict the scope of the claims during the claim interpretation process (and thereafter).

IPLAC suggests that the proper role for dictionaries in the claim interpretation process is limited. They will rarely be the most probative “evidence” on how one of ordinary skill in the art understands a claim term, and they should have a significant bearing on the outcome only in the rare case when there is no evidence that is more probative of what the inventor claimed in a particular patent than a dictionary.<sup>10</sup>

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<sup>10</sup> Dictionaries raise some evidentiary problems, for they are extra-judicial statements of what *other people* (who are not before the court and who may not be experts in a particular technical field) believe certain words mean, raising hearsay questions under Rules 801-802, F. R. Evid. The Supreme Court in deciding a tariff question (asking whether tomatoes are vegetables or fruit within the meaning of the Tariff Act of 1883) stated that such words must receive their ordinary meaning. As to that, the court was:

(Footnote continued next page)

On the other hand, IPLAC does not suggest completely barring dictionaries either, for they provide *some* information that *may* have a bearing on claim

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... bound to take judicial notice, as it does in regard to all words in our tongue; and upon such a question, dictionaries are admitted, not as evidence but only as aids to the memory and understanding of the court.

*Nix v. Hedden*, 149 U.S. 304, 306-07, 13 S.Ct. 881, 882, 37 L.Ed.745, 746 (1893).  
*Accord, Cybor v. FAS Technologies*, 138 F.3d 1448, 1462 (Fed. Cir. 1998)  
(concurring opinion by J. Plager); *Martin v. United States*, 62 Cust. Ct. 533, 535 (Cust. Ct. 1969).

However, if a dictionary definition is to be accepted by judicial notice, then the constraints of Rule 201 should apply:

**Rule 201 (b).** A judicially noticed fact must be one not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.

In a dispute over claim interpretation, if one party is reasonably disputing the dictionary definition in favor of other evidence, then the court must consider the effect of Rule 201(b) and whether it bars the court from taking judicial notice of the disputed dictionary definition.

Even if evidentiary problems are overcome, another is that in several instances, dictionaries (be they general or technical) speak in a vacuum. A patent case is different from a tariff case, where the party to be charged with a tariff has not written a public document such as a patent setting forth the invention as required by statute. Dictionaries do not consider the specific context in which an inventor (or his patent lawyer) used a term in a patent. Admittedly, there may be times when context is not necessary. For instance, if a claim uses the word “Celsius,” the dictionary meaning probably would be accepted unless the inventor explained clearly (in the intrinsic evidence) that he meant something special by that word. These problems ought to be resolved by the court, which in our view ought to consider what the patent actually states as superior evidence to what a dictionary states. Indeed, in *Vitronics, supra*, this Court stated that dictionaries, expert testimony, and technical treatises are extrinsic evidence which “*may not be used to vary or contradict the claim language*” but instead may be used “*only to help the court come to the proper understanding of the claims.*” 90 F.3d at 1584.

meaning. However, dictionaries should not be the ordinary tools for interpreting the meaning of a technical document that purports to crystallize what an inventor regards as an invention in a particular field of industry and which has undergone examination before a patent examiner.

**Question 2: If dictionaries should serve as the primary source for claim interpretation, should the specification limit the full scope of claim language (as defined by the dictionaries) only when the patentee has acted as his own lexicographer or when the specification reflects a clear disclaimer of claim scope? If so, what language in the specification will satisfy those conditions? What use should be made of general as opposed to technical dictionaries? How does the concept of ordinary meaning apply if there are multiple potentially applicable definitions for a term? Is it appropriate to look to the specification to determine what definition or definitions should apply?**

IPLAC considers that dictionaries should *not* be the primary source for claim interpretation. Even if they were, dictionary definitions should *not* take priority over intrinsic evidence that establishes the scope of patent coverage.

In the event that dictionaries are used, the definitions must be taken in the proper context, as this Court has amply pointed out in 2003.<sup>11</sup> When multiple definitions appear to be applicable, it certainly is appropriate to look to the specification to determine which definition is most apt.

**Question 3: If the primary source for claim construction should be the specification, what use should be made of dictionaries? Should the range of the ordinary meaning be limited to the scope of the invention disclosed in the specification, for example, when only a single embodiment is disclosed and no other indications of breadth are disclosed?**

Even though the specification should be a primary source of claim construction, dictionaries may be consulted also as extrinsic evidence bearing on the disputed issue. The lodestar for decision-making ought to be the understanding of the hypothetical ordinarily skilled artisan in the relevant field.

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<sup>11</sup> *E.g.*, *E-Pass Technologies, Inc. v. 3Com Corp.*, 343 F.3d 1364 (Fed. Cir. 2003); *Ferguson Beauregard/Logic Controls v. Mega Systems, LLC.*, 350 F.3d 1327 (Fed. Cir. 2003); *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364 (Fed. Cir. 2003); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294 (Fed. Cir. 2003).

IPLAC is divided on whether the scope of the disclosure in the specification should limit the scope of the claims. IPLAC acknowledges, however, that Supreme Court authority indicates that the specification is not to be used to read into claims an element that is not present, as this Court recently noted in *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, 2004 U.S. App. LEXIS 16549 at \*15 (Fed. Cir. August 11, 2004) *citing* *McCarty v. LeHigh Valley R.R. Co.*, 160 U.S. 110, 116 (1895).

Further, even when the specification discloses a single embodiment of an invention, the claims ought not be read restrictively absent a different reason for doing so, such as where the patentee has disclaimed or disavowed other subject matter. *Innova/Pure* at \*15.

In the present case, in considering the meaning of “internal steel baffles” which extend “inwardly from the steel shell walls” in claim 1, the word “baffle” should not be read in a vacuum. For example, the impact of other claims on the terms at issue should be considered. The other claims are part of the intrinsic evidence and are part of the specification. Specifically, dependent claim 2 requires that the steel baffles be “oriented with the panel sections disposed at angles for deflecting projectiles such as bullets ...” This Court could conclude, for example, that the claim 2 language means that the baffles (such as 16, 26, 27, 30, and 31 in the figures) are neither parallel nor perpendicular to the outer panel sections (20,

21). The Court may then consider whether claim 2 would be rendered superfluous if the word “baffle” in claim 1 were construed to mean the same thing.

Further considering the specification, the Court may also consider whether the inventor specifically disclaimed or disavowed “baffles” that are perpendicular or parallel to the outer panel sections.<sup>12</sup> IPLAC takes no view on how the Court should ultimately resolve this question. In considering the specification, the Court should also consider the impact, if any, of whether the drawings are said to describe an illustrative embodiment of the invention or the invention itself.<sup>13</sup>

In addition to the written description language to be considered, the Court also should consider the language in claim 1 itself that limits the baffles to ones “extending inwardly from the steel shell walls.”

Hence, various intrinsic evidence bears on the “baffles” of claim 1 and those of claim 2. The Court will ultimately need to determine what the evidence indicates to a person of ordinary skill in the art to which the invention pertains and what the language may mean as a matter of law.

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<sup>12</sup> Parallel baffles would appear to be specifically excluded by language in claim 1, requiring that the claimed baffles extend “inwardly from the steel shell walls.”)

<sup>13</sup> Col. 3, lines 63-67 discuss how the drawings show modules of “this invention,” and col. 4, line 3 refers to the module 10.

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

No. IPLAC submits that this would not serve the Constitutional mandate of promoting the progress of science and useful arts. Further, such a system would seem untenable. It would penalize a patentee for using language in a way that might vary slightly from a dictionary use. No statute places such a burden on a patentee, and IPLAC submits that imposing such a requirement would have a chilling effect on patents.

**Question 5: When, if ever, should claim language be narrowly construed for the sole purpose of avoiding invalidity under, *e.g.*, 35 U.S.C. §§102, 103, and 112?**

IPLAC is divided and believes that further development of this issue would be beneficial before making any *en banc* ruling on this point. Some of its members

would construe claims in whatever way the appropriate evidence dictates, regardless of the impact on validity. If the claims are ruled invalid, the patentee can use the mechanisms provided in the statute – the reissue and reexamination processes – to seek narrower claims or claims that cure the invalidity problem. Other members think that if the evidence on claim construction is in equipoise, with one construction leading to a valid claim and others not, then discretion ought to be exercised to preserve validity. Still others believe that claims ought to be construed to preserve validity whenever possible.

One narrower question concerns prior art that is *of record* and specifically whether a claim should be construed narrowly to preserve validity over prior art of record that the PTO examiner had actually used to reject claims. On this question, IPLAC is divided. Some members consider that the examiner must have viewed the issued claim as distinguishing somehow over such prior art of record, and the claim accordingly should be interpreted to distinguish over that art of record. Other members consider that if the prior art can invalidate the claim, then the claim is too broad and is invalid, and the patentee can use the PTO reexamination or reissue procedures to correct the infirmity. Other members consider that claim language should be interpreted to preserve validity only when there are two equally plausible interpretations based on the evidence, one which validates and one which does not.

**Question 6: What role should prosecution history and expert testimony by one of ordinary skill in the art play in determining the meaning of disputed claim terms?**

IPLAC submits that both the prosecution history and expert testimony should be considered. This Court in numerous panel decisions over the past several years has indicated the role of the prosecution history in the claim construction process.

IPLAC considers that the prosecution history is intrinsic evidence that should be reviewed in each case, provided it is in evidence. It may contain explicit or implicit definitions of terms used in claims. It may (and often does) indicate how the claims or the invention as a whole differ from the prior art. It may include a disclaimer of what the invention is not, *i.e.*, of claim scope. Any such evidence is important to interpreting claim language. IPLAC considers that claims ought not be construed in a way inconsistent with the prosecution history and that it is important that the understanding of the examiner as to why claims distinguish over the prior art before him not be disregarded. The patent ought not be construed more broadly than what the examiner agreed was allowable over the art, nor more narrowly.

“Expert” testimony has a proper and, possibly, important role in claim interpretation even though it is extrinsic evidence. A patent claim is a technical

communication created to delineate the scope of an invention to the inventor and to the public. It is to be understood by persons of ordinary skill in the relevant art, and testimony on what would be commonly understood in a particular field by certain words in a certain context in light of other claims, a written specification, drawings, and the prosecution history, as well as extrinsic evidence such as common usage in the industry, are meaningful evidence that courts ought to consider.

In the special case of Section 112, paragraph 6 “means” claim elements, expert testimony can be very useful in determining what in the specification actually corresponds to the claimed function. Federal judges may not be qualified technically to make such decisions without technical assistance.

Even though expert testimony may introduce more uncertainty into claim interpretation, the process sometimes calls for considering more than a dry, uninformed record. The public interest in knowing the metes and bounds of what it is prohibited from doing during the patent term may suffer some uncertainty due to the consideration of expert testimony. However, such uncertainty is no greater than the Supreme Court has already approved in considering the question of equivalency and whether there should be an absolute bar due to certain prosecution events. Any uncertainty in claim interpretation occasioned by the lack of expert

testimony in the intrinsic evidence is necessary to achieve the goals of the Constitution.

Hence, IPLAC considers that the intrinsic evidence and, in appropriate circumstances, certain extrinsic evidence are properly considered in claim interpretation.<sup>14</sup> On the other hand, IPLAC agrees with precedent of this Court indicating that expert testimony cannot be used to contradict the plain intrinsic evidence. Nor can expert testimony be used to insert missing descriptions into a specification.

**Question 7: Consistent with the Supreme Court’s decision in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), and our *en banc* decision in *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998), is it appropriate for this court to accord any deference to any aspect of trial court claim construction rulings? If so, on what aspects, in what circumstances, and to what extent?**

IPLAC considers that no deference is advisable on the ultimate issue of claim interpretation, which the Supreme Court has instructed is a question of law.

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<sup>14</sup> IPLAC agrees that testimony of the inventor as to what was *intended* is improper.

This Court was created for the purpose of promoting uniformity, and liberal deference in appellate review of claim construction would militate against that purpose. The trial court function under consideration here is determining a meaning of a legal document. Even when testimony is received and evidence has to be weighed, no deference is appropriate to the ultimate determination.

Guidance may come from consideration of the treatment of patent validity issues. Validity, ultimately a question of law, is subject to review without deference. This applies to Section 102, 103, and 112 determinations. On the other hand, some aspects of patent validity depend on purely factual inquiries, most notably the obviousness determination.<sup>15</sup> As to any purely factual findings that inform the legal determination, deference is due, and Rule 52(a) applies. *See Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809, 822, 106 S.Ct. 1578, 1579, 89 L.Ed.2d 817, 821-22 (1986).

This Court should treat the legal issue of claim interpretation in similar fashion. That is, it should give deference only to purely factual findings which

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<sup>15</sup> Another mixed question of fact and law involves patent claims written under the auspices of Section 112 paragraph 6. This Court has indicated that such a claim is invalid where it fails to “clearly link” the structure in the specification to the claim element. *Utah Medical Products, Inc. v. Graphic Controls Corp.*, 350 F.3d 1376 (Fed. Cir. 2003); *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 296 F.3d 1106 (Fed. Cir. 2002). Findings as to what the specification contains should be factual findings (subject to deference), but the ultimate question of whether the specification clearly links structure to claim language is a question of law to be reviewed without deference.

inform the claim construction process, but it should review the ultimate conclusion as a matter of law, *de novo*, without any deference. This Court has not required the district courts to use any particular form of ruling in the claim construction process. If deference were to be given to factual underpinnings, district courts should be encouraged to identify clearly their factual findings in their claim construction rulings.

## **CONCLUSION**

IPLAC hopes that its views submitted herein assist the Court in considering the issues presented for briefing and argument.

Respectfully submitted,

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**Certificate of Compliance**

1. This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 32(a)(7)(B) and specifically the 5,000 word limitation set forth in the Court Order of July 21, 2004 in the above-captioned appeals. The brief contains 3,630 words, excluding the parts of the brief exempted by F. R. App. Proc. 32(a)(7)(B)(iii), according to statistical information reported by the software on which it was prepared.
2. This brief complies with the typeface requirements of F. R. App. Proc. 32(a)(5) and the type style requirements of F. R. App. Proc. 32(a)(6). The brief has been prepared in a proportionally spaced typeface using Microsoft Office WORD 2003 in 14 point Times New Roman.

**Certificate of Service**

I hereby certify that the foregoing brief is being served on the principal counsel for each party and each *amicus curiae* who has entered an appearance, by mailing two copies to each of them via first class mail, postage prepaid, on the date indicated below, addressed as follows:

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