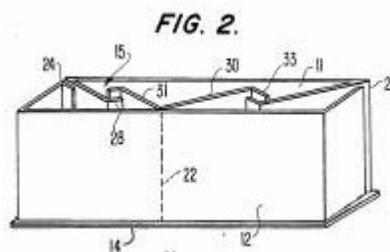


En Banc Federal Circuit Panel Changes The Law of Claim Construction: Phillips v. AWH Corp. (Fed. Cir. 2005) (en banc).

By Dennis Crouch

In a much anticipated opinion, the CAFC has refocused its approach to claim construction — moving away from the extrinsic evidence of dictionaries and encyclopedias toward a more detailed analysis of the patent specification.



In Texas Digital, the court noted that "dictionaries, encyclopedias and treatises are particularly useful resources to assist the court in determining the ordinary and customary meanings of claim terms." . . . Although the concern expressed by the court in Texas Digital was valid, the methodology it adopted placed too much reliance on extrinsic sources such as dictionaries, treatises, and encyclopedias and too little on intrinsic sources, in particular the specification and prosecution history. . . . That approach, in our view, improperly restricts the role of the specification in claim construction.

The court logically found that the problem of using dictionaries in claim construction is that they focus the inquiry on the abstract meaning of words rather than on the meaning of claim terms within the context of the patent.

Yet heavy reliance on the dictionary divorced from the intrinsic evidence risks transforming the meaning of the claim term to the artisan into the meaning of the term in the abstract, out of its particular context, which is the specification.

Interpreting 35 U.S.C. 112, the CAFC determined that the statute requires that the specification inform the claim construction.

In light of the statutory directive that the inventor provide a "full" and "exact" description of the claimed invention, the specification necessarily informs the proper construction of the claims.

The majority acknowledged that this decision does not fully clarify claim construction jurisprudence. Leaving the real analysis to be done on a case-by-case basis.

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

In addition to the majority opinion, a dissent and a dissent-in-part were filed. In dissent, Judges Mayer and Newman continued their longstanding vocal objections to the rule that claim construction is a “matter of law” that should be decided *de novo*.

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

Bottom Line:

- Careful patent drafting is now more important than ever. Under *Phillips*, the specification “necessarily” informs proper claim construction. Whether a patent drafter acts intentionally or not, the specification is now likely to shape the meaning of the claims. Best make it intentional.
- Textual analysis will be key: for example, because claims referred to “steel baffles,” a court may draw an inference that, in general, baffles can be made of non-steel materials.
- District court claim construction decisions will continue to be overturned on a regular basis.

NOTE: This article is not legal advice and is intended primarily for other attorneys. Views and conclusions expressed should not be attributed to MBHB LLP.