March 2016

Phillips v. AWH Corporation: Asking Questions, but Refusing to Hear the Answer - A Critical Analysis of the Court of Appeals for the Federal Circuit's Recent Decision Regarding the Use of Dictionaries and the Standard of Review in Claim Construction

Christopher A. Jethrow

Please take a moment to share how this work helps you through this survey. Your feedback will be important as we plan further development of our repository. Follow this and additional works at: http://ideaexchange.uakron.edu/akronintellectualproperty

Part of the Intellectual Property Law Commons

Recommended Citation
Available at: http://ideaexchange.uakron.edu/akronintellectualproperty/vol1/iss1/4

This Notes is brought to you for free and open access by Akron Law Journals at IdeaExchange@UAkron, the institutional repository of The University of Akron in Akron, Ohio, USA. It has been accepted for inclusion in Akron Intellectual Property Journal by an authorized administrator of IdeaExchange@UAkron. For more information, please contact mjon@uakron.edu, uapress@uakron.edu.
PHILLIPS V. AWH CORPORATION: ASKING QUESTIONS, BUT REFUSING TO HEAR THE ANSWER - A CRITICAL ANALYSIS OF THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT’S RECENT DECISION REGARDING THE USE OF DICTIONARIES AND THE STANDARD OF REVIEW IN CLAIM CONSTRUCTION

I. INTRODUCTION

In 1790, Congress passed the Patent Act of 1790. Although Congress passed the act with great reservation by one of its drafters, Thomas Jefferson, it would later spark a technology boom in the United States. If Thomas Jefferson were alive today, he would not be "embarrassed" at the granting of the monopoly for an invention, but at the embarrassment that after 200 hundred years there are basic questions about the patent system that have not been answered. The Court of Appeals for the Federal Circuit recently requested that interested parties assist the court in answering, among other questions, what role dictionaries should play in claim construction and what deference, if any, should the Federal Circuit give to a lower court’s claim construction. But when given those answers, the Federal Circuit chose only to deal with the “small” issue of the use of dictionaries and ignore the all important question of what deference to give to lower courts’ decisions. Hoping to take the battle to the Supreme Court, AWH petitioned the Supreme Court to finally answer the question that patent attorneys have been waiting to hear.

2. Graham et al. v. John Deere Co. of Kansas, 383 U.S. 1, 7-8 (1966) (stating that Jefferson feared that the creation of a patent system would also create the embarrassment of a monopoly).
3. See infra notes 80-99 and the accompanying text.
4. See infra notes 115-134 and the accompanying text.
5. Phillips v. AWH Corporation, 415 F.3d 1303, 1328 (2005) (en banc), cert. denied, 126 S. Ct. 1332 (2006) (“After consideration of the matter, we have decided not to address that issue at this time. We therefore leave undisturbed our prior en banc decision in Cybor.”).
This note begins in Section II by summarizing the history of the patent system and introducing two of the main issues raised in Phillips v. AWH Corp. Section III gives the history of Phillips v. AWH Corp. and how it has progressed through the legal system. Section IV analyzes the two main issues raised in Phillips and the impact of the decision. Finally, Section V concludes with closing remarks for the future of patent law in the United States.

II. BACKGROUND

A. The Patent System Generally

The Constitution of the United States of America invests in Congress the power to establish a national patent system. Using this granted power, Congress enacted the Act of 1790 that created a national patent system. Later, Congress amended this act in 1793 and created

is correct in holding that all aspects of a district court's patent claim construction may be reviewed de novo on appeal.” *Id.* at i. The main points of AWH Corps.' Petition are:

A. The Federal Circuit's Insistence That Claim Construction Does Not Include Any Factual Issues Conflicts With This Court's Decision In *Markman And Graham*.

B. The Federal Circuit's Applications of De Novo Review To The Factual Findings Underlying Claim Construction Conflicts With Federal Rule of Civil Procedure 52(a) And This Court's Decisions Regarding Appellate Review Of Mixed Questions Of Law And Fact

C. The Issue Of The Proper Standard Of Deference On Appeal Is Ripe For Review By This Court

D. This Case Is An Ideal Vehicle For Resolving The Issue

*Id.* at iii – iv. In opposition to AWH's petition, Phillips has filed a reply that states 1) the case is not presented in the correct posture for review because the district court has already declined to rule on the issue, the issue is not ripe for discussion and the facts of the case should not be reviewed, 2) that even if the case were in the correct posture for the appeal, the district court is following the guidance of the Supreme Court, there is no conflict with F. R. Civ. P. 52(a) and claim construction is purely question of law. F. David LaRiviere, Opposition to Petition filed by AWH Corporation, http://patentlaw.typepad.com/patent/2006/01/phillips_v_ahw_.html (last visited Feb. 11, 2006). On February 21, 2006 the Supreme Court of the United States denied certiorari to consider the questions raised in Phillips. AWH Corp. v. Phillips, 126 S. Ct. 1332 (2006) (certiorari denied).

7. See infra notes 11-99 and accompanying text.

8. See infra note 100-134 and accompanying text.

9. See infra note 135-200 and accompanying text.

10. See infra notes 201-206 and accompanying text.

11. U.S. CONST. art. I, § 8, cl. 8. (“The Congress shall have the Power To . . . promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive right to their respective Writings and Discoveries.”).

12. See Act of Apr. 10, 1790, ch. 7, 1 Stat. 109. The act authorized patents for "any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used," provided a designated group of executive officers (the Secretary of State, the Secretary of War, and the Attorney General) determined that the invention was "sufficiently useful and
the foundation for the patent system as it exists today. Congress later empowered the Commissioner of Patents to handle the large number of submitted patents. On April 2, 1982, in an attempt to create uniformity in the patent system, President Ronald Reagan signed into law the Federal Courts Improvements Acts of 1982. Congress has created several defenses that an alleged infringer can assert against the owner of a granted patent. Among the list of defenses, an alleged infringer can show that the patented matter lacks novelty or that the invention was “insufficiently disclosed in the inventor’s specification.” The Patent and Trademark Office subjects important.” DONALD S. CHISUM, CHISUM ON PATENTS §2.

13. CHISUM, supra note 12, at § 2. The Act of 1793 authorized patents for “any useful art, machine, manufacture, or composition of matter, or any new and useful improvement [thereon], not known or used before the application. . . .” Id. As stated by Donald Chisum, “[t]he 1790 and 1793 patent statutes, and court decisions interpreting them, introduced fundamental concepts that remain features of United States patent law.” Id. 

14. 35 U.S.C. §131(2005) (“It was duty of Commissioner [now Director of U.S. Patent and Trademark Office] to decide whether invention was new and whether it was proper subject of patent.”). Congress empowered the Commissioner to act free of the courts when it stated that “[the] Commissioner [now Director of U.S. Patent and Trademark Office], not the courts, has duty of promulgating rules and procedures for examination of patent applications.” Id. 

15. 28 U.S.C. § 1295 (2005). The creation of the Court of Appeals for the Federal Circuit was not without much controversy. See MARTIN J ADELMAN, RANDALL R. RADER, JOHN R. THOMAS & HAROLD C. WEGNER, CASES AND MATERIALS ON PATENT LAW 15-16 (2nd ed. 2003). Several lawmakers were concerned that the creation of a specialized court “might foster legal doctrines out of the mainstream of American jurisprudence or might fall captive to a narrow segment of the bar.” Id. at 16. To address this issue, the final version of the act provided jurisdiction for the court in “more than ten categories of appeals from patents to customs to taxes to government contracts and more.” Id. (commenting on the coverage of 28 U.S.C. §1295). Some authors see the creation of the Federal Circuit as the first major structural change in the federal appellate system since creation of the regional circuits in 1891. The confusion in patent law reached such proportions in the late 1960s and 1970s that only a structural change of this magnitude could correct the problem. Since its creation, the Federal Circuit has sought to bring uniformity and predictability to patent law. Id. 

16. CHISUM, supra note 12, at § 2. Because of the “embarrassment of an exclusive patent” the courts fashioned rules that limit the duration of a patent’s life and allow for those who believe the patent has been unjustly granted to challenge the patent. Graham v. John Deere Co., 383 U.S. 1, 9 (1966). As a proponent of the patent system, Jefferson feared that patents would be granted for “small details, obvious improvements or frivolous devices.” Id. The defenses granted to alleged infringers allows the public to ensure that patents that are issued provide some benefit to the public. Id. 

17. CHISUM, supra note 12, at § 2. The defenses provided are: [T]he specification, filed by the plaintiff, does not contain the whole truth relative to his discovery, or . . . contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made, for the purpose of deceiving the public;
each patent application to a thorough examination by an Examiner. In the event that a patent applicant disagrees with the finding of the Examiner, the applicant can appeal the decision to the Commissioner or to the Board of Patent Appeals. If the applicant is still not satisfied with the decision of the Board of Patent Appeals, the applicant can further appeal to the U.S. District Court for the District of Columbia or the U.S. Court of Appeals for the Federal Circuit.

One area of consistent conflict is over the construction of the meaning of claims in a patent. As a relatively new area of law, claim

18. CHISUM, supra note 12, at § 1. As stated by Donald Chisum: The PTO assigns each application to an examiner with technical training in the pertinent technology who conducts a search of the prior art and determines whether the applicant’s invention complies with the legal requirements of patentability: novelty, utility, nonobviousness, enabling disclosure, and clear claiming. If the examiner reaches a favorable decision, he or she allows the claims.

19. See IRA H. DONNER, 1 PATENT PROSECUTION, LAW, PRACTICE AND PROCEDURE 208-09 (4th ed. 2005). The Applicant may appeal the decision to either the Commissioner or to the Board of Patent Appeals and Interferences depending on the objection and rejection. Id. at 209. The Board has stated:

[T]hat part of the examiner’s “objection” which centers on description, enablement and best mode concerns the correspondence of the specification to the statutory requirements set fourth in 35 U.S.S. Section 112 and is within the jurisdiction of this Board. However, that part of the “objection” which relates to the examiner’s desire for information concerning (a) an explanation of the “gist” of the invention, [and] (b)... the goals sought to be achieved by the inventors, relates solely to the ease and accuracy of the examination process and the ability of the examiner to obtain sufficient information therefrom to effectively examine the application. It concerns either the rules of practice or established customs and practices. It is outside the jurisdiction of this Board.

Id. (quoting from Ex parte C, 27 USPQ2d 1492, 1494 (B.P.A.I. 1993)) The Patent Office is obligated to follow the decisions of the Federal Circuit or the Federal Circuit’s predecessor, the Court of Customs and Patent Appeals. Id. For a discussion on the appeal process within the Patent Office, see DONNER, supra note 19, at 208-17.

20. Id. at 217 (stating the rule as described in Rules of Practice Before the Board of Patent Appeals and Interferences, 68 Fed. Reg. 66, 648 (Nov. 26, 2003)). For a discussion on the appeal process with the Federal Circuit, see DONNER, supra note 19, at 217-37.

21. James W. Brady, Jr. and Gary M. Hoffman, Patent Claim Construction as Clarified by the Federal Circuit in Phillips v. AWH Corp., INTELLECTUAL PROPERTY TODAY, Sept. 2005, at 32 (stating that the decision in Phillips v. AWH Corp. leaves important questions unanswered). See also, Kimberly A. Moore, Markman, Eight Years Later: Is Claim Construction More Predictable?, 9 LEWIS & CLARK L. REV. 231, 233 (2005) (stating that the reversal rate, “rate at which the Federal Circuit determined the claim construction was wrong,” is at 34.5% since Markman was decided). Claims are the most important part of the patent because the claims define the metes and bounds of the invention. ADELMAN, supra note 15, at 525. Claims must “precisely define entitlements for worldwide markets and industries.” Id. Patent claims are have three major parts, the preamble, the
construction is still in its formative years. One area of patent law that is still in development is claim construction with regards to dictionaries, and what deference, if any, the Federal Circuit should give to the decisions of lower courts.

B. Dictionary definitions and claim construction

To determine if a patent has been infringed, judges developed a two-step process. The judge will first look at the claim and determine a construction of its meaning. The judge will then compare the construction of the claim to the accused product. The first step in this two-step process often uses both intrinsic and extrinsic evidence.

transition phrase, and the body. Id. at 533. The preamble is used to notify others of the broad area of technology to which the invention relates. Id. at 534. The transition phrase defines whether the claims is “open” or “closed.” Id. at 541. An open claim is limited to “structures containing at least the recited elements” while closed claims are limited to the elements listed in the claims. Id. The body of the patent claim “recites the elements of the invention, as well as their interaction with each other either structurally or functionally.” Id. at 542.

22. See generally, ADELMAN, supra note 15, at 16 (stating that the field of patent law was in a state of confusion in the late 1960s and 1970s.) Adelman’s book performs a case by case analysis of patent laws and decisions from the various courts in the history of patent law to determine how uniform and predictable this field of law is. Id. See also, Brady, supra note 21, at 33 (stating that the issue of deference to other courts still needs to be address in patent law); Moore, supra note 21, at 246-7 (stating that claim construction is still in its adolescence, “eight years from the Supreme Court’s Markman and ten years from the Federal Circuit’s Markman”).

23. See generally, Brady, supra note 21, at 32-33 (stating that the use of dictionaries as extrinsic or intrinsic evidence has been in flux since the decision of the Federal Circuit In Texas Digital Inc. v. Telegenix, Inc., 308 F.3d 1193 (2002), Nystrom v. TREX Co., 374 F.3d 1105 (Fed. Cir. 2004) withdrawn and substituted 424 F.3d 1136 (Fed. Cir. 2005) and Inverness Med. Switz. GmbH v. Warner Lambert Co., 309 F.3d 1373 (Fed. Cir. 2002). which place more weight on the dictionary than on the specification). Judges on the Federal Circuit, such as Judge Mayer, have consistently dissented from the Federal Circuit’s holding that claim construction is a question of law and not fact. See e.g., Phillips v. AWH Corp., 415 F.3d at 1330 (Mayer, J., dissenting).

24. CHISUM, supra note 12, at § 18.03. In one decision the court stated: This court’s precedent provides a road map for district courts in assessing whether accused devices infringe patent claims. In short, an assessment of whether an accused device infringes claims of a patent necessarily involves both an identification and interpretation of the asserted claims, and a comparison of the properly interpreted claim limitations to the elements of the accused device. The first step in any such analysis is to construe the claims at issue, which is a matter of law for the court. Once the court has construed the claim limitations, the second step in its analysis is to apply the claims to the accused device. Id. (quoting Allen Engineering Corp. v. Bartell Industries, Inc., 299 F.3d 1336 (Fed. Cir. 2002))

25. Id. at § 18.03 n. 1. Each claim in a patent is considered individually to determine if infringement has occurred. Id. If one claim of a patent is infringed, the entire patent is deemed to have been infringed. Id.

26. Id. at §18.03 n. 2. See also, Markman v. Westview Instruments, 52 F.3d 967, 976 (Fed. Cir. 1995) (en banc), aff’d, 517 U.S. 370 (1996).

27. Markman v. Westview Instruments, 52 F.3d at 979-980. The court in Markman stated the
Courts are often divided on whether certain evidence is intrinsic or extrinsic.\(^{28}\) Due to the complexity of modern technology, courts often resort to the use of dictionaries to define certain terms.\(^{29}\) Once a court allows the introduction of a dictionary as evidence of the meaning of a term, the court must also determine which dictionary to use because both general dictionaries and technical dictionaries exist.\(^{30}\) The decision of which dictionary to use is often based on the degree of technical information involved in the disputed patent.\(^{31}\)

Claim construction becomes an important issue when lower courts interpret the patent claims to have one construction and the Federal Circuit determines that the claims have a different construction.\(^{32}\) The meaning of a claim is determined by looking at the claims, specification and prosecution history. *Id.* at 979 (quoting from Unique Concepts, Inc. v. Brown, 939 F.2d 1558, 1561 (Fed. Cir. 1991)). The court goes on to state that “[i]n construing the claims in this case, all these sources, as well as extrinsic evidence in the form of Westview’s sales literature, were included in the record of the trial court proceedings.” *Id.* at 979.

28. *Chisum*, supra note 12, at § 18.03. Chisum states that:

Other decisions have questioned whether it is accurate to characterize dictionaries, treatises, and encyclopedia as extrinsic, given the accepted notion that courts may always consult them and given that such published texts, unlike other forms of extrinsic evidence, such as expert testimony, are available to the public as of the date the patent is granted.

*Id.* at § 18.03.

29. *Id.* at § 18.03. The court in *Texas Digital* stated that:

(1) [d]ictionaries, encyclopedias and treatises, publicly available at the time the patent is issued, are objective resources that serve as reliable sources of information on the established meanings that would have been attributed to the terms of the claims by those of skill in the art.;

(2)[a]s resources and references to inform and aid courts and judges in the understanding of technology and terminology, it is entirely proper for both trial and appellate judges to consult these materials at any stage of a litigation, regardless of whether they have been offered by a party in evidence or not”; and

(3) categorizing them as ‘extrinsic evidence’ or even a ‘special form of extrinsic evidence’ is misplaced and does not inform the analysis.

*Id.* at 18.03 (quoting from Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202-03 (2002)).

30. *Texas Digital*, 308 F.3d at 1204-05.

31. *Id.* at 1205. The court stated:

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

*Id.*

Federal Circuit has consistently held that claim construction is question of law, not a question of fact, and therefore the Federal Circuit does not have to give deference to the construction of the lower court. However, this lack of deference often results in needless rehearing of previously submitted evidence and high litigation costs. The Federal Circuit developed the rules of claim construction review and the use of dictionaries in claim construction in several major cases.

C. Prior Federal Court Cases

1. Markman v. Westview Instruments, Inc.

The use of dictionaries in claim construction has occurred over a long line of cases. One of the leading cases in claim construction is Federal Circuit’s decision in Markman v. Westview Instruments, Inc. The case concerned a patent that disclosed an apparatus and method for tracking articles in a dry cleaning business. The Markman jury ruled

in a patent claim in Inverness Medical Switzerland GmbH v. Warner Lambert Co., 309 F.3d 1373 (Fed. Cir. 2002)).

33. See infra notes 80-99 and accompanying text.
34. See, e.g., Moore supra note 21, at 233.
35. See infra notes 36-99 and accompanying text.
36. Markman, 52 F.3d at 967.
37. Compare Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576 (Fed. Cir. 1996) (holding that extrinsic evidence “in general, and expert testimony in particular, may be used only to help the court come to the proper understanding of the claims; it may not be used to vary or contradict the claim language”) with Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193 (Fed. Cir. 2002) (holding that dictionaries should be consulted first to determine “possible meanings that would have been attributed to the words of the claims by those skilled in the art” and then looking at the specification to see if the specification is consistent with the dictionary definition) and Brady, supra note 21, at 32 (stating that a line of cases beginning with Texas Digital and continuing through Nystrom v. TREX Co., 374 F.3d 1105 (Fed. Cir. 2004) and Inverness Med. Switz. GmbH v. Warner Lambert Co. 309 F.3d 1373 (Fed. Cir. 2002) agree that dictionaries should be given more weight in claim construction when determining the meaning of words in claims).
38. Markman, 52 F.3d at 967.

1. The inventory control and reporting system, comprising:

a data input device for manual operation by an attendant, the input device having switch means operable to encode information relating to sequential transactions, each of the transactions having articles associated therewith, said information including transaction identity and descriptions of each of said articles associated with the transactions;

a data processor including memory operable to record said information and means to maintain an inventory total, said data processor having means to associate sequential transactions with unique sequential indicia and to generate at least one report of said
that the Markman design was infringed by Westview. 40 The district court, however, reversed the opinion of the jury and construed the claims so that there was no infringement by Westview. 41 Markman appealed, claiming that the district court incorrectly reviewed the jury’s decision concerning the facts of the case and in turn substituted the district court’s decision for the jury’s. 42 Markman also claimed that the district court incorrectly construed the meaning of the word “inventory.” 43

The total and said transactions, the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another;

a dot matrix printer operable under control of the data processor to generate a written record of the indicia associated with sequential transactions, the written record including optically-detectable bar codes having a series of contrasting spaced bands, the bar codes being printed only in coincidence with each said transaction and at least part of the written record bearing a portion to be attached to said articles; and,

at least one optical scanner connected to the data processor and operable to detect said bar codes on all articles passing a predetermined station, whereby said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom.

‘054 Patent.

In dependent claim 10, Markman specifies that in the invention of claim 1, the input device is an alpha-numeric keyboard wherein single keys may be used to enter attributes of items being entered. Markman, 52 F.3d at 972.

40. Id. at 973. Westview is the owner of specialty electronic equipment that it uses in one of its dry cleaning shops. Id. at 972. The accused infringing device consists of a DATAMARK and a DATASCAN that is used to identify additional or missing invoices. Id. The DATAMARK only retains in its memory the invoice number, date, and cash total. Id. The DATASCAN is this carried about the store to read the inventory on hand and compare it to the list stored by the DATAMARK. Id. at 973. The jury was instructed by the court to construct the meaning of the claims of the ‘054 Patent by considering the specification, drawings, file history and other relevant documents. Id. at 973. The jury was then instructed to determine how the terms of the claim would be understood by those with ordinary skill in the art. Id. Finally, the jury was to compare the claims to the alleged infringing devices to determine if infringement occurred. Id. The jury found that the Westview infringing claims 1 and 10 of the ‘054 Patent.

41. Id. at 973. The district court reasoned that because claim construction was a matter of law, it was entitled to review the finding of the jury. Id. at 973. The court held that “inventory” was “articles of clothing” and not simply transaction totals or dollars.” Id. at 973. The court also found that “Westview’s device does not have the ‘means to maintain inventory total’ required by claim 1, and cannot ‘detect and localize spurious additions to inventory as well as spurious deletions therefrom,’ and directed a verdict of noninfringement of claims 1 and 10.” Id. at 973.

42. Markman, 52 F.3d at 973-4. Markman argued that the court had improperly replaced the finding of the jury with its own findings. Id. at 974. Markman argued that claim construction was an issue of fact that a jury is to decide based on the evidence presented. Id. at 973. As such, the judge is not permitted to replace his decision with that of the jury. Id. The claims at issue, according to Markman, were properly construed by a competent jury, as directed by the judge. Id. At trial, the judge was tasked by the judge to aid in the determination of infringement by construing the claims of the patent in issue. Id. at 974. Markman stated that once this task was given to the jury, it could not be taken back, or overruled by the judge. Id.

43. Id. at 974. The jury was presented with all the facts of the case, the patent, the prosecution history, experts and documents, to arrive a competent decision. Id. Aside for the issue
Federal Circuit affirmed the decision of the district court, holding that the claim construction is a question of law and the district court’s review of the jury’s decision was proper.\textsuperscript{44}

On review of the lower court’s decisions, the Supreme Court addressed the issue of whether claim construction is a question of law for the judge to decide or a question of fact for the jury to decide.\textsuperscript{45} The Supreme Court started by considering the history of patent law to determine if the question has historically been one of law or fact.\textsuperscript{46} However, the Supreme Court never ruled on the issue of the importance of extrinsic evidence, thus leaving the district courts to develop their own interpretation of its importance.\textsuperscript{47}

of who determines the meaning of the word “inventory” Markman claims that “based on all the evidence presented at trial, the term ‘inventory’ as used in claim 1 means ‘article of clothing’ or ‘dollars’ or ‘cash’ or ‘invoices,’ and is not necessarily limited to a construction that always includes ‘articles of clothing’ “ \textit{Id.}

\textsuperscript{44}. \textit{Id.} at 970. The opinion of the court, stated by Chief Judge Archer stated that “in this case the district court properly discharged its obligation to delineate the scope of the claim on motion for judgment as a matter of law when the jury had rendered a verdict that was incompatible with a proper claim construction.” \textit{Id.}

\textsuperscript{45}. \textit{Markman}, 517 U.S. at 376. The decision of the Supreme Court remains in controversy. See e.g., \textit{Phillips}, 415 F.3d at 1330-5 (Mayer, C.J., dissenting) (stating that the Supreme Court, in affirming \textit{Markman}, never stated that claim construction is purely a question of law). Judge Mayer has taken that position that the Supreme Court only stated that as a “policy matter” judges should determine the meaning of claims. \textit{Id.} at 1330. Judge Mayer argues that the Supreme Court has not accepted the Federal Circuit’s blanket formulation that claim construction is a question of law. See \textit{Cybor Corp. v. FAS Technologies, Inc.}, 138 F.3d. 1448, 1464 (Fed. Cir. 1998) (Mayer, C.J., dissenting).

\textsuperscript{46}. \textit{Markman}, 517 U.S. at 376. The Supreme Court has traditionally used a three part test to determine whether actions are questions of law or questions of equity. Joan E. Schaffner, \textit{The Seventh Amendment Right to Civil Jury Trial: The Supreme Court Giveth And The Supreme Court Taketh Away}, 31 U. BALT. L. REV. 225, 226 (Spring 2002). The first step is to determine if the action was tried at law or analogous to an action that was tried at law. \textit{Id.} If the action is one tried at law, the Court will determine “whether the particular trial decision must fall to the jury in order to preserve the substance of the common-law right as it existed in 1791.” \textit{Id.} (quoting \textit{Markman}, 517 U.S. 370, 376 (1996)). If the action meets this criteria, then the jury must decide the action. \textit{Id.} Finally, the Court will determine the deference to be given to the jury’s decision by the trial judge and the appellate courts. \textit{Id.} at 227-228. The Supreme Court in \textit{Markman} determined that there is a right to a jury trial for infringement actions. \textit{Markman}, 517 U.S. at 376. However, when dealing with claim construction the “Court found no persuasive authority indicating more than a possibility that juries historically interpreted terms of art in a specification. Consequently, the jury guarantee of the Seventh Amendment did not encompass the jury’s construction of the claim.” Schaffner, \textit{supra}, at 244. Ultimately, the Court determined that in an effort to achieve conformity in patent claim construction, the judge would be best at performing the claim construction. \textit{Id.} at 244.

\textsuperscript{47}. \textit{Chisum, supra} note 12, at § 18.03. See e.g., \textit{Astrazeneca AB v. Mut. Pharm. Co, Inc.}, 384 F.3d 1333, 1336 (Fed. Cir. 2004) (stating that the District Court is relying on “recent case law, which is unfortunately complex and inconsistent); C.R. Bard, Inc. v. United States Surgical Corp., 388 F.3d 858, 861-62 (Fed.Cir. 2004) (admitting that there are two opinions in the district courts where one opinion is that the “intrinsic record is the primary source for determining claim meaning” and a second opinion that follows \textit{Texas Digital} by “emphasiz[ing] technical and general-usage
2. Vitronics Corporation v. Conceptronic, Inc.\textsuperscript{48}

\textit{Vitronics} involved a suit between Vitronics and Conceptronic for the violation of two U.S. patents.\textsuperscript{49} A jury found that the '301 patent was not infringed but both parties disputed the meaning of the term “solder flow temperature” in the ‘502 patent.\textsuperscript{50} After hearing all the evidence, the district court found for Conceptronic as a matter of law.\textsuperscript{51}

dictionaries in determining the ordinary meaning”).

\textsuperscript{48} 90 F.3d 1576 (Fed. Cir. 1996).

\textsuperscript{49} \textit{Vitronics}, 90 F.3d at 1578-79. The invention in question dealt with a process for soldering of components onto a circuit board. \textit{Id.} at 1579. The process entailed placing the components on the solder board using a paste. \textit{Id.} The boards were then sent through a multizone oven to be soldered to the board. \textit{Id.} It was critical to the process that the temperature in the oven be below the critical temperature of the components being placed onto the solder board, but high enough to allow the paste to flow and create a solder joint. \textit{Id.} Vitronics sued Conceptronic for violation of U.S. Patent Nos. 4,654,502 and 4,833,301. \textit{Id.} The claim in issue of U.S. Patent No. 4,654,502 states:

1. A method for reflow soldering of surface mounted devices to a printed circuit board comprising:

   moving a printed circuit board having solder and devices disposed on a surface thereof through a first zone and in close proximity to a first emitting surface of at least one nonfocused infrared panel emitter, said first emitting surface being at a first panel temperature;

   moving said board through a second zone and in close proximity to a second emitting surface of at least one nonfocused infrared panel emitter, said second emitting surface being at a second panel temperature lower than said first panel temperature; and

   moving said board through a third zone and in close proximity to a third emitting surface of at least one nonfocused infrared panel emitter, said third emitting surface being at a third panel temperature higher than said second panel temperature, said third emitting surface heating said board and said solder to a solder reflow temperature for a period of time sufficient to cause said solder to reflow and said soldered devices to be soldered while maintaining the temperature of said devices below said solder reflow temperature.


\textsuperscript{50} \textit{Id.} at 1579-80. Vitronics’s appeal is centered around their requested jury instruction. \textit{Id.} at 1579. Vitronics claims that the proper jury instruction should have stated that the proper definition of solder reflow temperature is “the temperature reached by the solder during the period it is reflowing during the final stages of the soldering process, sometimes referred to as the ‘peak solder reflow temperature.’” \textit{Id.} Vitronics asserted that the definition does not mean the “liquidus temperature,” the temperature at which the solder first begins to melt. \textit{Id.} at 1580. As a result, if this definition is applied by the court, the ‘502 patent has been infringed as a matter of law. \textit{Id.} at 1580. Conceptronic, however, claims that solder reflow temperature means “peak reflow temperature, \textit{i.e.,} a temperature approximately 20 degrees C above the liquidus temperature, at which the solder is completely melted and moves freely.” \textit{Id.} If this definition is used, the ‘502 patent has not been infringed by Conceptronic. \textit{Id.}

\textsuperscript{51} \textit{Vitronics}, 90 F.3d at 1580. The district court delayed ruling on the meaning of the disputed term until the close of all testimony. \textit{Id.} The court relied on the patent specification, expert testimony, information for Vitronics and its employees and technical references provide
On review, the Federal Circuit, while relying significantly on the wording of the claims and specification, held that the "solder flow temperature" limitation should have been interpreted in favor of Vitronics. The Federal Circuit reasoned that the meaning of terms in a claim are to be construed by giving weight to intrinsic evidence first. Only when there is a significant conflict, will extrinsic evidence be used to determine the meaning of terms. As a result of the holding in Vitronics, courts subsequently gave more weight to intrinsic evidence over extrinsic evidence.


The Texas Digital case, however, signaled a change in the direction of several circuit courts in their handling of intrinsic versus extrinsic evidence. In Texas Digital, the plaintiff, Texas Digital Systems, Inc., brought an action against Telegenix, Inc. for patent infringement. During trial and through briefs filed by both parties, Vitronics asserted during the trial that, although the meaning of solder reflow temperature was ambiguous, there was still adequate explanation of the term in the specification for a court to use in determining the meaning of the term. However, Conceptronic based most of its case on expert testimony and documents from Vitronics that use a definition similar to the one asserted by Conceptronic. In effect, the construction of the claim hinged on what weight to give the specification versus extrinsic evidence.

[52. Id. at 1587. The Federal Circuit stated that the district court did not provide the reasoning behind its interpretation of the claim term, thus the Federal Circuit reviewed the evidence in total.]

[53. Id. at 1584. The Federal Circuit determined that the district court gave too much weight to the extrinsic evidence in allowing it to overrule the weight of the intrinsic evidence.]

[54. Id. at 1584. The Federal Circuit stated that extrinsic evidence, in particular expert testimony, can only be relied on if "the patent documents, taken as a whole, are insufficient to enable the court to construe disputed claim terms." However, the Federal Circuit did admit that dictionaries and prior art documents are not in the same class of extrinsic evidence as expert testimony, thus they are more objective and reliable guides. Id. The Federal Circuit reasoned that "these sources are accessible to the public in advance of litigation." For the Federal Circuit opinion on the weight of opinion testimony, refer to Markman, 52 F.3d at 983 ("First, the testimony of Markman and his patent attorney on the proper construction of the claims is entitled to no deference... This testimony about construction, however, amounts to no more than legal opinion – it is precisely the process of construction that the court must undertake.").]

55. Vitronics, 90 F.3d at 1584.


57. Brady, supra note 21, at 32 (stating that the opinion in Phillips "provided meaningful points and clarified concepts where previous Federal Circuit decisions were inconsistent"). Brady discusses how the Federal Circuit has acknowledged that its prior decisions needed "clarification" and how "previous Federal Circuit opinions placed too much emphasis on dictionary definitions of claim terms, and too little emphasis on the patent's specification.")

58. Texas Digital Systems, Inc. v. Telegenix, Inc. 308 F.3d 1193, 1197 (Fed. Cir. 2002). The plaintiff claims that the defendant has infringed four patents, U.S. Patent Nos. 4,845,481, 4,965,561, 4,734,619 and 4,804,490. Id. at 1197.
Texas Digital owned patents that disclosed how to control the color of pixels in a light emitting diode ("LED") display.\textsuperscript{59} The dispute between the parties centered on the meaning of the terms in the patent’s claims whose meaning had been constructed by the district court.\textsuperscript{60} Based on the district court’s claim construction, the jury in the original suit found in favor of Texas Digital and the trial court affirmed this finding.\textsuperscript{61} Telegenix appealed the judgment of the district court, alleging that the court did not correctly interpret several phrases in the patents owned by Texas Digital.\textsuperscript{62}

In its decision, the Federal Circuit found that several of the claim limitations were correctly interpreted, while others were not correctly interpreted, and thus affirmed in part, reversed in part, and remanded.\textsuperscript{63} In reaching its decision, the Federal Circuit relied heavily on the definitions of several of the terms as found in the dictionary.\textsuperscript{64} In one

\textsuperscript{59}. \textit{Id.} As stated by the court, “[e]ach pixel includes at least two elements corresponding to different primary colors, e.g., one red element and one green element. Light signals from the two elements may be blended to produce a composite light signal of variable color.” \textit{Id.} at 1197-98.

One representative claim from the ‘481 patent states:

A method for controlling a color of a variable color display device which comprises a plurality of display areas arranged in a pattern for selectively exhibiting a plurality of display areas arranged in a pattern for selectively exhibiting a plurality of display units, each said display area including a plurality of light sources for emitting upon activation light signals of respectively different primary colors and means for combining said light signals to obtain a composite light signal of a composite color, by exhibiting a selected display unit by repeatedly substantially simultaneously activating the light sources in selected display areas for brief time intervals to cause the light sources to emit light signals of said primary colors, and by selectively controlling the durations of the time intervals of activation of the light sources in the selected display areas to control the portions of the primary color light signals emitted therefrom, to thereby control the color of the exhibited display unit.

\textsuperscript{60}. \textit{Id.} at 1205-15. The jury was instructed as to the district court’s interpretation of the terms “repeatedly substantially simultaneously activating,” “selectively controlling the durations of the time intervals of activation,” “color control means,” “display areas” and “background area,” “display areas arranged in a pattern,” “means for selectively activating said display light sources,” “converter means,” “first means” and “second means,” and “control means for selectively coupling said light sources” \textit{Id.}

\textsuperscript{61}. \textit{Id.} at 1201. The court awarded significant damages to Texas Digital and also permanently enjoined Telegenix from “making, using, selling, or offering to sell its Colorgraphix color display devices.” \textit{Id.} at 1201. The district court also found that each of the asserted claims were not invalid. \textit{Id.}

\textsuperscript{62}. \textit{Texas Digital Systems}, 308 F.3d at 1201. Telegenix appealed the Markman order, the jury instruction, the refusal of the district court to consider several pieces of evidence offered by Telegenix, the admittance of certain evidence by Texas Digital and the reliance of the court on \textit{Wine Railway Appliance Co. v. Enterprise Railway Equipment Co.}, 297 U.S. 387 (1936). \textit{Id.}

\textsuperscript{63}. \textit{Id.} at 1220.

\textsuperscript{64}. \textit{Id.} at 1202-03. The court, in discussing the use of dictionaries in claim interpretation stated dictionaries, encyclopedias and treatises, are “unbiased reflections of common understanding not influenced by expert testimony or events subsequent to the fixing of the intrinsic record by the
instance, the court relied on the Modern Dictionary of Electronics to determine the meaning of a term.65 Once the meaning of the term in the dictionary was found, the court then compared that meaning to the specification to verify that the specification did not state a definition for the term that was counter to the definition in the dictionary.66 If no conflict was found, the court applied the dictionary definition in its interpretation of the claims in the patent.67

4. Inverness Medical Switzerland v. Warner Lambert Company68

*Inverness* continued the trend that began in *Texas Digital*.69 In *Inverness*, the plaintiff Inverness Medical, was the assignee of U.S. Patent Nos. 5,622,871, 5,602,040, and 5,656,503.70 The patents disclosed a pregnancy testing device that utilizes a woman’s urine to

grant of the patent, nor colored by the motives of the parties, and not inspired by litigation.” *Id.* at 1203. The court then went on to state that the intrinsic evidence is then compared to the ordinary meaning of the word. *Id.* at 1204.

65. *Id.* at 1206 (using Modern Dictionary of Electronics to construe the meaning of the term “activating”).

66. *Texas Digital*, 308 F.3d. at 1203. One claim that was in issue hinged on the meaning of the phrase “repeatedly substantially simultaneously activating.” *Id.* at 1205. The Federal Circuit began its claim construction by first looking to the relevant technical dictionary, the Modern Dictionary of Electronics 20 (6th ed. 1984). *Id.* at 1206. The Federal Circuit, then looked to the specification to see if this definition was rebutted, and finding that it was not, the definition from the dictionary was controlling. *Id.* In another instance, the Federal Circuit construed the meaning of the term “display areas” and “background area.” *Id.* at 1209. The Federal Circuit states the method of claim construction is to start by first looking for the “ordinary meaning of ‘display area,’ as reflected in these dictionary definitions.” *Id.* Then the judge is to look at the specification to see it is consistent with the dictionary definition. *Id.*

67. *Id.* at 1205-16. The Federal Circuit constructed a total of nine phrases in the disputed patents. *Id.* Commentors have attacked the ruling in *Texas Digital* as “increas[ing] uncertainty in patent litigation because litigants could never tell in advance what dictionary a judge might use to interpret the patent.” Steve Seidenberg, *Federal Circuit Clears Up Patent-Interpretation Rules, Phillips Forces Trial Courts to Construe Patents Narrowly*, CORPORATE LEGAL TIMES, October 2005, at 28. The change also “ended up creating patent rights beyond the scope of the claims.” *Id.* at 28 (quoting David Long, a partner in the Washington, D.C., office of Howrey). Another commentor stated that “*Texas Digital* created uncertainty in another way, too. Patent litigants could never be sure whether the court hearing their dispute would adhere to *Texas Digital*. About one-third of courts followed the ruling, while the rest used the traditional method of patent interpretation.” *Id.* at 28 (quoting R. Polk Wagner, a professor at the University of Pennsylvania Law School).

68. 309 F.3d 1373 (Fed. Cir. 2002).

69. Brady, *supra* note 21, at 32. Brady discusses how a line of cases, beginning with *Texas Digital* and including *Inverness*, included the dictionary in claim construction. *Id.* See also, *Phillips*, 415 F.3d at 1320-21 (discussing the *Texas* line of cases that place more weight on the dictionary and only looks to the specification if it “contains a sufficiently specific alternative definition or disavowal”).

70. *Inverness*, 309 F.3d at 1374.
determine if she is pregnant or not.71 Inverness claimed that Warner Lambert Company (also known as Pfizer, Inc.) was infringing each of the patents owned by Inverness.72 The issue of infringement centered around the meaning of the phrases "on said test strip," "onto a portion of said test strip," and "mobility... is facilitated."73 The district court construed each of these phrases to the benefit of Pfizer and entered a final judgment of non-infringement.74 Inverness, filed an appeal of the district court's ruling raising two issues of improper claim construction.75

71. Id. at 1375-76.
72. Id. at 1376.
73. Id. at 1377. The disputed language is contained in each patent and is represented by claim 1 of the '871 patent which states:

An analytical test device for detecting an analyte suspected of being present in a liquid biological sample, said device comprising:

a) a hollow casing having a liquid biological sample application aperture and means permitting observation of a test result;

b) a test strip comprising a dry porous carrier contained within said hollow casing, said carrier communicating directly or indirectly with the exterior of said hollow casing through said liquid biological sample application aperture to receive applied liquid biological sample, said carrier having a test result zone observable via said means permitting observation, said test strip, in the dry unused state, containing a labelled reagent capable of specifically binding with said analyte to form a first complex of said labelled reagent and said analyte, said label being a particulate direct label, wherein said labelled reagent is dry on said test strip prior to use and is released into mobile form by said applied liquid biological sample, wherein mobility of said labelled reagent within said test strip is facilitated by at least one of 1) coating at least a portion of said test strip upstream from said test result zone with, or 2) drying said labelled reagent onto a portion of said test strip upstream from said test result zone in the presence of, a material comprising a sugar, in an amount effective to reduce interaction between said test strip and said labelled reagent;

said carrier containing in said test result zone a means for binding said first complex, said means for binding comprising specific binding means and being immobilized in said test result zone;

migration of said applied liquid biological sample through said dry porous carrier conveying by capillarity said first complex to said test result zone of said dry porous carrier whereat said binding means binds said first complex thereby to form a second complex;

said second complex being observable via said means permitting observation, thereby to indicate the presence of said analyte in said liquid biological sample.

Id. at 1376-77.

74. Id. at 1379. The district court allowed both parties to present their evidence to the jury but at the conclusion of closing testimony ruled in favor of Conceptronic. Id.

75. Id. at 1377. The first issue of claim construction was regarding the phrase "mobility of
The Federal Circuit reviewed the construction of the phrases in question and held that the construction of the District Court was incorrect and thus vacated and remanded the case back for further proceedings. The Federal Circuit reviewed each of the disputed claim phrases by first relying on the dictionary meaning of the critical terms in each phrase to determine the phrases' "ordinary meaning[s]." Once the ordinary meaning of each phrase was determined, the court considered the specification, claim language and prosecution history to determine if the applicant had intended another meaning besides the ordinary meaning. Having found that the dictionary meaning was not contradicted, the court held that the district court incorrectly constructed the meaning of "on" and "onto."

D. Claim Interpretation – Question of fact or law?

Despite the fact that the Supreme Court stated in Markman v. Westview Instruments that claim interpretation contains questions and law and that the judge is in a better position than the jury to construe these terms, much debate still remains over whether this rule should still be followed. In other areas of law, issues that deal with determinations of facts are determined by the jury. Only when a question concerning
which law to apply, or the meaning of the law is in question, does a judge rule. 82 In recent years, the increase in the number of cases heard by the Federal Circuit has led many to question whether claim interpretation is really a question of law or fact. 83

1. Markman v. Westview 84

As previously stated, Markman involved the interpretation of a term in a patent. 85 One of the major rulings of the Supreme Court in this case was that claim interpretation should be left to the judge. 86 The Supreme Court began its analysis by first determining if patent infringement is an action at law or one that requires the protection of a jury trial. 87 After not finding an answer to the question in history or precedent, the Supreme Court decided that the judge is in the best position to decide claim interpretation issues. 88

"as with 'custom and usage' in contract interpretation, this is an issue on which an appellate court should defer to the trial judge's findings" and "according deference to underlying fact questions, while reviewing the ultimate conclusion de novo, is something the Federal Circuit already does, thus harmonizing claim construction with other areas").

82. See Hagberg, supra note 81, at 4.
83. See, e.g., Moore, supra note 21, at 246 (noting a rise in the number of cases reversed by the Federal Circuit after the Cybro decision that stated claim construction is a question of law that is reviewable de novo).
85. See supra note 36-47.
86. Markman, 517 U.S. at 373. The Supreme Court stated that the issues in the case were:

[F]irst, whether we are dealing with a cause of action that either was tried at law at the time of the founding or is at least analogous to one that was, see, e.g., Tull v. United States, 481 U.S. 412, 417, 95 L. Ed. 2d 365, 107 S. Ct. 1831 (1987). If the action in question belongs in the law category, we then ask whether the particular trial decision that stated claim construction is a question of law that is

87. Id. at 377-391.
88. Id. at 388-389. The Supreme Court stated:

The construction of written instruments is one of those things that judges often do and are likely to do better than jurors unburdened by training in exegesis. Patent construction in particular is a special occupation, requiring, like all others, special training and practice. The judge, from his training and discipline, is more likely to give a proper interpretation to such instruments than a jury; and he is, therefore, more likely to be right, in performing such a duty, than a jury can be expected to be. Parker v. Hulme, 18 F. Cas. at 1140. Such was the understanding nearly a century and a half ago, and there is

no reason to weigh the respective strengths of judge and jury differently in relation to the

modern claim; quite the contrary, for the claims of patents have become highly technical in many respects as the result of special doctrines relating to the proper form and scope of claims that have been developed by the courts and the Patent Office. Woodward, Definiteness and Particularity in Patent Claims, 46 Mich. L. Rev. 755, 765 (1948).

Id. at 388-389.
2. Cybor Corp. v. FAS Tech., Inc.  

Following the ruling in *Markman*, the Federal Circuit once again addressed the issue of whether claim interpretation is a question of law and thus subject to de novo review. Cybor sued FAS Tech for a declaratory judgment of non-infringement, invalidity and unenforceability of U.S. Patent No. 5,167,837 and FAS Tech, counterclaimed for infringement of the ‘837 patent. The ‘837 patent discloses a “device and method for accurately dispensing industrial liquids.” The invention disclosed in the ‘837 patent is primarily used to dispense small volumes of liquid onto semiconductor wafers. The case was heard by a jury which found that the patent claims were not invalid and that Cybor had literally infringed all claims except 11, 12 and 16, but these three claims were infringed under the doctrine of equivalents. The Federal Circuit, following the two-step process as discussed in *Markman*, found that the patent had been infringed. In
order to reach this decision, the Federal Circuit first considered whether claim interpretation is a question of law or fact.\textsuperscript{96} The Federal Circuit performed a thorough analysis of the decision of the Supreme Court and interpreted the decision to state that all claim construction is a question of law.\textsuperscript{97} However, in reaching this opinion, the Federal Circuit also acknowledged that past decisions by the Federal Circuit had decided in several cases that claim interpretation was a question of fact.\textsuperscript{98} The Federal Circuit attempted to dismiss these prior cases as being consistent with \textit{Markman}, but the standard of review of claim construction remains to be a highly debated issue.\textsuperscript{99}

III. STATEMENT OF THE CASE

\textit{A. Statement of Facts}

The plaintiff, Edward H. Phillips, was the inventor on Patent 4,677,798 entitled “Steel Shell Modules for Prisoner Detention Facilities.”\textsuperscript{100} The patent disclosed a method of constructing metal,
modular wall panels for use in prison facilities.\textsuperscript{101} Phillips’ invention was different from present facility construction practices.\textsuperscript{102} Phillips’ patent disclosed using internal baffles to bear load, eliminate a thermal-acoustical path and deflect projectiles that may impact upon the wall.\textsuperscript{103} Phillips disclosed his patent to AWH and afterwards Phillips discovered AWH was using his design in prison construction.\textsuperscript{104}

B. Procedural History

1. The United States District Court for the District of Colorado

Phillips brought suit on February 3, 1997 against AWH for patent infringement and trade secret misappropriation.\textsuperscript{105} Phillips alleged that AWH had infringed claims 1, 21, 22, 24, 25 and 26 of patent 4,467,798.\textsuperscript{106} The district court concluded that Phillips was barred by

\textsuperscript{101} Id.
\textsuperscript{102} Phillips v. AWH Corp., No. 97-MK-212 (CBS), 2002 U.S. Dist. LEXIS 27298, at *1, *4 (D. Colo. Nov. 20, 2002), rev’d en banc, 415 F.3d 1303 (Fed. Cir. 2005). Two prevailing methods of manufacturing prison facilities use are the “sandwich panels” and the “steel stud panels” methods. Id. The sandwich panel utilized sheets of metal skin over insulation. Id. This method is able to control sound and temperature, but is not adequate for bearing load or resisting fires. Id. Steel stud panels are an improvement over the sandwich panels because steel studs are placed between the panels to allow the wall to bear more load. Id. However, the steel studs also provide a thermal-acoustical path from one panel to the other and thus result in poor sound isolation and temperature control. Id.
\textsuperscript{103} Phillips, 2002 U.S. Dist LEXIS 27298, at *1. Phillip’s design uses a thermal-acoustical sealant between the two opposing panels and internal baffles at angles other than 90 degrees. Id. The baffles did not contact both exterior panels and thus do not provide an acoustical path from one panel to the other. Id. The baffles also are able to provide resistance to bullets and other projectiles by deflecting the bullets or projectiles. Id.
\textsuperscript{104} Phillips v. AWH Corp., 363 F.3d 1207, 1210 (Fed. Cir. 2004), vacated by Phillips v. AWH Corp., 376 F.3d 1382 (Fed. Cir., 2004). In 1989, Phillips entered into a contract with AWH Corporation, Hopeman Brothers, Inc., and Lofton Corporation (Collectively “AWH”). Id. The agreement between AWH and Phillips was for the marketing and selling of Phillips’ new design. Id. The agreement between Phillips and AWH expired on 1990 and the following year Phillips obtained a brochure from AWH that showed a panel design similar to that disclosed by Phillips to AWH. Id. Phillips attempted several times to resolve the issue. Id.
\textsuperscript{105} Phillips, 2002 U.S. Dist LEXIS 27298, at *1. A “Markman” hearing was conducted on October 3, 2000. Id. A Markman hearing is the common term used to describe a claim construction hearing as required by the United States Supreme Court in Markman v. Westview Instruments, 517 U.S. 370 (1996). Id. at *2.
\textsuperscript{106} Id. at *3. The disputed claims state:

Claim 1. Building modules adapted to fit together for construction of fire sound and impact resistant security barriers and rooms for use in securing records and person, comprising in combination, an outer shell of substantially parallelepipeds shaped with two outer steel plate panel sections of greater surface area serving as inner and outer walls for a structure with a plurality of the modules are fitted together, sealant means
the statute of limitations from bringing this cause of action regarding trade secret misappropriation.\textsuperscript{107} The district court also construed the meaning of the claims in question and found that the defendant AWH, had not infringed the ‘798 patent.\textsuperscript{108} Phillips appealed from the dismissal

Claim 21. A prisoner detention facility providing vandalism resistance constructed of modular shells having outer steel plate wall panels welded together to provide unitary inner and outer steel walls and internal baffles with the modular shells enclosing insulating material providing substantial thermal, sound and impact resistance.

Claim 22. Modular equipment for formulating detention structures comprising of a multiplicity of interchangeable modules of similar size having steel plate inner and outer wall sections defining end closures and internally directed load supported baffles with said modules welded together to form said detention structure.

Claim 24. Modular equipment as defined in claim 22 including insulation material inside the modules for resisting fire, sound and impact.

Claim 25. Modular equipment as defined in claim 22 including modular shape for abutting modules end to end in registration to meet substantially only along two welded lines appearing at the inner and outer wall outer surfaces, wherein the multiplicity of modules are welded together along the two weld lines.

Claim 26. Modular equipment as defined in claim 22 including means defined in the end closures disposing thermal insulation between the inner and outer walls to interrupt steel to steel contact.”

Id. at *17 – *19.

\textsuperscript{107} Phillips v. AWH Corp., No. 97-N-212 (D. Colo. Mar. 22, 1999) (Trade Secret Misappropriation Decision) The court reasoned that Phillips knew or should have known of his alleged injury and failed to exercise due diligence in pursing his claim of misappropriation.” Id. at 7. In the same opinion, the court also found that AWH had not engaged in wrongful acts to prevent Phillips from bringing his claim. Id. at 7-8.

\textsuperscript{108} Phillips v. AWH Corp., No. 97-MK-212, 2003 U.S. Dist. LEXIS 25199 (D. Colo. Jan. 22, 2003) (Noninfringement Decision). Based on the district court’s construction of the claims in the ‘798 patent, Phillips determined that it could not prove infringement. Id. at 1. The court determined the disputed claims as follows:

Claim 1 ‘Impact resistant’ is construed as pertaining to projectiles such as bullets and bomb fragments. ‘Substantially parallelepiped shaped’ means a six-sided parallelogram in which the end panels are neither parallel to each other nor perpendicular to the face walls. The phrase ‘steel plate panel sections of greater surface area serving as inner or outer walls for a structure when a plurality of the modules are fitted together’ is not limited to the embodiment described in Claims 4 through 16 nor as reflected in Figures 4, 5 and 6 where the modules are constructed with the assembly of three triangularly shaped pieces. ‘Sealant’ is not limited to glass fiber rope. ‘Internal steel baffle’ means a structure obstructing, impeding or checking the flow of heat and projectiles such as bullets or bomb fragments deployed toward the interior of the module at an angle of other than 90 degrees and when fully assembled forms an intermediate, interlocking, but not solid barrier.

Claim 21. The term ‘modular steel shells having outer steel plate wall panels[*]’ is not limited to the triangular shape reflected in Figures 4, 5 and 6 or described in Claims 4 through 20. Insulating material providing substantial thermal, sound or impact resistance does not require an intermediate interlocking barrier.
of the trade secret misappropriation claim and the motion for summary judgment of noninfringement.\textsuperscript{109}

2. United States Court of Appeals for the Federal Circuit

Phillips appealed to the Federal Court claiming that the claim construction used by the district court and the dismissal of the trade secret misappropriation claim was in error.\textsuperscript{110} The majority concluded that the district court erroneously considered the term “baffle” to be a means-plus-function, but this error was not sufficient enough to find that AWH infringed the ‘798 patent.\textsuperscript{111} The dissenting view, by Circuit Judge Dyk, stated that the court constructed the meaning of the term “baffle” too narrowly by limiting its meaning to that described in the

---

Claim 22. The phrase ‘inner or outer wall sections defining end closure and internally directed load supporting baffles’ does not mean that the wall need be configured by use of three triangular shapes as in Figures 4, 5 and 6, however, baffle is defined as in Claim 1.

Claim 24. No interpretation is required in light of the construction interpretation for Claim 22.

Claim 25. This language is interpreted to mean that the end closures are configured by bending the face walls at an angle other than 90\textdegree but not necessarily creating a concave surface.

Claim 26. The term ‘means defined in the end closure disposing thermal insulation between the inner and outer walls’ is not limited to glass fiber rope.


109. Phillips v. AWH Corp., 363 F.3d 1207, 1209, withdrawn 376 F.3d 1382 (Fed. Cir. 2004). The reasons for the Federal Circuit withdrawing the panel decision will be discussed infra notes 110-30 and accompanying text.

110. \textit{id.} at 1209. Phillips argues that the meaning of terms such as “baffle” and “impact resistance” should be given their ordinary meaning and not limited to what is described in the specification. \textit{id.} at 1211. AWH countered, that the meaning of the terms “baffle” and “impact resistance” should be limited to the way these terms are described in the specification. \textit{id.} at 1211-12.

111. \textit{id.} at 1212. The claim in question does not “expressly use the word ‘means,’ thereby invoking the presumption that \textsection 112, P 6 does not apply.” \textit{id.} The use of the word “baffle” does not denote means and furthermore the intrinsic and extrinsic evidence does not support the conclusion that “baffle” is a means-plus-function term. \textit{id.} Although the district court incorrectly constructed the meaning of the term “baffle” the Federal Circuit continued in its analysis of the specification. \textit{id.} at 1212-13. The Federal Circuit stated that the use of baffles in the specification and in the claims does not disclose baffles orientated at 90 degrees. \textit{id.} at 1214. The Federal Circuit based this ruling on its decision in \textit{CCS Fitness, Inc. v. Brunswick Corp.}, 288 F.3d 1359, 1366-67 (Fed. Cir. 2002), that states “[A] claim term will not carry its ordinary meaning if the intrinsic evidence shows that the patentee distinguished that term from prior art on the basis of a particular embodiment, expressly disclaimed subject matter, or described a particular embodiment as important to the invention.” \textit{id.} at 1213.
specification. The Federal Circuit also affirmed the dismissal of the trade secret misappropriation claim. Phillips filed a motion for en banc review and AWH filed a cross appeal.

C. The United States Court of Appeals for the Federal Circuit en banc Decision

The en banc Federal Circuit denied the motion for rehearing, granted the motion to rehear the appeal en banc and vacated the judgment and opinion of the Federal Court’s panel decision. The court invited the parties to submit additional briefs directed at seven questions. Judge Rader consented and added an additional issue for

112. Phillips, 363 F.3d. at 1217 (Dyk J., dissenting in part). Judge Dyk argues that a patent is not limited to the single embodiment that it describes. Id at 1217 (stating that in Liebel-Flarsheim Co. v. Medirad Inc., 358 F.3d. 898, 906 (Fed. Cir. 2004), the Federal Circuit had expressly rejected the contention that “if a patent describes only a single embodiment, the claims of the patent must just because a patent only describes a single embodiment, the claims of the patent must be construed as being limited to the embodiment”). Judge Dyk also argues that the patent should not be limited to the one purpose disclosed in the specification. Id. at 1217-18. Finally, Judge Dyk states that there is no reason to “supplement the plain meaning of the claim language with a limitation from the preferred embodiment.” Id. at 1218.

113. Id. at 1214–16. Colorado has a three-year statute of limitation for claims of trade secret misappropriation. Id. at 1215. “The Colorado Supreme Court has stated, with respect to actions in tort, that ‘the statute of limitations begins when the claimant has knowledge of facts which would put a reasonable person on notice of the nature and extent of an injury and that the injury was caused by wrongful conduct of another.” Mastro v. Brodie, 682 P.2d 1162, 1168 (Colo. 1984). Although Phillips argues that he did not “know” of AWH’s misappropriation until August 1996, the court reasoned that the letters from Phillips in 1991 and 1992 show Phillips’ awareness of AWH’s possible misappropriation. Phillips, 363 F.3d at 1215. The court stated that Phillips did not need to know the specific damage caused to bring his claim. Id. at 1216. The court concluded that “Phillips’ claim for trade secret misappropriation accrued prior to the critical date, February 3, 1994 – three years before the commencement of suit in the district court, and hence out of time.” Id.

114. Phillips v. AWH Corp., 376 F.3d 1382, 1382 (Fed. Cir. 2004)(en banc). Phillips continues to dispute the finding of the Federal Circuit that the claim construction was correct as done by the district court. Id. at 1310.

115. Id.

116. Id. at 1383-84. The issues invited by the en banc court were:

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

2. If dictionaries should serve as the primary source for claim interpretation, should the specification limit the full scope of claim language (as defined by the dictionaries) only when the patentee has acted as his own lexicographer or when the specification reflects a clear disclaimer of claim scope? If so, what language in the specification will satisfy those conditions? What use should be made of general as opposed to technical dictionaries? How does the concept of ordinary meaning apply if there are multiple dictionary definitions of the same term? If the dictionary provides multiple potentially applicable definitions for a term, is it appropriate to look to the specification to
the parties to consider. Chief Judge Mayer dissented stating that claim construction is a matter of fact and not law.

1. The Majority Opinion

The en banc panel affirmed the district court’s judgment regarding the trade secret misappropriation claim and dismissed AWH’s cross appeal because the finding of noninfringement was in its favor. The en banc panel reversed the opinion of the court regarding the issue of infringement and remanded the case back to the District Court for determine what definition or definitions should apply?

3. If the primary source for claim construction should be the specification, what use should be made of dictionaries? Should the range of the ordinary meaning of claim language 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?

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?

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?

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

7. Consistent with the Supreme Courts’ decision in Markman v. Westview Instruments, Inc., 517 U.S. 370, 134 L. Ed. 2d 577, 116 S. Ct. 1384 (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?

Id. In actuality there are fourteen questions that the Federal Court is inviting parties and amici to brief. Moore, supra note 21, at 247 n.7. For an analysis of the amicus briefs submittd to the Federal Circuit, see David Potashnik, Note, Phillips v. AWH: Changing the Name of the Game, 39 AKRON L. REV. 863, 884-888 (2006). Potashnik classifies the amicus briefs as either favoring the “holistic” approach, “procedural” approach or looking at both the specification as well as dictionaries. Id.

117. Id. The issue added by Judge Rader states:

Is claim construction amendable to resolution by resort to strictly algorithmic rules, e.g. specification first, dictionaries first, etc.? Or is claim construction better achieved by using the order or tools relevant in each case to discern the meaning of terms according to the understanding of one of ordinary skill in the art at the time of the invention, thus entrusting trial courts to interpret claims as a contract or statute?

Phillips, 376 F.3d. at 1383 (Radar, J., concurring).

118. Id. at 1384 (Mayer, C.J., dissenting). Chief Judge Mayer stated that the court should reconsider its decision in Markman v. Westview Instruments Inc., 52 F.3d 967, that claim construction is a matter of law and subject to de novo review. Id. Chief Judge Mayer states that claim construction is an issue of fact that should be determined by a district court and the appellate court should only review for clear error. Id.

further proceedings.120 The majority opinion, written by Judge Bryson, agreed with the panel decision that the term “baffle” should not be interpreted as a means-plus-function.121 Judge Bryson then discussed the steps in claim interpretation.122 Based on the outlined steps, the court concluded that the district court did not follow the proper claim interpretation procedure and therefore the case should be remanded back to the district court for further proceedings.123

2. The Concurring Opinion

Circuit Judge Lourie both concurred and dissented to the majority’s view.124 Judge Lourie joined the opinion of the majority that dictionaries are extrinsic evidence that should not be given more weight than the specification during claim construction.125 Judge Lourie also agreed with the Majority that claims do not have to be limited to specific or preferred embodiments, but they are limited by what is in the overall disclosure of the specification.126

120. Id. at 1328.
121. Id. at 1311. The term “baffle” as used in the specification and claims references a particular structure and not a general structure. Id. Furthermore, the lack of the term “means” creates a “rebuttable presumption that section 112, paragraph 6, does not apply.” Id. (relying on Personalized Media Communns., LLC v. ITC, 161 F.3d 696, 703-04 (Fed. Cir. 1998)).
122. Id. at 1312-19. The first step in claim interpretation is to give the terms the “meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” Phillips, 376 F.3d at 1313. The next step is to give the term the meaning that a person skilled in the art would use. Id. at 1314. The terms are then interpreted in the context of the surrounding words in the claim, in view of the entire specification and the patent prosecution history. Id. at 1314-17. Next, extrinsic evidence, such as dictionaries, learned treatises and expert and inventor testimony are considered but are “less significant than the intrinsic record in determining ‘the legal operative meaning of claim language.’” Id. at 1317 (relying on C.R. Bard, Inc. v. U.S. Surgical Corp., 388 F.3d 858, 862 (Fed. Cir. 2004) and quoting Vanderlande Indus. Nederland BV v. Int’l Trade Comm’n, 366 F.3d 1311, 1318 (Fed. Cir. 2004)).
123. Id. at 1324-28. The court reasoned that the term “baffles” should not be read restrictively to meet all the specified functions. Id. at 1326-27. The court concluded that “a person of skill in the art would not interpret the disclosure and claims of the ‘798 patent to mean that a structure extending inward from one of the wall faces is a “baffle” if it is at an acute or obtuse angle, but is not a “baffle” if it is disposed at a right angle.” Phillips, 376 F.3d at 1327.
124. Id. at 1328-29 (Lourie, J., concurring and dissenting).
125. Id. Judge Lourie’s concurrence emphasizes that the role of the Federal Court is to determine the method that the district court is to follow in claim construction. Id. The district court is not to follow the dissenting view in Phillips, 363 F.3d at 1216-1218 (Dyk, J., dissenting), of using the dictionary meaning prior to considering the specification. Id. But the district court is the follow the method of the majority in Phillips, 363 F.3d. at 1211-14, and first look to the specification and only consider the extrinsic evidence, such as the dictionary, when the specification is vague. Id.
126. Id.
3. The Dissenting Opinions

Circuit Judge Lourie’s dissent stated that the case should not be remanded back to the trial court for a determination of infringement. Judge Lourie reasoned that a reading of the specification does not disclose the use of baffles at any angle other than 90 degrees. Circuit Judge Newman also joined Circuit Judge Lourie in dissenting from the majority’s decision to perform another claim construction aside from that performed by the district court. Judge Mayer, however, wrote a separate dissent that was joined by Circuit Judge Newman. Judge Mayer’s dissent stated his belief that claim construction is a question of fact and not of law. Questions of fact are best handled by the trial court, and not the appellate court. Judge Mayer had been consistent in his belief that claim construction is a question of fact and not law.
This opinion has been echoed by others desiring that courts provide practioners with a consistent understanding of how courts will interpret claims in a patent.134

IV. ANALYSIS

A. Claim construction properly explained in Phillips v. AWH Corp.

The Federal Circuit’s holding in Phillips v. AWH Corporation addresses the minor issue of dictionaries as extrinsic evidence while completely ignoring the important issue of whether claim construction is a question of law or fact.135 Claim construction has always been a difficult task, whether done by a judge or a jury, because of the difficulty in describing physical inventions with words.136 Without making the claims so broad that every possible invention is covered, the court should give the inventor the broadest claim construction possible.137 The claim construction is not a pure legal question, but a combination of both legal and factual determinations and deference should be given to the district court’s factual conclusions; Fromson v. Anitec Printing Plates, Inc., 132 F.3d 1437, 1446 (Fed. Cir. 1998), overruled by Cybor Corp. v. FAS Tech., 138 F.3d 1448 (Fed. Cir. 1998) (stating that absent clear error, district court’s findings should be affirmed); and Eastman Kodak Co. v. Goodyear Tire & Rubber Co., 114 F.3d 1547, 1555-56 (Fed. Cir. 1997), overruled by. Cybor Corp. v. FAS Tech., 138 F.3d 1448 (Fed. Cir. 1998) (stating that the Federal Circuit will give deference to the trial court’s determination of the weight to give an expert’s testimony to clarify ambiguous claim terms).

134. See, e.g., Seidenberg, supra note 67, at 28 (“Many of the bar associations that filed amicus briefs in the case argue the current rule makes no sense. They believe that claim construction isn’t simply a matter of law; it is extremely fact-specific, and only the trial judge gets to see all the evidence first-hand.”); Gupta, supra note 80, at 8 (“The court also re-affirmed its procedure of reviewing claim construction de novo, which has prompted much consternation among the patent community, as recognized by the dissent.”); Hagberg, supra note 81, at 4 (admonishing the Federal Circuit to adopt the standing that claim construction is a question of fact not law).

135. Brady, supra note 21, at 32 (praising the Federal Circuit for clarifying the rules regarding dictionary use for claim construction but admitting that the “en banc opinion leaves important questions undecided”). See also, Hagberg, supra note 81, at 4 (stating that the court did address the seven questions it posed in its previous decision but “pass[ed] on the question of the proper standard of review for claim construction”) and Seidenberg, supra note 67, at 28 (stating that the Federal Circuit’s decision to forego discussion on the amount of deference to give lower court’s claim construction leaves an important question unanswered). The Federal Court appears to state that the issue is settled when it says that “[a]fter consideration of the matter, we have decided not to address that issue at this time.” Phillips v. AWH Corp., 415 F.3d at 1328.

136. Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd., 535 U.S. 722, 722 (2002). In its discussion concerning the doctrine of equivalents, the court engages in a discussion of the inadequacy of words to describe patents. Id. at 722. The court acknowledges that if words were given their literal meaning, it would be simple for others to invent around the claims of the patent. Id. at 722. The court, therefore, states that techniques such as the doctrine of equivalents should be used to widen the scope of claims to encompass the true intentions of the inventor. Id. at 722.

137. Autogiro Co. of America v. United States, 384 F.2d 391, 396-397 (Ct. Cl. 1967). In
Federal Circuit's decision in *Phillips v. AWH Corp.* seeks to find a balance between placing the proper limits on patent claims while giving applicants the ability to properly claim their invention. The structured analysis performed by the Federal Court in *Phillips v. AWH Corp.* is the type of structure that should have been applied in *Markman v. Westview Instruments.*

Although many scholars held *Markman v. Westview Instruments* to be a milestone ruling in patent prosecution, it failed in one respect: to explicitly define what weight to give extrinsic versus intrinsic evidence. By leaving this determination to the lower courts, the Supreme Court was giving these courts the ability to make this determination on a case by case basis. When the higher courts give

Autogiro the court discusses the inadequacy of words to describe inventions. *Id.* at 396. The court should not be restricted to just the words of the claim, but by looking at all relevant documents along with the patent. *Id.* at 397. The court discusses that three relevant documents are the specification, drawings and the file wrapper. *Id.* at 397. However, in *Markman v. Westview Instruments*, the court acknowledges that extrinsic evidence, such as dictionaries will provide proof of the prior art at the time of the invention. *Markman v. Westview Instruments*, Inc. 52 F.3d 967, 980.

*Philips v. AWH Corporation*, 415 F.3d 1303, 1321. The court discusses its concern that the claim construction technique of using the dictionary first, as developed in *Texas Digital v. Telegenix*, results in claims that are too broad. *Id.* at 1321.

*Id.* at 1312. The court, out of fear that prior decisions have unduly expanded the scope of claim interpretation, seeks to define the amount of weight that should be given to extrinsic evidence. *Id.* at 1316-1319. The Federal Court admits that it was not clear in its prior decisions on the proper methods of claim construction. *Id.* at 1312.

*CHISUM*, supra note 12, at § 18.03[1]. Three major court decisions have shaped the present patent system and how claims are interpreted: *Autogiro Co. of America v. United States*, *SRI International v. Matsushita Electric Corp. of America* and *Markman v. Westview Instruments*. *Id.* *Autogiro* discusses "claim interpretation and reviewed the basic principles of patent infringement, including the doctrine of equivalents and file wrapper (prosecution history) estoppel." *Id.* *SRI International* explains "claim interpretation and application, illustrat[ing] the continuing difficulties of achieving consistency and predictability in the interpretation and application of claim language." *Id.* *Markman* has been held by many to explain the role of extrinsic evidence in claim interpretation. *Id.*

*CHISUM*, supra note 12, at 18.03[1][c]. The court goes into an in depth discussion of what extrinsic evidence is, i.e., expert testimony, dictionaries and learned treatises. *Id.*

*Markman v. Westview Instruments*, 52 F.3d 967, 980-981. The court in *Markman* lists several examples of how courts have applied the use of extrinsic evidence on a case by case basis as shown in:

Seymour v. Osborne, 78 U.S. (11 Wall.) 516, 546, 20 L. Ed. 33 (1871) (reviewing a decree in equity); see United Carbon Co. v. Binney & Smith Co., 317 U.S. 228, 233, 55 U.S.P.Q. (BNA) 381, 384, 87 L. Ed. 232, 63 S. Ct. 165 (1942) (the court construed the claim by relying in part on the testimony of one of the patentees as the "clearest exposition of the significance which the terms employed in the claims had for those skilled in the art"); U.S. Indus. Chems., Inc. v. Carbide & Carbon Chems. Corp., 315 U.S. 668, 678, 53 U.S.P.Q. (BNA) 6, 10, 86 L. Ed. 1105, 62 S. Ct. 839 (1942) (It is permissible, and often necessary, to receive expert evidence to ascertain the meaning of a
too much flexibility in an area of law that is still in its adolescence, lower trial courts are sure to stray from the path and create their own interpretation of what the proper claim construction method should be.143

B. Past inconsistent decisions properly addressed by Phillips v. AWH Corp.

The application of the decision in *Markman* to subsequent proceedings shows the variability that resulted from the Supreme Court's lack of a standardized method of claim construction.144

---

143. See e.g., Moore, supra note 21, at 246-47 (stating that "[w]ith judicial claim construction now nearing its adolescence (eight years from the Supreme Court's *Markman* and ten years from the Federal Circuit's *Markman*), there should be more predictability"); SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc., 242 F.3d 1337 (Fed. Cir. 2001) (Dyk, J., concurring) ("Our decisions provide inadequate guidance as to when it is appropriate to look to the specification to narrow the claim by interpretation and when it is not appropriate to do so. Until we provide better guidance, I fear that the lower courts and litigants will remain confused."); William F. Lee & Anita K.Krug, Still Adjusting to Markman: A Prescription for the Timing of Claim Construction Hearings, 13 HARV. J.L. & TECH 55, 67 (1999) ("Although, according to the Federal Circuit and the Supreme Court, *Markman* should have ushered in greater uniformity, predictability, and certainty in patent litigation, many believe that the holding has had the opposite effect."); Erik Paul Belt, Federal Circuit Stresses Ordinary Meaning: In Recent Cases, The Court has Limited the Narrowing of Claims, Often Benefiting Patent Owners, NATL'T. L.J., Sept. 22, 2003, at S1, S14 (stating that "many feel that *Markman* has not yet led to the hoped-for certainty in claim construction"); Victoria Slind-Flor, Judges Receive Mixed Reviews on Handling of Patent Claims, N.Y.L.J., March 14, 2002, at 1 ("By most accounts, the *Markman* decision has added uncertainty, costs and delay to a system that already had plenty of all three.")

144. *Markman v. Westview*, 52 F.3d 967, 981. The Federal Appellate Court discusses the extensive use of extrinsic evidence in helping to "resolve disputes in route to pronouncing the
However, the Federal Circuit's decision in Phillips addresses many of the misconceptions of the Texas Digital court and brings claim construction back in line with traditional patent law and policy. First, the court in Phillips begins by acknowledging the role of the integral parts of the patent to the claim construction. In contrast, the court in Texas Digital first looked outside of the specification to determine the ordinary meaning of the word. Although this may seem like a simple and harmless step, it begins the analysis in the wrong direction by giving the presumption to the dictionary definition before looking to the specification. The Phillips court addresses this issue head-on by stating that the presumption should always be in favor of the specification over any other extrinsic information.

meaning of claim language.” Id. at 981. The court reasoned that the extrinsic evidence is often necessary to help the trial court understand the meaning of the patent. Id. at 981. The Appellate Court concluded that the district court's claim construction, while taking into account extrinsic evidence, is still “based upon the patent and prosecution history.” Id. at 981.

145. See infra notes 140-50, and accompanying text

146. Phillips v. AWH Corp., 415 F.3d at 1311-12. The Federal Court acknowledges that, as described in the Patent Act, 35 U.S.C. § 112, the specification of the patent is the area where the patentee describes his invention whereas the claims is the area that the patentee points out the subject matter which the patentee regards as the invention. Id. at 1311-12. The specification must be detailed enough to enable one skilled in the art to create the invention. ADELMAN, supra note 15, at 438-39.

147. Texas Digital, Sys. v. Telegenix, Inc., 308 F.3d at 1206 (stating that the Federal Circuit panel began its construction of the term “repeatedly” by first looking at the relevant dictionary definition). In determining the meaning of each of the disputed words in the specification the Federal Circuit panel first looked to the dictionary and then to the specification to determine if the specification was consistent with the dictionary. Id. at 1205-1216. One commentator is quoted as saying that this approach, in an of itself, gave “the broadest applicable dictionary definition to construe patent terms, often giving patent owners exceptionally wide rights.” Seidenberg, supra note 67, at 28. However, another commentator worries that the dictionary first approach “can be grossly out of context.” Jennifer K. Bush, John E. Gartman, Elizabeth I. Rogers, Six Patent Law Puzzlers, 13 TEX. INTELL. PROP. L. J. 1,12 (Fall 2004). Bush goes on to argue that construing a phrase is more than just taking each of the individual words in the phrase in determining their meaning. Id. Also, the date a dictionary was published may have a significant effect on the meaning of the words included in the dictionary. Id.

148. See e.g., Patent Act, 35 U.S.C. § 112 (stating that the claimed invention is to be described in the description in enough detail to enable one skilled in the art to make or use it). A patent would therefore not be complete if a person skilled in the art had to look outside of the patent to determine what the invention was. ADELMAN, supra note 15, at 438-39 (stating that one of the key requirements of a patent specification is that it enable one skilled in the art to make the invention). The court in Texas Digital, by allowing the construing of the claims to begin by looking outside of the specification is greatly expanding the scope of the claimed invention. Id. at 439.

149. Phillips v. AWH Corp., 415 F.3d at 1317 (stating that although some extrinsic evidence can assist in the determination of meanings in a claim, the extrinsic evidence is always given lower weight than the intrinsic evidence such as the specification). Paul W. Garrity commented that the Phillips decision “elevate[d] the importance of the specification and the prosecution history to the determination of infringement.” Paul W. Garrity and Steve Z. Szczepanski, Federal Circuit
The *Phillips* court also limits the coverage of claims in the patent in a proper manner.150 In contrast, the court in *Texas Digital* allowed the inclusion of terms from the dictionary that may have no relevance to the claimed invention.151 Once again, the *Phillips* court addresses this head-on by stating that this expansion in coverage can take the invention in a direction never contemplated by the inventor.152 One of the key policy
goals of patents is to provide the public with new and innovative inventions but at the expense of giving the inventor a limited monopoly. The approach of the court in Texas Digital completely ignores this policy goal by allowing inventors to claim more than they disclosed and prevents the public from really knowing what is claimed. The Texas Digital court also completely ignored one basic problem that it was creating by its method of claim construction, which dictionary to use? By beginning with the dictionary as the basis for claim construction, the court will have opened itself up to a vast number of dictionaries, each claiming the meaning of the word to be something different.

The treatment of dictionaries as both intrinsic and extrinsic evidence is proof of the confusion that has resulted from the Federal Court not providing clear direction to the district courts. In Vitronics, the Federal Circuit determined that the best way to interpret the claims

the effective filing date of the patent specification." Phillips v. AWH Corp., 415 F.3d at 1313. Although this was stated in dictum, one commentator, Lemley, has argued that it is the correct time at which to fix the meaning of terms in a patent claim. Lemley, supra note 150, at 119-21. The meaning of the terms should be fixed at the time of filing, and the court should use the doctrine of equivalents to cover any later-developed technologies. Id.

153. Phillips v. AWH Corp., 415 F.3d at 1313 (stating that the specification must include a portion of the invention that the inventor intends to claim).

154. ADELMAN, supra note 15, at 439 ("The enablement requirement serves to delimit the boundaries of patent protection by ensuring that the scope of a patent claim accords with the extent of the inventor's technical contribution."). See also, Grant v. Raymond, 31 U.S. (6 Pet.) 218, 247-48 (1832) (stating that the statute "requires, as preliminary to a patent, a correct specification and description of the thing discovered. This is necessary in order to give the public, after the privilege shall expire, the advantage for which the privilege is allowed, and is the foundation of the power to issue the patent.").

155. See generally, Texas Digital Sys. v. Telegenix, Inc., 308 F.3d 1193 (using several different dictionaries to construe the meaning of terms in conflict).

156. Phillips v. AWH Corp., 415 F.3d at 1321 ("Dictionaries, by their nature, provide an expansive array of definitions."). For an expansive analysis of the different types of dictionaries used in claim construction by the Federal Circuit see Joseph Scott Miller and James A Hilsenteger, The Proven Key: Roles and Rules for Dictionaries at the Patent Office and the Courts, 54 AM. U. L. REV. 829 (April 2005).

157. Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193, 1205 (Fed. Cir. 2002). The court in Texas Digital held that

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

Id. The court in essence is escalating the dictionary from being extrinsic evidence to intrinsic. CHISUM, supra note 12, at § 18.03[1][C].
was by looking at the specification over the testimony of experts.\textsuperscript{158} It should be noted that the court's ruling was based on the weighing of the specification versus expert testimony and not the specification versus the dictionary meaning.\textsuperscript{159} The \textit{Vitronics} court makes it clear that dictionary definitions are not the same as expert testimony.\textsuperscript{160} The \textit{Vitronics} court does not create a "quasi-implicit" category for dictionaries, but it uses the method that was later explicitly described in \textit{Phillips}, placing dictionaries in their proper place, below the specification.\textsuperscript{161}

In \textit{Phillips v. AWH Corporation}, the Federal Court has finally put an end to the "hide and seek" game by placing dictionaries below the specification.\textsuperscript{162} The \textit{Texas Digital} court attempted to argue that dictionaries are more reliable and objective guides than other extrinsic evidence.\textsuperscript{163} However, the \textit{Phillips} court outlines five reasons why

\begin{itemize}
\item \textsuperscript{158} \textit{Vitronics Corp. v. Conceptronic, Inc.}, 90 F.3d 1576, 1585 (Fed. Cir. 1996). The trial court had relied on the testimony of expert witnesses and employees of the applicant to determine the meaning of several critical terms in the patent application. \textit{Id.} The appellate court, based on its analysis, found that the specification properly defined these terms and that to allow the applicant to introduce evidence that was clearly contrary to the specification is "unnecessary and, hence, legally incorrect." \textit{Id.}
\item \textsuperscript{159} \textit{Vitronics}, 90 F.3d at 1585. The court stated that the applicants' reliance on opinion testimony should be limited. \textit{Id.} The court recognized that opinion testimony is "no better than opinion testimony on the meaning of statutory terms." \textit{Id.} However, the court did distinguish dictionaries and prior art documents from opinion testimony when it stated "[u]nlike expert testimony, these sources are accessible to the public in advance of litigation. They are to be preferred over opinion testimony, whether by an attorney or artisan in the field of technology to which the patent is directed." \textit{Id.}
\item \textsuperscript{160} \textit{Vitronics}, 90 F.3d at 1585. The court in \textit{Texas Digital} also stated that "[s]uch references are unbiased reflections of common understanding not influenced by expert testimony or events subsequent to the fixing of the intrinsic record by the grant of the patent, not colored by the motives of the parties, and not inspired by litigation." \textit{Texas Digital}, 308 F.3d at 1203. The court further argued that this type of evidence, dictionaries, encyclopedias and treatises are the most helpful to judges in "better understanding the technology and the terminology used by those skilled in the art to describe the technology." \textit{Id.}
\item \textsuperscript{161} \textit{Vitronics}, 90 F.3d at 1583 (stating that claims are construed by first looking at the specification, then extrinsic evidence if required).
\item \textsuperscript{162} \textit{Phillips}, 415 F.3d at 1318-1319. The court in \textit{Phillips}, after an in depth discussion of the various kinds of extrinsic evidence states that "[i]n sum, extrinsic evidence may be useful to the court, but it is unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence." \textit{Id.} at 1319.
\item \textsuperscript{163} \textit{Texas Digital}, 308 F.3d 1202. The court in \textit{Texas Digital} stated that:
\[d\]ictionaries are always available to the court to aid in the task of determining meanings that would have been attributed by those of skill in the relevant art to any disputed terms used by the inventor in the claims. \textit{Id.} See \textit{Vitronics Corp. v. Conceptronic, Inc.}, 90 F.3d 1576, 1584 (Fed. Cir. 1996) ("[T]echnical treatises and dictionaries ... are worthy of special note. Judges are free to consult such resources at any time... and may also rely on dictionary definitions when construing claim terms..."); \textit{Cybor Corp.}, 138 F.3d at 1459 (citing \textit{Vitronics} for the proposition that a court is free to consult dictionaries, encyclopedias, and treatises at any time to help determine the meaning of claim terms);
extrinsic evidence, such as dictionaries, is less reliable than the specification and other intrinsic evidence. Therefore, the only sensible approach to using dictionaries in claim construction is to first give weight to the specification, only when the specification is not clear should definitions in dictionaries be consulted.

C. Policy arguments in favor of dictionaries as extrinsic evidence

There are several policy considerations that should be considered in the use of dictionaries as extrinsic evidence including the ability of the applicant as his own lexicographer and the encouragement to patent drafters to be clear and concise in their claim drafting. Patent law saw the need for a system that met each of the policy considerations in a

(A dictionary is not prohibited extrinsic evidence, and is an available resource of claim construction.).

Id.

164. Phillips v. AWH Corp. 415 F.3d at 1318-19. The five basic reasons dictionaries are less reliable than the specification are 1) the dictionary was not created at the time the patent was created, 2) dictionaries may not have been written by a person skilled in the arts, 3) some extrinsic evidence, like testimonies, are created for litigation and thereby are biased in their opinion, 4) parties will only choose the extrinsic evidence that is beneficial to their cause, and 5) extrinsic evidence can be used to undermine the patent and thus reduce the ability of the patent to provide public notice of the invention. Id.

165. Texas Digital, 308 F.3d at 1203. The court, however, does place a limit on the use of dictionaries. Id. The court acknowledges that dictionaries often have more then one meaning and that the "intrinsic evidence must always be consulted to identify which of the different possible dictionary meanings of the claim terms in issue is most consistent with the use of the words by the inventor" Id. (emphasis added). Only if all the meanings are consistent with the use in the intrinsic record could the applicant use each meaning. Id.

166. Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 535 U.S. 722, 731-732. In Festo, the court commented on the inadequacies of words to describe an invention when it stated that:

The language in the patent claims may not capture every nuance of the invention or describe with complete precision the range of its novelty. If patents were always interpreted by their literal terms, their value would be greatly diminished. Unimportant and insubstantial substitutes for certain elements could defeat the patent, and its value to inventors could be destroyed by simple acts of copying. For this reason, the clearest rule of patent interpretation, literalism, may conserve judicial resources but is not necessarily the most efficient rule. The scope of a patent is not limited to its literal terms but instead embraces all equivalents to the claims described.

Id. at 731-732. Therefore, as the court states, words should be given their fair scope to allow the patent applicant to properly define his invention and prevent others from drafting claims that avoid the words of the patent but infringe on the meaning of the claims. Id. at 731.

167. Graham v. John Deere Co., 383 U.S. 1, 8-9 (1966). In Graham, the court remarks on the importance of patents to the advancement of society. Id. at 9. Jefferson, one of the key influences on the current patent system, stated that patents are an "award to bring forth new knowledge." Id. at 9.
manner that was fair both to society and to the inventor.  

1. Patent drafters as their own lexicographer

The patent system was created with several goals in mind, one such goal was to promote the progress of science and technology. However, in order to promote the progress of science and technology, patents must be written in ways that provide the public with inventions that can be utilized in the future. Due to the constantly changing state of technology, it is important that patent drafters be given the flexibility to create words that accurately describe the inventions. The decision in Phillips places the burden on patent drafters to adequately describe the invention, knowing that if the specification does not adequately describe the invention, the inventor is opening himself up to the discretion of the judge in determining which extrinsic evidence to allow in to construe the claim.

168. Id. at 9. Thomas Jefferson stated:

The patent monopoly was not designed to secure to the inventor his natural right in his discoveries. Rather, it was a reward, an inducement, to bring forth new knowledge. The grant of an exclusive right to an invention was the creation of society — at odds with the inherent free nature of disclosed ideas — and was not to be freely given. Only inventions and discoveries which furthered human knowledge, and were new and useful, justified the special inducement of a limited private monopoly.

Id. Martin Adelman states that “[a]t the heart these goals attempt to strike a balance between the encouragement of the labors that lead to innovation and dissemination of the fruits of those labors.”

ADELMAN, supra note 15, at 1.

169. See supra note 11 and accompanying text. Other policy goals by one commentator have been explained as “incentive to invent,” incentive to disclose,” “rent dissipative theory” and “race to invent.” ADELMAN, supra note 15, at 26-38 (summarizing views expressed in Rebecca S. Eisenberg, Patents and the Progress of Science: Exclusive Rights and Experimental Use, 56 U. CHI. L. REV. 1017, 1989).

170. See Graham, 383 U.S. at 167. Thomas Jefferson originally intended that patents be granted for inventions that were useful to society in order to minimize the “embarrassment” of a monopoly. Id. However, over time, Jefferson found it more and more difficult to deny patents for inventions whose benefit to society were not readily evident. Id. The patent system today no longer requires that the claimed invention provide a defined amount of social benefit, only that it be novel, non-obvious and useful. Id.

171. See, e.g., Autogiro Co. of America. v. United States, 181 Ct. Cl. 55 (1967) (discussing the inability of words to describe inventions). The court in Autogiro stated:

An invention exists most importantly as a tangible structure or a series of drawings. A verbal portrayal is usually an afterthought written to satisfy the requirements of patent law. This conversion of machine to words allows for unintended idea gaps which cannot be satisfactorily filled. Often the invention is novel and words do not exist to describe it. The dictionary does not always keep abreast of the inventor. It cannot. Things are not made for the sake words, but words for things. To overcome this lag, patent law allows the inventor to be his own lexicographer.

Id. at 61-62.

172. Phillips v. AWH Corp. 415 F.3d at 1319 (stating that extrinsic evidence is much less
2. Clear and concise claim drafting

The Federal Circuit’s decision in *Phillips* encourages patentees to ensure that their claim drafting skills are at a level to ensure the protection for the invention claimed. The benefit of a policy such as this will ensure that the public is completely aware of the invention to which it grants a temporary monopoly. The patentee will no longer be able to rely on “soft” rules like the doctrine of equivalents to convince the courts, after the patent has been drafted to include a scope not clearly delineated in the patent. However, *Phillips* encourages patent drafters to stay abreast of the latest court rulings so that they may be able to draft claims and patents that best protect their client and gives the client the best opportunity to win suits against infringers. Although this may result in excessively defining terms in a patent, the inventor will be sure to have a patent that protects her true invention when challenged in

reliable than intrinsic evidence and as such the judge should carefully weigh its use in claim construction). In warning patentees of the effect of the *Phillips*’ decision, Paul Garrity states that the skills and the knowledge of lawyers will be key in determining the success or failure of inventions claimed in patents. Garrity, *supra* note 149, at 2.

173. Garrity, *supra* note 149, at 2. The change in the rule of claim construction encourages drafters of patents to play closer attention to the drafting and prosecution of patents. *Id.* As stated by Garrity, “it behooves the owner of an invention to find the best legal talent to prepare a well-drafted, comprehensive patent specification that avoids the pitfalls that have reduced the scope of the patent coverage in prior cases.” *Id.* Now, a poorly drafted patent may be held to be invalid at summary judgment and not have the opportunity to convince a judge or jury of its validity by bringing in once admissible extrinsic evidence. *Id.*

174. See Graham v. John Deere, 383 U.S. at 9 (discussing the desire of Thomas Jefferson that patents be granted to inventors in return for the public receiving a benefit from the temporary monopoly granted.) The Federal Court’s decision in *Phillips* encourages the full disclosure of the invention to ensure that the public is aware of the invention. *Phillips v. AWH Corp.*, 415 F.3d at 1323 (stating that it is the goal of the specification to “teach and enable those of skill in the art to make and use the invention and provide the best mode for doing so”). *Id.*

175. Garrity, *supra* note 149, at 2. Commentors, such as Garrity, recognize that the importance of claim drafting and the avoidance of damaging statements during the prosecution of patents has increased because courts have begun to limit the use of the doctrine of equivalents. See, e.g., Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722 (2002) (showing the Supreme Court limiting the reach of the doctrine of equivalents through the use of prosecution history estoppel). The end result is that patentees are often unable to fix mistakes in their claims, specifications or limit the statements made during the prosecution phase of a patent application. Garrity, *supra* note 149, at 2.

176. Garrity, *supra* note 149, at 2. Knowledgeable patentee will be aware of the Federal Circuit’s recent decisions to limit the scope of protection based on prior art, statements made in the Summary of the Invention, and objectives stated in the specification. *Id.* Patentees who stay abreast of recent patent decisions will also be well aware the variations from case to case and the impact that this will have on their client’s patent. *Id.* (stating that some Federal Circuit cases have even limited the scope of a patent’s claims to the embodiment shown in the specification). However, there are ways to avoid these pitfalls and the well trained practitioner will know how to steer clear of trouble. *Id.*
court. Of equal importance, the patent drafter will be sure to have avoided the likelihood of malpractice.

D. Caution in use of dictionaries as extrinsic evidence

The Phillips court, while settling the law on dictionaries as extrinsic evidence may have created another problem in patent law. By placing more weight on the specification, the Phillips court has put more burden on patent drafters to be absolutely thorough in the description of the invention. This burden is needed to make sure that patent drafters know that if they do not properly draft the specification they may be doing a disservice to their clients. However, patent drafters only need point to the Phillips decision to show that the expertise of a patent drafter is of great value to inventors if they want their inventions protected. This in turn will allow patent drafters to justify raising their rates and possibly forcing the average inventor to go into business without a critical patent for their invention.

177. Garrity, supra note 149, at 2. Inventors, who consult well trained drafters will be warned that although other services are cheaper, if the drafter is not aware of the ever changing rules in patent law, the patent drafted may not be worth the paper it is written on. Id.

178. See generally, Garrity, supra note 149, at 2 (discussing the implications of the changes in the patent system and the effect that this will have on both clients and patent drafters).

179. See infra notes 180-85 and accompanying text.

180. See Garrity, supra note 149, at 2 (discussing the impact of Phillips on the drafting of patents). Based on the latest developments in patent law, the “scope of patent protection depends now more than ever on the skills of the patent lawyers who prepare and prosecute patent applications as opposed to the merits of the invention itself.” Id. This appears to go contrary to the patent policy by making the patent drafting more important than the invention. See generally, Graham v. John Deere, 383 U.S. 1 (1966) (discussing the importance of inventions to the growth of technology in the United States).

181. Garrity, supra note 149, at 2. Garrity states:

[I]t is more important than ever to carefully craft the patent application during drafting, and the arguments to the Patent Examiner during prosecution, so that the patent provides meaningful protection for the claimed invention. The failure to recognize what is needed and what should be avoided in drafting and prosecuting a patent application is now likely to lead to a patent that has a severely limited scope of coverage.

Id.

182. See supra note 175.

183. Garrity, supra note 149, at 2 (remarking that many large firms are not aware of the recent changes in patent law and continue to send their patent drafting to the lowest bidder or even oversees). However, for those inventors who are not financially able to shop around for the best patent drafter, they may be forced to either pay the high cost of an adequately patented invention, or risk losing their inventions to others. See generally, Garrity supra note 149, at 2 (discussing the impact of Phillips on the drafting of patents).
E. Judicial Review of Claim Construction – Question of Law or Fact?

Courts have often viewed the review of claim construction as a question of law. As such, the reviewing court should look at the evidence de novo. The review of a lower court’s decision, as a matter of law, allows the higher court to look at all the facts of the case, construct a meaning of the claimed invention and determine whether infringement has occurred. Although most courts follow the belief that claim construction is a question of law, there have been strong opinions stating that claim construction should only be reviewed as a matter of fact. This standard of review would allow juries and judges to construe the claims and determine infringement without the fear that this decision will be reversed by a higher court that was not present during the presentation of the facts, unless the finding of the jury or judge is clearly erroneous.

184. Markman, 517 U.S. at 389. The court states that “[t]he construction of written instruments is one of those things that judges often do and are likely to do better than jurors unburdened by training in exegesis.” Id. at 389. The court bases this decision upon the historical role of the judge to determine the meaning of the claims. Id. at 389. See supra note 98.

185. FED. R. CIV. P. 52(a). See, e.g., Cybor, 138 F.3d. at 1456 (stating the question of law will be reviewed de novo even when allegedly fact-based questions are in issue).

186. See, e.g., Phillips v. AWH Corp. 415 F.3d 1303 (2005) (discussing the Federal Circuits holding that the claim construction method used by the district court was correct, but replacing the district court’s finding of non-infringement with the Federal Circuit’s finding of infringement). See also Control Resources, Inc. v. Delta Elecs., Inc., 133 F. Supp. 2d 121, 123-24 (D. Mass. 2001) (“Disappointed litigants and commentators alike have criticized the court for fact-finding and other forms of hyperactive judging. Increasingly, the bar is expressing concern over the court’s decision-making procedures and its apparent willingness to take over the roles of patent examiner, advocate and trier of fact.”).

187. Phillips. 415 F.3d at 1330-35 (Mayer, J., dissenting) (discussing at length that the Supreme Court in Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996), did not affirm that claim construction was a question of law, only that the judge was in a better position to determine the meaning of a patent claim). See also, Eastman Kodak Co. v. Goodyear Tire & Rubber Co., 114 F.3d 1547, 1555-56 (Fed. Cir. 1997); Serrano, 111 F.3d at 1586 (Mayer, J., concurring); Wiener v. NEC Elecs. Inc., 102 F.3d 534, 539 (Fed. Cir. 1996), overruled by Cybor Corp. v. FAS Techs 138 F.3d 1448 (Fed. Cir. 1996); and Metalloics Sys. Co. v. Cooper, 100 F.3d 938 (Fed. Cir. 1996), overruled by Cybor Corp. v. FAS Techs 138 F.3d 1448 (Fed. Cir. 1998). See also, Hagberg, supra note 81, at 4. Hagberg states that:

[t]he U.S. Supreme Court’s decision in Markman v. Westview Instruments Inc., 517 US 370, 372 (1996), held “that the construction of a patent, including terms of art within its claim, is exclusively within the province of the court.” Markman is the leading precedent on certain aspects of claim construction, but a close read reveals that the Court did not address the issue at hand. The Court stated repeatedly that the issue it faced was only who should construe the claims: the judge or jury. See, e.g., 517 US at 372, 377, 384, 388. Markman did not mention the standard of review.

Id.

188. See generally, Hagberg, supra note 81, at 4 (outlining a method of claim construction whereby the trial court would review all the evidence presented by the parties regarding the proper
F. Patent Law vs. Other Areas of Law

Patent law is relatively new in comparison to other areas of law. The rules and standards of patent law are still being determined in the Federal Circuit courts and in the Supreme Court. As such, it is important that patent law look to other areas of the law and take note of what has been learned. Other areas of law follow FED. R. CIV. P. 52(a) in determining the standard of review. Circuit Judge Mayer has made several impressive arguments that the Federal Circuit’s present approach to claim construction is in violation of FED. R. CIV. P. 52(a). In order to bring patent law into harmony with other areas of law, Cybor should be overruled and claim construction held to be a question of fact.
reviewable using a clearly erroneous standard.\textsuperscript{194}

\textit{G. Policy Arguments}

There are several policy arguments to analyze when determining that claim construction is a question of fact and not law – court costs\textsuperscript{195} and clarity in court decisions.\textsuperscript{196}

1. Court Costs

With the present standard of review, court costs are almost doubled when the trial court performs a \textit{Markman} hearing to construe the claims, determines infringement and the Federal Court performs the same tasks when the infringement case is appealed.\textsuperscript{197} The additional cost of an appeal must be factored into every patent drafted, as it is almost a certainty that the party who loses at trial will appeal to the Federal Circuit and the parties will be subject to the same presentation of information as performed for the trial court.\textsuperscript{198}

2. Clarity in Court Decisions

Regarding clarity of court decisions, practitioners often take the view that the trial court is just a gate that they must pass through to get to the Federal Circuit.\textsuperscript{199} The decisions of the trial court often mean nothing as

\begin{footnotes}
\item[194] Hagberg, \textit{supra} note 81, at 4 (stating that Cybor’s new regime has had time to work and it has failed thereby requiring the Federal Court to overrule Cybor’s holding that claim construction is a question of law).
\item[195] \textit{See infra} notes 197-98, and accompanying text.
\item[196] \textit{See infra} notes 199-200, and accompanying text.
\item[197] Seidenberg, \textit{supra} note 67, at 28. (“Critics also complain that the lack of deference is a major reason why so many district courts claim constructions are overturned on appeal. This, in turn, makes patent litigations unduly lengthy, costly and unpredictable.”).
\item[198] \textit{Id.} With the present method of reviewing claim construction as a question of law, the reversal rate at the Federal Circuit level makes also every patent case subject to an immediate appeal. \textit{Id.} “The predominant view [among patent litigators] is that district courts are just a way station on the way to the Federal Circuit.” \textit{Id.} (quoting David Long, a partner in the Washington, D.C., office of Howrey). Litigators are more than willing to file for an appeal due to this high reversal rate. \textit{Id.} The reversal rate in the Federal Circuit has been calculated to be as high as 34.5%. Moore, \textit{supra} note 21, at 243-44.
\item[199] Seidenberg, \textit{supra} note 67, at 28. The counsel for Phillips, Carl Manthei states; “The Court of Appeals has gone back to a case-by-case method of claim construction . . . That’s problematic because going by that method, you got all sorts of different results at different levels. In this case, for instance, the three-judge panel disagreed among themselves and with the trial court [over the interpretation of a patent], and the en banc court disagreed with the panel. That type of thing is going to continue. 
\textit{Id.}
\end{footnotes}
the Federal Court will often take the case up on appeal and construe the claims in whatever manner it sees fit.200

V. CONCLUSION

The Federal Circuit's ruling in Phillips v. AWH Corporation limits the use of dictionaries in claim construction.201 These limitations encourage accurate and thorough drafting of claims by practitioners and limit the availability of "soft doctrines" like the doctrine of equivalents.202 However, for all the good that Phillips provides in claim construction, it is blind to the elephant in the room.203 The patent community was in anxious anticipation that the Federal Circuit would thoroughly consider the question of how much deference to give to lower court decisions.204 But, Judge Mayer stated that the court simply rearranged the deck chairs, as the Titantic headed for Davey Jones' Locker.205 Unfortunately, like the Titantic, hope disappeared for Phillips when the Supreme Court did not take notice of the clear conflict in the patent community and provide clarity and understanding to a field in search for direction.206

Christopher A. Jethrow*

200. Phillips, 415 F.3d at 1330 (Mayer, J., dissenting) (stating that the Federal Court will "decide cases to whatever mode or method results in the outcome [they] desire, or at least allows [them] a seemingly plausible way out of the case.").
201. See supra notes 135-83 and accompanying notes.
202. See, e.g., Garrity, supra note 149, at 2.
203. See generally, Phillips v. AWH Corp. 415 F.3d at 1334-1335 (Mayer, J., dissenting)
204. Seidenberg, supra note 67, at 28 ("This is one of the most important patent issues to come before the court in many years." Quoting Donald Dunner, a name partner at Finnegan, Henderson, Farabow, Garrett & Dunner in Washington, D.C.).
205. Phillips. 415 F.3d at 1334-1335 (Mayer, J., dissenting)

* J.D. Candidate, May 2007, University of Akron School of Law, M.S., Mechanical Engineering, 2006, University of Illinois, B.S., summa cum laude, Mechanical Engineering, 2004, Case Western Reserve University. I would like to express my endless gratitude to my wife, Latricia A. Jethrow, for her continued love and support throughout our marriage. I would also like to thank my parents, Clarence and Patricia Jethrow, for their constant encouragement and support throughout my life. I would also like to acknowledge and thank Michael Centanni, Mark Kusner and Michael Jaffe for their constant encouragement and assistance with this article. Finally, I would like to dedicate this article to the law students and professors at The University of Akron School of Law, who have become my friends and mentors.