

Client Alert

Phillips v. AWH Corp.: Interpretation of Patent Claims

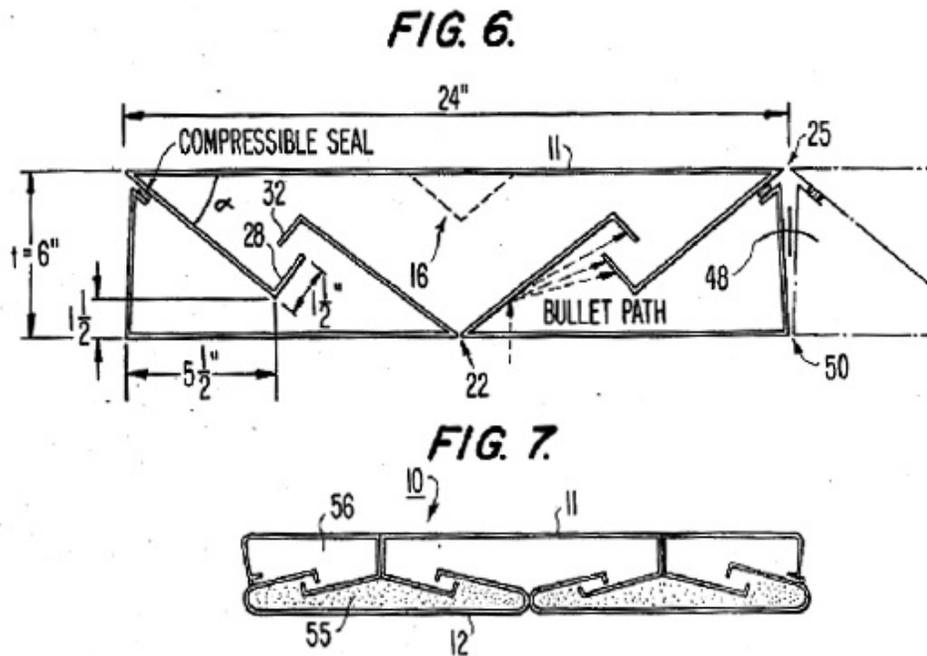
July 15, 2005
by Ross R. Barton

On July 12, 2005, in an en banc opinion in *Phillips v. AWH Corporation*, the United States Court of Appeals for the Federal Circuit clarified the procedure for interpreting patent claims. As a result, the patent specification, rather than dictionaries, is to be the primary tool for interpreting patent claims.

Intellectual
Property

Background on *Phillips*

Edward H. Phillips invented and patented modular, steel-shell panels that can be welded together to form vandalism-resistant walls of particular use in prisons. In the patent, Mr. Phillips claimed the use of “steel baffles” within the walls to provide impact or projectile resistance. Below are exemplary drawings from the patent at issue:



In 1997, Mr. Phillips brought an infringement suit against AWH Corp. The district court construed the patent’s claims to require that the baffles must “extend inward from the steel shell walls at an oblique or acute angle to the wall face.” The district court granted AWH’s motion for summary judgment of non-infringement because



Pillsbury
Winthrop
Shaw
Pittman^{LLP}

Vol. 1400, No. 1402

Client Alert

the defendant's accused walls contained internal baffles oriented at 90° angles from the steel shell walls.

On appeal, the three judge panel for the Federal Circuit relied upon the "specification's explicit descriptions" and concluded that "the patentee regarded his invention as panels providing impact or projectile resistance and that the baffles must be oriented at angles other than 90°." The panel upheld the District Court's summary judgment of no infringement based on this claim construction.

On July 21, 2004, the Federal Circuit vacated the panel opinion and issued an order granting rehearing en banc. In this order, the Court identified seven questions for which it sought input. These seven questions can be fairly characterized as falling into three general categories: 1) how and to what extent various types of evidence, particularly the specification and dictionaries, should be relied on for claim construction; 2) how the specification should properly be used to interpret claims without impermissibly importing limitations into the claims; and 3) what deference, if any, the Federal Circuit should give a district court's claim construction.

The *Phillips* Opinion

Before *Phillips*, Federal Circuit precedent contained significant conflicts regarding the proper role of dictionaries. Although cases such as *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996), *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996), and *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, 381 F.3d 1111 (Fed. Cir. 2004) downplayed the role of dictionary definitions, the Court's ruling in *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002) placed primary importance on dictionary definitions. In the *Phillips* opinion, authored by Judge Bryson, the Court set out to resolve the conflict precedent.

The Court strongly criticized the weight given to dictionary definitions in *Texas Digital*. Judge Bryson's opinion indicates that the methodology advocated in *Texas Digital* "placed too much reliance on extrinsic sources such as dictionaries, treatises, and encyclopedias and too little on intrinsic sources, in particular the specification and prosecution history." The Court stated that "[t]he sequence of steps used by the judge in consulting various sources is not important; what matters is for the court to attach the appropriate weight to be assigned to those sources in light of the statutes and policies that inform patent law." The court thus adopted the position argued by USPTO Solicitor Whealan at oral argument and reaffirmed the primacy of the specification as described in *Markman*, *Vitronics*, and *Innova*.

According to the Court's opinion in *Phillips*, the ordinary and customary meaning of the claim language, as understood by a person of skill in the art, remains the starting point for claim construction. When the ordinary meaning is not readily apparent from the claim language alone, a court should look to the patent's specification, as the claims and the specification constitute a "fully integrated written instrument." Throughout the opinion, the Court reiterates and reemphasizes the importance of the specification during claim construction, going so far as to state that "the specification necessarily informs the proper construction of the claims."

To a lesser extent, the Court approved the use of a patent's prosecution history during claim construction. The Court stated that the prosecution history may inform the meaning of the claim language, but warned that "because the prosecution



Pillsbury
Winthrop
Shaw
Pittman^{LLP}

Vol. 1400, No. 1402

Client Alert

history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the specification and thus is less useful for claim construction purposes."

Applying this clarified claim construction regime to the facts of this case, the Court vacated the District Court's claim construction and remanded for further proceedings. 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." On this point only, Judge Lourie dissented from the court's opinion, arguing instead that the District Court's claim construction was proper.

In the order granting rehearing en banc, the Court sought input regarding whether review of the trial court's claim construction should remain *de novo*. In *Phillips*, however, the Court expressly declined to address this issue or otherwise disturb the Court's leading precedent on this topic, *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998). Appellate review of claim construction therefore remains *de novo*. This was the subject of a scathing dissent authored by Judge Mayer and joined by Judge Newman. Judges Mayer and Newman are both in favor of treating claim construction as a Rule 52(a) determination--subject to review for clear error. Judge Mayer's dissent concludes with the following notable quote:

"Eloquent words can mask much mischief. The court's opinion today is akin to rearranging the deck chairs on the Titanic--the orchestra is playing as if nothing is amiss, but the ship is still heading for Davey Jones' locker."

The Future After *Phillips*

Phillips makes clear that, once again, a patent's specification is supreme. Moreover, there will likely be fewer "dictionary battles" during claim construction. Rather, dictionary definitions will take a much diminished role during claim construction and be used primarily to support or challenge statements in the specification. Whether *Phillips* will inject the claim construction process with greater certainty remains to be seen.

For further information, please contact:

Ross R. Barton ([bio](#))
Northern Virginia
+1.703.905.2127
ross.barton@pillsburylaw.com

Kevin T. Kramer ([bio](#))
Washington, DC
+1.202.663.8000
kevin.kramer@pillsburylaw.com



Pillsbury
Winthrop
Shaw
Pittman LLP

Vol. 1400, No. 1402

This publication is issued periodically to keep Pillsbury Winthrop Shaw Pittman LLP clients and other interested parties informed of current legal developments that may affect or otherwise be of interest to them. The comments contained herein do not constitute legal opinion and should not be regarded as a substitute for legal advice. © 2005 Pillsbury Winthrop Shaw Pittman LLP. All Rights Reserved.