

What Exactly Does Your Patent (Or Your Competitor's Patent) Cover?

The Federal Circuit has issued its long-awaited en banc decision in *Phillips v. AWH Corp.*, 03-1269, -1286 (July 12, 2005) on how patent claims ought to be construed. It is well established that claim terms must be given their ordinary and customary meaning as viewed from the perspective of one skilled in the art. The question addressed by the Federal Circuit was how the ordinary and customary meaning should be determined. The court ruled that the meaning of a claim term is to be determined based principally on intrinsic evidence, i.e. based on the language of the claims, the specification and the prosecution history. The court recognized that extrinsic evidence (such as dictionaries, treatises and expert testimony) can be useful in claim construction, but ruled that extrinsic evidence should be used as a secondary source and treated as less reliable than intrinsic evidence. *Id.* at 19.

The court rejected the approach to claim construction articulated in a line of cases which relied principally on the dictionary definitions of claim terms to ascertain their meanings. This approach is represented by *Texas Digital System, Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002). Under the rejected approach, a dictionary definition

was to be used if a term was not expressly defined in the specification and the meaning of the term was not clearly disclaimed in the prosecution history. The specification was used to select the proper dictionary definition. The court rejected the *Texas Digital* approach because that approach “improperly restricts the role of the specification in claim construction.” *Id.* at 24.

The court ruled that claim construction can be conducted in any sequence and may involve consideration of evidence from many sources “as long as those sources are not used to contradict claim meaning that is unambiguous in light of the intrinsic evidence.” *Id.* at 30-31. The court left it up to the District Court's discretion to “admit and use” extrinsic evidence. *Id.* at 21. For example, dictionaries can be used “to assist in understanding the commonly understood meaning of words.” *Id.* at 28.

The court declined to address the issue of the deference that should be given to the District Court's rulings on claim construction. *Id.* at 38. Accordingly, the current *de novo* standard for review of District Court claim constructions will continue to govern.

The *Phillips* case is of critical importance to nearly every patent

matter which involves infringement or claim coverage issues. The determination of infringement or coverage of a patent involves two steps: claim construction and application of the construed claims to the accused process or product. Since claim construction is often determinative of the issue of infringement and different approaches to claim construction produce significantly different results, the decision in *Phillips* will affect nearly

every pending and contemplated patent infringement litigation. It will also affect future and existing infringement opinions. It behooves clients who obtained infringement or non-infringement opinions prior to the *Phillips* decision to have them reviewed to determine whether the claim construction approach adopted by the Federal Circuit in the *Phillips* case changes the conclusion reached by the opinion on infringement.