

## **Summary of Phillips v. AWH Corp. (Fed. Cir. 2005)**

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### **SUMMARY**

The Federal Circuit handed down the long awaited Phillips decision today. The Court suggested that turning to dictionary definitions first to determine the ordinary meaning of claim terms improperly restricts the role of the specification in claim construction. Further, primary resort to dictionary definitions forces an inquiry on an "abstract meaning" of claim terms rather than the meaning of the terms "in the context" of the specification. Further, the Court explained that making dictionary definitions primary is unfair to applicants, since applicants did not create the dictionary or its definition.

### **BACKGROUND**

The invention in question is directed to modular steel-shell panels that can be welded together to form vandalism-resistant walls. The panels are load-bearing and impact-resistant, while also insulating against fire and noise. Claim 1 recited "further means disposed inside the shell for increasing its load bearing capacity comprising internal steel baffles extending inwardly from the steel shell walls." The district court interpreted this limitation under 35 USC §112(6) as a "means-plus-function" limitation, and looked to the specification for corresponding structure. The lower court noted that "every textual reference in the specification and its diagrams show baffle deployment at an angle other than 90 degrees to the wall faces"

and that "placement of the baffles at such angles creates an intermediate interlocking, but not solid, internal barrier." The lower court thus ruled that the baffles must "extend inward from the steel shell walls at an oblique or acute angle to the wall face" and must form part of an interlocking barrier in the interior of the wall module. Under this constructions, Phillips could not prove infringement, and summary judgment was granted.

The Federal Circuit, after an en banc rehearing, reversed the judgment of non-infringement. The Court affirmed its prior ruling that the claim term in question was not a "means-plus-function" limitation because the claim recited sufficient structure ("internal steel baffles"). Thus, the Court interpreted the term "baffles" as used in the patent in question.

### **CLAIM CONSTRUCTION**

The Court restated the principles set forth in Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370 (1996), Vitronics Corp. v. Conceptor, 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). Essentially, the Court refocused the question of claim construction on interpreting the claims in view of the specification, and if relevant, the prosecution history (the "intrinsic record"), without

improperly importing limitations from the specification into the claims.

### **USE OF DICTIONARIES**

In Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193 (Fed. Cir. 2002), the Federal Circuit noted that “dictionaries, encyclopedias, and treatises are particularly useful resources to assist the court in determining the ordinary and customary meanings of claim terms.” 308 F.3d at 1202. Dictionary definitions are particularly relevant since they represent established meanings, and they are unbiased. The intrinsic record should be consulted to decide between multiple definitions. The most meaning most consistent with the intrinsic record should be selected. If more than one definition is consistent, the claim terms may be construed to encompass all such consistent meanings. Id.

The Texas Digital court recognized two situations in which the patentee’s use of a term could be found to be inconsistent with the ordinary meaning determined by the dictionary. The first occurs when the patentee acts as his own lexicographer, and explicitly sets forth a definition contrary to the ordinary meaning. The second occurs if the patentee disavowed or disclaimed scope of coverage. The Texas Digital opinion further suggested that dictionaries are to be consulted before the specification and prosecution history.

The Federal Circuit in Phillips recognized that the motivation for the methodology set forth in Texas Digital – avoiding improperly importing limitations from the specification into the claims – was valid, but that the methodology was improper. The Texas Digital methodology reduced the specification to a mere check on the dictionary meaning of a claim term.

The Court held that such a limited role for the specification is inconsistent with prior rulings that the specification is “the single best guide to the meaning of a disputed term,” and that the specification “acts as a dictionary when it expressly defines terms used in the claims or

when it defines terms by implication.” Vitronics, 90 F.3d at 1582.

The Court noted that the main problem with elevating the dictionary to such prominence is that it focuses the inquiry on the “abstract meaning” of words rather than on the meaning of claim terms “within the context of the patent.” Properly viewed, the “ordinary meaning” of a claim term is its meaning to the ordinary artisan after reading the entire patent.

The ruling does not preclude the use of dictionaries in appropriate circumstances. Dictionary definitions are still useful as unbiased evidence of the ordinary meaning of terms.

### **CONSTRUCTION TO AVOID INVALIDITY**

The Court also addressed the question of when, if ever, a claim should be narrowly interpreted to avoid invalidity. The Court noted that claims should only be construed narrowly to avoid invalidity when the court concludes, after applying all the available tools of claim construction, that the claim is still ambiguous. The Court concluded that the claims in the present case are not ambiguous, and therefore an analysis of whether the interpretation rendered the claims invalid was inapplicable.

### **TRIAL COURT DEFERENCE**

The Court declined to address the question of what deference, if any, should be given to trial court claim construction rulings.