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# The Elusive Role of the Specification in Patent Claim Construction

**Keywords**

Patent laws & legislation, Intellectual property

# THE ELUSIVE ROLE OF THE SPECIFICATION IN PATENT CLAIM CONSTRUCTION

by Mohammad Nilforoush\*

## ABSTRACT

This Comment addresses the issue of predictability in the court's use of the written description of a patent to interpret the claims. The Federal Circuit attempted to provide a clearer claim construction methodology in its en banc decision in *Phillips v. AWH Corp.* Although the court clarified that the specification is the primary source for interpreting the claims, it did not provide clearer guidelines for determining the proper extent to which it should be used. The result has been that courts continue to use the specification in differing degrees, in line with the different claim construction methodologies that existed before *Phillips*. Two recent cases, *Retractable Technologies, Inc. v. Becton, Dickinson & Co.* and *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.* illustrate the split in the Federal Circuit's methodology. This Comment analyzes the use of the specification in the court's claim construction by applying the existing guidelines to identify areas where the current guidance is insufficient to allow for predictable claim constructions. This Comment also analyzes an older case, *Johnson Worldwide Associates, Inc. v. Zebco Corp.*, to show that the method of using the specification after *Phillips* is no clearer than it was before. This Comment then recommends that the court clearly articulate and apply additional guidelines to allow lower courts and practitioners to predictably construe claims.

## I. INTRODUCTION - DISAGREEMENTS OVER HOW MUCH THE SPECIFICATION SHOULD BE CONSULTED WHEN A COURT IS INTERPRETING THE CLAIMS MAKE CLAIM CONSTRUCTION UNPREDICTABLE

The way a court interprets the claims of a patent plays a pivotal, if not dispositive,

role in determining whether or not there is infringement.<sup>1</sup> Unfortunately, it is also one of the main reasons the Court of Appeals for the Federal Circuit reverses patent infringement decisions by the district courts.<sup>2</sup> The high reversal rate indicates that the current guidelines for construing claims are inadequate for determining the manner in which the appeals court will interpret claims.<sup>3</sup>

The unpredictability of claim construction makes it difficult for businesses involved in patent litigation to determine whether a particular product is going to infringe on a patented invention.<sup>4</sup> The impact on small businesses is even greater because they do not have the resources to spend on preparation

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1. See R. Polk Wagner & Lee Petherbridge, *Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance*, 152 U. PA. L. REV. 1105, 1119 (2004) (observing that the importance of claim construction in patent litigation is likely to increase); John M. Romary & Arie M. Michelsohn, *Patent Claim Interpretation After Markman: How the Federal Circuit Interprets Claims*, 46 AM. U. L. REV. 1887, 1889 (1997) (stating that the stakes for a particular claim interpretation are high because such interpretation determines whether or not a product infringes).

2. See Michael Saunders, *A Survey of Post-Phillips Claim Construction Cases*, 22 BERKELEY TECH. L.J. 215, 233-34 (2007) (showing a high rate of district court claim construction decisions reversal using different studies).

3. See Wagner & Petherbridge, *supra* note 1, at 1119 (noting that many of the claim construction canons are not particularly useful); Stephanie Ann Yonker, *Post-Phillips Claim Construction: Questions Unresolved*, 47 IDEA 301, 302 (2007) (stating that the Federal Circuit has "struggled to articulate a coherent and uniform methodology" for claim construction).

4. See Paul F. Prestia, *Can Federal Circuit Cut Patent Claim Construction a Clearer Path?*, THE LEGAL INTELLIGENCER (July 11, 2011), <http://www.law.com/jsp/lawtechnologynews/PubArticleLTN.jsp?id=1202499855484&slreturn=1&hbxlogin=1> (identifying the prediction of how a patent claim will be construed as one of the most difficult challenges for parties involved in litigation).

and litigation.<sup>5</sup> Therefore, when faced with infringement suits, small businesses will be more likely to settle rather than risk costly litigation with an unpredictable outcome.<sup>6</sup>

The Circuit Court's en banc decision in *Phillips v. AWH Corp.*<sup>7</sup> was meant to clarify claim construction issues, holding that the written description portion of the patent, or the specification, is the primary source to rely on in interpreting the claims.<sup>8</sup> Though the court in *Phillips* also laid down several guidelines for interpreting the claims in view of the specification, it left many questions about the role of the specification in interpreting the claims unanswered.<sup>9</sup> This left the door open to disagreements about the extent to which the

specification should be relied on, and the point at which the court should turn to the specification.<sup>10</sup>

This Comment argues that the current guidelines laid down by the courts for construing claims in light of the specification lead to unpredictable claim constructions, and that this may be remedied by clearly articulating additional guidelines to address the existing gaps. Part II provides background about the relationship between the claims and the rest of a patent's specification, and discusses the guidelines courts have provided for construing claims in view of the specification.<sup>11</sup> Part III applies these guidelines to several cases and analyzes the reasons why the guidelines could not be relied upon to adequately predict the outcomes of those cases.<sup>12</sup> Part IV recommends that the Federal Circuit modify or expand the existing guidelines by clearly articulating and applying additional rules to fill in the current gaps and arrive at more predictable outcomes.<sup>13</sup> Part V concludes that achieving predictable outcomes would advance the goals of the patent system and be beneficial to businesses seeking to protect their intellectual property.<sup>14</sup>

## II. THE RELATIONSHIP BETWEEN THE CLAIMS AND THE REST OF THE SPECIFICATION

### A. Goals and Policy Behind Patents

Article I of the Constitution provides

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10. See, e.g., Tony Dutra, et al., *Fed. Cir. Split for 2nd Time in 2011 on Use Of Patent Specification in Claim Construction*, PAT., TRADEMARK & COPYRIGHT LAW DAILY (BNA) (July 11, 2011) (reporting on cases in which the Federal Circuit was split regarding claim construction in 2011).

11. See discussion *infra* Part II (summarizing the goals and policy behind patents, the importance of predictability in claim construction, the current guidelines governing claim construction, and the facts of the cases to be analyzed).

12. See discussion *infra* Part III (analyzing *Retractable Techs., Inc. v. Becton, Dickinson & Co., Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, and *Johnson Worldwide Associates, Inc. v. Zebco Corp.*).

13. See discussion *infra* Part IV (recommending additional guidelines to govern the use of the specification in situations like those analyzed in Part III).

14. See discussion *infra* Part V (concluding that articulating clear guidelines would decrease costs, and preserve the notice function of patent claims).

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5. See Nydia M. Velázquez, Committee Reviews Impact of Patent Reform on Nation's Small Businesses, in *News from the Committee on Small Business*, <http://democrats.smallbusiness.house.gov/PressReleases/2007/pr-3-29-07-patent-reform.htm> (last visited June 24, 2012) (expressing several panelists' view of how the threat of costly litigation deters small businesses from engaging in research and development).

6. See, e.g., Letter from Chris MacAskill, Co-founder, SmugMug, Inc., to John Conyers, Jr., Chairman, House Committee on the Judiciary (Apr. 30, 2009) (submitted to the House Committee on the Judiciary), available at <http://www.patentfairness.org/pdf/SmugMug%20Submitted%20Testimony.pdf> (observing that small businesses like SmugMug are forced into crippling settlements because they lack resources to fight lawsuits).

7. 415 F.3d 1303 (Fed. Cir. 2005).

8. See *id.* at 1317 (ruling that it is appropriate for a court to rely heavily on the specification to guide its understanding of the claims); see also Crissa A. Seymour Cook, *Constructive Criticism: Phillips v. AWH Corp. and the Continuing Ambiguity of Patent Claim Construction Principles*, 55 U. KAN. L. REV. 225, 252 (2006) (characterizing the Federal Circuit's analysis of intrinsic evidence in *Phillips* as endorsing heavy reliance on the specification and emphasizing the probative value of the specification over all other sources).

9. See *Phillips*, 415 F.3d at 1317 (accepting that in some cases, it will remain difficult to determine the effect of the specification on the claims); Laura Mullendore, *Patent Claim Construction: A Sliding-Scale Standard of Review*, 28 REV. LITIG. 241, 252-53 (2008) (describing how the *Phillips* decision still leaves a great degree of uncertainty regarding claim construction); Yonker, *supra* note 3, at 323-24 ("[T]he Federal Circuit fails to establish a clear framework to guide district courts in the construction of patent claims."); Saunders, *supra* note 2, at 215 (mentioning that the court in *Phillips* acknowledged that its decision did not resolve some issues in claim construction); Joseph Root, *The Disclosure Revolution It's A Wydiwyg World*, 3 LANDSLIDE 20, 23 (2011) (describing claim construction as a process "characterized by flexibility," and illustrating the somewhat contradictory nature of existing claim construction principles).

the foundation on which the modern patent system has grown.<sup>15</sup> The patent system aims to “promote the Progress of Science and useful Arts”<sup>16</sup> by encouraging people to invent<sup>17</sup> and encouraging inventors to publicly disclose their inventions.<sup>18</sup>

One goal of the patent system articulated in the early case law is encouraging public disclosure of inventions.<sup>19</sup> Under this view, the public grants the inventor a monopoly over a particular invention, and is in turn compensated by the inventor’s publication of the invention.<sup>20</sup> To achieve this goal, the inventor is required to describe the invention in a manner that would allow a person skilled in the art to make and or use it.<sup>21</sup> To encourage the inventor to provide this disclosure, the patent provides a monopoly that allows the inventor to exclude others from making and using the invention for a limited period of time.<sup>22</sup> This right to exclude provides inventors an advantage superior to keeping the invention a secret, as inventors who keep their invention a secret have no such right if it is revealed.<sup>23</sup> To protect the public, the inventor

must file an application within one year of any public disclosure of the invention.<sup>24</sup> If an invention is described in a printed publication, falls into public use, or becomes available for sale, and the inventor does not file for a patent within one year, the inventor will no longer be entitled to a patent for that invention.<sup>25</sup>

Another goal of the patent system is to encourage individuals to put effort into developing inventions.<sup>26</sup> Without patents, an invention would have no monetary value, and only a product that was developed and marketed based on that invention would be valuable.<sup>27</sup> However, that product could be produced by anyone for only the cost of the materials and labor needed to make it, not incurring the costs related to developing the invention.<sup>28</sup> The result would be that potential inventors would not invest in developing new technology because others could make more profit from it than they could.<sup>29</sup> Patents address this problem by essentially making the inventor the temporary owner of his invention and providing him with the ability to recoup the costs incurred in developing the invention.<sup>30</sup> A patent is an important document in achieving this goal because the patent puts the public on notice about the extent of the rights granted to the inventor.<sup>31</sup>

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15. See U.S. CONST., art. I, § 8, cl. 8. (“The Congress shall have the Power To . . . secur[e] for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”); 1 R. CARL MOY, MOY’S WALKER ON PATENTS § 1:10 (4th ed., 2010) (recounting how the Constitution provides Congress the power to grant patents).

16. U.S. CONST., art. I, § 8, cl. 8.

17. See MOY, *supra* note 15, § 1:38 (relating how one explanation for the patent system is that the expectation that a person can get a patent will encourage people to invent).

18. See *id.* § 1:37 (conveying the view that one justification for patents is that the public grants the inventor the patent right in exchange for a disclosing knowledge of the invention).

19. *Id.*

20. *Id.*

21. See 35 U.S.C. § 112 (2006) (“The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.”).

22. See 35 U.S.C. § 154 (a) (2006) (“Every patent shall contain . . . a grant to the patentee . . . of the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States . . .”).

23. See LOUIS ALTMAN & MALLA POLLACK, 2 CALLMANN ON UNFAIR COMP., TR. & MONO. § 14:15 (4th ed., 2011) (outlining the difference between the protection provided by a patent and a trade secret, as well as the

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causes of action for misuse of a trade secret).

24. See 35 U.S.C. § 102 (b) (2006) (barring a person from obtaining a patent if the invention was published more than a year prior to patent application data).

25. *Id.*

26. See MOY, *supra* note 15, § 1:38 (expounding on how patents correct a flaw in the free market that requires private entities to invest in research on the one hand, whereas the fruits of that research will have little value in a completely free market).

27. *Id.*

28. *Id.*

29. See *id.* (observing how, once enough competitors enter the market, they will drive the price down to zero, and that when inventions yield inadequate profits, inventors will devote their time elsewhere).

30. See *id.* (illustrating how, without patent protection, an invention itself would have no monetary value).

31. See *id.* § 4:2 (relating the history of the development of patents and the patent document); Kirk M. Hartung, *Claim Construction: Another Matter of Chance and Confusion*, 88 J. PAT. & TRADEMARK OFF. SOC’Y 831, 832 (2006) (pointing out that the purpose of patent claims is to provide clear warning as to what constitutes infringement of the patent and provide clear measurement of the invention).



## B. The Written Description and Claims of a Patent

Originally, patents consisted only of a written description and drawings of the invention.<sup>32</sup> The reliance on the written description to define the scope of the patent led to difficulties in distinguishing between the portions of an invention that were already known and the portions that represented the inventor's original contribution.<sup>33</sup> Therefore, in 1836 Congress required inventors to include a separate portion particularly specifying what they claimed as their invention, and later required that this portion "distinctly claim" the invention.<sup>34</sup>

The Patent Office and the courts also changed the way inventions were claimed.<sup>35</sup> Originally, patent applicants used "central claiming," in which they claimed the invention in reference to the specification.<sup>36</sup> Under this approach, the language of the claim itself did not define the scope of the patent protection, but was used to identify the portion of the specification that described the inventive concept, which was then used to define the scope of the inventor's rights.<sup>37</sup>

The way inventors claimed their invention eventually switched to the method

used today—"peripheral claiming."<sup>38</sup> Under peripheral claiming, the inventor uses the claim language to describe the limits of the invention, rather than its fundamental aspects.<sup>39</sup> Because the focus of peripheral claiming is on the claim language itself, the interpretation of each word affects the overall scope of the patent right.<sup>40</sup> The law regarding the way in which inventions are claimed under this approach has continued to develop since the switch to peripheral claiming.<sup>41</sup>

## C. Guidelines for Using the Specification to Construe the Claims

Although there have been a large number of decisions that dealt with the different types of evidence that should be relied upon when construing claims,<sup>42</sup> the court in *Phillips* maintained that after the claims themselves, the specification is the primary source for defining

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38. See *id.* § 1:21 (characterizing peripheral claims as relying on the literal meaning of the words in the claims).

39. See Donald S. Chisum, *The Scope of Protection for Patents After the Supreme Court's Warner-Jenkinson Decision: The Fair Protection-Certainty Conundrum*, 14 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1, 38 (1998) (remarking that central claiming involves claiming the core principles of the invention and peripheral claiming involves describing the outer bounds of the invention).

40. See Moy, *supra* note 15, § 4:8 (identifying peripheral claiming as being a paradigm that assigns scope to the patent right using the definitions of the words in the claim).

41. See *id.* § 1:21 (noting that the effects of the switch to central claiming are still being sorted out).

42. See *SRI Int'l v. Matsushita Elec. Corp.* of Am., 775 F.2d 1107, 1118 (Fed. Cir. 1985) (stating that the claims should be construed in view of the claim language, specification, prior art, and prosecution history, before the claims are applied to an allegedly infringing device); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979-80 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996) (holding that claims must be read in view of the specification, and that this includes using the specification as "sort of a dictionary," but that it is the claims, and not the specification, that delimit the bounds of the patent right); *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202-03 (Fed. Cir. 2002) (holding that claim terms bear a "heavy presumption" that they have their ordinary meaning, which should be determined by using dictionaries, encyclopedias, and treatises, before turning to the specification). But see Peter S. Menell, et al., *Patent Claim Construction: A Modern Synthesis and Structured Framework*, 25 BERKELEY TECH. L.J. 711, 743-45 (2010) (reporting on how *Phillips* rejected the use of dictionaries as the primary source for obtaining the ordinary meaning of claim terms).

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32. See Moy, *supra* note 15, § 4:2 (detailing the historical reliance on the written description alone to determine the scope of a patent, as well as the problems that arose with this approach).

33. *Id.*

34. See Andrew J. Fischer & David A. Jones, *The Bow Tie of Patent Claim Construction*, 4 LANDSLIDE 21, 21-22 (2012) (describing the introduction of the claim requirement in 1836, and its subsequent amendment in 1870); Paul M. Schoenhard, *Reversing the Reversal Rate: Using Real Property Principles to Guide Federal Circuit Patent Jurisprudence*, 17 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 299, 309 (2007) (clarifying that although the Patent Act of 1836 required a separate portion that pointed out what the inventor regarded as his invention, the Patent Act of 1870 was the first to require claims, per se); Gretchen A. Bender, *Uncertainty and Unpredictability in Patent Litigation: The Time is Ripe for a Consistent Claim Construction Methodology*, 8 J. INTELL. PROP. L. 175, 182-83 (2001) (examining how the patent laws from 1790 to 1836 dealt with disclosure and claiming).

35. See Moy, *supra* note 15, § 1:21 (speculating about the source of the switch from central to peripheral claiming).

36. *Id.*

37. See *id.* § 4:8 (distinguishing between central and peripheral claiming).

terms during claim construction.<sup>43</sup> The court also laid out several guidelines, based on prior case law, for how to use the specification when interpreting claims, which are detailed below.<sup>44</sup>

### 1. Claims Define the Scope of the Patent Right

The claims define the limits of what an inventor has the right to exclude others from making or using.<sup>45</sup> The written description should not be used for this purpose, but can be used to interpret what the claim means.<sup>46</sup>

### 2. Claim Terms Generally Have Their Ordinary and Customary Meaning

The ordinary and customary meaning of claim terms, as understood by a person of ordinary skill in the art, provides a starting point from which to begin interpreting the claims.<sup>47</sup> The court had previously held that there should be a heavy presumption in favor of this ordinary meaning.<sup>48</sup> According to this view, this presumption could only be rebutted by the

specification in certain situations.<sup>49</sup> In *Phillips*, however, the court held that a person of ordinary skill is “deemed to read the claim term . . . in the context of the entire patent” and the ordinary meaning, when understood in this context, is the baseline from which claim interpretation should begin.<sup>50</sup> Thus, although the ordinary meaning would be applied in some situations, the court would look to intrinsic evidence, including the specification, to determine the ordinary meaning of a term in many cases.<sup>51</sup>

### 3. Claims Should be Interpreted in View of the Specification

Claims should not be interpreted in a vacuum, but must be read in view of the specification.<sup>52</sup> The specification provides context for the claims.<sup>53</sup> It can be used to understand the claim terms because the words in the claim should be interpreted consistently with their usage in the specification.<sup>54</sup> This generally includes understanding the terms in a manner

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43. See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (“[T]he specification . . . is the single best guide to the meaning of a disputed term.”).

44. See *id.* at 1312-1316 (summarizing the guidelines articulated in precedent for construing the claims).

45. See *id.* at 1312 (citing *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004)) (“It is a ‘bedrock principle’ of patent law that ‘the claims . . . define the invention . . .’”); *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (averring that the first step in claim interpretation is to look to the words of the claims to define the scope of the patented invention).

46. See *Markman*, 52 F.3d at 979-80 (stressing that although claims are read in view of the specification, only the claims, and not the specification, delimit the right to exclude).

47. See *Phillips*, 415 F.3d at 1313 (declaring the inquiry into how a person of ordinary skill understands a claim term as an “objective baseline” for beginning claim interpretation).

48. See *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002) (holding that there is a heavy presumption that claims have their ordinary meaning, and stressing that dictionaries are particularly useful for determining the ordinary meaning); *Menell*, *supra* note 42, at 743-44 (characterizing *Texas Digital* as putting emphasis on using dictionaries to define the ordinary meaning).

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49. See *Texas Digital*, 308 F.3d at 1204 (holding that the presumption of ordinary meaning is rebutted if the specification uses the words in a manner inconsistent with the ordinary meaning, if it sets forth an explicit definition of the term, or if it clearly disclaims claim scope); see also *Menell*, *supra* note 42, at 743-44 (commenting that *Texas Digital* established a heavy presumption in favor of the ordinary meaning from dictionaries unless it is overcome by definitions or clear disavowals of claim scope in the specification, but also arguing that, while *Phillips* did not explicitly reject this heavy presumption, it did reject the elevation of the dictionary definition and the court has rarely used the heavy presumption since *Phillips*).

50. *Phillips*, 415 F.3d at 1313.

51. See *id.* at 1314 (accepting that when the meaning of a term is readily apparent, claim construction involves merely applying the widely accepted meaning, but in most situations, the meaning is not readily apparent).

52. See *id.* at 1315 (maintaining that the claims are part of a fully integrated document that includes the specification).

53. See *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1116 (Fed. Cir. 2004) (pointing out that the specification provides context and can be used to better understand the meaning of the claim); *Yonker*, *supra* note 3, at 304-05 (declaring that the meaning of a claim term must be considered in the context of the intrinsic evidence, including the specification).

54. See *Autogiro Co. of Am. v. United States*, 384 F.2d 391, 397 (Ct. Cl. 1967) (summarizing the specification’s statutory purpose and instructing that words must be used in the same way in the both the claims and the specification); *Menell*, *supra* note 42, at 752 (suggesting that consistent usage of a term in the specification may be definitional).

that would not exclude the preferred embodiment from the scope of the claim.<sup>55</sup> When the ordinary meaning of a claim term makes the scope of the claim unclear, the specification should be used to determine the meaning of the term.<sup>56</sup> Therefore, the specification can act as a dictionary for the claim terms.<sup>57</sup> Also, if an inventor distinguishes the invention over the existing technology or prior art in a way that makes clear that this difference is the invention, the claim may be limited to it.<sup>58</sup> Generally, claims should be construed in a manner that “stays true to the claim language and most naturally aligns with the patent’s description of the invention.”<sup>59</sup> Although the use of the specification is no longer limited to specific situations, courts have also enumerated certain situations in which the specification should be used to limit the claim language.<sup>60</sup>

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55. See Menell, *supra* note 42, at 746 (examining the relationship between claim scope and the preferred embodiments).

56. *Teleflex, Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002) (listing other ways the specification limits claim scope); see generally Bender, *supra* note 34 (commenting that where the common meaning is unclear or a term has multiple meanings, the court may refer to the specification).

57. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370 (1996).

58. See Menell, *supra* note 42, at 751 (clarifying that statements distinguishing the prior art should only be used to narrow a claim construction when they are sufficiently clear, not when they include just a general criticism of the prior art).

59. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (quoting *Renishaw PLC v. Marposs Societa per Azioni*, 158 F.3d 1243, 1250 (1998)).

60. See *Phillips*, 415 F.3d at 1313-14, 1316 (holding that the meaning of a claim term, as understood by a person of ordinary skill, is determined within the context of the specification and that ultimately, the correct interpretation of a claim term will reflect what the inventors actually invented); see also Menell, *supra* note 42, at 743-52 (interpreting the court’s decreasing use of the heavy presumption in favor of the ordinary meaning of a term since *Phillips* as indicating that it is now appropriate to use the specification to depart from the ordinary meaning of a term even where the statements in the specification would not be considered explicit definitions or clear disavowals of claim scope, and listing several situations in which the specification may be used to limit the claim).

## a. Special Definitions Provided by the Patentee

The first situation courts have identified is that, when an inventor has clearly given a term a special definition in the specification, that definition should be used to construe the claims.<sup>61</sup> Also, a patentee may define terms by implication when the terms’ usage in the specification is inconsistent with their ordinary meaning.<sup>62</sup> Language that only describes a preferred embodiment, however, should not be considered as providing a lexicographic definition.<sup>63</sup>

## b. Disavowal or Disclaimer of Claim Scope

When breadth is clearly disavowed or disclaimed in the specification, the claims should be limited accordingly.<sup>64</sup> In order for a portion of the written description to be considered a disclaimer of claim scope, the language used must clearly exclude or restrict, and represent a clear disavowal of claim scope.<sup>65</sup> After *Phillips*, courts have also found an implied disavowal where factors suggest that the inventor intended

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61. See, e.g., *Phillips*, 415 F.3d at 1316 (recognizing the use of special definitions in the specification); *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (acknowledging that a patentee may be his own lexicographer if a special definition is clearly stated in the specification); see also Yonker, *supra* note 3, at 304-05 (maintaining that the patentee’s use of a special definition in the specification will overcome any presumption of ordinary meaning for a term).

62. See *Vitronics*, 90 F.3d at 1582 (instructing that the specification be consulted to determine if terms are used in a manner inconsistent with their ordinary meaning).

63. See *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (“[I]n determining whether a statement by a patentee was intended to be lexicographic, it is important to determine whether the statement was designed to define the claim term or to describe a preferred embodiment.”). But see Yonker, *supra*, note 3, at 305 (examining how a claim can be limited to an embodiment if the specification describes that embodiment such that it is not just a preferred embodiment, but the only one).

64. See *Phillips*, 415 F.3d at 1316 (instructing that an inventor dictates the correct claim scope by using disclaimers).

65. See *Teleflex, Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002) (maintaining that “expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope” demonstrate the patentee’s intent to depart from the ordinary meaning).



an embodiment to be the invention, such as when the inventor repeatedly describes that embodiment as “the invention” and it is the only embodiment described.<sup>66</sup>

#### 4. Limitations from the Specification Should not be Imported into the Claims

Although the specification can be used to better understand the claim, it cannot be used to change it.<sup>67</sup> If the specification describes an embodiment as being its “best mode,” or only describes a single embodiment, the claim should not necessarily be limited to this embodiment, unless other factors suggest there is an implied disavowal of claim scope.<sup>68</sup>

There is a thin line between interpreting the claims in view of the specification and improperly reading limitations from the specification into the claims.<sup>69</sup> Courts have often struggled with the amount of weight to give to the specification, or the extent to which claim construction should be limited to the language of the claims.<sup>70</sup>

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66. See Menell, *supra* note 42, at 750-51 (discussing the effect of characterizing an embodiment as “the invention” or “the present invention”).

67. See *Phillips*, 415 F.3d at 1312 (citing several cases to illustrate that it is the claims that define the invention and elements not included in the claims should not be used to limit them); *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1117 (Fed. Cir. 2004) (quoting *White v. Dunbar*, 119 U.S. 47, 51-52 (1886)) (stressing that although the specification can be used to better understand the meaning of the claims, it cannot be used to change them).

68. See *Autogiro Co. of Am. v. United States*, 384 F.2d 391, 398 (Ct. Cl. 1967) (cautioning that the claim should not be limited to an embodiment set forth in the specification if that embodiment is only characterized as the best mode for carrying out the invention); Menell, *supra* note 42, at 747 (stating that the claim should not be limited merely because the described embodiments have certain features, but that this is one factor that should be considered when deciding whether to limit a claim term).

69. *Innova/Pure Water*, 381 F.3d at 1117 (considering the contrasting nature of these axioms to be a “longstanding difficulty”).

70. See *Wagner & Petherbridge*, *supra* note 1, at 1119 (recognizing that efforts to resolve the tension between the two canons of interpreting the claims in light of the specification and not using the specification to import limitations into the claims have led to a split in authority); Menell, *supra* note 42, at 745 (identifying the “fundamental challenge in patent law” as being how to construe the claims in view of the specification given the

#### D. Cases to be Analyzed

In Part III, this article will analyze two cases, summarized below, that were recently decided by the Federal Circuit and resulted in disagreements within the court regarding the use of the specification to construe the claims.<sup>71</sup> This article will also examine one case decided before *Phillips* to demonstrate the similarity in the methodologies used before and after *Phillips*.<sup>72</sup>

##### 1. *Retractable Technologies, Inc. v. Becton, Dickinson & Co.*

In a claim for a retractable syringe, Judge Lourie construed the word “body” to be limited to a “one-piece” body.<sup>73</sup> Lourie acknowledged that the independent claim recited “body” while a dependent claim attempted to further limit this “body” to a “one-piece body,” and that this leaves open the possibility that the term “body” can include a body that has more than one piece.<sup>74</sup> However, he went on to rely on the specification to find that the term “body” was meant to be limited to a “one-piece body” because the specification does not indicate that a “body” is anything other than one piece, and the specification criticized the prior art’s failure to realize that a retractable syringe body could be made as one piece.<sup>75</sup> Judge Rader dissents

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tension between the competing principles); *Root*, *supra* note 9, at 23 (saying that for every claim construction principle that points to one direction, there is another that goes in another direction).

71. See *Dutra*, *supra* note 10 (detailing the second time the Federal Circuit has split on claim construction issues in 2011); *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1305, 1311-12 (Fed. Cir. 2011) (holding that the term “body” should be limited in light of the specification, while the dissent argues that this improperly imports limitations from the specification); *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1249, 1254, 1256-57 (Fed. Cir. 2011) (refusing to read a “split” limitation into the claims in the majority opinion, while the dissent argues that in one instance, interpreting the claim in light of the specification requires that the claim include a “split” limitation).

72. See *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 992, 994 (Fed. Cir. 1999) (refusing to interpret claim terms in a way other than their ordinary and customary meaning).

73. *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1305 (Fed. Cir. 2011).

74. *Id.* at 1304-05.

75. *Id.* at 1305.

from this opinion, saying that the language of the claims makes clear that “body” is not limited to a one-piece structure, that there is no contention that the term has any special, technical meaning, and the descriptions provided in the specification do not rise to the level of a manifest exclusion or an express disclaimer of claim scope.<sup>76</sup>

2. *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*

Judge Rader construed the terms “spring metal adaptor” and “spring steel adapter” in two patents as not including a “split” limitation.<sup>77</sup> Regarding the spring metal adapter, the court stated that the ordinary meaning of the phrase is an adapter made of spring metal, rather than a metal adapter with a springing function.<sup>78</sup> When looking at the specification, the court found that while the inventor described one of the embodiments as having an opening, and the drawings all depict an incomplete circle, nothing in the specification shows that the inventor clearly intended to limit the invention to embodiments having a “split.”<sup>79</sup> The court also compares claim 1, which describes the adapter as being less than a complete circle, with claim 8, which omits such a limitation, to find that the adapter could be either “split or unsplit.”<sup>80</sup> The court refuses to interpret the “spring steel adapter” as being split because only one of the embodiments and two of the figures show the adapter as being split.<sup>81</sup> The dissent argues that, in the case of one of the patents, the specification demonstrates that the inventors intended that the invention consisted only of adapters with a “split.”<sup>82</sup> Thus, according to the dissent, reading the claims in light of the specification requires that the claims be read as having a “split” limitation for that patent.<sup>83</sup>

3. *Johnson Worldwide Associates, Inc. v. Zebco Corp.*

In this case, the court also relied mainly on the claim language to find that the term “heading” used in the claims was not limited to the direction of a trolling motor, and that the phrase “coupled” was not limited to a mechanical or physical coupling.<sup>84</sup> The court began, as did the defendant, by recognizing that the ordinary and customary meaning of the term “heading” only means direction.<sup>85</sup> It then looked to the specification to see if the patentee had given that term a special meaning, as argued by the defendant.<sup>86</sup> The court declined to limit the meaning of the term because there was no clear and unambiguous statement in the specification that the term was meant to have a special meaning.<sup>87</sup> Rather, the court stated that the term was used in the specification in a variety of ways, and that this indicated the breadth of the term.<sup>88</sup>

Regarding the term “coupled,” the court also acknowledged the ordinary meaning of the term, but refused to find that language in the specification limited the meaning of the term to mean “mechanically coupled.”<sup>89</sup> The court stated that the usage of the term to describe the preferred embodiment cannot be used to infer a limitation on the term.<sup>90</sup>

III. THE CURRENT GUIDANCE FOR NAVIGATING THE FINE LINE BETWEEN INTERPRETING THE CLAIMS IN VIEW OF THE SPECIFICATION AND IMPROPERLY LIMITING THE CLAIMS LEADS TO UNPREDICTABLE CLAIM CONSTRUCTIONS

Claim construction by the courts usually results in varying degrees of reliance on the specification depending on whether a court relies heavily on the specification to interpret the claims in context or minimizes its reliance

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76. *Id.* at 1311-13 (Rader, J., dissenting).

77. *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1254, 1256 (Fed. Cir. 2011).

78. *Id.* at 1253.

79. *Id.* at 1254.

80. *Id.*

81. *Id.* at 1256.

82. *Id.* at 1258.

83. *Arlington Indus., Inc.*, 632 F.3d at 1257-58.

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84. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 992 (Fed. Cir. 1999).

85. *Id.* at 990.

86. *Id.* at 991.

87. *Id.*

88. *Id.*

89. *Id.* at 992.

90. *Johnson Worldwide Assocs., Inc.*, 175 F.3d at 992.

on the specification to avoid improperly limiting the claims.<sup>91</sup> This section compares the outcome that results when a particular approach is adopted with the guidelines that have been set in previous cases to determine where the guidelines leave room for unpredictability.

When a court emphasizes “interpreting the claims in view of the specification,” the result is a more liberal use of the specification.<sup>92</sup> Under this approach, the court focuses more on the rule that the specification provides context for the claims, rather than the rule that limitations from the specification should not be read into the claims.<sup>93</sup> This approach is based on the idea that the specification describes what was invented, and in the words of Judge Lourie, “you should get what you disclosed.”<sup>94</sup>

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91. See Wagner & Petherbridge, *supra* note 1, at 1119 (attributing the split in authority on claim construction methodologies to the tension between the pair of canons that say the claims should be interpreted in light of the specification and also that claims should not be modified beyond their actual language using the specification); Saunders, *supra* note 2, at 220-21 (reporting the two co-existing branches of claim construction jurisprudence that have developed); Menell, *supra* note 42, at 745 (identifying a fundamental challenge in patent law as being how to construe claims in view of the specification while balancing competing principles that require the claims to be the “sole measure” of the patent while also requiring that the claims be interpreted in a manner consistent with the document as a whole).

92. See Wagner & Petherbridge, *supra* note 1, at 1133-34 (explaining the “holistic” methodology, where the court avoids a formalized approach and seeks to arrive at the meaning of a claim term based on the particular circumstances presented); see also R. Polk Wagner and Lee Petherbridge, *Did Phillips Change Anything? Empirical Analysis of the Federal Circuit’s Claim Construction Jurisprudence*, in *INTELLECTUAL PROPERTY & THE COMMON LAW* (S. Balganesch ed., 2012) (forthcoming 2012) (manuscript at 7) available at <http://ssrn.com/abstract=1909028> [hereinafter Wagner & Petherbridge 2012] (defining the “holistic” approach as one in which the court interprets the claims using an open-ended reading of several sources, including the specification).

93. See *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1305 (Fed. Cir. 2011) (“[W]e strive to capture the scope of the actual invention, rather than strictly limit the scope of claims to disclosed embodiments or allow the claim language to become divorced from what the specification conveys is the invention.”); Root, *supra* note 9 (illustrating several situations where the court searched for the inventor’s intent in the specification, and then limited the claim based on what it perceived that intent to be).

94. See *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1257 (Fed. Cir. 2011) (characterizing the specification as the heart of the patent).

When the emphasis is on avoiding “improperly reading limitations from the specification into the claims,” the court tries to rely strictly on the claims themselves while minimizing reliance on the written description or other evidence.<sup>95</sup> This approach places more emphasis on the rule that the claims define the scope of the patent right and emphasizes giving claim terms their ordinary and customary meaning, while placing less emphasis on the notion that the specification provides the context for the claims.<sup>96</sup>

The analysis of each case compares the claim construction in the case to the guidelines discussed in the background to determine whether someone could rely on the guidelines to predict their outcomes.<sup>97</sup> This analysis concludes that not only do claim constructions result in unpredictable outcomes despite the court using the previously described guidelines in its reasoning, but also that this problem exists in cases decided both before and after the court’s en banc decision in *Phillips*, suggesting that *Phillips* did not resolve the question of how to use the specification in claim construction.<sup>98</sup>

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95. See, e.g., *id.* at 1254, 1256 (finding that there is no reason to depart from the claim language, and that the claim does not require a “split” as disclosed in the specification).

96. See Wagner & Petherbridge, *supra* note 1, at 1133 (regarding the “procedural” approach as one in which a court begins with the ordinary meaning of a claim term and then looks at other sources in a hierarchical manner to determine whether there is any significant evidence to justify a deviation from the ordinary meaning); Wagner & Petherbridge 2012, *supra* note 92 (describing the “procedural” approach as giving primary weight to the claim language); see also *Arlington Indus.*, 632 F.3d at 1254, 1256 (refusing to read a “split” limitation into the claims based on the specification); *Retractable Techs.*, 653 F.3d at 1311-13 (Rader, J., dissenting) (arguing that the claim should not be limited to “one-piece” because nothing in the specification rebuts the presumption that the term “body” does not include such a limitation).

97. See, e.g., Christopher A. Cotropia, *Patent Claim Interpretation Methodologies and Their Claim Scope Paradigms*, 47 WM. & MARY L. REV. 49, 97, 100 (2005) (contending that claim methodologies that result in unpredictable claim constructions would “thwart the notice aspect” of claims, but also pointing out that while adopting a single methodology would necessarily increase predictability, there may still be unpredictability depending on the rules used by the particular methodology).

98. Compare *Retractable Techs.*, 653 F.3d at 1305, 1312-13 (using the specification to limit the term “body” to a one-piece structure in the majority opinion), with *Arlington Indus.*, 632 F.3d at 1254-56 (finding that there

A. Predictability of *Retractable Technologies, Inc. v. Becton, Dickinson & Co.* Based on the Guidelines

The court's opinion is largely unpredictable based on the previously articulated guidelines because the court's approach adheres more closely to some guidelines, such as the general rule that the claims should be interpreted in view of the specification, while applying other guidelines, such as avoiding improperly limiting the claims based on the specification, more liberally.<sup>99</sup> The fact that different guidelines can be applied in varying degrees to result in different approaches demonstrates the need for additional, more specific, rules for adhering to the existing guidelines.<sup>100</sup>

The first issue to consider when comparing the court's reasoning to the previously established guidelines is how the court applies the guideline that the claims define the patent right.<sup>101</sup> The court's application of this principle would have been difficult to predict based on the existing guidance.<sup>102</sup> In *Retractable Technologies, Inc.*, the court began by looking at the language of the claims and determined that although there may be an implication that the term "body" is not limited to a one-piece

body, that would not be enough to interpret "body" as involving one or more pieces because none of the claims explicitly recite a body with more than one piece.<sup>103</sup> The court then relied heavily on the specification to find that the one-piece limitation from the specification should be read into the claim.<sup>104</sup> In contrast to other situations where the specification is only considered to resolve ambiguity, here, the court did not clearly state why the lack of an explicit recitation of a body with more than one piece in the claims required that the specification be used to determine the meaning of the term.<sup>105</sup> It may be that because claims must clearly and distinctly point out what the inventor regards as the invention, this court considered the lack of a limitation describing the number of pieces as making the claim unclear, thus necessitating the use of the specification.<sup>106</sup> Other courts may look to the same language and interpret the lack of an explicit limitation indicating the number of pieces as indicating that the claim has a broad scope and is meant to encompass a body with any number of pieces.<sup>107</sup> There is a need for a more clearly articulated rule regarding when to depart from the language of the claim and turn to the specification. As the guideline is currently applied, it is not clear when reliance on the specification would result in defining the scope

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is no reason to depart from the claim language, and that the claim does not require a "split" as disclosed the specification) and *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 991-94 (Fed. Cir. 1999) (refusing to modify the terms "coupled" and "heading" based on the specification).

99. See *Retractable Techs.*, 653 F.3d at 1312-13 (Rader, J., dissenting) (disagreeing with the majority's use of the specification and arguing that it is used to improperly limit the claims); see also *Wagner & Petherbridge*, *supra* note 1, at 1133-34 (describing the "holistic" methodology); *Wagner & Petherbridge* 2012, *supra* note 92 (describing the "holistic" approach which includes interpreting the claims using the specification, among other sources).

100. See *Cotropia*, *supra* note 97, at 97 (describing the problem with unpredictable claim construction methodologies).

101. See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996) (stating that purpose of the claims is to "delimit the right to exclude").

102. See, e.g., *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (citing *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004)) (maintaining that the claims define the invention).

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103. *Retractable Techs.*, 653 F.3d at 1304-05.

104. *Id.* at 1305.

105. See, e.g., *Phillips*, 415 F.3d at 1314 (elaborating that when the ordinary meaning of a claim term is readily apparent to lay judges, claim construction merely involves applying the widely accepted meaning of a term, but in most cases the meaning as understood by one of ordinary skill is not apparent, so judges must rely on other sources to determine the meaning); *Bender*, *supra* note 34, at 211-12 (mentioning that when a term is clear on its face, the court need not consider other evidence, but where the meaning is unclear, a court may look to the specification and prosecution history to discern a term's meaning).

106. See 35 U.S.C. § 112 (2006) ("The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.").

107. See, e.g., *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (arguing that if everything in the specification were read into the claims, an applicant would be unable to claim more broadly than their disclosed embodiment, regardless of the prior art); *Retractable Techs.*, 653 F.3d at 1311-13 (Rader, J., dissenting) (contending that the language of the claims makes clear that the term "body" does not include a "split" limitation, and it is improper to import such a limitation from the specification).



of the patent right based on the specification instead of the claims.<sup>108</sup>

The next guideline to consider is the degree to which the court relies on the claim term's ordinary and customary meaning.<sup>109</sup> Although the court's application of this rule is slightly more predictable in view of the court's decision in *Phillips*, because it does not rely on a heavy presumption in favor of the ordinary meaning, it illustrates that there is still some room for disagreement over the role of the ordinary meaning.<sup>110</sup> The opinion acknowledges the plaintiff's argument that the ordinary meaning of "body" is not limited to a one-piece body and can include a body that has more than one piece.<sup>111</sup> The court did not address why this ordinary meaning should not be used, but instead looked at the specification.<sup>112</sup> Thus, it appears that the court's reliance on the ordinary meaning of the claim term was minimal.<sup>113</sup> As mentioned previously, this can be expected considering the court's holding in *Phillips*, which backed away from the heavy presumption in

favor of the ordinary meaning of claim terms that led to the exaltation of dictionaries over the specification in cases such as *Texas Digital*.<sup>114</sup> Judge Rader in his dissent, however, still argued that the court should only abandon the ordinary meaning when it finds a clear reason to do so.<sup>115</sup> This illustrates a lingering disagreement as to the relationship between the ordinary meaning of a term and what the applicant has disclosed in the specification.<sup>116</sup> Although the court need not require a heavy presumption in favor of the ordinary meaning, the court could provide a predictable starting point for claim construction by providing criteria for determining whether to turn first to the ordinary meaning or to the specification.<sup>117</sup>

The next relevant principle to examine is the guideline that the claims should be interpreted in view of the specification.<sup>118</sup> The court's use of the specification to provide the context within which to interpret the claim language is predictable because courts have held that claims should be interpreted in the context of the specification.<sup>119</sup> The extent to which the court relies on the specification, however, raises the issue of when the use of the specification exceeds what is necessary to merely provide context.<sup>120</sup> In using the

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108. See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979-80 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996) (maintaining that only the claims, and not the specification, delimit a patentee's right).

109. Compare *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202-04 (Fed. Cir. 2002) (holding that there is a heavy presumption that claim terms have their ordinary meaning based on a dictionary definition, unless this presumption is overcome by intrinsic evidence), with *Phillips*, 415 F.3d at 1314 (instructing that a court should look to sources available to the public, including the specification, to determine the ordinary meaning of a claim term).

110. Cf. *Retractable Techs.*, 653 F.3d at 1311-13 (Rader, J., dissenting) (contending that the ordinary meaning should be used unless there is a clear reason not to).

111. *Id.* at 1304 (majority opinion).

112. See *Retractable Techs.*, 653 F.3d at 1305, 1311-13 (reading the claim language in view of the specification to find that "body" is limited to a one-piece structure in the majority opinion, while the dissent argues that the ordinary meaning of "body" should have been used because neither the claim language nor the specification demonstrate an intent to limit the term). See generally *Texas Digital*, 308 F.3d at 1202 (averring that unless compelled otherwise, a court will give a term its ordinary meaning).

113. Compare *Texas Digital*, 308 F.3d at 1202-04 (giving the ordinary meaning of a claim term, as defined by dictionaries, primary importance, even considering it above the specification), with *Phillips*, 415 F.3d at 1314-15 (determining the ordinary meaning based on sources available to the public, including the specification, and giving the specification a primary role in claim construction).

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114. See Menell, *supra* note 42, at 744-45 (characterizing *Phillips* as shifting towards dropping the presumption in favor of the ordinary meaning of a claim term, while acknowledging that *Phillips* did not "expressly disavow" this presumption); see generally *Texas Digital*, 308 F.3d at 1202-04 (considering the ordinary meaning as determined as dictionaries as being above the specification).

115. See *Retractable Techs.*, 653 F.3d at 1311-13 (arguing that the court improperly limited the claim language based on the specification).

116. See Menell, *supra* note 42, at 744-45 (examining how *Phillips* did not "expressly disavow" the presumption in favor of the ordinary meaning of a claim term).

117. See Cotropia, *supra* note 97, at 100 (suggesting that when the court selects a methodology and publicly identifies it, a degree of certainty is achieved).

118. See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979, 990 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996) (instructing that claim language must not be examined in a vacuum, but by reference to the specification).

119. See, e.g., Yonker, *supra* note 3, at 304-05 (mentioning that the meaning of a claim term must be considered in the context of the intrinsic evidence, including the specification).

120. See *Retractable Techs.*, 653 F.3d at 1312-13 (Rader, J., dissenting) (contending that the court is

specification to interpret the claims, the court essentially argued that in order for the term “body” to be interpreted in a manner consistent with its usage in the specification, the term should be limited to a one-piece body because it was not used to refer to anything other than a one-piece body in the specification.<sup>121</sup> The court justified the use of this interpretation by saying that the usage of the term in the specification essentially dictated that the term be interpreted this way in the claim.<sup>122</sup> This is in contrast to other applications of this guideline, where the courts have only relied on a term’s usage in the specification to define the term in situations where the patentee has provided a special definition in the specification,<sup>123</sup> when there is a clear disavowal or disclaimer of claim scope in the specification,<sup>124</sup> or when the ordinary meaning of the claim term makes the scope of the claim unclear.<sup>125</sup> Judge Rader also argued against this approach in his dissent, stating that the court was improperly importing limitations from the specification because none of these exceptions were met.<sup>126</sup> By relying on the way the specification distinguished the invention from the prior art by criticizing the prior art’s failure to recognize that retractable syringes can have a one-piece outer body, the court embraced the more liberal view of how the specification

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improperly importing limitations from the specification).

121. *Id.* at 1305.

122. *Id.*

123. See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979-80 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370 (1996) (expressing that the specification may serve as a dictionary for the claims, if it clearly defines any special definitions); *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (mentioning that a patentee may “imbue[] the claim terms with a particular meaning” in the specification, and rejecting the argument that language describing preferred aspects or embodiments of the invention can serve to provide a lexicographic definition).

124. See *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1204 (Fed. Cir. 2002) (holding that the specification can rebut a presumption in favor of the ordinary meaning of a claim term when an inventor disavows or disclaims claim scope).

125. See *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002) (noting that the specification may limit the scope of the claims where the ordinary meaning of a term is so unclear that the scope of the claim cannot be understood from the meaning of the words alone).

126. *Retractable Techs.*, 653 F.3d at 1311-12 (Rader, J., dissenting).

may be used.<sup>127</sup> The dissent also argued that this reliance on the way the inventor distinguishes the invention from the prior art is improper because the specification mentions numerous objectives, and the claims should not be limited to achieving just one of them.<sup>128</sup> The court’s approach leaves open the question of what, exactly, are the limits that are still applicable to the use of the specification.<sup>129</sup>

The fact that the court relied on the specification to limit the claim term gives rise to the issue of whether the court improperly imported limitations from the specification into the claims.<sup>130</sup> As described previously, in limiting the term “body” to a one-piece body, the court does not show that the inventor provided a special definition of the term, that the specification expressly excludes a body that is more than one piece, or that the ordinary meaning of the term “body” made the claim unclear.<sup>131</sup> Interpreting “body” as including any type of body, regardless of the number of pieces,

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127. See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313-14, 1316 (Fed. Cir. 2005) (describing how ultimately, the correct interpretation of a claim term will reflect what the inventors actually invented, and this is determined by the context provided by the specification).

128. See *Retractable Techs.*, 653 F.3d at 1312-13 (Rader, J., dissenting) (arguing that a claim does not have to be construed as achieving every objective mentioned in the specification).

129. See *Phillips*, 415 F.3d at 1316 (ruling that claims should be construed in line with the specification’s description of what the invention will be, thus leaving the door open for uses of the specification other than those explicitly mentioned, without enumerating any clear limits on the use of the specification); see also Menell, *supra* note 42, at 750-51 (giving examples of the applications of some situations from *Phillips*, and referring to *Phillips*’ instruction to construe claims according to what the inventors actually invented).

130. See *Phillips*, 415 F.3d at 1312 (quoting *McCarty v. Lehigh Val. R. Co.*, 160 U.S. 110, 116 (1895)) (conveying essentially that if elements not mentioned in a claim are allowed to be read into it, this would open the door for any number of limitations to be read into the claim).

131. See, e.g., *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979-80 (Fed. Cir. 1995) (noting that the specification may serve as a dictionary for the claims), *aff’d*, 517 U.S. 370 (1996); *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1204 (Fed. Cir. 2002) (conveying the effect of a disavowal or disclaimer of claim scope); *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002) (finding that where the ordinary meaning makes the claim scope unclear, the specification may limit the scope).

would make the claim broad, but not unclear.<sup>132</sup> The court's main reason for finding the term "body" to include only one-piece bodies is that the embodiments of the invention described in the specification use the term in this way.<sup>133</sup> Thus, it appears that the court diverted from opinions that held it improper to limit the claim language based on the specification's description of particular embodiments of the invention.<sup>134</sup> Without clear guidelines articulated by the court for how to deal with situations such as this, the use of the specification in claim construction will remain unpredictable.<sup>135</sup>

The comparison of the court's approach with the guidelines previously laid out demonstrates that the court relied heavily on the specification to guide its claim interpretation.<sup>136</sup> This case raises the question of whether interpreting the claims in view of the specification requires restricting the specification's role or allows a more liberal reliance on the specification. On one hand, claim terms may be interpreted in view of the specification while limiting the effect of the specification on the meaning of the terms to certain enumerated circumstances, such that the use of the specification in other circumstances constitutes improperly limiting the claims based on the specification. On the other hand, interpreting claims in view of the

specification could allow for any use of the specification except in certain enumerated situations that would constitute importing limitations into the claims improperly.<sup>137</sup> It appears that the latter approach would be more consistent with *Phillips'* guidance that claims should be interpreted consistent with a "full understanding of what the inventors actually invented."<sup>138</sup> If this is the case, then clearly articulated exceptions are needed to determine when reliance on the specification constitutes improperly importing limitations from the specification.<sup>139</sup> In other cases, such as those analyzed below, the court chooses to take a different approach and limits the use of the specification to certain specific circumstances, thus relying more heavily on the claim language itself when interpreting the claims.<sup>140</sup>

#### B. Predictability of *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.* Based on the Guidelines

The court's use of the specification in this

132. See, e.g., *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (observing that patentees should be able to claim more broadly than their disclosed embodiment).

133. See *Retractable Techs.*, 653 F.3d at 1305 (explaining why the specification makes clear that the invention the inventor actually invented consists of a one piece body).

134. See *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (characterizing language in the patentee's specification as describing a preferred aspect, preferred embodiment, or as describing an earlier technology, and holding that such language does not constitute a lexicographic definition).

135. See Rob Harmer, *Construing Patent Claims In Light Of The Specification Versus Importing Claim Limitations From The Specification: Is There Any Difference?*, 4 AKRON INTELL. PROP. J. 119, 146 (2010) (saying that predictability and clear guidelines provide a greater incentive to invent).

136. See *Wagner & Petherbridge*, *supra* note 1, at 1133-34 (describing the "holistic" methodology); see also *Wagner & Petherbridge* 2012, *supra* note 92 (describing the "holistic" approach which includes interpreting the claims using the specification, among other sources).

137. See, e.g., *Retractable Techs.*, 653 F.3d at 1305, 1312-13 (Fed. Cir. 2011) (Rader, J., dissenting) (using the specification to limit the term "body" to a one-piece structure in the majority opinion, while the dissenting opinion argues that this is an inappropriate use of the specification to import limitations into the claims).

138. See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (quoting *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998)) ("[T]he interpretation to be given a term can only be determined . . . with a full understanding of what the inventors actually invented and intended to envelop with the claim."); see also *Menell*, *supra* note 42, at 744 (evincing that the standard for deviating from the ordinary meaning of a claim term based on intrinsic evidence such as the specification is lower since *Phillips*, and that the evidence relied on to depart from the ordinary meaning must only "persuasively demonstrate" what the inventors actually invented).

139. See, e.g., *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1117 (Fed. Cir. 2004) (quoting *White v. Dunbar*, 119 U.S. 47, 51-52 (1886)) (cautioning against using the specification to change the meaning of the claim, rather than using it to understand the meaning of the claim).

140. See *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1254-56 (Fed. Cir. 2011) (refusing to interpret the claims as including a "split" limitation); *Johnson Worldwide Assocs., Inc. v. Zebco Corp.* 175 F.3d 985, 991-94 (Fed. Cir. 1999) (declining to modify the claim terms "coupled" and "heading" based on the specification).



case was predictable with respect to the guideline that the claim language defines the claim scope, but was less predictable with respect to the use of the ordinary meaning and the interpretation of the claims in view of the specification.<sup>141</sup> The first guideline to consider when analyzing this case is to what extent the court relied on the claims to define the patent right.<sup>142</sup> Because the current guidelines require that only the claim delimit the patent right, it is not surprising that that the court did not limit the scope of the claims beyond what their language suggests.<sup>143</sup> The opinion thus strictly adhered to the rule that the claims should define the scope of the patent right by refusing to read the “split” limitation into the claims based only on the drawings and an embodiment in the specifications.<sup>144</sup> Additionally, in applying the guideline regarding the ordinary meaning of the claim terms, the court used an approach similar to a heavy presumption that claim terms should have their ordinary and customary meaning.<sup>145</sup> The court began its claim construction by determining, based on the district court’s finding, that the ordinary meaning of “spring metal adapter” was an adapter made of spring metal, which would not necessarily have to be split.<sup>146</sup> This raised an issue similar to that discussed with respect to *Retractable Technologies, Inc.*, regarding the relationship of the specification and the ordinary meaning.<sup>147</sup> If there is no longer necessarily

a heavy presumption in favor of the ordinary meaning as defined by dictionaries after *Phillips*, when is it proper to determine the ordinary meaning before consulting the specification, and when should the meaning of the claim term be determined based on the specification from the outset?<sup>148</sup>

Next, the degree to which the court considered the claim in view of the specification must be considered.<sup>149</sup> The court used the specification for context in two ways. First, the court looked to a line in U.S. Patent No. 5,266,050 to support the interpretation that the term “spring metal adapter” meant an adapter made from spring metal or steel.<sup>150</sup> Second, to determine whether there was an implicit definition in the specification, the court looked for language that expressed a clear intent by the inventor to limit the invention to one with a “split” limitation, and found none.<sup>151</sup> Although all the drawings and one of the embodiments include such a feature, the court decided that the specification did not show a clear intent to limit the invention to one with a split.<sup>152</sup> The court’s justification for considering the drawings and the embodiment in the specification as not affecting the definition of the term, rather than providing context within which the claims should be interpreted, was that patent coverage should not be limited to the embodiments disclosed in the specification and the drawings, unless the patentee clearly states otherwise.<sup>153</sup>

141. *Compare Phillips*, 415 F.3d at 1313-14, 1316 (observing that a claim term should be interpreted to reflect what the inventors actually invented, as determined by the context provided by the specification), *with Arlington Indus.*, 632 F.3d at 1254 (refusing to find that the claims include a “split” limitation despite the presence of such a feature in the specification).

142. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (“The written description part of the specification itself does not delimit the right to exclude. That is the . . . purpose of claims.”), *aff’d*, 517 U.S. 370 (1996).

143. *See Markman*, 52 F.3d at 980 (maintaining that the claims define inventors’ rights).

144. *Arlington Indus.*, 632 F.3d at 1254.

145. *See Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002) (“The terms used in the claims bear a ‘heavy presumption’ that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.”).

146. *Arlington Indus., Inc.*, 632 F.3d at 1253.

147. *See Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1304 (Fed. Cir. 2011)

(acknowledging the ordinary meaning of “body,” and then looking to the specification to further interpret the term).

148. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1313-14 (Fed. Cir. 2005) (elaborating that in cases that give rise to the litigation, the ordinary meaning is not readily apparent and must be determined in the context of the specification).

149. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979-80, 990 (Fed. Cir. 1995) (citing several cases to show that the claims must be interpreted in view of the whole patent, particularly the specification), *aff’d*, 517 U.S. 370 (1996).

150. *Arlington Indus., Inc.*, 632 F.3d at 1253; U.S. Patent No. 5,266,050 (filed Sept. 11, 1992).

151. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (holding that when words are used in a way that is inconsistent with their ordinary meaning, special definitions must be clearly stated, or terms may be defined by implication).

152. *Arlington Indus.*, 632 F.3d at 1254.

153. *See Wagner & Petherbridge* 2012, *supra* note 92, at 1133 (defining the “procedural approach” in which the court looks for clear reasons for abandoning the ordinary



Additionally, the court found that the language of the specification in U.S. Patent No. 6,521,831 did not indicate that the inventor intended to provide a lexicographic definition of the phrase that would require it to be split.<sup>154</sup> Accordingly, the court refused to limit the feature to one with a split.<sup>155</sup>

Although this avoids importing limitations from the specification, it raises the issue of how to use the specification to come to a claim construction that aligns with the inventor's intent.<sup>156</sup> If the presence of a split in the description of one and in the drawings of all of the embodiments does not convey an intention by the inventor that the invention should have a split, then what would?<sup>157</sup> The dissent points to these facts and argues that they suggest the inventor contemplated that their invention would have split adaptors.<sup>158</sup> This demonstrates that although the court has stated, in cases such as *Phillips*, that the claims should be interpreted to align with the inventor's intent,<sup>159</sup> there are no clear guidelines for what sort of disclosure would be considered as manifesting an intent by the inventor that the invention include a certain feature, short of an explicit definition or disclaimer.<sup>160</sup> The court's approach led to its refusal to allow the specification to limit the claim language.<sup>161</sup> Thus, the issue of whether

the court improperly imported limitations from the specification into the claims need not be considered because the court did not import any limitations into the claims at all.<sup>162</sup> As discussed above, though, this may have been at the expense of disregarding the context provided by the specification.<sup>163</sup>

Contrary to the court in *Retractable Technologies*, this court resolved the tension between interpreting the claims in view of the specification and avoiding importing limitations into the claims in favor of avoiding limiting the claims based on the specification.<sup>164</sup> In so doing, it left open issues such as what the proper relationship between the ordinary meaning of a term and the specification is, and when a disclosure in the specification would convey an intention by the inventor to include a feature.<sup>165</sup> Guidelines that clarify this issue would also help clarify the issue of how to interpret the claims in view of the specification without improperly limiting the claims, as discussed in the analysis of *Retractable Technologies*. If it is clear when the specification conveys an intent by the inventor that the invention be limited by a particular feature and when it does not, then this would provide at least one situation in which it would be clear how much to rely on the specification.<sup>166</sup>

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meaning of the claim terms and using features from the specification).

154. See *Markman*, 52 F.3d at 980 (acknowledging that the caveat to allowing a patentee to be his own lexicographer is that special definitions must be clearly defined in the specification); U.S. Patent No. 6,521,831 (filed Aug. 29, 2001).

155. *Arlington Indus.*, 632 F.3d at 1256.

156. See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313-14, 1316, 1321 (Fed. Cir. 2005) (remarking that the claims can cover only the invented subject matter).

157. See *id.* at 1323 (observing that although the claims should not necessarily be confined to the embodiments described in the specification, the language in the specification will often make it clear whether the inventor intended the invention to be limited to the described embodiments, or whether it encompasses alternative embodiments as well); Menell, *supra* note 42, at 748-49 (detailing how the number and range of embodiments affects claim construction).

158. *Arlington Indus.*, 632 F.3d at 1258 (Lourie, J., dissenting).

159. *Phillips*, 415 F.3d at 1316.

160. See, e.g., *id.* at 1316 (recognizing that a specification may reveal a special definition of a claim term or a disavowal of claim scope).

161. *Arlington Indus.*, 632 F.3d at 1256.

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162. *Phillips*, 415 F.3d at 1312; *Autogiro Co. of Am. v. U.S.*, 384 F.2d 391, 398 (Ct. Cl. 1967).

163. See *Phillips*, 415 F.3d at 1313-14, 1316, 1321 (stating that claim interpretation should reflect what the inventors actually invented).

164. See *Wagner & Petherbridge*, *supra* note 1, at 1133-34 (explaining the difference between the "procedural" and "holistic" approaches to claim interpretation); see also *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1304-05 (Fed. Cir. 2011); *Wagner & Petherbridge 2012*, *supra* note 92 (describing the "procedural" and "holistic" approaches further).

165. See *Phillips*, 415 F.3d at 1313-14, 1316, 1321 (summarizing the ordinary meaning and requiring that the interpretation of a claim term reflect the inventor's actual invention without providing explicit guidelines for determining a patentee's intention, other than recognizing special definitions and disavowals of claim scope in the specification).

166. See *id.* at 1316 (leaving the door open for varied use of the specification without mentioning limitations on the use of the specification); *Retractable Techs.*, 653 F.3d at 1304-05 (Fed. Cir. 2011).

C. Predictability of *Johnson Worldwide Associates, Inc. v. Zebco Corp.* Based on the Guidelines

Although *Johnson* was decided before *Phillips*, the similarity of the court's approach with that taken in *Arlington Indus., Inc.* demonstrates that *Phillips* did not sufficiently clarify the extent of the specification's role in claim construction.<sup>167</sup> Like the opinion in *Arlington Indus., Inc.*, the *Johnson* court also adheres strictly to the rule that claims should define the scope of the patent right in its finding that the terms "heading" and "coupled" are not limited by the specification.<sup>168</sup> In analyzing this opinion in relation to the guidelines, the first guideline to consider is whether the court began by assigning the claim terms their ordinary and customary meaning.<sup>169</sup> In *Johnson*, the court acknowledges that the ordinary meaning of "heading" connotes only direction, and that the term "coupled" ordinarily only means that there is a connection, rather than a particular kind of connection.<sup>170</sup> The court does not address the basis for these ordinary and customary meanings, presumably because Zebco accepted these meanings.<sup>171</sup>

The next rule to consider is whether the court interpreted the claims in view of the specification.<sup>172</sup> The court mainly relied on the

specification to determine whether or not the patentee had given any of the terms a special meaning.<sup>173</sup> For both terms, the court refused to find a special meaning in the specification because there was no clear and deliberate definition of these terms in the specification, and a definition could not be inferred from the description of the preferred embodiment.<sup>174</sup> This is consistent with the view that the inventor can provide a special definition, but such a special definition should be clearly stated in the specification and cannot merely be inferred from a preferred embodiment.<sup>175</sup> Regarding "heading," the court also considered the fact that the specification used "heading" to refer to various directions, finding that term had a broad meaning.<sup>176</sup> Therefore, the court considered the context of the term based on the specification, at least to an extent.<sup>177</sup> It is unclear, however, whether a similar amount of context, if it did not support the ordinary meaning, would have been sufficient to convince the court to rely on the specification's usage of the term rather than the ordinary meaning.<sup>178</sup> When interpreting the term "coupled," the court refused to let the specification affect the meaning of the word in the claim.<sup>179</sup> This was despite the fact that the court did not point to any language in the specification to indicate that the term was intended to have any other meaning beyond the types of connections described in the

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167. See *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1256 (Fed. Cir. 2011); Cook, *supra* note 8, at 226 (contending that *Phillips* did not reconcile the different methodologies that the various circuits use).

168. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.* 175 F.3d 985, 992 (Fed. Cir. 1999); see also *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (mentioning the function and purpose of claims), *aff'd*, 517 U.S. 370 (1996). Compare *Arlington Indus.*, 632 F.3d at 1256 (finding that a "split" limitation should not be read into the claimed adapter), with *Johnson* 175 F.3d at 992 (refusing to limit the terms based on the specification).

169. See *Phillips*, 415 F.3d at 1313 (stating that the ordinary meaning serves as a baseline for starting claim interpretation); *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002) (stating that claims are originally presumed to have their ordinary and customary meaning).

170. *Johnson Worldwide*, 175 F.3d at 990, 992.

171. See *id.* (observing that Zebco recognizes the ordinary meaning of "heading" and "coupled").

172. See, e.g., *Markman*, 52 F.3d at 979-80 (giving examples of how the claims should be read in view of the

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specification).

173. *Johnson Worldwide*, 175 F.3d at 990.

174. *Id.* at 991.

175. See *Markman*, 52 F.3d at 979-80 ("For claim construction purposes, the description may act as a sort of dictionary . . ."); *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (refusing to find that language in the specification provided a lexicographic definition because it "suggest[s] a preferred aspect of the invention subject to variability rather than a precise definition").

176. See Menell, *supra* note 42, at 748-49 (discussing the effect of the range of embodiments the specification has on the scope of the claims).

177. See, e.g., *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1116 (Fed. Cir. 2004) (discussing the use of the specification to better understand a term's meaning).

178. See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313-14, 1316 (Fed. Cir. 2005) (maintaining that the correct interpretation of a claim term will reflect what the inventors actually invented).

179. *Johnson Worldwide*, 175 F.3d at 992.

specification.<sup>180</sup> Thus, it appears the court did not rely on context to interpret this term.<sup>181</sup> This was likely due to the fact that the court did not consider the term “coupled,” as used in the claim, to be unclear when given its ordinary meaning.<sup>182</sup> Therefore, the court’s reluctance to limit the claim terms because there is no special definition in the specification, and the claim terms are not unclear, would still be a predictable application of those guidelines after *Phillips*. However, it is unclear if any of the context provided by the specification would be sufficient for the court to consider it as conveying what the inventor has actually invented.<sup>183</sup>

The court’s use of the specification makes the analysis of whether the court improperly introduced limitations into the specification a short one.<sup>184</sup> The court did not allow the specification to affect the ordinary meaning of the claims’ terms, and thus no limitations from the specification were introduced into the claims at all.<sup>185</sup>

This case provides another example of an opinion in which the court placed relatively greater emphasis on not importing limitations from the specification into the claims, rather than interpreting the claims in view of the specification.<sup>186</sup> Having been decided in 1999, the opinion did not address the issue of how to use the specification to find an intention by the inventor that the invention should have a particular feature, although *Arlington Indus., Inc.* also left this issue open even though it

was decided after *Phillips*.<sup>187</sup> This opinion demonstrates that the different approaches to interpreting the claims in view of the specification in cases decided today are the same ones that have existed since before *Phillips*, despite *Phillips*’ attempt to clarify claim construction.<sup>188</sup>

#### IV. COURTS SHOULD CLOSELY ADHERE TO EXISTING GUIDELINES WHEN CONSTRUING CLAIMS, BUT ALSO SPELL OUT NEW RULES WHEN NECESSARY, RATHER THAN RELYING ON A FLEXIBLE APPROACH

Rather than continuing to apply the current rules in a flexible manner, the court should provide specific guidance to address ambiguities or gaps in the existing guidelines and increase predictability.<sup>189</sup> An important purpose of providing guidelines for using the specification to interpret the claims is to allow district courts to achieve correct claim constructions.<sup>190</sup> Additionally, one of the most important functions of claims is that they give the public notice of the scope of the patent protection.<sup>191</sup> The guidelines a court uses to interpret claims affects this function because a claim’s meaning, and thus the scope of the patent right, depends on the way the words in the claim are ultimately interpreted.<sup>192</sup> If these

180. *Id.*

181. *See Innova/Pure Water*, 381 F.3d at 1116 (explaining how the specification provides context for the claims). *But see Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1203-04 (Fed. Cir. 2002) (stating that the specification should only be turned to if it rebuts the presumption of the ordinary meaning, or helps in choosing among multiple dictionary definitions).

182. *See Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002) (mentioning how the specification can also limit the claims if the ordinary meaning of a claim term makes the claim unclear).

183. *See Phillips*, 415 F.3d at 1313-14, 1316 (asserting that a claim term’s meaning is determined within the context of the specification).

184. *See id.* at 1312 (citing cases warning against using the specification to limit the claims).

185. *Johnson Worldwide*, 175 F.3d at 991-92.

186. *See Wagner & Petherbridge*, *supra* note 1, at 1133 (defining the “procedural” approach, which is similar to the methodology used by the court in *Johnson Worldwide*).

187. *See Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1256 (Fed. Cir. 2011); *Phillips*, 415 F.3d at 1313-14, 1316, 1321 (emphasizing the importance of recognizing the inventor’s actual invention, without providing additional explicit guidelines for determining a patentee’s intention).

188. *Compare Johnson Worldwide*, 175 F.3d at 992 (refusing to limit the claims based on the specification), *with Arlington Indus., Inc.*, 632 F.3d at 1256 (using a similar methodology to refuse to limit the claims based on the specification).

189. *See Wagner & Petherbridge*, *supra* note 1, at 1176-77 (discussing the importance of developing consistency in claim construction methodologies); *Cook*, *supra* note 8, at 261-63 (stressing the need for the use of a distinct set of claim construction rules by the Federal Circuit).

190. *See Harmer*, *supra* note 135, at 131 (mentioning that higher courts must ensure that district courts are using the proper claim construction technique); *Yonker*, *supra* note 3, at 302 (expressing the difficulty the Federal Circuit has had in developing a uniform methodology for claim construction).

191. *See Fischer & Jones*, *supra* note 34, at 22.

192. *See Cotropia*, *supra* note 97 (discussing how



guidelines cannot produce predictable results, others will be unable to determine the limits of the right that a particular patent grants the inventor, thus diminishing one of the main purposes of patent claims.<sup>193</sup> Others are expected to rely on those guidelines when construing claims, and thus the court should consistently apply those same guidelines in its own opinions in order for the guidelines to be beneficial.<sup>194</sup> However, as demonstrated above, the current guidelines do not provide sufficient guidance in several circumstances, leaving much of the claim interpretation up to an individual judge's discretion.<sup>195</sup>

Circumstances where the existing guidelines present a grey area should be addressed by new rules. For example, the guidelines should address whether interpreting the claims in view of the specification involves limiting the effect of the specification to only certain enumerated circumstances, or whether the specification may be used except for certain enumerated purposes that would constitute importing limitations into the claims improperly.<sup>196</sup> Although it seems that the approach allowing the use of the specification except for certain enumerated purposes is more in line with *Phillips*, the court should still clearly articulate the types of scenarios in which reliance on the specification would be improper.<sup>197</sup> By clarifying this issue, the court would also address the issue of when such use would constitute relying on the specification, rather than the

claims, to delimit the patent holder's right.<sup>198</sup>

Another area the court should address is how to determine what the inventor's intended invention is based on the specification, and when it is proper to use this intent to limit the claims.<sup>199</sup> Although there are guidelines that require that claims be limited when the inventor expressly gives a term a special definition or disclaims claim scope in the specification, additional guidelines should be provided to determine when the description of the inventor's intended invention should limit claim scope.<sup>200</sup> Because the guidelines for determining the inventor's intent based on the specification and using that intent to determine the claim scope would specify one way in which the claims are interpreted in view of the specification, such guidelines would help in clarifying the first issue as well.<sup>201</sup>

Finally, the role of the ordinary meaning should also be clarified.<sup>202</sup> Although there is not necessarily a heavy presumption in favor of the ordinary meaning as determined by the dictionary definition after *Phillips*, the exact role of the ordinary meaning needs further clarification.<sup>203</sup> It is unclear whether and to what extent the ordinary meaning should still be used as a starting point for the meaning of a claim term before turning to the specification, or whether the use of the term in the specification should be the starting point. Clear guidelines addressing this issue would provide a predictable starting point for claim construction.<sup>204</sup>

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unpredictable claim constructions affect the notice aspect of claims); *see also* Moy, *supra* note 15, § 4:8 (detailing the role of the words in a patent claim under peripheral claiming).

193. *See* Bender, *supra* note 34, at 198 (discussing how predictability is necessary for competitors to ascertain the scope of a patentee's right to exclude).

194. *See* Harmer, *supra* note 135, at 146 (arguing that a predictable patent system with clear guidelines for construing claims would provide inventors with a greater incentive to invent).

195. *See, e.g.*, Bender, *supra* note 34, at 211-12 (characterizing legal rules related to claim construction as confusing and flawed).

196. *See* Harmer, *supra* note 135, at 145 (noting that the Federal Circuit has not provided much guidance regarding when a court may import limitations from the specification); *see also, e.g.*, Wagner & Petherbridge, *supra* note 1, at 1133-34 (explaining the "holistic" & "procedural" methodologies).

197. *See* Menell, *supra* note 42, at 743-52 (describing the increased role of the specification after *Phillips*).

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198. *See* Markman v. Westview Instruments, Inc., 52 F.3d 967, 979-80 (Fed. Cir. 1995) (maintaining that only the claims, and not the specification, delimit a patentee's right), *aff'd*, 517 U.S. 370 (1996).

199. *See* Phillips v. AWH Corp., 415 F.3d 1303, 1313-14, 1316 (Fed. Cir. 2005) (instructing that claim interpretation should reflect what the inventors actually invented).

200. *See, e.g., id.* at 1316 (mentioning situations where the specification should be used to limit the claims).

201. *See id.* (encouraging reliance on the specification without expressly limiting its use).

202. *See id.* at 1314-15 (determining the ordinary meaning based on sources available to the public, including the specification, and giving the specification a primary role in claim construction).

203. *See* Menell, *supra* note 42, at 744-45 (characterizing *Phillips* as shifting towards dropping the presumption in favor of the ordinary meaning of a claim term, while acknowledging that *Phillips* did not "expressly disavow" this presumption).

204. *See* Harmer, *supra* note 135, at 145 (noting



Adopting a clearly articulated methodology specifically addressing the use of the specification would improve the predictability of claim construction in view of *Phillips*' emphasis on the use of the specification as the primary source for interpreting the claims.<sup>205</sup> One problem that may arise as a result of creating additional guidelines, however, is that the large body of rules may become difficult to keep track of and lead to greater complexity and confusion.<sup>206</sup> Articulating more guidelines would also limit the court's flexibility, which many consider important as it gives the court a greater ability to achieve just results based on a particular set of facts.<sup>207</sup> Finally, some would argue that a more formalistic approach would harm innovation and work against the goals of the patent system.<sup>208</sup>

The existing guidelines are already difficult to apply because their limits are not clearly defined.<sup>209</sup> Articulating additional guidelines to allow the public to achieve a correct claim construction outside of court would be more useful and would outweigh any difficulty caused by having more guidelines.<sup>210</sup>

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that the Federal Circuit has not provided much guidance regarding when a court may import limitations from the specification).

205. See Cotropia, *supra* note 97, at 100 (suggesting that when the court selects a methodology and publicly identifies it, a degree of certainty is achieved).

206. See, e.g., John R. Thomas, *Formalism at the Federal Circuit*, 52 AM. U. L. REV. 771, 808 (2003) (pointing out that formalism does not necessarily result in certainty when the court has difficulty maintaining the many rules it has established).

207. See Timothy R. Holbrook, *The Supreme Court's Complicity in Federal Circuit Formalism*, 20 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1 (2003) (taking the position that the bright-line rules the Federal Circuit adopts promote certainty at the expense of fairness). But see Paul R. Michel, *The Challenge Ahead: Increasing Predictability in Federal Circuit Jurisprudence for the New Century*, 43 AM. U. L. REV. 1231, 1234 (1994) (addressing the argument that the benefits of fairness outweigh the costs associated with less predictability in regard to Federal Circuit decisions generally).

208. See Thomas, *supra* note 206, at 796, 799-801 (arguing that because the patent system deals with very dynamic situations, the use of rules would limit the ability to adjust doctrine to fit the realities of new industries to achieve the patent system's policy goals).

209. See Cotropia, *supra* note 97, at 81 (conveying the difficulty in distinguishing between some claim construction canons).

210. See Jeffrey A. Lefstin, *Claim Construction, Appeal, and the Predictability of Interpretive Regimes*, 61

The use of the specification in claim construction needs to be predictable because in addition to the courts, other parties, such as inventors who are drafting patent applications, need to be able to understand the guidelines and use them to construe claims consistently.<sup>211</sup> A fair result for both patentees and competitors is one in which the patentee receives protection for no more than the full scope of his claimed invention, potential competitors have fair notice of that scope, and courts deciding infringement construe the claims to have a similar scope.<sup>212</sup> Although achieving a fair result may require using a different claim construction methodology during litigation than that used during prosecution,<sup>213</sup> once a patent has been granted and is involved in litigation, the guidelines a court uses to construe the claims should be clear. Thus, clear and specific guidelines would achieve fairness by allowing different parties to construe claims consistently.<sup>214</sup> Finally, the predictability that results from better guidelines helps further the goals of the patent system by encouraging both disclosure and innovation. When inventors are certain that a patent will protect the intended scope of their invention, they are both more likely to invest in researching new technologies and to disclose their innovations through patent applications.<sup>215</sup>

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U. MIAMI L. REV. 1033, 1041-42 (2007) (remarking that predictability is most useful to participants in the patent system before litigation).

211. See Michel, *supra* note 207, at 1243 (articulating reasons why both patentees and their competitors need to be able to determine their rights in advance).

212. See Markman v. Westview Instruments, Inc., 52 F.3d 967, 978-79 (Fed. Cir. 1995) (maintaining that it is only fair that the rules of construction result in competitors and courts construing the claims consistently), *aff'd*, 517 U.S. 370 (1996).

213. See Fischer & Jones, *supra* note 34, at 22-24 (arguing for why the Morris approach to claim construction should be used during prosecution, while the Context Approach should be used during litigation.)

214. See Wagner & Petherbridge, *supra* note 1, at 1124 n.80 (articulating the benefits of clear rules in different stages of the patent process).

215. See Michel, *supra* note 207, at 1241-42 (arguing that unpredictability deters both patentees and potential competitors from innovating and disclosing their inventions).

## V. CONCLUSION

Addressing the issues outlined above, as well as other issues that arise as various cases are tried, by providing clear guidelines will help ensure that limitations from the specification will not be improperly read into the claims, while also allowing the meaning of the terms to be determined from the specification in appropriate situations. Although the court may lose some of its flexibility, articulating clear guidelines will increase the degree of predictability in claim construction. Thus, it will enhance the value of the existing guidelines by allowing them to better achieve their purpose of providing guidance to lower courts and parties involved in litigation.

Adopting measures to standardize claim construction and increase the predictability of outcomes would advance the goals of the patent system by promoting innovation. Predictability would decrease the costs of making competing products, and thus encourage competition. This will decrease costs for litigants, as well as lower the high reversal rate for patent cases based on claim construction issues.

Failure to address the lack of predictability, however, would result in increased costs for everyone. It is only natural that as the number of patent filings increases each year, there will be a greater number of patentees seeking to enforce their rights. Without a predictable way to resolve patent disputes, more cases will go to court, leading to greater backlogs and costs. The increase in costs will be detrimental to innovation as it will deter businesses from developing new products. Providing a predictable framework for determining the scope of patent claims based on the specification will help protect the value and strength of the patent system.