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Claim Construction

Stakeholders Question Fed. Cir.'s Emphasis On Patent Specification in Claim Construction

During the week of Feb. 9, the Federal Circuit issued two opinions—*Lexington Luminance v. Amazon.com* and *Fenner v. Cellco*—that clearly went beyond the plain language of patent claims and drew context from the patent specification.

While such reference has been a recourse for probably every member of the court at one point or another in the past, the question is whether the court is now doing it as the default approach, rather than only when a claim term is ambiguous on its face.

Stakeholders's views differed substantially, with the issue at hand—indefiniteness, infringement or patent eligibility—making a difference.

'Claim Is the Name of the Game' or Is It? In a series of e-mail exchanges, Bloomberg BNA asked stakeholders to comment on “the increasing relevance of the specification and prosecution history as intrinsic evidence of the meaning of claim terms, and a move away from a focus on the plain language of the claims.”

The Federal Circuit last addressed en banc how to construe claims in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 U.S.P.Q.2d 1321 (Fed. Cir. 2005) (en banc). But there is little debate that *Phillips* left some room for subjective judgment.

Disagreement on the extent to which the court should turn to the specification for clarification in claim construction peaked in 2011 with denial of en banc consideration of the question. The panel in that case paraphrased *Phillips* with different emphases.

Judge Alan D. Lourie's majority opinion said, “In reviewing the intrinsic record to construe the claims, we 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 di-

vorced from what the specification conveys is the invention.”

In dissent, then-Chief Judge Randall R. Rader said that it is “a bedrock principle of patent law that the claims themselves, not the written description portion of the specification, define the patented invention.” Rader's statement paraphrases one attributed to former Chief Judge Giles S. Rich—“The claim is the name of the game”—that now, seems to be under attack.

Reading Specification to Determine Meaning, Yes. “Judge Rich's views were always focused on the claims, which is always the most important and only starting point,” Neil A. Smith of Rimon P.C., San Francisco, said. “But he always recognized the limitations of the English language, particularly with words available at the time of the filing of the patent application, and the need to discern the meaning.”

“I think that there's a very slight difference in emphasis and that very slight difference in emphasis can yield different results in very close cases,” said Charles L. “Chico” Gholz of Oblon, McClelland, Maier & Neustadt LLP, Alexandria, Va.

“Judge Rich had to interpret claim language too, and he certainly did that with an eye to the entire specifications and how he believed that the people actually practicing in the area of technology under consideration in any given case used the language in question,” he said. “However, it does seem to me that Judge Lourie in the past (and Judge Newman in the surprising quotation [in *Fenner Invs., Ltd. v. Cellco P'ship*]) is a bit more loosey-goosey” (referring to: “Any explanation, elaboration, or qualification presented by the inventor during patent examination is relevant, for the role of claim construction is to ‘capture the scope of the actual invention’ that is disclosed, described, and patented.”).

“But only a bit,” he said, ultimately.

But Invention Scope Different Question? “Despite the Federal Circuit's en banc decision in *Phillips* concerning the proper evidentiary hierarchy for patent claim interpretation (as well as the Supreme Court's recent

guidance in *Teva* on standards of review), I believe that a schism exists within the Federal Circuit over fundamental approaches to the task,” according to Janice M. Mueller, patent attorney and cofounder of the Chisum Patent Academy.

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And while Smith and Gholz’s comments addressed consulting the specification to determine only the skill in the art at the time, Mueller, author of the treatise *Mueller on Patent Law*, saw the Federal Circuit going considerably further.

“Few would dispute that the specification is the single most important and informative piece of evidence for discerning the meaning of words in patent claims (we can argue whether the prosecution history is equally helpful),” she said. “But some judges of the Federal Circuit are using the specification to divine, in their view, ‘what the inventor actually invented,’ and limit the claim scope to that and nothing more.”

Mueller continued, “In my opinion, this approach is better aligned with the validity question of whether the written description of the invention requirement has been satisfied: What was the inventor in possession of as of the filing date, and is she now overreaching in asking for more? That’s a very important but different question from claim interpretation.”

“It’s true that Judge Rich (and others) often said that ‘the name of the game is the claim,’ ” the chief judge’s former clerk said. “But Judge Rich also disliked the expression that ‘the claims define the invention.’ The claims define the scope of the patent owner’s right to exclude others. The scope of that exclusionary right may in some cases wind up being a far cry from what the inventor actually invented.”

Mueller summed up the difference.

“The public notice function of patents cannot be ignored. We should seek to find the meaning that persons of ordinary skill who read the claims in the context of the entire patent would assign to the words of the claims,” she said. “This may or may not be precisely equivalent to the inventor’s actual contribution.”

Schism on the Court. “As I see it, the Federal Circuit’s long-standing rule that claims in an issued patent are to be construed, but not amended, is taken seriously by some judges on the Court and followed, but is given a back-of-the-hand treatment by other judges on the Court,” according to John F. Witherspoon of Washington, putting more emphasis on the “schism” that Mueller identified.

“The latter are inclined to follow the practice in vogue in the PTO back before Judge Rich got on the Court, which entails gleaning from the specification the reader’s own idea of what the invention is,” Witherspoon, a professor and director emeritus of the intellec-

tual property program at George Mason Law School, said.

Opposite Premise as to Patent Eligibility? “Unfortunately, in its recent Section 101 rulings, the Supreme Court has been doing exactly what the second group of judges is doing and is thereby giving support to that approach,” Witherspoon continued. “So we are now witnessing a different kind of claim ambiguity—one arising from lack of certainty in the law. A claim is what a reader of the specification says that it is.”

Robert R. Sachs of Fenwick & West LLP, San Francisco, was as disappointed as Witherspoon, but had a different argument, at least as far as the Federal Circuit was concerned.

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—ROBERT R. SACHS, FENWICK & WEST, RE SECTION 101 ANALYSIS

“The premise [of greater reliance on the specification] is wrong—at least as far as Section 101 is concerned—and could very well be exactly the opposite,” he said. And, he added, “I do not think that Rader and Lourie were saying different things.”

“Indeed, as far as 101 was concerned, Rader seemed to take the position that it was about eligible ‘subject matter,’ not claims per se.”

“What’s happening now is clearly divorced from claim language and its meaning in view of the specification,” he said, referring to recent patent ineligibility decisions by the appeals court.

In *Ultramercial* and *Planet Bingo or Content Extraction*, “the court really doesn’t care what the specification says—except to the extent that it says you can use a general purpose computer to implement the invention,” he said.

“Lourie has said that the details and complexity of the invention are beside the point—precisely because anything you do on a general purpose computer is pretty much beside the point,” Sachs said, quoting from *Ultramercial*: “Any transformation from the use of computers or the transfer of content between computers is merely what computers do and does not change the analysis.”

Sachs was the patent owner’s counsel in another case where the court held an “expert system” implemented on a computer to be patent ineligible. “In *SmartGene*, all the court saw was that there was a computer that did medical related analysis—merely what ‘a doctor could do,’ ” he said. “They did not care to look at the specification for any sense of interpreting the claim language.”

BY TONY DUTRA

Gholz, Smith and Witherspoon are members of this journal’s advisory board and all were once law clerks to Judge Rich.