
Don't Throw Out the Dictionaries: The Aftermath of Phillips v. AWH Corp.

By Bradley C. Wright

Bay has been doing a brisk business selling old technical dictionaries and treatises concerning once-obscure technical subjects. Patent law firms have recently been amassing collections of dictionaries. Why? Two words: Texas Digital. In *Texas Digital Systems Inc. v. Telegenix, Inc.*,¹ the US Court of Appeals for the Federal Circuit stated that “dictionaries, encyclopedias and treatises are particularly useful resources to assist the court in determining the ordinary and customary meaning of [patent] claim terms” and that dictionaries are “objective resources that serve as reliable sources of information on the established meanings that would have been attributed to the terms of the claims by those of skill in the art.” The Texas Digital court also ruled that “the presumption in favor of a dictionary definition” could be overcome only in certain limited circumstances, such as when the inventor had expressly defined a term in the patent or if the inventor had clearly disavowed or disclaimed certain meanings. In short, dictionaries were elevated to paramount importance in determining the scope of a patent. That tilt toward dictionary definitions was evidently intended to promote certainty in patent interpretation and to mitigate the somewhat subjective exercise of interpreting patent claims based on the patent specification, that is, the descriptive part of every patent document.

Since Texas Digital, district courts have been inundated with competing dictionary definitions for terms used in patent claims. Because the meaning of terms must be determined as of the filing date of the patent at issue, older dictionaries published at the time that the patents were filed have recently become the mother lode of patentspeak, thus leading to hoarding of older dictionaries.

The Federal Circuit has continued to encourage reliance on dictionaries. In one case, the Federal Circuit endorsed a chain-reaction parsing of dictionary definitions to arrive at the correct definition of a single word—“hydrosol”—over a vigorous dissent in which Judge Clevenger argued that “the majority has simply

overworked the dictionaries to a point of error.”² Other recent Federal Circuit opinions have illustrated the difficulty of applying dictionaries when competing definitions of words were available.³

Unfortunately, the Federal Circuit’s recent attempts at improving certainty in patent law – including Texas Digital -- have utterly failed. Reversal rates on appeals in patent cases involving claim interpretation have remained high, thus inviting appeals in virtually every patent case. The increased reliance on dictionaries has merely moved the battlefield to a different arena. District courts have been no more able to discern with certainty the correct meaning of a term used in a patent claim than they were prior to the “dictionary era.”

The Meaning of “Baffle”

In February 2005, the Federal Circuit reheard en banc a claim interpretation appeal that was intended to resolve some of the many problems stemming from the use of dictionaries. On July 12, it released its long-awaited decision in *Phillips v. AWH Corp.*⁴ Although the Federal Circuit clarified how litigants and district courts should interpret patents, the Phillips decision is likely to leave courts with some confusion and to leave companies with some uncertainty concerning the scope of their patents.

The dispute in Phillips arose over how to interpret the word “baffle” in a patent covering modular panels that are welded together to form vandalism-resistant walls. In its original decision, a three-judge appellate panel had ruled that the patent did not cover a structure unless it included baffles that were configured at certain angles, such that they would deflect bullets. The ruling was based on the fact that the patent described bullet deflection as one of the advantages of the invention, even though those advantages were not required by the claims of the patent. This narrow interpretation allowed the defendant to escape infringement, since its baffles were not configured at the angle that supposedly would deflect bullets.

The case attracted widespread attention in the patent community because the dispute highlighted difficulties faced by lower courts in interpreting the scope of patents. Recent court decisions, including Texas Digital,

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had suggested that courts should rely primarily on dictionaries to determine the meaning of words like “baffle,” whereas earlier decisions had focused on the descriptive parts of the patent to interpret the scope of such words. Recent Federal Circuit decisions went so far as to suggest that a patent owner could rely on any of the definitions in a dictionary to determine the breadth of a patent. In some cases, this could lead to a much broader patent scope, beyond what the inventor had intended at the time the patent was filed.

Following the full 12-judge court rehearing of the original appeal in February, the July 12 ruling overturned the prior panel decision. Nine of the 12 judges ruled that patents should not be interpreted based primarily on dictionaries; instead, they should be interpreted based primarily on the descriptive parts of the patent. The ruling essentially rolled back recent court decisions encouraging reliance on dictionary meanings.

Judge Bryson, writing for the majority, stated that the recent line of cases encouraging reliance on dictionaries “improperly restricts the role of the [patent] specification in claim construction.” He criticized focusing on the “abstract meaning of words rather than on the meaning of claim terms within the context of the patent.” According to Judge Bryson:

The use of a dictionary definition can conflict with that directive [to consider the context of the patent] because the patent applicant did not create the dictionary to describe the invention. Thus, there may be a disconnect between the patentee’s responsibility to describe and claim his invention, and the dictionary editors’ objective of aggregating all possible definitions for particular words.

Furthermore, according to the majority opinion, “a [patent claim] should not rise or fall based upon the preferences of a particular dictionary editor, or the court’s independent decision . . . to rely on one dictionary than another.” Despite these warnings, the full court stated that “judges are free to consult dictionaries and technical treatises” in order to understand the technology or to interpret a patent “so long as the dictionary definition does [not] contradict any definition found in or ascertained by a reading of the patent documents.”

The full court concluded that nothing in the Phillips patent description limited the patent claims to baffles that were formed at a bullet-deflecting angle. Although the patent mentioned several advantages that could be obtained with the invention, including the bullet-deflecting properties of the baffles, those advantages were

not affirmatively identified in the broadest patent claims. Therefore, the full court concluded that the lower court had erroneously limited the patent to incorporating one or more of those described advantages.

Despite the apparent clarification in the law, the full court conceded that interpreting a patent based on its descriptive part “can be difficult to apply in practice.” Reasonable minds can still differ as to whether a patent merely describes potential advantages or whether it is limited to products that include those advantages. Indeed, in this case, two of the 12 judges dissented on the basis that the earlier ruling, which was based on the patent specification, was correct. Judge Mayer also dissented for a different reason, arguing that “we say nothing new . . . we will decide cases according to whatever mode or method results in the outcome we desire, or at least allows us a seemingly plausible way out of the case.”

Judge Bryson’s majority opinion explained that courts must look at the ordinary meaning of claim terms in the context of the written description and prosecution history of the patent. In some cases, the ordinary meaning may be readily apparent even to lay judges, and claim interpretation in such cases involves little more than the application of the widely accepted meaning of commonly understood words. In such cases, according to Judge Bryson, “general purpose dictionaries may be helpful.” In other cases, determining the ordinary meaning may require examination of a particular meaning of a word in a technical field, and the court should look to “those sources available to the public that show what a person of skill in the art would have understood disputed claim language to mean,” including the claim language itself; the patent specification; the prosecution history of the patent; and extrinsic evidence, including dictionaries and expert testimony. However, Judge Bryson warned that extrinsic evidence was likely to be less reliable than the other sources of claim interpretation, and that extrinsic evidence including dictionaries should not be used to limit reliance on the patent specification as the court had earlier suggested in *Texas Digital*. In short, *Texas Digital* was abrogated, and claim interpretation was rolled back to its pre-dictionary era.

The full court also explained that patent claims should not generally be interpreted in such a way that their validity is preserved, despite some court rulings to the contrary. According to Judge Bryson, “while we have acknowledged the maxim that claims should be construed to preserve their validity, we have not applied that principle broadly, and we have certainly not endorsed a regime in which validity analysis is a regular component of claim construction.” Because such rul-

ings were rare, the effect of that aspect of the decision will likely be minimal.

No Deference on Claim Interpretation

One of the many questions presented for review in Phillips was whether the Federal Circuit, which hears all patent appeals in the United States, should give any deference to a lower court's interpretation of the claims of a patent. Writing on behalf of the majority, Judge Bryson demurred on that question, stating that "we have decided not to address that issue at this time." That response effectively left intact the court's prior en banc ruling in *Cybor Corp. v. FAS Technologies, Inc.*,⁵ in which the court held that claim interpretation is a purely legal question subject to de novo review.

Judge Mayer, joined by Judge Newman, filed a stinging dissenting opinion to the Phillips majority in which he strongly criticized the role of the court in treating patent interpretation as a purely legal matter, devoid of any factual evaluation. After complaining that the Federal Circuit was "whipping the [patent] bar into a frenzy of expectation," Judge Mayer characterized the majority's opinion as merely "rearranging the deck chairs on the Titanic." According to Judge Mayer, a lower court's interpretation should be reviewed on appeal with some deference by the appellate court, rather than starting over at the appellate level. Judge Mayer argued that, although claim interpretation was a matter reserved for the court, rather than the jury, certain factual underpinnings in claim interpretation, such as the skill of a person of ordinary skill in the art and the state of the art at the time of the invention, should be given deference on appeal. Indeed, a majority of amici curiae briefs in Phillips had urged adherence to the deference standard set forth in Rule 52(a) of the Federal rules of Civil Procedure. Absent the grant of certiorari by the Supreme Court in Phillips, that question must await another day.⁶

Don't Throw Out the Dictionaries

The Phillips court did not eliminate the ability of district courts to refer to dictionaries to determine the correct meaning of terms used in patent claims. Indeed, the court made clear that "general purpose dictionaries may be helpful" to interpret the ordinary meaning of claim language in some cases and that in other cases "it is permissible for the district court in its sound discretion to admit and use such evidence [including dictionaries]" as long as it keeps in mind the flaws inherent in each type of evidence and assesses that evidence accordingly. In other words, although the importance of dictionaries in the claim interpretation process has been reduced, they are still admissible and may be consulted

to help determine the ordinary meaning of claim terms, as long as they are not used to contradict claim meaning that is unambiguous in light of the intrinsic evidence.

The Phillips en banc court also endorsed prior case law holding that a patent specification may define a term "by implication," even if it does not expressly define the term, as reflected in prior cases such as *Bell Atlantic Network Services, Inc. v. Covad Communications Group Inc.*⁷ Although at oral argument the judges questioned the circumstances under which a term would be defined "by implication," that question was left unresolved by the Phillips opinion.

One difficulty that is likely to remain for district judges and litigants alike with the "implication" line of cases is that different judges can arrive at completely opposite conclusions regarding whether a patent specification limits a particular patent claim term in a certain way. Indeed, in Phillips, two of the 12 active Federal Circuit judges would have arrived at a different result after applying the same legal framework announced by the majority opinion. Judges Lourie and Newman filed an opinion concurring in part and dissenting in part, arguing that the Phillips patent specification required that the claimed "baffles" be angled such that they could deflect bullets, an "implication" from the specification that should have limited the claims. If different Federal Circuit judges can read the same Phillips specification in different ways and arrive at different results, it is likely that district court judges will be similarly challenged to discern the proper meaning of a claim term based on the "implications" of the specification.

Where does this leave patent litigants and district courts? First, don't throw out the dictionaries. They are still endorsed by the Federal Circuit as a potential source of definitions for terminology used in patents. Second, re-tool Markman briefs and hearings to reduce the primacy of dictionaries in the claim construction portion of a patent case and focus instead on the patent specification, especially if there is an argument that a term has been defined by the inventor in the specification "by implication." Look for new ground to be plowed in this fertile field of the law. And finally, downplay reference to rigid methodologies in claim construction, which the Phillips court dismissed as an unattainable "magic formula."

Notes

1. *Texas Digital Systems Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002).
2. *Novartis Pharm. Corp. v. Eon Labs Mfg., Inc.*, 363 F.3d 1306, 1316 (Fed. Cir. 2004).
3. *See, e.g., Nystrom v. Trex Co.*, 374 F.3d 1105 (Fed. Cir. 2004)

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- (dispute over meaning of the word “board”).
4. Phillips v. AWH Corp., 2005 WL 1620331 (Fed. Cir. July 12, 2005).
 5. Cybor Corp. v. FAS Technologies, Inc., 138 F.3d 1448 (Fed. Cir. 1998).
 6. The American Bar Association’s Intellectual Property Law

- Section has established an ad-hoc subcommittee, co-chaired by the author of this article, to consider whether deference should be given to factual components of a district court’s claim construction rulings.
7. Bell Atlantic Network Services, Inc. v. Covad Communications Group Inc., 262 F.3d 1258 (Fed. Cir. 2001).