

News From the Center

As this issue is being written, our fall semester is well under way. Fall is a very busy and very exciting time at The John Marshall Law School and particularly in the Center for Intellectual Property Law. We are welcoming new students from around the country—indeed, around the globe— new faculty members, and courses as well.

This year, we are pleased to announce the hiring of two new directors for the IP Center, as well as several new IP adjunct faculty members.



Howard Knopf

John Marshall and the center are so pleased to announce that Professor **HOWARD P. KNOPF** has been named director of the IP Center, as well as chair of the Information Technology and Privacy and Intellectual Property Law Group. Before joining John Marshall, Howard practiced law in Canada with the Ottawa law firm of Macera & Jarzyna,

LLP, where he will remain Of counsel. He was founding executive director of the Canadian Intellectual Property Institute at the University of Ottawa, and a senior advisor to the Canadian government on intellectual property and competition matters. Howard has served as head of the Canadian delegation at meetings of the World Intellectual Property Organization (WIPO) relating to copyright and industrial property, and was the first Canadian IP lawyer to obtain an arbitration training certificate from WIPO.

Howard has practiced in the areas of copyright, trademark, cyberlaw, and related trade, competition and policy issues. He has been an adjunct special lecturer at Queen's University, and since 2000 has served as a faculty member of the Fordham Annual Conference on International Intellectual Property Law and Policy. He is a prolific writer and was editor of the book *Security Interests in Intellectual Property* published in 2002. Howard received his law degree from Osgoode Hall Law School in 1978, and holds

an LL.M. degree from the University of Ottawa (1993).

Prior to his legal career, Howard was a Juilliard graduate and a professional clarinetist, internationally active as a soloist, chamber, and recording musician.



William McGrath

“Our” very own, **WILLIAM T. MCGRATH**, IP adjunct faculty member at the law school since 1990, has been named associate director of the center. Bill has practiced law in Chicago for many years and will continue as a partner with Davis Mannix & McGrath, where his practice

involves issues relating to the ownership, licensing, protection, and infringement of intellectual property rights. He has extensive experience not only in counseling and litigation in these areas, but also in arbitration and mediation.

Bill's primary areas of expertise are copyright and trademark law, as well as publishing law, software licensing, and other matters relating to the high-tech and information technology industries. Here at The John Marshall Law School, he has taught courses in Copyright Law, International Copyright Law, and Copyright Litigation. He is a past president of the Intellectual Property Law Association of Chicago, and has served as chair of the Patent, Trademark & Copyright Committee of the Chicago Bar Association. Bill also has served on the Board of Trustees of the Copyright Society of the USA, and is currently a member of the editorial board of the *Journal of the Copyright Society of the USA*.

Bill is a graduate of Washington University School of Law. He is the author of numerous articles on copyright law, and is a frequent speaker on copyright and related issues.

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News Source is published quarterly by The John Marshall Law School Center for Intellectual Property Law.

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MICHELE BRIDGES has been named executive director of the IP center. She came to John Marshall in 1998 after a long career with the American Bar Association where she served as staff director for the ABA Section of Intellectual Property Law. Michele will continue to manage the programs, publications, marketing and special events of the center.

The Center for Intellectual Property Law is also pleased to welcome **DAVID BREMER, ELDON HAM** and **MOLLY MOSLEY-GOREN** as new members of our IP adjunct faculty. David Bremer is the president of Sabre Technical

Services Corporation, a small engineering consulting company providing mechanical design, product development, and patent services to mid-market manufacturers. He received a B.S. degree in Mechanical Engineering from Northeastern University in 1982, and has been a registered patent agent since 2002. He will assist Don Moyer in teaching and supervising our Patent Clinic.

Eldon L. Ham is an attorney in private practice in Chicago, specializing in business, sports, and entertainment law. In 1988, he was the first attorney to challenge, overturn, and change

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IP Licensing –
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Copyright Litigation –
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The Patent Clinic –
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Right of Publicity/Protection of
Personality –
Jonathan Jennings

IP Licensing –
Robert Sloat



Federal Circuit to Play

“Name That ~~Tune~~ Baffle”

by Robert H. Resis, Esq.¹ © 2004

On July 21, 2004, the Federal Circuit determined to rehear *en banc* the appeal in *Phillips v. AWH Corp.*, and withdrew the panel decision reported at 363 F.3d 1207 (Fed. Cir. 2004). In doing so, the Federal Circuit invited the parties to submit additional briefs on construction of patent claims raised by the now-vacated panel majority and dissenting opinions. In addition, the Federal Circuit invited others, and in particular the United States Patent Office, to file *amicus curiae* briefs. When the Federal Circuit *en banc* opinion issues, it will likely have a far-reaching and immediate impact in most, if not all, other patent cases involving claim construction, infringement, and validity issues. It also will likely have a similar impact on patent applicants and the practice of the United States Patent Office with respect to claim construction. The uncertainty of how a particular district court will construe a particular claim, and whether that claim construction will be affirmed by the Federal Circuit, however, will still likely remain.

Specifically, the Federal Circuit directed the parties to submit additional briefs particularly with respect to the following questions:

1. Is the public notice function of patent claims better served by referencing primarily to technical and general purpose dictionaries and similar sources to interpret a claim term, or by looking primarily to the patentee’s use of the term in the specification? If both sources are to be consulted, in what order?
2. If dictionaries should serve as the primary source for claim interpretation, should the specification limit the full scope of claim language (as defined by the dictionaries) only when the patentee has acted as his own lexicographer, or when the specification reflects a clear disclaimer of claim scope? If so, what language in the specification will satisfy those conditions? What use should be made of general as opposed to technical dictionaries? How does the concept of ordinary meaning apply if there are multiple dictionary definitions of the same term? If the dictionary provides multiple potentially applicable definitions for a term, is it appropriate to look to the specification to determine what definition or definitions should apply?
3. If the primary source for claim construction should be the specification, what use should be made of dictionaries? Should the range of the ordinary meaning of claim language be limited to the scope of the invention disclosed in the specification, for example, when only a single embodiment is disclosed and no other indications of breadth are disclosed?

4. Instead of viewing the claim construction methodologies in the majority and dissent of the now-vacated panel decision as alternative, conflicting approaches, should the two approaches be treated as complementary methodologies such that there is a dual restriction on claim scope, and a patentee must satisfy both limiting methodologies in order to establish the claim coverage it seeks?
5. When, if ever, should claim language be narrowly construed for the sole purpose of avoiding invalidity under, *e.g.*, 35 U.S.C. §§ 102, 103 and 112?
6. What role should prosecution history and expert testimony by one of ordinary skill in the art play in determining the meaning of the disputed claim terms?
7. Consistent with the Supreme Court’s decision in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), and our *en banc* decision in *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998), is it appropriate for this court to accord any deference to any aspect of trial court claim construction rulings? If so, on what aspects, in what circumstances, and to what extent?

In a concurring opinion, Judge Rader asked “is claim construction amenable to resolution by resort to strictly algorithmic rules . . . Or is claim construction better achieved by using tools relevant in each case?” Chief Judge Mayer, dissenting, said the law must be changed so that claim construction is not a pure question of law.

At issue in *Phillips* is what is meant by the word “baffle” in the asserted claims. Even though the parties stipulated that “baffle” meant a “means for obstructing, impeding, or checking the flow of something,” the district court concluded that “baffle” was ambiguous because the term “did not identify the substance or force the flow of which it is intended to check, impede, or obstruct.” The district court concluded that the term “baffle” was means-plus-function language, and thus limited by the specification under 35 U.S.C. § 112.

The district court noted that “every textual reference in the specification and its diagrams show baffle deployment at an angle other than 90 degrees to wall faces,” and that the figures in the specification all displayed baffles placed in interlocking positions. Thus, the district court concluded that “baffle,” within the context of the asserted patent has two required properties: first, baffles extend inward from the shell walls at oblique or acute angles; and second, baffles form an intermediate, interlocking barrier in the interior of the wall module.

The Federal Circuit panel majority held that the term “baffle”

was not in means-plus-function language because the term is a sufficient recitation of structure, which carries its ordinary meaning of something “deflecting, checking, otherwise regulating flow,” quoting *Webster’s Third New International Dictionary* 162 (1993).



The Federal Circuit’s questions for the en banc rehearing show that the Federal Circuit wants to try to resolve deep divisions on claim construction methodology between its members.

The Federal Circuit panel majority, however, agreed with the accused infringer that the district court ultimately construed the meaning of the term “baffle” properly. In doing so, the panel majority focused on the patent specification’s references to impact resistance, especially against projectiles such as bullets and bombs, and the patentee’s statement that the baffles are “disposed at such angles that bullets which might penetrate the outer steel panels are deflected.” From the specification’s explicit descriptions of the invention, the Federal Circuit panel majority concluded that the patentee regarded his invention as panels providing impact or projectile resistance at angles other than 90 degrees. The panel majority also stated that the accused panels only having baffles at 90 degrees cannot deflect projectiles as described in the patent, and in any event are disclosed in the prior art. Based on this construction, the panel majority affirmed the district court’s summary judgment of noninfringement.

Judge Dyk dissented, stating that the majority improperly imposed a structural limitation based on the patentee’s preferred embodiments, and contrary to the plain meaning of the term “baffle.” Judge Dyk noted that there “is no argument here that one of ordinary skill in the art would ascribe a specialized meaning to the term baffles, and there has been no disclaimer in the specification or prosecution history, the general purpose dictionary definition . . . applies.”

The *Phillips* case highlights the problem inherent in having courts construe claim terms after patent issuance. The Federal Circuit’s questions for the *en banc* rehearing show that the Federal Circuit wants to try to resolve deep divisions on claim construction methodology between its members. For example, as highlighted by Judge Dyk’s dissent, the panel

majority’s decision *Phillips* is inconsistent with a number of Federal Circuit cases, most particularly, *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898 (Fed. Cir. 2004) (wherein the Federal Circuit expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment).

The panel majority decision in *Phillips* is also contrary to doctrine of claim differentiation. Unlike claim 1, dependent claim 2 of the asserted patent claims the modules “as defined in claim 1, wherein the steel baffles are oriented with the panel sections disposed at angles for deflecting projectiles such as bullets able to penetrate the steel plates.” Unlike claim 1, claim 4 claims “two partial side legs of a triangle forming acute angles . . . wherein the legs are inwardly directed to provide internal baffles.” Unlike claim 1, claim 17 claims “inner baffles projecting inwardly from the outer shell at angles tending to deflect projectiles that penetrate the outer shell”

The panel majority decision in *Phillips* (written by Judge Lourie) also appears to be contrary to the unanimous panel majority decision in *Chef America Inc. v. Lamb-Wesson Inc.*, 358 F.3d 1371 (Fed. Cir. 2004)—also written by Judge Lourie. In *Chef America*, the Federal Circuit held that even a nonsensical result does not require the court to redraft claims. In *Chef America*, the Federal Circuit held that “courts may not redraft claims whether to make them operable or to sustain their validity” and “[w]here, as here, the claim is susceptible to only one reasonable construction . . . we must construe the claims based on the patentee’s version of the claim as he himself drafted it.”

In *Phillips*, the term “baffle” was susceptible to only one reasonable construction—the general purpose dictionary definition. Indeed, the parties agreed to that very construction before the district court. Thus, in accordance with *Chef America*, it was legal error for the district court to redraft the claims in *Phillips* and to construe the term “baffles” as “baffles [that] must be oriented at angles other than 90 degrees”



Whichever way the Federal Circuit answers the questions posed in its determination to rehear the case *en banc* will not however, in this author's view, reduce the uncertainty of how a court will construe a particular claim term in a particular case.

The question in claim construction is:

What does the claim term mean to a person of ordinary skill in the art? Whether the Federal Circuit decides that dictionaries (general or technical) or the patent specification should be the primary source for claim interpretation, or that both should be equally consulted, that answer will not address what the claim term means to a person of ordinary skill in the art. The better approach is to ensure that the Patent Office requires that this question be expressly answered in the prosecution record as to each key claim term.

The fact that the Federal Circuit particularly invited the Patent Office to submit an *amicus curiae* brief for the rehearing *en banc* may indicate the Federal Circuit's desire for the Patent Office to ensure more definite and certain prosecution records on the scope and meaning of claim terms.

Indeed, the Federal Circuit's invitation to the Patent Office may prompt the Patent Office to require strict compliance with 35 U.S.C. §112, ¶2 and 37 C.F.R. 1.75(d)(1), both of which already dictate that the scope and meaning of the claims must be ascertainable by reference to the patent specification. Theoretically, strict compliance with 35 U.S.C. §112, ¶2 and 37 C.F.R. 1.75(d)(1) would eliminate the need for *Markman* hearings.

The Federal Circuit's invitation to the Patent Office may prompt the Patent Office to adopt new procedures that require patent applicants to identify which claim terms are

"means-plus-function" elements, identify the functions of the elements, and identify the corresponding structures, materials or acts for performing each specified function at the time of claim presentment to the examiner for examination. This would eliminate the need for a *Markman* hearing to determine whether 35 U.S.C. §112, ¶6 applies to a claim term, and if so, the need for a *Markman* hearing to determine the function and corresponding structure, material or act for performing each specified function.

The Federal Circuit's invitation to the Patent Office may prompt the Patent Office to adopt procedures that require patent applicants to provide the meaning of their key claim terms at the time of presentment to the examiner for examination. The Patent Office could require patent applicants to place into the patent specification the definition of key claim terms. Since the specification as originally filed must support the claims, this procedure would not involve the addition of new matter.

The Patent Office's adoption of these approaches, separately or in combination, will provide express meaning of claim terms to one of ordinary skill in the art. These approaches, if adopted, will bring more certainty and fairness to our patent system than any *en banc* decision in *Phillips*.

NOTE

1. Robert H. Resis is a principal shareholder with the intellectual property law firm of Banner & Witcoff, Ltd. in Chicago, Illinois.

The views expressed in this article are solely those of the author, and should not be attributed to Banner & Witcoff, Ltd. or any of its clients. Resis may be reached at 312.463.5405, or by e-mail at rresis@bannerwitcoff.com.



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