

Uncertainty in Claim Construction Remains After Federal Circuit *En Banc* Decision in *Phillips v. AWH Corp.*

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On July 12, 2005, after almost one year after determining to rehear *en banc* the appeal in *Phillips v. AWH Corp.*, and after the filing of 36 amicus briefs, the Federal Circuit issued its decision. The decision clarifies the methodology the public and the courts are to use in construing claims after patent issuance. The decision specifically demoted the *Texas Digital* line of cases that start claim construction with a “broad dictionary definition.” Instead, the Federal Circuit stated that the “risk of systematic overbreadth is greatly reduced if the court instead focuses at the outset on how the patentee used the claim term in the claims, specification, and prosecution history, rather than starting with a broad definition and whittling it down.” Slip Op. at 26.

While the Federal Circuit *en banc* decision clarifies appropriate claim construction methodology, it still leaves in place uncertainty of how a particular district court will construe a particular claim, and whether that claim construction will be affirmed by the Federal Circuit. This is because the ultimate claim construction question still remains: What is the meaning a disputed claim term would have to a person of ordinary skill in the art at the time of the invention? Slip Op. at 9.

This question can and should be answered no later than the time of patent issuance – not after patent issuance. The *Phillips en banc* court said as much when it stated:

The pertinence of the specification to claim construction is reinforced by the manner in which a patent is issued. The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must “conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find

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clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” 37 C.F.R. § 1.75(d)(1).

This passage is an indication of the Federal Circuit’s belief that the Patent Office should be doing more to ensure that “meaning of the terms in the claims” must “be ascertainable by reference to the description.” Indeed, if the “meaning of the terms in the claims” were readily ascertainable by reference to the description of each issued patent, then theoretically, the need for claim construction hearings would be eliminated.

Elimination of uncertainty in claim construction is of critical importance to patent applicants, the Patent Office, patent owners, competitors, the public, and the courts. This uncertainty can be best eliminated if the Patent Office required strict compliance with 35 U.S.C. § 112, ¶ 2 and 37 C.F.R. § 1.75(d)(1).

The Patent Office should 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.

Finally, applicants should be required to provide the meaning of their key claim terms at the time of presentment to the examiner for examination. All statements of the patent applicant on the scope and meaning of the claim terms should be placed into the patent specification itself just in front of the claims prior to patent issuance. Since the specification as originally filed must support the claims, this procedure would not involve the addition of new matter.

These approaches, separately or in combination, will bring more certainty to our patent system for the benefit of all.