

Avoiding Claim Construction Errors:

Determining the Ordinary Meaning Before Reading the Written Description

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The Problems to be Solved:

- ◆ Lowering the 40% reversal rate
- ◆ No finality until post-appeal
- ◆ Helping the trial court



The Proposed Solution:

- ◆ Determine the ordinary and customary meaning of disputed claim terms *before* reading the written description.
- ◆ *Then* review written description, drawings and file history for inconsistent use by patentee.
- ◆ If use is not inconsistent, ordinary meaning controls.

Why?

- ◆ Claims, not the written description or drawings, define invention scope.
- ◆ Ordinary meaning should prevail *unless* patentee explicitly used term in other way.
- ◆ Reading the written description *first* invites reading-in limitations.

Will it work?

Will more trial court claim constructions be affirmed?



Texas Digital Sys. v. Telegenix

308 F.3d 1193 (Fed. Cir. 2002) (J. Rader)

- ◆ Fed Cir. began with dictionary definition
- ◆ *Then* turned to written description to determine if ordinary meaning was rebutted.
- ◆ Giving term its dictionary definition, Fed. Cir. said: “We conclude that the presumption has not been rebutted”



Texas Digital Sys. v. Telegenix

308 F.3d 1193 (Fed. Cir. 2002) (J. Rader)

“Consulting the written description and prosecution history as a threshold step in the claim construction process, *before any effort is made* to discern the ordinary and customary meanings attributed to the words themselves, invites a violation of our precedent counseling against importing limitations into the claims.”



Texas Digital Sys. v. Telegenix

308 F.3d 1193 (Fed. Cir. 2002) (J. Rader)

- ◆ “Indeed, one can easily be misled to believe that this is precisely what our precedent requires when it informs that disputed claim terms should be considered in light of the intrinsic record.”



Resonate v. Alteon

338 F.3d 1360 (Fed. Cir. 2003) (J. Plager)

- ◆ Reversed trial court's claim construction
- ◆ “*After* identifying the ordinary meaning of a disputed claim term, we *turn* to the patent's written description and drawings to determine whether that meaning is inconsistent with the patentee's use of the term,”



E-Pass Tech v. 3Com

343 F.3d 1364 (Fed. Cir. 2003) (J. Dyk)

- ◆ Reversed trial court's claim construction
- ◆ Fed. Cir. used dictionaries and claim context to define ordinary meaning of "card."
- ◆ "we *next* look to the specification to determine whether the presumption of ordinary and customary meaning is rebutted."



Combined Systems Inc. v. Defense Tech.

350 F.3d 1207 (Fed. Cir. 2003) (J. Michel)

- ◆ CSI argued that trial court erred by resorting to dictionary first.
- ◆ The trial court then looked to the written description for an “unaccustomed” meaning and found none.
- ◆ Fed. Cir. affirmed the trial court.



IP Development v. UA-Columbia

336 F.3d 1308 (Fed. Cir. 2003) (J. Schall)

- ◆ Affirmed trial court's claim construction that began with dictionary and then written description.
- ◆ “the district court did not err in looking to dictionary definitions *before* consulting the written description”
- ◆ “The written description should be examined in every case to determine if the presumption of ordinary and customary meaning is rebutted.”



The Texas Two-Step is not settled law

Some case law seems to support using the written description to determine the ordinary meaning



Int'l Rectifier Corp. v. IXYS Corp.

_ F.3d _ (March 18, 2004) (J. Linn)

- ◆ Reversed trial court's claim construction.
- ◆ Stated that ordinary and customary meaning can be determined from, among other things, written description, drawings and prosecution history.
- ◆ “We look next to the written description for context and guidance as to the meanings attributed by those of ordinary skill in the art to the term “polygonal” and to see whether the patentee acted as his own lexicographer, or otherwise disavowed or disclaimed the full scope of the ordinary and customary meaning of the term in question.”



Deering Pres. Inst. v. Vector

347 F.3d 1314 (Fed. Cir. 2003) (J. Gajarsa)

- ◆ Modified trial court's claim construction because patentee used term inconsistent with ordinary meaning.
- ◆ "Claim construction analysis *begins* with the ordinary meaning of the disputed claim term."
- ◆ "The *next step* is to review the written description and the prosecution history, to determine if the patentee has chosen to be his or her own lexicographer, ..."



Genzyme v. Transkaryotic

346 F.3d 1094 (Fed. Cir. 2003) (J. Rader)

- ◆ Affirmed trial court's claim construction where patentee's use rebutted the presumption. But...J. Linn's dissent:
- ◆ "Consultation of the written description ...*before* attempting to ascertain the ordinary and customary meaning of the language of the claims is premature."
- ◆ "the majority hastens too quickly past the fundamental step of determining the ordinary and customary meaning"



ACTV v. Walt Disney

346 F.3d 1082 (Fed. Cir. 2003) (J. Linn)

- ◆ Reversed trial court's claim construction
- ◆ “The ordinary and customary meaning of a claim term may be determined by reviewing a variety of sources, including . . . the written description and drawings.”



Ferguson v. Mega

350 F.3d 1327 (Fed. Cir. 2003) (J. Linn)

- ◆ Ordinary and customary meaning of a claim term may be determined by reviewing a variety of sources.
- ◆ Claims, dictionaries, treatises and the *written description*.
- ◆ But Court first determined ordinary meaning based on dictionary and *then* found that consistent with the written description.



Ferguson v. Mega

Judge Rader's Concurrence

- ◆ A court can err by importing a limitation into patent claims from a dictionary as well as from a specification.
- ◆ When a court relies on a dictionary definition, it *must* include additional reasoning to substantiate its choice amongst many possible definitions in many possible dictionaries at many possible times.



Conclusions

- ◆ Determine the ordinary and customary meaning of the disputed claim term *before* reviewing the written description and drawings.
- ◆ Consult written description, drawings and prosecution history to determine if ordinary meaning was rebutted.
- ◆ If multiple ordinary meanings, use written description and drawings to select correct one(s).



“‘normal’ marriage probably means an average marriage, i.e., one perpetually in danger of divorce”

J. Rader (dissent) *Ferguson v. Mega*



Questions?

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