

**Baffled: *Phillips v. AWH Corp.* and the Reexamination of  
Dictionary Use in Patent Claim Interpretation**

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**I. Introduction**

When drafting a patent application, inventors or their legal representatives must carefully choose the language and terms employed in the claims section. A particular problem arises in a granted patent when a term with multiple definitions creates ambiguity in the interpretation of the claims and the scope of protection provided therein. How should courts determine which definition controls? Which authorities should be consulted, and if multiple authorities are consulted, how much weight should each carry respectively? These are some of the questions that the Federal Circuit seeks to address in its en banc rehearing of *Phillips v. AWH Corp.*<sup>2</sup>

The outcome of *Phillips* will significantly affect both the drafting of future patent applications and the interpretation of all patents, including those granted prior to this case. This Recent Development reviews the basic tenets of claim construction and considers whether the Federal Circuit should continue to favor, as it has increasingly been inclined to do, a formalistic method of interpretation that focuses on how dictionaries define terms in the claim. After considering the impact an adoption of such formalism may have on patent drafting and fair competition, this Recent Development argues that the Federal Circuit should retreat from this position upon rehearing *Phillips*.

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<sup>2</sup> 376 F.3d 1382 (Fed. Cir. 2004) (granting petition for en banc rehearing).

## II. The Patent Claim: Interpretive Methodologies and Clarification of Ambiguities

### A. Roles of Judge and Jury in the Enforcement of Patent Rights

When an inventive entity, whether an individual, a group of individuals, or a corporation, seeks to enforce its patent rights against an alleged infringer, it must show that the allegedly infringing product or process is covered by the claims section of the inventor's patent.<sup>3</sup> To determine whether the product infringes the patent, the patent holder must interpret the claims section of the patent and decide whether the other party's product actually infringes the patent as construed.<sup>4</sup> In *Markman v. Westview Instruments, Inc.*, the United States Supreme Court held that claim construction is an issue of law to be decided by judges, while infringement is an issue of fact to be determined by a jury.<sup>5</sup> As a result of this case, pre-trial hearings, commonly referred to as *Markman* hearings, are now held outside the presence of the jury to resolve interpretive ambiguities in a patent claim.

### B. Written Description Requirement

Under federal patent law, a patent's "specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same [invention]."<sup>6</sup> In order to meet this requirement, the inventor must "describ[e] the invention, with all its claimed limitations."<sup>7</sup> This means that the claims must be supported by the written description in the specification, and the

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<sup>3</sup> *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 374 (1996).

<sup>4</sup> *Id.* at 384.

<sup>5</sup> *Id.* at 371 (reaffirming the holding of *Winans v. Denmead*, 56 U.S. 330, 338 (1853)).

<sup>6</sup> 35 U.S.C. § 112 (2000).

<sup>7</sup> *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479 (Fed. Cir. 1998) (quoting *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)) (emphasis omitted).

claims may have no more breadth than what is described in the specification.<sup>8</sup> Because the claims must be read in light of the specification,<sup>9</sup> it is imperative that a patent drafter describe the invention with clarity in the specification.<sup>10</sup>

### C. Sources of Evidence in Claim Construction

Two commonly used sources of evidence in claim construction are the claims themselves and the specification. According to the Federal Circuit, terms within a claim “are generally given their ordinary and customary meaning, [but] a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history.”<sup>11</sup> As a result, “it is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning. The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication.”<sup>12</sup> The Federal Circuit has further asserted that, “[u]sually, [the specification] is dispositive; it is the single best guide to the meaning of a disputed term.”<sup>13</sup>

These sources—the specification and the claims—along with the prosecution history<sup>14</sup> are considered intrinsic evidence that

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<sup>8</sup> *Id.* at 1480 (“Claims may be no broader than the supporting disclosure, and therefore . . . a narrow disclosure will limit claim breadth.”).

<sup>9</sup> See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc) (“Claims must be read in view of the specification, of which they are a part.”).

<sup>10</sup> See, e.g., *Gentry Gallery*, 134 F.3d at 1480 (deciding that narrowness of the specification limited the plaintiff’s claims so as to preclude a finding of infringement outside the scope of the specification).

<sup>11</sup> *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

<sup>12</sup> *Id.*

<sup>13</sup> *Id.*

<sup>14</sup> *Vitronics* states,

[The prosecution] history contains the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims. As such, the record before

may be consulted when construing claim language.<sup>15</sup> Aside from the intrinsic evidence, courts may also consult extrinsic evidence.<sup>16</sup> Extrinsic evidence may include expert testimony, inventor testimony, dictionaries, encyclopedias, and treatises.<sup>17</sup>

#### D. Role of Dictionaries, Encyclopedias, and Treatises

Although dictionaries<sup>18</sup> have been considered valid sources of evidence in patent cases dating as far back as the 1940s,<sup>19</sup> their validity as extrinsic evidence was affirmed in multiple cases in the mid-1990s, around the time of the *Markman* decision.<sup>20</sup> Nevertheless, dictionaries were not considered a primary source of evidence until the Federal Circuit decided *Texas Digital Systems, Inc. v. Telegenix, Inc.*<sup>21</sup> in 2002. In *Telegenix*, the Federal Circuit asserted that “[c]onsulting 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.”<sup>22</sup> The court further stated:

By examining relevant dictionaries, encyclopedias and treatises to ascertain possible meanings that would have been attributed to the words of the claims by those skilled in the art, and by further utilizing the intrinsic record to select from those

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the Patent and Trademark Office is often of critical significance in determining the meaning of the claims.

*Id.*

<sup>15</sup> *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1216 (Fed. Cir. 1995).

<sup>16</sup> *Id.* (“Extrinsic evidence may also be considered, if needed to assist in determining the meaning or scope of technical terms in the claims.”).

<sup>17</sup> *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc).

<sup>18</sup> The term “dictionary” is used in the remainder of this Recent Development to include dictionaries, encyclopedias, and treatises, unless otherwise indicated.

<sup>19</sup> *See, e.g., In re Ripper*, 171 F.2d 297, 299 (C.C.P.A. 1948).

<sup>20</sup> *E.g., Markman*, 52 F.3d at 980; *Quantum Corp. v. Rodime, PLC*, 65 F.3d 1577, 1581 (Fed. Cir. 1995).

<sup>21</sup> 308 F.3d 1193 (Fed. Cir. 2002).

<sup>22</sup> *Id.* at 1204.

possible meanings the one or ones most consistent with the use of the words by the inventor, the full breadth of the limitations intended by the inventor will be more accurately determined and the improper importation of unintended limitations from the written description into the claims will be more easily avoided.<sup>23</sup>

This decision was seen as a significant move toward formalism in claim construction.<sup>24</sup>

The *Telegenix* court held that the intrinsic record must be examined, but only to ensure that the “ordinary and customary meaning” is not rebutted or, if there are multiple definitions, to determine which was intended.<sup>25</sup> The court’s decision established dictionaries as the initial source of evidence in patent claim construction. This holding appears irreconcilable with the past holdings of the Court. The Federal Circuit had previously held that the intrinsic evidence should be examined first, and if any ambiguities in claim construction remain, sources of extrinsic evidence may be consulted.<sup>26</sup> In *Telegenix*, however, the court stated dictionaries are outside the classification of extrinsic evidence.<sup>27</sup> This appears to be an attempt to avoid reversing its past holdings.<sup>28</sup> The Federal Circuit backed away from treating

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<sup>23</sup> *Id.* at 1205.

<sup>24</sup> See Ruoyu R. Wang, *Texas Digital Systems v. Telegenix, Inc.: Toward a More Formalistic Patent Claim Construction Model*, 19 BERKELEY TECH. L.J. 153, 162–73 (2004) (providing a more in depth analysis of this transition and arguments for it).

<sup>25</sup> *Telegenix*, 308 F.3d at 1204 (“The intrinsic record also must be examined in every case to determine whether the presumption of ordinary and customary meaning is rebutted.”).

<sup>26</sup> *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1584 (Fed. Cir. 1996) (“Only if there were still some genuine ambiguity in the claims, after consideration of all available intrinsic evidence, should the trial court have resorted to extrinsic evidence, such as expert testimony, in order to construe [the claim].”).

<sup>27</sup> *Telegenix*, 308 F.3d at 1203 (“Categorizing [dictionaries, encyclopedias, and treatises] as ‘extrinsic evidence’ or even a ‘special form of extrinsic evidence’ is misplaced and does not inform the analysis.”).

<sup>28</sup> See Jennifer R. Johnson, *Out of Context: Texas Digital, the Indefiniteness of Language, and the Search for Ordinary Meaning*, 35 J.L. & TECH 521 (2004).

dictionaries as extrinsic evidence, as it had in *Markman*, by placing them in their own category.<sup>29</sup>

### E. *Phillips v. AWH Corp.*

Recently the Federal Circuit chose to reexamine the trend toward a formalistic approach to claim construction.<sup>30</sup> In *Phillips v. AWH Corp.*,<sup>31</sup> the plaintiff patented a design for modular wall panels that could be used in correctional facilities because of their “desirable sound and fire resistance, impact resistance (i.e., against bullets, bombs), and axial and lateral load bearing qualities.”<sup>32</sup> In *Phillips*, the Federal Circuit largely focused on the definition of the term “baffle” as used in the patent claims. The alleged infringer “assert[ed] that the key innovative feature of the invention [was] the baffle configuration, including both the angled orientation and the interlocking pattern limitations.”<sup>33</sup> If the baffles constituted the key innovative feature, then infringement would most likely be precluded if the allegedly infringing product did not have baffles as construed in the patent.

Following the procedure set forth in *Telegenix*, the court examined the dictionary before consulting the intrinsic evidence. The court relied in part on the Webster’s Dictionary definition of baffle in determining its ordinary meaning: “something for deflecting, checking, or otherwise regulating flow.”<sup>34</sup> The court then examined the specification and determined that it treated the term more restrictively than the dictionary definition.<sup>35</sup> As a result, it concluded the use of the term “baffle” in the claims section was restricted to have a characteristic angle of other than 90 degrees, a

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<sup>29</sup> See *id.* (arguing that the assertion in *Telegenix* that dictionaries are improperly considered extrinsic is illogical).

<sup>30</sup> For an enumerated list of the issues being reheard, see *Phillips v. AWH Corp.*, 376 F.3d 1382, 1383 (Fed. Cir. 2004).

<sup>31</sup> 363 F.3d 1207 (Fed. Cir. 2004).

<sup>32</sup> *Id.* at 1209.

<sup>33</sup> *Id.* at 1212.

<sup>34</sup> *Id.* (quoting WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY 162 (3d ed. 1993)).

<sup>35</sup> *Phillips*, 363 F.3d. at 1213.

limitation not imposed by the dictionary definition.<sup>36</sup> The dictionary definition would clearly benefit the plaintiff-patentee, since it would provide broader protection and allow the court to find infringement. The court chose to use the definition in the specification and found for the defendant.<sup>37</sup>

Not satisfied with the method of claim construction in *Phillips*, the Federal Circuit has granted a motion for an en banc rehearing “in order to resolve issues concerning the construction of patent claims raised by the now-vacated [prior panel holding].”<sup>38</sup> Having already decided to consider a number of claim construction issues, the court now has the perfect opportunity to reexamine its past decisions regarding dictionary usage. The court should take advantage of this opportunity because, as illustrated by *Phillips*, courts struggle in trying to construe claims using dictionary definitions. The vacated *Phillips* opinion also provides a clear example of the court’s usage of the construction methodology advocated in *Telegenix*.

### III. Detrimental Effects of Favoring Dictionaries

#### A. Battle of the Dictionaries

The Federal Circuit has held that when the ordinary meaning of a term can be determined from dictionary definitions and intrinsic evidence, there is no need to consult expert witnesses.<sup>39</sup> Replacing experts with dictionaries, of course, sidesteps the proverbial “battle of the experts,” which can be a lengthy, confusing, and costly affair. Avoiding such battles is arguably best for both sides, and that may be one of the main reasons the Federal Circuit has increasingly preferred to use dictionaries in claim construction.

Using dictionaries, however, may give rise to a slightly different kind of battle. Like experts, dictionaries of different makes and time periods can offer diverse meanings on the same

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<sup>36</sup> *Id.*

<sup>37</sup> *Id.*

<sup>38</sup> *Phillips*, 376 F.3d at 1382.

<sup>39</sup> *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1368 (Fed. Cir. 2002).

term.<sup>40</sup> As a result, a “battle of the experts” can be replaced with a “battle of the dictionaries,” and a court could be faced with the potentially daunting decision as to which dictionary should control. Favoring dictionaries may be doing nothing more than replacing one problem with another.

## B. Patents vs. Contracts

In justifying its decision in *Telegenix*, the Federal Circuit referred to the use of dictionaries for interpretation of contracts.<sup>41</sup> A contract is generally defined as “[a]n agreement between two or more parties creating obligations that are enforceable or otherwise recognizable at law.”<sup>42</sup> A patent, however, is “an agreement between an inventor and the public, represented by the federal government: in return for a full public disclosure of the invention the inventor is granted the right for a fixed period of time to exclude others from making, using, or selling the defined invention . . . .”<sup>43</sup> An important distinction is that a contract only affects the rights of the “two or more parties” in agreement, while a patent affects the rights of the public, on whose behalf the government makes the agreement.

Since the public’s rights are affected by terms to which it is not directly agreeing, it is imperative that the patent give adequate public notice of how those rights are affected.<sup>44</sup> On the other hand, public notice would appear to play a minimal role, if any, in a contract, since the parties themselves are agreeing to its terms. Further, any ambiguities may be resolved prior to agreeing to the contract. The importance of the notice function of patents becomes more clear when fair competition and the costs involved in designing around a patent are more closely examined.

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<sup>40</sup> See Johnson, *supra* note 28 (describing the difficulty of competing dictionaries, using *Novartis Pharm. v. Eon Labs Mfg.*, 363 F.3d 1306 (Fed. Cir. 2004), a split-panel decision, as an example).

<sup>41</sup> *Telegenix*, 308 F.3d at 1203.

<sup>42</sup> BLACK’S LAW DICTIONARY 318 (7th ed. 1999).

<sup>43</sup> *Id.* at 1147 (quoting E. KINTNER & J. LAHR, AN INTELLECTUAL PROPERTY LAW PRIMER 7–11 (2d ed. 1982)).

<sup>44</sup> See *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33 (1997) (“Claims do indeed serve both a definitional and a notice function.”).

### C. Effect on Notice Function and Fair Competition

Public notice is an important function of patents because they grant a limited form of monopoly, excluding others from producing the invention without the patent holder's permission.<sup>45</sup> If courts show a strong preference toward dictionary definitions, patent applicants might make an effort to employ the terms used in their applications according to the dictionary definitions, creating normative patent claim drafting.<sup>46</sup> At first blush, the benefits of a normative method of drafting appear significant. A normative method would make the meaning of claims more predictable, facilitating the public notice function of patents.<sup>47</sup> Expecting these benefits to fully come to fruition, however, is overly optimistic. There are a number of practical difficulties that competitors face when dictionaries are the primary source of interpretation.

As the Federal Circuit stated in *Vitronics Corp. v. Conceptronic, Inc.*:<sup>48</sup>

The claims, specification, and file history, rather than extrinsic evidence, constitute the public record of the patentee's claim, a record on which the public is entitled to rely. In other words, competitors are entitled to review the public record, *apply the established rules of claim construction*, ascertain the scope of the patentee's claimed invention and, thus, design around the claimed invention.<sup>49</sup>

If this procedure is followed, competitors must employ the approach of *Telegenix*. As a result, competition will be hampered

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<sup>45</sup> See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 730 (2002) (stating "patent laws . . . reward[] innovation with a temporary monopoly.").

<sup>46</sup> See Wang, *supra* note 24, at 170–71 (claiming "[formalism] gradually reduces courts' interpretive burdens and mistakes, increases interpretive accuracy and predictability, and encourages a norm formation for patent drafting.").

<sup>47</sup> See *id.* at 169–70 (arguing "[f]ormalism . . . advances the public notice function more because it predictably emphasizes the meanings of claims within the four corners of a patent.").

<sup>48</sup> 90 F.3d 1576 (Fed. Cir. 1996).

<sup>49</sup> *Id.* at 1583 (emphasis added).

and the consuming public will likely be injured.<sup>50</sup> Rather than looking first to the intrinsic record to resolve ambiguities in claim terms, competitors must begin by consulting a dictionary in order to ascertain the ordinary meaning of the terms. This method of interpretation can give rise to difficult questions. For example, what type of source should be consulted—a dictionary, encyclopedia, or treatise? And how technologically specific should that source be? Also, if there are multiple sources to choose from, it may be quite difficult to decide which one should control.

Since competitors must look to the version of the source that was available at the time the patent application was processed,<sup>51</sup> they are in a challenging position. Not only is it extremely difficult to decide which source to consult, but the source may be unavailable. Could the courts expect competitors to find sources that were in place up to twenty years<sup>52</sup> prior to the date of their analysis of the patents?<sup>53</sup> This would appear to be necessary after *Telegenix*. Even if competitors could figure out which version and edition of dictionary controls,<sup>54</sup> they would still have to spend time locating the particular source, which may be difficult to find.

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<sup>50</sup> For a contrary perspective see Wang, *supra* note 24, at 169–70.

<sup>51</sup> “Dictionaries, encyclopedias, and treatises, publicly available at the time the patent is issued, 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.” Texas Digital Sys., Inc. v. Telegenix, 308 F.3d 1193, 1202–03 (Fed. Cir. 2002) (emphasis added).

<sup>52</sup> Utility patents generally provide protection for a term of twenty years from the date of filing an application. 35 U.S.C. § 154(a)(2) (2000).

<sup>53</sup> Some libraries may keep older versions of dictionaries on file. However, this is much less likely with treatises, which are often in loose-leaf binders and updated by replacing pages or sections. See LexisNexis, LexisNexis Bookstore, at

[http://bookstore.lexis.com/bookstore/catalog?action=product&toc=t&print=y&prod\\_id=10111&cat\\_id=W](http://bookstore.lexis.com/bookstore/catalog?action=product&toc=t&print=y&prod_id=10111&cat_id=W) (lasted visited Nov. 19, 2004) (showing that *Chisum on Patents*, a leading treatise on U.S. patent law, is “updated by replacement pages five times per year”).

<sup>54</sup> See Johnson, *supra* note 28 (arguing that “competitors cannot be sure of the proper meaning of words in the claims, and thus are more likely to infringe the patent or litigate the issue” when the court employs dictionaries *sua sponte* in claim construction).

The difficulties associated with choosing and locating the right dictionary add to the cost of designing around a patent. These costs would be reduced if the Federal Circuit retreated to the methodology in place prior to *Telegenix*, looking first to the written description. If the written description adequately defines a term that appears ambiguous in the claims, the competitor would have no need to look elsewhere. Only the patents in which the written description does not adequately define claim terms would require a search for relevant extrinsic evidence. Accordingly, the Federal Circuit should conclude the approach in *Telegenix* is both illogical and economically inefficient.

If an entity acquires a limited monopoly, it seems inequitable to raise the costs for competitors to offer similar products or services outside that monopoly. Once costs pass a threshold, many competitors may forego offering such products or services. If this occurs, consumers have fewer choices, resulting in a less efficient market. Although patents, by their exclusive nature, limit consumer choices, such limitations should be confined as closely as possible to the scope of the patent. By unduly hampering competition and increasing costs for competitors, the consuming public loses out due to fewer choices and higher prices.

#### IV. Conclusion

The Federal Circuit prudently chose to re-examine and clarify the role of dictionaries in patent claim construction. Though dictionaries can play a beneficial role in claim construction, the court should put them back on the shelf and redirect the focus to the patent's specification and intrinsic evidence. By making dictionary consultation the threshold step in determining the meaning of patent terms, the *Telegenix* decision potentially creates a number of problems for the courts, competitors, and consumers. The courts still have the problem of competing authorities, and both courts and competitors are forced to take steps that may otherwise be unnecessary, likely resulting in fewer choices and higher costs for consumers. Even if the Federal Circuit in the en banc rehearing in *Phillips* reaffirms the use of dictionaries as interpretive tools, the court should at least

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reestablish the written specification as the initial source of authority. Doing so would eliminate the inefficiency of ascertaining and locating appropriate sources in cases where the intrinsic record is sufficient. This would greatly limit the aforementioned problems and provide a sound policy.