In The
United States Court of Appeals
For The Federal Circuit

EDWARD H. PHILLIPS,

***Plaintiff-Appellant*,**

v.

**AWH CORPORATION,
HOPEMAN BROTHERS, INC.,
and LOFTON CORPORATION,**

***Defendants-Cross Appellants*.**

APPEALS FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLORADO IN CASE NO. 97-CV-212, JUDGE MARCIA S. KRIEGER.

BRIEF OF *AMICUS CURIAE* CONEJO VALLEY BAR ASSOCIATION IN SUPPORT OF NEITHER PARTY

Mark A. Goldstein, Esq.
Steven C. Sereboff, Esq.
Joel G. Landau, Esq.
SoCal IP Law Group
310 N. Westlake Boulevard
Suite 120
Westlake Village, California 91362
(805) 230-1350

Counsel for Amicus Curiae Conejo Valley Bar Association

Dated: September 20, 2004

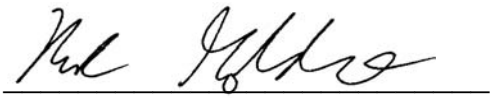
THE LEX GROUP^{DC} ♦ One Massachusetts Avenue, N.W. ♦ Suite 670 ♦Washington, DC 20001
(202) 789-2400 ♦ (800) 815-3791 ♦ Fax: (202) 789-1911 ♦ www.thelexgroupdc.com

CERTIFICATE OF INTEREST

Counsel for *amicus* Conejo Valley Bar Association certifies:

1. The full name of every party or *amicus* represented by me is: Conejo Valley Bar Association.
2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is: not applicable.
3. All parent corporations and any publicly held corporations that own 10 percent or more of the stock of the party or *amicus curiae* represented by me are: not applicable.
4. The names of all law firms and the partners or associates that appeared for the party or *amicus* now represented by me in the trial court or agency or are expected to appear in this court are: Mark A. Goldstein, Steven C. Sereboff, and Joel G. Landau of SoCal IP Law Group.

September 20, 2004



Mark A. Goldstein, Esq.

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES

Page(s)

Case:

INTRODUCTORY GENERAL STATEMENT OF IDENTITY AND ISSUES

The Conejo Valley Bar Association hereby files this *amicus curiae* brief in the captioned case. The Court, in order 03-1269,-1286, invited bar associations, trade or industry associations, and government entities to provide *amicus curiae* briefs addressing seven questions concerning patent claim construction.[1] In a concurring opinion, Judge Rader recommends that, for completeness, an eighth question also be briefed. We at the Conejo Valley Bar Association file this *amicus* brief in response to the Court's invitation. Our *amicus* brief addresses the issues raised by the seven questions concerning patent claim construction as well as the eighth question proffered by Judge Rader.

Based in the heart of Southern California's 101 Technology Corridor, the Conejo Valley Bar Association draws its membership from local law firms and in-house attorneys serving small, mid-market and large companies. Our members' clients include high technology, high growth companies in fields such as software, biotechnology, telecommunications and semiconductors. Our members' clients include technology innovators that sell in some of the world's most competitive markets.

[1] *Phillips v. AWH Corp.,* 376 F.3d 1382 (Fed. Cir. 2004).

On July 21 2004, the Court invited the parties in the above-captioned case to brief seven questions concerning patent claim construction. The Court also invited *amicus curiae* to brief the seven questions. *Amicus curiae* Conejo Valley Bar Association respectfully addresses the patent claim construction issues raised in these seven questions, as well as the eighth question proffered by Judge Rader.

Amicus curiae writes *in pro bono publico*, rather than in support of either party. We are unconcerned with the outcome of the case, though decidedly concerned about the issues and the resulting rules which will become precedent. We wish to see the American public benefit from innovation, from technical disclosure, and from competition in product and service markets. In short, we support the purpose of the patent system. The Conejo Valley Bar Association believes that the patent laws should be interpreted in ways that best serve these important public policies.

The Court has sought briefs concerning seven issues which are at the heart of patent law. Even though there are seven issues listed, the issues direct us to one question which needs to be answered. The question is simply, how should the claims in a patent be interpreted? This question needs to be answered so that the owners of patent applications are provided definitive guidance as to how pending claims will be interpreted upon

issuance of a patent. Such guidance will enable practitioners to draft claims in a fashion that not only increases the value of their patents but eases the burden of interpreting issued claims on the courts, the patentee, and competitors who may be possible infringers. Concomitantly, this question needs to be answered so that the public, including the patent owner and its competitors who may be possible infringers of patent owners, may have a definitive road map to use to ascertain the breadth of rights represented by a patent.

ARGUMENT

I. The Public Notice Function Of Patent Claims Is Best Served By Referencing Initially To The Intrinsic Evidence

In interpreting the meaning of patent claims, and therefore, the scope of the property right of a patent, the intrinsic evidence should be examined first, and, if necessary, extrinsic evidence may be used. Only after a review of the intrinsic record, the overall claim language, the specification and prosecution history, should a court define the words in a claim using extrinsic evidence, such as a dictionary or learned treatise.

Patent claims are construed from the perspective of one of ordinary skill in the art based on the priority date of the patent. It is well established that a patentee may only claim priority to a specific date where the invention was in their possession as of that date. Likewise, claim construction should

afford the inventor no more and no less than what the inventor possessed as of the priority date. Thus, the best way to ascertain the meaning of a claim is to review the specification. To ascertain what the inventor had in his possession at the time of filing a patent application based primarily on extrinsic evidence in the form of dictionaries, treatises and the like ignores the written description and enablement requirements of patent law. As such, the best way to achieve the public notice function is to ascertain the meaning of claims first by review of the specification of a patent.

This provides more certainty to patent drafters and the public as to how a claim will be interpreted. When a patent applicant knows that pertinent terms will be defined in view of the specification, the patentee will endeavor to draft a specification that lends itself to improve clarity of claim interpretation and to serve as his own lexicographer. If more patent applicants prepare patent applications knowing that the specification is the primary source for interpreting the claims, better patents will result.

One consideration is the balance between the need of a court to define an unclear claim term versus the risk of adding new matter to the patent specification by importing an unsupported extrinsic definition into the claim. We believe the better policy is to rely on information available at the time of filing, and the best evidence is what the inventor has written in the

application. The second best evidence is what was known to one of skill in the art at the time of filing. Here, the time of filing is meant to include the priority date of the subject claim, if different from the filing date.

Extrinsic evidence in the form of dictionaries, treatises, and the like should be referred to secondarily to interpret claims. If dictionaries or other extrinsic evidence is admitted, it must reflect the knowledge that one of ordinary skill in the art had at the date of priority. Although technical and/or general use dictionaries provide objective evidence as to what one of ordinary skill in the art may understand, it is important to refer to dictionaries that were published in the same relative time frame as the date of priority of a given claim.

Regarding the use of dictionaries, both general and technical dictionaries should be used to form a consensus meaning or ordinary meaning of a claim term. Technical dictionaries are most helpful when a technical term is either not included in a general dictionary or is poorly defined in a general dictionary. Reviewing definitions from multiple general dictionaries and multiple technical dictionaries allows for a check and balance as to the meaning and quality of a definition. In addition, such use of dictionaries reflects the analysis performed by many patent practitioners.

If there are multiple different dictionary definitions of the same term, a totality of the evidence approach should be used to evaluate which definition should be used to determine the meaning of a claim term. The evidence considered should include: (1) use of the term or its synonyms in the specification and file history; (2) the particular technical field of the patent application; (3) the scope of the specification; (4) and the definitions themselves. All of these should be used to rein in the appropriate definition to use to determine meaning of the particular claim term.

However, it should be cautioned that dictionaries should not be used as an erector set to construct a definition of a single claim term by connecting multiple definitions from multiple dictionaries. For example, using a first dictionary to define the claim term and then using a second dictionary to define a term used in the first dictionary should be avoided. In such situations the focus of analysis could move to analyzing the meaning of the terms in a dictionary rather than the proper focus on the meaning of a patent claim term.

We believe it is in the best interests of inventor-owners as well as large and small companies that the Court adopt an approach that avoids notice incommensurate with the intrinsic evidence.

II. Although We Believe That Dictionaries Should Not Be The Primary Source For Claim Construction, If Dictionaries Are Determined To Be The Primary Source For Claim Construction, The Specification Must Be Used To Confirm And Refine The External Definition Selected

Although we believe that the specification should be the primarily source for claim interpretation, if dictionaries are used primarily, the specification should be used to confirm and refine the external definition selected.

III. If The Specification Is Determined To Be The Primary Source For Claim Construction, Dictionaries May Optionally Be Consulted To Confirm And, When Necessary, To Clarify The Meaning Of A Claim Term

In evaluating the meaning of a patent claim, when referring primarily to the specification and file history, extrinsic evidence such as dictionaries may be consulted. When a claim term is unclear and the specification clarifies the meaning of the term, a dictionary published at a date contemporaneous to the filing or priority date of the patent may also be used to confirm the meaning of the term. In addition, should consultation of the patent specification and the file history not yield a clear meaning of a term, extrinsic sources should be consulted to clarify and define the unclear term.

IV. The Range Of The Ordinary Meaning Of Claim Language Should Be Limited To The Scope Of The Invention Disclosed In The Specification Only When Clearly And Unequivocally Set Forth Either By Definition, Disclaimer, Or Unambiguous Implication In The Specification And/Or The Prosecution History

Definitions in a patent may clearly and unequivocally yield the meaning of an important claim term. Definitions may take the form of definitions of structure, definitions of function, and definition by example. An example definition by structure is: "a storage device as used herein is a device that includes a read/write head, one or more receiving platters, an I/O bus, a cache memory, a power connector, a data input line and a data output line"; an example definition by function is: " a storage devices as used herein is any devices capable reading to and/writing to a magnetic medium;" and an example definition by example is: "a storage device as used herein means hard disk drives, floppy disk drives, and optical disk drives." Often, definitions are hybrids of these three forms.

It is an easy question when definitions are provided in a patent. The difficult question is what happens when a preferred embodiment, or rather, a sole embodiment is described in a patent. When a patentee could have but failed to clearly define the scope of an invention, questions of claim construction should be answered against the patentee. A patentee has many ways to characterize an invention. A patentee is in control of the words used

to describe the invention. It should be presumed when reviewing a patent that the patentee meant what was stated and also that omissions were intentionally made. As such, the courts should not rescue the patentee from himself, as it was the patentee who chose the words used to describe the invention. The Court should not award the patentee more or less than the patentee had within his grasp at the time of filing or as of the appropriate priority date.

V. Reading Limitations From The Specification Into The Claims

One of the most difficult questions in patent law is to determine when limitations from the specification should be read into the claims absent specific and explicit definition and disclaimer. We believe that the specification should always be reviewed to evaluate the meaning of claim terms, regardless of the clarity of meaning of the term to one of ordinary skill in the art. In doing so, limitations from the specification should be read into the claims only when the specification clearly and unequivocally directs one to conclude that such importation of limitations was intended by the patentee. In addition, in those circumstances when the patentee both described embodiments and used written cues to lead a reader of the patent to believe that the limitations from the embodiments were necessary to the

invention, the limitations, be they broad or narrow, should be read into the claims.

VI. Claim Language May Be Narrowly Construed For The Sole Purpose Of Avoiding Invalidity Only When The Specification And/Or The Prosecution History Clearly And Unequivocally Set Forth A Narrow Interpretation Either By Disclaimer Or Express Implication

Just as discussed above regarding limiting a patent claim to a sole described embodiment, a patentee is in control of the words used in the patent specification. As such the rule for rescuing a patent claim from invalidity should be commensurate with the rule for limiting a patent claim to its embodiments. It is only when the patentee clearly and unequivocally defines terms, disclaims terms, functionality or features, or unambiguously implicitly limits an invention to a sole embodiment that claim language should be narrowly construed to avoid invalidity.

Just as a patentee should not be rescued from himself when a specification is overly narrow, the patentee should not be rescued by the Court when a specification is overly broad such that a claim is rendered invalid. Because it was the patentee who chose the words used to describe the invention, the Court should not award the patentee more or less than the patentee had within his grasp at the time of filing or as of the appropriate priority date.

VII. Prosecution History And Expert Testimony By One Of Ordinary Skill Should Be Treated As Other Intrinsic And Extrinsic Evidence, Respectively, In Determining The Meaning Of Claim Terms

The prosecution history should be evaluated along with the other intrinsic evidence as described above. More specifically, the file history should be evaluated to learn whether the scope of any claim terms has been disclaimed. The file history is also reviewed to learn whether equivalents to the claim term are available in view of the Festo line of cases. In addition, the file history should be reviewed to learn whether the patentee has defined a claim term, described the functionality or attributes of a claim element, or provided other clues helpful in claim interpretation.

Although extrinsic evidence in the form of dictionaries is addressed herein, extrinsic evidence in the form of expert testimony has not yet been addressed. Unlike dictionaries, treatises and other documentary evidence, we believe that expert testimony should not play a role in determining how one skilled of the art at the time of the patent application would interpret the meaning of a claim term. The best additional source of information beyond dictionaries and treatises concerning what is known to those skilled in the art in many fields at a particular time is abundant in the academic journals, trade journals, and proposed and actual industry standards in the particular field. Such written documentation is unwavering and has unquestionable veracity

regarding the state of a technological art at a particular time. Relying on documents both reduces the costs of claim interpretation by removing an expensive factor (*i.e.*, expert witness fees) from the endeavor, and will result in a more accurate evaluation of what a term meant to one skilled in the art at the time of invention.

VIII. No Deference Should Be Given To A Trial Court's Claim Construction Rulings

In view of the unique stature of the Federal Circuit, its position can best cause the harmony of enforcement of the patent laws among the district courts by providing limited or no deference to claim construction rulings in the district courts.

Claim interpretation is a matter of law typically evaluated by a judge. The evaluation of the meaning of a claim, as set forth herein, primarily involves (and should only involve, we believe) the review of written documents. This Court can evaluate the written record equally effectively as a district court. The only instance where a district court may possibly better evaluate evidence concerning claim construction is when live, oral testimony is presented by an expert. As such, there is no compelling reason for the Federal Circuit to defer to the district courts when construing the meaning of patent claims.

IX. Claim Construction Is Amenable To Resolution By Resort To A Successive Refinement Of Analyses Of Intrinsic And, When Necessary, Extrinsic Evidence To Discern The Meaning Of Terms According To The Understanding Of One Of Ordinary Skill In The Art At The Time Of The Invention

Rarely is claim construction a black or white determination upon an initial read of the specification and claims on the one hand or a quick resort to dictionaries and treatises on the other. Claim interpretation is normally a shade of grey. Certainty of claim scope may be increased with review of intrinsic evidence and extrinsic evidence. Certainty is further enhanced by a successive refinement of claim analysis based on review first of the intrinsic evidence, and, if necessary, extrinsic evidence.

A successive refinement incorporating review of intrinsic evidence and, when necessary, extrinsic evidence will best achieve the desired goal of definitive claim interpretation. Intrinsic evidence should be reviewed first, by reference to the specification and then to the prosecution history.

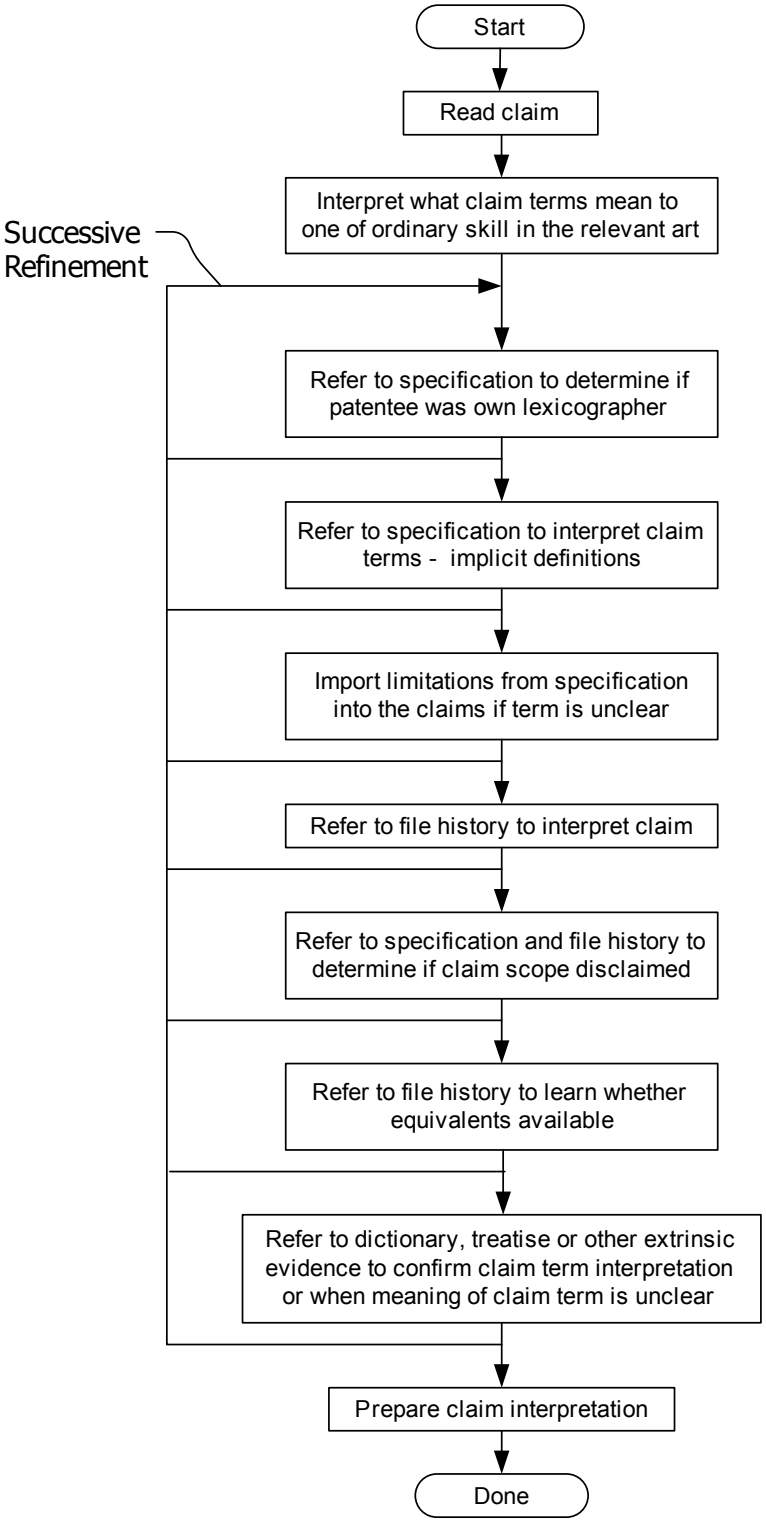
There are several reasons to review the specification. Most importantly, the specification must be reviewed for explicit definitions. When a claim or claim term is unclear, the specification may also be reviewed for implicit definitions. In some situations, the limitations from the specification may be imported into the claim when a claim term is unclear.

The prosecution history should also be reviewed in all situations, but particularly to evaluate a claim or claim term that is unclear. The prosecution history may include an express disclaimer of the scope of a claim or claim term. The prosecution history should also be reviewed to evaluate whether equivalents to claim terms are available.

Extrinsic evidence such as dictionaries, treatises, and the like may also be used when evaluating claims. Extrinsic evidence may be used to verify or confirm the meaning of claim terms, and may also be used to interpret unclear claim terms when the intrinsic evidence did not yield a clear result.

The steps discussed in this section may be successively repeated to refine the claim interpretation. For example, the specification may provide only examples, a dictionary may provide several definitions, and the specification may provide indicia of which definitions are apt. The goal should be not to follow a rigid guideline, but to achieve the desired end result -- a claim interpretation commensurate with the breadth of the invention set forth by the inventor in the specification as of the earliest priority date.

The successive refinement approach is set forth in the following drawing.



CONCLUSION

The Court has served the public well by issuing rulings that clarify and strengthen the patent laws. This has encouraged innovation while also creating greater respect for that innovation. We are encouraged by the Court's selection of the issue of claim construction for *en banc* review, and look forward to guidelines which third parties and judges may use to more concretely and more accurately evaluating the scope of a patent. The Conejo Valley Bar Association respectfully requests that the Court provide guidance in line with our analyses above to allow third parties and judges a more stable footing from which they can jump into the quagmire of claim interpretation.

September 20, 2004

Mark A. Goldstein, Esq.
Steven C. Sereboff, Esq.
Joel G. Landau, Esq.
SoCal IP Law Group
310 N. Westlake Blvd., Ste. 120
Westlake Village, CA 91362
www.socalip.com
mgoldstein@socalip.com
(805) 230-1350 x24
fax (805) 230-1355

For *Amicus Curiae*
Conejo Valley Bar Association

CERTIFICATE OF FILING AND SERVICE

I hereby certify that on September 20, 2004, two (2) true and correct copies of the foregoing Brief of Amicus Curiae were served by United States First Class Mail, postage prepaid, on counsel as noted below. Also on this date the original and thirty (30) copies of the Brief were provided to the Court by hand delivery.

Carl F. Manthei
ATTORNEY AT LAW
1205 17th Street
Boulder, CO 80302

Counsel for Appellant

Mark W. Fischer
Scott E. Holwick
FAEGRE & BENSON LLP
1900 15th Street
Boulder, CO 80302

Counsel for Cross Appellants

Filing and service were performed under instruction of Counsel.

_____

Kimberly J. Everitt
The Lex Group^{DC}
One Massachusetts Ave., NW
Suite 670
Washington, DC 20001
(202) 789-2400

Filed on Behalf of:

Mark A. Goldstein, Esq.
Steven C. Sereboff, Esq.
Joel G. Landau, Esq.
SOCAL IP LAW GROUP
310 N. Westlake Boulevard, Suite 120
Westlake Village, California 91362
(805) 230-1350

Counsel for Amicus Curiae
Conejo Valley Bar Association

CERTIFICATE OF COMPLIANCE

Pursuant to Federal Rule of Appellate Procedure 32(a)(7)(C), the undersigned certifies that this brief complies with the type-volume limitations of Federal Rule of Appellate Procedure 32(a)(7)(B)(i).

1. Exclusive of the exempted portions of the brief, as provided in Fed. R. App. Proc. 32(a)(7)(B)(iii), this brief includes **3,242** words.

2. This brief has been prepared in proportionally spaced typeface Microsoft Word 2000 in 14 point Times New Roman font. As permitted by Fed. R. App. Proc. 32(a)(7)(C), the undersigned has relied upon the word count of this word-processing system in preparing this certificate.

Mark A. Goldstein