

KEY IDEAS:

Straddling the ‘Fine Line’1

Exceptions to ‘Ordinary Meaning’1

The Rule – Ordinary and Customary Meaning.....2

Exception – Redefining the Term2

Exception 2 – Express Disclaimer or Disavowal of Claim Scope2

Two Rules Precluding Importation of Limitations3

What You Can Do4

**‘CARDINAL SIN’--THE SOLUTION (PART II)
LIMITING LIMITATIONS IN CLAIM CONSTRUCTION**

The “cardinal sin” of claims construction—importing limitations from specifications into claims—may seem inevitable when courts are forced to read claims in view of the specifications yet avoid slipping a limitation into a claim while doing so.¹

The inherent tension requires parties and trial courts to walk a very “fine line.”² The high cost to litigants over the battles regarding these two axioms merits a serious effort to prevent the problem. We offer a few creative strategies to neutralize the “cardinal sin” while using the rules to benefit your clients.

Straddling the ‘Fine Line’

The Federal Circuit has wisely said these two axioms seldom provide answers, but merely frame the issues.³ Fortunately, case law surrounding the high-wire act between “in view of” and “importing” provides helpful insights.

First, the “fine line” can be discerned with reasonable certainty and predictability *if* the focus remains on understanding how a person *of ordinary skill in the art* would understand the claim terms in dispute.⁴ Remember, the purposes of the specification are to teach and enable those of skill in the art to make and use the invention.⁵

Second, read the specification in light of its purpose. Is the patentee setting out “teachable” examples of the invention, or does the patentee instead intend for the claims and the embodiments in the specification to be strictly co-extensive?⁶

Exceptions to ‘Ordinary Meaning’

The Federal Circuit concisely summarized the rule regarding the meaning given to claims and two key exceptions as follows:

- **The Rule:** Claim terms take on their **ordinary and accustomed meanings**, unless the patentee demonstrated an intent to deviate from the ordinary and accustomed meaning of a claim term either by;
 - **Exception 1: redefining the term; or**

Prepared by:



PETER STRAND
Washington, D.C.
(202) 783-8400
pstrand@shb.com

Peter is a partner in the Firm’s Intellectual Property & Technology Litigation Practice. He holds an LLM in intellectual property law from the University of Houston School of Law.

1 *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1370 (Fed. Cir. 2008); see, e.g., *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005), *cert. denied*, 546 U.S. 1170 (2006); *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1117 (Fed. Cir. 2004) (citing *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 904-05 (Fed. Cir.), *cert. denied*, 543 U.S. 925 (2004)).

2 *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1255 (Fed. Cir. 2011); see e.g., *Kyocera Wireless Corp. v. ITC*, 545 F.3d 1340, 1347 (Fed. Cir. 2008); *Decisioning.Com, Inc. v. Federated Dep’t Stores, Inc.*, 527 F.3d 1300, 1307-08 (Fed. Cir. 2008); *Phillips*, 415 F.3d at 1323; *Comark Commc’ns, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir. 1998) (citation omitted).

3 *Liebel-Flarsheim Co.*, 358 F.3d at 904.

4 *Phillips*, 415 F.3d at 1323.

5 *Id.*

6 *Id.*; *Decisioning.Com, Inc.*, 527 F.3d at 1308.

Claims are generally construed as conveying the meaning they would have at the time of the invention to one of ordinary skill in the art who reads them in the context of the intrinsic record.

An inventor is free to be his or her own lexicographer. Any special definition given to a word, however, must be clearly set out in the specification.

The patentee may deviate from the ordinary and accustomed meaning of a claim term by including exclusions or restrictions in the specification, representing a clear disavowal of claim scope.

- **Exception 2:** characterizing the invention in the intrinsic record using words or expressions of **manifest exclusion or restriction** representing a **clear disavowal of claim scope**.⁷

The Rule – Ordinary and Customary Meaning

Claims are generally construed as conveying the meaning they would have at the time of the invention to one of ordinary skill in the art who reads them in the context of the intrinsic record.⁸ This focus provides an objective baseline for claim interpretation.⁹

Exception – Redefining the Term

It is fundamental to review the specification to see if the inventor used any disputed terms in a manner inconsistent with their ordinary meaning.¹⁰ The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication.¹¹

Patentee as Lexicographer – An inventor is free to be his or her own lexicographer. Any special definition given to a word, however, must be clearly set out in the specification.¹² In such cases, the inventor’s lexicography governs.¹³

Given the focus on what terms mean to those of ordinary skill in the art, all that is required is that the inventor explain his or her meaning in a manner sufficient to give that hypothetical person notice of the change from the ordinary meaning.¹⁴ Notice of a different usage may be implicit or explicit,¹⁵ and it will be binding, even if unintentional.¹⁶

For example, by consistently and clearly using a term in a manner inconsistent with its typical usage, the inventor may expand or limit that term in the context of the patent claims.¹⁷

If the foregoing sounds a bit murky, it is. But helpful language is in the cases. There is a ‘heavy presumption’ that a claim term carries its ordinary and customary meaning.¹⁸ And any alternate definition must be used “consistently and clearly”¹⁹ and with “reasonable clarity, deliberateness, and precision.”²⁰

Exception 2 – Express Disclaimer or Disavowal of Claim Scope

The patentee may deviate from the ordinary and accustomed meaning of a claim term by including exclusions or restrictions in the specification, representing a clear disavowal of claim scope.²¹ Unfortunately, this “squishy” language is subject to mischief. We must look to specific case examples for clarity.

Characterizing the Invention Manifesting a Clear Disavowal – The Federal Circuit said, “repeated and definitive remarks in the written description” can restrict a claim limita-

7 *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1324, 1327 (Fed. Cir. 2002); *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

8 *Netcraft Corp. v. eBay, Inc.*, 549 F.3d 1394, 1396-97 (Fed. Cir. 2008); *Kyocera Wireless Corp. v. ITC*, 545 F.3d 1340, 1346-47 (Fed. Cir. 2008); *Phillips*, 415 F.3d at 1312-13.

9 *Phillips*, 415 F.3d at 1313; *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1112, 1116 (Fed. Cir. 2004).

10 *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d at 1582.

11 *Id.*

12 *Markman v. Westview Instruments., Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995).

13 *Phillips*, 415 F.3d at 1316.

14 *Innova/Pure Water, Inc.*, 381 F.3d at 1116-17 (Fed. Cir. 2004).

15 *Rambus Inc. v. Infineon Techs. AG*, 318 F.3d 1081, 1088 (Fed. Cir.), *cert. denied*, 540 U.S. 874 (2003).

16 *Innova/Pure Water, Inc.*, 381 F.3d at 1116-17.

17 *Alloc, Inc. v. ITC*, 342 F.3d 1361, 1368 (Fed. Cir. 2003), *cert. denied*, 541 U.S. 1063 (2004).

18 *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002).

19 *Alloc, Inc.*, 342 F.3d at 1368.

20 *Teleflex, Inc.*, 299 F.3d at 1325.

21 *Voda v. Cordis Corp.*, 536 F.3d 1311, 1320 (Fed. Cir. 2008) (citing *Teleflex, Inc.*, 299 F.3d at 1324).

Problem phrases can trap—and unintentionally trip—inventors. If you represent the inventor, avoid them. If you represent the accused infringer, they may be a godsend:

- “The Invention”
- “Present Invention”
- “Primary Objective”

tion to a particular structure.²² Also, “consistent emphasis” on “this fundamental feature of the invention” was used to limit a claim term.²³ Claim terms include a limitation when doing so “most naturally aligns with the patent’s description of the invention.”²⁴ Finally, the court considers “whether the specification read as a whole suggests that the very character of the invention requires the limitation be a part of every embodiment.”²⁵

Problem Phrases -- Problem phrases can trap—and unintentionally trip—inventors. If you represent the inventor, avoid them. If you represent the accused infringer, they may be a godsend.

- **“The Invention”** – Claims have been limited based on language in the specification repeatedly stating that “the invention” required a specific limitation and that the limitation was applicable to “all embodiments of the present invention.”²⁶
- **“Present Invention”** – While no rule provides that using “present invention” automatically limits claims, repeated use of the phrase may describe the invention as a whole and limit the claims.²⁷ In one case, the court concluded that while the term might limit the ordinary meaning of claim terms, it must be read in the context of the entire specification and did not clearly disclaim or limit claim scope in that case.²⁸
- **“Primary Objective”** -- Courts have limited claims based on the specification’s identification of the “primary objective” of the invention and then distinguished the prior art based on that objective.²⁹

Saving Phrases – Other phrases in the specification may actually *expand* claims:

- **“For example”** – Use of “for example” in the specification may indicate the claim term should not be given a restrictive interpretation.³⁰
- **“Multitude”** -- As Judge William Bryson observed, “[I]t seems unlikely that a claim drafter would use a term of such biblical imprecision as ‘multitude’ if that term were meant to have an important restrictive function in the claim.”³¹
- **Ambiguity or inconsistency** in the use of what might otherwise be a limiting phrase may also preclude use of that phrase to limit claim scope.³² Thus, in the absence of any more convincing interpretation of a claim term, the court may adopt the broader interpretation proffered by the patent owner.³³

Two Rules Precluding Importation of Limitations

Two important rules preclude importation of limitations in specific circumstances.

Claims Not Limited to Preferred Embodiment -- Even though a specification describes only one embodiment, this does not require that each claim be limited to that one embodi-

22 *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366, 1374 (Fed. Cir. 2008) (citing *Watts v. XL Sys., Inc.*, 232 F.3d 877, 882 (Fed. Cir. 2001)).

23 *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1324 (Fed. Cir.) (citing *Ormco Corp. v. Align Tech., Inc.*, 498 F.3d 1307, 1313-14 (Fed. Cir. 2007)), *cert. denied*, 553 U.S. 1032 (2008).

24 *Ormco Corp.*, 498 F.3d at 1313-14.

25 *Praxair, Inc.*, 543 F.3d at 1324 (citing *Alloc, Inc. v. ITC*, 342 F.3d 1361, 1370 (Fed. Cir. 2003)).

26 *Howmedica Osteonics Corp. v. Wright Med. Tech., Inc.*, 540 F.3d 1337, 1345 (Fed. Cir. 2008) (citing *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1342-44 (Fed. Cir. 2001)); *Tivo, Inc. v. Echostar Commc’ns Corp.*, 516 F.3d 1290, 1300 (Fed. Cir.), *cert. denied*, 129 S. Ct. 306 (2008).

27 *Netcraft Corp. v. eBay, Inc.*, 549 F.3d 1394, 1397-98 (Fed. Cir. 2008); *Decisioning.Com, Inc. v. Federated Dep’t Stores, Inc.*, 527 F.3d 1300, 1311 (Fed. Cir. 2008) (citing *Honeywell Int’l, Inc. v. ITT Indus., Inc.*, 452 F.3d 1312, 1317-19 (Fed. Cir. 2006)).

28 *Rambus Inc. v. Infineon Techs. AG*, 318 F.3d 1081, 1094-95 (Fed. Cir. 2003).

29 *Howmedica Osteonics Corp.*, 540 F.3d at 1345 (citing *Ormco Corp.*, 498 F.3d at 1313-14).

30 *See Tivo, Inc. v. Echostar Commc’ns Corp.*, 516 F.3d 1290, 1297 (Fed. Cir.), *cert. denied*, 129 S. Ct. 306 (2008).

31 *Id.*

32 *Voda v. Cordis Corp.*, 536 F.3d 1311, 1320-21 (Fed. Cir. 2008).

33 *See Tivo, Inc.*, 516 F.3d at 1298.

ENHANCING YOUR IP IQ

Vol. III, No.10

OCTOBER 2011

ABOUT SHB

Shook, Hardy & Bacon offers expert, efficient and innovative representation to our clients. We know that the successful resolution of intellectual property issues requires a comprehensive strategy developed in partnership with our clients.



OFFICE LOCATIONS

Geneva, Switzerland
+41-22-787-2000

Houston, Texas
+1-713-227-8008

Irvine, California
+1-949-475-1500

Kansas City, Missouri
+1-816-474-6550

London, England
+44-207-332-4500

Miami, Florida
+1-305-358-5171

San Francisco, California
+1-415-544-1900

Tampa, Florida
+1-813-202-7100

Washington, D.C.
+1-202-783-8400

ment.³⁴ Specifically, the description of a preferred embodiment, in the absence of a clear intention to limit claim scope, is insufficient to narrow the claims.³⁵ Similarly, patent coverage is not necessarily limited to embodiments that look like the ones in the figures.³⁶

A patent applicant is not required to describe every conceivable embodiment of the invention in the specification.³⁷ Whether an invention is fairly claimed more broadly than a single preferred embodiment is dependent on the specification, context in which the embodiment is described, prosecution history, and, if appropriate, prior art.³⁸ Thus, where all embodiments reflect the same limitation, the claim may be so limited.³⁹ Or, statements that the invention uses specific structure or distinguishing close prior art in prosecution history may limit claim scope to one embodiment.⁴⁰

Claim Differentiation -- "Claim differentiation" says that when one claim does not contain a limitation and another claim does, that limitation cannot be read into the first claim to determine validity or infringement.⁴¹ When an applicant uses different terms in a claim, it is permissible to infer he *intended* to reflect differentiation in their meaning.⁴²

The presence of a dependent claim that adds a particular limitation supports a presumption that the limitation is not part of the independent claim.⁴³ Though that presumption is rebuttable, it is especially strong when the limitation in dispute is the only meaningful difference between an independent claim and a dependent claim and one party is attempting to read the limitation from the dependent claim into the independent claim.⁴⁴ So claim differentiation takes on relevance in the context of a claim construction that would render additional or different language in another independent claim superfluous.⁴⁵

What You Can Do

Keep five simple things in mind to prevent committing the cardinal sin:

1. Think to yourself, "How would a person of ordinary skill in the art at the time of the invention construe this term?" If you are unsure, locate such a paragon and ask!
2. Read the specification with an eye toward what the patentee was trying to accomplish. Was she trying to avoid prior art? Was she really limiting the invention? Why, or why not?
3. Beware of "problem phrases" and "saving phrases" in the specification. Why and how are the phrases used? Avoid or use them as appropriate.
4. Look for consistency/inconsistency or clarity/ambiguity in every use of limiting language in the specification. How does it all stack up?
5. Keep the rule of claim differentiation in mind. Every term must have meaning.

34 *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 n.14 (Fed. Cir. 1985).

35 *Decisioning.Com, Inc. v. Federated Dep't Stores, Inc.*, 527 F.3d 1300, 1313 (Fed. Cir. 2008) (citing *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004)).

36 *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1254 (Fed. Cir. 2011).

37 *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1370 (Fed. Cir. 2008) (citing *SRI Int'l*, 775 F.2d at 1121).

38 *Sunrace Roots Enter. Co., Ltd. v. SRAM Corp.*, 336 F.3d 1298, 1305-06 (Fed. Cir. 2003).

39 *Decisioning.Com, Inc. v. Federated Dep't Stores, Inc.*, 527 F.3d 1300, 1311 (Fed. Cir. 2008) (citing *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299-1302 (Fed. Cir. 1999)).

40 *See Watts v. XL Sys., Inc.*, 232 F.3d 877, 882-83 (Fed. Cir. 2001).

41 *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1122 (Fed. Cir. 1985).

42 *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1119, 1123 (Fed. Cir. 2004).

43 *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (citing *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004)).

44 *Sunrace Roots Enter. Co., Ltd. v. SRAM Corp.*, 336 F.3d 1298, 1203-03 (Fed. Cir. 2003) (citing *Comark Commc'ns, Inc. v. Harris Corp.*, 156 F.3d 1182, 1187 (Fed. Cir. 1998)).

45 *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1254 (Fed. Cir. 2011).