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Article

**DID MARKMAN AND PHILLIPS ANSWER THE RIGHT QUESTION? A REVIEW OF THE FRACTURED
STATE OF CLAIM CONSTRUCTION LAW AND THE POTENTIAL USE OF EQUITY TO UNIFY IT**

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Table of Contents

I.	Introduction and Overview	458
II.	Markman and the Illusion That Claim Construction is a Matter of Law	460
	A. Herbert Markman's Amazing Dry Cleaning Inventory System Before the Federal Circuit	460
	B. The Supreme Court Weighs In	465
	C. Did the Markman Decisions Miss an Alternate Framework?	466
III.	The Convoluted Path From Markman to Phillips	467
	A. Vitronics Corp. and the Early Emphasis on Intrinsic Evidence.	468
	B. From Intrinsic to Narrow Constructions	470
	C. The Ordinary Alternative	474
IV.	Phillips--Creating a Lovely Shade of Gray	478
V.	Post-Phillips Claim Construction--As Fractured as Ever	482
VI.	Equity--An Alternative Approach to Claim Construction	483

***458 I. Introduction and Overview**

The progeny of *Markman v. Westview Instruments, Inc.*¹ must seem bewildering and hopelessly convoluted to the casual observer. To anyone who has participated at the fringes of patent litigation, such as in-house counsel, business people, and the public at large, the claim construction process presents a series of seemingly contradictory axioms and promulgations. However, to a savvy (and perhaps somewhat cynical) practitioner, claim construction presents seemingly endless possibilities. No matter the end goal, there is always a legitimate basis for arguing for any--and I do mean any--end.

Unfortunately, this conflicted series of decisions visits upon the district judiciary the unavailing prospect of deciding on an

approach to claim construction among a thicket of possible conflicting yet endorsed perspectives. Each one has supporters and opponents, flaws and advantages. No matter the approach, judges (or magistrates, special masters or clerks, as the case may be) know they have no more than about a fifty percent chance of being upheld at the Federal Circuit. Given that state of affairs, why should judges waste their limited resources on a thorough analysis of claim construction? That they do, and try so very hard, is much more a testament to the dedication of district courts to their charge than any fealty of the Federal Circuit to the laudatory goals of *Markman I*.²

The Federal Circuit now acknowledges that claim construction turns not on any abstracts of law, but is instead informed by extremely fact specific issues including, but not limited to, the accused device and the level of skill in the art at the time of invention.³ This points to the fundamental flaw at the heart of *Markman* or any other effort to turn patents into mini-statutes and raises severe questions as to the value of the last decade of trial and appellate proceedings.

Recognizing that a patent, simply because it takes the form of a written document, is not necessarily amenable to legal construction points to an alternate way of viewing patents as a whole. In a very real sense, a patent is no more and no less than what the government (or the Federal Circuit) deems equitable. Indeed, as patents are rooted in equity,⁴ it would greatly simplify matters to simply admit that *459 the most that can be hoped for from claim construction is not truly a legal construction, but an effort at rough justice predicated on the best possible application of the English language to inchoate ideas. Even the Supreme Court has recognized the impossibility of a patentee in expressing him or herself with perfect clarity (although that imprecision is presumed to disappear once an examiner takes any action requiring an amendment).⁵ Hence, asserting that claim construction is truly a question of law makes no more and no less sense than saying that pornography can be determined by a uniform, precise legal standard. Justice Stewart recognized the fallacy of that approach to indecency nearly thirty years ago;⁶ yet the Supreme Court and the Federal Circuit have remained adamant that courts are somehow blessed with the ability to determine the meaning of patents as a matter of law.

This article reviews the background and result in *Markman* before both the Federal Circuit and Supreme Court, and points to even earlier case law that suggested that the choice between court and jury, based on whether claim construction was a matter of law or fact, perhaps missed the real question. It also examines the divergent scope of claim construction from the simplistic announcement that claim construction is a matter of law, up to the cusp of what was hoped to be the resolution of the issues borne out of *Markman* in *Phillips v. AWH Corp.*⁷ It then delves into the myriad of seemingly contradictory statements in *Phillips* which have either, depending on one's perspective, harmonized or utterly muddled the approaches to claim construction. It then examines the brief but conflicted post-*Phillips* claim construction history, which appears to demonstrate the lack of any consistency moving forward. Finally, in what is not so much a change in the current analytical approach to claim construction, this paper suggests recognizing the impossibility of more than rough justice predicated on assessing fact-intensive, essentially subjective questions, guided only by a loose set of claim construction precepts--a recognition supported by the recent cries of the Federal Circuit for knowledge of the accused device in order to assess the propriety of claim construction rulings. The resulting change would provide more stability and confidence to district courts confronting the claim construction process and some discouragement to those who would treat district court proceedings as merely a dress rehearsal for Federal Circuit arguments.

***460 II. *Markman* and the Illusion That Claim Construction is a Matter of Law**

A. Herbert Markman's Amazing Dry Cleaning Inventory System Before the Federal Circuit

The striking thing at first reading of *Markman I* is the relative simplicity of the technology involved. Herbert Markman's invention was not a stunning advance in the medical or mechanical arts. It did not involve the cutting edge of research. Rather, it was the sort of seemingly mundane advance that the Federal Trade Commission (FTC) and Department of Justice (DOJ) seem to be on a rampage about now in terms of validity--the introduction and adaptation of one known technology (computerized inventory systems) to another (dry cleaning).⁸ Specifically, *Markman* determined that it was necessary to track the progress of articles of clothing throughout a dry-cleaning establishment in order to ensure that customers' orders were not misplaced and to minimize losses due to employees cleaning items without registering them and pocketing the fee otherwise due to the establishment.⁹ To accomplish this, *Markman*'s patent called for a central inventory that was illustrated as being generated by a central computer when articles were first taken in for cleaning and then updated as the article traveled to a variety of stations.¹⁰ While hardly rocket science, the invention was undoubtedly significant to *Markman*. As we will see, that is one thing *Markman* shares with *Phillips*--the technology is so simple that even laypeople could be expected to understand

it. This makes the layers of legal theory espoused seem somewhat like taking an elephant gun to shoot a flea, which may explain in part the tangled use of such cases in practice.

Indeed, perhaps it was the ability to largely ignore any inherent complexities in the art as might be present in chemical or biological patents that caused the focus of the resulting litigation to be on claim scope and on who should make that determination. The key question was the meaning of the term inventory.¹¹ Markman's counsel argued, naturally enough, for a broad construction that would embrace the receipt records maintained by two products made by Westview Industries and used by dry cleaners.¹² Unlike the preferred embodiment of Markman's patent, neither of the accused infringing devices stored a written description of the goods taken in by the store in a central memory, although each could keep a record of printed tags and data (invoice number, date, and cost of services) associated with the tag, and one could be used to track and verify the progress of a particular tag throughout a facility.¹³ The only record the accused *461 infringing device maintained relating to a given order was the total charge for the goods to be cleaned--which Markman's counsel contended was an inventory.¹⁴ Westview Industries argued just as vehemently that the term inventory required a description of the items to be cleaned, not merely a record of receipts.¹⁵

Initially, the district court left the determination of this issue to the jury.¹⁶ The jury was asked to construe terms and then apply the resulting construction to the accused infringing device, but the jury was not asked to indicate its meaning for any given term.¹⁷ Rather, the jury's verdict form simply asked whether the accused device infringed or not.¹⁸ The jury answered in the affirmative as to two of three asserted claims.¹⁹ Needless to say, Markman's counsel was disappointed when the district court later found noninfringement as a matter of law, based on the court's interpretation of the term inventory as requiring some description of the actual clothing.²⁰

On appeal, the focus was whether the lower court should have deferred to the jury verdict. If, as Markman argued, the construction of the term was a question of fact, then the court could not have examined the issue anew, but only for the existence of substantial evidence.²¹ If, on the other hand, construction was a matter of law, then there was no error in the lower court's procedure, but at most a question of interpretation for the Federal Circuit to review *de novo*.²² On this second point, Markman asserted that the district court should have credited extrinsic evidence--that is, material not appearing on the face of or in the record of the patent--in determining the meaning of the term inventory. Specifically, Markman's own testimony, that of a "patent expert," and uses of the term by Westview in its product literature and in its president's testimony were claimed to support the broader meaning of the term.²³

This matter took an unusual procedural route on appeal. After briefing and panel argument, the Federal Circuit determined that a significant enough question was posed by conflicting lines of its authority to bypass a normal panel ruling in favor of deciding the case *en banc* in the first instance.²⁴ The resulting ruling, *462 including concurrences only as to the result by Judges Rader and Meyer, and a dissent by Judge Newman, made it clear that the Federal Circuit viewed the courts (and specifically itself) as best equipped to decide questions of claim construction.²⁵ The majority held that claim construction would therefore be dealt with as a matter of law. As almost an afterthought, the majority also affirmed the construction of the term inventory and the lower court's decision not to credit Markman's testimony and that of his patent expert.²⁶

The majority position facially claimed a number of sources of support for its view that claim construction is a question of law.²⁷ It could not reach back to the time of implementation of the Bill of Rights, the ultimate source for dividing questions of law and fact, as there was no equivalent to a claim in English patent practice in 1791.²⁸ However, without much in the way of examination, the majority did put forth a string of nineteenth and early twentieth century cases for the idea that claim construction had historically been done as a matter of law.²⁹ While acknowledging that some of its decisions suggested otherwise, the court also noted that some of the earliest Federal Circuit decisions had indicated claim construction was a legal issue.³⁰

Beyond this, the direct analysis was surprisingly scant. Initially, the majority found that making constructions legal rather than factual was supposedly more sensible because a patent is a written document and courts generally construe such instruments.³¹ The majority noted that a patent, at least in conjunction with its prosecution history, is meant to be a fully integrated document.³² As such, it was viewed as akin to a deed or other legal writing historically interpreted as a matter of law.³³ As will be discussed further below, the majority was enamored by the idea that claim construction was akin to statutory interpretation, as it amounted to a definition of "the federal legal rights created by the patent document."³⁴ It was stated that competitors "may understand what is the scope of the patent owner's right by obtaining the patent and prosecution history . . . and applying established rules of construction to the language of the patent claim in the context of the *463 patent."³⁵ Similarly the majority expected that "a judge, trained in the law, will similarly analyze the text of the patent and its associated

public record and apply the established rules of construction, and in that way arrive at the true and consistent scope of the patent owner's rights to be given legal effect."³⁶ All of these reasons led to the conclusion that there was "much wisdom to the rule that the construction of a patent should be a legal matter for a court."³⁷

In an effort at responding to the argument raised by the dissenting and concurring opinions that fully integrated contracts and documents such as deeds and wills are still nonetheless sometimes interpreted by juries, the majority had difficulty illustrating problems with such an approach.³⁸ The focus of this discussion was the one-sided nature of the proceedings leading to a patent, the lack of testimony on intent, and its general irrelevancy.³⁹ The examiner, for example, is not permitted to testify as to intent, and anything the prosecuting attorney has to say is suspect.⁴⁰ Moreover, the majority noted that as patents are not written by inventors but attorneys, even the inventor's subjective view of the scope of his invention would be of little use in determining the true scope of the patent (hence also striking a blow against Markman's key evidence for his proposed construction).⁴¹

Instead of considering it a contract, the majority analogized construing a patent claim to construing a statute and applying it to a situation.⁴² The majority found commonality in the limitation to the written record for obtaining indications of intent.⁴³ The majority also noted that a statute, like a patent, lacks any input from the party it will later be applied against and in theory should have a single, consistent meaning.⁴⁴ From these common points, the majority found that a patent, like a statute, could and should be construed as a matter of law.

In doing so, the majority also suggested that claim constructions would likely have a preclusive effect in a number of ways.⁴⁵ Obviously, claim construction *464 often suggests the outcome of a patent case. A claim construction also becomes law of the case, and if it becomes a final judgment will have a preclusive effect between the parties. The majority seemed to suggest, however, that as with a statute any construction would have a measure of preclusive effect.⁴⁶ This has not proven correct in most cases, as no infringer is bound by the construction derived from a prior case, and district courts are split on whether to give any preclusive effect to prior claim constructions.⁴⁷ It suggests, however, why the majority might have found its conclusion advantageous--if a claim construction would have some level of preclusive effect, in the long run it would promote the harmonization of patent laws at the core of the Federal Circuit's creation and reduce the burdens on the court by avoiding the need for repetitive appeals over the meaning of the same terms.⁴⁸

Judge Mayer, however, saw the impact of making claim construction exclusively a question of law as far more detrimental than the benefit of any perceived consistency.⁴⁹ Judge Mayer took the majority to task for paying insufficient heed to the impact of claim construction on the outcome of trials.⁵⁰ While acknowledging that the ultimate issue is a legal question, he found the majority had overstated its legal authority for the idea that there are no underlying factual issues to be determined.⁵¹ Going through several of the cases cited by the majority, he found that they did not produce a question of fact as there was only one possible construction.⁵² The concurrence also challenged the wisdom of assuming that judges were better equipped than juries to assess the factual underpinnings of claim construction and the potential issues of credibility.⁵³ Presciently, moreover, Judge Mayer stated that rather than bringing consistency, "the effect of this case is to make of the judicial process a charade, for notwithstanding any trial level activity, this court will do pretty much what it wants under its de novo retrial."⁵⁴

In her dissent, Judge Newman went farther than either the majority or Judge Mayer in examining the historical role of juries in patent cases.⁵⁵ Counter to the *465 historical viewpoint of the majority, she traced the English practices of the eighteenth century.⁵⁶ She noted that although patent cases were initiated in chancery, unless they were unopposed they would be resolved by a jury.⁵⁷ As English practice did not include examination of the patent prior to issuance, Judge Newman noted that juries were charged with determining validity as well as infringement.⁵⁸ Judge Newman traced this practice through American patent practice and found cases which she asserted (in contrast to the majority) indicated that juries were at least afforded the opportunity to supply their own interpretations of aspects of patents in reaching the ultimate conclusion of infringement and validity.⁵⁹ Given the significance of claim construction, Judge Newman argued it would effectively deprive a jury (or even a trial judge) of a meaningful role as the Federal Circuit would now resolve what evidence to credit based on brief hearings and de novo review.⁶⁰ Since the majority also acknowledged district courts might hold evidentiary hearings and receive testimony as part of claim construction in order to decide contested technical meanings, she noted that this would appear to create a novel "mini-trial" without the historic protections associated with trial proceedings.⁶¹ As all of this effort would then be subject to revised fact finding by the Federal Circuit on appeal, based on no more than briefs and half an hour of appellate review, Judge Newman questioned how the Federal Circuit could possibly be in a better position to properly determine the meanings of technical terms.⁶²

B. The Supreme Court Weighs In

The Supreme Court unanimously affirmed the ruling of the Federal Circuit, but largely on unrelated grounds.⁶³ It implicitly rejected the majority's view that claim construction had historically been done as a matter of law, instead noting that current claim practice was a relatively recent phenomenon not in existence in 1791 (again, the framework for assessing whether there was a right to a jury trial).⁶⁴ While readily finding a right to a jury trial on the ultimate issues of infringement and validity, the Court did not find this right necessarily required a jury trial on all issues impacting those ultimate questions, such as claim construction.⁶⁵ Instead, it found that it was a close question, but found that ultimately the experience of *466 district courts in determining the scope of written documents weighed sufficiently strongly in favor of assigning the task to judges exclusively as to uphold the Federal Circuit majority's ruling.⁶⁶ In doing so, notably, the Supreme Court retreated from any broad preclusive effect for individual claim constructions, noting instead the general value of such rulings in regulating the conduct between the parties and that making claim constructions a legal issue will "promote (though it will not guarantee) intrajurisdictional certainty through the application of stare decisis on those questions not yet subject to interjurisdictional uniformity under the authority of the single appeals court."⁶⁷

C. Did the Markman Decisions Miss an Alternate Framework?

Whatever value the Federal Circuit and Supreme Court's discussion of the jury's historical role in determining patent cases may have had, deciding whether claim construction was a question of law or one of fact may not have been the right question. In 1933, the Supreme Court noted in *Keystone Driller Co. v. General Excavator Co.* that the enforcement of a patent is in the first instance an action in equity.⁶⁸ The Supreme Court recognized unclean hands as a complete defense to an action to enforce a patent.⁶⁹ Although the focus of *Keystone Driller* was using litigation misconduct (particularly, active efforts at suppressing evidence of a potential prior public use of the invention) as a basis for denying enforcement of a patent, an idea that has evolved into the doctrine of inequitable conduct,⁷⁰ its guiding principle was that there is a fundamentally equitable aspect to all patent litigation.⁷¹ This concept seems to have been completely lost in the *Markman I* debate over claim construction. At most, there was the reference by Judge Newman to the fact that as creatures of equity, an action for enforcement of a patent in England would commence in the courts of chancery.⁷² The recognition of this fact, though, was followed by the notation that jury trials were conducted if infringement or validity were contested.⁷³ The Supreme Court, in largely ignoring the historical debate in the Federal Circuit majority and dissenting opinions, similarly ignored any consideration of the role of equity in determining claim construction in *Markman II*.⁷⁴

*467 Although the idea will be examined in more detail *infra*, one cannot but wonder what impact a greater recognition of the equitable nature of patent rights and patent infringement actions might have had on the outcome of *Markman I* and *II*. One way to read *Keystone Driller* and *Precision Instrument* is that there is no entitlement to a patent that covers any more or any less than what is equitable in light of all the evidence--and withholding evidence from that determination is itself so inequitable as to bar enforcement.⁷⁵ As will be discussed below, applying such an approach to claim construction would seem to harmonize much of the divergent case law by stripping away the artificial expectation of uniformity created by the "matter of law" pronouncement in *Markman I* and *II* from what are essentially equitable, fact specific determinations. It may also have the salutary effects of increasing the finality of district court rulings and perhaps decreasing the tendency of so many patent appeals on claim construction.

III. The Convoluted Path From Markman to Phillips

Rather than getting too far ahead of ourselves, it is worthwhile to examine some of the claim construction developments in the decade after the original *Markman I* ruling leading up to *Phillips III*. In the mid to late '90s, a series of opinions began to suggest that almost all claims would be construed solely on the record of the patent, which led to narrow constructions in most cases.⁷⁶ At one point the court went so far as to favor a narrow construction even if both narrower and broader meanings were equally supported by the intrinsic record.⁷⁷ This was followed with the en banc holding in 1998 that no seemingly factual resolutions in arriving at a claim construction were entitled to deference--making clear that the Federal Circuit had the unfettered power to arrive at whatever construction it wanted.⁷⁸ Following *Cybor Corp. v. FAS Technologies, Inc.*, there were a number of further cases in the same vein of narrow constructions.⁷⁹ While these cases generally arrived at constructions consistent with the equities of a given situation, to support these rulings the Federal Circuit turned to evidence that would seem rife *468 with credibility issues or other fact determinations that defied the idea of claim construction as a purely legal doctrine.

Perhaps inevitably, a counterpoint set of cases began to arise in the aftermath of *Cybor Corp.* These looked for objective but essentially extrinsic sources for the ordinary meaning of claim terms as an initial point of comparison to the specification.⁸⁰ These cases, focused as they were on general meanings and looking to the specification only for confirmation or conflict, typically gave broader constructions than those focused on the specification, but no less proper in the context of the particular case. The result of this was the tension between cases that suggested no term had an ordinary meaning unless a phrase, as a whole, had a special meaning as shown by testimony of those of skill in the art⁸¹ and cases that used the dictionary and/or specification to define each component part of a phrase as a whole in order to preserve the claim from a finding of indefiniteness.⁸² As we will see *infra*, *Phillips III*, the case expected to reconcile all of these divergent approaches, has instead haphazardly meshed them into Frankenstein's monster, complete with unintelligible speech and a lurching, unsteady gait.

A. Vitronics Corp. and the Early Emphasis on Intrinsic Evidence.

Although cases before and since have said much the same, *Vitronics Corp. v. Conceptronic, Inc.*⁸³ is the touchstone for anyone seeking to assert a narrow claim construction based purely on an examination of intrinsic evidence.⁸⁴ Ironically, though, in *Vitronics Corp.* the principle was used not to decide between narrow and broad constructions but between two distinct interpretations supported by different bodies of evidence.⁸⁵ There, the patent related to "a method for the reflow soldering of surface mounted devices to a printed circuit board in which the circuit board is moved by a conveyor through a multizone oven."⁸⁶ The key issue on appeal was the meaning of the phrase "solder reflow temperature," which according to *469 to the claim had to be higher than the temperature of the oven to find infringement.⁸⁷ The plaintiff, *Vitronics*, asserted that the term referred to the "peak solder reflow temperature," a value typically significantly higher than the initial temperature at which solder turns to liquid, and hence much more likely to be infringed.⁸⁸ This was based nearly entirely on two passages in the specification.⁸⁹ *Conceptronic*, on the other hand, sought to define the term based on expert testimony, testimony from *Vitronics*' chief engineer, and writings from *Vitronics*' employees and counsel, all to the effect that the term "solder reflow temperature" was the same as the lower "liquidus" temperature.⁹⁰ After hearing all the evidence without a claim construction, the district court announced it was adopting *Conceptronic*'s position, which led to a concession of noninfringement by *Vitronics*.⁹¹

On appeal, the Federal Circuit managed to recite nearly every maxim on claim construction in less than four pages.⁹² Relying largely on the Federal Circuit *Markman I* decision, the court set out what appears at first glance, a straightforward, step by step claim construction procedure.⁹³ Boiled down, it consists of reading the claim, the specification, and the prosecution history (if in evidence), in that order.⁹⁴ If the meaning of a term is unclear--and *Vitronics Corp.* suggests it will not be in all but a handful of cases, indicating the intrinsic record should ordinarily be a lexicon to some degree--then the use of truly extrinsic evidence is warranted to resolve any ambiguity.⁹⁵ However, in no event can such evidence trump a meaning arising from the intrinsic record.⁹⁶ Based on that rubric, the panel found the lower court had erred in crediting extrinsic evidence, however compelling the sources, over the discussion of the preferred embodiment in arriving at the meaning of "solder reflow temperature."⁹⁷

If *Vitronics Corp.* had simply made these points clearly and boldly, and the case had been embraced fully by the Federal Circuit, then it would have ended much of the debate over claim construction methodology, and most patent terms would receive meanings consistent with narrowest aspects of the intrinsic record. In furtherance of the second goal of giving patent terms their ordinary meanings, *470 though, *Vitronics Corp.* dramatically undercut whatever value its announced procedure would have otherwise had. Initially, it suggested that there were free-standing ordinary meanings for terms that could be sought from the collective knowledge of those of skill in the art.⁹⁸ Hence, the four corners of the intrinsic record could not be read as a dictionary without clear evidence to that effect.⁹⁹ To underscore that point, the court in *Vitronics Corp.* held that dictionaries, learned treatises, and the like, despite their plain separation from the intrinsic sources, are not extrinsic evidence in the sense of materials to be consulted only as a last resort.¹⁰⁰ Rather, they (and to a lesser extent prior art) represent a source for evidence of ordinary meaning¹⁰¹ and hence serve as a bulwark against reading too much into the use of a term in a patent itself. *Vitronics Corp.* also suggested that experts could be used to provide similar background information on the art to ground the court, without coming within the ambit of impermissible use of extrinsic evidence.¹⁰² So what can (and has on occasion) been read as a precise road map of a well known area is really more like a sketch of uncharted territory.

B. From Intrinsic to Narrow Constructions

Certain decisions coming after *Vitronics Corp.* suggested that despite the contrary language a rigid set of precise claim

construction instructions had been provided--one which would almost always favor a narrow construction. One of the first of these cases was *O.I. Corp. v. Tekmar Co.*¹⁰³ There, the court below interpreted the term “passage” as a means-plus-function element despite the fact it was described structurally in the claim and the patent.¹⁰⁴ Based on that conclusion, the claim was limited to the passage structures disclosed in the specification, all of which were “either non-smooth or conical.”¹⁰⁵ Although the Federal Circuit readily found the lower court’s methodology was in error, it found the resulting conclusion of noninfringement correct and hence any error was harmless.¹⁰⁶ In doing so, the panel boiled *Vitronics Corp.* down to the statement “[i]n construing [a] claim limitation, we look to the claim language, the written description, the prosecution *471 history and, if necessary, extrinsic evidence.”¹⁰⁷ Given that the specification did not mention any smooth-walled, nonconical passages, and at one point distinguished prior art as smooth-walled, the court found the claim could not encompass the smooth-walled, cylindrical passage of the accused device.¹⁰⁸

There is no doubt that the court correctly noted the lack of positive, broad descriptions of the term “passage.” At the same time, the Federal Circuit’s description of the accused device as containing a passage, albeit one with several modifiers, suggests the court really found a unique meaning for the term. This, in turn, appears to ignore the statement in *Vitronics Corp.* itself that:

Although words in a claim are generally given their ordinary and customary meaning, 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.¹⁰⁹

Rather than seek a clear definition, though, the court in *O.I. Corp.* simply took the description of the specification as an implicit disclaimer, suggesting that from this time on the narrowest aspects of a specification would likely be used to limit otherwise broad language.¹¹⁰

This trend continued in *Wang*. This decision by Judge Newman (on record in *Markman I* as opposing the entire concept of claim construction as a matter of law)¹¹¹ was revealing in what it considered as evidence and how it chose to limit the patent. The term at issue was “frame,” in the context of retrieving specific frames of information from central videotex storage (accused products, for example, included bookmarks on AOL).¹¹² It was conceded that at least two meanings for the term existed, referring to character-based and bit-map display systems.¹¹³ The specification used only references to character-based systems in describing the preferred embodiment.¹¹⁴ However, it did recognize the existence of “bit-map display” systems in the background of the art, at least suggesting the broad nature of the art.¹¹⁵ The court rejected this as evidence of breadth, instead finding the description of the preferred embodiment demonstrated the term was intended to be limited.

*472 Intriguingly, beyond the description of the preferred embodiment, the court next turned to purely extrinsic evidence. Specifically, the fact that the inventor’s testimony--testimony that would not have sufficed under *Markman I* to demonstrate a broad meaning for the term, reflecting at most subjective intent not reflected in the patent--indicated a bit-mapped system had not been developed by *Wang* was used to support applying the narrow claim construction.¹¹⁶ Again, this runs counter to the court’s recognition in *Markman I* that an inventor may often underplay the value of his invention or otherwise not recognize its true scope.¹¹⁷ This seemed to suggest a one-way ratchet effect to claim construction--anything to limit, nothing to broaden.

A similar result, albeit without the diversion of extrinsic evidence, occurred in *Watts*. The claim in question was the meaning of the term “sealingly connected” in the context of connecting joints of oilwell tubing.¹¹⁸ The specification described the invention as using the feature of “misaligned taper angles to effect a seal.”¹¹⁹ Once again, these references were taken as sufficient to provide the term with a unique meaning, limited to “misaligned taper angles” as an explicit limitation.¹²⁰ No discussion was made of what a person of skill would view as the ordinary meaning of the term, other than rejecting an effort by the patent holder to point out the breadth of connection techniques known in the art generally.¹²¹ This case, coupled with *O.I. Corp.* and *Wang*, became a murderer’s row for defendants seeking narrow claim constructions--no brief was complete without them.

One case that did not get cited quite as often was *Toro Co. v. White Consolidation Industries, Inc.*--perhaps because the subject matter of *Toro* was almost surreal to many patent practitioners. In *Toro*, what proved to be the dispositive issue on appeal was the meaning of the term “including.”¹²² Specifically, whether a patent to a leaf blower with a cover including means for increasing the pressure could cover means that formed part of an overall cover assembly but not permanently affixed to an outer cover.¹²³ The term including is such a common term, indicating some form of relationship, it is doubtful that anyone thought of whether the term was intended to connote attachment, much less whether that attachment had to be fixed. Indeed, as Judge Rader noted in his *473 dissent, among patent attorneys the term is on a par with having and

comprising, typically connoting nothing more than a comprehensive list.¹²⁴

The panel in *Toro*, though, saw the term as referring to structure. In doing so, the panel once more ignored the recognition in *Markman I* that patents are not drafted by persons of skill in the art, despite being directed at them, and hence sometimes employ terms of patent art rather than technical art.¹²⁵ Moreover, despite recognizing that “no special meaning in the field of the invention is attributed” to the term, the panel nonetheless limited “including” to a mechanical attachment between the cover and means for increasing pressure.¹²⁶ The panel went to great lengths to explain that the specification, while extensive, was strictly one-dimensional in its depiction of the invention.¹²⁷ As that singular depiction was universally a permanently affixed structure, the removable structure in the accused device took it outside of the literal scope of the claims.¹²⁸ This reflects either the high (or low) water mark of the intrinsic evidence branch of claim construction, with its near complete disassociation of standard patent prosecution practice and the Federal Circuit.

Other panels, while acknowledging the idea that ordinary meanings can exist and be used in a patent regard, have so twisted the application as to suggest that people of skill in the art do not interpret compound terms the way most people decipher such terms--by breaking them into their component parts. In *Vanderlande Industries Nederland BV v. International Trade Commission*, for example, a patented conveyor belt sorting system included a “glide surface” intended to improve the action of a “diverter shoe” in pushing objects off the conveyor belt to spur tracks.¹²⁹ The only defense to infringement was a desperate attempt at defining the “glide” in glide surface as referring to a physical structure used to assist in making furniture more movable.¹³⁰ While properly rejecting this attempt at a tortured use of one of several dictionary meanings, the panel went far beyond what was necessary to resolve this issue. It announced that henceforth ordinary meanings derived from normal use of the English language could only apply to terms that, once subjectively carved up by either the judge or attorney, had a distinct meaning to a person of skill in the art.¹³¹ Hence, that the term “surface” is perfectly comprehensible, and that glide was plainly intended to modify the nature of the surface, was of no moment as there was testimony that there was no *474 uniquely defined glide surface in the relevant art.¹³² Instead, and in all cases where there was no positive evidence that those skilled in the art “would understand a claim term to have the same meaning in the art as that term has in common, lay usage,” the term would have to be construed solely on the basis of the specification, since “general-usage dictionaries are rendered irrelevant with respect to that term.”¹³³ Taken to its logical extreme, and in conjunction with *Toro Co., O.I. Corp.*, and *Wang*, this holding would mean that almost no patent term could be given an ordinary meaning--the use of a single modifier would make each term one of art, and any description in the specification would likely be seen as defining the term. Fortunately, that extreme has only rarely been reached.

C. The Ordinary Alternative

From the beginning there were also panels that seized on the idea of ordinary meanings cited in *Vitronics Corp.* as the primary focus of claim construction. This line of cases inserted the quest for ordinary meanings as evidenced by the language of the claims as the initial step in the process, with the remainder of the intrinsic evidence supplying a check on overbreadth. While delineated most clearly in *Texas Digital*, and addressed in *Phillips III* based on the *Texas Digital* articulation, this idea was actually a theme in claim construction cases for a number of years.¹³⁴

Take, for example, *Johnson Worldwide Associates v. Zebco Corp.*¹³⁵ This case, announced within months of *Vitronics Corp.*, rejected the idea that a broad term must always be construed in conjunction with the uses in the preferred embodiment.¹³⁶ In *Johnson Worldwide*, the patent referred to a steering control apparatus for a trolling motor, with the idea being that a “heading lock” would keep the boat headed in a constant direction without “constant manipulation of trolling motor controls.”¹³⁷ The preferred embodiment and some of the figures of the patent depicted a physically attached compass.¹³⁸ From that, the defendant attempted to argue the term “heading” had to refer to the orientation of the motor and that the “heading lock” therefore had to be connected to the motor.¹³⁹ The district court disagreed with the defendant and found literal infringement at the summary judgment stage.¹⁴⁰

*475 On appeal, the Federal Circuit affirmed the Western District of Wisconsin.¹⁴¹ Like in *Vitronics Corp.*, the court noted that the analysis must begin “with the language of the claims.”¹⁴² Unlike *Vitronics Corp.*, though, the court did not simply gloss over the concept of giving terms “their ordinary and accustomed meaning.”¹⁴³ Instead, marshalling cases back to the founding of the Federal Circuit it announced the favorite maxim of anyone looking for a broad interpretation of a patent claim: “In short, a court must presume that the terms in the claim mean what they say, and, unless otherwise compelled, give full effect to the ordinary and accustomed meaning of claim terms.”¹⁴⁴ The panel went on to find only two circumstances justifying a definition out of the ordinary: 1) lexicography by the patentee, as shown “by clearly setting forth an explicit

definition for a claim term” and 2) where the claim language is so unclear “that there is no means by which the scope of the claim may be ascertained from the language used.”¹⁴⁵ It found no such evidence in the patent in suit, and hence gave “heading” a broad meaning of “direction” rather than limiting it to the direction of the trolling motor.¹⁴⁶ This case set the court on the second leg of the divergent paths that would culminate in Phillips III.

This line of ordinary meaning constructions continued in *Gart v. Logitech, Inc.* “The technology involved relates to ergonomically shaped computer mouse for reducing muscle fatigue.”¹⁴⁷ The district court determined that a claimed “angular medial surface” for resting three fingers required a “ledge,” a surface supporting those fingers “in an enclosed or folded position” and granted summary judgment of noninfringement.¹⁴⁸ On appeal, the panel found the actual claim term should be given its ordinary--that is, dictionary-- meaning of angled surface.¹⁴⁹ Despite the fact the specification described and the drawings depicted a ledge, the panel found that the specification did not plainly and clearly evidence an effort at lexicography by the patentee.¹⁵⁰ Since the specification and prosecution history was only to be consulted for lexicography or to provide meaning to otherwise unclear terms, there was no basis for importing the specification’s depiction into the claim term.¹⁵¹

***476** An offshoot of this line of cases’ view was the idea that all meanings consistent with the specification should be embraced, rather than trying to decipher if a single meaning had more support. In *Brookhill-Wilk 1, L.L.C. v. Intuitive Surgical, Inc.*, the term at issue was “remote location” in a patent relating to remotely monitoring and directing robotic surgery.¹⁵² The specification had abundant recitations of remote in the sense of great distance, but no direct indication of how close a physician could be before he or she was no longer remote.¹⁵³ The defendant convinced the district court that these depictions indicated that a meaning of “outside the operating room” applied.¹⁵⁴ On appeal the panel found that nothing in the patent was inconsistent with the full range of meanings for the term, which would indicate a physician could be remote so long as he or she were not capable of directly interacting with the patient (i.e., at more than arm’s length).¹⁵⁵ This conclusion was bolstered (although arguably it did not need to be) by the clarification in prosecution that the surgeon is not within arm’s length and hence cannot manually interact with the patient.¹⁵⁶ Thus, in at least this case, having only a single, distinct depiction was not necessarily adequate evidence of a narrow meaning.

In most regards, *Texas Digital Systems, Inc. v. Telegenix, Inc.* did not alter this law. Instead, it provided a clear justification for using dictionaries, learned treatises, or other third-party sources as the first step in understanding the ordinary meaning of the claim language.¹⁵⁷ As *Texas Digital* points out, in the absence of some neutral grounding in the art, it is easy to see the limited use of a term in the specification as a definition where none is intended.¹⁵⁸ By using nonlitigation driven sources the court is placed in a better position to perhaps appreciate the true scope of the term as ordinarily employed in the art, rather than as subjectively understood by the litigants or illustrated in the patent.¹⁵⁹ Hence, the supposed value of this approach is to make the process clearer and give to inventors the full measure of their invention.¹⁶⁰

Unfortunately, though, not even the cases embracing dictionaries were necessarily all that clear. In *Novartis Pharmaceuticals Corp. v. Eon Labs Manufacturing, Inc.*,¹⁶¹ for example, the term in question was “hydrosol.”¹⁶² This ***477** is a fairly common term in the biological arts--so common, in fact, as to have several different meanings depending on whether one is dealing with lab science or medicine.¹⁶³ Here, though, the panel found that while it could use a dictionary in the first instance, that definition (as can happen) itself left questions as to the ultimate meaning of the term.¹⁶⁴ To answer those questions the majority turned to another dictionary definition (of sol), a third (of solution), and then finally a fourth (of medicine).¹⁶⁵ This compounding of sources, as the dissenting opinion pointed out, led to a meaning for the term requiring soluble compounds--something that the compound addressed by the invention, cyclosporine, specifically was not.¹⁶⁶ Sticking to the original dictionary definition for hydrosol arguably would not have created this incongruity. Hence, the mere use of impartial sources does not guarantee a sensible, or even seemingly even-handed result.

Needless to say, the divergent approaches after *Markman* left the door open to make just about any argument possible on claim construction. Want a narrow construction? Assert that the specification plainly defines a term by citing *Vitronics Corp., Wang, Watts, and Toro*. Need a broad meaning to win? Trot out treatises and dictionaries while citing *Johnson Worldwide, Gart, Texas Digital, and Brookhill-Wilk 1*. Arriving at the proper claim construction, far from seeming like the sensible application of a legal doctrine, seemed more akin to sculpting from a block of stone, in which whatever was not the right construction was chipped away from a particular claim.

It is also reminiscent, of course, of Justice Stewart’s definition of pornography--judges would know the right construction when they saw it.¹⁶⁷ The Court determined en banc in *Cybor Corp.* that no aspect of claim construction was entitled to deference,¹⁶⁸ moreover, it was solely the view of any two members of the Federal Circuit that mattered, not anything the district court did. The district judge was, at best, compiling a record for review, and at worst serving as the “trial run”

prophesied in the concurrence and dissent to Markman I, with that body doing “whatever they wanted” on appeal.¹⁶⁹

All of this confusion did not go entirely unnoticed by the Federal Circuit. Various efforts were made at setting out rules regarding when and how to read a *478 patent. Vitronics Corp. itself is written as a step by step analysis.¹⁷⁰ Yet the lack of consensus was shown four years after Vitronics Corp. in Judge Dyk’s concurrence to Scimed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc., wherein he suggested a need for greater clarity as to when and how “to look to the specification to narrow the claim by interpretation Until we provide better guidance, I fear that the lower courts and litigants will remain confused.”¹⁷¹ Perhaps not surprisingly, Texas Digital came out the next year in an effort at doing just that.¹⁷² In the years after, a growing sense emerged that something had to be done, leading to the decision in Phillips II to take up en banc the issues of the use of various sources for claim construction and whether any issues of fact could be present in a claim construction.¹⁷³

IV. Phillips--Creating a Lovely Shade of Gray

Out of the post-Markman confusion came the panel decision in Phillips I,¹⁷⁴ which demonstrates the unpredictability in claim construction that differentiates it from anything one would normally associate with a question of law. The technology at issue in Phillips I was, once more, straightforward and fairly simple--modular wall panel systems for use primarily in security and prison environments.¹⁷⁵ The key term in Phillips I was “baffle,” a simple term typically referring to a “means for obstructing, impeding, or checking the flow of something.”¹⁷⁶ Although the parties had agreed to this meaning, the lower court had construed it as a means-plus-function claim and limited it to the preferred embodiment’s disclosure of baffles at an angle and forming a barrier in the interior of the wall of the module.¹⁷⁷ Despite finding that the term should not have been construed as a means-plus-function element, two of the three members of the panel felt obligated to read the term in view of a fairly narrow description of the preferred embodiment, which described the baffle as possessing bullet deflecting properties as a result of its angle at other than ninety degrees relative to the rest of the wall.¹⁷⁸ In doing so, the panel found that limited depictions of baffle segments at ninety degrees to the wall “merely support the predominant angled portions that impart the *479 bullet deflection properties that Phillips identifies as essential to his invention and are not identified as baffles.”¹⁷⁹ In dissenting in part, Judge Dyk viewed this as the result of an erroneous focus on the narrowest aspects of the specification rather than the ordinary meaning of the term.¹⁸⁰ En banc rehearing was subsequently granted.¹⁸¹

In granting rehearing and soliciting amicus curiae briefs, Phillips II proposed to redefine all aspects of claim construction. In blunt terms, it called for comments on whether and when extrinsic evidence could ever be used for claim construction.¹⁸² It also dangled the prospect that the Federal Circuit would reconsider the question of the standard of review and deference to be given to lower courts’ fact findings.¹⁸³ Not surprisingly, the response from the legal and business communities was significant, with no fewer than thirty-six amicus briefs representing a range of divergent viewpoints.¹⁸⁴ Given the fractured nature of the court’s jurisprudence, it seemed likely a clear doctrinal choice would have to emerge, with either the intrinsic review or ordinary meaning camp succeeding in obtaining a narrow majority.

Instead, the Federal Circuit nearly unanimously elected to blend all the various theories into a thoroughly murky shade of gray--a mishmash that is not offensive to most, but inspiring to none. Initially, the court started from the idea that ordinary meanings should be sought.¹⁸⁵ It then re-emphasized the core Vitronics Corp. emphasis on the intrinsic record, beginning with the claims, then the specification and prosecution history.¹⁸⁶ Taking more space than Vitronics Corp. itself, the court emphasized the role of intrinsic review in (1) ensuring that the notice function of 35 U.S.C. § 112 is served and (2) avoiding substitution of overbroad meanings for those truly supported by the specification.¹⁸⁷ If the court had simply stopped there, as it could have in Vitronics Corp., the debate would have been resolved. While it would have disappointed many practitioners, the stated goal of Markman I of creating a uniform process that could be meaningfully and consistently applied by both competitors and judges would have been met.

*480 Rather than doing so, the panel went on to clarify the reasons that it was disapproving the holding of Texas Digital.¹⁸⁸ The primary alleged defect was, given the range of potential dictionary or treatise definitions available, the court in Texas Digital failed to adequately emphasize the value of the intrinsic record, as it assumed such ordinary meanings controlled and used the specification only to confirm or check for conflict with those meanings.¹⁸⁹ At the same time, the panel noted that the court in Texas Digital had its heart in the right place, if not its head.¹⁹⁰ The Phillips III opinion re-emphasized the danger sought to be dealt with by the rules in Texas Digital--namely that without some grounding in the art, a court would be tempted to assume the specification was meant to be a universal lexicon.¹⁹¹ However, the court found the rigidity of Texas Digital unwarranted, as the patent itself should indicate whether it intended to impose limitations on claim meanings.¹⁹²

Indeed, avoiding rigidity of any sort seems to have been the largest part of the rationale behind Phillips III.¹⁹³ Whatever force the initial re-emphasis of Vitronics Corp. might have had, it was obviously undercut by preserving the rationale, if not the methodology, of Texas Digital.¹⁹⁴ The re-emphasis on the use of the intrinsic record was further undercut, if not wholly destroyed, by a single paragraph near the end of the portion of the opinion addressing claim construction methodology.¹⁹⁵ There, it was made clear a district court could receive evidence in any order and of any nature (other than conclusory expert testimony) so long as the judge was cognizant of the limitations and problems with each kind of evidence.¹⁹⁶ Thereafter the lower courts were essentially empowered to do whatever they wanted to on the issue of claim construction. Moreover, as the Federal Circuit simultaneously rejected any effort to review Cybor Corp. and the issue of deference to factual issues, notwithstanding having voted to hear that issue en banc, the Federal Circuit was similarly re-emphasizing its right to do whatever it wanted to on appeal.¹⁹⁷

The application of these principles to the question of the meaning of baffle reached a result that must have been, well, baffling to the original panel *481 members.¹⁹⁸ On the one hand, an emphasis had been placed on the very sort of intrinsic analysis the panel majority had engaged in.¹⁹⁹ However, by focusing on the context of the claim the term appeared in and its differentiation from others, the opinion gave a much broader meaning to the term.²⁰⁰ Essentially, the panel found the dictionary definition of a “means for obstructing, impeding, or checking the flow of something” applied without any limitation to a particular angle.²⁰¹ The narrow meaning arrived at by the panel majority was rejected as reading too much into the term.²⁰²

By adopting basically everyone’s views, all but three of the members of the Federal Circuit could sign off on the opinion in its entirety, apparently in good conscience--and Judge Lourie objected only to the Monday morning quarterbacking by the court en banc of the claim construction he had rendered in the panel decision below.²⁰³ Also, by adopting the legal position of one party and the factual stance of the other, arguably no one could appeal. The blistering dissent by Judge Mayer (also joined by Judge Newman), however, indicated that in the absence of acknowledging the factual nature of many of the subsidiary findings in claim construction, the entire effort was pointless.²⁰⁴ He noted that the de novo review standard was purely a creation of Federal Circuit law, rather than the Supreme Court’s pragmatic holding in Markman II.²⁰⁵ Beginning by citing his conviction “of the futility, indeed the absurdity, of this court’s persistence in adhering to the falsehood that claim construction is a matter of law devoid of any factual component,”²⁰⁶ Judge Mayer ended with a damning prediction: “Eloquent words can mask much mischief. The court’s opinion today is akin to rearranging the deck chairs on the Titanic--the orchestra is playing as if nothing is amiss, but the ship is still heading for Davey Jones’ locker.”²⁰⁷

***482 V. Post-Phillips Claim Construction--As Fractured as Ever**

The cases applying Phillips have proven every bit as fractured as the prior jurisprudence. In one of the first cases to apply the holding, *Research Plastics, Inc. v. Federal Packaging Corp.*,²⁰⁸ the panel relied purely on intrinsic evidence to reach a construction of “rear end” in the context of a tube of caulk.²⁰⁹ Specifically, the panel found that by various references in the specification and prosecution the term had to apply to the rear-most edge of the tube.²¹⁰ While broadening the term to include both the inner and outer surface of that edge, the court rejected any claim to the entire rear region of the tube (as might occur from using the term “end” in a dictionary sense) as too vague.²¹¹

A striking, similar application of Phillips III was made in the panel reconsideration of *Nystrom v. Trex Co.*²¹² The panel had originally split, with two members finding under Texas Digital that the term “board” was not limited to materials taken from wood despite references in the specification to the advantages of making the product by sawing it from a log.²¹³ On reconsideration after the issuance of Phillips III, the dissent of Judge Gajarsa essentially became the majority opinion, recast by Judge Linn. As shown above, Phillips III as written did not necessarily require a different outcome, yet the decision turned one-hundred eighty degrees. The same references were now found to indicate that a “board” could only come from a log, even though the claim did not specify wood.²¹⁴ In fact, the panel now found that wood was implicit in the ordinary meaning of the term board, and the patentee was seeking to unduly broaden that meaning without support in the specification.²¹⁵ Had this trend continued, it might have signaled that Phillips III, whatever its actual wording, was being interpreted as strongly encouraging, if not outright requiring, narrow constructions.

This has not proven to be the case. Within days of *Nystrom II*, the Federal Circuit handed down *Free Motion Fitness, Inc. v. Cybex International, Inc.*²¹⁶ There, the district court had reached a series of narrow constructions of the terms “first pivot point,” “adjacent the resistance assembly,” and “a cable linking” to arrive at summary judgment of noninfringement.²¹⁷

Finding there was no basis for ***483** such narrow constructions, the court noted that “first” and “a” were general relational terms and did not signal either a chronological relationship or a restriction to a single cable.²¹⁸ The court also resorted to a dictionary for the meaning of the term “adjacent,” ultimately concluding that the term simply meant “not distant,” rather than requiring a lack of intervening similar structure, owing to a lack of intrinsic references supporting the latter definition.²¹⁹

Hence, after all the angst and effort leading up to and reflected in Phillips III, claim constructions can still run the gamut and rely on anything including statements in the abstract and general purpose dictionaries. Nothing seems to have changed.

VI. Equity--An Alternative Approach to Claim Construction

The post-Phillips III landscape suggests that Phillips III was, as Judge Mayer predicted, little more than an exercise in rearranging the furniture.²²⁰ Even that may indicate more change than actually resulted from Phillips III. The same range of evidence can be used, the same range of arguments can be made, and the same uncertainty over the construction any judge might enter and the likelihood of that construction surviving appeals still pervades all patent litigation. In those circumstances, perhaps the patent bar is best served by the status quo--after all, where there are no wrong answers, it both encourages expenditures on opinions and litigation and rewards extreme creativity in arriving at claim construction arguments. It certainly does not seem that the Federal Circuit has any interest in clarifying matters further.

Alternatively, the direct re-examination of Cybor Corp. ducked by the Federal Circuit in Phillips III might be in order. As suggested by Judge Mayer, providing some deference to the factual, context driven decisions of district judges would at least reduce the sense that district court proceedings are at most a trial run for appeal.²²¹ At the same time, the fact that only Judge Newman was willing to join Judge Mayer’s dissent does not bode well for such a proposal.²²² If the current regime is, in fact, the Titanic, patching the hole in the hull by changing legal pronouncements back into fact may be too little, too late.

***484** However, there may be enough life boats to salvage some respect for the claim construction process. As much criticism as can and has been heaped on the Federal Circuit for intellectual inconsistency or results-oriented jurisprudence, few could argue with the intrinsic appeal of the results in most of the key cases. In Markman I, the inventor had pretty clearly intended to cover a unique system that centralized inventory.²²³ This was important in the specific context of the dry cleaning industry as he knew it, and the claims reflected as much. Westview Industries, on the other hand, was not in the dry cleaning industry per se, and hence likely lacked Markman’s sensibilities and assumptions about what a tracking system should be able to do. It produced, instead, something that could track any tag placed on any object, but without the focus on inventory control so important to Markman.²²⁴ Similarly, in Wang, although the source for this finding was extrinsic to the patent (the testimony of the inventors) it was pretty clear the named inventors would never have considered their invention to cover the alternate meaning of frame--they didn’t even think it was possible.²²⁵ Likewise, it is understandable why the Federal Circuit would find the term “including” in Toro to have a specific meaning in light of the exhaustive disclosure of a relatively simple apparatus with no mention of a nonattached alternative.²²⁶ On the other hand, in instances such as Brookhill-Wilk I, the infringer often comes across as trying too hard to narrow down the logical meaning of terms, and hence the Federal Circuit’s countenancing of a broader construction only seems fair.²²⁷

Indeed, what is striking about the outcomes in these cases is their fundamentally equitable nature. While dressed up as conclusions of law, few follow any effort at legal reasoning but reflect a best guess analysis of a situation from all the facts and circumstances. Indeed, many of the cases do no more than recite the same boiler-plate standards for construction followed by incredibly fact-intensive, highly subjective analysis of what a particular panel sees as the key evidence supporting its conclusion. Unlike the statutory construction analogy adopted in Markman I, this does not necessarily determine what the patent will mean if it is asserted against a third party.²²⁸ Nor does it give any indication how the same or similar term will be construed in a different context. Hence, these cases suggest none of the finality or even logical consistency that labeling a determination a question of law would suggest.

***485** In fact, recent cases suggest the beginning of an admission that claim constructions have less to do with the law than fundamental fairness.²²⁹ In a series of recent cases, the Federal Circuit has indicated that the accused device can and should be consulted as part of the claim construction process.²³⁰ Although consulting the accused device should only be done to put the dispute in context in order to avoid rendering advisory opinions,²³¹ this is something of an absurdity. The Federal Circuit only requires terms to be construed where they are in dispute either for purposes of infringement or validity.²³² Moreover, the accused device cannot properly inform how a person of ordinary skill in the art at the time of the invention would view the claim. Doing so would suggest the device predated the invention, in which case it would invalidate the claim if it infringed.²³³

Ultimately, though, expecting any judge to be versed in the distinctions between the patent, its specification, and the accused device and not have that influence his or her analysis of the claim construction is setting the bar very high. It plainly opens the door to shaping the construction in a manner to benefit one side or the other based on the court's sense of the equities.

So, we are left with a dilemma--although the results do not seem consistent with the orderly application of clear rules as a matter of law foretold in *Markman I*, and certainly lack the predictability *Markman I* suggested, they do not generally shock the conscience. It does not seem prudent to continue to ignore this dichotomy. Therefore, it would seem at least as beneficial as a re-examination of *Cybor Corp.* to embrace the reality that claim construction is essentially equitable in character, reflecting the best estimate of a judge, weighing all relevant evidence, of what the scope of the patent should be.

This may seem radical, but it is little more than a recognition of the nature of the patent process itself. As noted above, the doctrine of inequitable conduct has developed and cemented the idea that a patent is imbued with a public interest.²³⁴ ***486** One cannot obtain it through improper means.²³⁵ One cannot enforce it through improper means.²³⁶ It seems only logical that it should also be construed in a manner consistent with that public interest.

Indeed, the public interest has already been recognized in the course of claim construction law. As noted in *Markman I*, it is not consistent with the public interest to provide a claim with an overbroad construction beyond how a person of ordinary skill in the art would read it outside of the litigation context.²³⁷ Likewise, it has been recognized that it is not consistent with the public interest to provide a claim construction that would render the claims invalid (although this principle has become a footnote or consideration of last resort in cases such as *Phillips III*).²³⁸

Similarly, it cannot be in the public interest to provide a patent with less than its true scope. As the Constitution states, the very purpose of a patent is "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries"²³⁹--not simply to secure the clearest or narrowest expression of those discoveries.²³⁹ As previously discussed, the Supreme Court has recognized the difficulty in distilling inchoate ideas into words,²⁴⁰ and the Federal Circuit recognized in *Markman I* that the overwhelming majority of patents are written by patent lawyers attempting to force technological developments into the more stilted lingua franca of the patent bar.²⁴¹ Insisting on narrow constructions, excessive reliance on the written disclosure requirements as the only controlling concern would, over time, likely discourage investment in patent acquisition owing to the depreciation of the value of a monopoly of limited duration. Hence, to satisfy the concerns of the Supreme Court, the Patent Act, the Patent and Trademark Office, and, ultimately, the Patent Clause in the Constitution, an equity driven process could and should be adopted.

The fundamental first step in moving towards equity is recognizing that while a patent is reflected in a written document, it is far less straightforward than either a contract or a statute from a legal perspective. While contracts and statutes are the legal reflections of layperson's intent, their formulation and subsequent interpretation rests on a body of purely legal precedent. The possibility that outsiders to the contract or the statutory drafting process might have a subjective view of what should be that differs from the legal effect of the language used is ***487** almost always irrelevant. A court can therefore apply its legal training in the vast majority of cases without concern of error. A patent, by comparison, necessarily places the judge in the position of attempting not to assess the way a claim term has been construed historically, but how the artificial construct of a person of ordinary skill in the specific art of the patent in suit would ordinarily view the particular claim terms at issue.²⁴² Moreover, since actual people of ordinary skill in the art do not typically draft patent claims, do not examine patent claims, and claims are almost always written at least in part to comply with Patent and Trademark Office (PTO) practice and custom rather than in plain technical language, the district court is left with little choice but to reach an essentially subjective result.²⁴³ No prior familiarity can guide the current dispute, but at most his or her best sense of the gestalt as applied to a particular claim term. Openly embracing an equitable perspective, given these facts, is nothing more than a simple recognition of reality.²⁴⁴

Additionally, embracing the equitable reality of claim construction would help bring balance back to the considerations that should be used by courts in assessing patents. In *Markman I* and *II*, much concern was expressed for the ability of others to read the patent and understand its scope, both generally and consistent with the public notice function of 35 U.S.C. § 112.²⁴⁵ Unbalanced concern for this function ignores its proper place in the overall patent system. The primary goals of the patent system, as previously espoused by the Supreme Court, are:

First, patent law seeks to foster and reward invention; second, it promotes disclosure of inventions to stimulate further innovation and to permit the public to practice the invention once the patent expires; third, the stringent requirements for patent protection seek to assure that ideas in the public domain

remain there for the free use of the public.²⁴⁶

Providing notice of the exacting contours of the invention to potential infringers is, notably, nowhere to be found on this list. Moreover, not even *Markman II* foresaw the combination of *Festo* and repeated emphasis on the public notice function as creating a roadmap for the avoidance of infringement, as it *488 embraced a robust, heart of the invention view of the doctrine of equivalents.²⁴⁷ Thus, the current view of constructing a patent claim with an eye to whether the inventor provided a clear roadmap for purposes of avoiding infringement is, at most, a recent innovation. It is the byproduct of the goals of obtaining a full disclosure of the invention and assuring validity. By recognizing the fundamentally equitable nature of claim construction, a court could properly consider all of the purposes espoused in *Aronson* and *Kewanee Oil*, rather than only concerns of notice to potential infringers.

Embracing equity would mean remarkably few changes at the trial court level. As the Federal Circuit has refused to adopt a particular procedure or even a time frame for claim construction proceedings, the recognition of the role of equity would likely not alter the individual preferences of district courts.²⁴⁸ What it would allow, however, is the open consideration of things such as the accused infringing device, the inventive process, the economic impact of the invention, and the impressions and views of others in the industry as evidence of the proper scope of the patent. This broadening of the available evidence would ensure that the court was given a complete record to arrive at a construction consistent with the fullest appreciation of the invention's true scope. Effectively, the courts would be left in their familiar role of analyzing competing interests and assessing where necessary, credibility--skills that are highly developed among the lower bench.

One critical change that might be considered, consistent with equity and the stated goals of the patent system, is to afford greater deference to the standards and expertise of the PTO. The Federal Circuit in *Markman I* did note that ambiguities in patent terms should almost never arise because of the PTO's application of the requirements of 35 U.S.C. § 112, but did not note the fundamental difference between the PTO and the Federal Circuit's approach to claim construction.²⁴⁹ In every examination, including original examinations, re-examinations, and interferences, the PTO takes the default position of giving a claim term the "broadest reasonable construction consistent with the specification."²⁵⁰ This seeks to ensure that the greatest range of prior art is applied to ensure the validity of the resulting patent claims.²⁵¹ The Federal Circuit has rejected deferring to this approach, though, in the context of assessing validity or infringement.²⁵² In fact, as shown by *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, an equally supported broad meaning may be rejected over a narrower one, thus effectively *489 putting the onus on the patent owner to establish entitlement to a broad claim construction.²⁵³ By instead beginning from the position that, in the absence of evidence to the contrary the PTO has already determined the patentee is entitled to a patent claim of the broadest reasonable scope, the patentee's investment would be rewarded and the public interest in rewarding full disclosures of inventions to the public interest would be furthered. Adopting that vantage point, moreover, would serve every bit as much notice on third parties and the public of the potential scope of a patent claim as the current system. If potential infringers were forced to proceed with greater caution in trying to design around patents, this hardly disserves the public interest reflected in the very existence of the patent system.

Whether or not the starting point of the broadest reasonable construction is adopted at the trial court level, the larger impact of openly embracing the equitable nature of claim construction would hopefully be on the Federal Circuit. By recognizing that the trial courts are simply making an equitable decision, the Federal Circuit would be positioned to give more deference to trial courts. For example, the Federal Circuit could afford claim construction the same deference as the clear error review given to the underlying findings of materiality and intent in the context of inequitable conduct.²⁵⁴ If that were to emerge, along with a predictable expected increase in the affirmance rate of district court claim constructions as a result of such deferential review, the number and multiplicity of appeals would likely drop. Moreover, litigants would hopefully come to understand that it was in their best interest to take a reasoned approach before trial courts in order to position their arguments as an appealing one under the overtly equitable standard, rather than the constant battle of extremes currently waged in the trial run or dress rehearsal for appeal before the district courts. Thus, an equitable approach would not only ensure greater consideration of all of the various interests present in the patent system, it would further the public interest in conserving judicial resources and ideally foster greater collegiality, civility, and reasonableness among the patent bar. It would plainly be better than rearranging the deck furniture as the band plays on.

Footnotes

a1 Adjunct Professor, Indiana University School of Law, Indianapolis, Indiana. The views expressed are solely those of the author. The author would like to thank David Quick and Deborah Pollack-Milgate for their fresh eyes and helpful comments, and his wife Lilia Teninty for emotional support and understanding.

1 Markman v. Westview Instruments, Inc. (Markman I), 52 F.3d 967 (Fed. Cir. 1995), aff'd on other grounds, 517 U.S. 370 (1996).

2 See, e.g., 52 F.3d at 978-979 (noting that “[competitors] may understand the scope of the patent owner’s rights by obtaining the patent and prosecution history--‘the undisputed public record’--and applying established rules of construction to the language of the patent claim in the context of the patent. Moreover, competitors should be able to rest assured, if infringement litigation occurs, that a judge, trained in the law, will similarly analyze the text of the patent and its associated public record and apply the established rules of construction, and in that way arrive at the true and consistent scope of the patent owner’s rights to be given legal effect.” (citation omitted)).

3 See Wilson Sporting Goods Co. v. Hillerich & Bradsby Co., 442 F.3d 1322, 1327, 1330-31 (Fed. Cir. 2006); Lava Trading, Inc. v. Sonic Trading Mgmt., L.L.C., 445 F.3d 1348, 1350 (Fed. Cir. 2006).

4 See Markman I, 52 F.3d at 1012-13 (Newman, J., dissenting) (noting that patent suits, as patents were grants of the crown, would initially be lodged in chancery); see also Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co., 324 U.S. 806, 814 (1945) (holding that patents are imbued with a public interest imposing a duty of candor and good faith in seeking them).

5 See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722, 731, 736-37 (2002) (noting that “the nature of language makes it impossible to capture the essence of a thing in a patent application,” but going on to affirm that “[e]stoppel arises when an amendment is made to secure the patent and the amendment narrows the patent’s scope” regardless of whether the amendment was tied to a prior art rejection).

6 Jacobellis v. Ohio, 378 U.S. 184, 197 (1964) (Stewart, J., concurring).

7 Phillips v. AWH Corp. (Phillips III), 415 F.3d 1303 (Fed. Cir. 2005) (en banc), cert. denied, 126 S. Ct. 1332 (2006).

8 Markman I, 52 F.3d at 971-72.

9 Id. at 971.

10 Id. at 971-72.

11 Id. at 974.

12 Id.

13 Markman I, 52 F.3d 967, 972-73 (Fed. Cir. 2005), aff'd on other grounds, 517 U.S. 370 (1996).

14 Id. at 972-74.

15 Id. at 974.

16 Id. at 973.

17 Id.

18 Markman I, 52 F.3d 967, 973 (Fed. Cir. 2005), aff'd on other grounds, 517 U.S. 370 (1996).

19 Id.

20 Id.

21 Id. at 973-75.

22 Id.

23 Markman I, 52 F.3d 967, 974 (Fed. Cir. 2005), aff'd on other grounds, 517 U.S. 370 (1996).

24 Id. at 970 n.1.

25 Id. at 976-79.

26 Id. at 981-82.

27 Id. at 977-78.

28 Markman I, 52 F.3d 967, 984 (Fed. Cir. 2005) (noting lack of such cases in concurring and dissenting opinions), aff'd on other grounds, 517 U.S. 370 (1996).

29 Id. at 977-78.

30 Id. at 976-77.

31 Id. at 978.

32 Id. at 978-79 (but note the later discussion at 980-81 about the use of extrinsic evidence, which runs somewhat counter to the idea of full integration in all cases).

33 Markman I, 52 F.3d 967, 978 (Fed. Cir. 2005), aff'd on other grounds, 517 U.S. 370 (1996).

34 Id.

35 Id. at 978-79.

36 Id. at 979. One can only speculate on how the Federal Circuit would justify its record in the last decade as fulfilling this or the preceding statement's call for consistency.

37 Id. at 978.

38 Markman I, 52 F.3d 967, 984-87 (Fed. Cir. 2005), aff'd on other grounds, 517 U.S. 370 (1996).

39 Id. at 985.

40 Id. at 985-86.

41 Id. at 985.

42 Id. at 987-88.

43 Markman I, 52 F.3d 967, 987-88 (Fed. Cir. 2005), aff'd on other grounds, 517 U.S. 370 (1996).

44 Id.

45 Id. at 978-79, 987 (discussing need for consistent constructions and analogizing to statutory construction for the proposition that "[t]here can be only one correct interpretation of a statute that applies to all persons").

46 Id. (noting that patents should be treated like statutes, and that "[t]here can be only one correct interpretation of a statute that applies to all persons").

47 See Inpro II Licensing, S.A.R.L. v. T-Mobile U.S.A., Inc., 450 F.3d 1350, 1359 (Newman, J., concurring) (cataloging district court decisions on issue preclusion).

48 Markman I, 52 F.3d at 987.

49 Id. at 989 (Mayer, J., concurring).

50 Id. at 993.

51 Id. at 989, 993-94.

52 Id. at 994-95.

53 Markman I, 52 F.3d 967, 993 (Fed. Cir. 2005) (Mayer, J., concurring), aff'd on other grounds, 517 U.S. 370 (1996).

54 Id.

55 Id. at 1010-25 (Newman, J., dissenting).

56 Id. at 1011-15.

57 Id.

58 Markman I, 52 F.3d 967, 1011-15 (Fed. Cir. 2005) (Newman, J., dissenting), aff'd on other grounds, 517 U.S. 370 (1996).

59 Id. at 1015-25.

60 Id. at 1004-08, 1025-26.

61 Id. at 1008 & 974 n.5.

62 Id. at 999.

63 Markman v. Westview Instruments, Inc. (Markman II), 517 U.S. 370 (1996).

64 Id. at 377-80.

65 Id. at 376-77.

66 Id. at 388-89.

67 Id. at 391.

68 Keystone Driller Co. v. Gen. Excavator Co., 290 U.S. 240 (1933).

69 Id. at 243, 246-47.

70 By way of Precision Instrument Manufacturing Co. v. Automotive Maintenance Machinery Co., 324 U.S. 806 (1945), and its progeny.

71 Keystone Driller, 290 U.S. at 243.

72 Markman I, 52 F.3d 967, 1011-15 (Fed. Cir. 1995) (Newman, J., dissenting), aff'd on other grounds, 517 U.S. 370 (1996).

73 Id.

- 74 See *Markman II*, 517 U.S. 370, 378-80 (1996) (finding that prior case law did not shed light on the use of a jury for claim construction owing to lack of claims in earlier patents).
- 75 *Keystone Driller*, 290 U.S. at 243, 246-47; *Precision Instrument*, 324 U.S. at 816 (noting that “[a] patent by its very nature is affected with a public interest,” a holding subsequently incorporated into 37 C.F.R. §1.56’s rationale for the duty of disclosure).
- 76 See *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996); *O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576 (Fed. Cir. 1997).
- 77 See *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1579-81 (Fed. Cir. 1996) (ultimately finding “between” should be given the narrower of two potential ordinary meanings in order to ensure compliance with 35 U.S.C. §112, P 2).
- 78 See *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1456 (Fed. Cir. 1998) (en banc).
- 79 See *Renishaw P.L.C. v. Marposs Societa’ Per Azioni*, 158 F.3d 1243 (Fed. Cir. 1998); *Phillips Petroleum Co. v. Huntsman Polymers Corp.*, 157 F.3d 866 (Fed. Cir. 1998); *Toro Co. v. White Consol. Indus.*, 199 F.3d 1295 (Fed. Cir. 1999); *Wang Labs., Inc. v. Am. Online, Inc.*, 197 F.3d 1377 (Fed. Cir. 1999); *Watts v. XL Sys., Inc.*, 232 F.3d 877 (Fed. Cir. 2000); *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337 (Fed. Cir. 2001); *Biogen, Inc. v. Berlex Labs., Inc.*, 318 F.3d 1132 (Fed. Cir. 2003); *Vanderlande Indus. Nederland BV v. Int’l Trade Comm’n*, 366 F.3d 1311 (Fed. Cir. 2004).
- 80 See *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985 (Fed. Cir. 1999); *Gart v. Logitech, Inc.*, 254 F.3d 1334 (Fed. Cir. 2001); *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002); *Brookhill-Wilk 1, L.L.C. v. Intuitive Surgical, Inc.*, 334 F.3d 1294 (Fed. Cir. 2003); *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898 (Fed. Cir. 2004); *Novartis Pharms. Corp. v. Eon Labs Mfg., Inc.*, 363 F.3d 1306 (Fed. Cir. 2004).
- 81 See *Vanderlande Indus. Nederland BV v. Int’l Trade Comm’n*, 366 F.3d 1311, 1321 (2004) (holding testimony that “glide surface” term had no specialized meaning “rendered irrelevant” general sources such as dictionaries).
- 82 See *Bancorp Servs., L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372 (Fed. Cir. 2004) (construing “surrender value protected investment credits” by using a dictionary for meaning of “surrender value” and specification for meaning of “protected investment” and “credits”).
- 83 *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996).
- 84 See, e.g., *Phillips III*, 415 F.3d 1302, 1312-18 (Fed. Cir. 2005) (en banc) (citing *Vitronics* in support of use of the intrinsic record, and more specifically, the specification as a potentially exclusive source of construction), cert. denied, 125 S. Ct. 1332 (2006).
- 85 *Vitronics Corp.*, 90 F.3d at 1579-81.
- 86 *Id.* at 1579.
- 87 *Id.*
- 88 *Id.* at 1579-80.

89 Id. at 1580-81.

90 Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1581 (Fed. Cir. 1996).

91 Id. at 1580.

92 Id. at 1582-85.

93 Id. at 1582-83.

94 Id.

95 Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583 (Fed. Cir. 1996).

96 Id.

97 Id. at 1583-84.

98 Id. at 1582 (noting that “words in a claim are generally given their ordinary and customary meaning” except where the patentee “choose[s] to be his own lexicographer and use[s] terms in a manner other than their ordinary meaning” (emphasis added)).

99 Id. at 1582 (noting that the patentee acts as lexicographer only where “the special definition of the term is clearly stated in the patent specification or file history”).

100 Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1584 n.6 (Fed. Cir. 1996).

101 Id. at 1584, 1585 n.6.

102 Id. at 1585 (noting that “[h]ad the district court relied on the expert testimony and other extrinsic evidence solely to help it understand the underlying technology, we could not say the district court was in error”).

103 See O.I. Corp. v. Tekmar Co., 115 F.3d 1576 (Fed. Cir. 1997).

104 Id. at 1580-81.

105 Id.

106 Id.

107 Id. at 1581.

108 O.I. Corp. v. Tekmar Co., 115 F.3d 1576, 1581-82 (Fed. Cir. 1997).

109 See Vitronics Corp. v. Conceptor, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996) (emphasis added).

110 See O.I. Corp., 115 F.3d at 1581-82.

111 See supra Section II.A.

112 Wang Labs., Inc. v. Am. Online, Inc., 197 F.3d 1377, 1380-81 (Fed. Cir. 1999).

113 Id. at 1381-82.

114 Id.

115 Id. at 1382.

116 Id. at 1382-83.

117 Markman I, 52 F.3d 967, 985 (Fed. Cir. 1996), aff'd on other grounds, 517 U.S. 370 (1996).

118 Watts v. XL Sys., Inc., 232 F.3d 877, 879, 882 (Fed. Cir. 2000).

119 Id. at 882.

120 Id. Notably, the panel did not discuss whether the “misaligned taper joint” was the only feature described in the patent. If other features were described, then arguably the description of “the invention” using this should not have been taken as a limitation. See SunRace Roots Enter. Co. v. SRAM Corp., 336 F.3d 1298, 1305 (Fed. Cir. 2003).

121 Watts, 232 F.3d at 883.

122 Toro Co. v. White Consol. Indus., Inc., 199 F.3d 1295, 1300-02 (Fed. Cir. 1999).

123 Id.

124 Id. at 1303 (Rader, J., dissenting).

125 See Markman I, 52 F.3d 967, 985 (Fed. Cir. 1996), aff'd on other grounds, 517 U.S. 370 (1996).

126 Toro, 199 F.3d at 1299-1302.

127 Id. at 1301-02.

128 Id.

129 Vanderlande Indus. Nederland BV v. Int'l Trade Comm'n, 366 F.3d 1311, 1314-17 (Fed. Cir. 2004).

130 Id. at 1321.

131 Id.

132 Id.

133 Id.

134 Johnson Worldwide Assocs., Inc. v. Zebco Corp., 175 F.3d 985 (Fed. Cir. 1999); Gart v. Logitech, Inc., 254 F.3d 1334 (Fed. Cir. 2001); Brookhill-Wilk 1, L.L.C. v. Intuitive Surgical, Inc., 334 F.3d 1294 (Fed. Cir. 2003).

135 Johnson Worldwide, 175 F.3d 985.

136 Id. at 992.

137 Id. at 987.

138 Id. at 988.

139 Id. at 989.

140 Johnson Worldwide Assocs., Inc. v. Zebco Corp., 175 F.3d 985, 988 (Fed. Cir. 1999).

141 Id. at 994.

142 Id. at 989.

143 Id.

144 Id.

145 Johnson Worldwide Assocs., Inc. v. Zebco Corp., 175 F.3d 985, 990 (Fed. Cir. 1999).

146 Id. at 990-92.

147 Gart v. Logitech, Inc., 254 F.3d 1334, 1337 (Fed. Cir. 2001).

148 Id. at 1337, 1340.

149 Id. at 1340, 1343.

150 Id. at 1340-42.

151 Id. at 1341.

152 Brookhill-Wilk 1, L.L.C. v. Intuitive Surgical, Inc., 334 F.3d 1294, 1296 (Fed. Cir. 2003).

153 Id. at 1300-01.

154 Id. at 1297.

155 Id. at 1299-1302.

156 Id. at 1302-03.

157 Tex. Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202-05 (Fed. Cir. 2002).

158 Id. at 1204-05.

159 Id.

160 Id.

161 Novartis Pharms. Corp. v. Eon Labs Mfg., Inc., 363 F.3d 1306 (Fed. Cir. 2004).

162 Id. at 1308-09.

163 Id. at 1308-09 n.2.

164 Id. at 1308-09.

165 Id.

166 Novartis Pharms. Corp. v. Eon Labs Mfg., Inc., 363 F.3d 1306, 1313-14 (Fed. Cir. 2004). Indeed, the very problem with cyclosporine addressed with the patent was its lack of solubility.

167 Jacobellis v. Ohio, 378 U.S. 184, 197 (1964) (Stewart, J., concurring).

168 Cyber Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1455-56 (Fed. Cir. 1998) (en banc).

169 See Markman I, 52 F.3d 967, 993 (Fed. Cir. 1996) (Mayer, J., concurring); id. at 999 (Newman, J., dissenting).

170 Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582-83 (Fed. Cir. 1996).

171 Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc., 242 F.3d 1337, 1347 (Fed. Cir. 2001) (Dyk, J., concurring).

172 Tex. Digital Sys. v. Telegenix, Inc., 308 F.3d 1193, 1202-05 (Fed. Cir. 2002).

173 Phillips v. AWH Corp. (Phillips II), 376 F.3d 1382, 1382-84 (Fed. Cir. 2004) (order granting rehearing en banc).

174 Phillips v. AWH Corp. (Phillips I), 363 F.3d 1207 (Fed. Cir. 2004), vacated, 376 F.3d 1382 (Fed. Cir. 2004).

175 Id. at 1209-10.

176 Id. at 1210.

177 Id.

178 Id. at 1212-13.

179 Phillips I, 363 F.3d 1207, 1213 (Fed. Cir. 2004), vacated, 376 F.3d 1382 (Fed. Cir. 2004).

180 Id. at 1217-19.

181 See Phillips II, 376 F.3d 1382, 1382-84 (Fed. Cir. 2004) (order granting rehearing en banc).

182 Id. at 1383.

183 Id.

184 Phillips III, 415 F.3d 1303, 1303-08 (Fed. Cir. 2005) (listing amicus curiae briefs), cert. denied, 125 S. Ct. 1332 (2006).

185 Id. at 1312-13.

186 Id. at 1312-17.

187 Id. at 1312-17.

188 Id. at 1319-24.

189 Phillips III, 415 F.3d 1303, 1319-23 (Fed. Cir. 2005), cert. denied, 125 S. Ct. 1332 (2006).

190 Id. at 1320, 1323.

191 Id.

192 Id. at 1323-24.

193 Id. at 1320, 1323-24.

194 Phillips III, 415 F.3d 1303, 1320, 1323 (Fed. Cir. 2005), cert. denied, 125 S. Ct. 1332 (2006).

195 Id. at 1324.

196 Id. at 1318, 1324 (rejecting the use of conclusory expert testimony).

197 Id. at 1328.

198 Indeed, Judge Lourie and Judge Newman, the author and concurring member of the panel decision below, dissented from the claim construction aspect of the en banc appeal essentially on the grounds that no one had indicated that there could be anything wrong with the result if the technique was correct. Id. at 1328-30 (Lourie, J., dissenting in part).

199 See Phillips III, 415 F.3d 1303, 1312-17 (Fed. Cir. 2005), cert. denied, 125 S. Ct. 1332 (2006); cf. Phillips I, 363 F.3d 1207, 1212-13 (Fed. Cir. 2004), vacated, 376 F.3d 1382 (Fed. Cir. 2004).

200 Phillips III, 415 F.3d at 1324-28.

201 Id.

202 Id.

203 Id. at 1328-30 (Lourie, J., dissenting in part).

204 Id. at 1330-35 (Mayer, J., dissenting).

205 Phillips III, 415 F.3d 1303, 1330 n.1 (Fed. Cir. 2005), cert. denied, 125 S. Ct. 1332 (2006).

206 Id. at 1330.

207 Id. at 1334-35.

208 *Research Plastics, Inc. v. Fed. Packaging Corp.*, 421 F.3d 1290 (Fed. Cir. 2005).

209 Id. at 1295-97.

210 Id.

211 Id. at 1296-97.

212 *Nystrom v. Trex Co. (Nystrom II)*, 424 F.3d 1136 (Fed. Cir. 2005).

213 *Nystrom v. Trex Co. (Nystrom I)*, 374 F.3d 1105, 1112-13 (Fed. Cir. 2004), withdrawn and superseded on reh'g, 424 F.3d 1136 (Fed. Cir. 2005).

214 *Nystrom II*, 424 F.3d at 1142-46.

215 Id. at 1145-46.

216 *Free Motion Fitness, Inc. v. Cybex Int'l, Inc.*, 423 F.3d 1343 (Fed. Cir. 2005).

217 Id. at 1348-50.

218 Id. at 1348, 1350-51.

219 Id. at 1348-49.

220 *Phillips III*, 415 F.3d 1303, 1334-35 (Fed. Cir. 2005) (Mayer, J., dissenting), cert. denied, 125 S. Ct. 1332 (2006).

221 Id. at 1330-35.

222 Note that the recent opinions issued in response to the denial of rehearing en banc in *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 469 F.3d 1069 (Fed. Cir. 2006), suggest some review of *Cybor Corp.* might be forthcoming. However, it is clear that even among those in favor of deference there is no consensus as to when or how such deference is to be applied. Judges Michel, Rader, and Moore are generally in favor of substantial deference on a theory that the lower court is applying a factually driven analysis of the level of skill in the art. Judge Newman would apply a *Daubert*-like standard based on the same basis, while Judges Gajarsa, Linn, and Dyk would only give deference if a judge explicitly relied on extrinsic evidence to resolve an otherwise ambiguous term.

223 See *Markman I*, 52 F.3d 967, 971-72 (Fed. Cir. 1996), aff'd on other grounds, 517 U.S. 370 (1996).

224 Id. at 972-74.

225 Wang Labs., Inc. v. Am. Online, Inc., 197 F.3d 1377, 1382-83 (Fed. Cir. 1999).

226 Toro Co. v. White Consol. Indus. Inc., 199 F.3d 1295, 1301-02 (Fed. Cir. 1999).

227 Brookhill-Wilk 1, L.L.C. v. Intuitive Surgical, Inc., 334 F.3d 1294, 1299-1303 (Fed. Cir. 2003).

228 See Markman I, 52 F.3d at 987-88; cf. Inpro II Licensing S.A.R.L. v. T-Mobile U.S.A., 450 F.3d 1350, 1359 (Fed. Cir. 2006).

229 See Wilson Sporting Goods Co. v. Hillerich & Bradsby Co., 442 F.3d 1322, 1327, 1330-31 (Fed. Cir. 2006); Lava Trading, Inc. v. Sonic Trading Mgmt., L.L.C., 445 F.3d 1348, 1350 (Fed. Cir. 2006).

230 See Wilson Sporting Goods, 442 F.3d at 1327, 1330-31; Lava Trading, 445 F.3d at 1350.

231 Wilson Sporting Goods, 442 F.3d at 1327, 1330-31.

232 See U.S. Surgical Corp. v. Ethicon, Inc., 103 F.3d 1554, 1567 (Fed. Cir. 1997); Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc., 200 F.3d 795, 803 (Fed. Cir. 1999); NTP, Inc. v. Research In Motion, Ltd., 418 F.3d 1282, 1311 (Fed. Cir. 2005). Notably, the earliest case Wilson Sporting Goods cites for this proposition, SRI International v. Matsushita Electric Corp. of America, 775 F.2d 1107, 1118 (Fed. Cir. 1985), actually says something quite different: “[i]t is only after the claims have been construed without reference to the accused device that the claims, as so construed, are applied to the accused device to determine infringement” (emphasis in original). The remaining cases speak to identifying the scope of a dispute. But if the issue is before the Federal Circuit in the first instance, it is plainly disputed.

233 See Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc., 246 F.3d 1368, 1378 (Fed. Cir. 2001) (noting that structure which literally infringes and predates the invention anticipates).

234 See Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co., 324 U.S. 806, 816 (1945).

235 Id.; see also 37 C.F.R. §1.56 (2006).

236 See Keystone Driller Co. v. Gen. Excavator Co., 290 U.S. 240, 243, 246-47 (1933).

237 Markman I, 52 F.3d 967, 978-79 (1995), *aff'd* on other grounds, 517 U.S. 370 (1996).

238 Phillips III, 415 F.3d 1303, 1327 (Fed. Cir. 2005), cert. denied, 125 S. Ct. 1332 (2006); see also Pfizer, Inc. v. Teva Pharms. USA, Inc., 429 F.3d 1364, 1376 (Fed. Cir. 2005).

239 U.S. Const. art. I, §1, cl. 8.

240 See *supra* note 5.

241 Markman I, 52 F.3d at 985.

242 See, e.g., Phillips III, 415 F.3d at 1312-13.

243 See Markman I, 52 F.3d at 985; Toro Co. v. White Consol. Indus., Inc., 199 F.3d 1295, 1303 (Fed. Cir. 1999) (Rader, J., dissenting).

244 Several of these same considerations are articulated by Judges Michel, Newman, Rader, and Moore in advocating the review of Cybor Corp. in Amgen, Inc., and by Judge Mayer in his dissent to Phillips III. However, simply changing the label from law to fact, particularly given the dispute within the Federal Circuit as to when facts may even arise, does not seem to go far enough in ensuring that the district court's superior position to assess the equities of a particular situation is respected on appeal.

245 Markman I, 52 F.3d at 978-79; see also Markman II, 517 U.S. 370, 373 (1996).

246 Aronson v. Quick Point Pencil Co., 440 U.S. 257, 262 (1979) (citing Kewanee Oil Co. v. Bicorn Corp., 416 U.S. 470, 480-81 (1974)).

247 See Markman II, 517 U.S. at 582 (quoting H. Schwartz, Patent Law and Practice 82 n.1 (2d ed. 1995)).

248 See, e.g., Phillips III, 415 F.3d 1303, 1324 (Fed. Cir. 2005), cert. denied, 125 S. Ct. 1332 (2006).

249 See Markman I, 52 F.3d at 978-79.

250 In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004); see also In re Bond, 910 F.2d 881, 883 (Fed. Cir. 1990).

251 In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d at 1364.

252 See, e.g., Atl. Thermoplastics Co. v. Faytex Corp., 970 F.2d 834, 846 (Fed. Cir. 1992).

253 See Athletic Alternatives, Inc. v. Prince Mfg., Inc., 73 F.3d 1573, 1579-81.

254 See Bruno Indep. Living Aids, Inc. v. Acorn Mobility Servs., Ltd., 394 F.3d 1348, 1351 (Fed. Cir. 2005) (citing Kingsdown Med. Consultants, Ltd. v. Hollister, Inc., 863 F.2d 867, 872 (Fed. Cir. 1988)); see also Agfa Corp. v. Creo Prods., 451 F.3d 1366, 1371 (Fed. Cir. 2006). This would also truly make the review of materiality one for clear error, since currently the claim construction rulings that in turn inform a finding of materiality are reviewed de novo. Agfa Corp., 451 F.3d at 1371.