

Claim Construction Using Contexts of Implication

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ABSTRACT

During patent litigation, the court reviews the claims and specification of the patent in order to “construe the claims.” If any term in the claim is disputed or alleged to be ambiguous, the court will use information from the specification to provide a more distinct meaning for the disputed term. This information takes the form of various contexts, for example, the abstract, explicit definitions of claim terms, characterizations of claim terms that are merely implied, descriptions of the prior art, and working examples. A gray area in patent law is which contexts in the specification are appropriately used in claim construction and whether there must be some reason to believe that the disputed term is actually in need of interpretation. This gray area particularly relates to contexts of implication. This article documents, for the first time, the various categories of implicit contexts that might be found in the specification and the frequency with which the Federal Circuit uses contexts of implication for claim construction. The author suggests that the Federal Circuit set forth a rule as to when it is appropriate to use implicit contexts for claim construction. The rule should establish that claim construction must begin by assessing ambiguity in the disputed claim term and that the reviewing court should articulate why the term is ambiguous by some method, for example, by using the criteria for ambiguity set forth in Appendix One.

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I. INTRODUCTION

¶1 Patents contain two sections: the claims and the specification.¹ The interpretation of any disputed claim term first requires a review of the claims, and then a review of the specification for contexts that might aid in arriving at the meaning of the disputed claim term. The contexts can be categorized as explicit or implicit. Explicit contexts, as set forth by published opinions from the U.S. Court of Appeals for the Federal Circuit, include disclaimers and definitions.² Implicit contexts, as evidenced from case law, include recitations of advantage or disadvantage, global comments, and statements of a repeated and consistent nature. The various classes of contexts of implication have never been comprehensively described by any scholarly article or Federal Circuit opinion. These classes are documented in Appendix Two.

¶2 In practice, the exercise of claim construction often results in the narrowing of the disputed claim term, a situation disadvantageous to the patent owner. Contexts of implication are of special concern in patent law because they are usually inadvertent and not drafted into the patent’s specification with the goal of narrowing claim scope. During litigation, the court reviews any implicit contexts residing in the specification, which frequently results in the narrowing of claim scope. In contrast, explicit contexts are the result of conscientious deliberation on the part of the inventor or patent attorney, with the deliberate goal of narrowing the meaning of a claim term.

¹ U.S. PATENT & TRADEMARK OFFICE, U.S. DEP’T OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE § 608.01(a), 600-74 (8th ed., Rev. 5, 2006).

² See, e.g., *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366 (Fed. Cir. 2008).

¶3 Contexts of implication are valid tools for claim construction, as demonstrated by the Federal Circuit’s opinions in cases such as *Rambus Inc. v. Infineon Technologies AG*,³ *Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc.*,⁴ *Hockerson-Halberstadt, Inc. v. AVIA Group International, Inc.*,⁵ and *Phillips v. AWH Corp.*⁶ The circuit has held that “a claim term may be clearly redefined *without an explicit statement* of redefinition.”⁷ Similarly, the court has held that “even if the guidance is not provided in explicit definitional format . . . the specification may define claim terms ‘by implication’”⁸ In *Astrazeneca AB v. Mutual Pharmaceutical Co.*,⁹ the Federal Circuit held that a patent applicant need not expressly state “my invention does not include X” to indicate the exclusion of X from the scope of the patent.¹⁰ The opinion in *Hockerson-Halberstadt* set forth the role of contexts of implication: “[t]he court, therefore, must examine a patent’s specification to determine whether the patentee has given the term an unconventional meaning.”¹¹ This examination includes determining “whether the inventor used any terms in a manner inconsistent with their ordinary meaning [because the specification] acts as a dictionary when it expressly defines terms . . . or when it defines terms by implication.”¹² *Phillips*, an en banc Federal Circuit decision, summarized the role of the specification in the claim as “the single best guide to the meaning of a disputed term,” which “acts as a dictionary when it expressly defines terms used in the claims *or when it defines terms by implication.*”¹³

¶4 A dissenting opinion in *Phillips*, a high-profile patent case, provides an excellent example of a judge identifying an implicit context, in this situation from a repeated and consistent statement. The invention involved a metal barrier with air vent baffles. The implicit context was articulated by Judge Lourie in his dissent:

This specification makes clear that the “baffles” in this invention are angled. There is no reference to baffles that show them to be other than angled. The abstract refers to “bullet deflecting . . . baffles.” Only angled baffles can deflect. It then mentions “internal baffles at angles for deflecting bullets.” That could not be clearer. The specification then refers several times to baffles, often to figures in the drawings, all of which are to angled baffles. A compelling point is that the only numbered references to baffles (15, 16, 26, 27, 30, and 31) all show angled baffles.¹⁴

³ 318 F.3d 1081, 1088 (Fed. Cir. 2003).

⁴ 262 F.3d 1258, 1268 (Fed. Cir. 2001).

⁵ 222 F.3d 951, 955 (Fed. Cir. 2000).

⁶ 415 F.3d 1303, 1321 (Fed. Cir. 2005) (en banc).

⁷ *Rambus*, 318 F.3d at 1088 (citing *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1344 (Fed. Cir. 2001)) (emphasis added).

⁸ *Bell Atlantic*, 262 F.3d at 1268 (citing *SciMed Life Sys.*, 242 F.3d at 1344 (Fed. Cir. 2001)).

⁹ 384 F.3d 1333 (Fed. Cir. 2004).

¹⁰ *Id.* at 1340.

¹¹ *Hockerson-Halberstadt, Inc. v. AVIA Group Int’l, Inc.*, 222 F.3d 951, 955 (Fed. Cir. 2000).

¹² *Id.* (quoting *Vitronics Corp. v. Conceptiontronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)) (emphasis added).

¹³ *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005) (quoting *Vitronics Corp.*, 90 F.3d at 1582; *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1300 (Fed. Cir. 2004)) (emphasis added).

¹⁴ *Phillips*, 415 F.3d at 1329 (omissions in original).

Judge Lourie continued, “There is no specific reference in this patent to a baffle that is not angled at other than 90 [degrees]. . . . [T]he constantly stated objective of deflection of bullets is dependent upon such an angle.”¹⁵ According to the judge, the context of implication, residing in the patent’s specification, was relevant to the claims. On the basis of the repeated and consistent disclosure (but in absence of any expressed definition), Judge Lourie wanted the claim term “baffles” to be narrowly limited to “angled baffles” and to not encompass baffles projecting at right angles from the barrier.

¶5 Another context of implication, frequently appearing in patents, is the global comment. A global comment is one that appears to refer to all embodiments covered by the claims, including those set forth in the examples section of the patent, any disclosed prophetic embodiments, as well as embodiments not yet contemplated by the inventor at the time of the filing date.¹⁶ Global comments have been identified by residence in a prominent part of the specification, for example, in the abstract or near one of the section headings, or by the term “the present invention.” In *Alloc, Inc. v. International Trade Commission*,¹⁷ which concerned U.S. Patent Number 6,023,907, the global comment was identified by its residence near the heading, “TECHNICAL PROBLEMS AND OBJECTS OF THE INVENTION,” as shown below.¹⁸ The specification in this patent read as follows:

TECHNICAL PROBLEMS AND OBJECTS OF THE INVENTION . . .
 A particular object of the invention is to provide a panel-joining system which makes it possible in a simple, cheap and rational way to provide a joint between floor panels without requiring the use of glue . . . allows repeated disassembly and reassembly of a floor previously laid . . . said system being characterized in . . . that the *panels, when joined together, can occupy a relative position in said second direction where a play exists*
¹⁹

¶6 Claim 9 read, “A method of laying and mechanically joining . . . floor panels in parallel rows . . . comprising the steps of . . . displacing the . . . panels in its [longitudinal direction] . . . until a locking element . . . snaps up into a locking groove”²⁰

¶7 On the basis of the global comment, the court held that the claims were narrowly limited to a method of laying panels that included *play* and that the claims could not cover methods of laying tightly fitted panels.²¹ Note that the disputed claim, Claim 9, contains no requirement for play, and yet the Federal Circuit still held that the claimed method must be limited to using panels with “play.”

¹⁵ *Id.* at 1329-30.

¹⁶ *See infra* Appendix Three.

¹⁷ 342 F.3d 1361 (Fed. Cir. 2003).

¹⁸ *Id.* at 1368-69.

¹⁹ U.S. Patent No. 6,023,907 col.3 l.22-4 l.16 (filed Nov. 18, 1998) (emphasis added).

²⁰ '907 Patent col.12 l.1-1.27.

²¹ *Alloc*, 342 F.3d at 1370-72.

¶8 The fact that the en banc *Phillips* case affirmed the role of implicit contexts in claim construction removes any doubt that this context has a proper role in interpreting claims. However, this article demonstrates that this particular context can generate controversy—especially absent any guidance as to *when it is appropriate* and *when it is not appropriate* to use contexts of implication. Robust dissenting opinions have been set forth in cases in which the majority explored the specification for an implicit context and then, without hesitation, used it for interpreting the claims.²² Conversely, in cases where the majority ignored the implicit context, dissenters have bitterly argued that an implicit context militated the meaning of a claim term.²³

¶9 In *Microsoft Corp. v. Multi-Tech Systems, Inc.*,²⁴ the dissent disagreed with the majority’s use of an implicit context as a tool for claim construction.²⁵ The majority observed the specification’s repeated and consistent disclosure of the concept of messages over a telephone line. The dissent argued that only explicit contexts, like disclaimer or explicit definitions, are valid tools for claim construction, asserting, “this court’s conclusion significantly erodes the requirement that a disclaimer of subject matter be clear and ambiguous.”²⁶ It characterized the majority’s holding as a “leap in logic . . . akin to Evel Knievel jumping the Snake River Gorge on a motorcycle.”²⁷ The dissenting judge further complained that “the court manufactures an unreasonable limitation . . .” and “leaps into thin air”²⁸

¶10 In *Gillette Co. v. Energizer Holdings, Inc.*,²⁹ the majority refused to interpret claims according to an implicit context, but instead held that “words or expressions of manifest exclusion or explicit disclaimers in the specification are necessary to disavow claim scope.”³⁰ Here, the majority refused to use an implicit context that took the form of a repeated and consistent disclosure that the claimed razor was limited to three blades. In striking contrast, the dissent argued that contexts of implication are valid tools for claim construction, writing that “a redefinition or limitation of a claim term need not be explicit. ‘In other words, the specification may define claim terms ‘by implication’”³¹

¶11 In *Alloc, Inc. v. International Trade Commission*,³² the majority limited the claim on the basis of a context of implication, namely, a repeated and consistent use of the term in the specification, writing that “a patent applicant may consistently and clearly use a term in a manner either more or less expansive than its general usage in the relevant art,

²² See *infra* notes 24-28.

²³ See *infra* notes 29-31.

²⁴ 357 F.3d 1340 (Fed. Cir. 2004).

²⁵ *Id.* at 1355 (Rader, J., dissenting).

²⁶ *Id.* at 1356.

²⁷ *Id.* at 1355.

²⁸ *Id.*

²⁹ 405 F.3d 1367 (Fed. Cir. 2005).

³⁰ *Id.* at 1374 (quoting *Housey Pharms., Inc. v. Astrazeneca UK Ltd.*, 366 F.3d 1348, 1352 (Fed. Cir. 2004); *Liebel-Flarsheim v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004)).

³¹ *Id.* at 1375 (Archer, J., dissenting) (quoting *Bell Atl. Network Servs., Inc. v. Covad Commc’ns Group*, 262 F.3d 1258, 1268 (Fed. Cir. 2001)).

³² 342 F.3d 1361 (Fed. Cir. 2003).

thereby expanding or limiting the scope of the term in the context of the patent claims.”³³ The claim related to a method for laying panels, and the issue was whether the panels required “play.” The majority held that the claimed method required play.³⁴ In contrast, the dissent argued that the intrinsic evidence (from the specification) should be applied only if the term “deprives the claim of clarity,” or under the more frequently encountered situations where the specification provides an explicit definition, where the claim is in the means plus function format, or where there is prosecution disclaimer.³⁵

¶12 It is thus evident that some opinions have questioned the validity of implicit contexts as a valid tool for claim construction. In some cases, the dissent or majority set forth the opinion that implicit contexts should be used only where the disputed claim term is deprived of clarity. In other cases, the dissent or majority appeared to argue that implicit contexts are never appropriate as tools for claim construction.

¶13 Before disclosing further details on contexts of implication, it should be emphasized that, in the author’s opinion, the actual source of controversy is the Federal Circuit’s failure to set forth any rules as to *when it is appropriate* and *when it is not appropriate* to use implicit contexts as a tool.

¶14 Now that a handful of actual examples of contexts of implication has been characterized and identified, it is appropriate to provide more information on this controversial context. To summarize, contexts of implication include disclosures of advantage of the claimed invention, disclosures of disadvantage of the prior art, repeated and consistent statements, and global comments.³⁶ “Repeated and consistent statement” refers to the specification’s repeated association of a composition of matter with a particular structure, property, or use. In using a repeated and consistent statement to arrive at claim meaning, the Federal Circuit takes note of statements using the disputed claim term and counts the number of times throughout the specification that the disputed term is associated with a particular structure, property, or use.

¶15 For example, a listing or numbering of consistent statements can be found in *Novartis Pharmaceuticals Corp. v. Eon Labs Manufacturing, Inc.*,³⁷ where the claim term “hydrosol” was held to be a hydrosol in a pharmaceutical composition based on seven consistent disclosures, in the specification, of an embodiment where the hydrosol occurred as a pharmaceutical composition; in *Union Oil Co. of California v. Atlantic Richfield Co.*,³⁸ where several consistent statements all related to domestic commuter automobiles; in *Irdeto Access, Inc. v. Echostar Satellite Corp.*,³⁹ where consistent statements relating to the term “group” occurred in at least five places in the patent; and

³³ *Id.* at 1368 (citing *Middleton, Inc. v. Minn. Mining & Mfg. Co.*, 311 F.3d 1384, 1388 (Fed. Cir. 2002)).

³⁴ *Id.* at 1368-70.

³⁵ *Id.* at 1377 (Schall, J., dissenting) (citing *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1367 (Fed. Cir. 2002)).

³⁶ See *infra* Appendix Two.

³⁷ 363 F.3d 1306, 1309-10 (Fed. Cir. 2004).

³⁸ 208 F.3d 989 (Fed. Cir. 2000).

³⁹ 383 F.3d 1295, 1298 (Fed. Cir. 2004).

in *Gillette Co. v. Energizer*,⁴⁰ where about thirty consistent statements all related to three-bladed razors. Moreover, opinions have provided listings of consistent statements in *Ocean Innovations, Inc. v. Archer*,⁴¹ where the opinion pointed out four places in the specification where the term “hollow” was used; in *Poly-America, L.P. v. GSE Lining Technology, Inc.*,⁴² where the term “blown film” was repeated some fifty-four times; and in *TAP Pharmaceutical Products, Inc. v. Owl Pharmaceuticals, LLC*,⁴³ where there were thirty-one consistent disclosures of a drug in combination with a drug-retaining substance.

¶16 Additionally, the court provided a listing or numbering of consistent statements in *Phillips v. AWH Corp.*,⁴⁴ where the dissent observed a repeated disclosure relating to angles and argued that the disputed claim term should be at an angle on the basis that six of the figures and several points in the specification consistently disclosed the invention at an angle⁴⁵; in *Multiform Desiccants, Inc. v. Medzam, Ltd.*,⁴⁶ where the meaning of “degrade” was held to mean “dissolve” or “disintegrate” on the basis that the specification repeatedly (six times) disclosed the invention as one that dissolves or disintegrates; and in *Wang Laboratories, Inc. v. America Online*,⁴⁷ where the court narrowed the claim to require characters, on the basis that all of the descriptions of the invention in the specification referred to characters. In the patent at issue in *Wang Laboratories*, the terms “character” and “characters” occurred ninety-five times throughout the specification.⁴⁸

Explicit contexts are essentially free of controversy during patent litigation

¶17 As mentioned above, the two main types of explicit context are explicit definitions and disclaimers. An explicit definition can be provided in isolation, in the patent specification, or can occur with other definitions in a definitions section. U.S. Patent Number 6,423,394, a patent relating to mesh structures, contains a definitions section.⁴⁹ The definitions section in this patent defines about thirty terms, some of which reside in the claims. For example, “crotch-forming zone,” a term found in the claims, is defined as the zone adjacent to the corner of a notational junction zone.⁵⁰ The presence of an explicit definition likely prevents the examiner, during patent prosecution, from rejecting the claim containing the defined term as indefinite under statutory patent law.⁵¹ An explicit definition will also likely prevent the court, during litigation, from finding the claim term ambiguous and in need of interpretation. Given an explicit definition, the court will not examine the specification for an implicit context that it would consequently

⁴⁰ 405 F.3d 1367 (Fed. Cir. 2005).

⁴¹ 145 Fed. App'x 366 (Fed. Cir. 2005).

⁴² 383 F.3d 1303 (Fed. Cir. 2004).

⁴³ 419 F.3d 1346 (Fed. Cir. 2005).

⁴⁴ 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

⁴⁵ *Id.* at 1328-1331 (Lourie, J., dissenting).

⁴⁶ 133 F.3d 1473 (Fed. Cir. 1998).

⁴⁷ 197 F.3d 1377 (Fed. Cir. 1999).

⁴⁸ U.S. Patent No. 4,751,699 (filed April 4, 1985).

⁴⁹ U.S. Patent No. 6,423,394 col.3 l.39-col.6 l.36 (filed July 28, 1997).

⁵⁰ '394 Patent col.4 l.37.

⁵¹ See 35 U.S.C. § 112.

use to narrow the claim scope and to assign a meaning to the claim term that was not intended by the inventor. Thus, during patent prosecution or litigation, the explicit definition in U.S. Patent Number 6,423,394 prevents the patent examiner, the court, as well as the inventor from interpreting “crotch-forming zone” differently than how it was set forth in the definitions section.

II. THE PROPRIETY OF USING AN IMPLICIT CONTEXT TO ARRIVE AT THE MEANING OF A CLAIM HAS HINGED ON THE DEGREE OF PRIMA FACIE AMBIGUITY OF THE DISPUTED CLAIM TERM

¶18 Although the majority of patents contain contexts of implication, the Federal Circuit has refrained from the unbridled use of this source of claim construction. The court has reined in the use of implicit contexts in cases such as *Comark Communications, Inc. v. Harris Corp.*⁵² As discussed below, the unrestrained use of implicit contexts has been controlled by the courts’ occasional assessment of prima facie ambiguity, where a finding of a high degree of prima facie ambiguity was used to justify tapping into the implicit context and a low degree of prima facie ambiguity was used as a justification to refrain from tapping into the implicit context.

¶19 The potential impropriety of importing a meaning from an implicit context is set forth in *Comark*, which warns that there is “a fine line between reading a claim in light of the specification, and [impermissibly] reading a limitation into the claim from the specification.”⁵³ This “*Comark* warning” can now be found in a fair number of cases.⁵⁴

¶20 In addition to the *Comark* warning, another maxim, the “*Johnson Worldwide* warning,” cautions against importing limitations from the specification to the claims. It is found in two frequently cited cases, *Johnson Worldwide Associates Inc. v. Zebco Corp.*⁵⁵ and *CCS Fitness, Inc. v. Brunswick Corp.*⁵⁶ The *Johnson Worldwide* warning dictates that the meaning of a term, as evident in the contexts of the claim itself, can be overridden by a context of implication in a situation “where the term or terms chosen by the patentee so *deprive the claim of clarity* that there is no means by which the scope of the claims may be ascertained from the language used.”⁵⁷ The Federal Circuit, in *Altiris*,

⁵² 156 F.3d 1182,1186-87 (Fed. Cir. 1998).

⁵³ *Id.*

⁵⁴ See, e.g., *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc); *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 904 (Fed. Cir. 2004); *MBO Labs., Inc. v. Becton, Dickinson & Co.*, 474 F.3d 1323, 1333-34 (Fed. Cir. 2007); *Alloc, Inc. v. Int’l Trade Comm’n*, 342 F.3d 1361, 1370 (Fed. Cir. 2003); *Unitherm Food Sys., Inc. v. Swift-Eckrich, Inc.*, 375 F.3d 1341, 1351 (Fed. Cir. 2004); *Playtex Prods., Inc. v. Procter & Gamble Co.*, 400 F.3d 901, 906 (Fed. Cir. 2005); *Anchor Wall Sys., Inc. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298, 1307 (Fed. Cir. 2003); *Bell Atl. Network Servs., Inc. v. Covad Commc’ns Group, Inc.*, 262 F.3d 1258, 1270 (Fed. Cir. 2001); *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1331-32 (Fed. Cir. 2001); *Astrazeneca AB v. Mutual Pharm. Co.*, 384 F.3d 1333, 1337 n.2 (Fed. Cir. 2004); *Sibia Neurosciences, Inc. v. Cadus Pharm. Corp.*, 225 F.3d 1349, 1355 (Fed. Cir. 2000); *Liquid Dynamics Corp. v. Vaughan Co.*, 355 F.3d 1361, 1368-69 (Fed. Cir. 2004); *Prima Tek II, LLC v. Polypap, S.A.R.L.*, 318 F.3d 1143, 1148-49 (Fed. Cir. 2003).

⁵⁵ 175 F.3d 985 (Fed. Cir. 1999).

⁵⁶ 288 F.3d 1359 (Fed. Cir. 2002).

⁵⁷ *Johnson Worldwide*, 175 F.3d at 990 (emphasis added).

Inc. v. Symantec Corp.,⁵⁸ elaborated on the *Johnson Worldwide* warning, adding that resorting to the rest of the specification to define a claim term is “only appropriate in limited circumstances” where the phrase chosen by the patentee so deprives the claim of clarity.⁵⁹

¶21 In a number of opinions, the Federal Circuit has paused to assess the degree of prima facie ambiguity in a disputed claim before reviewing the specification for contexts of implication.⁶⁰ The term “prima facie,” as used in this article, refers to the meaning of a claim term derived at first glance, without regard to anything in the specification, where the derived meaning was based on the court’s life experiences and understanding of the case law and policies set forth by the Patent Office. After assessing ambiguity, the court assigns a corresponding weight to any implicit contexts residing in the specification. In short, where the court finds the term to have a high degree of prima facie ambiguity, the court assigns a high degree of weight to the implicit context and readily imports the limitation from the specification to the claim.⁶¹ Where the court finds the term not to be prima facie ambiguous, the court refrains from importing the limitation to the claims.⁶² This careful and reasonable exercise in claim construction is documented below.

III. EXAMPLES WHERE LACK OF PRIMA FACIE AMBIGUITY WAS USED TO ASSIGN A LESSER DEGREE OF WEIGHT TO ANY CONTEXTS OF IMPLICATION FOUND IN THE SPECIFICATION

¶22 Where the court finds that a disputed claim term has a detectable prima facie meaning—that is, where the court finds that the claim term is not deprived of clarity—the court has assigned a lesser degree of weight to contexts of implication.

¶23 For example, in *Free Motion Fitness, Inc. v. Cybex International, Inc.*,⁶³ the disputed claim term was the word “a.” The majority found the term “a” to be prima facie *lacking in ambiguity*, based on established case law holding that the word “a” means one or more.⁶⁴ In contrast, the dissent argued that “a” means only one, based on the specification’s repeated and consistent disclosure that the term “a,” in the context of “a cable,” was associated with only one cable.⁶⁵ The court ultimately held that “a” means one or more, based on the prima facie nonambiguity of the term “a” in the patent drafting art.⁶⁶ In short, the word “a” has a conventional meaning in the patent drafter’s art.

¶24 Similarly, in *Gillette Co. v. Energizer Holdings, Inc.*,⁶⁷ the disputed claim term was “group.” The majority found the term “group” to be prima facie *lacking in*

⁵⁸ 318 F.3d 1363 (Fed. Cir. 2003).

⁵⁹ *Id.* at 1372.

⁶⁰ See *infra* Parts III and IV.

⁶¹ See *infra* Part IV.

⁶² See *infra* Part III.

⁶³ 423 F.3d 1343 (Fed. Cir. 2005) (Prost, J., dissenting).

⁶⁴ *Id.* at 1350.

⁶⁵ *Id.* at 1355.

⁶⁶ *Id.* at 1350.

⁶⁷ 405 F.3d 1367 (Fed. Cir. 2005).

ambiguity, based on case law holding that “group” is an open-ended term.⁶⁸ In contrast, the dissent argued that “group” must be limited to three because of the specification’s repeated and consistent disclosure of the concept of a group of three razor blades.⁶⁹ A razor-blade unit containing a group of three blades was disclosed at thirty different places in the specification.⁷⁰ However, the *prima facie* unambiguous meaning trumped the overwhelming context of implication, and the court held “group” to mean three or more.

¶25 In *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*,⁷¹ another case in which the court found a *prima facie* lack of ambiguity, the disputed claim term was “operatively connected.”⁷² The dispute focused on whether the term narrowly required an actual connecting or fixing to a cap, or if the term more broadly encompassed adjoining or abutting, as well as connecting and fixing. The lower court held that “operative” meant an actual fixed connection, on the basis of the specification’s repeated and consistent disclosure of the concept of a cap connected to a tube.⁷³ The Federal Circuit realized that “operative” was a conventional term of the patent drafter’s art, where “operative” means a functional relationship.⁷⁴ Finding that the *prima facie* nonambiguity trumped the implicit context, the Federal Circuit remanded the case to the lower court.⁷⁵ The Federal Circuit has consistently taken this approach; these decisions are only a sample of the cases in which the court found a lack of *prima facie* ambiguity and assigned a lesser degree of weight to contexts of implication.⁷⁶

IV. EXAMPLES WHERE EXISTENCE OF PRIMA FACIE AMBIGUITY WAS USED TO ASSIGN A GREATER DEGREE OF WEIGHT TO ANY CONTEXTS OF IMPLICATION FOUND IN THE SPECIFICATION

¶26 Where the Federal Circuit finds that a disputed claim term is deficient, or totally lacking, in *prima facie* meaning, the court has assigned a greater degree of weight to contexts of implication. The Federal Circuit frequently has used a finding of a high degree of *prima facie* ambiguity as the justification for assigning a high degree of weight to contexts of implication.⁷⁷ For example, in *Bell Atlantic Network Services v. Covad*

⁶⁸ *Id.* at 1372.

⁶⁹ *Id.* at 1379 (Archer, J., dissenting).

⁷⁰ *Id.* at 1378 n.3.

⁷¹ 381 F.3d 1111 (Fed. Cir. 2004).

⁷² *Id.* at 1117-18.

⁷³ *Id.* at 1114.

⁷⁴ *Id.* at 1117-18.

⁷⁵ *Id.* at 1125.

⁷⁶ See also *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 905 (Fed. Cir. 2004); *Sunrace Roots Enterprise Co. v. SRAM Corp.*, 336 F.3d 1298, 1307 (Fed. Cir. 2003); *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309 (Fed. Cir. 1999); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1328 (Fed. Cir. 2005) (en banc); *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1561-62 (Fed. Cir. 1991); *ASM America, Inc. v. Genus, Inc.*, 401 F.3d 1340, 1343 (Fed. Cir. 2005); *Northern Telecom Ltd. v. Samsung Electronics, Co.*, 215 F.3d 1281, 1295 (Fed. Cir. 2000).

⁷⁷ See *Bell Atl. Network Servs. v. Covad Commc’ns, Inc.*, 262 F.3d 1258, 1269-70 (Fed. Cir. 2001); *Howmedica Osteonics Corp. v. Tranquil Prospects, Ltd.*, 401 F.3d 1367, 1372 (Fed. Cir. 2005); *Novartis Pharm. Corp. v. Eon Labs Mfg., Inc.*, 363 F.3d 1306, 1309-10 (Fed. Cir. 2004); *Watts v. XL Sys., Inc.*, 232 F.3d 877, 882-83 (Fed. Cir. 2000); *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1298 (Fed. Cir. 2004); *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1374 (Fed. Cir. 2003).

Communications, Inc., the court found a high degree of prima facie ambiguity based on the fact that the term “mode” was so broad as to be amorphous.⁷⁸ Similarly, in *Altiris, Inc. v. Symantec Corp.*, the court paused to assess ambiguity of the claim term “automation code,” and found it to be deprived of clarity because the term was so broad as to lack significant meaning.⁷⁹ In *Howmedica Osteonics Corp. v. Tranquil Prospects Ltd.*, prima facie ambiguity was established because the claim contained a number referring to a unit of measurement, but failed to indicate if the unit was a unit of length or a unit of area.⁸⁰ In *Novartis Pharmaceuticals Corp. v. Eon Labs Manufacturing, Inc.*, a high degree of prima facie ambiguity was established by competing dictionary definitions.⁸¹ In *Irdeto Access, Inc. v. Echostar Satellite Corp.*, prima facie ambiguity was established by admission.⁸² *Gentry Gallery v. Berkline Corp.*⁸³ discloses a striking example of ambiguity. The disputed term was “fixed,” and what was ambiguous was whether fixed meant a first object secured or attached to a second object, or if it meant no part movable, as with a pivot.⁸⁴ Both meanings are clearly different from each other. The first meaning—“attached”—in ordinary English language does not encompass the second meaning—“nonmovable.” Also, the second meaning does not encompass the first.

¶27 In *Genzyme Corp. v. Transkaryotic Therapies, Inc.*,⁸⁵ the majority and dissent disagreed on whether the disputed claim term, “integrated,” was prima facie ambiguous.⁸⁶ The majority expressly believed the term to be ambiguous and, in consequence, narrowed the meaning of the disputed claim term on the basis of an implicit context, a repeated and consistent statement.⁸⁷

¶28 To summarize, one body of case law, as represented by *Comark*, reminds us of a “fine line” and warns against importing limitations from the specification into the claims. Another body of case law, which also serves to limit use of implicit contexts in narrowing claim scope and is represented by *Johnson Worldwide*, holds that using contexts of implication can be justified where the claim term is devoid of clarity. However, there is no bright-line rule regarding the weight to be given to implicit contexts when the court is faced with claim terms suffering from only a moderate degree of ambiguity.

V. “ARTIFICIAL AMBIGUITY” AND THE FAILURE OF THE FEDERAL CIRCUIT TO PROPERLY ASSESS DEGREE OF AMBIGUITY OF A DISPUTED CLAIM TERM

¶29 Despite well-established guidance from *Comark* and from *Johnson Worldwide*, the Federal Circuit readily turns to the specification and imports limitations on the basis of implicit contexts, even where there are no expressed allegations of ambiguity in the

⁷⁸ *Bell Atl.*, 262 F.3d at 1269-70.

⁷⁹ *Altiris*, 318 F.3d at 1374.

⁸⁰ *Howmedica Osteonics*, 401 F.3d at 1372.

⁸¹ *Novartis*, 363 F.3d at 1309-10.

⁸² *Irdeto Access*, 383 F.3d at 1298.

⁸³ 134 F.3d 1473 (Fed. Cir. 1998).

⁸⁴ *Id.* at 1476-77.

⁸⁵ 346 F.3d 1094 (Fed. Cir. 2003).

⁸⁶ *Id.* at 1106-07 (Fed. Cir. 2003) (Linn, J., dissenting).

⁸⁷ *Id.* at 1098-1103.

disputed claim term. This behavior appears in a body of cases in which the Federal Circuit has refrained from any studied assessment of prima facie ambiguity and moved directly into the specification in search of implicit contexts that are subsequently used for claim construction. In these situations, the court has justified its exploration by invoking an artificial type of ambiguity. When utilized by the Federal Circuit, this artificial ambiguity is not based on how an ordinary person skilled in the art might view the disputed claim term; it apparently results solely from the urging of the accused infringer. Table 1 discloses the available cases where the court has invoked this artificial ambiguity. In view of the fact that an ordinary skilled artisan typically uses one word to encompass both a broad and a narrow meaning, and in view of the fact that cited opinions refused to allow one word to encompass both broad and narrow meanings (or to encompass two separate but compatible meanings), the alleged ambiguity can be reasonably characterized as artificial.

¶30 As detailed below, the Federal Circuit, at the urging of the adverse party, willingly turns to the specification for implicit contexts and, in consequence, narrows the claims. To give a hypothetical example, where a claim contains the term “chair,” the adverse party may raise the issue that “chair” is ambiguous because it could narrowly mean only wooden chairs or more broadly encompass wooden and metal chairs. To continue with this hypothetical example, a typical result of the claim construction exercise is that the court explores the specification for implicit contexts, detects repeated disclosure of metal chairs (metal patio chairs, metal office chairs), and willingly narrows the claim term “chair” to mean only “metal chair.” As documented in Table 1, this is a common fact pattern in the Federal Circuit, but the approach is contrary to court’s case law that holds, “[i]f an apparatus claim recites a general structure without limiting that structure to a specific subset of structures, we will generally construe the term to cover all known types of that structure.”⁸⁸

¶31 The fact pattern of the hypothetical example is a common one, as disclosed in the collection of cases documented in Table 1. In each of the listed cases, the accused infringer apparently had argued that the claim term could encompass two different meanings, with the goal of convincing the court that the term was ambiguous, thus convincing the court to explore the specification for contexts that might implicate one of these two meanings as the correct one. In all of the listed cases, the court detected a context of implication in the specification, imported meaning from these contexts to the claims, and narrowed the claim. In each case, the exercise of artificial ambiguity worked to the disadvantage of the patentee.

¶32 In noting the court’s logic in arriving at artificial ambiguity, patentees should consider making use of *Inverness Medical Switzerland GmbH v. Warner Lambert Co.*,⁸⁹ which held that “a word that has an ordinary meaning encompassing two relevant alternatives may be construed to encompass both alternatives.”⁹⁰

⁸⁸ *CSS Fitness v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002) (quoting *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998)).

⁸⁹ 309 F.3d 1373 (Fed. Cir. 2002).

⁹⁰ *Id.* at 1379 (citing *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336 (Fed. Cir. 2001)).

Table 1. Artificial ambiguity—Claim construction in absence of proper allegations of ambiguity.

Case	Disputed Claim Term	Issue
<i>Alloc, Inc. v. International Trade Commission</i> ⁹¹	The claim covered a method for the side-by-side laying of panels, but no particular claim term was in dispute.	Does the claim narrowly cover methods where panels are loosely fitted and have wiggle room or “play” or more broadly encompass methods with either loosely fitted (with play) and tightly fitted panels (no play)? ⁹²
<i>Hockerson-Halberstadt, Inc. v. AVIA Group</i> ⁹³	“Central longitudinal groove”	Does “central longitudinal groove” narrowly mean lesser than the width of fins or more broadly encompass widths that are both wider and narrower than the width of fins? ⁹⁴
<i>O.I. Corporation v. Tekmar Co.</i> ⁹⁵	“Passage”	Does “passage” narrowly have nonsmooth walls, or does “passage” more broadly encompass both smooth and nonsmooth walls? ⁹⁶
<i>Tronzo v. Biomet, Inc.</i> ⁹⁷	“Cup prothesis [sic]”	Does “cup prosthesis” narrowly mean a cone-shaped cup, or does it more broadly encompass cups of any shape? ⁹⁸
<i>Gaus v. Conair Corp.</i> ⁹⁹	“Pair of probes”	Does “pair of probes” narrowly encompass probes located outside of an interior electronics compartment or more broadly encompass locations both inside and outside? ¹⁰⁰

⁹¹ 342 F.3d 1361 (Fed. Cir. 2003).

⁹² *Id.* at 1373.

⁹³ 222 F.3d 951 (Fed. Cir. 2000).

⁹⁴ *Id.* at 954.

⁹⁵ F.3d 1576 (Fed. Cir. 1997).

⁹⁶ *Id.* at 1580.

⁹⁷ 156 F.3d 1154 (Fed. Cir. 1998).

⁹⁸ *Id.* at 1158.

⁹⁹ 363 F.3d 1284 (Fed. Cir. 2004).

¹⁰⁰ *Id.* at 1286.

Table 1. Artificial ambiguity—Claim construction in absence of proper allegations of ambiguity.

Case	Disputed Claim Term	Issue
<i>Multiform Desiccants, Inc. v. Medzam, Ltd.</i> ¹⁰¹	“Degradable”	Does “degradable” narrowly encompass dissolving or more broadly encompass both dissolving as well as splitting or bursting? ¹⁰²
<i>General American Transportation, Inc. v. Cryo-Trans, Incorp.</i> ¹⁰³	“Adjacent”	Does “adjacent” narrowly mean only adjacent to a side wall or more broadly encompass both adjacent to a side wall or adjacent to an end wall? ¹⁰⁴
<i>Renishaw PLC v. Marposs Societa’ Per Azioni</i> ¹⁰⁵	“When”	Does “when” narrowly mean at the same instant or more broadly encompass either at the same time as well as any time after? ¹⁰⁶
<i>Toro Co. v. White Consolidated Industries, Inc.</i> ¹⁰⁷	“Including”	Does “including” narrowly mean permanently attached or more broadly encompass either permanent or reversible attachment? ¹⁰⁸
<i>TAP Pharmaceutical Products, Inc. v. Owl Pharmaceuticals, LLC</i> ¹⁰⁹	“Particles”	Must the “particles” narrowly include a “drug-retaining substance” and a drug or does the term “particles” more broadly encompass a drug, with or without the drug-retaining substance? ¹¹⁰

VI. CONCLUSION

¶33 As disclosed in Appendix Three, contexts of implication are frequently used by the Federal Circuit as a tool for claim construction, where the end result of the claim construction exercise is usually a narrowing of claim scope. This narrowing of claim scope was undoubtedly, in most cases, unforeseen and unintended by the inventor.

¹⁰¹ 133 F.3d 1473 (Fed. Cir. 1998).

¹⁰² *Id.* at 1477.

¹⁰³ 93 F.3d 766 (Fed. Cir. 1996).

¹⁰⁴ *Id.* at 769.

¹⁰⁵ 158 F.3d 1243 (Fed. Cir. 1998).

¹⁰⁶ *Id.* at 1250-51.

¹⁰⁷ 199 F.3d 1295 (Fed. Cir. 1999).

¹⁰⁸ *Id.* at 1300.

¹⁰⁹ 419 F.3d 1346 (Fed. Cir. 2005).

¹¹⁰ *Id.* at 1353.

Sometimes, the Federal Circuit proceeds to review the specification for contexts of implication, without first pausing to assess if the disputed claim term suffered from ambiguity or if the term suffered from some mistaken usage. In short, the Federal Circuit frequently sets out to fix something that arguably is not broken. The opinions listed in Table 1 demonstrate that allegations of ambiguity follow a simple formula (the chair hypothetical), easily initiated by any accused infringer. The end result is that the Federal Circuit places an undue burden on the patentee to defend the intended breadth of scope claims.

¶34 The Federal Circuit should set forth a rule that claim construction must begin by assessing ambiguity in the disputed claim term, and then continue with an explanation of why the term is ambiguous or why the disputed term was used incorrectly. In making this assessment of ambiguity, the court might refer to Appendix One of this article. An opinion that is consistent with the author's suggestion is *Howmedica Osteonics Corp. v. Tranquil Products Ltd.*¹¹¹ The ambiguous claim term was "seventy percent (70%) of the transverse sectional dimensions,"¹¹² which left in question whether "seventy percent" referred to an area or to a length. The court paused to draft a studied analysis of the source of ambiguity, writing that "[t]he claims . . . require that the 'transverse sectional dimensions' of the coated prosthesis constitute certain percentages of the 'transverse sectional dimensions' of the medullary canal . . . [t]he parties dispute which 'dimensions' of the 'transverse section' define the claimed percentages"¹¹³

¶35 After engaging in this reasoned analysis of the ambiguity, the court reviewed the specification for contexts of implication. This reasoned analysis of ambiguity is distinguished by the following phrase, which serves as a turning point in the opinion: "Consequently, one of ordinary skill in the art must [need to] know [which dimension to use]."¹¹⁴ It should be evident that an interpretation of the claim that encompasses both meanings (area and length) is unreasonable and contrary to the meaning understood by any person with a working knowledge of high school geometry. Then, on the basis of a recitation of advantage, the *Howmedica* court appropriately narrowed the claim.¹¹⁵ In contrast to the reasoned analysis found in *Howmedica*, the opinions documented in Table 1 take the accused infringer's allegations of ambiguity at face value, and readily tap the specification's implicit contexts to arrive at the meaning of the disputed claim term.

¶36 In finding that a disputed claim term is ambiguous, the Federal Circuit should use a basis more substantial than the artificial ambiguity set forth in the "chair hypothetical" and those justifications set forth in a fair number of published opinions, like those cited in Table 1. The court's tendency to periodically undertake claim construction without first pausing to explain why the claim is in need of interpretation, or in need of narrowing, places an undue burden on the patentee.

¹¹¹ 401 F.3d 1367 (Fed. Cir. 2005).

¹¹² *Id.* at 1369.

¹¹³ *Id.* at 1370.

¹¹⁴ *Id.* at 1371.

¹¹⁵ *Id.* at 1372.

¶37 The Federal Circuit should hold that contexts of implication are a valid tool for claim construction. In view of the occasional dissent and discord as to the validity of contexts of implication, the court should directly address the issue of whether contexts of implication are valid tools under any situation, or only where the disputed claim term is deprived of clarity. Implicit contexts can be a valuable source of meaning where the ambiguity stems from the fact that the disputed term arises from an emerging technology, or where the inventor was simply not in a position to provide a suitable definition at the patent's filing date. Ambiguous terms in the claim can also be a consequence of time constraints in the claim drafting and patent preparation processes.

¶38 The following is practical advice to any patent attorney or agent. First, while it is essential to disclose any advantages of the claimed invention, it is a poor idea to label them as "advantages" and a poor idea to explicitly contrast them with any "prior art." During the prosecution phase of any patent in which the inventor wishes to contrast the invention with the prior art and disclose advantages that the invention has over the prior art, the inventor can easily educate the examiner as to the advantages of the invention by a telephonic conference or by submitting a Declaration. Second, the patent practitioner should avoid the potential effects of a repeated and consistent disclosure by drafting a number of alternate embodiments, for example, embodiments made of different materials or used for different purposes. The attorney or agent should include the term "without limitation" or "in an alternative embodiment" in disclosures accompanying each embodiment. Third, the attorney or agent should avoid using global comments, such as recitations of "the present invention." If the attorney or agent wishes to use the phrase "the present invention," it should be set forth as "the present invention, in some embodiments . . ." or "the present invention, in some aspects" Fourth, where the claims contain any nonstandard terms, or terms newly arising in the art, the patent practitioner should include an *explicit definition*. Sometimes, the inventor is unable, or does not have time, to provide a definition for a technical term used in the claims. Where this is the case, the patent practitioner should consider citing scientific publications that disclose how the skilled artisan uses the term in question.

APPENDIX ONE

CATAGORIES OF AMBIGUITY

¶39 The categories of ambiguity, as set forth in various opinions from the Federal Circuit, are as follows:

A. SUBJECTIVE TERMS

¶40 Terms that refer to the subjective impressions of an individual, or to emotions, have a high degree of ambiguity. For example, U.S. Patent No. 6,014,137, which contained the term “aesthetically pleasing” in its claims, was held to be invalid for indefiniteness under 35 U.S.C. § 112.¹¹⁶ The invalidated claim read as follows: “Claim 1. In an electronic kiosk system . . . a method for defining custom interface screens customized for individual kiosks . . . comprising the steps of . . . providing a plurality of pre-defined interface screen element types . . . wherein each said element type permits limited variation in its on-screen characteristics in conformity with *a desired uniform and aesthetically pleasing look and feel* for said interface screens”¹¹⁷

B. AMORPHOUS TERMS

¶41 Words having an amorphous or “catch-all” meaning, such as “mode” or “material object,” have been held to have a high degree of ambiguity.¹¹⁸ The terms “substantially” and “sufficient,” when used in a claim, can be a source of ambiguity during litigation. These terms have been used in the following contexts: “distance sufficient,” “substantially within,” “substantially completely wetted,” or “a substantial part of the entire height.”¹¹⁹

C. FUNCTIONAL ELEMENTS

¶42 Established case law from the Federal Circuit, and its predecessor the Court of Customs and Patent Appeals, holds that functional elements are valid tools in the claim

¹¹⁶ *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1356 (Fed. Cir. 2005).

¹¹⁷ U.S. Patent No. 6,014,137 col.20 l.37-1.57 (filed Feb. 27, 1997) (emphasis added).

¹¹⁸ *See, e.g., Bell Atl. Network Servs. v. Covad Commc'ns, Inc.*, 262 F.3d 1258 (Fed. Cir. 2001) (“[T]he ordinary meaning of the non-technical term ‘mode’ is sufficiently broad and amorphous”); *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323 (Fed. Cir. 2001) (defining four “technical terms”).

¹¹⁹ *See, e.g., Moore U.S.A., Inc. v. Standard Register Co.*, 229 F.3d 1091 (Fed. Cir. 2000) (defining the term “distance sufficient”); *American Seating Co. v. Transportation Seating, Inc.*, 62 Fed. App’x 344, 2003 U.S. App. LEXIS 5826 (Fed. Cir. 2003) (determining the proper meaning of the terms “bulkhead,” “stowed,” and “substantially within”).

drafting art.¹²⁰ A functional element can take the place of a structural element, in that both types of elements can distinguish the claimed invention from a prior art device and that both types of elements can satisfy the statutory written description requirements.¹²¹ According to the *Manual of Patent Examining Procedure*, interpretation of a functional element may entail a review of the specification, or evidence of knowledge typical of a skilled artisan, for structures that are correlated with that function.¹²² “[I]f the art has established a strong correlation between structure and function, one skilled in the art would be able to predict . . . the structure of the claimed invention from a recitation of function [in the claims] . . . without such a correlation, the capacity to recognize and understand the structure from the mere recitation of function and minimal structure . . . does not satisfy the written description requirement.”¹²³

¶43 In view of the need to review the specification or the knowledge typical of the skilled artisan to assess this correlation, functional elements in claims can be seen as a potential source of ambiguity. For example, functional elements like “synergistically effective amount” can be a source of ambiguity.¹²⁴ Environment of use descriptions residing in a composition of matter claim, such as “allows several kernels of popped popcorn to pass through,” also can raise issues of ambiguity.¹²⁵ The functional term “amount sufficient” was a source of ambiguity in *Abbott Laboratories v. Baxter Pharmaceutical Products, Inc.*¹²⁶ The functional term “conductive” was an issue and a source of ambiguity in *Ekchian v. Home Depot*.¹²⁷

D. ADMISSIONS

¶44 Where the applicant admits that a claim term has no ordinary and customary meaning in the art, the court will likely find the term to be ambiguous and will explore the specification for contexts useful for arriving at the proper meaning. *Irdeto Access, Inc. v. Echostar Satellite Corp.*¹²⁸ involved an admission of this nature that arose in an argument submitted by the inventor to the examiner.¹²⁹

E. PREAMBLE

¶45 Where a claim has a preamble, the claim is divided into the preamble and the

¹²⁰ See, e.g., *In re Swinehart*, 439 F.2d 210 (C.C.P.A. 1970); *In re Venezia*, 530 F.2d 956 (C.C.P.A. 1976); *In re Hallman*, 655 F.2d 212 (C.C.P.A. 1981); *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356 (Fed. Cir. 1999).

¹²¹ See 35 U.S.C. § 112.

¹²² U.S. PATENT & TRADEMARK OFFICE, U.S. DEP’T OF COMMERCE, *MANUAL OF PATENT EXAMINING PROCEDURE* § 2163, 2100-174 (8th ed., Rev. 5, 2006).

¹²³ *Id.*

¹²⁴ *Geneva Pharm., Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1383 (Fed. Cir. 2003).

¹²⁵ *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997).

¹²⁶ 334 F.3d 1274 (Fed. Cir. 2003).

¹²⁷ 104 F.3d 1299 (Fed. Cir. 1997).

¹²⁸ 383 F.3d 1295 (Fed. Cir. 2004).

¹²⁹ *Id.* at 1303.

body.¹³⁰ For most patents, the preamble is everything before the word “comprising,” while the body of the claim is everything after “comprising.” The preamble has often been a source of ambiguity in determining whether one or more terms residing in the preamble are limitations to the claim. The question of whether a preamble is a limitation to the claims, or merely recites a possible environment of use or optional purpose of the invention, has been resolved by a number of tests. One test asks whether deletion of the preamble causes the body of the claim to make no sense.¹³¹ A second test asks whether the specification implies that the material recited in the preamble is a part of the invention.¹³² Most cases from the Federal Circuit use the first test, though the court will sometimes apply the second test and occasionally use both. In *Rockwell International Corp. v. United States*,¹³³ for example, the Federal Circuit used only the second test and made use of contexts of implication, residing in the specification, to resolve the ambiguity.¹³⁴ Thus, the mere fact that a claim term resides in the preamble can raise an ambiguity issue.

F. MEANS PLUS FUNCTION CLAIMS

¶46 Means plus function claims have a statutory basis in 35 U.S.C. § 112, paragraph six. Guidance for interpretation of means plus function claims can be found in *Kemco Sales, Inc. v. Control Papers Co.*¹³⁵ According to the established case law, a means plus function claim is automatically ambiguous and always requires an exploration of the specification to arrive at structures or compositions corresponding to the term “means.”¹³⁶

G. TWO INCOMPATIBLE MEANINGS

¶47 The skilled artisan often uses one broad word to encompass a broad meaning and one or more narrow meanings, or one broad word to encompass two or more narrow meanings. For example, the word “color” can encompass red, but it can also encompass rose, crimson, pink, and scarlet. But sometimes, a single broad word (or claim term) is not conventionally used by the skilled artisan to refer to two separate narrow meanings. In this situation, allegations of ambiguity can properly be raised. Examples are as follows. In *General American Transportation, Inc. v. Cryo-Trans, Inc.*,¹³⁷ the term “adjacent,” as it applied to a row of holes, could have been used to refer to the row (the row as a single entity) being adjacent to a wall. Or “adjacent” could have been applied to only one of the holes in the row, where the term did not require that all of the holes be adjacent to the wall. The court held that only one of these meanings of “adjacent” was

¹³⁰ U.S. PATENT & TRADEMARK OFFICE, U.S. DEP’T OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE § 2111.02, 2100-41 (8th ed., Rev. 5, 2006).

¹³¹ *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305-1306 (Fed. Cir. 1999).

¹³² *See, e.g., Rockwell International Corp. v. United States*, 147 F.3d 1358, 1362-63 (Fed. Cir. 1998).

¹³³ *Id.*

¹³⁴ *Id.* at 1362-63.

¹³⁵ 208 F.3d 1352 (Fed. Cir. 2000).

¹³⁶ *Id.* at 1360-61.

¹³⁷ 93 F.3d 766 (Fed. Cir. 1996).

correct. In *Howmedica Osteonics Corp. v. Tranquil Products Ltd.*,¹³⁸ the term “dimensioned” could conceivably have been used to encompass both length and area, but this use was at odds with the use of the skilled artisan. The court held that only one of these meanings of “dimensioned” was correct. The examples of the row of holes, and of the dimensioned bone implant, are reminiscent of the duck/bunny illusion, where a single drawing can be perceived as being either a duck or a bunny, but not as both simultaneously.¹³⁹

H. MISTAKE

¶48 *Superior Fireplace Co. v. Majestic Products Co.*¹⁴⁰ sets forth three categories of mistakes:

Examples of such errors include misspellings that leave no doubt as to the word which was intended; “frane” instead of “frame,” for example. In contrast, a second category includes those typographical mistakes not apparent to the reader at all; for example, a mistake resulting in another word that is spelled correctly and that reads logically in the context of the sentence. A third category of mistakes includes those where it is apparent that a mistake has been made, but it is unclear what the mistake is.¹⁴¹

¶49 The issue in this case was inconsistent use of a term. At one point in the claim, the term was “rear wall” while at another point in the same claim, the term was “rear walls.”¹⁴² The opinion used an implicit context—that is, a context that was neither a definition nor a disclaimer—to arrive at the correct meaning. The implicit context took the form of one of the figures in the patent, which disclosed a fireplace having two rear walls.¹⁴³

¹³⁸ 401 F.3d 1367 (Fed. Cir. 2005).

¹³⁹ LUDWIG WITGENSTEIN, *PHILOSOPHICAL INVESTIGATIONS* 166 (Blackwell Publishing 2001) (1953).

¹⁴⁰ 270 F.3d 1358 (Fed. Cir. 2001).

¹⁴¹ *Id.* at 1370.

¹⁴² *Id.* at 1362.

¹⁴³ *Id.* at 1373-74.

APPENDIX TWO

HIERARCHY OF CONTEXTS

¶50 A complete list of all the contexts available for claim construction has not yet been set forth in any essay or opinion. The best available opinion is *Phillips v. AWH Corp.*¹⁴⁴ For this reason, these contexts are outlined below in Table 2.

¶51 Claim construction begins by assessing the meaning of a claim term without regard to the context of the entire claim. In some opinions, the Federal Circuit has used its own day-to-day experiences to determine the customary meaning of a claim term. For example, in *Wenger v. Coating Machinery*,¹⁴⁵ the issue was the meaning of “circulation.” The court wrote that “in common parlance, it is customary to speak of ‘circulating’ something once . . . without ‘recirculating’ it a second time.”¹⁴⁶ Similarly, in *Sunrace Roots Enterprises Co. v. SRAM Corp.*,¹⁴⁷ the ordinary and customary meaning was assessed by a consensus between all parties involved.¹⁴⁸

¶52 Conversely, in a concurring opinion in *Fromson v. Anitec Printing Plates, Inc.*,¹⁴⁹ Judge Mayer stated that the court should refrain from applying its own background in interpreting technical terms and should defer to the specification: “I ‘know’ what anodization means from my own undergraduate studies and experiments . . . [b]ut, I am neither an expert in the field nor one of ordinary skill in the art despite how much I think I ‘know’ about a process I once studied. Nor do my colleagues on this court . . . possess such expertise, and even if they did, they would have to defer to the record in the case.”¹⁵⁰ Judge Rader made a similar argument in his dissent in *K-2 Corp. v. Salomon S.A.*,¹⁵¹ stating that “[w]hen judges intuit an ordinary and accustomed meaning divorced from context, they are (usually unwittingly) imposing their own subjective linguistic values on a public decision.”¹⁵²

¶53 The context of the entire claim is another context used to construe a term residing in that claim. In interpreting a claim term, “[t]he context of the surrounding words in a claim . . . must be considered in determining the ordinary and customary meaning of a disputed claim limitation.”¹⁵³ *Housey Pharmaceuticals v. Astrazeneca UK Ltd.*¹⁵⁴ and *Interactive Gift Express, Inc. v. Compuserve Inc.*¹⁵⁵ provide dramatic examples of

¹⁴⁴ 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

¹⁴⁵ 239 F.3d 1225 (Fed. Cir. 2000).

¹⁴⁶ *Id.* at 1233.

¹⁴⁷ 336 F.3d 1298 (Fed. Cir. 2003).

¹⁴⁸ *Id.* at 1302.

¹⁴⁹ 132 F.3d 1437 (Fed. Cir. 1997).

¹⁵⁰ *Id.* at 1448 (Mayer, J., concurring).

¹⁵¹ 191 F.3d 1356, 1370 (Fed. Cir. 1999).

¹⁵² *Id.* at 1370 (Rader, J., dissenting).

¹⁵³ *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 345 F.3d 1318, 1325 (Fed. Cir. 2003).

¹⁵⁴ 366 F.3d 1348, 1354 (Fed. Cir. 2004).

¹⁵⁵ 256 F.3d 1326, 1331 (Fed. Cir. 2001).

interpreting a claim term by reference to neighboring terms in the same claim.

¶54 If a claim term appears clear and unambiguous solely in the context of the claims, there is little in the published case law suggesting that claim construction should come to a halt. In fact, the case law holds that claim construction must include a review of the specification.¹⁵⁶

¶55 Only after reviewing the intrinsic evidence, including the prosecution history, and finding that the disputed claim term remains ambiguous is the court permitted to review extrinsic evidence to determine the meaning of a term (see Table 2). Importantly, ambiguity is a condition precedent for reviewing the extrinsic evidence.¹⁵⁷ A concurring opinion in the en banc case *Cybor Corp. v. FAS Technologies, Inc.*¹⁵⁸ approved of the use of extrinsic evidence, even though extrinsic evidence might seem to be a matter of fact, rather than a matter of law: “[i]f need be, the trial judge may seek understanding outside the patent proper, from relevant texts and materials, and from experts in the art. None of the review involves “fact-finding” in the sense of the traditional fact-law dichotomy.”¹⁵⁹ The final step of the hierarchy of claim construction is reached when a claim is insolubly ambiguous and therefore must be held to be invalid under 35 U.S.C. § 112.¹⁶⁰

¶56 Contexts used to arrive at the meaning of a claim term can be found in the intrinsic evidence and the extrinsic evidence. The intrinsic evidence includes the claims, the specification, the prosecution history including the declarations and publications cited in declarations, and any other papers found in the patent application and associated formalities, such as the transmission form, information disclosure statement (IDS), and publications cited in the IDS.¹⁶¹

¹⁵⁶ See, e.g., *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) *aff’d*, 517 U.S. 370 (1996); *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

¹⁵⁷ See, e.g., *Intel Corp. v. VIA Techs., Inc.*, 319 F.3d 1357, 1367 (Fed. Cir. 2003); *Frank’s Casing Crew & Rental Tools, Inc. v. PMR Technologies, Ltd.*, 292 F.3d 1363, 1374 (Fed. Cir. 2002). Interestingly, ambiguity is a condition precedent to gaining proper access to certain types of evidence in other fields of law. In criminal procedure, once the authorities make a suspect aware of his Miranda rights, and the suspect makes clear that he wants to remain silent, further questions must not be asked. However, if the suspect provides an ambiguous answer, then the agent may interrogate the suspect. See, e.g., *People v. Carey*, 227 Cal. Rptr. 813 (1986); *Davis v. United States*, 512 U.S. 452 (1994); *Smith v. Illinois*, 469 U.S. 91 (1984).

¹⁵⁸ 138 F.3d 1448 (Fed. Cir. 1998).

¹⁵⁹ *Id.* at 1462 (Plager, J., concurring).

¹⁶⁰ *Honeywell Int’l, Inc. v. Int’l Trade Comm’n*, 341 F.3d 1332, 1338 (Fed. Cir. 2003).

¹⁶¹ See *Kumar v. Ovonic Battery Co.*, 351 F.3d 1364, 1368 (Fed. Cir. 2003); *Nazomi Commc’ns, Inc. v. Arm Holdings*, 403 F.3d 1364, 1368 (Fed. Cir. 2005).

Table 2. Hierarchy of contexts used for claim construction.	
CLAIMS	
1	The disputed claim term itself, separated from the rest of the claim.
2	Claim term in the context of the claim. Where it was argued that one claim element is redundant with another, and is not a limitation on the claim, the Federal Circuit has consistently refused to agree that both elements (or terms) had the same meaning, invoking the “all elements rule.” ¹⁶²
3	Claim term in the context of all the claims, not just the claim containing the disputed term.
SPECIFICATION—EXPLICIT CONTEXTS	
4	Outright disavowals. For example, disclosures that a disadvantage of a prior art device is that it is incapable of working.
5	Explicit definitions.
SPECIFICATION—CONTEXTS OF IMPLICATION	
6	Disclosures of advantage of the claimed invention, or disadvantages of prior art devices.
7	Repeated and consistent statements or disclosures.
8	Global comments.
SPECIFICATION—EXPLICIT CONTEXTS	
9	Explicit definitions are controlling. The definition must be set forth with reasonable clarity, deliberateness, and precision. ¹⁶³ Disclaimer is a controlling context. ¹⁶⁴ Disclaimer has been characterized as “expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.” ¹⁶⁵
PROSECUTION HISTORY	
10	The prosecution history includes Office Actions, e.g., rejections from the examiner, Amendments and Responses (rebuttals by the applicant, Declarations submitted by the applicant), Notice of Allowance, and any comments found in formalities, for example, in the Information Disclosure Statement (IDS) and Petition to Make Special. The Notice of Allowance often contains a paragraph disclosing the

¹⁶² See, e.g., *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1562 (Fed. Cir. 1991); *ASM America, Inc. v. Genus, Inc.*, 401 F.3d 1340, 1346-47 (Fed. Cir. 2005); *Primos, Inc. v. Hunter’s Specialties, Inc.*, 451 F.3d 841 (Fed. Cir. 2006).

¹⁶³ See, e.g., *Abbott Labs v. Syntron Bioresearch, Inc.*, 334 F.3d 1343, 1354 (Fed. Cir. 2003); *Tate Access Floors, Inc. v. Interface Architectural Resources, Inc.*, 279 F.3d 1357, 1370 (Fed. Cir. 2002); *Union Carbide Chem. & Plastics Tech. Corp. v. Shell Oil Co.*, 308 F.3d 1167, 1177 (Fed. Cir. 2002).

¹⁶⁴ See, e.g., *C.R. Bard, Inc. v. United States Surgical Corp.*, 388 F.3d 858, 868 (Fed. Cir. 2004); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc).

¹⁶⁵ *Inverness Medical Switzerland GmbH v. Princeton Biomeditech Corp.*, 309 F.3d 1365, 1372 (Fed. Cir. 2002) (quoting *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002)).

	examiner's reasons for allowing the claims.
EXTRINSIC EVIDENCE	
11	Extrinsic evidence is available for claim construction only if ambiguity still exists after reviewing the intrinsic evidence. If a claim term is still ambiguous after reviewing the intrinsic evidence, then it is permissible to explore any extrinsic evidence. ¹⁶⁶
INVALIDATION UNDER 35 U.S.C. § 112	
12	If a claim is still ambiguous after reviewing the intrinsic evidence and extrinsic evidence, the court can invalidate the claim for indefiniteness under 35 U.S.C. § 112. Where a claim is insolubly ambiguous even after all efforts at claim construction, the claim must be held to be invalid under 35 U.S.C. § 112. ¹⁶⁷

¹⁶⁶ See, e.g., *Intel Corp. v. VIA Techs. Inc.*, 319 F.3d 1357, 1367 (Fed. Cir. 2003); *Frank's Casing Crew and Rental Tools, Inc. v. PMR Techs.*, 292 F.3d 1363, 1374 (Fed. Cir. 2002).

¹⁶⁷ See, e.g., *Honeywell Int'l, Inc. v. Int'l Trade Comm'n*, 341 F.3d 1332, 1338 (Fed. Cir. 2003).

APPENDIX THREE

CLASSES OF CONTEXTS OF IMPLICATION

¶57 The frequency with which the Federal Circuit uses contexts of implication as a tool for claim construction is demonstrated by a succession of cases.¹⁶⁸ In all of these cases, the implicit context included the context of *a repeated a consistent statement*. In about half of these cases, a second additional context of implication was utilized, namely, *a recitation of advantage*.¹⁶⁹

A. STATEMENTS OF ADVANTAGE OR DISADVANTAGE

¶58 The Federal Circuit has warned against using statements of advantage or disadvantage as tools for determining the meaning of a disputed claim term. For example, the court in *Brookhill-Wilk I, LLC v. Intuitive Surgical, Inc.*¹⁷⁰ warned that “[a]dvantages described in the body of the specification . . . are not per se limitations to the claimed invention.”¹⁷¹ Similarly, the Federal Circuit in *Resqnet.com, Inc. v. Lansa, Inc.*¹⁷² stated that disclosures of problems of the prior art should preferably serve only a confirmatory role in claim construction.¹⁷³

¹⁶⁸ *Bell Atl. Network Servs. v. Covad Commc’ns Group, Inc.*, 262 F.3d 1258 (Fed. Cir. 2001); *Howmedica Osteonics Corp. v. Tranquil Prospects, Ltd.*, 401 F.3d 1367 (Fed. Cir. 2005); *Novartis Pharm. Corp. v. Eon Labs Mfg, Inc.*, 363 F.3d 1306 (Fed. Cir. 2004); *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295 (Fed. Cir. 2004); *Union Oil Co. of Calif. v. Atlantic Richfield Co.*, 208 F.3d 989 (Fed. Cir. 2000); *Poly-America, L.P. v. GSE Lining Tech., Inc.*, 383 F.3d 1303 (Fed. Cir. 2004); *Wang Labs., Inc. v. America Online*, 197 F.3d 1377 (Fed. Cir. 1999); *Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d 1367 (Fed. Cir. 2005); *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111 (Fed. Cir. 2004); *Liebel-Flarsheim Company v. Medrad, Inc.*, 358 F.3d 898 (Fed. Cir. 2004); *Advanced Cardiovascular Sys., Inc. v. Scimed Life Sys., Inc.*, 261 F.3d 1329 (Fed. Cir. 2001); *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473 (Fed. Cir. 1998); *Fuji Photo Film Co. v. Int’l Trade Comm’n*, 386 F.3d 1095 (Fed. Cir. 2004); *Toro Co. v. White Consol. Industries, Inc.*, 199 F.3d 1295 (Fed. Cir. 1999); *Kraft Foods, Inc. v. Int’l Trading Co.*, 203 F.3d 1362 (Fed. Cir. 2000); *Phillips v. AWH Corp.*, 363 F.3d 1207 (Fed. Cir. 2004), *vacated*, 376 F.3d 1382 (Fed. Cir. 2004) (en banc); *Seachange Int’l, Inc. v. C-COR, Inc.*, 413 F.3d 1361 (Fed. Cir. 2005); *General American Trans., Inc. v. Cryo-Trans, Inc.*, 93 F.3d 766 (Fed. Cir. 1996); *Ocean Innovations, Inc. v. Archer*, 145 Fed. App’x 366 (Fed. Cir. 2005) (unpublished); *Interactive Gift Express, Inc. v. Compuserve, Inc.*, 256 F.3d 1323 (Fed. Cir. 2001); *VLT, Inc. v. Artesyn Techs., Inc.*, 103 Fed. App’x 356 (Fed. Cir. 2004) (unpublished); *Genzyme Corp. v. Transkaryotic Therapies, Inc.*, 346 F.3d 1094 (Fed. Cir. 2003); *Moore U.S.A., Inc. v. Standard Register Co.*, 229 F.3d 1091 (Fed. Cir. 2000); *TAP Pharm. Products, Inc. v. Owl Pharm., LLC*, 419 F.3d 1346 (Fed. Cir. 2005).

¹⁶⁹ *Howmedica Osteonics Corp.*, 401 F.3d 1367; *Union Oil Co. of Calif.*, 208 F.3d 989; *Wang Labs., Inc.*, 197 F.3d 1377; *Toro Co.*, 199 F.3d 1295; *Kraft Foods, Inc.*, 203 F.3d 1362; *Phillips*, 363 F.3d 1207; *Seachange Int’l, Inc.*, 413 F.3d 1361; *General American Trans., Inc.*, 93 F.3d 766; *TAP Pharm. Products, Inc.*, 419 F.3d 1346.

¹⁷⁰ 334 F.3d 1294 (Fed. Cir. 2003).

¹⁷¹ *Id.* at 1301 (quoting *Vehicular Techs. Corp. v. Titan Wheel Int’l, Inc.*, 141 F.3d 1084, 1096 (Fed. Cir. 1998)).

¹⁷² 346 F.3d 1374 (Fed. Cir. 2003).

¹⁷³ *Id.* at 1380-81.

¶59 Despite these warnings, the Federal Circuit readily utilizes disclosures of advantage or disadvantage to arrive at the meaning of a disputed claim term. For example, in *Alloc, Inc. v. International Trade Commission*,¹⁷⁴ the specification of a patent recited the advantage of “play” in the claimed invention. The advantage of “play” was that it enabled ready disassembly and reassembly of the floor panels, for example, in replacing damaged floor panels.¹⁷⁵ Even though the claim did not include any terms relating to spacing or “wiggle room” between the panels, the court imported the limitation “play” into the claims, thereby requiring at least some wiggle room. The court justified this importation, in part, on the basis of the specification’s recitation of advantage of “play.”¹⁷⁶ In *Hockerson-Halberstadt, Inc. v. AVIA Group Inc.*,¹⁷⁷ the court held that the claim term “central longitudinal groove” was necessarily limited by having a lesser width than the fins, on the basis that the specification disclosed an advantage of a lesser width groove, namely, that the fins would be correspondingly broader and provide an advantageous cushion.¹⁷⁸ In *Tronzo v. Biomet, Inc.*,¹⁷⁹ the court observed that the first patent stated that prior art implants were inferior and that conical implants were advantageous. On this basis, the court held that the claimed prosthetic cup must be limited to cone-shaped cups.¹⁸⁰

¶60 Similarly, in *Gaus v. Conair Corp.*¹⁸¹ and *Kinik Co. v. International Trade Commission*,¹⁸² the court imported limitations from the specification to the claims, on the basis of a recitation of advantage and failed to comment in their decisions on whether the claim suffered from any ambiguity.

B. REPEATED AND CONSISTENT STATEMENTS

¶61 A statement of a repeated and consistent nature is a distinct tool for interpreting claims. *Alloc, Inc. v. International Trade Commission*¹⁸³ held that “[a] patent applicant may *consistently* and clearly use a term in a manner either more or less expansive than its general usage in the relevant art, thereby expanding or limiting the scope of the term in the context of the patent claims.”¹⁸⁴ In the opinions discussed below, the court failed to comment on the possible ambiguity of a disputed claim term. Solely at the urging of the accused infringer, the court reviewed the specification for contexts of implication and on the basis of a repeated and consistent disclosure imported meaning from this implicit context to the claims.

¹⁷⁴ 342 F.3d 1361 (Fed. Cir. 2003).

¹⁷⁵ *Id.* at 1369.

¹⁷⁶ *Id.* at 1373.

¹⁷⁷ 222 F.3d 951 (Fed. Cir. 2000).

¹⁷⁸ *Id.* at 956.

¹⁷⁹ 156 F.3d 1154 (Fed. Cir. 1998).

¹⁸⁰ *Id.* at 1159.

¹⁸¹ 363 F.3d 1284, 1289 (Fed. Cir. 2004).

¹⁸² 362 F.3d 1359, 1365 (Fed. Cir. 2004).

¹⁸³ 342 F.3d 1361 (Fed. Cir. 2003).

¹⁸⁴ *Id.* at 1368 (emphasis added).

¶62 In *Multiform Desiccants, Inc. v. Medzam, Ltd.*¹⁸⁵ and *Bell Communications Research, Inc. v. Fore Systems, Inc.*,¹⁸⁶ the context of a repeated and consistent disclosure was the sole basis for arriving at the meaning of the disputed claim term. In other cases, meaning was assessed on the basis of a plurality of implicit contexts, that is, a repeated and consistent disclosure and also a recitation of advantage and a global comment.¹⁸⁷

C. GLOBAL COMMENTS

¶63 Global comments are readily used by the Federal Circuit to determine the meaning of a disputed claim term. “Statements that describe the invention as a whole, rather than statements that describe only preferred embodiments, are more likely to support a limiting definition of a claim term.”¹⁸⁸ The Federal Circuit in *C.R. Bard, Inc. v. United States Surgical Corp.* made it clear that the category of “global comments” is not part of the category of “explicit definition.” The court wrote that the global comment, as it appeared in the patent, was “not intended to invoke the theory that the inventors acted as lexicographers and redefined words differently from their ordinary meaning in the art.”¹⁸⁹ The case law reveals that global comments tend to be identified in the Title, Abstract, or Summary of the Invention sections of the patent. The term “present invention,” in referring to one or another embodiment of the invention, is often interpreted by the court as signaling a global comment. In *nCube Corp. v. Seachange International, Inc.*,¹⁹⁰ the dissent argued that the Federal Circuit has typically held that the use of the term “present invention” is strong evidence that the use applies to the invention as a whole.¹⁹¹

¶64 In *Astrazeneca AB v. Mutual Pharmaceutical Co.*,¹⁹² the Federal Circuit provided guidance for identifying global comments: “this court looks to whether the specification refers to a limitation only as a part of less than all possible embodiments or whether the specification read as a whole suggests that the very character of the invention requires the limitation to be part of every embodiment.”¹⁹³ In *Alloc, Inc. v. International Trade Commission*,¹⁹⁴ the global comment was identified by the fact that it was located near the heading, “Technical Problems and Objects of the Invention.”¹⁹⁵ The Federal Circuit’s application of a global comment to narrow the meaning of a disputed claim term has also

¹⁸⁵ 133 F.3d 1473, 1477 (Fed. Cir. 1998).

¹⁸⁶ 62 Fed. App’x 951, 956 (Fed. Cir. 2003) (unpublished).

¹⁸⁷ See *Toro Co. v. White Consol. Industries, Inc.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999); *Renishaw PLC v. Marposs Societa’ Per Azioni*, 158 F.3d 1243, 1251-52 (Fed. Cir. 1998); *General American Trans., Inc. v. Cryo Trans, Inc.*, 93 F.3d 766, 770 (Fed. Cir. 1996).

¹⁸⁸ *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 864 (Fed. Cir. 2004).

¹⁸⁹ *Id.* at 863 n.3.

¹⁹⁰ 436 F.3d 1317 (Fed. Cir. 2006).

¹⁹¹ *Id.* at 1329 (Dyk, J., dissenting) (citing *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1343 (Fed. Cir. 2001)).

¹⁹² 384 F.3d 1333 (Fed. Cir. 2004).

¹⁹³ *Id.* at 1337.

¹⁹⁴ 342 F.3d 1361 (Fed. Cir. 2003).

¹⁹⁵ *Id.* at 1368.

been illustrated in a number of other cases.¹⁹⁶ As determined by a search of all issued patents over a twenty-six-year time frame, the use of global comments is an established habit (but a bad habit) in patent drafting.¹⁹⁷ The disclosure residing in the global comment is not likely to reflect the actual invention as envisioned by the inventor.

¹⁹⁶ *Honeywell Int'l, Inc. v. ITT Industries, Inc.*, 452 F.3d 1312, 1318 (Fed. Cir. 2006); *Gaus v. Conair Corp.*, 363 F.3d 1284, 1289 (Fed. Cir. 2004); *Biogen, Inc., v. Berlex Labs., Inc.*, 318 F.3d 1132, 1139 (Fed. Cir. 2003); *Ocean Innovations, Inc. v. Archer*, 145 Fed. App'x 366, 370 (Fed. Cir. 2005); *TAP Pharm. Products, Inc. v. Owl Pharm., LLC*, 419 F.3d 1346, 1354 (Fed. Cir. 2005).

¹⁹⁷ The phrase “the present invention” occurs in about 73 to 87 percent (depending on the year) of all issued U.S. patents, as determined using the “STN on the Web” searching tool, available from the American Chemical Society. This search was conducted for patents issued for every year from 1980 to 2006. In a separate search, the author determined the typical location in the patent specification of the phrase “the present invention.” This phrase often occurs in the Abstract, and other introductory locations such as section headings, of patents, as determined by viewing patents issued to a variety of assignees (companies that make automobiles, toys, computers, and drugs) in the database available from the United States Patent and Trademark Office, which is available at <http://www.uspto.gov/patft/>.