

### **PHILLIPS V. AWH CORP.: CLAIM CONSTRUCTION**

The U.S. Court of Appeals for the Federal Circuit (“CAFC”) recently issued its highly anticipated en banc decision in *Phillips v. AWH Corp.* (03-1269, -1286), which represents a clear retreat from the court’s “dictionary first” approach to claim construction of *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002). In *Phillips*, the court held that the claims must be read in view of the specification and that to a meaning of a disputed claim term, the meaning attributed thereto in the specification is usually dispositive.

The CAFC restated the principles of *Vitronics v. Conceptoronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996), where the court stated that “...the best source for discerning the proper context of claim terms is the patent specification wherein the patent applicant describes the invention.” The *Vitronics* approach is to first consult intrinsic evidence such as other claims, the specification, and prosecution history and determine if the meaning of the claim is clear. Only if the meaning of the claim remains unclear in view of the intrinsic evidence, is extrinsic evidence such as dictionaries and expert testimony consulted. Consequently, the starting point for claim interpretation is the claims themselves.

However, it is important to note that the court did not bar the use of extrinsic evidence such as dictionaries and expert testimony in claim construction. Specifically, the Court noted that “dictionaries, and especially technical dictionaries, endeavor to collect the accepted meanings of terms used in various fields of science and technology, those resources have been properly recognized as among the many tools that can assist the court in determining the meaning of particular terminology to those of skill in the art of the invention.” In many cases where the ordinary and customary meaning of a claim term is not readily discernable, a judge must look to “those sources available to the public that show what a person of skill in the art would have understood the claim to mean.” In such cases, a judge may refer to “the words of the claims themselves,...the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.”

The CAFC placed particular weight on the specification because of the statutory requirement that a patent specification must disclose the invention in “full, clear, concise, and exact terms.” 35 U.S.C. §112, paragraph 1. Additionally, a court may consult the patent prosecution history to determine how the Patent Office and the inventor understood the patent at the time it issued. Nevertheless, the court stated: “extrinsic evidence in general is less reliable than the patent and its prosecution history in determining how to read claim terms...” Essentially, a patent litigant is likely to be constrained to the meaning of terms that are apparent from the patent itself and the prosecution history thereof.

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