



Experts and Claim Construction after *Phillips*

Claim construction is a critical aspect of any patent infringement action. Not only will the parties to the action be bound by the court's interpretation of the claims, but the patentee (absent modification on appeal) will likely be left with the same claim scope to assert against other potential infringing parties through the life of the patent. For years courts struggled to consistently approach claim construction. Some would reach straight for a dictionary. See *Ccs Fitness v. Brunswick Corp.*, 288 F.3d 1359, 1367 (Fed. Cir. 2002). Others would rely principally upon expert testimony. See *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 709, 713-15 (Fed. Cir. 1998). In 2005, the Federal Circuit attempted to unify a methodology for claim construction, providing a definitive guide to district courts on the appropriate manner in which to construe patent claims. *Phillips v. AWH*, 415 F.3d 1303, 1319 (Fed. Cir. 2005).

When it was issued, there was some uncertainty as to the extent to which courts and parties should use expert testimony to aid in claim construction proceedings. Now that a few years have passed since the issuance of *Phillips*, it is clear that expert testimony remains an important tool for advocates seeking to convince a district court as to the appropriate definition of claim terms. An analysis of decisions from the Federal Circuit issued since *Phillips* in fact shows that expert testimony, if focused on the appropriate subject matter and supported by an adequate foundation, remains quite influential in the claim construction process.

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A. The *Phillips* Canons of Claim Construction

The *Phillips* methodology is relatively straight forward. Courts are directed to define claim terms by first relying on the patent claims and the specification. *Phillips*, 415 F.3d at 1314. Courts are also permitted to consult the prosecution history as evidence of the understanding of the patent of both the inventor and the patent examiner. *Phillips*, 415 F.3d at 1317 (Fed. Cir. 2005). These sources, known as the “intrinsic record,” after all, form the “public record” upon which competitors may rely in designing around patent claims, or avoiding infringement. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996).

The court, however, is not limited to this intrinsic evidence. The court can consider other sources, known as “extrinsic evidence,” such as dictionary definitions, technical references, and inventor and expert testimony to aid in interpreting the claims. *Phillips*, 415 F.3d at 1317. According to *Phillips*, extrinsic evidence is deemed less reliable, but nonetheless remains available for consideration. Importantly, the *Phillips* court affirmatively rejected the use of conclusory, unsupported assertions by experts as to the meaning of a claim term and expert testimony that is clearly at odds with the claims themselves, the written description and the prosecution history. *Id.* However, the court did not ban the use of expert testimony in claim construction. Instead, district courts are permitted to use their discretion to



admit and use expert testimony for proper purposes. *Id.* at 1319.

Under *Phillips*, expert testimony and other extrinsic sources are useful tools to provide the court with background on the technology at issue, to explain how an invention works, to ensure that the court's understanding of the technical aspects of the patent is consistent with that of a person of skill in the art, to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field, or to teach the court the way in which one of skill in the art might use the claim terms. *Phillips*, 415 F.3d at 1318-19.

B. The Use Of Expert Testimony Since *Phillips*

The *Phillips* opinion left some aspects of the use of expert testimony in claim construction advocacy open for interpretation, which led to some uncertainty. Examination of post-*Phillips* opinions reveals that although *Phillips* relegated expert testimony to the second, "less reliable" category of "extrinsic evidence," courts certainly continue to look to and rely upon the parties' experts in claim construction.

In the past few years, courts have applied the Canons announced in *Phillips* as a guide to determining the proper weight to afford expert testimony in claim construction. These opinions highlight several important considerations for the use of expert testimony as an appropriate aspect of any claim construction strategy.

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- Expert testimony must not contradict or be inconsistent with the claims, specification, or prosecution history of the patent. *Desa IP, LLC v. EML Technologies, LLC*, 211 Fed. Appx. 932 (Fed. Cir. 2007).

The Federal Circuit held that the district court erred in identifying the claimed functions and corresponding structures of the disputed phrases because the expert testimony conflicted with the intrinsic evidence. The defendant's expert testified that the term "sensor means" included the circuitry structure. The plaintiff argued that statements in the specification, such as "the sensors . . . are coupled to a detector portion of the circuit," showed that the term "sensor means" did not include the circuitry structure. The court agreed with the plaintiff and rejected the expert testimony because it contradicted the specification.

- Expert testimony should be supported by independent references, such as industry publications or other independent sources. *Network Commerce, Inc. v. Microsoft Corp.*, 422 F.3d 1353 (Fed. Cir. 2005).

The Federal Circuit construed the claim term "download component" by examining the claims and the specification. The court found that the specification clearly defined "download component" to include a boot program and that the boot program interacts directly with the operating system of the computer without the assistance of any other program. The plaintiff, relying on the declaration of its expert as evidence, argued that "download component" did not contain the boot program. The plaintiff's expert's declaration simply quoted passages

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from the specification and concluded that the term “download component” does not contain the boot program. The court declined to rely on this declaration because the expert did not support his conclusion with any references to industry publications or other independent sources. The court also rejected the expert’s interpretation of the term because it contradicted the specification.

- Expert testimony can be used to construe non-technical terms. *Tap Pharmaceutical Products, Inc. v. Owl Pharmaceuticals, L.L.C.*, 419 F.3d 1346 (Fed. Cir. 2005).

The court reviewed the district court’s use of expert testimony in construing the claim term “containing.” The plaintiff argued that because the term is not technical the court should not have used extrinsic evidence to determine its meaning. The court rejected this argument because a word describing patented technology takes its definition from the context in which it was used in by the inventor. The court noted that the word “containing” has two possible meanings: (1) having at least the named component or (2) one substance encompassed within another. The court concluded that the term could not be defined by an ordinary meaning isolated from the proper context and that it was proper for the district court to look at the specification and expert testimony to determine the manner in which the term was used in the patent.



- An expert can testify regarding the interpretation of a claim term in the context of a patent itself as well as the term's meaning in the relevant field from the perspective of one of ordinary skill in the art. *Tap Pharmaceutical Products, Inc. v. Owl Pharmaceuticals, L.L.C.*, 419 F.3d 1346 (Fed. Cir. 2005).

The *Tap Pharmaceutical* court also held that district court correctly considered intrinsic evidence and the testimony of an expert who opined on the interpretation of the term both in the context of the patent and from the perspective of a person of ordinary skill in the art. Thus, expert testimony can be used to interpret the term's meaning in the pertinent field as a whole as well as the meaning the narrower confines of the patent.

Patent litigants should keep in mind that it is not guaranteed that a court will consider expert testimony. Because courts can use their discretion in using expert testimony to construe their claims, parties should not rely solely on their experts to support their positions. For example, if the intrinsic evidence is sufficient, the court may conclude that the expert testimony is unnecessary. In *VDP Patent, LLC v. Welch Allyn Holdings, Inc.*, No. 06 Civ. 5821, 2007 U.S. Dist. LEXIS 46956 (S.D.N.Y. June 28, 2007), the patent claimed a method of irrigating a patient's ear using an otoscope. The parties disputed the meaning of the claim term "otoscope." The court determined that the specification and the prosecution history supported the defendant's proposed construction and that the extrinsic evidence did not need to be considered.

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C. Conclusion

Claim construction is a complicated, unpredictable endeavor, and expert opinion continues to be an important resource. Patent litigants, however, are well advised to follow the *Phillips* Canons and to utilize expert testimony in an appropriate manner as an aid to the court's analysis. Well-crafted and properly supported expert testimony that is both consistent with the claims and the specification and supported by outside references is likely to have the greatest impact upon the claim construction process.

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