

# Avoiding Patent Claim Construction Errors:

## Determining the Ordinary and Customary Meaning Before Reading the Written Description

*Fifty percent of all trial judges' patent claim constructions are reversed or modified on appeal. Want to improve your odds? The Texas Two-Step approach to patent claim construction might be two steps in the right direction.*

By Anthony R. Zeuli and Rachel Clark Hughey

Trial judges are frustrated. Lawyers grapple with the uncertainty of the process. Clients loathe the expense. What is the common rub aggravating these three groups? Patent claim construction: the legal process of having the court determine the meaning of the words used by an inventor to describe the scope of his or her invention. The reversal rate of patent claim constructions is nearing 50 percent. Many believe the process is flawed, the results too unpredictable, and the procedures too costly. What can be done to keep a claim construction from being reversed? Tell the trial judge not to read the patent. Well, at least tell the judge not to read the patent's written description and file history until *after* he or she determines the ordinary and customary meaning of the words in the claims that are in need of definition. Overloaded trial judges will thank you.

Should trial judges really shield their eyes from the written description, drawings, and file history of a patent until *after* they have determined the ordinary and customary meaning of the claim terms they are defining? With the reversal rate nearing a coin toss and the most common wrongdoing being importing limitations from the written description, drawings, or file history, the answer in many cases is yes. Of course, such a simplistic fix will not work in all cases, but it will work in many cases. This solution also drives home a point that the Court of Appeals for the Federal Circuit — the appellate court to which all patent-related issues are appealed — has been chanting for years: Patent claim terms are entitled to their ordinary and customary meaning unless the inventor used those terms differently. This is easier said than done. The problem has its roots in the patent document itself.

### Why Hide the Claims at the End of the Patent If They Are So Important?

A patent issued by the U.S. government has two distinct parts (collectively called the specification): (1) one or more claims that define in words the scope of the inventor's property and (2) the written description and drawings that describe at least one preferred embodiment of the invention and enable a person skilled in the art to make and use the invention. In many countries other than the United States, the patent claims precede the rest of the patent document. This makes sense, given that it is the claims, not the written description and drawings, that define the scope of the invention. The claims come at the very end of U.S. patents, however, usually following many, many pages of written detail and graphic depiction. Like reading a book, judges, lawyers, and competitors begin reading the patent not with the claims but on the first page, and they fill their minds with the details and graphics on their way to the end of the patent. At the end they encounter, usually for the first time, the claims, which are entitled to be free from the detail of the written description unless the patentee also used such detail in the claims. Can busy trial judges be expected to unlearn the details of the written description when faced with defining possibly broader terms used in the claims?

Often the dispute in patent litigation turns on the meaning of one or more of the words in the claims. More often than not, trial judges' opinions are reversed because the Federal Circuit, applying a *de novo* standard of review, rules that the trial judge perceived an incorrect meaning of the words that he or she was charged with defining — usually because the trial judge improperly

read limitations from the written description that improperly narrowed the ordinary and customary meaning of the term. It's no wonder busy trial judges feel like record keepers for the appeals court. But the patent document itself is not the sole culprit.

### Another Fine Mess

In 1996, the Federal Circuit issued its decision in *Markman v. Westview Instruments Inc.*, ruling that the interpretation of the claims in a patent constituted a matter of law to be decided by the trial judge.<sup>1</sup> Before *Markman*, the jury had been permitted to determine the meaning of the claims. At the time of this decision, the Federal Circuit believed that by applying the same general rules of construction used for other written instruments, the trial court could provide better guidance for inventors and competitors attempting to ascertain the scope of a patent. Although almost 10 years later many disagree with this decision, federal lawyers and trial judges need to work successfully with the system that we have today. Trial judges have to define the patent claim terms, and lawyers have to help judges get it right or at least help to not get reversed.

### Help Is on the Way

While the court may be better suited to interpret the claims than a jury is, the task has proved difficult even for trial judges. Receiving no deference on appeal, trial judges find that the Federal Circuit reverses nearly every other claim construction. It comes as little surprise that some trial judges have grown apathetic to the process, and that nearly all litigants unhappy with the outcome of their cases will appeal and include a claim construction issue. Reducing this large number of appeals and reversals would lessen costs and frustrations for litigants, conserve limited judicial resources, and eliminate the uncertainty surrounding the meaning of patent claims.

So what's a busy judge to do? In attempting to understand the invention at issue, judges should turn the patent face down and read it from back to front, starting with the words of the claims. Judges should try to determine the ordinary and customary meaning of the words used in the claims by relying on dictionaries, other patents, and industry treatises if the words taken in context of the claims do not reveal their meaning. Only after determining the ordinary and customary meaning, or attempting to do so, should the trial court turn to the written description, drawings, and file history to determine if the inventor meant the words in the claims to have an inconsistent (narrower or broader) definition. If not, the claim terms should receive their ordinary and customary meaning. Trial judges should follow a two-step process to claim construction: determine the ordinary meaning and then determine if the patentee meant the term to mean something different.

### The Texas Two-Step

In *Texas Digital Systems Inc. v. Telegenix Inc.*, the Federal Circuit recently described such a two-step approach.<sup>2</sup> The court cautioned that, to avoid the error of importing limitations into the claims, judges must make an effort to

discern the customary and ordinary meaning of patent claim terms *before* consulting the patent's written description and drawings. This article attempts to provide guidance in construing patent claims in such a two-step way so as to avoid reversal; to explain recent case law that discusses or applies; or both, this two-step approach; and to explain a few exceptions to the approach. A basic overview of claim construction, details of the *Texas Digital* decision, and a review of post-*Texas Digital* cases dealing with the two-step approach to claim construction are also discussed. Reversal rates of claim constructions will decline if both trial courts and federal lawyers approach claim construction using the following two steps: *first*, to determine the ordinary and customary meaning of the claim terms and *then* to determine if the inventor used those terms inconsistently with that meaning.

### A Brief Overview of Patent Claim Construction

A U.S. patent consists of a specification, which includes drawings, a detailed written description of the invention, and the claims. A patent is analogous to a land deed: both are written documents that convey rights to property, and like the legal description of a parcel of land, the claims of the patent are the legal description of the inventor's intellectual property. The written description and drawings are the consideration for the right to exploit that property for a term of years: the inventor must not only tell the public how to make and use the invention but also describe in detail the invention and the best mode of the invention. Disclosure of every embodiment within the scope of the claims is not required in the written description; to do so would make patents unwieldy. The claims of the patent, not the written description, are the measure of the patentee's invention, and only the specifically described claims of a patent may be infringed.

An infringement analysis consists of the following two steps: (1) construing the patent claims and (2) determining if the disputed device or process infringes one or more of the patent's claims. Both steps had been historically the province of the jury. However, in *Markman v. Westview Instruments Inc.*, the U.S. Supreme Court held that a trial court judge, not a jury, must construe the meaning of a patent's claims.<sup>3</sup> The *Markman* decision provided no procedure, however, for how the district courts should approach their new task. Since the *Markman* decision, district courts have attempted to devise proper procedures for claim construction, but not all have been successful. Approximately every other claim construction reviewed by the Federal Circuit is reversed and reconstrued.

Patent claim construction must begin by focusing on the claims themselves — and must remain focused on them. The claim terms may be interpreted in view of intrinsic evidence and, if necessary, extrinsic evidence. Intrinsic evidence includes the specification, including the claims, written description, drawings, and the prosecution history if this is in evidence. Extrinsic evidence is evidence outside the patent record, including testimony by the inventor and an expert. Dictionaries and technical

treatises, formerly considered extrinsic evidence, have been elevated to a form of quasi-intrinsic evidence during claim interpretation.

When construing the claims, the courts first consider the words of the claims themselves, because the words are the measure of the patent's scope. Patent claim terms must be given their *accustomed, ordinary, and customary* meaning, as understood by one skilled in the art, unless the inventor defined or used the terms differently. The Federal Circuit has held that, "[i]n construing claims, the analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to 'particularly point out and distinctly claim the subject matter which the patentee regards as his invention.'" The words used in the claims bear a heavy presumption that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art. Unless compelled to do otherwise, a court will give a claim term the full range of its ordinary meaning as understood by persons skilled in the relevant art.

The court also considers the written description and the prosecution history, if in evidence, to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning. Courts have suggested that the written description can act as a kind of dictionary when it expressly defines the terms used in the claims. Thus, patent owners may define the claim terms, choosing to be their own lexicographer. The Federal Circuit has held that the unambiguous meaning of a disputed claim term must control when the term's meaning is not contradicted by either the written description or the prosecution history. Thus, the claim terms must be given their ordinary meaning, unless a different meaning is clearly indicated in the written description or prosecution history. In *Markman*, the Federal Circuit explained it in this way:

The specification contains a written description of the invention that must enable one of ordinary skill in the art to make and use the invention. For claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claims. ... As we have often stated, a patentee is free to be his own lexicographer. ... The caveat is that any special definition given to a word must be clearly defined in the specification. ... The written description part of the specification itself does not delimit the right to exclude. That is the function and purpose of claims.<sup>4</sup>

At the same time the Federal Circuit was also carefully reminding the trial courts that a fine line exists between properly construing claims in light of the written description and improperly reading limitations from the written description into the claims. Apparently this fine line was crossed too often — in about half of the claim constructions reviewed by the Federal Circuit. Perhaps to keep busy trial judges on the correct side of that fine line, the Federal Circuit provided a little lesson, Texas-style.

#### *Texas Digital Systems Inc. v. Telegenix Inc.*

In *Texas Digital Systems Inc. v. Telegenix Inc.*, the Federal Circuit said that the written description should not be consulted before an attempt is made to determine the ordinary and customary meaning of the disputed claim term. To do so, said the court, invites error. Texas Digital Systems Inc. owned four patents involving methods and devices for controlling the color of pixels in a light-emitting diode display.<sup>5</sup> In 1997, the company filed suit against Telegenix Inc., alleging that Telegenix's products infringed upon Texas Digital's patents. A jury found that Telegenix literally infringed upon Texas Digital's patents, the claims were not invalid, and the infringement was willful. Telegenix appealed the decision.

The Federal Circuit affirmed the ruling in part, reversed it in part, and remanded the decision. First, the court recognized that "[i]n construing claims, the analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to 'particularly point out and distinctly claim the subject matter which the patentee regards as his invention.'" The court emphasized the heavy presumption that claim terms "mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." However, the court also noted that the intrinsic record "must be examined in every case to determine whether the presumption of ordinary meaning is rebutted." The court stated that, if an inventor used a word in such a way in the written description that was wholly inconsistent with any ordinary meaning of a word, the ordinary meaning must be rejected in favor of the inventor's definition. But with a single sentence, the court went a step further than it had gone in the past:

Consulting the written description and prosecution history as a threshold step in the claim construction process, *before* any effort is made to discern the ordinary and customary meanings attributed to the words themselves, invites a violation of our precedent counseling against importing limitations into the claims. (Emphasis added.)

The court acknowledged the problem that trial courts were having with claim interpretation, noting, "one can easily be misled to believe that this is precisely what our precedent requires when it informs that disputed claim terms should be construed in light of the intrinsic record." The court then warned against importing limitations from the written description to the claim terms:

But if the meaning of the words themselves would not have been understood to persons of skill in the art to be limited only to the examples or embodiments described in the specification, reading the words in such a confined way would mandate the wrong result and would violate our proscription of not reading limitations from the specification into the claims. *By examining relevant dictionaries, encyclopedias and treatises to ascertain possible mean-*

ings that would have been attributed to the words of the claims by those skilled in the art, and by further utilizing the intrinsic record to select from those possible meanings the one or ones most consistent with the use of the words by the inventor, the full breadth of the limitations intended by the inventor will be more accurately determined and the improper importation of unintended limitations from the written description into the claims will be more easily avoided. (Emphasis added.)

The decision in *Texas Digital* began the recognition of a simple claim construction procedure that can help busy trial judges avoid claim construction errors: first, to determine the ordinary meaning of a disputed term, then to consult the written description and prosecution history to determine if the term's ordinary meaning was rebutted — that is, if the patentee used it in a way that was inconsistent with the ordinary meaning. If not, the claim term must be given the full scope of its ordinary meaning. In *Altiris Inc. v. Symantec Corp.*, a case decided only a few months after *Texas Digital*, the Federal Circuit admitted that “[t]he appropriate use of the rest of the specification in claim construction has not always been clear.”<sup>6</sup> The court then said: “Several recent cases, however, have clarified the subject” and cited *Texas Digital*.

### The Texas Two-Step

So does applying the two-step claim construction approach that came from the *Texas Digital* case reduce the number of reversals? Since the *Texas Digital* decision, the Federal Circuit has repeatedly considered the timing of considering a patent's written description when reviewing trial courts' claim constructions. Strong evidence exists that a two-step construction results in fewer reversals. In cases where the trial court used a two-step approach, compared with those that used a more holistic, one-step approach, the trial judges fared better. And when correcting the claim constructions of those trial judges that did not fare as well, the Federal Circuit itself routinely applied, sometimes explicitly, the two-step approach. Although the two-step approach of *Texas Digital* is by no means settled law that can be applied to every case, it does seem to have legs.

### Recent Federal Circuit Cases Using or Approving a Two-Step Process

Several recent cases from the Federal Circuit support a two-step claim construction process: the trial court first interprets the ordinary and customary meaning of the claim language, then determines whether the written description and drawings rebut or alter that ordinary meaning. In *Intellectual Property Development Inc. v. UA-Columbia Cablevision of Westchester Inc.*, the Federal Circuit affirmed a trial judge who had used a two-step approach.<sup>7</sup> On appeal, the plaintiff argued that “the district court ‘put the cart before the horse’ by looking at dictionary definitions first instead of the specification to determine the meaning of the term ‘high frequency.’” The Federal Circuit dis-

agreed: “As we have noted, ‘consulting the written description and prosecution history as a threshold step in the claim construction process, before any effort is made to discern the ordinary and customary meanings attributed to the words themselves, invites a violation of our precedent counseling against importing limitations into the claims.’” (Emphasis added.) Thus, the court held that “the district court did not err in looking to dictionary definitions before consulting the written description or the prosecution history to determine the meaning of the term. ...” (Emphasis added.)

Trial judges who did not use the two-step approach often saw the case come back. In reviewing a one-step approach case, *Simmons Inc. v. Bombardier Inc.*, the Federal Circuit reversed a trial judge who apparently relied on the written description before determining the ordinary meaning of the disputed terms.<sup>8</sup> Relying on *Texas Digital*, the Federal Circuit wrote: “The district court erred in incorporating limitations of the preferred embodiment into the ... claim limitation.” The appellate court stated that the district court's “consultation of the written description and prosecution history before making any effort to discern the ordinary and customary meanings attributed to the language of the claims was premature.” (Emphasis added.)

The Federal Circuit's temporal language in *Resonate Inc. v. Alteon Websystems Inc.* also provides compelling support for the two-step approach: “After identifying the ordinary meaning of a disputed claim term, we turn to the patent's written description and drawings to determine whether that meaning is inconsistent with the patentee's use of the term, for example whether the patentee has specially defined the term or otherwise limited the scope of the claim.”<sup>9</sup> (Emphasis added.) The trial judge in *Resonate* crossed that fine line and impermissibly read into the claims a limitation that did not exist in the ordinary and customary meaning of the claim term in dispute. The written description, drawings, and file history did not rebut or alter the broader, ordinary meaning. The Federal Circuit construed the term and remanded the case. The same fate has befallen other trial judges who did not first determine the ordinary meaning before consulting the written description.

In *E-Pass Technologies Inc. v. 3COM Corp.*, the Federal Circuit found error in the trial court's construction of the term *card*.<sup>10</sup> In correcting the error, the Federal Circuit cited *Texas Digital*, stating that “we first seek the ordinary meaning of the claim term. ... However, we next look to the specification to determine ‘whether the presumption of ordinary and customary meaning is rebutted.’” Finding that the presumption was not rebutted in this case, the Federal Circuit defined the term *card* using its ordinary and customary meaning. The appellate court's use of a two-step approach in the claim construction was unmistakable in this case. However, other cases require use of the written description to select which one of many ordinary and customary meanings is the correct one. This is still a two-step approach, but with a twist.

### Texas Two-Step With a Twist

This added twist doesn't change the basic two-step approach but simply adds consultation of the written description and drawings when multiple ordinary and customary meanings exist for the disputed term. For example, *Deering Precision Instruments L.L.C. v. Vector Distribution Systems Inc.* is just such a case.<sup>11</sup> The disputed term was *substantially* — a very common term used in patent claims and one that has multiple meanings in dictionaries and treatises. To ensure that the correct ordinary and customary meaning of *substantially* was selected, the Federal Circuit looked to the written description of the patent to cull the choices and determine which interpretation should be adopted. However, the court did not waver in the application of its two-step approach:

Claim construction analysis *begins* with the ordinary meaning of the disputed claim term. ... The *next* step is to review the written description and the prosecution history, to determine if the patentee has chosen to be his or her own lexicographer, *or when the claim language itself lacks sufficient clarity to ascertain the scope of the claims.* (Emphasis added.)

*Ferguson Beauregard/Logic Controls, Div. of Dover Res. Inc. v. Mega Sys. LLC*, is another example.<sup>12</sup> Starting with dictionary definitions the Federal Circuit stated that “we consider *first* the ordinary and customary meaning of the word ‘normal’ — a term with many meanings.” Analyzing the written description *next*, the court found that the patentee had not used the term inconsistently with the ordinary and customary meaning: “The written description is consistent with and supports this construction in the context of this invention.” A separate concurring opinion specifically addressed the need to consult the written description when multiple ordinary meanings are available: “This court properly links [the selected dictionary definition of ‘normal’] to the specification’s terminology. ...”

When multiple dictionary or treatise definitions could apply, the written description, drawings, and file history should be used to determine which ordinary and customary meaning makes sense given the context of the invention. Unfortunately, some Federal Circuit decisions still intone the single-step approach of using the written description to determine the ordinary and customary meaning of a claim term, even though many of those decisions do not actually apply that approach.

### The Texas Two-Step Is Not Settled Law

The two-step approach to claim construction is not settled law.<sup>13</sup> Some Federal Circuit decisions still use language that at least suggests that use of the written description to determine the ordinary and customary meaning of a claim term is appropriate. For example, in *Combined Systems Inc. v. Defense Technology Corporation of America*, the court affirmed the trial court’s use of the two-step approach to claim construction. After discussing the dictionary definition ... and before reviewing pertinent portions of the written description, the trial court stated:

“Even when the ordinary meaning of a term appears to be clear from the claim language, however, it is necessary to read the claim in the context of the specification to determine whether the patentee has given the phrase ‘forming folds in said ... body’ an unaccustomed meaning.”<sup>14</sup>

But then the court said:

If, which we doubt, this language indicates that *the district court believed that our cases permit consulting the specification solely for the limited purpose of determining whether it contradicts the dictionary meaning of a claim term, such a view is not supported by our case law, read as a whole.* As we have recently stated, “[t]he written description must be examined in every case, *because it is relevant not only to aid in the claim construction analysis*, but also to determine if the presumption of ordinary and customary meaning is rebutted.” Thus use of the specification to “determine if the presumption of ordinary and customary meaning is rebutted” is no more important than examining it “to aid in the claim construction analysis. ...” (Emphasis added.)

Although this panel certainly accepted using the written description to determine if the presumption of the ordinary and customary meaning was rebutted, the court suggested that the written description aids in determination of the ordinary meaning. While not inconsistent with the two-step approach, it is not consistent with the idea of limiting the role of the written description to be used after determination of the ordinary and customary meaning has at least been attempted.

Sometimes even judges on the same panel disagree. In one case that can be used as an example, *Genzyme Corp. v. Transkaryotic Therapies Inc.*,<sup>15</sup> the appellate court determined that the claim term *chromosomally integrated* was capable of yielding two different interpretations, and the panel suggested that “perhaps the best tool to put the claims in proper temporal and technical context is the patent specification itself.” Judge Linn dissented from the majority’s reliance on the written description and stated: “In my view, the majority hastens too quickly past the fundamental step of determining the ordinary and customary meaning.” Relying on *Texas Digital*, Judge Linn stated that “[d]etermining the ordinary and customary meaning of the terms of the claims is the *first step* in claim construction, and consultation of the written description and prosecution history before attempting to ascertain the ordinary and customary meaning of the language of the claims is premature.” (Emphasis added.) Judge Linn clearly separated the claim interpretation into two parts: (1) determination of the ordinary and customary meaning and (2) consideration of the written description and the prosecution history. The language from these cases indicates that it is not clear whether determining the ordinary and customary meaning of a claim term is a two-step or a one-step process.

In yet another set of cases, the language used by the Federal Circuit indicates that determining the ordinary meaning of a claim is a one-step process. In *Alloc Inc. v. International Trade Commission*, for example, a Federal Circuit panel said, “to determine claim meaning, a court immerses itself in the specification, the prior art, and other evidence, such as the understanding of skilled artisans at the time of invention, to discern the context and normal usage of the words in the patent claim.”<sup>16</sup> Apparently acknowledging that the ordinary meaning stems first from the language of the patent, the court suggested that “the specification or the prosecution history of a patent may alter the meaning of a claim term from its conventional usage.” But the court barely paused to consider the plain meaning of the claims before moving on to the written description, stating:

[A court] must interpret the claims in light of the specification, yet avoid impermissibly importing limitations from the specification. That balance turns on how the specification characterizes the claimed invention. In this respect, 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 be a part of every embodiment. For example, it is impermissible to read the one and only disclosed embodiment into a claim without other indicia that the patentee so intended to limit the invention. On the other hand, where the specification makes clear at various points that the claimed invention is narrower than the claim language might imply, it is entirely permissible and proper to limit the claims.

In a dissent, Judge Schall criticized the majority, saying that “the majority has allowed the accused infringer to narrow the scope of the claims to a preferred embodiment disclosed in the specification.” Judge Schall looked first to the terms in the claims to determine their ordinary meaning and then considered the written description. He noted that there is a very fine line between “examining the specification to determine if the patentee has limited the scope of the claims,” and improperly importing a limitation from a patent specification into a claim. A specification may only be used to limit a claim if a patentee has disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope. Thus, although the majority in this case applied a one-step process for claim construction, Judge Schall advocated for a two-step approach.

### Reversing the Trend of Reversals: Adopting the Two-Step Approach

The high reversal rate of claim constructions must be decreased. Litigants and trial court judges need a straightforward, simple claim construction procedure that will decrease errors. The two-step approach might be the best

solution. Although it is true that the written description and drawings should be consulted in every case, temporally this step should occur after the ordinary and customary meaning of the claim terms has been determined unless multiple such meanings exist. Certainly, determining whether the patentee rebutted the ordinary meaning of the disputed term or narrowing a multitude of ordinary meanings is a proper use of the written description and drawings, but this should be done after an attempt at determining the ordinary meaning. Using the written description, drawings, and prosecution history to make an initial determination invites error by reading unintended limitations into the claims. Dictionaries, treatises, other patents, and the context of the claims are much better suited for making an initial determination of the ordinary meaning of claim terms.

### A Two-Step Process Is Supported by *Texas Digital and Its Progeny*

So will such a two-step methodology help? In support of its holding that trial courts must attempt to discern a claim term's ordinary meaning before using the written description to define those terms, the Federal Circuit in *Texas Digital* stated that “[c]onsulting the written description and prosecution history as a threshold step in the claim construction process, before any effort is made to discern the ordinary and customary meanings attributed to the words themselves, invites a violation of our precedent counseling against importing limitations into the claims.” (Emphasis added.) This language means that judges may review and consider the written description in interpreting the language in claim terms, but they are prohibited from using the written description and prosecution history prior to discerning the term's ordinary meaning. Also inherent in the quoted language is the idea that judges may consult the written description once they make an effort to establish the ordinary meaning, whether or not that effort was successful. Both of these implications reveal that the new hierarchy, a two-step approach, represents a positive step in the development of the law of claim construction; nevertheless this method allows for some ambiguity in the process.

Is it realistic to expect trial judges to read a patent from back to front? Perhaps not, but if federal lawyers and trial judges — and, one hopes, the Federal Circuit — continue to describe the claim construction process as two distinct steps, it is likely that the result will be the correct one: terms given their ordinary and customary meaning unless the patentee used them in a way that was inconsistent with that meaning.

Even though the *Texas Digital* court applied precedent and logic to arrive at a sound conclusion, the court missed the opportunity to set down an easily administrable claim construction procedure that would help prevent trial court judges from erring by allowing the written description of a patent to taint the ordinary meaning of claim terms. The decision in *Texas Digital* requires courts to first look to the claim language before consulting the written description in considering the ordinary meaning

of the claim terms, but the court could have gone further by holding that the ordinary meaning must be determined before turning to the written description.

### **A Two-Step Approach Makes Sense**

A heavy presumption exists that claim terms carry their ordinary and customary meaning. This presumption can be overcome only when a claim term is clearly defined in a way that is contrary to the ordinary meaning of the term in the written description or prosecution history. Such a presumption supports a claim construction method that only turns to the written description after the ordinary meaning of the claim language has been determined. To do otherwise invites error because it reads in limitations from the preferred embodiment.

One of the Federal Circuit's primary concerns in the *Texas Digital* opinion was that starting with the written description before an effort is made to determine the ordinary meaning leaves a judge vulnerable to impermissibly reading limitations from the written description into the claims. The other result of *Texas Digital* is that, as long as courts make an effort to discern the ordinary meaning of a claim term, they can proceed to the written description regardless of whether or not they were successful in that effort. The spirit of the *Texas Digital* decision is that courts must exert the most reasonable effort to determine the meaning of a claim term before consulting the written description as a threshold step in the claim construction process. Because determination of ordinary meaning may be as simple as looking up the definition of a claim term in a dictionary, technical treatise, or another related patent, a genuine effort will typically yield the ordinary meaning.

In *Texas Digital*, the Federal Circuit took a significant step in the proper direction toward clarifying the claim construction methodology and adopting a two-step approach. Now that dictionaries, encyclopedias, and technical treatises are no longer relegated to the category of "extrinsic evidence," courts can go about discerning the ordinary meaning of claim terms using the most logical and rational sequence. In order to make sure that courts follow the proper sequence, however, the Federal Circuit needs to go one step further. The ordinary meaning of a term should always be fully discerned prior to consulting the written description, if possible. In the *Intellectual Property Development* case, the Federal Circuit approved a district court's following the procedure provided in the *Texas Digital* case but did not say that the district court was required to do so. The Federal Circuit should take the next step and clarify the process. If the Federal Circuit has occasion to visit this issue in the future, which is likely, considering the laundry list of cases on the issue in the year since the *Texas Digital* case, it should bear in mind that, in order to correctly construe patent claims, a court must indeed shield itself from a patent's written description until the ordinary meanings of the claim terms have been fully determined.

### **Conclusion**

To sum up the solution to the problem of patent claim construction: Skip right to the end of the patent. *First*, read the claim and determine the ordinary and customary meaning of the disputed terms, if possible, before reading the lengthy, detailed written description. If multiple meanings exist, use the patent to determine the best fit. *Then* make sure that the inventor did not explicitly define the term more narrowly or broadly than the term's ordinary meaning. That's the *Texas* two-step for patent claim construction. It may not make every claim construction error-proof, but it should significantly reduce the rate of reversal by the Federal Circuit. **TFL**

*Tony Zeuli is a trial lawyer specializing in patent litigation in the Minneapolis office of Merchant & Gould. Prior to joining Merchant & Gould, Zeuli was a physics engineer at Argonne National Laboratory, where he was involved in the study of nuclear physics. He writes a regular column on Intellectual Property law for the Minnesota State Bar Association's publication Bench & Bar and has spoken to several groups about patent claim construction. Rachel Clark Hughey is an associate at Merchant & Gould in Minneapolis. She has published numerous articles on patent law and co-coaches the University of Minnesota's IP appellate moot court team. The opinions expressed in this article are those of the authors alone and not of Merchant & Gould or any of its clients. © 2004 Anthony R. Zeuli and Rachel Clark Hughey. All rights reserved.*

### **Endnotes**

- <sup>1</sup>52 F.3d 967 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996).
- <sup>2</sup>308 F.3d 1193 (Fed. Cir. 2002).
- <sup>3</sup>517 U.S. 370 (1996).
- <sup>4</sup>*Markman v. Westview Instruments Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996).
- <sup>5</sup>*Tex. Digital Sys. Inc. v. Telegenix Inc.*, 308 F.3d 1193 (Fed. Cir. 2002).
- <sup>6</sup>318 F.3d 1363 (Fed. Cir. 2003).
- <sup>7</sup>336 F.3d 1308 (Fed. Cir. 2003).
- <sup>8</sup>73 Fed. Appx. 421 (Fed. Cir. 2003).
- <sup>9</sup>338 F.3d 1360 (Fed. Cir. 2003).
- <sup>10</sup>343 F.3d 1364 (Fed. Cir. 2003).
- <sup>11</sup>Nos. 02-1013, 02-1197, 2003 U.S. App. LEXIS 21066 (Fed. Cir. Oct. 17, 2003).
- <sup>12</sup>350 F.3d 1327 (Fed. Cir. 2003).
- <sup>13</sup>*Housey Pharm. v. Astrazeneca et al.*, \_\_\_ F.3d \_\_\_, 03-1193, 1210 (Fed. Cir. May 7, 2004) (J. Newman dissenting).
- <sup>14</sup>No. 03-1251, 2003 U.S. App. LEXIS 23633 (Fed. Cir. Nov. 20, 2003).
- <sup>15</sup>346 F.3d 1094 (Fed. Cir. 2003).
- <sup>16</sup>342 F.3d 1361 (Fed. Cir. 2003).