

10-1-2002

Federal Circuit and Claim Construction: Resolving the Conflict between the Claims and the Written Description

Gregory J. Gallagher

Follow this and additional works at: <http://scholarship.law.unc.edu/ncjolt>Part of the [Law Commons](#)

Recommended Citation

Gregory J. Gallagher, *Federal Circuit and Claim Construction: Resolving the Conflict between the Claims and the Written Description*, 4 N.C. J.L. & TECH. 121 (2002).Available at: <http://scholarship.law.unc.edu/ncjolt/vol4/iss1/7>

This Notes is brought to you for free and open access by Carolina Law Scholarship Repository. It has been accepted for inclusion in North Carolina Journal of Law & Technology by an authorized administrator of Carolina Law Scholarship Repository. For more information, please contact law_repository@unc.edu.

Recent Development: The Federal Circuit and Claim Construction: Resolving the Conflict between the Claims and the Written Description

*Gregory J. Gallagher*¹

I. Introduction

Conflicting standards of claim construction confuse patent practitioners and the patent holders they represent about the scope of the patent's protection. In particular, claim construction canons establishing the relationship between the claims and the written description in determining the scope of protection are unclear.² In a recent case, *Teleflex, Inc. v. Ficosa North America Corp.*,³ the Federal Circuit articulated a comprehensive standard that resolves this conflict and provides the appropriate amount of protection to a patentee while providing adequate incentive for innovation. This Recent Development first explores how the standard developed by the court in *Teleflex* provides a logical framework for claim construction. Second, it describes why the *Teleflex* approach provides certainty to claim construction and why it will lead to even greater certainty in claim construction over time. Finally, this Recent Development addresses potential criticisms of the *Teleflex* standard.

II. Claim Construction and its Conflicting Canons

The role of claim construction in a suit for patent infringement is of paramount importance. A determination of patent infringement is a distinct two-step process. First, the court

¹ J.D. Candidate, University of North Carolina School of Law, 2004.

² The prosecution history has a similar role to the written description's role in claim construction. This Recent Development will not discuss the role of the prosecution history in determining a claim's meaning.

³ *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313 (Fed. Cir. 2002), *reh'g and reh'g en banc denied* 2002 U.S. App. LEXIS 19256 (Fed. Cir. Aug. 30, 2002).

construes the scope of the claims; then, the court compares the properly construed claims to the allegedly infringing device to determine infringement.⁴ Often, after claim construction, a party will be subject to summary judgment because the comparison of an actual device to the construed claim is relatively straightforward.⁵ As a result, the claim construction process in a suit for patent infringement usually determines the outcome of the suit.⁶

Unfortunately, the claim construction process has been far from clear, and, as a result, the amount of litigation regarding claim construction is voluminous.⁷ At the center of the difficulty in construing claims is the Federal Circuit's use of two apparently conflicting canons of construction with regard to the relationship between the claims and the written description in determining a patent's scope.⁸ One canon of claim construction declares that

⁴ *Id.* at 1323.

⁵ See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 989 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996) (Judge Mayer in his concurrence in *Markman* pointed out that "to decide what the claims mean is nearly always to decide the case."); Christian A. Chu, *Empirical Analysis of the Federal Circuit's Claim Construction Trends*, 16 BERKLEY TECH. L.J. 1075, 1107 (2001) (quoting Paul R. Michel, *The Court of Appeals for the Federal Circuit Must Evolve to Meet the Challenges Ahead*, 48 AM U. L. REV. 1177, 1188-89 (1999)) (predicting that an increasing ratio of patent infringement suits will be resolved on summary judgment). See also *Toro Co. v. White Consol. Indus.*, 199 F.3d 1295, 1298 (Fed. Cir. 1999) (noting that the district court granted summary judgment on literal infringement after claim construction); *Wang Labs., Inc. v. Am. Online, Inc.*, 197 F.3d 1377, 1380 (Fed. Cir. 1999) (observing that "the district court granted summary judgment of non-infringement as to literal infringement including infringement under 35 U.S.C. § 112 P6, and also under the doctrine of equivalents after claim construction").

⁶ See Chu, *supra* note 5, at 1107 (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 989 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996) (Mayer, J. concurring "to decide what the claims mean is nearly always to decide the use")).

⁷ See Gretchen Ann Bender, *Uncertainty and Unpredictability in Patent Litigation: The Time is Ripe for a Consistent Claim Construction Methodology*, 8 J. INTELL. PROP. L. 175, 203 (2001) ("Since the Supreme Court's *Markman* decision on April 23, 1996, the Federal Circuit has reviewed approximately 160 district court claim construction decisions.").

⁸ See *Renishaw P.L.C. v. Marposs Societa' Per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998) (observing that plaintiff-appellant's argument that the district

“one may not read a limitation into a claim from the written description.”⁹ A competing canon insists that “one may look to the written description to define a term already in a claim limitation, for a claim must be read in view of the specification of which it is a part.”¹⁰ The Federal Circuit has struggled to reconcile these seemingly conflicting canons and articulate how to read a claim in view of the specification without reading limitations into the claim.

At one end of the spectrum are Federal Circuit decisions holding that claims are construed according to their ordinary and accustomed meaning, unless the claim itself invites reference to the written description expressly, or unless the claim itself is unclear.¹¹ At the other end of the spectrum are Federal Circuit decisions holding that anytime the written description of the invention disclaims subject matter of the invention the claims should be limited.¹² Recent Federal Circuit decisions resolved these differing approaches to claim construction by adopting an approach that advocates always looking to the written description when determining the meaning of claim terms.¹³ Furthermore, in *Teleflex, Inc. v. Ficosa North America Corp.*, the Federal Circuit

court improperly limited a claim term based on the written description implicates a “pair of claim construction canons . . .”).

⁹ *Id.*

¹⁰ *Id.*

¹¹ See *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 990 (Fed. Cir. 1999) (“[C]laim terms cannot be narrowed by reference to the written description or prosecution history unless the language of the claims invites reference to those sources.”); *Gart v. Logitech, Inc.*, 254 F.3d 1334, 1341 (Fed. Cir. 2001) (“[I]t is certainly correct that the specification and the prosecution history should be consulted to construe the language of the claims. However, we perform this consultation to determine if the patentee has chosen to be his or her own lexicographer or when the language itself lacks sufficient clarity” (citations omitted)).

¹² See *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1344 (Fed. Cir. 2001) (finding that the claim must be narrowed because “[t]his is therefore a clear case of disclaimer of subject matter that, absent the disclaimer, could have been considered to fall within the scope of the claim language”).

¹³ See *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313 (Fed. Cir. 2002), *reh’g and reh’g en banc denied* 2002 U.S. App. LEXIS 19256 (Fed. Cir. Aug. 30, 2002); *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359 (Fed. Cir. 2002); *SciMed*, 242 F.3d at 1337.

articulated a comprehensive standard that provides the courts with sufficient guidance to determine when it is appropriate to use the written description of an invention to limit the meaning of a claim term.

This Recent Development will evaluate the Federal Circuit's decision in *Teleflex* along with other significant recent decisions to show how the Federal Circuit developed a trend for claim construction that culminated in a clear articulation of when expressions in the written description limit the meaning of claim terms.

III. Recent Decisions

A. *Johnson Worldwide Associates v. Zebco Corp.*¹⁴

The first important case in the recent trend toward a comprehensive standard for claim interpretation based on the written description is *Johnson*. The Federal Circuit began its claim interpretation analysis in *Johnson* by asserting that there is a heavy presumption in favor of the ordinary meaning of claim language, unless the claim language itself points to the written description.¹⁵ Under this framework, the court asserted that there are only two situations according to precedent "where a sufficient reason exists to require the entry of a definition of a claim term other than its ordinary and accustomed meaning."¹⁶ They are (1) where the patentee chose to be his or her own lexicographer¹⁷ and (2) where

¹⁴ 175 F.3d at 985.

¹⁵ *Id.* at 989.

¹⁶ *Id.* at 990.

¹⁷ Often, the public may not be familiar with the terminology of a technical art or there may not be an existing term that adequately defines a specific structure. A patent applicant may choose to be his own lexicographer by providing an explicit definition in the written description for a claim term. Thus, being a lexicographer simply means that a patent applicant may choose to create words and their meanings or assign a precise definition to a term. Furthermore, "[t]he patentees lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw P.L.C. v. Marposs Societa' Per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998) (quoting *In re Paulsen*, 30 F.3d 1475, 1480 (Fed Cir. 1994)).

the terms used by the patentee “so deprive the claim of clarity that there is no means by which the scope of the claim may be ascertained from the language used.”¹⁸ Thus, the court espoused a claim construction framework that purported to put strong emphasis on the claims’ language to determine their meaning and provided only a very limited role for the written description. Not surprisingly then, the court interpreted the patentee’s claims for his “Trolling Motor with Heading Lock” according to their ordinary meaning, thereby giving the patent a broad scope of protection.

B. *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*¹⁹

To the contrary, in *SciMed*, the Federal Circuit began a line of cases that expanded the use of the written description in determining the meaning of claim terms. In *SciMed*, the court held that “[w]here the specification makes clear that the invention does not include a particular feature,” the court will construe the claims narrowly not to include that feature, even though the claim’s ordinary meaning is clear and may be construed more broadly.²⁰ Thus, the court embraced a claim construction framework where “the written description can provide guidance as to the meaning of the claims, thereby dictating the manner in which the claims are to be construed, even if the guidance is not provided in explicit definitional format.”²¹

After concluding that courts could limit an otherwise clear claim term, the *SciMed* court used five recent cases to show how courts have limited a patentee’s claims based on representations made in the written description.²² According to those cases, a court will limit a claim’s meaning: (1) when the specification describes only one feature and states that “the present invention” utilizes that feature;²³ (2) “[w]hen the ‘preferred embodiment’ is

¹⁸ *Johnson*, 175 F.3d at 990.

¹⁹ 242 F.3d 1337 (Fed. Cir. 2001).

²⁰ *Id.* at 1341.

²¹ *Id.* at 1344.

²² *Id.* at 1341–42.

²³ *Watts v. XL Sys., Inc.*, 232 F.3d 877, 882–83 (Fed. Cir. 2000).

described as the invention itself ...”;²⁴ (3) when patentees expressly disclaimed subject matter in the written description;²⁵ (4) when patentees expressly disclaimed subject matter to avoid the prior art;²⁶ and (5) when the specification and drawings show a feature, do not illustrate or describe any other structure, and describe the advantages of the feature as important to the invention.²⁷

The *SciMed* court then held that the claim language at issue must be narrowed in accordance with the prior cases because the specification expressly disclaimed subject matter to avoid prior art and pointed to the advantages of doing so.²⁸ In a concurring opinion, Judge Dyk agreed that the court should look to the written description for guidance as to the meaning of the claim.²⁹ However, Judge Dyk asserted that the *SciMed* court did not provide adequate guidance as to when it is appropriate to limit claim terms based on the specification.³⁰

C. *CCS Fitness, Inc. v. Brunswick Corp.*³¹

In *CCS Fitness*, the Federal Circuit added momentum to *SciMed*'s express holding by articulating a concise rule. The *CCS Fitness* court held that a court may limit otherwise clear claim terms when “the intrinsic evidence shows that the patentee distinguished that term from prior art on the basis of a particular embodiment, expressly disclaimed subject matter, or described a

²⁴ Wang Labs, Inc. v. Am. Online, Inc., 197 F.3d 1377, 1383 (Fed. Cir. 1999).

²⁵ Cultor Corp. v. A.E. Staley Mfg. Co., 224 F.3d 1328, 1331 (Fed. Cir. 2000).

²⁶ O.I. Corp. v. Tekmar Co., 115 F.3d 1576, 1581 (Fed. Cir. 1997).

²⁷ Toro Co. v. White Consol. Indus., Inc., 199 F.3d 1295, 1302 (Fed. Cir. 1999).

²⁸ *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1342–43 (Fed. Cir. 2001) (“[T]he written description of each of the patents explains that the prior art catheters with shortened guide wire lumens ‘suffer from several disadvantages.’ The first cited disadvantage is that ‘such catheters have been one piece polyethylene catheters having dual lumen configurations adjacent their distal regions. Typically, such catheters have larger than necessary shaft sizes and are stiffer in their distal regions than would be desired’”).

²⁹ *Id.* at 1347.

³⁰ *Id.*

³¹ 288 F.3d 1359 (Fed. Cir. 2002).

particular embodiment as important to the invention.”³² This rule encompasses the five situations identified by the *SciMed* court as being appropriate to limit a claim term’s meaning. Additionally, this rule appears to address Judge Dyk’s criticism in *SciMed* because the “three category standard” is generally applicable when interpreting claims and, thus, provides guidance to courts, patentees, and the public.

Most recently, in *Teleflex* the Federal Circuit refined the rule developed in *SciMed* and *CCS Fitness*. In *Teleflex*, the court expressly added to the *Johnson* exceptions to the general rule that a claim term must take on its ordinary and accustomed meaning.³³ To this end, the court expressly held that “[t]he patentee may demonstrate an intent to deviate from the ordinary and accustomed meaning of a claim term by redefining the term or by characterizing the invention in the intrinsic record using words or *expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.*”³⁴ This most recent articulation of an exception to the “ordinary and accustomed meaning” rule encompasses the rule applied in both *SciMed* and *CCS Fitness* and broadens the court’s ability to construe claims.

The decision in *Teleflex* was necessary because the *SciMed* and *CCS Fitness* courts did not provide a comprehensive standard for determining when the written description limits the ordinary and plain meaning of terms in the claims. Instead, the courts simply identified circumstances in which it would be appropriate to do so.³⁵ The *Teleflex* court solved the problems left unresolved in *SciMed* and *CCS Fitness* by providing a comprehensive and flexible standard that provides sufficient guidance for when it is acceptable to limit claim terms based on representations made in the written description of the invention.

³² *Id.* at 1366–67.

³³ See *Teleflex, Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313, 1327 (Fed. Cir. 2002) (holding that a claim term may be limited by the specification “via other routes” than the inventor choosing to be his own lexicographer and where claim terms lack sufficient clarity to permit the scope to be ascertained), *reh’g and reh’g en banc denied* 2002 U.S. App. LEXIS 19256 (Fed. Cir. Aug. 30, 2002).

³⁴ *Id.* (emphasis added).

³⁵ See *supra* notes 23–28, 32 and accompanying text.

D. *Teleflex, Inc. v. Ficosa North America Corp.*³⁶

Both Teleflex, Inc. ("Teleflex") and Ficosa North American Corporation ("Ficosa") manufactured shift cables for use in automatic transmissions for automobiles.³⁷ Teleflex had a successful relationship with General Motors, Inc. ("General Motors") and supplied "two-piece shift cables" to General Motors for use in the automatic transmissions of its sport utility vehicles.³⁸ In 1990, Teleflex and Ficosa entered into a joint venture to market the cables in Europe where Ficosa had traditionally done business.³⁹ However, the venture fell apart, and soon after, Teleflex discovered that Ficosa had attempted to sell shift cables to General Motors in North America.⁴⁰ After this discovery, Teleflex sued Ficosa for patent infringement in federal district court, alleging that Ficosa had infringed its patent for a component part of the "two-piece shift cable."⁴¹ As in most patent infringement suits, the district court's claim construction was a primary issue.

In *Teleflex*, the district court construed a claim term by limiting the term to a meaning consistent with the written description of the preferred embodiment.⁴² The Federal Circuit concluded that the district court erred in narrowing the meaning of the term "clip" to a clip with a single pair of legs based on the description of a single embodiment.⁴³ The defendant, Ficosa, argued that the district court was correct because "where only one embodiment is disclosed in the specification, claim terms are limited to the embodiment disclosed."⁴⁴

Ficosa's argument shows how the role of the written description in construing claim terms confuses practitioners. Some practitioners believed that the Federal Circuit had established a so-

³⁶ 299 F.3d at 1313.

³⁷ *Id.* at 1318–20.

³⁸ *Id.* at 1320.

³⁹ *Id.*

⁴⁰ *Id.*

⁴¹ *Id.*

⁴² See *id.* at 1328 (holding that the "district court thus erred by importing the 'single pair of legs' limitation from the specification into the claim").

⁴³ *Id.*

⁴⁴ *Id.* at 1326.

called “single embodiment rule” in cases such as *Toro Co. v. White Consolidated Industries, Inc.*,⁴⁵ *Wang Laboratories, Inc. v. America Online, Inc.*,⁴⁶ and *Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc.*⁴⁷ that limited the scope of an invention to the preferred embodiment if only one embodiment was disclosed.⁴⁸ In *Teleflex*, the Federal Circuit expressly rejected this notion of a “single embodiment rule” and held that the number of embodiments described is not determinative.⁴⁹

Instead, the Federal Circuit articulated a comprehensive standard in *Teleflex* for determining when a claim term’s meaning should be limited based on the written description. The court held that:

claim terms take on their ordinary and accustomed meanings unless the patentee demonstrated an intent to deviate from the ordinary and accustomed meaning of a claim term by redefining the term or by characterizing the invention in the intrinsic record using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.⁵⁰

The *Teleflex* court applied this “words or expressions of manifest exclusion or restriction” standard to analyze the district court’s claim construction. In doing so, the court found that the written description did not include “an expression of manifest exclusion or restriction demonstrating an intent to limit ‘clip’”⁵¹ The court observed that the word “clip” was not defined in the written description and that, although there was only a single

⁴⁵ *Toro Co. v. White Consol. Indus.*, 199 F.3d 1295 (Fed. Cir. 1999).

⁴⁶ *Wang Labs., Inc. v. Am. Online, Inc.*, 197 F.3d 1377 (Fed. Cir. 1999).

⁴⁷ *Bell Atl. Network Servs., Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1273 (Fed. Cir. 2001).

⁴⁸ See *Teleflex*, 299 F.3d at 1326 (“[Defendant] argues that where only one embodiment is disclosed in the specification, claim terms are limited to the embodiment disclosed, citing *Toro Co. v. White Consol. Indus.*, *Wang Labs., Inc. v. Am. Online, Inc.*, and *Bell Atl. Network Servs., Inc. v. Covad Communications Group, Inc.*” (citations omitted)).

⁴⁹ *Id.* at 1327.

⁵⁰ *Id.*

⁵¹ *Id.*

embodiment showing the clip with a single pair of legs, there were no “clear statements of scope” limiting the term “clip.”⁵² The court’s claim construction comports with the trend of recent Federal Circuit decisions looking to the written description in determining the meaning of claim terms and, consequently, patent scope.

IV. Discussion

A. The *Teleflex* Framework is the Most Logical According to Claim Construction Canons

In *Teleflex*, the Federal Circuit establishes the most logical method for how the court should use the claims, written description, and prosecution history to obtain the precise scope of the patentee’s right to exclude. As established by the Supreme Court in *Markman v. Westview Instruments, Inc.*, claim construction must adhere to the principle “that a term can be defined only in a way that comports with the instrument as a whole.”⁵³ Moreover, “[t]o ascertain the meaning of claims, [the court] consider[s] three sources: The claims, the specification, and the prosecution history.”⁵⁴ Thus, the written description, which is a part of the specification,⁵⁵ plays a role in interpreting the meaning of claims.

Furthermore, the federal statute controlling patents provides that “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”⁵⁶ It is a well-settled principle of claim construction that claim construction

⁵² *Id.* at 1327–28.

⁵³ *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996).

⁵⁴ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (1995) (quoting *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1561 (Fed. Cir. 1991)), *aff’d*, 517 U.S. 370 (1996).

⁵⁵ 37 C.F.R. § 1.71(a) (2002) (“The specification must include a written description of the invention or discovery . . .”).

⁵⁶ 35 U.S.C. § 112 (2000).

analysis begins and ends with the words of the claim.⁵⁷ As the court acknowledged in *Teleflex*, “[t]he claims define the scope of the right to exclude; the claim construction inquiry, therefore, begins and ends in all cases with the actual words of the claim.”⁵⁸

Another important canon of claim construction is that a claim term is given its ordinary and accustomed meaning as determined from the standpoint of a person of ordinary skill in the relevant art.⁵⁹ This “ordinary meaning” rule, however, has been qualified by two distinct exceptions. First, a patentee may choose to be his own lexicographer by defining “specific terms used to describe the invention ‘with reasonable clarity, deliberateness, and precision.’”⁶⁰ This rule is necessary because the public may not understand the terminology of the technical art or there may not be a single term that embodies the concept of the invention with sufficient precision.⁶¹ The second exception to the “ordinary meaning” rule is that the court may use the written description to interpret a claim term where the term “lacks sufficient clarity to permit the scope of the claim to be ascertained from the words alone.”⁶² Thus, the court must always review the specification, which includes a background of the invention, summary of invention, brief description of the drawings, description of preferred embodiment, and the claims, to determine whether the patentee used any term in a manner inconsistent with its ordinary meaning.⁶³

Difficulty in determining the meaning of a claim term generally arises when the patentee provides a non-technical word

⁵⁷ *Teleflex*, 299 F.3d at 1324; *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

⁵⁸ *Id.* (citing *Renishaw P.L.C. v. Marposs Societa' Per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998)).

⁵⁹ *Vitronics*, 90 F.3d at 1582.

⁶⁰ *Teleflex*, 299 F.3d at 1325 (quoting *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994)).

⁶¹ *Renishaw*, 158 F.3d at 1249.

⁶² *Teleflex*, 299 F.3d at 1325.

⁶³ See *Vitronics*, 90 F.3d at 1582 (“[I]t is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning. The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication.”).

in a claim that either has a very broad ordinary and accustomed meaning or has several ordinary meanings. For example, in *Teleflex*, the disputed term was “clip,” in *Toro*, it was “including,” and in *Renishaw P.L.C. v. Marposs Societa' Per Azioni*, the disputed term was “when.”⁶⁴ In each of these cases, the litigants argued over whether the term should be limited by expressions in the written description or should be allowed to maintain its broad ordinary meaning.

Where a claim uses a term with a broad meaning or with several meanings, the court must narrow its meaning if the written description provides “words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.”⁶⁵ There are two bases for this assertion. First, where a term is used that has a very broad ordinary meaning, the court may deem that term so “sufficiently broad and amorphous that the scope of the claim language can be reconciled only with recourse to the written description.”⁶⁶ Second, once the court turns to the specification and finds a characterization of the invention that is clearly and directly contrary to the ordinary meaning of an otherwise broad term, the court cannot ignore the limitations imposed on the claims.⁶⁷

Ignoring clear disavowals of claim scope in the written description and other parts of the specification would violate at

⁶⁴ See *Teleflex*, 299 F.3d at 1324 (“In this case, the parties disagree as to whether the district court correctly performed the first step with regard to the ‘clip (28)’ limitation in claim 1 of the ’182 patent.”); *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999) (“It is a matter of interpretation of the words ‘including’ and ‘cover’ to determine whether, as a matter of law, the claim requires that the cover and the ring are attached to each other.”); *Renishaw*, 158 F.3d at 1251 (“Because infringement of this limitation depends on the meaning of the word ‘when,’ we refer to it in the remainder of the opinion as the ‘when’ limitation.”).

⁶⁵ *Teleflex*, 299 F.3d at 1327.

⁶⁶ *Bell Atl. Network Servs., Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1269–70 (Fed. Cir. 2001).

⁶⁷ See, e.g., *Wang Labs., Inc. v. Am. Online, Inc.*, 197 F.3d 1377, 1383 (Fed. Cir. 1999) (“Although Wang is correct that a claim is not invalid simply because it embraces subject matter that is not specifically illustrated, in order to be covered by the claims that subject matter must be sufficiently described as the applicant’s invention . . .”).

least two paramount principles of claim construction. First, ignoring clear disavowals of claim scope and interpreting a claim term in accordance with its ordinary meaning would violate the principle that a court must interpret the patent document as a whole.⁶⁸ Second, ignoring clear disavowals of claim scope would violate the principle that “[c]laims are to be construed in light of the specifications and both are to be read with a view to ascertaining the invention.”⁶⁹ Thus, as the courts in both *Wang* and *Bell Atl.* indicate, interpreting a claim more broadly than the invention’s scope would not make sense.

In *Wang*, the Federal Circuit defined the claim term “frame” in accordance with the use of the term in the written description.⁷⁰ According to the court, the patentee used the term “frame” consistently throughout the specification with respect to a character-based protocol, and not with respect to bit-mapped display systems.⁷¹ Furthermore, the court concluded that the single embodiment in the specification was the actual invention; thus, the court could not construe the claim terms more broadly than that embodiment.⁷² When the court read the patent “as a whole,” as it must be read, it was clear that the patentee did not possess the bit-mapped display system as part of the invention.⁷³ Thus, the court gave the term “frame” a narrow meaning in accordance with the invention.

Similarly, in *Bell Atlantic*, the district court construed the term “modes” as limited to three categories defined in the specification.⁷⁴ The Federal Circuit affirmed the district court’s

⁶⁸ *Markman v. Westview Instruments, Inc.* 517 U.S. 370, 389 (1996).

⁶⁹ *United States v. Adams*, 383 U.S. 39, 49 (1966).

⁷⁰ *Wang*, 197 F.3d at 1383.

⁷¹ *See id.* at 1381–82 (concluding that references to protocols other than character-based systems did not describe them as part of the invention but as “acknowledgments of the state of the art”).

⁷² *Id.* at 1383.

⁷³ *See id.* (“Whether an invention is fairly claimed more broadly than the ‘preferred embodiment’ in the specification is a question specific to the content of the specification, the context in which the embodiment is described, the prosecution history, and if appropriate the prior art . . .”).

⁷⁴ *Bell Atl. Network Servs., Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1266 (Fed. Cir. 2001).

finding that the three modes discussed in the specification “literally occupy the field of possibilities contemplated by the . . . patent.”⁷⁵ Additionally, the Federal Circuit asserted that the specification consistently used “the terms ‘mode’ and ‘rate’ to refer to two different and distinct concepts.”⁷⁶ Thus, the court narrowed the term “mode,” reasoning that giving the term its broad meaning would go beyond the actual invention possessed by the inventor.⁷⁷ Yet again, when the Federal Circuit was confronted with a claim term whose ordinary meaning was broader than the invention as clearly disclosed in the specification, the court was bound to narrow the meaning of the term.

Furthermore, the framework proposed in *Teleflex* protects the ordinary meaning of a claim term by providing a heavy presumption in favor of that meaning and requiring clear disavowals of claim scope in the written description of the invention.⁷⁸ Claim construction is a complex process, and the court must always complete the process within the context of the intrinsic record.⁷⁹ By providing that otherwise clear claim terms must be given their ordinary meaning unless there are expressions of manifest exclusion or restriction, the court provided a measuring stick by which to review lower court decisions. This framework provides the appropriate balance between the claims and the written description because the claim terms define the scope of the inquiry, and the written description provides the context necessary to determine the scope of the invention.

⁷⁵ *Id.*

⁷⁶ *Id.* at 1272.

⁷⁷ *See id.* at 1273 (concluding that the definition of “mode” as described by the detailed description of the preferred embodiments as three modes is limited to such modes on the basis that claims are not entitled to a broader scope than the invention).

⁷⁸ *Teleflex, Inc. v. Ficos N. Am. Corp.*, 299 F.3d 1313, 1327 (Fed. Cir. 2002), *reh’g and reh’g en banc denied* 2002 U.S. App. LEXIS 19256 (Fed. Cir. Aug. 30, 2002).

⁷⁹ *Id.* at 1324–25.

B. The Claim Construction Framework in *Teleflex* Will Provide Certainty over Time

Any framework for claim construction must provide certainty⁸⁰ to avoid wasting judicial resources and to provide for stable property rights.⁸¹ To achieve certainty in claim construction, courts must stake out the metes and bounds of the patent's protection, and courts must construe patents consistently. The Supreme Court explained the importance of knowing the metes and bounds of a patent in *Markman*:

[T]he limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. Otherwise, a 'zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field,' and the public [would] be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights.⁸²

Unfortunately, claim construction is an uncertain process.⁸³

To begin with, courts must construe terms within the context of the claims, the written description, the drawings, and the prosecution history.⁸⁴ Interpreting a claim in the context of the entire intrinsic record is difficult. To complicate claim construction, patents

⁸⁰ See, e.g., Bender, *supra* note 7, at 175 ("Corporations, in-house counsel and even trial litigators require certainty and predictability in order to develop products, businesses and litigation strategies.").

⁸¹ Russell B. Hill & Frank P. Cote, *Ending the Federal Circuit Crapshoot: Emphasizing Plain Meaning in Patent Claim Interpretation*, 42 IDEA 1, 1 (2002).

⁸² *Markman v. Westview Instruments, Inc.* 517 U.S. 370, 390 (1996) (citing *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364 (1938); *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228 (1942); *Merrill v. Yeomans*, 94 U.S. 568 (1877)).

⁸³ See Bender, *supra* note 7, at 175 ("The Federal Circuit changes the trial court's claim construction in approximately forty percent of its cases.").

⁸⁴ *Markman*, 517 U.S. at 389.

generally cover exceptionally sophisticated subject matter for which there is no precise vocabulary available. Although the subject matter of most patents may be grouped according to whether they are in the mechanical arts, electrical arts, computer arts, and so on, the actual range of potential subject matter is almost limitless. Thus, courts cannot use claim construction canons as a set of step-by-step rules to extract the scope of every invention.⁸⁵ Instead, claim construction canons are a framework courts employ to arrive at term interpretations that comport with a “full understanding of what the inventors actually invented and intended to envelop with the claim.”⁸⁶

The key to providing the maximum amount of certainty in the claim construction process is to develop a logical framework that comports with the overall goals of patent law and to apply this framework consistently. The framework asserted in *Teleflex* provides a logical framework that achieves the goals of patent law.⁸⁷ In fact, the *Teleflex* framework is inescapable in its application because it ascertains the “true invention.”⁸⁸ The inescapable nature of the *Teleflex* framework provides inherent certainty. Thus, patentees, inventors, patent examiners, patent agents, patent attorneys, and the courts need only look to the recent case law in the context of the framework asserted in *Teleflex* to understand how the claims and written description relate to one another. Two cases, *Johnson Worldwide Associates, Inc. v. Zebco Corp.*⁸⁹ and *Gart v. Logitech, Inc.*,⁹⁰ illustrate this point.

Both *Johnson* and *Gart* purport to use a claim construction contrary to *Teleflex*.⁹¹ However, under close examination even

⁸⁵ See *Renishaw P.L.C. v. Marposs Societa' Per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998) (asserting that “[a] claim construction is persuasive, not because it follows a certain rule, but because it defines terms in the context of the whole patent”).

⁸⁶ *Id.*

⁸⁷ See *supra* Part IV.A.

⁸⁸ See, e.g., *Renishaw*, 158 F.3d at 1250 (observing that a claim term must be interpreted “with a full understanding of what the inventors actually invented”).

⁸⁹ *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985 (1999).

⁹⁰ *Gart v. Logitech, Inc.*, 254 F.3d 1334 (Fed. Cir. 2001).

⁹¹ See *Johnson*, 175 F.3d at 990 (holding that only when a patentee chooses to be his own lexicographer or claim terms are ambiguous does “a term or terms used

these cases employ the “expressions of manifest exclusion” rule of *Teleflex*. In *Johnson*, for instance, the plaintiff-patentee had a patent for an apparatus that functioned as a sort of autopilot for small outboard electric trolling motors.⁹² The preferred embodiment as set forth in the written description employed a compass attached directly to the trolling motor.⁹³ The defendant, Zebco Corp. (“Zebco”), argued that the plaintiff’s patent covered only those trolling motor autopilot systems where the directional indicator attached directly to the trolling motor. Specifically, Zebco argued that the proper interpretation of the terms “heading signal” and “coupled” required the scope of the claim to be limited to a directional indicator that is mechanically attached to the trolling motor.⁹⁴ Zebco based this argument on the meaning of the word “heading” used in the written description and drawings of the preferred embodiment.⁹⁵

The court in *Johnson* did not endorse a claim construction framework that always looks to the written description for guidance in determining the meaning of claim terms. Instead, the court held that the written description should only be used to limit a claim term where the patentee has chosen to be his own lexicographer or where the terms used by the patentee lack sufficient clarity.⁹⁶ Nevertheless, the court’s claim construction is completely consistent with the framework asserted in *Teleflex*. The court held the following: (1) that the term heading had many varied uses in the written description, (2) that the varied uses of the term demonstrated a broad scope, and (3) that there was a lack of unambiguous language limiting the scope in the written

in the claim invites—or indeed, requires—reference to intrinsic, or in some cases, extrinsic evidence”); *Gart*, 254 F.3d at 1341 (A court looks to the written description only when a patentee chooses to be his own lexicographer or when claim terms lack sufficient clarity. “[W]hen the foregoing circumstances are not present, we follow the general rule that terms in the claim are to be given their ordinary and accustomed meaning.”).

⁹² *Johnson*, 175 F.3d at 987.

⁹³ *Id.*

⁹⁴ *Id.* at 988–89.

⁹⁵ *Id.* at 989.

⁹⁶ *Id.* at 990.

description.⁹⁷ Thus, the court in *Johnson* did not look to see if the patentee chose to be his own lexicographer or if the claim term lacked sufficient clarity. Instead, the court applied the “*using words or expressions of manifest exclusion or restriction*” standard. Concluding that the plaintiff-patentee did not use the claim term “heading” in a consistent manner that restricted claim scope, the court found that the ordinary meaning of the term “heading” should apply.⁹⁸

Likewise, in *Gart*, the plaintiff-patentee had a patent for an ergonomically shaped computer mouse for reducing muscle fatigue.⁹⁹ The district court construed the claim phrase “an angular medial surface” to require that the mouse housing have “an angular ledge.”¹⁰⁰ In support of the district court’s claim construction, the defendant, Logitech, Inc. (“Logitech”), asserted that all drawings of the preferred embodiment possessed an angular ledge.¹⁰¹ Furthermore, Logitech asserted that “the written description particularly describes the invention as a ‘medial ledge undercut’” and that this reference is not related to a preferred embodiment and, thus, must relate to the invention.¹⁰²

Once again, the court did not explicitly endorse a claim construction framework as set forth later in *Teleflex*. Nevertheless, the *Gart* court’s claim construction is also consistent with the *Teleflex* framework. In holding that the “angular ledge” limitation not be imported into the claim, the court found that the specification did not describe “the invention” as having an angular ledge.¹⁰³ Furthermore, the court found that “[t]he written description does not explicitly limit the subject matter of the patent to the ledge configuration set forth in the drawings.”¹⁰⁴ Thus, the

⁹⁷ *Id.* at 991.

⁹⁸ *Id.* at 992 (concluding that “Zebco thus has not shown that sufficient reasons exist to import a limited definition of this term into the clear language of the claim”).

⁹⁹ *Gart v. Logitech, Inc.*, 254 F.3d 1334, 1337 (Fed. Cir. 2001).

¹⁰⁰ *Id.* at 1340.

¹⁰¹ *Id.*

¹⁰² *Id.*

¹⁰³ *Id.* at 1342 (finding that references to the preferred embodiment “did not contain all of the ergonomic surface feature of the invention . . .”).

¹⁰⁴ *Id.*

Gart court construed a term by looking to the written description, even though the court did not find that the patentee chose to be his own lexicographer, and the claim term lacked sufficient clarity. Once again, a court, purporting to use the *Johnson* framework, explicitly looked to the written description for “*expressions or words of manifest exclusion, representing clear disavowals of scope.*”¹⁰⁵ When the court found no such expressions or words, the ordinary meaning was allowed.¹⁰⁶

In addition to the *Teleflex* framework’s inherent ability to provide certainty because of its inescapable logic, the rule in *Teleflex* will increase the amount of certainty over time as practitioners have time to review the court’s consistent use of the framework.¹⁰⁷ Furthermore, the standard makes it clear to those preparing patent applications and prosecuting patents that the language used in the written description and the claims must have the same meaning, a rule that is consistent with the requirements of 35 USC § 112.¹⁰⁸

¹⁰⁵ See *id.* at 1341–42 (failing to find that the patentee chose to be his own lexicographer or that the claims lacked sufficient clarity, nevertheless, using the written description to determine the scope of claim terms).

¹⁰⁶ *Id.* at 1342 (“[T]here were no express representations made in obtaining the patent regarding the scope and meaning of the claim terms. Moreover, the scope of claim 7 may be ascertained from the plain language of that claim.”).

¹⁰⁷ See *Bender*, *supra* note 7, at 222 (“At a minimum, the consistent use by all courts of a specific claim construction approach will correct the current problems of uncertainty.”).

¹⁰⁸ The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. . . . The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regard as his invention.

35 U.S.C. § 112 (2000).

C. Response to Criticisms that the *Teleflex* Framework is Less Certain than the Ordinary and Accustomed Meaning Rule and Requires a Description of All Potential Embodiments

One criticism of the *Teleflex* framework is that by allowing the court to overcome the ordinary meaning of a claim term by finding “expressions of manifest exclusion or restriction” the court may give a claim term an implied definition based on the written description.¹⁰⁹ The consequence of allowing the court to determine an implied meaning is that the court will read “unintended limitations into the claims from the written description.”¹¹⁰ According to this criticism, the court must be forced into a more rigid claim construction framework, one that depends on either express representations by the patentee, or a lack of clarity in claim terms before looking to the written description.¹¹¹

However, this argument has three serious problems. First, it overlooks the plain fact that courts, patentees, and the public must look to the patent as a whole to ascertain the scope of protection.¹¹² Second, this argument fails to notice the fact that many claim terms, although clear and unambiguous on their face, do not provide sufficient specificity to be given a broad meaning, especially in the presence of a manifest expression of restriction or exclusion.¹¹³ To give a claim term a meaning that clearly is contrary to what the patentee describes as the invention is unsupportable.¹¹⁴ Finally, this criticism is based on the mistaken

¹⁰⁹ Hill & Cote, *supra* note 81, at 22–23.

¹¹⁰ *Id.* at 23.

¹¹¹ *Id.*

¹¹² See *Renishaw P.L.C. v. Marposs Societa' Per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998) (“The construction that stays true to the claim language and most naturally aligns with the patent’s description of the invention will be, in the end, the correct construction.”).

¹¹³ See *Toro Co. v. White Consol. Indus.*, 199 F.3d 1295, 1300 (Fed. Cir. 1999) (holding the term “cover” must be limited); *Renishaw*, 158 F.3d at 1250–51 (holding that the term “when” has too many ordinary meanings and is limited to the meaning given in the written description).

¹¹⁴ See ROBERT L. HARMON, PATENTS AND THE FEDERAL CIRCUIT § 5.6(b) (5th ed. 2001) (“Ultimately, the interpretation to be given a term can only be

belief that interpreting claim terms in the context of the written description is the same as importing a limitation from the written description.¹¹⁵ On the contrary, the written description may be properly used to narrow a claim term without improperly importing a limitation into the claim.¹¹⁶

Another criticism of the framework established in *Teleflex* is that the framework requires that the written description describe the “invention” in all its potential embodiments.¹¹⁷ This interpretation of the claim construction framework asserted in *Teleflex* is mistaken. The court in *Teleflex* was careful in expressly holding that the number of embodiments described in a specification is not determinative.¹¹⁸ Furthermore, the framework in *Teleflex* does not mean that a patentee must fully describe the “true invention” in the written description, although doing so may be necessary under the written description requirement. The framework in *Teleflex* properly avoids such validity considerations by holding that if the invention is clearly restricted, or if subject matter is clearly excluded from a claim term’s meaning, then the court will give a claim term a narrow interpretation. Thus, the court in *Teleflex* avoided involving the written description requirement by limiting its approach to claim construction.

determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim.”).

¹¹⁵ See Hill & Cote, *supra* note 81, at 23 (“The pernicious result of applying the ‘implied meaning’ logic of cases like Bell Atlantic is reading unintended limitations into the claims from the written description. Thus, this logic runs afoul of long-standing Federal Circuit claim construction principles.”).

¹¹⁶ See HARMON, *supra* note 114, § 5.6(c)

There is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification. . . . [W]hile it is entirely proper to use the specification to interpret what the patentee meant by a word or phrase in the claim, this is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.

Id.

¹¹⁷ Hill & Cote, *supra* note 81, at 7.

¹¹⁸ *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327 (Fed. Cir. 2002) (holding “[i]n sum, the number of embodiments disclosed in the specification is not determinative of the meaning of disputed claim terms”), *reh’g and reh’g en banc denied* 2002 U.S. App. LEXIS 19256 (Fed. Cir. Aug. 30, 2002).

V. Conclusion

The Federal Circuit's use of conflicting claim construction canons confused patentees and practitioners and made determining the scope of a patent uncertain. In *Teleflex*, the Federal Circuit resolved this confusion by providing a comprehensive standard that finally establishes a clear relationship between a patent's claims and the written description.¹¹⁹ The claims are preeminent¹²⁰ and define the limits of the patent. The written description can only speak to the scope of protection through the terms provided in the claims.¹²¹ Claim terms, however, will not be given their ordinary meaning when the terms are used in the written description of the patent in a manner that makes it manifestly clear that the ordinary meaning of the claim's terms should be restricted.¹²² Thus, the court in *Teleflex* provided a logical standard that may be applied with certainty to achieve the goals of the patent system. To apply a claim construction framework that gives a patentee a scope of protection clearly broader than the "true invention" she possessed at the time of patenting would lead to further uncertainty and miss the aims of patent law. In summary, because the *Teleflex* framework is the most logical claim construction framework, lower courts will construe claims more predictably; thus, patentees and practitioners will better understand the scope of existing and future patents. These increases in predictability and user comprehension will provide increased certainty in claim construction.

¹¹⁹ *Teleflex*, 299 F.3d at 1327.

¹²⁰ See *id.* at 1324 (asserting that "[t]he claims define the scope of the right to exclude; the claim construction inquiry, therefore, begins and ends in all cases with . . . the claim") (quoting *Renishaw P.L.C. v. Marposs Societa' Per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998)).

¹²¹ *Id.*

¹²² *Id.* at 1327.