

Nos. 03-1269 & 03-1286

In The
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

EDWARD H. PHILLIPS,

Plaintiff-Appellant,

v.

**AWH CORPORATION, HOPEMAN BROTHERS, INC.,
and LOFTON CORPORATION,**

Defendants/Cross-Appellants.

On Appeal from United States District Court for the District of Colorado
in Case No. 97-N-212, Judge Marcia S. Krieger

**BRIEF FOR AMICUS CURIAE ASSOCIATION OF CORPORATE
COUNSEL ON REHEARING EN BANC IN SUPPORT OF NEITHER SIDE**

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Phillips

v.

AWH Corporation, et al.

Appeal Nos. 03-1269 & 03-1286

Certificate of Interest and Corporate Disclosure

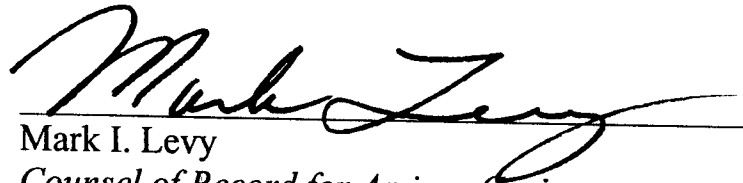
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1. The full name of every party or amicus represented by me is the Association of Corporate Counsel, formerly known as the American Corporate Counsel Association (ACCA).
2. The name of the real party in interest represented by me is the amicus curiae.
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are: None.
4. There is no such corporation as listed in paragraph 3.
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INTEREST OF AMICUS CURIAE

The Association of Corporate Counsel (“ACC”) is a bar association of attorneys practicing in the legal departments of corporations and other private-sector organizations worldwide. ACC promotes the common interests of its members, contributes to their continuing education, seeks to improve understanding of the role of in-house attorneys, and encourages advancements in standards of corporate legal practice. ACC includes a diverse mix of over 15,000 in-house attorneys representing over 7,000 companies throughout the world. ACC’s members include counsel to corporations that both defend against patent infringement allegations and enforce patent rights. ACC’s Intellectual Property Law Committee has over 3,500 members, many of whom have direct responsibility for patent matters for their corporate clients.

ACC’s primary interest is that the Court’s approach to claim construction provide certainty on the meaning and scope of patents. The rules for construing patent claims will have a direct bearing on ACC’s members and their clients and will significantly affect the clients’ business, investment, and litigation decisions concerning patents. ACC takes no position on the merits of the parties’ underlying dispute.

This brief is filed pursuant to the Court’s Order of July 21, 2004, granting rehearing en banc and inviting the submission of amicus briefs.

INTRODUCTION AND SUMMARY OF ARGUMENT

Claim construction issues have proved vexing for businesses, litigants, and judges alike. This brief advances a step-by-step sequential methodology to provide structure and consistency to claim determination. This approach accomplishes the paramount goals of objective public notice of the claimed invention, certainty and predictability regarding the scope and meaning of patent rights, efficient resolution of patent disputes, and a decrease in the current high rate of appellate reversals.

This brief addresses the specific issues raised by the Court in the context of the three different steps of the suggested methodology. These three steps include:

- (1) Examining the intrinsic evidence first to determine if the inventor has explicitly defined the term;
- (2) If the intrinsic evidence does not provide an explicit definition, determining an ordinary meaning by examining appropriate extrinsic evidence; and
- (3) Re-examining the intrinsic evidence to ensure that the ordinary meaning is consistent with it.

This brief furnishes the following answers to the Court's specific questions:

1. Public notice is best served by first looking to the intrinsic evidence, including the claims, the specification, and the prosecution history. Dictionaries and other extrinsic evidence are to be used only if the intrinsic evidence does not determine the meaning of the claim.

2. Dictionaries, as extrinsic evidence, should not be the primary source for claim construction.

3. The intrinsic evidence should be the primary source for claim construction. Dictionaries should be used only as secondary evidence in the event the intrinsic evidence does not resolve the claim interpretation. Since the guiding inquiry is the meaning of terms to those of ordinary skill in the relevant art, relevant technical dictionaries should usually be consulted before, and carry more weight than, general dictionaries. If it becomes necessary to consult a dictionary, the specification and prosecution history should not restrict the dictionary meaning of a term, and thus narrow the patent, unless such intrinsic evidence expressly makes clear that the invention is confined to less than the full dictionary definition. The same should hold true even when the specification discloses only one embodiment of the invention. Multiple potentially applicable and relevant dictionary definitions of a term should all be included in the construction of a claim unless the intrinsic patent evidence or an applicable interpretive canon requires otherwise.

4. The claim-construction methodologies applied by the majority and dissent of the now-vacated panel decision should not be used as complementary methodologies. A single approach that limits subjective determinations and thereby provides the most consistent and predictable results is preferable.

5. Claim language should be construed narrowly to avoid invalidity but this construction should not conflict with the explicit claim language, or the intrinsic record, even if necessary to preserve validity. Furthermore, when construing claims to preserve validity, a court should ensure that the claim is given the same meaning for both validity and infringement purposes.

6. The prosecution history is intrinsic evidence and therefore should be considered, along with the claim language and the specification, a primary source for claim construction. By contrast, expert testimony should be used to construe the claim only if the intrinsic evidence is insufficient. When the intrinsic evidence does not provide a meaning, a judge may examine extrinsic evidence including dictionaries, treatises, prior art, and expert testimony to determine the meaning of the disputed term to one of ordinary skill in the art.

7. Claim construction generally is a question of law subject to *de novo* appellate review without deference to the trial court's construction. However, where the trial court's ruling involves a finding of fact on live testimony (typically from an expert), and that finding is embedded in the court's ultimate conclusion, that factual finding is reviewed under the "clearly erroneous" standard.¹

¹ The answer to the question posed in the opinion concurring in the order granting rehearing *en banc* is that an orderly and sequential methodology is possible and preferable to an unstructured approach that depends upon the circumstances of the particular case. See also R. Polk Wagner & Lee Petherbridge, *Is The Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance*, 152 U.

ARGUMENT

I. **SOUND RULES OF CLAIM CONSTRUCTION SHOULD FURTHER THE OBJECTIVES OF THE PATENT AND LITIGATION SYSTEMS.**

Claim construction rules affect businesses not only in patent litigation but also in their decisions to invest in, develop, and patent new inventions. These decisions turn on the certainty and security of the patent rights that will be obtained. Sound claim-construction rules protect investment and encourage risk-taking and thereby promote new inventions.

In making their evaluation, businesses consider how their competitors may design around their patented inventions. This directly affects a patent's scope and value and thus the incentives to undertake the invention. By the same token, businesses considering investment in a new invention must consider the prior art and be able to determine both whether their invention is patentable and whether their invention will infringe another's patent rights. In these respects as well, clear and certain claim-construction rules are essential. Indeed, uncertainty over the scope of patents may present a barrier to entry.

Finally, sound claim-construction rules should permit the efficient and determinate resolution of disputes. It serves important public and private interests for parties to be able to ascertain the strengths of their competing positions and

PA. L. REV. 1105 (2004) (analyzing the "procedural" and "holistic" methods of claim construction).

therefore reasonably evaluate whether to litigate or voluntarily resolve their dispute. Furthermore, if litigation ensues, claim-construction rules should facilitate efficient adjudication by providing clear and definite principles of decision (both substantive and procedural) and enabling disposition of suits on pretrial motion wherever possible. Lower courts and litigants should have a clear understanding of the governing rules followed by this Court so that excessive appellate reversals and wasted trial proceedings may be avoided to the extent possible.

To these ends, claim-construction rules should reflect, and be measured against, the following objectives:

- To provide adequate and objective public notice of the claimed invention;
- To provide patent holders with certain and complete rights;
- To prevent the inadvertent loss or limiting of patent rights; and
- To facilitate efficient resolution of patent disputes through early settlement or speedy adjudication, and avoid excessive reversals on appeal.

II. AS THIS COURT HAS RECOGNIZED, SOUND RULES OF CLAIM CONSTRUCTION ARE ANALOGOUS TO PRINCIPLES OF STATUTORY CONSTRUCTION.

This Court, sitting en banc, has recognized that claim construction is analogous to statutory construction. In *Markman v. Westview Instruments, Inc.*, 52

F.3d 967, 987 (Fed. Cir. 1995) (en banc), *aff'd on other grounds*, 517 U.S. 370 (1996), the Court held that “[t]he . . . appropriate analogy for interpreting patent claims is the statutory interpretation analogy [rather than the contract-interpretation analogy].” While “[t]here are, of course, differences between a statute and a patent,” the Court described the controlling similarities:

Statutory interpretation is a matter of law strictly for the court. There can be only one correct interpretation of a statute that applies to all persons. Statutes are written instruments that all persons are presumed to be aware of and are bound to follow. Statutes, like patents, are enforceable against the public, unlike private agreements between contracting parties. When interpreting statutes, a court looks to the language of the statute and construes it according to the traditional tools of statutory construction, including certain well known canons of construction. A court may also find it necessary to review the legislative history of the statute, which is itself a matter of public record, just as the specification and prosecution history of a patent are public records. While a court may seek from the public record to ascertain the collective intent of Congress when it interprets a statute, the subjective intent of any particular person involved in the legislative process is not determinative. . . . Similarly, the subjective meaning that a patentee may ascribe to claim language is also not determinative. Thus, it is from the public record that a court should seek in a patent infringement case to find the meaning of claim language.

Id. at 987 (citations omitted). The statutory construction analogy provides substantial guidance for the development of appropriate claim-construction rules that fulfill the foregoing objectives.

III. CLAIM CONSTRUCTION, LIKE STATUTORY CONSTRUCTION, SHOULD ENTAIL A SEQUENTIAL ANALYSIS THAT LOOKS TO INTRINSIC EVIDENCE, APPROPRIATE EXTRINSIC EVIDENCE, AND APPLICABLE INTERPRETIVE CANONS.

A template or roadmap for claim construction is necessary to ensure objective public notice, certainty and predictability regarding the scope and meaning of patents, and protection of the full measure of patent rights. In addition, an express claim-construction methodology that can be followed by litigants and trial courts as well as this Court will further efficient litigation and avoid a high rate of appellate reversals.

This is not to say, of course, that such an approach will provide mechanistic or formulaic answers to questions of claim construction. Judgment is unavoidable (and in fact is desirable), and reasonable people may continue to differ about hard cases. But the following structured analysis will best facilitate predictable and consistent claim construction.

Furthermore, the single methodology presented will provide more predictability than any combination of multiple methodologies. Specifically, with respect to question 4 posed in the Court's Order of July 21, 2004, use of the claim-construction methodologies applied by the majority and dissent of the now-vacated panel decision as complementary methodologies would introduce layers of complexity inconsistent with the objective of providing predictable claim construction results. Accordingly, the brief proposes the following sequential

approach that limits subjective determinations and thereby provides consistent and predictable results.

A. Step One: Patent Claims Should Be Construed In Light Of The Intrinsic Evidence Of The Claims, Specifications, And Prosecution History.

First and foremost, claim construction should focus on the patent itself. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (“the court should look first to the intrinsic evidence of record, *i.e.*, the patent itself”). This “intrinsic evidence” of “the patent itself” “includ[es] the claims, the specification and, if in evidence, the prosecution history.” *Id.* *See also, e.g., Markman*, 52 F.3d at 979. This is consistent with the guiding principle that whenever possible, claim should be construed from the objective evidence available in the public record of the patent itself. *See Vitronics*, 90 F.3d at 1583 (where the intrinsic evidence is sufficient to define a claim, “it is improper to rely on extrinsic evidence”).

At this step of the analysis, the salient question is whether the court can conclude with sufficient confidence (that is, without the need for extrinsic evidence or canons of claim construction) that the patent claim has a plain meaning known to one of ordinary skill in the relevant art. *See Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed. Cir. 2001). Because language customarily is used (unless otherwise indicated) in accordance with accepted definitions, the starting

point is the literal language of the claim as understood by those of ordinary skill in the relevant art. *See* 35 U.S.C. §12, ¶¶ 1 & 2. Because the patent holder “is free to be his own lexicographer,” any “special definition . . . made explicit” in the patent must be considered. *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 243 F.3d 1316, 1327 (Fed. Cir. 2001), *vacated on other grounds*, 535 U.S. 1109 (2002).

Likewise, in describing the subject matter of the invention, the specification can shed important light on the claim’s meaning. At the same time, patent rights should not be unduly restricted or inadvertently waived by reading in a preferred embodiment or “best mode” to limit the claim’s scope. *See Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 904-05 (Fed. Cir. 2004) (distinction between properly interpreting a claim in light of a specification and improperly limiting a claim by reading a preferred embodiment into it); *Inverness Med. Switz. v. Warner Lambert Co.*, 309 F.3d 1373, 1379 (Fed. Cir. 2002).

Accordingly, an explicit definition of the term is required, such as the Court found in *Scimed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337 (Fed. Cir. 2001). In *Scimed*, the specification stated:

The intermediate sleeve structure defined above is the basic sleeve structure for *all embodiments of the present invention contemplated and disclosed herein*—namely, an inner core tube bonded to a distal portion of the main catheter shaft, with an outer sleeve forming an annular continuation of the inflation lumen through the main shaft between the core tube and outer sleeve.

Id. at 1343 (emphasis added by Court). This Court found that “[t]his language defines Scimed’s invention in a way that excludes” an alternative arrangement, and reasoned that this “characterization of the invention cannot reasonably be interpreted as limited to the preferred embodiment ... but is expressly made applicable to ‘all embodiments of the present invention.’” *Id.* at 1343-44.

Finally, the prosecution history also can illuminate proper construction. In some cases, an applicant may clearly disclaim a certain meaning during prosecution. An applicant may make such a disclaimer, for example, to distinguish prior art or otherwise avoid an examiner’s rejection. Whatever the reason, the disclaimer establishes a limitation on the claim at issue. As explained in *Hockerson Halbertstadt, Inc. v. Avia Group International, Inc.*, a court “must” examine the “prosecution history to determine whether the patentee has given the term an unconventional meaning.” 222 F.3d 951, 955 (Fed. Cir. 2000). In *Hockerson*, although the specification supported the ordinary meaning, the prosecution history demonstrated that the applicant had distinguished prior art by disclaiming the ordinary meaning of the term in favor of a narrower, unconventional meaning. *Id.* at 956. By arguing that the invention had a “much

narrower groove,” the inventor had disavowed a groove width greater than that disclosed in the prior art.²

Because this analysis is grounded in objective and publicly available information, it best serves the purposes of a sound claim construction methodology discussed above. Public notice is provided in a manner clear to people knowledgeable in the art. *See Vitronics*, 90 F.3d at 1583 (“competitors are entitled to review the public record, apply the established rules of claim construction, ascertain the scope of the patentee’s claimed invention and, thus, design around the claimed invention”). Similarly, patent holders will be afforded the full benefit of the invention as expressed in the patent and will avoid the risk of an inadvertent loss or waiver of patent rights. Channeling patent disputes into this structure will result in less litigation, more pretrial resolution of patent disputes, and increased predictability in the appellate-review stage.

The approach advocated here is contrary to those decisions of this Court that examine dictionaries prior to the intrinsic record. *See, e.g., Texas Digital Syst., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202-03 (Fed. Cir. 2002) *cert denied*, 538 U.S. 1058 (2003) (looking at dictionaries first). Those decisions are

² *See also Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1477 (Fed. Cir. 1998) (statement made during prosecution “unambiguously indicates” that tray units in a prior art device “are not ‘consoles’ as that term is used in the patent, regardless of the term’s ordinary meaning”); *Day Int’l, Inc. v. Reeves Bros., Inc.*, 260 F.3d 1343 (Fed. Cir. 2001) (prosecution arguments disavowing high temperatures limited the ordinary meaning of a claim that did not explicitly require a low temperature).

inconsistent with the guiding principle articulated in *Vitronics*, and urged here, that a court must examine intrinsic evidence prior to examining extrinsic evidence. *Vitronics*, 90 F.3d at 1582. Furthermore, this approach allows courts to determine who one of ordinary skill in the art is before determining the ordinary meaning of the claims. Similarly, it permits courts to consider whether the patentee has explicitly defined the claim term in the intrinsic record and, thus, obviated the need to resort to extrinsic evidence.

Finally, this methodology closely parallels the established approach to statutory construction. As the Supreme Court emphatically and repeatedly has held, the language of a statute is the first and principal guide to its meaning.

[I]n interpreting a statute a court should always turn first to one, cardinal canon before all others. We have stated time and again that courts must presume that a legislature says in a statute what it means and means in a statute what it says there. When the words of a statute are unambiguous, then, this first canon is also the last: “judicial inquiry is complete.”

Conn. Nat’l Bank v. Germane, 503 U.S. 249, 253-54 (1992) (citations omitted).

B. Step Two: If The Intrinsic Evidence Does Not Provide A Claim Construction, Appropriate Extrinsic Evidence Should Be Considered.

If the intrinsic evidence does not provide a claim construction, appropriate extrinsic evidence should be considered as sources of the term’s ordinary meaning

to one of ordinary skill in the art. Extrinsic evidence typically consists of dictionaries (technical or lay), treatises, prior art, and expert witnesses.

1. Dictionaries, treatises, and prior art.

Because the controlling inquiry is the meaning of the claim to one of ordinary skill in the relevant art, technical dictionaries should be consulted before, and given weight over, lay dictionaries. This certainly is true for technical terms. *See Inverness Medical*, 309 F.3d at 1378. With respect to common terms, general purpose dictionaries may be used (although even here technical dictionaries unexpectedly may shed light). *See id.*

For dictionaries or treatises, care must be taken to look to relevant sources. For example, for an electrical patent, a dictionary or treatise on electrical engineering is more likely to be instructive (and less likely to cause confusion or lead to unsound results) than a book on mechanical engineering. Again, the touchstone is the relevant art. Moreover, because a term's meaning (particularly a technical term) can change over time, the relevant sources are those that provide a meaning of the term as used in the patent, not the meaning that exists at the time the patent is being construed.

From the range of definitions thus obtained, some may be plainly irrelevant to the term and context at issue and therefore can be eliminated. The remaining definitions should be presumed to be valid and applicable. *See Nystrom v. Trex*

Co., 374 F.3d 1105, 1112 n.2 (Fed. Cir. 2004) (“claim terms may be construed to encompass *all* dictionary definitions not inconsistent with the intrinsic record”) (emphasis in original); *Inverness Medical*, 309 F.3d at 1379 (meaning may encompass two relevant alternatives). Significantly, multiple definitions and even contradictory meanings may remain. The fact that cumulative definitions broaden a term’s meaning beyond any single definition, and the fact that competing definitions can not be concurrently applied, are not grounds at this juncture to select one (or some) among the possibilities and hence to narrow the patent. Rather, all relevant definitions should be carried to the next stage of the analysis to be tested against the patent.

Prior art may also be used to determine the ordinary meaning of a term. As described in *Vitronics*, a court has discretion to rely on prior art because such evidence may demonstrate how a disputed term is used by those skilled in the art. *Vitronics*, 90 F.3d. at 1584. However, reliance on prior art is unnecessary, and indeed improper, when the disputed terms can be understood from a careful reading of the intrinsic record. *Id.* at 1584.

Once again, this step in claim construction parallels statutory construction where secondary sources are considered, including history, purpose, and, in particular, dictionaries. *See, e.g., Smith v. United States*, 508 U.S. 223, 233 (1993).

2. Expert witnesses.

Although included in the category of extrinsic evidence, the role of experts presents special concerns. In particular, their use often lends to the much-criticized “battle of the hired experts.” If not appropriately limited, their use contributes nothing – indeed, may be antithetical – to the overarching objectives of public notice, predictability and consistency, and efficient litigation. Accordingly, the trial court should exercise its discretion in light of these considerations to permit expert testimony regarding the understanding of the term to one of ordinary skill in the art and the technical background of the claimed invention.

C. Step Three: The Claim Should Be Construed To Encompass All Relevant Definitions That Are Not Inconsistent With The Patent Or With Applicable Canons of Construction.

At this point one or more possible, relevant ordinary meanings of the claim have been determined. These available definitions should be tested against the patent to ensure consistency with the intrinsic evidence and the given context. Some meanings – even though found in a dictionary and relevant to the patent in question – may be disclaimed or restricted in the claims, its specification, or prosecution history, or otherwise inappropriate and unreasonable in light of such intrinsic record. *See Novartis Pharms. Corp. v. Eon Labs Mfg., Inc.*, 363 F.3d 1306, 1310 (Fed. Cir. 2004) (“[f]or more than 45 years we . . . have looked to the intrinsic record to determine . . . which of the available, relevant definitions should

be applied to the claim term at issue”); *see also Nystrom*, 374 F.3d at 1112 n.2 (“claim terms may be construed to encompass all dictionary definitions not inconsistent with the intrinsic record”) (emphasis omitted).³

This would be the case, for example, where the patent clearly disclaims a relevant dictionary definition. *See Scimed Life Sys.*, 242 F.3d at 1341 (“[w]here specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims . . . might be considered broad enough to encompass the feature in question”). Similarly, even where the patentee makes no explicit disclaimer, some meanings may be clearly inconsistent with the intrinsic record. *See Novartis*, 363 F.3d at 1311 (statement in intrinsic record that “hydrosol” was to be administered by intravenous injection demonstrated that dictionary definition allowing formation of “hydrosol” after ingestion was inappropriate for the claim).

In addition, proper claim construction should take account of applicable interpretive canons. Patents are to be construed, if fairly possible, to avoid invalidity. *See Klein v. Russell*, 86 U.S. 433, 466 (1874); *Wang Labs., Inc. v. America Online, Inc.*, 197 F.3d 1377, 1383 (Fed. Cir. 1999). Furthermore, when

³ This step does not duplicate step one of the analysis. There, the question was whether the patent defines the claim without regard to any other interpretive aids. That is a more exacting inquiry than the one here: whether the patent excludes or limits any definitions derived from extrinsic evidence.

construing claims to preserve validity, a court should take care to give the claim the same meaning for both validity and infringement purposes. Allowing a plaintiff to interpret a claim narrowly to avoid invalidity, but broadly to prove infringement, unfairly gives the plaintiff two bites at the apple. *See Bristol Myers Squibb Co. v. Ben Venue Labs, Inc.*, 246 F.3d 1368 (Fed. Cir. 2001) (“[h]aving construed the claims one way for determining their validity, it is axiomatic that the claims must be construed in the same way for infringement”).

Furthermore, the doctrine of claim differentiation – that claims in a patent should not be interpreted to be redundant – also is a presumptive guide to claim construction. *See Fantasy Sports Props., Inc. v. SportsLine.com, Inc.*, 287 F.3d 1108, 1115-16 (Fed. Cir. 2002).

As above, this approach to claim construction is analogous to statutory interpretation. It is familiar law that a statutory term is to be understood in light of related provisions of the statute. *See Smith v. United States*, 508 U.S. at 233. It equally is settled that statutes are to be construed to avoid absurd results. *See United States v. Turkette*, 452 U.S. 576, 580 (1981). And statutes are to be read not to raise questions of constitutional validity or to render terms redundant or superfluous. *See Jones v. United States*, 526 U.S. 227, 229 (1999); *Gustafson v. Alloyd Co.*, 513 U.S. 561, 574 (1995).

IV. CLAIM CONSTRUCTION GENERALLY IS A QUESTION OF LAW SUBJECT TO *DE NOVO* REVIEW.

In *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), the Supreme Court, in holding that construction of a claim presents a question for the court rather than the jury under the Seventh Amendment, recognized that appellate review of claim construction serves to promote consistency in the interpretation of a claim:

[T]reating interpretive issues as *purely legal* will promote (though it will not guarantee) intrajurisdictional certainty through the application of *stare decisis* on those questions not yet subject to interjurisdictional uniformity under the authority of the single appeals court.

Id. at 391 (emphasis added). In *Cybor Corp. v. FAS Technologies*, 138 F.3d 1448 (Fed. Cir. 1998) (en banc), this Court, relying on *Markman*, held that claim construction is subject to *de novo* review. A dissent in *Cybor* cautioned that *de novo* review would lead to high rates of appellate reversal. Following *Cybor*, similar concerns have continued to be expressed, with some estimates of the rate of appellate reversals on claim construction being as high as 50% (*i.e.*, one out of every two such appeals).

Markman and *Cybor* correctly establish that claim construction is reviewable *de novo* on appeal. That conclusion is consistent with the foregoing analysis and will best achieve the goals of certainty and predictability.

Furthermore, although the present high rate of appellate reversals raises significant and legitimate concerns, it likely is attributable (at least in substantial part) to the imprecise and inconsistent approaches that have governed claim construction to this point. The Court's *en banc* decision in this case should provide a direct and appropriate corrective to this problem. Accordingly, it is unnecessary to depart from *Markman* and *Cybor*, and to distort the conventional appellate principle that *de novo* review applies to questions of law, to reach the salutary policy objective of establishing legal standards that will reduce the high reversal rate in claim-construction cases. *See Salve Regina College v. Russell*, 499 U.S. 225, 231, 240 n. 5 (1991) (*de novo* appellate review applies to questions of state law even if district courts are better able to decide state law; “[i]ndependent appellate review of legal issues best serves the dual goals of doctrinal coherence and economy of judicial administration”).⁴

For these reasons, this Court should decide questions of claim construction *de novo* and not defer to the district court's construction. As with any question of

⁴ Moreover, even were deferential review to promote certainty for the parties *after* the district court's decision, it would do nothing to achieve that end *prior* to such a decision (including prior to the commencement of litigation). Quite the contrary: the range of permissible results that would be sustained under a deferential standard of review would exacerbate the *ex ante* uncertainties. What is more, it would fail to provide a definitive answer to the construction of a claim *ex post*; all that could be said following an affirmance is that the first decision was not an abuse of discretion, not that it was legally correct or that another interpretation at odds with it would not also and equally be within the bounds of allowable fact-finding or discretion.

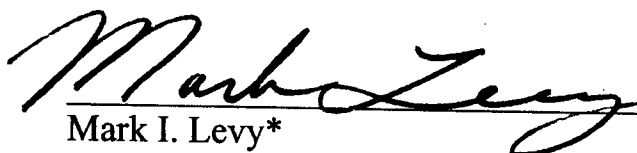
law, however, determinations of fact may be embedded in the lower court's legal conclusion. If so, such factual findings should be reviewed under the usual "clearly erroneous" standard. See Fed. R. Civ. P. 52(a); *Anderson v. City of Bessemer City*, 470 U.S. 564 (1985); *United States v. United States Gypsum Co.*, 333 U.S. 364, 394-95 (1948). In particular, if extrinsic evidence is introduced through live testimony (typically expert witnesses), and if the district court's ruling rests on a finding of fact (including a credibility determination) with respect to that testimony, such a fact-based and case-specific finding should be reviewed for clear error. See *Cybor*, 138 F.3d at 1463 (Bryson, J., concurring); see also *Markman*, 517 U.S. at 388-90 (claim construction will rarely turn on the credibility of experts).

CONCLUSION

The Court should adopt the structured and sequential methodology for claim construction proposed in this brief to promote the fundamental objectives of adequate public notice of claimed inventions, certainty and predictability in the meaning and scope of patents, and efficiency in the resolution of patent disputes.

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Respectfully submitted,



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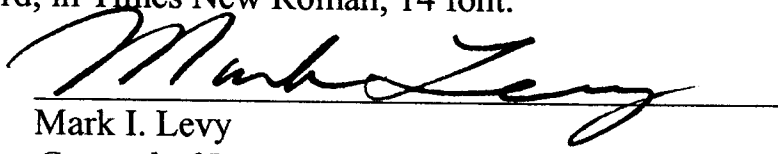
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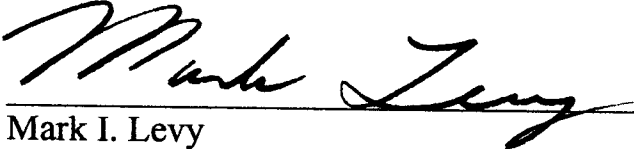
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