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## U.S. Court of Appeals for the Federal Circuit Emphasizes the Patent Specification and De-emphasizes the Use of Dictionaries in Interpreting Patent Claims

In a much anticipated opinion, the Federal Circuit Court of Appeals, presiding en banc, recently pronounced in *Phillips v. AWH Corp.*, No. 03-1269 (Fed. Cir. July 12, 2005) that prior decisions by the court which had emphasized the use of dictionaries in interpreting patent claims were wrong. The dissent described the case as having “whipp[ed] the bar into a frenzy of expectation.”

Prior cases stated that terms used in a patent claim should be interpreted by first looking to the plain and ordinary meanings set forth in dictionaries and the specification would only then be reviewed to determine whether it disavowed one of the dictionary meanings or explicitly defined the terms. The court decided that this prior manner of claim interpretation placed an improper restriction on the role of the specification.

In de-emphasizing the importance of dictionaries, including technical dictionaries, when interpreting terms set forth in patent claims, the court noted that the patent

specification and prosecution history provides a context within which the claim language may be interpreted. Although the court emphasized the need to base claims interpretation more upon the specification and prosecution history, the court declined to describe a “rigid algorithm for claim construction.” Instead, the court noted that its intent was to explain why reliance upon the specification and prosecution history was more important than the use of dictionaries when interpreting terms contained in patent claims.

This decision means that inventors filing patent claims should be more hesitant to assume that a court will interpret a claim term as consistent with the meaning set forth in standard dictionaries. Rather, the language set forth in the specification and the prosecution history will be given greater weight when interpreting the meaning of claim terms. Thus, there will be a greater need for attention to the drafting of the specification portion of patents and to conduct, such as amendments and

PTO communications pertaining to the prosecution history. The specification and prosecution history will become even more significant in claim construction during patent litigation, with claims possibly being limited to the preferred embodiment or by any statement made during prosecution that could impact claim meaning and scope.

The case is also noticeable for the court's handling of the issue of the appellate standard of review for claim

construction; i.e., whether the appellate court should simply substitute its determination of claims construction for the trial court's claims construction when those determinations differ, or whether the appellate court should intervene only when the trial court is clearly in error. After requesting the parties brief this issue, the court declined to address the issue — in effect maintaining prior case law that the appellate court should substitute its determination of claims

construction for the trial court's claim construction when those determinations differ. The dissenting judge strongly attacked the court's position, stating:

Eloquent words can mask much mischief. The court's opinion today is akin to rearranging the deck chairs on the Titanic — the orchestra is playing as if nothing is amiss, but the ship is still heading for Davey Jones' locker.

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