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Comment

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COMMENT

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I. CLAIM CONSTRUCTION

The most pronounced development in the area of claim construction over the past year relates directly to the predictability issue, and perhaps to the reversal rate that has been bandied about in this Symposium. I speak of the Federal Circuit's increased emphasis on the use of dictionaries.

Mr. Filardi mentioned dictionary usage as one of the canons of claim construction.¹ While dictionaries have always been a resource available for claim construction, they have recently gone to the head of the class in terms of their importance in construing claims. The reason for this may be the lack of predictability experienced in recent years with respect to claim construction. For example, many practitioners had been frustrated by the Federal Circuit's "single embodiment" cases, which arguably created uncertainty concerning whether one was improperly reading limitations in from the specification, as opposed to just interpreting the claim term in light of the specification.

Whatever the reason may be, this past year has seen a number of cases, starting with *Texas Digital Systems, Inc. v. Telegenix, Inc.*,² in which the Federal Circuit has tried to lay down very clear rules about what needs to be done to interpret claims. The *Texas Digital* decision says you go to the dictionary and look up the word.³ You get the dictionary definition first, and *then* go to the specification. In other words, you go to the dictionary after you read the claim, and then you look in the specification to see if

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¹ Edward V. Filardi & Mark D. Baker, *The Past, Present, and Future of the Federal Circuit: Practitioner Perspectives on the Law of Inequitable Conduct, Claim Construction, and the Doctrine of Equivalents*, 54 CASE W. RES. L. REV. 823, 825 (2004).

² 308 F.3d 1193 (Fed. Cir. 2002).

³ *Tex. Digital Sys. Inc.*, 308 F.3d at 1202-03 (explaining how dictionaries are useful tools to aid courts' interpretations of claim meanings).

there is any special definition that would moot the dictionary definition. If there is no special definition, you look to see if the usage of the term in the specification is inconsistent with one or more of the definitions that you found. If the usage of the term is inconsistent with a particular definition, you toss it out. Otherwise, you use that definition. And cases like *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, which came out last summer, say that it is okay to use more than one definition from the dictionaries if they are all consistent with the specification of the patent.⁴

Some things stand out about this trend toward heavy reliance on dictionaries. First, it seems that dictionaries are frequently consulted in litigation for relatively simple terms that litigants thought they understood at the outset. Commonly, the disputed term is not one for which you would ordinarily go to a dictionary to understand. It is not “reverse transcriptase,” or “polymerase chain reaction,” or some other highfalutin’ technical term you read and do not understand. Rather, disputes are over terms like “lock,” or “fasten,” or “control.” I have even seen litigants refer to dictionary definitions of “the” or “said”: These are all words you think you understand but about which the parties may have a dispute regarding the meaning in a particular context in a particular claim.

Second, no particular dictionaries are sanctioned by the court. You can use a variety of them. It seems that Webster’s Third New International Dictionary (various editions) enjoys some favor, and is frequently relied on by the court.⁵ The American Heritage Dictionary is also fine.⁶ It is fine to use a technical dictionary, although it is not frequently used for common, non-technical terms. For example, a technical dictionary might not be the appropriate dictionary in which to look up the word “lock.”

Any litigator going into a *Markman*⁷ hearing would be remiss not to be armed with the dictionary definition they want to have. If you do not have one, be advised that your opposition will, and he or she is going to get the definition they want. And you do not want to go up on appeal without having cited the dictionary. If you do, the Federal Circuit may, on its own, pull a dictionary off the shelf and use it, which it is not restricted from doing for the first time during the appeals process.

⁴ 334 F.3d 1294, 1300 (Fed. Cir. 2003).

⁵ WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY (various editions); see *Abbott Labs. v. Syntron Bioresearch, Inc.*, 334 F.3d 1343, 1350 (Fed. Cir. 2003); *Optical Disc Corp. v. Del Mar Avionics*, 208 F.3d 1324, 1335 (Fed. Cir. 2000).

⁶ THE AMERICAN HERITAGE DICTIONARY (4th ed. 2001); see *Masco Corp. v. United States*, 303 F.3d 1316, 1323 (Fed. Cir. 2002).

⁷ *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 387-88 (1996).

One recent exception to this dictionary trend is the *Alloc* case, which Mr. Filardi mentioned in his remarks. In *Alloc*, the Federal Circuit found that a special definition (not a dictionary definition) applied to the term in question. The striking thing, however, was that the specification did not clearly set forth a special definition.⁸ When you think of a special definition, you think of something like the specification saying, "as used herein the term 'nucleotide' means RNA, DNA, and so on," or something such as that. But in *Alloc*, there was no "as used herein" statement;⁹ it was more nebulous than that. The point is that the *Alloc* case muddies the water as to when a special definition in the specification trumps the dictionary, and litigants will cite *Alloc* most commonly when they want to narrow a claim term to the specific embodiment shown in the patent.

From my perspective, the heightened emphasis on the use of the dictionary is a development that will favor broad claim construction, which is to say it will generally be favorable for plaintiffs. In addition to the need for predictability, it may be that this trend is a reaction to the decreased availability of the doctrine of equivalents. There is no doubt that any litigator would rather not be relying on the doctrine of equivalents when going into court. There is so much baggage on the doctrine, and a patent owner would really rather have a literal infringement position. The dictionary may be the litigator's best tool for getting the broadest construction possible, and he or she may not be able to go much beyond that using the doctrine of equivalents.

Looking forward, one question I would like to see answered is: Will this trend bring about more predictability? And, if past practice is any prelude to the future, maybe it will not. A second question that should be considered is whether this is a favorable trend for plaintiffs. My opinion is that it will be generally favorable for patent plaintiffs, but only time will tell.

II. THE DOCTRINE OF EQUIVALENTS

The most significant limitation on the doctrine of equivalents emerging in the past five years has not been *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*,¹⁰ particularly since there is no longer a complete bar. Instead, the most significant devel-

⁸ *Alloc, Inc. v. Int'l Trade Comm'n*, 342 F.3d 1361, 68 U.S.P.Q.2d (BNA) 1161 (Fed. Cir. 2003).

⁹ *Id.* at 1166-67.

¹⁰ (*Festo IX*) 344 F.3d 1359 (Fed. Cir. 2003) (This is the most recent of the *Festo* decisions).

opments have involved the so-called “all elements rule” and the “claim vitiation” doctrine. This is a doctrine that is asserted in every instance that a patent owner relies on the doctrine of equivalents. There is virtually no circumstance under which the claim vitiation doctrine will not be asserted by a defendant responding to an equivalents allegation.

The doctrine stems from the *Pennwalt Corp. v. Durand-Wayland, Inc.* case in 1987,¹¹ although that case did not talk about it in precisely these terms. *Pennwalt* initiated the All Elements Rule, which says when you are applying the doctrine of equivalents, you have to do the analysis on an element-by-element basis, not just for the accused device or invention as a whole. In other words, you have to argue that some specific element in the accused device is equivalent to a specific element that is literally claimed, but not literally present in the device.¹² That principle has been expanded through a number of cases—*Sage Products, Inc. v. Devon Industries, Inc.*,¹³ *Moore U.S.A., Inc. v. Standard Register Co.*,¹⁴ *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*,¹⁵ and a host of others—into something that is much more difficult to understand and apply, and is certainly much less predictable, than estoppel.

In *Moore v. Standard Register*, the claim at issue involved an envelope that had to have an adhesive around the “majority” of a margin. The accused product had adhesive around forty-eight or forty-nine percent of the margin. The plaintiff argued that it was the equivalent of a majority, and there was no prosecution history of estoppel. The Federal Circuit, however, said that the plaintiff’s equivalents argument was wrong because it would result in vitiation of the element.¹⁶ In essence, the plaintiff’s interpretation would have meant that a minority was the equivalent of a majority, and thus a limitation would have been read out of the claim.

Arguably, however, any time the doctrine of equivalents is applied, one is reading a limitation out of the claim. That is why you are applying the doctrine—it’s because the device does not literally contain the element. Thus, every time the doctrine of equivalents is used, an argument is made that it cannot be asserted against the accused device because it would be vitiating the claim element.

¹¹ 833 F.2d 931 (Fed. Cir. 1987).

¹² *Id.* at 935-36.

¹³ 126 F.3d 1420 (Fed. Cir. 1997).

¹⁴ 229 F.3d 1091 (Fed. Cir. 2000).

¹⁵ 242 F.3d 1337 (Fed. Cir. 2001).

¹⁶ 229 F.3d at 1106.

There is a good article in the Federal Bar Journal from a few years ago that tracks the usage of the doctrine of claim vitiation.¹⁷ There is considerable variability in its application at the Federal Circuit. The authors in that article categorize how different judges on the court apply the doctrine.¹⁸ The authors also offer their own unification theory for that doctrine.¹⁹ In the years to come, it may well be that this doctrine will have more impact than *Festo* on how and when the doctrine of equivalents may be applied in patent litigation.

¹⁷ Daniel H. Shulman & Donald W. Rupert, "Vitiating" the Doctrine of Equivalents: A New Patent Law Doctrine, 13 FED. CIR. B.J. 457 (2003).

¹⁸ *Id.* at 464-82.

¹⁹ *Id.* at 482-88.

