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PAGE 1

Canons of Patent Claim Construction

PAGE 9

Avoiding Infringement of United States Patents Through Foreign Acts

PAGE 12

Innovating from Pumps to Genes into the "Nano-Dimension"

PAGE 18

PIPLA's 2004 Judge's Dinner

PAGE 20

PIPLA Committees

PAGE 21

Upcoming Intellectual Property Events 2005

Canons of Patent Claim Construction

By KEVIN R. CASEY

There are many rules or "canons" stated in treatises and in judicial opinions providing direction for proper patent claim construction. The U.S. Court of Appeals for the Federal Circuit continually states these canons and attempts to apply them in a consistent fashion. Unfortunately, although the canons are the tools of the claim construction trade, the degree of utility provided by the canons as devices to resolve claim ambiguity is questionable. So questionable, in fact, that the Federal Circuit has decided to reconsider its approach to patent claim construction.¹

I. INTRODUCTION

The purpose of this article is to provide context for the Federal Circuit's pending en banc decision on patent claim construction in *Phillips v. AWH Corp.*, Appeals No. 03-1269 and No. 03-1286 (Fed. Cir. 2004). More particularly, the article focuses on where we are and why the Federal Circuit may believe that an en banc decision is needed to resolve the confusion and uncertainty now inherent in patent claim construction analyses. Toward that end, the article sets the stage by summarizing the importance of claim construction and warming up with what we DO know about claim construction. The "meat" of the article focuses on the five C's (alliteration at its best!) and what might be viewed as the crux of confusion, namely the competing and often inconsistent canons of claim construction. Finally, the conclusion provides a transition for future consideration of the *Phillips* decision when it is published.

II. WHY IS *PHILLIPS* IMPORTANT?

Why is *Phillips* important, warranting our attention? There are at least two reasons.

A. First, claim construction is the critical first step of any patent case. A basic principle of patent law is that the claim language defines the scope of the exclusive rights granted by the patent statute.² With respect to patentability, validity, and infringement, the Federal Circuit has quipped, "the name of the game is the claim."³ It is also well recognized that the construction of the claims may resolve some or all of the issues in a case.⁴ Finally, claim construction is "the central issue of nearly every patent appeal."⁵

B. Second, the law is extraordinarily unclear on the issue of claim construction and, therefore, in need of revision. Many federal jurists have ranked the issue as among the most challenging faced by the federal bench. The famous U.S. Supreme Court quotation from 1886 in *White v. Dunbar*, referring to claims as “like a nose of wax,” illustrates this point:

Some persons seem to suppose that a claim in a patent is like a nose of wax, which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim; but not for the purpose of changing it, and making it different from what it is. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of this court that it is unnecessary to pursue the subject further.⁶

Perhaps more important, the Federal Circuit itself just recently noted its “complex and inconsistent” precedent regarding patent claim construction.⁷

III. WHAT DO WE KNOW ABOUT CLAIM CONSTRUCTION?

As a quick warm-up, let’s consider briefly some canons or principles of claim construction that appear largely uncontroversial.

A. Whatever the claim construction, it must be consistently applied to the issues of patentability, infringement, and validity.⁸

B. A claim term must be interpreted consistently in all claims.⁹ Consider the converse: “[W]hen an applicant uses different terms in a claim it is permissible to infer that he intended his choice of different terms to reflect a differentiation in the meaning of those terms.”¹⁰

C. During prosecution in the U.S. Patent and Trademark Office (PTO), claims are given their broadest possible interpretation because the applicant is free to amend the claims.¹¹

D. Exercise caution when referring to the opinion of an earlier court decision to interpret a patent claim term. For example, the meaning of a claim term “may not have been stagnant between” an earlier case or application and the present case or application.¹²

E. Patent claim interpretation is a question of law exclusively for the court (not a jury) to decide; it is reviewed *de novo* on appeal.¹³ But note the long line of pre-*Markman* cases holding that claim construction may have underlying factual questions left to the trier of fact.¹⁴

IV. THE CRUX of CONFUSION: CANONS of CLAIM CONSTRUCTION (THE FIVE C’s)

When it comes to presenting a proposed claim construction in court, there is an accepted conventional vocabulary. The parties and the court strive to reach the “correct” claim construction using an established set of rules or “canons” of construction stated in treatises and in judicial opinions. The canons are designed to provide guidance for proper patent claim construction. The Federal Circuit continually states these canons and attempts to apply them in a consistent fashion.¹⁵ Unfortunately, although the canons are the tools of the claim construction trade, their ability to resolve claim ambiguity is questionable.

Why are these canon-tools problematic? As with many legal points, there are often two opposing views on how properly to construe a claim limitation. Each view will undoubtedly be supported by one of two opposing canons. Every lawyer must be familiar with all of the canons, because they are the required tools of argument.

Summarized below are about twenty of the competing, often opposing canons. For each canon, provided is an example case or two applying the canon to interpret a claim. Also listed, however, are a countervailing case or two that refused to apply that canon—instead choosing to apply a different canon. In short, the courts engage in point-counterpoint applications of the canons.

Canon A. *Claims must be construed at the time of the invention.*

True: Smith-Kline Beecham Corp. v. Apotex Corp., 365 F.3d 1306, 1313 (Fed. Cir. 2004) (“Claim

interpretation requires the court to ascertain the meaning of the claim to one of ordinary skill in the art at the time of the invention.”).

v.

False: Historically, courts have stated that the appropriate time frame for claim interpretation is one of three events: (1) the date of invention, (2) the date of filing the patent application, and (3) the date the patent issues. *See, e.g., Inverness Medical Switzerland GmbH v. Warner Lambert Co.*, 309 F.3d 1373, 1378 at n.2 (Fed. Cir. 2002) (“Our decisions have not always been consistent as to whether the pertinent date is the filing date of the application or the issue date of the patent.”).

One important consequence of fixing the time frame for claim interpretation is that the court may refuse to consider information published after that time frame when interpreting the claim.

Canon B. *Claims must be construed to give limitations their “ordinary meaning” as understood by an artisan.*

True: “We note also here that when we, the district courts, and parties refer to the ‘ordinary meaning’ of a claim term, such references are ‘short-hand’ for the appropriate connotation under the law: the meaning, to a person of ordinary skill in the art.” *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed.Cir. 2002).

v.

False: The patentee may override the “ordinary meaning” and a court may restrict the ordinary meaning of a claim term in one of at least four ways. *Alloc, Inc. v. Int’l Trade Comm’n*, 342 F. 3d 1361, 1368 (Fed. Cir. 2003).

First, a claim term will not receive its ordinary meaning if the patentee acted as a lexicographer and clearly set forth a definition of the disputed term in either the specification or prosecution history.

Second, a claim term also will not receive its ordinary meaning if the term “chosen by the patentee so deprives the claim of clarity” as to require resort to other intrinsic evidence for a definite meaning.

Third, if the patentee phrased a claim term in means-plus-function format, the term will only cover the corresponding structure disclosed in the specification, as well as equivalents thereto.

Finally, a claim term will not carry its ordinary meaning if the intrinsic evidence (e.g., specification, prosecution history) shows that the patentee limited the claim scope via “disclaimer” or “disavowal.”

The evidence used in claim construction falls into three categories:

1. Intrinsic = Other claims, specification, prosecution history;
2. Intermediate = Dictionaries, treatises, encyclopedias; and
3. Extrinsic = Uncited prior art, expert testimony.

Canon C. *Claim construction begins with dictionary, encyclopedia, and treatise definitions.*

True: Texas Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193, 1204 (Fed. Cir. 2002), *cert. denied*, 538 U.S. 1058 (2003). Start first by determining the ordinary meaning for claim terms, as defined by dictionaries, encyclopedias, and treatises extant at the time the patent issued. The Federal Circuit admonished against resort to the specification and prosecution history (the “intrinsic evidence”) “as a threshold step in the claim construction process, before any effort is made to discern the ordinary and customary meanings attributed to the words themselves, [because that] invites a violation of our precedent counseling against importing limitations into the claims.”

v.

False: In *Irdeto Access, Inc., v. Echostar Satellite Corp.*, 383 F.3d 1295, 1299-1300 (Fed. Cir. 2004), the Federal Circuit stated: “Claim construction analysis begins with the intrinsic evidence.” In most situations (other situations “will rarely, if ever, occur”), an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term. In such circumstances, it is improper to rely on extrinsic evidence; when the patent documents (which are part of the public record relied upon by members of the public) are unambiguous, extrinsic evidence regarding the meaning of a claim is entitled to no weight. Prior art documents and dictionaries are more objective and reliable guides than, and are to be preferred over, opinion

testimony. Moreover, extrinsic evidence that is inconsistent with intrinsic evidence should be accorded no weight. Distinguish the court's reliance on extrinsic evidence to help it to understand the underlying technology from reliance on such evidence to interpret claims. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). *Digital Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1335, 1344 (Fed. Cir. 1998) ("If upon examination of this intrinsic evidence the meaning of the claim language is sufficiently clear, resort to 'extrinsic' evidence, such as treatises and technical references, as well as expert testimony when appropriate, should not be necessary.").

OR

In *Gemstar-TV Guide Int'l, Inc. v. ITC*, 383 F.3d 1352 (Fed. Cir. 2004), the Federal Circuit provided the following instruction. Consider first whether the claim term has an ordinary, accepted meaning to an artisan. If so, consult intermediate references (e.g., dictionaries); if not, rely on the intrinsic evidence. If there is an ordinary meaning in the dictionary, adopt that meaning unless the specification or prosecution history overrides it by showing a disclaimer or lexicography. Alternatively, if there is no accepted ordinary meaning per the dictionary, the interpreter must derive the meaning from the intrinsic evidence.

Canon D. *Dictionaries, treatises, and encyclopedias are critical to claim construction.*

True: Texas Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193 (Fed. Cir. 2002) (dictionaries elevated to primary resource for proper claim interpretation).

v.

False: Digital Biometrics, Inc. v. Identix, Inc. 149 F.3d 1335, 1346 (Fed. Cir. 1998) ("Because the intrinsic record is clear we do not give weight to an inconsistent dictionary definition" in construing patent claims.); *Renshaw PLC v. Marposs Societa Per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998) (quoting *Liebscher v. Boothroyd*, 258 F.2d 948, 951 (CCPA 1958), "Indiscriminate reliance on definitions found in dictionaries can often produce absurd results."); *AFG Indus., Inc. v. Cardinal IG Co.*, 239 F.3d 1239, 1247 (Fed. Cir. 2001) ("This court has repeatedly cautioned against using non-scientific dictionaries for defining technical terms;" finding that district court erred in claim interpretation, by relying on dictionary definition, and vacating decision).

Canon E. *The doctrine of claim differentiation applies to presume a difference in meaning and scope when different words or phrases are used in separate claims.*

True: Comark Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1187 (Fed. Cir. 1998) (invoking doctrine to support claim interpretation; although "the doctrine of claim differentiation is not a hard and fast rule of construction, it does create a presumption that each claim in a patent has a different scope").

v.

False: Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc., 246 F.3d 1368, 1376 (Fed. Cir. 2001) ("We decline to blindly apply the doctrine in this case to supplant other canons of claim construction that compel our conclusion that [the claims] have identical scope...."; even two independent claims can have identical scope).

Canon F. *Preamble terms do not constitute claim limitations.*

True: A preamble term may or may not be interpreted as a claim limitation; the decision is made case-by-case depending upon whether the preamble language is "necessary to give life, meaning and vitality" to a claim. "Generally, the preamble does not limit the claims." *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1346 (Fed. Cir. 2002) (holding preamble terms at issue not to constitute limitations).

v.

False: In *Catalina Marketing Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808-10 (Fed. Cir. 2002), the Federal Circuit summarized the law governing when the preamble of a claim constitutes a limitation rather than a non-limiting statement of purpose or intended use. The court listed the following guideposts indicating that a part of the preamble is a claim limitation: (1) the preamble of a Jepson claim generally limits claim scope; (2) dependence on a particular disputed preamble phrase for antecedent basis in the claim body

generally limits claim scope; (3) when the preamble is essential to understand limitations or terms in the claim body, the preamble limits claim scope; (4) a preamble term underscored as important by the specification operates as a claim limitation; and (5) reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation.

Canon G. *Limitations may not be read into the claims from the specification.*

True: “We recognize that there is sometimes a fine line between [properly] reading a claim in light of the specification, and [improperly] reading a limitation into the claim from the specification.” *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1187 (Fed. Cir. 1998).

But: *Phillips v. AWH Corp.*, 363 F.3d 1207 (Fed. Cir. 2004) (claim limitation reciting “comprising internal steel baffles extending inwardly from the steel shell walls” interpreted to mean baffles angled at other than 90° despite absence from such language in the claim); *Innovad Inc. v. Microsoft Corp.*, 260 F.3d 1326 (Fed. Cir. 2001) (expressly recognizing that limitations cannot be read into the claims from the specification, yet interpreting “dialer” claim term of patent to exclude a dialer with a keypad, because specification emphasized that dialer did not include keypad, and therefore affirmed summary judgment of no infringement by devices with a keypad); *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359 (Fed. Cir. 2002) (When the patent specification describes the particular claim structure at issue in a patent infringement suit as “important to the invention,” the claim term may be interpreted as limited to the structure described in the specification and shown in the patent drawing.).

Canon H. *Claims may not be construed so as to read an express limitation out of the claims.*

True: *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 29 (1997) (“It is important to ensure that application of the doctrine [of equivalents], even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety.”).

But: *Ericsson, Inc. v. Harris Corp.*, 352 F.3d 1369 (Fed. Cir. 2003) (reversing district court grant of JMOL of non-infringement because district court erred in determining that a finding of infringement would vitiate a claim limitation).

Canon I. *Claims must be construed to cover preferred embodiments.*

True: *National Steel Car, Ltd. v. Canadian Pacific Railway, LTD.*, 357 F.3d 1319, 1336 n.19 (Fed. Cir. 2004) (“Claim interpretations that do not read on the preferred embodiment are ‘rarely, if ever correct and would require highly persuasive evidentiary support.’”).

v.

False: *Elekta Instrument S.A. v. O.U.R. Scientific Int’l, Inc.*, 214 F.3d 1302 (Fed. Cir. 2000) (claim construction adopted that excluded the preferred and only embodiment disclosed in the specification).

Canon J. *Claims must be interpreted to uphold their validity.*

True: “This Court has frequently alluded to the ‘familiar axiom that claims should be so construed, if possible, as to sustain their validity.’”

False: “At the same time, however, the court has ‘admonished against judicial rewriting of claims to preserve validity.’” “[T]he canon that claims should be construed to preserve their validity, if possible, applies only if the scope of the claims is ambiguous. The asserted claims at issue in this case [are clear and not ambiguous]. We therefore may not interpret the claims narrowly because of concerns about their possible invalidity. Rather, the issue of invalidity must be addressed head-on in the remand proceedings....” *Liebe-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 911, 914 (Fed. Cir. 2004) (same case for both statements).

Canon K. *Inventor testimony is helpful to claim construction.*

Perhaps: *Voice Technologies Group, Inc. v. VMC Systems, Inc.*, 164 F.3d 605, 615 (Fed. Cir. 1999)

(statement in *Markman* “that ‘the subjective intent of the inventor when he used a particular term is of little or no probative weight in determining the scope of a claim’ ... does not disqualify the inventor as a witness, or overrule the large body of precedent that recognizes the value of the inventor’s testimony.... An inventor is a competent witness to explain the invention and what was intended to be conveyed by the specification and covered by the claims.”).

Canon L. *Expert testimony on claim construction is impermissible.*

True: *Bell & Howell Document Management Prods. Co. v. Altek Sys.*, 132 F.3d 701 (Fed. Cir. 1997) (citing *Vitronics* extensively and reversing district court because court erred in relying on expert testimony when claims were unambiguous in view of intrinsic evidence).

v.

False: *Kumar v. Ovonic Battery Co.*, 351 F.3d 1364, 1372 (Fed. Cir. 2003) (given that none of the primary claim interpretation sources provided a clear definition of a term, the Federal Circuit “conclude[d] that testimony from those skilled in the art is *required* to establish the meaning of the term”) (emphasis added).

OR

“[T]rial courts generally can hear expert testimony for background and education on the technology implicated by the presented claim construction issues, and trial courts have broad discretion in this regard.” *Key Pharmaceuticals v. Hercon Laboratories Corp.*, 161 F.3d 709, 716 (Fed. Cir. 1998).

Canon M. *Drawings are highly relevant to claim construction.*

True: “[T]he patent drawings are highly relevant in construing the ... limitations of the claims.” *CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146, 1153 (Fed. Cir. 1997).

v.

False: *Gart v. Logitech, Inc.*, 254 F.3d 1334, 1342 (Fed. Cir. 2001) (“drawings are not meant to represent ‘the’ invention or to limit the scope of coverage defined by the words used in the claims themselves”).

Canon N. *The title is highly relevant to claim construction.*

True: *Poly-America, L.P. v. GSE Lining Tech., Inc.*, 383 F.3d 1303, 1310 (Fed. Cir. 2004) (using the title to find that a term in the preamble constitutes a claim limitation).

v.

False: *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1312 (Fed. Cir. 1999) (“The near irrelevancy of the patent title to claim construction is further demonstrated by the dearth of case law in which the patent title has been used as an aid to claim construction.”).

Canon O. *The abstract is highly relevant to claim construction.*

True: The Federal Circuit used the patent abstract to support its claim construction in *Hill-Rom Co. v. Kinetic Concepts, Inc.*, 209 F.3d 1337, 1341 n.* (Fed. Cir. 2000) (citing other Federal Circuit cases that have used the patent abstract to interpret claims).

v.

False: *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1121 (Fed. Cir. 2004) (“While a statement in the Abstract may operate as a clear expression of manifest exclusion, for several reasons, this statement does not. Nor does this statement weigh heavily when considering whether the applicant has acted as his own lexicographer. To begin, this statement is in the Abstract of the patent. This section of a patent speaks generally to the invention and, much like the syllabus of an opinion, sets forth general information about the document’s content, which is described in more detail in the remainder of the document.”).

Canon P. *An Examiner’s statements do not limit claim construction.*

True: “We note that statements made by an examiner will not necessarily limit a claim.” Limiting state-

ments made by an examiner may be ignored when such limitations are not present in the claim language. *The Dow Chemical Co. v. Sumitomo Chemical Co.*, 257 F.3d 1364, 1382 (Fed. Cir. 2001).

v.

False: On the other hand, “failure to object to an examiner’s interpretation of a claim ordinarily disclaims a broader interpretation.” *Inverness Medical Switzerland GmbH v. Warner Lambert Co.*, 309 F.3d 1373, 1380 (Fed. Cir. 2002).

Canon Q. “Whereby” clauses do not constitute claim limitations.

True: *Lockheed Martin Corp. v. Space Sys./Loral, Inc.*, 324 F.3d 1308, 1319 (Fed. Cir. 2003) (“a whereby clause that merely states the result of the limitations in the claim adds nothing to the substance of the claim.”).

v.

False: *Scheinman v. Zalkind*, 112 F.2d 1017, 1019 (CCPA 1940) (whereby clause that sets forth a structural limitation and not merely the results achieved by the claimed structure is a positive limitation of the claim).

Canon R. Errors during prosecution may be ignored when interpreting claims.

True: *Storage Technology Corp. v. Cisco Sys., Inc.*, 329 F.3d 823, 832 (Fed. Cir. 2003) (“The applicants’ inaccurate statement [made during prosecution] cannot override the claim language itself, which controls the bounds of the claims.”).

v.

False: *Viskase Corp. v. American National Can Co.*, 261 F.3d 1316 (Fed. Cir. 2001) (refusing to disregard attorney’s statement made during prosecution as error, when interpreting claims).

Canon S. Ties require a narrow claim interpretation.

True: “Where there is an equal choice between a broader and a narrower meaning of a claim, and there is an enabling disclosure that indicates that the applicant is at least entitled to a claim having the narrower meaning, we consider the notice function of the claim to be best served by adopting the narrower meaning.” *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1581 (Fed. Cir. 1996).

v.

False: *Housey Pharmaceuticals, Inc. v. Astrazeneca UK Ltd.*, 366 F.3d 1348, 1356 (Fed. Cir. 2004) (party citing *Athletic Alternatives* for the proposition that in the event of a tie between a broader and narrower meaning, the notice function of patent law requires that the narrower meaning prevails misreads *Athletic Alternatives*; “In that unusual case, one patent applicant made two *contradictory* and *irreconcilable* affirmative representations of the contested limitation. In those circumstances, we held that the narrower interpretation trumps the broader interpretation. In this case, there are no contradictory and irreconcilable choices for the meaning of [the claim term].”).

V. CONCLUSION

Basically, the problem with claim construction might be viewed as analogous to Newtonian physics: for every action, there is an equal and opposite reaction. In context, for every canon, or principle of claim construction, there is an equal and opposite canon or principle. The patent bar cannot know which canon will prevail in any given case and perhaps more important, nor can district courts. The reversal rate on claim construction at the Federal Circuit is about 50%, and hence, there is no doubt that there is a need for clarification. All hope to get such clarification from the Federal Circuit in the *Phillips* case.



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¹ The patent bar awaits expectantly the Federal Circuit's pending en banc decision on patent claim construction following the court's July 21, 2004 order in *Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004).

² *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1552 (Fed. Cir. 1998).

³ *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998).

⁴ "[T]he central issue in this appeal—as is often the case in patent appeals in the wake of *Markman*, 52 F.3d at 989 (Mayer, J., concurring) (“[T]o decide what the claims means is nearly always to decide the case.”)—is the district court's claim interpretation.” *Eastman Kodak Co. v. The Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1552 (Fed. Cir. 1997).

⁵ *Minco, Inc. v. Combustion Eng'g, Inc.*, 95 F.3d 1109, 1114 (Fed. Cir. 1996).

⁶ *White v. Dunbar*, 119 U.S. 47, 51-52 (1886) (cited in *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1116 (Fed. Cir. 2004)).

⁷ “The district court's lengthy and careful opinions relied extensively on our recent case law [on patent claim construction], which is unfortunately complex and inconsistent.” *Astrazeneca AB v. Mutual Pharmaceutical Co.*, 384 F.3d 1333, 1336 (Fed. Cir. 2004).

⁸ *Southwall Tech., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir.) (“Claims may not be construed one way in order to obtain their allowance and in a different way against accused infringers.”), *cert. denied*, 516 U.S. 987 (1995).

⁹ *Digital Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1335, 1345 (Fed. Cir. 1998).

¹⁰ *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1120 (Fed. Cir. 2004) (Nevertheless, “we must conclude that this is simply a case where the patentee used different words [“connected” and “associated”] to express similar concepts, even though it may be confusing drafting practice.”).

¹¹ *In re Graves*, 69 F.3d 1147, 1152 (Fed. Cir. 1995). Product-by-process claims are a possible exception. The PTO construes the product as not limited to the process stated in the claim for purposes of patentability. Essentially, the PTO treats product-by-process claims as product claims. In court, however, process terms in product-by-process claims serve as limitations for determining infringement and validity. *Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 846-47 (Fed. Cir. 1992) (perhaps overruling *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991), on that point).

¹² *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1257 (Fed. Cir. 2004).

¹³ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970-71, 979 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996).

¹⁴ See, e.g., *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985); *McGill Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir. 1984).

¹⁵ In *Reznord Corp. v. The Lairum Corp.*, 274 F.3d 1336, 1341 (Fed. Cir. 2001) (emphasis added), the Federal Circuit stated: “Cases presenting issues of claim interpretation are often close. When words in claims have more than one possible meaning, our canons of claim interpretation are the tools that permit resolution of disputes as to the correct meaning of claim language.”