

**From: Brief For the United States as Amicus Curiae
in Appeal Nos. 03-1269, -1286
Phillips v. AWH Corp.**

2001), claims can only be construed to preserve their validity where the proposed claim construction is practicable, is based on sound claim construction principles, and does not revise or ignore the explicit language of the claims.

Finally, if a disputed term lacks a customary meaning, and was essentially created by the patentee (but not defined in the specification or prosecution history), its meaning should be derived from the context of the patent, but construed narrowly against the patent drafter, in view of the patentee's failure in his obligation to clearly define the term. See J.T. Eaton & Co. v. Atl. Paste & Glue Co., 106 F.3d 1563, 1568 (Fed. Cir. 1997). As this Court has stated, [w]here 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 the narrower meaning, we consider the notice function of the claim to be best served by adopting the narrower meaning. See Athletic Alternatives, Inc. v. Prince Mfg., Inc., 73 F.3d 1573, 1581 (Fed. Cir. 1996).

III. The Tension Between Proper Use of the Specification and Improper Reading in of Limitations

Our second issue—how the specification should properly be used to interpret claims without impermissibly importing limitations into the claims—relates to this Court's question (3). As this Court noted in Markman, [t]he written

description part of the specification itself does not delimit the right to exclude. That is the function and purpose of claims. 52 F.3d at 980. The Texas Digital court's motivation for advocating starting with dictionaries rather than the intrinsic evidence was the frequent mistake of impermissibly importing limitations from the specification. See Texas Digital, 308 F.3d at 1204. Despite the government's recommendation to scale back the use of dictionaries as the baseline for claim meaning, the government, like Texas Digital, recognizes that courts conducting claim construction face a great challenge navigating the shoals between properly relying on the specification and going too far and improperly importing limitations from it. Fairness and the public notice function of the patent law require courts to afford patentees the full breadth of clear claim language, and bind them to it as well. Tate Access Floors, Inc. v. Interface Architectural, 279 F.3d 1357, 1367 (Fed. Cir. 2002). Typically, these competing policy concerns form the tension behind a determination whether to limit or broaden a claim term in view of the specification, even where the specification has not explicitly defined the term.

Recently, in Liebel-Flarsheim, 358 F.3d at 904, Judge Bryson described the fine line between the competing axioms that claims be read in view of the specification, and that limitations not be imported from the specification into the claims. He aptly observed that [a]lthough parties frequently cite one or the other

of these axioms to us as if the axiom were sufficient, standing alone, to resolve the claim construction issues we are called upon to decide, the axioms themselves seldom provide an answer, but instead merely frame the question to be resolved.

Id.

Additional guidance by this Court on the issue could assist the district courts in resolving this tension. As a general matter, courts should be less inclined to infer a more narrow definition of a disputed claim term from the specification if a person of ordinary skill in the art would consider the feature relied on from the specification exemplary or insignificant to the essence or primary purpose of the invention. As this Court in Alloc phrased it, the balance between construing in light of the specification and impermissibly importing limitations, turns on how the specification characterizes the claimed invention. 342 F.3d at 1370. This Court has attempted to interpret claims to encompass a feature that the specification describes as essential to the invention, or that the specification used to distinguish the prior art. For example, in SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc., 242 F.3d 1337, 1344 (Fed. Cir. 2000) and in Wang Labs. v. America Online, Inc., 197 F.3d 1377, 1384 (Fed. Cir. 1999), this Court held that claims cannot be construed as encompassing prior art that was distinguished in the specification and disclaimed during prosecution. Toro Co. v.

White Consolidated Indus., 199 F.3d 1295, 1301 (Fed. Cir. 1999) illustrates a claim interpretation consistent with a feature emphasized in the specification as important to the invention.

A merely exemplary feature, because of its *exemplary* status, should not be read into claims whose words do not include that feature. By way of illustration, where the specification describes a feature, not found in the words of the claims, only to fulfill the statutory best mode requirement, the feature should be considered exemplary, and the patentee should not be unfairly penalized by the importation of that feature into the claims. A person of ordinary skill may also consider a feature merely exemplary where nothing in the written description indicates that the invention is exclusively directed toward the feature or suggests that embodiments without it are outside the scope of the invention. Sunrace Roots Enter. Co. v. SRAM Corp., 336 F.3d 1297, 1305 (Fed. Cir. 2003). However, if the specification as a whole suggests that the very character of the invention requires the limitation be a part of every embodiment, then defining a claim term in accordance with that limitation would be appropriate. Alloc, 342 F.3d at 1370.