

SHOOTING FROM OUTSIDE THE THREE POINT LINE USING EXTRINSIC EVIDENCE

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Every Chicago Bull's fan cherishes the memory of Michael Jordon driving for the basket, only to pass the ball back to a team mate for the game winning, long distance shot from outside the three point line. In the world of claim construction, extrinsic evidence can serve a similar role. It is outside of the "intrinsic" record of the patent and its prosecution history, and extrinsic evidence may be important in obtaining a desirable claim construction that will be affirmed on appeal.

The intrinsic evidence of the patent's claims language, specification and prosecution history must always be considered by the trial court interpreting disputed claim terms. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979-81 (Fed. Cir. 1995), (*en banc*), *aff'd*, 517 U.S. 370 (1996). The admission and use of extrinsic evidence (everything else relevant to claim construction), however, is solely within the trial court's discretion. *E.g. Markman*, 52 F.3d at 980. Moreover, the Federal Circuit's guidelines on the use of extrinsic evidence are not a model of clarity.

There are Federal Circuit decisions holding that normally the "clear meaning" of disputed claim terms can be ascertained solely from the patent's intrinsic evidence, and that extrinsic evidence should be ignored. *See e.g. Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996). Other Federal Circuit decisions remand cases to trial courts for consideration of extrinsic evidence, or criticize the trial court for the failure to consider extrinsic evidence. *NeoMagic Corp. v. Trident Microsystems, Inc.*, 287 F.3d 1062, 1073 (Fed. Cir. 2002); *AFG Industries, Inc. v. Cardinal IG Co.*, 239 F.3d 1239, 1245-49 (Fed. Cir. 2000).

The question then remains, to the extent there are guidelines for the use of extrinsic evidence, what could they be? In other words, when do you "shoot for three?"

A. The Tension Created By The Markman Decision

The tension in the *Markman* authority concerning extrinsic evidence results from the basic *Markman* premises. In *Markman*, 52 F.3d at 986, the Federal Circuit explained that the central claim construction directive is to determine the *objective* meaning of the disputed claim terms *at the time of the invention, to those of ordinary skill in the art*:

Thus, the focus in construing disputed terms in claim language is not the subjective intent of the parties to the

patent contract when they used a particular term. Rather the focus is on the objective test of what one of ordinary skill in the art at the time of the invention would have understood the term to mean.

To do so, the Federal Circuit requires reference primarily to the patent's intrinsic evidence. *Markman*, 52 F.3d at 979-81. The court, recognized that the words of the patent and its prosecution history do not address the central person in the analysis – the hypothetical person of ordinary skill in the art. This ordinary artisan is the audience for the patent and its claims, and is presumed to come to the patent with a working knowledge of the prior art, and the ordinary usage of the technical language used in the relevant field. *See e.g. Markman*, 52 F.3d at 980-81. Yet, this presumed knowledge is seldom discussed in the intrinsic evidence.

Thus, in *Markman*, 52 F.3d at 980-81, the Federal Circuit recognized that extrinsic evidence can provide this essential information concerning the understanding of those skilled in the art. Very few federal judges (at any level) possess the technical training and background to substitute for someone of ordinary skill in the art of a particular patent art, thus the Federal Circuit held, 52 F.3d at 980 (emphasis supplied):

The court may, in its discretion, receive extrinsic evidence in order ***"to aid the court in coming to a correct conclusion" as to the "true meaning of the language employed"*** in the patent. *Seymour v. Osborne*, 78 U.S. (11 Wall.) 516, 546, 20 L. Ed. 33 (1871).

The Federal Circuit further explained what constitutes extrinsic evidence and its possible roles in the claim interpretation proceeds, 52 F.3d at 980 (emphasis supplied):

Extrinsic evidence consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises. ***This evidence may be helpful to explain scientific principles, the meaning of technical terms, and terms of art that appear in the patent and prosecution history. Extrinsic evidence may demonstrate the state of the prior art at the time of the invention. It is useful "to show what was then old, to distinguish what was new, and to aid the court in the construction of the patent."*** *Brown v. Piper*, 91 U.S. 37, 41, 23 L. Ed. 200 (1875).

The Federal Circuit warned of the possible misuse of extrinsic evidence, as well: “[e]xtrinsic evidence is to be used for the court's understanding of the patent, not for the purpose of varying or contradicting the terms of the claims.” 52 F.3d at 981. The court explained, in terms that have created considerable controversy, the proper use and admissibility of extrinsic evidence, 52 F.3d at 986 (emphasis supplied):

A judge is not usually a person conversant in the particular technical art involved and is not the hypothetical person skilled in the art to whom a patent is addressed. Extrinsic evidence, therefore, may be necessary to inform the court about the language in which the patent is written. ***But this evidence is not for the purpose of clarifying ambiguity in claim terminology. It is not ambiguity in the document that creates the need for extrinsic evidence but rather unfamiliarity of the court with the terminology of the art to which the patent is addressed.***

The Federal Circuit's attempt to further distinguish between "informing" the court about the patent, and "clarifying ambiguities" in claim terms led to the Federal Circuit's holding in *Vitronics*. In that case, the Federal Circuit suggested that use of extrinsic evidence should ***not*** be considered ***at all*** in most cases. "In most situations, 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." 90 F.3d at 1583. This decision goes so far as to state that:

In those cases where the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper. The claims, specification, and file history, rather than extrinsic evidence, constitute the public record of the patentee's claim, a record on which the public is entitled to rely. In other words, 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. *See Markman*, 52 F.3d at 978-79, 34 USPQ2d at 1329. ***Allowing the public record to be altered or changed by extrinsic evidence introduced at trial, such as expert testimony, would make this right meaningless.***

90 F.3d at 1583 (emphasis supplied).

Even the court in *Vitronics*, however, recognized that certain forms of extrinsic evidence can be particularly important sources for the "ordinary meaning" of claim terms to those skilled in the art. The court noted that technical treatises and dictionaries, and the prior art (whether considered by the PTO or not), constitute extrinsic evidence that can demonstrate the meaning and use of claim terms. 90 F.3d at 1584 and n. 6. The court warned that such extrinsic evidence is only a starting place and cannot be used to "vary or contradict" the meaning of the claim language that is established by the intrinsic evidence. *Id.* at 1584.

The *Vitronics* decision, in fact, discouraged the use of expert testimony on the meaning of claim terms 90 F.3d at 1585. According to *Vitronics*, such testimony frequently indicates only what a particular expert believes a term means, not the meaning to one of ordinary skill informed by the patent and its prosecution history. *Id.*

Subsequent Federal Circuit decisions backed off from the hard line positions in *Vitronics*. For example, in *AFG Industries, Inc. v. Cardinal IG Co.*, 239 F.3d 1239, 1249 (Fed. Cir. 2000), the Federal Circuit reversed a claim construction for the trial court's *failure* to consider the extrinsic evidence of testimony and documents that established the understandings of one of ordinary skill in art. Similarly, in *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309 (Fed. Cir. 1999), the Federal Circuit approved of the use of trustworthy extrinsic evidence to ensure that the claim construction is consistent with widely held understandings in the pertinent technical field.

Thus we must ask: "what role does extrinsic evidence presently play in the *Markman* claim construction 'play book', and when can it be used?" The *Markman* decision itself explains that extrinsic evidence always may be offered (1) to assist the Court in understanding the underlying technology, the specific patent (*i.e.*, "what was then old, to distinguish what was new") and level of skill in the relevant field; (2) to establish the ordinary meaning of specific claim terms to those of ordinary skill in that art; and (3) to assist in determining the meaning of those terms where the intrinsic record is insufficient to resolve ambiguities in those terms. *See Markman*, 52 F.3d at 980-81; *AFG*, 239 F.3d at 1245-49; *Pitney*, 182 F.3d at 1309.

Furthermore, where there is an established meaning to those skilled in the art for the claim terms, and the patent specification does not provide any other definition for those terms, extrinsic evidence can be particularly important in arriving at the correct claim interpretation. *See e.g.*, *AFG*, 239 F.3d at 1245-49; *Pitney*, 182 F.3d at 1309. Thus, the threshold for admission of extrinsic evidence will depend on both the type of evidence offered and the reason it was offered.

As further discussed below, the Federal Circuit has given some guidance in sorting out the possible sources of extrinsic evidence and their significance. The weight given to the extrinsic evidence ultimately is within the trial court's discretion, as long as it is clear that the court based its determination on a correct reading of intrinsic evidence. *See Markman*, 52 F.3d at 980-81.

B. Dictionaries, Encyclopedias and Technical Treatises

Dictionaries and technical treatises are treated as a unique form of extrinsic evidence. They are routinely relied upon by the Federal Circuit and the district courts as controlling evidence of the "ordinary meaning" of the words used in a patent's claims. *See e.g. Inverness Medical Switzerland GmbH v. Princeton Biomeditech Corp.*, 309 F.3d 1365, 1369-70 (Fed. Cir. 2002); *Inverness Medical Switzerland GmbH v. Warner Lambert Co.*, 309 F.3d 1373, 1378-79 (Fed. Cir. 2002).

In fact, the definitions from dictionaries and technical treatises are among the very few categories of evidence that the Federal Circuit regularly permits the courts (and itself) to admit based on judicial notice. *See Reiffin v. Microsoft Corp.* 214 F.3d 1342, 1344 (Fed. Cir. 2000); *Vitronics*, 90 F.3d at 1584 n.6 (Judges are free to consult technical treatises and dictionaries “at any time.”); Fed.R.Evid. 201. Furthermore, the Federal Circuit requires a “heavy presumption” that a claim term carries its ordinary and customary meaning as defined by such dictionaries, treatises, etc. *Texas Digital Systems, Inc. v. Telegenix Inc.*, 308 F. 3d 1193, 1202 (Fed. Cir 2002); *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F. 3d 1359, 1366 (Fed. Cir. 2002). Nevertheless, this presumption, of course, can be rebutted by the patent’s intrinsic evidence. *See Id.*

Indeed, it is clear that identifying the “ordinary meaning” of claim terms from the appropriate dictionaries, encyclopedias and technical treatises is the *first* step in the claim construction process, before any of the patent’s intrinsic evidence is considered. *See Id.*; *Princeton*, 309 F.3d at 1369-73.

1. The Choice Of The Appropriate Dictionary Meaning

The choice of the appropriate dictionary or treatise will depend on the specific claim terms at issue. “Potentially relevant dictionaries include dictionaries of the English language (providing general definitions and usages), as well as technical dictionaries, encyclopedias, and treatises (providing specialized meanings as used in particular fields of art).” *Warner Lambert*, 309 F.3d at 1378; *CSC Fitness*, 288 F.3d at 1366; *Renishaw PLC v. Marposs Societa’ Per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998).

Thus, the Federal Circuit permits the use of general, non-technical dictionaries when interpreting claim terms drawn from the common usage of the English language. *Princeton*, 309 F.3d at 1369; *Warner Lambert Co.*, 309 F.3d at 1378. For example, in *Warner Lambert*, the terms in dispute were “on” and “on to,” and in *Princeton*, the term at issue was “mobility.” The parties in both cases agreed that those terms did not possess an established specialized meaning in the relevant art. *Id.* Therefore, the Federal Circuit started with the “ordinary meaning” of those terms from general purpose dictionaries and then looked at whether a different meaning was evident from the intrinsic evidence. *Princeton*, 309 F.3d at 1369-73; *Warner Lambert*, 309 F.3d at 1378-81.

However, if the claim terms do, or are alleged to have, a specialized meaning to those of ordinary skill in the art, then it is improper to use a general purpose dictionary to provide the “ordinary meaning” for the terms. *See Toro Co. v. White Consolidated Industries, Inc.*, 199 F.3d 1295, 1299 (Fed. Cir. 1999)(holding that one of ordinary skill in the art would not rely on general purpose dictionaries). The “ordinary meaning” for specialized terms should be determined from the relevant technical dictionaries, encyclopedias and treatises. *See e.g. Optical Disc Corp. v. Del Mar Avionics*, 208 F.3d 1324, 1334-35 (Fed. Cir. 2000); *Toro*, 199 F.3d at 1299.

In *Optical*, 208 F.3d at 1335, the Federal Circuit, in fact, consulted both a general dictionary and a specialized technical dictionary to interpret the word “ramp” in a claim

directed to a circuit creating an electrical wave form. The court used the narrower, more specialized meaning from the technical dictionary. *Id.*; see also *Karlin Technology, Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971 (Fed. Cir. 1999)(both ordinary and specialized dictionaries used).

2. Dictionaries and Encyclopedias With Multiple Definitions

One problem with general purpose dictionaries is that they frequently provide different definitions for the same term. See *Beckson Marine, Inc. v. NFM, Inc.*, 292 F.3d 718, 723-24 (Fed. Cir. 2002); See also *Anderson v. International Engineering and Manufacturing, Inc.*, 160 F.3d 1345, 1348 (Fed. Cir. 1998); *Toro*, 199 F.3d at 1299. In such cases, the Federal Circuit is just as likely to reject all of the proposed dictionary meanings and turn to other evidence, intrinsic and extrinsic, to resolve the dispute. See *Anderson*, 160 F.3d at 1348; *Toro*, 199 F.3d at 1299.

The Federal Circuit, however, recently provided one solution for this problem. See *Princeton*, 309 F.3d at 1370; *Warner Lambert*, 309 F.3d at 1378. In *Princeton*, 309 F.3d at 1370 the Federal Circuit held that the patent can be used to select the meaning or meanings that apply to the claims at issue.

“[W]here there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meaning.” *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed Cir. 1998). See also *Tex. Digital Sys.*, 308 F.3d at 1203...

In *Princeton*, 309 F.3d at 1370-73, the court found that the examination of all of the available definitions and the patent’s intrinsic evidence permitted it to select only one definition for the claim term. When the dictionary definition of the “ordinary meaning” for a term provides two equally applicable alternatives after consideration of the patent’s specification and prosecution history, then the claim term should be interpreted to encompass **both** definitions. *Warner Lambert*, 309 F.3d at 1378-79; See also *Rexnord*, 274 F.3d at 1343 (claim term “portion” means both “separate” or “integral”). In *Warner Lambert*, 309 F.3d at 1379-80, for example, the Federal Circuit held that the plain meaning for claim terms “on” and “onto” for disposing a chemical agent on a test strip encompassed **both** deposition of the reagent as a surface layer on the top of the strip, and soaking the reagent into and within the test strip.

3. The Relevant Date Of Dictionaries, Encyclopedias, Etc.

The Federal Circuit’s recent *Princeton* and *Warner Lambert* cases raise, in dicta, a further question concerning the use of dictionaries, treatises, etc. The unambiguous language of *Markman*, requires the interpretation of a patent’s claims at the time the “invention was made.” 52 F.3d at 986. The same panel decided *Princeton* and *Warner Lambert*, (Rader, J., Bryson, J. and Dyk, J.) and in both cases asserted that “[w]e may

look, therefore, to the dictionary definitions of the claim terms...*as the date the patents issued.*” *Princeton*, 309 F.3d at 1370; *Warner Lambert*, 309 F.3d 1378 (emphasis supplied). The panel stated in a footnote in both decisions that:

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. *Compare Tex. Digital Sys.*, 308 F.3d at 1202 with *Schering Corp. v. Amgen, Inc.*, 222 F.3d 1347, 1353, 55 USPQ2d 1650, 1654 (Fed. Cir. 2000).

Princeton, 309 F.3d at 1370, n.1; *Warner Lambert* 309 F3d 1378, n.2.

In *Princeton* and *Lambert*, the parties did not assert that the meaning of the claim terms at issue had changed during the period between the filing date of the application and the issuance of the patents. *Id.* In rapidly developing technologies, however, it is not uncommon for technical terms to change or acquire a specialized meaning during the prosecution of a patent, particularly if the prosecution is extended by reissue and or reexamination proceedings. Similarly, during the prosecution of the patent, technical treatises, federal regulations, industry specifications, or other reliable publications may establish or record the “ordinary meanings” for claim terms that were uncertain and difficult to establish at the patent’s filing date.

If the dictionary, treatise, etc. simply reduces to writing commonly held definitions that were current when the “invention was made,” then their date should be immaterial (although other extrinsic evidence may be required to establish that fact). The *Princeton* and *Warner Lambert* cases open the possibility that one may look to a period as late as the issuance of the patent for the “ordinary meaning” of claim terms, even if those meanings did not exist at the “time of invention.”

An appealing argument for such a flexible rule can be made for new claim terms that were added to a patent application for the first time with an amendment during the prosecution of the patent (and thus do not appear in the patent’s specification). The patentee’s and the examiner’s understanding of the meaning of such terms presumably were those current as of the date of the amendment and up to issuance of the patent. Thus, requiring the back dating of those terms to the application’s filing date, or before, may constitute a legal fiction that should correctly be challenged. Of course, if an applicant wishes to establish the meaning of a claim term at a particular time, the applicant is always free to submit that definition during the prosecution of the patent, so that it becomes part of the mandatory “intrinsic” evidence for the patent.

4. Examples Of Accepted Dictionaries, Encyclopedias, Etc.

The Federal Circuit has not identified a preferred or controlling general purpose dictionary. Among those frequently cited general purpose dictionaries are various editions of Webster's New World Dictionary, Webster's Third New International Dictionary, Webster's Ninth New Collegiate Dictionary, the American Heritage Dictionary, Random House Unabridged Dictionary, and the Shorter Oxford English Dictionary. *See e.g. Princeton*, 309 F.3d at 1370, n.2; *Warner Lambert*, 309 F.3d at 1378; *Rexnord Corp. v. Laitron Corp.* 274 F.3d 1336, 1344 (Fed. Cir. 2001); Kahrl, *Patent Claim Construction*, §7.03, p. 7-15 (2002).

The technical dictionaries and treatises used by the Federal Circuit depend on the specific technology at issue, and the Federal Circuit has not expressed a preference for any particular source in regard to either. Examples of such more specialized sources are Steadman's Medical Dictionary, Hawley's Condensed Chemical Dictionary, the New IEEE Standard Dictionary of Electrical and Electronics Terms, McGraw-Hill Dictionary of Scientific and Technical terms, and Rudolph C. Graf, *Modern Dictionary of Electronics*. *See Kahrl* at p. 7-16 (citing cases using those resources). Each of these references has been recognized as an accepted source for technical definitions in their applicable fields, *i.e.* medicine, chemistry, or electrical engineering. *Id.* They explained basic concepts used in that field and the terminology typically used by those of ordinary skill in that field. *Id.*

Other publications, such as technical articles, industry publications or academic papers provide an alternative to a formal dictionary. If the article or publication was written for those of ordinary skill, and was the type of article a skilled artisan would turn to for information on the subject matter of the patent, then the definitions found in the article (which presumably was created independently from the litigation) can be used. For example, in *Key Pharmaceuticals, Inc. v. Hercon Laboratories Corp.*, 161 F.3d 709, 716-17 (Fed. Cir. 1998), the Federal Circuit relied on published FDA regulations and standards for evaluating the claim terms "pharmaceutically effective amount" for a drug delivery system.

C. Uncited Prior Art And Other Pre-Invention Information

The Federal Circuit also held in *Markman* that extrinsic evidence concerning the prior art is important, if not necessary, in the claim construction process. "Extrinsic evidence may demonstrate the state of the prior art at the time of the invention. It is useful 'to show what was then old, to distinguish what was new, and to aid the court in the construction of the patent.'" *Markman*, 52 F.3d 980. One would expect that the Federal Circuit would have given further guidance concerning the proper use of uncited prior art and other pre-invention information." This issue, however, has not received much attention from the Federal Circuit.

The *Markman* decision, for example, does not define "prior art" in the context of claim construction. Certainly publications, patents, and other documentary evidence that

satisfy the traditional definitions of prior art under 35 USC §§ 102 and 103 qualify as *Markman* extrinsic, prior art evidence. Products or methods that actually were offered for sale or, sold (*i.e.* “on sale”); or in “public use” according to the provisions of §102(b); or otherwise available to the relevant public should also qualify as “prior art” for *Markman* purposes. It is presumed that this type of information is available to one of ordinary skill and in the public domain.

The Federal Circuit, however has yet to address the treatment of information that qualifies as “prior art” under §§102 and 103, but was confidential or unavailable to the relevant public at the time relevant for claim interpretation. Similarly, the Court has not addressed information that is publicly available, but not “prior art” under §§102 and 103, such as experimental uses under §102(b) more than a year before the patent’s filing date.

For example, a partially developed product or method may “on sale” under the Supreme Court’s *Pfaff* standards (*i.e.* “ready for patenting”, but not reduced to practice), and still held in confidence by the developer. *See Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 67-68 (1998). The prior art offer for sale, in fact, may be to a related company, without any disclosure to the public. *See Brasseler USA I, L.P. v. Stryker Sales Corp.*, 182 F.3d 888, 890-91 (Fed. Cir. 1999). Other similar situations arise from work that is held in confidence before the relevant *Markman* date, but later disclosed through a patent application or commercial use that qualifies the work as § 102(e) or (g) prior art.

This is a very practical problem for a trial court faced with the evidentiary issues that can arise during a *Markman* hearing. If the purpose of this uncited prior art evidence is to give the court necessary technical background information to focus on “what was new” and “what was old” in the patent’s claims, there is no reason to deny the court the benefit of such background information. Indeed, the trial court may later be considering the same prior art as an invalidity defense. In addition, the Federal Circuit’s interpretation maxim that claims should be interpreted, if possible, to maintain their validity is still good law. *See Rhine v. Casio, Inc.* 183 F.3d 1342, 1345 (Fed. Cir. 1997).

The difficulty lies in drawing the line between admissible, “helpful” evidence, and evidence that goes to the validity of the patent but not the interpretation of specific claim terms at issue. The trial court may allow the latter evidence into the record for later consideration, but this also must be weighed against the confusion and inefficiencies created by permitting the presentation of evidence that has little relevance to the issues the court must actually decide.

On the other hand, if the purpose of the uncited prior art is to establish an accepted meaning for a claim term, then the considerations governing the relevance of unpublished or “secret” prior art are different. In many fields, the best sources of information on the meaning of terms of art are the actual workers in the field. In most private sector business, the publication of articles or other materials concerning a particular technology is not permitted. Thus, the best documentation of the common definition for a particular term of art may be unpublished, even confidential, routine, business documents, showing the every day usage of a term that presumably is reliable,

because it is a usage unrelated to the litigation. *See Ajinomoto Co. v. Archer-Daniels-midland Co.* 228 F.3d 1338, 1348-49 (Fed. Cir. 2000)(claim constructions consistent with the parties' own usages and company documents explained by experts).

The use of such evidence for claim construction purposes seems contrary to the Federal Circuit's emphasis on the need to use information freely available to those of ordinary skill in the art for claim construction purposes. *Vitronics*, 90 F.3d at 1585. According to the court, as mentioned above, the public availability of claim construction resources is necessary for the "notice" function of a patents claim. *See Id.*

The party offering uncited prior art, therefore, should be prepared to establish that this extrinsic evidence does in fact constitute the "ordinary meaning" for the terms at issue that is generally accepted in the field, not a specialized or unique meaning for that specific patent, company, application or circumstance. *See Ajinomoto*, 228 F.3d at 1348-49. Such "private" uses of terminology may not be consistent with a broader usage of a term used in a patent claims, and may be dependant on unstated assumptions or practices of a particular person or company.

For example, in *Vitronics*, 90 F.3d at 1581, 1585, the Federal Circuit rejected the use of a paper written by the patent holder's former employee as the source for a claim definition. In that case, the proposed definition from the paper improperly excluded the patent's preferred embodiment from the claim. *Id.* at 1583. This is a particular concern for documents from the patentee or the patent's assignee. They often reflect a subjective understanding of the meaning of claim terms that is not relevant to the *Markman* claim construction process. *See Markman*, 52 F.3d at 983, 985.

D. Expert, Inventor And Other Testimony

The use of expert, inventor and other testimony during the claim interpretation process was expressly authorized by *Markman*, 52 F.3d at 980-81; *Endress + Hauser Inc. v. Hawk Measurement System Prys. Ltd.*, 122 F.3d 1040, 1042 (Fed. Cir. 1997). This type of extrinsic evidence also is among the most controversial. There is no question that the explanation of the relevant technology and the common understandings of terminology used by one of ordinary skill in the art can be very helpful, and often necessary, to a court attempting to interpret patent claims. *See Markman*, 52 F.3d at 980-81; *Vitronic*, 90 F.3d at 1585. In most cases, the trial court and the Federal Circuit lack the inventor's specialized knowledge of the technology, terminology and technical issues relevant to a particular patent.

The controversy arises from the Federal Circuit's concern, also voiced in *Markman*, that such extrinsic evidence should not be offered "for the purpose of varying or contradicting the terms of the claims." 52 F.3d at 980-81. The Federal Circuit in *Vitronics* ruled that testimony from experts, patent attorneys and inventors normally cannot be relied upon for "the *proper construction* of disputed claim term". 90 F.3d at 1585 (emphasis in the original); *Markman*, 52 F.3d at 985. Under *Vitronics*, "[t]he latter

kind of testimony may only be relied upon if the patent documents, taken as a whole, are insufficient to enable the court to construe disputed claim terms.” 90 F.3d at 1585.

In *Vitronics*, the Federal Circuit did not dictate when or what kind of expert, inventor, patent attorney or other testimony can be admitted for the purposes of claim construction. See *Aqua-Aerobic Systems, Inc. v. Aerators, Inc.*, 211 F.3d 1241, 1244 (Fed. Cir. 2000); *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1308, n. 2 (Fed. Cir. 1999). Subsequent Federal Circuit decisions narrowed the *Vitronics* holding to only whether and under what circumstances courts can rely on already admitted extrinsic evidence as ***dispositive in their claim construction.***” *Id.* (emphasis supplied).

In other words, the testimony of experts, inventors, patent attorneys and others properly can be used for all of the purposes authorized by *Markman*, as long as the final claim construction is based on the intrinsic evidence or proper extrinsic evidence (particularly dictionaries, etc.). See *Key Pharmaceuticals*, 161 F.3d at 716-17. The Federal Circuit reaffirmed this basic proposition in *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1454 n.3 (Fed. Cir. 1998) (*en banc*) (extrinsic evidence is only “an aid to the court in coming to a correct conclusion as to the true meaning of the language employed in the patent”).

1. The Admissibility Of Expert, Patentee Or Other Testimony

The admissibility of expert, patentee, patent attorney and other testimony, therefore, rests on the Fed.R.Evid. 702 and the *Markman* requirements that it “be helpful to explain scientific principles, the meaning of technical terms, and the terms of art that appear in the patent and the prosecution history.” 52 F.3d at 980. *Markman* testimony, by its nature, will be subject to the court’s gatekeeper function required by *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579, 592-98 (1993) and *Kuhmo Tire Co. v. Carmichael*, 526 U.S. 137, 147-53 (1999), as is all testimony “based on scientific, technical or other specialized knowledge” under Fed.R.Evid. 702.

When opposing experts or other witnesses offer different claim interpretations, the trial court will be forced to make credibility decisions usually reserved for a fact finder. In *Markman*, the Federal Circuit attempted to distinguish such credibility determinations concerning expert (or other) testimony, that is normally the job of a fact finder, from determining what is “helpful” in claim construction. *Markman*, 56 F.3d at 980-81. In affirming *Markman*, the Supreme Court eliminated the need for such distinctions, 517 U.S. at 389-90:

It is, of course, true that credibility judgments have to be made about the experts who testify in patent cases, and in theory there could be a case in which a simple credibility judgment would suffice to choose between experts whose testimony was equally consistent with a patent’s internal logic. But our own experience with document construction leaves us doubtful that trial courts will run into many cases

like that....The [trial court] vested with the task of construing the patent is in a better position to ascertain whether an expert's proposed definition fully comports with the specification and claims and so will preserve the patent's internal coherence.

The post-*Markman* Federal Circuit cases criticizing trial courts for relying on testimony from experts, inventors, etc. generally are those cases where the technology at issue is not particularly difficult, and the contested claim terms did not possess a specialized or technology-specific meaning. See e.g. *Pitney Bowes*, 182 F.3d at 1308-09. The Federal Circuit does not object to a trial court's reliance on expert or other testimony where the claims at issue required a more in depth knowledge of the relevant technology and the disputed claim terms possess specialized meaning in the art. See e.g. *Ajinomoto Co. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 1349 (Fed. Cir. 2000); *Wang Laboratories, Inc. v. AOL, Inc.*, 197 F.3d 1377, 1380-82 (Fed. Cir. 1999); *EMI Group North America, Inc. v. Intel Corp.*, 157 F.3d 887, 892 (Fed. Cir. 1998). See also *Vitronics*, 90 F.3d at 1585.

Indeed, in *EMI*, 157 F.3d at 892, the court summarized the evidence received by the trial court, which in addition to background on the technology included the following:

The expert witnesses discussed the specification and the prosecution history and the meaning of certain rejections, arguments, and amendments during patent prosecution. The expert witnesses expressed their views on the meaning and scope to the claims, as well as on legal and technologic issues relating to prosecution history estoppel and equivalency.

In its *de novo* review, the Federal Circuit also drew heavily on this record, including the conflicting testimony of the expert witnesses on the patent's prosecution history, the prior art, and the allegedly infringing methods. *Id*

The Federal Circuit, in addition, has remanded cases back to the trial court to take expert or other testimony and for further consideration of extrinsic evidence. In such cases, the court determined that expert testimony was, or would likely, provide necessary information to properly determine the meaning of disputed claim terms to those of ordinary skill in the art. See e.g. *NeoMagic Corp. v. Trident Microsystems, Inc.*, 287 F.3d 1062, 1073 (Fed. Cir. 2002); *Bayer AG v. Biovail Corp.*, 279 F.3d 1340, 1349 (Fed. Cir. 2002); *Advanced Cardiovascular Systems, Inc. v. SciMed Life Systems, Inc.*, 261 F.3d 1329, 1344 (Fed. Cir. 2001).

The testimony of the patentee/inventor presents a special case of expert testimony. Normally, it is presumed that the patentees are competent to testify concerning the subject matter of the patent and have personal knowledge of how the invention was made. Although, in patents with multiple patentees, it is not uncommon for the

individual patentees to have expertise in only a portion of the technology required by the patent. Thus, they may not be competent to testify concerning claim terms directed to subject matter outside of their field.

Furthermore, the patentees are presumed to have personal knowledge of that patent's prosecution, as it is carried out in their name. However, that also is frequently a legal fiction. *Markman*, 52 F.3d at 985. In many patent prosecutions, the application drafting work and the subsequent interactions with the patent examiners are primarily the work of the prosecuting attorney. *Id.* The choice of claim terms, in particular, is frequently the decision of the attorney and examiner, with the patentees playing a passive role, if any at all. *Id.* Indeed, it is not uncommon for the patentees to consider the choice of claim terms a legal issue, completely outside of their expertise.

Thus, careful consideration should be given of any testimony offered by a patentee on the integration of claim terms. In other words, is the patentee really in a better position than the trial court or other reader of the patent to offer claim construction? Similarly, is a patentee's testimony offered on the ultimate issue of claim construction, or solely for background purposes concerning the technology and ordinary meaning of claim terms in the relevant field?

2. The Special Consideration Required Of Patentee Testimony

Any testimony from a patentee also must be carefully evaluated based on the objective record before the court. A patentees' subjective intent or understanding is not relevant or admissible in the *Markman* process. *See Vitronics*, 90 F.3d at 1584; *Markman*, 52 F.3d at 985.

The Federal Circuit in *Markman*, 52 F.3d at 985, warned that litigation-derived inventor testimony possesses little, if any, probative value: "it is not unusual for there to be a significant difference between what an inventor thinks his patented invention is and what the ultimate scope of the claims is after allowance by the PTO." *Accord Bell & Howell Document Management Co. v. Altek Systems*, 132 F.3d 701, 706 (Fed. Cir. 1997)(inventor testimony self-serving); *Roton Barrier, Inc. v. Stanley Works*, 79 F.3d 1112, 1126 (Fed. Cir. 1996). Furthermore, the public function of a patent and its prosecution history would be severely compromised if the patentee's subjective and undisclosed definitions of claim terms was controlling. *See Vitronics*, 90 F.3d at 1584.

The Federal Circuit, in fact, has permitted and considered patentee testimony for the more limited purpose of establishing meaning and usage of specific terms by those of ordinary skill in the art. *See e.g. Hoechst Celanese Corp. v. BP Chemical, Ltd.*, 78 F.3d 1575, 1580-81 Fed. Cir. 1996); *Pall Corp v. Micron Separations, Inc.*, 66 F.3d 1211, 1217-18 (Fed. Cir. 1995). In such a case, the weight given to patentee testimony and competing expert testimony will depend, as the Supreme Court noted, on credibility determinations by the trial court. *See Markman* 517 U.S. at 389-90. Whether such determinations will be honored on *de novo* review by the Federal Circuit will depend on

the Federal Circuit's view of the need for such testimony and its consistency with the intrinsic evidence. *See Hoechst*, 78 F.3d at 1579; *Pall*, 66 F.3d at 1217-18.

3. Patent Attorney Testimony

Patent attorney experts also raise interesting issues in a *Markman* proceeding. The Federal Circuit in *Markman*, 52 F.3d at 983, expressly recognized that the trial courts are free to consider testimony from patent attorney experts (but did not rely on it there), with a warning:

This testimony about construction, however, amounts to no more than legal opinion-it is precisely the process of construction that the court must undertake. Thus, as to these types of opinions, the court has complete discretion to adopt the expert legal opinion as its own, to find guidance for it, or to ignore it entirely, or even to exclude it.

A patent attorney testifying within his or her expertise can provide assistance to the trial courts in the specialized practices of patent prosecution. That is an area of law in which few federal judges have (or desire to have) significant working knowledge. A patent attorney expert can provide testimony, if appropriate in view of the disputed claim terms, on Patent and Trademark Office procedures, the significance of events occurring during the prosecution of the patents, the application of prior art to claims in the context of patent prosecution, and the meaning of terminology used by patent examiners. This provides expertise in a specialized field that trial courts rarely possess. *See Fed.R.Evid.* 702.

In some district courts, it is assumed that the attorneys arguing the matter possess the required expertise to explain the prosecution history issues to the court. In those courts, it may be more difficult to prevail in attempts to present expert testimony on that issue. Such procedures also raise significant issues concerning the record that must be established before the trial court should it be necessary to appeal the *Markman* interpretation.

In addition, patent attorneys testifying concerning the knowledge and understandings of one of ordinary skill will have the additional burden of establishing the basis for their testimony on such issues. The Federal Circuit has rejected any requirement for attorney testimony on the ultimate issue of claim construction. *See Endress + Hauser Inc. v. Hawk Measurement System Prys. Ltd*, 122 F.3d 1040, 1042 (Fed. Cir. 1997)(rejecting asserted requirement for patent attorney experts for claim construction).

E. Other Extrinsic Evidence

The Federal Circuit in *Markman* did not limit the potential sources of extrinsic evidence to just those discussed above. *See* 52 F.3d at 980-81. Thus, other evidence outside of the patent and its prosecution history may be relevant and even controlling as a matter of law on the patent's claim construction.

For example, while the patentee or patent holder's subjective intent is not material to the correct claim construction, admissions limiting the scope of the claims can be important *Markman* evidence. *See Jonsson v. The Stanley Works*, 903 F.2d 812, 820-21 (Fed. Cir. 1990); *Evans Medical, Ltd v. American Cyanamid Co.*, 11 F.Supp2d 223, 350-51 SDNY 1998), *aff'd* 215 F.3d 1347 (Fed. Cir. 1999). In *Gentex Corp. v. Donnelly Corp.*, 69 F.3d 527, 530 (Fed. Cir. 1995), the inventor's testimony concerning the intent of the meaning of the disputed claim terms was cited as one reason for rejecting the patent holder's claim construction.

Similarly, assertions by the patent owner in previous court proceedings interpreting the claim terms at issue can be controlling under the doctrines of judicial estoppel and collateral estoppel. If a party successfully asserts a claim construction in a previous case, then that party cannot change its position in a subsequent case to assert a new or different claim construction. *See New Hampshire v. Maine*, 532 U.S. 742, 749 (2000); *Interactive Gift Express, Inc. v. Compuserve, Inc.*, 256 F.3d 1323, 1345-46 (Fed. Cir. 201); *Key Pharmaceuticals*, 161 F.3d at 713-16; *see also, Lampi Corp. v. American Power Products, Inc.* 228 F.3d 1365, 1377 (Fed. Cir. 2000).

The doctrine of judicial estoppel protects the courts 'from being manipulated by chameleonic litigants who seek to prevail, twice, on opposite theories.'" *Levinson v. United States*, 969 F.2d 260, 264 (7th Cir. 1992); *accord Minnesota Mining And Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1302-04 (Fed. Cir. 2002). While judicial estoppel applies to the successful party and its arguments, the doctrine of collateral estoppel (or issue preclusion) will apply to the parties to prior litigation whether successful or not.

It is well established that a party cannot relitigate an issue that it fully litigated, was finally decided, and was necessary for a prior decision. *See Blonder-Tongue Lab., Inc. v. University of Illinois Foundation*, 402 U.S. 313, 329 (1971); *A.B. Dick Co. v. Burrough Corp.*, 713 F.2d 700, 702 (Fed. Cir. 1983)(explaining the standards for collateral estoppel). A patent holder, in particular, cannot take several bites from the litigation apple simply switching adversaries. *See Id; Parklane Hosiery Co. v. Shore.*, 439 US 322, 329 (1979); *Amgen, Inc. v. Genetics Institute*, 98 F.3d 1328, 1331-32 (Fed. Cir. 1996); *Molinaro v. Fannon/Courier Corp.*, 745 F.2d 651, 655 (Fed. Cir. 1984).

Thus, evidence of a prior claim construction that qualifies for collateral estoppel effect also can be introduced in *Markman* proceedings. Such prior decisions should be

given controlling weight with respect to those who were represented in the previous case. *See Molinaro*, 745 F.3d at 655 (claim scope decision give collateral estoppel effect).

A party (typically a patent challenger) who was not represented in the previous litigation will not be so bound and can seek reconsideration of an adverse claim construction. *See Blonder-Toungue*, 402 US. at 329. As a result, the final claim construction need not be identical to the interpretation in the previous case.

A prior decision, particularly from the Federal Circuit, also may be given *stare decisis* effect. This doctrine applies to legal conclusions, and provides for consistent legal holdings on the same facts or a very similar factual record in later proceedings. *See Mendenhall v. Cedarapids, Inc.*, 5 F.3d 1557, 1570 (Fed. Cir. 1993). However, *stare decisis* may only apply to prior decisions of the same court or to decisions by a higher, controlling court. *Id.* Thus, the Federal Circuit's decisions on claim construction may have *stare decisis* effect on the federal district courts. *Id.* Claim constructions from other district courts are entitled only to deference under the principle of comity. *See Mendenhall*, 5 F. 3d at. 1570.

CONCLUSION

The decisions from the Federal Circuit provide some guidance on the use of extrinsic evidence. In the end, whether extrinsic evidence affects the outcome of the claim construction dispute will depend on the claim terms at issue, the technology involved in the case and the proposed use for the evidence. Moreover, whether the extrinsic evidence is actually allowed to “go in” will depend on the discretion of the trial court, who unlike a basketball hoop, can choose to keep the evidence out, or even let it in without letting it “score.”

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