

# *Fitch, Even, Tabin & Flannery*

FITCH EVEN TABIN & FLANNERY  
INTELLECTUAL PROPERTY LAW | EST. IN 1859

## **Extrinsic Evidence – “Back Up” Or Potential “Star” Player**

**Association of Patent Law Firms  
Roundtable**

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# *Extrinsic Evidence Is A Role Player*

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- Intrinsic evidence – claim language, specification and prosecution history **must** be considered.
- Extrinsic evidence is **everything else** and is entirely **discretionary**.

*Markman*, 52 F.3d 967, 979-81 (Fed. Cir. 1995)

# Can You Score? You Won't Know Until It's Over

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- Extrinsic Evidence **Ignored** - the “clear meaning” of the claims evident from “intrinsic evidence.”
- Extrinsic Evidence **Required** - cases sent back for failure to consider extrinsic evidence.

*See Vitronics, 90 F.3d 1576, 1583 (Fed. Cir. 1996); E-Pass Technologies, Inc. v. 3Com Corp., No. 02-1593 (Fed. Cir. 8/20/03); Cordis Corp. v. Medtronic AVE, Inc., 339 F.3d 1352 (Fed. Cir. 2003); NeoMagic, 287 F.3d 1062, 1073 (Fed. Cir. 2002); AFG, 239 F.3d 1239, 1245-49 (Fed. Cir. 2000).*

# Does It Start Or Wait On The Bench?

- The goal: the objective meaning of the disputed claim terms to those of ordinary skill in the art.
- But who are those of “ordinary skill” and what do they know?
- At the time of the invention (or not)?

*Alloc, Inc. v. ITC*, No. 02-1222 (Fed. Cir. 9/10/03); *Resonate, Inc. v. Alteon Websystems, Inc.*, No. 02-1201 (Fed. Cir. 8/05/03); *Riverwood, Intn'l Corp. v. R.A. Jones, Co.* 324 F.3d 1346, 1357 (Fed. Cir. 2003); *Princeton*, 309 F.3d at 1370; *Warner Lambert*, 309 F.3d 1378; *Texas Digital Systems, Inc. v Telegenix, Inc.*, 308F.3d 1193, 1203 (Fed. Cir. 2002); *Key Pharmaceuticals*, 161 F.3d at 716-17

# *Extrinsic Evidence – Role Player?*

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- Explain scientific principles, specific technology.
- The level and knowledge of those skilled in the art.
- The development and state of the prior art.
- To “show what was then old, to distinguish what was new.”

*Markman*, 52 F.3d at 980-81

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# *Extrinsic Evidence – Putting Up Points*

- Dictionaries – ordinary meaning of ordinary words.
- Specialized meanings – when dictionaries fail:
  - Technical terms.
  - Terms of art.
- The meaning of terms where the intrinsic record is insufficient.

*See Markman*, 52 F.3d at 980-81; *Alloc*, 02-1222, p. 8; *Princeton*, 309 F.3d at 1369; *Warner*, 309 F.3d at 1378; *Toro*, 199 F.3d 1295, 1299 (Fed. Cir. 1999); *AFG*, 239 F.3d 1239, 1245-49 (Fed. Cir. 2000); *Optical Disc*, 208 F.3d 1324, 1334-35 (Fed. Cir. 2000); *Pitney Bowes*, 182F.3d 1298, 1309 (Fed. Cir. 1999).

# *Your Bench Is Full - Which Do You Pick?*

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- Different definitions for the same term?
  - Reject'em all and look else where.
  - Pick the ones that fit.
  - Give'm all that they can support.

*See Princeton*, 309 F.3d at 1370; *Warner Lambert*, 309 F.3d at 1378; *Anderson*, 160 F.3d 1345, 1348 (Fed. Cir. 1998); *Toro*, 199 F.3d at 1299.

## ***What About Undrafted Players—The Uncited Prior Art?***

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- Uncited prior art -- extrinsic evidence specifically recognized by *Markman*.
- How does the prior art define the terms?
- Claims should be interpreted, if possible, to maintain their validity.
- The practical problems for the trial courts.

*Rhine*, 183 F.3d 1342, 1345 (Fed. Cir. 1997).

# *Are All Of Your Players Eligible?*

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- Aren't the parties' own usages relevant too?
- But, what about the public notice issue?
- Admissions?

*Ajinomoto* 228 F.3d 1338, 1348-49 (Fed. Cir. 2000); *Vitronics*, 90 F.3d at 1581, 1585

## *Those Free Agents And Prima Donnas-Experts And Inventors*

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- Expert, inventor and other testimony o.k. by *Markman*
  - For explaining technology
  - For explaining specialized meanings
- Not for “varying or contradicting the terms of the claims.”

*Markman*, 52 F.3d at 980-81; *Akamai Technologies, Inc. v. Cable & Wireless Internet Services, Inc.*, 03-1007 (Fed. Cir. 9/15/03); *Cordis*, 339 F.3d 1532; *Endress*, 122 F.3d 1040, 1042 (Fed. Cir. 1997).

# *Oh No! A Ringer The Patent Attorney*

- *Markman* authorizes consideration of patent attorney expert testimony.
- Must be more than legal opinion, such as:
  - Explanation of prosecution history.
  - Explanation of PTO Procedures.
  - Terms of patent art.

*Markman*, 52 F.3d at 983.

# ***Don't Forget The Other Guy's On The BENCH***

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- Markman does not limit the potential sources of extrinsic evidence.
  - Patent's own cited extrinsic evidence.
  - Cited extrinsic evidence during prosecution.
- Prior court interpretations.
- Collateral estoppel, judicial estoppel, etc.

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