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A PROPOSED ANALYTICAL FRAMEWORK FOR RESOLVING AN INTRA-COURT SPLIT ON CLAIM CONSTRUCTION AMBIGUITY

By Erik I. Perez*

The Federal Circuit was created to ensure patent law consistency by reducing inter-circuit splits.¹ For decades, the Federal Circuit has oscillated between two standards associated with claim construction. This Article attempts to explain, analyze, and propose a solution to the intra-court split on claim construction.

Part I examines the historical overview of patent litigation. This section briefly describes patent document sections, protectable patent rights, and patent interpretation shifts, from relying on the patent's specification, to the patent's claim. Part II examines current patent law. This section briefly describes how patent claims are interpreted and what role the specification aids in the interpretation.

Part III examines the Federal Circuit's intra-court split regarding the role that the specification plays in determining the limitations imposed on patent claims. This section is split into four parts: (A) the exacting presumption standard is analyzed through two cases; (B) the holistic standard is analyzed through two cases and subsequently compared against the exacting presumption standard; (C) a proposed theoretical standard is explained and analyzed; and (D) the current Federal Circuit standards are evaluated and analyzed to determine which one is more likely to prevail.

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¹ Paul Michel & John Battaglia, *On Claim Construction, Predictability, and Patent Law Consistency: The Federal Circuit Needs to Vote En Banc*, IPWATCHDOG (Feb. 3, 2020),

<https://www.ipwatchdog.com/2020/02/03/claim-construction-predictability-patent-law-consistency-federal-circuit-needs-vote-en-banc/id=118481/> (Paul Michel is a former Federal Circuit Judge).

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I. PART I: HISTORICAL OVERVIEW OF PATENT LITIGATION AND THE COURT’S SHIFT FROM RELYING ON THE PATENT’S SPECIFICATION TO DETERMINE THE SCOPE OF A PATENT RIGHT, TO RELYING ON THE PATENT’S CLAIM

Intellectual property includes intangible creations of the human intellect. A patent is a form of intellectual property which gives the owner legal rights to exclude others from making, using, or selling an invention for a limited period of time in exchange for publishing an enabling public disclosure of the invention.² If the right is infringed, patent laws grant a cause of action against violators.³

In the eighteenth and early nineteenth centuries, the courts decided patent infringement disputes by comparing the accused product with the patentee’s whole specification.⁴ The specification encompasses a majority of the patent document and is written entirely by the inventor.⁵ The specification has three basic requirements, where the inventor must describe: the invention; the manner and process of making and using the invention; and the “best mode” of carrying out the invention.⁶ In the nineteenth century, patents began to have claims.⁷ Claims are at the end of the patent and “particularly specify and point out the part, improvement, or combination, which [an inventor] claims as [her] own invention or discovery.”⁸ In 1836, claims were statutorily required in every patent application.⁹

Even after the law required claims in the patent document, infringement analysis continued to rely primarily on the specification.¹⁰ For example, George T. Curtis’ comprehensive 1849 treatise described infringement as “a copy of the thing described in the specification of the patentee, either without variation, or with only such variations as are consistent with its being in substance the same thing.”¹¹ Curtis did not include an index entry for the subject of patent claims.¹² As a later commentator observed, “the courts for a long time did not regard [the claim] as the definitive measure of the scope of the

² See 35 U.S.C. § 271(a).

³ See, e.g., *id.*; Patent Act of 1790 §4, 1 Stat. 109, 111 (establishing liability of infringers); Patent Act of 1793 §5, 1 Stat. 318, 322 (same).

⁴ George T. Curtis, *The Law of Patents* § 220 (1849).

⁵ See 35 U.S.C. § 111.

⁶ *Id.* at § 112.

⁷ See Curtis, *supra* note 4.

⁸ See Patent Act of 1836, § 6, 5 Stat. at 119.

⁹ *Merrill v. Yeomans*, 94 U.S. 568, 570 (1876).

¹⁰ See Curtis, *supra* note 4.

¹¹ *Id.*

¹² See *Id.*

patent” but rather looked to “the whole patent document, including the claims as a guide.”¹³

However, courts in the second half of the nineteenth century began to place increased weight on claims for deciding the scope of patent rights.¹⁴ In 1869, the Supreme Court indicated infringement is based on the “specification and claims of their letter’s patent.”¹⁵ The enactment of the Patent Act of 1870 modified the statutory claiming requirement and stated “[the inventor] shall particularly point out and distinctly claim the part, improvement, or combination which [she] claims as [her] invention or discover.”¹⁶ In 1874, the Court indicated “[i]t is true the patent cannot be extended beyond the claim. That bounds the patentee’s right. But the claim in this case covers the whole process invented, and the complainants seek no enlargement of the process.”¹⁷ This led to the courts’ shift to using the claim language to determine the bounds of the invention.

Now, the patent’s claims are the most important part of the patent document. Claims provide the “portion of the patent document that defines the patentee’s rights.”¹⁸ By statute, the claims are set forth at the conclusion of the specification.¹⁹ The function of claims is only to define the precise scope of the intellectual property rights. Everything in the claim must be supported in the inventor’s specification, and claims introducing new features not described in the original specification are invalid.²⁰ However, Congress has not specified precisely how courts are to determine what constitutes “the patented invention,” thus leaving courts with the difficult question of the scope of patent rights.

II. PART II: OVERVIEW OF THE MODERN LAW OF CLAIM CONSTRUCTION

Modern patent infringement litigation requires two key steps. First, the claim construction determines the scope of the protectable

¹³ William R. Wood-Ward, *Definiteness and Particularity in Patent Claims*, 46 MICH. L. REV. 755, 760 (1948).

¹⁴ See Curtis, *supra* note 4.

¹⁵ *Blanchard v. Putnam*, 75 U.S. 420,425 (1869).

¹⁶ Leahy-Smith America Invents Act, §4(c), 125 Stat. 284 (2011).

¹⁷ *Am. Wood-Paper Co. v. Fibre Disintegrating Co.*, 90 U.S. 566, 606 (1874).

¹⁸ *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996).

¹⁹ See 35 U.S.C. § 112(b).

²⁰ See Manual of Patent Examining Procedure, 8th ed., rev. 7 § 2161.01 (Jul. 2008).

patent right.²¹ Claim construction is where the court interprets the claims to determine what the patentee actually invented and what the patentee intended to protect.²² During claim construction, the patent's claims are interpreted based on the patent's intrinsic and extrinsic evidence.²³ This claim construction is a prerequisite to the second step: the infringement analysis.²⁴ Claim constructions are questions of law reserved for the court, while infringement is a question of fact reserved for the fact finder.²⁵ This paper focuses on how claims are constructed in light of the specification, which is a type of intrinsic evidence.

A. *Interpreting a Patent's Claim - The Laws of Claim Construction*

Claim construction determines the patent right's protectable outer limits.²⁶ Patent claim terms are generally given their plain and ordinary meaning, which is the meaning they would have to a person of ordinary skill in the art.²⁷ This person of ordinary skill in the art is a hypothetical person, who knows the specification and prior art.²⁸ The patentee may have characteristics of the person of ordinary skill in the art but is not considered that hypothetical person. The skill level of the hypothetical person is based on: "type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field."²⁹ "In a given case, every factor may not be present, and one or more factors may predominate."³⁰ Additional guidelines support this general inquiry to help the court determine the correct person of ordinary skill in the art.³¹

Because the claim construction determines the scope of the patentee's rights and can determine the outcome of a patent suit,

²¹ *Markman*, 517 U.S. at 372.

²² *See generally Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243 (Fed. Cir. 1998).

²³ *Phillips v. AWH Corp.*, 415 F.3d 1303, 1319 (Fed. Cir. 2005) (en banc).

²⁴ *Markman*, 517 U.S. at 372.

²⁵ *Id.*

²⁶ *See e.g., Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917).

²⁷ *Phillips*, 415 F.3d at 1313–14.

²⁸ *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citing *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986)).

²⁹ *Id.* (quoting *Custom Accessories, Inc.*, 807 F.2d at 962).

³⁰ *Id.* (quoting *Custom Accessories, Inc.*, 807 F.2d at 962–63).

³¹ *See Phillips*, 415 F.3d at 1319.

reliable methods of interpretation are important to establish consistent court rulings. In *Phillips v. AWH Corp.*, the en banc Federal Circuit attempted to clarify various patent claim construction interpretation issues.³² The *Phillips* Court indicated claim terms are given their ordinary and customary meaning to a person of ordinary skill in the art at the time of the invention.³³ “[T]he person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.”³⁴ Reviewing the disputed claim terms in light of the intrinsic evidence is necessary because this is how the person of ordinary skill in the art would understand and interpret the claim terms.³⁵ Generally, the court will attach different meanings to different words or phrases used in separate claims.³⁶ However, this claim differentiation doctrine only creates a presumption that the terms have different meanings, which can be overcome by the specification and prosecution history.³⁷

B. *The Specification - Overview of How the Specification Aids the Claim Construction*

The *Phillips* court emphasized the specification is always highly relevant to the claim construction analysis.³⁸ It is usually dispositive when the proposed construction most naturally aligns with the patent’s description of the invention in the specification.³⁹ For example, the specification may aid in claim construction where it does any of the following: describes the invention’s preferred or sole embodiment; excludes an embodiment from the invention; distinguishes prior art or cites particular advantages over prior art; or defines certain terms.⁴⁰ The court may look to these distinguishing aspects to ensure that its construction aligns with these aspects.⁴¹

³² *Id.*

³³ *Id.* at 1313.

³⁴ *Id.*

³⁵ *Id.*

³⁶ *Anderson Corp. v. Fiber Composites, LLC*, 474 F.3d 1361, 1369–70 (Fed. Cir. 2007); *Seachange Int’l, Inc. v. C-COR Inc.*, 413 F.3d 1361, 1368–69 (Fed. Cir. 2005).

³⁷ *Howmedica Osteonics Corp. v. Zimmer, Inc.*, 822 F.3d 1312, 1323 (Fed. Cir. 2016).

³⁸ *Phillips*, 415 F.3d at 1316.

³⁹ *Id.*

⁴⁰ *Id.* at 1313–14.

⁴¹ *Inpro II Licensing, S.A.R.L. v. T-Mobile USA, Inc.*, 450 F.3d 1350, 1354–55 (Fed. Cir. 2006).

There are certain instances where a patentee may wish to use words in their own particular way. In these cases, the patentee may act as her own lexicographer.⁴² Therefore, a patentee is free to provide any definition for a claim term, often in the specification, regardless of the term's ordinary meaning.⁴³ However, the Federal Circuit has stated that the inventor must clearly indicate in the specification or file history the desired definition to overcome the presumption that the term's ordinary and customary meaning applies.⁴⁴

A fine line exists between construing the claims in light of the specification and improperly importing a limitation from the specification into the claims. In reviewing the intrinsic record to construe the claims, a proper claim construction should capture the scope of the actual invention. It should not limit the scope of the claims to the disclosed embodiment or allow the claim language to become divorced from what the specification conveys is the invention.⁴⁵ The context in which the terms appear in the claim as a whole is an important consideration in claim construction.⁴⁶ For example, terms have different meanings if the patentee uses different terms to identify similar claim limitations.⁴⁷

Ultimately, claim construction is the first step in a patent infringement suit. Success in an infringement suit requires a finding "that the patent claim covers the alleged infringer's product or process."⁴⁸ Because claim construction is a prerequisite to infringement, typically patentees seeking enforcement want broad interpretations of the patent claims. These broad interpretations would increase the probability of a jury finding the patent claims cover the alleged infringers product, leading to a finding of infringement. Conversely, an individual seeking to avoid infringement would want to narrow the claim language to decrease the probability of a jury finding infringement.

While the claim language is distinct from the specification, the specification is used as the foundation of claim language interpretation. However, the Federal Circuit is fractured between two competing

⁴² *Id.*

⁴³ *Phillips*, 415 F.3d at 1316.

⁴⁴ *Thorner v. Sony Computer Entm't America LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012).

⁴⁵ *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1305 (Fed. Cir. 2011).

⁴⁶ *Bancorp Servs., L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1373 (Fed. Cir. 2004).

⁴⁷ *Id.*

⁴⁸ *Markman*, 517 U.S. at 374.

methodologies and has not established a clear rule in determining how much impact the specification has on limiting the claim language.

III. PART III: DESCRIPTION AND ANALYSIS OF THE FEDERAL CIRCUITS INTRA-COURT SPLIT REGARDING THE INFLUENCE OF THE SPECIFICATION DURING CLAIM CONSTRUCTION

Extrinsic evidence was the starting point of claim construction before *Phillips*.⁴⁹ Dictionaries, treaties, or other extrinsic sources derived a claim's ordinary meaning.⁵⁰ *Phillips* recognizes the delicate and difficult balance because there "is no magic formula or catechism for conducting claim construction."⁵¹ The Federal Circuit indicated the specification "is the primary basis for construing the claims."⁵² The Federal Circuit has reaffirmed "[t]he best source for understanding a technical term is the specification from which it arose."⁵³ *Phillips* states "the claims are to be construed in the light of the specifications."⁵⁴ But, *Phillips* never defines what it means to construe claims "in light of the specification."⁵⁵ *Phillips* did not resolve the intra-court split about the specification's role in claim construction.⁵⁶

Some commentators have described Federal Circuit jurisprudence as a battle between warring factions.⁵⁷ For decades, Federal Circuit panels have oscillated between two different approaches to the role the patent's specification plays in the claim

⁴⁹ Greg Reilly, *Judicial Capacities and Patent Claim Construction: An Ordinary Reader Standard*, 20 MICH. TELECOMM. & TECH. L. REV. 243, 262–63 (2014).

⁵⁰ *Id.* at 260.

⁵¹ *Phillips*, 415 F.3d at 1324.

⁵² *Id.* at 1315 (quoting *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985)).

⁵³ *Id.*

⁵⁴ *United States v. Adams*, 383 U.S. 39, 49, 86 (1966).

⁵⁵ *Phillips*, 415 F.3d at 1315.

⁵⁶ *Id.* at 1313.

⁵⁷ See Craig Allen Nard, *A Theory of Claim Interpretation*, 14 HARV. J.L. & TECH. 1, 4–5 (2000) (Nard indicates there are inconsistencies. Nard divides the Federal Circuit judges into hypertextualists and pragmatic textualists); R. Polk Wagner & Lee Petherbridge, *Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance*, 152 U. PA. L. REV. 1105–11 (2004) (They divide Federal Circuit judges into holistic and proceduralist claim interpreters); Joseph Scott Miller, *Enhancing Patent Disclosure for Faithful Claim Construction*, 9 LEWIS & CLARK L. REV. 177, 177 (2005) (Miller viewed the entire area as being "in disarray").

construction process.⁵⁸ Part A of this Article explains the Federal Circuit’s textual presumption approach, where a claim carries its broad ordinary meaning and can be narrowed after overcoming a presumption standard. Part B explains the Federal Circuit’s holistic approach, where a claim can be narrowed by the specification. Part C explains a proposed analytical framework, which merges the two approaches. Part D theorizes whether the textual presumption or holistic approach will prevail.

A. *The Presumption Standard – Claims Obtain a Broad Meaning and are Narrowed if the Specification Meets an “Exacting” Standard*

The Federal Circuit has applied a presumption where a claim carries its ordinary meaning, as understood by a person of ordinary skill in the art.⁵⁹ This heavy presumption can only be overcome if the specification meets an exacting standard and demonstrates either: (i) clear lexicography, a clear re-definition in the patent document itself for the claim term-at-issue; or (ii) a clear disavowal of claim scope.⁶⁰ Since *Phillips*, the line of cases regarding presumption generally start the analysis with the judge’s own understanding of the claim language through the person of ordinary skill in the art, without any effort to corroborate their understanding with sources in the field of the invention.⁶¹ In these cases, a judge should only consult the specification in limited circumstances.⁶² This section analyzes two Federal Circuit cases: *Thorner v. Sony Computer Entm’t Am. LLC* and *Hill-Rom Servs., Inc. v. Stryker Corp.*

The *Thorner* Court explained the presumption standard.⁶³ In *Thorner*, Judge Moore indicates a patentee acting as their own

⁵⁸ See Craig Allen Nard, *A Theory of Claim Interpretation*, 14 HARV. J.L. & TECH. 1, 4–5 (2000) (Nard indicates there are inconsistencies. Nard divides the Federal Circuit judges into hypertextualists and pragmatic textualists).

⁵⁹ *Starhome GmbH v. AT & T Mobility LLC*, 743 F.3d 849, 857 (Fed. Cir. 2014) (quoting *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002)).

⁶⁰ See, e.g., *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1371 (Fed. Cir. 2014); *Thorner*, 669 F.3d at 1365–66; *Teleflex, Inc.*, 299 F.3d at 1325–28; *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989–90 (Fed. Cir. 1999).

⁶¹ Reilly, *supra* note 49, at 262.

⁶² *Id.*

⁶³ *Thorner*, 669 F.3d at 1364–65 (The *Thorner* decision was unanimous. The *Thorner* panel consisted of Chief Judge Rader, Judge Moore, and Judge Aiken. Judge Moore authored the opinion. Chief Judge Rader was a part of the *Phillips* majority.).

lexicographer must “clearly set forth a definition of the disputed claim term’ other than its plain and ordinary meaning.”⁶⁴ “It is not enough for a patentee to simply disclose a single embodiment or use a word in the same manner in all embodiments, the patentee must ‘clearly express an intent’ to redefine the term.”⁶⁵

“The standard for disavowal of claim scope is similarly exacting.”⁶⁶ The specification must make “clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad” enough to encompass the feature in question.⁶⁷ “The patentee may demonstrate intent to deviate from the ordinary and accustomed meaning of a claim term by including in the specification expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.”⁶⁸ Yet, the use of the words “exacting,” “clearness,” “intent to deviate from the ordinary and accustomed meaning,” and “manifest exclusion or restriction” does not necessarily clarify the standard.

In *Hill-Rom*, the Court cites previous examples where “[t]he standards for finding lexicography and disavowal are exacting.”⁶⁹ *Hill-*

⁶⁴ *Id.* at 1365 (quoting *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002)).

⁶⁵ *Id.* (citing *Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1381 (Fed. Cir. 2008); *Kara Tech. Inc. v. Stamps.com*, 582 F.3d 1341, 1347–48 (Fed. Cir. 2009)).

⁶⁶ *Id.* at 1366.

⁶⁷ *Id.* (quoting *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001)).

⁶⁸ *Id.* (quoting *Teleflex, Inc.*, 299 F.3d at 1325); see also *Home Diagnostics, Inc. v. LifeScan, Inc.*, 381 F.3d 1352, 1358 (Fed. Cir. 2004).

⁶⁹ *Hill-Rom*, 755 F.3d at 1371. Judge Moore cites to statements where the patentee included: “the present invention requires”; “the present invention is”; or “all embodiments of the present invention are.” *Id.* at 1372 (citing *Regents of Univ. of Minn. v. AGA Med. Corp.*, 717 F.3d 929, 936 (Fed. Cir. 2013); *Honeywell Int’l, Inc. v. IIT Indus., Inc.*, 452 F.3d 1312, 1316–19 (Fed. Cir. 2006); *SciMed*, 242 F.3d at 1343–44; *AstraZeneca AB v. Hanmi USA, Inc.*, 554 Fed. Appx. 912, 915 (Fed. Cir. 2013) (nonprecedential)). Judge Moore cites to language from the specification which includes: “successful manufacture” for a particular step “require[d]” a specific element; “pushing forces” as opposed to pulling forces were “an important feature of the present invention”; repeated disparagement of “an embodiment as ‘antiquated,’ having ‘inherent inadequacies,’ and then [the specification] detailed the ‘deficiencies [that] make it difficult’ to use”; the “specification described [a] feature as a ‘very important feature . . . in an aspect of the present invention’ and disparaged alternatives to that feature.” *Id.* (citing *Andersen Corp. v. Fiber*

Rom dealt with whether the patent’s claim term “datalink” limited data communication technology to only physical or both physical and wireless links.⁷⁰ The *Hill-Rom* majority found the exacting standard to disavow scope was not met; therefore, “datalink” was not limited to physical cables but included wireless and physical cables.⁷¹ Judge Moore stated the exacting standard was not met because the invention language did not describe the invention using phrases like “‘is,’ ‘includes,’ or ‘refers to’ [regarding] a wired datalink and there is nothing expressing the advantages, importance, or essentiality of using a wired as opposed to wireless datalink,”⁷² “nor is there language of limitation or restriction of the datalink.”⁷³ “Nothing in the specification or prosecution history makes clear that the invention is limited to use of a cable as a datalink.”⁷⁴ The patent’s specification does have some language that has limitations which include “the terms ‘datalink 39,’ ‘cable 39,’ and ‘serial datalink 39’ to describe the same component of the preferred embodiment.”⁷⁵ However, the Court found these limitations do not limit the “term datalink to one type of datalink—a cable.”⁷⁶

In contrast, the *Hill-Rom* dissent found the term “datalink” to be limited to physical cables.⁷⁷ Judge Reyna’s dissent begins by highlighting the invention was patented in 1993, possibly implying wireless communication was not standard at the time and a person of ordinary skill in the art would have understood the technology to be limited to physical linkage.⁷⁸ Judge Reyna reasons “the intrinsic record

Composites, LLC, 474 F.3d 1361, 1367 (Fed. Cir. 2007) (“Those statements are not descriptions of particular embodiments, but are characterizations directed to the invention as a whole.”); *SafeTCare Mfg., Inc. v. Tele-Made, Inc.*, 497 F.3d 1262, 1269–70 (Fed. Cir. 2007); *Chicago Bd. Options Exch., Inc. v. Int’l Sec. Exch., LLC*, 677 F.3d 1361, 1372 (Fed. Cir. 2012)) (“[T]he specification goes well beyond expressing the patentee’s preference . . . and its repeated derogatory statements about [a particular embodiment] reasonably may be viewed as a disavowal”); *Inpro II Licensing, S.A.R.L.*, 450 F.3d at 1354–55).

⁷⁰ *Hill-Rom*, 755 F.3d at 1372.

⁷¹ *Id.* at 1375.

⁷² *Id.*

⁷³ *Id.*

⁷⁴ *Id.*

⁷⁵ *Id.* at 1373.

⁷⁶ *Hill-Rom*, 755 F.3d at 1373.

⁷⁷ *Id.* at 1383 (Reyna, J., dissenting).

⁷⁸ *Id.* at 1382 (Reyna, J., dissenting) (“This construction literally encompasses all data communication technology regardless of whether it

is devoid of any description of a wireless ‘datalink’ structure.”⁷⁹ Specifically, the claim language recites “messages are sent ‘over a/the datalink,’ ‘by a/the datalink,’ and ‘via a/the datalink.’”⁸⁰ While this does not indicate a requirement for a physical cable, the patent claim’s context indicates “[t]he only way the ‘datalink’ could also connect[,] . . . while being ‘in line’ with the electrically connected ‘optical isolator[,]’ is if it is a physical structure.”⁸¹ For Judge Reyna, the patent’s specification met the exacting standard and limited the patent’s claim language to physical link cables.⁸²

Ultimately, the presumption of the claims being interpreted by a person of ordinary skill in the art promotes predictability and public notice.⁸³ Professors Wagner and Petherbridge reason “embrac[ing] the commonly-understood meaning of words [in the field], and plac[ing] the burden on the patent applicant to clearly explain any deviations” will ensure that “the meaning of claim language is readily apparent to patent readers.”⁸⁴ Because patents are a type of property right,⁸⁵ it is important that the boundaries of the right are clear.⁸⁶

B. *The Holistic Approach – Claims Obtain Their Meaning and are Narrowed Based on the Specification*

The Federal Circuit has applied a holistic approach toward claim construction.⁸⁷ The Federal Circuit allows the patent

existed in 1993 when the patents were filed, whether it was created yesterday, or whether it shall be created in the future.”).

⁷⁹ *Id.*

⁸⁰ *Id.*

⁸¹ *Id.* at 1383 (citing *Phillips*, 415 F.3d at 1314) (“the usage of a term in one claim can often illuminate the meaning of the same term in other claims”).

⁸² *Hill-Rom*, 755 F.3d at 1386 (Reyna, J., dissenting).

⁸³ Reilly, *supra* note 49, at 263.

⁸⁴ R. Polk Wagner & Lee Petherbridge, *Did Phillips Change Anything? Empirical Analysis of the Federal Circuit’s Claim Construction Jurisprudence*, INT’L PROP. & COMMON L. 125, 128 (2013).

⁸⁵ *Florida Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627, 642 (1999) (patents “long . . . considered a species of property”).

⁸⁶ *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014).

⁸⁷ See e.g., *Kinetic Concepts v. Blue Sky Med. Grp.*, 554 F.3d 1010, 1017–19 (Fed. Cir. 2009); *On Demand Machine Corp. v. Ingram Indus. Inc.*, 442 F.3d 1331, 1338–39 (Fed. Cir. 2006); *Nystrom v. TREX Co.*, 424 F.3d 1136, 1142–44 (Fed. Cir. 2005); *AquaTex Indus., Inc. v. Techniche Solutions*, 419 F.3d 1374, 1380–83 (Fed. Cir. 2005); *Wang Labs, Inc. v. Am. Online, Inc.*,

specification to limit a claim term's scope even when there is no clear lexicography or disclaimer.⁸⁸ This section explores the analysis in *Nystrom v. TREX Co.* and *Kinetic Concepts, Inc. v. Blue Sky Med. Grp., Inc.* and evaluates and interprets the decisions through the presumption standard.

First, *Nystrom* focused on the scope of claim 1.⁸⁹ The Court initially found claim 1's use of the term "board" was not limited to wood by the patent's claim language.⁹⁰ The *Nystrom* Court then turned to claim 16, a claim not at issue. The Court found "claim 16, which is similar to claim 1, covers '[a] wood decking board for use in constructing a flooring surface for exterior use, said decking board having a convex top surface, a bottom surface, opposite side edges, and curved growth rings . . .'"⁹¹ Under *Tandon Corp. v. United States Int'l Trade Comm'n*, the *Nystrom* Court presumed a "difference in the use of terms has significance and that 'board' should not be limited to wood that is cut from a log."⁹² If the *Nystrom* Court ended their analysis here, then the "board" term's scope would have been very broad. However, *Nystrom* examined the language of the specification to determine the context of the term "board" and concluded that the "term 'board' must be limited to wood cut from a log."⁹³

The *Nystrom* Court never indicated it met a presumption. Yet, in some way, it seems *Nystrom* implicitly met the exacting presumption standard. The patent-in-suit used language similarly described in *Hill-Rom*. *Nystrom* found "[i]n the context of the discussion of wood flooring materials for exterior use, the patent states, 'In all conventional flooring materials known to applicant.'"⁹⁴ The use of "all" in the specification is similar to what *Hill-Rom* indicates as relevant to the presumption analysis. *Nystrom* explains the patent states "the process used to cut such lumber from logs can produce inferior product on the

197 F.3d 1377, 1382–83 (Fed. Cir. 1999); *O.I. Corp. v. Tekmar Co., Inc.*, 115 F.3d 1576, 1581 (Fed. Cir. 1997).

⁸⁸ *Nystrom*, 424 F.3d at 1138 (The *Nystrom* decision was unanimous and consisted of Judge Mayer, Judge Gajarsa, and Judge Linn. Judge Lin was in the majority of *Phillips*. Judge Mayer dissented in *Phillips*. Additionally, "the petition for panel rehearing is granted for the limited purpose of addressing the effects of *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005).").

⁸⁹ *Id.* at 1143.

⁹⁰ *Id.*

⁹¹ *Id.* (quoting '831 patent, col. 5, ll. 32–35).

⁹² *Id.* (citing *Tandon Corp. v. U.S. Int'l Trade Comm'n*, 831 F.2d 1017 (Fed. Cir. 1987)).

⁹³ *Id.*

⁹⁴ *Nystrom*, 424 F.3d at 1143–44 (quoting '831 patent, col. 1, ll. 57–61).

outermost boards, often leading to scrap.”⁹⁵ Like *Hill-Rom*’s explanations, the specification notes inferior products. Plus, the “context [was] maintained throughout the written description.”⁹⁶

The patent-in-suit’s written description goes on to note that the manner of installation of conventional decking boards “leads to accelerated deterioration of the boards when exposed to weather.”⁹⁷ Like *Hill-Rom* indicates, explanations of inherent inadequacies of the invention or prior art greatly influence the analysis. While *Nystrom* does not specifically indicate there is a presumption that must be overcome, the opinion signals the presumption is implicitly within the law. Additionally, *Phillips* was recently decided, and the merits of *Nystrom* were tried shortly after *Phillips* was released.⁹⁸ The new laws associated with claim construction were newly explained and elaborated, and it is likely the court was attempting to stay as close to *Phillips* as possible.

Second, *Kinetic Concepts*, decided in 2009, can be described as employing the holistic approach.⁹⁹ In *Kinetic Concepts* the term “wound” was at issue.¹⁰⁰ Defendants ask the court to adopt their proposed “plain and ordinary meaning” construction, taken from Stedman’s Medical Dictionary. The medical dictionary defined “wound” as: “(1) trauma to any of the tissues of the body, especially that caused by physical means and with interruption of continuity [or] (2) a surgical incision.”¹⁰¹ The *Kinetic Concepts* Court declined to use the medical dictionary because it was “broader than the scope of the specification and cannot be used to define ‘wound’ as used in the claims.”¹⁰² *Kinetic Concepts* limited the term “wound” to mean “tissue damage to the surface of the body, including the epithelial and subcutaneous layers” because “[a]ll of the examples described in the specification involve skin wounds.”¹⁰³ The Court found, under the Defendant’s construction, “wound” would include “fistulae” and “conditions such as ruptured appendices and stomach ulcers” which the “specification in no way suggests can be treated according to the

⁹⁵ *Id.* (quoting ’831 patent, col. 1, ll. 65–67).

⁹⁶ *Id.*

⁹⁷ *Id.* (quoting ’831 patent, col. 1, ll. 34–35).

⁹⁸ *Id.* at 1136.

⁹⁹ *Kinetic Concepts*, 554 F.3d at 1013 (*Kinetic Concepts* was before Judge Bryson, Judge Prost, and Judge Dyk. Judge Bryson and Judge Prost were in the majority in *Phillips*. Judge Dyk dissents in *Kinetic Concepts*.).

¹⁰⁰ *Id.* at 1017.

¹⁰¹ *Id.* at 1018.

¹⁰² *Id.*

¹⁰³ *Id.*

claimed invention.”¹⁰⁴ This led to the Court finding that the patents were not obvious and the patents were deemed valid.¹⁰⁵

The *Kinetic Concepts* dissent first looks to the “words of the claim [to] define the scope of the patent.”¹⁰⁶ Judge Dyk indicates the specification merely illustrates the invention as useful for “treating a variety of wounds.”¹⁰⁷ The specification does not, in its totality, narrow the invention to skin wounds.¹⁰⁸ Judge Dyk cites the specification which included broad language covering exposed bones, infected bones, drained fluids, and surgical incisions through the abdominal wall.¹⁰⁹ Judge Dyk indicates the “majority is incorrect in asserting that ‘[a]ll of the examples described in the specification involve skin wounds’” because multiple “examples illustrate that the wounds at issue are not merely skin wounds but” also other types of wounds.¹¹⁰

The *Kinetic Concepts* Court used the holistic approach and used the specification to limit the term “wounds” without needing to overcome a presumption.¹¹¹ If the exacting presumption standard applied, the *Kinetic Concepts* Court would have initially determined the term “wound” contained a broad meaning. The meaning would have likely been similar to the medical dictionary definition that the Defendants proposed. The term “wound” would have been limited only after the presumption was overcome through the specification. The limiting of the claim language had drastic consequences in *Kinetic Concepts*. Judge Dyk’s dissent suggests the specification would likely not have been clear enough to meet the presumption standard to narrow the term “wound.”¹¹² If the term “wound” was broad and incorporated fistulae, then the court would have found the patent-in-suit obvious and invalidated the patent. Paradoxically, the majority does not show specific language from the specification to warrant their conclusion that “[a]ll of the examples described in the specification involve skin wounds.”¹¹³

Kinetic Concepts highlights the subtle distinction of when a court should limit the language of a claim. Under the presumption approach, judges first look to the claims of the patent and give the

¹⁰⁴ *Id.*

¹⁰⁵ *Kinetic Concepts*, 554 F.3d at 1019.

¹⁰⁶ *Id.* at 1027 (Dyk, J., dissenting).

¹⁰⁷ *Id.* at 1028.

¹⁰⁸ *Id.*

¹⁰⁹ *Id.*

¹¹⁰ *Id.* at 1028–29.

¹¹¹ *Kinetic Concepts*, 554 F.3d at 1028–29.

¹¹² *Id.*

¹¹³ *Id.* at 1018 (majority).

claims the broadest scope reasonable to a person of ordinary skill in the art. Facially, these judges do not necessarily use the specification to limit the words of the claim but use the specification to determine how a person of ordinary skill in the art views the claim language. These judges interpret the scope of the claim language almost independently from the specification once the person of ordinary skill in the art is determined.

Under the holistic approach, judges consult the specification much more often. They do not necessarily give the claim language the broadest interpretation reasonable to a person of ordinary skill in the art. They give the claim language the broadest interpretation reasonable to a person of ordinary skill in the art while simultaneously limiting the language based on how a person of ordinary skill in the art would read the claim language if they could refer to the specification.

Ultimately, the holistic approach can be used because “[l]imiting claim construction to the specific context of the patent is justified as ensuring that the patentee’s exclusive rights are proportional to what the patentee actually invented and contributed to the field.”¹¹⁴ “Proportionality, like predictability, is reasonably grounded in the classic economic justifications of the patent system”¹¹⁵ However, the intra-court split is what creates the problem. It can lead to inconsistent litigation and inconsistent outcomes.

C. *The Slide Scale - Proposing a Compromise Between the Presumption and Holistic Approach*

This paper ultimately culminates in the proposal of a compromise. I propose a three-step methodological approach to determine the limits to the claim language: (1) determine the person of ordinary skill in the art, (2) determine the broadest reasonable interpretation of the claim language, and (3) determine the standard to overcome presumption to narrow the claim language.

Step One: determine what constitutes the person of ordinary skill in the art. A court must determine the abilities of the person of ordinary skill in the art. *Phillips* signals the first step in claim construction analysis is to determine the abilities of the person of ordinary skill in the art. The interpretation rests in what this hypothetical person understands and knows.¹¹⁶ The patentee may have characteristics of the person of ordinary skill in the art even though they are not that hypothetical person. “In determining this skill level, the

¹¹⁴ Reilly, *supra* note 49, at 264.

¹¹⁵ *Id.*

¹¹⁶ *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citing *Custom Accessories, Inc.*, 807 F.2d at 962).

court may consider various factors including ‘type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.’”¹¹⁷ “In a given case, every factor may not be present, and one or more factors may predominate.”¹¹⁸

In practice, a judge determines the characteristics of the person of ordinary skill in the art through the patent-in-suit and through expert testimony.¹¹⁹ The judge does need to sometimes make credibility judgments about the expert testimony to ultimately determine what constitutes the person of ordinary skill in the art. This step is a prerequisite for all claim constructions because the claim language must be interpreted through the eyes of the person of ordinary skill in the art. However, it is important to not limit the person of ordinary skill in the art based solely on the patent. The hypothetical person could potentially interpret things differently based on the hypothetical knowledge they would have based on their educational experiences. For example, parties are litigating a baking recipe.¹²⁰ Party A defines the person of ordinary skill in the art as a college student. Party B defines the person of ordinary skill in the art as a chef. These two individuals might interpret the baking patent differently. The college student might understand caramelization as only being applied to candy while the chef might understand caramelization as applying to all types of food. While the patent should be able to teach the person of ordinary skill in the art how to make the invention, this does not indicate the broadest reasonable interpretation of the language of the claim.

Step Two: determine the broadest reasonable interpretation of the claim language in accordance with the interpretation of the person of ordinary skill in the art. This step ensures claim construction aligns with how patents are issued and determined in the Patent Trademark Office. “The Patent and Trademark Office determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’”¹²¹

This indicates all the claims, when patented, are given their

¹¹⁷ *Id.* (quoting *Custom Accessories, Inc.*, 807 F.2d at 962).

¹¹⁸ *Id.* (quoting *Custom Accessories, Inc.*, 807 F.2d at 962–63).

¹¹⁹ *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 330 (2015).

¹²⁰ For the purposes of this thought exercise, ignore any statutory or constitutional issues associated with patentability.

¹²¹ *Phillips*, 415 F.3d at 1216 (citing *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)).

broadest reasonable scope and are defined through the person of ordinary skill in the art. The scope of the claims is not defined by the patentee but by the person of ordinary skill in the art. Any limiting language present in the specification, which limits the patent, would be incorporated within the broadest reasonable construction interpreted by one of ordinary skill in the art.

The patentee may be the drafter, but the person of ordinary skill in the art is the interpreter of the scope of the claims. A patentee may define their own invention and act as their own lexicographer. In those cases, the patentee's interpretation of the language could be radically different from the way a person of ordinary skill in the art interprets the language. For example, a patentee may create an invention that defines the bounds of a rectangle.¹²² Assume the person of ordinary skill in the art is a kindergartner. A kindergartner may not know a square is considered a rectangle, so the kindergartner may not interpret a square as a rectangle even though, geometrically, squares are rectangles. There then becomes a fundamental issue with how the invention is interpreted if the patentee's understanding of the invention is radically different from how a person of ordinary skill in the art would interpret the invention.

Step Three: determine the presumption to overcome the broadest reasonable interpretation in accordance with the person of ordinary skill in the art. The claim language should carry the broadest reasonable interpretation to the person of ordinary skill in the art. Then, courts should determine the differences between the patentee and the person of ordinary skill in the art and use the differences as a metric to determine the standard to overcome the presumption presented by *Thorner*. If the patentee more closely resembles the person of ordinary skill in the art, then a higher standard should be met. If the patentee does not resemble the person of ordinary skill in the art, then a lower standard should be met.

If a higher standard must be met, then the presumption standard would look more exacting like in *Thorner* and *Hill-Rom*. There would need to be repeated language in the patent specification to indicate a person of ordinary skill in the art would understand there is a deliberate departure from how they would interpret the claim language. If a lower standard must be met, then the presumption standard would be analogous to *Nystrom* and *Kinetic Concepts*. The court may look at the specification and see if it would be reasonable for a person of ordinary skill in the art to understand the language of the specification narrows the scope of the claims.

¹²² For the purposes of this thought exercise, ignore any statutory or constitutional issues associated with patentability.

The justification for this sliding scale rests in the fact the patentee and person of ordinary skill in the art are two separate individuals. If the patentee is closer to the person of ordinary skill in the art, there is a higher likelihood the patentee would use language and context that is consistent with language used by the person of ordinary skill in the art. The similarities between the patentee and the person of ordinary skill in the art implies there has to be clearer language to disavow the language in the claims to overcome the presumption. Further, a patentee who is less similar to the person of ordinary skill in the art, would be less likely to use the correct language, to understand the jargon, etc.

Adopting the sliding scale approach would create a variety of different legal questions. For example, how is the comparison between the patentee and the person of ordinary skill in the art. I propose it would be reviewed for clear error. This standard would coincide with prior case law.¹²³ Currently, “courts construing patent claims must sometimes make ‘credibility judgments’ about witnesses.”¹²⁴ There is no fundamental shift in how courts will determine these questions as most of the time it is implicitly done during normal claims construction.

However, the finding that the level of presumption has been overcome would be a question of law that is reviewed *de novo*. Ultimately, this inquiry determines the proposed standard to overcome the claim’s broad interpretation. While it may have factual issues, its ultimate purpose is to determine a question of law.

D. *Theorizing Which Current Federal Circuit Standard Will Prevail*

The standard that will prevail is dependent on two specific situations: (1) whether the Federal Circuit takes up this issue en banc and (2) whether the Supreme Court grants *certiorari*.

First, the Federal Circuit is the only circuit court of appeals that reviews patent law. The Federal Circuit does not have the inter-circuit pressure to reconsider its earlier decisions.¹²⁵ En banc decisions are incredibly rare in any circuit. It seems unlikely the Federal Circuit will take up this issue soon. This is especially prevalent when the Federal Circuit denied a request for an en banc hearing on this same claim construction issue in *Cont’l Circuits LLC v. Intel Corp.*, 915 F.3d 788 (Fed. Cir. 2019). After losing in the Federal Circuit, because the court used the presumption standard, Intel Corp. sought an en banc review of

¹²³ *Id.* (citing *Markman*, 517 U.S. at 389–90).

¹²⁴ *Id.* (citing *Markman*, 517 U.S. at 389–90).

¹²⁵ Daniel Kazhdan, *The Federal Circuit Should Be More Tolerant of Intra-Circuit Splits*, 26 FED. CIR. B.J. 105, 105 (2016).

the decision and was denied.¹²⁶ It seems the Federal Circuit is comfortable with having a shifting standard.

However, if an en banc hearing is granted, the Federal Circuit will likely adopt the exacting presumption standard outlined in *Thorner*. The Federal Circuit has a propensity for clearly established, easy-to-implement rules regarding to patent laws. For example, the Federal Circuit has desired rules resembling bright-line rules regarding section 101.¹²⁷

Additionally, the influence of Judge Moore and Judge Lourie is compelling. Both judges have technical backgrounds. Judge Moore “has written and presented widely on patent litigation.”¹²⁸ She co-wrote a legal casebook and served as a law professor specializing in patent law before her appointment.¹²⁹ Judge Lourie “was corporate counsel for SmithKline Beecham, [and] practiced and wrote about patent law before his appointment.”¹³⁰ Judge Lourie also authored the opinion in *Cont’l Circuits* where the presumption standard was implemented. Both Judges have drastically influenced patent law in the past decades and influenced this specific issue. If the Federal Circuit does resolve the intra-court split, the Supreme Court would likely not review the decision. The Supreme Court seems reluctant to decide this issue at the current time because it denied *certiorari* on this same issue in *Intel Corp. v. Cont’l Circuits LLC*, 140 S. Ct. 648 (2019).

Second, assuming the Supreme Court grants *certiorari*, the Supreme Court’s decision becomes more complicated. Because of the limited judicial history of the newest members of the Supreme Court, this determination is more difficult to theorize. The members of the Supreme Court before Justice Gorsuch typically had a propensity to prefer factor tests when it comes to patent laws.¹³¹ These types of factor tests would coincide with the holistic view the Federal Circuit employs.

However, fundamentally, claim construction is an exercise of legal interpretation.¹³² In *Teva*, the majority highlights the distinction between the factual underpinnings associated with claim construction, which are reviewed for clear error, and the legal interpretations, which

¹²⁶ See *Intel Corp. v. Cont’l Circuits LLC*, 140 S. Ct. 648 (2019).

¹²⁷ See *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012); *Alice Corp. Pty. v. CLS Bank Int’l*, 573 U.S. 208 (2014).

¹²⁸ Kimberly A. Moore, Circuit Judge, *U.S. Ct. Of Appeals For The Fed. Cir.*, <http://www.cafc.uscourts.gov/judges/kimberly-a-moore-circuit-judge.html> (last visited Aug. 28, 2022).

¹²⁹ *Id.*

¹³⁰ John R. Allison & Mark A. Lemley, *How Federal Circuit Judges Vote in Patent Validity Cases*, 27 FLA. ST. U. L. REV. 745, 745 (2000).

¹³¹ See *Mayo*, 566 U.S. at 66; *Alice*, 573 U.S. at 208.

¹³² *Markman*, 517 U.S. at 372.

are reviewed *de novo*.¹³³ Many of the current members and newest members of the Supreme Court prefer textual constructions. This could indicate they would prefer the presumption approach as claim construction is a question of law and a textual inquiry.

The historical underpinnings of the infringement analysis may lead to inconclusive results. Justice Thomas' dissent in *Teva Pharm. USA, Inc. v. Sandoz, Inc.* states "the pre-1937 evidence of this Court's treatment of evidentiary determinations underlying claim construction is inconclusive."¹³⁴ Not much is known about how claim construction analysis occurred. Most of the pre-1937 evidence is based on infringement where courts determined infringement by comparing the specification to the accused product.¹³⁵

IV. CONCLUSION

The Federal Circuit's doctrinal inconsistency on a claim construction transforms the fundamental principle into a panel-dependent outcome. The competing interpretations reflects the "dissatisfaction with the case-by-case adjudication endorsed by *Phillips*."¹³⁶ *Phillips*' vague standard allows for flexibility but creates turmoil with consistency.¹³⁷ Judges and litigators will always be concerned over what constitutes a correct interpretation. In an analogous setting, statutory and constitutional interpretation has many of the relevant questions which are related to intractable empirical questions.¹³⁸ Because of this, commentators have indicated limiting judges "to a small set of interpretive sources" to lead to more consistent outcomes.¹³⁹ There is no talismanic way to determine the absolute correct way to determine the scope of a patent. Language is difficult and flexible. Patent law standards must reflect this flexibility while promoting standards all can use.

Although, there is much exploration on this topic which warrants further research. First, there are more cases from the presumption and holistic line of cases which can be reviewed. Second, these cases could be analyzed under the sliding scale analysis. This would require meticulous research of the facts. Additionally, the record may be silent on the patentee or the person of ordinary skill in the art. Third, the "Third step: determining the presumption to overcome the

¹³³ *Teva*, 574 U.S. at 330 (citing *Markman*, 517 U.S. at 389–90).

¹³⁴ *Id.* at 338 (Thomas, J., dissenting).

¹³⁵ Curtis, *supra* note 4.

¹³⁶ Reilly, *supra* note 49, at 264.

¹³⁷ *Id.*

¹³⁸ *Id.*

¹³⁹ *Id.*

broad interpretation” could be a question of fact, which a judge could not rule as a matter of law. Ultimately, having clear and consistent standards of claim interpretation is vital to the U.S. patent system.