

A Patent Panacea? THE PROMISE OF CORBINIZED CLAIM CONSTRUCTION

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A patent’s claims define the scope of a patent-holder’s right to exclude others. Because patent infringement actions often hinge on how a court construes claim terms, the interpretative approach that a court uses has a significant effect on the scope of patent rights.

This article examines claim construction through the lens of contract law. In theory, the Federal Circuit has explicitly rejected the application of contract interpretation principles to claim construction, despite historical acceptance of the patent-contract analogy. In practice, however, the Federal Circuit applies the theory of contract interpretation espoused by Samuel Williston, a theory that focuses on the text of the document itself.

Unfortunately, this approach has resulted in a claim construction jurisprudence that lacks certainty and divides the judiciary. Accordingly, this article argues that courts should construe patent claims by following the theory of contract interpretation outlined by Williston’s rival, Arthur Corbin—a theory that values substance over form. If applied in the patent context, this theory would expand the quality of sources used to interpret a claim and mitigate the problems spawned by the use of a Willistonian approach. In light of these advantages, Corbinized claim construction offers a doctrinal solution to the problems plaguing the Federal Circuit’s current claim construction jurisprudence.

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Introduction

The “correct” method of interpreting any legal document is far from settled. Whether it is a statute, a contract, or some other text, if it contains words, it will probably require interpretation at some point, either by the public, individuals, or courts.¹ Unfortunately, there is no “lawyer’s paradise where all words have a fixed, precisely ascertained meaning . . . and where, if the writer has been careful, a lawyer . . . may sit in his chair, inspect the text, and answer all questions without raising his eyes.”² Accordingly, a vast array of scholarship exists proposing, and critiquing, various methods of interpretation for each of these types of documents.³

¹ See, e.g., 5 JOHN HENRY WIGMORE, A TREATISE ON THE ANGLO-AMERICAN SYSTEM OF EVIDENCE IN TRIALS AT COMMON LAW § 2470, at 404 (2d ed. 1923) (“The truth had finally been recognized that words always need interpretation; that the process of interpretation inherently and invariably means the ascertainment of the association between words and external objects . . . the fact is that there must always be interpretation.”).

² JAMES BRADLEY THAYER, A PRELIMINARY TREATISE ON EVIDENCE AT THE COMMON LAW 428–29 (2d ed. 1898); see also *Towne v. Eisner*, 245 U.S. 418, 425 (1918) (Holmes, J.) (“A word is not a crystal, transparent and unchanged, it is the skin of a living thought and may vary greatly in color and content according to the circumstances and the time in which it is used.”).

³ See, e.g., Lawrence Friedman, *Judicial Construction of Written Documents*, 59 NW. U. L. REV. 751, 753 (1965) (“The Anglo-American rules for interpreting written documents are many and variable. Some are verbose, some pithy; some are specific, some general; some are statutory, some judge-made.”). See generally Larry A. DiMatteo, *Reason and Context: A Dual Track Theory of Interpretation*, 109 PENN. ST. L. REV. 397 (2004) (outlining competing theories of contract interpretation); R. Randall Kelso, *Styles of Constitutional Interpretation and the Four Main Approaches to Constitutional Interpretation in American Legal History*, 29 VAL. U. L. REV. 121 (1994) (outlining competing theories of constitutional interpretation); Cass R. Sunstein, *Interpreting Statutes in the Regulatory State*, 103 HARV. L. REV. 405 (1989) (outlining competing theories of statutory interpretation).

A recurring theme in interpretative debates is the question of form versus substance.⁴ Some scholars argue for the strict interpretation of legal documents, narrowly interpreting them based primarily, if not completely, on the text itself.⁵ In contrast, other scholars argue for the broad interpretation of legal documents, seeking to interpret these documents in a manner that effectuates the substance and underlying purpose.⁶ Central to this debate is the role that extrinsic evidence, or evidence outside of the text itself, should play in interpretation.⁷

Unsurprisingly, a similar debate is occurring over the best method of interpreting a patent.⁸ Since its creation in 1982, the United States Court of Appeals for the Federal Circuit, which retains exclusive jurisdiction over appeals in patent cases,⁹ has been sharply divided over this precise question.¹⁰ Specifically, the court has split over the proper method of interpreting a patent's "claims,"¹¹—single-sentence statements at the end of the patent document which define the scope of the patented invention.¹² When a patent-holder brings an infringement action to enforce his or her patent rights, these claims must be interpreted, a process that is known as claim construction.¹³

Given the broad protections provided to patent-holders in the United States, the interpretative approach used by the Federal Circuit can have a significant impact.¹⁴ A patent gives its owner the power to prevent others from

⁴ See Avery Wiener Katz, *The Economics of Form and Substance in Contract Interpretation*, 104 COLUM. L. REV. 496, 496 (2004) (noting that "almost all applications of legal doctrine turn on questions of interpretation; and almost all questions of interpretation implicate the tension between form and substance"). Indeed, some scholars have traced debates over this issue back to early English common law courts. See, e.g., 5 WIGMORE, *supra* note 1, § 2470, at 402–03.

⁵ See, e.g., Frank Easterbrook, *Statutes' Domain*, 50 U. CHI. L. REV. 533 (1983); see also Sunstein, *supra* note 3, at 415–24.

⁶ See, e.g., William N. Eskridge, Jr., *Public Values in Statutory Interpretation*, 137 U. PA. L. REV. 1007, 1017–19 (1989); see also Sunstein, *supra* note 3, at 424–28.

⁷ See, e.g., Felix Frankfurter, *Some Reflections on the Reading of Statutes*, 47 COLUM. L. REV. 527, 529 (1947) ("I should say that the troublesome phase of construction is the determination of the extent to which extraneous documentation and external circumstances may be allowed to infiltrate the text on the theory that they were part of it, written in ink discernible to the judicial eye.").

⁸ See, e.g., Timothy R. Holbrook, *Substantive Versus Process-Based Formalism in Claim Construction*, 9 LEWIS & CLARK L. REV. 123 (2005); John R. Thomas, *Formalism at the Federal Circuit*, 52 AM. U. L. REV. 771 (2003).

⁹ See 28 U.S.C. § 1295(a)(4) (2006).

¹⁰ See, e.g., Craig Allen Nard, *A Theory of Claim Interpretation*, 14 HARV. J.L. & TECH. 1, 4–5 (2000) (outlining hypertextualism and pragmatic textualism as two schools of interpretation used by the Federal Circuit); R. Polk Wagner & Lee Petherbridge, *Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance*, 152 U. PA. L. REV. 1105, 1133–34 (2004) (outlining two distinct methodologies in the Federal Circuit's claim construction jurisprudence).

¹¹ See, e.g., Nard, *supra* note 10, at 4–5; Wagner & Petherbridge, *supra* note 10, at 1170–71.

¹² See, e.g., Christopher A. Cotropia, *Patent Claim Interpretation Methodologies and Their Claim Scope Paradigms*, 47 WM. & MARY L. REV. 49, 53–54 (2005).

¹³ E.g., *id.* at 54; Kelly Casey Mullally, *Patent Hermeneutics: Form and Substance in Claim Construction*, 59 FLA. L. REV. 333, 336–37 (2007).

¹⁴ See 35 U.S.C. § 271(a) (2006) ("Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or

making, using, offering to sell, or selling the patented invention.¹⁵ These broad rights last for twenty years¹⁶ and include potentially broad remedies such as treble damages,¹⁷ attorney's fees,¹⁸ and injunctive relief.¹⁹ In recent years, patent-holders have attempted to use these broad remedies against Microsoft for the use of minor patented software components in Microsoft Office,²⁰ as well as in an attempt to shut down the maker of the "Blackberry."²¹ Getting claim construction right is therefore of vital importance in patent law—the broader the claim, the more powerful the patent.

This article's thesis is twofold. First, despite the Federal Circuit's assertions to the contrary, its approach to claim construction resembles the contract interpretation theory espoused by Samuel Williston: a model focused on the plain meaning of the text of the patent document. Second, the Willistonian approach is inapt; the court should instead construe claims according to Arthur Corbin's theory of contract interpretation, which would look at the subjective intent of the patentee and the patent examiner, provide a greater role for extrinsic evidence, and address some of the problems that have arisen under the current framework.²² Part I provides a background on claims, claim construction, and the Federal Circuit's current jurisprudence, including how the court has explicitly rejected a claim construction methodology based on contract law. Part II sets forth Williston's method of contract interpretation and describes how the Federal Circuit, despite its explicit rejection of the patent-contract analogy, implicitly

imports into the United States any patented invention during the term of the patent therefor[e], infringes the patent.").

¹⁵ See *id.*; see also 35 U.S.C. § 154(a)(1) (2006) ("Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, of the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States, and, if the invention is a process, of the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof.").

¹⁶ See 35 U.S.C. § 154(a)(2).

¹⁷ See *id.* § 284.

¹⁸ See *id.* § 285.

¹⁹ See *id.* § 283 ("The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable."); see also *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391–92 (2006) (outlining equitable principles that a court should consider when determining whether injunctive relief is appropriate).

²⁰ See *z4 Techs., Inc. v. Microsoft Corp.*, 507 F.3d 1340, 1345–46 (Fed. Cir. 2007). The Federal Circuit affirmed a jury verdict of \$25 million against Microsoft in the case. *Id.* at 1346. In another recent case, a \$1.52 billion verdict was reached against Microsoft, but this verdict was later vacated. See John Markoff, *Judge Sets Aside Record \$1.5 Billion Verdict Against Microsoft in MP3 Case*, N.Y. TIMES, Aug. 7, 2007, at C3.

²¹ See *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282 (Fed. Cir. 2005). The district court found against the maker of Blackberries and awarded over \$53 million in damages as well as an injunction against future infringement, *id.* at 1287, which was affirmed-in-part, reversed-in-part, vacated-in-part, and remanded on appeal. See *id.* at 1325–26.

²² This article argues in favor of applying Corbin's "substance" theory of interpretation to patent claims. It takes no position on whether this interpretative theory is appropriate in other areas of the law.

applies this framework to patent claim construction. Finally, Part III discusses Corbin's interpretative approach and shows how it provides a better framework for the interpretation of patent claims by focusing on an inventor's intent, expanding the quantity and quality of the evidentiary tools available for claim construction, and minimizing the uncertainty created by the Federal Circuit's current jurisprudence.

I. Background

A. *The Role of Claims and the Significance of Claim Construction*

Patents in the United States consist of a written description, drawings, and claims.²³ These various parts describe the invention being patented and teach those skilled in that particular field how to make and use it.²⁴ The description concludes with one or more claims, which “point[] out and distinctly claim[] the subject matter which the applicant regards as his invention.”²⁵ The inclusion of claims in a patent, as well as their location within the patent document itself, is statutorily mandated.²⁶

But what exactly does a claim look like? Claims can exist in either independent or dependent form.²⁷ An independent claim typically includes a preamble that generally describes the elements or steps of a claimed combination, a phrase such as “comprising” or “wherein the improvement comprises,” and the elements which the applicant considers to be his or her invention.²⁸ In contrast, a dependent claim incorporates a prior independent claim and provides an additional limitation.²⁹ Further, the Patent and Trademark Office, the agency charged with making the initial determination on whether a patent should be granted, requires claims to be drafted as a single sentence.³⁰

For example, a recently issued patent covered an “edible flying retrievable animal toy.”³¹ Essentially, the invention was a Frisbee-shaped dog toy made of

²³ See 35 U.S.C. § 112 (2006). For an extensive discussion of the historical development of claims, see 5 DONALD S. CHISUM, CHISUM ON PATENTS § 18.02 (2007).

²⁴ See 35 U.S.C. § 112.

²⁵ *Id.*

²⁶ See *id.* (stating that “[t]he specification *shall* conclude with one or more claims” (emphasis added)). Thus, claims are mandatory and they must appear at the end of the patent document. See *id.*

²⁷ See 35 U.S.C. § 112 (“A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.”).

²⁸ *E.g.*, 37 C.F.R. § 1.75(e) (2008).

²⁹ See 35 U.S.C. § 112 (“Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.”).

³⁰ See, *e.g.*, U.S. PATENT & TRADEMARK OFFICE, U.S. DEP'T OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE § 608.01(m) (8th ed., 6th rev. 2007) [hereinafter MPEP]; see also 1 R. CARL MOY, MOY'S WALKER ON PATENTS § 4:95 (4th ed. 2007).

³¹ See U.S. Patent No. 6,725,809 (filed Feb. 26, 2003) (issued Apr. 27, 2004).

rawhide.³² An independent claim from the patent read as follows: “An edible flying retrievable animal toy, comprising: a circular body member having a convex upper surface and a concave lower surface wherein the body member is formed of rawhide.”³³ A dependent claim incorporated this independent claim, along with an additional limitation: “The animal toy of claim 1 wherein the rawhide is flavored.”³⁴

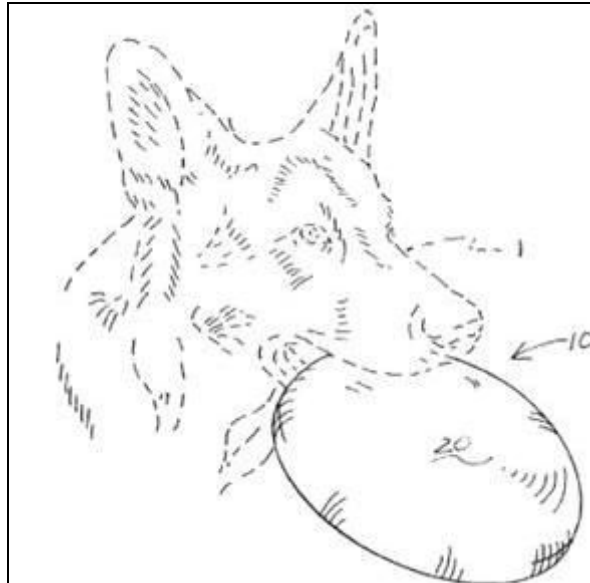


Fig. 1. Drawing from Edible Flying Retrievable Animal Toy Patent

The claims of an issued patent are often significantly different from the claims that were originally submitted to the PTO by the inventor.³⁵ After a patent application is submitted to the PTO, that application is assigned to a patent examiner, a “quasi-judicial official” who, as a general matter, represents the PTO and the public during a patent’s prosecution.³⁶ As part of this process, the patent examiner and the inventor engage in a dialogue, amending claims as needed in

³² See *id.*

³³ *Id.*

³⁴ *Id.*

³⁵ See, e.g., 1 MOY, *supra* note 30, § 3:18 (noting that amendments to patent applications are common during patent prosecution).

³⁶ See *W. Elec. Co., Inc. v. Piezo Tech., Inc.*, 860 F.2d 428, 431–32 (Fed. Cir. 1988) (citing numerous cases for the proposition that a patent examiner is a “quasi-judicial official”); see also 35 U.S.C. § 131 (2006) (“The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor[e].”). See generally Michael Risch, *The Failure of Public Notice in Patent Prosecution*, 21 HARV. J.L. & TECH. 179, 182–84 (2007) (summarizing the patent prosecution process). For a more extensive discussion of this process, see 4 CHISUM, *supra* note 23, § 11.03.

order for the patent to satisfy the statutory requirements for validity.³⁷ The records of all of the PTO proceedings involving the patent application, including representations made by the applicant about the scope of the patent's claims, are called the patent's prosecution history.³⁸

Claims serve two similar purposes. First, claims "set[] the metes and bounds of the invention entitled to the protection of the patent system."³⁹ In other words, claims define a patent's scope and thus the subject matter over which the patentee can claim a monopoly.⁴⁰ For example, returning to the "edible flying retrievable animal toy,"⁴¹ the claims describe the scope of the invention—a Frisbee-shaped retrievable toy consisting of rawhide would fall within the claim, whereas a retrievable toy in the shape of a tennis ball would not.

Claims also serve a notice function.⁴² As the Federal Circuit noted, "one of ordinary skill in the art should be able to read a patent, to discern which matter is disclosed and discussed in the written description, and to recognize which matter has been claimed."⁴³ Accordingly, an edible animal toy manufacturer should be able to read the patent and know whether one of its planned products

³⁷ See 35 U.S.C. § 131; *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) ("The process of patent prosecution is an interactive one."); John R. Thomas, *On Preparatory Texts and Proprietary Technologies: The Place of Prosecution Histories in Patent Claim Interpretation*, 47 UCLA L. REV. 183, 184 (1999) (noting the development of claims following a "dialogue between applicant and Patent Office examiner").

³⁸ See, e.g., *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc); *Vitronics Corp. v. Conceptronc, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (noting that prosecution history "contains the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims").

³⁹ *Zenith Labs., Inc. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1424 (Fed. Cir. 1994); see *Phillips*, 415 F.3d at 1312 ("It is a 'bedrock principle' of patent law that 'the claims of a patent define the invention to which the patentee is entitled the right to exclude.'" (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004))); see also *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 336 U.S. 271, 277 (1949), *aff'd on r'hrq by* 339 U.S. 605 (1950) ("We have frequently held that it is the claim which measures the grant to the patentee."); *McClain v. Ortmyer*, 141 U.S. 419, 424 (1891) (stating that "[t]he claim is the measure of [the patentee's] right to relief").

⁴⁰ See, e.g., *Datamize L.L.C. v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005) (noting that "claims perform the fundamental function of delineating the scope of the invention"); see also *Cotropia*, *supra* note 12, at 65 ("The claim tells the public the patent's particular scope of exclusivity by defining the patent grant's metes and bounds.").

⁴¹ See *supra* notes 32–33 and accompanying text.

⁴² See *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29 (1992) (noting the "definitional and public-notice functions of the statutory claiming requirement"); *Vitronics Corp.*, 90 F.3d at 1583 ("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."); *Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948, 951 (Fed. Cir. 1993) (noting "the function of claims in putting competitors on notice of the scope of the claimed invention").

⁴³ *PSC Computer Prods., Inc. v. Foxconn Int'l Inc.*, 355 F.3d 1353, 1359 (Fed. Cir. 2004); see also *Cotropia*, *supra* note 12, at 62 ("A patent claim seeks to inform the public of the subject matter over which the patent provides exclusivity.").

falls within the patent's scope. In light of these significant functions, as Judge Giles Rich famously wrote, "the name of the game is the claim."⁴⁴

In order to accomplish these goals, however, the actual words of a claim must be interpreted.⁴⁵ Through claim interpretation, a court seeks to give a fixed and definite meaning to the words of a claim, regardless of the context in which the interpretation occurs.⁴⁶ A patentee cannot argue for differing interpretations of a claim in different situations.⁴⁷

The process of interpreting claims can occur in a variety of contexts by a variety of actors.⁴⁸ For example, a business could interpret a claim when developing new products or technologies.⁴⁹ If the business's interpretation indicated that its activity might infringe the patent, it may decide to design around the patent or seek a license from the patentee.⁵⁰ Notably, many commentators dispute whether businesses actually interpret, or even look at, patents in practice.⁵¹

Arguably, the most important context in which claim interpretation occurs, and the context on which this article focuses, is patent infringement litigation.⁵²

⁴⁴ Giles S. Rich, *Extent of Protection and Interpretation of Claims—American Perspectives*, 21 INT'L REV. INDUS. PROP. & COPYRIGHT L. 497, 499 (1990).

⁴⁵ See, e.g., Cotropia, *supra* note 12, at 54 ("In a vacuum, claim terms are of little use. They must be interpreted and given meaning so they can be used in a given context."); see also *supra* note 1 and accompanying text.

⁴⁶ See, e.g., Mark A. Lemley, *The Changing Meaning of Patent Claim Terms*, 104 MICH. L. REV. 101, 103 (2005) (noting that "courts give claims a single meaning in any given case, engaging in only one act of claim construction for any given patent").

⁴⁷ See, e.g., *id.*; see also *White v. Dunbar*, 119 U.S. 47, 51–52 (1886) ("Some persons seem to suppose that a claim in a patent is like a nose of wax, which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express."); *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1583 (Fed. Cir. 1991) (noting that "claims must be construed the same way for validity and for infringement").

⁴⁸ See, e.g., *Wagner & Petherbridge*, *supra* note 10, at 1118 (noting that "claim construction is undertaken by a variety of public and private actors").

⁴⁹ See *Nard*, *supra* note 10, at 4; see also *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1358 (Fed. Cir. 2005) ("The ability to discern both what has been disclosed and what has been claimed is the essence of public notice. It tells the public which products or processes would infringe the patent and which would not."). When a patent is granted (or eighteen months after an application is filed), the PTO is required to publish the application. See 35 U.S.C. § 122(b) (2000 & Supp. V 2005).

⁵⁰ See *Nard*, *supra* note 10, at 40–41; see also *Slimfold Mfg. Co., Inc. v. Kinkead Indus., Inc.*, 932 F.2d 1453, 1457 (Fed. Cir. 1991) ("Designing around patents is, in fact, one of the ways in which the patent system works to the advantage of the public in promoting progress in the useful arts, its constitutional purpose."). For a more extensive discussion of design-around theory, see generally Paul N. Katz & Robert R. Riddle, *Designing Around a United States Patent*, 45 S. TEX. L. REV. 647 (2004).

⁵¹ See, e.g., Mark A. Lemley, *Ignoring Patents*, 2008 MICH. ST. L. REV. 19, 21.

⁵² See, e.g., Lemley, *supra* note 46, at 101 ("One of the most significant aspects of patent litigation is 'claim construction,' the process of defining the words of the claim in other, theoretically clearer words.").

An increasing number of patent infringement cases are filed each year.⁵³ In most of these cases, claim construction is the first inquiry.⁵⁴ The ultimate goal for a court when interpreting terms in a claim is to provide a fixed meaning which can then be compared with the allegedly infringing device.⁵⁵ However, even though it is only the first step, it is usually determinative. Shortly after a district court's claim construction, infringement cases typically resolve via summary judgment or settlement.⁵⁶ As a result, "litigants usually spend significant resources disputing the meaning of each claim term at issue in a suit."⁵⁷

⁵³ From September 2007 to September 2008, almost three thousand patent infringement suits were filed. See ADMIN. OFFICE OF THE U.S. COURTS, 2008 ANNUAL REPORT OF THE DIRECTOR: JUDICIAL BUSINESS OF THE UNITED STATES COURTS 205 tbl.C-11 (2009) [hereinafter 2008 ANNUAL REPORT]. Further, at the end of the same period, over 3600 suits remained pending. See *id.* The number of these suits has steadily increased over the past twenty years. See, e.g., Jean O. Lanjouw & Mark Schankerman, *Protecting Intellectual Property Rights: Are Small Firms Handicapped?*, 47 J.L. & ECON. 45, 45 (2004) (noting the "very rapid growth in patent litigation over the past [two] decades, during which the number of patent suits increased almost [ten]-fold"); see also Gauri Prakash-Canjels, *Trends in Patent Cases*, 41 IDEA 283, 284 (2001) (showing that from 1990 to 2000, the total number of filed patent infringement cases increased by 111%).

⁵⁴ See, e.g., *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (en banc); *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1581-82 (Fed. Cir. 1996); see also *Abbott Labs. v. Sandoz*, 544 F.3d 1341, 1358 (Fed. Cir. 2008) ("The first step in most infringement suits is the procedure called 'claim construction,' where the scope of the claim is defined by the court.").

⁵⁵ See, e.g., *Chimie v. PPG Indus., Inc.*, 402 F.3d 1371, 1377 (Fed. Cir. 2005) ("Courts construe claim terms in order to assign a fixed, unambiguous, legally operative meaning to the claim.").

⁵⁶ See Lemley, *supra* note 46, at 108 ("Claim construction is often outcome-determinative in infringement cases; once the patent claims have been construed summary judgment for one side or the other is quite common."); see also MANUAL FOR COMPLEX LITIGATION (FOURTH) § 33.22 (2004) (noting that "many patent cases are resolved once the claim construction is decided, either through summary judgment or settlement, with substantial savings in judicial time and resources that would otherwise be spent in a lengthy, often complicated trial"); Patent Litigation Committee, Am. Intell. Prop. L. Ass'n, *The Interpretation of Patent Claims*, 32 AIPLA Q.J. 1, 5 (2004) [hereinafter *Interpretation of Patent Claims*] ("Given the great impact claim construction may have on the outcome of a case, the court's construction of the claims of a patent may be case dispositive or drastically affect the prospect of settlement."). But see Arti Rai, *Engaging Facts and Policy: A Multi-Institutional Approach to Patent System Reform*, 103 COLUM. L. REV. 1035, 1059 (2003) (citing a 1999 survey indicating that only 29% of patent infringement cases settle based on a trial court's claim construction). Indeed, a party's failure to settle or dismiss an infringement suit following an adverse claim construction decision has caused some courts to award attorney's fees to the opposing party. See, e.g., *Thomas & Betts Power Solutions, L.L.C. v. Power Distrib., Inc.*, No. 3:07CV167-HEH, 2008 WL 373639, at *2-3 (E.D. Va. Feb. 8, 2008) (finding a case "exceptional" pursuant to 35 U.S.C. § 285 based on a party's "disturbing litigation strategy" that unnecessarily prolonged litigation following an adverse claim construction ruling).

⁵⁷ *Interpretation of Patent Claims*, *supra* note 56, at 5; see also John M. Golden, *Construing Patent Claims According to Their "Interpretative Community": A Call for an Attorney-Plus-Artisan Perspective*, 21 HARV. J.L. & TECH. 321, 322 (2008) (noting that because so much is at stake, claim construction is "one of the most contentious and difficult tasks of modern patent law").

B. The Federal Circuit's Current Claim Construction Jurisprudence

The primary jurisprudential foundations for the Federal Circuit's current claim construction framework can be traced back to 1995, when the en banc court in *Markman v. Westview Instruments, Inc.* decided that judges, not juries, construe patent claims.⁵⁸ As the Supreme Court stated when affirming this decision, "the construction of a patent, including terms of art within its claim, is exclusively within the province of the court."⁵⁹ Because judges construe claims, claim construction is reviewed on appeal without deference, using a de novo standard.⁶⁰

When interpreting claim language, a court looks at the text of the claims and gives terms their "ordinary and customary meaning."⁶¹ The perspective used is "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application."⁶² Thus, a court applies an objective standard when ascertaining a claim's meaning.⁶³

One of the more hotly contested issues in the court's jurisprudence has been the types of evidence that a judge may consider when construing claims.⁶⁴ In 1996, the Federal Circuit attempted to address this issue in *Vitronics Corp. v. Conceptor, Inc.*⁶⁵ In *Vitronics*, the court outlined a process for judges to use when engaging in claim construction.⁶⁶ The court began its analysis by noting that when interpreting a disputed claim, the first inquiry is to examine the intrinsic evidence of a patent, specifically the "words of the claims themselves."⁶⁷ Even though words are given their "ordinary and customary meaning, a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning," provided that "the special definition . . . is stated in the patent specification or file history."⁶⁸ Next, a court can examine additional intrinsic evidence, particularly the specification, which the court described as "the single best guide to the meaning of a disputed term."⁶⁹

The *Vitronics* court went on to address the admissibility of extrinsic evidence—i.e., "evidence which is external to the patent and file history, such as expert testimony, inventor testimony, dictionaries, and technical treatises and

⁵⁸ 52 F.3d 967, 970–71 (Fed. Cir. 1995) (en banc).

⁵⁹ *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996).

⁶⁰ *See Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1456 (Fed. Cir. 1998) (en banc)

(concluding that claim construction is a purely legal issue that is reviewed de novo).

⁶¹ *E.g.*, *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc).

⁶² *Id.*

⁶³ *See id.*

⁶⁴ *See, e.g.*, Mullally, *supra* note 13, at 362–63.

⁶⁵ 90 F.3d 1576 (Fed. Cir. 1996).

⁶⁶ *Id.* at 1582–83.

⁶⁷ *Id.* at 1582 (noting that "intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language").

⁶⁸ *Id.* "File history" refers to the patent's prosecution history, which can also be considered. *See id.* at 1582–83.

⁶⁹ *Id.* at 1582.

articles.”⁷⁰ According to the court, if intrinsic evidence resolves any ambiguity in the disputed claim term, “it is improper to rely on extrinsic evidence.”⁷¹ Further, extrinsic evidence “may be used only to help the court come to the proper understanding of claims; it may not be used to vary or contradict the claim language.”⁷² Thus, the *Vitronics* decision limited the use of extrinsic evidence for purposes of claim construction.

Six years later, however, the Federal Circuit adopted a more flexible approach to the role of extrinsic evidence, or at least certain types of extrinsic evidence, in *Texas Digital Systems, Inc. v. Telegenix, Inc.*⁷³ In *Texas Digital*, the court began by reaffirming that claim terms are interpreted in order to ascertain their ordinary meaning to a person having ordinary skill in the relevant art (“PHOSITA”).⁷⁴ The court then outlined relevant precedent holding that “dictionaries, encyclopedias, and treatises are particularly useful resources to assist the court in determining the ordinary and customary meanings of claim terms.”⁷⁵ Part of the reason for this special role is that these sources are publicly available and provide objective, reliable sources of information as to the established meaning of claim terms.⁷⁶

In order to adapt claim construction to account for the elevated role of dictionaries and similar sources, the *Texas Digital* court offered a new process for claim construction.⁷⁷ First, the court emphasized that dictionaries could appropriately be consulted at any point by a judge faced with construing the claims of a patent.⁷⁸ In fact, a dictionary definition was the presumed meaning of a disputed claim term.⁷⁹ After this initial use of a dictionary, the intrinsic record could be consulted either to select the correct dictionary definition or to determine whether the patentee had acted as his or her own lexicographer and provided a different definition.⁸⁰ Intrinsic evidence could also reveal a disavowal of claim scope.⁸¹ Thus, *Texas Digital* reexamined the process outlined in *Vitronics* and elevated the role of specific types of extrinsic evidence in claim construction.

In *Phillips v. AWH Corp.*, an en banc opinion, the Federal Circuit endeavored to resolve this conflicting precedent and provide guidance to lower courts.⁸² In outlining the appropriate interpretative framework, the court began by

⁷⁰ *Id.* at 1584.

⁷¹ *Id.* at 1583.

⁷² *Id.* at 1584.

⁷³ 308 F.3d 1193 (Fed. Cir. 2002).

⁷⁴ *Id.* at 1202 (“The terms used in the claims bear a ‘heavy presumption’ that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.”).

⁷⁵ *Id.*

⁷⁶ *Id.* at 1202–03.

⁷⁷ *See id.* at 1203–04.

⁷⁸ *Id.* at 1203.

⁷⁹ *See id.* at 1203–04.

⁸⁰ *See id.*

⁸¹ *Id.* at 1204.

⁸² 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

noting that the primary interpretative aid is intrinsic evidence.⁸³ Accordingly, because claims are part of the specification, the court reaffirmed the principle from *Vitronics* that the specification provides the “single best guide to the meaning of a disputed term.”⁸⁴ A court should therefore examine how the disputed term is used in the context of the claim itself.⁸⁵ Additional claims within the same patent also provide a “valuable source[] of enlightenment as to the meaning of a claim term,”⁸⁶ as well as the patent’s written description.⁸⁷

The court also reaffirmed that another relevant intrinsic source is the patent’s prosecution history.⁸⁸ Because this history “provides evidence of how the PTO and the inventor understood the patent,” as well as the fact that it was “created by the patentee in attempting to explain and obtain the patent,” it can have relevance for purposes of claim construction.⁸⁹ However, the lack of clarity and finality of this negotiation between the PTO and the patentee makes it “less useful for claim construction purposes.”⁹⁰

The court in *Phillips* also implicitly adopted the limited role for extrinsic evidence outlined in *Vitronics*.⁹¹ Extrinsic evidence is essentially any evidence that is not intrinsic.⁹² According to the court, such evidence is “less reliable than the patent and its prosecution history in determining how to read claim terms.”⁹³ Thus, the court rejected the process and elevated position of dictionaries outlined in *Texas Digital*.⁹⁴

Helmsderfer v. Bobrick Washroom Equipment, Inc. provides an example of how the court applies this interpretative framework.⁹⁵ In *Helmsderfer*, the patented invention was a vandalism-resistant baby diaper changing station.⁹⁶ Specifically, the patent provided for a wall-mounted station where the changing table could fold against the wall when it was not in use.⁹⁷ The claim at issue

⁸³ *See id.* at 1314–17.

⁸⁴ *Id.* at 1315 (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)).

⁸⁵ *Id.* at 1314. For example, the use of a modifier or adjective with the disputed term limits the breadth of that term’s definition. *Id.* Specifically, in *Phillips*, the claim referred to “steel baffles,” which the Federal Circuit noted “strongly implies that the term ‘baffles’ does not inherently mean objects made of steel.” *Id.*

⁸⁶ *Id.* As the Federal Circuit noted, “[b]ecause claim terms are normally used consistently throughout the patent, the usage of a term in one claim can often illuminate the meaning of the same term in other claims.” *Id.*

⁸⁷ *Id.* at 1317 (“It is therefore entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims.”).

⁸⁸ *Id.*

⁸⁹ *Id.*

⁹⁰ *Id.*

⁹¹ *See id.* at 1319 (“In sum, extrinsic evidence may be useful to the court, but it is unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence.”).

⁹² *See id.* at 1317.

⁹³ *Id.* at 1318.

⁹⁴ *See id.* at 1320–23.

⁹⁵ 527 F.3d 1379 (Fed. Cir. 2008).

⁹⁶ *Id.* at 1380.

⁹⁷ *Id.* Claim one of the patent stated:

stated that when the table was folded against the wall, the top surface was “partially hidden from view and the bottom surface is exposed for view.”⁹⁸ The dispute was whether the term “partially” included “completely.”⁹⁹

In resolving this dispute, the court began by examining the patent’s intrinsic evidence.¹⁰⁰ First, the court noted that the patentee’s argument rested solely on the premise that the plain meaning of “partially” included “completely,” and not that it had provided a unique definition based on the written description.¹⁰¹ Next, the court noted that the specification never used the claim language at issue and, accordingly, provided no guidance.¹⁰² Since the parties stipulated that the prosecution history did not give any insight either, the court concluded that intrinsic evidence did not provide a clear meaning of “partially hidden from view.”¹⁰³ For that reason, the court could appropriately examine extrinsic evidence, specifically, several dictionary definitions.¹⁰⁴ Based on these sources, the court concluded that “the ordinary and customary meaning of the term ‘partially’ excludes ‘totally.’”¹⁰⁵

In addition to the *Phillips* framework, the Federal Circuit has outlined several “canons” of claim construction.¹⁰⁶ Courts use these canons when applying various interpretative tools, but “no canon of construction is absolute in its application.”¹⁰⁷ For example, courts will use a patent’s written description to help

A wall-mounted station for changing the diapers of a baby comprising:
a support platform having top and bottom surfaces and opposing sides, the support platform being hingedly fixable at one side with respect to a wall; the support platform being movable between a closed position up against a wall wherein the platform top surface is *partially hidden from view* and the bottom surface is exposed for view and an opened position hinged away from a wall wherein the support platform is disposed generally perpendicular to a wall and the top surface is exposed for receiving a baby;
a generally flat protective panel, formed of a non-glass, abrasion-resistant material, the platform bottom surface being configured for receiving said panel such that said panel overlies at least a portion of the platform bottom surface and covers the exposed bottom surface of the platform when the support platform is in a closed position to create vandalism proof support platform for reducing the effects of graffiti and abrasions on the platform and for improving the inner decor of a facility in which the changing station is installed.

U.S. Patent No. 6,049,928 (filed Jan. 27, 1998) (issued Apr. 18, 2000) (emphasis added).

⁹⁸ U.S. Patent No. 6,049,928.

⁹⁹ See *Helmsderfer*, 527 F.3d at 1381–82.

¹⁰⁰ *Id.* at 1381.

¹⁰¹ *Id.*

¹⁰² See *id.* at 1381–82.

¹⁰³ *Id.* at 1382 & n.2.

¹⁰⁴ *Id.* at 1382–83.

¹⁰⁵ *Id.* at 1383; see also *id.* (“In this case there is only one ordinary meaning attributable to the word ‘partially’ and this meaning does not include ‘totally.’”).

¹⁰⁶ See, e.g., *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1341–48 (Fed. Cir. 2001) (outlining common canons of claim construction utilized by the Federal Circuit); *Cotropia*, *supra* note 12, at 73–74 (describing the various canons of claim construction).

¹⁰⁷ *Renishaw P.L.C. v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998); see also *Modine Mfg. Co. v. U.S. Int’l Trade Comm’n*, 75 F.3d 1545, 1551 (Fed. Cir. 1996) (“All

ascertain the meaning of a term in a claim, but will not use it to impose restrictions on the claim's scope.¹⁰⁸ Further, the canon of claim differentiation provides that each claim within a patent should be interpreted as having a different meaning.¹⁰⁹ Other canons include construing claims to preserve their validity¹¹⁰ and not construing a claim to exclude the preferred embodiment of an invention.¹¹¹

C. *Patents and Contracts*

1. The Patent-Contract Analogy

Historically, patents have been compared to contracts, primarily because the theoretical underpinnings of patent law coincide with the underlying contractual concept of a bargain. In order for a contract to exist, a bargain is generally required.¹¹² A bargain consists of “a manifestation of mutual assent to the exchange and a consideration.”¹¹³

This bargaining dynamic also exists in patent law. Congress's constitutional power to create the patent system hinges on its ability to promote progress in “Science and the useful Arts.”¹¹⁴ As a result, the Supreme Court

rules of construction must be understood in terms of the factual situations that produced them, and applied in fidelity to their origins.”)

¹⁰⁸ See, e.g., *Renishaw P.L.C.*, 158 F.3d at 1248 (“Renishaw, of course, alludes to a familiar pair of claim construction canons: (a) one may not read a limitation into a claim from the written description, but (b) one may look to the written description to define a term already in a claim limitation, for a claim must be read in view of the specification of which it is a part. These two rules lay out the general relationship between the claims and the written description.”).

¹⁰⁹ See, e.g., *Ecolab, Inc. v. Paraclypse, Inc.*, 285 F.3d 1362, 1375 (Fed. Cir. 2002) (“Under the doctrine of claim differentiation, ‘each claim in a patent is presumptively different in scope.’ This presumption is especially strong where ‘there is a dispute over whether a limitation found in a dependent claim should be read into an independent claim, and that limitation is the only meaningful difference between the two claims.’” (quoting *Intermatic Inc. v. Lamson & Sessions Co.*, 273 F.3d 1355, 1364 (Fed. Cir. 2001)) (internal citation omitted)).

¹¹⁰ See, e.g., *Smith v. Snow*, 294 U.S. 1, 14 (1935) (“[I]f the claim were fairly susceptible to two constructions, that should be adopted which will secure to the patentee his actual invention”); *Modine Mfg. Co.*, 75 F.3d at 1557 (“When claims are amenable to more than one construction, they should when reasonably possible be interpreted so as to preserve their validity.”).

¹¹¹ See, e.g., *Primos, Inc. v. Hunter's Specialties, Inc.*, 451 F.3d 841, 848 (Fed. Cir. 2006) (“While we are mindful that we cannot import limitations from the preferred embodiments into the claim, we also should not normally interpret a claim term to exclude a preferred embodiment.” (citing *Burke, Inc. v. Bruno Indep. Living Aids, Inc.*, 183 F.3d 1334, 1341 (Fed. Cir. 1999))).

¹¹² See, e.g., RESTATEMENT (SECOND) OF CONTRACTS § 17(1) (1979). This general rule is subject to exceptions. See *id.* § 17(2). For example, a promise which reasonably induces reliance can be binding, provided that “injustice can be avoided only by enforcement of the promise.” *Id.* § 90.

¹¹³ *Id.* § 17(1); see also *id.* § 3 (“A bargain is an agreement to exchange promises or to exchange a promise for a performance or to exchange performances.”).

¹¹⁴ U.S. CONST. art. 1, § 8 (“The Congress shall have the power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . .”); see also *Graham v. John Deere Co.*, 383 U.S. 1, 5–6 (1966) (“This qualified authority . . . is limited to the promotion of advances in the ‘useful arts.’ . . . The Congress in the exercise of the patent power may not overreach the restraints

noted, the modern patent system “represents a carefully crafted bargain,” which is designed to encourage the creation of new technology and ensure its disclosure to the public.¹¹⁵ An inventor receives a monopoly in his or her invention, in return for the public receiving the benefits of the disclosure of information into the public domain and the incentivizing of inventions generally.¹¹⁶ Historically, courts viewed this bargain as the basis for recognizing that a patent is a contract.¹¹⁷ Accordingly, some courts argued that principles of contract interpretation should apply when construing patents.¹¹⁸

An additional parallel exists in how a patent is obtained. During the prosecution of a patent application, an examiner at the PTO, representing the public, engages in a series of communications with the applicant.¹¹⁹ Often, this

imposed by the stated constitutional purpose. Nor may it enlarge the patent monopoly without regard to the innovation, advancement or social benefit gained thereby. . . . Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must ‘promote the Progress of useful Arts.’”)

¹¹⁵ *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 63 (1998).

¹¹⁶ *See, e.g.*, *Bonito Boats v. Thunder Craft Boats*, 489 U.S. 141, 150–52 (1989); *Scott Paper Co. v. Marcalus Mfg. Co.*, 326 U.S. 249, 255 (1945); FLOYD L. VAUGHAN, *ECONOMICS OF OUR PATENT SYSTEM* 32 (MacMillan Co. 1925).

¹¹⁷ *See, e.g.*, *Fried. Krupp Aktien-Gesellschaft v. Midvale Steel Co.*, 191 F. 588, 594 (C.C.A.3d 1911) (“Tersely stated, an American patent is a written contract between an inventor and the government. . . . The consideration given on the part of the inventor to the government is the disclosure of his invention in such plain and full terms that any one skilled in the art to which it appertains may practice it. The consideration on the part of the government given to the patentee for such disclosure is a monopoly . . . of the invention disclosed to the extent of the claims allowed in the patent.”); *Davis Airfoils v. United States*, 124 F. Supp. 350, 352 (Ct. Cl. 1954) (“A patent is a contract between the inventor and the public, the terms of which are formulated by the United States Patent Office.”); *United States v. Hartford-Empire Co.*, 73 F. Supp. 979, 981 (D. Del. 1947) (“A patent is a contract between an inventor and the government. The consideration which supports the contract is the inventor’s disclosure of his invention and the government’s grant of an exclusive monopoly for a stated period of time.”). More recently, one commentator viewed patents as unilateral, not bilateral, contracts. *See* Orin S. Kerr, *Rethinking Patent Law in the Administrative State*, 42 WM. & MARY L. REV. 127, 134–41 (2000). Viewing patents substantively as contracts is currently foreclosed by statute. *See* 35 U.S.C. § 261 (2006) (stating that, as a general matter, “patents shall have the attributes of personal property”).

¹¹⁸ *See, e.g.*, *Photo Elecs. Corp. v. England*, 581 F.2d 772, 776 (9th Cir. 1978) (“The patent is a contract between the government and the patentee. The accepted rules for construing contracts should be consulted and applied.”); *Doble Eng’g Co. v. Leeds & Northrup Co.*, 134 F.2d 78, 84 (1st Cir. 1943) (“But the fact remains that patents, like contracts, are bilateral instruments, and this common feature makes the rules for the construction of contracts applicable to them.”); *see also* *Technitrol, Inc. v. Control Data Corp.*, 550 F.2d 992, 997 (4th Cir. 1977) (“Since letters patent are contracts, they should be construed with the interest of the parties in mind to give effect to their legitimate expectations.”); GEORGE TICKNOR CURTIS, *A TREATISE ON THE LAW OF PATENTS FOR USEFUL INVENTIONS IN THE UNITED STATES OF AMERICA* xxxvi (1849) (noting that “a patent should be construed as, what it really is in substance, namely, a contract or bargain between the patentee and the public”); JOHN BARKER WAITE, *PATENT LAW* 271 (1920) (stating that when interpreting patents, “[t]he ordinary rules for the construction of contracts apply”).

¹¹⁹ *See* 35 U.S.C. § 131 (2006) (“The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor[e].”); *see also* Mullally, *supra* note 13, at 346–47 (describing the patent examination process).

occurs as part of an initial rejection of one or more claims from the patent application.¹²⁰ When responding to this initial rejection, an applicant will either submit arguments in support of the original claim or amend his or her claims in order to address the examiner's concerns.¹²¹ Undoubtedly, this process resembles the negotiating and bargaining that routinely occurs with contracts.¹²²

2. Rejection by the Federal Circuit

In *Markman*, however, the Federal Circuit explicitly rejected both the idea of a patent as a contract and the idea that the interpretative principles of contract law could apply to patent claim construction.¹²³ This argument was not unanimous, as several concurring and dissenting opinions disagreed with the majority's analysis on this issue.¹²⁴

In reaching its conclusion, the Federal Circuit first noted that “[a] patent is not [] a contract.”¹²⁵ According to the court, “[o]nce a patent is issued, any purported exchange of promises between the applicant and the [PTO] has been fully executed.”¹²⁶ Further, the court noted that the PTO has no discretion on whether to issue a patent if the statutory requirements have been met, and the patentee is unable to contract with anyone other than the government.¹²⁷

The court also outlined why differences between patents and contracts made theories of contract interpretation irrelevant for purposes of claim construction.¹²⁸ First, the court discussed how a patent infringement action differs from a breach of contract action.¹²⁹ Specifically, an alleged infringer is “never a party to the so-called ‘contract’ between the government and the inventor,”¹³⁰ and likely does not have personal knowledge of the process by which the patent was obtained.¹³¹ Additionally, the court stated that unlike contract law, “[t]here is no parol evidence rule in patent law,”¹³² and that when construing claim terms in

¹²⁰ See 35 U.S.C. § 132 (2000 & Supp. V 2005).

¹²¹ See *id.*

¹²² See Mullally, *supra* note 13, at 346 (describing the back and forth process of negotiation during patent procurement as similar to a contract negotiation); Craig Allen Nard, *Certainty, Fence Building, and the Useful Arts*, 74 IND. L.J. 759, 766 (1999) (noting that “the process whereby one obtains a patent is comparable to a contract negotiation between the patent applicant and the PTO, as representative of the public, including the applicant’s competitors”).

¹²³ See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 984–87 (Fed. Cir. 1995) (en banc). Notably, this analysis was not addressed by the Supreme Court in its decision affirming the Federal Circuit. For an additional critique of the patent-contract analogy, see I MOY, *supra* note 30, § 4:53.

¹²⁴ See *Markman*, 52 F.3d at 998–1026.

¹²⁵ *Id.* at 985 n.14.

¹²⁶ *Id.*

¹²⁷ *Id.*

¹²⁸ See *id.* at 985–87.

¹²⁹ *Id.* at 985.

¹³⁰ *Id.*

¹³¹ *Id.* at 987.

¹³² *Id.* at 985; see also *id.* (“Parol or other extrinsic evidence cannot add, subtract, or vary the limitations of the claims.”).

patent cases, the inventor's subjective intent plays no role—whereas in contract cases, the subjective intent of the parties is the primary focus.¹³³ Accordingly, the court concluded that “[t]he more appropriate analogy for interpreting patent claims is the statutory interpretation analogy.”¹³⁴

II. Claim Construction and Williston's Theory of Contract Interpretation

The Federal Circuit has expressly and strongly repudiated the patent-contract analogy and the use of principles of contract interpretation for purposes of claim construction. A closer examination of the process outlined by the court's current claim construction jurisprudence, however, indicates that in reality the court is implicitly applying the interpretative principles of contract law. More specifically, the Federal Circuit applies Professor Samuel Williston's theory, which relies on the plain meaning of language contained in the document. This theory, which the court explicitly adopts in other substantive areas of its jurisprudence, has had significant implications for claim construction and patent law generally.

A. Williston's Approach to Contract Interpretation

Williston espoused a view of contract interpretation that focused on the text of the document. Specifically, he argued that interpretation should look to the “plain, common, or normal meaning of language.”¹³⁵ Although a court's ultimate goal is to ascertain the intent of the parties, “it is not the real intent but the intent expressed or apparent in the writing which is sought.”¹³⁶ Thus, when interpreting a contract, “it is not primarily the intention of the parties which the court is seeking, but the meaning of the words at the time and place when they were used.”¹³⁷

¹³³ See *id.* at 985–86.

¹³⁴ *Id.* at 987.

¹³⁵ See 11 RICHARD A. LORD, WILLISTON ON CONTRACTS § 32:3 (4th ed. 1999) [hereinafter WILLISTON ON CONTRACTS].

¹³⁶ 2 SAMUEL WILLISTON, THE LAW OF CONTRACTS § 610, at 1177 (Baker, Voorhis & Co. 1921) [hereinafter WILLISTON, LAW OF CONTRACTS].

¹³⁷ *Id.* § 613, at 1186; see also Samuel Williston, *Mutual Assent in Contracts*, 14 ILL. L. REV. 85, 89 (1919) (“No evidence or admission will alter the application of the rule that the writing, not the intent of the parties, even though otherwise expressed, defines the terms of the contract.”); *Hotchkiss v. Nat'l City Bank*, 200 F. 287, 293 (S.D.N.Y. 1911) (Hand, J.) (“A contract has, strictly speaking, nothing to do with the personal, or individual intent of the parties.”).

Under Williston's approach, interpretation is a two-step process.¹³⁸ First, a court must decide whether the language of the contract is ambiguous.¹³⁹ A word or phrase is ambiguous if a "genuine doubt appears as to its meaning."¹⁴⁰ When making this determination, "the court begins with its plain language, construed in harmony with the plain and generally accepted meaning of the words used."¹⁴¹ This process is a purely objective inquiry and the subjective intent of the parties is not considered.¹⁴²

If a contract is unambiguous, the court effectuates the words as written.¹⁴³ In that scenario, Williston tells us, "the court determines the contract's meaning from the language alone, without reference to extrinsic facts or aids, and without resort to the rules of construction."¹⁴⁴ While a court may admit extrinsic evidence, "whatever the extrinsic evidence might show, it [can] not change the intent of the parties as expressed in the writing."¹⁴⁵

If a contract is ambiguous, the court is faced with a question as to the meaning of the term.¹⁴⁶ Accordingly, the fact-finder must interpret the meaning of the term in light of the intent of the parties.¹⁴⁷ For example, a fact-finder must look to the purpose of the contract as a whole, established rules of construction, and extrinsic evidence.¹⁴⁸

Williston's views were incorporated into the *Restatement (First) of Contracts*, for which he was the reporter.¹⁴⁹ In the case of an integrated writing, the First Restatement gave words, "except where it produces an ambiguous result," a meaning consistent to that "a reasonably intelligent person acquainted with all operative usages and knowing all the circumstances prior to and

¹³⁸ See E. Allan Farnsworth, "Meaning" in *the Law of Contracts*, 76 YALE L.J. 939, 959 (1967) ("Under the older and more restrictive [approach], parol evidence may only be used for the purpose of interpretation where the language in the writing is 'ambiguous.' The decision to admit parol evidence, that is, consists of two steps: first, one decides whether the language is ambiguous; second, if it is ambiguous, then one admits parol evidence only for the purpose of clearing up that ambiguity. This is the view adopted both by Williston and by the *Restatement of Contracts*.").

¹³⁹ See WILLISTON ON CONTRACTS, *supra* note 135, § 30:4 ("It is a generally accepted proposition that where the terms of a writing are plain and unambiguous, there is no room for interpretation or construction, since the only purpose of judicial construction is to remove doubt and uncertainty. . . . However, . . . the interpretation of a contract requires an initial determination of whether the contract is ambiguous . . .").

¹⁴⁰ *Id.* § 30:4; *id.* § 31:4.

¹⁴¹ *Id.* § 30:5.

¹⁴² *Id.* § 30:4; see also WILLISTON, LAW OF CONTRACTS, *supra* note 136, § 611 (stating that "the so-called parol evidence rule . . . precludes the parties not only from applying a standard which is based on their individual mental understanding but also one based on their individual oral agreement").

¹⁴³ See WILLISTON ON CONTRACTS, *supra* note 135, § 30:6.

¹⁴⁴ *Id.*

¹⁴⁵ *Id.* § 30:5.

¹⁴⁶ *Id.* § 30:7.

¹⁴⁷ *Id.*

¹⁴⁸ *Id.*

¹⁴⁹ See, e.g., Stephen F. Ross & Daniel Tranen, *The Modern Parol Evidence Rule and Its Implications for New Textualist Statutory Construction*, 87 GEO. L.J. 195, 201-02 (1998).

contemporaneous with the making of the integration” would give it.¹⁵⁰ Thus, “[t]he objective viewpoint of a third person is taken,”¹⁵¹ and “the terms of the writing are conclusive.”¹⁵² Although “evidence of surroundings is always admissible,” that evidence only affects a court’s analysis if reformation of the contract is necessary.¹⁵³

B. The Federal Circuit’s Adoption of Williston’s Approach in Contract Cases

As previously outlined, the Federal Circuit has explicitly rejected the use of any theory of contract interpretation for purposes of claim construction.¹⁵⁴ Despite this rejection, examining the approach taken by the court in non-patent cases involving contract interpretation remains relevant as an indicator of the court’s overall interpretative philosophy. Because interpretative philosophies often remain consistent between different areas of the law,¹⁵⁵ the adoption of Williston’s interpretative theory in contract cases would provide insight into how the Federal Circuit considers interpretative questions in patent law.

In addition to patents, the Federal Circuit retains appellate jurisdiction over many disputes involving government contracts.¹⁵⁶ As a result, it frequently faces problems of contract interpretation.¹⁵⁷ In these government contract decisions, the Federal Circuit has developed a jurisprudence that “by-in-large . . . follows the [] Williston approach, mandating that in general, trial courts should not admit extrinsic evidence to determine the meaning of contractual terms and provisions.”¹⁵⁸ The court’s decision to apply this approach runs contrary to the majority of jurisdictions within the United States, which reject the Willistonian method of contract interpretation.¹⁵⁹

Specifically, the Federal Circuit has adopted Williston’s general interpretative philosophy of seeking the “plain meaning” of the text of a

¹⁵⁰ RESTATEMENT (FIRST) OF CONTRACTS § 230 (1932).

¹⁵¹ *Id.* § 230 cmt. a.

¹⁵² *Id.* § 230 cmt. b.

¹⁵³ *Id.* § 235 cmt. f; *see also id.* § 235 cmt. g (“Even if a contract is not integrated, words when explicit ordinarily have a higher probative value than accompanying circumstances can have.”).

¹⁵⁴ *See supra* Part I.C.2.

¹⁵⁵ *See generally* Christopher H. Schroeder, *Foreword*, 67 LAW & CONTEMP. PROBS. 1 (2004) (discussing competing ideologies influencing American jurisprudence).

¹⁵⁶ *See* 28 U.S.C. § 1295(a), (b) (2000); 41 U.S.C. § 607(g)(1) (2000 & Supp. V 2005); *see also* 28 U.S.C. § 1491 (2000 & Supp. V 2005) (outlining the jurisdiction of the Court of Federal Claims, over which the Federal Circuit has appellate jurisdiction).

¹⁵⁷ *See, e.g.*, Ralph C. Nash & John Cibinic, *Interpretation Disputes: Finding an Ambiguity*, 4 NASH & CIBINIC REP. ¶ 25, Apr. 1990, at 58 (“The most frequently litigated issue in Government contracting is probably the correct interpretation of contract language.”).

¹⁵⁸ *Travelers Casualty & Surety Co. v. United States*, 75 Fed. Cl. 696, 707 (2007). *See generally* W. Stanfield Johnson, *Interpreting Government Contracts: Plain Meaning Precludes Extrinsic Evidence and Controls at the Federal Circuit*, 34 PUB. CONT. L.J. 635 (2005) (discussing the Federal Circuit’s application of Willistonian principles in government contract cases generally).

¹⁵⁹ *See Travelers Casualty & Surety Co.*, 75 Fed. Cl. at 707.

contract.¹⁶⁰ The court has held that “[w]hen the contractual language is unambiguous on its face, our inquiry ends and the plain language of the Agreement controls.”¹⁶¹ Similarly, the court has adopted Williston’s view that the subjective intent of the parties, if relevant at all, is subordinate to the text of the document.¹⁶² Thus, “extrinsic evidence may not be used to interpret an unambiguous contract provision.”¹⁶³ Accordingly, the Federal Circuit agrees with Williston’s theory of interpretation and has adopted it in government contract cases.

C. The Federal Circuit’s Implicit Application of Williston’s Interpretative Approach to Patent Claim Construction

The Federal Circuit’s contract jurisprudence indicates that members of the court have accepted Willistonian interpretative principles. The potential therefore exists for this engrained interpretative philosophy to bleed over into different substantive areas of the Federal Circuit’s jurisprudence.¹⁶⁴ Indeed, despite its explicit rejection of the application of principles of contract interpretation to patent claim construction in *Markman*,¹⁶⁵ the Federal Circuit has implicitly adopted Williston’s philosophy in its claim construction jurisprudence.

Initially, like Williston, the Federal Circuit has developed an interpretative philosophy in patent claim construction cases centering on the “plain and ordinary meaning” of words.¹⁶⁶ Specifically, the court has instructed that, when

¹⁶⁰ See, e.g., *Ace Constructors, Inc. v. United States*, 499 F.3d 1357, 1361 (Fed. Cir. 2007) (“In contract interpretation, the plain meaning of the contract’s text controls unless it is apparent that some other meaning was intended and mutually understood.”).

¹⁶¹ *Coast Fed. Bank, F.S.B. v. United States*, 323 F.3d 1035, 1040 (Fed. Cir. 2003) (en banc).

¹⁶² See, e.g., *R.B. Wright Constr. Co. v. United States*, 919 F.2d 1569, 1572 (Fed. Cir. 1992)

(“Neither a contractor’s belief nor contrary customary practice however, can make an unambiguous contract provision ambiguous, or justify a departure from its terms.”).

¹⁶³ *Teg-Paradigm Environ., Inc. v. United States*, 465 F.3d 1329, 1338 (Fed. Cir. 2006); see also *Coast Fed. Bank, F.S.B.*, 323 F.3d at 1040 (“If the ‘provisions are clear and unambiguous, they must be given their plain and ordinary meaning,’ and we may not resort to extrinsic evidence to interpret them.” (internal citation omitted) (quoting *Landmark Land Co. v. Fed. Deposit Ins. Corp.*, 256 F.3d 1365, 1373 (Fed. Cir. 2001))).

¹⁶⁴ See *Travelers Casualty & Surety Co. v. United States*, 75 Fed. Cl. 696, 708 (2007) (discussing how the Federal Circuit’s statutory construction methodology has generally been incorporated into its contract jurisprudence); see also *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337, 1351 (Fed. Cir. 2004) (en banc) (Dyk, J., concurring-in-part, dissenting-in-part) (“Patent law is not an island separated from the main body of American jurisprudence.”). See generally Gregory C. Sisk et al., *Charting the Influences on the Judicial Mind: An Empirical Study of Judicial Reasoning*, 73 N.Y.U. L. REV. 1377, 1465–69 (1998) (discussing the impact of ideology on judicial decision-making).

¹⁶⁵ See *supra* Part I.C.2.

¹⁶⁶ E.g., *N. Telecom Ltd. v. Samsung Elecs. Co., Ltd.*, 215 F.3d 1281, 1295 (Fed. Cir. 2000) (“The plain and ordinary meaning of claim language controls, unless that meaning renders the claim unclear or is overcome by a special definition that appears in the intrinsic record with reasonable clarity and precision.”); see also *DSW, Inc. v. Shoe Pavilion, Inc.*, 537 F.3d 1342, 1347 (Fed. Cir. 2008) (stating that “absent contravening evidence from the specification or prosecution history, plain and unambiguous claim language controls the construction analysis”). See generally

conducting claim construction, a district court must give claim terms their ordinary and plain meaning to a PHOSITA at the time of the invention.¹⁶⁷ As a result, “the claim construction inquiry, therefore, begins and ends in all cases with the actual words of the claim.”¹⁶⁸ Indeed, the Federal Circuit has previously rejected attempts by patentees to use extrinsic evidence to expand the scope of a patent beyond what the intrinsic evidence would support.¹⁶⁹

Because the PHOSITA standard is an objective inquiry,¹⁷⁰ the Federal Circuit has concluded that the subjective intent of the inventor and the patent examiner do not affect how a claim is construed.¹⁷¹ First, the court has generally limited, if not eliminated, the role that the subjective intent of an inventor plays in the claim construction process, except to the extent that this intent is evidenced in the patent’s intrinsic record.¹⁷² For example, in *Markman*, the Federal Circuit stated that “[t]he subjective intent of the inventor when he used a particular term is of little or no probative weight in determining the scope of the claim (except as

Thomas, *supra* note 8, at 792–96 (discussing how the Federal Circuit has become increasingly formalistic).

¹⁶⁷ See, e.g., *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998) (“It is the person of ordinary skill in the field of the invention through whose eyes the claims are construed. Such person is deemed to read the words used in the patent documents with an understanding of their meaning in the field, and to have knowledge of any special meaning and usage in the field. The inventor’s words that are used to describe the invention—the inventor’s lexicography—must be understood and interpreted by the court as they would be understood and interpreted by a person in that field of technology.”).

¹⁶⁸ E.g., *Renishaw P.L.C. v. Marposso Societa’ per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998); see also *Johnson Worldwide Assocs., Inc. v. Zebo Corp.*, 175 F.3d 985, 990 (Fed. Cir. 1999) (noting that “there must be a textual reference in the actual language of the claim with which to associate a proffered claim construction”).

¹⁶⁹ See, e.g., *Astrazeneca AB, Aktiebolaget Hassle, KBI-E, Inc. v. Mut. Pharm. Co.*, 384 F.3d 1333, 1338 (Fed. Cir. 2004) (noting that even though the parties agreed that the extrinsic meaning of a disputed claim term was broad, “[t]he intrinsic evidence . . . clearly binds [the patentee] to a narrower definition . . . than the extrinsic evidence would support”).

¹⁷⁰ See, e.g., *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc); see also *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1117 (Fed. Cir. 2004) (noting that “the inquiry into the meaning of claim terms is an objective one”).

¹⁷¹ See, e.g., *Superior Fireplace Co. v. Majestic Prods. Co.*, 270 F.3d 1358, 1375 (Fed. Cir. 2001) (“Thus, Superior’s suggestion that we compare claim scope by considering what was ‘intended’ by the parties, rather than by construing the claims for what they actually recite, is completely without merit.”).

¹⁷² See, e.g., *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 985 (Fed. Cir. 1995) (en banc); see also *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327 (Fed. Cir. 2002) (“We hold that claim terms take on their ordinary and accustomed meanings unless the patentee demonstrated an intent to deviate from the ordinary and accustomed meaning of a claim term by redefining the term or by characterizing the invention in the intrinsic record using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.”); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387 (Fed. Cir. 1992) (“Thus, where a disputed term would be understood to have its ordinary meaning by one of skill in the art from the patent and its history, extrinsic evidence that the inventor may have subjectively intended a different meaning does not preclude summary judgment.”).

documented in the prosecution history).¹⁷³ As the court indicated, an exception to this rule is if an inventor's intent is evident from intrinsic evidence.¹⁷⁴ Indeed, it is well-established that patentees are free to be their own lexicographers and define terms within the patent itself.¹⁷⁵ Otherwise, evidence of subjective intent, such as inventor testimony, "cannot be relied on to change the meaning of the claims."¹⁷⁶ This limitation on subjective intent is linked to the notice function of claims.¹⁷⁷

The Federal Circuit has also rejected the use of the patent examiner's understanding of a claim term as an interpretative tool.¹⁷⁸ The court has noted, however, that a patent examiner's statements "may be evidence of how one of skill in the art understood the term at the time the application was filed."¹⁷⁹ Additionally, there is an exception for when an examiner's statements merely repeat arguments presented by the patentee.¹⁸⁰ Besides these limited purposes, as a general matter, an examiner's statements regarding his or her interpretation of a claim, even if the patentee does not respond or refute that interpretation, cannot assist in construing claims in a subsequent infringement case.¹⁸¹

¹⁷³ *Markman*, 52 F.3d at 985; *see also id.* ("No inquiry as to the subjective intent of the applicant or PTO is appropriate or even possible in the context of a patent infringement suit.").

¹⁷⁴ *See, e.g., id.*

¹⁷⁵ *See, e.g., Phillips*, 415 F.3d at 1316; *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) ("Although words in a claim are generally given their ordinary and customary meaning, a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history.").

¹⁷⁶ *Markman*, 52 F.3d at 983.

¹⁷⁷ *See Vitronics*, 90 F.3d at 1583; *see also Nystrom v. TREX Co.*, 424 F.3d 1136, 1145 (Fed. Cir. 2005) ("[I]n the absence of something in the written description and/or prosecution history to provide explicit or implicit notice to the public—i.e., those of ordinary skill in the art—that the inventor intended a disputed term to cover more than the ordinary and customary meaning revealed by the context of the intrinsic record, it is improper to read the term to encompass a broader definition simply because it may be found in a dictionary, treatise, or other extrinsic source.").

¹⁷⁸ *See, e.g., Bell Atlantic Network Servs., Inc. v. Covad Commc'ns Group, Inc.*, 262 F.3d 1258, 1273 (Fed. Cir. 2001) (noting that "the statements of an examiner will not necessarily limit a claim"); *Dow Chem. Co. v. Sumitomo Chem. Co.*, 257 F.3d 1364, 1382 (Fed. Cir. 2001) (same); *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1556 (Fed. Cir. 1997), *overruled on other grounds by Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448 (Fed. Cir. 1998) (en banc) (disregarding limiting statements made by an examiner for purposes of claim construction when the limitations were not found in the claim language); *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 102 F. Supp. 2d 199, 217 (D. Del. 2000) ("The court recognizes that the Federal Circuit has cautioned against reading examiners' statements into the scope of claims.").

¹⁷⁹ *Salazar v. Procter & Gamble Co.*, 414 F.3d 1342, 1347 (Fed. Cir. 2005).

¹⁸⁰ *See id.* at 1346–47; *ACCO Brands, Inc. v. Micro Sec. Devices, Inc.* 346 F.3d 1075, 1079 (Fed. Cir. 2003).

¹⁸¹ *See Salazar*, 414 F.3d at 1347 (concluding that "an applicant's silence regarding [a patent examiner's] statements does not preclude the applicant from taking a position contrary to the examiner's statements when the claim terms are construed during litigation"); *3M Innovative Props. Co. v. Avery Dennison Corp.*, 350 F.3d 1365, 1373–74 (Fed. Cir. 2003) ("An applicant's silence in response to an examiner's characterization of a claim does not reflect the applicant's clear and unmistakable acquiescence to that characterization if the claim is eventually allowed on

Similarly, the Federal Circuit has restricted the role of extrinsic evidence in claim construction.¹⁸² Although a court may *use* extrinsic evidence, the Federal Circuit has urged caution in *relying* upon it when construing a claim.¹⁸³ This rule is reminiscent of Williston's belief that a court could listen to extrinsic evidence, but could not admit it for purposes of interpretation.¹⁸⁴

Additionally, the guidelines provided by the Federal Circuit as to how a court should go about the claim construction process are remarkably similar to the interpretative process described by Williston for contract interpretation. As outlined in *Vitronics*, when interpreting a disputed claim term, the first inquiry is to examine the intrinsic evidence of a patent.¹⁸⁵ If the plain and ordinary meaning is evident, the analysis ends there.¹⁸⁶ If an ambiguity exists, however, a court can examine extrinsic evidence to resolve that ambiguity.¹⁸⁷ In the absence of any ambiguity, however, relying on extrinsic evidence is improper.¹⁸⁸ If an ambiguity

grounds unrelated to the examiner's un rebutted characterization."); *Schwing GmbH v. Putzmeister Aktiengesellschaft*, 305 F.3d 1318, 1324 (Fed. Cir. 2002) ("Although prosecution history can be a useful tool for interpreting claim terms, it cannot be used to limit the scope of a claim unless the applicant took a position before the PTO that would lead a competitor to believe that the applicant had disavowed coverage of the relevant subject matter." (emphasis added)); *see also* *Prima Tek II, L.L.C. v. Polypap, S.A.R.L.*, 318 F.3d 1143, 1151 (Fed. Cir. 2003) ("We note that drawing inferences of the meaning of claim terms from an examiner's silence is not a proper basis on which to construe a patent claim.")

¹⁸² *See, e.g.*, *Lucent Techs., Inc. v. Gateway, Inc.*, 525 F.3d 1200, 1206 (Fed. Cir. 2008) ("In determining the meaning of a disputed claim limitation, we look primarily to the intrinsic evidence including the claim language, written description, and prosecution history."); *Dow Chem. Co. v. Sumitomo Chem. Co.*, 257 F.3d 1364, 1373 (Fed. Cir. 2001) (noting that a court may turn to extrinsic evidence only in the "rare circumstance that the court is unable to determine the meaning of the asserted claims after assessing the intrinsic evidence"). Notably, any theory of contract interpretation would consider a patent's prosecution history to be extrinsic evidence. *See, e.g.*, BLACK'S LAW DICTIONARY 597 (8th ed. 2004) (defining "extrinsic evidence" as "[e]vidence relating to a contract but not appearing on the face of the contract because it comes from other sources, such as statements between the parties or the circumstances surrounding the agreement").

¹⁸³ *See Phillips*, 415 F.3d at 1318–19 (outlining why extrinsic evidence is "less reliable" and how it is "unlikely to result in a reliable interpretation of patent claim scope"); *see also* *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1308 (Fed. Cir. 1999) ("Certainly, there are no prohibitions in *Vitronics* on courts hearing evidence from experts. Rather, *Vitronics* merely warned courts not to *rely* on extrinsic evidence in claim construction to contradict the meaning of claims discernible from thoughtful examination of the claims, the written description, and the prosecution history—the intrinsic evidence."); *Bell & Howell Document Mgmt. Prods. Co. v. Altek Sys.*, 132 F.3d 701, 706 (Fed. Cir. 1997) ("Use of expert testimony to explain an invention may be useful. But *reliance* on extrinsic evidence to interpret claims is proper only when the claim language remains genuinely ambiguous after consideration of the intrinsic evidence" (emphasis added)).

¹⁸⁴ *See* WILLISTON ON CONTRACTS, *supra* note 135, § 30:6.

¹⁸⁵ *See Vitronics Corp. v. Conception, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

¹⁸⁶ *See id.* at 1583.

¹⁸⁷ *See id.* *But see* *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 986 (Fed. Cir. 1995) (en banc) ("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.")

¹⁸⁸ *See Vitronics Corp.*, 90 F.3d at 1583 ("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.")

exists, then the court may rely upon extrinsic evidence to determine the meaning of the disputed term.¹⁸⁹

One example of how the court applies this approach is the case of *Chef America, Inc. v. Lamb-Weston, Inc.*¹⁹⁰ In *Chef America*, the patent at issue involved a process of making dough products.¹⁹¹ The disputed claim language was “heating the resulting batter-coated dough to a temperature in the range of about 400° F. to 850° F.”¹⁹² The Federal Circuit was asked to decide whether this language required the dough itself to be heated to the listed temperature, or if this range referred to the temperature of the oven.¹⁹³

The court began by noting that the claim language itself consisted of “ordinary, simple English words whose meaning is clear and unquestionable.”¹⁹⁴ Accordingly, the court stated, “[t]hey mean exactly what they say. The dough is to be heated *to* the specified temperature.”¹⁹⁵ However, the problem with this conclusion was that heating the dough to that temperature would cause it to be “burned to a crisp,” or, as one of the attorneys arguing the case stated, “something that . . . resembles a charcoal briquet[te].”¹⁹⁶ Yet, despite this result, the court stated that it would “construe the claim as written, not as the patentees wish they had written it” in light of the claim’s unambiguous language.¹⁹⁷

This result typifies the Federal Circuit’s Willistonian interpretative methodology. Like Williston, the court made an initial determination of whether the language of the claim was ambiguous.¹⁹⁸ Since the court did not find the required ambiguity, it declined to examine any extrinsic evidence, despite the fact that this analysis would have effectuated the intent of the patentee by allowing the patented process to perform its intended function.¹⁹⁹ Thus, this case illustrates the text-centric approach currently used by the Federal Circuit.

Despite the sweeping statements of some commentators,²⁰⁰ the continuing vitality of the *Vitronics* framework underscores the Federal Circuit’s unstated

¹⁸⁹ *See id.*

¹⁹⁰ 358 F.3d 1371 (Fed. Cir. 2004).

¹⁹¹ *Id.* at 1372.

¹⁹² *Id.* at 1371.

¹⁹³ *Id.* at 1371–72. Essentially, this decision consisted of determining whether the dough should be heated *to* the specified temperature or *at* the specified temperature. *See id.* at 1373–74.

¹⁹⁴ *Id.* at 1373.

¹⁹⁵ *Id.* (emphasis added).

¹⁹⁶ *Id.*

¹⁹⁷ *Id.* at 1374.

¹⁹⁸ *See supra* note 139.

¹⁹⁹ *See id.* at 1375 (“To the contrary [the patentees] argue only that ‘to’ should be construed to mean ‘at’ because otherwise the patented process could not perform the function the patentees intended. As we have noted, however, we have repeatedly declined to rewrite unambiguous patent claim language for that reason.”).

²⁰⁰ *See, e.g.,* Frederick W. Claybrook, Jr., *It’s Patent that “Plain Meaning” Dictionary Definitions Shouldn’t Dictate: What Phillips Portends for Contract Interpretation*, 16 FED. CIR. B.J. 91, 91 (2006) (“In *Phillips*, the Federal Circuit basically adopted, for its patent construction cases, the interpretation principles for contracts set out in the *Restatement (Second) of Contracts*.”).

devotion to Willistonian interpretative methods.²⁰¹ In *Phillips*, the court remarked that “[t]he sequence of steps used by the judge in consulting various sources is not important” and that “there is no magic formula or catechism for conducting claim construction.”²⁰² However, the court also described the statements in *Vitronics* as “attempt[ing] to explain why, in general, certain types of evidence are more valuable than others.”²⁰³ Accordingly, the court “adhere[d]” and “reaffirm[ed]” the claim construction approach outlined in *Vitronics* and similar cases.²⁰⁴ If anything, the court’s rejection of *Texas Digital* served to further solidify the claim construction process articulated in *Vitronics*.²⁰⁵ Thus, *Vitronics*, and its implicit adoption of Williston’s method of contract interpretation, remains intact following *Phillips*. It should come as no surprise, therefore, that *Phillips* did not have a significant practical effect on district court decision-making.²⁰⁶

Moreover, post-*Phillips* decisions have only further entrenched this interpretative philosophy. For example, in a recent case, the Federal Circuit reaffirmed that a district court may only “look to extrinsic evidence so long as the extrinsic evidence does not contradict the meaning otherwise apparent from the intrinsic record.”²⁰⁷ Another case held that inventor testimony as to subjective intent is irrelevant for purposes of claim construction.²⁰⁸ Thus, the Federal Circuit’s implicit adoption of Williston’s model of contract interpretation continues in the post-*Phillips* era.

D. Weaknesses/Critiques of Williston’s Approach and the Federal Circuit’s Claim Construction Jurisprudence

The Federal Circuit’s claim construction jurisprudence has another similarity to Williston’s theory of contract interpretation—both have been subject to many of the same critiques by scholars and commentators.

Initially, both interpretative regimes have been criticized for ignoring the fact that words are inherently ambiguous. Similar to concerns noted by critics of Williston, a standard focused on determining an amorphous objective meaning of words ignores the reality that words cannot have an objective, set meaning.²⁰⁹ As

²⁰¹ See, e.g., Golden, *supra* note 57, at 325 (“Aside from rejecting such extreme excursions in dictionary-driven literalism, however, *Phillips* generally reaffirmed existing precedent.”).

²⁰² *Phillips*, 415 F.3d at 1324.

²⁰³ *Id.*

²⁰⁴ *Id.*

²⁰⁵ See *id.*

²⁰⁶ See, e.g., Eric W. Hagen, *No Big Change in Claim Construction Since Phillips: In Hundreds of Decisions in Past Year, Case Has Had Only A Small Ripple Effect*, NAT’L L.J., Oct. 15, 2006, at S4.

²⁰⁷ *Helmsderfer v. Bobrick Washroom Equip.*, 527 F.3d 1379, 1382 (Fed. Cir. 2008).

²⁰⁸ See *Howmedica Osteonics Corp. v. Wright Medical Tech., Inc.*, 540 F.3d 1337, 1347 (Fed. Cir. 2008) (“We hold that inventor testimony as to the inventor’s subjective intent is irrelevant to the issue of claim construction.”).

²⁰⁹ See, e.g., Oliver Wendell Holmes, *The Theory of Legal Interpretation*, 12 HARV. L. REV. 417, 417 (1898) (“It is not true (and I know of no reason why theory should disagree with the facts) a

a result, a restrictive process unduly favors a judge's view of how "reasonable" contracts should look and what a "reasonable" meaning would be.²¹⁰ Indeed, "an identical set of words can be plain and clear to some judges and ambiguous to other judges (who are equally reasonable)."²¹¹ Thus, vagaries and buzzwords such as "ambiguity" can provide judges with room to maneuver to effectuate a desired outcome.²¹² Further, even when a judge determines that disputed language is "plain and clear," that judge is using his or her own background (i.e., extrinsic evidence), to reach that conclusion.²¹³

This problem is only exacerbated by the nature of patents and patent claims.²¹⁴ As one court pointed out, "[t]he very nature of words would make a clear and unambiguous claim a rare occurrence."²¹⁵ In the realm of patents, claims are attempting to describe a physical invention, and "[t]his conversion of machine to words allows for unintended idea gaps which cannot be satisfactorily filled. Often the invention is novel and words do not exist to describe it."²¹⁶ These difficulties demonstrate the inherent problems with relying upon a text-centered approach to claim construction and weighing intrinsic evidence too highly.

given word or even a given collocation of words has one meaning and no other. A word generally has several meanings, even in the dictionary.").

²¹⁰ See Ross & Tranen, *supra* note 149, at 203.

²¹¹ Arthur L. Corbin, *The Interpretation of Words and the Parol Evidence Rule*, 50 CORNELL L.Q. 161, 183 (1964).

²¹² See Gretchen Ann Bender, *Uncertainty and Unpredictability in Patent Litigation: The Time is Ripe for A Consistent Claim Construction Methodology*, 8 J. INTELL. PROP. L. 175, 215–16 (2001); see also Farnsworth, *supra* note 138, at 965; Frankfurter, *supra* note 7, at 529 (noting the potential for "a judge to use words as 'empty vessels into which he can pour anything he will'").

²¹³ See Corbin, *supra* note 211, at 162 & n.2.

²¹⁴ See, e.g., William R. Hubbard, *Efficient Definition and Communication of Patent Rights: The Importance of Ex Post Delineation*, 25 SANTA CLARA COMPUTER & HIGH TECH. L.J. 327, 345 (2009) (noting that "the problems stemming from indeterminacies of language are magnified with patents").

²¹⁵ *Autogiro Co. v. United States*, 384 F.2d 391, 396 (Ct. Cl. 1967); see *Q-Pharma, Inc. v. Andrew Jergens Co.*, 360 F.3d 1295, 1301 (Fed. Cir. 2004) ("Claim interpretation is not always an exact science, and it is not unusual for parties to offer competing definitions of even the simplest claim language."); see also *Topliff v. Topliff*, 145 U.S. 156, 171 (1892) ("The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy . . ."); Kenneth D. Bassinger, *Allocating Linguistic Uncertainty in Patent Claims: The Proper Role of Prosecution History Estoppel*, 49 LOY. L. REV. 339, 340 (2003) ("The subtle nuances of inventive genius are not readily described by the often strict confines imposed by language. In trying to draft the text of a patent to precisely capture the essence of the inventive subject matter, a patent attorney faces many choices in selecting the proper words to describe the often abstract nature of invention.").

²¹⁶ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002) (quoting *Autogiro Co.*, 384 F.2d at 397); *PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1373 (Fed. Cir. 2007) ("The courts have recognized, particularly in fields of new and evolving knowledge, that the claims can be no more precise than the knowledge in the field permits."); see also James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 YALE L.J. 882, 928 (2007) (noting that "reducing a technological concept to words is a chancy thing; the available terminology may fail to capture the true nature of the innovation").

The current claim construction jurisprudence is also problematic because of the perspective that judges use to interpret disputed claim terms.²¹⁷ By its nature, the PHOSITA standard requires judges to give a claim term the meaning it would have to a hypothetical third party at the time of the invention.²¹⁸ Thus, it requires judges to determine who a relevant PHOSITA would be, as well as that person's background, experience, and knowledge.²¹⁹ This inquiry is difficult since a PHOSITA varies according to the technology at issue.²²⁰ Further fictionalizing the inquiry, a PHOSITA is presumed to know all relevant prior art, a presumption that rarely, if ever, occurs in real life.²²¹

The PHOSITA standard also presents difficulties of hindsight bias.²²² When attempting to go back in time and look at how an imaginary PHOSITA would have interpreted a claim term, it is easy for a judge to give meaning to a term based on the current state of technology.²²³ As a result, judges will frequently overestimate the level of skill in the art.²²⁴ Indeed, the Federal Circuit has recognized this problem in other contexts and made an effort to limit its

²¹⁷ See, e.g., Hubbard, *supra* note 214, at 345. For a discussion of the issues created by utilizing the PHOSITA standard in other contexts, see generally Dan L. Burk & Mark A. Lemley, *Is Patent Law Technology-Specific?*, 17 BERKELEY TECH. L.J. 1155 (2002), and Michael H. Davis, *Patent Politics*, 56 S.C. L. REV. 337 (2004).

²¹⁸ See, e.g., *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 986 (Fed. Cir. 1995) (en banc) (noting that a claim term means “what one of ordinary skill in the art at the time of the invention would have understood the term to mean”); Douglas R. Nemeck & Emily J. Zelenock, *Rethinking the Role of the Written Description Requirement in Claim Construction: Whatever Happened to “Possession is Nine-Tenths of the Law?”*, 8 MINN. J.L. SCI. & TECH. 357, 361 (2007) (“Under current canons of claim construction, the analysis focuses on the so-called ‘ordinary meaning’ of a patent claim term to a hypothetical person of ordinary skill in the art, rather than what the patentee actually conceived, reduced to practice, and disclosed to the public.”).

²¹⁹ See, e.g., *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1338 (Fed. Cir. 2005) (“Claim interpretation requires the court to ascertain the meaning of the claim to one of ordinary skill in the art at the time of invention. This task requires the court to place the claim language in its proper technological and temporal context.”). In the obviousness context, the Federal Circuit has outlined several factors for courts to consider. See *Env'tl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696 (Fed. Cir. 1983).

²²⁰ See Mullally, *supra* note 13, at 351–52; Lemley, *supra* note 46, at 102 (“Both the knowledge of the PHOSITA in a particular field and the meaning of particular terms to that PHOSITA will frequently change over time.”).

²²¹ See *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986) (“The person of ordinary skill is a hypothetical person who is presumed to be aware of all the pertinent prior art.”); see also *In re Application of Winslow*, 365 F.2d 1017, 1020 (C.C.P.A. 1966) (“We think the proper way to apply the [35 U.S.C. §]103 obviousness test to a case like this is to first picture the inventor as working in his shop with the prior art references—which he is presumed to know—hanging on the walls around him.”).

²²² See Burk & Lemley, *supra* note 217, at 1198–99; Gregory N. Mandel, *Patently Non-Obvious: Empirical Demonstration that the Hindsight Bias Renders Patent Decisions Irrational*, 67 OHIO ST. L.J. 1391, 1440–41 (2006) (noting how hindsight bias impacts claim construction). See generally Chris Guthrie et al., *Inside the Judicial Mind*, 86 CORNELL L. REV. 777, 799–805 (2001) (discussing the problem of hindsight bias among the federal judiciary more generally).

²²³ See Burk & Lemley, *supra* note 217, at 1198–99.

²²⁴ *Id.* at 1199.

effect.²²⁵ Such an effort has not been made, however, in the area of claim construction.

On top of all of these challenges, a court must also familiarize itself with the underlying technology at issue.²²⁶ Judges are selected for the bench because of their expertise in the law generally, not because of their technical background.²²⁷ Thus, this lack of background makes the current claim construction regime even more difficult to apply by district court judges.²²⁸ In contrast, many Federal Circuit judges *do* have a technological background.²²⁹ When combined with the temporal requirement, a court is not only faced with the difficulty of determining the skill level of a PHOSITA in a particular field, but also the history of that particular field, a notoriously difficult process.²³⁰ Further, all of these challenges are exacerbated by the fact that, unlike juries, judges typically must provide written opinions explaining their decisions.²³¹

In light of these inherent difficulties, it should come as no surprise that courts often disagree as to how a claim term should be defined. Indeed, the

²²⁵ *Id.* at 1198–99 (“The Federal Circuit has repeatedly recognized the problem of hindsight bias in its obviousness jurisprudence, and has built rules designed to cope with it there, but hindsight bias risks infecting the PHOSITA analysis in enablement and claim scope as well.”).

²²⁶ *E.g., id.* at 1197; Rai, *supra* note 56, at 1068–69. *See generally* S. Jay Plager, *Challenges for Intellectual Property Law in the Twenty-First Century: Indeterminacy and Other Problems*, 2001 U. ILL. L. REV. 69 (discussing the challenges that patent litigation creates for trial judges).

²²⁷ *See, e.g.,* Judge James F. Holderman, *The Patent Litigation Predicament in the United States*, 2007 U. ILL. J.L. TECH. & POL’Y 1, 5 (“United States district court judges are appointed by the President and confirmed by the Senate, but typically not for their prowess in patent litigation.”); Rai, *supra* note 56, at 1046–47 (“Because the typical judge is not likely to be a person of ordinary skill in the relevant scientific or technological art, she is not likely to be endowed with the appropriate technical knowledge. As a consequence, even after examining a claim term in light of the accompanying specification (or, more generally, in light of any of the applicable canons of claim construction) she might still find the term difficult to understand.”).

²²⁸ *See* Holderman, *supra* note 227, at 5–6; Mullally, *supra* note 13, at 365; *see also* ROBERT L. HARMON, PATENTS AND THE FEDERAL CIRCUIT § 6.1 (8th ed. 2007) (noting that “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”). *See generally* *Blonder-Tongue Labs., Inc. v. Univ. of Ill. Found.*, 402 U.S. 313, 331–32 (1971) (“We are also aware that some courts have frankly stated that patent litigation can present issues so complex that legal minds, without appropriate grounding in science and technology, may have difficulty in reaching decision.”).

²²⁹ Judges Gajarsa, Linn, Lourie, Moore, and Newman have extensive scientific backgrounds. *See* Federal Circuit – Judicial Biographies, <http://www.cafc.uscourts.gov/judgbios.html> (last visited May 15, 2009). *See generally* Rochelle Cooper Dreyfuss, *In Search of Institutional Identity: The Federal Circuit Comes of Age*, 23 BERKELEY TECH. L.J. 765, 797–800 (2008) (discussing how the backgrounds of Federal Circuit judges differ from judges on other courts). However, as some commentators have pointed out, even possessing scientific prowess is not necessarily beneficial in patent cases, since technology rapidly changes and a judge’s expertise may not relate to all of the potential technical areas that patents can cover. *See, e.g.,* Robin Feldman, *Plain Language Patents*, 17 TEX. INTELL. PROP. L.J. 289, 290–91 (2009).

²³⁰ *See* Burk & Lemley, *supra* note 217, at 1198 (“So courts trying to determine the level of skill in the art must learn not just science, but the history of that science. Courts and expert witnesses must shut out of their minds intervening developments in the field. This is notoriously hard to do.”).

²³¹ *See, e.g.,* Plager, *supra* note 226, at 72.

Federal Circuit itself has been heavily divided over the results in *Markman*, *Cybor*, and *Phillips*.²³² More recently, a denial of en banc review prompted sharp dissents from several judges.²³³ Scholars have outlined this division as a philosophical one, with judges split over, among other things, how formalistic claim construction should be.²³⁴ As a result, as one empirical study concluded, “[c]laim construction analysis at the Federal Circuit is clearly affected by the composition of the panel that hears and decides the case.”²³⁵

Because of this disagreement, certainty in claim construction cases is often elusive, if not illusory.²³⁶ Several empirical studies suggest that the reversal rate of district court claim construction rulings is abnormally high.²³⁷ Accordingly, a party defeated at trial often seeks the benefit of a do-over at the Federal Circuit under a de novo standard of review.²³⁸ Thus, a significant percentage of patent cases are appealed, with claim construction usually being an issue.²³⁹ Judges themselves often write about their frustrations with the lack of certainty in their claim construction rulings.²⁴⁰ This unrest is indicative of the flaws of the Federal Circuit’s current claim construction jurisprudence.

²³² See *supra* note 10.

²³³ See *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 469 F.3d 1039 (Fed. Cir. 2006) (order denying rehearing en banc).

²³⁴ See *supra* note 10.

²³⁵ Polk & Petherbridge, *supra* note 10, at 1171.

²³⁶ See, e.g., Nard, *supra* note 10, at 82.

²³⁷ See, e.g., Bender, *supra* note 212, at 207 (finding a reversal rate of 40% for claim construction); Christian A. Chu, *Empirical Analysis of the Federal Circuit’s Claim Construction Trends*, 16 BERKELEY TECH. L.J. 1075, 1143 (2001) (“[A] litigant whose case only involved an infringement issue had a 34% chance that the Federal Circuit would reverse the case on the basis of erroneous claim constructions.”); Kimberly A. Moore, *Markman Eight Years Later: Is Claim Construction More Predictable?*, 8 LEWIS & CLARK L. REV. 231, 236–39 (2005) (finding a reversal rate of 40.8% when summary affirmances were excluded and 34.51% if summary affirmances are included); Andrew T. Zidel, Comment, *Patent Claim Construction in the Trial Courts: A Study Showing the Need for Clear Guidance from the Federal Circuit*, 33 SETON HALL L. REV. 711, 745–46 (2003) (finding a reversal rate of 41.5% in 2001); see also *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1476 (Fed. Cir. 1998) (en banc) (Rader, J., dissenting) (“[O]ne study shows that the plenary standard of review has produced reversal, in whole or in part, of almost 40% of all claim constructions since *Markman I*. . . . In fact, this reversal rate, hovering near 50%, is the worst possible. Even a rate that was much higher would provide greater certainty.”).

²³⁸ See, e.g., Holderman, *supra* note 227, at 10. Or, in the alternative, a party will settle the case early to minimize litigation costs. *Id.*

²³⁹ See REBECCA N. EYRE, JOE S. CECIL & ERIC TOPOR, FED. JUDICIAL CTR., PATENT CLAIM CONSTRUCTION: A SURVEY OF FEDERAL DISTRICT COURT JUDGES 23 (2008), available at [http://www.fjc.gov/public/pdf.nsf/lookup/patclaim.pdf/\\$file/patclaim.pdf](http://www.fjc.gov/public/pdf.nsf/lookup/patclaim.pdf/$file/patclaim.pdf) (finding that of the judges surveyed, 71% of cases resolved by summary judgment or jury trial were appealed, with claim construction being an issue on appeal in 73% of those cases).

²⁴⁰ See, e.g., Holderman, *supra* note 227, at 1 (“Something has to change when your boss, upon reviewing your work, continues to tell you year after year that you are doing your job incorrectly about one-third to one-half of the time, and your customers continue to tell you their costs are too high. That is the predicament in which we United States district court judges have collectively found ourselves during the past decade when presiding over patent litigation.”).

III. Claim Construction and Corbin's Approach to Contract Interpretation

Although, as a descriptive matter, the Federal Circuit has been quietly applying a Willistonian approach to claim construction, as a normative matter, the disadvantages of this approach call for a claim construction model based more on that of Williston's rival, Professor Arthur Corbin. Corbin attempted to address these criticisms of Williston's approach by espousing a different view of contract interpretation based more on the intent of the parties. As this section will show, applying this approach when interpreting claims has the potential to avoid the pitfalls of Willistonian interpretation and significantly improve patent claim construction.

A. Corbin's Approach to Contract Interpretation

For Corbin, the overall goal was for a court to determine what the parties subjectively intended a disputed term to mean.²⁴¹ Thus, Corbin argued, “[a] reasonably intelligent judge will not try to force that judge’s own meaning upon the parties when relevant and trustworthy evidence may show that one or both parties intended a different meaning.”²⁴²

Corbin also recognized the inherent ambiguities of language and rejected the concept of “plain and clear” meaning.²⁴³ Accordingly, he argued that “[b]efore the meaning of words . . . can be plain and clear, at least some of the surrounding circumstances must be known.”²⁴⁴ Thus, Corbin argued that extrinsic evidence “should be admissible even though the words of the contract may seem to the judge to have a ‘plain and clear’ meaning.”²⁴⁵

In furtherance of these goals, Corbin’s interpretative theory freely admitted extrinsic evidence for the purpose of “discernment of the parties’ intentions.”²⁴⁶ In other words, a contract consists of a “meeting of the minds” of its parties.²⁴⁷ Since the document itself could not be the sole evidence of the parties’ intent, he argued, a court should consider all relevant extrinsic

²⁴¹ *E.g.*, 5 ARTHUR L. CORBIN, CORBIN ON CONTRACTS § 24.11 (rev. ed. 2002) [hereinafter CORBIN ON CONTRACTS] (“Interpretation consists of ascertaining the meaning that the parties intended to attach to the terms of the contract.”).

²⁴² *Id.* § 24.10.

²⁴³ *See id.*

²⁴⁴ *Id.* § 24.7; *id.* § 24.10.

²⁴⁵ *Id.* § 24.10; *see also id.* § 24.7 (“When a judge refuses to consider relevant extrinsic evidence on the ground that the meaning of stated words is plain and clear, that decision is formed by and wholly based upon the completely extrinsic evidence of the judge’s own personal education and experience.”).

²⁴⁶ *Id.* § 24.9.

²⁴⁷ *See* 4 CORBIN ON CONTRACTS, *supra* note 241, § 4.13. The “meeting of the minds” theory has significant historical roots, with one scholar tracing its origins back to as early as sixteenth century England. *See* Farnsworth, *supra* note 138, at 942–45 (discussing the historical development and evolution of the “meeting of the minds” theory of contract law).

evidence.²⁴⁸ The types of extrinsic evidence that could be considered are “limitless.”²⁴⁹ The question was not one of admissibility, but rather that of weighing evidence.²⁵⁰ Thus, all extrinsic evidence was relevant for purposes of interpretation, regardless of whether a term was ambiguous.²⁵¹

Notably, however, this evidence could not be used to change the terms of the writing.²⁵² The use of extrinsic evidence was admissible “to aid in the process of interpretation, to determine the meaning that the parties actually gave to a term, and to expound and enforce the contract that the parties actually intended to make.”²⁵³ Thus, a party could not use such evidence to contradict, delete, or substitute terms in the written contract.²⁵⁴ Similarly, although testimony of the parties was clearly admissible, “[a] party will not be permitted to build up an argument by means of self-serving statements.”²⁵⁵

In the end, Corbin’s approach was incorporated into the *Restatement (Second) of Contracts*.²⁵⁶ Contract interpretation “deals with the meaning given to language and other conduct *by the parties* rather than meanings established by law.”²⁵⁷ However, “the relevant intention of a party is that manifested by him rather than any different undisclosed intention.”²⁵⁸ Further, “[a]ny determination of meaning or ambiguity should only be made in the light of the relevant evidence of the situation and relations of the parties.”²⁵⁹ This evidence also includes “the subject matter of the transaction, preliminary negotiations and statements made therein, usages of trade, and the course of dealing between the parties.”²⁶⁰ The most important evidence of intent, however, remains the words themselves and extrinsic evidence cannot contradict the terms of the writing.²⁶¹ These provisions clearly reflect Corbin’s interpretative philosophy.

²⁴⁸ 5 CORBIN ON CONTRACTS, *supra* note 241, § 24.10.

²⁴⁹ *Id.* (“The varieties of extrinsic evidence that may demonstrate circumstances surrounding formation of the contract are as limitless as are the types of circumstances.”).

²⁵⁰ *Id.* § 24.9 (“Interpretation requires, therefore, the weighing of evidence rather than a decision concerning admissibility.”).

²⁵¹ *See id.*

²⁵² *E.g.*, 6 CORBIN ON CONTRACTS, *supra* note 241, § 579 (noting that such evidence “does not vary or contradict the written words”).

²⁵³ 5 CORBIN ON CONTRACTS, *supra* note 241, § 24.6.

²⁵⁴ *Id.* (“Contradiction, deletion, and substitution: none of these is interpretation.”).

²⁵⁵ *Id.* § 24.10.

²⁵⁶ *See, e.g.*, Ross & Tranen, *supra* note 149, at 205; *see also id.* (noting that “the critical aspect of the Williston-Corbin struggle is that Corbin won”).

²⁵⁷ RESTATEMENT (SECOND) OF CONTRACTS § 212 cmt. a (1979).

²⁵⁸ *Id.* The term “manifestation of intention” means an “external expression of intention.” *Id.* § 2 cmt. b.

²⁵⁹ *Id.* § 212 cmt. b; *see also id.* § 202(1) (“Words and other conduct are interpreted in the light of all the circumstances.”).

²⁶⁰ *Id.* § 212 cmt. b.

²⁶¹ *See id.* (“But after the transaction has been shown in all its length and breadth, the words of an integrated agreement remain the most important evidence of intention.”).

B. Corbinized Claim Construction

As previously outlined, the Federal Circuit has implicitly adopted Williston's approach to contract interpretation in its claim construction jurisprudence. But what would patent claim construction look like under Corbin's interpretative approach?

Generally, adopting a Corbin-esque approach to claim construction would shift the focus away from attempting to determine how a PHOSITA at the time of filing would have defined a term and instead to looking at what an inventor and the patent examiner intended that term to mean at the time of filing. In other words, the interpretative focus would shift from an objective standard to a more subjective one.²⁶² Thus, the ever-elusive PHOSITA standard would be replaced—but only for purposes of claim construction.²⁶³ Further, similar to contract law, an inventor's secret undisclosed intent would not matter.²⁶⁴ Instead, a court would be looking at the *manifestations* of an inventor's intent.²⁶⁵

Additionally, as a practical matter, changing this perspective could occur judicially, because unlike other areas of patent law,²⁶⁶ in the context of claim construction, the application of a PHOSITA standard is a judicial construct, as opposed to a statutory mandate.²⁶⁷ Indeed, a more subjective standard would appear to fit within the statutory language describing claims, which requires an applicant to “distinctly claim the subject matter *which the applicant regards as his invention.*”²⁶⁸ The perspective of the patent examiner, as gleaned from the prosecution history, would also play a role, since the examiner serves as the public representative and another party to the patent “contract.”²⁶⁹

²⁶² Notably, this subjective standard has historically had a role in claim construction. *See, e.g.,* *Evans v. Eaton*, 16 U.S. (3 Wheat.) 454, 506 (1818) (Marshall, C.J.) (“The intention of the parties, if that intention can be collected from sources which the principles of law permit us to explore, are entitled to great consideration.”); *Laitram Corp. v. Deepsouth Packing Co.*, 443 F.2d 928, 933 (5th Cir. 1971) (“[A] patent is to be construed as a contract, with the intent of the parties as the lodestar.”).

²⁶³ As previously noted, courts apply the PHOSITA standard in other contexts as well. *See supra* note 217.

²⁶⁴ *See supra* note 258 and accompanying text.

²⁶⁵ *See id.*

²⁶⁶ *See* 35 U.S.C. § 103(a) (2000 & Supp. V 2005) (“A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”); *id.* § 112 ¶ 1 (“The specification shall contain a written description of the invention, . . . in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, . . . to make and use the same . . .”).

²⁶⁷ *See, e.g.,* Dan L. Burk & Mark A. Lemley, *Policy Levers in Patent Law*, 89 VA. L. REV. 1575, 1649–50 (2003) (discussing the application of the PHOSITA standard to claim construction as a “judicially created patent doctrine[.]”).

²⁶⁸ 35 U.S.C. § 112 ¶ 2 (emphasis added).

²⁶⁹ *See, e.g.,* Lee Petherbridge, *Positive Examination*, 46 IDEA 173, 204 (2006) (“The Patent Office is charged with making certain that the U.S. public receives the benefit of the patent bargain.”). The evidentiary issues surrounding the intent of the patent examiner are discussed *infra* Part III.C.2.

In recognition of the importance of context in interpretation, all relevant extrinsic evidence of such manifestations would be admissible for purposes of interpreting a disputed claim term.²⁷⁰ Practically, however, and similar to the *Phillips* and *Vitronics* methodology, intrinsic evidence would still play an important role.²⁷¹ For example, under Corbin’s theory, the text of the claim itself would still constitute a key, if not dispositive, manifestation of the inventor’s intent.²⁷² As Corbin noted, “[t]he more bizarre and unusual an asserted interpretation is, the more convincing must be the testimony that supports it. Just when the court should quit listening to testimony that white is black and that a dollar is fifty cents is a matter for sound judicial discretion and common sense.”²⁷³ Accordingly, “[s]uch testimony does not vary or contradict the written words.”²⁷⁴ However, in at least some cases, using a subjective standard would allow a court to give a more practical meaning to patent claims and avoid the irrational result of cases such as *Chef America*.²⁷⁵

Intrinsic evidence would continue to play an important role. The specification would remain strong evidence for purposes of claim construction.²⁷⁶ A patent’s prosecution history would also be highly relevant for purposes of examining the manifestations that an inventor made to the PTO during the course of the patent application process.²⁷⁷

Further, although the PHOSITA standard would no longer be the primary inquiry, evidence pertaining to how a PHOSITA would interpret a term would remain relevant for purposes of claim construction. First, such extrinsic evidence could be relevant as evidence of a usage of trade. In contract law, a usage of trade is “a usage having such regularity of observance in a place, vocation, or trade as to justify an expectation that it will be observed with respect to a particular agreement.”²⁷⁸ This evidence would be relevant given the technical background of patent examiners and an implicit assumption in most patent cases that the inventor *is* a PHOSITA.²⁷⁹

²⁷⁰ See 5 CORBIN ON CONTRACTS, *supra* note 241, § 24.10 (“The varieties of extrinsic evidence that may demonstrate circumstances surrounding formation of the contract are as limitless as are the types of circumstances.”); see also *id.* § 24.7 (“No person can determine the meaning of written words merely by gluing his or her eyes within the four corners of a square paper.”).

²⁷¹ See *supra* Part I.B.

²⁷² See *supra* note 252–54 and accompanying text.

²⁷³ 6 CORBIN ON CONTRACTS, *supra* note 241, § 579.

²⁷⁴ *Id.*

²⁷⁵ See *supra* notes 190–97 and accompanying text.

²⁷⁶ See *supra* note 69 and accompanying text.

²⁷⁷ See *supra* notes 88–90 and accompanying text.

²⁷⁸ RESTATEMENT (SECOND) OF CONTRACTS § 222(1) (1979).

²⁷⁹ See, e.g., *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc) (noting the “well-settled understanding that inventors are typically persons skilled in the field of the invention”); HARMON, *supra* note 228, § 6.2(a).

The PHOSITA standard could also come into play for technical terms.²⁸⁰ As the *Restatement (Second) of Contracts* points out, “technical terms and words of art are given their technical meaning when used in a transaction within their technical field.”²⁸¹ However, this applies “unless a different intention is manifested.”²⁸² Thus, this standard could be applied as creating a rebuttable presumption in favor of the PHOSITA standard for technical terms. Currently, this distinction does not apply, as the Federal Circuit routinely construes terms such as “or,” “and,” and other similar terms as part of its claim construction jurisprudence.²⁸³

A shift toward a subjective intent standard would also result in a new evidentiary tool for purposes of claim construction: embodiments of the invention. Historically, an inventor was required to submit a working model of an invention with their patent application when possible.²⁸⁴ Currently, however, evidence as to a commercial embodiment of an invention is generally not permitted for purposes of claim construction.²⁸⁵

Under Corbin’s approach, such evidence would be relevant to the inventor’s subjective intent, analogous to a course of performance. As noted by the *Restatement (Second) of Contracts*, course of performance refers to the “practical construction” of a contract by the parties following its execution.²⁸⁶

²⁸⁰ The *Restatement (Second) of Contracts* indicates that a technical term is “the vocabulary of a particular place, vocation or trade, in which new words are coined and common words are assigned new meanings.” RESTATEMENT (SECOND) OF CONTRACTS § 202 cmt. f (1979).

²⁸¹ *Id.* § 202(3)(b).

²⁸² *Id.* § 202(3).

²⁸³ See, e.g., *TIP Sys., L.L.C. v. Phillips & Brooks/Gladwin, Inc.*, 529 F.3d 1364, 1376 (Fed. Cir. 2008) (construing the word “and” in a patent claim); *Baldwin Graphic Sys., Inc. v. Siebert, Inc.*, 512 F.3d 1338, 1342–43 (Fed. Cir. 2008) (construing the word “a” in a patent claim); *Schumer v. Lab. Computer Sys., Inc.*, 308 F.3d 1304, 1311–12 (Fed. Cir. 2002) (construing the word “or” in a patent claim).

²⁸⁴ See 1 MOY, *supra* note 30, § 3:9.

²⁸⁵ See *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1578 (Fed. Cir. 1984) (“Infringement is determined on the basis of the claims, not on the basis of a comparison with the patentee’s commercial embodiment of the claimed invention.”); see also *Maclaren v. B-I-W Group Inc.*, 535 F.2d 1367, 1372 (2d Cir. 1976) (“It is a fundamental rule of patent law that the scope of protection granted by a patent is defined by the language of its claims rather than by its title, specifications, exhibits or by the commercial embodiments of the claimed invention.”); *Andis Clipper Co. v. Oster Corp.*, 481 F. Supp. 1360, 1377 (D. Wis. 1979) (“Under 35 U.S.C. § 112, it is impermissible in defense of a patent to read into the specifications or claims of the patent structures or uses that may inhere in the embodiment of the patent or the uses of that embodiment but which are not in fact in the language of the claim or claims in issue.”). Further, a patent applicant is no longer required to submit a working model of the invention. See MPEP, *supra* note 30, § 608.3(a); see also 37 C.F.R. § 1.91 (2008); *In re Strahilevitz*, 668 F.2d 1229, 1232 (C.C.P.A. 1982) (“We recognize that working examples are desirable in complex technologies Indeed, the inclusion of such examples here might well have avoided a lengthy and, no doubt, expensive appeal. Nevertheless, as acknowledged by the board, examples are not required to satisfy section 112”).

²⁸⁶ RESTATEMENT (SECOND) OF CONTRACTS § 202 cmt. g; see also UNIF. COMM. CODE § 1-303(a) (2002) (“A ‘course of performance’ is a sequence of conduct between the parties to a particular transaction that exists if: (1) the agreement of the parties with respect to the transaction involves repeated occasions for performance by a party; and (2) the other party, with knowledge of the

This evidence, however, “must be weighed in the light of the terms of the agreement and their possible meanings.”²⁸⁷

Evidence as to a course of performance, although rarely dispositive in contract law,²⁸⁸ can still assist a court in giving meaning to a disputed claim term.²⁸⁹ In the context of patent claim construction, an examination of a commercial embodiment would be indicative of not only what inventors subjectively thought they invented, but how they intended their claims to be interpreted as well.²⁹⁰ Again, it probably would not be dispositive, but it would become evidence that a court could legitimately consider under Corbin’s theory.

One example of how Corbinized claim construction could apply in practice is *SuperGuide Corp. v. DirectTV Enterprises, Inc.*, where the disputed claim language was “regularly received television signal.”²⁹¹ When the patent was granted in 1985, the only type of television signals that were broadcast were analog signals.²⁹² The issue faced by the court was whether the disputed claim language encompassed digital signals, which were not developed until well after the patent was issued.²⁹³

In examining the issue, the court began by noting that “[t]he claim language does not limit the disputed phrases to any particular type of technology or specify a particular type of signal format, such as analog or digital.”²⁹⁴ Thus, the court stated, if the patentees intended to limit the claim to cover only analog signals, they would have modified the claim language to read “regularly received analog television signal.”²⁹⁵ Further, nothing in the claim language or the specification prevented the invention from receiving signals in digital format.²⁹⁶ Accordingly, because “[t]he law ‘does not require that an applicant describe in his specification every conceivable and possible future embodiment of his

nature of the performance and opportunity for objection to it, accepts the performance or acquiesces in it without objection.”).

²⁸⁷ RESTATEMENT (SECOND) OF CONTRACTS § 202 cmt. g.

²⁸⁸ Indeed, under the *Restatement (Second) of Contracts*, express terms always outweigh a course of performance. See RESTATEMENT (SECOND) OF CONTRACTS § 203(b) (1979). *Accord* U.C.C. § 1-303(e) (2002). Corbin also noted how course of performance evidence could be outweighed by other forms of extrinsic evidence. See 5 CORBIN ON CONTRACTS, *supra* note 241, § 24.16 (“There are many additional sources of extrinsic evidence and of methods useful in interpreting contracts. Any of these sources may produce a degree of conviction that overpowers inferences to be drawn from the parties’ course of performance.” (internal citation omitted)).

²⁸⁹ RESTATEMENT (SECOND) OF CONTRACTS § 202 cmt. g (“The parties to an agreement know best what they meant, and their action under it is often the strongest evidence of their meaning.”).

²⁹⁰ See *Paulik v. Rizkalla*, 760 F.2d 1270, 1276 (Fed. Cir. 1985) (noting that “it is the rare invention that cannot be deciphered more readily from its commercial embodiment than from the printed patent”). This would be similar to the current use of the specification.

²⁹¹ 358 F.3d 870, 878 (Fed. Cir. 2004).

²⁹² *Id.* at 876.

²⁹³ See *id.* at 876–78.

²⁹⁴ *Id.* at 878.

²⁹⁵ See *id.* at 880 (“Had the patentees intended to limit the disputed claim terms to ‘analog’ technology, they could have easily done so by explicitly modifying the disputed claim language with the term ‘analog.’”).

²⁹⁶ *Id.*

invention,” the court found “no reason here to limit the scope of the claimed invention to analog technology.”²⁹⁷

Chief Judge Michel disagreed with this claim construction, stating that it “expand[ed] the scope of the [] patent far beyond what the named inventors say they actually invented in their application, and what it describes and enables.”²⁹⁸ He also criticized the “literalist and abstract reading” given to the claim language by the majority, particularly since digital television signals were “indisputably not broadcast until the mid-1990s.”²⁹⁹ Chief Judge Michel concluded his opinion by criticizing the court’s trend of “providing the broadest possible scope to claim terms . . . regardless of what the inventors actually invented,” threatening to give patentees broader protection than contemplated by the patent examiner.³⁰⁰ Accordingly, “[t]he inventors here most assuredly did not invent a system that receives digital signals; their patent cannot therefore cover such systems.”³⁰¹

Applying Corbin’s approach to claim construction would adopt Chief Judge Michel’s reasoning in *SuperGuide*. When faced with a patentee attempting to include after-arising technologies within the scope of a patent claim, if the patentee did not contemplate these technologies at the time of invention, making claim construction more of a subjective inquiry would exclude them from being within the scope of the claim.³⁰² Unless, of course, the patentee could show that he or she manifested the intent to include these technologies as part of specific claim terms.³⁰³ If so, as Chief Judge Michel noted, the patent examiner could take the breadth of the claim into consideration as part of the validity inquiry.³⁰⁴

As this outcome illustrates, practically, Corbinized claim construction may result in narrower claim scope. As previously outlined, extrinsic evidence could only be used to interpret, and not to add, terms to a claim.³⁰⁵ Further, applying a subjective standard, an examination of an inventor’s manifestations of intent probably would not result in a disputed claim term including after-arising technology not contemplated by the inventor.³⁰⁶

This result arguably has its weaknesses. Limiting the definition of claim terms to what the inventor contemplated at the time that the application was filed

²⁹⁷ *Id.* (quoting *SRI Int’l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985)).

²⁹⁸ *Id.* at 896 (Michel, C.J., concurring in result).

²⁹⁹ *Id.* at 896–97.

³⁰⁰ *Id.* at 898.

³⁰¹ *Id.* He previously noted how the patentees were not even in the process of developing digital signal technology at the time they received the patent. *See id.* at 898 n.20.

³⁰² Logically, the definition of after-arising technology does not indicate that it is something considered by the inventor at the time of invention. *See, e.g., In re Hogan*, 559 F.2d 595, 605 (C.C.P.A. 1977) (defining “after-arising” technology as technology that “come[s] into existence after the filing date of an application”). Accordingly, it is doubtful that an inventor would have manifested an intent for a disputed claim term to include technology not even fathomed at the time of invention.

³⁰³ For example, in *SuperGuide*, the patentees could have shown that they intended the term “regularly received” to include no temporal restriction.

³⁰⁴ *See supra* note 300 and accompanying text.

³⁰⁵ *See supra* note 274 and accompanying text.

³⁰⁶ *See supra* note 302.

could present problems for cutting-edge technology that is at an early stage of development.³⁰⁷ As one commentator noted, patent protection “may be hollow if it does not confer the ability to prevent logical applications of the principal of the invention to new and unforeseen circumstances.”³⁰⁸

However, it is important to note that adopting Corbin’s interpretative approach would only affect how claims are interpreted. Other devices are available with which a patentee can broaden the scope of a patent.³⁰⁹ The doctrine of equivalents presents one such mechanism.³¹⁰ According to this doctrine, if a product or process does not literally infringe on the patent, the alleged infringer will nonetheless be liable “if there is ‘equivalence’ between the elements of the accused product or process and the claimed elements of the patented invention.”³¹¹ Although the Supreme Court has recognized the potential notice problems created by the doctrine, “[e]ach time the Court has considered the doctrine, it has acknowledged this uncertainty as the price of ensuring the appropriate incentives for innovation, and it has affirmed the doctrine over dissents that urged a more certain rule.”³¹² Indeed, one of the significant benefits of the doctrine is its ability to cover equivalent technology that was not contemplated at the time the patent claims were written.³¹³ Notably, however, there are limits to a patentee’s ability to use the doctrine to expand the scope of a claim, such as prosecution history estoppel, which prevents a patentee from using

³⁰⁷ See, e.g., Lemley, *supra* note 46, at 120.

³⁰⁸ *Id.*

³⁰⁹ See *id.* at 120–21 (outlining various mechanisms that allow a patentee to broaden the scope of a patent). See generally Robert Unikel & Douglas Eveleigh, *Protecting Inventors, Not Fortune Tellers: The Available Patent Protection for After-Developed Technologies*, 34 AIPLA Q.J. 81 (2006) (discussing various doctrines used by courts when faced with after-developed technologies).

³¹⁰ See, e.g., *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731–32 (2002) (“The language in the patent claims may not capture every nuance of the invention or describe with complete precision the range of its novelty. If patents were always interpreted by their literal terms, their value would be greatly diminished. . . . The scope of a patent is not limited to its literal terms but instead embraces all equivalents to the claims described.”).

³¹¹ *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21 (1997); see also *Festo Corp.*, 535 U.S. at 733 (“The doctrine of equivalents allows the patentee to claim those insubstantial alterations that were not captured in drafting the original patent claim but which could be created through trivial changes.”). For a thorough discussion of the doctrine of equivalents, including its historical roots and development over time, see generally 5 CHISUM, *supra* note 23, § 18.02. Some commentators, however, argue that the doctrine should be abolished. See, e.g., Joshua D. Sarnoff, *Abolishing the Doctrine of Equivalents and Claiming the Future After Festo*, 19 BERKELEY TECH. L.J. 1157 (2004).

³¹² *Festo Corp.*, 535 U.S. at 732; see also *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1425 (Fed. Cir. 1997) (“Because the doctrine of equivalents blurs the line of demarcation between infringing and non-infringing activity, it creates a zone of uncertainty, into which competitors tread only at their peril.”).

³¹³ Lemley, *supra* note 46, at 120; see also *id.* at 121 (noting that “the doctrine of equivalents remains robust enough to . . . ensur[e] that pioneering patents retain effective scope as improvers develop next-generation technologies”).

the doctrine of equivalents to cover subject matter that the patentee relinquished during the patent's prosecution at the PTO.³¹⁴

Further, the potential for a narrower patent scope could produce an incentive for patentees to disclose more information during patent prosecution, since a patentee could always stymie any potential for narrow claim construction when drafting the patent.³¹⁵ A patentee could accomplish this solution by providing clear claim language and providing clear intrinsic evidence of the meaning of terms.³¹⁶ For example, a patentee could choose to be a lexicographer and include a glossary of terms within the patent.³¹⁷ Another option would be to cite to desired interpretative sources or provide additional examples of embodiments of the invention.³¹⁸ Any of these options, when combined with the knowledge of the precise interpretative regime a court will apply in any subsequent litigation, provides a patentee with the ability to build the record and compensate for any potential narrowing of patent scope. Thus, one of the advantages of adopting Corbin's approach is that it would improve the accuracy of the claim construction inquiry by limiting the scope of a claim to what was contemplated by inventors, or, alternatively, at least force them to talk about it.

Corbin's interpretative approach also may improve the certainty involved with patent claim construction by avoiding many of the problems created by the PHOSITA standard.³¹⁹ Instead of a court attempting to determine how a PHOSITA at the time of filing would have interpreted a term, it would look at the inventor's manifestations of his or her subjective interpretation of the term.³²⁰ This would limit the potential for hindsight bias and manipulation because a court

³¹⁴ See, e.g., *Festo Corp.*, 535 U.S. at 734–35 (“Where the original application once embraced the purported equivalent but the patentee narrowed his claims to obtain the patent or to protect its validity, the patentee cannot assert that he lacked the words to describe the subject matter in question. . . . In that instance the prosecution history has established that the inventor turned his attention to the subject matter in question, knew the words for both the broader and narrower claim, and affirmatively chose the latter.”); see also *Wang Labs., Inc. v. Mitsubishi Elecs. Am., Inc.*, 103 F.3d 1571, 1577–78 (Fed. Cir. 1997) (“Prosecution history estoppel acts as one check on [the] application of the doctrine of equivalents by precluding a patentee from regaining, through litigation, coverage of subject matter relinquished during prosecution of the application for the patent.” (internal citations omitted)); *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1107 (Fed. Cir. 1996) (“A patentee may not narrowly claim his invention and then, in the course of an infringement suit, argue that the doctrine of equivalents should permit a finding of infringement because the specification discloses the equivalents.”).

³¹⁵ See Mullally, *supra* note 13, at 377 (“The success of a patent having the scope desired by the inventor depends, as it should, on the words and techniques that the inventor selects.”); see also *Sage Prods., Inc.*, 126 F.3d at 1425 (noting the “premium on forethought in patent drafting”).

³¹⁶ See Mullally, *supra* note 13, at 376–78 (outlining methods that a patentee could use when drafting a patent to control how it is interpreted).

³¹⁷ *Id.*

³¹⁸ See *id.* at 378; Joseph Scott Miller, *Enhancing Patent Disclosure for Faithful Claim Construction*, 9 LEWIS & CLARK L. REV. 177, 206 (2005). For the PTO's current rules regarding incorporating documents by reference, see 37 C.F.R. § 1.57 (2008).

³¹⁹ See *supra* Part II.D. Although the PHOSITA standard may still play a role in Corbinized claim construction, the fact that it would no longer be the exclusive standard for claim interpretation mitigates the problems previously outlined.

³²⁰ See *supra* Part III.B.

could point to specific manifestations made by the inventor, which, at least in theory, would be more ascertainable.³²¹

By focusing more on an inventor's subjective intent, claim construction also minimizes the problems posed by a judge's lack of technological background.³²² Instead of being forced to learn the underlying technology, then attempting to look at how a PHOSITA at the time of filing would have interpreted a term, a judge could simply do what he or she frequently does in the context of contract cases: examine evidence indicating a party's subjective intent.³²³ This approach also has the potential to limit hindsight bias from creeping into a judge's determination of the knowledge that a PHOSITA at the time of filing would possess.³²⁴

Commentators, however, may disagree with this assessment. According to one recent study, the "measure of indeterminacy" between patent claim construction cases and contract interpretation cases was similar.³²⁵ Assuming that this conclusion is accurate,³²⁶ adopting Corbin's approach may still have benefits for certainty. Initially, there may be a labeling benefit for district court judges faced with claim construction. Avoiding the current charade that courts are not applying a theory of contract interpretation allows judges to recognize that, in reality, claim construction is really the same process that they undergo in the thousands of contract cases they are faced with each year.³²⁷

Further, alleviating the current panel-dependent nature of claim construction by adopting a consistent interpretative methodology creates additional certainty.³²⁸ Although explicitly announcing that the court was applying Williston's interpretative approach could have similar labeling benefits,

³²¹ Theoretically, an inventor would only have one subjective meaning of a term. If evidence was disputed, a court could simply exercise its authority to weigh the evidence. This, along with the additional weighing of evidence at the district court level that would be necessitated by Corbinized claim construction, could provide an opportunity to adopt a more deferential standard of review on appeals to the Federal Circuit.

³²² See *supra* notes 227–30 and accompanying text.

³²³ Indeed, in 2008, compared to the almost 3000 patent infringement suits filed, district courts were faced with over 34,000 filed contract cases. See 2008 ANNUAL REPORT, *supra* note 53, at 146 tbl.C-2A.

³²⁴ See, e.g., Jeffrey J. Rachlinski, *A Positive Psychological Theory of Judging in Hindsight*, 65 U. CHI. L. REV. 571, 592 (1998) (noting that "hindsight bias probably has less influence on judgments made under subjective standards than it does on judgments made under objective standards").

³²⁵ See Jeffrey A. Lefstin, *The Measure of Doubt: Dissent Indeterminacy, and Interpretation at the Federal Circuit*, 58 HASTINGS L.J. 1025, 1088 (2006).

³²⁶ Given the sheer number of contract cases, see *supra* note 323, it may simply be that there is a selection bias in the cases that Courts of Appeals decide to hear. Other commentators have critiqued the results of Lefstin's study. See Hubbard, *supra* note 214, at 343 n.96.

³²⁷ See *supra* note 323.

³²⁸ See Cotropia, *supra* note 12, at 99–100 (noting the certainty benefits of selecting a consistent claim construction methodology). Some commentators argue that uncertainty may even be beneficial in the patent context. See generally Ian Ayres & Paul Klemperer, *Limiting Patentees' Market Power Without Reducing Innovation Incentives: The Perverse Benefits of Uncertainty and Non-Injunctive Remedies*, 97 MICH. L. REV. 985 (1999).

because the majority of jurisdictions adopt Corbin's approach, courts would be more familiar with its application and hence the certainty benefit would be greater.³²⁹

C. *The Limits of Corbinized Claim Construction*

1. Notice

Perhaps the most obvious implication of adopting Corbin's approach is for the notice function of claims. As previously outlined, one of the purposes of claims is to inform members of the public about the scope of the claim.³³⁰ Indeed, "[i]nherent in our claim-based patent system is . . . the principle that the protected invention is what the claims say it is, and thus that infringement can be avoided by avoiding the language of the claims."³³¹ Injecting elements of a subjective standard, by definition, appears to counteract this function, since it prevents a third party from being able to look at the public record and understand the scope of a patent.³³² At a minimum, information costs related to finding evidence of an inventor's manifestations regarding a disputed claim term would arguably increase.³³³

However, several factors indicate that the consequences of adopting Corbin's approach may not be as drastic in practice. First, the practical changes in the evidence and process used by a court when construing claims is not as significant as one may initially fear.³³⁴ A competitor or member of the public could still examine the intrinsic evidence of the patent, the state of the art at the

³²⁹ See, e.g., *Travelers Casualty & Surety Co. v. United States*, 75 Fed. Cl. 696, 707 (2007) ("The Corbin approach is followed in the *Restatement (Second)*, as well as by most jurisdictions in the United States, including most United States Circuit Courts of Appeal."); see also Johnson, *supra* note 158, at 672 (noting how the Supreme Court has recognized the *Restatement (Second) of Contracts* as embodying the general law of contracts in the United States).

³³⁰ See *supra* Part I.A.

³³¹ *Slimfold Mfg. Co., Inc. v. Kinkead Indus., Inc.*, 932 F.2d 1453, 1457 (Fed. Cir. 1991); see also *PSC Computer Prods., Inc. v. Foxconn Int'l Inc.*, 355 F.3d 1353, 1359 (Fed. Cir. 2004) (noting that "one of ordinary skill in the art should be able to read a patent, to discern which matter is disclosed and discussed in the written description, and to recognize which matter has been claimed").

³³² See Benjamin Hattenbach, *On Illuminating Black Holes in Patent Disclosures: Toward a Structured Approach to Identifying Omitted Elements under the Written Description Requirement of Patent Law*, 38 HOUS. L. REV. 1195, 1226 n.173 (2001) ("If a subjective standard were adopted, the public would no longer have a right to rely on the public record, but instead would be required to initiate litigation and cross-examine inventors about their subjective beliefs . . ."); see also Hubbard, *supra* note 214, at 355–56 (noting factors in contracts that reduce certainty and notice).

³³³ See Christopher A. Cotropia, *Patent Claim Construction and Information Costs*, 9 LEWIS & CLARK L. REV. 57, 90 (2005) ("The definition of an invention presents unique information cost problems. The lower the information costs encountered in defining the scope of the invention, the easier it is for all observers to understand the critical aspect of a patent—the scope of its exclusivity. Claim interpretation is, at its base, an information costs problem and should be judged as such.")

³³⁴ See *supra* Part III.B.

time of filing, and similar evidence in order to be on notice of the claim's scope. Also, creating a role for easily accessible extrinsic evidence such as commercial embodiments may actually *lower* information costs for a PHOSITA or competitor seeking to design-around a patent.³³⁵

Even with these potential notice issues, Corbin's interpretative model remains preferable because the notice function of claims under the current approach to claim construction is minimal. As some commentators have pointed out, the mercurial nature of the Federal Circuit's claim construction jurisprudence makes any form of notice difficult.³³⁶ The ideological split among members of the court, and the resulting panel-dependent nature of claim construction, only exacerbates this problem.³³⁷ Thus, it is questionable whether a PHOSITA or any member of the public could simply look at a patent or its intrinsic evidence and be on notice of the claim's scope for purposes of designing-around a patent—no matter what claim construction approach the law adopted.³³⁸

Even if the patent document could satisfy the notice functions of claims, practically, many segments of the public have no desire to be aware of the document in the first place. For example, a recent article concluded that “both researchers and companies in component industries simply ignore patents. Virtually everyone does it.”³³⁹ Indeed, “many companies discourage employees from reading patents,” because it “presumably lessens the chance that the

³³⁵ See JAMES BESSEN & MICHAEL J. MEURER, PATENT FAILURE: HOW JUDGES, BUREAUCRATS, AND LAWYERS PUT INNOVATORS AT RISK 61 (2008) (noting that “[p]otentially, greater use of extrinsic evidence would *strengthen* the notice function” (emphasis added)); Cotropia, *supra* note 333, at 83–84; Clarisa Long, *Information Costs in Patent and Copyright*, 90 VA. L. REV. 465, 486–88 (2004) (discussing how using embodiments of an invention reduce information costs). Presumably, a competitor or inventor seeking to design-around a patent would be familiar with a competitor's products (i.e. a commercial embodiment of the patented invention). See, e.g., Liam Fahey, *Competitor Analysis: From Data to Insight*, in BUSINESS: THE ULTIMATE RESOURCE 328, 328–29 (2d ed. 2006) (discussing how competitive intelligence is a regular part of business activity).

³³⁶ See, e.g., Nard, *supra* note 10, at 41–43; see also Matthew D. Powers & Steven C. Carlson, *The Evolution and Impact of the Doctrine of Willful Patent Infringement*, 51 SYRACUSE L. REV. 53, 102–03 (2001) (“Even if companies were to attempt to investigate every patent under which they face potential liability, it is unclear how much more certain of their legal rights they would be. Patents are notoriously hard to interpret, and the outcome of patent litigation is equally difficult to predict. The most sophisticated patent analysis may fail to clarify for the alleged infringer whether an eventual judge and jury will find a patent valid and infringed.”).

³³⁷ See *supra* note 10.

³³⁸ See, e.g., Bender, *supra* note 212, at 213–14 (“In most cases, a lay person, even an experienced judge, is not able to fully understand the technology and to extrapolate from that knowledge about the ordinary meaning of disputed scientific terms.”); Cotropia, *supra* note 333, at 74 (“While claims provide information on the boundaries of patent protection, claims by themselves, without any further evaluation, fail to fully convey these boundaries to those who need to use them to make patent decisions.”); Hubbard, *supra* note 214, at 337 (noting that the notice function of claims is “somewhat fictional because claim construction is far from being an exact science, and reasonable people often disagree regarding the construction of crucial terms”).

³³⁹ Lemley, *supra* note 51, at 21.

company will be found to have knowledge of a patent.”³⁴⁰ Additionally, few patent infringement cases, possibly for this reason, involve allegations of actual copying on the part of an alleged infringer.³⁴¹ In light of the minimal notice currently provided by patents, any detrimental effects on notice caused by Corbinized claim construction may be mitigated.

2. Evidentiary Obstacles

The effectiveness of Corbinized claim construction is also hindered by difficulties with determining the understanding of the patent examiner, the public representative and the other party to the patent contract.³⁴² Because Corbin’s theory revolves around a “meeting of the minds,”³⁴³ the proper interpretation of a patent would therefore require consideration of how the patent examiner understood disputed claim language. However, even if the Federal Circuit’s current doctrinal limitations³⁴⁴ on the use of the patent examiner’s perspective were lifted, evidentiary problems would remain. Currently, examiners are barred from testifying in infringement proceedings.³⁴⁵ This bar is premised on the fact that examiners are deemed “quasi-judicial officials.”³⁴⁶

A truly Corbinized claim construction would allow inventor testimony about his or her subjective intent to play a role. Thus, without any mechanism to introduce evidence from patent examiners, this would result in evidence from the patentee arguing in favor of broad claim scope without the counter-balancing testimony of the patent examiner. Although such one-sided testimony could be problematic, in practice, it can only get a party so far. As Corbin noted, “[a] party will not be permitted to build up an argument by means of self-serving statements.”³⁴⁷ Further, courts are already entrusted with performing an evidentiary gate-keeping function.³⁴⁸ Why should testimony in the context of claim construction be any different? Certainly, at least in some cases, an

³⁴⁰ Edwin H. Taylor & Glenn E. Von Tersch, *A Proposal to Shore Up the Foundations of Patent Law That the Underwater Line Eroded*, 20 HASTINGS COMM. & ENT. L.J. 721, 737 (1998).

³⁴¹ See generally Christopher A. Cotropia & Mark A. Lemley, *Copying in Patent Law*, 87 N.C. L. REV. 1421 (2009) (finding that only 10.9% of patent infringement complaints studied even included allegations of copying, with copying actually established in only 1.76% of cases).

³⁴² See *supra* note 269 and accompanying text.

³⁴³ See *supra* note 247 and accompanying text.

³⁴⁴ See *supra* notes 178–81 and accompanying text.

³⁴⁵ MPEP, *supra* note 30, § 1701.01 (“It is the policy of the United States Patent and Trademark Office that its employees, including patent examiners, will not appear as witnesses or give testimony in legal proceedings . . .”); see *Green v. Rich Iron Co., Inc.*, 944 F.2d 852, 854 (Fed. Cir. 1991) (“Examiners cannot be compelled to testify about their ‘mental processes’ in reaching a decision on an application. Only factual matters . . . are fair subjects for inquiry.”); *W. Elec. Co., Inc. v. Piezo Tech., Inc.*, 860 F.2d 428, 431 (Fed. Cir. 1988) (noting that “the general rule has been that a patent examiner cannot be compelled to testify regarding his ‘mental processes’ in reaching a decision on a patent application”); see also 15 C.F.R. § 15.16(b) (2008); 37 C.F.R. § 104.22 (2008).

³⁴⁶ See, e.g., *W. Elec. Co.*, 860 F.2d at 431–32.

³⁴⁷ 6 CORBIN ON CONTRACTS, *supra* note 241, § 24.10.

³⁴⁸ See FED. R. EVID. 104(a).

inventor's testimony as to his or her subjective intent could be a legitimate, credible piece of extrinsic evidence that a court could consider.³⁴⁹

Additionally, other mechanisms currently exist with which a court could glean the examiner's understanding of claim language. The PTO could use these mechanisms to expand the prosecution history and provide more evidence of the examiner's intent during subsequent litigation.³⁵⁰ For example, the PTO has the ability to request interviews with applicants, the substance of which must be documented by the primary patent examiner.³⁵¹ In recent years, the PTO has taken measures to increase the number of these interviews.³⁵² Patent examiners also have the ability to issue "patentability reports"³⁵³ and statements providing their reasons for allowing a specific claim.³⁵⁴

Another potential issue with considering a patent examiner's understanding of claim language is that, during patent prosecution, an examiner gives claim terms their "broadest reasonable construction."³⁵⁵ The rationale for this rule is the assumption that a patentee will argue for broader construction of claim terms in infringement litigation, while arguing for a narrow construction during patent prosecution in order to ensure that the requirements for validity are met.³⁵⁶ Because this standard differs from the interpretative approach that would be used during subsequent infringement litigation, it would arguably skew an examiner's understanding of claim language.³⁵⁷

³⁴⁹ See, e.g., *Stearns v. Beckman Instruments, Inc.*, 669 F.2d 1095, 1099 (5th Cir. 1982) (noting that a patentee's testimony "cannot be entirely disregarded").

³⁵⁰ See *BESSEN & MEURER*, *supra* note 335, at 238–39 (arguing that patent examiners should request more information about the meaning of claims and provide more documentation of the patent prosecution process); see also *id.* at 226–27 ("Patent examiners need to record the interpretation of claims that they use to decide patent validity and courts need to defer to these interpretations unless they are in clear error.").

³⁵¹ See MPEP, *supra* note 30, § 713; see also 37 C.F.R. § 1.133 (2008) (outlining the parameters for applicant interviews with the PTO).

³⁵² See PATENT PUBLIC ADVISORY COMMITTEE, U.S. PATENT & TRADEMARK OFFICE, ANNUAL REPORT 6 (2008), available at http://www.uspto.gov/web/offices/com/advisory/reports/ppac_2008annualrpt.pdf (noting recent PTO policy changes designed to encourage more pre-examination interviews).

³⁵³ See MPEP, *supra* note 30, §§ 705–705.01(a).

³⁵⁴ See 37 C.F.R. § 1.104(e) (2008); see also John F. Duffy, *On Improving the Process of Claim Interpretation: Administrative Alternatives*, 2 WASH. U. J.L. & POL'Y 109, 156–58 (2000) (proposing that the PTO issue administrative opinions to assist courts in claim construction).

³⁵⁵ See, e.g., MPEP, *supra* note 30, § 2111; *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) ("[A]s an initial matter, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.").

³⁵⁶ See, e.g., *In re Buszard*, 504 F.3d 1364, 1366–67 (Fed. Cir. 2007); *In re Yamamoto*, 740 F.2d 1569, 1571–72 (Fed. Cir. 1984); Hubbard, *supra* note 214, at 366–67.

³⁵⁷ See, e.g., *In re Morris*, 127 F.3d at 1054 ("It would be inconsistent with the role assigned to the PTO in issuing a patent to require it to interpret claims in the same manner as judges . . ."); Risch, *supra* note 36, at 202 (noting that "the broadest reasonable construction rule was never intended to define claim terms during patent enforcement").

However, as a practical matter, the broadest reasonable construction rule exemplifies the bargaining dynamic of contract law more than a shift in how patent examiners understand claim terms. The rule implicitly recognizes that the patentee will be arguing for a similarly broad interpretation in litigation.³⁵⁸ By having a patent examiner take this stance during patent prosecution, and therefore increasing the risk of a finding of invalidity, the rule forces an applicant to narrow the construction of the patent's claims through the patent prosecution process.³⁵⁹ Thus, the rule is more like an initial bargaining position that the patent examiner, the de facto public representative, can use to ensure that the public receives the best deal in exchange for the patent right.³⁶⁰ Accordingly, the broadest reasonable construction rule will not have a significant effect on the efficacy of Corbinized claim construction.

Conclusion

We should recognize the obvious: the patent system reflects a bargain between the public and the patentee. Despite the Federal Circuit's claims to the contrary, the fact that it has adopted a claim construction jurisprudence that mirrors Williston's interpretative theory provides proof that the contract analogy has merit. Of the two primary theories of contract interpretation, however, the Federal Circuit chose to adopt the approach that has been rejected by most jurisdictions. Why should patent claim construction continue to mirror an interpretative theory rejected by most courts, particularly in light of the unique problems that this theory has spawned when applied in the patent context?

Instead, courts should construe claims according to Corbin's theory and provide a greater role for the subjective intent of the patentee and the patent examiner, as well as extrinsic evidence. While this approach certainly would not be a panacea for all that ails the modern patent system in the United States, it would be a significant step toward addressing many of the problems that have arisen under the current claim construction framework, and would unite these different areas of the law. That is the promise of Corbinized claim construction.

³⁵⁸ See, e.g., Lemley, *supra* note 46, at 110 ("Patent owners would like their patent claims to be construed broadly in infringement proceedings, so that they cover defendants' products, but would generally like their claims to be construed narrowly when it comes to validity, to avoid the risk of either treading on the prior art or claiming more than the patentee has enabled or described.").

³⁵⁹ See Hubbard, *supra* note 214, at 366–67. See generally Nancy A. Welsh, *Perceptions of Fairness in Negotiation*, 87 MARQ. L. REV. 753 (2004) (discussing the back and forth of negotiating and bargaining).

³⁶⁰ See *supra* note 269 and accompanying text.