

PATENT CLAIM INTERPRETATION
What is the Game in North America?
(An Outline)

By J. Alan Aucoin

With apologies for my title (and a nod) to a former Chief Judge of the U.S. Federal Circuit, my presentation will highlight the similarities and differences of claim interpretation by the courts in the United States and Canada. Following Judge Fysh's example when he spoke about the "Scope of Claims" to a FICPI Forum in Monte Carlo, I will primarily consider the proper interpretation of claims in the context of patent litigation.

For the United States, you will appreciate that the primary "spokescourt" is the U.S. Federal Circuit (as affirmed by the U.S. Supreme Court); for Canada, decisions of the Supreme Court of Canada and its Federal Courts (Trial and Appellate) will provide the latest word. Given the limitations of an overview and risking oversimplification, I will outline here what I see as the approaches taken by North American courts today.

(i) The importance of claims

To state the obvious at the outset, patent claims are central and indeed crucial to every aspect of patent law in both Canada and the United States; especially in litigation, where interpretation/construction (it makes no difference which term is used) will determine whether a patent is valid or infringed. American and Canadian jurisprudence is replete with tests, cannons, rules, nuances and shibboleths about the manner in which patent claims are to be interpreted.

(ii) Interpretation is a legal matter

Since 1995 (in the U.S.) and forever in Canada, the interpretation of patent claims has been treated as a matter of law to be decided, at first instance, by the judge. In the U.S., that means the U.S. Federal District Court. However, because construction is appealable to the Federal Circuit *de novo*, we look to the decisions (and especially those *en banc*) of the Federal Circuit for ultimate guidance. In Canada, although Provincial Superior Courts and Federal Courts have concurrent jurisdiction over patent disputes, expertise and the exclusive jurisdiction to expunge patents resides primarily with the Federal Court of Canada where jury trials are prohibited.

In the U.S., "Markman hearings" are conducted, in the absence of the jury, to construe the patent claims without regard to the issues of validity and infringement which may follow at trial. In Canada, such hearings are currently unavailable although the trial judge will also construe the claims before deciding validity and infringement issues. Some have suggested that Markman rulings in advance of a trial can (depending on their outcome) promote early settlement; others have argued that they are an expensive and time consuming process. In the Canadian context, some question how the judge can effectively separate the construction

function from rulings on validity and infringement when the decision on all matters is delivered well after the trial on all issues.

(iii) The Skilled Person/Reader (a.k.a. the person having ordinary skill in the art (“PHOSITA”))

Expert evidence is almost always received by courts in both countries to “assist” the trial judge with interpretation of the entire patent. This is because the court must read the claims through the eyes of a skilled reader as of the “relevant date”. Some have questioned whether this is truly a “legal” as opposed to “factual” tool and whether, in the case of the U.S., this should affect the *de novo* appeal process.

(iv) The Entire Patent

To interpret the meaning of the claims, courts in both countries will look to the entire patent. Intrinsic evidence is looked at first to discern the meaning of words used in the claims. This includes, the language of the claims, the preceding specification and (except in Canada) the prosecution history for the patent. Extrinsic evidence which can also be received includes expert testimony from the perspective of a PHOSITA (almost always received), dictionaries and technical journals.

(v) Cannons of Construction

Courts in both countries recognize cannons of construction as a means of prioritizing and assisting with the interpretation of patent claims. For example, one accepted cannon is that validity should be maintained if there are equally arguable interpretations, one favouring validity and the other leading to invalidity. Another cannon precludes using the importation of limitations to the claims from the specification.

(vi) Purposive of Construction

Although arguably not new and certainly articulated by the English House of Lords in the *Catnic* decision, the Supreme Court of Canada has clearly stated that purposive construction rules the roost when it comes to the interpretation of patents. In essence, this technique requires separating the invention claimed into its essential and non essential elements, not only to construe the claims but also to determine whether there is infringement from functional equivalence.

(vii) The Relevant Date

The relevant date for a PHOSITA’s reading of the patent and meaning of its claims will, it has been suggested, vary depending upon what legal issue is being focused upon (e.g. novelty/obviousness, functional equivalence or infringement). In practice, Markman hearings will use the filing date. In Canada, the Supreme Court of Canada has pronounced that the effective publication date governs.

(viii) Summary

There is little doubt that claim construction is one of the most difficult aspects of patent litigation. The interpretation of patent claims is a much different exercise than undertaken with contract interpretation. In part, this is because of the public and private interests that patents serve. In addition, interpretation of claims will invariably involve legal and technical issues on a scale unparalleled in other types of litigation. When one adds the significant financial stakes that result from the cost of prosecution, litigation and ultimate recovery, it is easy to understand why Judge Rich said “The name of the game is the claim”.

Patent Claim Interpretation

The North American Game

J. Alan Aucoin

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What is this Game of Claim Construction/Interpretation?

- In Shakespeare's *Macbeth*, King Duncan says "There's no art to find the mind's construction in the face".
- In Lewis Carroll's *Through the Looking Glass*, Humpty Dumpty grumpily says "When I use a word, it means just what I choose it to mean – neither more nor less."
- In *Catalin Corporation of America v. Catazuli*, Judge Learned Hand remarked, "...if a patent can be construed only by threading one's way through all the verbal ingenuities which caustical solicitors develop to circumvent the objections of examiners, a labyrinth results, from which there is no escape."

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The Function of Claims

- Historically, American and Canadian Patent statutes did not expressly require a “claim” as part of the specification. Today, as Judge Rich cleverly put it, “The name of the game is the claim.”
- Claims are intimately intertwined with infringement and invalidity issues – the two core questions in patent litigation.
- Claims define what the Patentee regards as the “invention” and set the metes and bounds of the Patentee’s exclusive rights.
- Claims provide public notice (a) to advance technology and (b) to provide no trespass signs.

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Claim Function

- In *Electric & Musical Industries Ltd. v. Lissen Ltd.*, the House of Lords summed it up as follows:

“The function of claims is to define clearly and with precision the monopoly claimed, so that others may know the exact boundaries of the area within which they will be trespassers. Their primary object is to limit and not extend a monopoly. What is not claimed is disclaimed.”

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Claim Function

- William Hayhurst in “The Art of Claiming and Reading a Claim” states:

“ The principal function of claims is not to describe or instruct... but to de-limit. Claims are intended to define the metes and bounds of what the patent covers. They are intended to eliminate the surplusage in the preceding description and in that sense to disclaim. Ideally they recite only what is essential to the invention.”

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Claim Construction

- Claim construction is difficult – it has both a legal and technical component.
- Judge Plager of the U.S. Federal Circuit has remarked that “reading claims is an art of sorts, involving half technology and half linguistics.”
- Justice Collier of the Federal Court of Canada has observed: “In patent suits, claims are often at best riddles. When technical and difficult words and phrases are bundled into one huge sentence, the claim passes from riddle to enigma.”

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Claim Construction

- There are similarities and differences in the American and Canadian approaches.
- In the U.S., claims are to be construed by first looking at the intrinsic evidence.
- Intrinsic evidence includes the claim language, the remainder of the specification portion of the patent and the patent's prosecution history.
- Extrinsic evidence such as dictionaries, expert and inventor testimony and technical treatises can be used where the intrinsic evidence is inconclusive.

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Claim Construction

- In *Phillips III*, the U.S. Federal Circuit, *en banc*, stated:

“[T]here is no magic formula or catechism for conducting claim construction. Nor is the court barred from considering any particular sources were required to analyze sources in any specific sequence, as long as those sources are not used to contradict claim meaning that is unambiguous in light of the intrinsic evidence.”

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Claim Construction

- In Canada, the courts can consider both intrinsic and extrinsic evidence in construing the meaning of claims. However, the patent's prosecution history is treated as extrinsic evidence and is inadmissible for purposes of claim construction.
- Various construction terms have been used by the courts to approach claim construction ranging from “literal”, “spirit of the claim” and “pith and marrow of the claim.” The approach now is “purposive construction”.

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What is Purposive Construction?

- In *Catnic Components Ltd. v. Hill & Smith Ltd.*, Lord Diplock put it this way:

“A patent specification should be given a purposive construction rather than a purely literal one derived from applying to it the kind of meticulous verbal analysis in which lawyers are often too tempted by the training to indulge.”

Hayhurst has added:

“Purposive construction is a compendious term meaning that the specification should be construed in such a way as to give effect to the purpose of the drafter, at least where the purpose would be obvious to a person skilled in the art. It focuses on what the drafter was trying to accomplish.”

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What is Purposive Construction?

- The Supreme Court of Canada adopted purposive construction as the test for construction in two cases: *Free World Trust v. Electro Sante Inc.* and *Whirlpool Corp. v. Camco Inc.*
- Purposive construction is more than an equivalence test.
- Referring to *Catnic*, Justice Binnie in *Whirlpool* advocates differentiating the essential from the non-essential elements of the claim, based upon reading of the whole specification through the eyes of a skilled reader.

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What is Purposive Construction?

- In *Free World*, Justice Binnie stated:
“I think we should now recognize, however, that the greater level of discretion left courts to peer below the language of claims in search for the ‘the spirit of invention’, the less the claims can perform their public notice function and the greater the resulting level of unwelcome uncertainty and unpredictability. ‘Purposive construction’ does away with the first step of purely literal interpretation but disciplines the scope of ‘substantive’ claims construction in the interest of fairness to both the patentee and the public.”

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Legal Interpretation

- In the United States (as in Canada) claim construction is a legal function performed by the Judge.
- In the U.S. (not Canada), claim construction is generally conducted by the court prior to trial in *Markman* hearings.
- In both countries, claim construction is recognized as a pure question of law without reference to the facts.
- The *de novo* review of District Court construction decisions by the U.S. Federal Circuit has given rise to questions about whether that practice should continue having regard to a number of factors articulated by Judge Michel in *Amgen Inc. v. Hoechst Marion Rouselle, Inc.*

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PHOSITA Function

- Although patent claim interpretation has been compared to contract and statutory interpretation, there is a significant difference: patent claims are addressed to and must be understood by persons having ordinary skill in the art (“Phosita”).
- American and Canadian courts (except in the clearest cases of claims language) will use Phositas to educate the court’s reading of the terms in the claim and the specification.

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The Whole Patent

- As pointed out by the U.S. Federal Circuit in *Vitronics Corp v. Conceptoronic Inc.*, claim construction must begin with the language of the claims. The same approach follows in Canada.
- Claim terms must be given their ordinary and customary meaning as given by a *Phosita* unless the patentee used special terms or disavowed claim scope.
- In addition, the court will look to the specification (not to limit or enlarge the meaning of the claim terms) but to assist in construing their meaning.

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Canons of Construction

- Canons of construction are techniques used by the courts to assist with claim interpretation.
- “Canons” have been described as no more than pointers to discovering presumed intention. They have also been described as governing how a court uses sources to define the claim terms.

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Canons of Construction

- Weiss and Miller (*Practical Tips on Enforcing and Defending Patents*) list the following canons used by American courts:
 - Where intrinsic evidence unambiguously sets out claim scope, it controls
 - There is a heavy presumption in favour of the ordinary meaning of claim language
 - General and technical dictionaries can be used to determine ordinary meaning
 - A claim term may be read with reference to the specification but a limitation/expansion from the specification should not be read into the claim

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Canons of Construction

-If possible, a claim should be construed to encompass a disclosed embodiment of the invention

-Claims should be construed to uphold their validity unless their clear language shows otherwise

-Where a claim is susceptible to a broad and narrow construction, the narrow should be adopted

-The presumption of claim differentiation may be overcome by intrinsic and relevant extrinsic evidence

- In Canada, one of the few patent cases mentioning canons of construction is *Lovell Manufacturing Co. v. Beatty Brothers Ltd.*

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Canons of Construction

- In *Lovell*, Judge Thorson recognized the need for a court to construe the specification in light of the common knowledge which such person skilled in the art is assumed to have. He then went on to say:

“It is then the duty of the court to construe the specification and the claims in suit according to the recognized canons of construction. It is elementary that so far as a patent is a contract it is subject to the same rules of construction as would be applicable to a document embodying the terms of a contract.”

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The Relevant Date

- As a practical matter, claims interpretation in U.S cases will take place at the *Markman* hearing. The date used for a Phosita's reading of the patent will be the filing date of the patent.
- In Canada, the Supreme Court has pronounced that the effective publication date will govern. This may be different than the Canadian publication date if the patent application is based upon the priority of a foreign patent application.

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Summary

- Claim construction is one of the most difficult aspects of patent litigation.
- The interpretation of patent claims is a much different exercise than undertaken with contract interpretation. In part, this is because of the public and private interests that patents serve and the use of *Phositas* for technical issues.
- Adding the significant financial stakes that result from the cost of prosecution, litigation and ultimate recovery in respect of patents, it is easy to understand why Judge Rich said “The name of the game is the claim”.

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