



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

***Inverness Med.
Switzerland
GmbH
v.
Warner-
Lambert Co.***

Nos. 01-1147,
-1177
Federal Circuit
Oct. 31, 2002

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On October 31, 2002, the Federal Circuit vacated and remanded the district court’s summary judgment that Warner did not infringe U.S. Patents No. 5,622,871, No. 5,602,040, and No. 5,656,506, which related to analytical testing devices such as those to test a woman’s urine for the presence of human chorionic gonadotropin, a protein indicative of pregnancy. The Federal Circuit stated:

Appellants [contend] that the district court incorrectly construed the phrases “said labelled reagent is dry on said test strip” and “drying said labelled reagent onto a portion of said test strip.” The parties here do not argue that the terms “on” and “onto” have established specialized meanings, and we agree that “on” and “onto” have no such specialized meanings. Accordingly, standard dictionaries of the English language are the proper source of ordinary meaning of the phrase. . . . The definition of “onto,” . . . refers to the word “on” as part of its definition, such that both prepositions are properly addressed through the interpretation of “on.” . . .

The standard dictionaries provide a number of definitions of “on” in positional, functional, and temporal contexts. “[W]here there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.” . . . Here there are two possibly pertinent definitions. One is the definition . . . “used as a function word to indicate position over and in contact with that which supports from beneath.” The other is a definition of the term “on” encompassing internal positioning, providing: “used as a function word to indicate presence within.” In such situations, a word that has an ordinary meaning encompassing two relevant alternatives may be construed to encompass both alternatives. [W]e must determine whether the specification or prosecution history clearly demonstrates that only one of the multiple meanings was intended.

Appellee asserts that the specifications of the patents-in-suit show that the term “on” was used in a limited sense to mean only surface deposition. . . . The surface layer disposition is disclosed as a preferred embodiment of the invention, however, it is not the sole embodiment disclosed. Impregnation within the thickness of the test strip is also disclosed. . . . It is improper to limit the claim based on a preferred embodiment of the invention.

Appellee also cites to the prosecution histories of the patents as suggesting a limited use of the words “on” and “onto.” . . . Although we are not convinced that the appellants’ reading of the history is the only plausible reading, we are also not convinced that the prosecution history demonstrates that the patentee clearly was using the disputed language in a limited sense that would foreclose the broader dictionary definitions that encompass both surface and internal positioning. It is inappropriate to limit a broad definition of a claim term based on prosecution history that is itself ambiguous. “[A]lthough 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.”