

24 May 2004



TECHNOLOGY LAW UPDATE

A report of the latest Federal Circuit updates brought to you by Preston Gates.

Combined Sys., Inc. & Def. Tech. Corp. of Am.

No. 03-1251 (Fed. Cir. Nov. 20, 2003)

“The written description must be examined in every case, because it is relevant not only to aid in the claim construction analysis, but also to determine if the presumption of ordinary and customary meaning is rebutted.”

On November 20, 2003, the Federal Circuit affirmed the district court’s summary judgment that DTCA did not infringe U.S. Patent No. 6,202,562, which related to anti-personnel munitions--shotgun projectiles designed to distract or incapacitate individuals without causing serious injury or death. The Federal Circuit stated:

Claim terms must be construed as they would be understood by a person of ordinary skill in the art to which the invention pertains. “The words used in the claim[] are interpreted in light of the intrinsic evidence of record, including the written description, the drawings, and the prosecution history, if in evidence.” “In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art.” [CSI] argues that the district court erred in relying on the dictionary definition for the verb form of “fold” when “folds” is used in the claim as a noun, that the written description’s uses of the term “fold” are “unrelated” to the claim language and that the district court improperly relied on (1) “the figures in the preferred embodiment” (2) “in view of extrinsic evidence to support a previously flawed conclusion that any folds must be formed deliberately and systematically.” We conclude [that] the claim construction and hence the grant of summary judgment was correct.

[P]lainly as a matter of grammar, the recitation of “inserting said formed folds . . . into said projectile compartment” forecloses-- at least in the absence of compelling evidence to the contrary in the written description or prosecution history--a construction permitting the “folds” to be formed after or during insertion of the projectile into the projectile compartment in the shotgun shell. . . . CSI also assigns error to the methodology by which the district court used the dictionary in its claim construction analysis, including its “place[ment of] primary importance on the extrinsic evidence before consideration of the intrinsic evidence.” Had the district court relied exclusively on the dictionary definition or allowed it to overcome clear language in the patent itself, its methodology (although not necessarily its conclusion) would have been clearly wrong. . . . The district court, however, did not rely solely on the dictionary definition; rather, it reviewed and considered the written description and the figures of the patent. In addition, it did not allow a dictionary meaning to overcome clear language in the patent. Its opinion on claim construction, though, suggests it may have read some isolated statements in certain recent opinions too rigidly and in isolation from the entire body of our claim construction jurisprudence.

Specifically, [the] district court stated: “Even when the ordinary meaning of a term appears to be clear from the claim language, however, it is necessary to read the claim in the context of the specification to determine whether the patentee has given the phrase ‘forming folds in said . . . body’ an unaccustomed meaning.” If, which we doubt, this language indicates that the district court believed that our cases permit consulting the specification solely for the limited purpose of determining whether it contradicts the dictionary meaning of a claim term, such a view is not supported by our case law, read as a whole. “The written description must be examined in every case, because it is relevant not only to aid in the claim construction analysis, but also to determine if the presumption of ordinary and customary meaning is rebutted.” Thus use of the specification to “determine if the presumption of ordinary and customary meaning is rebutted” is no more important than examining it “to aid in the claim construction analysis. . . .”