LITIGATORS CORNER:

Claim Construction: A Question of Language, Not Law

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Claim construction has become a mess, and I think this is because, since Markman, we have approached it like lawyers, seeing it as a purely legal issue. In my opinion, this is not the correct way to look at it, since claim construction cannot be divorced from language, which means that it cannot be divorced from experience. Words are not mathematical functions. They are not even as certain as two plus two equals four. Their meanings are often very dependent on both the context in which the words are used, and the experience of the reader.

English is tricky. Some words have two meanings: a few, called "Janus words," actually have two meanings that are opposites: for instance, "cleave" and "sanction." The verb "cleave" can mean "to adhere," but it can also mean the opposite, "to separate." And "sanction" can mean "to approve" or "to disapprove." In each case, which meaning is "correct" is not the issue, since they are both correct. The issue is which meaning is appropriate, a question which can only be answered by examining the context. There are other words with two opposite meanings: for instance, "clip," which can mean "to fasten to" or "to cut off"; "overlook," which can mean "to supervise" or "to forget about"; and "quantum," which can mean both "small" and "large," as in atom and leap, respectively. See http://www.fun-with-words.com for more examples.

Sometimes even the context is not enough to figure out how a word is being used. An article I read, "To Make Yourself Januinely Clear, Write With One Face," by communications expert Mannie Sherberg, gives the example of this sentence: "Before starting the meeting, he drew the curtains." The word "drew" could mean that the curtains were either opened, or that they were closed. It isn't possible to know, without knowing more about the situation.

The editors who created the Oxford English Dictionary knew the importance of context. The OED was an ambitious undertaking because its editors decided to look for examples of usages for every listed word, and they traced each word back as far as they could, to about the year 1100 or so. They wanted to see how the word is used in combination with other words — in a sentence — to insure its meaning was understood. Read Simon Winchester's book, *The Professor and the Madman*, for the whole story. Words aren't 2 + 2. Oliver Wendell Holmes said, "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 time in which it is used." Time, circumstance, and the knowledge of the user all count.

A patent includes many words; some are routine, but many others are not in the average person's lexicon. A document like this is more like a painting or a pearl: you see more on each successive look. Context and experience are far more important in such a document, which may contain scores of specialized words, while still leaving much unsaid.

One's experience, or lack of it, is part of the context. When our son was very young, he stared at a sprinkling can for a while. He understood its function because he had seen it used in the garden, but he was too young to know what it was ordinarily called. Not having much experience (which is why some say artificial intelligence stumbles), he came up with the name "bucket hose." It was logical, but not based on experience. Another example comes from a friend's daughter. She is playing her first year of baseball. Told by her coach to "play third base," she did so, quite literally, and stood right on the base, refusing to move from it — even when a ball went by a few feet away. She was following the coach's directions quite literally.

But an experienced player — a Mike Schmidt or a Robin Ventura — knows that "playing" third isn't "standing on" third. To an experienced player, "third base" is a region, not a spot. To an inexperienced person, "third base" is just that: a spot identified by a white square. But the experienced player plays "third base" by moving around. The position an experienced player will take in the region of third base depends on the batter, the pitcher, the inning, the score, the outs, and who's on base. After thinking about all these factors, Schmidt or Ventura might be on the base, behind it, or toward second. But, an inexperienced person does not yet know what "playing third" means. Both my friend's daughter and my son used or understood words without the benefit of the context brought by experience.

So, maybe one of the reasons claim construction has become a mess is because it ignores these realities, and we lawyers pretend it is a question of law and nothing else. It really isn't a question of law. It is, instead, a question of language, which is inevitably a question of context and experience. That is why Judge Rader said in *Markman* that whether claim construction was always a question of law was not before the court in that case. A patent is like a ship at sea; the patent itself is the invention, and the knowledge that persons of skill in the art have is the surrounding and supporting ocean. A patent has to be read by one of experience in that particular field. If a judge had been a passenger on the Bounty, he certainly could have read numbers in a nautical almanac, and said them aloud. But only Captain William Bligh, one of the greatest navigators in history, knew their true significance. His experience made it possible for him to use those numbers to navigate an open boat 1,200 miles to safety. Of course, there are exceptions; and unfortunately, the laundry inventory patent in

Markman may have been one of those. (Didn't one Supreme Court decision concern itself with an invention that involved shoveling you-know-what out of a barn?)

Many patents are not like the laundry inventory patent. Our firm has a case involving a patent about how to model a semiconductor fabrication plant to make it more efficient. The patent cannot possibly include, for example, all the chemical engineering, fabrication knowledge, computer science, and computer structure that is part of the knowledge of one of skill in the art. If the patent did include every scrap of knowledge relevant to a semiconductor fabrication facility, it would be thousands, if not tens of thousands, of pages in length. Another example is the patent we litigated in a case against Intel, which involved the internal structure and operation of computer microprocessors and instruction sets.

There may be some patents that a judge can read and interpret, but there are certainly many others he cannot. I venture to say that even the canine scuba diving apparatus described in my last month's column involves a few things — knowledge gleaned both from training animals and from diving — that a judge who had never done either would not understand. Another quote from Holmes which I like is, "The life of law has not been logic: it has been experience. . . The law embodies the story of a nation's development through many centuries, and it cannot be dealt with as if it contained only the axioms and corollaries of a book of mathematics. In order to know what it is, we must know what it has been, and what it tends to become." This also tells us that specialized patent courts are a waste of time. What we need is a traditional judge: one who knows how to determine what evidence is needed and is admissible to resolve a disputed issue of fact. Claim construction is the most disputed issue there is these days in patent law.

In a recent decision, *Merck v. Teva*, Judge Rader, who made some prescient comments in *Markman*, stings the concept of claim construction as a pure question of law with his dissent. *Merck v. Teva* was an argument about the meaning of "about," and how that meaning was derived. The patent owner argued it had followed the lexicographer's rule and defined what it meant. Judge Rader said in his dissent that the case was a very close call:

> This is the classic "close case," so close in fact that ultimately two federal judges (one of whom conducted an entire bench trial on this issue) and the United States Patent and Trademark Office agreed with Merck & Co., and two federal judges agreed with Teva Pharmaceuticals. The United States District Court of Delaware tried this case from March 4 - 7, 2003, then issued a 75-page opinion analyzing the claims and arguments in consummate and accurate detail. . . .This court received the typical briefs from the parties, an appendix containing selected portions of the record, and heard a total of approximately thirty minutes of argument by the parties on the issues before this court. Despite the district court's superior tools and time to evaluate the complete record, to hear and inquire from expert and fact witnesses, to delve into countless related details, to probe the scientific and semantic context, and to entertain argument as long as necessary for clarity, this court with its reading three briefs before its half-hour hearing becomes enamored with its own analysis of a very close issue and reverses the district court.

There is no doubt that Judge Rader favored the result that was reached in the district court:

> This court often hears criticism from district court judges that its reversal rate on claim construction issues far exceeds that of other circuit courts. . . In response, nearly every judge on this court has publicly professed to accord some level of deference to district courts regardless of this court's *de novo* review of claim construction issues. See, e.g., Symposium I at 680 (a district court judge stating "I have certainly heard a number of federal circuit judges agree, that the CAFC gives some deference to a well-reasoned opinion, as a practical matter"); Symposium, The Past, Present and Future of the Federal Circuit: Judicial Constellations: Guiding Principles as Navigational Aids, 54 Case W. Res. L. Rev. 757, 761 (2004) (judge of the Federal Circuit stating: "Review is really not *de novo* after all. It is unfortunate that there is no label in between *de novo* and clear error review. Functionally, claim construction falls in this middle ground."). Either the Federal Circuit accords deference in accordance with its public protestations or it does not in accordance with its legal standard barring any deference. If the former, this court has a "truth in advertising" problem. Its actual practice clashes with its professed legal duty. If the latter, this court has a different kind of "truth in advertising" problem.
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> In this case, this court eschews all deference, a particularly striking choice in the face of a very close case and a district court whose diligent and intelligent process and resolution earned more respect than it received. I am not entirely sure which aspect of the "truth in advertising" problem this case illustrates, but it certainly makes any protestations of deference in fact sound rather hollow.

Exposure to a few briefs and an oral argument is not enough. No human sees everything in a Picasso or Rembrandt in the first leisurely look. As with Captain Bligh, being able to say the words (or find them in a dictionary) does not mean you understand them. You have to immerse yourself, as the district court did in *Merck*.

A brief review will not work. In our Intel case, here is just a piece of what the appellate court had to deal with:

> The patent is entitled "RISC Architecture Computer Configured for Emulation of the Instruction Set of a Target Computer." The acronym RISC stands for "Reduced Instruction Set Computer." The patent discloses a RISC architecture computer microprocessor that can emulate the architectural behavior of another microprocessor. The claimed RISC processor and emulation technique permit use of existing software written for a target computer, even if that computer is a Complex Instruction Set Computer or "CISC" microprocessor, while retaining the benefits inherent in RISC processors. '927 patent, col. 2, ll. 52-57.

Respectfully, folks, it can't be done in many cases without digging into facts. An oral argument and dictionaries aren't enough. Getting to the right answer requires some time, some exposure to the context of the words used, and knowing how a person of skill in the art looks at it. Claim construction is often a question of fact. You know where that leads us, don't you? IPT