

# LITIGATORS CORNER:

## The Specification Is the Claim



BY JOSEPH N. HOSTENY,  
OF NIRO, SCAVONE,  
HALLER & NIRO

*Regular IP Today columnist Joseph N. Hosteny is an intellectual property litigation attorney with the Chicago law firm of Niro, Scavone, Haller & Niro. A Registered Professional Engineer and former Assistant US Attorney, his articles have also appeared in Corporate Counsel Magazine, The Docket (American Corporate Counsel Association), American Medical News, Inventors' Digest, Litigation Magazine and Assembly Engineering Magazine. Mr. Hosteny can be reached at (312) 236-0733, or by e-mail at [jhosteny@hosteny.com](mailto:jhosteny@hosteny.com), or by visiting his web site at <http://www.hosteny.com>.*

The Federal Circuit doesn't import limitations from the specification of a patent into its claims. See *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*). But who believes that? And what are the consequences when our appellate court doesn't follow its own decisions? After all, it was two judges of that court who, in their dissent, described the Federal Circuit as a "black hole" and as engaging in "interpretive necromancy." *Phillips*, 415 F.3d at 1330 (JJ. Mayer and Newman, dissenting). In his 2001 article, "When a Patent Claim is Broader Than the Disclosure: The Federal Circuit's Game Has No Rules," published in the *John Marshall Review of Intellectual Property Law*, Robert Harmon wrote:

Traditionally, patent law provided that patent claims could be broader than just what the patent's specification contained. . . . The Federal Circuit has started to do something that it has said, time after time, is totally improper. It has begun reading limitations from the specification into the claims during the claim construction process. The court is not doing so to save the validity of claims. Instead, it is doing so to avoid infringement.

The Federal Circuit is pursuing results, not rules. The court continues to use the specification to add limitations that appear nowhere in the claims.

In *Medtronic Navigation, Inc. v. Brainlab Medizinische Computersysteme GmbH*, 222 F.Appx. 952, Slip Op. 06-1289 (Fed. Cir. February 5, 2007), the court claimed it was following *Phillips*, when it affirmed a judgment of non-infringement of a patent claiming an invention for guiding surgical instruments. The district court set aside the jury's verdict of infringement. (By the way, one of the plaintiffs was the trustees of Dartmouth College. The last I knew, Dartmouth was an educational institution, not a factory. Doesn't that make it a troll?) Even though the over-arching question was the grant of a motion for judgment as a matter of law, the Federal Circuit first addressed claim construction. It said that an optical reference system could not be covered by a claim limitation, "establishing a spatial relationship." The specification only described an acoustic tracking system. An optical system was only mentioned in passing. The Federal Circuit said, "There is no enabling description of how to make and use an optical tracking system, and claims are best construed to preserve their validity." It also remarked, "Such a minimal dropping of an unenabled reference to an undeveloped system does not support a claim to it."

So the Federal Circuit made itself a person of ordinary skill in the art of this patent—engineers skilled in acoustics and optics—and decided infringement under the guise of preserving validity.

Another U.S. Patent, No. 821,393, "Flying-Machine," shows only one embodiment. It describes and depicts only a machine with "two parallel superposed aeroplanes." It refers to, but does not describe, a "single aeroplane." Nor does it refer to an engine or a propeller. It refers to gliding, and adds that "power applied to the machine to propel it positively forward will cause the air to support the machine in a similar manner." The inventors also commented, "Contrary to the usual custom, we place the horizontal rudder in front of the

aeroplanes at a negative angle and employ no horizontal tail at all."

If the claims of this famous patent were being construed according to today's standards, the patent would be worthless, because only biplane gliders would infringe it. The absence of a description of a single-aeroplane embodiment would limit the claims (such as claim 1 or 3) that refer to an "aeroplane" to biplanes. The absence of any description of a propeller or motor would be used to limit all of the claims to gliders. The remark about a rudder would place any infringer with a rear rudder outside the scope of any claim. The Federal Circuit would again make itself a person of ordinary skill, and rule that monoplanes were not described, only mentioned. It would hold that powered machines were only mentioned, not enabled. The Federal Circuit would be attributing to itself much or most of the knowledge of the two most famous inventors in the history of the United States. That is what it does every time it construes a claim as a question of law and says what a person of ordinary skill would know or do. The idea that claim construction can never involve fact questions is bankrupt; it was so from the start, when the court made a decision in *Markman* that leapt far beyond its laundry-tag facts.

In *Ormco Corp. v. Align Technology, Inc.*, \_\_\_ F.3d \_\_\_, Slip Op. 2006-1240 (Fed. Cir. August 24, 2007), the district court said it wasn't "interpreting specific language of the claims to favor one side or the other." (J. O'Malley, dissenting). The Federal Circuit charged ahead with claim construction, despite its own prior admonitions about accepting appeals involving claim construction—don't they all?—without a record including the district court's views on the proper construction of the claims. See the stinging dissent by District Judge Kathleen O'Malley.

The patents in this case involved computer-aided design of orthodontic appliances. The district court disposed of all four patents by holding that they were limited to processes where the final positions of teeth were automatically determined. The appellate court again went first to claim construction, and cited *Phillips*. But, even though *Phillips* started with the claim, the court in *Ormco* started with the specifications, not the claim language. It said the specifications, not the claims, distinguished the invention from the prior art.

But the patent statutes say that this is the role of claims, not the role of the specification. 35 U.S.C. §112, second paragraph. The appellate court also said that the common specifications' references to automated design, and the absence of references to manual adjustment, meant that "the invention is in the automatic determination of tooth position." None of the claims recited automatic control. Thus, in claims which admittedly did not recite automated tooth finish positioning, the court held that that was all they meant, "because that was all the specification describes . . . ."

The dissent by Judge O'Malley was thoughtful. It pointed to claims in one of the patents that recited an "operator," and dependent claims that referred to substantially automatic operation. It criticized the majority's failure to abide by the Federal Circuit's prior decisions.

In another recent decision, *Data Encryption Corp. v. Microsoft Corp.*, \_\_\_ F.3d \_\_\_, Slip Op. 2006-1603 (Fed. Cir. September 6, 2007), the court said that data had to be decrypted when being moved from kernel memory to user memory. At least here the claim limitation that was being further limited—I should say "interpreted"—was mentioned: a system interface routine for transmitting a predetermined block of data between the two memories "through said encryption routine." According to the claim, the encryption routine both encrypted and decrypted data. The specification said that "all data subject to encryption . . . is maintained in an encrypted state in the buffer pool." Based on that single statement, the Federal Circuit held that the inventor had disavowed any system that maintained data in an unencrypted state in the pool. It reached this conclusion even though it agreed that the claim in question said nothing about how data was "maintained." Its justification was that the claim must require that encrypted data be decrypted upon transfer from one area of memory to another area of memory, because transfer was via the encryption routine. This second conclusion, however, depends entirely upon the first—that is, that the specification disavowed any storage of unencrypted data in the first memory. Thus, the Federal Circuit concluded from the use of the word "all" that there was no infringement. There was no discussion of reaching this conclusion in the interests of preserving the validity of the claims.

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The Federal Circuit's statements that it is not importing limitations, but only interpreting the claims in light of the specification, cannot be reconciled with its decisions. In fact, the court is repeatedly using the specification of patents to tell us what the "metes and bounds" of the invention are. We have "rules" that no one can follow. The Federal Circuit is not able to follow its own rules, as Judge O'Malley wrote in her dissent.

Once again, the specification is the claim. In 1880, in United States Patent No. 223,898, "Electric Lamp," Thomas Edison said:

I claim as my invention:

1. An electric lamp for giving light by incandescence, consisting of a filament of carbon of high resistance, made as described, and secured to metallic wires, as set forth.

For the same concept, in a lesser-known patent, see 1868 U.S. Patent No. 81,437, "Improved Burial Case," which claims "The application of the tube C and ladder H to a burial-case or coffin for the purposes described and as set forth."

The Federal Circuit has returned to the past, and some decisions appear as though the second paragraph of §112 had never been enacted. Once again, as in the days of Thomas Edison, it is saying that the specification is the claim. The Federal Circuit is putting itself in the role of the person of ordinary skill in the art in many of its decisions. Perhaps it believes that it must remedy the mistakes made by Patent Office examiners when they fail to do a good job of examination. Perhaps the court is responding to some of the rather ignorant public commentary (for example, by Intel), that patents are too broad. Whatever the reason, that approach does more harm than good to the body of patent law. What would promote progress is a Patent Office that had the money to do its job, and which was then held to its mandate. The results-oriented approach of the Federal Circuit has given us a process with an extraordinary reversal rate, a process that takes longer and is a lot more expensive than a coin toss. One of my friends once joked about a certain athlete: "He's small, but he's slow." One might say about our current process much the same: It's expensive, but it's slow and inaccurate. 