Federal Circuit Clarifies the Methodology for Performing Claim Construction

Phillips v. AWH Corp.
Federal Circuit (*en banc*) (July 12, 2005)

In a much anticipated *en banc* decision, the Court of Appeals for the Federal Circuit has clarified the procedure for performing claim construction. On July 12, 2005, the *en banc* Court held that claim terms must be given the meaning they would have to one of ordinary skill in the art after reading the entire patent. The Court rejected the methodology set forth in several of its prior decisions that relied heavily on broad dictionary definitions. The Court explained that such an approach would "improperly restrict the role of the specification in claim construction." Although the Court stated that all sources of evidence showing a claim term's ordinary meaning should be considered, including the claims, specification, prosecution history, and extrinsic evidence, the Court concluded that the specification is the "single best guide" to claim construction. The Court also reaffirmed the doctrine of claim differentiation, noting that an additional limitation in a dependent claim gives rise to a "presumption" that that limitation is not present in the independent claim.

Only time will tell whether the Court's *Phillips* decision will improve the consistency in claim constructions. However, the Federal Circuit's renewed reliance on the specification as the primary source of guidance in performing claim construction may generally result in narrower constructions than pre-*Phillips*. Patentees can, of course, avoid any uncertainty by defining important terms in the specification and by carefully drafting the specification to avoid any unintended implied definitions that might restrict the scope of the claims. Given the Court's renewed reliance on the doctrine of claim differentiation, it is also important to claim non-essential limitations in dependent claims in order to highlight the breadth of the independent claims. As always, patentees would be well-served to keep continuations alive.