IV. CLAIM CONSTRUCTION IN THE WAKE OF PHILLIPS

A. The Pre-Phillips Landscape: Vitronics/Texas Digital Split

Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576 (Fed. Cir. 1996)

According to the Vitronics decision, in interpreting an asserted claim in a patent infringement action, a trial court should look first to the intrinsic evidence of record such as the patent itself, including the claims, the specification and, if in evidence, the prosecution history. According to Vitronics, such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language. An analysis of intrinsic evidence will usually resolve any ambiguity in a disputed claim term. In such circumstances, the Vitronics panel noted that it is improper to rely on extrinsic evidence.

Texas Digital Sys. v. Telegenix, Inc., 308 F.3d 1193 (Fed. Cir. 2002)

The Texas Digital decision states that, when a patent is granted, prosecution is concluded, the intrinsic record is fixed, and the public is placed on notice of its allowed claims. According to Texas Digital, dictionaries, encyclopedias, and treatises, publicly available at the time the patent is issued, are objective resources that serve as reliable sources of information on the established meanings that would have been attributed to the terms of the claims by those of skill in the art. Such references are unbiased reflections of common understanding not influenced by expert testimony or events subsequent to the fixing of the intrinsic record by the grant of the patent, not colored by the motives of the parties, and not inspired by litigation. Indeed, Texas Digital noted that these materials may be the most meaningful sources of information to aid judges in better understanding both the technology and the terminology used by those skilled in the art to describe the technology.

B. The Phillips *En Banc* Decision

Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005)

PHILLIPS ON THE PRIMACY OF THE SPECIFICATION IN CLAIM CONSTRUCTION:

'The best source for understanding a technical term is the specification from which it arose, informed, as needed, by the prosecution history."

Patent claims are part of a fully integrated written instrument, consisting principally of a specification that concludes with the claims. For that reason, claims must be read in view of the specification, of which they are a part. The specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.

The descriptive part of the patent specification aids in ascertaining the scope and meaning of the claims inasmuch as the words of the claims must be based on the description. The specification is, thus, the primary basis for construing the claims. The best source for understanding a

technical term is the specification from which it arose, informed, as needed, by the prosecution history.

PHILLIPS ON CLAIM DIFFERENTIATION:

In construing a patent, other claims of the patent in question, both asserted and unasserted, can be valuable sources of enlightenment as to the meaning of a claim term. Because claim terms are normally used consistently throughout the patent, the usage of a term in one claim can often illuminate the meaning of the same term in other claims.

Differences among claims can be a useful guide in understanding the meaning of particular claim terms. For example, the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim.

PHILLIPS ON IMPORTING CLAIM LIMITATIONS FROM THE SPECIFICATION:

The line between construing terms and importing limitations can be discerned with reasonable certainty and predictability if the court's focus remains on understanding how a person of ordinary skill in the art would understand the claim terms. For instance, although the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments. In particular, we have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment.

PHILLIPS ON EXTRINSIC EVIDENCE:

Different dictionaries may contain somewhat different sets of definitions for the same words. A patent claim should not rise or fall based upon the preferences of a particular dictionary editor, or the court's independent decision, uninformed by the specification, to rely on one dictionary rather than another.

Extrinsic evidence in the form of expert testimony can be useful to a court interpreting patent claims for a variety of purposes, such as to provide background on the technology at issue, to explain how an invention works, to ensure that the court's understanding of the technical aspects of the patent is consistent with that of a person of skill in the art, or to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field.

Extrinsic evidence by definition is not part of the patent and does not have the specification's virtue of being created at the time of patent prosecution for the purpose of explaining the patent's scope and meaning.

C. Claim Construction Post-Phillips

1. BROAD CLAIM CONSTRUCTION

Fiber Optic Designs, Inc. v. Seasonal Specialties, LLC, 172 Fed. Appx. 995 (Fed. Cir. 2006)

The patent related to a type of holiday light strings. Fiber Optic Designs sought a preliminary injunction against Seasonal's ongoing sales of its light strings. After concluding that Seasonal Specialties had raised a "substantial question" by suggesting that the specification limited the scope of the patent to light strings without current-limiting circuitry, the district court denied plaintiffs' motion for a preliminary injunction.

The Federal Circuit reviewed the decision to deny or grant a preliminary injunction for an abuse of discretion, but underlying legal issues, such as claim construction, received no deference. The panel found that, on its face, the asserted claim did not include any language excluding current-limiting circuitry. Citing Phillips, the panel noted that, regardless of the broad claim language, the descriptions in the specification can limit the apparent breadth of a claim in two instances: (1) where the specification reveals a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess; and (2) where the specification reveals an intentional disclaimer, or disavowal, of claim scope by the inventor. However, the panel concluded that this case did not feature either reason to read a limitation from the specification into the claims. Therefore, the panel found that the standard rule that a claim construction should decline to incorporate additional limitations from the specification governed. The principle of claim differentiation also came into play. Here, a dependent claim's scope clearly excluded current-limiting circuitry. The Court noted this distinction as significant and observed that claim differentiation works best when dependent claims show a distinction over related independent claims. The court vacated the district court's denial of plaintiffs' motion for preliminary injunction and remanded for further proceedings.

Kapusta v. Gale Corp., 155 Fed. Appx. 518 (Fed. Cir. 2005)

Kapusta appealed from the decision of the U.S. District Court for the Eastern District of California granting summary judgment of noninfringement of a patent in favor of Gale, the alleged infringer. The invention related to a continuity testing instrument for coaxial cables that provided a signal to indicate the malfunction of any installed coaxial cable component of a television network. Kapusta asserted on appeal that the district court erred in construing the claim term "hand-grip size case" to require the limitations that the case be "no smaller than the width of an adult palm, so that it can be grasped firmly in one's hand, no smaller than 1 inch in width, and of a rectangular shape."

The Federal Circuit panel agreed with the patent owner that the district court erred in its claim construction by including extraneous limitations. The panel noted that the trial court should have given the term "hand-grip size case" its ordinary and customary meaning, which was a case of a size that can be gripped in a normal hand. The panel saw no reason to depart from that ordinary and customary meaning or to add dimensions to

the term as there was no support for the district court's limitations in the intrinsic record. Citing Phillips, the Court noted that, while a specification should be used to interpret the meaning of a claim, it should not be used to import unnecessary limitations into the claims and re-emphasized that claims must not necessarily be restricted to those embodiments disclosed in the specification, even if a patent describes only a single embodiment. Accordingly, the Court vacated the district court's finding of noninfringement of the patent to the extent that it was based on an erroneous claim construction of the term "hand-grip size case" and remanded for the district court to re-determine whether the alleged infringer's products met the limitation as the court construed it.

Free Motion Fitness, Inc. v. Cybex Int'l, 423 F.3d 1343 (Fed. Cir. 2005)

Free Motion sued Cybex and Nautilus for infringement of its patents relating to pulley-based exercise machine. After construing the claims, the district court granted summary judgment of noninfringement to the defendants and also found that an amendment made to the claims during prosecution estopped Free Motion from asserting equivalence.

On appeal, Free Motion contended that the district court misconstrued the claim terms, "first pivot point," "adjacent," and "a cable," and relied upon such erroneous constructions in finding noninfringement. In particular, the panel found that the term "first pivot point" did not denote spatial location but merely associated the point with the first pivot arm, and the term "adjacent" meant not distant, regardless of whether another object was between the pivot points and the resistance assembly. Further, the Court found that use of the word "a" in relation to "cable" indicated one or more cables, and the claim was thus not limited to a single cable. In view of the changes in claim construction, a redetermination of infringement was required, and the appellate court further noted that prosecution history estoppel did not preclude infringement merely because the sellers' machines included additional features which were expressly disclaimed by the holder. The order granting summary judgment of noninfringement was vacated, and the case was remanded for a determination of infringement under the correct claim construction.

Amgen Inc. v. Hoechst Marion Roussel, Inc., 457 F.3d 1293, 1303 (Fed. Cir. 2006)

In a split decision based exclusively on the intrinsic evidence, the U.S. Court of Appeals for the Federal Circuit held, *inter alia*, that the claim term “therapeutically effective amount” in one patent did not limit the claim to products effective in curing disease and remanded to determine whether a prior art reference anticipated the claim.

On appeal, the panel majority considered intrinsic evidence only and relied almost exclusively on the patent specification, which indicates that the claimed invention is used in “therapy” to produce “any or all” of the following “effects”: stimulation of reticulocyte response, development of ferrokinetic effects, erythrocyte mass changes, stimulation of hemoglobin and increasing hematocrit levels. Based on this language, the panel majority concluded that increasing hematocrit is only one of the biological effects produced by the claimed invention and agreed with HMR/TKT that the district court misinterpreted this

passage when it read it as limiting the claimed invention to products with "any or all" of the first four listed effects ascribed in vivo to EPO and also an increase in hematocrit. Concluding that the claim term "therapeutically effective amount" did not limit the claim to products effective in curing disease, the Court remanded the case to determine whether a prior art reference anticipated the claim.

Varco, L.P. v. Pason Systems USA Corp., Case No. 05-1136 (Fed. Cir. Feb. 1, 2006)

The U.S. Court of Appeals for the Federal Circuit reversed and remanded an order denying a preliminary injunction because the district court's unduly restrictive claim interpretation led directly to the denial of the preliminary injunction. The patent at issue was directed to the system and method for automatically regulating the release of a drill string on a drilling rig in response to a combination of four parameters. The claim construction dispute focused on a "selecting" step and a "relaying" step. The district court interpreted "selecting" to require "manual operation of valve selectors and manual calibration of regulators" and interpreted "relaying" to mean "transmitting a signal by means of pneumatically operated valves." In arriving at these constructions, the district court relied heavily on the specification and prosecution history. Varco appealed and argued the district court improperly narrowed the claims by importing limitations from the specification.

The Federal Circuit agreed and held the district court impermissibly imported limitations into the claims resulting in an unduly narrow claim construction. The Court explained that claim terms are generally given their ordinary and customary meaning, and the inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation. Focusing on the claim language, the Court found the "selecting" step was not limited to manual operations. On the contrary, other claims expressly stated that selection was performed automatically, and the specification and prosecution history clearly indicated that manual operations related to calibration prior to automatic selection. As to the "relaying" step, the Court found that although the preferred embodiment used pneumatic valves operating as relays, it would be improper to use the preferred embodiment to limit the claim as nothing in the claim itself required the use of pneumatically operated valves to perform the "relaying" step.

2. NARROW CLAIM CONSTRUCTION

Old Town Canoe Co. v. Confluence Holdings Corp., 448 F.3d 1309 (Fed. Cir. 2006)

Old Town Canoe sued Confluence Holdings for infringing its patent directed a method of making plastic laminate canoe hulls. The patent claimed a method of making multilayered plastic hulls by rotation of heated molds, and Old Town Canoe asserted that the limitation of opening the mold assembly only after coalescence was completed provided for coalescence when a layer was formed. Confluence argued that the patent was invalid for obviousness, lack of enablement, and failure to disclose best mode, and that the patent was unenforceable for inequitable conduct.

Citing Phillips, the Federal Circuit commenced its analysis noting that there is no magic formula or catechism for conducting claim construction and a court is not barred from considering any particular sources or required to analyze sources in any specific sequence, as long as those sources are not used to contradict claim meaning that is unambiguous in light of the intrinsic evidence. The panel, again relying on Phillips, emphasized that the sequence of steps used by the judge in consulting various sources is not important; what matters is for the court to attach the appropriate weight to be assigned to those sources in light of the statutes and policies that inform patent law. In construing the claim terms in this case, the district court began its analysis by referring to dictionary definitions presented by the parties. The Federal Circuit found that the district court's reference to the dictionary was not an improper attempt to find meaning in the abstract divorced from the context of the intrinsic record but properly was a starting point in its analysis, which was centered around the intrinsic record consistent with Phillips. Here, the claim did not state explicitly whether the completion of coalescence means that the plastic particulate must reach its optimum state, but the specification described coalescence as being complete when it reaches an optimal state as opposed to when the process is brought to a halt. Finally, the panel noted that the prosecution history supported the conclusion that completion of coalescence means progress of coalescence to the optimum state as opposed to being brought to a halt at an arbitrary point by operator intervention. Based on this discussion of the written description and prosecution history, the panel concluded that the district court's constructions of "coalescence" and "complete" are correct and no basis exists to conclude that one of ordinary skill would have understood completion of coalescence to mean anything other than reaching an optimum stage. See Phillips, 415 F.3d at 1316 ("The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction.").

Ocean Innovations, Inc. v. Archer, 145 Fed. Appx. 366 (Fed. Cir. 2005)

Ocean Innovations, Inc. and Jet Dock Systems, Inc. (collectively "Jet Dock") sued Rick Archer and Zeppelin Marine, Inc. ("Zeppelin") for infringement of Jet Dock's patent for a floating drive-on dry dock assembly which allowed personal watercraft to be stored or

boarded out of water. The district court granted summary judgment of infringement in favor of Jet Dock. After conducting a bench trial on the issue of damages, the court awarded Jet Dock a reasonable royalty and permanently enjoined Zeppelin from infringing the asserted claims. Zeppelin appealed, arguing that the district court erred when it granted summary judgment of infringement.

On appeal, Zeppelin challenged the district court's construction of the term "flexible joints between the units." The court construed the term to mean "a point or position in the interval or position separating the floatation units of the dock, which point or position is capable of bending or flexing." Zeppelin argued that the district court erred in its construction because the term "joint" in the claims must refer to a tangible object, not merely a "conceptual" "point." According to Zeppelin, a "point" cannot be characterized as "capable of bending or flexing." Zeppelin proposed that the term "flexible joints between the units" should be construed to mean "a configuration or component connecting the flotation units of the dock, which configuration or component is capable of bending or flexing." Rejecting, Zeppelin's construction, the Federal Circuit first held that the flexibility referenced in the patent did not require that the material forming the joints be flexible, but that the joints permit the units to flex relative to each other, and thus there was no requirements that the joint be a tangible object.

Zeppelin also challenged the district court's construction of the term "floatation units." The district court construed the term to mean "an individual structural constituent of a whole which is buoyed on water" and also determined that the "floatation units" must be "airtight" but not necessarily "hollow." Zeppelin argues that the claimed "floatation units" must be hollow as well as airtight. Jet Dock agreed that the claimed "floatation units" are properly construed to be "airtight," but argued that construing the claims as requiring the units to also be "hollow" imports a limitation into the claims. Citing Phillips, the Federal Circuit noted that the general description of the patent, the patent summary, and references to prior art all indicated floatation units that were hollow, and one skilled in the art would understand the units to be hollow as well as airtight. In Phillips the Court had pointed out that the line between construing terms and importing limitations can be discerned with reasonable certainty and predictability if the court's focus remains on understanding how a person of ordinary skill in the art would understand the claim terms."

Nystrom v. Trex Co., 424 F.3d 1136 (Fed. Cir. 2005)

Nystrom appealed an order of the United States District Court for the Eastern District of Virginia, which granted summary judgment of non-infringement of claims 1-15 and 18-20 of the patent at issue, and of invalidity of claims 18-20. The patent was directed to construction material for use in flooring surfaces: specifically, boards for use in constructing an exterior floor, such as a deck. The invention described and claimed in the patent was an exterior wood flooring board shaped to shed water from its upper surface while at the same time providing a surface on which it is comfortable to walk and stand. The district court construed the word “board” in independent claim 1 to mean a “piece of elongated construction material made from wood cut from a log.” The district court held

that Nystrom had limited the scope of the claim term "board" by statements in the written description that a board is cut or obtained from a log and statements made by Nystrom during prosecution in arguing against an obviousness rejection.

On appeal, Nystrom argued that "board" in claim 1 is not limited to conventional wood boards that are cut from a log and that the claim language "board" does not contain a description of the material from which the board is composed and that the claim should not be so limited. Nystrom argued it was error for the district court to rely on statements in the specification to limit the claim because those statements do not represent a clear disavowal of claim scope. Moreover, Nystrom asserted that there was no such a clear and unambiguous disclaimer as to justify limiting the claim term. TREX responded that the ordinary meaning of "board" is a piece of sawn lumber. Because the specification only disclosed a board as made of wood and cut from a log, TREX contended that the claim term "board" must be limited to wood boards cut from a log. TREX further argued that Nystrom disclaimed non-wood boards by the statements he made during prosecution in overcoming an obviousness rejection.

The Federal Circuit held that the district court properly construed the word "board" to mean a piece of elongated construction material made from wood cut from a log and also properly construed the term "manufactured to have" to be a manufacturing process utilizing woodworking techniques. However, the panel found that the term "convex top surface" was the ordinary and customary meaning of an upper surface that curved or bulged outward, as the exterior of a sphere. Accordingly, the district court erred in determining invalidity based on evidence improperly derived from a patent drawing.

Network Commerce, Inc. v. Microsoft Corp., 422 F.3d 1353 (Fed. Cir. 2005)

The United States District Court for the Western District of Washington had granted Microsoft's motion for summary judgment of non-infringement. Network Commerce appealed. The patent claimed a method and system for purchasing electronic information over a computer network. The accused products were Microsoft's media player (used to obtain and play digital audio and video content files) and metafiles (data files containing information the media player used to obtain and play digital audio and video content files). The trial court found no literal infringement and no infringement under the doctrine of equivalents as neither product was a download component, since on their own the media files could not control the download of information, nor request electronic content from a source computer; and there was no showing that the media player was downloaded onto a client computer in response to a request for electronic content, or that once installed it made a request on its own for that content.

The Federal Circuit affirmed. The panel agreed with the district court's construction of "download components." Citing Phillips, the panel noted that, in general "the specification necessarily informs the proper construction of the claims" and it is "appropriate for a court . . . to rely heavily on the written description for guidance as to the meaning of claims." Here, the panel found that the specification did not use the term

"download component," presumably because this claim terminology was added during prosecution after the specification had been prepared. However, the Court pointed out that the specification did describe a "download file" and concluded, based on function and description of the "download file" that this item corresponds most closely to the download component of the claims. The specification explained that the download file resides in the computer of an online merchant or is accessible to that computer. When the merchant receives an online request for electronic content, the online merchant "downloads and installs the download file" on the customer's computer. The specification disclosed that this file, when downloaded into the customer's computer, "extracts from the download file the executable boot program and component list." Noting that here was no evidence that Windows Media Player was downloaded in response to a request for electronic content, much less evidence that Windows Media Player and metafiles were downloaded together in the required combination, the Federal Circuit affirmed the district court's finding of non-infringement.

AquaTex Indus. v. Techniche Solutions, 419 F.3d 1374 (Fed. Cir. 2005)

Aquatex filed a contributory infringement action under 35 U.S.C.S. § 271(c) against Technine Solutions, alleging that the competitor's evaporative cooling garment and products infringed the patentee's patent either literally or under the doctrine of equivalents. The United States District Court for the Middle District of Tennessee granted summary judgment of noninfringement in favor of Technine Solutions. Both parties marketed multi-layered, liquid-retaining composite material for evaporative cooling garments, and the Aquatex's patent claimed a method of cooling a person through evaporation by providing a multi-layered, liquid-retaining composite material comprising a fiberfill batting.

The primary issue on appeal was whether "fiberfill batting material" should be construed to encompass only synthetic fibers as the district court had held. Citing Phillips, the Federal Circuit commenced its analysis with the observation that "[w]here, as here, the disputed claim term is technical or a term of art, "the best source for understanding [it] is the specification from which it arose, informed, as needed, by the prosecution history." Applying this principle, the Federal Circuit held that the trial court properly found that the accused product did not literally infringe two claims in the Aquatex's patent because the combined teachings within the specification of the patent, the patents incorporated by reference, and the consistent interpretations in the industry publications would lead one skilled in the art to conclude that commercial "fiberfill batting material" was made of synthetic or polyester fibers. The panel affirmed the trial court's holding that there was no literal infringement, but it reversed the holding on the separate ground that the patentee was barred from asserting infringement under the doctrine of equivalents. The case was remanded with directions for the trial court to consider whether or not each limitation of the claims in dispute, or its equivalent, was present in the accused competitor products.

Honeywell Int'l, Inc. v. ITT Indus., 452 F.3d 1312 (Fed. Cir. 2006)

Finding that a district court properly limited the claim scope to the patentee's preferred embodiment because the specification repeatedly referred to this embodiment as "the invention," the U.S. Court of Appeals for the Federal Circuit affirmed the grant of summary judgment of non-infringement. The patent at issue disclosed a fuel filter that was specially made for use in motor vehicles having electronic fuel injection (EFI) systems. The district court construed the claim limitation "fuel system component" as referring to a fuel filter and determined that the accused products did not meet that limitation.

On appeal, the patentee argued that the district court erred by limiting the fuel injection system component to a fuel filter because, in doing so, it imported a limitation from the specification into the claims and thereby improperly limited the scope of the claims to the specification's preferred embodiment. However, the Federal Circuit agreed with the district court that the plain language of the specification clearly limited the claim to a fuel filter. As a result, the accused products, which did not filter fuel, were not equivalent devices. As a separate basis for non-infringement, the court modified the district court's construction of the claim limitation "electrically conductive fibers," finding that the use of carbon fibers was disavowed from the scope of the patent. Because the accused products used carbon fibers, they did not meet that limitation either. The court affirmed the summary judgment of non-infringement.

Inpro II Licensing, S.A.R.L. v. T-Mobile USA, Inc., 450 F.3d 1350 (Fed. Cir. 2006)

Inpro accused RIM of infringing its patent for a credit-card-sized personal digital assistant that communicates with a host computer. Inpro appealed the district court's interpretation of three claim terms, including the term "host interface." The district court had interpreted "host interface" as "a direct parallel bus interface." Inpro conceded that if the district court's interpretation of "host interface" was correct, infringement would not lie. Plaintiff patent holder sued defendant telecommunications company, alleging infringement of its patent directed to novel personal digital assistant modules. The United States District Court for the District of Delaware granted defendant judgment of noninfringement. The parties appealed, challenging, *inter alia*, the construction of the term "host interface."

The U.S. Court of Appeals for the Federal Circuit rejected a claim construction that was arguably correct on a term-by-term basis, but failed "to implement the invention described in the specification." Inpro argued that under the doctrine of claim differentiation, the limitations of "host interface" in some unasserted claims demonstrate that the broader asserted claims are not limited to a "direct parallel bus interface" but include any interface (serial or parallel, direct or indirect) for communicating with the host. Rejecting application of the doctrine of claim differentiation, the Court stated that describing claims in different words "does not invariably change the scope of the claim." Citing Phillips, the Court recognized the boundaries of patented inventions are contained

in the claims but construed in light of the specification, prior art and prosecution history. Turning to the patent, the Court found that Inpro had referred to communication with the host by serial connection as "a big drawback" and "very troublesome" while it referred to communication with the host by "direct parallel bus interface" as a "very important feature" of the invention. The Court also found that the prosecution history of related applications supported the view that "host interface" requires "a direct parallel bus interface."

On Demand Mach. Corp. v. Ingram Indus., 442 F.3d 1331 (Fed. Cir. 2006)

On Demand Machine Corporation (ODMC) owns the Ross patent, for a "System and Method of Manufacturing a Single Book Copy," which envisions that a consumer will browse an electronic database that includes promotional material regarding various books, select a book for purchase and then have one copy of the book printed and bound for him or her, preferably at the same site.

One of the defendants, Lightning Source, Inc. is a book-printing company with a factory in Tennessee. Ingram Industries, is the corporate parent of Lightning Source. Lightning Source prints and sells books as ordered by publishers, wholesalers and retailers such as defendant Amazon.com. Purchasers may order books from Lightning Source through its website, identifying the book by its title and author or International Standard Book Number (ISBN). Lightning Source usually prints books in batches, often as large as several hundred books, but may also print single copies if ordered.

In a decision reached before the Federal Circuit's Phillips case, the district court arrived at a claim construction influenced heavily by "plain meaning" and dictionary definitions. For example, it held that the "sales" information to be included in the accused computer system could be something as basic as "data stored in a computer which is involved in the promoting and selling of a book" and that the term was not limited to promotional information, but included any sort of descriptive information, such as price.

The Federal Circuit held that this, and other terms, had been construed in such a way as to make the scope of the patent considerably broader than the invention described in the specification. In so doing, it warned, "[c]are must be taken lest word-by-word definition, removed from the context of the invention, leads to an overall result that departs significantly from the patented invention."

Curtiss-Wright Flow Control Corp. v. Velan, Inc., 438 F.3d 1374 (Fed. Cir. 2006)

Vacating a preliminary injunction granted by the district court, the U.S. Court of Appeals for the Federal Circuit held that the district court's claim construction was improper because it used the claim differentiation to expand the claim scope beyond that supported by the specification. In construing Curtiss-Wright's claim for a de-header valve, the district court broadly defined the term "adjustable" to mean the valve can be adjusted in a manner that is "not limited by any time, place, manner, or means of adjustment." The district court arrived at this construction by first applying the ordinary meaning of the term "adjustable" and then determining a narrower construction of the term would be

inconsistent with other claims in the same patent that provide for adjustment of the device while in operation.

The Federal Circuit cited the Phillips for the general rule that the specification (rather than a dictionary) is the single best guide to the meaning of a claim term. The Court then noted the specification of Curtiss-Wright's patent stressed the importance of one aspect—that the device be adjustable while in use—as opposed to the prior art in which the adjustment is made when the device is not in use. The Court further noted the district court's construction encompassed embodiments in which the adjustment was made when the device was not in use, and such embodiments were not supported by the specification.

The Court determined the district court misapplied the presumption of claim differentiation to impermissibly broaden the meaning of the term "adjustable" beyond that supported by the specification. In this regard, the Court noted that claim differentiation is a presumption, but it is not a rigid rule. First, the Court recognized it is possible for different claims using different language to have the same scope. Second, the Court admonished that claim differentiation cannot contradict the correct meaning of the claim as defined by the "overall context of this invention and this field of art as described in the specification." Accordingly, the Court held the district court's error in claim construction and resulting grant of the preliminary injunction was an abuse of discretion.