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## Avoiding Infringement of United States Patents Through Foreign Acts

*By Paul B. Milcetic and Joseph Milowic III*

Now more than ever, businesses should be aware that foreign activities may result in infringement of a United States patent, and should avoid those activities. Recent case law, especially at the district court level, increasingly calls into question the traditional axiom that the scope of United States patents is territorially limited to the United States.

According to some courts, for example, a business may subject itself to infringement liability by extending an offer from the United States to sell products abroad. It may also be subject to liability for acts committed in a foreign country that induce another to infringe in the United States. As another example, it may be subject to infringement liability for exporting a single "component" of a patented invention, even if the patented invention is assembled wholly abroad.

In view of these decisions, and until the trend toward extra-

territorial application of United States patent law is clarified, businesses should not assume that foreign activity cannot infringe a United States patent.

### I. The Trend Toward Extra-Territorial Application of the Patent Act

Recent court opinions increasingly call into question the notion that the scope of a United States patent is territorially limited to the United States. The laws governing infringement of United States patents have conventionally

**"[B]usinesses should not assume that foreign activity cannot infringe a United States patent."**

been understood to proscribe domestic activity only. As the Supreme Court explained in 1915, “[t]he right conferred by a patent under our law is confined to the United States and its Territories ...and infringement of this right cannot be predicated of acts wholly done in a foreign country.”<sup>1</sup>

When Congress later passed the 1952 Patent Act, the plain language of the act, and subsequent amendments, defined patent infringement as a strictly domestic activity.<sup>2</sup> To this day, the Patent Act limits liability for direct patent infringement only to those who make, use, sell or offer to sell a patented invention “*within the United States*,” or import a patented invention “*into the United States*.”<sup>3</sup>

In 1984, Congress amended the Patent Act to add new categories of infringement to close loopholes that had allowed businesses to avoid infringement by moving manufacturing operations

**“[S]ome courts... interpret the Patent Act as an overt prohibition of certain foreign activities.”**

overseas. The 1984 Amendments prohibited circumvention of the patent laws by domestic actors who exported “components” of a patented invention while intending that these “components” will be assembled abroad in an infringing manner.<sup>4</sup> The 1984 Amendments

did not expressly prohibit foreign activity that would infringe a United States patent.

Since then however, the increasingly global nature of business transactions has induced some courts to interpret the Patent Act as an overt prohibition on certain foreign activities. These decisions, and some of their implications, are discussed below.

## II. Foreign Activities to Avoid

### A. Do Not Make an Offer to Sell a Patented Invention Abroad

At least one district court has held that a company can infringe a United States patent by offering, in the United States, to sell a patented invention in a foreign country. In *Wesley Jessen Corp. v. Bausch & Lomb, Inc.*,<sup>5</sup> the District Court for the District of Delaware held that Bausch & Lomb could infringe a United States patent by offering to sell, in the United States, Bausch & Lomb’s contact lenses to a customer in Ireland. The dispute in the *Wesley* case arose after Wesley Jessen had already obtained a judgment of infringement against Bausch & Lomb, and an injunction prohibiting Bausch & Lomb from “offering for sale” in “the United States contact lens materials.”<sup>6</sup> Wesley Jessen moved to hold Bausch & Lomb in contempt for violating the injunction because Bausch & Lomb had offered its lenses to an Irish customer despite the court’s injunction. Bausch & Lomb, on the other hand, argued that it should not be held in contempt because, under the Patent Act, an infringing offer for sale requires that the contemplated “sale itself”

would “be in the United States.”<sup>7</sup> The court rejected this argument.<sup>8</sup> According to the court, “the ‘sale’ contemplated by the ‘offer to sell’ need not ... be intended to take place in the United States for there to be infringement” under the Patent Act, so long as the offer itself occurred in the U.S.<sup>9</sup>

### B. Do Not Commit Foreign Acts that Induce Domestic Infringement

In *Kabushiki Kaisha Hattori Seiko v. Refac Tech. Dev. Corp.*<sup>10</sup>, the District Court for the Southern District of New York held that, through foreign activity alone, a company can infringe a United States patent by inducing infringement of the patent by another. The dispute in *Hattori Seiko* involved a patent license agreement between Hattori Seiko, Ltd. (“Seiko”) and Refac Tech, Ltd. (“Refac”). Under the agreement, Refac granted Seiko a license to sell products “within the scope of” Refac’s United States patents.<sup>11</sup> Seiko sued Refac for breach of the patent license agreement after Refac brought patent infringement suits against Seiko’s foreign customers. Seiko argued that Refac’s suit against Seiko’s foreign customers, who purchased products from Seiko and then resold in the United States, breached the agreement because Seiko’s foreign sales were “within the scope” of the patents. Refac argued that it was not in breach because Seiko’s extraterritorial sales were outside the scope of its patents and therefore unlicensed. The court found Refac in breach. According to the court, the foreign sales were

“within the scope” of the patents because they would have rendered Seiko liable for “inducement of infringement” but for the license.<sup>12</sup>

### C. Do Not Export the “Components” of a Patented Invention

Under Congress’s 1984 Amendments to the the Patent Act, a company may infringe a United States patent by exporting the physical constituents of a patented invention from the United States for assembly abroad.<sup>13</sup> More specifically, whoever “supplies” from the United States a “substantial portion of the components of” an invention to “induce the combination of such components” abroad is an infringer.<sup>14</sup> Similarly, whoever “supplies” from “the United States any component of” an invention that is “especially adapted for use in the invention,” knowing that the “component” will be combined abroad to make the invention, is also an infringer.

In three high-profile cases, two of which are now on appeal, district courts relied on the 1984 Amendments to hold that a company may be liable for foreign sales of a patented apparatus, even though it did not export any physical part of the apparatus from the United States.

In (1) *Eolas Tech., Inc. v. Microsoft Corp.*,<sup>15</sup> (2) *Imagexpo, LLC v. Microsoft Corp.*,<sup>16</sup> and (3) *AT&T Corp. v. Microsoft Corp.*,<sup>17</sup> Microsoft was found liable for foreign sales of computers loaded with its Windows® operating system. In each case, it was undisputed that Microsoft supplied no physical component of any computer sold abroad. Instead,

Microsoft merely conceived the software instructions comprising Windows®, and provided foreign computer sellers with a way of recreating those instructions using Microsoft’s “golden master disks.”<sup>18</sup> According to each of the *Eolas*, *Imagexpo*, and *AT&T* courts, however, the 1984 Amendments prohibited Microsoft from supplying the instructions that govern the operation of the foreign assembled computers, and not merely the physical constituents of the computers.<sup>19</sup> The *Eolas* and *Imagexpo* holdings led to the two largest intellectual property verdicts reported last year.<sup>20</sup>

### III. A Reversal in Trend?

The Federal Circuit appears to have effectively overruled these last decisions in *Pellegrini v. Analog Devices, Inc.*<sup>21</sup> In *Pellegrini*, the Federal Circuit affirmed a district court’s judgment of no infringement for the foreign sales of Analog Device’s

integrated circuits. The Court held that Analog Devices could not be held liable for the foreign sales because it did not supply any physical component of any integrated circuit sold abroad. Instead, Analog Devices merely provided foreign sellers of its integrated circuits with “instructions for their manufacture.”<sup>22</sup> According to the Federal Circuit, the word “supplying” in the 1984 Amendments “clearly refers to physical supply of components, not simply to the supply of instructions.”<sup>23</sup>

Whether the Federal Circuit will explicitly reverse *Eolas* and *AT&T Corp.* in view of *Pellegrini* remains to be seen. The *Pellegrini* decision may indeed suggest that the Federal Circuit will begin to cut back on some district court’s extra-territorial application of United States patent law. Until the Federal Circuit clearly does so, however, businesses should think twice before assuming that foreign activity cannot give rise to patent infringement.

<sup>1</sup> *Dowagiac Mfg. Co. v. Minnesota Moline Plow Co.*, 235 U.S. 641 (1915).

<sup>2</sup> 35 U.S.C. §271(a); Holbrook, “Territoriality Waning? Patent Infringement for Offering in the United States to Sell an Invention Abroad,” 37 U.C. Davis L. Rev. 701 (Feb. 2004).

<sup>3</sup> 35 U.S.C. §271(a).

<sup>4</sup> 35 U.S.C. §271(f).

<sup>5</sup> 256 F. Supp. 2d 228 (D. Del. 2003).

<sup>6</sup> *Id.* at 229.

<sup>7</sup> *Id.* at 230.

<sup>8</sup> *Id.* at 235.

<sup>9</sup> *Id.* at 233-34.

<sup>10</sup> 690 F. Supp. 1339, 1344 (S.D.N.Y. 1988).

<sup>11</sup> *Id.* at 1341.

<sup>12</sup> *Id.* at 1344.

<sup>13</sup> 35 U.S.C. §271(f).

<sup>14</sup> 35 U.S.C. §271(f)(1).

<sup>15</sup> 70 U.S.P.Q.2d 1939, 1943-44 (N.D. Ill. 2004).

<sup>16</sup> 299 F. Supp. 2d 550, 553 (E.D. Va. 2003).

<sup>17</sup> 71 U.S.P.Q.2d 1118, 1125-26 (S.D.N.Y. 2004).

<sup>18</sup> *Eolas*, 70 U.S.P.Q.2d at 1944; *Imagexpo*, 299 F. Supp. 2d at 551-52; *AT&T Corp.*, 71 U.S.P.Q.2d at 1125-26.

<sup>19</sup> *Eolas*, 70 U.S.P.Q.2d at 1944; *Imagexpo*, 299 F. Supp. 2d at 553; *AT&T Corp.*, 71 U.S.P.Q.2d at 1125.

<sup>20</sup> “Top 100 Verdicts of 2003,” *National Law Journal*, Feb. 9, 2004 at S.5.-S.6.

<sup>21</sup> 375 F.3d 1113 (Fed. Cir. 2004).

<sup>22</sup> *Id.* at 1115, 1118.

<sup>23</sup> *Id.* at 1118.



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## So Close Yet So Far: EU Community Patent

*By Wendy A. Choi and Hallum O. Bailey*

Since the 1970's, many have desired a system for providing uniform patent coverage throughout Europe. In March 2003, a political compromise was reached which seemed to signal the beginning of a system to give inventors pan-European Union coverage. This ended years of protracted negotiations on issues such as mandatory translation languages and jurisdictional supervision. Unfortunately, the rose has fallen off the bloom less than a year after the historic agreement. The issue of translation has again stalled progress on the Community Patent, and its future looks rather bleak.

Currently, a patentee has three choices for filing a patent applica-

tion in Europe: (1) direct national filing in individual countries, (2) European regional filing, or (3) PCT filing. The addition of the Community Patent promised a system designed to maximize patent protection while minimizing expensive, and sometimes prohibitive, patenting costs.

Under a national patent strategy, a party can prosecute his patent application in each individual country of choice. However, paying multiple filing and prosecution costs can quickly become an expensive endeavor, as each national patent office has individual procedural idiosyncrasies (including translation requirements) and differing legal requirements for patentability.

Still further, upon grant, the patentee is faced with multiple national patents, each incurring separate maintenance and administrative costs, and each being enforceable only in the country that granted it.

Under a European regional strategy, a party filing with the European Patent Office (EPO) may take advantage of a centralized filing and examination agency whereby the applicant may select from any number of designated European countries for patent protection.<sup>1</sup> This, of course, saves the cost of preparing and filing the patent application in each individual country of choice. Upon grant, the European patent acts as a "bundle" of national

patents and becomes enforceable in each of the patentee's selected countries. However, this still results in multiple, and expensive, renewal fees and does not reduce the need for local patent agents to attend to administrative issues associated with those national patents. Again, expenses abound. Further, strategic or economic factors may initially limit the patentee's selection of countries under either the national or European regional patenting strategies. The patentee may later find himself faced with a potential infringer in a European country he did not select for protection.

A patentee can also elect to file a PCT (Patent Cooperation Treaty) application under the administration of the World Intellectual Property Organization. Here, a single filing designates all available member countries and regions for patent prosecution.<sup>2</sup> The patentee may then elect to individually prosecute his application in any of the designated countries or regions. Thus, for example, the patentee may choose to further prosecute his "international" PCT application as a European regional application. In addition to centralized administration and reduced filing costs, the PCT system allows the patentee up to 30 months before having to decide whether to further prosecute the application in the regions or countries of choice. The extra time, in addition to receipt of a preliminary patentability examination, allows the patentee to evaluate his chances of patentability, either nationally or regionally, before incurring further patent prosecution costs. Nonetheless, the PCT strategy suffers from similar shortcomings of the national and

European regional strategies; the international application must be further prosecuted in individual countries or regions of choice, and may ultimately result in a "bundle" of national patent rights requiring multiple and expensive renewal/administrative costs.

Historically, the cost of filing a patent throughout Europe has been significantly more than filing costs in either the U.S. or Japan. Thus, European companies were competitively disadvantaged in their domestic market. As compared to the United States and Japan, a party filing in Europe is faced with many concerns, particularly since

**“Historically, the cost of filing a patent throughout Europe has been significantly more than filing costs in either the U.S. or Japan.”**

each country requires individual translation and maintenance fees, and each country requires a local patent agent for optimal prosecution and administration. Still further, patent protection is limited to only those countries selected, and disputes must be litigated separately in each country, with possibly different outcomes. These factors contribute to the expense and complexity of obtaining patent protection in Europe.

The historic March 2003 Community Patent agreement, attempting to unify Europe's separate national and regional patent

systems, outlined the following:

- (1) The current European Patent Office, in Munich, Germany, would examine and issue the new Community Patents.
- (2) Initial applications would be made in English, German, or French, and, once granted, would be translated into the remaining two, non-selected languages, at the applicant's expense.
- (3) Patent claims would be translated into all of the European Union's official languages at the applicant's expense, including Danish, Finnish, Greek, Italian, Portuguese, Spanish, and Swedish.
- (4) A new Community Patent Court, based in Luxembourg, would have exclusive jurisdiction over Community Patent disputes with litigation conducted in the defendant's native language.
- (5) The Community Patent system would be operational by 2006, at the earliest, with the Community Patent Court following by 2010.

Many European patent practitioners applauded the agreement as a measure to reduce patenting costs in Europe while increasing competition with U.S. and Japanese companies. Some estimated the Community Patent filing cost to be no more than 25,000 Euros (about \$31,000 U.S., as of this writing), about the same as to obtain a patent in just eight member countries at the time. Further, upon grant, the Community Patent would require only one set of maintenance fees, rather than multiple sets as under the national, European regional or PCT systems. The agreement was also thought to increase research incentives while spurring

innovation and economic growth in Europe.

Other practitioners, however, were not so enthusiastic about the new system, noting several downsides to its implementation. For example, a pan-European patent would fundamentally change litigation and patenting strategies as successful validity challenges to a Community Patent would have effect in all member countries rather than merely the country of suit. Further, translation costs would seem to be ever increasing as more countries entered the European Union. For example, in March 2003 a Community Patent would require translation into only eleven languages. However, with EU membership now growing to 25 countries, the number of official languages is expected to rise to 20 including Czech, Estonian, Hungarian, Latvian, Lithuanian, Maltese, Polish, Slovakian, and Slovenian. And, of course, proper translation will not come cheaply, as each claim must be carefully and accurately translated into multiple languages while maintaining proper claim scope. The translation of English to Maltese would definitely bring many nuanced (and expensive) challenges. These “hidden” translation costs could raise the cost of obtaining a Community Patent beyond the reach of small-to-medium sized companies.

Also, many companies may

rightfully be hesitant in pursuing the Community Patent since national court systems would have jurisdiction until the Community Patent Court is established. Thus, early adopters would still face the problem of inconsistent results in multiple jurisdictions. Worse still, a savvy litigator would realize that he had four patenting systems from which to choose (National

**“Despite some flaws, the Community Patent system would be viewed as a welcome addition to the European patent landscape.”**

Patent, European Patent, PCT filing, Community Patent) and attempt “more than one bite at the apple.” For example, a party could file for a national patent and a Community Patent, and sue under the first patent to issue. Notwithstanding national rules prohibiting multiple patents covering the same subject matter, and if dissatisfied with the result, the party could bring suit under the second patent to issue. This would give the party the opportunity to correct tactical or technical errors in its patent strategy by claim

amendments or other means.

Progress on the Community Patent stalled in March 2004 due to translation issues and national interest. EU Ministers were unable to agree on the legal validity of translations and the consequences of incorrect translations. This is a particularly important issue as a type of “innocent infringement” defense could conceivably be argued by an accused party who relied upon an incorrect translation. Spain, arguing to promote its language in European institutions, argued that the original claim languages should be given effect in Community Patent disputes. Germany also rejected the proposed agreement, some say, to protect the status and revenue stream of its national patent courts, a favored forum of European patent suits, which would have been circumvented by the Community Patent Court.

Despite some flaws, the Community Patent system would be viewed by many as a welcome addition to the European patent landscape. While some have noted that its prospects of progression are “as dead as a dodo,” it is highly likely to be considered for years to come. The European Union’s desire to create a dynamic and competitive market place may someday resolve the individual differences among the Member States, and lead to agreement on this issue.

<sup>1</sup> There are currently 28 countries available via the European regional strategy, including:

Austria, Belgium, Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Liechtenstein, Luxembourg, Monaco, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden, Switzerland, Turkey, and the United Kingdom.

<sup>2</sup> There are currently over 120 countries available via the PCT strategy including:

Australia, Canada, China, India, Israel, Japan, Mexico, South Korea, South Africa, and the United States.

There are also 4 regional patent treaties available including the European Region (EP), African Regional Industrial Property Organization, Euroasian Patent Organization and African Intellectual Property Organization.



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## Woodcock Washburn Preferred Provider For Microsoft

Woodcock Washburn is pleased to announce that it has been selected as one of Microsoft's preferred law firms for handling its intellectual property matters, including patent litigation, procurement and counseling. In making this selection,

Microsoft noted that only few of the many outside firms that it had retained over the years were selected for this honor. "Microsoft's preferred firms are the highest quality, best value service providers available," said Kevin Harrang, Deputy General

Counsel for Operations at Microsoft's Law and Corporate Affairs department. "This selection speaks very highly of Woodcock Washburn, and deserves congratulations."



*Microsoft.  
Preferred  
Legal Counsel*

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## Woodcock Recognized For Donation to American Intellectual Property Law Education Foundation

For its multi-year commitment to the American Intellectual Property Law Education Foundation (AIPLEF), Woodcock Washburn LLP has been recognized as a Gold Scholarship Sponsor. The AIPLEF sponsors

scholarships that address the need to increase the number of minority intellectual property attorneys and to bring these attorneys to the attention of firms and corporations as candidates for employment. The \$10,000 scholarships are

awarded to minority students developing a career in intellectual property law or holding a past or present, full or part-time position in an area related to intellectual property law.

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# Rules Without Exception: Will That Work For Claim Construction?

By Barbara L. Mullin and Hallum O. Bailey

Is claim construction amenable to resolution by resort to strictly algorithmic rules ... ?” So asked Judge Rader in his concurrence to the Federal Circuit’s recent decision to rehear *en banc* the appeal in *Phillips v. AWH Corporation*.<sup>1</sup> Since the claims of a patent define the “metes and bounds” of the rights conferred,<sup>2</sup> the issue of how those claims are construed is far from trivial and, right now, far from settled. As evidenced by its willingness to rehear this case, the Federal Circuit apparently recognizes the lack of consistency in the “rules” that it has applied in interpreting patent claims. The Court has now indicated that it will finally address, among other issues, whether there should be one uniform approach to claim construction, and, if so, what it should be.

In recent years, claim construction has generally followed two different approaches – the “**Specification**” approach and the “**Plain Meaning**” approach. Federal Circuit panels following the **Specification** approach look to the patent’s specification as the primary source for interpreting claim language. In a few cases, the specification has been used to limit the claimed invention to what the inventor actually *disclosed* in the specification, even though the claim language, on its face, would afford a broader interpretation.<sup>3</sup>

Federal Circuit panels following the **Plain Meaning** approach

give claim terms their ordinary and broadest meaning as evidenced through dictionary definitions, absent a clear disclaimer of scope. The Federal Circuit has cautioned that consulting the written description before any attempt has been made to discern the plain meaning of the claim terms invites violation of its precedent counseling against importing limitations into the claims.<sup>4</sup>

The dichotomy between these approaches was plainly evident in January 2003. In *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, Federal Circuit Judges Michel, Schall, and Clevenger affirmed a district court’s decision *not to limit* the claim terms based on

“In recent years, claim construction has generally followed two different approaches—the “*Specification*” approach and the “*Plain Meaning*” approach.”

examples in the specification and characterizations of the invention made during prosecution.<sup>5</sup> The Court stated that, although the prosecution history may be relevant to claim construction, it “may not be used to infer the intentional narrowing of a claim

absent the applicant’s clear disavowal of claim coverage.”<sup>6</sup>

Just twenty-five days later, in *Biogen, Inc. v. Berlex Laboratories, Inc.*, Federal Circuit Judges Newman, Friedman, and Rader affirmed a district court’s decision *to limit* the claims to the single example disclosed in the specification and prosecution history.<sup>7</sup> Judge Newman, writing for the Court, stated that the district court properly construed the claims to conform to the basis on which the patent was presented in the specification.<sup>8</sup> Judge Newman further stated that the informed decision maker is required to focus on the patent specification because it is the inventor’s basic representation of the invention and the “claims represent the final product of a sometimes imperfect process.”<sup>9</sup>

Even a cursory review of the case law shows that the Federal Circuit is split on which methodology to use when construing patent claims.<sup>10</sup> Judges Clevenger, Mayer, and Schall have each employed the **Specification** method in about one-third of the reviewed cases. On the other hand, Judges Newman, Bryson, and Lourie seem to adhere to the **Specification** methodology, relying on this method in every case reviewed in which they have participated. Indeed, Judge Newman, a vocal dissenter of the **Plain Meaning** protocol, has cautioned that indiscriminate reliance on the ordinary meaning derived from

dictionary definitions without consideration of the context of the invention may lead to “absurd results.”<sup>11</sup> Judge Michel has recently questioned the **Plain Meaning** methodology because it mandates broad claim scope regardless of what the inventor actually invented.<sup>12</sup> Judge Rader’s approach is less predictable.

The two contrasting methods have spawned some heated dissents in recent months. In *Microsoft Corp. v. Multi-Tech Systems, Inc.*, for example, the Federal Circuit affirmed a district court’s decision to limit the claims to cover only communications over a telephone line (excluding communications over a packet-switched system such as the Internet) even though the claim at issue made no reference to a telephone line.<sup>13</sup> The majority so reasoned, because the specification referred to “over” or “through” a telephone line roughly two dozen times and did not suggest use of a packet switched network.<sup>14</sup> In his dissent, Judge Rader, characterized the majority’s analysis as requiring Evel Knievel-like leaps

of logic.<sup>15</sup> In fact, Judge Rader noted that a person connecting to the Internet would likely do so over a telephone line using a modem and there was nothing in the record that limited the patent scope to communication exclusively over a telephone line.

The tension was also evident in *Novartis Pharmaceuticals Corp. v. Eon Labs Manufacturing, Inc.*<sup>16</sup> Here, the Federal Circuit began its analysis with an examination of dictionary definitions and, in fact, referred to eight dictionaries to determine the “ordinary meaning” of the claim term at issue, “hydrosol.”<sup>17</sup> The Court determined that the dictionary definitions could cover either compounds formed inside or outside of the patient’s stomach. Nonetheless, it limited the term “hydrosol” to compounds formed outside the patient’s stomach since the specification described the term as a pharmaceutical composition (*i.e.* a manufactured compound) and made no mention of the term in any other context.<sup>18</sup> The Court did this despite noting that there was no explicit dis-

claimer of claim scope. Judge Clevenger dissented, arguing that the term should be given its broadest possible meaning since no disclaimers were present in the specification.

At first blush, the **Plain Meaning** approach seemed to provide some certainty in clarifying claim construction. As Judge Rader suggests, however, any attempt to establish “algorithmic rules” may be misguided. Claims, as products of an imperfect process, may be inapposite to such an approach. Each invention is different, and patents, as written documents, exhibit countless permutations of style, complexity, language, and scope. The Federal Circuit’s *en banc* decision will likely define how patents are litigated, and drafted, for the foreseeable future. It remains to be seen whether the Federal Circuit will establish firm rules and, if so, whether the rules will be based on a new claim construction paradigm or a middle ground between the existing methodologies.<sup>19</sup>

<sup>1</sup> 376 F.3d 1382, 1384 (Fed. Cir. 2004) (vacating *Phillips v. AWH Corp.*, 363 F.3d 1207 (Fed. Cir. 2004)).

<sup>2</sup> *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989) (“A claim in a patent provides the metes and bounds of the right which the patent confers on the patentee to exclude others from making, using, or selling the protected invention.”).

<sup>3</sup> See, e.g., *Toro Co. v. White Consol. Indus.*, 199 F.3d 1295 (Fed. Cir. 1999); *Wang Labs. v. Am. Online, Inc.*, 197 F.3d 1377 (Fed. Cir. 1999); *Watts v. XL Sys., Inc.*, 232 F.3d 877 (Fed. Cir. 2000).

<sup>4</sup> *Tex Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1204 (Fed. Cir. 2002).

<sup>5</sup> 314 F.3d 1313 (Fed. Cir. 2003) (decided Jan. 6, 2003).

<sup>6</sup> *Amgen*, 314 F.3d at 1327.

<sup>7</sup> 318 F.3d 1132 (Fed. Cir. 2003) (decided Jan. 31, 2003).

<sup>8</sup> *Biogen*, 318 F.3d at 1140.

<sup>9</sup> *Id.*

<sup>10</sup> *Modine Mfg. Co. v. ITC*, 75 F.3d 1545 (Fed. Cir. 1996) (Newman, Clevenger, Mayer (dissenting)); *Gen. Am. Trans. Corp. v. Cryo-Trans, Inc.*, 93 F.3d 766 (Fed. Cir. 1996) (Lourie, Schall, Mayer (dissenting)); *Toro Co. v. White Consol. Indus.*, 199 F.3d 1295 (Fed. Cir. 1999) (Newman, Friedman, Rader (dissenting)); *Wang Labs. v. Am. Online, Inc.*, 197 F.3d 1377 (Fed. Cir. 1999) (Newman, Mayer, Gajarsa); *Cultor Corp. v. A.E. Staley Mfg. Co.*, 224 F.3d 1328 (Fed. Cir. 2000) (Newman, Friedman, Rader); *Watts v. XL Sys., Inc.*, 232 F.3d 877 (Fed. Cir. 2000) (Linn, Bryson, Gajarsa); *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337 (Fed. Cir. 2001) (Bryson, Plager, Dyk (concurring)); *Novworld, LLC v. Central Corp.*, 242 F.3d 1347 (Fed. Cir. 2001) (Newman, Archer, Clevenger (dissenting)); *Bell Atl. Network Servs., Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258 (Fed. Cir. 2001) (Gajarsa, Lourie, Plager); *Biogen, Inc. v. Berlex Labs.*, 318 F.3d 1132 (Fed. Cir. 2003) (Newman, Friedman, Rader (concurring)); *Alloc, Inc. v. ITC*, 342 F.3d 1361 (Fed. Cir. 2003) (Rader, Michel, Schall (dissenting));



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*Hallum O. Bailey is an associate at Woodcock Washburn, specializing in patent and trademark litigation, counseling, and procurement. He holds B.S. and M.S. degrees in Materials Science and Engineering and his J.D. from the University of Pittsburgh. He is registered to practice before the U.S. Patent and Trademark Office.*

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*Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340 (Fed. Cir. 2004) (Lourie, Bryson, Rader (dissenting)); *Novartis Pharm. Corp. v. Eon Labs Mfg., Inc.* 363 F.3d 1306 (Fed. Cir. 2004) (Dyk, Prost, Cleverger (dissenting)); *Norian Corp. v. Stryker Corp.*, 363 F.3d 1321 (Fed. Cir. 2004) (Newman, Friedman, Schall (dissenting in part)); *Phillips v. AWH Corp.*, 363 F.3d 1207 (Fed. Cir. 2004) (Newman, Lourie, Dyk (dissenting)).

<sup>11</sup> *Housey Pharm., Inc. v. Astrazeneca UK, Ltd.*, 366 F.3d 1348, 1356 (Fed. Cir. 2004) (Judge Newman dissenting).

<sup>12</sup> *SuperGuide Corp., v. DirecTV Enters., Inc.*, 358 F.3d 870, 897-98 (Fed. Cir. 2004) (Judge Michel concurring in the result).

<sup>13</sup> 357 F.3d 1340, 1354-58 (Fed. Cir. 2004) (Judge Rader dissenting).

<sup>14</sup> *Microsoft*, 357 F.3d at 1348.

<sup>15</sup> *Id.* at 1355.

<sup>16</sup> 363 F.3d 1306 (Fed. Cir. 2004). (Judge Cleverger dissenting).

<sup>17</sup> The court used the following dictionaries in determining the ordinary meaning of “hydrosol”:  
Webster’s Third New International Dictionary (2002); Oxford English Dictionary (1989); Merriam Webster Medical Dictionary (2003); Webster’s Ninth New Collegiate Dictionary (1985); Merriam-Webster’s Collegiate Dictionary (2003); Stedman’s Medical Dictionary (2000); Dorland’s Illustrated Medical Dictionary (2003); and Attorney’s Dictionary of Medicine (1995).

<sup>18</sup> *Novartis*, 363 F.3d at 1310-11.

<sup>19</sup> The Federal Circuit has invited bar associations and trade associations, including the United States Patent and Trademark Office, to file amicus curie briefs on the issue. In addition to asking whether it would be better to use dictionaries or the patent specification as the primary tool in determining claim scope, the Court inquired whether the two methodologies could be combined. The Court also asked whether it should simply defer to the trial court’s claim construction. The roles of expert testimony and the prosecution history, in determining claim scope, are also being questioned.

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## Woodcock Partners Named Pennsylvania "Superlawyers"

Woodcock Washburn partners John Donohue, Dianne Elderkin, Dale Heist, Dick Kurtz, Gary Levin, Lynn Morreale, Barbara Mullin, Rik Parker and Steve Rocci have been named Pennsylvania Super Lawyers for 2004, a distinction bestowed on only 5 percent of Pennsylvania lawyers. In addition, Dale Heist was named a Top 100 Philadelphia Super Lawyer and Dianne Elderkin was named a Top 50 Pennsylvania Female Super Lawyer.

The awards followed a six-month three-step process in which Pennsylvania lawyers were asked to name the best lawyers that they had personally observed in action, further review of top candidates by a blue ribbon panel of prominent Pennsylvania attorneys, and a final review and selection by an attorney-led independent research group. The award is sponsored jointly between Philadelphia Magazine and Law & Politics Magazine.



## Woodcock Washburn News



**Lynn A. Malinoski**

Lynn A. Malinoski, a partner in the firm's Philadelphia office, has been elected the 2004-2005 President of the Philadelphia Intellectual Property Law Association (PIPLA). PIPLA is a key organization for intellectual property lawyers in the Philadelphia, Delaware, and New Jersey

area. PIPLA provides a forum for local attorneys to discuss substantive and ethical developments relating to the practice of patent, copyright, and trademark law, while also providing a forum for attorneys to develop and foster professional relationships. PIPLA also serves as a resource through which local intellectual property attorneys can provide comments to federal judicial and legislative bodies about developments in intellectual property law.



**Michael D. Stein**

Michael D. Stein, a partner in the firm's Seattle office, has been appointed to the position of Chair of the American Intellectual Property Law Association's (AIPLA) Electronic and Computer Law Committee (ECLC). The Mission of the ECLC is to provide AIPLA members with

timely information on developments in intellectual property law relating to electronics, computers, software and the Internet, and to provide committee members with opportunities to serve the bar, the Patent Office, and the technical community through involvement in professional programs, legal analysis and advice, policy making opportunities, and informal networking.



**Michael J. Swope**

Michael J. Swope, also a partner in the firm's Seattle office, has been elected to the board of the Washington State Patent Lawyers Association (WSPLA). WSPLA is

the leading organization for patent lawyers in the state of Washington, providing a forum for patent law issues and a resource for new and developing rules and regulations.

## Woodcock Washburn Announces New Associates



**Jeremiah J. Baunach**

Jeremiah ("Jim") recently joined our Seattle office as an associate specializing in patent law, especially in the computer science area. Jim received his B.S. in Computer Science from the University of Portland. He worked as a software engineer for a private company designing and developing software for

telecommunications multiplexer equipment.

Jim received his J.D. from Willamett University College of Law. Following graduation, he was commissioned to the United States Air Force where he served as a Project Engineer, Communications and Information Systems, in Kuwait.

Jim is registered to practice before the U.S. Patent and Trademark Office. He is also admitted to the Washington State bar.



### **Thomas S. Kim**

Thomas joins us as an associate and specializes in patent law, especially in the chemical and biochemical areas.

Thomas received his B.S., with Honors, in Chemistry, from Georgia Institute of Technology. He then earned his M.S. in Biochemistry from the University of Illinois

where he studied the enzyme lecithin:cholesterol acyltransferase and its role in HDL metabolism.

Thomas received his J.D. from Washington University. He is admitted to practice in Illinois and the Northern District of Illinois. He is also registered to practice before the U.S. Patent and Trademark Office.



### **Eric J. Schaal**

Eric has recently joined our firm as an associate specializing in patent law, especially in the mechanical engineering area.

Eric received his undergraduate degree in Mechanical Engineering from Vanderbilt University. Following graduation, Eric was commissioned in the United States Air Force

where he worked in weapons systems operations as an Evaluator Deputy Missile Combat Crew Commander and also received Space and Missile Training.

Eric received his J.D., *magna cum laude*, from Villanova University School of Law. While in law school Eric was a judicial clerk for the United States Magistrate Court. He has recently taken the Pennsylvania bar exam.



### **David B. Hoffman**

David joins our firm as an associate specializing in patent law, especially in the biotechnology and chemical fields.

David received his B.S., with Highest Honors and Highest Distinction, in Biology and a Minor in Chemistry from the University of North Carolina at Chapel Hill.

Following graduation, David joined the Biology Department at UNC-Chapel Hill, as a research technician. He designed and executed experiments and procedures in cell biology, biochemistry, and immunocytochemistry.

David received his J.D. from the University of Pennsylvania Law School where he was the recipient of the James Wilson Memorial Scholarship. He has recently taken the Pennsylvania bar exam.



### **Brian A. Cocca**

Brian joins us as an associate specializing in patent law, especially in the biotechnology field.

Brian graduated, *magna cum laude*, with a degree in Biology, from Muhlenberg College. He then went on to earn his Ph.D. in Immunology at MCP Hahnemann

University School of Medicine. While a Ph.D. candidate, Brian was a graduate student/researcher at the University of Tennessee Health Services Center in Memphis. His work included developing advanced systems for the engineering, expression, and purification of recombinant antibodies in *E. coli*.

Brian received his J.D. from The George Washington University School of Law and has recently taken the Pennsylvania bar exam.



### **Greg S. Plichta**

Greg joins our Seattle office as an associate who specializes in patent law, especially in the electrical engineering area.

Greg received his undergraduate degree in Electrical Engineering at the University of

Washington. Prior to going to law school, Greg worked as an electrical engineer for a private company where he built electro-mechanical logic control panels.

Greg received his J.D. from the University of Washington Law School and has recently sat for the Washington state bar exam.

# Woodcock Washburn Welcomes Summer Associates



Woodcock Washburn welcomed seven Summer Associates to the firm this summer. Pictured with firm founder Bob Washburn are:

(seated from left to right) **Stephanie Barbosa**, BA, Chemistry; Rutgers University, 1995; Ph.D., Organic Chemistry; University of Pennsylvania, 2000; JD candidate, Rutgers School of Law, 2005; **Matt Pearson**, BS, Biochemistry & Chemistry, Michigan State University, 1993; Ph.D., Biochemistry, Molecular & Cell Biology, Cornell University, 1999; JD candidate, University of Pennsylvania School of Law, 2005;

(standing from left to right) **Sean B. Seymore**, BS, Chemistry, University of Tennessee, 1993; MS, Chemistry, Georgia Institute of Technology, 1996; Ph.D., Chemistry, University of Notre Dame, 2001; JD candidate, University of Notre Dame Law School, 2006; **Sergio F. Chung**, BS, Mechanical Engineering; MIT, 2000; JD candidate, Boston University School of Law, 2005; **Bob Washburn**; **David L. Breau**, BS, Mechanical Engineering, Johns Hopkins University, 1998; JD candidate, Duke University School of Law, 2006; **Bryan T. Giles**, BS, Electrical Engineering, Drexel University, 1997; JD candidate, Temple University Beasley School of Law, 2005; **Mansi H. Shah**, BS, Computer Science, University of California, San Diego, 2003; JD candidate, The George Washington University Law School, 2006.



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