Attorneys Alexander Rozenblat, Yusuf Esat and D. Matthew Feldhaus of Jenner & Block discuss the reasons why patent applicants may want to consider crafting their own definitions for patent claim terms, and some reasons why they might not want to.

Presidents and patent applicants alike are able to be their own lexicographers and redefine words away from their ordinary meanings. As in presidential impeachment proceedings, this “lexicography” practice is often the difference between success and failure in patent litigation.


Patent applicants must beware, however, that setting forth a definition for a claim term may just as easily be a patentee's downfall. To navigate the fine line separating success from failure, an applicant should consider whether a contemplated definition is necessary to perfect a claim's scope, or whether the definition is surplus disclosure that could come back to haunt the patentee during litigation.

The ‘lexicographer’ rule

It is axiomatic that in a patent specification, an inventor may act as his own lexicographer and define a term used in the patent claims. Phillips v. AWH Corp., 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc). In general, the terms of a claim are given “their ordinary and customary meaning.” Id. at 1312 (quoting Vitronics Corp. v. Conceptronic Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996)).

According to the current understanding of the “lexicographer” rule, however, an inventor may expressly define claim terms, even defining terms inconsistently with the ordinary meaning of the term known to those of ordinary skill in the art. When an inventor clearly and unambiguously defines a term as a lexicographer, that special definition -- and not the ordinary meaning of the term -- controls.

Notwithstanding the present state of the law, the “lexicographer” rule did not always allow an inventor to redefine a term away from its ordinary meaning. For years, the U.S. Patent and Trademark Office and the Federal Circuit's predecessor, the Court of Customs and Patent Appeals, foreclosed the lexicographer rule in situations where the inventor wholly changed the meaning of a term.

For example, the PTO's Manual of Patent Examining Procedure explained that “[w]hile applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term.” MPEP 706.03(d) (6th
Expansion of the lexicographer rule

*2 The Federal Circuit has never supported the *In re Hill* doctrine. Instead, it has held that the specification can “circumvent the plain language of the claim and the clear definition of the disputed claim language” where it “clearly redefine[s]” the claim language. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357 (Fed. Cir. 1999). The Federal Circuit has emphasized that redefinitions of terms must be clear: “When a patentee acts as his own lexicographer in redefining the meaning of particular claim terms away from their ordinary meaning, he must clearly express that intent in the written description.” *Merck & Co. v. Teva Pharms. USA*, 395 F.3d 1364, 1370 (Fed. Cir. 2005).

Following Federal Circuit precedent, in 2003, the PTO amended the eighth edition of the Manual of Patent Examining Procedure to remove the admonition that a claim “may not be given a meaning repugnant to the usual meaning” of the term. See MPEP 706.03(d) (8th ed. Rev. 1). MPEP 706.03(d) now states that if a term is specifically defined contrary to its ordinary meaning, “the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term.” MPEP 706.03(d) (8th ed. Rev. 9) (August 2012) (citing *Process Control*, 190 F.3d at 1357).

The boon of lexicography: The Allergan decision

The ability to define a claim term can be a potent tool for a patentee. The potential benefits of lexicography were on full display in the Federal Circuit’s recent *Allergan* ruling.

In *Allergan*, the plaintiff asserted a claim for a method of treating glaucoma using a class of compounds that included “a radical selected from the group consisting of -OR\(^4\) and -N(R\(^4\))\(^2\) *Allergan*, 2013 WL 314446 at *2.* The parties disputed whether “-N(R\(^4\))\(^2\)” required two identical R\(^4\) substituents. *Id.*

While the court found that the plain and ordinary meaning -N(R\(^4\))\(^2\) required identical R\(^4\) substituents, the court went on to hold that Allergan had acted as its own lexicographer and redefined the term away from its ordinary meaning to encompass non-identical R\(^4\) \(^0\) substituents. *Id.* at *4.* As a result, the defendants’ drugs infringed the asserted claim. *Id.* at *2, *4.*

*Allergan* is just the latest example of a patentee benefitting from its decision to act as a lexicographer. In *Martek Biosciences Corp. v. Nutrinova Inc.*, 579 F.3d 1363 (Fed. Cir. 2009), for example, the asserted claims recited methods for achieving high concentrations of omega-3 fats in an “animal.” *Id.* at 1379. The District Court construed “animal” to exclude humans. *Id.* Under this construction, the defendant did not infringe the claims because it used the claimed method only in connection with humans. *Id.*

The Federal Circuit reversed the district court because “Martek explicitly defined the term ‘animal’” in the asserted patent to encompass “any organism belonging to the kingdom Animalia,” which includes humans. *Id.* at 1380. The court deemed “irrelevant” the defendant’s extrinsic evidence showing that the ordinary meaning of “animal” excludes humans because the patentee’s explicit definition controlled. *Id.* at 1382.

The bane of lexicography: Saying too much
While Allergan and Martek demonstrate that a specialized definition for a claim term may be crucial to maintaining a patentee’s infringement case, not every act of lexicography ends so happily for the patentee. Often, a patentee is left to rue a special definition that foreclosed an infringement position that would have been viable under the ordinary meaning of the term.

In Trading Technologies International Inc. v. eSpeed Inc., 595 F.3d 1340 (Fed. Cir. 2010), the parties disputed whether an object could be “static” if it changed positions in response to any re-centering command, whether manual or automatic. Id. at 1352-53. While the ordinary meaning of the term likely included manual and automatic commands, the specification explicitly defined “static” by stating that “[t]he values in the price column are static; that is, they do not normally change positions unless a re-centering command is received (discussed in detail later).” Id. at 1353. The specification proceeded to discuss only manual re-centering commands. Id.

The Federal Circuit reasoned that, although it cannot import limitations from a preferred embodiment into the claim, the patentee’s definition of “static” required change in response to a manual re-centering command. Id. This construction was fatal to the patentee's case because the accused systems utilized only automatic re-centering commands. Id. at 1353, 1355.

Similarly, in Edwards LifeSciences v. Cook Inc., 582 F.3d 1322 (Fed. Cir. 2009), the Federal Circuit again foreclosed an infringement position based on the patentee's redefinition of a term away from its ordinary meaning. The dispute focused on whether “malleable” wires could display substantial resilience to bending. Id. at 1333. The specification stated that its wires “are maleable [sic] and may be bent into any desired shape, i.e [sic] they are not resilient to any substantial extent.” Id. at 1334.

While the patentee argued that the wires could display substantial resilience because the plain meaning of “malleable” allowed for such resilience, id. at 1333, the Federal Circuit rejected the patentee's argument because “the specification defines ‘malleable’ to exclude any substantial resilience, and that definition overrides any ordinary meaning of the word ‘malleable’ that might allow for substantial resilience.” Id. at 1334.

The Federal Circuit stated that the “use of ‘i.e.’ signals an intent to define the word to which it refers,” even though the specification did not explicitly state that it was defining the term. Id. The court affirmed summary judgment of non-infringement because the accused wires “are primarily resilient, and therefore not malleable.” Id. at 1335.

In both Trading Technologies and Edwards, verbose descriptions of certain claim terms permitted accused infringers to evade the asserted claims. Had the patentees not included these descriptions, they could have relied on the plain meaning of the terms to maintain their infringement cases.

When silence is golden

While silence is golden

*4 The varying fortunes of lexicographers demonstrate that a patent applicant must be selective when using special definitions for claim terms. An applicant should assess whether any definition, or even a description that might be perceived as a definition, is necessary to the patent. An applicant may consider leaving out a definition when the ordinary meaning of a term is clear and unambiguous. And, if the definition is not needed to fend off an invalidity challenge or to alter a term from its ordinary meaning, the definition should be excluded.

While a definition might seem useful for explanatory purposes, it could undermine the desired claim scope. On the other hand, if the ordinary meaning of a term is not acceptable, or if there are varying definitions for a specific term, the applicant should use his lexicographer’s pen to possibly preserve an infringement case or to avoid an otherwise invalidating piece of prior art.

Perhaps a prudent course of action when preparing a patent application is to follow the “silence is golden” proverb learned in first grade: Avoid providing an express definition for a term used in the patent unless its ordinary meaning is undesirable. One possible approach for increased claim scope is not to define terms in the specification but, instead, to provide the varying
definitions in dependent claims. Following this rule allows the inventor greater flexibility to define the boundaries of claim terms when it matters most -- in litigation.

Footnotes

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