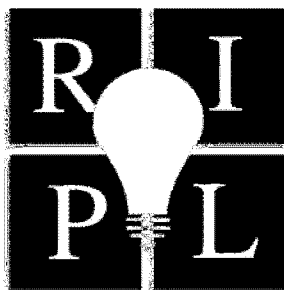


# THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



## REDUCING THE NEED FOR *MARKMAN* DETERMINATIONS

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### ABSTRACT

The uncertainty as to whether claim interpretation decisions will survive appeal is an ever growing concern as the Federal Circuit's reversal rate of lower court claim interpretations averages fifty percent. At a minimum, uncertainty in claim construction prolongs patent infringement disputes. Moreover, the reality is that many times it is the uncertainty of a claim's scope and meaning that leads to litigation in the first place. In order to alleviate this stress on patentees, competitors and the federal court system, most if not all questions regarding the scope and meaning of claim terms should be clarified by the applicant during patent prosecution. The applicant should be required to specifically define the claim terms either by referencing a specific dictionary definition(s) or providing alternative, synonymous wording. Although these are steps that would likely occur during a *Markman* or claim construction hearing, taking preemptive action during prosecution will reduce the complexity of such hearings—if not eliminate the need for them altogether—and will assure that the scope and meaning of claim terms are readily apparent from the moment the applicant applies for a patent.

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REDUCING THE NEED FOR *MARKMAN* DETERMINATIONS\*

ROBERT H. RESIS, ESQ.\*\*

INTRODUCTION

The existing patent system has been criticized for its failure to eliminate uncertainty as to the scope and meaning of patent claim terms.<sup>1</sup> *Markman* hearings to determine the scope and meaning of claim terms are hotly contested proceedings because they control—and sometimes immediately resolve—validity and infringement determinations.<sup>2</sup> At a minimum, uncertainty in claim construction substantially prolongs patent infringement disputes.<sup>3</sup> Indeed, many times the uncertainty as to a claim's scope and meaning in and of itself will give rise to a patent dispute.<sup>4</sup> This uncertainty is exacerbated by the Federal Circuit's fifty percent reversal rate of lower courts' *Markman* decisions.<sup>5</sup> A single patent

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<sup>1</sup> Timothy P. Ryan, *Markman: Where Are We Now? An Update on Developments & Trends in Claim Construction*, in PROCEEDINGS OF THE A.B.A. SEC. INTELL. PROP. L. CONFERENCE (San Francisco, CA, June 23–27, 1999) (“The implementation of *Markman* has raised more questions than it has resolved, and the impact on the creation of a unique procedure for patent infringement litigation has spawned uncertainty, rather than eliminated it, as *Markman* intended.”).

<sup>2</sup> See, e.g., *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1580 (Fed. Cir. 1996). After the district court agreed with Conceptoronic's claim construction, “Vitronics . . . conceded that the court was required to grant judgment as a matter of law in favor of Conceptoronic, as Vitronics had not presented any evidence of infringement under the court's interpretation of solder flow temperature.” *Id.*

<sup>3</sup> There is no requirement for district courts to make a *Markman* determination on the scope and meaning of the claims at the outset of litigation. See *id.* In *Vitronics*, the district court delayed announcing its claim construction until hearing all of the evidence put forth at trial. *Id.* On appeal, the Federal Circuit reversed and remanded because the specification dictated a claim interpretation in accordance with Vitronics's proposed construction, and so construed, the patent may have been infringed. *Id.*; accord William F. Lee & Anita K. Krug, *Still Adjusting to Markman: A Prescription for the Timing of Claim Construction Hearings*, 13 HARV. J.L. & TECH. 55, 57 (1999) (arguing that the most appropriate time for a *Markman* hearing is after the needed discovery has been completed but before the trial begins); JAMES M. AMEND, PATENT LAW – A PRIMER FOR FEDERAL DISTRICT COURT JUDGES 13–14, 65–67 (1998) (proposing “Plaintiff's Claim Chart” on infringement sixty days after the complaint is filed, “Defendant's Claim Chart” of non-infringement thirty days later, and ninety days later the district court hold a *Markman* hearing).

<sup>4</sup> See *Vitronics*, 90 F.3d. at 1582.

<sup>5</sup> See Mark T. Banner, *Changes in Patent Trial and Appellate Practices: Reversal and Addressing the Problems*, in PROCEEDINGS OF THE 48TH ANNUAL CONFERENCE ON DEVS. IN INTELL. PROP. L. (The John Marshall Law School, Feb. 27, 2004) (reporting that in calendar year 2003, the Federal Circuit decided ninety-one cases where the issue of claim construction was at issue, and that the Federal Circuit reversed district courts' claim construction forty-eight times, or fifty-three percent of the time, and that the reversal changed the result in forty-one of the ninety-one cases, or forty-five percent of the cases); accord *Cybor Corp. v. Fas Techs., Inc.*, 138 F.3d 1448, 1476 & n.4 (Fed. Cir. 1998) (Rader, J., dissenting) (stating that between April 5, 1995 (the date of the Federal

infringement case can take years and frequently will run into the millions of dollars for both the patent owner and the accused infringer.<sup>6</sup>

Claim construction need not and should not be an issue in litigation. Rather, the issue of claim construction can and should be resolved before patent issuance. The patent laws and regulations; specifically, 35 U.S.C. § 112, ¶ 2 and 37 C.F.R. § 1.75(d)(1), already dictate that the scope and meaning of claims must be ascertainable by reference to the patent specification. Thus, theoretically, strict compliance with both 35 U.S.C. § 112, ¶ 2 and 37 C.F.R. § 1.75(d)(1) would eliminate the need for *Markman* hearings.

Further, patent applicants should be required to identify: (1) which claim terms are “means-plus-function” elements; (2) the functions of those elements; and (3) the corresponding structures, materials or acts for performing each specified function at the time the claims are presented to the patent examiner. This would eliminate the need for a *Markman* hearing to determine whether 35 U.S.C. § 112, ¶ 6 applies to a given claim term; and, if so, the need for a *Markman* hearing to determine the function(s) of the term, as well as the corresponding structure, material or act for performing each specified function.<sup>7</sup>

Finally, applicants should be required to provide the meaning of their key claim terms at the time each claim is presented to the patent examiner. All statements of the patent applicant on the scope and meaning of the claim terms should be placed into the patent specification, in front of the claims. This procedure would not involve the addition of new matter because the specification as originally filed must support the claims and provide at least a cursory definition of the terms used in each.

The three approaches above, separately or in combination, will bring more certainty to our patent system. This certainty would benefit both patent applicants and market competitors alike.

#### I. REQUIRE STRICT COMPLIANCE WITH 35 U.S.C. § 112, ¶ 2 & 37 C.F.R. § 1.75(d)(1) DURING PATENT PROSECUTION

The Code of Federal Regulations states in part:

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims

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Circuit’s decision in *Markman*) and November 24, 1997, the Federal Circuit’s reversal rate, “in whole or in part,” as to claim construction was almost forty percent).

<sup>6</sup> AM. INTELL. PROP. L. ASS’N, 2003 REPORT OF THE ECONOMIC SURVEY 21, 22 (2003). In 2003, the median estimated cost of a patent infringement suit with \$1–25 million at risk, inclusive of all costs through appeal, was \$2 million per party. *Id.*

<sup>7</sup> Section 112, ¶ 6 allows for claims to be expressed in means-plus-function form, specifically setting forth:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. § 112, ¶ 6 (2000).

must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.<sup>8</sup>

This provision of the Federal Regulations, 37 C.F.R. § 1.75(d)(1), requires terms used in claims to be ascertainable by reference to the description section of the patent specification.<sup>9</sup> However, the Federal Circuit has rarely cited § 1.75(d)(1) for any such proposition.

The integrity and fairness of the patent system would be strengthened if the U.S. Patent and Trademark Office (“USPTO”) required strict compliance with § 1.75(d)(1) prior to issuing a patent. Arguably, issued patent claims should not need a *Markman* hearing because the meaning of the terms in the claim should be ascertainable by reference to the description in the patent.

The second paragraph of 35 U.S.C. § 112, ¶ 2 requires the specification of a patent to “conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”<sup>10</sup> The Federal Circuit has held that “[t]he test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification.”<sup>11</sup> Thus, any claim read in light of the specification that does not apprise those skilled in the art of the scope of that claim is invalid under § 112, ¶ 2. When claims are read in light of the specification, the meaning of the terms used in each should be sufficiently apparent to apprise those skilled in the art of the scope of a given claim. Therefore, issued patent claims, which presumably conform with § 112, ¶ 2, should never require a *Markman* hearing—theoretically.

In their specifications, patent applicants should be required to provide clear support for the terms used in their claims so the meanings of those terms are ascertainable by reference to the application’s written description. According to the Federal Circuit, the intrinsic record for claim construction includes not only the claims, but also the patent’s specification and prosecution history.<sup>12</sup> The Federal Circuit also has held that the claims are not limited to the preferred embodiment(s) disclosed in the detailed description.<sup>13</sup> To avoid being limited to what they specifically disclose, patent applicants can simply draft dependent claims that are broader than their preferred embodiment(s). Regardless, patent applicants are presumably not limited to the preferred embodiment(s). The discussions in the following sections exemplify how requiring strict compliance with 35 U.S.C. § 112, ¶ 2 and 37 C.F.R. § 1.75(d) prior to patent issuance would have eliminated the need for a *Markman* hearing in three seminal Federal Circuit cases.

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<sup>8</sup> 37 C.F.R. § 1.75(d)(1) (2004).

<sup>9</sup> See *Tandon Corp. v. U.S. Int’l Trade Comm’n*, 831 F.2d 1017, 1024 (Fed. Cir. 1987).

<sup>10</sup> 35 U.S.C. § 112, ¶ 2. The second paragraph of § 112 is known as the “definiteness” requirement. See *Miles Labs., Inc. v. Shandon, Inc.*, 997 F.2d 870, 875 (Fed. Cir. 1993).

<sup>11</sup> *Id.*; accord *SmithKline Beecham Corp. v. Apotex Corp.*, 365 F.3d 1306, 1314 (Fed. Cir. 2004) (stating that in order “[t]o satisfy [the] requirement [of § 112, ¶ 2], the claim, read in light of the specification, must apprise those skilled in the art of the scope of the claim”).

<sup>12</sup> See *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

<sup>13</sup> See *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344 (Fed. Cir. 2001).

A. *Case Study One*: Markman v. Westview Instruments, Inc.

In *Markman*, the patent at issue was entitled “Inventory Control and Reporting System for Drycleaning Stores.”<sup>14</sup> The district court instructed the jury to determine the meaning of the claims as understood by those of ordinary skill in the art using the relevant patent documents, including the specification, the drawings and the file history, and then compare the claims with the accused device to determine if there was infringement.<sup>15</sup> After a jury verdict of infringement, the district court granted the defendant’s motion for judgment as a matter of law.<sup>16</sup> The district court found that the claim term “inventory” meant “articles of clothing” and not simply “transaction totals” or “dollars.”<sup>17</sup> The district court also found that the accused devices did not have the claimed “means to maintain an inventory total.”<sup>18</sup> The Federal Circuit affirmed after finding that the claims, the specification and the prosecution history all supported an interpretation of the term “inventory” as “articles of clothing.”<sup>19</sup>

If the patent applicant had expressly defined “inventory” in his specification as “articles of clothing,” then the patentee’s suit, if he had even filed one, could have easily and quickly been resolved on summary judgment. Thus, the patentee clearly would have benefited by expressly defining “inventory” in his specification. Specifically, the patentee would have known, prior to filing his application, exactly what this claim term would be construed to mean. He could have expressly stated a broad definition of “inventory” in his specification prior to filing his application. If the patentee had opted not to broaden his express definition of the term “inventory” at the time of filing the application, then he would have known from the start that he could not prevail against infringers by alleging a broader definition. In either circumstance, the patentee would have saved both the time and the expense incurred in litigating the claim construction issue.

B. *Case Study Two*: Vitronics Corp. v. Conceptoronic, Inc.

In *Vitronics*, the district court entered a judgment as a matter of law, stating that Vitronics had not proven infringement because the disputed claim term “solder reflow temperature,” as used in claim one, referred to 183°C, which, as alleged by Conceptoronic, was the “liquidus temperature of a particular type of solder known as 63/37 (Sn/Pb) solder” (one of three exemplary types of solders in the specification).<sup>20</sup> The Federal Circuit reversed after finding that the disputed claim term actually meant “peak reflow temperature” and not “liquidus temperature.”<sup>21</sup> The Federal Circuit noted that the specification clearly defined “peak reflow temperature” and

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<sup>14</sup> Markman v. Westview Instruments, Inc., 52 F.3d 967, 971 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370 (1996).

<sup>15</sup> *Markman*, 52 F.3d at 973.

<sup>16</sup> *Id.*

<sup>17</sup> *Id.*

<sup>18</sup> *Id.*

<sup>19</sup> *Id.* at 981–82, 988–89.

<sup>20</sup> Vitronics Corp. v. Conceptoronic, Inc., 90 F.3d 1576, 1580 (Fed. Cir. 1996).

<sup>21</sup> *Id.* at 1583.

“liquidus temperature” differently.<sup>22</sup> Furthermore, in order to be consistent with the specification and the preferred embodiment described therein, the Federal Circuit construed the term to mean “peak reflow temperature.”<sup>23</sup> Had the Federal Circuit’s interpretation been otherwise the preferred—and indeed only—embodiment in the specification would not have fallen within the scope of the patent claim.<sup>24</sup>

If the patent applicant had expressly defined the term “solder reflow temperature” in his specification as the “peak reflow temperature,” the defendant could not have alleged that the term meant otherwise. The patentee clearly would have benefited from this additional definition since it would have prevented litigation over the meaning of the term. In addition, the defendant would have been aware that the term actually meant “peak reflow temperature.” Thus, the defendant could have more efficiently resolved the matter by practicing the prior art, agreeing to take a license from the patentee, developing a non-infringing method or locating prior art that invalidated the patent claims—all with a confident understanding of the scope and meaning of the patentee’s patent claims.

### C. Case Study Three: Texas Digital Systems, Inc. v. Telegenix, Inc.

In *Texas Digital*, the district court held the claimed phrase “repeatedly substantially simultaneously activating” meant “that during some portion of this period (defined as repeatedly), the two separate lights are on at the same time.”<sup>25</sup> The Federal Circuit found the district court correctly construed the term “repeatedly” but erred in its construction of the phrase as a whole and ignored the meaning of the term “activating.” Apparently, the patent specification was of little help, so the Federal Circuit considered a “relevant technical dictionary” to determine the meaning of the word “activate.” The Federal Circuit stated the intrinsic evidence was “entirely consistent with the dictionary definition,” but failed to elaborate.<sup>26</sup> The Federal Circuit held the meaning of the “phrase requires that during some portion of the period defined as ‘repeatedly,’ the two separate lights are turned on at the same or nearly the same time.”<sup>27</sup>

If the patentee had expressly defined the term “activating” in the specification, then a dispute over the meaning of this claim term could have been avoided. Similarly, had the patentee expressly defined the other claim terms in the specification, disputes over the meaning of these other claim terms could have been avoided. Moreover, the patentee could have broadened the definition of the claim terms in the specification prior to filing the application. However, even if the patentee had opted not to broaden the express definition of the claim terms prior to filing the application, at least it would have known that it could not prevail against purported infringers by alleging broader definitions.

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<sup>22</sup> *Id.*

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

<sup>24</sup> *Id.*

<sup>25</sup> *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, No. 3:98-CV-1537-BF, 2000 WL 1801849, at \*5 (N.D. Tex. Dec. 6, 2000).

<sup>26</sup> *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1206 (Fed. Cir. 2002).

<sup>27</sup> *Id.*

II. REQUIRE APPLICANTS TO IDENTIFY WHICH CLAIM TERMS ARE “MEANS-PLUS-FUNCTION” ELEMENTS AND IDENTIFY THE CORRESPONDING STRUCTURE FOR PERFORMING EACH SPECIFIED FUNCTION

Section 112, ¶ 6 allows patent applicants, if they wish, to express a claim element “as a means or step for performing a specified function, without the recital of structure, material, or acts in support thereof and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”<sup>28</sup> There have been a number of cases where the issue revolved around a means-plus-function element. The use of “means for” language creates a rebuttable presumption that the claim term is a means-plus-function element.<sup>29</sup> In the absence of such language, no presumption exists.<sup>30</sup> Two other issues which are sometimes litigated include determinations of the specified function of the claim, and the corresponding structure, material or acts for performing that specified function.<sup>31</sup> Litigation surrounding these issues will continue unless they are resolved during patent prosecution, prior to issuance.

If the patent applicant chooses to express a claim element “as a means or step for performing a specified function without recital of structure, material, or acts in support thereof,” it is only fair that the applicant specifically declare during prosecution which claim elements are “means-plus-function” elements. Moreover, the applicant should be required to identify the specified function, as well as the corresponding structure, material or acts for performing that function. With this clear identification, the USPTO can properly examine the claims. Furthermore, only with this clear identification can the above three issues be resolved and uncertainty removed at the proper stage and at the proper time: during prosecution, prior to issuance. The following cases exemplify litigated issues that could have been avoided if patent applicants were required to declare during prosecution which claim terms were “means-plus-function” elements and, as such, identify the specified function and corresponding structure, material or acts for performing that function.

A. *Case Study One*: Greenberg v. Ethicon Endo-Surgery, Inc.

In *Greenberg*, the district court construed the term “detent mechanism” to be a means-plus-function element.<sup>32</sup> The district court then granted the defendant’s motion for summary judgment of non-infringement after finding the defendant’s accused structure for performing the function was not structurally equivalent to the detent mechanism disclosed in the patent.<sup>33</sup>

The district court gave two principal reasons to support its ruling. First, the court concluded that “detent mechanism” in itself invoked [§112, ¶ 6],

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<sup>28</sup> 35 U.S.C. § 112, ¶ 6 (2000).

<sup>29</sup> *See, e.g.*, Personalized Media Communications LLC v. Int’l Trade Comm’n, 161 F.3d 696, 703 (Fed. Cir. 1998).

<sup>30</sup> *See id.*

<sup>31</sup> Cardiac Pacemakers Inc. v. St. Jude Med., Inc., 296 F.3d 1106, 1113 (Fed. Cir. 2002).

<sup>32</sup> Greenberg v. Ethicon Endo-Surgery, Inc., 91 F.3d 1580, 1582, (Fed. Cir. 1996).

<sup>33</sup> *Id.*



because the term did not describe a particular structure but described any structure that performed a detent function. The court noted that both the dictionary definition of the word “detent” (*i.e.*, “a device for positioning and holding one mechanical part in relation to another”) and the definition of “detent mechanism” provided by [the plaintiff’s] expert (*i.e.*, “[a]ny device for positioning and holding one mechanical part in relation to another so that the device can be released by force applied to one of the parts”) were expressed in functional terms.

In addition, the district court reasoned that although claim 1 of the . . . patent employed the term “detent mechanism,” the summary of the invention twice used “detent means” when referring to the detent that defined the rotation of the shafts at predetermined intervals, and that the two terms should therefore be viewed as synonymous, at least as used in the . . . patent. Thus, the court concluded that the term “detent mechanism” was equivalent to “means for,” and the phrase “defining the conjoint rotation of said shafts in predetermined intervals” stated the function performed by the means.<sup>34</sup>

The Federal Circuit reversed, holding that the factors upon which the district court relied did not justify treating the claim language as falling within the purview of § 112, ¶ 6.<sup>35</sup> The Federal Circuit noted that the fact a particular mechanism—the “detent mechanism”—was defined in functional terms is not sufficient to convert a claim element containing that term into a “means for performing a specified function” within the meaning of section § 112, ¶ 6.<sup>36</sup> The Federal Circuit also found various dictionary definitions to clarify that a “detent” is a type of device with a generally understood meaning in the mechanical arts—despite the fact the definition was expressed within the patent in functional terms.<sup>37</sup> The Federal Circuit stated while the noun “detent” does not call to mind a single, well-defined structure, the same could be said of other commonplace structural terms, such as “clamp” or “container.”<sup>38</sup> The Federal Circuit concluded that a function-focused definition of a “detent” or “detent mechanism” was not as important as the term’s well understood meaning in the art.<sup>39</sup>

Additionally, the Federal Circuit did

not agree with the district court that the term “detent mechanism” . . . should be treated as synonymous with the term “detent means” simply because the patent use[d] the term “detent means” in place of “detent mechanism” on two occasions in the “summary of the invention” portion of the specification.<sup>40</sup>

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<sup>34</sup> *Id.* at 1583.

<sup>35</sup> *Id.* at 1583–84.

<sup>36</sup> *Id.*

<sup>37</sup> *Id.* at 1583.

<sup>38</sup> *Id.*

<sup>39</sup> *Id.*

<sup>40</sup> *Id.*

The Federal Circuit reasoned simply that “[t]he drafter of the application that matured into the . . . patent appear[ed] to have been enamored of the word ‘means,’ as the word [was] used repeatedly in the summary of the invention.”<sup>41</sup> Indeed, the court found that “[a] close reading of the specification reveal[ed] . . . that the term [was] used in that portion of the patent simply as a shorthand way of referring to each of the key structural elements of the invention.”<sup>42</sup> Furthermore, the court noted that “each of those elements [was] subsequently described in detail, without the use of the term ‘means,’ in the ‘description of the invention’ portion of the specification, and each [was] subsequently claimed, . . . without the use of the term ‘means,’ in claim 1 of the patent.”<sup>43</sup>

The Federal Circuit clarified that its decision did not suggest that § 112, ¶ 6 is triggered only if the claim uses the word “means.”<sup>44</sup> In addition, the Federal Circuit stated its agreement on the matter with the USPTO, which previously had “rejected the argument that only the term ‘means’ will invoke [§ 112, ¶ 6].”<sup>45</sup>

If the patent applicant had been required to identify during prosecution whether any of the claim terms were meant to be “means-plus-function” limitations, it would have been forced to expressly clarify that the answer was “no.” In that instance, the issue would have been resolved prior to the patent’s issuance, rather than on appeal. The patentee would have benefited because an appeal would not have been necessary. In addition, the defendant would have been able to attempt to resolve the dispute on a basis other than an uncertain claim interpretation that ultimately proved to be wrong as a matter of law.

*B. Case Study Two: Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*

In *Cardiac Pacemakers*, the district court concluded—four years after suit was filed—that the claims could not be construed “because no structure in the disclosed embodiments perform[ed] the functions as stated in the [sole independent] claim.”<sup>46</sup> The parties stipulated that under the district court’s claim construction, the claims were invalid.<sup>47</sup> As such, the district court entered summary judgment that the claims were indefinite for failure to comply with § 112, ¶ 2.<sup>48</sup> The Federal Circuit affirmed, stating:

Cardiac Pacemakers’ attempts to identify structure corresponding to the function of the “third monitoring means” limitation are in vain. . . . [T]he function identified by the claim language is dual: it requires the same means to monitor the ECG signal and to activate the charging means in the presence of abnormal cardiac rhythm. Because only the physician both

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<sup>41</sup> *Id.* at 1583–84.

<sup>42</sup> *Id.* at 1584.

<sup>43</sup> *Id.*

<sup>44</sup> *Id.*

<sup>45</sup> *Id.*

<sup>46</sup> *Cardiac Pacemakers, Inc., v. St. Jude Med., Inc.*, 296 F.3d 1106, 1112 (Fed. Cir. 2002) (second alteration in original).

<sup>47</sup> *Id.*

<sup>48</sup> *Id.*

monitors the ECG signal and activates the charging means in the presence of abnormal cardiac rhythm, and Cardiac Pacemakers concedes that the physician cannot be corresponding structure, the specification discloses no structure that corresponds to the claimed function. This renders the claim, and the claims depending from it, invalid for indefiniteness. This is so notwithstanding the presumption of validity, and the issuance of dependent claim 15, in which the “third monitoring means” includes a display. Although it remains true that we will construe claims to preserve validity, if possible where the specification fails to disclose structure corresponding to the claimed function, it is impossible. As in this case, the claims are invalid.<sup>49</sup>

Here, the patent applicant clearly would have benefited from the proposed requirement of identifying whether any of the claim terms were “means-plus-function” limitations at the time the original claims were presented to the USPTO. Specifically, the applicant would have realized that there was no corresponding structure in the original application. As a result, the applicant could have avoided the time and expense of filing the patent application. Alternately, the applicant could have corrected the matter prior to filing. Finally, the applicant would have avoided losing the time and money necessary to conduct both trial litigation and his ultimately unsuccessful appeal of an adverse district court decision.

### III. REQUIRE APPLICANTS TO PROVIDE THE MEANING OF THEIR KEY ORIGINAL CLAIM TERMS AT THE TIME THE PATENT APPLICATION IS FILED, & ANY NEW TERMS IN THE INSERTED CLAIMS DURING PROSECUTION

Since the patent applicant can choose which words to use in the claims to particularly point out and distinctly claim the invention, it seems fair to require the applicant to provide the specific meaning of key claim terms at the time the applicant presents each term to the USPTO. The applicant can accomplish this by simply using a dictionary or by being her own lexicographer.<sup>50</sup>

One commentator has proposed the requirement of a “dictionary preference,” selected either by the patent examiner or applicant, in the prosecution history of the patent.<sup>51</sup> Such a preference would provide a default source used to resolve questions about the meaning of claim terms.<sup>52</sup> Although this proposal is a step in the right direction, it does not account for instances when a single dictionary may have multiple definitions for the same word. Nor does this proposal account for how words in combination should be construed. Further, the reliance on a single dictionary to resolve questions about the meaning of claim terms may not be appropriate in all cases.

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<sup>49</sup> *Id.* at 1114 (citations omitted).

<sup>50</sup> See *Vitronics Corp. v. Conceptiontronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

<sup>51</sup> See Eric Yeager, *Professor Calls for Dictionary Preference to be put on Prosecution Record*, 67, No. 1665 Pat. Trademark & Copyright J. (BNA) 506 (Apr. 2, 2004) (discussing comments made by Assistant Professor Joseph Scott Miller of Lewis and Clark Law School in a lecture delivered at George Washington University Law School on March 25, 2004).

<sup>52</sup> *Id.*

A more balanced and fair proposal is to require applicants to define their claim terms either by specifically reciting a dictionary definition of the applicant's own choosing or providing alternative, synonymous language to serve the same function. The definitions chosen by an applicant can and should appear just prior to the claims in the issued patent.

As stated in Section I, strict compliance with 35 U.S.C. § 112, ¶ 2 and 37 C.F.R. § 1.75(d)(1) prior to patent issuance likely would have eliminated the need for a *Markman* hearing in three seminal Federal Circuit cases: *Markman*, *Vitronics* and *Texas Digital*. To ensure vigilant compliance with both of those provisions, patent applicants should be required to provide the meaning given to key claim terms at the time each claim is presented to the USPTO. In addition, such a requirement should serve as a condition precedent to patent issuance.

#### IV. CONCLUSION

To reduce the uncertainty as to the scope and meaning of patent claims, and to truly comply with 35 U.S.C. § 112, ¶ 2 and 37 C.F.R. § 1.75(d)(1), the USPTO should be more vigilant in enforcing the requirement that applicants provide a description in their specifications so that the meanings of the terms used in the claims are readily ascertainable. The USPTO can best implement this proposal by adopting appropriate rules requiring applicants to provide the meaning of each key claim term at the time each claim is presented to the USPTO. Moreover, those definitions should appear just prior to the claims in the patent. Applicants can comply with this standard by simply reciting dictionary definitions of the applicants' own choosing or by acting as lexicographers and defining the terms themselves.

To further reduce the uncertainty as to scope and meaning of claim terms in connection with 35 U.S.C. § 112, ¶ 6, patent applicants should be required to declare during patent prosecution which claim elements are "means-plus-function" elements. In addition, applicants should be required to expressly identify the corresponding structure, material or acts for performing the specified function.

To eliminate most, if not all, questions on the scope and meaning of claim terms, applicants should be required during patent prosecution to define their claim terms with alternative, synonymous wording—something that they would likely have to do anyway in a *Markman* hearing.