

# Patent Claim Construction: The Neglected Preamble



By Shawn Kolitch

Kolisch - Hartwell

shawn@kolisch-hartwell.com

Patent infringement analysis involves two steps: claim construction, followed by a comparison of the accused product to the properly construed claim.<sup>1</sup> In the first step of the infringement analysis, which is exclusively a matter of law for the court, each asserted claim is construed to determine its scope and meaning.<sup>2</sup> In the second step of the infringement analysis, a fact finder compares each properly construed claim to the accused device, to determine whether all of the claim limitations are present in that device, either literally or by a substantial equivalent.<sup>3</sup>

The claim construction step is crucial, as it determines the scope of each claim for the subsequent comparison. Therefore, the parties in patent litigation often dispute the construction of each claim at issue, and courts construe the claims to resolve those disputes and to assign a fixed, unambiguous, legally operative meaning to the claims.<sup>4</sup> Ideally, a patent practitioner will consider the future construction of the claims when drafting them, to provide support for a construction that broadly captures the subject matter of the invention, while still remaining valid over the prior art. One aspect of claim construction that only occasionally becomes important, and that therefore is often neglected by the claim drafter, is construction of the preamble to a claim. This article first reviews some general principles of claim construction, and then focuses on the current legal status of claim preamble construction.

## I. General Principles Of Claim Construction

Claims generally are given their plain and customary meanings “to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application.”<sup>5</sup> “The person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears,” but in the context of the entire patent record, including the other claims, the specification, and the prosecution history.<sup>6</sup>

In construing claims, courts look first and primarily to “intrinsic evidence” of claim term meaning, which as described above includes the claims themselves, the specification and the prosecution history.<sup>7</sup> “Extrinsic evidence,” on the other hand, is evidence that is external to the patent and its prosecution history, such as expert testimony, inventor testimony, dictionaries, and technical treatises and articles.<sup>8</sup> Although courts may look to extrinsic evidence, the recent en banc Federal Circuit decision in *Phillips v. AWH Corporation* warns that such evidence can be “less reliable” than intrinsic evidence, and ultimately must be considered in the context of the patent itself.<sup>9</sup>

### A. Claim Language

With regard to particular words and phrases, the analytical focus of claim construction must begin with the language of the claims themselves.<sup>10</sup> As noted above, in the absence of an express attempt to impart a novel meaning to the claim terms, the words of the claim are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art.<sup>11</sup>

### B. Specification

Next, and particularly in light of *Phillips*, the court should “rely heavily” on the written description, or specification, of the patent at issue for guidance as to the meaning of its claims.<sup>12</sup> As the Federal Circuit has emphasized, the specification “is the single best guide to the meaning of a disputed term” and is “usually dispositive.”<sup>13</sup> In light of the directive of 35 U.S.C. § 112(1) that the inventor provide a “full” and “exact” description of the claimed invention, the specification necessarily informs the proper construction of the claims.<sup>14</sup> As the *Phillips* court stated,

[O]ur cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor’s lexicography governs. In other cases, the specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor. In that instance as well, the inventor has dictated the correct claim scope, and the inventor’s intention, as expressed in the specification, is regarded as dispositive.<sup>15</sup>

In addition to the written description, courts also may look to patent drawings showing the physical relationship between components, particularly where the language of the specification agrees with the drawing.<sup>16</sup>

### C. Prosecution History

The prosecution history is the “undisputed public record” of the patentee’s proceedings in the Patent and Trademark Office (PTO), and is “of primary significance in understanding the claims,” once the court has considered the claims in the light of the specification.<sup>17</sup> Claim meaning may be restricted by prior art cited by the PTO in an Office action rejecting the originally filed claims, or by amendments made during prosecution to overcome a rejection.<sup>18</sup> Furthermore, “where the patentee has unequivocally disavowed a certain meaning to obtain his patent, the doctrine of prosecution disclaimer attaches and narrows the ordinary meaning of the claim congruent with the scope of the surrender.”<sup>19</sup>

### D. Extrinsic Evidence

“In most situations, an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term.”<sup>20</sup> In such cases, reliance on any extrinsic evidence is improper.<sup>21</sup> In *Phillips*, the Federal Circuit stated that courts must not look to extrinsic sources such as dictionaries, treatises, and encyclopedias before consulting the claims, specification and prosecution history.<sup>22</sup> Although judges are free to consult dictionaries and technical treatises at any time for assistance in better understanding the underlying technology, and also may rely on dictionary definitions to help determine the plain and ordinary meaning of a term, dictionary definitions relied upon in this manner must not contradict any definition found in or ascertained by a reading of the patent documents.<sup>23</sup>

## II. Claim Preamble Limitations

A patent claim generally includes a preamble to the claim, and, following the preamble, a body of the claim. The preamble typically introduces the subject matter of the claim, and may also describe the intended purpose of the invention. The body of the claim includes the specific elements of the invention, also commonly known as the claim limitations. The exact scope of these limitations is crucial, because an accused product only infringes the claim if it includes all of the claim limitations, either literally or under the doctrine of equivalents. Ordinarily, the preamble is viewed merely as a statement of purpose, in which case it does not have a limiting effect on the claim, and plays essentially no role in an infringement analysis.

However, in rare cases, the preamble may be viewed as a claim limitation.

The Federal Circuit has held that the inventor’s intent is the crucial factor in determining whether or not a claim preamble should be given a limiting effect during claim construction. In keeping with the general principles of claim construction, this intent should be determined through a review of the patent record as a whole. As the court stated in *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, whether a preamble recitation is a limitation or just a statement of purpose “can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.”<sup>24</sup> Thus, to determine the inventor’s intent, a court may review the claims, specification, drawings, and prosecution history.<sup>25</sup>

In examining the patent record to determine if the inventor intended the preamble to have a limiting effect, the Federal Circuit has held that “a preamble limits the invention if it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim. Conversely, a preamble is not limiting where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.”<sup>26</sup> In deciding whether a preamble term is “necessary to give life, meaning, and vitality to the claim,” a court may consider a number of factors, including 1) the overall claim structure, 2) whether the claim would be understandable in the absence of the preamble term at issue, 3) the use of the term as antecedent basis for subsequent limitations in the claims, and 4) the prevalence of the term in describing the invention throughout the application.

### A. Overall Claim Structure

Claims may be written in a form implying that the preamble includes claim limitations. In *Rowe*, for example, the Court found the preamble term “angioplasty” to be a structural limitation of the claims, based primarily on the applicant’s use of the Jepson claim form, including “angioplasty” in the preamble, “to recite elements or steps of the claimed invention which are conventional or known.”<sup>27</sup> In other words, if an invention is claimed as an improvement over the prior art, and the preamble term at issue is a limitation common to the prior art, the term may be construed as a limitation to the improvement.

### B. Logical Necessity of Preamble Term

If a preamble term is not necessary to understand the body of the claim, it is less likely to be found limiting.

*continued on page 12*

For example, in the successor case to *Catalina I*, the Court found a claim preamble not limiting because its purpose was “not to give any information that is indispensable to understanding the invention recited by [the] claim.”<sup>28</sup> Further, the Court in *Catalina II* stated that to be limiting, the preamble would have to offer “details, structure or description that would aid one of skill in the art in understanding what is being covered by the limitations of [the] claim.”<sup>29</sup> Therefore, if a person of skill in the art could understand the claim in the absence of the preamble term at issue, the term is less likely to be construed as a limitation.

### C. Antecedent Basis

The subsequent occurrence of a preamble term in the claims is another indicator as to whether the inventor intended the preamble to be limiting. For example, the Court in *Pitney Bowes, Inc. v. Hewlett-Packard Company* held that the preamble term “producing on a photoreceptor an image of generated shapes made up of spots” limited the construction of “spots” in the claims, because both “spots” and “generated shapes” subsequently occurred in the claim in a manner that relied on reference to the preamble for antecedent basis.<sup>30</sup> Thus, a term used in a claim preamble to provide antecedent basis for subsequent claim limitations is more likely to be considered a limiting part of the invention than a preamble term that does not also appear in the body of the claim.

### D. Prevalence of Preamble Term

Repeated use of a preamble term to describe the invention throughout a patent specification weighs in favor of the term being construed as a claim limitation. For example, the Court in *Poly-America v. GSE Lining Technology* held that the preamble term “blown-film” was a limitation of the claims, because “[t]he specification is replete with references to the invention as a ‘blown-film’ liner, including the title of the patent itself and the ‘Summary of the Invention,’” and because “the entire preamble ‘blown-film textured liner’ is restated in each of the patent’s seven claims.”<sup>31</sup> Thus, a preamble term appearing throughout the patent application as an important or indispensable element of the invention will likely be construed as a claim limitation.

## III. Conclusion

As every patent practitioner knows, claim drafting is something of an art. The drafter must not only capture the useful, novel, and nonobvious features of an invention as clearly and broadly as possible, but also must anticipate

how the claims might be construed up to 26 years later.<sup>32</sup> As the cases cited above indicate, even the preamble must be carefully crafted. To avoid giving the claim preamble a limiting effect, the patent as a whole should reflect a lack of intent to do so. This can be accomplished by avoiding the Jepson claim form, by ensuring that the body of the claim is sufficiently self-contained to be comprehensible without the preamble, by providing antecedent basis to the claim limitations from within the body of the claim, and by avoiding characterizing the preamble terms within the specification as indispensable elements of the invention.

### Endnotes

- 1 *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370 (1996).
- 2 *Markman*, 52 F.3d at 979; *see also Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1581–82 (Fed. Cir. 1996).
- 3 *Renishaw PLC v. Marposs Societa’ Per Azioni*, 158 F.3d 1243, 1247–48 (Fed. Cir. 1998).
- 4 *See Vitronics*, 90 F.3d at 1582.
- 5 *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc), *citing Innova /Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, 381 F.3d 1111 (Fed. Cir. 2004).
- 6 *Phillips*, 415 F.3d at 1313.
- 7 *Vitronics*, 90 F.3d at 1582.
- 8 *Id.* at 1584.
- 9 *Phillips*, 415 F.3d at 1318.
- 10 *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003).
- 11 *Id.*; *see also Texas Digital Sys. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002).
- 12 *Phillips*, 415 F.3d at 1316–17.
- 13 *Vitronics*, 90 F.3d at 1582.
- 14 *Phillips*, 415 F.3d at 1311–12.
- 15 *Id.* at 1316 (internal citations omitted).
- 16 *See Cross Med. Prod., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1306 (Fed. Cir. 2005) (patent drawings showed that anchor and bone were in contact, a relationship consistent with the specification).
- 17 *Markman*, 52 F.3d at 980.
- 18 *Autogiro Co. of Am. v. United States*, 181 Ct. Cl. 55, 65 (1967) (“In its broader use as source material, the prior art cited in the file wrapper gives clues as to what the claims do not cover”); *Liquid Dynamics Corp. v. Vaughan Co.*, 355 F.3d 1361, 1368 (Fed. Cir. 2004).
- 19 *Omega Engr., Inc. v. Raytek Corp.*, 334 F.3d 1314, 1324 (Fed. Cir. 2003).
- 20 *Vitronics*, 90 F.3d at 1583.
- 21 *Id.*
- 22 *Phillips*, 415 F.3d at 1320–21.
- 23 *Id.* at 1322–23.
- 24 868 F.2d 1251, 1257 (Fed. Cir. 1989).
- 25 *See Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997) (citing cases in which the court looked at various

- elements of the record to determine if a claim preamble was intended to limit the claim).
- 26 *Catalina Mktg. Intl. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) ("*Catalina I*") (internal citations omitted).
- 27 *Rowe*, 112 F.3d at 479 (internal quotations and citations omitted).
- 28 *Catalina Mktg. Intl. v. Coolsavings.com, Inc.*, 115 Fed. Appx. 84, 90 (Fed. Cir. 2004) ("*Catalina II*").
- 29 *Id.*
- 30 182 F.3d 1298, 1306 (Fed. Cir. 1999).
- 31 383 F.3d 1303, 1310 (Fed. Cir. 2004).
- 32 This is the case because infringement damages may be recovered for up to six years prior to filing a complaint alleging infringement. 35 U.S.C. § 286 (2006). Thus, since a patent is valid from its date of issue to a date 20 years from the filing date of the associated application, 35 U.S.C. § 154 (2006), a complaint may be filed up to 26 years after a patent application is filed, and still include a claim for patent damages.

## Letter From the Editor



By Greg Touchton

3L, Lewis & Clark Law School  
touchton@lclark.edu

With the previous issue of the Oregon Intellectual Property Newsletter, we began a shift from Fall-Spring publication to a Winter-Summer schedule.

We have found that this schedule allows us to be more true to the listed date of the newsletter and expected issue dates. We are pleased to have several understanding submitters who were willing to work with us to meet our deadlines for this Summer issue.

Our Winter issue was well acclaimed by our readers both within and beyond the Oregon Bar. The praise was particularly drawn to the thematic nature of the newsletter along with the contemporary applicability of many of the articles. We expect to continue a focused Winter issue along with a generally applicable Summer issue of the newsletter.

This following the Winter issue, our Summer staff consisted of exuberant and diligent editors to contribute to the newsletter. I am pleased to announce that we had more volunteer editors than we could feasibly use to edit our submissions. We hope that the expansion of student interests in intellectual property will allow us to branch out into the more interaction with the programs at Willamette College and the University of Oregon.

To submit a complete article, we have several law students interested in working with practitioners to develop material for the newsletter.

Although we have yet to decide a theme for the Winter newsletter, we are interested in exploring the

patenting and licensing issues related to both obviousness and the new version of the GPL. We look forward to our future submissions, and please do not hesitate to contact us.

This Fall we look forward to three Lewis & Clark Professors actively involved with the newsletter. We welcome back to teaching Prof. Lydia Loren after her time as interim dean. As always, Joe Miller has provided valuable insight into practitioner expectations and to changes in the law. I would like to take the time to highlight his blog particularly in its tracking of court cases interpreting the *KSR v. Teleflex* decision. In addition, we have had the benefit of the guidance of our copyright and international intellectual property focused professor, Tomás Gómez-Arostegui. We are lucky to have three great advisors.

In addition to our advisors, we depend on the submissions of Oregon practitioners and students in order to develop are newsletter. We have been happy to receive submissions from students and legal professionals of all walks. In addition, for those professionals without the time, we have several students interested in assisting with article research or production.

While we have yet to decide on a theme for our Winter issue, we are considering a few ideas which have been prevalent in the legal community. Continuing with last Winter's Open Source issue, we would love consideration of the new version of the GPL. Also, the ongoing elucidation of *KSR v. Teleflex* seems to figure prominently throughout the patent industry. As always we welcome your comments, suggestions, and submissions.