

Appellee's  
Supplemental  
Brief

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SUPPLEMENTAL BRIEF OF APPELLEES  
WESTVIEW INSTRUMENTS, INC. AND ALTHON ENTERPRISES, INC. FRANCIS X. GINDHART  
CLERK

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UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

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No. 92-1049

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HERBERT MARKMAN and POSITEK, INC.,

Plaintiffs-Appellants,

v.

WESTVIEW INSTRUMENTS, INC. and  
ALTHON ENTERPRISES, INC.,

Defendants-Appellees

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APPEAL FROM A DECISION OF THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF PENNSYLVANIA IN NO. 91-CA-0940  
ENTERED OCTOBER 1, 1991  
FROM JUDGE MARVIN KATZ

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March 14, 1994

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3. COUNTER-STATEMENT OF THE ISSUE

Was not the district court correct in granting Westview's motion under Rule 50 of the Federal Rules of Civil Procedure for a directed verdict in its favor where there was no dispute about any material fact and Westview was entitled to judgment as a matter of law?

## II. SUMMARY OF ARGUMENT RELATING TO ISSUES RAISED FOR IN BANC REVIEW

Additional briefing on four specific questions has been requested by this Court for in banc consideration. The following is a summary of the answers of appellees Westview Instruments, Inc. and Althon Enterprises, Inc. to these four questions.

### Question 1

Are disputes over the meaning of a term in a claim (a) issues of law to be decided on a documentary record similar to questions of statutory construction, or (b) are there some claim construction disputes that can only be resolved by resort to extrinsic evidence which requires the taking of factual and expert testimony?

### Answer

A dispute over the meaning of a term in a claim is an issue of law that in most cases should be decided on the documentary record consisting of the specification and prosecution history. If the claim contains terms that are familiar to those skilled in the art but unfamiliar to the trial judge, then the court, in its discretion, may hear testimony as an aid to construction.

### Question 2

If factual or expert testimony is proffered to resolve a particular dispute, what are the respective roles of the trial judge and jury?

Answer

When a court receives factual or expert testimony as an aid to claim interpretation, the judge must then determine if a genuine ambiguity exists. If there is no true ambiguity, then the testimony is not evidence and should not be considered by the jury. A more difficult question arises in the rare case where the judge decides that a technical term is genuinely ambiguous. Appellees submit that any genuine ambiguities should be construed against the patentee as a matter of law.

Question 3

When a claim construction dispute is on appeal to this court, what is the standard of review this court should apply to the judgment below on the merits? With regard to permissible post-trial motions?

Answer

On appeal, this Court reviews claim construction de novo. With respect to a permissible post-trial motion, the trial court independently decides the meaning of a claim and then determines whether a reasonable jury could find that the accused product or process falls within the properly-interpreted claim.

Question 4

When the meaning of a claim term must be decided in the course of deciding the question of infringement, what are the respective roles of trial judge and jury?

Answer

The trial court should instruct the jury what the claim means as a matter of law. The jury should then determine any factual dispute relating to the elements and function of the accused product or process.



### III. COUNTER-STATEMENT OF THE CASE

#### A. Nature of the Case and Procedural History

This infringement case involves no genuine disputed issues of fact. The parties agree on the capabilities of the accused system, which can print and read bar-coded invoices for use in the drycleaning industry. The only issue presented at trial was whether the properly construed claims read on the accused system. The trial court correctly concluded that they did not.

This appeal is from the trial court's Order and Opinion granting Westview's motion for directed verdict. The trial court deferred ruling on the motion until after the jury gave contradictory answers to general interrogatories, finding that the accused system infringed claims 1 and 10 but not claim 14.<sup>1</sup>

The trial court then heard argument on the directed verdict motion and subsequently granted it. The trial court directed a verdict for defendants because it found, as a matter of law, that the patent-in-suit requires numerous elements and functions that the accused system does not possess. Although the district court waited to construe the patent claims until after the jury had performed a flawed claim construction, it then correctly construed the claim language as defining a system that: 1) can monitor and report upon the location of articles of clothing; 2)

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<sup>1</sup> It is undisputed that claim 14 is broader than claims 1 and 10. Consequently, the jury's general interrogatory answers made no sense.

can generate at least one report that reconciles the invoice number against the descriptions of articles of clothing; and 3) has at least one optical scanner connected to the data processor operable to detect bar codes on all articles of clothing that pass a predetermined, or fixed, station. The accused system cannot perform any of these tasks. Consequently, the district court's decision should be affirmed.

B. Counter-Statement of Facts

For the court's convenience, appellees have summarized the facts pertinent to this in banc proceeding. A more complete recital of the facts is contained in appellees' original brief.

1. Industry Background

For all their differences, the patent-in-suit and the accused system are both intended for use in the drycleaning industry. A brief summary of the typical operation of a drycleaning establishment may prove helpful to this Court in understanding the issues presented in this case.

As summarized in the specification of the patent-in-suit, the drycleaning process involves intermingling large numbers of clothes from different customers in one drycleaning machine. (A 48, col. 1, ln. 42-45). Each article of clothing is labelled with an article tag bearing a unique, sequential number. (A 48, col 2., ln. 5-9). The tags are used so that the customer's clothes can be reassembled in one batch at the end of the drycleaning process. (A 52, col. 9, ln. 41-46). The article tag

numbers are also written on the customer's invoice. (A 46, Fig. 2). After the clothes are cleaned, the individual articles are reassembled into the customer's original batch by matching the numbers on the article tags with the numbers on the invoice.

## 2. The Patent-in-Suit

The patent of plaintiff Herbert Markman claims an inventory control and reporting system, primarily for use in drycleaning stores. The system enables the drycleaner to identify, calculate and process costs of laundry articles to be cleaned, to print bar-coded records and tags for attachment to the laundry articles, to scan bar-coded tags on articles so as to monitor their location, and to generate reports based upon the information contained in the records and obtained by the scanner or scanners. (A 1014-22).

### a. Prosecution History

Markman's original application for his patent was rejected by the patent examiner for obviousness. (A 1571; 1655-56). To distinguish his claims over the prior art, Markman submitted amended claims. The patent, as amended by Markman, was issued by the United States Patent Office on October 29, 1985. (A 1014-22). The amendments contain limiting language that defines the boundaries of Markman's invention and distinguishes the patent from Westview's system. Amended claim 1, as granted by the patent examiner, is reproduced below. Language deleted from the original claim 1 is in brackets and language added to the

original claim 1 is underlined.

1. An inventory control and reporting system, comprising:

a data input device for manual operation by an attendant, the input device having switch means operable to encode information relating to sequential transactions, each of the transactions having articles associated therewith, said information including transaction identity and descriptions of each of said [a plurality of] articles associated with the transactions [a transaction];

a data processor including memory operable to record said information and means to maintain an inventory total, said data processor having means to associate sequential transactions with unique sequential indicia and to generate at least one report of said total and said transactions, the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another; [and,]

a dot matrix printer operable under control of the data processor to generate a written record of the indicia associated with sequential transactions, the written record including [comprising a plurality of] optically-detectable bar codes having a series of contrasting spaced bands, the bar codes being printed only in coincidence with each said transaction and at least part of the written record bearing a portion to be attached to [directly associated with] said articles; and,

at least one optical scanner connected to the data processor and operable to detect said bar codes on all articles passing a predetermined station,

whereby said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom.

(A 1661-62).



In 1987, spurred by a declaratory judgment action seeking to invalidate his patent, Markman applied for a reissue patent in which he sought to add two new claims. (A 1700-1702). In his application for the reissue patent, Markman stated that his original patent was invalid because he had claimed less than he had a right to claim. (A 1733-1734). The patent examiner initially rejected all of Markman's claims on the ground that his invention was known or used by others before Markman invented it. (A 2292-93). Upon reconsideration, the patent examiner issued United States Reissue Patent No. 33,054 ("the '054 patent" or "the patent-in-suit"), which retained all of the original claims and added two new claims, 14 and 15. (A 2329; A 1014-22; A 895-96). The two new claims were broader than the claims of the original patent. Claim 14 of the '054 patent stated:

An inventory control and reporting system,  
comprising:

a data input device having switch means for encoding information related to sequential transactions, each of the transactions having articles associated therewith, said information including transaction identity data and data relating to the transactions;

a data processor including memory operable for recording said information, means for generating an inventory report and means for associating sequential transactions with unique indicia sequentially assigned to the transactions and for generating at least one report of said transactions, the unique indicia and the data relating to the transactions being reconcilable against one another;

a printer operable under control of the data

processor to generate a written record for each of the sequential transactions, the written record including optically-detectable bar codes printed only in substantial coincidence with each said transaction and at least part of the written record bearing a portion to be attached to said articles; and,

at least one optical scanner for data communication with the data processor and operable to detect said bar codes on all articles passing a predetermined station.

(A 1022).

In this lawsuit, appellants have treated claim 1 like putty, pulling and pushing it to try to make it read on Westview's system. They ignore the simple truth that the patent-in-suit describes a system that is fundamentally different from the accused system in function, elements and purpose. With after-the-fact expert testimony, appellants have attempted to go far beyond the proper boundaries of the claim. They cannot alter the documentary evidence like a nose of wax. That immutable record damns their current interpretation as false.

3. The Purpose of the Invention Defined by the Patent-in-Suit

The patent-in-suit defines an invention intended to prevent attendants from losing or stealing clothes or processing undocumented clothes. Markman's remarks to the patent examiner explained the industry problem that his patent was intended to address:

As described in the specification, some basic difficulties with retail drycleaning establishments relate to the fact that attendants sometimes process undocumented

articles through the system and pocket the proceeds. Another difficulty is that the loss, misplacement or separation in process of even a single article of even relatively minor value will have a major impact on the customer's estimation of the quality of the establishment.

(A 1666-67).

To curtail the processing of undocumented articles and the loss or theft of even a single item of clothing, Markman's system, as defined by the '054 patent, tracks articles of clothing through the drycleaning process. The tracking of articles is accomplished by printing bar-coded article tags, attaching the tags to articles of clothing and scanning them at predetermined stations. There is no dispute that the accused system does not print article tags and that it does not track articles of clothing.

The function and purpose of the patent is apparent on its face. The patent specification describes Markman's invention as relating to "inventory control devices capable of monitoring and reporting upon the status, location and throughput of inventory in the establishment." (A 1017, col. 1, ln. 12-15). The last paragraph of claim 1 explains that "said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom." (A 1022, col. 11, ln. 9-11). The specification summarizes the function of the invention, stating that "the progress of articles through the laundry and drycleaning system can be completely monitored." (A 1017, col.

2, ln. 55-56).

The specification thus leaves no doubt that the system described by claim 1 must have the ability to track individual articles of clothing through the drycleaning process, to detect and localize missing and additional articles of clothing and to generate reports about the status and location of the individual articles of clothing.

During the trial and now on appeal, appellants deny their own invention. They complain that "the court's interpretation of the claim is contrary to the evidence.... 'Tracking' is not required." (Appellants' Supp. Mem. at 45). This assertion is flatly contradicted by the entire prosecution history. For example, Markman's application for the '054 patent contains the following comments about his claims:

The limitations which render the claims unnecessarily narrow over all known prior art, are:

1. Tracking of individual articles.

It may be argued that the claims are limited to a system that tracks individual articles such as individual pieces of clothing brought by a single customer to a drycleaning establishment or the like.... The claim language recites entry of "descriptions of each of said articles associated with the transactions." This passage is more limited than I had a right to claim because, although individual articles, e.g. a pair of pants, could be accounted for by marking, scanning and reconciliation in reports, the grouping of such articles into sets for tracking is reasonably disclosed as forming part of the invention and is allowable over the prior art.



(A 1734-35).

Appellants quibble over whether the patent-in-suit defines a system that tracks batches of articles or individual articles. Their whole argument, however, is moot because the accused system does not track clothing at all.

4. The DATAMARK/DATASCAN System

The accused system was invented and manufactured by defendant Westview Instruments, Inc. for use in the drycleaning business. The trial court described Westview's system as nothing more than "a rudimentary invoice printer, like a cash register." (Op. at 7; A 9). The following facts about the accused system are not in dispute.

The accused system consists of two devices -- the DATAMARK and the DATASCAN. (A 1058-1094; A 1587-1602). The DATAMARK prints bar coded invoices that contain information about the customer, the clothes to be cleaned and charges for cleaning. (A 1587-1602). The DATASCAN is a portable bar code reader containing a microprocessor. (A 714-15; A 722-29).

The DATASCAN reads bar codes on all invoices regardless of where they are located in the store. (A 918). First, the invoice list is transferred from the DATAMARK to the DATASCAN. (A 913). Next, the DATASCAN is carried through the store and used to read invoices wherever they are found. (A 918). The DATASCAN will then report any discrepancy between the invoice list it has received from the DATAMARK and the list of invoices

that it has actually read. (A 913).

In this way, DATAMARK detects extra or missing invoices. However, it cannot localize where those additions or deletions occurred because DATASCAN is portable and does not operate at a fixed, predetermined station. (A 918). While the accused system can compute the cash total, it has no ability to generate a report in which the article descriptions and the invoice numbers are reconcilable against one another. (A 912). In fact, the invoice itself is the only document the Westview system prints that contains article descriptions. (A 912).

Since the accused system does not retain article descriptions in its memory, it cannot track articles of clothing individually or in batches. To track articles of clothing, the DATAMARK would also have to print individual bar-coded tags for attachment to the articles. It does not. (A 931). The only bar-coded document that the DATAMARK prints is the invoice. Similarly, the DATAMARK stores the invoice numbers in memory but does not store descriptions of individual articles of clothing. (A 922). Since the DATAMARK does not tag individual articles or store information about them, it cannot detect deletions or additions of clothing as it passes through the drycleaning process. (A 918).

5. Appellants' Distortion of the Claim Language

Appellants have tried to distort the meaning of the claim language to encompass Westview's system, which does not identify

extra or missing clothing and does not generate any reports about articles. The only bar-coded document that the accused system prints is an invoice, and it can identify only missing or extra invoices. Like frustrated alchemists, appellants unsuccessfully try to change the meaning of three separate claim words so that they all suddenly become "invoices." Appellants now contend that spurious additions or deletions to "inventory" are spurious deletions and additions to invoices. (Appellants' Mem. at 15; A 722). They redefine the "report" that reconciles article descriptions against invoice numbers so that it too is an invoice. (A 768-69). Finally, they argue that the "tag" attached to the articles is an invoice. (Appellants' Mem. at 45; A 771).

Appellants are unable to cite one example of documentary evidence that supports their contention that the detection of spurious additions and deletions to inventory means the detection of extra and missing invoices. In fact, the specification and the prosecution history show the absurdity of their current argument. Consider the following remarks submitted in support of the amended patent:

Unlike the usual system in which apparatus generates non-unique indicia (e.g., Stewart's price indicia) and/or indicia that is not produced concurrently with the commencement of a transaction (e.g., pre-printed tags), applicant's system is operable to keep a running reconcilable inventory total by adding input articles and subtracting output articles, and also protect against the possibility of undocumented or spuriously-

documented articles entering the system  
(emphasis in original).

(A 1666).

The remarks also explain that in claim 1:

Means are also provided for reconciling the very same unique and concurrently-generated indicia at later points during processing whereby the entry or exit of inventory articles in irregular ways can be localized.

(A 1666).

One need not look beyond the patent specification to see clearly that the word "inventory," as used in the claim language, means articles of clothing and not invoices:

"[a] basic function of inventory control is the counting of incoming and outgoing materials" (A 1017, col. 1, ln. 19-20).

"The identity of specific articles must be monitored, making inventory control somewhat more complicated" (A 1017, col. 1, ln. 21-23).

"inventory control in connection with a laundry or retail establishment is assisted by use of automatically-scannable tags attached to articles of clothing." (A 1017, col. 1, ln. 66-68).

"Every transaction is recorded, including identification of the articles placed in inventory." (A 1019, col. 5, ln. 8-10).

"The best inventory control and management information reporting system has the ability to determine and report the current location of any given article in the inventory." (A 1019, col. 5, ln. 14-17).

"logging of inventory articles" (A 1019, col. 6, ln. 53-59).

"a problem which appears to occur randomly in the inventory (e.g., damage to garments)" (A



1019, col. 5, ln. 59).

"incoming articles to be placed in inventory are accumulated over a counter" (A 1019, col. 6, ln. 8).

"[I]ndividual article tags may be attached to items in inventory" (A 1020, col. 8, ln. 9-10).

Common sense also dictates that the phrase "detect and localize spurious additions to inventory as well as spurious deletions therefrom," must refer to clothing and not "dollars" or "invoices." First, there is no reason to "localize" dollars or invoices since dollars do not travel through the plant and the precise location of invoices within the plant is irrelevant. Only clothes need to be localized, because they can be lost, stolen or damaged at different points as they travel through the plant. Second, "spurious additions" and "spurious deletions" to inventory must also refer to clothing because dollars and invoices are only spuriously deleted. It is not a problem for the drycleaner if the attendant adds money to the till. Similarly, the other industry problem, as explained by Markman, is that undocumented clothing is processed, which presumes a deleted invoice, not an additional one.

Plaintiffs try to twist the ordinary meaning of the terms "tag" and "report" to make them mean "invoice." However, the specification demonstrates that the invoice, tags and the report are each separate documents. The specification distinguishes between tags and reports, stating: "the bar code tags are

attached to articles of clothing and are used with the scanning apparatus to facilitate generation of reports according to various management needs." (A 1014). The patent-in-suit also refers to "bar code records and tags," thereby differentiating tags from invoices. (A 1014). Additionally, Figure 2 of the specification (A 1015) clearly shows a multiple part record that includes an invoice (numbered 46 and referred to in the specification as "an establishment ticket copy" at A 1020, col. 7, ln. 44-45) and detachable tags (numbered 48 and referred to in the specification as "article tags" at A 1020, col. 7, ln. 46).

Finally, the specification states that the optical scanning station is used to reconcile inventory articles. (A 1021, col. 9, ln. 57-59). Inventory articles can be reconciled at an optical scanning station by reading tags attached to the articles. However, reading invoices with an optical scanner does not reconcile articles because it does not divulge any article-specific information. In sum, the specification shows that the patentee meant for his invention to print tags, invoices and reports as distinctly different documents. Moreover, the inventor admitted at trial that his system distinguished among tickets, reports and tags. (A 889).

Appellants contend that the DATASCAN, Westview's portable bar code reader, operates at a predetermined station. Of course, operating at a predetermined station defeats the entire purpose of a portable device. In fact, the testimony was that the user

of DATASCAN carried it to the different invoices and read them where they were found. (A 918). Furthermore, the DATASCAN is not connected to the DATAMARK when it is used to scan bar codes; yet, claim 1 requires that the scanner be connected to the data processor.

Plaintiffs claim that Westview's system has memory operable to record article descriptions and means to maintain an inventory total. In support of their argument, they rely on Westview's promotional literature, which states that before the ticket is printed, certain data (garment, color, fabric, and price) is "saved in DATAMARK memory and printed on the laundry/drycleaning ticket." (Appellants' Mem. at 31; A 1067).

But, plaintiffs fail to mention that article-specific information is kept in DATAMARK memory only until the ticket is totalled and printed. Once the ticket is finished printing, the DATAMARK has no memory of individual clothing descriptions. (A 921-22). Since it fails to maintain a database of article descriptions, the DATAMARK is unable to generate any reports containing article descriptions.

#### IV. ARGUMENT

##### A. This Case Was Correctly Decided by the Trial Court

This lawsuit provides a clear example of a trial judge who properly, albeit belatedly, fulfilled the judicial duty to interpret the meaning of terms in a patent claim in a case where

there was no underlying factual dispute. It also posts a warning as to the potential mischief that can be caused when a jury is allowed to hear partisan expert testimony concerning the meaning of patent claims, and then uses that testimony to construe the claims.

The jury's inability to construe the claims properly is readily apparent from its contradictory answers to general interrogatories. It is undisputed that claim 14 of the patent-in-suit is broader than claim 1. Indeed, claim 14 was specifically added to the reissue patent to expand claim 1. Yet, the jury determined that defendants had infringed claim 1, but not claim 14. Not even appellants can make sense of these answers.

After the jury returned its contradictory findings, the trial court considered Westview's motion for a directed verdict. To decide the motion, the trial court was required to construe the patent claims. The necessity of this requirement was made crystal clear here by the jury's nonsensical decision. Upon review of the specification, drawings and prosecution history, the trial court concluded that there was no genuine underlying issue of fact, and that, as a matter of law, the properly construed claims did not read on the accused system. Consequently, the trial court granted Westview's directed verdict motion.

Although this Court has suggested that claim interpretation



disputes may turn on underlying factual disputes, this is not such a case. Rather, the trial court correctly concluded that plaintiffs' artificial interpretation of several key claim words did not create a genuine issue of material fact. The trial court properly rejected the phony definitions of key words offered by the plaintiffs because:

These definitions are contrary to the ordinary and customary meaning of these terms, as well as the obvious meaning intended by the patentee, determined from the specifications, the drawings and the file histories of the original patent and the patent-in-suit.

(Op. at 3; A 5).

This, then, is an easy case for the court to decide. In a case where there is a genuine underlying factual dispute about the meaning of a scientific or technical term in the patent claim, difficult questions arise about the respective roles of judge and jury. However, where, as here, the specification and prosecution history all point to a single interpretation, there is no doubt that claim interpretation is a question of law for the court to decide. Regardless of how this Court decides the issues it has asked to be addressed in this in banc proceeding, the order of the court below should be affirmed.

B. The Court Has the Duty to Interpret Claim Terms As a Question of Law

Cases stating that claim interpretation is a question of law to be decided by the court stretch in an unbroken string dating from before the Civil War to the present. Winans v. Denmead, 56

U.S. (15 How.) 330, 338 (1853); North American Vaccine, Inc. v. American Cyanamid Co., 7 F.3d 1571, 1575, 28 U.S.P.Q.2d 1333, 1336 (Fed. Cir. 1993). Obviously, the only way to interpret a claim is by interpreting the words and phrases that constitute the claim. Consequently, the meaning of a particular term in a claim is also a question of law. See Hormone Research Found., Inc. v. Genentech, Inc., 904 F.2d 1558, 1563 n.7, 15 U.S.P.Q.2d 1039, 1043 n.7 (Fed. Cir. 1990), cert. dismissed, 499 U.S. 955 (1991). In sum, the court, at both the trial and the appellate levels, has the power and obligation to interpret the boundaries of the claim.

This determination rarely involves underlying factual issues. Rather,

[R]esolution of disputed issues regarding the meaning of contested language is ultimately a determination of what claims mean and what they cover. It is a matter of law for this court to decide without special deference to the district court.

North American Vaccine, Inc., 7 F.3d at 1575, 28 U.S.P.Q.2d at 1336 (emphasis added). By the same token, even if the jury has been allowed to construe a claim, claim construction at trial is for the court without special deference to the jury's interpretation. See, e.g., Read Corp. v. Portec, Inc., 970 F.2d 816, 822 n.3, 23 U.S.P.Q.2d 1426, 1432 n.3 (Fed. Cir. 1992).

The first step in claim construction is to look at the claim itself. In other words, "It is elementary that resort must be had in the first instance to the words of the claim which define

the metes and bounds of the invention." Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759, 221 U.S.P.Q. 473, 477 (Fed. Cir. 1984). If necessary, the court next should consider the documentary record, which includes the specification and prosecution history. Bausch and Lomb, Inc. v. Barnes-Hind/Hydrocurve, 796 F.2d 443, 450, 230 U.S.P.Q. 416, 420-21 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987).

The claim is interpreted from the vantage point of one skilled in the art. See Smithkline Diagnostics, Inc. v. Helena Lab. Corp., 859 F.2d 878, 882, 8 U.S.P.Q.2d 1468, 1471 (Fed. Cir. 1988), rehearing en banc declined, 859 F.2d 878, 8 U.S.P.Q.2d 1468 (Fed. Cir. 1988). Therefore, as an aid to construction, the trial court, in its discretion, can consider expert or inventor testimony concerning the meaning of complex technical terms. Snellman v. Ricoh Co., Ltd., 862 F.2d 283, 287-88, 8 U.S.P.Q.2d 1996, 2000 (Fed. Cir. 1988), cert. denied, 491 U.S. 910 (1989). However, for the reasons discussed below, appellees suggest that virtually all disputes concerning the meaning of claims are and should be decided on the documentary record without resort to such testimony. Furthermore, consideration of testimony concerning the meaning of claims does not change the question of claim construction from one of law to one of fact. See, e.g., Senmed v. Richard-Allan Med. Indus., 888 F.2d 815, 818, 12 U.S.P.Q.2d 1508, 1511 (Fed. Cir. 1989). The law is clear that the trial court does not abdicate its responsibility to interpret

claims by allowing a jury initially to construe the claims.

1. Most Claims Should Be Construed Solely on the Documentary Record

Allowing an inventor to offer testimony to explain his or her patent is ordinarily inappropriate because the patent should speak for itself. Patent law contemplates a trade-off. The inventor discloses the invention to "stimulate ideas and the eventual development of further significant advances in the art." Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 481, 181 U.S.P.Q. 673, 678 (1974). In return, the patentee receives the exclusive right to use and license his invention until the patent expires. The inventor is required to define his invention unambiguously so that the public can understand the extent of the inventor's monopoly. Section 112 requires that the specification of a patent shall describe the invention "in such full, clear, concise and exact terms as to enable any person skilled in the art" to make and use the invention, and that the "specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112 (emphasis added). The disclosure under section 112 must be sufficient to enable persons skilled in the art to determine with certainty and consistency the scope of the claimed invention. See Hoganas AB v. Dresser Indus., Inc., 9 F.3d 948, 951, 28 U.S.P.Q.2d 1936, 1939 (Fed. Cir. 1993).

The Supreme Court has observed that claiming is the



patentee's "most solemn act." Mahn v. Harwood, 112 U.S. 354, 360-61 (1884). The solemnity stems from the fact that "[O]ther players in the marketplace are entitled to rely on the record made in the Patent Office in determining the meaning and scope of the patent." Lemelson v. General Mills, Inc., 968 F.2d 1202, 1208, 23 U.S.P.Q.2d 1284, 1289 (Fed. Cir. 1992), cert. denied, 113 S.Ct. 976 (1993). The disclosure obligation becomes a farce if the public cannot interpret the patent on the basis of the documentar<sup>y</sup> record. Therefore, under normal circumstances, the claim interpretation should be based completely on the documentary record available to the public.

This position is supported by White v. Dunbar, 119 U.S. 47, 51-52 (1886), where the Supreme Court stressed the importance of construing the patent on the basis of the claim itself:

Some persons seem to suppose that a claim in a patent is like a nose of wax, which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than or something different from what its words express.... The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms.

Another reason to interpret claims solely on the documentary evidence is that expert testimony concerning claim interpretation is so partisan that it is generally worthless. As this Court noted in Senmed, Inc. v. Richard-Allan Med. Indus., 888 F.2d 815,

819 n.8, 12 U.S.P.Q.2d 1508, 1512 n.8 (Fed. Cir. 1989), "lawyers may create a 'dispute' about any word." Most expert or witness testimony about claim construction is ultimately rejected by courts. See North American Vaccine, Inc., 7 F.3d 1571, 1577, 28 U.S.P.Q.2d 1332, 1337 (Fed. Cir. 1993) (inventor's "after-the-fact testimony" regarding prosecution history entitled to little weight); Hormone Research Found., Inc. v. Genentech, Inc., 904 F.2d 1558, 1561, 15 U.S.P.Q.2d 1039, 1044 (Fed. Cir. 1990), cert. dismissed, 499 U.S. 955 (1991) (rejecting patentee's arguments as "little more than a post-hoc attempt to redefine its claims during litigation"); Senmed, Inc., 888 F.2d at 819, 12 U.S.P.Q.2d at 1512 (criticizing the patentee's "litigation-induced" testimony and "semantic antics" in interpreting the term "on"); Whapeton Canvas Co., Inc. v. Frontier, Inc., 870 F.2d 1546, 1551, 10 U.S.P.Q.2d 1201, 1206 (Fed. Cir. 1989) (criticizing claims as "a semantic mish mash"); Molinaro v. Fannon/Corrier Corp., 745 F.2d 651, 654, 223 U.S.P.Q. 706, 708 (Fed. Cir. 1984) (court rejected expert's testimony as "merely efforts to read the patent claims on the accused receiver in light of undisputed facts"); Intellicall, Inc. v. Phonometrics, Inc. 952 F.2d 1384, 1388, 21 U.S.P.Q.2d 1383, 1386 (Fed. Cir. 1992) (testimony of the inventors and their attorneys cannot negate the meaning to one of ordinary skill in the art from reading the patent).<sup>2</sup>

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<sup>2</sup> See also Advanced Cardiovascular Sys. v. Scimed Sys., 887 F.2d 1070, 1076, 12 U.S.P.Q.2d 1539, 1543 (Fed. Cir. 1989)

The use of testimony by the inventor or inventor's expert as an aid in claim construction should also be discouraged because, unlike contract cases, both sides of the dispute are not on equal footing. If parole evidence is allowed in a contract case, both parties to the contract are permitted to testify about the meaning of contract terms. However, in a patent case, the patent examiner is not allowed to testify about the government's interpretation of the claim. See Western Electric Co. v. Piezo Technology, Inc., 860 F.2d 428, 431-32, 8 U.S.P.Q.2d 1853, 1856 (Fed. Cir. 1988). No one can directly challenge the inventor's testimony about what was intended by the patent language. If contradictory testimony is offered by the other side, in virtually every case it must be "second-hand" interpretation by a witness who was not a party to the patent grant. To the extent that testimony is allowed, the patentee holds an unfair advantage over the public.

Interpreting claims solely on the basis of the specification and prosecution history promotes the twin goals of consistency and predictability, which gave rise to the creation of this Court. As Congress has said:

The uniformity in the law that will result from the centralization of patent appeals in a single court will be a significant

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(Newman, J. dissenting) (expert testimony cannot change the meaning of common terms used, as understood in light of the specification, prosecution history, and prior art).

improvement from the standpoint of the industries and businesses that rely on the patent system. Business planning becomes easier as more stable and predictable patent law is introduced.

H.R. No. 97-312, 97th Cong., 1st Sess at 9 (1981).

The documentary record is immutable, unlike testimony, which can be tailored to the current position of the litigant. The documentary record is more susceptible to consistent interpretation by both the trial court and this Court on appeal than testimony, which may vary from case to case. Finally, eliminating witness testimony removes any doubt about whether claim construction can ever be a question of fact for the jury. Allowing juries to decide claim construction often clouds patent law because their claim construction is so inextricably interwoven with fact findings that it is difficult to review on appeal.

2. Claim Construction Is Most Analogous to Statutory Construction

Appellees agree with the argument that patent cases should be decided like other cases. Courts are routinely called upon to interpret the meaning of documents as a matter of law. Courts construe consent orders, agency regulations, city charters, treaties, public land grants, and the scope of protectable elements in a copyrightable work. United States v. Reader's Digest Ass'n, 662 F.2d 955, 961 (3d Cir. 1981), cert. denied, 455 U.S. 908 (1982) (consent order); United States v. Boeing Co., 802 F.2d 1390, 1393 (Fed. Cir. 1986) (agency regulations); Driggins



v. Oklahoma City, 954 F.2d 1511, 1513 (10th Cir. 1991), cert. denied, 113 S.Ct. 129 (1992) (city charter); Choctaw Nation of Indians v. United States, 318 U.S. 423, 431-432 (1943) (treaty); Great Northern Ry. Co. v. United States, 315 U.S. 262, 62 S.Ct. 529 (1942) (public land grant); Lotus Development Corp. v. Borland Intern. Inc., 788 F.Supp. 78, 85, 22 U.S.P.Q.2d 1641, 1646 (D. Mass. 1992) (scope of protectable elements in a copyrightable work).

The best analogy to claim construction is statutory construction. A patent and a statute are similar in that they each delineate the public rights and/or obligations. They are each applicable to all persons similarly situated. The construction of a patent or statute establishes a standard that will then impact on people who were not involved in the drafting of the document. Thus, important issues of public policy arise in statutory and patent construction.

Statutory construction is, of course, a question of law. See e.g., 2A SINGER, SUTHERLAND ON STATUTORY CONSTRUCTION §47.31. The court's initial inquiry begins with the words of the statute. Johns-Manville Corp. v. United States, 855 F.2d 1556, 1559 (Fed. Cir. 1988), cert. denied, 489 U.S. 1066 (1989) (citations omitted). Where necessary, the court can consider extrinsic evidence or testimony such as legislative history or committee reports. See Order of Railway Conductors v. Swan, 329 U.S. 520, 525 (1947). The consideration of such evidence does not change

statutory construction from a legal question to a factual question. See, e.g., Dakota Nat'l Bank & Trust Co. v. First Nat'l Bank Trust Co., 554 F.2d 345 (8th Cir. 1977), cert. denied, 434 U.S. 877 (1977). In sum, statutory construction is the most appropriate analogy for the interpretation of claim language in a patent.

3. There Are Significant Differences Between Claim Construction and Contract Construction

Appellants argue that claim construction is analogous to contract interpretation. This argument is flawed because there are significant differences between patents and contracts. As stated above, statutes and patents affect public rights and interests, whereas contracts normally have little or no impact on the public. Therefore, it is vitally important that the public is able to understand the meaning of a patent and a statute. As a result, statutes that are overly vague violate the Constitution, while patents that are overly vague violate the requirements of Section 112. However, there is no statutory requirement that a contract be clear and unambiguous. Parties are free to write contracts in a language that only they can understand. Since subjective intent is important in a contract interpretation, in an appropriate case, both sides to the contract can testify about the meaning of a contract. In a patent case, where there is no subjective intent to determine, the patent examiner is not allowed to testify. Even if the inventor is allowed to testify, his or her subjective intent

about the patent's meaning is irrelevant.

4. Under Either Analogy, the Trial Court Properly  
Rejected Expert Testimony in Deciding that No  
Ambiguities Existed as a Matter of Law

Assuming arguendo that the significant differences between patents and contracts can be discounted and they can be interpreted according to the same principles, a trial court in a patent case still would have discretion to consider testimony to determine the legal question of whether an ambiguity exists.<sup>3</sup> That is exactly what happened in the instant case. The trial court did not "weigh evidence" or "judge credibility," as the plaintiffs hotly contend. To the contrary, the trial court allowed testimony, in an abundance of caution, to ensure that all sources of information were considered before determining whether

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<sup>3</sup> Under the canons of contract law, construction of an unambiguous contract is generally a question of law while the interpretation of an ambiguous contract is generally a question of fact. See, e.g., Tigg Corp. v. Dow Corning Corp., 822 F.2d 358, 362-63 (3d Cir. 1987), cert. dismissed, 113 S.Ct. 834 (1993). Whether a contract is ambiguous is a question of law. Id. To determine this threshold issue, a court may consider extrinsic evidence. Mellon Bank, N.A. v. Aetna Business Credit, Inc., 619 F.2d 1001, 1011 (3d Cir. 1980). But even though the court hears factual or expert testimony, the ambiguity question remains a legal issue. Id.

there was a genuine dispute about the terms of the patent. Just as in a contract case, the court was free to consider expert testimony, decide that it was not evidence, and reject it. See, e.g., Girard v. Allis Chalmers Corp., 787 F.Supp. 482, 487 (W.D. Pa. 1992) (rejecting affidavits from an engineer and an attorney concerning contract interpretation because interpretation of an unambiguous contract is a matter of law and court not aided by "professionally conclusory opinions.")

In fact, the only time that inventor or expert testimony is appropriate in a claim interpretation dispute is where the meaning of a technical term is known by a person reasonably skilled in the art, but is unfamiliar to the court. The recognition that expert testimony should be so limited is longstanding. For example, Justice Learned Hand said:

We have not the slightest wish to minimize the vital importance of expert testimony in patent suits, or to suggest that we are not absolutely dependent upon it within its proper scope; but that scope is often altogether misapprehended.... Specifications are written to those skilled in the art, among whom judges are not. It therefore becomes necessary, when the terminology of the art is not comprehensible to a lay person, that so much of it as used in the specifications should be translated into colloquial language; in short, that the judge should understand what the specifications say. This is the only permissible use of expert testimony which we recognize. When the judge has understood the specifications, he cannot avoid the responsibility of deciding himself all questions of infringement and anticipation, and the testimony of experts upon these issues is inevitably a burdensome impertinence.



Kohn v. Eimer, 265 F. 900, 902 (2d Cir. 1920) (emphasis added).<sup>4</sup>

In this case, the expert testimony presented was nothing more than a "burdensome impertinence." Plaintiffs presented a patent lawyer, Eugene Chovanes, who testified over defendants' objection about the meaning of the patent claims. Mr. Chovanes had no skill or expertise in the subject taught in the patent, the application of bar codes to an inventory control system. (A 832). The key words that Mr. Chovanes interpreted (in a highly creative way) were "inventory," "attached to" and "report." Clearly, these are not technical terms. Moreover, the trial court rightly decided that Mr. Chovanes' interpretation of these terms was "artificial" and "contrary to their ordinary and customary meaning, as well as the obvious meaning intended by the patentee." (Op at 3-4; A 5-6). Specifically, the trial court explicitly rejected Mr. Chovanes' definitions of "report" as "invoice"; "attached to said articles" as "attached to a plastic

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<sup>4</sup> See also Judge Newman's dissent in Advanced Cardiovascular Sys. v. Scimed Life Sys., 887 F.2d 1070, 1076, 12 U.S.P.Q.2d 1539, 1543 (Fed. Cir. 1989) ("purpose of expert testimony is to provide assistance to the court in understanding when the claims are technologically correct or linguistically obscure, how a technician in the field, reading the patent, would understand the claims") (citing Snellman v. Ricoh Co., 862 F.2d 283, 287, 8 U.S.P.Q.2d 1996, 2000 (Fed. Cir. 1988), cert. denied, 491 U.S. 910 (1989)).

bag that covers a batch of the articles"; and "inventory" as "cash" or "invoices" but not "articles of clothing." (Op. at 3; A 5).<sup>5</sup> Mr. Chovanes' testimony was not even evidence, much less substantial evidence.

Consequently, the trial court properly disregarded Mr. Chovanes' testimony, stating:

Plaintiffs' technical expert's testimony is based on an artificial interpretation of key words and phrases that run counter to their ordinary meaning. The patent expert's testimony about the interpretation of the claim is not helpful because that is a legal issue for the court.

(Op. at 4; A 6).

Although the trial court's decision about Mr. Chovanes' testimony was correct, the better course for a trial judge is not to permit such testimony at all. Rather, a trial judge should be guided by what this Court has said in the similar context of expert testimony about the legal question of obviousness.

The spectacle of experts arguing over the legal conclusions of obviousness before the jury, even if not error, should be avoided inasmuch as such opinions are not substantive evidence (emphasis added).

Mendenhall v. Cedarapids, Inc., 5 F.3d 1557, 1574 n.17, 28 U.S.P.Q.2d 1081, 1096 n.17 (Fed. Cir. 1993).

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<sup>5</sup> Mr. Chovanes also offered the unusual definition that a "bar code" equals "bar codes" because a bar code consists of lines and spaces. (A 832-33).

C. The Proffer of Factual or Expert Testimony Does Not Change Claim Construction from a Question of Law into a Question of Fact

In this appeal, appellants misperceive the nature of the right to a jury trial. Put simply, there is no right to have a jury decide an issue of law. On this point, appellees echo the statement set forth in Newell Cos., Inc. v. Kenney Mfg. Co., 864 F.2d 757, 763, 9 U.S.P.Q.2d 1417, 1422 (Fed. Cir. 1988), cert. denied, 493 U.S. 814 (1989), "a party has a right to a jury trial in an action at law, not a right to a jury verdict" (emphasis in original).

There can be no doubt that many patent infringement cases, like other cases, involve no conflicting evidence and must be decided on the law. See Howes v. Medical Components, Inc., 814 F.2d 638, 643, 2 U.S.P.Q.2d 1271, 1273 (Fed. Cir. 1987). There is no role for the jury in these cases since "it is not the function of a jury to pick and choose among established facts.... Its obligation [is] to sift through conflicting evidence and determine what those facts are." Newell, supra, 864 F.2d at 763, 9 U.S.P.Q.2d at 1422 (emphasis added.)

On occasion, a judge may want to hear testimony before deciding whether or not a genuine fact issue exists, as happened in this case. But even if it takes the "agony of a full-blown trial" before the court decides that "there was never really the

decisive issue of fact at all,"<sup>6</sup> the judge's deferral of the legal issue has not forfeited to the jury the duty to decide the law.

Trial judges are not given strict deadlines by which to decide issues of law. A court can consider testimony without fear that the clock will strike midnight on its powers to decide issues and turn a question of law into a question of fact. Rather, "the authority of the judge to rule on issues of law during the course of proceedings is an essential element of a jury trial." Newell, *supra*, 864 F.2d at 763.

- D. In the Rare Case Where Claim Language Is Truly Ambiguous, the Court Should Construe the Ambiguity against the Patentee as a Matter of Law

The rare and difficult case, not presented here, is where the court considers extrinsic evidence and concludes that there is a genuine dispute about a truly ambiguous technical term. There is, admittedly, arguable precedent for the position that the meaning of a truly ambiguous technical term is an underlying factual question that should be determined by the jury.<sup>7</sup> Appellees submit, however, that truly ambiguous patent language does not present a fact question. If two persons skilled in the art could reasonably interpret the same claim language differently, there is no further inquiry. Where there are two

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<sup>6</sup> Id., quoting Robbins v. Milner Enters., Inc., 278 F.2d 490, 497 (5th Cir. 1960).

<sup>7</sup> See Johnston v. IVAC Corp., 885 F.2d 1574, 1579, 12 U.S.P.Q.2d 1382, 1385-1386 (Fed. Cir. 1989).



reasonable claim constructions, neither can be the single correct interpretation.

Under these rare circumstances, patent construction is different from both contract interpretation and statutory construction. Ambiguous language in a patent must be treated differently from ambiguous language in a contract or statute because the drafter's intent is not controlling. In a contract dispute, the fact-finder decides which reasonable interpretation of the ambiguous language the parties really intended. When construing a statute, the court decides the true intent of the legislature. In a patent case, however, the subjective intent of the patentee cannot control the interpretation of truly ambiguous claim language. If the patentee's intent were to govern, a person skilled in the art could be subject to infringement liability even though his or her interpretation of the ambiguous language is reasonable. The patentee, not the public, should suffer the consequences of the truly ambiguous patent. Consequently, in an infringement case, truly ambiguous claim language should be construed against the patentee.<sup>8</sup>

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<sup>8</sup> Construing ambiguities against the patentee is analogous to, and serves the same purpose as, the rule of statutory construction that ambiguities in a public land grant are construed against the grantee. Great Northern Ry. Co. v. United States, 315 U.S. 262, 272 (1942) ("nothing passes but what is conveyed in clear and explicit language.") Of course, contract

The patentee is entitled to draft the patent as broadly as the Patent Office will permit. However, if ambiguous terms are used by the patentee, they must be construed narrowly so that the public is not misled about the scope of the patent. Moreover, construing ambiguous claims against the patentee supports and protects the "fundamental underpinning of patent law"<sup>9</sup> that a patentee is prohibited from recapturing what was forfeited in obtaining the patent.<sup>10</sup>

E. Construction is Reviewable De Novo by the Trial Court and by this Court on Appeal

On appeal, this Court reviews claim construction de novo regardless of whether the court or the jury interpreted the claim. See, e.g., Mendenhall v. Cedarapids, Inc., 5 F.3d 1557, 1578, 28 U.S.P.Q.2d 1081, 1100 (Fed.Cir. 1993), (de novo standard applied to review a jury's claim construction); Carroll Touch, Inc. v. Electro Mechanical Sys., Inc., 3 F.3d 404, 408, 27 U.S.P.Q.2d 1836, 1839 (Fed. Cir. 1993) (de novo standard applied to review trial court's claim construction).

The de novo standard also applies where, as in this case, a law also recognizes as a general proposition that ambiguities should be construed against the drafter.

<sup>9</sup> Senmed v. Richard-Allan Med. Indus., 888 F.2d 815, 818, 12 U.S.P.Q.2d 1508, 1511 (Fed. Cir. 1989).

<sup>10</sup> It also may follow that if a term in a patent is truly ambiguous, the patent should be invalid for failure to satisfy Section 112 requirements.

trial judge reviews the claim construction of a jury on a directed verdict or JNOV motion. As recently stated in Read Corp. v. Portec, Inc., 970 F.2d 816, 822-23, 23 U.S.P.Q.2d 1426, 1432 (Fed. Cir. 1992):

Where the court's interpretation is not set forth in its instructions to the jury, the court must perform its role of deciding the issue of law in ruling on the JNOV motion.

Appellants devote much of their brief to the deference the court must pay to jury verdicts supported by substantial evidence. Their argument ignores both law and fact. The process by which a court reviews a jury's verdict involving a mixed question of law and fact has two parts. Appellants' argument looks only to the first part of that review process. In reviewing a jury verdict, the court first presumes that the jury resolved the underlying factual disputes in favor of the verdict winner, and it leaves those presumed findings undisturbed if they are supported by substantial evidence. Appellants ignore the second step, where the court examines the jury's legal conclusion de novo to see whether it is correct in light of the presumed fact findings. Jurgens v. McKasy, 927 F.2d 1552, 1557, 18 U.S.P.Q.2d 1031, 1035 (Fed. Cir. 1991).

In this case, as in most claim interpretation disputes, there were no underlying factual issues. Therefore, the jury's claim construction must have been a legal conclusion that was not

fact-based.<sup>11</sup> This Court has recognized that the substantial evidence standard has no application to a claim dispute that is solely a matter of claim interpretation, stating succinctly, "One employs evidence to prove facts, not legal conclusions." Senmed v. Richard-Allan Med. Indus., 888 F.2d 815, 818, 12 U.S.P.Q.2d 1508, 1511 (Fed. Cir. 1989).

The message from this Court is loud and clear. The trial court cannot shirk its duty to construe a claim by deferring this task to a jury. The ultimate claim interpretation must be done by the judge. These words apply to this case:

That a jury has answered a legal question may not in itself require reversal. Of a certainty, however, this circumstance cannot serve to relieve the trial judge or this court of the judicial duty to insure that the law is correctly applied.

Senmed, 888 F.2d at 818, 12 U.S.P.Q.2d at 1511.

The trial court properly discounted plaintiffs' expert testimony because it twisted the meanings of common words such as "inventory" and "report." In Johnston v. IVAC Corp., 885 F.2d 1574, 1579, 12 U.S.P.Q.2d 1382, 1385-86 (Fed. Cir. 1989), this Court recognized that:

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<sup>11</sup> It is theoretically possible, but highly unlikely, that the jury correctly construed the claim, but misunderstood the elements and function of the accused system. Under this scenario, the jury's fact findings were not supported by substantial evidence.



[A] mere dispute over the meaning of a term does not itself create an issue of fact. This is true even where the meaning cannot be determined without resort to the specification, the prosecution history or other extrinsic evidence, provided upon consideration of the entirety of such evidence the court concludes that there is no underlying issue of material fact. <sup>12</sup>

Ordinarily, there is no issue of a material fact underlying claim construction. The specification and the prosecution history are undisputed. Conflicting opinions on the meaning of a claim term that are merely conclusory do not create an issue of fact. Johnston, supra, 885 F.2d at 1580, 12 U.S.P.Q.2d at 1385 (citation omitted). Rather, the meaning of contested language is a determination of what claims mean and what they cover, and is a matter of law. See North American Vaccine, Inc. v. American Cyanamid Co., 7 F.3d 1571, 1578, 28 U.S.P.Q.2d 1333, 1336 (Fed. Cir. 1993). This Court has postulated that disputed issues of fact may arise in connection with interpretation of a term in a claim if there is genuine evidentiary conflict created by the underlying probative evidence pertinent to the claim's

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<sup>12</sup> Appellees note that the Johnston court expressly disapproved of language to the contrary in Palumbo v. Don Joy Co., 762 F.2d 969, 974, 226 U.S.P.Q. 5, 8 (Fed. Cir. 1985), relied on repeatedly by appellants (Appellants' Supp. Mem. at 19, 36) in their supplemental memorandum. Johnston, 885 F.2d at 1579 n.4, 12 U.S.P.Q.2d at 1385-86 n.4.

interpretation. Johnston, 885 F.2d at 1579, 12 U.S.P.Q.2d at 1385-86. In such a case, the underlying fact issues would be decided by the jury, and reviewed pursuant to the substantial evidence standard. This is not such a case, however.

F. There Was no Genuine Fact Dispute for the Jury, and Judgment for Defendants Was Proper

Here, there was no genuine underlying factual dispute. Although there was a lawyer-created dispute about claim interpretation, the trial court correctly found that the meaning of the claim was clear from the patent specification and prosecution history. The dispute was artificially created by the patentee and his expert and concerned simple, non-technical words such as "inventory" and "report." Appellants base their interpretation of the claim language solely on expert testimony. The trial court was not bound to treat the contradictory jury findings with any deference because the findings were not fact-based. For the reasons previously discussed, the mere fact that extrinsic evidence was considered does not change the question from law to fact. The trial court was correct to review the jury's legal conclusion de novo. This Court should apply the de novo standard in reviewing claim construction regardless of whether the claim was construed by the judge or the jury. To assist this Court in its de novo review of the claim construction in this case, the following argument will demonstrate that Appellants' complaints about the lower court's claim interpretation are baseless.

1. Westview's System Does Not Infringe the Patent

Appellants have attacked the district court's claim interpretation on two grounds. First, they argue that the lower court erred when it interpreted the claim to require a system that stored in its memory for later use information about articles of clothing. Second, they argue that the district court was mistaken when it construed the patent language to require a system that tracked individual articles of clothing. In fact, the trial court's interpretation of the patent language on these two points is compelled by a review of the documentary evidence. In essence, appellants try to distort select phrases in the patent-in-suit in an attempt to conceal the obvious fundamental differences between the accused system and the invention described in the patent-in-suit.

- a. The Patent Defines a System that Generates a Report that Reconciles Invoice Numbers against Article Descriptions, Not Merely a System that Has Memory Operable to Record

Appellants contend that because the accused system prints (and therefore arguably records) an invoice containing article descriptions and also maintains a total of the drycleaner's dollar and invoice inventory, it satisfies the claim requirement of memory operable to record article descriptions and means to maintain an inventory total. Putting aside the obvious problem that the patentee did not define "inventory" as invoices or dollars, appellants' argument is faulty because it takes the phrase "memory operable to record said information and means to

maintain an inventory total" out of context. The rest of the paragraph requires that the data processor generate

at least one report of said total and said transactions, the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another.

(A 1021, col. 10, lns. 60-64).

The trial court properly read the two requirements together. Thus, the purpose of memory operable to record information and means to maintain an inventory total is to enable the invention to generate a report that includes the total and the transactions and which reconcile article descriptions against invoice numbers. To generate such a report, the system must maintain a database of article descriptions in memory. The accused system does not maintain article descriptions and therefore is unable to generate the type of report required by the patent. Consequently, even if appellants' fanciful definition of "inventory" is accepted, claim 1 still does not read on the accused system.

b. The Accused System Does Not Track Articles of Clothing, Individually or Collectively

Appellants complain that the district court improperly narrowed claim 1 by finding that it required that bar code tags be attached to each individual article. Now, appellants contend that claim 1 allows individual articles or batches of clothes to be encoded.<sup>13</sup> This argument ignores the patent language, which

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<sup>13</sup> This position contradicts Markman's deposition testimony where he said that the difference between one of his earlier



specifically requires "part of the written record bearing a portion to be attached to said articles" and "bar codes on all articles passing a predetermined station." (A 1022, col. 11, lns. 3-5, 7-8). Whether the patent requires attachment of tags to individual articles or attachment of tags to batches is moot because the accused system simply does not print tags for attachment to articles of clothing.

Moreover, appellants are missing the forest for the trees. The patent uses article tags so that it can track articles through the drycleaning process. The Westview system is incapable of tracking individual articles or batches of articles.

Since Westview's system does not print article tags, appellants are forced to equate an invoice with an article tag. Of course, as discussed earlier, this is pure nonsense. The distinction between the invoice and the tag is underscored by the fact that the invoice is not attached to the clothes. While the clothes travel through the drycleaning process, the invoice is not even associated with the clothes. After the clothes are processed, the invoice is attached to the plastic bag covering the cleaned clothes. It does not take expert testimony to understand that an invoice attached to the plastic bag is neither

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inventions and the invention defined by the patent-in-suit was that in the earlier invention specific articles were not tracked in the inventory control system as they were in the invention defined by the '054 patent. (A 888).

a tag nor is it attached to clothing. More to the point, because the accused system does not print bar-coded tags for attachment to clothing, it does not permit the user to detect said bar codes on all articles passing a predetermined station, as required by claim 1.

c. Article Tagging and Tracking Is Required by Claim 1, as well as by Claims 5 and 6

Another red herring advanced by appellants is the argument that the district court improperly interpreted claim 1 to include elements of claims 5 and 6.

Dependent claims 5 and 6 read as follows:

5. The system of claim 1, wherein the written record has multiple separable parts printed concurrently, including a customer ticket, an establishment ticket and a plurality of article tags [sic tags], and at least one of the tickets and tags having a bar code printed thereon, and each tag being detachable from the written record for direct association with at least one of the customer articles.

(A 1022).

6. The system of claim 1, wherein the data input device is the keyboard and the printer is operable to generate tags for direct attachment to articles comprising textile material, the articles being pieces of drycleaning.

(A 1022).

According to appellants, claim 1 does not require tags to be attached to articles of clothing. Rather, they argue that this requirement is only necessitated by dependent claims 5 and 6,

which are alternative embodiments of claim 1. Once again, appellants disregard the language of claim 1, which requires that "part of the written record bearing a portion to be attached to said articles." (A 1022). Thus, the "direct association" language of claim 5 is actually weaker than the "attached" language of claim 1. Appellees submit that there is no meaningful distinction between "attached" and "direct attachment," the phrases used in claims 1 and 6, respectively. This is not to say that claims 5 and 6 are completely superfluous. Rather, they define certain elements of claim 1 as specifically applicable to the drycleaning business. This is consistent with appellants' position that claim 1 of the patent-in-suit is not limited to use in the drycleaning business. (See, e.g., Appellants' Mem. at 33, n.13.)

Thus, claim 5 specifically defines the written record as including "a customer ticket, an establishment ticket and a plurality of article tags [sic] [tags]" and claim 6 specifically discusses "articles comprising textile material, the articles being pieces of drycleaning."

This explanation also squares with the remarks in support of the amended patent, which state:

Further refinements of the invention which are recited in the claims and are likewise missing in the references relate to the mixture of the optically-scannable and alphanumeric indicia, generated at different print speeds, the multi-part nature of the printed media, the reconcilable nature of the system at any of various stations besides the

initial receipt or ultimate delivery, and a unique keyboard data entry device that ties the package together. The subject matter in these claims as well as in independent claim 1 relate not only to general purpose inventory control or general purpose totalizing, but also to the specific usefulness of concurrently-generated unique bar code indicia in a laundry and drycleaning establishment, together with the integration of such a system into the pricing, marking and actual article [sic] [article], processing to improve the entire operation.

(A 1670).

This statement shows that claim 1, not just claims 5 and 6, relates to article marking and processing despite what the plaintiffs are now contending. Article marking and article processing necessarily require the printing and attachment of article tags and the tracking of articles through the system. Dependent claims 5 and 6 were merely intended to limit claim 1, which defines a "general purpose inventory control" system, to an inventory control system for use in a drycleaning establishment.

#### V. CONCLUSION

Regardless of how this Court resolves the four questions that have been raised, this case was correctly decided by the district court. There was no genuine underlying factual dispute here. Plaintiffs created an artificial dispute about ordinary common words that were not used by the inventor in any special technical way. Read apart or together, the specification and prosecution history make clear that the patent-in-suit defines an

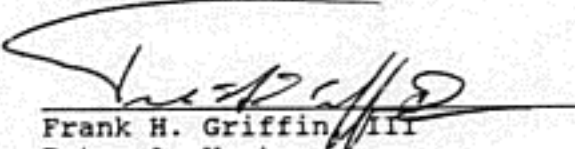


invention totally different from the accused system.

The fact that, in an abundance of caution, the trial court permitted expert testimony does not transform that artificial litigation-induced testimony about claim interpretation into evidence or change the issue of claim construction from law to fact. The trial court retained the power and the duty to construe claims as a matter of law. That duty was brought into sharper focus by the fact that the jury's claim construction was clearly erroneous since its answers to general interrogatories were contradictory. This Court reviews claim construction de novo. Upon consideration of the documentary record, this Court should construe the patent-in-suit exactly as the trial court did. The proper claim construction compels a judgment for the defendants.

For all of the foregoing reasons, the trial court properly construed the claims and its judgment should be affirmed.

Respectfully submitted,



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CERTIFICATE OF SERVICE

I hereby certify that true and correct copies of the foregoing Brief of Appellees, Westview Instruments, Inc. and Althon Enterprises, Inc., were served today upon the following attorneys by first class mail addressed as follows:

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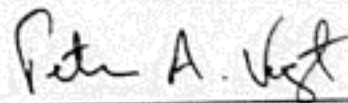
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A handwritten signature in dark ink, reading "Peter A. Vogt". The signature is written in a cursive style with a horizontal line underneath the name.

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