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COMPUTER LAW

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'Markman' Hearings and Computer Terms

WHAT DO THE words blog, firewall and hyperlink have in common? For the more technologically savvy, it is obvious that these words are just a few of the many computer terms that have made their way into the English language and, depending on their continued usage, may have landed a spot in a general purpose dictionary such as the Merriam Webster or American Heritage volumes. New computer terms and other, new computer-related meanings for existing words, enter the language on a regular basis, but it is not until they are widely recognized, which often takes years, that they are added to, an authoritative lexicon.[1]

Establishing the definition of a newly minted computer term can present challenges in patent litigation, where case law allows judges to reach for a dictionary, encyclopedia or treatise to determine the meaning of a critical term. The meaning given to a new computer term not only can define the scope of a patent but also can have an enormous impact on the outcome of a particular litigation.

One of the most important aspects of any patent litigation is the pre-trial *Markman* hearing, a proceeding in which the trial judge is presented with evidence to construe the key terms in the patent claims. In *Markman v. Westview Instruments, Inc.*, 517 US 370, 116 SCt 1384, 134 LEd2d 577 (1996) the U.S. Supreme Court held that before a jury can determine whether a claim has been infringed, the trial judge must, as a matter of law, construe the claims. This claim construction encompasses the interpretation of disputed technical and nontechnical terms. Although the rules governing *Markman* hearings and the point at which they are held vary from court to court, they are generally held before the start of trial. The side that prevails at the *Markman* hearing is often also the ultimate winner of the case itself. Therefore, the stakes in a *Markman* hearing are usually quite high.

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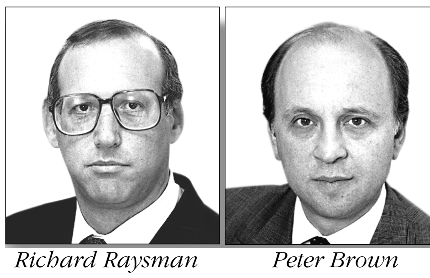

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Interestingly, nearly a decade ago and prior to the Supreme Court's *Markman* decision, the U.S. Court of Appeals for the Federal Circuit, in *In Re Paulsen*, 30 F3d 1475 (Fed. Cir. 1994), was faced with a matter involving the construction of the term "computer." The court held that although an inventor may define the specific terms used to describe his invention, he must do so "with reasonable clarity, deliberateness, and precision."[2] In *Paulsen*, the inventor had not defined the term "computer" to remove the word "calculator" from its definition, such that one of ordinary skill in the art would deem it to be different from its common meaning. As a result, the court held that the basic definition of a computer included a device capable of performing calculations. According to the court, although a calculator "may be a 'limited function' computer as opposed to a 'full function' computer, (this) does not change the fact that it is nonetheless a computer."[3]

With the plethora of new computer terms and new computer-related definitions being added to existing words as a result of the rapid advances in computer technology in the almost 10 years since *Paulsen* was decided, many of them have been and will continue to be the subject of *Markman* hearings.

Initial Steps

When preparing for a *Markman* hearing, the allegations, defenses and overall strategy of the case must be considered and the pros and cons of all possible interpretations of disputed terms, both for infringement and invalidity, must be examined. It is also important to bear in mind that a broad construction may help prove infringement, but also can result in more easily invalidated claims.

As a first step, the disputed words and proposed definitions that would be helpful to the case should be selected. But from where can support for these definitions be found? The starting point is the patent itself. Not all patents have express definitions, but if one is found in the specification, that definition will control. In the absence of an express definition in the patent, an examination of the entire file history should be performed for statements explicitly defining the disputed terms. If, at this point, no definitions are available, then the "ordinary meaning" of the words may control.[4]

In the event that the computer term is undefined in the patent and a definition of it does not appear in any reference materials, the patent and file history should be checked to see if the patentee has disclaimed any meanings. If this is the case, then the court will at least know what the term does not mean. Additionally, use in prior art cited in the file history may help to define a term[5] and, finally, a search of previous cases should be performed to determine if another court has defined the disputed term or terms.

Authoritative Sources, Intrinsic Evidence

Under *Markman* and its progeny,[6] the court

usually will look first to intrinsic evidence for a definition when interpreting an asserted claim that is undefined in the patent. Intrinsic evidence consists of the prosecution history and claims specification and includes all the file documents for the applicable patent at the U.S. Patent and Trademark Office (USPTO). Extrinsic evidence, on the other hand, consists, more or less, of all evidence unrelated to the public record of the patent and, depending on the case, may include inventor and/or expert testimony. It is only when the intrinsic evidence is insufficient to resolve an ambiguity that a court will resort to using extrinsic evidence. Some district courts, however, have excluded extrinsic evidence altogether from the hearings, while others have chosen to hear it before deciding whether to exclude or admit it. Still, others have gone so far as to refuse to allow any discovery of extrinsic evidence prior to the *Markman* hearing.[7]

In order to ascertain the "ordinary meaning," of a word, a trial judge often will consult a dictionary, encyclopedia and/or treatise. Although these resources are technically not intrinsic evidence, they are, for practical purposes, treated as such. To categorize them as extrinsic evidence or a "special form of extrinsic evidence" would be misplaced.[8] After consulting the necessary reference material(s), the trial judge may afford significant weight to what is found in them.

Key Resources

The importance of these resources should never be underestimated. In *Texas Digital Systems Instruments Inc. v. Telegenix, Inc.*, 308 F3d 1193 (Fed. Cir. 2002), the Court of Appeals for the Federal Circuit made clear the value of these reference materials. The court stated that "dictionaries, encyclopedias, and treatises, publicly available at the time the patent is issued, are objective resources that serve as reliable sources of information on the established meanings that would have been attributed to the terms of the claims by those of skill in the art."[9] In the court's opinion, these references provide "unbiased reflections of common understanding" because they are (1) not influenced by expert testimony or events subsequent to the fixing of the intrinsic record by the grant of the patent, (2) not colored by the motives of the parties and (3) not inspired by litigation.[10] Noting their usefulness in aiding courts in many ways, the court went so far as to say that these materials "may be the most meaningful source of information to aid judges in better understanding both the technology and the terminology used by those skilled in the art to describe the technology."[11]

Because the potential for a trial court to place much weight upon these resources is so great, it is imperative that some fundamental principles are kept in mind in order to be in a better position to influence the determination of the claims in a manner most favorable during the *Markman* hearing.

Although there is no case law that offers guidance as to exactly what may make one reference more authoritative than another, courts will generally accept sources with longstanding reputations (e.g., Merriam-Webster Dictionary, American Heritage Dictionary), as well as those unique to a particular area (e.g., McGraw-Hill Dictionary of Scientific and Technical Terms). As a practical matter, any number of sources may be used to try to convince the court to adopt the meaning of the disputed term. Although the source is considered objective, the selection process is subjective.

In the computer field, unlike other areas involving patents (e.g., life sciences, chemistry), the meaning of terms can vary wildly from source to source, owing in large part to the rapidly evolving nature of the industry, the use of acronyms for many terms, and the fact that most of the literature is published by companies themselves. In *Altris, Inc. v. Symantec Corp.* 318 F3d 1363 (Fed. Cir. 2003), for example, the Federal Circuit, in reversing the district court's claim construction of the term "boot selection flag," relied on the Microsoft Press Computer Dictionary (3d ed.) for a definition of the term "flag" in its attempt to define the entire phrase, which it noted was modified by the other two words "boot" and "selection."[12]

In order to ascertain the "ordinary meaning," of a word, a trial judge often will consult a dictionary, encyclopedia or treatise, or all three.

As a matter of practice, it should not be assumed that a computer term will have a similar definition in different authorities, much in the way that nontechnical terms or even established scientific terms do. While there is widespread acceptance of the Physician's Desk Reference (PDR) in pharmaceuticals, for example, there is no equivalently recognized reference in the computer field. In fact, a search for a definition through a number of authorities to locate one that best suits a position should be undertaken.

Further, the appropriate edition of the reference material should be used. Because a patent may be in litigation several years after it is issued, a source publicly available at the time the patent issued should be consulted to determine the meaning of a particular disputed term.[13] Therefore, it is good practice to save old editions of dictionaries, treatises and encyclopedias and to maintain a list of book dealers and retail publishers from whom these reference materials can be purchased. In fact, many of these reference materials can be purchased directly from online vendors.

Conclusion

As a result of the Supreme Court's determination that claim construction is, as a matter of law, solely within the province of the trial judge, *Markman* hearings have become de rigueur in patent litigation cases. With the increasing number of patents related to computers and computer technology being filed, more computer terms are likely to become the subject of claim construction hearings. Consequently, patent attorneys handling these cases will need to be aware of certain pitfalls and examine particular issues very carefully as the computer industry continues to evolve and change so swiftly.

(1) "Hyperlink" and "firewall" have made it into the Merriam-Webster Online dictionary, while "blog" has yet to appear there. See www.m-w.com. New meanings also have been given to existing words such as cookie, server, and mouse.

(2) *In Re Paulsen*, 30 F3d 1475, 1480 (Fed. Cir. 1994).

(3) Id.

(4) See *PSC Computer Products, Inc. v. Foxconn International, Inc. and Hon Hai Precision Industry Co., Ltd.*, 2004 U.S. App. LEXIS 776 (Fed. Cir. Jan. 20, 2004).

(5) See, e.g, *Vitronics Corp. v. Conceptronic, Inc.*, 90 F3d 1576 (Fed. Cir. 1996); See also, *Chad Industries, Inc. v. Automation Tooling Systems, Inc.*, 938 FSupp 601 (C.D. Cal. 1996).

(6) See e.g., *Vitronics*, supra n. 5.

(7) See e.g., *Rohm & Haas Co. v. Lonza Inc.*, 997 FSupp 635 (E.D. Pa. Feb. 11, 1998).

(8) See e.g, *Texas Digital Systems v. Telegenix, Inc.*, 308 F3d 1193 (Fed. Cir. 2002); *AT&T Corporation v. Microsoft Corporation*, 2003 USDistLEXIS 10716 (SDNY June 23, 2003), partial summary judgment granted, 290 FSupp2d 409, 2003 U.S. Dist. LEXIS 19738 (SDNY Nov. 5, 2003).

(9) *Texas Digital Systems v. Telegenix, Inc.*, 308 F3d 1193, 1202-1203 (Fed. Cir. 2002).

(10) Id. at 1203.

(11) Id.

(12) *Altris, Inc. v. Symantec Corp.*, 318 F3d 1363, 1372-1374 (Fed. Cir. 2003).

(13) See *Texas Digital Systems*, supra. n. 8.

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