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## Applying the Rationales of Patent Claim Construction Doctrines to Interpretation of Patent Statutes

Grace Pak

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# Applying the Rationales of Patent Claim Construction Doctrines to Interpretation of Patent Statutes

by  
GRACE PAK<sup>♦</sup>

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## I. Introduction

In *Microsoft v. AT&T*, the U.S. Supreme Court held that Microsoft did not infringe AT&T’s software patent under 35 U.S.C. § 271(f).<sup>1</sup> The issue in the case was largely one of statutory interpretation, to which the Court applied a strict textual approach.<sup>2</sup> However, applying a different theory of statutory interpretation, namely purposivism, would have yielded a radically different holding. Indeed, the Court of Appeals for the Federal Circuit’s application of purposivism in interpreting § 271(f) led to a finding that Microsoft did infringe AT&T’s software patent.<sup>3</sup>

Both the textual and purposivist theories of statutory interpretation, as well as the third major theory of statutory interpretation—intentionalism—boast advantages, but also suffer flaws. All three theories are in tension with

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1. *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 442 (2007).

2. *Id.* at 452–54.

3. *AT&T Corp. v. Microsoft Corp.*, 414 F.3d 1366, 1371–72 (Fed. Cir. 2005).

each other, and no one theory has proven itself as the dominant theory of interpretation.<sup>4</sup> This note argues that in the context of patent law, strict textualism should rarely, if ever, prevail in statutory interpretation. Rather, purposivism should be a driving force behind the interpretation of patent statutes. This conclusion is largely based on an analysis of claim construction doctrines in patent law.

First, this note provides background on the three foundational theories of statutory interpretation. Then, this note discusses the Supreme Court's textualist analysis in interpreting 35 U.S.C. § 271(f) in *Microsoft v. AT&T*<sup>5</sup> and contrasts this analysis to the Federal Circuit's purposivist approach in interpreting the same statute.<sup>6</sup> Next, this note explores the problems associated with textualism in patent law, such as in *Microsoft v. AT&T*. Finally, this note examines the rationales behind certain claim construction doctrines in patent law and submits that those same rationales vouch for a purposivist approach to interpreting patent statutes. Accordingly, this note concludes that patent statutes are particularly ill-suited candidates for textualism, but particularly well-suited candidates for purposivism. As such, this note argues that the Supreme Court's statutory interpretation of § 271(f) was too strict, while the Federal Circuit's statutory interpretation of § 271(f) was more appropriate.

## II. Background

### A. The Three Foundational Theories of Statutory Interpretation

The three foundational theories of statutory interpretation are textualism, intentionalism, and purposivism.<sup>7</sup> Textualism gives the words of the statute primacy—statutes are interpreted by focusing on the apparent literal commands of the statutory text.<sup>8</sup> Textualism is related to the “plain meaning rule,” which gives the words of a statute their plain and ordinary meaning.<sup>9</sup> Intentionalism aims to uncover the intent of the legislature enacting the statute.<sup>10</sup> Specifically, intentionalism looks into how the legislature would have resolved the specific fact situation before the court by examining the legislative history in order to glean what the legislature intended when it

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4. William N. Eskridge, Jr. & Philip P. Frickey, *Statutory Interpretation as Practical Reasoning*, 42 STAN. L. REV. 321, 324–25 (1990).

5. *Microsoft*, 550 U.S. at 449.

6. *AT&T*, 414 F.3d at 1371.

7. Eskridge & Frickey, *supra* note 4, at 324.

8. *Id.*

9. *Id.* at 340.

10. *Id.* at 324.

enacted the statute.<sup>11</sup> Purposivism calls for identifying the purpose behind a statute and interpreting the statute in a way that furthers that purpose.<sup>12</sup> Purposivism grew out of the “mischief rule.” This rule provides that a court should determine the mischief the legislature targeted in enacting a statute, and then apply that statute to expunge that mischief as presented in the current fact situation.<sup>13</sup>

Purposivism is different from, and more flexible than, intentionalism because purposivism does not focus on how the legislature would have handled the specific fact situation before the court.<sup>14</sup> Rather, purposivism looks to the general purpose that motivated enactment of the statute.<sup>15</sup> To draw an analogy to criminal law, intentionalism is to specific intent as purposivism is to general intent.<sup>16</sup>

Purposivism is also more flexible than textualism because purposivism is not limited by the fixed words of the statute.<sup>17</sup> In contrast to purposivism, textualism might bring about an interpretation that is completely at odds with the purpose of the statute.<sup>18</sup> For example, in *United Steelworkers of America v. Weber*, the plaintiff attacked affirmative action in the employment context, by using a textual interpretation of Title VII of the Civil Rights Act of 1965.<sup>19</sup> The Supreme Court recognized that a literal textual interpretation of the statute would prohibit affirmative action because the statute made it unlawful to “discriminate . . . because of . . . race” in employment.<sup>20</sup> Nevertheless, guided by the purpose of the statute—the integration of blacks into mainstream American society—the Court upheld affirmative action.<sup>21</sup> Textualism proponents counter that it is the *words* that Congress enacted into law and not the legislature’s purpose or intent, and thus it is the *words* which carry the force of law.<sup>22</sup>

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11. *Id.* at 326.

12. *Id.* at 324.

13. WILLIAM P. STATSKY, *LEGISLATIVE ANALYSIS AND DRAFTING* 77 (John F. O’Connell & Bruce Comly French eds., West Publ’g Co. 2d ed. 1984) (1975).

14. Eskridge & Frickey, *supra* note 4, at 332–33.

15. HENRY M. HART, JR. & ALBERT M. SACKS, *THE LEGAL PROCESS: BASIC PROBLEMS IN THE MAKING AND APPLICATION OF LAW* 1124 (William N. Eskridge, Jr. & Philip P. Frickey eds., 1994).

16. William N. Eskridge, Jr., *Symposium on Statutory Interpretation: Legislative History Values*, 66 CHI.-KENT. L. REV. 365, 367 (1990).

17. Eskridge & Frickey, *supra* note 4, at 340.

18. *Id.* at 333.

19. *United Steelworkers of America v. Weber*, 443 U.S. 193, 201 (1979).

20. *Id.*

21. *Id.* at 201–02.

22. ANTONIN SCALIA, *A MATTER OF INTERPRETATION: FEDERAL COURTS AND THE LAW* 17 (Amy Gutmann ed., 1997).

This note analyzes how the justifications and flaws behind these statutory interpretation theories pan out in patent law, in particular by focusing on the Federal Circuit's statutory interpretation of 35 U.S.C. § 271(f) in *AT&T v. Microsoft*<sup>23</sup> and the Supreme Court's review thereof.<sup>24</sup>

#### B. The Supreme Court's Textualism in *Microsoft v. AT&T*

In *Microsoft v. AT&T*, the Supreme Court adhered to textualism in interpreting 35 U.S.C. § 271(f) and struck down the Federal Circuit's purposivist approach of interpretation.<sup>25</sup> Generally, patent law is territorial—an owner of a United States patent has rights only within the United States.<sup>26</sup> However, § 271(f) allows a U.S. patent owner to reach certain acts of infringement that fall outside of the U.S.<sup>27</sup>

In *Microsoft v. AT&T*, the Supreme Court held that Microsoft's Windows operating system incorporated software that infringed AT&T's software patent, but only when Windows was installed and run on a computer.<sup>28</sup> However, Windows, in the abstract, such as Windows on a CD in a box in a store, did not infringe AT&T's patent.<sup>29</sup> Microsoft made a master copy of Windows in the United States and shipped it abroad, where foreign manufacturers made copies from that master copy.<sup>30</sup> The foreign manufacturers then installed those copies on foreign computers.<sup>31</sup>

AT&T filed suit against Microsoft alleging that it was liable as an infringer under § 271(f),<sup>32</sup> which assigns liability to whoever, without authority, supplies or causes to be supplied in or from the United States:

- (1) all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States . . . [or]
- (2) any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or

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23. *AT&T Corp. v. Microsoft Corp.*, 414 F.3d 1366 (Fed. Cir. 2005).

24. *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437 (2007).

25. *Id.* at 457.

26. *Id.* at 444.

27. 35 U.S.C. § 271(f) (2006).

28. *Microsoft*, 550 U.S. at 446.

29. *Id.*

30. *Id.* at 445–46.

31. *Id.*

32. *Id.* at 441–42.

commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States . . . .<sup>33</sup>

At issue in this case was whether Microsoft supplied “components” within the meaning of § 271(f), consequently making it liable for infringing AT&T’s patent.<sup>34</sup> If “components” referred to the *copies* of Windows that were generated and installed on computers abroad, Microsoft would not have supplied “components” because Microsoft only supplied the master copy, not the copies that were actually installed on computers abroad.<sup>35</sup> In contrast, if “components” referred to Windows in the abstract—without a physical embodiment—Microsoft would have supplied a “component” and would hence be liable under § 271(f).<sup>36</sup> The District Court found Microsoft liable and the Federal Circuit affirmed, but the Supreme Court reversed the ruling.<sup>37</sup>

The Supreme Court began its opinion by interpreting the term “components” in § 271(f).<sup>38</sup> The Court reasoned that “components” must be amenable to combination because the text of § 271(f) indicated as much.<sup>39</sup> Section 271(f)(1) provides that it applies to “components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components.”<sup>40</sup> Windows in the abstract, detached from a physical medium, is not amenable to combination.<sup>41</sup> Thus, the Court held that Windows in the abstract did not qualify as a “component” under § 271(f).<sup>42</sup>

The Court’s textualism stands in stark contrast to the purposivist approach the Federal Circuit adopted in interpreting § 271(f).<sup>43</sup> The Federal Circuit rejected such a reading of “component” because doing so would create a loophole through § 271(f), making it easy to avoid liability.<sup>44</sup> This

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33. 35 U.S.C. § 271(f).

34. *Microsoft*, 550 U.S. at 447.

35. *Id.* at 448–49.

36. *Id.*

37. *Id.* at 447.

38. *Id.* at 449.

39. *Id.*

40. 35 U.S.C. § 271(f)(1).

41. *Microsoft*, 550 U.S. at 449–50.

42. *Id.* at 452.

43. *AT&T Corp. v. Microsoft Corp.*, 414 F.3d 1366, 1371 (Fed. Cir. 2005).

44. *Id.*

was especially true for software patents because software is easily copied.<sup>45</sup> Instead, the Federal Circuit focused on the remedial nature of § 271(f) and condemned a technical avoidance of the statute that ignored technological advances developed after § 271(f) was enacted.<sup>46</sup> The Federal Circuit elaborated that if Microsoft were allowed to avoid infringement, the court would be “subverting the remedial nature of § 271(f), permitting a technical avoidance of the statute by ignoring the advances in a field of technology—and its associated industry practices—that developed after the enactment of § 271(f).”<sup>47</sup> Hence, the court explained that “[§] 271(f), if it is to remain effective, must therefore be interpreted in a manner that is appropriate to the nature of the technology at issue.”<sup>48</sup>

The legislature designed the remedial nature of § 271(f) to remedy the mischief in *Deepsouth Packing Co. v. Laitram Corp.*<sup>49</sup> In *Deepsouth*, Laitram held a patent for a shrimp deveining machine.<sup>50</sup> Deepsouth made the parts of Laitram’s patented machine and sold those parts abroad.<sup>51</sup> Those parts were then assembled for use abroad.<sup>52</sup> United States Patent Law prohibits making and selling a patented machine, but at the time *Deepsouth* was decided, patent law did not prohibit making and selling *parts* of a patented machine.<sup>53</sup> Thus, the Supreme Court held that Deepsouth did not infringe Laitram’s patent.<sup>54</sup> In direct response to this decision, Congress enacted § 271(f), which made it an act of infringement to supply components of a patented machine.<sup>55</sup> Accordingly, the Federal Circuit focused on the mischief that § 271(f) was designed to remedy and interpreted § 271(f) in a way that would combat that mischief.<sup>56</sup>

In contrast, the Supreme Court rejected the Federal Circuit’s purposivist approach to interpreting § 271(f) and advocated a textual interpretation of “component.”<sup>57</sup> The Court reasoned that Congress could have chosen words such as “information, instructions, or tools from which those components readily may be generated,” but it did not.<sup>58</sup> Further, the Court noted that §

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45. *Microsoft*, 550 U.S. at 451.

46. *AT&T*, 414 F.3d at 1371.

47. *Id.*

48. *Id.*

49. *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518, 522–24 (1972).

50. *Id.* at 519.

51. *Id.* at 523.

52. *Id.*

53. *Id.* at 532.

54. *Id.*

55. *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 444–45 (2007).

56. *AT&T Corp. v. Microsoft Corp.*, 414 F.3d 1366, 1371 (Fed. Cir. 2005).

57. *Microsoft*, 550 U.S. at 451–59.

58. *Id.* at 451.

271(f) contains no textual indication that ease of copying is a relevant factor in determining liability.<sup>59</sup> Finally, the Court explained that the loophole was for Congress to consider, not for the courts to close as they saw fit.<sup>60</sup> Thus, based on a textualist interpretation of § 271(f), the Supreme Court held that Microsoft did not infringe AT&T's patent under § 271(f).<sup>61</sup>

### III. Analysis: The Problems with Textualism in Patent Law

This note argues that textualism was an improper approach to interpreting § 271(f), as applied to the facts of *Microsoft v. AT&T*. More broadly, it is improper to examine patent statutes from a strict textualist lens when a fact pattern concerns technological advances in patent law. Instead, purposivism should be a considerable force behind the interpretation of patent statutes.

One notable problem with textualism is that it assumes the statutory text offers a complete and reasonably determinate source of meaning, but often it does not.<sup>62</sup> Strict textualism's requirement of staying within the confines of the text exacerbates this problem; one must determine statutory meaning without reference to context.<sup>63</sup> When the text of a statute is applied to fact patterns unforeseen by the legislature, it becomes likely that the statutory text will fail to reveal a complete and reasonably determinate meaning. This is especially true when the text of a patent statute is applied to future technology because the words to describe that future technology may not have existed at the time the statute was enacted.<sup>64</sup> In such a case, it is difficult to see how a determinate meaning could be gleaned from the statutory text that is applied to unforeseen future technology. This is one reason why textualism should not be the sole statutory regime in the area of patent law.

Many statutes suffer from this problem. The legislature drafts statutes from a predictive angle, keeping in mind that society and technology are in a state of constant flux. However, this problem is heightened in patent law because the very goal of patent law is to "*promote* the Progress of Science and useful Arts."<sup>65</sup> Patent law, by its very nature, is a uniquely hyper-dynamic area of law. As a result, patent law naturally encounters a formidable number of novel situations, both in volume and in frequency in the courts. When dealing with a legal issue in patent law, the Court necessarily grapples with inventive

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59. *Id.* at 453.

60. *Id.* at 457.

61. *Id.* at 458.

62. Eskridge & Frickey, *supra* note 4, at 341.

63. *Id.* at 342.

64. *Autogiro Co. of Am. v. United States*, 384 F.2d 391, 397 (Ct. Cl. 1967).

65. U.S. CONST. art. I, § 8, cl. 8 (emphasis added).

technology. Thus, patent law has a special need for statutes that can be applicable to unforeseen situations.

Despite these concerns, supporters of textualism defend the theory on grounds of reliance and predictability: “citizens ought to be able to read the statute books and know their rights and duties.”<sup>66</sup> However, when a determinate meaning cannot be discerned from the text, these justifications for textualism are insufficient. Without a determinate textual meaning of the statute, reasonable reliance and predictability are untenable. Regarding patent statutes, the situation will often be that a determinate meaning cannot be discerned from the statutory text. Words written in the past will be applied to technological advances made after enactment of the statute. Thus, reliance on and predictability from patent statutes will be relatively rare.

This is not to say that statutory text should be disregarded completely. On the contrary, the statutory text is always the best place to start when interpreting a statute.<sup>67</sup> The point is that the Supreme Court in *Microsoft v. AT&T* was too strict in adhering *only* to textualism, without any heed to purposivism, especially in light of the unique nature of patent law.

#### **IV. Proposal: Interpretation of Patent Statutes Should be Guided by Claim Construction Doctrines**

##### **A. Patent Statutes and Claims are Analogous**

Patent law recognizes textualism’s deficiencies and accommodates those deficiencies with a number of doctrines of claim construction.

In patent law, the claim language delineates the metes and bounds of the inventor’s patent rights.<sup>68</sup> Thus, construing the meaning of claim terms is central to determining the scope of the invention and the rights of the patent holder.<sup>69</sup> For example, in *Phillips v. AWH Corp.*, whether the defendant infringed plaintiff’s patent hinged on whether the term “baffles” in plaintiff’s patent covered baffles at right angles to a wall, or only baffles at oblique angles to a wall.<sup>70</sup> If the former, the defendant infringed, but if the latter, the defendant did not infringe.<sup>71</sup> In another case, the Federal Circuit explained that “[i]mproper claim construction [could] distort the entire infringement

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66. Eskridge & Frickey, *supra* note 4, at 340.

67. *Id.*

68. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005).

69. *Key Mfg. Group, Inc. v. Microdot, Inc.*, 925 F.2d 1444, 1448 (Fed. Cir. 1991).

70. *Phillips*, 415 F.3d at 1309.

71. *Id.*

analysis.<sup>72</sup> Similarly, in *Microsoft v. AT&T*, Microsoft's liability hinged on the interpretation of the term "components" in § 271(f).<sup>73</sup>

In fact, claim construction and statutory construction are analogous in many respects. *Black's Law Dictionary* defines "statute" as "[a] law passed by a legislative body . . ." <sup>74</sup> and defines "law" as "[t]he regime that orders human activities and relations . . ." <sup>75</sup> A criminal statute, for instance, is "[a] law that defines, classifies, and sets forth punishment for one or more specific crimes." <sup>76</sup> Similarly, a patent claim delineates the scope of the inventor's monopoly right—as determined by the exact nature of his invention—and anyone who infringes that right is liable.<sup>77</sup> Thus, both claim drafting and statute drafting entail using words to convey an abstract, imprecise, but prodigious concept. In construing those words, both claim construction and statutory interpretation involve transforming abstractions into precise contours to apply to specific facts. Further, both claims and statutes serve the purpose of providing notice to the public at large of what is legal and not legal.<sup>78</sup> Thus, only one correct interpretation applies to all persons.<sup>79</sup>

Patent law has developed a number of doctrines of claim construction, some of which are direct consequences of the imprecision of words used in describing inventions.<sup>80</sup> Such words do not suddenly gain precision when taken out of the context of patent claims and put into patent statutes. Accordingly, claim construction doctrines should inform the interpretation of patent statutes.

## **B. Claim Construction Involves Reference to Sources Other than the Claim Itself**

A principle doctrine of claim construction is that "words of a claim are generally given their ordinary and customary meaning."<sup>81</sup> At first blush, this tenet of claim construction appears similar to the "plain meaning rule." However, claim terms are not construed in a vacuum.<sup>82</sup> Rather, the ordinary and customary meaning of a claim term is discerned by reference to sources other than the claim itself, such as the specification and prosecution history.<sup>83</sup>

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72. *Key Mfg. Group*, 925 F.2d at 1448.

73. *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 446-47 (2007).

74. BLACK'S LAW DICTIONARY 1448 (8th ed. 2004).

75. *Id.* at 900.

76. *Id.* at 1448.

77. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005).

78. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 987 (Fed. Cir. 1995).

79. *Id.*

80. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002).

81. *Phillips*, 415 F.3d at 1312.

82. *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005).

83. *Phillips*, 415 F.3d at 1313.

Patent law allows reference to sources outside of the claim itself because it recognizes the importance of context in interpreting inherently imprecise words that are used to describe inventive technology.<sup>84</sup>

The patent specification is one important source of context that can illuminate the meaning of a claim term.<sup>85</sup> The patent specification describes what the claimed invention is and how to make and use it.<sup>86</sup> The specification “is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.”<sup>87</sup>

Prosecution history is another source for illuminating the meaning of a claim term.<sup>88</sup> The patent prosecution history is a record of the proceedings between the inventor and the Patent Office during the period when the inventor applies for a patent.<sup>89</sup> It represents a negotiation, during which the inventor attempts to obtain a patent.<sup>90</sup> It provides evidence of how the inventor regarded his invention.<sup>91</sup>

Just as the claim interpreter is allowed to, even encouraged to, look to sources beyond the claim, so too should the patent statute interpreter look to sources other than the statutory text. One such notable source of statutory interpretation is legislative history. In fact, legislative history and prosecution history share many similarities. Legislative history, in the same way as prosecution history, represents a negotiation. Further, both provide evidence of the drafters’ view of the subject matter at hand, a view that came from dialogue and deliberation.

Concededly, legislative history has been criticized for being more confusing than clarifying,<sup>92</sup> just as prosecution history has been criticized for lacking clarity.<sup>93</sup> For this reason, the Federal Circuit has held that prosecution history is less useful as an interpretive source of claim construction.<sup>94</sup> However, patent law recognizes that prosecution history can be a valuable interpretive source in the right circumstances.<sup>95</sup> Patent law does not categorically condemn any and all resort to prosecution history as an

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84. *Medrad*, 401 F.3d at 1319.

85. *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

86. 35 U.S.C. § 112 (2006).

87. *Vitronics*, 90 F.3d at 1582.

88. *Phillips*, 415 F.3d at 1317.

89. *Id.*

90. *Id.*

91. *Id.*

92. *Conroy v. Aniskoff*, 507 U.S. 511, 519 (1993) (Scalia, J., concurring) (observing that legislative history is indeterminate, and therefore confusing).

93. *Phillips*, 415 F.3d at 1317.

94. *Id.*

95. *Id.*

interpretive source.<sup>96</sup> Similarly, although there is nothing directly analogous to the specification in patent statutes, patent law recognizes the importance of resorting to sources outside of the legally operative words themselves.

### **C. Patent Law Accommodates the Inability of Words to Keep Up with the Pace of Inventions**

Two other doctrines of claim construction stem directly from the recognition that words are imperfect at describing inventions. It proves particularly problematic to describe inventions because words are unable to keep up with the pace of innovation.<sup>97</sup> Because an invention is, by definition, new, words do not always exist to describe an invention.<sup>98</sup> To overcome this lag, patent law provides two doctrines of claim interpretation. First, an inventor is his own lexicographer.<sup>99</sup> That is, an inventor has license to make up and define words in any way he chooses. Second, the role of dictionaries in claim interpretation is deemphasized.<sup>100</sup> Since an inventor has license to define his own words, and the inventor did not write the dictionary, the dictionary meaning of words can conflict with the proper meaning of claim terms.<sup>101</sup> While consultation with a dictionary is not inappropriate when interpreting claim terms, the inventor's definition of a term, as provided in the claims, specification, and prosecution history, is paramount over the dictionary's meaning of the term.<sup>102</sup>

These two doctrines of claim construction arose to accommodate the difficulty of describing inventions with existing vocabulary. This inadequacy of words is no different in patent statutes than in patent claims. Thus, interpretation of patent statutes should be flexible enough to accommodate for the inherent imprecision of words.

### **D. The Doctrine of Equivalents Can Expand the Literal Scope of a Patent Claim**

Finally, the doctrine of claim interpretation that stands in most contrast to textualism is the Doctrine of Equivalents. The Doctrine of Equivalents allows a patentee to expand the scope of his patent right beyond the literal scope of his claims.<sup>103</sup> Thus, even if a product or process does not fit the

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96. *Id.*

97. *Autogiro Co. of Am. v. United States*, 384 F.2d 391, 397 (Ct. Cl. 1967).

98. *Id.*

99. *Id.*

100. *Phillips*, 415 F.3d at 1321–22.

101. *Id.* at 1321.

102. *Id.* at 1322–23.

103. 5B DONALD S. CHISUM, CHISUM ON PATENTS § 18.04 (Matthew Bender & Co., Inc. 2007) (1978).

literal definition of the invention provided by a patent claim, it may still be held to infringe the patent claim under the Doctrine of Equivalents.<sup>104</sup>

One purpose behind the Doctrine of Equivalents is to prevent unscrupulous copyists from making unimportant and insubstantial changes to the invention that would take the copied matter outside the literal scope of the claim.<sup>105</sup> In other words, the Doctrine of Equivalents exists to protect the benefit of the invention.<sup>106</sup> Without the Doctrine of Equivalents, the value of a patent could be destroyed by simple acts of copying.<sup>107</sup> The Supreme Court has reasoned that “[i]f patents were always interpreted by their literal terms, their value would be greatly diminished.”<sup>108</sup> The unscrupulous copyist of a patented invention also exists in the realm of patent statutes—he is the one who exploits loopholes in patent statutes. Because the rule of law prohibits the unscrupulous copyist from stealing the benefit of an invention, it should also prohibit the loophole exploiter from bypassing the snares of a patent statute.

Another purpose behind the Doctrine of Equivalents is to allow the inventor to capture future technology.<sup>109</sup> Often, future technology is unforeseeable by the inventor and thus impossible to describe, yet the future technology emerges substantially the same as the inventor's creation.<sup>110</sup> Patent law allows a patent holder to reach such after-arising technology through the Doctrine of Equivalents. Similarly, patent statutes should also reach such after-arising technology. Just as the Federal Circuit reasoned in *AT&T v. Microsoft*, courts should not permit “a technical avoidance of the statute by ignoring the advances in a field of technology—and its associated industry practices—that developed after the enactment of § 271(f).”<sup>111</sup> The Federal Circuit's reasoning behind its interpretation of § 271(f) is analogous to that of the Doctrine of Equivalents. In *Datascope Corp. v. SMEC, Inc.*, the Federal Circuit Court explained the rationale behind the Doctrine of Equivalents: “an embellishment made possible by technological advances may not permit an accused device to escape the web of infringement.”<sup>112</sup>

These purposes behind the Doctrine of Equivalents stem from the insight that it is unreasonable to expect an inventor to draft impenetrable claim

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104. *Id.*

105. *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 607 (1950).

106. *Id.*

107. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002).

108. *Id.*

109. *Varco, L.P. v. Pason Sys. USA Corp.*, 436 F.3d 1368, 1376 (Fed. Cir. 2006).

110. *Id.*

111. *AT&T Corp. v. Microsoft Corp.*, 414 F.3d 1366, 1371 (Fed. Cir. 2005).

112. *Datascope Corp. v. SMEC, Inc.*, 776 F.2d 320, 326 (Fed. Cir. 1985).

language.<sup>113</sup> Claim language that contemplates future technology is especially problematic.<sup>114</sup> As such, patent law does not require an inventor to predict and describe every conceivable embodiment of his invention.<sup>115</sup> It is similarly unreasonable to expect Congress to draft perfect impenetrable language in a patent statute that encompasses all fact situations, including unforeseeable fact situations involving future technology.

It may seem that, because Congress has the opportunity to amend a statute once it realizes an unforeseen problem, while an inventor cannot, the inventor has more of a need for doctrines such as the Doctrine of Equivalents. However, through the Reissue Application process, the inventor actually does have an opportunity to amend his claims after his patent issues, similar to Congress' ability to amend statutes.<sup>116</sup> The Reissue process allows the patentee to return to the Patent Office to obtain broader claims under certain situations.<sup>117</sup> Thus, Congress and inventors can fairly face similar standards for drafting. Namely, Congress should not be required to predict and describe every conceivable situation where the statute might be applicable, as inventors are not imposed with such a requirement.

There must be some guiding principle circumscribing the expansion of claim meaning beyond its literal meaning. The "triple identity" test is one test for determining equivalence.<sup>118</sup> The "triple identity" test provides that a product accused of infringement is deemed equivalent to the claimed invention if the accused product performs substantially the same function, in substantially the same way, to yield substantially the same result as the claimed invention.<sup>119</sup> Under a second test, an accused product is deemed equivalent if there is only an insubstantial change between the accused product and the invention.<sup>120</sup> Each test may be more suited to one case or another, depending on the facts of each case.<sup>121</sup> One might call these tests a search for the "spirit" of the claimed invention. In other words, an accused product is deemed an equivalent if it infringes the "spirit" of the claimed invention.

Just as the spirit of the invention guides application of the Doctrine of Equivalents, the spirit of the statute should guide interpretation of a patent statute. Indeed, a similar principle guides purposivism in statutory

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113. *Festo*, 535 U.S. at 731.

114. *Varvo*, 436 F.3d at 1376.

115. *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985).

116. 35 U.S.C. § 251 (2006).

117. *Id.*

118. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 39–40 (1997).

119. *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608 (1950) (quoting *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42 (1929)).

120. *Id.* at 610.

121. *Warner-Jenkinson*, 520 U.S. at 40.

interpretation. As Justice Brewer famously said in *Church of the Holy Trinity v. United States*, “[i]t is a familiar rule, that a thing may be within the letter of the statute and yet not within the statute, because not within its spirit . . . .”<sup>122</sup> Thus, the Supreme Court interpreted the statute at issue by following the spirit of the statute instead of the letter of the statute.<sup>123</sup>

Proponents of textualism argue that following the spirit of a statute could distort the literal meaning of the statutory text and thus erode public notice.<sup>124</sup> A similar criticism exists as to the Doctrine of Equivalents.<sup>125</sup> Critics of the Doctrine of Equivalents argue that it has the potential to erode public notice because the public may not be able to rely on the literal meaning of a claim.<sup>126</sup>

However, the Doctrine of Equivalents does not provide free reign to interpret claim scope in any way one chooses. Infringement under the Doctrine of Equivalents is the exception, not the rule, and it is to be applied cautiously.<sup>127</sup> Courts have placed many restrictions on its use to help preserve the public notice function of patent claims. For example, the Doctrine of Equivalents cannot be used to vitiate a claim limitation entirely.<sup>128</sup> While the Doctrine of Equivalents may be used to broaden the meaning of the claim limitation somewhat, it may not be used to broaden the meaning of the claim limitation so much that it renders the claim limitation meaningless.<sup>129</sup> Other limitations on the Doctrine of Equivalents include prosecution history estoppel,<sup>130</sup> public dedication,<sup>131</sup> and ensnaring prior art.<sup>132</sup> Notwithstanding, the Doctrine of Equivalents is an established doctrine with a long lineage.<sup>133</sup> In the right circumstances, the Doctrine of Equivalents has sound justifications, while not vitiating the central functions of patent claims.<sup>134</sup> Purposivism should apply to interpretation patent statutes in a similar manner

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122. *Church of the Holy Trinity v. United States*, 143 U.S. 457, 459 (1892).

123. *Id.* at 465. (holding that importation of a minister from overseas does not violate the statute’s mandate against “the importation and migration of foreigners and aliens . . . to perform labor in the United States” because the spirit of the statute was directed only against cheap unskilled labor, not brain toilers or ministers).

124. Eskridge & Frickey, *supra* note 4, at 340.

125. *Wallace London & Clemco Products, Inc. v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538 (Fed. Cir. 1991).

126. *Id.*

127. *Id.*

128. *Novartis Pharm. Corp. v. Eon Labs Mfg., Inc.*, 363 F.3d 1306, 1312 (Fed. Cir. 2004).

129. *Nautilus Group, Inc. v. Icon Health & Fitness, Inc.*, 308 F. Supp. 2d 1217, 1219 (W.D. Wash. 2003).

130. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 737–38 (2002).

131. *Johnson & Johnston Assocs. v. R.E. Serv. Co.*, 285 F.3d 1046, 1053 (Fed. Cir. 2002).

132. *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 684 (Fed. Cir. 1990).

133. CHISUM ON PATENTS, *supra* note 103.

134. *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 114 F.3d 1161, 1164 (Fed. Cir. 1997).

to the way the Doctrine of Equivalents applies in construction of patent claims.

## V. Conclusion

In *Microsoft v. AT&T*, the Supreme Court was too rigid in only looking at the text of 35 U.S.C. § 271(f). In contrast, the Federal Circuit took the more appropriate approach when it explained that “[§] 271(f), if it is to remain effective, must therefore be interpreted in a manner that is appropriate to the nature of the technology at issue.”<sup>135</sup> The court reasoned that permitting Microsoft to escape liability would be tantamount to “subverting the remedial nature of § 271(f), permitting a technical avoidance of the statute by ignoring the advances in a field of technology—and its associated industry practices—that developed after the enactment of § 271(f).”<sup>136</sup>

Whenever a fact pattern calls for applying a patent statute to a situation involving unforeseen technology, such as in *Microsoft v. AT&T*, courts should not exclusively utilize textualism, nor should they categorically disregard purposivism.

Intrinsic traits of patent law make textualism especially problematic in the context of patent statutes. Given that patent law governs inventions, which, by definition, are new, adequate words do not always exist to fully describe an invention.<sup>137</sup> In addition, because the very purpose of patent law is to promote innovation,<sup>138</sup> patent law will encounter a daunting number of unforeseen circumstances. Patent law thus has a higher need for flexible statutes than other areas of law.

Patent law recognizes the problems associated with adhering to a literal meaning of a word used to describe an invention. To account for this, a number of doctrines of claim construction have developed. The Supreme Court’s approach to claim construction should enlighten how patent statutes should be interpreted.

First, context is important in claim construction.<sup>139</sup> The specification and prosecution history are valuable sources in construing the meaning of a claim term.<sup>140</sup> Second, patent law recognizes that the English language cannot keep up with the pace of inventions.<sup>141</sup> Patent law accommodates by allowing the inventor to be his own lexicographer<sup>142</sup> and deemphasizes the role of

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135. *AT&T Corp. v. Microsoft Corp.*, 414 F.3d 1366, 1371 (Fed. Cir. 2005).

136. *Id.*

137. *Autogiro Co. of Am. v. United States*, 384 F.2d 391, 397 (Ct. Cl. 1967).

138. U.S. CONST. art. I, § 8, cl. 8.

139. *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005).

140. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005).

141. *Autogiro*, 384 F.2d at 397.

142. *Id.*

dictionaries in claim construction.<sup>143</sup> Lastly, the Doctrine of Equivalents allows the patentee to expand his patent rights beyond the literal scope of his claim, as long as the “spirit” of the invention is not lost.<sup>144</sup>

Patent law recognizes sound reasons for not confining claim scope to its strict literal text, in certain situations. These same reasons are no different in the world of interpreting patent statutes. Therefore, patent statutes, similar to patent claims, should be flexible enough to accommodate for unscrupulous loophole exploiters and unforeseen technologies.

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143. *Phillips*, 415 F.3d at 1321–22.

144. CHISUM ON PATENTS, *supra* note 103.