

## Claim Construction or Statutory Construction?: A Response to Chiang & Solum

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### INTRODUCTION

“Claim construction” is the process by which a court determines the meaning of a patent’s claims—a process that in turn determines the scope of the covered invention. This process is extremely important because a court must determine what the patent covers before it can determine whether the patent is invalid or infringed.<sup>1</sup> Uncertainty over how a given court will construe a patent’s claims is one of the main problems facing patent professionals.<sup>2</sup> This problem was on the Supreme Court’s mind in *Nautilus, Inc. v. Biosig Instruments, Inc.*, where the Court overturned the Federal Circuit’s standard for claim definiteness,<sup>3</sup> and is also at the forefront of the Court’s upcoming decision in *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, where the Court will consider whether the Federal Circuit, which has exclusive jurisdiction over patent appeals, should continue to review district court claim construction decisions de novo or apply the more deferential clear error standard.<sup>4</sup>

In *The Interpretation-Construction Distinction in Patent Law*, Tun-Jen Chiang and Lawrence Solum offer an innovative analysis of the problem of uncertainty in claim construction outcomes.<sup>5</sup> First, they propose that constitutional law’s interpretation-construction distinction, which separates “interpretation” of a

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1. For a general discussion of claim construction substance and procedure and leading cases, see ROBERT MERGES & JOHN DUFFY, *PATENT LAW: CASES AND MATERIALS* 800-29 (5th ed. 2011); and CRAIG ALLEN NARD, *THE LAW OF PATENTS* 58-86 (2d ed. 2011).

2. See, e.g., Kimberly A. Moore, Markman *Eight Years Later: Is Claim Construction More Predictable?*, 9 LEWIS & CLARK L. REV. 231, 233 (2005) (finding that between 1996 and 2003, the Federal Circuit reversed 34.5% of claim construction cases); see also Tun-Jen Chiang & Lawrence B. Solum, *The Interpretation-Construction Distinction in Patent Law*, 123 YALE L.J. 530, 533 n.1 (2013) (collecting sources).

3. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2129 (2014) (quoting *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228 (1942)) (expressing concern that the Federal Circuit’s definiteness standard created a “zone of uncertainty” for enterprises and researchers trying to decide what claims cover and “bred confusion” among lower courts).

4. See Petition for a Writ of Certiorari at 2-4, *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, No. 13-854 (U.S. Jan. 16, 2014).

5. Chiang & Solum, *supra* note 2, at 534.

legal text’s linguistic meaning from “construction” of its legal effect, can be employed to analyze the process through which judges “interpret” and “construct” patent claims.<sup>6</sup> Second, by applying the distinction to several canonical claim construction cases in which judges have contested the meaning of claim terms,<sup>7</sup> Chiang and Solum convincingly argue that uncertainty in claim construction outcomes is frequently caused by disagreements over policy, not disagreements over the objective meaning of claim language. In other words, claim construction really is about *construction*, not interpretation, of claims. Third, they conclude that the underlying policy debate in claim construction is a conflict between two distinct theories of claim construction: “textualism,” which pursues the linguistic meaning of claim text and often leads to a broader claim scope, and “anti-textualism,” which “pursues the true invention” and often leads to a narrowing of claim scope.<sup>8</sup>

Chiang and Solum’s central example, used throughout their article, is the Federal Circuit’s en banc decision in *Phillips v. AWH Corp.*<sup>9</sup> In *Phillips*, the judges disagreed over whether the claim term “baffles” should be construed according to its ordinary meaning – a structure – or more narrowly, as a structure extending at a particular angle. The majority adopted the broader construction, holding that “baffles,” when read in light of the description and illustrations in the patent’s specification, did not expressly require “baffles” to have any particular angle.<sup>10</sup> Conversely, the dissent argued the court should have affirmed the district court’s narrower construction because the specification indicated that the invention’s intended purpose was to deflect bullets, which could only be done effectively using baffles extending at acute or obtuse angles.<sup>11</sup>

According to Chiang and Solum, the debate in *Phillips* was not over interpretation, but over construction. The judges agreed on what the *linguistic* meaning of “baffles” should be, but not on its ultimate *legal* meaning.<sup>12</sup> The reason for the disagreement, the authors contend, is that the judges applied fundamentally different methodologies: the majority adopted a “textualist” approach, pursuing only the linguistic meaning of claim text; the dissent adopted

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6. See *id.*; see also Lawrence B. Solum, *The Interpretation-Construction Distinction*, 27 CONST. COMMENT. 95, 108 (2010).

7. These canonical cases include: *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc); *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448 (Fed. Cir. 1998) (en banc); and *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370 (1996). For Chiang and Solum’s analysis of these cases, see Chiang & Solum, *supra* note 2, at 566-72, 595-97.

8. See Chiang & Solum, *supra* note 2, at 573, 607.

9. 415 F.3d 1303.

10. See *id.* at 1327.

11. *Id.* at 1329-30 (Lourie, J., concurring in part and dissenting in part).

12. See Chiang & Solum, *supra* note 2, at 569.

an “anti-textualist” approach, going beyond the text to find the “true invention.”<sup>13</sup> Chiang and Solum further link this methodological debate to a policy debate between judges who prefer broader patents and those who prefer narrower ones. Textualist methodologies, they suggest, tend to produce broader rights than anti-textualist methodologies because claims are drafted “by self-interested patentees” who “write the claim text broadly as a general matter.”<sup>14</sup> These disagreements, Chiang and Solum conclude, explain the divided outcome in *Phillips*<sup>15</sup> and are the “most significant source of uncertainty in patent law today.”<sup>16</sup>

Although Chiang and Solum’s methodological approach is different, their diagnosis is consistent with those of other commentators, who have recognized that the Federal Circuit’s claim construction decisions are increasingly panel-dependent.<sup>17</sup> For instance, in a recent empirical study, Thomas Krause and Heather Auyang analyze cases in which judges disagreed over claim construction and conclude that “there are striking differences” among the judges with respect to how they come out in claim construction.<sup>18</sup> Specifically, they find that Judges Linn, Clevenger, and Rader (all members of the *Phillips* majority) are more likely to broaden patent scope, while Judges Lourie and Newman (both members of the *Phillips* dissent) are more likely to narrow patent scope,<sup>19</sup> and that, with the exception of Judge Moore, this distribution aligns with the judges’ pro- and anti-patentee holdings.<sup>20</sup> Like Chiang and Solum, Krause and

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13. *Id.* at 569-70, 573.

14. *Id.* at 580.

15. *See id.* at 581-82.

16. *Id.* at 605.

17. Polk Wagner was an early observer of this phenomenon. Wagner created an online calculator that would predict the case outcomes based on the identities of the judges assigned to the panel. *See* Crissa A. Seymour Cook, Comment, *Constructive Criticism: Phillips v. AWH Corp. and the Continuing Ambiguity of Patent Claim Construction Principles*, 55 U. KAN. L. REV. 225, 226 n.4 (2006) (citing Wagner’s “Claim Construction Project”); *see also* R. Polk Wagner & Lee Petherbridge, *Did Phillips Change Anything? Empirical Analysis of the Federal Circuit’s Claim Construction Jurisprudence*, in *INTELLECTUAL PROPERTY AND THE COMMON LAW* 123, 128 (Shyamkrishna Balganesh ed., 2012) (showing that the judges on the Federal Circuit continued to apply “two distinct approaches to claim construction” even after the issue was supposedly resolved in *Phillips*, discussed *infra* Part I.).

18. *See* Thomas W. Krause & Heather F. Auyang, *What Close Cases and Reversals Reveal About Claim Construction at the Federal Circuit*, 12 J. MARSHALL REV. INTELL. PROP. L. 583, 584 (2013). Chiang and Solum cite Krause and Auyang’s study as an exception to the “wide agreement” that uncertainty is caused by linguistic ambiguity. *See* Chiang & Solum, *supra* note 2, at 534 & n.9 (citing Krause & Auyang, *supra*).

19. *See* Krause & Auyang, *supra* note 18, at 595.

20. *See id.* at 590 figs.6 & 8 (Judges Clevenger and Linn); *id.* at 591 fig.9 (Judge Lourie); *id.* at 592 fig.12 (Judge Newman); *id.* at 593 fig.16 (Chief Judge Rader); *id.* at 596 (noting that Judge Moore is an “exception[.]”).

Auyang link these observed differences to the debate over whether judges should “determine what the inventor actually invented” and “limit the claims accordingly” or construe claims according to their linguistic meaning.<sup>21</sup>

Chiang and Solum’s conclusions concerning uncertainty in claim construction – that claim construction debates are debates over construction, not interpretation, and that the core policy debate concerns patent scope – are persuasive. However, in applying the interpretation-construction distinction, Chiang and Solum should be more attentive to the institutional context in which patent claim construction occurs. Unlike in constitutional law, where judges operate within a broad “construction zone”<sup>22</sup> and outcomes are “essentially driven by normative concerns,”<sup>23</sup> in patent law, judges do not construct patent claims in isolation. Instead, their actions are constrained by the Patent Act’s requirements. At a conceptual level, the Patent Act restricts judges’ discretion during claim construction. The Act establishes minimum standards of disclosure that patentees must meet when drafting claims.<sup>24</sup> Under 35 U.S.C. § 112(a), a patent claim is legally invalid if it is not supported by a specification that includes, at minimum, details of the invention that are sufficient to permit “any person skilled in the art” to make and use it.<sup>25</sup> Under § 112(b), a claim is invalid if it does not conclude with “one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or joint inventor regards as the invention.”<sup>26</sup> Regardless of whether a judge adopts a “textualist” or “anti-textualist” approach to claim construction, he or she must enforce these minimum standards of disclosure when deciding what a patent’s claims mean.

This is not to say that, in practice, debates over policy do not enter into claim construction and affect outcomes. To the contrary, even though these requirements are statutory, judges have very different views about how much disclosure or definiteness the law requires, and they engage in significant *statutory construction* when defining the precise contours of § 112. This is consistent with the perception that patent law, like other areas of intellectual property law, evolves largely through the common law method. As Craig Nard puts it, the Patent Act serves as the “enabling statute,” leaving “ample room” for courts

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21. *Id.* at 595 (“Judges Lourie, Newman, Plager, Prost, and possibly O’Malley have endorsed [the actually invented] approach, while Chief Judge Rader and Judge Moore have expressly rejected it.”); *see also id.* at 602–03 (collecting cases discussing the “actually invented” standard).

22. Solum, *supra* note 6, at 108.

23. Lawrence B. Solum, *Originalism and Constitutional Construction*, 82 *FORDHAM L. REV.* 453, 472 (2013) (“Constitutional construction is not driven by facts [like interpretation is]. Rather, construction is essentially driven by normative concerns.”).

24. *See* 35 U.S.C. § 112 (2012).

25. *Id.* § 112(a); *see also infra* Part I.

26. *Id.* § 112(b); *see also infra* Part II.

to fill in gaps and generate explanatory doctrine.<sup>27</sup> We argue that what Chiang and Solum identify as “construction,” as opposed to “interpretation,” of patent claims is better understood as statutory construction of § 112, which, in turn, influences how judges construct claims. On this view, differences of opinion over the precise contours of the disclosure requirement—not an adherence to different methodologies of textual analysis—cause uncertainty in claim construction outcomes.

In Parts I and II, we illustrate this subtle, but important distinction between claim construction, in Chiang and Solum’s terminology, and statutory construction. In Part I, we show that several of the cases Chiang and Solum analyze using the interpretation-construction distinction appear to be the direct result of judicial disagreements over whether § 112(a) contains a separate “written description” requirement. In Part II, we suggest that judicial understandings of § 112(b)’s definiteness requirement have also historically influenced judges’ claim construction decisions, representing another example of statutory construction influencing how judges construe claims. Although, like Chiang and Solum’s, our evidence is limited to individual cases, our analysis suggests that statutory construction of § 112 may be partly responsible for the uncertainty in claim construction outcomes motivating Chiang and Solum’s project. In Part III, we discuss the implications of this statutory view of claim construction for the Supreme Court’s upcoming decision in *Teva* addressing whether claim construction is a question of law or fact and the amount of deference that should be granted to lower courts’ claim construction decisions.

## I. THE WRITTEN DESCRIPTION CONTROVERSY

Chiang and Solum argue that debates over policy are responsible for uncertainty in claim construction and represent the “age-old conflict between textualism and anti-textualism” with respect to patent claims.<sup>28</sup> However, many of the cases cited by Chiang and Solum are better read as debates over the proper statutory construction of § 112(a). This section provides:

[A patent’s] specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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27. Craig Allen Nard, *Legal Forms and the Common Law of Patents*, 90 B.U. L. REV. 51, 53 (2010) (“[T]he patent code, much like the Sherman Act, is a common law enabling statute, leaving ample room for courts to fill in the interstices or to create doctrine emanating solely from Article III’s province. Indeed, the common law has been the dominant legal force in the development of U.S. patent law for over two hundred years.”).

28. Chiang & Solum, *supra* note 2, at 573.

art to which it pertains, or with which it is most nearly connected, to make and use the same . . . .<sup>29</sup>

Over the course of history, courts have debated the precise contours of this requirement. Since the late nineteenth century, § 112(a) and its predecessors have been read to require that every patent claim be written so as to “enable” a person of ordinary “skill in the art” to practice the invention without undue experimentation.<sup>30</sup> This enablement requirement limits the scope of the inventor’s exclusive right by creating a general rule that the inventor cannot claim what he or she cannot clearly describe.<sup>31</sup> It also facilitates the patent system’s goal of teaching useful information to others in the field.<sup>32</sup>

Despite general agreement on this basic framework, § 112(a)’s language has generated significant controversy.<sup>33</sup> The most recent debate concerns whether the section requires that a patent specification contain a “written description” of the invention *separate* from the enabling disclosure discussed above. Pursuant to this written description requirement, a patent must show that the inventor “had possession” of the invention at the time the patent application was filed.<sup>34</sup>

The Federal Circuit debated this issue for over a decade<sup>35</sup> until finally deciding in *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.* that § 112(a) contains a separate written description requirement.<sup>36</sup> After discussing the statutory text, Supreme Court precedents, and the distinct roles of the enablement and written description requirements, Judge Lourie, writing for the majority, explained

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29. 35 U.S.C. § 112(a) (2012).

30. *Consol. Elec. Light Co. v. McKeesport Light Co.*, 159 U.S. 465, 474 (1895) (“If the description be so vague and uncertain that no one can tell, except by independent experiments, how to construct the patented device, the patent is void.”).

31. *See O’Reilly v. Morse*, 56 U.S. (15 How.) 62, 119–20 (1854) (invalidating the claim at issue because it was “outside” the specification); *see also MERGES & DUFFY*, *supra* note 1, at 261–65.

32. *See Lisa Larrimore Ouellette, Do Patents Disclose Useful Information?*, 25 HARV. J.L. & TECH. 545 (2012).

33. *See Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1360 (Fed. Cir. 2010) (en banc) (Gajarsa, J., concurring) (“[T]he text of § 112(a) is a model of legislative ambiguity. The interpretation of the statute, therefore, is one over which reasonable people can disagree, and, have so disagreed for the better part of a decade.”).

34. *Id.* at 1351 (majority opinion).

35. *See Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559 (Fed. Cir. 1997). For examples of the other contentious cases involving the written description debate, *see LizardTech, Inc. v. Earth Res. Mapping Inc.*, 424 F.3d 1336 (Fed. Cir. 2005); *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916 (Fed. Cir.); *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 285 F.3d 1013 (Fed. Cir.), *vacated*, 323 F.3d 956 (Fed. Cir. 2002); *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1998).

36. 598 F.3d at 1351.

that pursuant to this requirement a patent must show “possession” at the time of filing and “show that the inventor *actually invented* the invention claimed.”<sup>37</sup> Judges Rader and Linn dissented, arguing that a separate written description requirement was not justified on legal or policy grounds.<sup>38</sup>

As explained in the Introduction, Chiang and Solum classify the Federal Circuit’s leading claim construction case, *Phillips*,<sup>39</sup> where the judges argued over the meaning of the claim term “baffles,” as a debate over claim construction methodology—textualism versus anti-textualism—and policy—broad versus narrow claiming. However, we argue that *Phillips* is better understood as part of the debate over whether § 112 contains a written description requirement, which is ultimately a debate over statutory construction. *Phillips* was decided squarely in the midst of this debate.<sup>40</sup> More importantly, analysis of the case shows that the two issues—whether the meaning of “baffles” should be narrowly construed according to the embodiments disclosed in the specification and whether § 112(a) requires the patentee to describe, as well as enable, the invention—are intertwined.<sup>41</sup> In *Phillips* and *Ariad*, the breakdowns of the judges and their rationales for narrowly/broadly construing “baffles” and adopting/rejecting a written description requirement, respectively, were similar. The *Phillips* majority, joined by Judges Linn, Cleverger, and Rader, the last of whom wrote the *Ariad* dissent, construed “baffles” broadly to cover structures beyond those the specification revealed the inventor possessed.<sup>42</sup> The dissent, written by Judge Lourie and joined by Judge Newman, construed “baffles” narrowly. Consistent with his construction of § 112(a) in cases establishing the written description requirement,<sup>43</sup> Judge Lourie sought to limit the claim according to what the inventor “actually invented.” Because “the specification contains no disclosure of baffles at right angles,” he wrote, the claim could not be construed to include this embodiment.<sup>44</sup>

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37. *Id.* (emphasis added).

38. See *id.* at 1361–67 (Rader, J., dissenting in part and concurring in part); *id.* at 1367–72 (Linn, J., dissenting in part and concurring in part). Judges Rader and Linn had criticized the separate written description requirement in previous cases. See *id.* at 1362 (Rader, J., dissenting in part and concurring in part) (collecting cases); *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 560 F.3d 1366, 1380 (Fed. Cir. 2009) (Linn, J., concurring) (“[E]ngrafting of a separate written description requirement onto section 112[(a)] is misguided.”).

39. 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

40. See cases cited *supra* note 35.

41. Others have noted this link. See MERGES & DUFFY, *supra* note 1, at 820–21 (noting that the majority’s interpretation of “baffles” in *Phillips* was in conflict with a separate “written description” requirement).

42. See *Phillips*, 415 F.3d at 1311 (citing 35 U.S.C. § 112).

43. See *Ariad*, 598 F.3d at 1342 (majority opinion).

44. *Phillips*, 415 F.3d at 1329–30 (Lourie, J., dissenting).

In other words, the *Phillips* dissent narrowed the claim because the claim did not, in their reading of § 112(a), meet the statute’s requirements; the *Phillips* majority broadened the claim due to their perception that it did. This is a debate over statutory construction. Classifying it simply as “claim construction” versus “claim interpretation,” while this might be analytically accurate, misses the meat of what the debate was about—namely, how much disclosure does the Patent Act require?

*Retractable Technologies, Inc. v. Becton, Dickenson & Co.*<sup>45</sup> offers a more recent example of the same phenomenon. As in *Phillips*, the judges’ constructions of the claim term, “body,” mirrored their constructions of § 112(a). Judge Lourie, now writing for the majority and joined by Judge Plager, concluded that “body” referred to only a one-piece syringe body because “a construction of ‘body’ that limits the term to a one-piece body is required to tether the claims to what the specifications indicate the inventor *actually invented*.”<sup>46</sup> This language, although written in the context of claim construction, precisely tracks Judge Lourie’s language in *Ariad* explaining that the specification must contain a written description of the invention in addition to an enabling disclosure. In his concurring opinion, Judge Plager agreed with Judge Lourie’s view that the court should seek to construe claims in accordance with what the patentee “actually invented,” and he made the connection between this standard and § 112(a)’s written description requirement explicit, writing that “claims cannot go beyond the actual invention that entitles the inventor to a patent. For that we look to the written description.”<sup>47</sup> “[M]ore stringent rules,” he concluded, were “need[ed]” to “control” “the curse of indefinite and ambiguous claims, divorced from the written description . . . .”<sup>48</sup> In Judge Plager’s view, and likely those of some members of the majority, the “actually invented” standard for claiming and the written description requirement for disclosure go hand in hand.

In the dissent’s view, in contrast, neither standard is mandated by § 112 or necessary as a policy matter. “The ordinary and customary meaning of ‘body,’” wrote then-Chief Judge Rader, “does not inherently contain a one-piece structural limitation.”<sup>49</sup> “[T]he claims themselves, not the written description portion of the specification, define the patented invention.”<sup>50</sup> It would be “improper to import limitations from the specification into the claims, and th[e] court ha[d] expressly and repeatedly warned against confining claims to specif-

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45. 653 F.3d 1296 (Fed. Cir. 2011).

46. *Id.* at 1305 (emphasis added).

47. *Id.* at 1311 (Plager, J., concurring) (citing 35 U.S.C. § 112).

48. *Id.*

49. *Id.* at 1312 (Rader, C.J., dissenting).

50. *Id.* (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc)).

ic embodiments of the invention set forth in the specification.”<sup>51</sup> Consistent with his opposition to a separate written description requirement and his view that § 112(a) requires less disclosure than the majority demanded, Chief Judge Rader favored a broader construction of the claim term and effectively rejected the “actually invented” standard for claiming.<sup>52</sup>

We are not alone in perceiving statutory construction of § 112(a) as relevant for debates over claim construction. Following *Retractable*, Judge Moore dissented from the court’s denial of rehearing en banc. Review was necessary, she argued, because the panel’s decision in *Retractable* demonstrated the court’s continuing disagreement over whether claims should be construed according to what the inventor “actually invented.”<sup>53</sup> Significantly, Judge Moore noted the connection between the debates over the “actually invented” standard in claim construction and the written description requirement.<sup>54</sup>

## II. THE INSOLUBLE DEFINITENESS REQUIREMENT

As just explained, Chiang and Solum’s illustrations of “claim construction” and “claim interpretation” in cases like *Phillips* and *Retractable*<sup>55</sup> are better read as disagreements over the proper construction of § 112(a). Section 112(b)’s definiteness requirement presents another example of statutory construction’s influence on claim construction.

In 1870, Congress amended the Patent Act to specify that inventors must “particularly point out and distinctly claim” their inventions.<sup>56</sup> This language is

51. *Id.* at 1313 (citing *Phillips* 415 F.3d at 1323).

52. As discussed above, this is consistent with Chief Judge Rader’s voting behavior in cases involving claim construction. *See supra* notes 19-21 and accompanying text.

53. *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 659 F.3d 1369, 1372 (Fed. Cir. 2011) (en banc) (Moore, J., dissenting); *see also* Dennis Crouch, *Claim Construction in the Abstract*, PATENTLYO (Nov. 9, 2011), <http://patentlyo.com/patent/2011/11/claim-construction-in-the-abstract.html> [<http://perma.cc/WL6X-8HV9>] (discussing Judge Moore’s dissent and the “actually invented” standard).

54. *See Retractable*, 659 F.3d at 1373 (“The majority’s approach to claim construction in this case is virtually identical to the analysis performed under § 112’s written description requirement . . . . If the majority . . . is correct that as part of claim construction, we must determine the nature of the invention described in the specification and ensure that the scope of the claims are limited only to the actual invention disclosed, we must acknowledge the factual underpinnings of this analysis and there should be deference.”).

55. *See Chiang & Solum, supra* note 2, at 568-70.

56. *See* Patent Act of 1870, ch. 230, § 26, 16 Stat. 198, 201; *see also* Nard, *supra* note 27, at 70-71 (explaining that the Act’s new language codified the patent bar’s practice of more precise claiming and “increased the statutory emphasis on the patent claim and sought to promote the public notice function of patents”).

preserved in the modern definiteness requirement.<sup>57</sup> In *Merrill v. Yeomans*, decided six years after the Patent Act’s amendment, the Supreme Court praised the “developed and improved” claiming provision,<sup>58</sup> stating that the “distinct and formal claim” is “of primary importance, in the effort to ascertain precisely what it is that is patented.”<sup>59</sup> A patent’s claims, the Court reasoned, should give the public “fair notice” of what the patent covers and ensure that “[t]he public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits the rights.”<sup>60</sup>

Today, courts continue to apply this rationale, requiring that claims provide the public “clear notice”<sup>61</sup> of what is claimed by the patent and of “what is still open to them.”<sup>62</sup> Upon motion, courts will invalidate claims that do not meet this standard.<sup>63</sup> However, like § 112(a), § 112(b)’s language has generated significant disagreement. The Supreme Court’s decision in *Nautilus, Inc. v. Biosig Instruments, Inc.* represents the most recent example of judges disagreeing over “how much imprecision § 112[(b)] tolerates.”<sup>64</sup> In *Nautilus*, the Court overturned the Federal Circuit’s definiteness standard, which held that a claim was invalid for indefiniteness only if it was not “amenable to construction” or “insolubly ambiguous.”<sup>65</sup> Instead, the Court announced a different, apparently stricter standard and held that a claim is invalid if it “fail[s] to inform, with reasonable certainty, those skilled in the art about the scope of the invention.”<sup>66</sup>

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57. See 35 U.S.C. § 112(b) (2012) (“The [patent] specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or joint inventor regards as the invention.”); see also NARD, *supra* note 1, at 141 (discussing the definiteness requirement).

58. 94 U.S. 568, 573 (1876); see also MERGES & DUFFY, *supra* note 1, at 798–801 (discussing *Merrill* and the Patent Act of 1870).

59. *Merrill*, 94 U.S. at 570.

60. *Id.* at 573.

61. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2129 (2014).

62. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996).

63. John Allison, Mark Lemley, and David Schwartz have observed that indefiniteness motions are increasing, despite the Federal Circuit’s (pre-*Nautilus*) “hostility to the doctrine.” John R. Allison, Mark A. Lemley & David L. Schwartz, *Understanding the Realities of Modern Patent Litigation*, 92 TEX. L. REV. 1769, 1784 (2014). Of the 176 indefiniteness motions filed in 2008 and 2009, only 17% were successful. *Id.* at 1785 tbl.2. Thus, they conclude, “the indefiniteness doctrine plays a larger role than previously recognized in patent law . . . [and] may play an even larger role . . . in the near future.” *Id.* at 1784.

64. 134 S. Ct. at 2128.

65. *Id.* at 2124 (quoting *Biosig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 898–99 (Fed. Cir. 2013)).

66. *Id.*

Jurists have disagreed over the degree of claim definiteness mandated by § 112(b) for more than a century. *Merrill* was an early attempt to grapple with this question. In *Merrill*, the parties disputed whether the claim covered a method for making hydrocarbon oils or the hydrocarbon oil product.<sup>67</sup> The Supreme Court held that the claim covered the method,<sup>68</sup> rejecting the petitioner's arguments that the patent be construed "liberal[ly]" to cover the product because the claim language did not provide the public with "fair notice" of this construction.<sup>69</sup> The petitioner's construction, the Court wrote, would undermine the purpose of the Patent Act's new distinct claiming requirement by allowing patentees to exclude the public through "ambiguous language or vague descriptions."<sup>70</sup> Justice Clifford dissented tersely, concluding that the claim, "when properly construed," covered the product, not the method.<sup>71</sup>

Chiang and Solum cite *Merrill* to support their conclusion that most linguistic ambiguity can be "resolved through interpretation" using ordinary interpretive tools.<sup>72</sup> We emphasize instead the role of the definiteness requirement in influencing the Court's construction of the claim at issue. The Court was not only concerned with resolving linguistic ambiguity, but also with the effects of this ambiguity on public rights.<sup>73</sup> Upon considering the public goals underlying the amended definiteness requirement, the Court rejected the petitioner's construction because it was inconsistent with those goals.

To us, *Merrill* suggests that judges' understandings of the meaning and purpose of § 112(b)'s definiteness requirement, like their understandings of § 112(a)'s written description requirement, can affect their claim construction decisions and result in divergent claim construction outcomes. Again, framing this disagreement over statutory meaning as one over "claim construction" versus "claim interpretation" misses what the debate was about—namely, how definite § 112(b) requires claims to be. As discussed in the next Part, it also ignores an important pathway for resolving the debate—clarifying § 112(b)'s meaning or amending the statute.

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67. See *Merrill v. Yeomans*, 94 U.S. 568, 568-69 (1876).

68. *Id.* at 570 ("[T]he [claim] language is far from possessing that precision and clearness of statement with which one who proposes to secure a monopoly at the expense of the public ought to describe the thing [claimed as exclusive].").

69. *Id.* at 572, 573.

70. *Id.* at 573.

71. *Id.* at 574 (Clifford, J., dissenting).

72. Chiang & Solum, *supra* note 2, at 549. In their discussion, Chiang and Solum do not mention Justice Clifford's dissent.

73. See *Merrill*, 94 U.S. at 570.

### III. IS CLAIM CONSTRUCTION A QUESTION OF LAW?

This “statutory” view of claim construction, in which judicial disagreements over the law affect judges’ constructions of patent claims, has implications for the ongoing debate over whether claim construction is a question of law or a question of fact. In *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, the Supreme Court will decide whether the Federal Circuit should continue to review district court claim construction decisions de novo, or whether it should apply the more deferential clear error standard, applied to district courts’ factual findings.<sup>74</sup> In *Markman v. Westview Instruments, Inc.*, the Court held that claim construction is a “mongrel practice,” with both factual and legal components, but that judges, not juries, should determine claim meaning because of judges’ greater expertise in interpreting legal documents and establishing uniformity.<sup>75</sup> In *Cybor Corp. v. FAS Technologies, Inc.*, the Federal Circuit interpreted *Markman* to hold that claim construction is a “purely legal” issue and that appellate courts should therefore not defer to a “trial judge’s asserted factual determinations incident to claim construction.”<sup>76</sup>

In *Teva*, the petitioners have asked the Court to overrule *Cybor* and hold that although claim construction is “ultimate[ly]” a question of law, it involves “subsidiary” questions of fact, which must be reviewed under the clear error standard.<sup>77</sup> The government also recommends this outcome.<sup>78</sup> In contrast, the respondents argue that claim construction is a “pure question of law,”<sup>79</sup> or, al-

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74. See Petition for a Writ of Certiorari, *supra* note 4, at i, 4-5; see also Fed. R. Civ. P. 52(a)(6) (“Findings of fact, whether based on oral or other evidence, must not be set aside unless clearly erroneous, and the reviewing court must give due regard to the trial court’s opportunity to judge the witnesses’ credibility.”).

75. 517 U.S. 370, 378 (1996); see also *id.* at 391 (“Uniformity . . . would be ill served by submitting issues of document construction to juries.”).

76. 138 F.3d 1448, 1451, 1455 (Fed. Cir. 1998) (en banc); see also *Lighting Ballast Control LLC v. Phillips Elecs. N.A. Corp.*, 744 F.3d 1272 (Fed. Cir. 2014) (en banc) (declining to overrule *Cybor Corp.*).

77. Brief for Petitioners at 16, *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, No. 13-854 (U.S. Jun. 13, 2014).

78. See Brief for the United States as Amicus Curiae Supporting Neither Party at 8, *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, No. 13-854 (U.S. Jun. 16, 2014). As John Duffy has noted, the government’s recommendation is tremendously influential in patent law cases. See John F. Duffy, *The Federal Circuit in the Shadow of the Solicitor General*, 78 GEO. WASH. L. REV. 518, 538-43 (2010).

79. Brief for Respondents at 42, *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, No. 13-854 (U.S. Aug. 11, 2014).

ternatively, is “ultimate[ly]” “a legal question, subject to de novo review” with “all disputes, factual” or otherwise “subsumed within” that question.<sup>80</sup>

Many commentators disagree with the current institutional allocation and support granting greater deference to district courts because, they argue, district courts are “better positioned” to examine expert testimony and other evidence regarding how skilled artisans would understand the patent’s claims.<sup>81</sup> Chiang and Solum, in contrast, defend the status quo, arguing that claim construction really is a legal matter. Applying the interpretation-construction distinction, they argue that because most disputes over claim meaning involve construction and not interpretation, claim construction should continue to be treated as a question of law and not reviewed deferentially.<sup>82</sup>

Our view, which recognizes the role of statutory construction in influencing claim construction, partially aligns with Chiang and Solum’s. Although we agree with the *Teva* petitioners that claim construction involves many factual issues,<sup>83</sup> we also see legal issues lurking in judges’ claim construction decisions. Admittedly, the precise boundary between fact and law is very difficult to determine in this context.<sup>84</sup> However, we identify at least two significant legal questions over which judges currently disagree and which appear to affect claim construction outcomes.

The first question, discussed in Part I, is whether § 112(a), which *Ariad* held to contain a written description requirement separate from enablement, also

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80. See Transcript of Oral Argument at 34, *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, No. 13-854 (U.S. Oct. 15, 2014) (arguing that “the ultimate question” is “a legal question” subject to de novo review, and that “all of the disputes, factual in nature or however you describe them, get subsumed within that [question]”).

81. Craig Allen Nard, *A Theory of Claim Interpretation*, 14 HARV. J.L. & TECH. 1, 63, 66-67 (2000) (arguing for deference to trial courts “because the trial judge is institutionally positioned to examine the extrinsic context [i.e., evidence outside the claims, specification, and prosecution history], determine credibility, and then choose (i.e., interpret) between or among the proffered meanings”); see also Timothy R. Holbrook, *Patents, Presumptions, and Public Notice*, 86 IND. L.J. 779, 809, 819-25 & 822 n.260 (2011) (proposing greater use of extrinsic evidence in claim construction, but conceding that this would require the Federal Circuit to review district court findings deferentially).

82. See Chiang & Solum, *supra* note 2, at 612-13.

83. See Brief for Petitioners, *supra* note 77, at 25-33; Brief for the United States as Amicus Curiae Supporting Neither Party, *supra* note 77, at 14-16; Transcript of Oral Argument, *supra* note 80, 23-27.

84. During oral argument, Chief Justice Roberts stated that “the difference between questions of law and fact has not always been an easy one for the Court to draw” and repeatedly asked the petitioners to define the “subsidiary facts” involved in claim construction. Transcript of Oral Argument, *supra* note 80, at 11.

requires claims to be construed according to the “actually invented” standard.<sup>85</sup> The second question, discussed in Part II, is whether and how § 112(b) and its definiteness requirement should influence claim construction.<sup>86</sup> For example, does § 112(b), as construed by the Supreme Court in *Nautilus*, require courts to review more expert evidence in order to determine whether a patent’s claims would inform those skilled in the art “with reasonable certainty” about the scope of the invention?<sup>87</sup>

These questions are questions of statutory interpretation and are, therefore, purely legal.<sup>88</sup> The answers would greatly help to define the kinds of “subsidiary” factual questions that district courts could or should consider when construing claims and which should be treated as questions subject to deferential review on appeal. Although the Supreme Court is unfortunately unlikely to address these questions in *Teva*, the Court (or the Federal Circuit) should provide answers in subsequent cases.<sup>89</sup>

Our view also leads us to be less pessimistic than Chiang and Solum about the prospect of deference to district courts on issues that do not clearly involve statutory construction. The authors argue that giving district courts an open-ended license to construe claims based on their policy preferences would increase uncertainty and disuniformity, with “hundreds of district court judges across the nation each following their own individually preferred methodolo-

85. For a discussion of the interrelationship between the Federal Circuit’s claim construction doctrine and the written description requirement, see *supra* notes 35-54 and accompanying text.

86. The majority’s approach in *Merrill*, discussed *supra* Part II, demonstrates how the definiteness requirement might influence claim construction. As we read *Merrill*, the majority construed the claim to cover the method for making hydrocarbon oils and not the hydrocarbon product because the latter construction would undermine the definiteness requirement’s purpose of ensuring that the patent gave “fair notice” to the public. See *supra* note 68 and accompanying text.

87. Several district courts since *Nautilus* have asked this question. See, e.g., *Mycone Dental Supply Co. v. Creative Nail Design, Inc.*, No. 11-4380, 2014 U.S. Dist. LEXIS 93051, at \*11 (D.N.J. July 9, 2014) (stating that *Nautilus* “changed the standard for indefiniteness such that there is a new standard of proof and a new role for someone skilled in the art; because the district court must consider whether a claim term informs, with reasonable certainty those of skill in the art about the scope of the invention, expert testimony is especially relevant”); *Hand Held Prods., Inc. v. Amazon.com, Inc.*, No. 12-768, 2014 U.S. Dist. LEXIS 85345, at \*14-15, 48-49 (D. Del. June 24, 2014) (citing Amazon’s lack of expert testimony in rejecting Amazon’s indefiniteness arguments).

88. See *Romero v. United States*, 38 F.3d 1204, 1207 (Fed. Cir. 1994) (citing *Madison Galleries, Ltd. v. United States*, 870 F.2d 627, 629 (Fed. Cir. 1989)) (“[S]tatutory construction [is] a matter of law which we review de novo.”) (emphasis removed); see also Transcript of Oral Argument, *supra* note 80, at 46 (“If a patent is like . . . a statute or like a rule, then factual findings regarding the meaning of that patent are not entitled to clear error review.”).

89. The question presented involves the standard of review, not the Federal Circuit’s claim construction doctrine or the definiteness standard. See Brief for Petitioners, *supra* note 77, at i.

gies in the individual cases that come before them.”<sup>90</sup> However, if, as we have suggested, the disagreements over claim construction methodology that concern Chiang and Solum are really disagreements over § 112’s disclosure and definiteness requirements, then resolving those legal disagreements should theoretically guide district courts during claim construction and increase certainty in claim construction outcomes. This, of course, would require the Federal Circuit and the Supreme Court to agree on a claim construction standard and district courts to decide cases consistently under this standard, but agreement and consistency would be needed regardless of the standard of review. If the courts are not up to the task, then Congress can amend the statute to provide greater clarity. This is how patent law has historically progressed,<sup>91</sup> and, we believe, this is how lawmaking *should* work within a well-functioning statutory framework.

## CONCLUSION

Chiang and Solum’s article is a welcome example of cross-disciplinary legal scholarship, and their framework is useful for shedding light on the policy debates underlying claim construction decisions. However, applying the interpretation-construction distinction to patent law requires taking into account the statutory context in which claim construction is performed. In this Response, we have argued that the debate the authors identify—between “textualist” and “anti-textualist” approaches to claim construction—is better classified as a debate over statutory construction, with judges construing claims in light of their divergent constructions of § 112’s disclosure and definiteness requirements. We have shown that recognizing the prevalent role of statutory construction in framing judicial debates during claim construction is consistent with case history and leads to several useful suggestions for improving certainty in claim construction outcomes and resolving whether claim construction is a question of law or fact. Most importantly, it provides a clearer and more optimistic framework for improving the law of claim construction than Chiang and Solum provide. The fact that a statute limits both patentees’ discretion in drafting claims and judicial discretion in construing claims distinguishes patent law claim construction from constitutional construction, where clear rules and consensus are neither possible nor necessarily desirable.

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90. Chiang & Solum, *supra* note 2, at 613.

91. As Craig Nard has argued, “the U.S. experience with patent law provides a strong case for an important but modest congressional role in its development, one limited to (1) bringing about procedural change relating to . . . patent law’s judicial architecture; or (2) engaging in substantive corrective action by addressing a jurisprudence gone awry.” Nard, *supra* note 27, at 58 (citations omitted).

## CLAIM CONSTRUCTION OR STATUTORY CONSTRUCTION?

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