

## A Potential Lightsaber In The “Dictionary Wars”

*Thursday, April 26, 2007* --- Texas Digital for a short time held out hope that a simple dictionary definition of a complex term in a patent case could avoid the need for experts and quickly clarify many claim construction issues.

This was to be accomplished by raising the status of a dictionary to a primary source of information for the judicial construction of patent terms.

What appeared to be such a neat, clean solution created a quagmire of controversy culminating in numerous amici briefs attacking Texas Digital and leading to the en banc reclassification in Phillips of dictionaries into the disfavored category of extrinsic evidence that should never trump the ordinary meaning of a term based upon the intrinsic evidence comprising the specification and prosecution history.

Yet, the void created through such downgrading of dictionary evidence has left claim construction particularly in rapidly evolving new and emerging technologies in a state of confusion.

Reversal rates for claim construction in the post-Phillips era remain extraordinarily high while confusion at the appellate level is manifest by the high rate of 2-1 split panel opinions on claim construction.

Phillips never provided clear guidelines for courts to use when confronted with multiple dictionary definitions for a specific term. Until changes are made to this system, “dictionary wars” will continue to escalate.

\* Creation of “Controlled Wikipedia”—Dictionary of Common Patent Term Usage \*

As a potential solution to this growing problem, I propose that a Dictionary of Common Patent Term Usage be created, essentially a “controlled Wikipedia.”

This dictionary would be available online and would contain entries for both “general” and “technical” terms. After the first “edition” of the dictionary is created, the dictionary would be updated periodically by either special staff at the USPTO or a special editorial board.

This dictionary could serve as the default dictionary to be used by patentees, the USPTO, district courts and the Federal Circuit.

The Federal Circuit and USPTO could even create a presumption that if a court or examiner needed to consult a dictionary to construe a specific claim

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term, the court or examiner would consult the Dictionary of Common Patent Term Usage unless the patentee had stated otherwise within the patent.

This rule would be similar to the rule allowing a patentee to act at his or her own lexicographer. The Dictionary of Common Patent Term Usage could then be elevated from extrinsic evidence to intrinsic evidence.

Courts would then use the specification, prosecution history, and the Dictionary of Common Patent Term Usage as intrinsic evidence to construe all patent claim terms, unless the patentee acted as his or her own lexicographer.

Even short of any general acceptance of the Dictionary of Common Patent Term Usage by the courts, any patent applicant as part of his or her original application would be free to include a statement that the Dictionary of Common Patent Term Usage controls as to the meaning of any undefined term in the specification.

In effect, the patentee—serving as his or her own lexicographer—would be incorporating the Dictionary of Common Patent Term Usage by reference into his or her application.

The Dictionary of Common Patent Term Usage would minimize, if not eliminate, all “dictionary wars” that occur both in district courts and the Federal Circuit.

Since patentees would have all their claim terms defined by one dictionary (unless otherwise stated by the patentee), the only potential “dictionary wars” would be over how a particular Dictionary of Common Patent Term Usage definition itself should be defined.

The inherent problem in defining any word is that the definition of the word consists of additional words that also may need to be defined. This problem exists when defining any patent claim term, whether by extrinsic or intrinsic evidence.

There is presently no effective way to solve the “definitions of definitions” problem, however use of the Dictionary of Common Patent Term Usage would provide clarity at the initial stage of choosing a specific definition for any patent claim term.

Efficiency at the stage of patent drafting would be a potential benefit of using the Dictionary of Common Patent Term Usage. Patentees would only need to consult one standard dictionary for useful definitions of their claim terms.

If a patentee did not want to utilize the Dictionary of Common Patent Term Usage definition of a claim term, the patentee would have two options. First, the patentee could locate another dictionary definition of the term and place a brief statement in the patent specification relating the definition chosen. Second, the patentee could act as his or her own lexicographer to create a

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special definition for the claim term.

Another added benefit of the Dictionary of Common Patent Term Usage proposal is that it would create a community of understanding within the patent community over what commonly used words actually mean.

Every patent drafter in this country could consult the Dictionary of Common Patent Term Usage every day. Common words, specifically general purpose words that normally do not have a specific definition depending on the field of study, would have consistent definitions across all patents.

Through using a common lexicon, patent drafters would join the community of understanding over what terms used in patents generally mean.

Unlike general terms, technical terms may have different meanings depending on the specific field using the term.

Additionally, the meaning of terminology may evolve over time, making it difficult to precisely pinpoint which meaning should control. (See Mark A Lemley, “The Changing Meaning of Patent Claim Terms” (March 2, 2005). Available at SSRN: <http://ssrn.com/abstract=677645>.)

An example of this problem arises for the term “base.” In the field of chemistry, the term “base” can be defined as a chemical compound that absorbs hydronium ions when dissolved in water. (See [http://en.wikipedia.org/wiki/Base\\_%28chemistry%29](http://en.wikipedia.org/wiki/Base_%28chemistry%29).)

In the field of mathematics, the term “base” can be defined as either a topological space (See [http://en.wikipedia.org/wiki/Base\\_%28topology%29](http://en.wikipedia.org/wiki/Base_%28topology%29).) or the number of digits in a positional numeral system. (See [http://en.wikipedia.org/wiki/Base\\_%28mathematics%29](http://en.wikipedia.org/wiki/Base_%28mathematics%29).)

Words like “base” would hold a special place in the Dictionary of Common Patent Term Usage. These words would be properly notated online for each field of study through the dictionary editorial board, preferably individuals with experience in different fields. Potential problems created by the existence of special definitions in different fields would therefore be solved.

If anyone in the patent community believed the Dictionary of Common Patent Term Usage should be updated to either create a new entry for a term or modify an existing entry, e-mail addresses (or other electronic means) could be set up for this specific purpose.

The editors in charge of updating the dictionary would also be in charge of reviewing correspondence received regarding potential updates. It would be in the editors’ discretion to determine whether entries should be modified or new entries should be created.

Patent drafters, those with a specific interest in the process of properly updating entries, would then have the ability to add to the community of

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understanding created by the Dictionary of Common Patent Term Usage.

As stated above, the Dictionary of Common Patent Term Usage could be elevated to the level of “intrinsic evidence” by the Federal Circuit.

But, even short of the Federal Circuit doing so, the individual applicant who wishes to rely upon the Dictionary of Common Patent Term Usage would be able to so state in the application as filed through incorporating the dictionary by reference. (See Joseph Scott Miller and James A. Hilsenteger, “The Proven Key: Roles and Rules for Dictionaries in the Patent Office and the Courts” (October 5, 2004). Available at SSRN: <http://ssrn.com/abstract=577262>.)

This dictionary would be reliable because it would reflect the community of understanding as to definitions for specific terms at any given point in time. Neither side during patent litigation would easily be able to tailor a Dictionary of Common Patent Term Usage definition for a specific purpose.

Through a time-stamp or archiving system, Dictionary of Common Patent Term Usage definitions for every term would be known for all applicable time periods (time of invention, reduction to practice, etc...). Given the consistency in definitions a Dictionary of Common Patent Term Usage provides, such a reference could potentially be elevated to “intrinsic evidence” status.

Creation of a Dictionary of Common Patent Term Usage is potentially a good first step in solving the “dictionary wars” problem.

The dictionary would be created and updated by people skilled in different fields. Patent drafters would have an interest in making sure all entries were accurate and envelope the current understanding in different fields as to what terms actually mean.

This dictionary would also create a community of understanding for all those in the patent community.

The potential benefits of the dictionary are such that the idea should be considered. Until appropriate steps are taken to change the ways dictionaries are used in patent practice, “dictionary wars” will continue to plague patent practice and the courts.

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