

PROBLEMS OF UNIVERSALS/CLAIM CONSTRUCTION

1. Title Slide

- Whenever we think about patents, we start with Plato.

2. Plato Picture.

- In his middle dialogues, written in the early part of the 4th century BCE, Plato became interested in the problem of universals. He came to propose a radical solution to this problem and ignited a controversy that continues to the present. This controversy – the controversy between what philosophers call realism vs. nominalism is at the heart of how we should think about patents. To understand the controversy, let's begin with 'universals.' What is a universal?

3. Chair.

- When we have one of something, we can give it a name: Chair. We know what we are thinking about. We are thinking about that chair.

4. Chairs.

- But when we have many of something and we give them all the same name: Chair. What exactly do we mean? What is this "Chairness" that applies to all of these individual things? They are so different, yet we have no difficulty agreeing that these are all chairs. Notice that our understanding of chair is very tenacious. We can recognize very different sorts of chairs. Even broken chairs, or pieces of

chairs. What is it that allows us to have such an understanding? This thing that enables our understanding is what philosophers refer to as a ‘universal.’

5. Chair in Sky.

- Plato took this question very seriously and proposed an exceedingly strange solution. He offered his famous **theory of the forms**. He thought that somewhere, at some level of being, there is a divine-like chair that is **perfect, unchanging and eternal**. It encompasses all chairs. He would call the perfect, unchanging, eternal chair a “form.” Make no mistake, to Plato the form for chair is something real. And it is the universal that allows us all to share our understanding of “chairness.” The individual chairs that we encounter in real life are but imperfect examples of Plato’s “universal chair.”

6. Nominalists.

- Needless to say, this went too far for some people and they criticized Plato’s theory. The principle opponents of Plato’s theory – became known as nominalists. They believe that “chair” is just a name. And to understand “chairness,” you don’t need for there to be something ‘real’ that corresponds to “chairness,” you just need to understand how language works, particularly how nouns and names work in language.
- As I said, the thesis/antithesis are referred to as realism vs. nominalism.
- Plato is a realist. Realists think “chairness” really exists, maybe as an idea if not a platonic form. [For philosophers, ideas are real things, just as real as this lecturn.]

- Nominalists think “chairness” does not really exist as such, but is simply a function of how language works.
- The 2400 year old controversy in philosophy between realism and nominalism is the same controversy that has emerged in patent claim construction since the Supreme Court’s decision in *Markman v. Westview Instruments*, 116 S. Ct. 1384 (1996).
- I refer to a controversy – not often spoken of, but which underlies all recent claim construction jurisprudence. Namely, whether in construing the claims of a patent – do we focus on the invention or do we focus on the words used to claim the invention.
- In other words, when it comes to interpreting patent claims, are we realists or are we nominalists?

7. Rodin’s Thinker

- When a patent lawyer tries to frame the language of a patent claim he/she is trying to “universalize” the client’s invention. He/She is trying to create a universal. That can mean two things.
- Is he/she crafting a claim with scope to fit what was invented.
- Or is he/she just creating a legal document using words to protect a right to exclude.

8. If These Are the Ways Claims are Created, Then We Have a Choice When Resolving Ambiguities in Claim Language.

- Focus on invention.
- Focus on the language.

9. Advantages of Focusing on the Invention.

- Emphasis is on technology.
- Give claim scope co-extensive with the invention.
- Intuitive to the non-lawyer public.

10. Disadvantages of Focusing on the Invention.

- Hard to do.
- May “read in” limitations. [This worried the *Phillips* court.]
- May not serve the public notice function as readily.

11. Advantage of Focusing on the Words.

- This is the equivalent of nominalism. If we take this approach, we may be saying that it’s not about technology. It’s about how language is used in a legal document to create a legal right to exclude others.
- Simpler. We focus on the patent documents.

- Avoid “reading in” limitations.
- Public notice is facilitated too because the public only need read the patent documents.

12. Disadvantages of Focusing on the Words.

- Sometimes we get claim constructions that are broader than what was actually invented.
- Has hurt the credibility of the patent system. Empowered “paper patents” and “patent trolls.”

13. Process When Focusing on the Invention.

- Wide open process.
- Receive evidence that is probative of the invention.
- Little or no bias against or in favor of types of evidence.

14. Process When Focusing on Words.

- Use tools of linguist.
- Dictionaries.
- Formal Rules of Construction.
- Algorithmic and Hierarchical. [UCC § 2-202] [Four corners; course of performing K; course of deciding; trade usage; parole evidence.]

15. So What about *Phillips v. AWH Corporation, en banc*?

- The case was about whether the baffles in pre-fabricated walls used mainly for prisons had to be at acute or oblique angles to the plane of the wall. Defendant's baffles were perpendicular and it contended that because its baffles were at right angles, it did not infringe.
- Trial court agreed the patent did not cover right angles. Granted summary judgment for the Defendant.
- Panel affirmed.
- *En banc* Court of appeals disagreed and concluded that the patent covered even perpendicular baffles. Reversed and remanded.
- Invention or Words?

16. Phillips Court Creates a Hybrid.

- Expresses preference for the invention: "The patent system is based on the proposition that claims cover only the invented subject matter."
- But Adopts Some Tools of a Linguist.
- Hierarchical, in probativity.
- Formal Rules of Construction – [Independent claim – baffles; dependent claim – baffles at acute or oblique angles.]

- Importantly, *Texas Digital* rejected. The most extremely nominalistic of the Court's claim construction opinions. *Texas Digital* is all about dictionaries. After the *Phillips* decision, dictionaries are disfavored.

17. What is invention?

18. Conclusions.

- Court rejected ideological purity and opted for a hybrid.
- Genius of the common law to ignore ideological purity in favor of what works.