
Stephen J. Stark

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KEY WORDS AND TRICKY PHRASES: AN ANALYSIS OF PATENT DRAFTER’S ATTEMPTS TO CIRCUMVENT THE LANGUAGE OF 35 U.S.C. § 112

I. INTRODUCTION

In *York Products v. Central Tractor Farm & Family Center*, the Federal Circuit upheld the validity of U.S. Patent No. 4,858,876 entitled “Vehicle Cargo Bed Liner.”¹ This patent describes a protective liner for a vehicle, such as the type commonly found in the bed of a pickup truck. A novel feature of this particular bed liner includes protective sidewall ridges which align to create slots.² The slots allow for the insertion of a structure, such as a wooden board, to lock a load of cargo in place. The claim litigated requires the sidewall ridges to extend “a substantial part [] of the entire height thereof.”³ The Court of Appeals held that this language requires that those ridges cover nearly the entire height of the sidewall portion of the invention.⁴

There is nothing unusual about a patent being challenged for invalidity during a patent infringement suit. Nothing is unusual about a court upholding the validity of a contested patent. In fact, patents are presumed valid, and the defendant has the burden of proof to affirmatively show a contested patent’s invalidity.⁵ Interestingly, the Federal Circuit recognized a continued practice of patent drafter’s use of ambiguous terms of degree in patent claims. The court assigned a definitive meaning to an apparently ambiguous term after the patent was issued and litigation commenced.

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¹ *99 F.3d 1568, 40 U.S.P.Q.2d (BNA) 1619 (Fed. Cir. 1996).*
² *Id.* at 1569.
³ *Id.* at 1572.
⁴ *Id.* at 1572-3.
Make no mistake, "substantial" was a cleverly chosen word selected by the drafter of the patent claim. However, should patent claim drafters have the luxury of utilizing flexible terms in the patent to allow the coverage of the patent to grow after the patent has issued? How much vagueness should the United States Patent and Trademark Office (USPTO) allow patent drafters to include in the claims when the patent statute explicitly requires particularity in the claims?

This Note will examine the "gray language," often litigated in patent cases, utilized by patent claim drafters in an attempt to circumvent the language of 35 U.S.C. § 112: "The specification [of a patent] shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. The Federal Circuit has acknowledged the difficulty and problems that this requirement instills on prospective patent drafters, however no court has demanded that the Patent and Trademark Office (PTO) require the removal of "gray language" in patent claims.7

The PTO utilizes the Manual of Patent Examining Procedure (MPEP) as a guide for patent examiners to follow in the course of patent prosecution. The MPEP does not prohibit relative terminology within the claim language: "Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification."8 The Federal Circuit has said that this determination is to be conducted by the Examiner where "the fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. [§]112."9 In the absence of clarification within the specification of terms of degree or otherwise imprecise terminology located in the claims, facially ambiguous terminology within patent claims should be held to be indefinite.

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8 See MANUAL OF PATENT EXAMINING PROCEDURE § 2173.05(b) (6th ed. 1996) (designating the section "Relative Terminology").
9 MANUAL OF PATENT EXAMINING PROCEDURE § 2173.05(b) (6th ed. 1996) (citing Seattle Box Co. v. Industrial Crating and Packaging, Inc., 731 F.2d 818, 221 U.S.P.Q. (BNA) 568 (Fed. Cir. 1984)).
Specifically, this Note examines six cases which either expand "gray language" to include an allegedly infringing device or narrow "gray language" to permit an allegedly infringing device to escape the gnarled web of infringement. This Note focuses on the use of the term "substantial" within a patent claim where litigation over the meaning of the term later develops. 10

II. BACKGROUND

A. A PATENT IS A CONSTITUTIONAL GRANT DESIGNED TO BENEFIT SOCIETY

The Constitution of the United States states that "Congress shall have the Power . . . To Promote the Progress of Science and useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries." 11 In order to accomplish this Constitutional mandate, Congress established the patent system. This patent system is founded on the understanding that if individuals are given the incentive to invent, society as a whole will benefit.

It is helpful to view the American patent system as a contract model based on an exchange for value. 12 On one side of the exchange, the government offers the inventor the sole right to


exclude others from making, using or selling the invention for a limited period of time.\textsuperscript{13} On the other side of the bargain, the inventor must initially publicly disclose the best way to make the invention. Additionally, at the end of the patent term, the patentee must allow the invention to enter the public domain. A fundamental policy behind patent law promotes this exchange: "technology will progress more rapidly if inventors are encouraged to disclose their inventions rather than trying to horde them as trade secrets."\textsuperscript{14}

By allowing inventors to participate in the patent system, the progress of technology will emanate in at least two directions to the benefit of society.\textsuperscript{15} First, since patent law encourages invention, society will enjoy the fruits of the inventor's labor through the existence of new products of invention. Secondly, by demanding a written disclosure of the invention as a prerequisite to the granting of patent protection, patent law requires inventors to "make public the teachings of their inventions."\textsuperscript{16} In theory, this creates a domino effect where subsequent inventors may use the patentee's teachings to create other inventions that will also prove useful to society.

B. CLARITY IS IMPORTANT IN PATENT CLAIMS

The first and second paragraphs of § 112 of the current patent act require an inventor to make a written disclosure to the public in exchange for a patent:

The 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 art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

\textsuperscript{14} Leibold, supra note 12, at 626.
\textsuperscript{15} Deron Burton, Comment, Bringing Theory Into Practice: Predictable Scope For Functional Patent Claims, 42 UCLA L. REV. 221, 228 (1994).
\textsuperscript{16} Id.
The specification [of a patent] shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.\textsuperscript{17}

These two paragraphs require the inventor to disclose the invention to the public, thereby advancing the current state of technology. Attention should be paid to the second paragraph which requires that the claims “particularly point[] out and distinctly claim” the invention.\textsuperscript{18} The purpose of the claiming system is to provide the public with fair notice of the boundaries of a patent.\textsuperscript{19} These claims will be used to measure the “metes and bounds” of the inventor’s creation, and it is important for society to know the precise limits of the patent claims.\textsuperscript{20}

Unfortunately, within the idealistic policies underlying the patent system, conflicting interests lurk.\textsuperscript{21} On one hand, patent drafters should be given “complete and fair protection” for their inventions.\textsuperscript{22} Otherwise patent grants may lose their “incentive-giving quality” as inventors have no reason to pursue a hollow, useless patent grant.\textsuperscript{23} This suggests that courts should interpret patent claims broadly to give them a wide scope of protection. On the other hand, competitors may be discouraged from applying teachings of patents to make further inventions and innovations if they cannot rely on claim language to set the boundaries of the protected invention and to warn precisely of the conduct which will infringe. This policy suggests that the courts should put great weight on the language patentees use in claiming their inventions to strictly limit protection to what those words say. Thus, “judicial determination of claim meaning and scope of protection is inevitably a balancing act.”\textsuperscript{24}

\textsuperscript{17} 35 U.S.C. § 112 (1994).
\textsuperscript{18} Id.
\textsuperscript{19} Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 945, 4 U.S.P.Q.2d (BNA) 1737 (Fed. Cir. 1987).
\textsuperscript{20} In re Vampco Machine and Tool, Inc., 752 F.2d 1564, 1577 n.5, 224 U.S.P.Q. (BNA) 617 (Fed. Cir. 1985).
\textsuperscript{21} Burton, supra note 15, at 228.
\textsuperscript{22} Burton, supra note 15, at 228.
\textsuperscript{23} Burton, supra note 15, at 228.
\textsuperscript{24} Burton, supra note 15, at 229.
The Federal Circuit noted in *Markman, Inc. v. Westview Instruments, Inc.*: "it is only fair that the competitors be able to ascertain to a reasonable degree the scope of the patentee's right to exclude." In an Amicus Curiae brief to the Supreme Court, one commentator has noted that there are two reasons to somewhat accurately proscribe the limits of a patent: one is fairness, the other is a statutory requirement. It may be argued that the primary purpose of the statutory requirement is to provide express and clear warning to competitors as to what constitutes infringement of the patent. Additionally, the statutory requirement provides the public with a reduced area of uncertainty around which research and discovery may proceed to "promote the Progress of Science and useful Arts" as well as positively notify the patentee of the limits of the patentee's invention.

Particularity in patent claim language is important because a patent should not unduly inhibit experimentation or obstruct further advances in the field. The Supreme Court has stated that "[a] zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field." The discouragement of invention is obviously inapposite to the policy of having a patent system.

A third justification for requiring particularity in the claims is to apprise the inventor of the scope of the invention to which the inventor has acquired rights. It is important for the inventor to be able to accurately, as well as reasonably, interpret the scope of the claims without resorting to constant litigation. The Supreme Court agrees: "[t]he limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public."
C. SOURCES OF AMBIGUITY IN PATENT CLAIMS

In patent law, ambiguity of claim language necessarily results in uncertainty in the scope of protection. This uncertainty impairs all of society—the patentee, the competitor, and the public. The process of determining a particular meaning to define a term in a patent claim may result in ambiguity.

1. Ordinary Meaning. First, words in a patent are to be given their ordinary meaning unless otherwise defined.30 However, what if a particular word has multiple meanings? For example, consider the word "substantial." The Webster dictionary gives eleven different definitions of the word substantial.31 Additionally, there are another two definitions specifically provided for the adverb "substantially."32 Thus, the "ordinary meaning" is not clear.

The first definition of the word "substantial" given by the Webster's Dictionary is "of ample or considerable amount, quantity, size, etc."33 Supposing that this is the precise definition that the drafter had in mind when drafting the patent, the meaning of "ample or considerable amount" appears amorphous. This could have one of at least the following interpretations: (1) almost all, (2) more than half, or (3) barely enough to do the job. Therefore, the use of a term, such as "substantial," which usually has a very ambiguous meaning, makes the scope of protection particularly hard to determine.

31 Webster's definitions of substantial are as follows:
(1) of ample or considerable amount, quantity, size, etc.; (2) of a corporeal or material nature; real or actual; (3) of solid character or quality; firm, stout, or strong; (4) based on solid or firm essentials; (5) wealthy or influential; (6) of real worth, value or effect; (7) pertaining to the substance, matter, or material of a thing; (8) of or pertaining to the essence of a thing; essential, material, or important; (9) being a substance; having independent existence; (10) pertaining to or of the nature of substance rather than an accident or attribute; (11) something substantial.

32 Id.
33 Id.
2. *The Writer's Special Meanings.* An additional source of ambiguity within the patent claim results from the Federal Circuit's assertion that a patent drafter is "free to be his own lexicographer." Effectively, the writer of the patent can attribute a special meaning to words chosen to describe the invention, as long as the meaning is not contrary to the ordinary meaning of the words. Words chosen by the patent drafter to have a meaning not commonly associated with those particular words will necessarily create ambiguity with regard to exactly what the patent drafter intended the particular words to mean. The Federal Circuit attempts to regulate the practice of lexicography within the body of a patent by requiring that "any special definition given to a word must be clearly defined in the specification." However, in the process of ascribing a special meaning to a particular term, the patent drafter may fail to clearly surrender the word's common definition. In this regard, even more ambiguity will result.

Suppose that the patentee has chosen to give a special meaning to a term in a patent claim. In order to interpret the meaning of a term in a patent claim, "resort must be had in the first instance to the words of the claim," but the courts have additionally required a reading into the specification. This inherently means that the public cannot now rely on the claims of the patent alone: "[c]laims must be read in view of the specification, of which they are a part . . . . For claim construction purposes, the [specification's] description may act as a sort of dictionary, which explains the invention and may define terms used in the claims." The specification itself is also likely to contain terminology which may be interpreted in a variety of different ways.

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34 Markman v. Westview Instruments, Inc., 52 F.3d 967, 980 (Fed. Cir. 1996). See also Webster's, supra note 31, at 825 (defining lexicographer as "a writer or a compiler of a dictionary").

35 Manual of Patent Examining Procedure § 2173.05(a) (6th ed. 1996) (requiring a term may not be given a meaning repugnant to its usual meaning).

36 Markman v. Westview Instruments, Inc., 52 F.3d at 980.


38 Seymour v. Osborne, 78 U.S. 516, 547 (1871) (stating "it is fundamental that claims are to be construed in the light of specifications and both are to be read with a view to ascertaining the invention").

39 Markman v. Westview Instruments, Inc., 52 F.3d at 979.
3. The Effect of the Prosecution History on Meaning. In addition to the Supreme Court mandate to construe claims in light of the specification, other courts have held that in order to ascertain the meaning of the claims, the court should look to the prosecution history as well.\textsuperscript{40} Although ambiguity will not likely be introduced by an examination of the patent's prosecution history, the public will not know by looking at the patent itself whether or not the file wrapper should be obtained for examination. The expectation that the public may need to reference the prosecution history to define ambiguous claim language places an unnecessary burden on the public when the patent statute explicitly requires the patentee to particularly point out and distinctly claim the invention.

Finally, the Federal Circuit requires that claim construction take into account "the specification of the patent, the prosecution history, and the prior art."\textsuperscript{41} Requiring prior art to be taken into account imposes a huge burden on users of the patent system. This imposition will require a determination of which prior art is relevant in construing the claims of a particular patent. Both sides in many disagreements will likely be able to find prior art that is favorable to their respective arguments. For example, one source has identified over one hundred connotations for the word "substantial" that exist in issued patents.\textsuperscript{42} An examination of these patents would most certainly yield interpretations favorable to either side of a disagreement.

The Supreme Court has recently noted that "we see the importance of uniformity in the treatment of a given patent . . . ."\textsuperscript{43} In order to achieve uniformity, individuals must wade through the mire of ambiguity and uncertainty that may arise in regards to claim interpretation. Courts have also acknowledged that patent claim language is inherently susceptible to dispute over its meaning.\textsuperscript{44} It would appear that a step in the direction of elimi-
nating some disputes over claim language interpretation would be to disallow inventors the use of words that are ambiguous on their face within the body of the claims. Words like "substantial" or "substantially" are amorphous; they inherently defy the requirement of "particularly pointing out" and "distinctly claiming" the invention sought to be patented.45

Inherently ambiguous terminology such as "substantial" and "substantially" should not be allowed within the claims of a patent. One possible exception could be to allow this type of terminology in the claims only where the patent drafter explicitly defines the apparently ambiguous term within the body of the specification.

D. AMBIGUOUS PATENT CLAIMS ARE BAD POLICY

A patent owner has the right to exclude others from making, using, or selling the claimed invention in the United States for a term of twenty years from the date of filing the patent application.46 The patent statute allows a patent owner to file a civil proceeding against anyone thought by the patentee to be making, using or selling the patented invention without permission of the patent owner.47 This type of activity is known as patent infringement.

Establishing patent infringement is not a simple exercise. In most instances, it is a two-step process.48 The first step, the one that is highly prejudiced by ambiguous claim language, requires the court to construe the meaning of the claim language.49 The second step requires the fact-finder to apply the claims, as construed in the first step, to the accused infringing product or processes "in order to determine whether the accused product or process falls within the scope of the claims."50

Applying the claims to the accused device may lead to one of two categories of patent infringement: literal infringement or infringe-

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48 Burton, supra note 15, at 222.
49 Burton, supra note 15, at 222.
50 Burton, supra note 15, at 222.
ment under the doctrine of equivalents. If an accused device includes every limitation stated in a patent claim, the accused device literally infringes the claim. The process for determining literal infringement is stringent; "if even a single claim limitation has no [corresponding equivalent] in the accused device, there can be no literal infringement." Because of the stringency of the test, however, literal infringement is rarely successful in practice.

By utilizing nebulous language, a patent drafter may be able to create a flexible patent that allows a particular element to expand in order to encompass an alleged infringer. It is entirely possible that the patentee had not sought expanded protection during its prosecution through the PTO. The court is then forced to create a patent claim interpretation that was not contemplated by the PTO and could be invalid for obviousness in light of the prior art, lack of novelty, or any other reason commonly utilized by the PTO to invalidate claims. At this point in time, the court is most likely not privy to the type of information needed and the processes necessary to evaluate the patent claims for other invalidity concerns. A skillful patent drafter may avoid these invalidity concerns by relying on flexible patent claims in patent infringement suits.

The second category of patent infringement is utilized when the court does not find the allegedly infringing device to literally infringe the patent. The doctrine of equivalents is an equitable determination conducted when the claim language does not literally read on the accused device, but where the alleged infringer has made only minor, pretextural changes. Even where an accused device does not literally infringe a patent claim, infringement may occur under the doctrine of equivalents if the accused device performs substantially the same function in substantially the same way to achieve substantially the same result as the claimed invention. An accused device that satisfies this so-called tripartite function/way/result test is legally "equivalent" to the

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51 Burton, supra note 15, at 222.
52 Burton, supra note 15, at 223.
53 Burton, supra note 15, at 223.
54 Burton, supra note 15, at 223.
claimed invention, and thus infringes the patent.\textsuperscript{56}

When ambiguous claim language is examined under the doctrine of equivalents, there is no telling what a fact finder will determine. What performs or achieves substantially the same function, way, and result as a claim requiring a given element to extend "at least a substantial part of the entire height thereof?" The requirement that "the language of the claim defines the scope of the protected invention" is circumvented by the patent drafter by the creation of amorphous, ambiguous claims when analyzed under the doctrine of equivalents.\textsuperscript{57}

III. ANALYSIS

A. THE COURTS' CONFUSION

At least sixteen cases have been litigated to some extent over ambiguity created by the inclusion of the term "substantial" within the body of a patent claim.\textsuperscript{68} This Note will focus on six of these cases showing that various courts are not arriving at a consistent meaning of this term. Judge McKelvie observed in \textit{Thorn EMI North America, Inc. v. Intel Corp.} that the term "substantial" typically takes on little meaning during patent prosecution, but upon issuance, the patentee often allows this term to "swell[] up" to encompass potential infringers.\textsuperscript{59} When courts allow this amorphous word to expand after issuance, the patent drafters are rewarded through successful circumvention of the objectives of 35 U.S.C. § 112, by failing to particularly point out and distinctly claim their inventions.

1. \textit{In re Curley}. The Court of Customs and Patent Appeals, the predecessor to the Federal Circuit Court of Appeals over some jurisdictional matters, entertained a disagreement over the term "substantially" as early as 1946.\textsuperscript{59} In \textit{In re Curley}, the applicant appealed from an affirmation of a denial of Curley's patent

\textsuperscript{56} Id.

\textsuperscript{57} Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 619, 34 U.S.P.Q.2d (BNA) 1816 (Fed. Cir. 1995).

\textsuperscript{58} See supra note 10.

\textsuperscript{59} Id.

\textsuperscript{60} In re Curley, 158 F.2d 300, 72 U.S.P.Q. (BNA) 116 (C.C.P.A. 1946).
application by the United States Patent Office's Board of Appeals.\textsuperscript{61} The applicant's invention related to an improved ventilator for use in underground mines.\textsuperscript{62} Claim 1 of this patent includes a motor and controlling switch in a "substantially complete enclosure."\textsuperscript{63} The Board of Appeals held that this language would not exclude an "enclosure having apertures or [be] restricted to a housing or covering that is completely closed."\textsuperscript{64} Because prior art teaches the inclusion of a housing with apertures, the Board sustained the rejection of the patent application.

The applicant argued that the patent's use of the term "substantially enclosed" required that no apertures for ventilation or other purposes be used. The applicant relied on a description of coal mines in the Electrical Engineer's Handbook which stresses the importance of enclosed motors and controls due to risk of explosion.\textsuperscript{65} The applicant was able to convince the court to allow other claims. Nevertheless, the court affirmed the board's decision holding that "a 'substantially complete enclosure,' is sufficiently broad to include a device which is not restricted . . . to a housing or covering which completely encloses the motor and the controlling switch."\textsuperscript{66}

When defining "substantially complete enclosure," the court did not refer to an ordinary meaning of the words, but determined that "[substantially] is a relative term and should be interpreted in accordance with the context of the claim in which it is used."\textsuperscript{67}

The court does not mention the specification, the prosecution history, or the prior art for guidance in interpreting the claim. The court simply determined that "[t]he word 'substantially' does not necessarily have the same meaning as the word 'essentially.'"\textsuperscript{68} Had the court adopted the interpretation sought by the patent applicant, the patentee would have effectively obtained a monopoly over prior art which included ventilation apertures. This runs

\textsuperscript{61} Id. at 301.
\textsuperscript{62} Id.
\textsuperscript{63} Id. at 302.
\textsuperscript{64} Id. at 303 (emphasis in original).
\textsuperscript{65} Id. at 304.
\textsuperscript{66} Id.
\textsuperscript{67} Id.
\textsuperscript{68} Id.
afoul of the policies of the patent system as the PTO would have
granted a patent for technology currently in use. The court in this
instance, however, recognized the possible harmful effects of
granting a flexible patent claim in the patent.

2. *Ex parte Wheeler*. In 1969, the Patent Office Board of Appeals
had another opportunity to determine what “substantially” may
mean in the context of a patent claim. Once again a different
definition and interpretation was obtained. In *Ex parte Wheeler*, a
patent application was determined to be patentable despite a
dispute concerning the term “substantial.” In this action, the
Board held that “[a] surface which is ‘substantially parallel’ to a
fixed direction is to all intents and purposes, disposed as closely
parallel to such direction as is humanly possible.” Furthermore,
the Board holds that “[s]ubstantially is to be differentiated from
approximately.”

The Board made no reference to a basis for the interpretation of
“substantially parallel” in this situation. No reference is made to
interpretation in light of the claims, the specification, the prosecu-
tion history, or the prior art. The Board simply states that
“substantially” is not “approximately” and further requires that the
surfaces be as parallel as “humanly possible.” This interpreta-
tion gives very little flexibility imparted to this term as one may
commonly expect. Especially when the MPEP has described
“substantially” as “a broad term.”

3. *York Products, Inc. v. Central Tractor Farm & Family Center.*
U.S. Patent No. 4,958,876 entitled “Vehicle Cargo Bed Liner” is
owned by York Products. The invention behind this patent is a
protective liner suitable for use in a vehicle cargo body, such as the
type commonly utilized in the bed of a pickup truck. A particularly
novel aspect of this invention is the special sidewalls of the bed
liner. These sidewalls contain protective ridges which align

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70 Id. at 569-70.
71 Id. at 570.
72 Id.
73 Id.
74 MANUAL OF PATENT EXAMINING PROCEDURE § 2173.05 (6th ed. 1996).
75 York Prods. Inc. v. Central Tractor Farm & Family Ctr., 99 F.3d 1568, 1569 (Fed. Cir.
1996).
oppositely to create load bearing slots into which a user may insert a plank to serve as a cargo lock, thus preventing cargo from sliding in the bed of the vehicle.\textsuperscript{76}

Central Tractor has manufactured two models of bed liners for Custom Ford that York believes infringe this patent.\textsuperscript{77} As a result of the suspected infringement, York brought suit for damages. The Federal Circuit followed the two step approach to determine first the meaning of the disputed claims, and second, if the allegedly infringing product fell within the scope of the claims.

In carrying out the first step of delineating the meaning of the disputed claims, the court acknowledged that "[t]he claim language, of course, defines the bounds of claim scope."\textsuperscript{78} The Federal Circuit implicitly conceded that there is ambiguity in the claims in question. The court expressed its desire to consider other sources including the patent specification and the prosecution history in order to arrive at the meaning of the disputed claims.\textsuperscript{79} The text of this claim must be examined to see why the Federal Circuit quickly referred to extrinsic sources to determine the meaning of the claim:

Claim 1 states as follows:

A protective liner for a vehicle cargo bed, said protective liner permitting structure positioned in the vehicle cargo bed to be supported and affixed in position in the cargo bed, said liner comprising: a liner floor portion positionable upon the floor of the vehicle cargo bed, said liner floor portion having elevated portions formed thereupon to conform to wheel wells protruding from the vehicle cargo bed floor; liner sidewall portions extending upwardly from opposite sides of the liner floor portion, one of each of said liner sidewall portions being positionable

\textsuperscript{76} Id.
\textsuperscript{77} Id. at 1570-71.
\textsuperscript{78} Id. at 1572. See Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 619-20 (Fed. Cir. 1995) (describing importance of claim language).
\textsuperscript{79} York Prods., 99 F.3d at 1572. "To determine the meaning of disputed claim terms, however, a construing court may consider other sources, including the patent specification and the administrative record leading to patent issuance." Whittaker Corp. v. UNR Indus., Inc., 911 F.2d 709, 711, 15 U.S.P.Q.2d (BNA) 1742 (Fed. Cir. 1990).
against one of a pair of opposite sidewalls of the vehicle cargo bed; a liner frontwall portion extending upwardly from a front end of the liner floor portion, said liner front-wall portion being positionable against a frontwall of the vehicle cargo bed; and a plurality of spaced apart, vertically extending ridge members protruding in a common plane from the liner sidewall portions for at least a substantial part of the entire height thereof whereby gaps separating adjacent ones of the ridge members of each liner sidewall portion from co-operative opposed load locks of a depth sufficient to receive opposite ends of the structure positioned in the vehicle cargo bed in order to affix the structure against movement in a direction parallel to said liner sidewall portion in the vehicle cargo bed.  

Although the Federal Circuit affirmed the holding of the district court, the Federal Circuit found at least one different meaning of "substantial" to be significant. The district court defined the limitation "at least a substantial part of the entire height thereof" to mean "the ridge member must protrude from near the bottom to near the top of the liner sidewall." One of the interested parties in the litigation did not like this interpretation of the term "substantial" and subsequently appealed the district court's decision to the Federal Circuit. Although the Federal Circuit affirmed the decision as to the meaning of the term "substantial" in this case, the Federal Circuit, in dicta, ascribed a slightly different meaning to the term.

The Federal Circuit interpreted the meaning of the phrase describing the height of the ridges: "Substantially the entire height thereof simply means that the ridges must cover nearly the entire length of the sidewall . . . . A projection in the sidewall that does not span nearly the entire distance from the top to the bottom of the sidewall does not meet this limitation." The Federal Circuit did not mention how the district court arrived at its

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80 York Prods., 99 F.3d at 1572 (emphasis added).
81 Id. (emphasis added).
82 Id.
interpretation of this claim, but attributed the Federal Circuit’s correct interpretation to the patent prosecution history where the limitation was claimed to be added by the applicant.83

Furthermore, the Federal Circuit attested that the court was giving the claim its “ordinary meaning” since the patent “discloses no novel uses of claim words.”84 Likely, fewer than one percent of the patents that used the term “substantial” ascribe a specific definition to the word unless the patent drafter defined every word in the patent claim explicitly within the body of the specification. Nevertheless, utilizing the “ordinary meaning” philosophy, the court consulted a dictionary and picked out one of the numerous choices which must have been present to definitively state: “Ordinarily . . . ‘substantially’ means ‘considerable in . . . extent.’”85 However, the court continued in analyzing the term, further refining the definition to include: “largely but not wholly that which is specified.”86 Although “considerable in extent” and “largely but not wholly that which is specified” may sometimes be equivalent ways of describing a similar attribute, some situations may arise where only one of these two choices may be applicable to a given use of the term “substantial.”

Instead of providing clear guidance for future patent drafters, the Federal Circuit perpetuated the use of this ambiguous word even though the Federal Circuit found at least two other applicable interpretations.87 By deferring to the district court’s previous interpretation, “substantial” is certain to be interpreted in multiple ways. Furthermore, a third alternative interpretation was alleged by the Federal Circuit to have an equivalent meaning to the meanings developed by both the Federal Circuit and the district court.88

83 Id.
84 Id. Without an express intent to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning. Hoganas AB v. Dresser Indus., Inc., 9 F.3d 948, 951, 28 U.S.P.Q.2d (BNA) 1936 (Fed. Cir. 1993).
86 York Prods., 99 F.3d at 1573. See WEBSTER’S NINTH NEW COLLEGIATE DICTIONARY 1176 (9th ed. 1983) (containing even more alternative definitions of “substantial”).
87 York Prods., 99 F.3d at 1572-3.
88 Id. at 1573 (stating “the modifier “substantially” conveys that the ridge members extend over most of the ‘entire height’ of the sidewall portions”).
The Federal Circuit's affirmation of the district court's interpretation of the meaning of the language of the claim is awkward. The Federal Circuit interprets "substantial" to require a sidewall that "cover[s] nearly the entire length."\footnote{Id. at 1572.} The trial court held that the language required the sidewall to extend from "near the bottom to near the top."\footnote{Id.} These two interpretations are somewhat different as is the alternate interpretation given by the court as "extend[ing] over most of the 'entire height.'"\footnote{Id. at 1573.} A third court would likely ascribe a fourth meaning to this amorphous phrase, if not a fifth, sixth or seventh meaning.

The Federal Circuit did not merely affirm the district court's determination that "at least a substantial part of the entire height thereof" means extending from "near the bottom to near the top."\footnote{Id. at 1572.} Finding further clarification necessary, the court placed additional limitations on this phrase and justified the limitations on the "language and syntax" of the claims.\footnote{Id. at 1573.} The court hypothesized that "if 'substantial part' meant only ample height to accomplish a purpose, the claim would need to read 'only so much height as necessary to affix a structure against movement.'"\footnote{Id.} Perhaps this is exactly what the patent drafter believed was captured by the term "substantial" acting in reliance on previous uses of the term upheld in other patent infringement cases.\footnote{Id. at 1573.} However, this court, this day, held that this interpretation would be a "redraft . . . essentially strip[ping] many words in the claim of their meaning."\footnote{Id.} Perhaps the meaning attributed to this phrase by the court is a "redraft" of the intention of the patentee.

The Federal Circuit boldly stated that the specification and the drawings support the district court's interpretation of the claim.\footnote{Id.} The court held that "the scope of the claims is not necessarily limited to the specific embodiments described in the specifica-

\footnote{Id. at 1572.}
\footnote{Id.}
\footnote{Id. at 1573.}
\footnote{Id. at 1572.}
\footnote{Id. at 1573.}
\footnote{Id.}
\footnote{See supra note 10.}
\footnote{York Prods., 99 F.3d at 1573.}
\footnote{Id.}
tion". Remarkably, the York Products court found that because the specification does not suggest that less than the entire height is contemplated, then it has been disclaimed. This specification is conveniently not included as a reference because it is likely ambiguous and would not support the Federal Circuit's finding. Furthermore, an examination of the drawings provided in the case, Figures 2 and 7, portray two different load lock arrangements within the bed liner of the truck, neither of which is higher than three quarters of the height of the protective liner. Apparently the court did not understand the simple mechanics involved with this invention when it states: "At no point does the specification suggest that 'at least a substantial part of the entire height [of the sidewall]' means less than the entire height of the sidewall." 

The Federal Circuit must have felt some unease about its analysis of the meaning of the term "substantial" as the court utilized a separate claim that did not adhere to this language to remand the case back to the district court. The term "substantial" cannot be treated by either an alleged infringer or a patentee as a definitive term to which a court will ascribe a known meaning. In this case, "substantial" was held to mean near the bottom to near the top. In other situations, this flexible term may adopt alternative meanings, even in the absence of specific definitive language within the specification.

4. Amhil Enterprises Ltd. v. Wawa, Inc. The next case of interest concerning the interpretation of the term "substantial" is Amhil Enterprises Ltd. v. Wawa, Inc. Amhil is the assignee of U.S. Patent No. 4,421,244 entitled "Plastic Lids for Containers." The '244 patent describes a plastic container lid that improves over prior lids because of three features. First, the patent claims to improve the fabrication process by utilizing a lid that separates more easily from a mold. Secondly, the size is smaller, which facilitates shipping and storage as less volume is consumed by the
individual lids. Finally, the lid's design has an "enhanced rim-gripping ability" to provide for a more "secure hold." Amhil alleged that Wawa, among others, provided allegedly infringing cup lids to customers for covering beverages purchased at Wawa stores. The court granted the defendant's motion for summary judgment of noninfringement of the '244 patent upon finding no infringement of the '244 patent. The plaintiff appealed this issue in a case before the Federal Circuit.

Claim 1 was the subject of the alleged infringement action in the '244 patent, and part of that claim requires:

1. A lid for containers, made of thin, flexible plastic for mounting on and receiving the bead of a container, comprising: a central panel; a cavity...; means connecting said cavity to said central panel; a skirt portion extending downwardly from said cavity; said skirt portion having a plurality of outwardly extending projections, each having a SUBSTANTIALLY vertical face with substantially vertical side edges, and SUBSTANTIALLY vertical side walls extending inwardly from said face; the portions of said skirt... forming an undercut...; said outwardly extending projections... terminating...

The claim construction issues centered on two arguments. The first dealt with whether the "cavity" of the accused lids opened "downwardly and inwardly" as required by the third paragraph of claim 1. The second issue, "hotly contested" by the opposing parties, was whether the "outwardly extending projections" of the accused lids had "substantially vertical" faces, side edges, and walls.

Without citing precedent, Judge Rich began his analysis of the meaning of the "substantial" term by examining the figures...
included within the patent. Although he noted that the preferred embodiment, as may be illustrated by the patent drawings, does not necessarily or automatically limit the scope of a patentee's claims, in this case, the Federal Circuit considered the drawings first to determine the meaning of the term "substantial." Next, the Federal Circuit noted that "[t]he entire specification, including all of the claims, the prosecution history, and the prior art may all affect the interpretation ultimately placed on [the] claim language." The court did not discuss the "ordinary meaning" of the term "substantial"; the Federal Circuit did not utilize the ordinary meaning test until six months later when deciding the York Products case.

On the facts of the case, the patent drafter did a much poorer job of creating a smoke screen as to what was meant by the term "substantial" than was done by the '876 patent drafter in the York Products case. Within claim 1, the drafter appears to use "substantially vertical face" and "vertical face" interchangeably. Furthermore, the court held that the specification creates the impression that the drafter intended for "substantially vertical" and "vertical" to mean the same thing. However, the court does not acknowledge the unlikeliness and impracticability that a patent drafter would go to the trouble to include the "substantial" term unless creating some flexibility as to the degree of vertical required by the invention.

An examination of the prosecution history of the '244 patent reveals flaws in the plaintiff's argument causing it to unravel. Plastic container lids are a crowded art, implying that many different inventions deal with this subject. When Amhil obtained the '244 patent, Amhil had to distinguish the '244 patent from prior art. During the prosecution, the patent examiner cited U.S. Patent No. 4,194,645 as making the '244 patent obvious. The '645

110 Id.
111 Id.
112 Id.
114 Amhil, 81 F.3d at 1558-59 (Fed. Cir. 1996).
115 Id. at 1559.
116 Id. at 1560.
patent was a plastic lid with sloping vertical faces. In order to overcome the obviousness rejection, the applicant distinguished the '645 patent on the basis of the slope of the projecting faces. This allowed the Federal Circuit to conclude that "substantially vertical" may be properly interpreted as not including lids with sloping faces like those of the Zabner '645 patent."\footnote{Id. at 1561 (emphasis added).}

In other responses to the PTO, the patentee used "substantially vertical" and "vertical" interchangeably, which encouraged the court to hold that "substantially vertical" is essentially "vertical."\footnote{Id. at 1562.} Claims should be construed when possible to sustain their validity.\footnote{Idcs Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 U.S.P.Q. (BNA) 929 (Fed. Cir. 1984).} In the '244 patent, the court held that "substantially vertical face" means the same or as very close to "vertical face."\footnote{Amhil, 81 F.3d at 1562.} The court utilized prior art depicting outwardly extending projections of the same angle used by the accused infringer to arrive at this interpretation.\footnote{Id. at 1562.} The court held that this is the only interpretation which will maintain the validity of this claim in light of the crowded area of prior art.\footnote{Id.} In sum, the court concluded, "we interpret claim 1 to include only lids wherein the outwardly extending projections have well-defined faces that deviate only slightly, if at all, from the vertical."\footnote{Idcs Indus., Inc. v. Automation Tooling Sys., Inc., 938 F. Supp. 601, 605 (C.D. Cal. 1996).}

5. Chad Industries, Inc. v. Automation Tooling Systems, Inc. Once again, a court must interpret nebulous terms, including the meaning of "substantial." The patent at issue was U.S. Patent No. 4,910,859 entitled "Circuit Assembly System."\footnote{Chad Indus., Inc. v. Automation Tooling Sys., Inc., 938 F. Supp. 601, 605 (C.D. Cal. 1996).} This patent describes a type of robotic mechanism for putting electrical components (e.g., resistors, capacitors, and microprocessors) on printed circuit boards and securing them in place.\footnote{Chad Indus., Inc. v. Automation Tooling Sys., Inc., 938 F. Supp. 601, 605 (C.D. Cal. 1996).} The robotic arm moves the electrical component precisely over holes in the circuit board and places them into the board with an accuracy of...
within one thousandth of an inch. The technique used to temporarily hold the components in place before the soldering process is called "clinching." Clinching involves the bending of the component's leads sideways underneath the circuit board. Traditionally, there are two clinching methods: either positioning a barrier under the circuit board against a wire lead and moving the board until the lead is bent, or alternatively holding the board still and moving the barrier against the lead until the lead is bent. Chad's patent proposes a new method that attaches both uniform and non-uniform components by using a clinching device that is able to bend a lead in any direction and at any angle. This new method uses a clinching pin sticking up from a movable table below the circuit board. The clinching pin clinches the component at the desired angle and performs at a reported speed of up to one hundred inches per second. The pin also retracts allowing it to miss obstacles which may be in its way from clinching point to clinching point.

Chad's patent comprises fifty-one claims, however the court contemplates only claim one. The clinching pin operation described in claim one requires "means for driving said clinching element through a programmably determined path of travel substantially within a plane adjacent said lower surface .... The adversaries in this disagreement have diametrically opposing views so as to whether this claim allows the pin to avoid obstacles outside the plane of travel. The plaintiff, Chad Industries, asserted that the claim's use of the word "substantially" encompassed the ability to avoid obstacles outside of the plane of travel. However, the defendant, Automation Tooling, adamantly opposed this interpretation and argued that the claims of the patent require the pin to move "entirely in single horizontal plane.

126 Id.
127 Id. at 605-06.
128 Id.
129 Id. at 606.
130 Id.
131 Id.
132 Id. at 607-08 (emphasis added).
133 Id.
134 Id. at 607.
The court first examined the claim language to determine which interpretation of the claim would prevail. Then, utilizing the claims, the specification, and the prosecution history, the court determined the meaning of the claims. The court held that Chad's claim could "cover a system whose clinching pin goes down and up before it has finished bending all the leads on a particular component." The court found support for this holding in the claim, within the body of the specification, and alternatively from extrinsic evidence of how one skilled in the art of clinching would interpret the meaning of this terminology. The court in this case arrived at a broad interpretation of the word "substantially." Significant analysis into the specification as well as the prosecution history was required for this interpretation.

6. *Thorn EMI North America, Inc. v. Intel, Corp.* The final case to be examined by this Note on the interpretation of the word "substantial" is *Thorn EMI v. North America, Inc. v. Intel, Corp.* The patentee, Thorn, brought an infringement action against a competitor, Intel, alleging patent infringement of its U.S. Patent No. 4,486,943 which claims "an improved method for fabricating metal oxide semiconductor field effect transistors . . . in a large scale integrated circuit." Claim one, paragraph (e) of the patent, requires "heat driving the implanted source/drain region until its side edge is substantially aligned with the previously separated side edge of the gate electrode, whereby the source/drain edge is aligned with the gate electrode edge and there is substantially zero overlap." The patentee and the defendant disputed the meaning of the claim language "substantially zero overlap" and "substantially aligned." The defendant asserted that this language allowed absolutely no overlap to occur, but the patentee asserted the language meant that a ten percent tolerance of the

135 Id. at 606 (citing North Am. Vaccine, Inc. v. American Cynamid Co., 7 F.3d 1571, 1575, 28 U.S.P.Q.2d (BNA) 1333 (Fed. Cir. 1993)).
136 Chad Indus., 938 F. Supp. at 608 (citing Markman, Inc. v. Westview Instruments, Inc., 52 F.3d 967, 979 [sic] (Fed. Cir. 1995)).
137 Id. at 608.
138 Id. at 608-610.
140 Id. at 1188-89.
141 Id. at 1189 (emphasis added).
142 Id. at 1197-98.
gate electrodes length was permissible. The court rejected both parties' interpretations of the phrases "substantially zero overlap" and "substantially aligned."

Intel relied heavily on Amhil Enterprises, Ltd. v. Wawa, Inc. and attempted to read the word "substantially" out of the claims. The court noted that Amhil interpreted the claim's language "substantially vertical face" as "the same as or very close to vertical face." However, this court distinguished Amhil on the facts because they related to a crowded art that compelled a narrow construction of the claim language and dealt with a physical object whose dimensions were easy to measure as opposed to the submicroscopic measurements involved in Thorn. Furthermore, the Thorn court also noted that unlike the Amhil claim, which used the phrases "substantially vertical" and "vertical" interchangeably, the Thorn claim did not use the phrases "substantially aligned" and "aligned" interchangeably. For these reasons, the district court rejected the defendant's interpretation.

Conversely, the patentee requested that a tolerance of plus or minus ten percent be assigned to the word "substantially" based on the testimony of an expert witness. Because the expert changed his testimony on what an expert in the field would expect from a range of plus or minus five percent to ten percent, the court disregarded this inconsistent testimony. Additional testimony revealed that the asserted range of inaccuracy would lead to a poorly performing MOS transistor which was precisely the problem that this transistor sought to avoid.

The court noted that "[t]he word 'substantially' tends to become somewhat of a chameleon when it appears in patent claims." Judge McKelvie observed that during prosecution, the word takes on little substance or importance, but upon issuance, the term

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143 Id.
144 Id. at 1197-98.
145 Id. at 1197.
146 Id. at 1198 (citing Amhil Enterprises, Ltd. v. Wawa, Inc., 81 F.3d 1554, 1562 (Fed. Cir. 1996)).
147 Thorn, 81 F.3d at 1198.
148 Id. at 1197.
149 Id. at 1198.
150 Id.
151 Id.
“swells up to envelop potentially infringing products or processes.” Judge McKelvie further noted the awkward position the court is placed in when interpreting the claims for the jury, especially where a “chameleon” is present within the claims.

Upon looking to the ordinary meaning of “substantially” in the dictionary, the court was frustrated by a definition proving to be “practically useless as a guide to understanding or decision.” In some circumstances, the court suggested that the language in the claims, specification or prosecution history may provide guidance as to how to interpret this language, but the court admitted that the meaning is ambiguous when no guidance is given.

In this case, the court rejected both parties’ interpretations of “substantially” and defined the term as “the same as or very close to.” The court held this construction to be based on “the many references to zero overlap and perfect alignment in the patent and the prosecution history and the stated importance in the specification of near-perfect alignment for the speed and efficiency of the '943 patent.”

B. ALLOWANCE OF THE USE OF THE TERM “SUBSTANTIAL” IS BAD POLICY

When the PTO allows a patent drafter the flexibility to include terms like “substantial” or “substantially” in the claims of a patent, the drafter adeptly circumvents 35 U.S.C. § 112. No longer can a competitor judge the scope of one’s invention by the specific language utilized by the claim. No longer can the public rely on the language of the claim without resort to the specification. Furthermore, the public may be forced to make a determination of the interpretation of the terms by referring to prosecution history or possibly even through examination of prior art.

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152 Id.
153 Id.
154 Id. at 1198-99.
155 Id.
156 Id. at 1199.
157 Id.
The patent drafter should not be able to intentionally create a flexible patent claim using terminology such as the term "substantial." Flexible terminology may pass through the patent prosecution stage unnoticed, or at least given little consideration, by a patent examiner. Once the patent issues, the patentee may later assert this same terminology as having significant meaning. Interpretation by the courts may allow this type of claim to swallow up would-be infringers. In effect, the use of the term "substantial" literally defeats the specific language of § 112. Neither "substantial" nor "substantially" can be found to "particularly point out" and "distinctly claim" anything. "Substantial" is an amorphous word that the patentee hopes will be disregarded during patent prosecution only to grow, upon issuance, into a monster of a monopoly.

In just the six cases examined, at least a dozen different interpretations for the term "substantial" and "substantially" were defined by the various courts. No court gave a concrete definition of the term. For instance, recall York Products where the court affirmed that in bed liner technology "at least a substantial part of the entire height thereof" meant "near the bottom to near the top" even though the court also held that the height must "cover nearly the entire length." Notice that the Federal Circuit did not necessitate which direction the ridges must be close to, only "nearly the entire length." Using the dictionary, the York Products court discovered definitions which were not selected. Furthermore, a third definition was found to conclude that "substantial" "conveys that the ridge members extend over most of the 'entire height' of the sidewall portions." In this case alone, three slightly differing interpretations arose. Unfortunately, this court failed to insist on the importance of particularity and definiteness in the patent claim language to solve the problem.

The court in Amhil determined that "substantially vertical" faces could only be interpreted to mean the same as "vertical" due to the patent drafter's interchanging of the terms within the body of both the claims and specification. The court utilized a statement

\[99\text{ F.3d. 1568, 1572 (Fed. Cir. 1996).}\]
\[\text{Id.}\]
\[\text{Id. at 1572-73.}\]
\[\text{Id. at 1573.}\]
\[\text{81 F.3d 1554, 1559 (Fed. Cir. 1996).}\]
made to the PTO by Amhil asserting that "substantially vertical" did not include lids with sloping faces like a particular prior art reference. The court held that the faces could deviate "only slightly, if at all from the vertical." Effectively, this court held that "substantial" was meaningless within the body of these claims both literally as well as under the doctrine of equivalents.

In the Curley case, the court held that "substantially complete enclosure" could possibly include ventilation slots which would encompass prior art and therefore disallowed the patent application. This is not the interpretation of the term "substantial" as applied in the Amhil case. In fact, this was a broad interpretation utilized by the court to negate the argument made by Curley which suggested that "substantially" meant "essentially." However, the court in Amhil effectively stated that "substantially" meant "essentially."

In Ex parte Wheeler, the court held that "substantially parallel" effectively meant essentially parallel when it held that the two surfaces must be as closely to parallel as is humanly possible. Furthermore, "substantially" does not mean "approximately." However, the Chad court granted the term great flexibility by allowing "means for driving said clinching element through a programmably determined path of travel substantially within a plane adjacent said lower surface" to include the movement of the clinching element in a perpendicular direction to avoid obstacles. The Chad court allowed "travel substantially within a plane" to include intentional travel outside of that plane. "Substantially" appears to be interpreted as "occasionally" according to this court.

Lastly, in Thorn, the court was totally frustrated by the use of the terminology "substantially aligned" and "substantially zero overlap." The court held that "substantially" meant "the same as or very close to" after rejecting two opposing interpretations.

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163 Id. at 1561.
164 Id. at 1562.
165 158 F.2d 300, 303 (C.C.P.A. 1946).
166 Id. at 304.
168 Id.
proffered by the parties. This seems to be a compromise between the "essentially" type of interpretations found in *York Products*, *Amhil*, and *Wheeler* and the open-ended interpretations found in the *Chad* and *Curley* cases.

IV. CONCLUSION

The results of not allowing the use of amorphous terms in patent claim language will benefit the patentee, the competitor, the PTO and all of the public—in a sense, there is no loser. The only party disadvantaged is the prospective patentee who wishes to attempt to monopolize more than legally allowable and then enforce this expanded patent against an alleged infringer. The claims of this expanded patent would not have been prosecuted with the same meaning as now ascribed by the patentee and would serve to be a detriment to the common good. Elimination of this type of language within the patent claim by forcing patent applicants to observe 35 U.S.C. § 112 would benefit society as a whole.

Admittedly, if a few dozen words of the same amorphousness as "substantial" were precluded from use in patent claims, the ability of one to claim the invention would be somewhat limited. However, this limitation would not prove to be unduly burdensome. Theoretically, less infringement would occur because competitors would better understand the boundaries of the patentee’s monopoly. Also, litigation would be initiated in fewer cases because the patentee and the alleged infringer would be in a better position to predict the outcome of a lengthy and expensive trial. The applicant would not be harmed because the patent attorney would know which words were "off limits" in the claim section of a patent. The inventor would not be aware of any change in policy or coverage of his invention.

As mentioned above, in the six cases examined in detail in this Note, at least six interpretations of the term “substantial” resulted. The courts differed in their methods of interpreting the language within the claims. The courts relied, in varying degrees, on the ordinary meaning of the terms, language within the claims, language in the specification, the prosecution history, and prior art

to arrive at their respective interpretations. There was no consistent definition provided for the term; some, even recent cases, discovered diametrically opposing interpretations. This type of terminology will continue to breed litigation and ambiguity in the interpretation of patent claims. The need for uniformity in the interpretation of patent claims is important as was stressed by the Supreme Court in Markman. The use of ambiguous terminology within the claims themselves does not further this goal.

The public and especially the competitor benefit from not having to question whether or not the specification or prosecution should be examined. An examination of the prosecution history by the general public seems to run afoul of the purpose of the patent system’s requirement to particularly point out and distinctly claim the invention. Additionally, the requirement of some courts that the claim language be interpreted in light of the prior art is too great a burden for society to bear when the language of § 112 requires particularity. How is the public to know which prior art should be examined? This appears to be an unreasonable burden at first glance.

An alternate method would be to require the patent applicant to particularly define amorphous words within the body of the specification itself or else be limited to a standard definition included within the MPEP. For example, within the body of the specification of a patent using “substantially vertical,” the patentee should be required by the PTO to define “substantially vertical.” The patentee may state something like, “substantially vertical requires that the vertical surface be within five degrees of perpendicular from the lower surface.” This would fulfill the requirement of § 112 without burdening anyone except the patent drafters. What a small price to pay for clarity and definiteness in this area of patent law.

Before a change is made at the PTO, when “substantial” is utilized in patent claims, the only way to accurately determine the interpretation is to file suit against a suspected infringer. If the

173 Id.
interpretation selected by the court is found to be unacceptable, the unsatisfied party may appeal to the Federal Circuit for a final determination. However, this litigation could be prevented by the simple requirement of explicitly defining facially ambiguous terms within the body of the specification or alternatively preventing their use within the patent claims.

STEPHEN J. STARK