

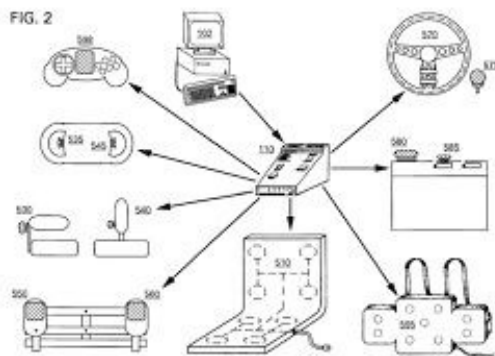
## Federal Circuit Narrows Claim Construction Options in Game Controller Suit

February 22, 2012 by [Ryan Lindsey](#) and [Nick Setty](#)

In *Thorner v. Sony Computer Entertainment America, LLC* (Case No. 2011-1114, Feb. 1, 2012) (Moore\*, Rader & Aiken (D. Or. sitting by designation)), the Federal Circuit reiterated the prohibition against importing limitations from the specification and reversed a district court construction depending from consistent uses of the disputed phrase in the specification.

Thorner sued Sony for infringement of U.S. Patent No. 6,422,941, which claims a feedback system for video games. *Id.* at 2-3 The claimed system involved an actuator that provides tactile feedback to a player when certain events occur in a game. *Id.* If the player crashes a car, the actuator can vibrate to give tactile feedback to enhance the user experience and to supplement visual and audio effects simulating the crash. *Id.*

One claim construction dispute centered on the phrase “attached to said pad,” which the district court construed to mean that an actuator was attached to an exterior surface of the pad, based on the ‘941 specification. *Thorner v. Sony Computer Entm’t Am. LLC*, No. 09-cv-1894, 2010 WL 3811283, at \*6 (D.N.J. Sept. 23, 2010). The district court relied on the specification’s use of the term “attached” only in embodiments with an actuator attached to a pad’s outside surface, and contrasted an embodiment which described as “embedded” an actuator inside the pad. *Id.* After claim construction, the parties stipulated to noninfringement and appealed. Slip Op. at 4.



The panel reversed, finding that the district court erred in its reliance on the specification and its uses of “attached” with embodiments with external actuators and “embedded” for an internal actuator. Slip Op. at 8.

[T]he specification never uses the word 'attached' when referring to an actuator located on the interior of a controller. We hold that this does not rise to the level of either lexicography or disavowal. Both exceptions require a clear and explicit statement by the patentee. It is not enough that the patentee used the term when referencing an attachment to an outer surface in each embodiment. [Slip Op. at 9 (citations omitted).]

The panel acknowledged that such use of distinct descriptors *could* amount to a redefinition, slip Op. at 9-10, but rejected the notion that the specification at hand was sufficiently clear in its redefinition or disavowal. *Id.* In so concluding, *Thorne* reiterated the axiom that claim terms are to be afforded the ordinary and customary meanings a skilled artisan would employ, see e.g., *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (*en banc*), and recognized that the two potential exceptions—own lexicographer or express disavowal—factually did not apply. Slip Op. at 5.

To be a lexicographer “a patentee must ‘clearly set forth a definition of the disputed claim term’ other than its plain and ordinary meaning.” Slip Op. at 5 (*citing CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002)). Disclosing a single embodiment or referring to all embodiments consistently, do not satisfy the standard. Slip Op. at 5. Rather, the patentee must “‘clearly express an intent’ to redefine the term.” *Id.* (citations omitted).

Express disavowal likewise requires a patentee to “demonstrate intent to deviate from the ordinary and accustomed meaning of a claim term by including in the specification expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.” *Id.* at 6 (*citing Teleflex, Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002)). Exclusionary language may appear in either the specification or the prosecution history. *Id.* Disparaging a particular embodiment, characterizing an embodiment exclusively as the “present invention,” and confining the invention to “the embodiments ... contemplated and disclosed herein,” may satisfy the disavowal standard under the appropriate circumstances. *Id.* (*citing Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1339, 1342-43 (Fed. Cir. 2001)).