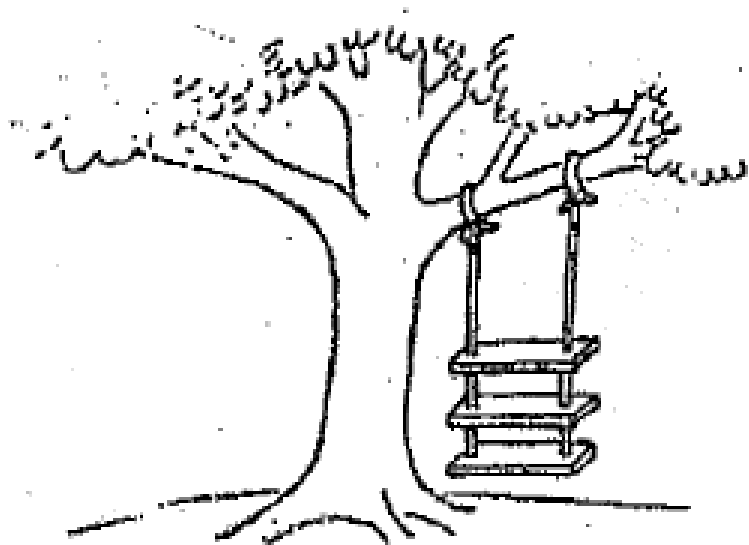


# Broadest Reasonable Interpretation Standard

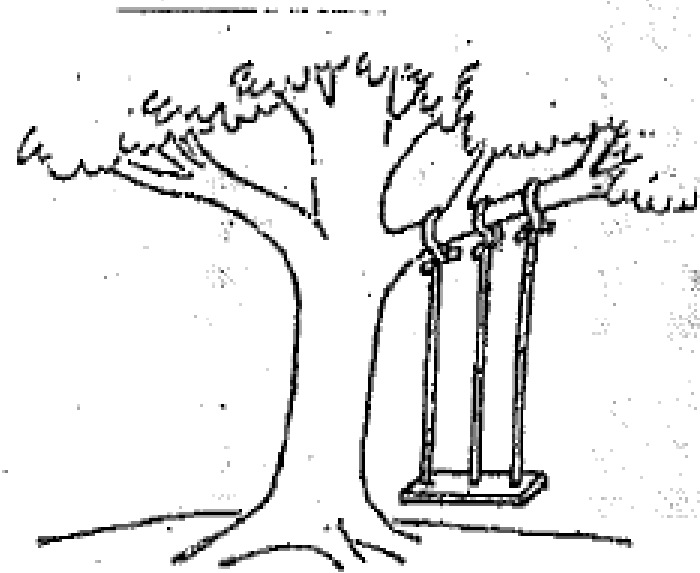
Janet Gongola  
Associate Solicitor  
Office of the Solicitor  
U.S. Patent & Trademark Office

# Setting the Stage

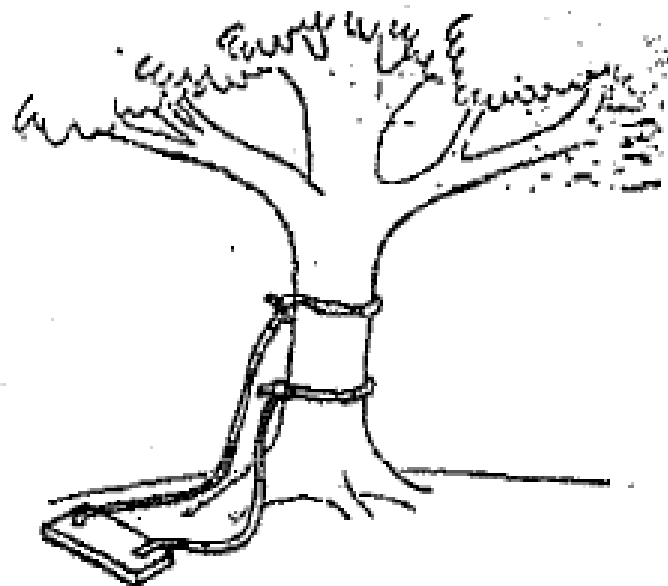
# Why Claim Interpretation Matters



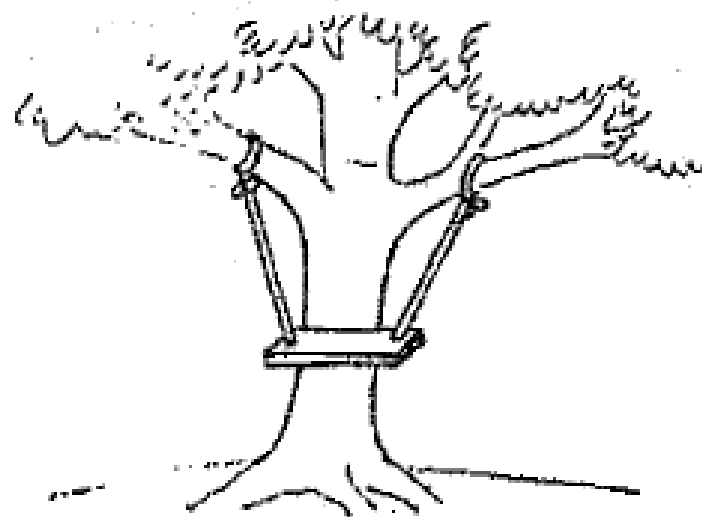
As Dan understood it.



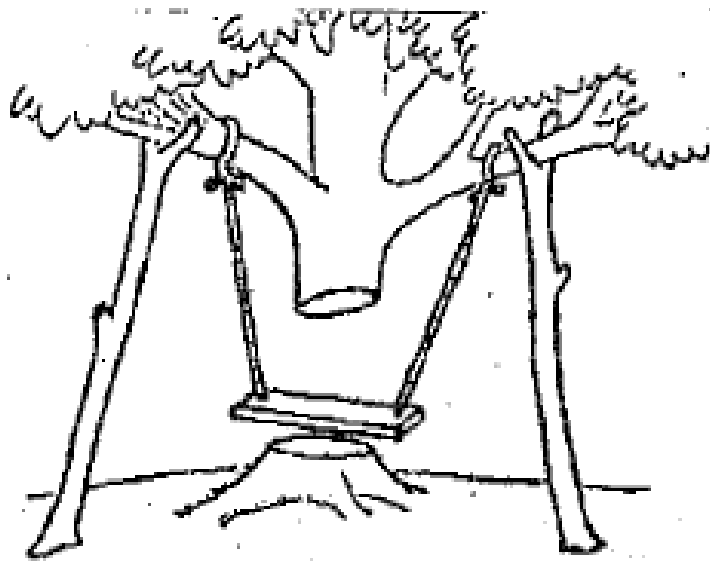
As Brent described it.



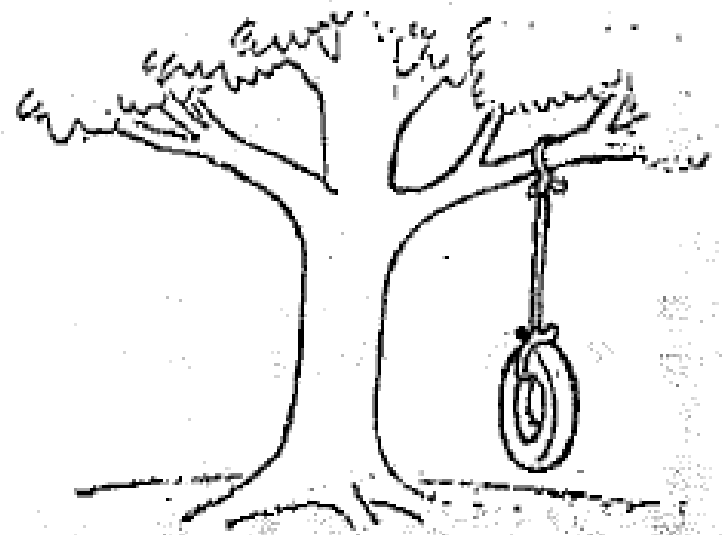
As Martin explained it.



As Mark told the examiner.



As Trent issued the CIP.



What the inventor had in mind.

# Overview

- Birth and Evolution of BRI Standard
- Justification for BRI Standard
- Extension of BRI Standard
- Importance and Application of BRI
- Practical Tips
- When Worlds Collide: Parallel USPTO and District Court Proceedings Involving Claim Construction

# Birth and Evolution

# In re Carr

(D.C. Cir. 1924)

- Distinguished between claim interpretation before and after the issuance of a patent

<b>Before Patent Issuance</b>	<b>After Patent Issuance</b>
Applicant can control phraseology to cover his actual invention	Patentee cannot control phraseology
Give claim “the broadest interpretation of which [it] reasonably [is] susceptible” to protect real invention and to prevent needless litigation after patent issues	Interpret claim to protect patentee



# In re Kebrich

(CCPA 1953)

- Echoes *Carr* Court's distinction between claim interpretation pre- and post- patent issuance
- After patent issuance, a court construes a claim to “sustain patents once granted”
- Before patent issuance, the USPTO and reviewing courts shall give claims “the broadest interpretation which, within reason, may be applied”

# In re Prater

## (CCPA 1969)

- Enhanced the *Kebrich* standard
- “Claims yet unpatented are to be given the broadest reasonable interpretation consistent with the specification” during examination
- No sound reason why, at any time before patent grant, an applicant should have limitations from the specification read into the claims where no express statement of limitation is included in the claim

# In re Sneed

(Fed. Cir. 1983)

- Enhanced the *Prater* standard
- “It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, . . . . and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art”

# Vitronics Corp. v. Conceptronic, Inc.

(Fed. Cir. 1996)

- Prior art references may be “indicative of what all those skilled in the art generally believe a certain term means . . . [and] can often help to demonstrate how a disputed term is used by those skilled in the art”

# In re Morris

(Fed. Cir. 1997)

- Set the definitive claim construction standard to be applied by the USPTO
- Applicant argued that USPTO required to use same claim construction standard applied by courts during infringement proceedings pursuant to *Markman v. Westview Instruments*, 52 F.3d 967 (Fed. Cir. 1995) (*en banc*)
- USPTO argued that it follows the BRI standard pursuant to long line of Federal Circuit precedent

# Morris (cont.)

- *Markman* involved an infringement suit, “a distinction with a difference”
- Patents in infringement suits are presumed valid by statute. *See* 35 U.S.C. § 282
- In contrast, no presumption of validity before the USPTO; it is the USPTO’s duty to assure that the patentability requirements are met before issuing a patent

## Morris (cont.)

- “It would be inconsistent with the role assigned to the PTO in issuing a patent to require it to interpret claims in the same manner as judges who, post-issuance, operate under the assumption the patent is valid”

# Morris (cont.)

- “[T]he PTO applies to the verbiage of the proposed claims

[a] the broadest reasonable meaning of the words in their ordinary usage

[b] as they would be understood by one of ordinary skill in the art,

[c] taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification”



# Phillips v. AWH Corp.

(Fed. Cir. 2005) (*en banc*)

- Confirmed the *Morris* standard
- “The Patent and Trademark Office (‘PTO’) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art’”

# BRI Standard Today

- **Then:** broadest interpretation within reason
- **Now:** broadest reasonable interpretation in light of the specification as it would be interpreted by one of ordinary skill in the art
- *See* MPEP § 2111.01

# Justification for BRI

# Amendment of Claims

- During prosecution, an applicant can amend the claims to obtain protection commensurate with his invention
  - Avoid cited prior art
  - Overcome written description or enablement rejection
- Applicant and Examiner work to define the metes and bounds of the claim via the give and take of the rejection and response
  - Amend claim language to convey specific meaning
  - Provide a definition in the specification
- Prosecution should result in claims that are precise, clear, correct, and unambiguous

# Amendment of Claims (cont.)

- Only by amending claims with the BRI can uncertainties in claim scope be removed before patent issuance
- Serves the public by reducing the possibility that, after the patent is granted, the claims may be interpreted by the courts as having broader coverage than justified or examined by the USPTO

# Presumption of Validity

- After patent issues, patentee cannot amend during infringement litigation—the patent is presumed valid under 35 U.S.C. § 282
- The exchange that transpired in the USPTO gave birth to the presumption of validity

# Presumption of Validity (cont.)

- Because of the presumption of validity, district courts construe claims to preserve validity
- But, this rule of claim construction applies only where there is an ambiguity, *i.e.*, more than one possible construction. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1327 (Fed. Cir. 2005)

# In re Etter

(Fed. Cir. 1985) (*en banc*)

- Suggests inverse relationship between BRI and the presumption of validity, *i.e.*, where the presumption attaches, BRI does not apply
- After a patent issues, two situations exist:
  - The patent is presumed valid, placing the burdens of proof and persuasion on the party that attacks validity
  - The patentee cannot amend his claims. Claims are construed, if possible, to preserve them
- Before a patent issues, neither situation exists:
  - There is no presumption of validity
  - The patentee can amend his claims. BRI applies



# Extension of BRI

# In re Reuter

(CCPA 1981)

- Applied BRI to reissue proceedings
- Little analysis; adoption of the logic of *Prater*
- Acknowledges that the USPTO applies BRI “to reduce the possibility that, after the patent is granted, the claims may be interpreted as giving broader coverage than is justified.” *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969)

# In re Yamamoto

(Fed. Cir. 1984)

- Applied BRI to reexamination proceedings. *See* MPEP § 2258, Part G
- Applicant in a reissue proceeding has a statutory right to amend his claims to correspond with his contribution over the art. *See* 35 U.S.C. § 305

# Miel v. Young

(D.C. Circuit 1907)

- Applied BRI to interference proceeding
- “The reasonable presumption is that an inventor intends to protect his invention broadly; and consequently the courts have often said that the scope of a claim should not be restricted beyond the fair and ordinary meaning of the words, save for the purpose of saving it.”

# Kuppenbender v. Risdorfer

## (CCPA 1939)

- BRI applies to an interference count if no ambiguity exists in the language of the count
- If ambiguity exists, then resort to specification to interpret the count
- *See* 37 C.F.R. 41.200(b) (2004) (“A claim shall be given its broadest reasonable construction in light of the specification of the application or patent in which it appears.”)

# Ex Parte Papst-Motoren

## (BPAI 1986)

- Single exception to USPTO's application of BRI.  
*See* MPEP § 2258, Part G
- In a reexamination proceeding after the patent expires, BRI does not apply. Instead, the USPTO construes claims like the district court
- The reason is because an applicant cannot amend the claims since the patent has already expired. *See* 37 C.F.R. § 1.530(d) (1986) (providing that “[n]o amended or new claims may be proposed for entry in an expired patent”)

# Papst-Motoren (cont.)

- When would the USPTO reexamine an expired patent?
- Reexamination requested 13 months before patent expired, and Board decision issued 13 months after patent expired

# In Re Tan

(Reexamination No. 90/006,696; pending CAFC Appeal)

- Raises the *Papst-Motoren* rule as an issue
- Facts similar to *Papst-Motorsen*: reexamination request, patent expired, Board decision
- Board declined to follow *Papst-Motoren* rule, reasoning that BRI applies because patentee had the opportunity to amend the claims during the First Office action, which issued before the patent expired
- Briefing in progress



# Importance & Application of BRI

# Why the BRI Standard Matters

- Applicability of prior art and, in turn, rejections under 35 U.S.C. §§ 102 and 103
- Written description and enablement under 35 U.S.C. § 112, first paragraph
- Whether claim particularly points out and distinctly claims an applicant's invention as required by 35 U.S.C. § 112, second paragraph

# Standard of Review

- Claim construction is matter of law that the CAFC reviews *de novo*. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998)
- But, since USPTO gives claims their broadest reasonable interpretation, CAFC reviews the “reasonableness” of the USPTO’s interpretation. *In re Morris*, 127 F.3d 1048, 1055 (Fed. Cir. 1997)

# In re Buszard

(Fed. Cir. 2007)

- Claim 1: A flame retardant composition comprising . . . a flexible polyurethane foam reaction mixture
- USPTO construed “flexible polyurethane foam” to mean “any reaction mixture which produces, at least ultimately, a flexible polyurethane foam” such that a “flexible polyurethane foam” would encompass a rigid foam product
- Applicant argued that a “flexible polyurethane foam” cannot include a rigid polyurethane mixture; the two mixtures are chemically different

# Buszard (cont.)

- Was USPTO's construction reasonable?

# Buszard (cont.)

- CAFC: No
- “No matter how broadly ‘flexible foam reaction mixture is construed,’ it is not a rigid foam reaction mixture”
- “[I]t is not a reasonable claim interpretation to equate ‘flexible’ with ‘rigid,’ or to equate a crushed rigid polyurethane foam with a flexible polyurethane foam”

## Buszard (cont.)

- Implication: Prior art reference directed to a rigid foam product is not anticipatory
- “Only by mechanically crushing the rigid product into small particles is it rendered flexible, as a rock can be mechanically crushed to produce particles of sand”
- Reversed the Board’s anticipation rejection

# Buszard (cont.)

(J. Prost dissent)

- Board's interpretation was broad, but not unreasonable
  
- Specification states:
  - “[t]he flexible polyurethane foam compositions . . . according to the present invention include all well known, industrial compositions.” (Emphasis added)
  - Description of how to make “[t]he flexible polyurethane foam compositions” covers how to make rigid polyurethane foam compositions
  
- No evidence in the record of how a skilled artisan would define “flexible polyurethane foam”



# In re Bigio

(Fed. Cir. 2004)

- Claim 1: A “hair brush” comprising: . . .
- USPTO construed “hair brush” broadly to mean brushes used for human hair on the scalp as well as brushes used for hair on other animal parts (e.g., human facial hair, human eyebrow hair, pet hair)
- Applicant argued that “hair brush” was limited to brushes for the scalp hair only
- For support, Applicant pointed to “Objects of the Invention,” which discussed an “anatomically correct hairbrush” for brushing scalp hair

# Bigio (cont.)

- Was USPTO's construction reasonable?

# Bigio (cont.)

- CAFC: Yes
- “Hair” preceding “brush” does not limit claim to any particular kind of hair (*e.g.*, scalp hair)
- Hair brush may encompass not only scalp hair but any kind of hair (*e.g.*, facial hair)
- Board correctly did not import limitation from specification, *i.e.*, “Objects of the Invention”

# Bigio (cont.)

- Implication: Board could apply three references directed to toothbrushes as prior art
- CAFC ultimately upheld obviousness rejection based on those toothbrush references

# In re Cortright

(Fed. Cir. 1999)

- Claim 1 recites a method of “treating scalp baldness with an antimicrobial to restore hair growth, which comprises rubbing into the scalp [Bag Balm®]”
- USPTO construed “restore hair growth” to mean returning the user’s hair “to its original state,” that is, a full head of hair

# Cortright (cont.)

- Was USPTO's construction reasonable?

# Cortright (cont.)

- CAFC: No
- USPTO's construction should not be so broad as to conflict with the meaning given to identical terms in other patents from analogous arts

# Cortright (cont.)

- USPTO's construction of "restore hair growth" was inconsistent with the definition it gave to that phrase in three other patents
  - Patent 1: "achieved a significant degree of improvement," "partial filling-in and restoration of the bald spot," and "fifty percent more hair in both the frontal and middle sections of his scalp"
  - Patent 2: "approximately 25% regrowth" and "increase in the number of new hairs . . . from 0 to 22"
  - Patent 3: increased hair growth but not a complete baldness cure
- Skilled artisan would have construed "restore hair growth" to mean increasing the amount of hair grown on the scalp but not necessarily producing a full head of hair



# Cortright (cont.)

- Implication: Enablement rejection reversed because specification taught the amount of Bag Balm® to apply and the amount of time in which to expect results

**When Worlds Collide:  
Parallel USPTO & District  
Court Proceedings Involving  
Claim Construction**

# Ethicon v. Quigg

(Fed. Cir. 1988)

- U.S. Surgical sued Ethicon for patent infringement
- Approximately 1 year later, Ethicon filed a reexamination request on the patent
- U.S. Surgical moved to stay the reexamination, pending the outcome of the litigation
- USPTO granted the stay, and Ethicon sued

# Ethicon (cont.)

- CAFC required USPTO to resume the reexamination, rejecting the argument that the district court and reexamination proceedings would be duplicative
- The reason is because USPTO and district court employ different standards

<b>District Court</b>	<b>USPTO</b>
Patent presumed valid	Patent not presumed valid; BRI applies
Clear & convincing evidence to show invalidity	Preponderant evidence to show invalidity

# Ethicon (cont.)

- “[W]e see nothing untoward about the PTO upholding the validity of a reexamined patent which the district court later finds invalid. . . . [I]f the district court determines a patent is not invalid, the PTO should continue its reexamination . . . . On the other hand, if a court finds a patent invalid, and that decision is either upheld on appeal or not appealed, the PTO may discontinue its reexamination”

<b>First in Time</b>	<b>Later in Time</b>
USPTO—valid	D.C.—invalid
D.C.—not invalid	USPTO—continue
D.C.—invalid	USPTO—stop

# In re Trans Texas Holdings Corp.

(Fed. Cir. 2007)

- District court infringement proceeding with claim construction followed by reexamination proceeding before USPTO
- Disputed claim limitation was “responsive to the rate of inflation”
- District court construed the limitation to mean “directly responsive to a market indicator of prior actual inflation,” *i.e.*, a one-to-one relationship

# Trans Texas (cont.)

- USPTO applied the BRI and construed the limitation to mean not limited to a one-to-one relationship but instead includes a delayed relationship in which adjustments are made in one percent increments
- Applicant argued that USPTO should have applied district court's narrower construction

# Trans Texas (cont.)

- CAFC upheld USPTO's construction, observing that USPTO applies BRI and that BRI supported a broader construction than accorded by the district court
  - Nothing in the specification or prosecution history to require an immediate inflation adjustment
  - Dictionary defines “directly” *inter alia* as “after a little while: shortly, presently”

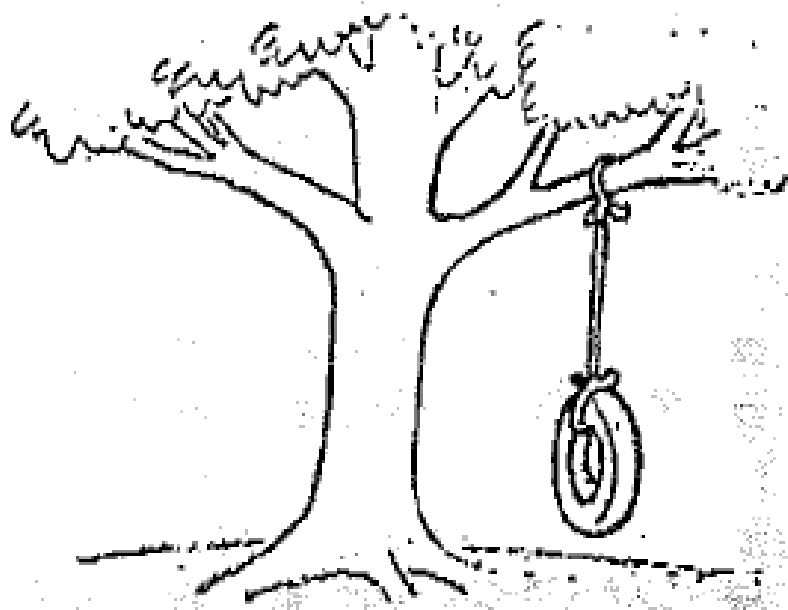


# In re Translogic Tech., Inc.

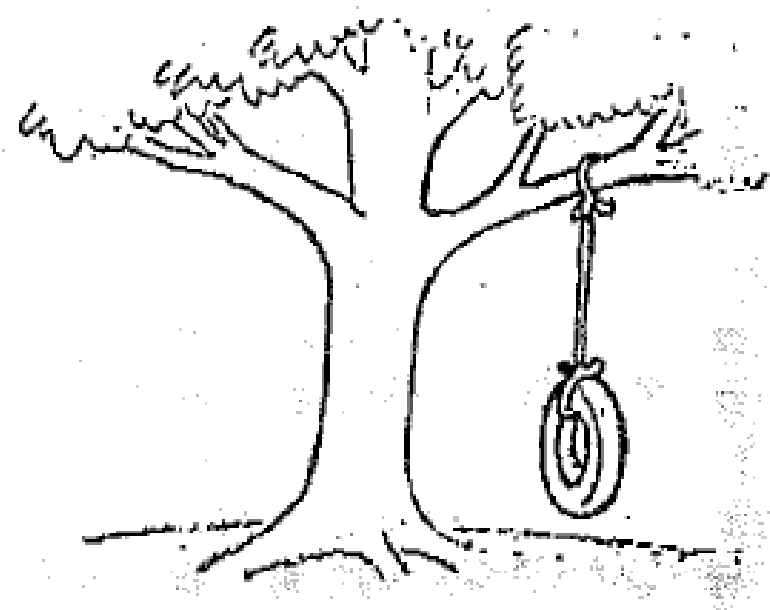
(Fed. Cir. 2007)

- Confirms *Trans Texas* that USPTO is not bound by a district court's earlier (and narrower) claim construction
- Same facts as *Trans Texas*: district court infringement proceeding with claim construction followed by reexamination proceeding before USPTO
- CAFC again upheld USPTO's broader construction made under BRI standard

# And the Curtain Falls . . .



What the inventor had in mind.



As Trent issued the CIP.

# Contact Information & Disclaimer

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- Thanks to Anish Gupta, detailee, for his fine research assistance in preparing this presentation