

# UPDATE

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## BEST PRACTICES FOR LEVERAGING BROADEST REASONABLE INTERPRETATION IN PATENT PROSECUTION



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Broadest reasonable interpretation (BRI) can be a challenging, and at times frustrating, issue for patent practitioners. When it comes to interpreting claim terms, examiners usually grasp the concept of “broadest” but at times can struggle with the “reasonable” part. Now that the Supreme Court has confirmed that BRI is here to stay, in *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131 (2016), patent practitioners should try to find ways to leverage the doctrine to best serve their clients’ interests.

Several policy reasons have been cited in support of the U.S. Patent and Trademark Office (USPTO) using BRI to interpret claims during examination, in contrast to the sometimes narrower construction used by federal district courts and other tribunals as outlined in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). For example, the practice of BRI functions to ensure that claims are not

given a broader interpretation during enforcement than they were given during procurement. M.P.E.P. § 2111. A broader construction during prosecution also has been justified on the ground that patent applicants have the opportunity to amend claims while an application is pending before the USPTO, whereas patentees are not permitted to amend claims during an enforcement action. *Id.*

Several recent decisions by the U.S. Court of Appeals for the Federal Circuit provide guidance for practitioners, both when drafting a patent application and initial claim set, as well as when arguing that an examiner’s construction of a claim term or application of the prior art is unreasonable.

### CLEARLY DEFINE CLAIM TERMS IN THE SPECIFICATION

A patentee may be his or her “own lexicographer and/or may disavow claim scope,” but to do so, the “patentee must *clearly* express that intent in the written description.” M.P.E.P. § 2111.01. Oftentimes patent drafters avoid including explicit definitions in the

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specification due to the risk of unnecessarily limiting claim scope. However, in appropriate situations an applicant may strategically leverage lexicography, for instance to assign a special definition to a term that narrowly avoids known prior art or excludes an inapplicable definition that otherwise may fall under its “plain and ordinary” meaning.

If a claim term is not explicitly defined in the specification, it should be expected that the term may be construed under BRI in a way that is broader than the disclosed embodiments. For example, in *In re Chaganti*, 468 F. App’x 974, 976 (Fed. Cir. 2012), the applicant argued that the Patent Trial and Appeal Board’s (PTAB’s) interpretation of “intangible property” to include “stocks and bonds” was unreasonable in light of the specification. *Id.* However, the Federal Circuit noted that the specification included several references to “intangible property,” and even though the specification listed types of intangible property that did not include stocks and bonds, the list was non-exclusive. *Id.* Some of the phrasing that indicated a non-exclusive list included “related to,” “intangible forms of property such as,” and a statement that “the invented method and system should not be limited by the discussion provided herein.” *Id.* The PTAB’s interpretation was thus held to be reasonable. *Id.*

### **RELY ON SPECIFICATION TO LIMIT REACH OF BRI**

Even when a claim term is not explicitly defined in the specification, the specification often provides the best ammunition against an unreasonable construction of the term. Under BRI, “claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Abbott Diabetes Care, Inc.*, 696 F.3d 1142, 1149 (Fed. Cir. 2012). BRI “does not give the PTO an

unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, claims should always be read in light of the specification and teachings in the underlying patent.” *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). The specification has been identified as “the single best guide to the meaning of a disputed term.” *Abbott*, 696 F.3d at 1149.

In *Abbott*, the Federal Circuit found that the PTAB improperly construed “electrochemical sensor” to include wires and cables despite the specification criticizing prior art that included the same, and further despite “every embodiment showing the electrochemical sensor without wires and cables.” *Id.* at 1149-50. In finding the PTAB’s interpretation unreasonable, the Federal Circuit noted that, “[e]ven when guidance is not provided in explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents.” *Id.*

### **USE TERMS TO EXPLAIN THE RELATIONSHIP BETWEEN CLAIM ELEMENTS**

When drafting claims, an applicant may use language to clarify that different elements in the claims refer to distinct items. Appropriate use of antecedent basis, as well as relative terms, such as “other,” can help to show that a claim interpretation that ignores the antecedent basis or relative term is improper. For example, in *Microsoft Corp. v. Proxycorn, Inc.*, 789 F.3d 1292, 1299 (Fed. Cir. 2015), the Federal Circuit found that the PTAB “erred in concluding that the ‘two *other* computers’ could include the caching computer” where the claim language recited a “system comprising a gateway, a caching computer, and ‘two other computers.’” The Federal

Circuit noted that “[n]ot only are the ‘two other computers’ recited independently from, and in addition to, the gateway and caching computers, the word ‘other’ denotes a further level of distinction between those two computers and the specific gateway and caching computers recited separately in the claim.” *Id.*

### **CITE OTHER CLAIM LIMITATIONS TO SHOW A PROFFERED CONSTRUCTION IS ILLOGICAL**

An applicant sometimes may use other limitations in a claim to show that an overly broad construction of a term is illogical. The Federal Circuit has on multiple occasions found the PTAB’s construction, or the PTAB’s application of the prior art relative to the construction, unreasonable when the construction created an illogical result. Other limitations explicitly recited in a claim are relevant to both how the claim should be interpreted and whether the claim is novel and non-obvious over the prior art. Note that “[c]onstruing a claim term to include features of that term already recited in the claims would make those expressly recited features redundant.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1237 (Fed. Cir. 2016).

For example, in *PPC Broadband, Inc. v. Corning Optical Commc’ns RE, LLC*, 815 F.3d 734, 743 (Fed. Cir. 2016), a claim recited “a continuity member disposed ... so as to maintain electrical continuity between the coupler and the post when the coupler is in the partially tightened position on the interface port, even when the coupler is in the fully tightened position on the interface port, and even when the post moves relative to the coupler.” Yet, the PTAB “explicitly declined to require the continuity member to ‘maintain a continuous electrical connection.’” *Id.* at 744. In finding the PTAB’s interpretation unreasonable, the

Federal Circuit noted that, the “claims expressly require” the continuity member to maintain a continuous electrical connection, “not because they use the term ‘continuity member,’ but because they use the phrase ‘maintain electrical continuity.’” *Id.*

As another example, in *D’Agostino v. MasterCard Int’l Inc.*, 844 F.3d 945, 950 (Fed. Cir. 2016), the PTAB improperly construed “single merchant.” The Federal Circuit noted that this limitation required “that, when the transaction code is requested, the request limits the number of authorized merchants to one but does not then identify the merchant, such identification occurring only later.” *Id.* Yet, the PTAB construed the single merchant reference so that a prior art reference disclosing the scenario “in which the customer seeks a transaction code for an identified chain of stores and, later, picks a specific store within that chain” anticipated or rendered obvious the claim at issue. *Id.* In explaining why the PTAB’s construction was unreasonable, the Federal Circuit noted that “[t]he only way to avoid [the] straightforward logic would be to separate “single merchant” (in the first clause) from “particular merchant” (in the second clause). [However] the claim language of the single-merchant limitation does not allow that separation. Indeed, the second clause speaks expressly of “any particular merchant being identified as said single merchant.” *Id.*

### **USE DEPENDENT CLAIMS AND CLAIM DIFFERENTIATION TO GIVE FURTHER CONTEXT TO TERMS IN INDEPENDENT CLAIMS**

When drafting claims, an applicant may include additional features or defining language in a dependent claim of a target scope to help ensure that a corresponding term in the independent claim is construed at least as broadly as the target scope. If

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a proposed construction of a term in an independent claim “would nullify claims that depend from it, the doctrine of claim differentiation creates a presumption that such a construction is improper.” *Marine Polymer Techs., Inc. v. HemCon, Inc.*, 672 F.3d 1350, 1368 (Fed. Cir. 2012). Dependent claims thus can be used not only to create fallback positions, but also as a tool to guide the construction of terms in independent claims.

### CONCLUSION

Although BRI at times may present a source of frustration for patent practitioners, it is possible to strategically navigate the doctrine to procure strong and defensible patents.

Practitioners should keep in mind that the specification always plays a central role in giving meaning to claim terms, whether by an explicit definition or through contextual guidance from which the meaning may be inferred. Structuring claims in a way that clarifies the relationship between claim elements also may help to avoid unreasonable or unintended constructions of terms during prosecution. Dependent claims also should be used to help set inner boundaries on the scope given to terms in independent claims. ■

## BANNER & WITCOFF JOINS 2017 LAWYERS HAVE HEART 5K RUN & FUN WALK IN WASHINGTON, D.C.

Banner & Witcoff participated in the Lawyers Have Heart 5K Run & Fun Walk in Washington, D.C. on June 10, 2017. The annual race brings together more than 250 organizations and 6,000 runners and walkers to support the American Heart Association and help advance its nonprofit mission of fighting heart disease and stroke.



Pictured, front row (left to right): Camille Sauer, Elyse Braner, Alisa Abbott, Eleanor Chang and Marcie Burkhart; Back row: Rachel Johns, Zach Stevenson, Rajit Kapur, Steve Chang, Thomas Vaseliou, Brad Edgington, Ben Koopferstock, Jeff Chang, Jason Wagner and Dale Faulls. Participants not pictured: Jennifer Brady, Jay Kim, Donna Koenig, Zach Leciejewski, Deirdre Morris, Teneasha Peirson, Kimberly Turner, Darrell Mottley and Chris McKee.