

Is Broadest Reasonable Interpretation of Claim Terms, as Applied in Inter Partes Review, Converging on Standard Applied in Litigation?



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This past summer, the **Supreme Court** settled the debate about the standard to be applied by the **Patent Trial and Appeal Board (PTAB)** in construing patent claims – finding its use of the **broadest reasonable interpretation (BRI)**, the approach used by the US patent office for the past century, was proper.¹ Its decision left in place what academics and practitioners alike had bemoaned to be an unjustified distinction in the standards used by the PTAB in assessing the validity of claims compared to those used by the courts.² This may, however, become a distinction without a difference.

The rules for determining the BRI are seemingly self-evident. The patent office instructs its patent examiners to give pending claims “their broadest reasonable interpretation consistent with the specification.” MPEP §2111. It emphasizes that this does not mean the broadest “possible” interpretation. Rather, the meaning of a claim term must be “consistent with the ordinary and customary meaning of the term [and] the use of the claim term in the specification and drawings.” *Id.* Limitations on

the plain meaning of a claim term can be made, but only if the patentee expressly provides for them.

It is generally assumed that the BRI is at least as broad, and possibly broader, than the interpretation that a court might make. This result is commonly justified as helping ensure that claims are properly allowed in view of the prior art, and as fair to the patentee because the rules allow the patentee to amend its claims. But a court, like an examiner, is required to interpret the claims in view of the specification. When is the BRI of a claim term going to be broader than the interpretation a court would reach?

The case of *PPC Broadband, Inc. v. Corning Optical Communications RF, LLC*, 815 F.3d 734 (Fed. Cir. 2016) provides one such example. In this case, the PTAB construed the “continuity member” in a coaxial cable connector to require contact that establishes an electrical connection, but it did not require that the contact be continuous in time. The Federal Circuit determined that the claim as “correctly” construed would require continuity in time, but also found that the BRI was plausible because the referenced continuity could be in space rather than in time, and it therefore upheld the PTAB’s construction and decision. Thus, the court’s claim interpretation was narrower than the BRI because the court considered the strength of the support for the different interpretations rather than their mere plausibility.

Another way that a court’s construction might be narrower than the BRI is by limitation of the claim’s meaning in view of the prosecution history. Traditionally, the BRI has not required consideration of statements made during prosecution.³ And while the PTAB has considered the possibility of narrowing its interpretation of claim terms in view of potential prosecution history disclaimers, I have been unable to find a case where it has done so. Indeed, the Federal Circuit held in *Tempo Lighting, Inc. v. Tivoli, LLC*, 742 F.3d 973, 978 (2014), that “the PTO is under no obligation to accept a claim construction proffered as a prosecution history disclaimer, which generally only binds the patent owner.”

However, in that same case, the Federal Circuit noted that “the prosecution history, while not literally within the patent document, serves as intrinsic evidence for purposes of claim construction [and] [t]his remains true in construing patent claims before the PTO.” *Id.* at 977. In June of 2015, in the case of *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015), citing *Tempo Lighting*, the Federal Circuit may have changed course – stating explicitly that the PTO “should also consult the patent’s prosecution history in proceedings in which the patent has been brought back to the agency for a second review” (emphasis added).

The Federal Circuit has now reiterated the importance of the prosecution history for assessing BRI. In the case of *John D’Agostino v. Mastercard International Inc.*, 2016 U.S. App. LEXIS 23025 (Fed. Cir., December 22, 2016), the court considered the meaning of “single-merchant” in a claim directed to a method for performing secure credit card purchases. The specification described several embodiments, but the court cited *Microsoft Corp. v. Proxyconn, Inc.* and relied upon statements made by the patentee during prosecution and reexamination. In so doing, it limited the BRI of the term to a single identified merchant, rather than, for example, a chain of stores – with the result that the claim was no longer invalidated by the cited prior art.

While there may still be room for a difference of opinion between the PTAB and a court, these cases suggest that the BRI standard may be converging on the approach used by the courts. At the very least, the PTAB should now be more inclined to consider statements made during prosecution in determining the BRI.

Footnotes:

¹ *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2142 (2016).

² The courts use the approach set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005).

³ *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983) (“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, *In re Prater*, 56 C.C.P.A. 1381, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969), 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. *In re Johnson*, 558 F.2d 1008, 1016, 194 USPQ 187, 194 (CCPA 1977).”).

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