

Electronic *and* Software Patents

Law *and* Practice

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Chapter 8: Claim Interpretation for Patent Drafters

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§8.02 Basic Rules Governing Claim Interpretation by the Courts

D. Sources of Interpretation

1. Intrinsic Evidence: Claims, Specification, and Prosecution History

b. Specification

[On page 8-11, insert the following at the end of the subsection.]

Conversely, the recent case *GNPE Corp. v. Apple Inc.*¹ underscores the importance of carefully drafting the specification to avoid blanket statements about “the invention,” which can serve to narrow the scope of seemingly broad claims. In *GNPE Corp.*, the court held that the district court did not err in its construction of a claim reciting a paging system that “operates independently of a telephone network” because the interpretation was reasonable in light of a single summation sentence from the specification, which read: “Thus, the

¹830 F.3d 1365, 119 USPQ2d 1646 (Fed. Cir. 2016).

invention provides a two-way paging system which operates independently from a telephone system for wireless data communication between users.”²

While the court agreed with GNPE that the phrase “operates independently from [the] telephone system” appears in only this one sentence of the Detailed Description section of the specification, it disagreed that it was improper for the district court to limit the claims in this way. In support of its decision, the court quoted *Verizon Services Corp. v. Vonage Holdings Corp.*,³ which stated that “When a patent . . . describes the features of the ‘present invention’ as a whole, this description limits the scope of the invention.”⁴ The court found that the summation sentence in the present case likewise described “the invention” as a whole.⁵ The court further noted that the characterization of the invention in that sentence was bolstered by the prosecution history, as the inventor’s Rule 131 declaration stated several times that the invention operates independently of a telephone network.⁶ Accordingly, the court held that it was proper for the district court to conclude that a “pager” or “node” should have the capability to “operate[] independently from a telephone network.”⁷

c. *Prosecution History*

[On page 8-13, insert the following before the last paragraph of the subsection.]

The scope of potentially relevant prosecution history extends beyond the file history of the particular nonprovisional application from which the patent issued. The meaning of claim terms in one patent can be informed by statements made during prosecution of other patents in the same family. Past and future prosecution of related patents may be relevant to the construction of a given claim term. In *Mastermine Software, Inc. v. Microsoft Corp.*,⁸ the court found that the district court properly construed the term “pivot table” to mean “an interactive set of data displayed in rows and columns that can be rotated and filtered to summarize or view the data in different ways.”⁹ During prosecution of a related parent patent, the applicant, in an attempt to overcome prior art rejections, distinguished a prior art reference by emphasizing that a pivot table is created when filled with data. The court agreed with the district court in finding that the statements made, while not amounting to a disclaimer, were relevant to claim construction, “for the role of claim construction is to ‘capture the scope of the actual invention’ that is disclosed, described, and patented.”¹⁰

²830 F.3d at 1371, 119 USPQ2d at 1651.

³503 F.3d 1295, 1308 (Fed. Cir. 2007).

⁴830 F.3d 1371, 119 USPQ2d at 1651.

⁵*Id.*

⁶*Id.*

⁷*Id.*

⁸874 F.3d 1307, 124 USPQ2d 1618 (Fed. Cir. 2017).

⁹874 F.3d at 1312.

¹⁰*Id.* at 1311–12 (quoting *Fenner Invs., Ltd. v. Cellico P’ship*, 778 F.3d 1320, 1323 (Fed. Cir. 2015) (internal citations and quotations omitted)).

A provisional patent application is also potentially relevant prosecution history for interpreting claims issuing from a later corresponding nonprovisional application. However, inconsistencies between the two are likely to be resolved based on the nonprovisional application. The Federal Circuit recently declined to use statements from a provisional application to support a narrower claim interpretation when those statements were not included in the corresponding nonprovisional application. In fact, the court viewed the relative change between the provisional and nonprovisional regarding the statements in question as reinforcing a broader interpretation. In *MPHJ Technology Investments LLC v. Ricoh America*,¹¹ the court upheld the Patent Trial and Appeal Board's (PTAB's) determination on inter partes review (IPR) that a deletion from the provisional application relative to the final patent signaled that the inventor intended for a "one-step" operation, a process that involved paper being scanned from a device at one location and copied to a device at another location, to be optional, not obligatory. Appellant-patent owner MPHJ argued that two statements in the provisional application expressly limited the scope of the invention to a one-step copying and sending process; however, these statements were not recited in the issued nonprovisional patent.

Judge Newman, speaking for the court, agreed "that a provisional application can contribute to understanding the claims," but found that, "[i]n this case, it is the deletion from the ... [p]rovisional application that contributes understanding of the intended scope of the final application."¹² Further, the court noted that the final patent contained no statement or suggestion of an intent to limit the claims to the one-step operation that distinguished it from the prior art.¹³ In addition, statements in the abstract section of the final patent were in accord with the change from the provisional application to the final patent, as the abstract expressly described the single-step operation as "optional."¹⁴ Therefore, the court held that a person skilled in the field would reasonably conclude that the claims were not so limited.

§8.03 Claim Language Issues

A. Functional Versus Structural Language

1. Avoiding Unintentional Application of 35 U.S.C. §112(f)

[On page 8-25, insert the following before the last paragraph on the page.]

In *Zeroclick, LLC v. Apple Inc.*,¹⁵ the court vacated the district court's determination that claims in the patents at issue recited means-plus-function terms for which the specifications did not disclose sufficient structure. Neither

¹¹847 F.3d 1363, 121 USPQ2d 1625 (Fed. Cir. 2017).

¹²*Id.* at 1369, 121 USPQ2d at 1629.

¹³*Id.*

¹⁴*Id.*

¹⁵891 F.3d 1003 (Fed. Cir. 2018).

of the limitations at issue—“program” and “user interface code”—used the word “means.” Presumptively, therefore, Section 112, Paragraph 6 did not apply to the limitations, and the court held that the presumption against the application of Section 112, Paragraph 6 to the disputed limitations remained un rebutted.¹⁶

Moreover, the court stated that by taking its approach, the district court effectively treated “program” and “user interface code” as nonce words, which can operate as substitutes for “means” and presumptively bring the disputed claims limitations within the ambit of Section 112, Paragraph 6. The court found that reasoning to be erroneous for three related reasons. First, the court found that the mere fact that the disputed limitations incorporate functional language does not automatically convert the words into means for performing such functions.¹⁷ Second, the court found that the district court’s analysis removed the terms from their context, which otherwise strongly suggested the plain and ordinary meaning of the terms.¹⁸ Third, and relatedly, the court found that the district court made no pertinent finding that compelled the conclusion that a conventional graphical user interface program or code is used in common parlance as substitute for “means.”¹⁹

E. The Preamble

[On page 8-44, insert the following before the last paragraph on the page.]

In a similarly decided case, *Georgetown Rail Equipment Co. v. Holland L.P.*,²⁰ the court held that the term “mounted on a vehicle for movement along the railroad track” was meant to describe the principal intended use of the invention but not to import a structural limitation or to exclude from the reach of the claims an assembly that does not include a vehicle mount.²¹ Particularly, the court found that nothing in the specification or prosecution history stated, or even suggested, an intent to exclude the use of technology that was structurally identical to its claimed product but that was installed and performed analysis on a nonvehicle mount. The court noted that a preamble may be limiting if “it recites essential structure or steps”; claims “depend[] on a particular disputed preamble phrase for antecedent basis”; the preamble “is essential to understand limitations or terms in the claim body”; the preamble “recit[es] additional structure or steps underscored as important by the specification”; or there was “clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art.”²² However, the court confirmed that the reverse is also true. A preamble is not a claim limitation if the claim body “defines a structurally

¹⁶*Id.* at 1007–08.

¹⁷*Id.* at 1008 (internal citations and quotations omitted).

¹⁸*Id.*

¹⁹*Id.* at 1009 (internal citations and quotations omitted).

²⁰867 F.3d 1229, 123 USPQ2d 1766 (Fed. Cir. 2017).

²¹*Id.* at 1236–37, 123 USPQ2d at 1770.

²²*Id.* at 1236, 123 USPQ2d at 1770 (quoting *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (additional citations omitted)).

complete invention . . . and uses the preamble only to state a purpose or intended use for the invention.”²³ Further, “preamble language merely extolling benefits or features of the claimed invention does not limit the claim scope without clear reliance on those benefits or features as patentably significant.”²⁴

§8.04 Specification Issues

A. Patentee as “Lexicographer”

1. Definition by Implication

[On page 8-52, insert the following at the end of the subsection.]

However, *Wasica Finance GmbH v. Continental Automotive Systems, LLC*,²⁵ illustrates an instance in which the patentee failed in an attempt to define claim terms by implication because the ordinary meaning or an alternative lexicography of the disputed claim terms was not clearly disavowed.

In *Wasica*, the court held that the PTAB, in related IPR proceedings, did not err by finding that claims included in a patent that described systems for monitoring tire pressure in a vehicle were unpatentable based upon prior art that disclosed a pressure sensor that detected the air pressure in a tire. While appellant *Wasica* argued that the terms “electrical pressure signal” and “pressure transmitting signal” must contain numerical values of pressure, the court found that the disjunctive “or,” as in “numbers or symbols” in the claim language, designated numbers and symbols as distinct alternatives to one another.²⁶ Further, the claims required the electrical pressure signal to be only “representative of air pressure.” However, citing the ordinary meaning dictionary definition of “representative”—i.e., “serving to . . . symbolize” or “standing for”—the court refused to construe “signals representative of” various items as being confined to numerical values.²⁷

2. Definition by Varied Usage

[On page 8-54, insert the following at the end of the subsection.]

*Wasica Finance GmbH v. Continental Automotive Systems, LLC*²⁸ illustrates an instance in which the patentee’s use of terms interchangeably in the specification broadened the scope of the claims, rendering them unpatentable.

²³*Id.* (quoting *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997)).

²⁴*Id.* (quoting *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002) (additional citations omitted)).

²⁵853 F.3d 1272, 122 USPQ2d 1267 (Fed. Cir. 2017).

²⁶853 F.3d at 1280, 122 USPQ2d at 1273.

²⁷*Id.*

²⁸853 F.3d 1272, 122 USPQ2d 1267 (Fed. Cir. 2017).

The Federal Circuit held that there was no error in the Board’s conclusion that “emittance” in claim 17 included both wired and wireless transmissions. While appellant Wasica argued that the Board erred by construing “emittance” to include wired transmissions, the court noted that the plain and ordinary meaning of “emit” is simply “to send out.”²⁹ The court noted that because the specification used the words “emit” and “transmit” interchangeably, this drafting choice equated the two terms for claim construction purposes.³⁰

§8.05 Prosecution History

A. Prosecution Disclaimer

[On page 8-83, insert the following before the last paragraph of the subsection.]

In *Aylus Networks, Inc. v. Apple Inc.*,³¹ the Federal Circuit held that the doctrine of prosecution disclaimer, which originally arose in the context of pre-issuance prosecution, also applies in post-issuance IPR proceedings before the PTO. The court likened IPR statements made during proceedings to statements made during other post-issuance proceedings where the doctrine was applied in the past, such as, for example, reissue proceedings.³² In its reasoning, the court found that extending the prosecution disclaimer doctrine to IPR proceedings will ensure that claims are not argued one way in order to maintain their patentability and in a different way against accused infringers. Further, the court noted that, in keeping with the purposes of the doctrine, the extension will promote the public notice function of the intrinsic evidence and protect the public’s reliance on definitive statements made during IPR proceedings.³³

B. Importance of Carefully Limited Statements Distinguishing Prior Art

[On page 8-85, insert the following at the end of the subsection.]

*Technology Properties Ltd. v. Huawei Technologies Co.*³⁴ illustrates why patentees should be careful not to disclaim more than is necessary to overcome cited art during prosecution, lest additional limitations be read into the claims. In *Technology Properties*, the court held that the district court’s claim construction properly included the patentee’s clear disclaimers that an “entire oscillator,”

²⁹853 F.3d at 1282, 122 USPQ2d at 1275.

³⁰*Id.*

³¹856 F.3d 1353, 122 USPQ2d 1672 (Fed Cir. 2017).

³²*Id.* at 1360, 122 USPQ2d at 1676–77.

³³*Id.*, 122 USPQ2d at 1677 (internal quotations omitted).

³⁴849 F.3d 1349, 121 USPQ2d 1916 (Fed. Cir. 2017).

as used in the claims, was an oscillator (1) “whose frequency is not fixed by any external crystal,” and (2) that cannot require an external crystal or frequency generator. In its analysis of the distinctions made by the patentee in response to a first office action rejection, the court noted that the patentee’s disclaimer “may not have been necessary, but its statements made to overcome [the cited reference] were clear and unmistakable.”³⁵

However, in considering another claim interpretation question, *Technology Properties* illustrated the traditional limits on the application of prosecution disclaimers. The Federal Circuit found that the district court erred by holding that the patentee disclaimed any use of a command signal by the entire oscillator based on other prosecution history distinctions made by the patentee regarding a second reference. Particularly, the court noted that “[e]very time the patentee mentioned a ‘control signal’ or ‘command input,’ it did so only in the context of using a command input to modify the frequency of the CPU clock.”³⁶ As such, the patentee disclaimed only a particular use of a command signal—using a command signal to change the clock frequency. However, none of the patentee’s statements clearly and unmistakably disclaimed an entire oscillator receiving a command input for any purpose.³⁷

F. Examiner Statements in the Reasons of Allowance

[On page 8-89, insert the following at the end of the subsection.]

In *Arendi S.A.R.L. v. Google LLC*,³⁸ the Federal Circuit found that an examiner’s Reasons for Allowance that makes clear that the examiner and the applicant understood what the applicant had changed in an amendment can be viewed as a prosecution history disclaimer. The court held that the PTAB erred regarding “prosecution disclaimer” in an IPR decision relating to a computerized method for identifying and substituting information in an electronic document. In the PTAB proceeding, Arendi argued that an amendment was a “prosecution disclaimer” that distinguished a reference at issue that requires that a user select the information to be searched. The PTAB presented alternative rulings. In its primary ruling, the PTAB held that no prosecution disclaimer had occurred, and construed the “single entry” limitation of the claims to include text selection by a user. On this reasoning, the PTAB held that the claims were not limited by the prosecution record.

Citing *Sorensen v. International Trade Commission*,³⁹ the Federal Circuit acknowledged that in order to disavow claim scope, a patent applicant must clearly and unambiguously express surrender of subject matter during prosecution. Specifically, the court cited *Sorensen’s* reference to *Innova/Pure Water*⁴⁰

³⁵*Id.* at 1358, 121 USPQ2d at 1922.

³⁶*Id.* at 1360, 121 USPQ2d at 1922.

³⁷*Id.*

³⁸882 F.3d 1132, 125 USPQ2d 1828 (Fed. Cir. 2018).

³⁹427 F.3d 1375 (Fed. Cir. 2005).

⁴⁰*Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111 (Fed. Cir. 2004).

for the ruling that it is the applicant, not the examiner, who must give up or disclaim subject matter that would otherwise fall within the scope of the claims. However, the court held that the PTAB misapplied *Sorensen*. In the present case, the applicant amended the claims and explained what was changed and why, and the examiner confirmed the reasons why the amended claims were deemed allowable in the Reasons for Allowance.⁴¹ Thus, the examiner's Reasons for Allowance made clear that the examiner and the applicant understood what the applicant had changed and what the claim amendment required.⁴² Therefore, the claims should have been construed based on acceptance of the asserted prosecution disclaimer.

§8.06 Claim Interpretation in Inter Partes Review and Other Post-Grant Proceedings

[On page 8-89, replace the second paragraph of the section with the following.]

However, the USPTO is now using its rulemaking authority to do away with the broadest reasonable interpretation standard in IPR, post-grant review, and covered business method proceedings. On May 9, 2018, the *Federal Register* published the USPTO's new proposed rules for claim interpretation in these proceedings.⁴³ Assuming the proposed rule changes are implemented, the relevant sections of Title 37 of the Code of Federal Regulations, Part 42, would be amended to provide that a patent claim in such proceedings

shall be construed using the same claim construction standard that would be used to construe such claim in a civil action to invalidate a patent under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.⁴⁴

The proposed rule change, if implemented, will establish much-needed consistency between the new adversarial proceedings implemented by the America Invents Act (AIA) and the district court proceeding to which the new USPTO proceedings were intended to provide an alternative. Using the prosecution-based broadest reasonable interpretation standard for the new AIA proceedings had created the strange result that two parties could fight a dispute over the same claim language, but that claim language would be interpreted differently depending on whether the parties' arguments regarding the claim were being considered by the Patent Trial and Appeal Board or by a district court. Moreover, because IPR before the Board has, as a practical matter, almost completely replaced district court as a forum for litigating patent validity, claims

⁴¹882 F.3d at 1136, 125 USPQ2d at 1830 (internal citations and quotations omitted).

⁴²*Id.*

⁴³83 Fed. Reg. 21,221 (May 9, 2018).

⁴⁴*Id.* at 21,224.

have been effectively interpreted differently for validity purposes than for infringement purposes.

The rule change will remove this painful inconsistency. However, perhaps the only benefit to the half-dozen years of using the broadest reasonable interpretation standard in IPRs and other AIA-established proceedings is that it forced the Federal Circuit to pay increased attention to how broadest reasonable interpretation should be applied by the USPTO. Although this will no longer be relevant for the AIA-established proceedings, the resulting case law regarding broadest reasonable interpretation provides potentially useful guidance for patent applicants during patent prosecution and during *ex parte* reexamination.

[On page 8-91, insert the following before the last paragraph of the section.]

In *D’Agostino v. Mastercard International*,⁴⁵ the court vacated the PTAB’s determination that claims in the patents at issue were unpatentable for anticipation and obviousness because the PTAB misinterpreted the “single-merchant” claim limitation in both patents and that error affected its decision.

D’Agostino involved method claims of two patents that disclosed processes for generating limited-use transaction codes to be given to a merchant by a customer for the purchase of goods and services. The purpose was to enhance security for the customer by withholding the customer’s credit card number from the merchant and using the transaction code to complete the transaction instead. In two IPR proceedings, the PTAB decided that the disputed claims were unpatentable for anticipation and obviousness. However, the court found that the Board’s decisions rested on an *unreasonable* claim interpretation.

The court ruled that the PTAB departed from or misapplied the clear meaning of claims in both patents when—whether as a matter of claim construction or as a matter of applying prior art—it concluded that the “single merchant” claim limitation in the patents at issue required a separation in time between the communication of one piece of information and the communication of another—i.e., a situation in which a customer first sought a transaction code for an identified “chain of stores” and later picked a specific store within that chain.⁴⁶ Notably, the evident meaning of the “single merchant” claim limitation was determined from the specification and reinforced by the prosecution history.⁴⁷ Thus, it can be argued that the court’s analysis appears to bring the Board’s broadest reasonable interpretation standard closer to the *Phillips* claim interpretation standard. However, while the ultimate inquiry under *Phillips* is to determine the particular meaning of the claims from the viewpoint of one of ordinary skill in light of the specification and the prosecution history, the court here appears to first determine the viewpoint of one of ordinary skill in light of the specification and the prosecution history in order to limit the breadth of the broadest reasonable claim interpretation.

⁴⁵844 F.3d 945, 121 USPQ2d 1134 (Fed. Cir. 2016).

⁴⁶844 F.3d at 949, 121 USPQ2d at 1136.

⁴⁷*Id.*

*Nestlé USA Inc. v. Steuben Foods Inc. LLC*⁴⁸ is another recent IPR case that seems to rein in claim interpretations under the PTAB's broadest reasonable interpretation standard. In *Nestlé*, the court overturned the PTAB's IPR ruling on the scope of the claim term "aseptic" because consistent definitions in the specification were held to be dispositive of an intent to limit the claims. Specifically, the court held that the PTAB erred by construing "aseptic" as incorporating "any applicable United States FDA standard" rather than only FDA regulations governing "aseptic packaging." The court's reasoning was supported by the specification, which twice defined "aseptic" as the United States "FDA level of aseptic."⁴⁹ Moreover, the court noted that while the FDA does not define the term "aseptic" outright, at the time of the application, it defined "aseptic processing and packaging" as "the filling of a commercially sterilized cooled product into presterilized containers, followed by aseptic hermetical sealing, with a presterilized closure, in an atmosphere free of microorganisms."⁵⁰ Thus, the broadest reasonable interpretation scope of "aseptic" could not include regulations that applied to foods that were not aseptically packaged.

[On page 8-91, insert the following after the last paragraph on the page.]

Most recently, the court further refined the broadest reasonable interpretation standard. In *In re Power Integrations, Inc.*,⁵¹ the court reversed the PTAB's determination that claims in the patents at issue were unpatentable for anticipation because the PTAB erred when it found that it did not have to consider the manner in which other courts had interpreted the term "coupled." In particular, the court found that the PTAB's definition was overly expansive, rendered claim language that was used in the claims meaningless, and was unsupported by the specification.

The court held that "[w]hile the broadest reasonable interpretation standard is broad, it does not give the [b]oard an unfettered license to interpret the words in a claim without regard for the full claim language and the written description."⁵² In the present case, the court found that the board's claim construction was unreasonably broad and improperly omitted any consideration of the disclosure in the specification.⁵³ Specifically, the court found that under the board's overly expansive view of the term "coupled," every element anywhere in the same circuit is potentially "coupled" to every other element in that circuit, no matter how far apart they are, how many intervening components are between them, or whether they are connected in series or in parallel.⁵⁴ Thus, the construction rendered the claim language meaningless. Further, the board's reading of the language was found to be unsupported by the specification. The

⁴⁸2017 U.S. App. LEXIS 8421 (Fed. Cir. 2017).

⁴⁹*Id.* at *3–4.

⁵⁰*Id.* at *4–5 (internal citations omitted).

⁵¹884 F.3d 1370, 126 USPQ2d 1001 (Fed. Cir. 2018).

⁵²*Id.* at 1375, 126 USPQ2d at 1006 (quoting *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1062 (Fed. Cir. 2016)).

⁵³884 F.3d at 1375.

⁵⁴*Id.* (internal citations and quotations omitted).

court noted that “[t]he correct inquiry in giving a claim term its broadest reasonable interpretation in light of the specification is not whether the specification proscribes or precludes some broad reading of the claim term adopted by the examiner.”⁵⁵ Instead, a proper claim construction analysis endeavors to assign a meaning to a disputed claim term “that corresponds with . . . how the inventor describes his invention in the specification.”⁵⁶

In another case involving the broadest reasonable interpretation standard, *In re Smith International, Inc.*,⁵⁷ the court reversed the PTAB’s determination that claims in the patent at issue which described an expandable tool used for drilling oil and gas wells were unpatentable for obviousness because the PTAB erred when it interpreted the word “body” to include other components of the tool, such as the mandrel and cam sleeve. Although the patent did not define the term “body,” the court found that the patent holder’s construction of the term as the “outer housing” of the tool was reasonable in light of how that term was used, and when the term was properly limited to that interpretation, the claims in question were not obvious over a combination of prior art references.

In its analysis, the court noted that the correct inquiry in giving a claim term its broadest reasonable interpretation in light of the specification is not whether the specification proscribes or precludes some broad reading of the claim term adopted by the examiner. And it is not simply an interpretation that is not inconsistent with the specification. Rather, it is an interpretation that corresponds with what and how the inventor describes his invention in the specification, i.e., an interpretation that is “consistent with the specification.”⁵⁸

In its IPR ruling, the PTAB emphasized that the patentee did not act as a lexicographer, and that the specification neither defines nor precludes the examiner’s reading of the term “body.” Accordingly, they found that nothing in the specification would disallow the examiner’s interpretation, rendering it “reasonable.” However, the court noted that following such logic, any description short of an express definition or disclaimer in the specification would result in adoption of a broadest *possible* interpretation of a claim term, regardless of repeated and consistent descriptions in the specification that indicate otherwise. That is not properly giving the claim term its broadest *reasonable* interpretation in light of the specification.⁵⁹

As such, the court found that the description did not support a “strained” construction of the term “body,” that would correspond to the “body,” “mandrel,” and “cam sleeve” of cited art. Therefore, the court concluded that the “body” in the claims at issue is a component distinct from other separately identified components in the specification, such as the mandrel, and cannot be understood to include the “cam sleeve” in the cited art.⁶⁰ Because the Board’s findings were

⁵⁵*Id.* at 1377, 126 USPQ2d at 1007 (quoting *In re Smith Int’l, Inc.*, 871 F.3d 1375, 1382–83 (Fed. Cir. 2017)).

⁵⁶*Id.*

⁵⁷871 F.3d 1375, 124 USPQ2d 1210 (Fed. Cir. 2017).

⁵⁸*Id.* at 1382–83, 124 USPQ2d at 1215 (citing *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (citation and internal quotation marks omitted)); *see also In re Suitco Surface, Inc.*, 603 F.3d 1255, 1259–60 (Fed. Cir. 2010).

⁵⁹*Id.* at 1383, 124 USPQ2d at 1215.

⁶⁰*Id.* at 1383, 124 USPQ2d at 1216.

dependent on its broad construction of the term “body,” the court held that the Board’s findings of anticipation were not supported by substantial evidence.⁶¹

[On page 8-92, insert the following at the end of the section.]

The Federal Circuit recently held that statements made by a patent owner during an IPR proceeding, whether before or after an institution decision, can be relied upon to support a finding of prosecution disclaimer during claim construction.

In *Aylus Networks, Inc. v. Apple Inc.*,⁶² Aylus appealed the district court’s grant of summary judgment finding that Apple’s AirPlay feature did not infringe the asserted claims of the patent at issue. In construing the claim limitation at issue, the district court relied on statements made by Aylus in its preliminary responses to Apple’s petitions for IPR of the patent at issue, finding the statements “akin to prosecution disclaimer.”⁶³ On appeal, Aylus argued that statements made during an IPR cannot be relied upon to support a finding of prosecution disclaimer. Alternatively, Aylus argued that its statements did not constitute a clear and unmistakable disclaimer of claim scope.

The court held that the doctrine of prosecution disclaimer applies in post-issuance IPR proceedings just as in other post-issuance proceedings, such as reexaminations.⁶⁴ In its reasoning, the court cited *Cuozzo* for the recognition that an IPR proceeding involves the reexamination of a patent.⁶⁵ Further, while an IPR proceeding is a two-step process—the Director’s decision whether to institute a proceeding, followed (if the proceeding is instituted) by the Board’s conduct of the proceeding and decision with respect to patentability—for the purposes of prosecution disclaimer, the court found the differences between the two phases of an IPR to be “a distinction without a difference.” Therefore, statements made by a patent owner during an IPR proceeding, whether before or after an institution decision, can be considered for claim construction and relied upon to support a finding of prosecution disclaimer.⁶⁶ In this case, the court found that the appellant patentee’s statements during an IPR proceeding were a clear and unmistakable disavowal of claim scope. While the court noted that when a prosecution argument is subject to more than one reasonable interpretation it cannot rise to the level of a clear and unmistakable disclaimer, Aylus’s interpretation of its disavowing statements was found to be unreasonable.⁶⁷

Practitioners should also keep in mind that previous judicial interpretations of a disputed claim term also may be relevant to the PTAB’s later construction of that same disputed term. In *Knowles Electronics LLC v. Cirrus Logic, Inc.*,⁶⁸

⁶¹*Id.* at 1384, 124 USPQ2d at 1216.

⁶²856 F.3d 1353, 122 USPQ2d 1672 (Fed Cir. 2017).

⁶³*Id.* at 1358, 122 USPQ2d at 1675 (quoting summary judgment order, 2016 U.S. Dist. LEXIS 7299, at *5).

⁶⁴*Id.* at 1360, 122 USPQ2d at 1677.

⁶⁵*Id.* (citing *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2143–44 (2016)).

⁶⁶*Id.* at 1361, 122 USPQ2d at 1677.

⁶⁷*Id.* at 1363, 122 USPQ2d at 1679 (internal citations and quotations omitted).

⁶⁸883 F.3d 1358, 126 USPQ2d 1137 (Fed. Cir. 2018).

the court found that the PTAB properly considered a previous Federal Circuit interpretation of a term. Citing *Power Integrations, Inc. v. Lee*,⁶⁹ the court found that the PTAB did not err in its claim construction. Rather, the court held that, although the PTAB is not generally bound by a previous judicial interpretation of a disputed claim term, this does not mean that it has no obligation to acknowledge that interpretation or to assess whether it was consistent with the broadest reasonable interpretation of the term.⁷⁰

⁶⁹797 F.3d 1318, 1327 (Fed. Cir. 2015).

⁷⁰*Knowles Electronics*, 883 F.3d at 1376, 126 USPQ2d at 1141.