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PATENTS

The author suggests that the Patent and Trademark Office's use of the broadest reasonable interpretation in assessing the definiteness of patent claims has resulted in ambiguous patents.

Fulfilling the Public Notice Function of Patent Claims by 'Annealing' Claims with Boundaries That Everyone Can Recognize



BY DANIEL GOLUB

“The developed and improved condition of the patent law, and of the principles which govern the exclusive rights conferred by it, leave no excuse for ambiguous language or vague descriptions.”

Merrill v. Yeomans, 94 U.S. 568, 573 (1877).

“Simply put then, an applicant and an examiner are annealing the claims during prosecution much like an ironworker anneals steel before use. The applicant and examiner, like the ironworker, aim to strengthen the claims so that they will operate as intended—to unam-

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biguously define the property boundary around an invention.”

J. Gongola, U.S. Patent and Trademark Office, “*Annealing Steel: The USPTO's Application of the Broadest Reasonable Interpretation Standard for Claim Derivation*” (2010).

The definiteness requirement set forth in 35 U.S.C. § 112, para. 2, serves a notice function by requiring that the patent provides clear notice of the scope of the patentee's right to exclude. When the boundaries of a patent are not clearly recognizable by everyone, resulting uncertainties can harm both the patent owner and the general public. If the scope of a patent is not clear, an individual inventor may not be able to secure investment capital to pursue his invention. Competition may also be harmed if a competitor cannot discern the boundaries of a patent.

During examination of a patent application by the Patent and Trademark Office, the office strives to satisfy the notice function of claim language by deriving its “broadest reasonable interpretation.” Using the broad-

est reasonable interpretation as the measure, the office seeks to “anneal” precise claim language through an iterative process of rejection, argument, and amendment, until the broadest reasonable interpretation of the language is clear and unambiguous.

Unfortunately, after the patent issues, neither the patent owner nor the public can rely on this broadest reasonable construction to measure whether the patent claims will be found infringed in court. This is because, in subsequent infringement litigation, the broadest reasonable interpretation does not apply. Rather, in such cases, courts construe claims using a different claim construction standard, articulated by the U.S. Court of Appeals for the Federal Circuit in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (70 PTCJ 309, 7/15/05).

Virtually every patent infringement case has multiple claim construction disputes, often involving constructions where reasonable persons applying *Phillips* differ as to the correct outcome. The high reversal rate for claim construction issues at the Federal Circuit is not based on a general failure by the district courts to properly apply *Phillips*, but rather on the fact that, at present, issued patent claims are often ambiguous under *Phillips*, i.e., there are often multiple reasonable constructions of a claim under *Phillips*, and the district courts and the Federal Circuit often differ on which reasonable construction is best. Indeed, there are often cases where three judges on the Federal Circuit cannot agree on the most apt construction under *Phillips*.

With the office working as hard as it is to anneal unambiguous patent claims, why are there so many *Markman* disputes in court about the scope of the claims? The answer is plain. Many *Markman* disputes are grounded in the fact that, during prosecution, the office makes no attempt to anneal claim language that will be unambiguous under the claim construction standard to be applied in subsequent infringement litigation, i.e., *Phillips* and its progeny. Not surprisingly, when a patent ends up in litigation, its claim language—while clear under the broadest reasonable interpretation standard—is often susceptible to multiple reasonable interpretations under *Phillips*.

The fact that the office uses a different claim construction standard in assessing definiteness than the courts will use to construe the patent, has undermined the public notice function of 35 U.S.C. § 112, para. 2. What is needed is for the office to assess the definiteness of claim language during prosecution under *Phillips*, and reject as indefinite claim language that is susceptible to multiple reasonable interpretations under *Phillips*. Such an approach will provide applicants an opportunity to “anneal” the scope of their claims under *Phillips* during prosecution, and provide patent owners, the public, and the courts with a clearer definition of the scope of issued patent claims.

A. Different Standards for Construction Apply During Prosecution and Infringement Litigation

While “issued patents are interpreted in light of the specification, prosecution history, prior art, and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow.” Manual of Patent Examining Procedure § 2111.01. The PTO characterizes the broadest reasonable interpretation as a “totally different stan-

dard” from that used by the courts to construe claims in infringement litigation.¹

The difference between the claim construction standard applied by the PTO during prosecution and that applied by the courts in infringement litigation was exemplified by the Federal Circuit’s decision in *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827 (Fed. Cir. 2004) (68 PTCJ 63, 5/21/04). In that case, the PTO rejected the patent during reexamination by interpreting the limitation “user computer” more broadly than the district court had during infringement litigation. In affirming the rejection of the claims by the PTO, the Federal Circuit stated:

Finally, American Academy points to an inconsistency between the Board’s construction of the term “user computer” and that of the district court in American Academy’s litigation against Novell. In the district court litigation, the court construed “user computer” to refer to a computer that serves one user at a time. However, the Board is required to use a different standard for construing claims than that used by district courts. We have held that it is error for the Board to “appl[y] the mode of claim interpretation that is used by courts in litigation, when interpreting the claims of issued patents in connection with determinations of infringement and validity.” *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320 (Fed. Cir. 1989); accord *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023 (Fed. Cir. 1997) (“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.”). Instead, as we explained above, the PTO is obligated to give claims their broadest reasonable interpretation during examination. Under that standard, it was proper for the Board to construe “user computer” to encompass the mainframes and minicomputers of the cited prior art.

American Academy, 367 F.3d at 1369. ² *cf. In re Morris*, 127 F.3d at 1054-55.

Given that different claim construction standards apply during prosecution and infringement litigation, the question remains—how do the two claim construction standards differ? The standards differ significantly

¹ J. Gongola, U.S. Patent and Trademark Office, “*Annealing Steel: The USPTO’s Application of the Broadest Reasonable Interpretation Standard for Claim Derivation*” (2010).

² The district courts routinely hold that they are required to construe claims in infringement suits using a standard that is different from the broadest reasonable construction that the office applies. See, e.g., *St. Clair Intellectual Property Consultants Inc. v. Matsushita Electronic Industries Co.*, 691 F. Supp.2d 538, 550 (D. Del. 2010) (“There are important differences, however, between the legal standard applicable to claim construction before the PTO and claim construction before an Article III Court. A PTO Examiner construing claims is required to apply the broadest reasonable construction consistent with the specification. . . . Courts do not apply this “broadest reasonable construction” rule.”); *Power Integrations Inc. v. Fairchild Semiconductor International Inc.*, 2009 WL 4928029 (D. Del. 2009); *Highway Equipment Co. v. FECO Ltd.*, 2005 WL 1843469 (N.D. Iowa 2005); *Rambus Inc. v. Infineon Technologies AG*, 2001 WL 34138091 (E.D. Va. 2001).

in practice because, in many cases, examiners pay little attention to the specification in construing claims during prosecution, while courts give more scrutiny to the specification in construing claims during infringement litigation.

Examiners typically focus on the “four corners” of the claim itself in assessing claim scope, and are therefore unlikely to read a limitation from the specification into the claims in applying the broadest reasonable construction standard during prosecution. For example, in a situation where the summary equates a particular feature with “the Invention” but such feature is not recited in the language of the independent claims, an examiner is unlikely to read the feature from the summary into the independent claims when applying the broadest reasonable construction standard.

By contrast, in infringement litigation, a court applying *Phillips* will look beyond the “four corners” of such a claim and consider whether the feature described in the summary should be “read into” the claim during the claim construction process. In a case where the court decides that the feature from the summary should be read into the claim, the broadest reasonable construction that the PTO reached during prosecution, and the construction by the court of the same claim under *Phillips*, will be markedly different.³

B. Definiteness Is Evaluated During Prosecution Using the Broadest Reasonable Construction

During prosecution, the PTO determines whether the broadest reasonable construction of the claim is definite, i.e., whether, under the broadest reasonable construction, the claim language is sufficiently clear and unambiguous to particularly point and distinctly claim the applicant’s invention for purposes of 35 U.S.C. § 112, second paragraph.

As explained by the PTO,

When the Agency interprets the claims in an application under the broadest reasonable interpretation standard, it does so with a view toward the indefiniteness provision of 35 U.S.C. § 112, second paragraph. As noted earlier, that statutory provision requires an applicant to “particularly point out and distinctly claim the subject matter which the applicant regards as his invention.” Hence, as part of the claim derivation process, the Agency considers whether the claims are too indefinite for

³ The wording used by the office to describe the application of the broadest reasonable construction standard bears much similarity to the principles for claim construction articulated in *Phillips*, because both the MPEP and *Phillips* speak of construing claims in light of the specification. See, e.g., MPEP 2111 (“During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification.”). Indeed, if one were to focus primarily on the wording used to describe the broadest reasonable construction standard and the claim construction standard articulated in *Phillips*, an argument could be made that the standards are quite similar. However, despite the similarity in the way the standards are worded, they are applied in practice quite differently because, in practice, courts pay substantially more attention to the specification in construing claims during infringement litigation than the office does in examining applications.

derivation, and if so, issues a rejection under 35 U.S.C. § 112, second paragraph.⁴

In its Examination Guidelines, the PTO has also explained how claims should be reviewed for definiteness during prosecution:

During examination, after applying the broadest reasonable interpretation to the claim, if the metes and bounds of the claimed invention are not clear, the claim is indefinite and should be rejected. For example, if the language of a claim, given its broadest reasonable interpretation, is such that a person of ordinary skill in the relevant art would read it with more than one reasonable interpretation, then a rejection under § 112, ¶ 2 is appropriate.⁵

Significantly, the PTO’s definiteness examination is limited to whether the broadest reasonable construction of a claim is susceptible to multiple reasonable interpretations. During examination, the office does not examine whether a claim is susceptible to multiple reasonable interpretations under the claim construction standard that will apply in subsequent infringement litigation, i.e., *Phillips*.

Since the PTO does not act as a gatekeeper by rejecting claims that are susceptible to multiple reasonable interpretations under *Phillips*, it should come as no surprise that, when patents end up in infringement litigation, they may be susceptible to multiple reasonable interpretations under *Phillips*.

C. Indefinite Patents Harm Everyone, Including the Patent Owner

Much of the discussion about the harm of indefinite patents has focused on the distortion to competition that happens when a patent owner’s competitor is unable to discern the boundaries of the patent. A topic that has received far less attention is the harm that the patent owner may suffer as a result of an indefinite patent.

From the patent holder’s point of view, uncertainty as to the scope of a patent may make it more difficult to attract investment capital. For example, if the scope of a patent (as construed under *Phillips*) has two reasonable interpretations—a narrow interpretation that that would permit inexpensive design-arounds, and a broad interpretation that would block such “design-arounds” from the market—it may be difficult to attract investment capital based on the patent, as an investor might not want to take the risk of the patent being construed

⁴ J. Gongola, U.S. Patent and Trademark Office, “*Annealing Steel: The USPTO’s Application of the Broadest Reasonable Interpretation Standard for Claim Derivation*” (2010).

⁵ “Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications” (2011) (emphasis added). 76 Fed. Reg. 7,162, 7,164 (Feb. 9, 2011) (emphasis added). See also, *Ex Parte Miyazaki*, 89 USPQ 1207 (B.P.A.I. 2008) (“if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite. . . . [W]e adopt this lower threshold standard of ambiguity for indefiniteness for claims during prosecution in keeping with the USPTO’s broadest reasonable interpretation standard for claim construction.”)

narrowly (under *Phillips*) in subsequent infringement litigation.

Even if the investor were willing to take some risk as to the future interpretation of the scope of the patent, the investor might not be able to quantify the risk with sufficient confidence to support an investment. In addition, if the patent owner was a small research organization that depended on patent licensing for revenue, the ability to negotiate a license may be stymied if the scope of the patent is unclear.

The PTO has a longstanding policy of ensuring that small companies and individual inventors have access to the patent system. The reduced fees that the PTO charges small entities, and the assistance that examiners provide to pro se inventors, are two examples of this policy in action.

There is no doubt that the PTO, through its policies, has done a tremendous service to small companies and individual investors with these efforts. However, the goals of the PTO's efforts to help small entities will not be reached if the indefiniteness issues that plague issued patents are not corrected.

The full measure of the innovation that the PTO is striving to encourage through its efforts to help small entities will not be attained if these entities cannot attract capital or license their technology because the scope of their patents is indefinite.

Of course, for businesses that seek to market products potentially covered by someone else's patent, uncertainty as to the scope of the patent is also harmful. As explained by the Federal Trade Commission:

The ability to identify and assess the scope of relevant patents at an early stage can be critical for firms considering making investments in developing and commercializing an innovative product. They may unnecessarily elect not to pursue a R&D effort when the scope of coverage is unclear if they fear that another firm has blocking patents. Such decisions deter and lessen innovation and competition among technologies that might otherwise have been created. Poor patent notice also hinders competition by forcing firms to design products with incomplete knowledge of the cost and availability of different technologies. Technologies compete to be incorporated into products. But that competition is distorted if designers cannot discern in advance which technologies carry the cost of patent royalties and negotiate those royalties before they incur sunk costs based on the patented technology.⁶

While the benefits of having patents with clear boundaries are undeniable, we are far away from a patent system that attains such a result. Rather, our patent litigation system is clogged with a huge number of cases, many of which cannot be resolved by the par-

⁶ Federal Trade Commission, "The Evolving IP Marketplace, Aligning Patent Notice and Remedies with Competition," (2011), at 3. See also, M. Risch, "The Failure of Public Notice in Patent Prosecution," 21 Harv. J.L. & Tech. 179, 188 (2007) ("A patent system without certainty in claim scope encourages gaming, increases uncertainty, retards free competition, fails to encourage invention properly, and discourages the use of unprotected ideas.")

ties because it is not clear how the claim should be construed under *Phillips*.⁷

As discussed below, many of these claim construction disputes involve the situation where there are *multiple* reasonable constructions of the claim under *Phillips* a result which is difficult to reconcile with the notice policy embodied in 35 U.S.C. § 112, par. 2.

D. Claim Construction Disputes Abound Under *Phillips*

Even after the *Phillips* decision—which sought to clarify the rules for construing patent claims—claim construction disputes exist in virtually every patent infringement case:

Despite repeated efforts to set out the rules for construing patent claims, culminating in the Federal Circuit's en banc *Phillips* decision in 2005, parties and courts seem unable to agree on what particular patent claims mean. Patent law has provided none of the certainty associated with the definition of boundaries in real property law. Literally every case involves a fight over the meaning of multiple terms.⁸

Making matters worse, such claim construction disputes are often not resolved by the district courts. In an empirical study, Judge Kimberly A. Moore found that, in 37.5 percent of cases, the Federal Circuit disagreed with the claim construction made by the district court.⁹

Commentators have explored various possible causes for this high reversal rate. For example, one commentator has questioned whether the high reversal rate is due to district judges being "incapable of or not interested in learning how to perform claim construction."¹⁰

Other commentators have postulated that "claim construction may be inherently indeterminate."¹¹ These explanations miss the mark.

The high reversal rate is not due to an inability of district judges to do their job, or to claims being "inherently indeterminate." Rather, it is due to the PTO's failure to reject claims that are susceptible to multiple reasonable interpretations under *Phillips*, and the confusion that results in subsequent infringement litigation from an issued patent that is susceptible to multiple reasonable interpretations under *Phillips*.

Retractable Technologies Inc. v. Becton, Dickinson & Co., 635 F.3d 1296, 1000 USPQ2d 1714 (Fed. Cir. 2011) (82 PTCJ 326, 7/15/11), provides a recent example where the patent was susceptible to multiple reasonable interpretations under *Phillips*. That case involved whether the "body" of a retractable syringe was limited

⁷ See D. Burk and M. Lemley, "Fence Posts or Sign Posts? Rethinking Patent Claim Construction," 157 U.Pa.L.Rev. 1743, 1745 (2009) ("Claim construction is sufficiently uncertain that parties don't settle a case until after the court has construed the claims, because there is no baseline for agreement on what the patent might possibly cover.")

⁸ *Id.* at 1744.

⁹ Kimberly A. Moore, Markman *Eight Years Later: Is Claim Construction More Predictable?*, 9 Lewis & Clark L. Rev. 231, 238 (2005).

¹⁰ D. Schwartz, *Practice Makes Perfect? An Empirical Study Of Claim Construction Reversal Rates in Patent Cases*, 107 Michigan Law Rev. 223 (2008).

¹¹ See Burk, *supra*, note 8, at 1745.

to a “one-piece structure.” The following conflicting factors were at issue:

- The plain wording of the claim did *not* limit the body to a one-piece structure.
- The Summary of the Invention stated that “[t]he invention is a retractable tamperproof syringe,” and that this syringe “features a one piece hollow body.”
- The specification stated that the prior art failed to recognize a retractable syringe that “can be molded as one piece outer body.”
- The disclosed embodiments were all one-piece bodies.

Like many claim construction disputes, the question turned on whether it was appropriate, in light of certain statements in the specification, to read the “one-piece structure” limitation into the claim.

In the case below, Judge David J. Folsom ruled that the claim was not limited to a one-piece structure. The Federal Circuit reversed in a 2-1 decision.

Judge Randall R. Rader (dissenting) agreed with Folsom. Judges Alan D. Lourie and S. Jay Plager disagreed with Judges Rader and Folsom, finding that the claim was limited to a one-piece structure.

The reasoning behind these conflicting conclusions is set forth below:

“In this case, while the claims leave open the possibility that the recited “body” may encompass a syringe body composed of more than one piece, *the specifications tell us otherwise*. They expressly recite that “the invention” has a body constructed as a single structure, expressly distinguish the invention from the prior art based on this feature, and only disclose embodiments that are expressly limited to having a body that is a single piece. Thus, a construction of “body” that limits the term to a one-piece body is required to tether the claims to what the specifications indicate the inventor actually invented. Accordingly, the district court erred when it construed “body” as encompassing bodies composed of multiple pieces. (Lourie, J.) (writing for the court) (emphasis added).

* * *

The ordinary and customary meaning of “body” does not inherently contain a one-piece structural limitation. . . . *Nothing in the specifications, however, rebuts the strong presumption created by the claim language that “body” does not contain a one-piece structural limitation*. . . . [T]he fact that a one-piece body would achieve one of the objectives of the patented invention does not mean that such a limitation should be read into every claim. . . . The fact that the embodiments described in the specifications have one-piece bodies is also an insufficient basis for construing “body” to have a one-piece structural limitation. (Rader, J.) (dissenting) (emphasis added).

No one would argue that Lourie, Plager, Rader, and Folsom are unskilled at claim construction under *Phillips*, and none of their conclusions were unreasonable. On the contrary, *both* the majority and the dissent arrived at *reasonable* constructions of “body” under

Phillips. They just disagreed as to which of these reasonable constructions was best.¹²

The problem with the patent in *Retractable Technologies* was that it was susceptible to *multiple* reasonable constructions of “body” under *Phillips*. Unfortunately, the situation in *Retractable Technologies* is not an isolated case.¹³ Too many of the claim construction disagreements between district courts and the Federal Circuit, or within the Federal Circuit itself, are the result of an issued patent that is susceptible to multiple reasonable constructions under *Phillips*.¹⁴

E. Proposed Solution: Examine Claims for Definiteness Under *Phillips*

If we turn back in time to the prosecution of the patent in *Retractable Technologies*, and the application of the broadest reasonable construction standard during the process, it is clear why there was no rejection of “body” for indefiniteness during prosecution—namely, because the broadest reasonable interpretation of “body” is clear (and not limited to a one-piece struc-

¹² See *Enzo Biochem Inc. v. Applera Corp.*, 605 F.3d 1347, 1348, 94 USPQ2d 1894 (Fed. Cir. 2010) (80 PTCJ 150, 6/4/10) (Plager, J. dissenting) (“[I]f several persons of ordinary skill come up with competing but plausible interpretations of a disputed term . . . the problem is not one of an inherently ambiguous and potentially indefinite claim term, but rather the problem becomes simply one of picking the “right” interpretation for that term. . . . [I]t is not until three court of appeals judges randomly selected for that purpose pick the “right” interpretation that the public, not to mention the patentee and its competitors, know what the patent actually claims.”)

¹³ See, e.g., *Ormco Corp. v. Align Technology Inc.*, 498 F.3d 1307, 84 USPQ2d 1146 (Fed. Cir. 2007) (74 PTCJ 564, 9/14/07), (majority and dissent disagree over whether specification requires claims to be limited to “automatic control of the finish tooth positioning” when none of the claims in suit expressly recite the limitation); *Markem-Imaje Corp. v. Zipher Ltd.*, 657 F.3d 1293, 100 USPQ2d 1068 (Fed. Cir. 2011) (82 PTCJ 647, 9/16/11), (majority and dissent disagree over whether specification requires claims to be construed to include terms for measuring tension when the claim does not expressly recite such terms); *Arlington Industries Inc. v. Bridgeport Fittings Inc.*, 632 F.3d 1246, 97 USPQ2d 1811 (Fed. Cir. 2011) (81 PTCJ 427, 2/4/11) (majority and dissent disagree as whether a “split limitation” from the specification should be read into the claims); *St. Clair Intellectual Property Consultants Inc. v. Canon Inc.*, 412 Fed. Appx. 270 (Fed. Cir. 2011), (majority and dissent disagree over when specification limits “plurality of data formats” to “still” pictures).

¹⁴ Part of the reason why there are multiple reasonable constructions under *Phillips* stems from the fact that the judges on the Federal Circuit do not agree on the meaning of *Phillips*, especially where the question involves whether to read a limitation from the specification into the claims. See R. Polk Wagner & L. Petherbridge, “Did *Phillips* Change Anything? Empirical Analysis of the Federal Circuit’s Claim Construction Jurisprudence,” Cambridge University Press (S. Balganes, ed. 2012) (discussing the failure of *Phillips* to resolve a longstanding split in claim construction jurisprudence). Despite the lack of complete clarity in *Phillips*, the scope of patent claims can still be made clear during prosecution so long as limitations from the specification that have the potential to be read into the claims under a restrictive reading of *Phillips* are identified and addressed (through amendment and/or argument) during prosecution. See Section E, *infra*. Addressing such issues during prosecution will minimize the negative impact on patent holders and the public caused by disagreements among the members of the Federal Circuit on claim construction jurisprudence.

ture). Imagine how the result would have been different if the examiner had applied *Phillips* in performing the definiteness analysis and rejected the claim for indefiniteness during prosecution.

For example, the examiner could have maintained that the claim was ambiguous under *Phillips* because the specification could be read to indicate that a “one-piece structure” was essential to the invention, but no “one-piece structure” limitation was recited in the independent claim.

The basis for such an indefiniteness rejection is already suggested by several provisions in the Manual of Patent Examining Procedure. For example, MPEP § 608.01(d) provides that the Summary of the Invention should be “commensurate with the invention as claimed and any object recited should be that of the invention as claimed.” In addition, MPEP § 2172 permits rejection of a claim under 35 U.S.C. § 112 if the claim “omits matter disclosed to be essential to the invention as described in the specification.”

Both of these MPEP sections could have been used to raise an indefiniteness rejection in the *Retractable Technologies* patent, because the summary in that case mentioned the “one-piece” feature and all of the disclosed embodiments included the feature (suggesting the possibility that the feature was essential), but the feature was not recited in the claims. Had such a rejection been made, the applicant would have had the ability (through amendment and/or argument) to clarify whether the one-piece limitation was part of the claimed invention or not, and through that process the office could have “annealed” claims that were far less ambiguous under *Phillips*.

Below is a preliminary list of straightforward questions that examiners could analyze during prosecution to assess whether a claim is ambiguous under *Phillips*¹⁵ and, if so, whether an indefiniteness rejection should be made:

- Does the summary or title recite limitations that are not recited in the independent claims?
- Does the background distinguish prior art based on a feature not recited in the independent claims?
- Does the specification equate a feature with the “invention” while not reciting the feature in the independent claims?
- Is there a feature that is not recited in the independent claims that is required to accomplish one or more stated objects of the invention?
- Are there limitations expressed only in dependent claims that are arguably essential to the Invention?

The Patent Office is already overburdened. Increasing what examiners are currently required to do—by re-

¹⁵ This article should not be read as advocating that the office abandon the broadest reasonable construction standard entirely. For example, given the presumption of validity afforded to issued patents, strong arguments can be made that the broadest reasonable interpretation should be used in assessing whether claims are patentable over the prior art, and in assessing enablement. The suggestions advocated in this article are limited to the application by the office of the *Phillips* standard in assessing definiteness, for the purposes of providing clearer notice of the scope of the patent and avoiding many of the claim construction disputes that currently burden the courts.

quiring that they assess definiteness under *Phillips*—has the potential to make a bad situation even worse.

One approach for addressing this burden involves relaxation of the policy against piecemeal prosecution—having the examiner confirm that claims are definite based on a careful review of the specification under *Phillips* (or issue a rejection based on indefiniteness) *before* the claims are examined for novelty and non-obviousness.

The office’s policy against piecemeal prosecution is captured in 37 CFR 1.104(b) (“[t]he examiner’s action will be complete as to all matters”) and MPEP 7.07(g) (“[p]iecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available.”) Where an examiner finds that the claims are indefinite, the policy against piecemeal litigation often requires an examiner to reject the claims for both indefiniteness and over prior art in the *same* office action. MPEP 2173.06 (this “approach is recommended from an examination standpoint because it avoids piecemeal examination . . .”)

But how can an examiner frame a prior art rejection when the claim at issue is indefinite? In such circumstances, MPEP 2173.06 provides that:

. . . where the claim is subject to more than one interpretation and at least one interpretation would render the claim unpatentable over the prior art, an appropriate course of action would be for the examiner to enter two rejections: (A) a rejection based on indefiniteness under 35 U.S.C. 112, second paragraph; and (B) a rejection over the prior art based on the interpretation of the claims which renders the prior art applicable. When making a rejection over prior art in these circumstances, it is important for the examiner to point out how the claim is being interpreted. . . .

In some situations, the framework set forth in MPEP 2173.06 requires the examiner to waste time and effort performing a prior art analysis that serves no useful purpose. Consider the situation where the examiner rejects a claim based on indefiniteness and prior art, with the prior art rejection being based on one interpretation of the indefinite claim.

Assume that, in response, the applicant overcomes the indefiniteness rejection by amending the claim to mean something different from the interpretation used previously in rejecting the claims over the prior art. In this situation, some or all of the work that the examiner performed in rejecting the claim over the prior art was wasted.

An alternative approach would eliminate such waste by requiring that an applicant’s claims be definite *before* the examiner begins comparing the claims to the prior art. Under this approach, if the examiner found that the claims were indefinite under *Phillips*, the examiner would issue a first office action (and receive a count) on that basis alone, without analyzing prior art.

If, in response, the applicant amended the claims to clarify the indefiniteness, the examiner would then do a prior art search and, if the search results yielded invalidating prior art, issue a second (final) office action on the basis of such prior art. By crediting examiners with a count for a first office action that rejects a claim as indefinite under *Phillips*, this approach would provide ex-

aminers with more time to examine the specification in assessing each claim for definiteness under *Phillips*.

While this approach would result in an increase in the number of requests for continued examination, it would also incentivize applicants to work harder in the first instance to ensure that claims are definite under *Phillips*, so that the cost and delay associated with a request for continued examination could be avoided.

Conclusion

The office's use of the broadest reasonable interpretation in assessing definiteness has resulted in patents

that are ambiguous under *Phillips*, resulting in countless numbers of claim construction disputes in infringement litigation, and undermining the notice function of patents. The office should begin assessing the definiteness of claim language during prosecution under *Phillips*, and reject as indefinite claim language that is susceptible to multiple reasonable interpretations under *Phillips*.

Such an approach will provide everyone with a clearer definition of the scope of issued patent claims, and remove harmful uncertainty from the patent system.