



UNITED STATES PATENT AND TRADEMARK OFFICE

***Claim Interpretation:
Broadest Reasonable Interpretation
(BRI) and the Plain Meaning of Claim
Terms***

A full transcript of this presentation can be found under the “Notes” Tab.

Goals

- Ensure that issued claims have clear boundaries
 - Provides public notice of the scope of protection
 - Reduces risk of infringement and encourages innovation
- Ensure claim scope is properly established during prosecution by construing the claim under the broadest reasonable interpretation (BRI) using the plain meaning of terms, when appropriate
 - Using the BRI reduces the possibility that issued claims will be interpreted more broadly than justified
- Make the record clear during prosecution by explaining the claim interpretation, as necessary

Informative Claim Interpretation

- Clarity of claim terms in granted patents is improved when the interpretation of claim terms is explained in Office actions
 - Early explanation of the examiner's interpretation will allow the applicant to clarify the meaning of a term, amend the claim, and/or provide a more effective response to any rejections, thus leading to more efficient prosecution
 - The prosecution record will provide a map for the public to understand the boundaries of the patent protection
 - The PTAB and courts will be informed as to what the examiner and the applicant understood the claims to mean

Broadest Reasonable Interpretation

- Broadest Reasonable Interpretation (BRI) is always used to interpret claims under examination
- 112(f) places a limit on how broadly a 112(f) claim limitation may be interpreted
- The corresponding structure/materials/acts disclosed in the specification must be considered in determining the BRI of a 112(f) claim limitation

Broadest Reasonable Interpretation

- For a claim limitation that does not invoke 112(f)
 - The claim terms are given the broadest interpretation that is consistent with their **plain meaning** in light of the specification as understood by one of ordinary skill in the art
 - The plain meaning is the ordinary and customary meaning to those skilled in the art

See MPEP § 2111.

Broadest Reasonable Interpretation

Comparison of non-112(f) and 112(f) claim limitations

§112(f) Not Invoked: Plain Meaning

The claim terms are given the broadest interpretation that is consistent with their **plain meaning** in light of the specification as understood by one of ordinary skill in the art

See MPEP 2111 & 2181

§112(f) Invoked: Means- plus-function

The corresponding structure, material or acts disclosed in the specification, and their equivalents, that perform the claimed function are considered part of the claim limitation

Plain Meaning

- A claim term is interpreted in view of—
 - the other words of the claims, the specification and drawings, and
 - the prior art (prior art patent and published applications, trade publications, and dictionaries)

Plain Meaning

- The specification (including claims) and drawings are the best source for determining the meaning of a claim term
- The prior art may also be used to determine the meaning of a claim term,
 - Any meaning from the prior art must be consistent with the use of the claim term in the specification and drawings

Plain Meaning

- Interpreting claim terms in light of the other words of the claim, and the specification and drawings
- The specification is used to *interpret* the meaning of the terms that appear in the claims
- It is not appropriate to incorporate limitations from the specification which are not recited in the claim itself

Exceptions to Plain Meaning

- The specification must be consulted to ascertain whether there is a special definition for a claim term
- The terms in a claim limitation are not given their plain meaning when the specification provides a special definition for the term (applicant acting as lexicographer or disavowal)

Presumption of Plain Meaning

- There is a presumption that terms in a claim are given their plain meaning
- A claim term having a special definition (acting as lexicographer or disavowal) is an exception to this presumption that must be--
 - Clear and intentional
 - Presented in the specification as filed

Broadest Reasonable Interpretation

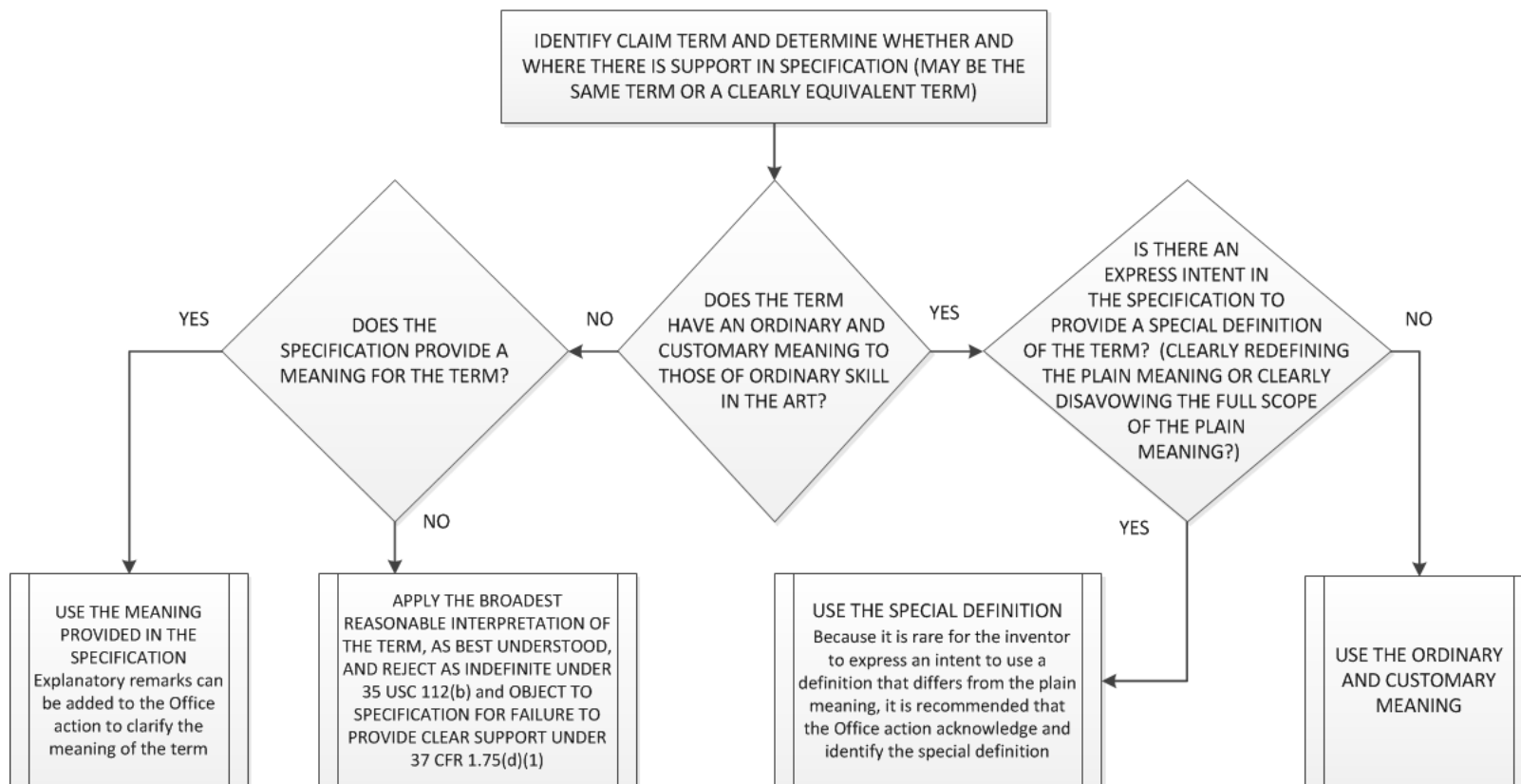
- BRI does not mean broadest *possible* interpretation
- The interpretation of a term must be consistent with the specification and how the term is commonly used in the art.

Broadest Reasonable Interpretation

- The meaning or scope of claim terms should be clarified if necessary with explanatory remarks in the Office action
 - This will provide a clear record of what the examiner understands the claim terms to mean
- If the meaning or scope of claim terms is not clear, then a rejection as to clarity/indefiniteness under § 112(b) should be considered.
- See MPEP § 2173 concerning rejections under § 112(b) when a claim does not particularly point out and distinctly claim the invention

Meaning of Claim Term Flow Chart

HOW TO DETERMINE THE MEANING OF A CLAIM TERM THAT DOES NOT INVOLVE 35 USC 112(f)



Example 1 (In re Morris)

- In re Morris, 127 F.3d 1048 (Fed. Cir. 1997)
- The claim was directed to an acoustic isolator for a disc drive, having “at least one acoustic compliance area integrally formed as a portion of a selected area of the support member.”
- The reference had an elastomeric pad formed of foam rubber fixed to the support.
- The appellant argued that the acoustic compliance area must be a one-piece or unitary part of the support member or housing.

Example 1 (In re Morris) (continued)

- In re Morris, 127 F.3d 1048 (Fed. Cir. 1997)
- The Federal Circuit noted that the specification did not use the phrase integrally formed and thus—
 - The specification provides no special definition for this term, and
 - The term “integrally formed” takes its ordinary meaning
- The term integral does not require one-piece or unitary construction (per numerous prior CCPA decisions).
- Also, an object may be a “portion” of a structure and still be removable from that structure.

Example 2 (In re Bigio)

- In re Bigio, 381 F.3d 1320 (Fed. Cir. 2004)
- The claim was directed to a “hair brush.”
- The references were toothbrushes, which together meet all of the limitations of the claims.
- The appellant argued that the phrase “hair brush” is limited to brushes that may be used for human hair on the scalp.

Example 2 (In re Bigio) (continued)

- In re Bigio, 381 F.3d 1320 (Fed. Cir. 2004)
- The Federal Circuit held that the phrase “hair brush” is not limited to scalp hair, but may also include other facial hair.
- The Federal Circuit stated that the USPTO should not limit broad terms in a claim based upon passages from the specification absent an express disclaimer of the broader definition of the term.

Example 3 (In re Skvorecz)

- In re Skvorecz, 580 F.3d 1262 (Fed. Cir. 2009)
- The claim was directed to chafing tray, having a wire chafing stand with “at least two wire legs,” including “a plurality of offsets located either in said upright sections of said wire legs or in said first rim for laterally displacing each wire leg”
- The reference had two wire legs with one wire leg including a pair of offsets.
 - The Board stated that the term “comprising” allowed for the second wire leg not having an offset.

Example 3 (In re Skvorecz) (continued)

- In re Skvorecz, 580 F.3d 1262 (Fed. Cir. 2009)
- The appellant argued that the phrase “said wire legs” (plural) and “each wire leg” required that each wire leg have an offset.
- The Federal Circuit stated that the USPTO may not disregard the requirement that each wire leg of the reference have an offset to anticipate the claim.

How Proper Claim Interpretation leads to Clarity

- A detailed and informative claim interpretation that is clearly set forth in the record will benefit the applicant and the public by:
 - reducing guesswork in responding to the Office action;
 - clearly setting forth the protection afforded the applicant;
 - providing a clear file history that would prevent or reduce unnecessary litigation, interferences, reissues, *ex parte* reexaminations, *inter partes* reviews, *supplemental examinations*, and *post-grant proceedings*; and
 - providing public notice as to how the claim was interpreted during examination.

Summary

- Claim interpretation requires utilizing BRI
 - BRI in context of plain meaning means limitations from specification not imported into claim
 - Claim terms are given their plain meaning, the ordinary and customary usage of the term by those of ordinary skill in the art, unless there is a special definition (lexicography or disavowal)
- Informative claim interpretation increases the clarity of the Office Action and benefits the Applicant, Public and the Examiner