



Memorandum

Date: June 25, 2003

To: Technology Center Directors
Patent Examining Corps

From: *Stephen G. Kunin*
Stephen G. Kunin
Deputy Commissioner for Patent Examination Policy

Subject: Claim interpretation and procedures to handle applicant's reply arguing that a term in the claim is limited to the special definition provided in the written description

This memorandum sets forth guidance for claim interpretation and the procedures to handle an applicant's reply arguing that a term in the claim is limited to the special definition provided in the written description.

Claim Interpretation:

As noted in MPEP § 2111, during patent examination, claims are given their broadest reasonable interpretation consistent with the specification. It is proper to use the specification to interpret what the applicant meant by a word or phrase recited in the claim. However, it is **not** proper to read limitations appearing in the specification into the claim when these limitations are not recited in the claim. See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); *Intervet America Inc. v. Kee-Vet Lab. Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989).

Words of the claim are generally given their ordinary and customary meaning, unless it appears from the written description that they were used differently by the applicant. Where an applicant chooses to be his or her own lexicographer and defines terms with special meanings, he or she must set out the special definition explicitly and with "reasonable clarity, deliberateness, and precision" in the disclosure to give one of ordinary skill in the art notice of the change. See *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001), and MPEP § 2111.01. Pursuant to 35 U.S.C. § 112, 2nd paragraph, "[i]t is applicant's burden to precisely define the invention, and not the [examiner's]." *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997). Therefore, it would **not** be proper for the examiner to give words of the claim special meaning when no such special meaning has been defined by the applicant in the written description. Furthermore, it would **not** be proper for the examiner to allow a claim and issue the application with an examiner's statement of reasons for

allowance setting forth the special definition given to the words of the claim when no such special definition has been defined by the applicant in the written description.

Procedures to handle applicant's reply arguing that a term in the claim is limited to the special definition provided in the written description:

If during examination of an application, the examiner has given a term in the claim its plain meaning as interpreted by one of ordinary skill in the art and applied prior art accordingly, and in applicant's reply pursuant to 37 CFR § 1.111, applicant argues that the term in the claim is limited to the special definition set forth in the written description (by referring specifically to the page and line/paragraph number of the specification), the examiner must review the written description to determine whether applicant's argument has support in the written description. It is **not** appropriate to merely accept applicant's argument without reviewing the written description to determine whether applicant's argument has support. If applicant's argument is persuasive, that is, the written description explicitly and clearly set forth a special definition for the term in the claim, the examiner should reconsider the rejection in view of applicant's reply. If the previous rejection is withdrawn, the examiner must provide in the next Office communication the reasons why the previous rejection is withdrawn by referring specifically to the page(s) and line(s) of applicant's remarks that form the basis for withdrawing the rejection. See MPEP § 707.07(f).

If upon review of the written description, the examiner determines that **no** special definition is set forth by the applicant and an amendment to include such a special definition in the claims and/or the written description would constitute new matter pursuant to 35 U.S.C. § 132(a), the examiner should maintain the previous rejection and provide an explanation to the applicant in the next Office communication. It would **not** be proper for the examiner to allow a claim and issue the application with an examiner's statement of reasons for allowance setting forth the special definition given to the words of the claim when no such special definition has been defined by the applicant in the written description. Note that where the definition set forth in the written description is merely exemplary (where applicant used the phrase "for example"), the examiner should not consider this as a special definition and an explanation should be provided in the next Office communication as to the reasons why applicant's argument is not persuasive.

If upon review of the written description, the examiner determines that applicant's argument is supported by the written description and the claims would be allowable over the prior art but the special definition for the term in the claim as noted in applicant's arguments is not explicitly or clearly stated in the written description, and an amendment to the written description to explicitly and clearly include such a special definition would **not** constitute new matter, the examiner should contact the applicant and request approval for an examiner's amendment. It would be appropriate in such a case to include an examiner's statement of reasons for allowance to ensure that the record is clear as to the reasons why the claims are allowable over the prior art of record. See MPEP § 1302.14. One of the reasons for requiring an amendment to the written description to explicitly set forth the special definition is so that when the patent issues, notice would be provided to the public as to the scope of the patentee's rights without the public having to check the prosecution history for the information.