

# **Claim Interpretation: Part 1 of 2 (In the Examination Process)**

Patent Training Academy  
Entry Level

*Approved by OPLA 2/2018*

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Objectives

You will become more familiar with the following:

- Claim Interpretation
- Broadest Reasonable Interpretation
- The effect of Preamble on claim scope
- Functional Language
- Intended Use

# Claim Interpretation

## No Claim Limitation May Be Ignored

- Every word in a claim **must** be considered
  - No limitation, functional or otherwise, can be ignored
  - All limitations must be addressed

*See MPEP 2143.03*

# Claim Interpretation (From Examiner's Point of View)

Examiner benefits from detailed and correct claim analysis in a first Office action:

- Less rework necessary in future Office actions
- Second, subsequent Office actions more likely to be a Final Office action or an Allowance

# Claim Interpretation (From Applicant's Point of View)

Applicant benefits from detailed and correct claim analysis in an Office action:

- Reduces guesswork in responding to the Office action
- Clearly sets forth the protection afforded the Applicant
- Provides a clear file history to prevent or reduce unnecessary litigation, interferences, reissues, *ex parte* reexaminations, *inter partes* reviews, supplemental examinations, and post-grant reviews

# **Broadest Reasonable Interpretation**

Claims must be given their broadest reasonable interpretation (BRI) consistent with the supporting description (specification)

*See MPEP 2111*

# Broadest Reasonable Interpretation (*cont.*)

Broadest reasonable interpretation leads to consideration of the following:

- Plain meaning of claim terms
- Explicit definitions, if any, in the specification
- Functional language
  - Intended use statements
  - Wherein/whereby clauses
  - Capability

# Broadest Reasonable Interpretation – Why?

- Broadest reasonable interpretation by the Examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified
- Applicant has the opportunity to amend the claims during prosecution
- The USPTO's interpretation of claims in applications differs from how a court interprets claims in an infringement case of an issued patent

*See MPEP §2111*



# Knowledge Check A

Every word in a claim must be considered; however, functional limitations may be ignored.

- True
- False

## Knowledge Check A: Answer

The answer is **FALSE**. Every word in a claim must be considered. No limitation, functional or otherwise, can be ignored. All limitations should be addressed whether or not they are given patentable weight.

*See MPEP 2143.03*

# **Claim Interpretation Preamble**

Effect of the Preamble on Claim Scope

*MPEP 2111.02*

# Claim Structure Review

- A claim can be broken into parts, much like diagramming a sentence
- The beginning or introductory phrase of the claim is the “preamble”
- The next part is a “transitional phrase”
  - “comprising,” “consisting of,” or “consisting essentially of”
- Finally, the remainder of the claim is referred to as the “body” of the claim

# Preamble

The preamble is an introductory phrase of a claim, which may:

- Summarize the invention
- Summarize the invention's relation to the prior art
- Summarize the invention's intended use or results
- Under certain circumstances constitute a limitation of the claimed device or process

# When Does the Preamble Limit Claim Scope?

- The determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case
- There is no litmus test defining when a preamble limits the scope of a claim
- Whether to treat a preamble as a claim limitation is determined on the facts of each case in light of the claim as a whole and the application specification's disclosure

*See MPEP 2111.02*

# When a Preamble Will Limit Claim Scope

- The general guideposts for when a preamble limits the claim include:
  - A preamble that is necessary to give “life, meaning and vitality” to the claim, i.e., words that add context for claim construction may limit the claim
  - A preamble that recites, and thereby limits, the structure of the claimed invention
  - A preamble that provides antecedent basis for a limitation in the body of the claim
  - A preamble recitation that is relied upon during prosecution to distinguish the claimed invention from the prior art
- Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation

*See MPEP 2111.02*

# When a Preamble *Will Not Likely* Limit a Claim

- When the body of the claim following the preamble is a self-contained description of the structure and does not depend on the preamble for completeness

*See MPEP 2111.02*

- When the preamble describes the purpose or intended use of an invention
  - Patentability of apparatus or composition claims depends on the claimed structure, not on the use or purpose of that structure

*See MPEP 2111.02*



# When a Preamble *Will Not Likely* Limit a Claim (*cont.*)

- When the preamble merely extols benefits or features of the claimed invention and there is no clear reliance on those benefits or features as patentably significant
  - For example, the preamble recites, “[a] head for a lacrosse stick which provides improved handling and playing characteristics”

*See MPEP 2111.02*

## Knowledge Check B

Which of the following indicate that the preamble will likely be a limitation of a claim? (*Select all that apply.*)

- A. The preamble language provides antecedent basis for terms in the body of the claim.
- B. The language in the body of the claim sets out the complete invention.
- C. The preamble recites only the intended use of the invention.
- D. The preamble is essential to understanding limitations or terms in the body portion of the claim.

## Knowledge Check B: Answer

The correct answers are **A and D**. The preamble will likely be a limitation of the claim if (A) it provides antecedent basis for terms in the body of the claim or (D) is essential to understanding limitations or terms in the body portion of the claim. The preamble will likely not be a limitation of the claim if (B) the language in the body of the claim sets out the complete invention and (C) the preamble recites only the intended use of the invention.

*See MPEP 2111.02*

# Functional Language

# Functional Language

- Every word in a claim must be considered in judging the patentability of that claim against the prior art

*See MPEP 2143.03*

- No claim limitation, ***functional or otherwise***, can be ignored

# What is a Functional Limitation?

- A functional limitation is an attempt to **define something by what it does**, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients)
- A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step

*See MPEP 2173.05(g)*

# Are Functional Limitations Per Se Improper?

- Functional language does not in and of itself render a claim improper
- There is nothing wrong with defining some part of an invention in functional terms
- Often functional language is used to tie claim elements together or to provide context

See MPEP 2173.05(g)

# Functional Language Handled Differently?

Is functional language handled differently than other types of claim language?

“A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used”

*See MPEP 2173.05(g)*



# Functional Language Under 35 USC 112(b)

As with any other claim limitation, functional language is acceptable so long as it sets definite boundaries on the patent protection sought

When functional language is recited in a claim without connection to any structure, material or acts, it raises concerns of whether the boundaries of the claim limitation can be understood and whether any limits are imposed by the language.

*See MPEP 2173.05(g)*

# Functional Language Under 35 USC 112(b) (*cont.*)

- Primary inquiry is whether the language leaves room for ambiguity or whether the boundaries are clear and precise
- Factors to consider:
  - 1) Is there a clear cut indication of the scope of subject matter covered by the claims?
  - 2) Does the claim language set forth well-defined boundaries of the invention?
  - 3) Would one of ordinary skill in the art know from the claim terms what structures or steps are encompassed by the claim?

*See MPEP 2173.05(g)*

## **Functional Language Under 35 USC 112(a)**

Use of functional language raises no issues under 35 USC 112(a) as long as the specification discloses sufficient information to put the public in possession of the claimed invention and to enable those skilled in the art to make and use the claimed invention.

*See MPEP 2173.05(g)*

# Consideration of Functional Language for Purposes of Applying Prior Art

While features of an apparatus may be described either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function

*See MPEP 2114*

# Consideration of Functional Language for Purposes of Applying Prior Art (cont.)

If the Examiner has a “reason to believe” that a functional limitation can be performed by the prior art structure, the Examiner should establish a prima facie case, shifting the burden to the Applicant to prove otherwise

See MPEP 2114

# Consideration of Functional Language for Purposes of Applying Prior Art (*cont.*)

- The strongest rejection to make is one in which the reference explicitly discloses all claimed features or limitations including those recited as functional language
- The Examiner should, therefore, search for all claimed features or limitations including functional language

# Consideration of Functional Language for Purposes of Applying Prior Art (*cont.*)

- However, if the prior art fails to explicitly disclose limitations recited as functional language, the Examiner should determine:
  - Whether the prior art discloses all claimed structural limitations
  - and
  - Whether the prior art structure is capable of performing the recited function

# Consideration of Functional Language for Purposes of Applying Prior Art (*cont.*)

When the prior art fails to disclose a functional limitation, the Examiner may be able to rely on the theory of inherency

- In relying upon the theory of inherency, the **Examiner** **must** provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily** flows from the teachings of the applied prior art

*See MPEP 2112(IV);*



# Functional Language: Apparatus Claims

When the prior art apparatus teaches all the **structural** limitations of an **apparatus claim**:

- A recitation of function **may not** distinguish over the prior art since an apparatus claim covers what a device **is**, not what it does
- A recitation directed to the manner in which a claimed apparatus is **intended to be used** does not differentiate the claimed apparatus from a prior art apparatus
- The **material or article worked upon** also does not limit an apparatus claim but is rather an intended use of the apparatus

*See MPEP 2114 and 2115*

# Functional Language: Method Claims

- The materials on which a claimed process is carried out must be considered in determining the patentability of a process
- All limitations in process or method claims must be considered when weighing the differences between the claimed invention and the prior art

See MPEP 2116.01

# Functional Language: Method Claims (cont.)

- Use of a novel, nonobvious product may render patentable an otherwise conventional process in a claim directed to a process of making or using the product
- Product limitations should be treated the same way in both process of making and process of using claims

See MPEP 2116.01

# Means or Step Plus Function Language

- Another type of functional limitation is a “means plus function” or “step plus function” limitation
- There is a separate presentation on this topic: 35 USC 112(f)

*See MPEP 2181*

## Knowledge Check C

The strongest rejection to make is one in which the reference explicitly discloses all claimed features or limitations to include functional limitations even though it may not specifically recite them with functional language.

- True
- False

## Knowledge Check C: Answer

The answer is **TRUE**. The strongest rejection to make is one in which the reference explicitly discloses all claimed features or limitations, including those recited as functional limitations. The Examiner should, therefore, search for all claimed features or limitations including functional language.

## Knowledge Check D

When the prior art fails to disclose a functional limitation, the Examiner may be able to rely on the theory of inherency.

- True
- False

## Knowledge Check D: Answer

The answer is **TRUE**. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *See MPEP 2112(IV)*



## Knowledge Check E

When examining functional limitations in a method claim, the materials on which a process is carried out are not accorded weight in determining the patentability of a process.

- True
- False

## Knowledge Check E: Answer

The answer is **FALSE**. The materials on which a claimed process is carried out must be considered in determining the patentability of a process. *See MPEP 2116.01*

# **Intended Use**

# Intended Use Limitations

- An intended use statement may be found within the body of the claim or in the preamble
- An intended use limitation may form the basis for distinguishing the prior art from the claimed invention, e.g., a reference may disclose all the limitations but may not be capable of performing the intended use

*See MPEP 2111.02(II)*

# Examples of Intended Use Phrases

- Claim limitations that use phrases of the type:
  - **"ADAPTED TO"**
  - **"CAPABLE OF"**
  - **"SUFFICIENT TO"**
  - **"FOR"** doing something

May introduce expressions of intended use in the claims. Note that this is not an exhaustive list and the determination of whether particular language is an expression of intended use in the claim depends on the specific facts of the case.

# Intended Use and Prior Art

“A claim containing a ‘recitation with respect to the manner in which a claimed **apparatus** is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus’ if the prior art apparatus has all the **structural** limitations of the claim”

*See MPEP 2114*

# Intended Use and Prior Art (*cont.*)

- If the prior art fails to discuss the intended use and the Examiner has a basis for asserting that prior art product is capable of performing in the claimed manner, the claims should be rejected
  - “(T)he recitation of a new intended use for an old product does not make a claim to that old product patentable.”
- In the rejection, the Examiner should set forth the basis for stating that the prior art is capable of performing the intended use

*See MPEP 2173.05(g)*

# Intended Use: Example 1

Claim 1: "An anaerobic curing sealant composition ***adapted to remain*** in a liquid, non-polymerizing state for prolonged periods of time while in contact with air ***and to polymerize*** to the solid state in the absence of air and ***upon contact with metal surfaces...***" (U.S. Patent No. 3,435,012, emphasis added)

*Loctite Corp. v. Ultraseal Ltd., et al.*, 228 USPQ 90 (Fed. Cir. 1985)



## Intended Use: Example 1 (*cont.*)

- When evaluating the claim scope, the court looked to the disclosure that the composition could be applied to “glass, ceramic, and metal surfaces and combinations thereof” (a metal surface was not required)
- The court interpreted “adapted to remain ... metal surfaces” as merely language of intended use, not a claim limitation (*Loctite* at p. 94)

# Intended Use: Example 2

## What should you search for?

Claim 1. "...including a digital camera adapted to take a picture of an infant"

- The specification gives no details of any modifications that must be made to a digital camera in order to take pictures of infants

# Intended Use: Example 2 (*cont.*)

## What should you search for?

Claim 1. "...including a digital camera adapted to take a picture of an infant"

- If you find a reference meeting all structural limitations of the claims and including a digital camera, it anticipates the claim, even if the camera in the reference is being used to take pictures of bottles in a manufacturing plant, for example, because digital cameras are **capable of** taking a picture of an infant

# Intended Use: Example 3

Claim 1. "...a printer adapted to print out an index sheet"

## Intended Use: Example 3 (*cont.*)

Claim 1. "...a printer adapted to print out an index sheet"

- In this situation, if a reference meets all claimed structural limitations and includes a generic printer that merely prints out whatever data is sent to it in any desired format, it **anticipates** this limitation because the generic printer is **capable of** printing out index sheets

# Intended Use: Example 4

Claim 1: "A splice connector kit having ... a pair of sleeves of elastomeric material, each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables..."

*See MPEP 2173.05(g)*

## Intended Use: Example 4 (*cont.*)

- The court held that the language “adapted to be fitted over the insulating jacket of one of said cables” imparts a structural limitation to the sleeves “defined by how the parts are to be interconnected in the final assembly, if assembled”
- “Each sleeve is so structured or dimensioned that it can be fitted over the insulating jacket of a cable”

# Intended Use: Example 5

## What should you search for?

Claim 1: "A device ... including a printer for printing high resolution pictures."

- In the specification, a high resolution picture is defined as having a resolution of 600 dpi (dots per inch) or greater



## Intended Use: Example 5 (*cont.*)

- All printers are not capable of printing pictures at a resolution of at least 600 dpi. Thus, a reference meeting all claimed structural limitations and including a generic printer that merely prints out whatever data are sent to it **would not anticipate** this limitation unless the printer is capable of printing high resolution pictures
- The Examiner should consider whether a secondary reference exists that could be used in combination with the reference discussed above to make a 35 USC 103 rejection

# Intended Use: Example 6

Claim 1: "A dispensing top ***for passing only several kernels of a popped popcorn at a time from an open-ended container filled with popped popcorn***, having a generally conical shape and an opening at each end, the opening at the reduced end ***allows several kernels of popped popcorn to pass through at the same time***, and means at the enlarged end of the top to embrace the open end of the container, the taper of the top being uniform and ***such as to by itself jam up the popped popcorn before the end of the cone and permit the dispensing of only a few kernels at a shake of a package when the top is mounted on the container***"

See MPEP 2173.05(g)

# Intended Use: Example 6 (cont.)

Prior art had a “spout for nozzle-ready canisters,” which may be tapered inward in a conical fashion and which is ***useful for purposes such as dispensing oil from an oil can***

- The argument centered on whether the prior art spout was capable of performing the functional limitations in the claimed dispensing top
- The court found that the spout was sized and shaped in a manner that would inherently meet the claim limitations for the dispensing top when mounted on a popped popcorn container, and that there was no evidence that the prior art spout was incapable of performing the claimed functions

# Intended Use: Whereby or Wherein Clauses

- A “whereby” clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim
  - In this situation, the Examiner should inform the Applicant that the phrase does not limit the claim and explain why
- On the other hand, a “whereby” clause that relates back to and clarifies what is required by the claim and gives meaning and purpose to the claim, rather than merely stating inherent results, is a limitation that must be given patentable weight

*See MPEP 2111.04*

## Knowledge Check F

Which of the following are accurate? (Select all that apply.)

- A. An intended use limitation may impart a structural limitation that is otherwise not found in the claim language.
- B. A “whereby” clause that clarifies what is required by the claim adds nothing to the patentability or substance of the claim.
- C. If the prior art fails to discuss the intended use and the Examiner has a basis for asserting that prior art product is capable of performing in the claimed manner, the claims should be rejected.

## Knowledge Check F: Answer

The answer is **A and C**. B is false because a “whereby” clause that relates back to and clarifies what is required by the claim and gives meaning and purpose to the claim, rather than merely stating inherent results, is a limitation that must be given patentable weight.

*See MPEP 2111.02 and 2114.*

# Claim Interpretation: Further Guidance

## The *MPEP*

- Especially *Chapter 2100*
- Refer to the relevant sections and the decisions cited therein for further guidance

# Summary

You should now be more familiar with:

- Claim Interpretation
- Broadest Reasonable Interpretation
- The effect of Preamble on claim scope
- Functional Language
- Intended Use



**Questions?**

**Thank you!**

**Please remember to complete your course  
evaluation survey**