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BROADEST REASONABLE INTERPRETATION

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II. INTRODUCTION

The standard under which the United States Patent and Trademark Office (hereafter just "USPTO") construes patent claims is called the broadest reasonable interpretation (sometimes herein just "BRI") standard. The broadest reasonable interpretation standard affords the claims their broadest reasonable interpretation consistent with the specification as it would be interpreted by one of ordinary skill in the art. The broadest reasonable interpretation standard is different than the standard employed by federal courts to construe patent claims during litigation—the *Phillips* standard—and the difference may result in identical claims construed narrowly in court and more broadly by the USPTO. While differing constructions for the same claim may be confusing to patent owners, it is all too familiar to practitioners. This paper discusses various examples of how the broadest reasonable interpretation standard has been applied by patent examiners in *ex parte* patent prosecution, and points the reader to examples of the use of the broadest reasonable interpretation during post-grant review proceedings, such as *inter partes* review and covered business method review.

III. HISTORICAL DEVELOPMENT

The phrase "broadest reasonable interpretation," and the interpretational standard the phrase represents, traces its origin to the early twentieth century. In particular, in 1924 in the case of *In re Carr*[1] the D.C. Circuit was addressing differences in claim interpretation applied during pendency, and after issuance.[2] In the *Carr* case, the statement was made that, with respect to claim interpretation when an application is pending, the "claims will be given the broadest interpretation of which they are reasonably susceptible."[3]

The standard was refined to address ambiguity in the reasonableness starting with *In re Prater.*[4] In *Prater*, the Court of Customs and Patent Appeals ("CCPA") refined the broadest reasonable interpretation standard[5] such that the standard was to be applied consistent with the

[1] 297 F. 542 (D.C. Cir. 1924).

[2] *Id.*

[3] *Id.* at 544.

[4] 415 F.2d 1393 (CCPA 1969).

[5] Which standard had already been adopted by the CCPA in 1953 in the case of *In re Kebrich*, 201 F.2d 951 (CCPA 1953).

specification.[6] In particular, the claims at issue in *Prater* were admitted by *Prater* to be broad enough to cover purely mental processes (and thus non-statutory subject matter under 35 U.S.C. §101), but *Prater* urged the court that, read in view of the *Prater's* specification which disclosed an analog device to perform the task, the claim must cover a statutory machine.[7] The CCPA agreed with *Prater* regarding reading claims in light of the specification, but viewed the particular issue as a request to read a limitation into the claims, as opposed to interpret a particular limitation in view of the claims.[8]

After coming into existence, the Court of Appeals for the Federal Circuit (hereafter just "Federal Circuit") also adopted the broadest reasonable interpretation standard for cases appealed from the USPTO, with reasonableness limited by the specification, stating "claims in an application are to be given their broadest reasonable interpretation consistent with the specification."[9] Moreover, the Federal Circuit indicated that during prosecution terms of claims are to be interpreted as one having ordinary skill in the art would interpret them.[10]

The broadest reasonable interpretation standard was re-affirmed in 2005 in the *en banc* case of *Phillips v. AWH Corp.*[11]

> The Patent and Trademark Office ("PTO") determines the scope of the claims in patent applications not solely on the basis of claim language, but upon giving claims their broadest reasonable constructions in light of the specification as it would be interpreted by one having ordinary skill in the art. … Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description."[12]

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[6] *Prater*, 415 F.2d at 1404.

[7] *Id.*

[8] *Id.*

[9] *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983) (Citing *Prater*).

[10] *Id.*

[11] 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

[12] *Id.* at 1316 (internal quotations and citations omitted).

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