

New Ruling Portends Stricter Screening of Patent Applications for Claim Ambiguities

By Yakov Sidorin, Ph.D.

In *Ex parte Miyazaki*, the Board of Patent Appeals and Interferences (BPAI) departed from a long-standing standard of claim indefiniteness established by the Federal Circuit in the context of patent litigation. In doing so, the BPAI introduced a dramatically more stringent standard to be applied during patent prosecution. To draft fatally indefinite claims is now much easier than one would think.

Until now, the requirement of 35 U.S.C. Sec. 112(2) – that a patent claim particularly point out and distinctly claim the subject matter which the applicant regards as his invention – had been thought of as well understood. In *Exxon Research and Engineering Co. v. U.S.*, the Federal Circuit held in 2001 that only claims that are “insolubly ambiguous” in light of the specification and do not allow any narrowing construction are indefinite. Although the Federal Circuit standard was established in the context of ascertaining the meaning of claims in already-issued patents, patent examiners have been applying it at the prosecution stage as well.

Now, according to the BPAI’s holding in *Miyazaki*, during patent prosecution the examiner will be justified in rejecting a claim if it is amenable to more than one plausible claim construction. The BPAI reasoned that: (i) it is a fundamental principle of patent law that the claims measure the invention, (ii) the primary responsibility for sifting out unpatentable material lies with the Patent Office, and (iii) patent applications have no presumption of validity. The Board embraced the warning issued in 1965 by the Supreme Court in *Graham v. John Deere Co.*: “To await litigation [in order to determine whether a claim is indefinite] is – for all practical purposes – to debilitate the patent system.”

The Federal Circuit had observed, in *Exxon*, that standards of indefiniteness during prosecution and litigation may differ. The BPAI’s new approach does not

contradict either this observation or the USPTO’s practice of giving the pending claims their broadest possible interpretation consistent with the specification, and appears designed to ensure that issued patents can be counted on as valid patents.

Indeed, the definiteness requirements are intended to avoid the kind of ambiguity that requires extrinsic evidence to resolve. If patent claims are sufficiently unambiguous for the PTO, there should ideally exist no factual ambiguity when those claims are later construed by a court of law in an infringement action. Finally, it does seem apt to impose a stricter standard on claim-drafting during patent prosecution, while language can be sharpened by the applicant himself without incurring undue costs.

Despite the seemingly straightforward decision of the BPAI, experience suggests that questions of definiteness will be decided on a case-by-case basis. And yet, *Miyazaki* provides a patent practitioner with some useful tips. In particular:

- a) According to a familiar canon of claim construction, the limitations from the specification should not be imported into the claim. Therefore, it may be beneficial to recite specific limitations on the claimed subject matter in the claim as well as in the specification to unambiguously define what the applicant intends to cover within the four corners of the claim itself. Such recitation may sometimes lead to a situation where even the broadest claim defines less than the entire invention. However, this is not inconsistent with the requirement of Sec. 112(2) and can be supplemented by claims highlighting other aspects of the invention.
- b) Claim language thought to be broader than the disclosed embodiments would prompt the examiner to consider the ordinary meaning of the claimed

phrase. The phrase may be amenable to two or more possible definitions and make the claim indefinite. It may be prudent, therefore, to include in the application a set of definitions applicable to words in both the description and claims. Only the rare examiner would disregard such definitions, in light of the observation of the *Manual of Patent Examining Procedure, Sec. 608.1(g)* that “the [patent] description is a dictionary for the claims.”

c) Patent claims often employ terms of degree such as “about”, “approximately”, or “substantially.” Now more than ever, terms like these can invite an indefiniteness rejection unless the specification allows a skilled artisan to measure the precise limits of words of degree.

d) Finally, providing illustrations for every feature specified in the claims in some cases may save the trouble of reciting specific limitations in the claim altogether.

Experience suggests that close questions of claim indefiniteness will probably be resolved against the patentee. Is this attitude likely to apply to all prosecutions, including reexaminations and reissues? This remains to be seen. ✧