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The Unreasonableness of the Patent Office's 'Broadest Reasonable Interpretation' Standard

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THE UNREASONABLENESS OF THE PATENT OFFICE'S "BROADEST REASONABLE INTERPRETATION" STANDARD*

*Dawn-Marie Bey** & Christopher A. Cotropia****

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*** Professor of Law, Intellectual Property Institute, University of Richmond School of Law. The authors were members of an American Bar Association (ABA) Section of Intellectual Property Law subcommittee that produced a report recommending that the BRI standard be abandoned. See *Determining Patentability of a Claim in a Patent Application*, 2008 A.B.A. SEC. OF INTELL. PROP. L. REP. 108-3, available at <http://www.abanet.org/intelprop/annual2008/business-session/108-3.pdf>. However, the opinions set forth in this article are those of the individual authors and not their employers, clients, or other organizations, such as the ABA, for whom they have worked for or with.

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I. INTRODUCTION

A patent's claims define the invention.¹ The United States Patent and Trademark Office (USPTO) examines the invention to determine its patentability, and if the Office issues a patent on the invention, the same claims may be scrutinized in a district court to determine whether the patent is enforceable and valid.² The process of interpreting claims, not surprisingly, plays a critical role in both examination by the USPTO and litigation in the courts. A claim's meaning must be known in order to determine whether the claimed invention is novel and non-obvious, or whether someone else is practicing the invention. Accordingly, the way in which claims are interpreted—the methodology that is employed—is a constant focus of the judiciary, scholars, and attorneys. In fact, some commentators identify the difficulty in determining a claim's meaning as one of the primary reasons the patent system is broken.³

Interestingly, although there has been much commentary on claim interpretation methodology in general, no one has fully explored the propriety of the unique claim interpretation doctrine that the USPTO employs to interpret every claim in every patent application.⁴ The courts instruct the USPTO to give every applied-for claim its "broadest reasonable interpretation" (BRI) during patent examination.⁵ Everyone seems to have accepted this dichotomy—that a

¹ See 35 U.S.C. § 112 (2006) ("The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."); *White v. Dunbar*, 119 U.S. 47, 52 (1886) ("The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is . . .").

² See 35 U.S.C. §§ 131, 281-282 (2006).

³ See, e.g., JAMES BESSEN & MICHAEL J. MEURER, *PATENT FAILURE* 8-11 (2008).

⁴ While not directly discussing the validity of the USPTO's use of the broadest reasonable interpretation standard in interpreting patent claims, Michael Risch has explored whether the USPTO's current claim construction methodology helps or hinders the public notice function of patent claims. See Michael Risch, *The Failure of Public Notice in Patent Prosecution*, 21 HARV. J.L. & TECH. 179, 192-200 (2007) (concluding that the standard employed inhibits public notice of claim scope); see also Joel Miller, *Claim Construction at the PTO - The "Broadest Reasonable Interpretation . . ."*, 88 J. PAT. & TRADEMARK OFF. SOC'Y 279 (2006) (describing the broadest reasonable interpretation standard).

⁵ *In re Morris*, 127 F.3d 1048, 1054, 44 U.S.P.Q.2d (BNA) 1023, 1027 (Fed. Cir. 1997).

different claim interpretation methodology should be used in examination than that which is used in enforcement actions.⁶

Nevertheless, interpreting a claim's meaning differently—depending on the venue in which the interpretation takes place—requires some justification. Given that the BRI standard plays a role in every applied-for patent, the propriety of the BRI standard needs to be explored. An examination of the BRI standard has become even more important given the standard's foundational role in a recent precedential opinion of the Board of Patent Appeals and Interferences (Board).⁷

This article does what is long overdue: it fully explores the validity of the BRI standard. The previously articulated rationales behind the BRI standard are severely lacking. Not only does the BRI standard fail to provide the advantages touted by the courts that created the standard, the standard is contrary to both the patent statutes and the concept of a unitary patent system. It allows examiners to avoid difficult claim interpretation issues; it leads to improper and uncorrectable denials of patent protection; and it is incurably ambiguous. Given that the BRI standard is severely lacking, the courts and the USPTO should abandon it and utilize a single, consistent claim interpretation methodology throughout the patent system.

This Article proceeds in three parts. Part II describes the BRI standard and the traditional justifications for the standard. Part III details objections to the standard, and discusses why the commonly offered justifications do not hold up under critical analysis. Finally, Part IV uses three recent Federal Circuit cases employing the BRI standard as examples of what is wrong with the BRI standard.

II. DESCRIPTION OF THE "BROADEST REASONABLE INTERPRETATION" STANDARD

A. *Operation of the BRI Standard*

During the examination process at the USPTO, the Office gives pending claims their BRI pursuant to "decades old case law."⁸ The Federal Circuit, its

⁶ See *infra* Part II and accompanying notes.

⁷ See *ex parte* Miyazaki, 89 U.S.P.Q.2d (BNA) 1207, 1211 (B.P.A.I. 2008).

⁸ *Morris*, 127 F.3d at 1054, 44 U.S.P.Q.2d (BNA) at 1027. The USPTO also applies the BRI standard in reexamination proceedings, *In re* Swanson, 540

predecessor court—the Court of Customs and Patent Appeals (CCPA)—and the USPTO have all consistently applied the BRI standard to the interpretation of patent claims during prosecution.⁹ The use and unique application of the BRI standard by the USPTO is well established, as articulated by the CCPA in the 1953 case, *In re Kebrich*:

Whatever may be the practice of the courts in the interpretation of claims in infringement proceedings in order to sustain patents once granted, it is very definitely settled by a line of consistent decisions rendered during a long period of time that in the initial consideration of the question of patentability neither the tribunals of the Patent Office nor the courts in reviewing their action may properly read unexpressed limitations into claims, and it is equally as well settled that, so limited, the tribunals and the reviewing courts in the initial consideration of patentability will give claims the broadest interpretation which, within reason, may be applied.¹⁰

The Federal Circuit has recently approved the use of the BRI standard in *Phillips v. AWH Corp.*, an en banc decision addressing claim interpretation.¹¹ The specifics of the standard, as explained by the Federal Circuit in *In re Morris*, are as follows:

[A]s an initial matter, the [US]PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of

F.3d 1368, 1377-78, 88 U.S.P.Q.2d (BNA) 1196, 1203 (Fed. Cir. 2008), as well as in reissue proceedings, *In re Reuter*, 670 F.2d 1015, 1019, 210 U.S.P.Q. (BNA) 249, 253 (C.C.P.A. 1981).

⁹ See, e.g., *Burlington Indus., Inc. v. Quigg*, 822 F.2d 1581, 1583, 3 U.S.P.Q.2d (BNA) 1436, 1438 (Fed. Cir. 1987); *In re Sweet*, 393 F.2d 837, 841-42, 157 U.S.P.Q. (BNA) 495, 499 (C.C.P.A. 1968); *In re Tibbals*, 316 F.2d 955, 958, 137 U.S.P.Q. (BNA) 565, 567 (C.C.P.A. 1963); *In re Kebrich*, 201 F.2d 951, 954, 96 U.S.P.Q. (BNA) 411, 414 (C.C.P.A. 1953) (articulating the broadest reasonable interpretation standard).

¹⁰ 201 F.2d at 954, 96 U.S.P.Q. (BNA) at 414.

¹¹ 415 F.3d 1303, 1316, 75 U.S.P.Q.2d (BNA) 1321, 1329 (Fed. Cir. 2005) (en banc). The Federal Circuit has rejected the argument that decisions such as *Markman v. Westview Instruments* have overruled the standard. *Morris*, 127 F.3d at 1053-54, 44 U.S.P.Q.2d (BNA) at 1027-28.

ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.¹²

The BRI standard is commonly accompanied by the additional qualifier "consistent with the specification" or similar verbiage.¹³ The Federal Circuit explains this qualifier as a further explanation of a "reasonable" interpretation—one that does not "ignore any interpretative guidance afforded by the applicant's written description."¹⁴

The BRI standard creates a different and unique interpretation methodology for the USPTO compared to the methodology used by district courts to interpret issued claims (the post-grant methodology).¹⁵ The Federal Circuit has held it to be reversible error for the USPTO to apply the post-grant methodology.¹⁶ The USPTO must use the BRI standard.¹⁷

Additionally, the Federal Circuit applies a different standard of appellate review to USPTO interpretations of pending claims than it does to district court interpretations of issued claims. Since its decision in *Cybor Corp. v. FAS Technologies, Inc.*, the Federal Circuit has upheld the *de novo* standard of review for district court interpretations of issued claims.¹⁸ In contrast, the Federal Circuit reviews claim interpretations by the USPTO under a "reasonableness" standard, which is consistent with the BRI standard applied in the USPTO

¹² 127 F.3d at 1054, 44 U.S.P.Q.2d (BNA) at 1027.

¹³ *See id.*

¹⁴ *See id.*

¹⁵ *Id.* at 1054, 44 U.S.P.Q.2d (BNA) at 1027-28.

¹⁶ *In re Zletz*, 893 F.2d 319, 321-22, 13 U.S.P.Q.2d (BNA) 1320, 1321-22 (Fed. Cir. 1989). Although the Federal Circuit, in *In re Zletz*, found that the Board had committed a serious error by applying the wrong interpretation standard and took the time to reprimand the Board and explain this error, *id.*, the court ultimately affirmed the board's decision because the error was deemed irrelevant to the outcome due to collateral estoppel. *Id.* at 324, 13 U.S.P.Q.2d (BNA) at 1324.

¹⁷ *Id.* at 321-22, 13 U.S.P.Q.2d (BNA) at 1321-22.

¹⁸ *See* 138 F.3d 1448, 1454, 46 U.S.P.Q.2d (BNA) 1169, 1172 (Fed. Cir. 1998) (en banc).

setting.¹⁹ Under this “reasonableness” standard of review, the Federal Circuit gives the USPTO’s interpretations under the BRI standard deference.²⁰ In contrast, it gives district court interpretations of issued claims none.²¹

B. Articulated Rationales Behind the BRI Standard

1. Reduces the Likelihood that an Issued Claim is Subsequently Interpreted More Broadly

The major justification for the BRI standard is that “[g]iving claims their broadest reasonable construction ‘serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.’”²² Using the BRI standard during prosecution allows the patent system to “hedge its bets.” In other words, the BRI standard allows the USPTO to consider the full range of reasonable claim interpretations that a claim could be given. Then, once a patent issues, the public may assume that the USPTO’s review for patentability encompassed any reasonable interpretation of the claim(s) done either by a district court or by another patent observer.²³

The standard allegedly helps the USPTO avoid erroneously blessing a claim as patentable when a district court may construe the same claim more broadly than the USPTO had considered, with the resulting increase in scope capturing prior art or an obvious variation of the prior art.²⁴ Thus, the BRI standard helps avoid a Type I error—an incorrect finding by the USPTO that the

¹⁹ *Morris*, 127 F.3d at 1055, 44 U.S.P.Q.2d (BNA) at 1028-29.

²⁰ *See id.*

²¹ *See Cybor*, 138 F.3d at 1454, 46 U.S.P.Q.2d (BNA) at 1172. This lack of deference for district court interpretations is a point of contention. *See, e.g., Phillips v. AWH Corp.*, 415 F.3d 1303, 1330-31, 75 U.S.P.Q.2d (BNA) 1321, 1339 (Fed. Cir. 2005) (Mayer, J., dissenting) (“Now more than ever I am convinced of the futility, indeed the absurdity, of this court’s persistence in adhering to the falsehood that claim construction is a matter of law devoid of any factual component.”).

²² *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364, 70 U.S.P.Q.2d (BNA) 1827, 1830 (Fed. Cir. 2004) (quoting *In re Yamamoto*, 740 F.2d 1569, 1571, 222 U.S.P.Q. (BNA) 934, 936 (Fed. Cir. 1984)); *see also In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. (BNA) 541, 550 (C.C.P.A. 1969).

²³ *See Am. Acad.*, 367 F.3d at 1364, 70 U.S.P.Q.2d (BNA) at 1830.

²⁴ *See Yamamoto*, 740 F.2d at 1571-72, 222 U.S.P.Q. (BNA) at 936.

claims are patentable when a district court's interpretation would actually render them anticipated or non-obvious.²⁵

2. Claims can be Amended During Prosecution

A second argument offered in support of the BRI standard is that, in contrast to litigation, claims are open to amendment during prosecution.²⁶ Therefore, "[a]pplicants' interests are not impaired [by the BRI standard] since they are not foreclosed from obtaining appropriate coverage for their invention with express claim language."²⁷ Presumably, the applicant can fix the examiner's interpretation of the claims by amending or arguing the claim whose meaning is in dispute.

The Federal Circuit has stated that the BRI standard "promotes the development of [a] written record before the [US]PTO that provides the requisite written notice to the public as to what the applicant claims as the invention."²⁸ This record helps identify the claimed invention because "during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed."²⁹ Amending in response to broad interpretations also allows the applicant to "amend the claims to obtain protection commensurate with his actual contribution to the

²⁵ A "Type I error" is a false-positive—in this context, a false finding of patentability; a "Type II error" is a false-negative—in this context is a false finding of unpatentability. See, e.g., Ian Ayers & Katharine K. Baker, *A Separate Crime of Reckless Sex*, 72 U. CHI. L. REV. 599, 639-40 (2005) (discussing Type I and Type II errors in the context of criminal law). See *infra* Part III.D for more discussion of Type II errors.

²⁶ See 35 U.S.C. § 132(a) (2006) (indicating that an applicant can amend in response to an examiner's rejection); *Burlington Indus., Inc. v. Quiqq*, 822 F.2d 1581, 1583, 3 U.S.P.Q.2d (BNA) 1436, 1438 (Fed. Cir. 1987) ("Patent application claims are given their broadest reasonable interpretation during examination proceedings, for the simple reason that before a patent is granted the claims are readily amended as part of the examination process."); *Prater*, 415 F.2d at 1404-05, 162 U.S.P.Q. (BNA) at 550.

²⁷ *Yamamoto*, 740 F.2d at 1571, 222 U.S.P.Q. (BNA) at 936.

²⁸ *In re Morris*, 127 F.3d 1048, 1054, 44 U.S.P.Q.2d (BNA) 1023, 1028 (Fed. Cir. 1997).

²⁹ See *In re Zletz*, 893 F.2d 319, 321-22, 13 U.S.P.Q.2d (BNA) 1320, 1322 (Fed. Cir. 1989).

art."³⁰ As such, purported justifications of the BRI standard arise from the possibility of amending. Amending the claims not only appears to take the sting away from the BRI standard, but also is beneficial due to the resulting certainty and narrowness in claim scope, thus bringing claims more in line with what the applicant actually invented.³¹

3. No Presumption of Validity Exists During Prosecution

The Federal Circuit and CCPA also attempt to justify the BRI standard by pointing to the fact that, during examination, patent applications do not enjoy the presumption of validity afforded to issued patents.³² Once the examiner rejects the application, "the burden of production falls upon the applicant to establish entitlement to a patent."³³ Rejections under the BRI standard seemingly force the applicant to prove that her invention is worthy of patent protection.³⁴ Responses to rejections and amendments to clarify claim meaning are part of this process.³⁵ Thus, the BRI is further justified because it facilitates this necessary exchange and provides the public with notice of the scope of the invention before the presumption of validity attaches.³⁶

III. PROBLEMS WITH THE BRI STANDARD

Although the BRI standard has been applied for quite some time, this standard has never been substantively questioned or vetted.³⁷ In fact, the Board

³⁰ See *Prater*, 415 F.2d 1393, 1404 n.30, 162 U.S.P.Q. (BNA) 541, 550 n.30 (C.C.P.A. 1969).

³¹ See *Zletz*, 893 F.2d at 321-22, 13 U.S.P.Q.2d (BNA) at 1322.

³² See, e.g., *Morris*, 127 F.3d at 1054, 44 U.S.P.Q.2d (BNA) at 1027-28.

³³ *Id.* at 1054, 44 U.S.P.Q.2d at 1028 (BNA).

³⁴ See *id.*

³⁵ See *Zletz*, 893 F.2d at 321-22, 13 U.S.P.Q.2d (BNA) at 1322.

³⁶ See *Morris*, 127 F.3d at 1054, 44 U.S.P.Q.2d (BNA) at 1027-28.

³⁷ This standard, however, was questioned by an ABA Section of Intellectual Property Law subcommittee, chaired by an author of this article, that produced a report recommending that the BRI standard be abandoned. See *Determining Patentability of a Claim in a Patent Application*, 2008 A.B.A. SEC. OF INTELL. PROP. L. REP. 108-3, available at <http://www.abanet.org/intelprop/annual2008/business-session/108-3.pdf>.

recently reaffirmed the use of the BRI standard in a significant indefiniteness holding.³⁸

The following section articulates a number of fundamental problems resulting from the use of a different standard to interpret claims during prosecution from the standard applied to interpret issued claims. The BRI standard is inconsistent with the plain language of the patent statutes, is contrary to the unitary patent system established by the creation of the Federal Circuit, allows examiners to hide from tough claim interpretation questions, results in incorrect denials of patent protection, and is hopelessly vague. These inconsistencies, contradictions, and denials illustrate that none of the previously articulated justifications for the differences in the standards hold true.

A. *The BRI Standard Is Inconsistent with the Patent Statutes*

The identical statutory requirements for patentability and validity,³⁹ which the USPTO applies during examination,⁴⁰ are applied by district courts during litigation.⁴¹ These statutory requirements focus on the patentability (or validity, in the case of an issued patent) of an "invention,"⁴² which is defined by the patent's claims.⁴³ The same term, "invention," is also used in 35 U.S.C. § 271 to define the scope of exclusivity that an issued patent affords the patent holder.⁴⁴ The use of the term "invention" does not change throughout Title 35; and nothing in the statute suggests that its definition should vary between validity considerations and infringement considerations, or between examination and litigation.⁴⁵ Sections 101, 102, 103, and 112—defining the requirements for

³⁸ See *ex parte* Miyazaki, 89 U.S.P.Q.2d (BNA) 1207, 1211 (B.P.A.I. 2008).

³⁹ 35 U.S.C. §§ 101-103, 112 (2006).

⁴⁰ *Id.* § 131.

⁴¹ *Id.* §§ 151, 282. In addition to district courts, the definitions are applied by the International Trade Commission during 337 enforcement actions. See 19 U.S.C. § 1337(a) (2006).

⁴² 35 U.S.C. §§ 101-103, 112.

⁴³ *Id.* § 112, ¶ 2.

⁴⁴ *Id.* § 271(a).

⁴⁵ See *id.* §§ 101-103, 112, 131, 151, 282.

patent protection—apply to both determinations of patentability during prosecution and to inquiries into validity during litigation.⁴⁶

The patent statutes therefore establish a singular concept of "invention," which is defined by one or more claims that are reviewed for patentability at the USPTO and define a right to exclude that is enforceable in district court.⁴⁷ The case law also describes this singular view of invention.⁴⁸ Patent examiners must examine each patent claim to determine its patentability.⁴⁹ The Office then issues patents on those claims that meet the patentability standards,⁵⁰ and the patentee can enforce the issued claims in district courts.⁵¹

Using the BRI standard only during examination and not during enforcement proceedings violates this statutorily coded concept of a singular invention. Under the current mode of interpretation, the USPTO examines the patentability of one invention, construing the claims under the unique BRI methodology.⁵² Once the USPTO issues the patent, the district court may be called upon to review the validity of, and give exclusivity for, a different invention—the scope of the invention now defined by claims interpreted through the post-grant methodology—a methodology that is not glossed by the BRI requirement.⁵³ The applicability of differing interpretation standards necessarily means that the scope of a claim could be different at issuance from the scope

⁴⁶ See *id.*

⁴⁷ See *id.* §§ 131, 281.

⁴⁸ See, e.g., *Graham v. John Deere Co.*, 383 U.S. 1, 34, 148 U.S.P.Q. (BNA) 459, 473 (1966) (“[T]he patentee obtained his patent only by accepting the limitations imposed by the Examiner. The claims were carefully drafted to accept these limitations and [the patent holder] is not now free to assert a broader view of [the] invention. The subject matter as a whole reduces, then, to the distinguishing features clearly incorporated into the claims.”).

⁴⁹ See 35 U.S.C. § 131.

⁵⁰ *Id.* § 151.

⁵¹ *Id.* § 271 (defining what actions a patentee can take in court when a patent is infringed); see also *Graham*, 383 U.S. at 34, 148 U.S.P.Q. (BNA) at 473 (stating that courts scrutinize the same invention whose claims and scope were defined during examination).

⁵² *In re Morris*, 127 F.3d 1048, 1054, 44 U.S.P.Q.2d (BNA) 1023, 1027 (Fed. Cir. 1997)

⁵³ See *id.*

determined during enforcement, which would establish different "inventions" for the same claim.

The possibility of such a result violates the unitary nature of "invention" set forth in the patent statutes. The USPTO must judge the patentability of the very same invention whose validity a district court will enforce.⁵⁴ The BRI standard flies in the face of this required outcome; in fact, it instructs examiners to examine a potentially broader invention than that which a district court will enforce.

Concededly, not all patent laws are applied in the same way during examination as they are during enforcement actions. Notably, the strong presumption of validity, which is applicable to an issued patent during litigation,⁵⁵ does not apply to a patent application during examination.⁵⁶ In addition, the examiner does not have to establish unpatentability of a pending patent claim by clear and convincing evidence, which is the threshold an alleged infringer must meet to establish the invalidity of an asserted patent claim in defense of an infringement action.⁵⁷

The act of examination and issuance is what creates the presumption of validity in the first place, and it follows that the examiner works unconstrained

⁵⁴ ROGER E. SCHECHTER & JOHN R. THOMAS, PRINCIPLES OF PATENT LAW 200 (2004) ("When considering patentability and infringement issues, courts and [US]PTO examiners turn to the particular wording of the invention as claimed.").

⁵⁵ 35 U.S.C. § 282 (2006) ("A patent shall be presumed valid.").

⁵⁶ *In re Etter*, 756 F.2d 852, 856, 225 U.S.P.Q. (BNA) 1, 4 (Fed. Cir. 1985) (en banc) (finding that the presumption of validity does not apply to proceedings before the USPTO and noting, in addition, that patents in reexamination do not enjoy the same presumption of validity).

⁵⁷ *See id.*; *SRAM Corp. v. AD-II Eng'g, Inc.*, 465 F.3d 1351, 1357, 80 U.S.P.Q.2d (BNA) 1363, 1367 (Fed. Cir. 2006) ("Under the patent statutes, a patent enjoys a presumption of validity, *see* 35 U.S.C. § 282, which can be overcome only through facts supported by clear and convincing evidence."). The presumption is not without its critics, however. *See* Doug Lichtman & Mark A. Lemley, *Rethinking Patent Law's Presumption of Validity*, 60 STAN. L. REV. 45, 46-47 (2007).

by any presumption.⁵⁸ The purpose of examination is to take the first pass on the issue of validity—i.e., to determine the patentability of the pending claim(s).⁵⁹

The fact that the examiner makes the initial determination on validity, whereas a district court looks at an already-examined claim, may justify some amount of deference by the district court to the USPTO's findings.⁶⁰ This reasoning, however, does not extend far enough to justify interpreting inventions differently based on the forum (being either the USPTO or a district court) where the interpretation takes place. The same invention that is the subject of examination forms the basis for enforcement proceedings in district court.⁶¹ It does not make sense to vary a claim's meaning—and in turn, the definition of the invention—due to the fact that, during examination, patentability has yet to be determined.

In fact, the concept of a presumption of validity necessitates a singular understanding of an invention. If, because different standards of interpretation are applied, a different invention is deemed to exist during enforcement than exists during prosecution, the rationale behind the presumption of validity does not hold true.⁶² The district courts cannot presume that the USPTO has already deemed the claimed invention valid because the USPTO looks at an invention defined by the BRI standard, which, in theory, is a broader invention—and therefore a different invention—than that which the district courts use. It may make some sense for subsequent venues to defer to previous adjudicative bodies on the issue of validity, but claim meaning and, in turn, the definition of an invention, must remain static between venues for such deference to be justified.⁶³

⁵⁸ See Lichtman & Lemley, *supra* note 57, at 52 ("First, the presumption of validity forces courts to defer to the expertise of the [US]PTO, thereby avoiding redundant and possibly inferior second looks by the courts. Presumptions are used throughout the law for precisely this reason.").

⁵⁹ See *id.* at 46.

⁶⁰ *Id.* at 51-54. However, the current low quality of examination, amongst other factors, brings this strong presumption into question. *Id.*

⁶¹ 35 U.S.C. §§ 131, 281 (2006).

⁶² Lichtman & Lemley, *supra* note 57, at 53-56.

⁶³ The doctrine of equivalents does allow the claim scope to vary post-issuance. Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 40-41, 41 U.S.P.Q.2d (BNA) 1865, 1876 (1997). However, the Supreme Court suggests that examiners consider even the equivalents of claims under

B. *The BRI Standard Is Contrary to the Unitary Appellate Structure of the Patent System*

Congress created the Federal Circuit, in part, to establish uniformity in the substantive patent law applied in USPTO proceedings and district court patent litigation proceedings.⁶⁴ Prior to the court's institution, different standards could apply in different venues because different appellate courts independently reviewed decisions from these venues.⁶⁵ This lack of uniformity resulted in varying interpretations of the patent laws.⁶⁶ The creation of a single appellate court and, in turn, a singular body of appellate law, over both the USPTO and all district courts, created horizontal equity, which ensures, for example, that the same obviousness standard applied during examination also applies during enforcement actions.⁶⁷ Without such horizontal equity, there would be uncertainty as to one's patent rights.⁶⁸ For example, the USPTO, with

examination. *Id.* at 32, 41 U.S.P.Q.2d (BNA) at 1872 ("And if the [US]PTO has been requesting changes in claim language without the intent to limit equivalents or, indeed, with the expectation that language it required would in many cases allow for a range of equivalents, we should be extremely reluctant to upset the basic assumptions of the [US]PTO without substantial reason for doing so.").

⁶⁴ See Commission on Revision of the Federal Court Appellate System, *Structure and Internal Procedures: Recommendations for Change*, 67 F.R.D. 195, 369-71, 373-74 (1976). *But see* Craig Allen Nard & John F. Duffy, *Rethinking Patent Law's Uniformity Principle*, 101 NW. U. L. REV. 1619, 1675 (2007) (questioning whether the Federal Circuit has been a successful experiment).

⁶⁵ The CCPA had exclusive jurisdiction over appeals of rejected applications from the USPTO while the appropriate regional circuit courts reviewed patent infringement decisions. Rochelle Cooper Dreyfuss, *The Federal Circuit: A Case Study in Specialized Courts*, 64 N.Y.U. L. REV. 1, 6-8 (1989).

⁶⁶ *Graham v. John Deere Co.*, 383 U.S. 1, 18, 148 U.S.P.Q. (BNA) 459, 467 (1966) (noting the varying nonobviousness standard and stating that the Court had "observed a notorious difference between the standards [of patentability] applied by the Patent Office and by the courts").

⁶⁷ See Dreyfuss, *supra* note 65, at 8.

⁶⁸ See Christopher A. Cotropia, *"Arising Under" Jurisdiction and Uniformity in Patent Law*, 9 MICH. TELECOMM. & TECH. L. REV. 253, 305 (2003) ("With the creation of the Federal Circuit, the same appellate law governed the USPTO and federal district court patent cases. The same rule of law applied to a patent before the USPTO and a patent in federal court, creating a degree of horizontal equity.").

one set of standards, may think that an application is directed to patentable subject matter; whereas, a district court, with a different set of standards, could disagree. The court's disagreement would not be with the USPTO's application of the law, but rather with the actual interpretation of the law on a given patent issue.⁶⁹ The Federal Circuit removes this inequity and instills a level of certainty to patent rights.⁷⁰

The BRI standard disrupts the horizontal equity that the creation of the Federal Circuit aimed to establish. By introducing an interpretation methodology unique to the USPTO, the Federal Circuit applies a different claim interpretation doctrine in USPTO appeals than in district court appeals.⁷¹ The substantive law of claim interpretation varies depending on the venue.⁷² This variation in interpretation methodology makes it possible for claims to have variable meanings depending on the venue of the court interpreting the claims.

Accordingly, between the USPTO and the district courts, a patentee's rights may vary as the claim meaning varies. Such an occurrence is particularly likely with the BRI standard given that claim meaning is the fundamental, first step in determining questions of patentability and the scope of exclusivity.⁷³ This

⁶⁹ For example, prior to the Federal Circuit's creation, regional circuits disagreed with each other about the patentability of business methods. *See id.* at 301-02 ("Some regional circuits also held that business methods were not patentable statutory subject matter, coming to an opposite conclusion to that of the Federal Circuit.") (footnote omitted).

⁷⁰ Dreyfuss, *supra* note 65, at 8; Joan E. Schaffner, *Federal Circuit "Choice of Law": Erie Through the Looking Glass*, 81 IOWA L. REV. 1173, 1196 (1996).

⁷¹ *See supra* Part III.A.

⁷² This situation recreates the problem the Federal Circuit was designed to solve: different treatment in different forums due to different interpretations of the law. *See Schaffner, supra* note 70, at 1196.

⁷³ *See TI Group Auto. Sys. (N. Am.), Inc. v. VDO N. Am., L.L.C.*, 375 F.3d 1126, 1139, 71 U.S.P.Q.2d (BNA) 1328, 1338 (Fed. Cir. 2004) ("Our validity analysis is a two-step procedure: 'The first step involves the proper interpretation of the claims. The second step involves determining whether the limitations of the claims as properly interpreted are met by the prior art.'" (quoting *Beachcombers, Int'l, Inc. v. WildeWood Creative Prods., Inc.*, 31 F.3d 1154, 1160, 31 U.S.P.Q.2d 1653, 1660 (Fed. Cir. 1994))); *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454, 46 U.S.P.Q.2d (BNA) 1169, 1172 (Fed. Cir. 1998) (en banc) ("An infringement analysis involves two steps. First, the court determines the scope and meaning of the patent claims asserted, and then

difference in treatment injects uncertainty into the beginning of the patent process because the meanings of patent claims vary due to venue and, in turn, the questions of validity and infringement, which build off claim meaning, vary as well. The same patent is not treated the same in different venues; the BRI standard explicitly makes this the case and it, as a result, violates the concept of horizontal equity.⁷⁴

Again, evidentiary standards applied in the two venues differ when determining questions of validity.⁷⁵ As explained in Part III.A., however, the difference in standards—specifically the existence of a presumption of validity in district court—makes structural sense, while the BRI standard does not.⁷⁶

C. *The BRI Standard Allows Examiners and the Federal Circuit to Skirt Tough Claim Interpretation Issues*

The BRI standard also allows examiners to avoid tough claim interpretation issues. It explicitly does not require the examiner to determine the correct claim interpretation.⁷⁷ Instead, examiners just need to give the claim a “reasonable” interpretation. This means that examiners never need to resolve on paper the difficult “read the claims in light of the specification, but do not read the limitations from the specification into the claims” conundrum faced in almost every claim interpretation inquiry.⁷⁸ Most importantly, the applicant does not have to respond to such analysis. Prosecution history as to whether limitation “A” from the specification should be read into the claims is never created because the BRI standard prevents the conversation from ever happening. The public is then robbed of discussions of claim meaning that could assist in future interpretation. These discussions are tailored to the actual methodology courts will apply when interpreting the claims in litigation.

the properly construed claims are compared to the allegedly infringing device.” (citations omitted)).

⁷⁴ See *supra* notes 64-70 and accompanying text.

⁷⁵ See *supra* Part III.A.

⁷⁶ *Id.*

⁷⁷ In other words, the BRI explicitly forecloses any need to find a “correct interpretation.”

⁷⁸ See Christopher A. Cotropia, *Patent Claim Interpretation Methodologies and Their Claim Scope Paradigm*, 47 WM. & MARY L. REV. 49, 81 (2005).

The case law actually celebrates this fact by arguing that the USPTO should err on examining a broader claim because a district court may later give the claim a similar broad construction.⁷⁹ Put another way, the unique standard in the prosecution context tilts examination toward a broader claim just in case district courts will apply such a broad construction.

This argument makes some dangerous assumptions. It assumes that examiners and district courts are unlikely to arrive at the same interpretation under the current claim interpretation rubric. If this assumption is true, then there is no reason to believe an examiner would arrive at a correct, broadest interpretation under the BRI standard. Examiners are just as likely to misapply the BRI standard as they are to misapply the interpretation standard used in the litigation process. If anything, the addition of another layer to claim interpretation procedure injects more uncertainty and unpredictability into the process, making it even more likely that the USPTO will interpret claims differently than district courts.

Adding another interpretation step—determining the BRI after discerning the standard claim meaning—just creates another opportunity for like minds to differ. If a difference in the resulting interpretation by the USPTO and the district courts is so likely that an express doctrine is needed to compensate for it, then a deeper-rooted problem exists. The real problem is the lack of certainty and predictability in claim construction.⁸⁰ The real change should therefore be to the underlying claim interpretation methodology, not the addition of a BRI gloss at the USPTO.⁸¹ The BRI standard, at best, only hides a more fundamental problem of claim construction. The better solution is to attack that problem head-on instead of creating a doctrine to compensate for the base doctrine's shortcomings.

One could argue, as the Board did recently in *Ex parte Miyazaki*, that the BRI standard facilitates definiteness in claim meaning.⁸² In *Miyazaki*, the Board

⁷⁹ See, e.g., *In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. (BNA) 541, 550 (C.C.P.A. 1969).

⁸⁰ See, e.g., Christian A. Chu, *Empirical Analysis of the Federal Circuit's Claim Construction Trends*, 16 BERKELEY TECH. L.J. 1075, 1143 (2001).

⁸¹ For example, decreasing information costs may help the interpretation process. See Christopher A. Cotropia, *Patent Claim Interpretation and Information Costs*, 9 LEWIS & CLARK L. REV. 57, 90 (2005).

⁸² See 89 U.S.P.Q.2d (BNA) 1207, 1211 (B.P.A.I. 2008).

laid out a new lower standard for indefiniteness, partially grounded in the BRI standard.⁸³ The BRI standard assumes that a claim can be "amenable to two or more plausible claim constructions," and so "the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite."⁸⁴

The Board's reasoning misses the point. The Board is correct that the BRI standard is premised, at least in part, on the assumption that claim interpretation is difficult and that like minds can reach different conclusions. This assumption is, however, faulty if it supports different claim-interpretation processes at the USPTO and in district courts. Again, if claim interpretation as currently articulated is difficult and embroiled in uncertainty, Congress should fix it all the way around.⁸⁵ Notably, this point is not an indictment of the *Miyazaki* holding, which is better grounded, as the Board recognized, in the lack of a presumption of validity than in the BRI standard.⁸⁶

D. *The BRI Standard Results in Improper Denial of Patent Protection*

The BRI standard also creates the possibility that the USPTO will improperly reject a patent claim. Under the standard, the USPTO does not review an application pursuant to the normal meaning of the pending claims in that the USPTO does not use the traditional claim interpretation methodology applied in district court.⁸⁷ Instead, as the BRI standard requires, examiners give

⁸³ *Id.*

⁸⁴ *Id.*

⁸⁵ It is possible that the fix will involve using the BRI standard in both the USPTO and in district courts rather than abandoning the BRI standard altogether.

⁸⁶ See *Miyazaki*, 89 U.S.P.Q.2d (BNA) at 1212 ("If this case were before an examiner, the examiner might well be justified in demanding that the applicant more clearly define [specific claim language], and thereby remove any degree of ambiguity. However, we are faced with an issued patent that enjoys a presumption of validity." (quoting *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1384, 60 U.S.P.Q.2d 1272, 1283 (Fed. Cir. 2001))).

⁸⁷ See *In re Morris*, 127 F.3d 1048, 1054, 44 U.S.P.Q.2d (BNA) 1023, 1027 (Fed. Cir. 1997); *In re Kebrich*, 201 F.2d 951, 954, 96 U.S.P.Q. (BNA) 411, 414 (C.C.P.A. 1953).

claims their "broadest" interpretation.⁸⁸ Claim scope, as interpreted by the USPTO, therefore has the possibility of encompassing more subject matter than the claim captures when interpreted and enforced in district court.⁸⁹ This differential is shown in Figure 1 below.

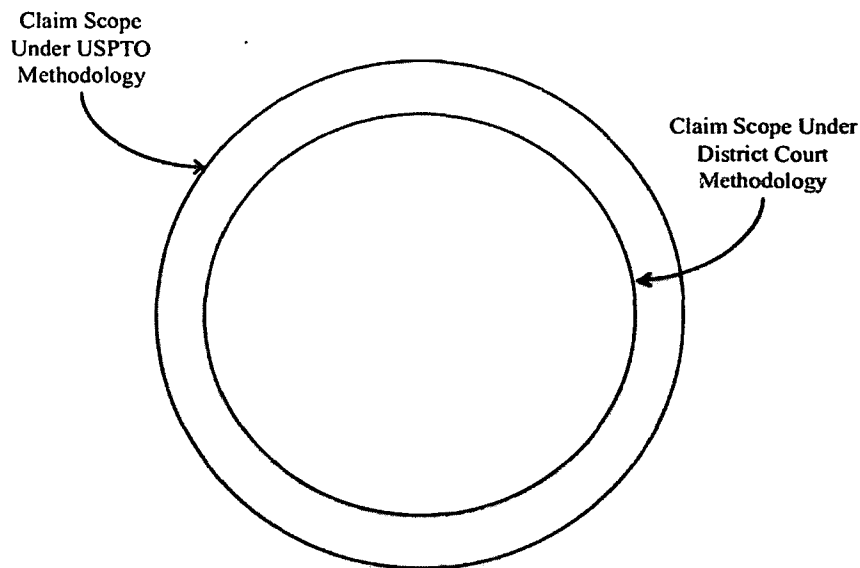


Figure 1
Claim Scope under Different Interpretation Methodologies

Figure 1 contrasts the resulting scope under the two methodologies. The requirement that the USPTO give the claim language its "broadest" reasonable interpretation necessarily contemplates a larger resulting claim scope than a district court would determine under the normal interpretation methodology without the "broadest" lens.

The complete scope of a pending claim must be patentable to be worthy of patent protection.⁹⁰ The broader the claim, the more likely the USPTO will hold it to be unpatentable. Under broader constructions, more subject matter falls under the breadth of the claim that could be anticipated, obvious, or

⁸⁸ See *Morris*, 127 F.3d at 1054, 44 U.S.P.Q.2d (BNA) at 1027.

⁸⁹ See *id.*

⁹⁰ See *id.*

unsupported by the application's specification.⁹¹ If a claim captures subject matter that is any of these, the claim is invalid.⁹² Referring to Figure 1, the diagram depicts the extra scope in gray, and if any prior art either anticipates or renders obvious this additional gray material, the claim is invalid.⁹³ Essentially, the correlation is that the broader the interpreted scope is, the higher the likelihood of rejection.

Not only does the BRI standard make rejections more likely, it also means that some rejections are, in fact, incorrect. They are incorrect because the prior art or an obvious variation of the prior art only falls within the claim scope that exists under the USPTO's interpretation of the claim—the gray area in Figure 1. Under the normal claim interpretation methodology applied by district courts, the claim is valid because it does not capture this unpatentable subject matter.⁹⁴ However, upon initial examination of the application, the USPTO takes a broader view of the claim's meaning, as required by the BRI standard, and finds that the claim is invalid. The BRI standard can thus cause the USPTO to reject an application as unpatentable when, in fact, the application contained a patentable invention that the Office should have issued.

The BRI standard has the real possibility of creating Type II errors, false negatives, by falsely triggering rejections when no real patentability issue exists.⁹⁵ One rationale for using the BRI, and thereby allowing more Type II errors, may be the prevention of Type I errors, or false positives, i.e., invalid patents that may issue when the USPTO gives pending claims too narrow of an interpretation.⁹⁶ The problem with angling the system to avoid Type I errors at the expense of Type II errors is that mechanisms are already in place to solve Type I errors, but no such mechanisms exist for Type II errors. The USPTO, and the courts, can remedy incorrectly issued patents—Type I errors—in a variety of ways, such as

⁹¹ See Christopher A. Cotropia, *The Folly of Early Filing in Patent Law*, 66 HASTINGS L.J. (forthcoming 2009) (manuscript at 7, on file with authors).

⁹² *Id.*

⁹³ See SCHECHTER & THOMAS, *supra* note 54, at 201.

⁹⁴ See *Morris*, 127 F.3d at 1054, 44 U.S.P.Q.2d (BNA) at 1027.

⁹⁵ The court seems much more concerned with “reducing the possibility that claims, finally allowed, will be given [a] broader scope than is justified,” see *In re Yamamoto*, 740 F.2d 1569, 1571, 222 U.S.P.Q.2d (BNA) 934, 936 (Fed. Cir. 1984), than with inappropriate rejections of inventions that are actually patentable when construed under the normal standard.

⁹⁶ See *id.*; *supra* Part II.B.1.

through reexamination, reissue, or invalidation.⁹⁷ Type II errors, in contrast, cannot be resolved under the current system. Once the USPTO deems a patent application as unpatentable, there is no recourse. Certainly, an applicant can argue the rejection, appeal the rejection to the Board, or appeal the final USPTO ruling to the Federal Circuit and eventually to the Supreme Court.⁹⁸ The BRI standard will apply, however, throughout the entire appellate review process.⁹⁹ Under the current law, all avenues would continue to apply the BRI standard, so if the USPTO incorrectly deems the claim invalid due to a broad claim scope, that incorrect interpretation never changes throughout the review process.¹⁰⁰ Thus, Type II errors that directly result from the BRI standard are irreversible, and even invited, under the current system, whereas the system has extensive mechanisms for correcting Type I errors.¹⁰¹ This disparity makes tilting the interpretation methodology at the USPTO (by mandating the use of the BRI standard) toward the creation of Type II errors to prevent Type I errors even more irrational.

To compound the problem, recent changes in patentability case law make Type II errors more likely. For example, the Supreme Court's decision in *KSR International Co. v. Teleflex Inc.* gives examiners additional avenues for establishing a pending patent claim as obvious.¹⁰² Examiners can now establish obviousness even if there was no teaching, suggestion, or motivation to combine the prior art.¹⁰³ Examiners, for example, can rely on "common sense," the

⁹⁷ 35 U.S.C. § 251 (2006) (allowing for the reissue of defectively issued patents); *id.* § 282 (providing district courts with the ability to invalidate claims); *id.* § 301 (setting forth the basis for *ex parte* reexamination proceedings); *id.* § 311 (describing *inter partes* reexamination).

⁹⁸ *Id.* § 134 (providing appeal to the Board); *id.* § 141 (providing appeal to the Federal Circuit).

⁹⁹ *See, e.g., Morris*, 127 F.3d at 1053-54, 44 U.S.P.Q.2d (BNA) at 1027 (applying the BRI standard in an appeal to the Federal Circuit from the Board, who had affirmed an examiner's rejection under the BRI). Also, pursuant to 35 U.S.C. § 145 (2006), the applicant could appeal to the district court from the Board and the BRI standard would continue to apply.

¹⁰⁰ This fact is demonstrated by the examples set forth below. *See infra* Part IV.

¹⁰¹ *See* Mark A. Lemley, *Rational Ignorance at the Patent Office*, 95 Nw. U. L. REV. 1495, 1500 (2001) (pointing out that litigation may be a better way to weed out bad patents).

¹⁰² 550 U.S. 398, 419, 421, 82 U.S.P.Q.2d (BNA) 1385, 1397 (2007).

¹⁰³ *Id.* at 419, 82 U.S.P.Q.2d (BNA) at 1396-97.

"ordinary creativity of the PHOSITA," or market demand.¹⁰⁴ Combining the relaxed standard for non-obviousness with an overly broad claim scope makes it much more likely that claims will be rejected as obvious under § 103.¹⁰⁵ This Type II error, stemming from the BRI standard, cannot be corrected—it follows the patent application throughout the examination process.

Accordingly, the BRI standard creates an odd situation: a patent applicant must fight to have subject matter allowed that she will not be able to enforce in court. Referencing Figure 1, an inventor must prove that the gray area is patentable to get into the larger white circle, but will never be able to exclude others from practicing the gray area.¹⁰⁶

E. *The BRI Standard Forces Costly Amending of Patent Claims*

Additional policy positions in support of the BRI standard suggest that the standard does no real harm to the applicant because she can simply amend the claims in response to the interpretation and, in turn, achieve the interpretation she desires.¹⁰⁷ Amending claims, however, carries a recognizable cost that has a real impact on the inventor's rights and pocketbook, as well as on society in general.¹⁰⁸

¹⁰⁴ *Id.* at 419, 421, 82 U.S.P.Q.2d (BNA) at 1397. "PHOSITA" stands for person having ordinary skill in the art.

¹⁰⁵ See Daralyn J. Durie & Mark A. Lemley, *A Realistic Approach to the Obviousness of Inventions*, 50 WM. & MARY L. REV. 989, 991 (2008) ("The greater focus on the characteristics of individual cases suggests a need for evidence and factual determinations, but the legal and structural framework under which obviousness is tested means that it is difficult to make and review those determinations. The realistic approach is also incomplete, because the obviousness inquiry depends critically on the counterfactual assumption that the PHOSITA, while ordinarily skilled, is perfectly informed about the prior art.").

¹⁰⁶ Perhaps the inventor will be able to exclude others from practicing the subject matter contained within that gray area via the doctrine of equivalents (DOE). There is no linkage, however, between the subject matter captured by the DOE and that examined because of the BRI.

¹⁰⁷ See *supra* Part II.B.2.

¹⁰⁸ Professor Risch even argues that the BRI standard can lead to "a greater number of *unclear* amendments." See, Risch, *supra* note 4, at 195.

First, amendment, by definition, constricts the patentee's rights. Most amendments restrict the scope of equivalents afforded to a patent claim.¹⁰⁹ The doctrine of prosecution history estoppel, in most cases, causes amended claims to lose the possibility of obtaining any equivalents.¹¹⁰ If the BRI standard is meant to prompt amendment, then the standard forces applicants to forgo some equivalence protection.

Second, amendments go hand-in-hand with additional USPTO and attorney costs. Given the complexities of claim drafting, preparing amendments requires potentially significant amounts of costly attorney time.¹¹¹ Amendments also prompt additional negotiations with the USPTO and may be filed with a request for continued examination, which entails still more attorney time and additional filing fees.¹¹² Likewise, amendments can force a given round of prosecution to end immediately, allowing the examiner to issue a final office action.¹¹³

This result has special significance because of the pending continuation rules, which limit the ability to continue prosecution after final action.¹¹⁴ If the

¹⁰⁹ See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 736, 62 U.S.P.Q.2d (BNA) 1705, 1711-12 (2002) ("We agree with the Court of Appeals that a narrowing amendment made to satisfy any requirement of the Patent Act may give rise to an estoppel.").

¹¹⁰ See *id.* at 737, 62 U.S.P.Q.2d (BNA) at 1712.

¹¹¹ See, e.g., AIPLA, REPORT OF THE ECONOMIC SURVEY 2007 I-79 to I-80 (finding the average cost of a single argument or amendment to a patent application to be between \$1,920 and \$3,680, depending on the type and complexity of patent application). This cost is beyond the initial amount that is spent to prepare and file the original application, averaging \$7,012-12,393 or more. *Id.* at I-78.

¹¹² See 35 U.S.C. § 132(b) (2006); 37 C.F.R. § 1.17(e) (2008) (detailing the cost of filing a request for continued examination (RCE), currently at \$810 for someone other than a small entity); 37 C.F.R. § 1.114 (2008) (providing specifics for the RCE filing process).

¹¹³ See 35 U.S.C. § 132(a); 37 C.F.R. § 1.113 (2008) (indicating when an examiner can issue a final rejection).

¹¹⁴ See Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications, 72 Fed. Reg. 46,716-46,843 (Aug. 21, 2007) (to be codified at 37 C.F.R. pt. 1) [hereinafter Changes]. The validity of the rules is still in flux, with some aspects of the rules invalidated because they

rules come into force, the amendments eat into a patentee's opportunity to file continuations.¹¹⁵ Once the available continuations run out, the applicant no longer has an available measure to remedy the broadest interpretation, leaving the applicant with a claim meaning that does not reflect the same meaning a district court would have given the claim.¹¹⁶

Third, the requirement to amend also necessarily prolongs prosecution, generating more of a delay. This delay adds to the backlog at the USPTO, which has its own negative impact on patent quality.¹¹⁷ The delay also harms competitors who then have to wait longer for the patent's final issuance and the accompanying information as to what scope of exclusivity they must avoid.¹¹⁸

Fourth, the argument that an applicant must amend to clarify claim meaning ignores the import of statements made during prosecution regarding claim interpretation.¹¹⁹ There is no need to force the applicant to amend the patent claims. Statements as to claim term meaning may have equal force as amendments without causing some of the same negative consequences.¹²⁰ An

conflict with 35 U.S.C. § 120. See *Tafas v. Doll*, 559 F.3d 1345, 1364-65, 90 U.S.P.Q.2d (BNA) 1129, 1142-43 (Fed. Cir. 2009) (remanding the rule challenge to the district court), *vacated* 91 U.S.P.Q.2d 1153 (Fed. Cir. 2009) (granting a rehearing en banc).

¹¹⁵ See *Changes*, *supra* note 114.

¹¹⁶ See *supra* Part III.D.

¹¹⁷ See *Lichtman & Lemley*, *supra* note 57, at 46 (identifying the USPTO's resource problem affecting their effective reviewability of the growing number of applications).

¹¹⁸ Patents perform a disclosure function, allowing competitors to design around claimed subject matter. See *Craig Allen Nard, A Theory of Claim Interpretation*, 14 *HARV. J.L. & TECH.* 1, 40 (2000) ("As the term 'design-around' suggests, a competitor of the patentee may purposefully circumvent the boundaries of the patent claim and create a competitive, non-infringing alternative to the claimed invention.").

¹¹⁹ See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317, 75 U.S.P.Q.2d (BNA) 1321, 1329 (Fed. Cir. 2005) ("In addition to consulting the specification, we have held that a court 'should also consider the patent's prosecution history, if it is in evidence.'" (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980, 34 U.S.P.Q.2d (BNA) 1321, 1330 (Fed. Cir. 1995))).

¹²⁰ *Id.* Prosecution history statements can also limit equivalence. See *Conoco, Inc. v. Energy & Env'tl. Int'l, L.C.*, 460 F.3d 1349, 1363, 79 U.S.P.Q.2d (BNA) 1801, 1811 (Fed. Cir. 2006).

examiner can resolve any ambiguity simply by asking the applicant to clarify and then putting the response on the record.¹²¹ This course is preferable to broadly interpreting the claim and then forcing the applicant to respond with a costly amendment. Moreover, as previously argued, the BRI standard can actually have the opposite effect with regard to creating a prosecution history as to claim meaning.¹²² The BRI standard allows examiners to avoid discussions of claim meaning—particularly, discussions in the same terms as will take place in district court.¹²³

F. *The BRI Standard Is Fatally Ambiguous*

Finally, the case law provides little to no guidance on the contours of the BRI standard. It is difficult to find examples or additional verbiage in Federal Circuit case law that demonstrate how examiners are to implement the BRI standard. The Manual of Patent Examining Procedure's (MPEP) description of claim interpretation during prosecution contains no further instructions specific to employing the BRI.¹²⁴ The interpretation section, MPEP section 2111, begins by instructing examiners to give pending claims their "broadest reasonable interpretation."¹²⁵ The section goes on to provide no examples, no tests, and no direction to examiners on how to implement or employ this standard.¹²⁶ The rest of section 2111 then recites the same methodology used in district courts to interpret claims.¹²⁷

The case law regarding claim interpretation actually cited in the MPEP exemplifies general claim interpretation principles that apply during both prosecution and enforcement proceedings, but it does not elaborate on the

¹²¹ *Conoco*, 460 F.3d at 1364, 79 U.S.P.Q.2d (BNA) at 1812. To invoke argument-based estoppel, however, "the prosecution history must evince a 'clear and unmistakable surrender of subject matter.'" *Eagle Comtronics, Inc. v. Arrow Commc'n Labs., Inc.*, 305 F.3d 1303, 1316, 64 U.S.P.Q.2d (BNA) 1481, 1489 (Fed. Cir. 2002) (quoting *Pharmacia & Upjohn Co. v. Mylan Pharms., Inc.*, 170 F.3d 1373, 1377, 50 U.S.P.Q.2d (BNA) 1033, 1036 (Fed. Cir. 1999)).

¹²² *See supra* Part III.C.

¹²³ *Id.*

¹²⁴ *See* U.S. Patent and Trademark Office, MANUAL OF PATENT EXAMINING PROCEDURE § 2111 (2007).

¹²⁵ *Id.*

¹²⁶ *See id.*

¹²⁷ *See id.*

specifics of the BRI standard unique to the USPTO.¹²⁸ Other than the mantra "broadest reasonable interpretation," there is simply no articulation of how to accomplish this step other than that it should be consistent with the teachings in the specification.¹²⁹ Should the examiner first determine the correct interpretation of the claims and then slightly broaden this interpretation? How exactly is this accomplished and to what end?

Finally, the BRI standard has a troubling circularity. When does the examiner stop giving claims the BRI gloss? The case law seems to assume that once the claims are amended, everything becomes static. Under the letter of the law, however, it seems that even amended language needs to be given a BRI, which broadens the amended claims beyond their actual meaning.¹³⁰ Presumably, the applicant responds by amending again and the process never stops. Admittedly, in practice, the process of broad interpretation probably stops after an iteration or two. No authority officially indicates, however, when it should end; the door is open for multiple applications of the BRI standard to the same claim language, regardless of whether the applicant amends it.

IV. RECENT CASES EXEMPLIFYING THE PROBLEMS WITH THE BRI STANDARD

A. *In re Trans Texas Holdings Corp. – Lack of a Singular Definition of Invention and the Introduction of Horizontal Inequity*

The Federal Circuit's recent decision in *In re Trans Texas Holdings Corp.* exemplifies how application of the BRI standard results in different definitions of the same claim term by the USPTO and a district court.¹³¹ In *Trans Texas*, the district court gave the claims at issue a particular meaning, but the USPTO, during a reexamination that occurred after the district court's claim construction, gave the claims a different meaning based on the BRI standard, which the Federal Circuit then affirmed.¹³²

¹²⁸ See *id.*

¹²⁹ See *id.*

¹³⁰ See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 U.S.P.Q.2d (BNA) 1321, 1329 (Fed. Cir. 2005).

¹³¹ See 498 F.3d 1290, 1292, 83 U.S.P.Q.2d (BNA) 1835, 1836 (Fed. Cir. 2007).

¹³² See *id.*

The patent at issue in *Trans Texas* addressed a system of inflation-adjusted deposit and loan accounts.¹³³ In a pending patent litigation, the district court construed certain claims and, in due course, the parties to that litigation reached a settlement before trial.¹³⁴ The district court dismissed the case with prejudice.¹³⁵ After the district court had issued the claim construction order, the patent holder filed a request for reexamination of the patents at issue.¹³⁶ The USPTO granted the request and reexamination commenced.¹³⁷ During the reexamination, the applicant argued that the district court's claim interpretation bound the USPTO.¹³⁸ The USPTO, however, denied this request and, under its interpretation using the BRI standard, found certain claims invalid as obvious.¹³⁹

The applicant appealed the resulting rejection in the reexamination, arguing again that the USPTO must follow the district court's earlier claim interpretation.¹⁴⁰ The Federal Circuit did not agree, noting that the USPTO was not a party to the earlier action, so there was no issue preclusion as to the question of claim interpretation before the USPTO in the reexamination.¹⁴¹

The Federal Circuit then reviewed the USPTO's claim interpretation, focusing on whether the "[c]laims [were] given 'their broadest reasonable interpretation, consistent with the specification, in reexamination proceedings.'"¹⁴² Under this standard, the Federal Circuit agreed with the USPTO's interpretation even though it was broader than the district court's earlier interpretation of the same claims.¹⁴³

¹³³ *Id.*

¹³⁴ *Id.* at 1294-95, 83 U.S.P.Q.2d (BNA) at 1838.

¹³⁵ *Id.* at 1295, 83 U.S.P.Q.2d (BNA) at 1838.

¹³⁶ *Id.* at 1294, 83 U.S.P.Q.2d (BNA) at 1838.

¹³⁷ *Id.*

¹³⁸ *Id.*

¹³⁹ *Id.* at 1295, 83 U.S.P.Q.2d (BNA) at 1838.

¹⁴⁰ *Id.*, 83 U.S.P.Q.2d (BNA) at 1839.

¹⁴¹ *Id.* at 1297, 83 U.S.P.Q.2d (BNA) at 1840.

¹⁴² *Id.* at 1298, 83 U.S.P.Q.2d (BNA) at 1841 (quoting *In re Yamamoto*, 740 F.2d 1569, 1571, 222 U.S.P.Q. (BNA) 934, 936 (Fed. Cir. 1984)).

¹⁴³ *See id.* at 1299, 83 U.S.P.Q.2d (BNA) at 1841 (holding that the USPTO did not err by interpreting "responsive to the rate of inflation" as not limited to a

This differential created by the BRI—the district court giving the claims a different meaning than the USPTO—creates, in essence, two different inventions. Yet the application contains only one set of claims and, in turn, only singular inventions are at issue. The scope and definition of these inventions should not change between the venues. Application of the BRI standard allows for this inconsistency and even demands it in some cases, as demonstrated in *Trans Texas*. As noted earlier, such a result contradicts the patent statutes.¹⁴⁴

The result in *Trans Texas* also demonstrates the horizontal inequity introduced by the BRI standard.¹⁴⁵ The same claims have different meanings depending on the venue of the court interpreting them.¹⁴⁶ This inequity occurs even post-issuance, when claims are reexamined after district court litigation. This practice introduces uncertainty as to a claim's validity and, ultimately, enforceability, depending on which venue performs the claim interpretation. A patent claim may be valid in district court under normal interpretation methodology, but invalid upon a USPTO reexamination because of the BRI.¹⁴⁷

B. In re Graves – Improper Denial of Patent Protection

The Federal Circuit's decision in *In re Graves* provides a clear example of how the use of the BRI standard can cause the USPTO to deny improperly patent protection.¹⁴⁸ The court affirmed an anticipation rejection of claims that were

one-to-one relationship); *id.* at 1294, 83 U.S.P.Q.2d (BNA) at 1838 (noting the district court's interpretation of "responsive to the rate of inflation" as clearly imparting a one-to-one correlation).

¹⁴⁴ See *supra* Part III.A.

¹⁴⁵ See *supra* Part III.B.

¹⁴⁶ See *id.*

¹⁴⁷ This lack of horizontal equity presents a very interesting, and plausible, scenario. A patentee may successfully enforce a patent claim in district court, but the alleged infringer could pursue a reexamination and subsequently invalidate the patent claim when interpreted under the BRI—an analysis that the district court would never have performed under normal claim interpretation rules.

¹⁴⁸ See 69 F.3d 1147, 1152, 36 U.S.P.Q.2d (BNA) 1697, 1701 (Fed. Cir. 1995).

given their BRI.¹⁴⁹ The dissent in *Graves* pointed out that, under a narrower interpretation, the claims would have been allowable.¹⁵⁰

The invention at issue in *Graves* was a device and method for testing an electrical system for wire shorts.¹⁵¹ Three independent claims remained in the pending application when it was appealed to the Board, who then affirmed the rejection under § 102(b).¹⁵² On appeal to the Federal Circuit, these rejections were at issue and their validity hinged on the interpretation of the following claim element:

(b) simultaneously monitoring the selected multiple connection points or wires for presence of the test signal which is applied sequentially [sic] to each point on the interconnect of the system under test[.]¹⁵³

The examiner and the Board employed the BRI standard and found the limitation to mean that "the simultaneous monitoring of input and output points, but not necessarily the simultaneous monitoring of an input point and multiple output points."¹⁵⁴ A majority at the Federal Circuit agreed.¹⁵⁵ The court, staying true to the application of the BRI standard, found that this interpretation gave the claim element "as broad a reading as possible not inconsistent with the applicant's disclosure."¹⁵⁶

The dissent, authored by Judge Nies, offered a different, narrower construction of the limitation. The dissent found that "element (b) requires the simultaneous monitoring of each of multiple connection points or wires (i.e., each of multiple output points)."¹⁵⁷ Judge Nies came to this construction because, otherwise, "the word 'simultaneously' is rendered superfluous."¹⁵⁸ She then

¹⁴⁹ *Id.* at 1148-49, 36 U.S.P.Q.2d (BNA) at 1698.

¹⁵⁰ *See id.* at 1154, 36 U.S.P.Q.2d (BNA) at 1702 (Nies, J., dissenting).

¹⁵¹ *Id.* at 1149, 36 U.S.P.Q.2d (BNA) at 1698.

¹⁵² *Id.*

¹⁵³ *Id.* at 1151, 36 U.S.P.Q.2d (BNA) at 1700.

¹⁵⁴ *Id.* at 1152, 36 U.S.P.Q.2d (BNA) at 1701.

¹⁵⁵ *Id.*

¹⁵⁶ *Id.*

¹⁵⁷ *Id.*

¹⁵⁸ *Id.* at 1153, 36 U.S.P.Q.2d (BNA) at 1702 (Nies, J., dissenting).

noted that "[i]t is axiomatic that, in a continuity test of a wire, one must monitor the connection point at the same time the test signal is applied."¹⁵⁹ Judge Nies also pointed to parts of the specification that supported this narrower construction.¹⁶⁰ Under the narrower construction, the claims were not anticipated.¹⁶¹

The application of the BRI standard by the majority in *Graves* exemplifies the possibility that the use of the standard will deny patent protection for claims that, given their "normal" construction, are actually valid.¹⁶² The difference between the majority and the dissent's constructions is that the majority construes the claims more broadly, citing the BRI standard for support.¹⁶³ If the majority had not applied the BRI standard, they may have agreed with the dissent; and the claims would have survived scrutiny. Applying the BRI standard forced the majority to judge the validity of an invention with a broader claim scope, which captured subject matter that was not novel.¹⁶⁴ Referring back to Figure 1,¹⁶⁵ the anticipating reference in *Graves* fell within the gray area captured by only the BRI standard. Put another way, the decision in *Graves* was a Type II error—just the type of irreversible, erroneous rejection of an invention that the BRI standard invites.¹⁶⁶ Hence, the BRI standard has a direct link to the denial of patentability for claims that would be valid if scrutinized under the normal interpretation methodology employed in litigation.

This reading of *Graves* is open to critique. The majority in *Graves* did conclude, in the alternative, that the claims would have been anticipated even under the narrower interpretation of the dissent.¹⁶⁷ That is, the prior art actually fell within the white part of Figure 1 and, thus, would have anticipated the invention under both the BRI and the normal interpretation. If true, the BRI standard created harmless error. The dissent, however, contested the majority's

¹⁵⁹ *Id.*

¹⁶⁰ *Id.*

¹⁶¹ *Id.* at 1154, 36 U.S.P.Q.2d (BNA) at 1702 (Nies, J., dissenting).

¹⁶² *See supra* Part III.D.

¹⁶³ *See Graves*, 69 F.3d at 1152, 36 U.S.P.Q.2d (BNA) at 1701.

¹⁶⁴ *See id.*

¹⁶⁵ *See supra* Part III.D.

¹⁶⁶ *See id.*

¹⁶⁷ *Graves*, 69 F.3d at 1152, 36 U.S.P.Q.2d (BNA) at 1701.

conclusion.¹⁶⁸ Regardless of the situation in *Graves*, the fact that the BRI standard creates a harmless rejection of the pending claims in one case does not mean such BRI-prompted rejections are harmless in all cases. One also has to wonder if the majority made this alternative holding to take some of the sting out of the inequity of applying the BRI standard in this case. In other words, the BRI standard may force courts to articulate alternative justifications for their holdings because of the inequitable and unjustifiable harm the BRI standard imposes on applicants.

One may also read *Graves* as a case in which both the majority and dissent apply the same BRI standard but arrive at different conclusions. This may be true, but the majority's interpretation is a broader BRI than the dissent's.¹⁶⁹ The majority also made a point of citing BRI case law to support its interpretation.¹⁷⁰ Moreover, if *Graves* simply demonstrates an intra-circuit dispute as to the meaning of the BRI, then the inconsistent conclusions reached prove the final problem with the BRI standard—that it is hopelessly ambiguous.¹⁷¹ *In re Buszard*, described below, exemplifies this problem in more detail.¹⁷²

Graves, similar to *Trans Texas*, also exemplifies the BRI standard's unseemly ability to generate a different definition of an invention than normal claim interpretation.¹⁷³ The majority in *Graves*, taking the BRI approach, reached a different definition of the claim limitation at issue than the dissent, who took a narrower view of the limitation's meaning.¹⁷⁴

The difference between the majority's interpretation and the dissent's interpretation also shows the BRI standard's disruption to horizontal equity and certainty in patent law, which are goals of the Federal Circuit.¹⁷⁵ If this was an appeal from a district court decision, the absence of the BRI standard would

¹⁶⁸ *Id.* at 1153-54, 36 U.S.P.Q.2d (BNA) at 1702 (Nies, J., dissenting).

¹⁶⁹ *See id.* at 1152, 36 U.S.P.Q.2d (BNA) at 1701.

¹⁷⁰ *Id.*

¹⁷¹ *See supra* Part III.F.

¹⁷² *See* 504 F.3d 1364, 84 U.S.P.Q.2d (BNA) 1749 (Fed. Cir. 2007); *infra* Part IV.C.

¹⁷³ *See supra* Part III.D.

¹⁷⁴ *See supra* notes 162-68 and accompanying text.

¹⁷⁵ *See supra* Part III.B.

likely have put the majority and dissent on the same page as to claim meaning—the dissent's.

C. In re Buszard – Ambiguity in the BRI Standard

The Federal Circuit's recent decision in *In re Buszard* provides another good example of the ambiguity in the BRI standard and the uncertainty its application generates.¹⁷⁶ The factual situation in *Buszard* was very similar to that in *Graves*: the appropriateness of an anticipation rejection of pending claims hinged on whether the USPTO correctly interpreted the claims at issue.¹⁷⁷ In *Buszard*, the majority and dissent were both more explicit about using the BRI standard, although the dissent claimed the majority did not correctly apply the standard in its review of the USPTO's interpretation.¹⁷⁸

The technology at issue in *Buszard* was a flame retardant composition that contained flexible polyurethane foam.¹⁷⁹ The claim term at issue was a "flexible polyurethane foam reaction mixture."¹⁸⁰ The prior art disclosed a rigid polyurethane foam that, when crushed, loses its rigidity because it breaks up into small particles.¹⁸¹ The USPTO interpreted the claim term "flexible polyurethane foam" to include the earlier disclosed rigid foam because the claim term included "any reaction mixture which produces, at least ultimately, a flexible polyurethane foam."¹⁸²

The applicant argued that those skilled in the art know that "a flexible polyurethane foam reaction mixture is different from a rigid polyurethane foam reaction mixture" and thus the claim term was not anticipated.¹⁸³ At oral argument before the Federal Circuit, the USPTO agreed that one skilled in the art knows that flexible polyurethane foams have a different chemical structure and produce different chemical reactants than rigid foams.¹⁸⁴ Regardless, the USPTO

¹⁷⁶ See 504 F.3d at 1364, 84 U.S.P.Q.2d (BNA) at 1749.

¹⁷⁷ *Id.* at 1366, 84 U.S.P.Q.2d (BNA) at 1750.

¹⁷⁸ *Id.* at 1369, 84 U.S.P.Q.2d (BNA) at 1752 (Prost, J., dissenting).

¹⁷⁹ *Id.* at 1365-66, 84 U.S.P.Q.2d (BNA) at 1749-50.

¹⁸⁰ *Id.* at 1366, 84 U.S.P.Q.2d (BNA) at 1750 (internal quotations omitted).

¹⁸¹ *Id.*

¹⁸² *Id.*

¹⁸³ *Id.* at 1367, 84 U.S.P.Q.2d (BNA) at 1751.

¹⁸⁴ *Id.*

argued that the claims encompassed rigid foams when the BRI standard was properly applied.¹⁸⁵

The majority agreed with the applicant's argument that the claims cannot encompass rigid foam because the claims and specification "specifically state the requirement of a flexible polyurethane foam reaction mixture."¹⁸⁶ Trying to stay true to the BRI standard, the majority concluded that, although the USPTO's interpretation was broad, it was not "reasonable," and thus they reversed the USPTO's rejection.¹⁸⁷

The dissent, however, asserted that the majority failed to properly apply the BRI standard.¹⁸⁸ Under the dissent's application of the BRI standard, in absence of an explicit definition of "flexible polyurethane foam" in the specification, the term must be given its broadest interpretation.¹⁸⁹ The dissent concluded that the USPTO's interpretation met the standard—it was "broad," and it was also not unreasonable.¹⁹⁰ This interpretation would have rendered the claims invalid.¹⁹¹ The dissent pointed out in its conclusion that if the applicant "seeks a specific claim interpretation, he should amend his claim so it conveys his intended meaning."¹⁹²

The disagreement between the majority and dissent in *Buszard* exemplifies the last problem with the BRI standard: the ambiguity of the standard and the uncertainty it produces. Both the majority and the dissent cited the same BRI standard; and they both looked at the claim language and the specification, yet they came up with different claim interpretations.¹⁹³ Unlike in *Graves*, the majority and dissent applied the same BRI standard.¹⁹⁴ They

¹⁸⁵ *Id.*

¹⁸⁶ *Id.*

¹⁸⁷ *Id.*

¹⁸⁸ *Id.* at 1368, 84 U.S.P.Q.2d (BNA) at 1751 (Prost, J., dissenting).

¹⁸⁹ *Id.* (Prost, J., dissenting).

¹⁹⁰ *Id.* at 1369, 84 U.S.P.Q.2d (BNA) at 1752 (Prost, J., dissenting).

¹⁹¹ *Id.* (Prost, J., dissenting).

¹⁹² *Id.* at 1370-71, 84 U.S.P.Q.2d (BNA) at 1754 (Prost, J., dissenting).

¹⁹³ Compare *id.* at 1367, 84 U.S.P.Q.2d (BNA) at 1751, with *id.* at 1370, 84 U.S.P.Q.2d (BNA) at 1753 (Prost, J., dissenting).

¹⁹⁴ *Id.* at 1367, 84 U.S.P.Q.2d (BNA) at 1751.

nonetheless reached different results due to a difference of opinion as to whether the USPTO's interpretation was "reasonable."¹⁹⁵

The BRI standard creates this additional battleground in the interpretation process—even after the intrinsic and extrinsic evidence is evaluated, there can still be a dispute over the reasonableness of the resulting interpretation. The lack of any metric that defines what is reasonable in this situation causes the majority and dissent to point fingers, using such imprecise phrases as "not reasonable"¹⁹⁶ or "not unreasonable."¹⁹⁷ The BRI standard is not robust enough to contribute to the discussion; it only increases disagreement among judges, examiners, and other observers.

One could read *Buszard* as a case simply about a failure of the majority to apply the BRI standard at all, as opposed to one about the uncertainty in applying the BRI standard. The dissent certainly made this claim, stating that the "majority's opinion pays lip service to this precedent," the BRI standard, "[but] does not apply it in this case."¹⁹⁸ If so, then *Buszard* is like *Graves*, providing another example of how the BRI standard can improperly deny patent protection to a pending claim. The majority may have had to go out of its way to pay lip service to, but ultimately avoid, the BRI standard—in contradiction of case law—to allow the claims. Put another way, the claims are patentable under normal claim interpretation methodology, but become invalid when broadened. Although the result was not disastrous in *Buszard*—the applicant got her patent just as she presumably would have under the narrower "normal" standard—the dissent contends that the USPTO should have denied the patent if it had correctly applied the BRI standard.¹⁹⁹ *Buszard* is another example of how the BRI standard can lead to denial of patent protection on a claim that would be allowable in district court. Specifically, if one more judge had agreed with the dissent's conclusion to deny patent protection in this case, it would have created a Type II error.²⁰⁰

¹⁹⁵ Compare *id.* at 1367, 84 U.S.P.Q.2d (BNA) at 1751, with *id.* at 1370, 84 U.S.P.Q.2d (BNA) at 1753 (Prost, J., dissenting).

¹⁹⁶ *Id.* at 1367, 84 U.S.P.Q.2d (BNA) at 1751.

¹⁹⁷ *Id.* at 1369, 84 U.S.P.Q.2d (BNA) at 1752 (Prost, J., dissenting).

¹⁹⁸ *Id.* (Prost, J., dissenting).

¹⁹⁹ *Id.* at 1370, 84 U.S.P.Q.2d (BNA) at 1753 (Prost, J., dissenting).

²⁰⁰ See *supra* text accompanying notes 95-105.

If the dissent is correct in that *Buszard* is a case about the majority failing to apply the BRI standard, then the case also demonstrates how the standard generates different meanings of the invention.²⁰¹ The BRI standard changes the way an interpreter looks at intrinsic evidence such as the claim and the specification. It forces the examiner to give the claim language a broad meaning, even if, as the USPTO admitted in the case, the meaning is not the one given to the term by those skilled in the art.²⁰² The claims then have a meaning that is different from the one a district court would give them. In the same vein, there is no equitable treatment of the claims between the USPTO and in district court.

V. CONCLUSION

The BRI standard has probably lasted this long because its propriety has not been closely questioned. Scrutiny leads to the conclusion that there is simply no justification for the "broadest reasonable interpretation" standard. In fact, the standard has the potential to do significant harm. The BRI standard is a judicial construction created by the CCPA and currently used by the Federal Circuit. The Federal Circuit should stop using the standard and officially adopt a unitary approach to claim interpretation, regardless of forum. Appeals from cases such as the recent Board opinion in *Miyazaki* provide a great vehicle for making such a change.

²⁰¹ See *supra* Part II.A.

²⁰² *Buszard*, 503 F.3d at 1367, 84 U.S.P.Q.2d (BNA) at 1751.

