

Just Because the Patent Office Understood a Claim Term Does Not Mean that a Court Will: The Different Claim Construction Standards between the Patent Office and U.S. Courts Post-*Nautilus*

By: Raymond K. Chan | 858.720.6339 | raymond.chan@procopio.com

Section 112 of the U.S. Patent Act imposes a “definiteness” requirement on patent claims. The requirement pertains to the construction or interpretation of patent claims. To meet this requirement, a patent claim must “particularly” point out and “distinctly” claim the subject matter which the inventor regards as his invention. The U.S. Supreme Court recently made this requirement more stringent in its *Nautilus* decision, holding that a patent claim must inform one of ordinary skill in the art about the scope of the invention with “reasonable certainty” when read in light of the patent specification and its prosecution history. This heightened definiteness requirement is at odds with how patent claims are traditionally interpreted by the U.S. Patent & Trademark Office (“PTO”). Thus, a patent claim issued by the PTO would not necessarily meet this heightened requirement if its construction is later disputed in litigation.

A recent claim construction (also known as “Markman”) order issued by a District Court in Florida illustrates the discrepancy between the traditional “broadest reasonable interpretation” applied by the PTO and the U.S. Supreme Court’s new definiteness requirement. In *Atlas IP, Inc. v. St. Jude Medical, Inc.*,¹ the following claim limitation was at issue:

the hub allocating a number of transmission opportunities [N_{TXOP}] during at least one communication cycle which is at least one less in number than the number of remotes in the Group [N_{Remote}].

The parties offered different constructions of this claim limitation. Their dispute centered on how to deconstruct the phrase “at least one less in number than the number of remotes in the Group.” Their respective constructions are as follows:

Party	Argument	Construction
Atlas	“at least” applies to “one less in number than the number of remotes in the Group”	$N_{TXOP} \geq N_{Remote} - 1$
St. Jude	“at least one less in number than” applies to “the number of remotes in the Group”	$N_{TXOP} \leq N_{Remote} - 1$

Citing the Supreme Court’s *Nautilus* decision, the District Court held that this claim limitation is indefinite because neither

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¹ 2014 WL 3764129 (July 30, 2014).

construction was more or less faithful to the language of the patent. In other words, both constructions were consistent with the patent specification in the Court's view.

Let us suppose that the interpretation of the same claim limitation was at issue during prosecution before the PTO. There, pending patent claims are given "their broadest reasonable interpretation consistent with the specification."² This traditional standard is applied to reduce the possibility of construing the claims more broadly after allowance to capture claim scope not considered during prosecution. Under the "broadest reasonable interpretation" standard, if there was any ambiguity (during prosecution) regarding the number of transmission opportunities contemplated by this limitation, the PTO would have applied Atlas' construction because it results in a broader range of the number of transmission opportunities (N_{TXOP}). The "broadest reasonable interpretation" standard therefore provides a tiebreaker rule for situations where two possible claim constructions are both consistent with the patent specification.

By requiring the meaning of patent claims to be "reasonably certain" in view of the specification, the Supreme Court eliminated the tiebreaker provided by the "broadest reasonable interpretation" standard. Without the benefit of the tiebreaker, Atlas argued that its construction was superior to St. Jude's because the latter did not account for the situation where there is only a single remote ($N_{Remote} = 1$). In that situation, the number of transmission opportunities would be zero ($N_{TXOP} = 0$) under St. Jude's construction, which did not make sense. However, the District Court discounted this argument, stating that the patent "never explicitly discusses such a situation." Evidently, the Court interpreted the "reasonable certainty" standard in *Nautilus* to require the patent to provide explicit support for the interpretation of its claim terms.

Thus, even if the PTO understood a patent claim term during prosecution, it does not necessarily mean that a court will also be able to interpret the claim term when its construction is disputed in litigation. Atlas would likely have avoided the Court's finding of indefiniteness if its patent had conclusively described the relationship between the number of remotes (N_{Remote}) and number of transmission opportunities (N_{TXOP}) in a communication cycle. However, nothing in the patent specification describes N_{TXOP} having to be at least one greater *or* less than N_{Remote} .

It remains to be seen whether other district courts (or the Federal Circuit) will similarly interpret the new Supreme Court "reasonable certainty" standard in *Nautilus* for "definiteness" to require a patent specification to provide explicit support for a definite construction of its claim terms. Since patent claims must be construed from the perspective of one of ordinary skill in the art, whose familiarity with the art should provide a "reasonably certain" understanding of claim terms in many cases, a strict requirement of explicit support in every case seems excessive. Nonetheless, in view of the *Atlas* decision, a patentee should strive to explicitly support its desired construction of claim terms in its patent, especially for any claim term that could be subject to multiple constructions that are consistent with the patent specification. While this may result in a narrower claim scope, it will improve the enforceability of the patent.

Raymond Chan is an experienced patent litigator and a registered patent attorney admitted to practice before the USPTO. He has represented clients from the automotive, biotechnology, chemical engineering, computer and consumer products industries. Raymond previously served as the in house counsel for a leading automotive aftermarket part and accessory distributor, where he managed design patent and trade dress litigation against its competitors. His recent matters include the successful assertion of patents on flame retardant polyester artificial hair fibers in litigation on behalf of a global chemical products company against its competitor.

² See Manual of Patent Examining Procedure ("MPEP"), § 2111.