“Broadest Reasonable Interpretation” and Appellate Review

Jason Rantanen¹

INTRODUCTION

One of the most significant issues in patent law today is the United States Court of Appeals’ approach to the “broadest reasonable interpretation” standard for construing patent claims. Although the Patent Office has employed the broadest reasonable interpretation (or “BRI” as it is affectionately known) standard in examining patent claims for decades, appellate decisions reviewing the Patent Office’s use of BRI did not occur with much frequency prior to the passage of the America Invents Act in 2011.² Since 2011, however, the BRI standard has become radically more significant in the last few years due to the host of inter partes review proceedings following in the wake of the America Invents Act.³ And to the extent there were any questions about its continued use, in June 2016 the Supreme Court resoundingly rejected a challenge to the BRI standard in *Cuozzo v. Lee*.⁴

The recent explosion of appeals from inter partes reviews has produced a renewed focus on the meaning of broadest reasonable interpretation. After all, it has long been believed by those involved with patent law that challenges to claim construction present the best vehicle for reversing district court decisions on appeal.⁵ Logic suggests that this may be true in appeals in inter partes review

¹ Professor of Law, University of Iowa College of Law. Thanks to Christopher Cotropia and Jonas Anderson for helpful discussions while working on this draft, as well to my research assistant, Peter Kline.

² A Westlaw search conducted for “broadest reasonable interpretation” returned 85 written Federal Circuit opinions containing that term between 1982 and September 16, 2011 (the day the America Invents Act became law)—about three per year. As a comparison, during the period 2000-2011, there were over a thousand cases involving claim construction appeals arising from the district courts. See J. Jonas Anderson & Peter M. Menell, *Informal Deference*, 108 Northwestern L. Rev. 1, 35 (2013) (reporting an empirical study of claim construction with a dataset of 1067 cases decided between 1/1/2000 and 12/31/2011), of which about 25% were summary affirmances under Rule 36, *id.* at 55, (which would not be captured by a simple Westlaw keyword search).

³ Indeed, in the last year (as of the date the search described in note 2 was conducted, July 25, 2016) alone, the Federal Circuit issued 25 such written opinions.

⁴ *Cuozzo Speed Techs., LLC v. Lee*, 136 S.Ct. 2131 (2016).

⁵ See *Lighting Ballast Control LLC v. Philips Electronics North America*, 744 F.3d 1272, 1313 (Fed. Cir. 2014) (en banc) (Judge O’Malley in dissent, describing the incentives created for losing parties to appeal under the *Cybor* completely de novo review standard for claim construction). Although the Supreme Court’s decision in *Teva v. Sandoz*, 135 S.Ct. 831 (2015), instructed the Federal Circuit to apply a deferential standard when reviewing findings made by district judges with respect to extrinsic evidence, it left intact the court’s de novo review of the vast majority of claim construction decisions. See Jason Rantanen,

proceedings as well. These new appeals bring additional uncertainty because the specifics of the Federal Circuit's review of the BRI are not as well defined as, say, claim constructions arising from the district courts.⁶

In this essay, I examine the meaning of "broadest reasonable interpretation" along two dimensions: how it affects the Federal Circuit's review of Patent Office claim constructions and what it means in substantive terms. Central to both is the term "reasonable." How should that term be understood? Does it mean that the Federal Circuit grants deference to the Patent Office when reviewing its constructions, as some commentators describe and some opinions suggest?⁷ And, perhaps more importantly, what is a "broadest reasonable interpretation" and how does that fit into the process of claim construction generally?

Here, I argue that regardless of one's view on the historical nature of judicial review of Patent Office claim interpretation, any deference is inconsistent with the Federal Circuit's use of a *de novo* standard when reviewing claim interpretations by the Patent Office (with the exception of findings of fact relating to extrinsic evidence). Second, I argue that the still-developing jurisprudence at the Federal Circuit is coalescing around a meaning of "broadest reasonable interpretation" that allows for the existence of multiple ordinary meanings and reads the intrinsic evidence with a certain degree of "looseness," but which is still hesitant to embrace ambiguity within the application of the tools of claim construction.

I. BACKGROUND ON BROADEST REASONABLE INTERPRETATION

"Broadest reasonable interpretation" or "BRI" is the standard applied by the Patent Office when interpreting the claims of unexpired patents.⁸ The Patent Office uses BRI both when examining patent applications for compliance with the requirements of patentability and in post-issuance proceedings.⁹ A particularly important subset of the latter are inter partes reviews: post-issuance proceedings

Teva, Nautilus, and Change Without Change, 18 STAN. TECH. L. REV. 430 (2015) (describing the effect of *Teva v. Sandoz*).

⁶ See, e.g., Joel Miller, *Claim Construction at the PTO—the "Broadest Reasonable Interpretation,"* 88 J. PAT. & TRADEMARK OFF. SOC. 279, 281 (2006) (commenting that "[a]n understanding of 'reasonable' is elusive, as none of the cases reviewed for this article define this term or provide any objective parameters for determining reasonableness."); *Flo Healthcare Solutions, LLC v. Kappos*, 697 F.3d 1367, 1376–78 (Fed. Cir. 2012) (Plager, J. additional views describing multiple different approaches to BRI at the Federal Circuit).

⁷ Dawn-Marie Bey & Christopher A. Cotropia, *The Unreasonableness Of The Patent Office's "Broadest Reasonable Interpretation" Standard*, 37 AIPLA Q. J. 285, 290–91 ("Under this 'reasonableness' standard of review, the Federal Circuit gives the USPTO's interpretations under the BRI standard deference."), *citing* *In re Morris*, 127 F.3d 1048 (1997).

⁸ *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1275 (Fed. Cir. 2015).

⁹ *Id.*

between a patent owner and a party who is challenging the validity of the patent.¹⁰ Inter partes review proceedings, created by the 2011 America Invents Act, are wildly popular among patent challengers with approximately 1500 filed per year.¹¹ In *Cuozzo v. Lee*, the Supreme Court affirmed the Patent Office's use of broadest reasonable interpretation approach during inter partes review proceedings as within the scope of the agency's authority.¹²

Conceptually, "broadest reasonable interpretation" is simple—so much so, that in many pre-2011 appeals, precision in the standard was not really necessary. Certainly the Supreme Court did not evince any difficulty with the concept in *Cuozzo*. When examining claims, the patent office uses the "broadest reasonable construction in light of the specification of the patent in which it appears."¹³ As long as the construction is a reasonable one, the Patent Office may use it.

The difficulty lies not in the conceptual understanding of broadest reasonable interpretation, but in how it actually operates within the substantive and procedural framework of patent law. In practice, BRI is conventionally understood to involve two components. The first relates to the meaning of the claim term and how that meaning is arrived at. In contrast with district court proceedings, where claim terms are given their ordinary and customary meaning to a person of ordinary skill in art who reads the term in the context of the entire patent, "[t]he Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.'"¹⁴ "Broadest reasonable interpretation" thus implies that the scope of the claim is potentially broader than a district court might arrive at.¹⁵

The second component of "broadest reasonable interpretation" relates to the degree of review applied by the Federal Circuit to the Patent Office's claim interpretations. In their 2009 article *The Unreasonableness of the Patent Office's "Broadest Reasonable Interpretation Standard"*, Dawn-Marie Bey and Christopher A. Cotropia described the Federal Circuit as applying a deferential standard when reviewing Patent Office interpretations under BRI,¹⁶ a view recognized as valid by a

¹⁰ *Cuozzo Speed Techs., LLC*, 136 S.Ct. at 2136.

¹¹ See <http://www.uspto.gov/patents-application-process/appealing-patent-decisions/statistics/aia-trial-statistics>.

¹² *Cuozzo Speed Techs., LLC*, 136 S.Ct. at 2142.

¹³ 37 C.F.R. § 42.110(b).

¹⁴ See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 1316 (Fed. Cir. 2005) (en banc); see also *Morris*, 127 F.3d 1048; MANUAL OF PATENT EXAMINING PROCEDURE at § 2111.

¹⁵ See Bey & Cotropia, *supra* note 7, at 303 (visually illustrating this concept).

¹⁶ Bey & Cotropia, *supra* note 7, at 290-91 (citing *In re Morris*).

least one Federal Circuit judge as late as 2012.¹⁷ In contrast, district court constructions were, and largely continue to be, reviewed without any deference.¹⁸

II. “REASONABLE” AND DEFERENCE TO THE PATENT OFFICE

Before coming to the question of what “broadest reasonable interpretation” means in substance—that is, what a claim construed under the BRI standard looks like as compared to a claim construed under the district court standard—it is first necessary to address the standard of review. After all, there is support for the view that the Federal Circuit applies a deferential standard of review to Patent Office interpretations.¹⁹ If this is so, then imposition of deference will necessarily affect how BRI is understood in substantive terms and will grant the Patent Office a degree of flexibility should it depart from the Federal Circuit’s interpretation.

At first look, the most appealing way to think about “reasonable” in the context of “broadest reasonable interpretation” seems to be that it requires the Federal Circuit to give deference to the Patent Office’s interpretation of a claim term—akin to some form of deference to an administrative agency.²⁰ The Patent Office simply needs to pick a reasonable interpretation of the claims and the Federal Circuit will not substitute its own judgment for that of the agency.

This view of “reasonable” has some support in the language of the Federal Circuit’s opinions reviewing Patent Office claim interpretations. In *Dell v. Accelleron*, for example, the court stated that “we conclude the Board’s construction of claim 20 is unreasonable.”²¹ A plausible reading of this language, even in context, is that the focus is on the reasonableness of the Board’s decision itself. It logically follows, then, that as long as the Patent Office’s interpretation is “reasonable,” it must be affirmed.

¹⁷ *Flo Healthcare Solutions, LLC v. Kappos*, 697 F.3d 1367, 1376–78 (Fed. Cir. 2012) (Plager, J., additional views discussing historic practice of deference to PTO in review of claim interpretations).

¹⁸ *See Teva*, 135 S.Ct. at 837. (extrinsic evidence reviewed with deference but intrinsic evidence and ultimate determination of claim meaning reviewed with no deference); *see also* Rantanen, *supra* note 5.

¹⁹ *See* Bey & Cotropia, *supra* note 7; *Flo Healthcare Solutions*, 697 F.3d at 1376–78 (Plager, J., additional views discussing historic practice of deference to PTO in review of claim interpretations); *but see id.* at 1382–83 (Newman, J., additional views arguing that deference to the PTO on claim construction is incorrect.); Michael Risch, *The Failure of Public Notice in Patent Prosecution*, 21 HARV. J. L. & TECH. 179, 184 (2007) (stating that “[b]oth the BPAI and Federal Circuit review claim construction de novo, considering the broadest reasonable construction of the claims without deference to the factual findings of the patent examiner.”).

²⁰ *See Flo Healthcare Solutions*, 697 F.3d at 1376–78 (Fed. Cir. 2012).

²¹ *Dell Inc. v. Accelleron, LLC*, 818 F.3d 1293, 1300 (Fed. Cir. 2016); *c.f. id.* (“It is unreasonable to deny effect to the “remotely poll” language, which naturally indicates that the microcontroller module is actually configured to communicate in that way.”).

Although not without controversy, that approach has precedential legs. In his Additional Views to *Flo Healthcare Solutions v. Kappos*, Judge Plager described this approach to “reasonable” as connoting a “deferential standard.”²² He further observed that “[t]his deferential ‘is the Board’s decision reasonable’ standard for review of Board claim constructions, pronounced in *Morris*, has been followed by a number of Federal Circuit cases since then, including one as recent as 2010.”²³ Although Judge Plager recognized that the deferential standard was not the only one used by the Federal Circuit²⁴ and Judge Newman disagreed as to the existence of a deferential standard of review in her own Additional Views,²⁵ the *Morris* approach—that the Federal Circuit reviews the Patent Office’s interpretation for reasonableness—has been referenced in recent decisions.²⁶

The view that the Federal Circuit must or should defer to the Patent Office on claim construction is wrong—or at least, to the extent it is correct, it would require a radical revision of current Federal Circuit standards of review.²⁷ In any event, the Federal Circuit is not simply reviewing the reasonableness of the Patent Office’s decision—it is reviewing whether the interpretation is the *broadest* reasonable interpretation.

The first problem with viewing “reasonable” involving deference to the Patent Office is that there is already a standard of review that the Federal Circuit applies when reviewing claim constructions, including those of the Patent Office. In *Teva v. Sandoz*, the Supreme Court addressed the standard of review for claim construction in appeals arising from the district courts: “[w]hen reviewing a district court’s resolution of subsidiary factual matters made in the course of its construction of a patent claim, the Federal Circuit must apply a “clear error,” not a de novo, standard of review.”²⁸ On the other hand, “when the district court reviews

²² *Flo Healthcare Solutions*, 697 F.3d at 1377.

²³ *Id.* (citing *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1259 (Fed. Cir. 2010)). Judge Plager saw his opinion in *Morris*, 127 F.3d 1048, as having perhaps created the deferential review. *Flo Healthcare Solutions, LLC*, 697 F.3d at 1378 (“*Morris*, as one of the first of these cases to pronounce on this issue with its “reasonableness” standard....”).

²⁴ *Id.* at 1378 (“The consequence of all this is that we now appear to have two contradictory lines of authority on the question of how this court reviews Board claim constructions—a deferential “reasonable” (arbitrary/capricious-type) review, and a no-deference “pure” law type review.”).

²⁵ *Id.* at 1382–83.

²⁶ See *Acme Scale Co. v. LTS Scale Co.*, 615 Fed. Appx. 673, 678 (Fed. Cir. 2015) (nonprecedential) (“Thus, this court reviews the Board’s interpretation of disputed claim language to determine whether it is ‘reasonable’”).

²⁷ In this Essay, I don’t take a position on the pre-*Teva* “correctness” of *Morris*, other than to note that Judge Newman raises some important points in her Additional Views to *Flo Healthcare*. *Flo Healthcare Solutions*, 697 F.3d at 1382–83 (Newman, J., additional views arguing that deference to the PTO on claim construction is incorrect).

²⁸ *Teva*, 135 S.Ct. at 833.

only evidence intrinsic to the patent (the patent claims and specifications, along with the patent's prosecution history), the judge's determination will amount solely to a determination of law, and the Court of Appeals will review that construction *de novo*."²⁹ In addition, the Federal Circuit "can still review the district court's ultimate construction of the claim *de novo*."³⁰

The Federal Circuit has embraced these instructions in numerous decisions reviewing Patent Office claim interpretations since *Teva v. Sandoz*.³¹ The typical language in its standard of review sections in appeals of inter partes review proceedings reads something like:

"The ultimate construction of the claim is a legal question and, therefore, is reviewed *de novo*....Further, claim construction based solely upon intrinsic evidence—meaning the patent claims, the patent specification, and the prosecution history—is a matter of law reviewed *de novo*...On the other hand, when extrinsic evidence is relied upon, we review the Board's "underlying factual determinations involving extrinsic evidence for substantial evidence."³²

The primary authority cited for this standard is *Teva v. Sandoz*.³³ The court's opinion in *Prolitec v. Scenari* offers another example, stating that "[w]e review the Board's ultimate claim constructions *de novo* and its underlying factual determinations involving extrinsic evidence for substantial evidence."³⁴ Similarly, in

²⁹ *Id.* at 841.

³⁰ *Id.* at 841.

³¹ See, e.g., *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1297 (Fed. Cir. 2015) ("because the intrinsic record fully determines the proper construction, we review the Board's claim constructions *de novo*."); but see Alana Canfield Mannige, *The Standard of Review for Claim Construction in Inter Partes Review*, 8 HASTINGS SCI. & TECH. L. J. 157 (arguing that under principles of administrative law, the Federal Circuit must give deference to the Patent Office's interpretation even when reviewing intrinsic evidence or the ultimate question of claim construction). As the point made above is simply descriptive of what the Federal Circuit is doing, I am not commenting here on Mannige's argument that the Federal Circuit's application of *Teva* to claim construction in IPRs is inappropriate. Instead, I am simply observing that the Federal Circuit has embraced the *Teva* standard of review in appeals from Board decisions.

³² *SAS Institute, Inc. v. ComplementSoft, LLC*, -- F.3d ---, *3 (Fed. Cir. June 10, 2016) (internal citations and quotation marks omitted).

³³ *Id.* A sharp-eyed reader might immediately notice a divergence between this standard and that stated in *Teva*: in *Teva*, extrinsic evidence is reviewed under the "clear error" standard, whereas in the court's articulation when reviewing the Patent Office, it is reviewed under a "substantial evidence" standard. The reason is that in *Dickinson v. Zurko*, 527 U.S. 150, 154 (1999), the Supreme Court held that the Federal Circuit must apply the Administrative Procedure Act's "substantial evidence" standard when reviewing Patent Office factfinding.

³⁴ *Prolitec, Inc. v. Scenari*, 807 F.3d 1353, 1358 (Fed. Cir. 2015).

Pride Mobility v. Permobil, the court observed that “[s]uch de novo review accords with the de novo review of ordinary judicial claim construction where, as here, no facts are in dispute.”³⁵

Granting the Patent Office deference to its interpretation and at the same time reviewing the Patent Office’s determination without deference is directly contradictory. To the extent the Federal Circuit ever gave formal deference to the Patent Office on its interpretations, that deference is contradicted by the avowed use of a *de novo* standard of review for most aspects of claim interpretations by the Patent Office.

In addition, deference implies that the Patent Office has a choice among different permissible interpretations. But the Patent Office most definitely does *not* have a choice. The rule requires it to apply the *broadest* reasonable interpretation, not a reasonable interpretation of its choosing.³⁶

Historically, this distinction may not have mattered much because the prototypical appeal of the Patent Office’s interpretation challenged the interpretation on the ground that it was too broad, not too narrow. A patent applicant whose claims were denied by the examiner under a construction that the applicant thought was too broad would appeal.³⁷ The Patent Office, on the other hand, never appealed because there was nothing *to* appeal: it was the examiner’s construction, after all.³⁸ In these appeals, the Federal Circuit would not need to address whether the Patent Office’s construction was the *broadest* reasonable construction—that question was irrelevant. Instead, the question would be whether the allegedly invalidating construction used by the Patent Office was reasonable.

The America Invents Act changed all that through the creation of inter partes review.³⁹ In these proceedings, there is inevitably a winner and a loser, one of whom will almost inevitably appeal. While most final trial outcomes have resulted in unfavorable rulings for the patent owner, a substantial (and perhaps growing) number have gone against the patent challenger.⁴⁰ Appeals in these cases are filed by patent challengers who argue that the Patent Office failed to apply the *broadest* reasonable interpretation. These cases turn on whether the *challenger’s* proposed

³⁵ *Pride Mobility Prods. Corp. v. Permobil, Inc.*, 818 F.3d 1307, 1313 (Fed. Cir. 2016).

³⁶ 37 C.F.R. § 42.110(b).

³⁷ See, e.g., *Morris*, 127 F.3d at 1055-56 (reviewing meaning of term “integrally formed as a portion of a selected area of the support member.”).

³⁸ See Jonathan Masur, *Patent Inflation*, YALE LAW JOURNAL 470, 474 (2011) (describing the asymmetric nature of appeals arising from the Patent Office). The exception would be appeals in interferences and, since 2001, inter partes reexamination proceedings.

³⁹ For a discussion of the inter partes review proceeding, see Brian J. Love and Shawn Ambwani, *Inter Partes Review: An Early Look at the Numbers*, 81 U. CHI. L. REV. DIALOGUE 93 (2014).

⁴⁰ See Jason Rantanen, *Inter Partes Review Statistics*, [WWW.PATENTLYO.COM](http://www.patentlyo.com/patent/2016/07/partes-review-statistics.html) (<http://patentlyo.com/patent/2016/07/partes-review-statistics.html>) (July 28, 2016).

construction is reasonable or not, not whether the Patent Office's construction is reasonable.⁴¹ If the challenger's proposed construction is reasonable, the Patent Office would logically not have the option of declining to use it. Seen in this way, "broadest reasonable interpretation" does not convey deference to the Patent Office so much as constitute a standard that the Patent Office itself must apply—or be reversed.

The idea that "reasonable" in "broadest reasonable interpretation" involves some form of deference to the Patent Office's interpretation is thus difficult to reconcile with both the current stated standard of review and the requirement of a *broadest* reasonable interpretation. Of course, the Federal Circuit might seek to revisit its longstanding approach of not reviewing determinations of law made by the Patent Office without deference.⁴² Unless and until then, though, the court should take care in its opinions to avoid language that incorrectly suggests that it is giving deference to the Patent Office on anything other than findings of fact involving extrinsic evidence.

III. "BROADEST REASONABLE INTERPRETATION" AS A CLAIM CONSTRUCTION

If "reasonable" does not mean that the Federal Circuit must apply deference to the Patent Office's interpretation of intrinsic evidence and application of the principles of claim construction, then what *does* "broadest reasonable interpretation" mean? In other words, how does a claim construed under the "broadest reasonable interpretation" standard differ from one construed under the approach used in infringement proceedings in the district courts?⁴³

As a starting point, it is well-accepted that "reasonable" imposes some limits on what the interpretation may be. "Above all, the broadest reasonable interpretation must be *reasonable* in light of the claims and specification."⁴⁴ Thus,

⁴¹ See, e.g., *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1346-47 (Fed. Cir. 2016).

⁴² See *Mannige*, *supra* note 31.

⁴³ In addition to the overall question of deference on review of claim interpretations by the PTO, *Mannige* also raises the point that "even if the Federal Circuit were to address the general meaning of the BRI, it would have to do so with a high level of deference to the PTO" because it is the agency interpreting its own regulation. *Mannige*, *supra* note 31, at 172. *Mannige* makes an important point, but as the Federal Circuit has not hinted at such deference in its opinions thus far, I leave that point for future consideration.

⁴⁴ *PPC Broadband, Inc. v. Corning Optical Communs. RF, LLC*, 815 F.3d 747, 755 (Fed. Cir. 2016); see also *SAS Institute, Inc. v. ComplementSoft, LLC*, 2016 WL 3213103, *4 ("While we have endorsed the Board's use of the broadest reasonable interpretation standard in IPR proceedings, we also take care to not read "reasonable" out of the standard.").

for example, an interpretation that ignores the specification completely is not a reasonable one.⁴⁵ But beyond this, what are the limits on reasonableness?

Conventionally the “broadest reasonable interpretation” as a substantive concept meant something akin to erring generally on the side of breadth throughout the process of claim construction.⁴⁶ For example, in *In re Morris*, Judge Plager wrote:

“the 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 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.”⁴⁷

Here, “broadest reasonable interpretation” comes into play at the outset of the claim interpretation process, where the range of possible ordinary meanings is developed. Consider, for example, the word “hand.” Even viewed just as a noun, that word can mean a part of a person’s body, a round of applause, the pointer of a clock or dial, a person who engages in manual labor, a promise of betrothal, and the set of cards dealt to a person in a card game.⁴⁸ The approach described by Judge Plager would begin with the broadest reasonable meaning within that set, as understood by a person of ordinary skill in the art, taking into account the specification—especially any definitions contained within the specification.

Viewed in this light, the question on appeal is whether the broadest construction presented to the court—the allegedly invalidating one—is reasonable or not, given the record on appeal. Put another way, the Federal Circuit is not called upon to determine the broadest reasonable interpretation of the claims in the abstract. Rather, it is called upon to decide whether the broadest construction presented to it (whether by the Patent Office or a patent challenger) is reasonable or not.⁴⁹

Against this backdrop, the Federal Circuit’s recent opinions approach “reasonable” as constraining the choices that may be made during claim interpretation. “Even under the broadest reasonable interpretation, the Board’s construction cannot be divorced from the specification and the record evidence, and

⁴⁵ See *Morris*, 127 F.3d at at 1054.

⁴⁶ See *Bey & Cotropia*, *supra* note 7; see also Newman’s additional views in *Flo Healthcare Solutions, LLC*.

⁴⁷ *Morris*, 127 F.3d at at 1054.

⁴⁸ See e.g., WEBSTER’S NINTH NEW COLLEGIATE DICTIONARY (1990).

⁴⁹ This is not really all that different than claim construction in the infringement context, where the court is only called upon to construe those claims in dispute rather than to construe every term in the claim. And even when terms are construed, claim construction is generally a choice between proffered alternatives rather than a third-party inquiry in the meaning of the words.

must be consistent with the one that those skilled in the art would reach.”⁵⁰ Furthermore, because the Federal Circuit reads the intrinsic evidence without deference, the meaning of that evidence is constrained by the Federal Circuit’s reading. Thus, if the Federal Circuit reads the specification one way, while the Patent Office reads it another way, the error in the Patent Office’s reading renders it incorrect.⁵¹

This does not mean, however, that the Federal Circuit is reading the intrinsic evidence to arrive at a “correct” construction. Instead, it appears to be reading the intrinsic evidence with, for want of a better term, more “looseness” than in the district court claim construction context. *PPC Broadband, Inc. v. Corning Optical Communications (PPC I)* offers an illustration of this point.⁵² In *PPC I*, the court expressly stated that “claim construction in inter partes review proceedings is *not* governed by *Phillips*.”⁵³ Instead, although the meaning of the claim term could be arrived at through application of the *Phillips* framework, the court instead reached a broader construction of the term by asking the question of whether an alternative possible ordinary meaning was “consistent” with the written description—that is, whether there was “some language in the specification” to support the alternate interpretation.⁵⁴ Under the *Phillips* approach, the court would have construed “continuity member” as requiring “a continuous or consistent connection.”⁵⁵ Under the broadest reasonable interpretation approach, the court construed that term as *not* “requiring consistent or continuous contact.”⁵⁶

A hypothetical may more illustrate this point more simply. Consider the term “bi-monthly.” What does it mean to you? Does it mean twice a month? Or once every other month? Both, it turns out, are in the definition:

Bi•month•ly...1: occurring every two months 2 : occurring twice a month⁵⁷

Under the approach to claim meaning applied in the district courts, the term would be interpreted based on whichever meaning is the most correct one based on the ordinary meaning of the term to persons of skill in the art read in light of the written

⁵⁰ *Proxycorr*, 789 F.3d at 1298 (internal quotation marks omitted)

⁵¹ *C.f.* *Pride Mobility Prods. Corp. v. Permobil, Inc.*, 818 F.3d 1307, 1314–15 (Fed. Cir. 2016) (concluding that “It is unreasonable to read that straightforward language as meaning anything other than that the drive-wheel axis is perpendicular to the surface of the mounting plate that makes the plate substantially planar.”); *In re Man Machine*, -- F.3d --- 2016, *2–3. (Fed. Cir. Apr. 19, 2016) (rejecting Board’s constructions based on intrinsic evidence).

⁵² *PPC Broadband*, 815 F.3d 734 (Fed. Cir. 2016).

⁵³ *PPC Broadband*, 815 F.3d at 742 (emphasis added).

⁵⁴ *Id.*

⁵⁵ *Id.* at 741.

⁵⁶ *Id.* at 743.

⁵⁷ WEBSTERS NINTH NEW COLLEGIATE DICTIONARY (1990).

description and usage by persons of skill in the art.⁵⁸ Thus, for example, if the written description emphasized the need to perform a given task (say, calling your parents) at least once a month, then the second definition might be the appropriate one. On the other hand under the broadest reasonable interpretation approach, as long as the written description contained language consistent with the first definition (perhaps acknowledging the possibility of once-every-other month performance of the task), it, too, could be encompassed within the broadest reasonable interpretation.⁵⁹

PPC I thus places the difference in meaning between the “correct” standard of claim construction and the broadest reasonable interpretation on the degree to which the specification constrains the range of ordinary meanings of a claim term.⁶⁰ The result is, indeed, a greater scope of the claim (at least in this case), but not because the “correct” meaning of the claim term is ambiguous—indeed, the court is quite certain of what the correct construction of the term is.⁶¹ It is just that the alternative proposed by the patent challenger was within the scope of reasonableness.

But claim construction is not simply a selection from a range of possible meanings, taking into account the intrinsic evidence. It is also process governed by principles and rules—the “tools” of the claim construction process.⁶² One “tool,” for example, is the rule that while the claim must be read in light of the specification, limitations from the specification may not be imported into the claims.⁶³ Another is that of claim differentiation: that different claims are presumed to have different meanings—in particular, “the presence of a dependent claim that adds a particular

⁵⁸ Under *Nautilus v. Biosig*, “a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” 134 S.Ct. 2120, 2124 (2014). Thus, for example, the Federal Circuit has found indefinite claims where someone skilled in the art would be unable to choose among multiple possible methods leading to different results for determining whether a limitation is met. See *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335, 1344-45 (Fed. Cir. 2015); *Dow Chemical Co. v. Nova Chemicals Corp.*, 803 F.3d 620, 634-35 (Fed. Cir. 2015).

⁵⁹ It should go without saying that there are variations on this hypothetical that could change the result. As discussed above, the Federal Circuit appears to be taking a relatively close look at what the intrinsic evidence actually says.

⁶⁰ *PPC Broadband*, 815 F.3d at 742–43 (contrasting the meaning of the term under the *Phillips* framework with the meaning of the term under the BRI framework).

⁶¹ *Id.* at 742 (“the correct construction of continuity member” under the framework laid out in *Phillips*, 415 F.3d 1303, requires ‘consistent or continuous contact with the coupler/nut and the post to establish an electrical connection.’”).

⁶² *Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005).

⁶³ *Id.* at 1310. For an extensive discussion of canons of claim construction, see Peter S. Menell, Matthew D. Powers & Steven C. Carlson, *Patent Claim Construction: A Modern Synthesis and Structured Framework*, 25 BERK. TECH. L. J. 711 (2010).

limitation raises a presumption that the limitation in question is not found in the independent claim.”⁶⁴

Unlike when dealing with the intrinsic evidence, the Federal Circuit seems less willing to allow for the reasonableness of alternate applications of these tools of claim construction. *Dell v. Acceleron* offers an example. In that case, the Federal Circuit held that the “[t]he Board’s construction runs counter to the claim-construction principle that meaning should be given to all of a claim’s terms.”⁶⁵ Two other recent opinions reinforce the idea that the Federal Circuit is hesitant to recognize ambiguity flowing from the canons of claim construction (as opposed to from the intrinsic evidence).⁶⁶

If this observation is correct—and I stress that it is at best a descriptive claim based on a handful of opinions only—it suggests that while the Federal Circuit may be willing to recognize the existence of multiple ordinary meanings or view the intrinsic evidence with a certain degree of “looseness,” it will be less willing to deviate from its own views about how the canons of claim construction apply. This, then, has implications for the predictability of Federal Circuit decisionmaking in appeals arising from the Patent Office, as that predictability will turn at least in part on the degree to which the court’s approach to the canons of construction and their application can be ascertained.

⁶⁴ *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004); *see also* *SightSound Techs., LLC v. Apple Inc.*, 809 F.3d 1307, 1318 (Fed. Cir. 2015) (applying the principle of claim differentiation in the context of reviewing a broadest reasonable interpretation).

⁶⁵ *Dell Inc. v. Acceleron, LLC*, 818 F.3d 1293, 1300 (Fed. Cir. 2016);

⁶⁶ *See* *PPC Broadband, Inc. v. Corning Optical Comm’s RF, LLC*, 815 F.3d 747, 752-53 (PPC II) (addressing use of canons of construction by the Board.); *In re Varma*, 816 F.3d 1352, 1363 (Fed. Cir. 2016) (applying the “same meaning” principle of claim construction in reversing the Board);