

HOW SHOULD “COPIED” CLAIMS BE INTERPRETED?¹

By

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Introduction

Two recent opinions tee up this issue nicely. They are Robertson v. Timmermans, 90 USPQ2d 1898 (PTOBPAI 2008)(non-precedential)(opinion by APJ Lee for a panel that also consisted of APJs Schafer and Tierney), which held that “copied” claims³ are to be interpreted in light of the specification of the application into which they were “copied,” and Agilent Technologies, Inc. v. Affymetrix, Inc., 567 F.3d 1366, 91 USPQ2d 1161 (Fed. Cir. 2009)(opinion by Circuit Judge Rader for a panel also consisted of Circuit Judge Mayer and Circuit Judge Posner of the Seventh Circuit, sitting by designation), which held that they are to be interpreted in light of the specification of the application or patent from which they were “copied.”⁴ However, to understand either opinion, one must consider two older opinions, In re Spina, 979 F.2d 854, 24 USPQ2d 1142 (Fed. Cir. 1992)(opinion by Circuit Judge Newman for a panel that also consisted of Senior Circuit Judge Cowen and Circuit Judge Lourie), which held that they are to be interpreted in light of the specification of the application or patent from which they were “copied,” and Rowe v. Dror, 112 F.3d 473, 42 USPQ2d 1550 (Fed. Cir. 1997)(opinion by Circuit Judge Rader for a panel that also consisted of Circuit Judge Lourie and Senior Circuit Judge Friedman), which held that they are to be interpreted in light of the specification of the application into which they were “copied.” In addition, one must consider the PTO’s attempt to “legislatively” overrule Spina, which came after Spina and before Rowe v. Dror.

In re Spina

In re Spina is difficult to interpret. At one point it says that “A claim is not interpreted one way in light of the specification in which it originally was granted^[5], and another way in light of the specification into which it is copied as a proposed interference count.”^[6] However, at another point it says that, “When interpretation is required of a claim that is copied for interference purposes, the copied claim is viewed in the context of the patent^[7] from which it was copied. *DeGeorge v. Bernier*, 768 F.2d 1318, 1322, 226 USPQ 758, 761 (Fed. Cir. 1985)(if claim language is ambiguous “resort must be had to the specification of the patent from which the copied claim came”).”⁸ As I said in my 1993 write-up of In re Spina:

Thus, the view of this panel of the court *seems* to be that, if the language in a claim copied from a patent for the purpose of provoking an interference is non-ambiguous, the question of whether the application has written description support for the claim is decided independently of the disclosure of the patent from which the claim was copied, *but*, if the language in the claim *is* ambiguous, then the claim is first interpreted in light of the specification of the patent before turning to the applicant’s specification to see if the applicant has written description support for the so-interpreted claim.⁹

The “Legislative” Attempt to Overrule In re Spina

The PTO (or, at least, the APJs) didn’t like In re Spina. So, in 1995 the PTO attempted to “legislatively” overrule it. As Judge Lee¹⁰ wrote for the unanimous panel in Robertson:

Expressly provided in 37 CFR §41.200(b) (2005-2007) is the following:

A claim shall be given its broadest reasonable construction in light of the *specification of the application of patent in which it appears*. (Emphasis added)

The predecessor rule to 37 CFR §41.200(b), i.e., 37 CFR §1.633(a) (1995-2004), also states the same, regarding the basis of claim interpretation:

In deciding an issue raised in a motion filed under this paragraph (a), a claim will be construed in light of the specification of the *application or patent in which it appears*. (Emphasis added)

When the predecessor rule was promulgated in 1995, there was a notice in the Federal Register making clear that under the rule it was improper to interpret a party's claim in light of another party's specification, even where the claim was copied from the other party. Specifically, it was stated, 60 Fed. Reg. 14488, 14506 (March 17, 1995):

As proposed in the Notice of Proposed Rulemaking, paragraph (a) of §1.633 is revised in several respects. The first is to specify that a claim shall be construed in light of the specification of the application or patent in which it appears. The amendment clarifies an ambiguity in PTO interference practice. Previously, the Federal Circuit had interpreted §1.633 to require an ambiguous claim to be interpreted in light of the patent from which it was copied. *In re Spina*, 975 F.2d 854, 856, 24 USPQ2d 1142, 1144 (Fed. Cir. 1992). While this interpretation was a possible interpretation of previous §1.633, [the] PTO had intended that a copied claim be interpreted in light of the specification of the application or patent in which it appears. The rule, as adopted, will make ex parte and inter partes practice the same. A claim that has been added to a pending application for any purpose, including to provoke an interference, will be given the broadest reasonable interpretation consistent with the disclosure of the application to which it is added, as are claims which are added during ex parte prosecution.

In *Rowe v. Dror*, 112 F.3d 473, 479 n.2, 42 USPQ2d 1550, 1554 n.2 (Fed. Cir. 1997), the Court of Appeals for the Federal Circuit explained that the U.S. Patent and Trademark Office had ample authority to promulgate such a rule and allowed to stand a plain application of the rule.¹¹

Rowe v. Dror

So, the PTO thought that it had disposed of In re Spina. But, then along came Rowe v. Dror. Rowe had “copied” its claims in question from Dror’s patent.¹² According to the court’s opinion, “The parties argue over whether this court should interpret the claim [sic; claims] with

reference to the Dror patent, in which it [sic; they] originated, or the Rowe application, into which it was [sic; they were] copied.”¹³ The court resolved that dispute as follows:

The nature of this inquiry provides the answer. At this juncture, this court and the PTO examine claims to determine their patentability over the prior art. In effect, section 1.633(a) [the direct ancestor of present 37 CFR 41.200(b)] allows the PTO to consider the novelty or non-obviousness of each application’s claims as if the application stood alone. In this posture, the PTO properly interpreted the claim in light of its host disclosure, just as it would during *ex parte* prosecution. Thus, this court looks to the Rowe application to determine the meaning of the phrase at issue.¹⁴

Dror, of course, relied on In re Spina for the proposition that “the phrase at issue” should be interpreted in light of its specification. However, the court distinguished Spina as follows:

In *Spina*, this court considered whether an applicant was eligible to copy a patentee's claim and thereby challenge priority of invention, a question that turned on whether the copying party's specification adequately supported the subject matter claimed by the other party. *Id.* at 856. This court held, in that context, that a copied claim is interpreted in light of its originating disclosure. *Id.* This *Spina* rule sought to ensure that the PTO would only declare an interference if both parties had a right to claim the same subject matter. However, that rule does not apply in cases, such as this one, where the issue is whether the claim is patentable to one or the other party in light of prior art. In this posture, the PTO and this court must interpret the claim in light of the specification in which it appears.¹⁵

And what of the PTO’s attempt to “legislatively” over rule In re Spina? According to the court in Rowe:

This court is aware of the PTO's 1995 amendment to 37 C.F.R. Section 1.633 (a), which added a sentence: “In deciding an issue raised in a motion filed under this paragraph (a), a claim will be construed in light of the specification of the application or patent in which it appears.” 37 C.F.R. Section 1.633 (a) (1996) (effective date of amendment, April 21, 1995); *see also* 60 Fed.Reg. 14488, 14505, 1173 Off. Gaz. Pat. Office 36, 51 (1995) (explanatory notes on adoption of amended provision). This court does not accept the PTO's statement that it can “administratively set aside the judicially created rule of *In re Spina*,” *see* 59 Fed.Reg. 50181,

50185, 1167 Off. Gaz. Pat. Office 98, 101 (1994). Judicial precedent is as binding on administrative agencies as are statutes. However, the PTO had good reason to promulgate a new rule in light of the new practice in which patentability of claims can be considered during the motion period of an interference. *See* 37 C.F.R. 1.633(a) (effective date February 11, 1985). Earlier case law did not deal with such a situation. Moreover, *Spina* did not involve a Rule 633(a) motion. Thus, the PTO was writing on a clean slate, not flouting judicial precedent.¹⁶

Thus, the view of this panel of the court *seems* to be that the “copied” claims truly were, to use the famous phrase from White v. Dunbar,¹⁷ “nose[s] of wax,”¹⁸ having one meaning when considered for patentability over the prior art and another meaning when considered for some other purpose. But what other purpose?¹⁹

Agilent v. Affymetrix

Agilent is further support for the proposition that one should never (well, hardly ever) copy claims from a target patent or application in *ipsisssimis verbis*—i.e., in word-for-word-identical form.²⁰ Affymetrix had done just that, and it got into a peck of perhaps unnecessary trouble as a result.

The fact that Affymetrix had copied Agilent’s claims in *ipsisssimis verbis* led to the court’s revisiting the inconsistency between its holdings in In re Spina and Rowe v. Dror. However, while the court acknowledged that, to decide the case before it, “this court must examine two of its prior decisions,”²¹ it refused to acknowledge the inconsistency between them. Instead, it held that each rule is valid, but in different circumstances. The rule of Rowe v. Dror is applicable “where the issue...[is] whether...[a] claim...[is] ‘patentable to one or the other party in light of prior art’.”²² The rule of In re Spina is applicable where “the question is ‘whether the copying party’s specification...adequately...[supports] the subject matter claimed by the other party’.”²³ That is, the copied claim is interpreted one way for purposes of 35 USC 102 and 103

and in a completely different way for purposes of the written description requirement of the first paragraph of 35 USC 112.

Agilent is also interesting for a separate point bearing on Tafas v. Doll, 539 F.3d 1345, 90 USPQ2d 1129 (Fed. Cir. 2009) (petition for en banc rehearing granted July 6, 2009). As previously stated, the PTO did not like the holding in In re Spina, and it sought to “legislatively” overrule Spina. However, notwithstanding its statement in Rowe that, in enacting 37 CFR 1.633(a), “the PTO was writing on a clean slate, not flouting judicial precedent,”²⁴ in Agilent the court said that:

Rowe explicitly recognized that administrative regulations cannot trump judicial directives. In considering the effect of Rule 200’s substantively similar predecessor (37 C.F.R. § 1.633(a)(1996) on the rule from Spina, this court stated: “This court does not accept the PTO’s statement that it can ‘administratively set aside the judicially created rule of In re Spina.’ Judicial precedent is as binding on administrative agencies as are statutes.” Id. at 479 n.2 (internal citations omitted).²⁵

Comments

(1) In the interference context, it has been the law at least since Blackmore v. Hall, 1905 C.D. 561, 563 (Comm’r 1905), that, “under certain circumstances[,] the same claim may be interpreted differently in different specifications.” Parker v. Frilette, 462 F.2d 544, 553, 174 USPQ 321, 328 (CCPA 1972) (Rich, Acting Chief Judge, dissenting). This is particularly likely to occur with claims that contain mean-plus-function or step-plus-function limitations or with claims containing limitations that are specifically but differently defined in the two specifications.

(2) As I said in my long ago write-up of In re Spina:

The moral of this opinion, as well as many others to a like effect, is that neither 37 CFR 1.601(n) nor 37 CFR 1.607 requires an applicant to copy a patentee’s claims in *ipsis verbis* in order to

provoke an interference and that an applicant's attorney can save his or her client a great deal of unnecessary grief by slightly revising a copied claim to ensure that there is clear support for the copied claim in the specification of the application.²⁶

Doing that can both avoid 35 USC 112 first paragraph written description problems and focus the attention both of the parties and of the APJs on the real question in most such cases: Do the claims of the parties interfere or don't they? In my opinion, that is how the PTO should "ensure that...[it] only declare[s] an interference if both parties ha[ve] a right to claim the same subject matter."²⁷

(3) The court's holding that the same claim in the same party's case in interference should be interpreted one way for purpose of judging whether it is patentable over the prior art and in a different way for purposes of judging whether it is patentable under the written description requirement is at the very least inconsistent in thrust with the court's repeated statements that a claim must be interpreted the same way for judging patentability and infringement.²⁸ Moreover, what will the court do if interpreting a claim one way leads to a holding that it is valid over the prior art but invalid under the written description requirement? Worse, what will it do if interpreting a claim one way leads to a holding that it is valid under the written description requirement if interpreted that way and invalid under the self same requirement if interpreted the other way?!

(4) What about other patentability issues? Is a copied claim to be interpreted *a la In re Spina* or *a la Rowe v. Dror* if the issue is patentability under the enablement requirement? Under the "particularly point out and distinctly claiming" requirement? Like the written description requirement, they both stem from 35 USC 112. However, In re Spina seems to indicate that ambiguous claims are interpreted in light of "the specification of the patent from

which the copied claim came,”²⁹ but enablement is clearly keyed to the “host” specification. Thus, we may see those two types of patentability issues treated differently.

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³ “Copied” claims is a term of art in interference law. It does not mean that the targeting claims are necessarily word-for-word identical to the targeted claims. What it means is that the targeting claims are based on the targeted claims and at least allegedly interfere with the targeted claims.

⁴ A petition for rehearing en banc was filed on August 5, 2009.

⁵ Note that a claim can be “copied” from another application, usually (but not always) a published application, as well as from a patent.

⁶ 975 F.2d at 858, 24 USPQ2d at 1145; emphasis supplied. The emphasized language may explain some of the confusion. In today’s practice, claims are not “copied as a proposed interference count.” Instead, they are “copied” (either literally or, more often, in language based on the copier’s specification) for the purpose of provoking an interference, but the count or counts of that interference are formulated later based on completely different considerations.

⁷ See backnote 5, supra.

⁸ 975 F.2d at 856, 24 USPQ2d at 1144.

⁹ Gholz, A Critique of Recent Opinions of the Federal Circuit in Patent Interferences, 75 JPTOS 448 (1993) at page 457.

¹⁰ Interestingly, then Associate Solicitor Lee and APJ Schafer (who was also on the panel in Robertson) represented the PTO in In re Spina.

¹¹ 90 USPQ2d at 1902.

¹² The court's opinion does not indicate whether Rowe had copied the claims literally or in modified form.

¹³ 112 F.3d at 479, 42 USPQ2d at 1554.

¹⁴ 112 F.3d at 479, 42 USPQ2d at 1554.

¹⁵ 112 F.2d at 479, 42 USPQ2d at 1554; footnote omitted.

¹⁶ 112 F.2d at 479 n.2, 42 USPQ2d at 1554 n.2.

¹⁷ 119 U.S. 47, 7 S.Ct. 72 (1886).

¹⁸ 119 U.S. at 51, 7 S.Ct. at 74.

¹⁹ See comment (4), *infra*.

²⁰ One might want to do that in the rather rare situation presented in Sewall v. Walters, 21 F.3d 411, 30 USPQ2d 1356 (Fed. Cir. 1994) (Rich, CJ). In that case, the interferences' entire specifications were word-for-word identical, and the question was which party had conceived the invention, not which party had made the invention first.

²¹ 567 F.3d at 1374, 91 USPQ2d at 1166.

²² 567 F.3d at 1375, 91 USPQ2d at 1166, quoting from Rowe.

²³ 567 F.3d at 1374, 91 USPQ2d at 1166; quoting from Spina.

²⁴ 112 F.3d at 479 n.2, 42 USPQ2d at 1554 n.2.

²⁵ 567 F.3d at 1375, 91 USPQ2d at 1166.

²⁶ 75 JPTOS at 466.

²⁷ Agilent, 567 F.3d at 1375, 91 USPQ2d at 1166, quoting from Rowe.

²⁸ See generally Harmon, Patents and the Federal Circuit (8th ed. 2007) page 388: “It is axiomatic that the claims must be construed the same way for infringement that they were for determining validity....”

²⁹ Spina, 975 F.3d at 856, 24 USPQ2d at 1144.