Keywords: claim interpretation during examination; broadest reasonable interpretation; ordinary meaning; specification

General: During examination, claims terms are given their broadest reasonable interpretation consistent with the interpretation one of ordinary skill in the art would reach in view of the specification.

In re American Academy of Science Tech Center
70 U.S.P.Q.2d 1827 (Fed. Cir. 2004)
Decided May 13, 2004

I. Facts

The '989 patent, which is assigned to American Academy, relates to a network system in which individual "user computers," each having processing capabilities, are respectively connected to a dedicated database computer. During operation, the user computers locally process data requested from the common dedicated database computer. Additionally, each user computer employs a local database simulator that enables application programs running on the given user computer to call for the storage or retrieval of data from the remote database computer as if this data were maintained locally. The functionality of this network is reflected in claim 1 of the '989 patent, which recites, *inter alia*, "a plurality of independent, not necessarily uniform, general purpose user computers" and "said user application program indirectly issuing data base calls."

In 1991, American Academy sued Novell, alleging infringement of the '989 patent. In response, Novell filed a reexamination request on June 6, 1994, and the district court stayed the suit pending the outcome of the reexamination.

During the reexamination, the examiner rejected each of the claims of the '989 patent as anticipated by four different references. The examiner took the position that each of the cited references disclosed a "back-end" system in which several mainframe computers interface with a single database computer, i.e., the "back-end" computer. Relying on this interpretation, the examiner asserted that the disclosed mainframe computers anticipated the claimed user computers. The examiner also asserted that the recitation "indirectly issuing data base calls" simply required that database calls from the application program to the database manager program at the database computer be sent through some other program or hardware, as is the case in the cited systems.

In response, American Academy argued that the examiner's claim interpretations were too broad and inconsistent with the specification. American Academy submitted arguments and declarations contending that the claims of the '989 patent are limited to user computers that are each dedicated to a single user such as personal computers. Additionally, American Academy argued that the recitation "indirectly issuing" is limited to situations where the application program running on the user computer is unaware that calls to a remote database are being made. In effect, American Academy argued that the "indirectly issuing" limitation requires the use of a database simulator program, such as the simulator program described in the '989 patent. For both of these contentions, American Academy cited to various sections of the specification of the '989 patent and emphasized that claim terms must be interpreted in a manner consistent with the specification. The examiner, however, was unpersuaded, and American Academy appealed to Board.

The Board sided with the examiner and affirmed the rejections. The Board broadly construed the recitation "user computer" to include "any computer capable of running application programs for a user." As support, the Board stressed that claim terms are to be given their broadest reasonable interpretation. Moreover, the Board pointed to portions of the '989 patent that emphasized a user could be a person, another device, or machine and the disclosed embodiment of the '989 patent was merely exemplary. Additionally, the Board argued that the declarations offered by American Academy lacked factual evidence and demonstrated nothing more than American Academy's opinion of what a user computer is. The Board also broadly construed the recitation "indirectly issuing" to mean only that a

request must go "through some other component before it is sent to the data base." Again, the Board found the declarations submitted by American Academy as well as American Academy's citations to the '989 patent unpersuasive.

II. Issues

A. Did the Board properly construe the recitation "user computer?"

B. Did the Board properly construe the recitation "indirectly issuing data base calls?"

III. Discussion

A. Yes. The Federal Circuit agreed with the Board's interpretation of "user computer." With regard to American Academy's assertion that the specification of the '989 patent required a narrow construction of the recitation "user computer," the Federal Circuit stated that "[a]lthough some of the language of the specification, when viewed in isolation, might lead a reader to conclude that the term 'user computer' is meant to refer to a computer that serves only a single user, the specification as a whole suggests a construction that is not so narrow." The Federal Circuit cited language in the '989 patent that emphasized the exemplary nature of the disclosed embodiment and that explicitly noted that a user may be a person, computer, or other machine. Thus, the Federal Circuit concluded that encompassing multi-user computers within the category of user computers is neither overly broad nor inconsistent with the specification. Additionally, with respect to the declarations submitted by American Academy, the Federal Circuit agreed with the Board and concluded that these declarations merely presented conclusory opinion evidence, which was not persuasive.

B. Yes. The Federal Circuit agreed with the Board's interpretation of "indirectly issuing data base calls." Again, the Federal Circuit declined to construe the claims terms of the '989 patent more narrowly than required, cautioning against the importation of limitations into a claim that are founded on the preferred embodiment described in the specification absent a clear disclaimer in the specification. Indeed, the Federal Circuit again cited sections in the '989 patent that emphasize the exemplary nature of the described embodiment. Furthermore, the Federal Circuit again dismissed the declarations submitted by American Academy as presenting nothing more than unpersuasive opinion evidence.

IV. Conclusion

The Federal Circuit enforced well-known principles of claim construction during examination. This case illustrates another example of the level of care necessary for well-drafted claims that have the appropriate scope.