

Keywords: Broadest reasonable interpretation; “comprising”; anticipation; § 102; indefiniteness; § 112, second paragraph; written description; § 112, first paragraph; mechanical arts.

General: The Federal Circuit finds that the B.P.A.I. incorrectly construed the claim term “comprising”, further noting that the protocol of giving claims their broadest reasonable interpretation during examination is solely an examination expedient and does not include giving claims a legally incorrect interpretation.

In re Skvorecz

92 U.S.P.Q.2d 1020 (Fed. Cir. 2009)

Decided September 3, 2009

I. Facts

Robert J. Skvorecz received U.S. Patent No. 5,996,948 (“the ‘948 patent”) for a wire chafing stand having an improved structure to enable nested wire chafing stands to separate easily. Specifically, the ‘948 patent claims a wire chafing stand with “offsets” on the wire legs of the stand to reduce wedging when multiple chafing stands are stacked together. The ‘948 patent application was filed on January 12, 1998 as a continuation-in-part, and the Examiner issued a notice of allowance on August 12, 1999. Skvorecz subsequently filed an amendment to correct figures 12 and 13, which had been misprepared by the PTO. Specifically, Skvorecz stated that the Examiner had drawn the offsets backwards, facing the wrong direction. However, the Examiner denied the request, stating that the amendments represented new matter.

On March 15, 2001, Skvorecz filed a reissue application to broaden the claims of the ‘948 patent under 35 U.S.C. § 251. In particular, the claim term “upper rim” was replaced with the claim term “first rim,” and the claim term “lower rim” was removed. In a manner similar to claim 1 of the ‘948 patent, reissue claim 1 recited, among other things, “having at least two wire legs” and “a plurality of offsets located either in said upper right sections of said wire legs or in said first rim.” No changes were made to the specification or drawings.

The Reissue Examiner allowed claim 6, but rejected claims 1, 2, and 5 for anticipation under § 102 based on U.S. Patent No. 5,503,062 to Buff (“Buff”). When Skvorecz appealed the case to the B.P.A.I. (“the Board”), the Board sustained the anticipation rejection only as to claims 1 and 2, but applied new grounds for rejection as to claim 5. The Board rejected claim 5, which recited, among other things, “said plurality of offsets are welded to said wire legs at the separation of the upright sections into segments,” for indefiniteness under § 112 ¶ 2. The Board also rejected claims 1-5 and 7 for failing to comply with the written description requirement of § 112 ¶ 1.

Regarding the anticipation rejection of claims 1 and 2, the Board stated that Skvorecz “failed to demonstrate that the functional characteristics of his claimed invention are not inherent in the structure disclosed by Buff.” Skvorecz argued that the claims require each wire leg to have a laterally displacing offset, while the wire leg 48 of Buff does not have an offset that laterally displaces the leg from the rim. Although the Board agreed, the Board nonetheless maintained the rejection. On rehearing, the Board stated instead that the wire 48 of Buff represented a transverse member “and not a wire leg.” The PTO would later argue that the Board’s decision was justified because claim 1 uses the open-ended of transition term “comprising” and, therefore, the Board could interpret claim 1 as not requiring every wire leg to include offsets.

Regarding the rejection of claim 5 for indefiniteness, the Board noted that (1) the phrase “at the separation” lacks antecedent basis in claim 1, and (2) the indefiniteness of “at the separation”

renders the term “segments,” which is not defined in the specification of the ‘948 patent, indefinite. Regarding the written description rejection, the Board argued that the offsets were not described in the specification and are shown only in the proposed corrections to figures 12 and 13, which the Examiner refused to enter. Skvorecz then appealed the decision to the Federal Circuit.

II. Issues

1. Did the Board correctly interpret claim 1 as anticipated under § 102?
2. Did the Board correctly determine that claim 5 was indefinite under § 112 ¶ 2?
3. Did the Board correctly determine that claims 1-5 and 7 fail to comply with the written description requirement of § 112 ¶ 1?

III. Discussion

1. No. The Federal Circuit court flatly stated that “[t]he protocol of giving claims their broadest reasonable interpretation during examination does not include giving claims a legally incorrect interpretation.” In re Skvorecz, 92 U.S.P.Q.2d at 1024. In this case, the PTO argued that the term “comprising” in claim 1 permitted the claimed Skvorecz structure to include legs without offsets, despite claim 1 stating that “said wire legs” and “each wire leg” have offsets. The court reiterated that the claim term “comprising” means that the claimed invention may contain additional elements not explicitly mentioned in the claim. *See* CIAS, Inc. v. Alliance Gaming Corp., 84 U.S.P.Q.2d 1737 (Fed. Cir. 2007). However, the court noted that “[t]he signal ‘comprising’ does not render a claim anticipated by a device that contains less (rather than more) than what is claimed.” In re Skvorecz, 92 U.S.P.Q.2d at 1024.

The court concluded that the examination protocol of giving claims their broadest reasonable interpretation was incorrectly applied, thereby allowing an interpretation that found a device in which not all the wire legs have offsets to be anticipating. To the contrary, the court stated, claim 1 requires that “each wire leg” have an offset. Since Buff did not disclose an offset for each wire leg (interpreting the wire segment 48 as a wire leg), the court concluded claim 1 was not anticipated as a matter of law.

2. Yes and no. The Federal Circuit court noted that definiteness of claim language is analyzed in light of (A) the content of the disclosure, (B) the teachings of the prior art, and (C) the claim interpretation of one of ordinary skill in the art. *See* M.P.E.P. § 2173.02. The Board had argued that (1) the phrase “at the separation” lacks antecedent basis in claim 1, and (2) the indefiniteness of “at the separation” renders the term “segments,” which was not defined in the specification of the ‘948 patent, indefinite. The court recalled that claim terms are not required to match those used in the specification and that a lack of explicit antecedent basis does not always render a claim indefinite. *See id.*

In this case, the Federal Circuit agreed that the clause “welded to said wire legs at the separation” did not require antecedent basis in claim 1, since one of ordinary skill would understand the claim in the context of the specification. Regarding the indefiniteness of the claim term “segments,” the Board had offered a suggestion that providing antecedent basis in claim 1 would alleviate its concerns. The Federal Circuit also agreed with this suggestion, and concluded that the indefiniteness rejection would be reversed subject to the suggested amendment.

3. No. Despite the discrepancies of figures 12 and 13, since a person skilled in the art would understand the specification including the drawings as showing the offsets and the lateral displacement of each wire leg, the Federal Circuit held that the written description rejection

was not supported by substantial evidence, as required under the APA. *See* 5 U.S.C. § 706(2). Although the Examiner had refused to enter the amended figures 12 and 13, original figures 12 and 13 are described in the specification as including offsets 42 laterally displacing each leg in the upper rim of the wire chafing stand. While the PTO argued that figures 12 and 13 are only partial figures, and therefore do not show every leg's offsets, the full structure is shown in other drawings. As noted by the Federal Circuit, "[a]n applicant's disclosure obligation varies according to the art to which the invention pertains." *In re Hayes Microcomputer Products, Inc. Patent Litig.*, 25 U.S.P.Q.2d 1241 (Fed. Cir. 1992). The court held that a person skilled in the mechanical arts would understand the disclosure of Skvorecz as including the offsets and, therefore, reversed the written description rejection.