



## Federal Circuit Reminds US BPAI of Fundamentals

- *Journal of Intellectual Property Law and Practice*, December 9, 2009

Author(s): Charles R. Macedo

*In re Skvorecz*, No. 2008-1221, US Court of Appeals for the Federal Circuit, 580 F.3d 1262, 3 September 2009

### Abstract

This case concerned rejection of patent claims by US BPAI based on patent law fundamentals.

### Legal context

Most cases presented to the US Court of Appeals for the Federal Circuit involve complex areas of law in which courts may find it difficult to elucidate appropriate rules based on the facts presented. *In re Skvorecz*, 580 F.3d 1262, 2009, presents a rather different situation, the Federal Circuit applying fundamental principles of patent law to reverse multiple rejections sustained by, and/or made in the first instance by, the US Board of Patent Appeals and Interferences ('BPAI'). This case provides a useful reminder of some of those fundamental principles.

### Facts

US Patent No. 5,996,948, entitled 'Wire Chafing Stand' ('the '948 patent'), issued to Robert J. Skvorecz. This patent, as originally issued, contains six claims directed to a wire chafing stand that can be nested inside of another such stand and easily removed. Claims 1 and 6 are in independent form. Skvorecz later filed reissue application no. 09/772,278 ('the '278 reissue application'), seeking reissuance of claims 1–7 of the '948 patent under 35 USC §251.

During examination of the '278 reissue application, the examiner allowed claim 6 (which was not considered by the BPAI or the Federal Circuit) and rejected claims 1–5 and 7 as being an improper recapture of surrendered subject matter. The BPAI reversed this rejection, so the issue was not considered by the Federal Circuit.

The reissue examiner also rejected claims 1, 2, and 5 as being anticipated based on Figure 2 of US Patent No. 5,503,062 ('the Buff patent'). The BPAI reversed the anticipation rejection with respect to claim 5, but sustained the anticipation rejection as to claims 1 and 2.

The BPAI also entered two new grounds for rejection:

1. claim 5 ('A wire chafing stand as defined in claim 1 wherein said plurality of offsets are



welded to said wire legs at the separation of the upright sections into segments’) was indefinite; and

2. claims 1–5 and 7 failed to comply with the written description requirement.

Skvorecz elected to have the BPAI reconsider the new grounds for rejection, which resulted in the BPAI sustaining the rejection.

On appeal, the Federal Circuit was thus presented with the following three issues to review:

- i. the examiner’s rejection of claims 1 and 2 based on anticipation, which was sustained by the BPAI;
- ii. the BPAI’s new rejection of claim 5 as being indefinite; and
- iii. the BPAI’s new rejection of claims 1–5 and 7 as failing to comply with the written description requirement.

## **Analysis**

The Federal Circuit reversed the BPAI on all three grounds for rejection and remanded for further proceedings, relying upon various fundamental principles of patent law that the Federal Circuit found were misapplied by the BPAI.

## **Anticipation**

First, the Federal Circuit addressed the BPAI’s affirmation of the examiner’s anticipation rejection of claims 1 and 2 based on the Buff patent.

The BPAI’s rationale for affirming the anticipation rejection rested on the BPAI’s construction of claim 1 as allowing for a construction to include wire legs without offsets, because the claim uses the open-ended transition term ‘comprising’. Specifically, claim 1 (as amended) provides in pertinent part:

1. A wire chafing stand...*further comprising a plurality of offsets* located either in said upright sections of said wire legs or in said first rim for laterally displacing *each wire leg* relative to said first rim to facilitate the nesting of a multiplicity of stands into one another without significant wedging. (Emphasis added.)

Based on this language, the PTO argued as follows:

The PTO argues that because the signal ‘comprising’ is open-ended, not every wire leg is required by claim 1 to include offsets. The PTO states that the usage ‘comprising’ permits the Skvorecz structure to include legs without offsets, although claim 1 states that ‘said wire legs’ and ‘each wire leg’ have offsets. Thus the PTO argues that even if claim 1 were construed to



require that every wire leg has an offset, the Buff patent shows offsets 52 that laterally displace wire leg 49, apparently arguing that it is irrelevant whether Buff's wire leg 48 has an offset. Thus the Board held that claim 1, when given its broadest interpretation, reads on the Buff structure and thus is anticipated.

The Federal Circuit began with the fundamental statement of US Patent Law on anticipation (S Kvorecz, 580 F.3d at 1267):

A rejection for 'anticipation' means that the invention is not new. Anticipation requires that all of the claim elements and their limitations are shown in a single prior art reference.

The Federal Circuit then flatly rejected the PTO's argument using fundamental principles of patent law (Id at 1206):

The PTO has not correctly construed the signal 'comprising.' This signal simply means that the device may contain elements in addition to those explicitly mentioned in the claim. The Board erred in holding that some wire legs of the Skvorecz device, as claimed, need not have an offset, when the claims state that each wire leg has an offset....

The signal 'comprising' does not render a claim anticipated by a device that contains less (rather than more) than what is claimed. Here the examination expedient of 'broadest reasonable interpretation' was incorrectly applied to interpret 'comprising' to mean that not all the Skvorecz wire legs need have offsets, despite the claims that state that 'each wire leg' has an offset. The Buff device does not have an offset located in each wire that serves as a leg to support the device. In the Buff structure both the transverse wire 48 and the longitudinal wire 49 provide the bottom support analogous to wire legs, and it is undisputed that wire segment 48 does not have an offset. Anticipation cannot be found, as a matter of law, if any claimed element or limitation is not present in the reference. The 'anticipation' rejection is reversed.

## **Indefiniteness**

Next the Federal Circuit addressed the BPAI's new 'indefiniteness' (Id at 1267–68.) rejection. Once again, the Federal Circuit began its discussion with a review of patent law fundamentals:

35 U.S.C. §112 ¶2 states:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The MPEP at §2173.02 ('Clarity and Precision') states that the 'focus during the examination of claims for compliance with the requirement for definiteness of 35 U.S.C. [§]112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available.' The MPEP states:



Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

Id at 1268. (The ‘MPEP’ is the Manual for Patent Examining Procedure, which is published by the USPTO to provide a reference work on the practices and procedures relative to the prosecution of patent applications before it.)

The BPAI’s indefiniteness rejection rested on two grounds:

- i. the phrase ‘at the separation’ in dependent claim 5 lacks antecedent basis in independent claim 1, rendering claim 5 indefinite; and
- ii. the indefiniteness of ‘at the separation’ renders the term ‘segments’ indefinite, especially because ‘segments’ is not defined in the specification.

The Federal Circuit overturned the rejection with respect to both grounds.

With respect to the first point, the Federal Circuit found:

We agree with Mr. Skvorecz that the clause ‘welded to said wire legs at the separation’ does not require further antecedent basis in claim 1, for a person skilled in the field of the invention would understand the claim when viewed in the context of the specification.

To support this holding, the Federal Circuit relied upon the following fundamental principles of patent law as set forth in the MPEP (Id at 1269.):

MPEP §2173.05(e), entitled ‘Lack of Antecedent Basis,’ states: ‘There is no requirement that the words in the claim must match those used in the specification disclosure,’ and ‘Obviously,...the failure to provide explicit antecedent basis for terms does not always render a claim indefinite.’ MPEP §2173.02 states: ‘Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.’

With respect to the second argument, the BPAI explained (Id at 1268–69.):

We would agree with Applicant’s argument if claim 5 cited ‘welded to said wire legs to form a separation’ (i.e., the separation does not yet exist). However, the claim recites ‘welded to said wire legs at the separation’ and the language ‘at the separation’ indicates that the separation



already exists prior to the welding. This contradicts Applicant's explanation.

Id at 1269 (quoting Rehearing op. at 4). With respect to this ground, the Federal Circuit found the BPAI's 'suggestion' helpful, and indicated it 'may be implemented on remand' (Id at 1269.).

### **Written description**

Finally, the Federal Circuit rejected the BPAI's new 'written description' rejection. Once again, the Federal Circuit began with a statement of fundamental principles:

The written description requirement is set forth in 35 U.S.C. §112, ¶1:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

A purpose of the written description requirement is to provide the public with knowledge of the patented technology, thereby to advance the useful arts. The description of the invention provides the foundation for the scope and content of the claims, and serves to demonstrate that the applicant is in possession of the invention that is claimed. In fulfillment of these purposes, the applicant may employ 'such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.' *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). The form and presentation of the description can vary with the nature of the invention; compliance with the written description requirement is a fact-dependent inquiry. *In re Alton*, 76 F.3d 1168, 1172 (Fed. Cir. 1996).

The BPAI's written description argument centres on the claim element 'a plurality of offsets located ... in said first rim', which the BPAI found was not described in the specification, and was only described in proposed corrections to Figures 12 and 13, which the examiner refused to enter. Skvorecz took issue with the Board's finding and showed where this feature was shown in the specification. The Federal Circuit agreed that 'Figures 12 and 13 do show such offsets in the rim' (Id at 1269–70).

To support its argument, the PTO argued that Figures 12 and 13 are partial figures, and do not show every leg's offsets and its displacement. The Federal Circuit made short shrift of this argument:

However, the full structure is shown in other drawings of the various embodiments, in full structure (such as Figures 1 and 7) and partial structure (such as Figures 10 and 11). See *In re Wright*, 866 F.2d 422, 426 (Fed. Cir. 1989) (the specification as a whole must be considered). A skilled artisan would readily understand Figures 12 and 13 as partial



structures showing detail of the offsets. ‘An applicant’s disclosure obligation varies according to the art to which the invention pertains.’ *In re Hayes Microcomputer Products, Inc. Patent Litig.*, 982 F.2d 1527, 1534 (Fed. Cir. 1992). A person skilled in the mechanical arts would understand the specification including the drawings as showing the offsets and the lateral displacement of each wire leg. The Board’s finding that the written description requirement is not met is unsupported by substantial evidence, and is reversed.

## **Practical Significance**

*Skvorecz* is a reminder that fundamental principles of patent law cannot be ignored when analysing any set of claims (Id at 1270). These principles are often set forth in the MPEP. The Federal Circuit repeatedly turned to the MPEP to remind the BPAI of these fundamental principles. The failure of the BPAI in the present case to consider and apply such principles properly resulted in *Skovorecz* having to spend a substantial amount of time, effort, and, no doubt, resources to have his invention appropriately considered.

The Federal Circuit clarified that, although the PTO should give claims to their broadest reasonable interpretation during examination, this principle is not a licence for the PTO to ignore limitations that are present in the claims.

## **[Charles R. Macedo](#)**

Amster, Rothstein & Ebenstein LLP, New York, NY

Email: [cmacedo@arelaw.com](mailto:cmacedo@arelaw.com)

[Charles Macedo](#) is author of [The Corporate Insider’s Guide to US Patent Practice](#), published by Oxford University Press in 2009. [Charles R. Macedo](#) is a partner at Amster, Rothstein & Ebenstein LLP. The firm’s practice focuses exclusively on all facets of intellectual property law. The author can be contacted at [cmacedo@arelaw.com](mailto:cmacedo@arelaw.com).