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## Federal Circuit Clarifies Standard For Construing Claims in Interference

Copied claim is construed based on originating specification for written description purposes, but based on the specification into which it is copied for prior-art purposes

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Applicants commonly provoke an interference by copying into their application (the “host application”) a claim from someone else’s pending application or issued patent. As the interference progresses, the other party may challenge the applicant’s right to do this by contending that the copied claim lacks written description in the host application under 35 U.S.C. § 112, or that the claim is unpatentable to the applicant as anticipated or obvious under 35 U.S.C. §§ 102 or 103 by virtue of the prior art.

In *Koninklijke Philips Electronics N.V. v. Cardiac Science Operating Co.*, 590 F.3d 1326 (Fed. Cir. 2010), the Federal Circuit explained that the specification used to construe a copied claim depends on the purpose of the construction. Specifically, the copied claim is (i) construed based on the originating application when the question is whether the claim has written-description support in the host application (the so-called *Spina* rule after *In re Spina*, 975 F.2d 854 (Fed. Cir. 1992)), but (ii) construed for purposes of determining patentability over the prior art based on the host application (as would be the case in prosecution).

Although the court has stated these rules of construction before, their illustration here is notable because both constructions were required in the same case. This is because the copied claims were attacked on both written description grounds and on prior art grounds, requiring the use of different constructions to resolve the separate grounds of attack.

Here, applicant Owen provoked an interference by copying claims from a patent issued to Philips. The Board of Patent Appeals and Interferences formulated one count for the interference, corresponding to one of the claims that Owen copied from Philips.

Philips contended that Owen could not make the count because Owen’s specification did not provide written-description support when the claim used to formulate the count was construed in view of the Philips specification. Philips also argued that if the claims were construed based

on Owen’s specification, they were unpatentable over the prior art.

The Board rejected Philips’ written-description challenge, stating that the Philips patent was irrelevant to construction of a claim that would (if allowed) be in a patent to Owen. In doing so, it relied on 37 C.F.R. 41.200(b), which requires claims in an interference to be given their broadest reasonable construction based on the specification in which they appear (without regard to the grounds of challenge).<sup>1</sup>

According to the Board, the PTO had authority to promulgate section 41.200(b) in 2004, effectively overruling the *Spina* rule dating from 1992, because of the Federal Circuit’s intervening decision in *Rowe v. Dror*, 112 F.3d 473 (Fed. Cir. 1997), which endorsed construction of a copied claim based on the host application. Unlike in *Spina*, however, the copied claim in *Rowe* was challenged on prior art grounds. *Rowe*, 112 F.3d at 479. Although the court observed in *Rowe* that its holding was consistent with the PTO’s then-existing interference rule 633(a), the predecessor of section 41.200(b), it noted that the PTO did not have the authority to overrule precedent by rulemaking and rejected the PTO’s statement that it had administratively set aside *Spina* by promulgating rule 633(a). 112 F.3d at 479 n.2.

In *Philips*, the Federal Circuit rejected the Board’s reliance on section 41.200(b) and explained that *Rowe* was inapplicable because it involved a challenge to a copied claim based on prior art. The court noted that despite the distinction between *Rowe* and *Spina*, “some parties still misunderstand when the *Spina* rule should apply.” 590 F.3d at 1335. It further held that the Board had (again) erred in believing that the PTO could effectively negate *Spina* by rulemaking, reminding the PTO that the agency lacks substantive rulemaking authority and must resolve conflicts between controlling precedent and its rules in favor of the precedent. *Id.* at 1337.

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<sup>1</sup> The Board’s decision is available at <https://acts.uspto.gov/ifiling/PublicView.jsp> under Interference No. 105,451.

To patent lawyers raised on the doctrine that claims must be construed consistently for purposes of infringement and validity, a doctrine requiring different constructions of the same claim may seem anomalous. Perhaps this seeming inconsistency also troubled the Board, and influenced its decision to disregard the *Spina* rule and construe the copied claim based on the host application (as the claim would be construed in *ex parte* prosecution and in an interference to determine its patentability over the prior art). However, *Spina*'s requirement to construe a copied claim for written-description purposes based on the originating application makes sense because the fundamental issue in an interference is which party has the right to the claimed invention. If a copied claim is not supported by

the application into which it is copied, then that application does not belong in an interference with the application or patent from which the claim was copied. Because the copied claim must have the same meaning to both parties when this threshold issue is addressed, it is construed based on the originating application or patent.

If this threshold is crossed, the inquiry becomes whether the copied claim is patentable in the host application over the prior art. For that purpose, the claim must be construed based on the host application (as in ordinary prosecution), because if the copied claim issues in a patent from the host application it will be construed based on that application.