

# Seyfarth PTAB Blog



A legal look at Patent Trial and Appeal Board decisions and trends

## PTAB's Precedential Decision Related to Broadest Reasonable Claim Construction

By King Lit Wong, Ph.D.

The claims are undoubtedly the most important part of a utility patent or patent application. The claim scope is extremely important in determining the validity of a patent claim and performing infringement analysis. How claim limitations are interpreted have a primary impact on the claim scope. During patent prosecution and in post-issuance patent challenge proceedings, the U.S. Patent and Trademark Office (USPTO) has used the broadest reasonable interpretation (BRI) standard in claim construction in light of the specification.

In April 2016, the Patent Trial and Appeal Board (PTAB) rendered an opinion, [Ex parte Schulhauser](#), on an appeal taken from the final rejections of a U.S. patent application, where the BRI standard was applied in claim construction. On October 4, 2016, the opinion was made precedential by the PTAB as a decision involving the BRI of method claim steps as related to conditions precedent.

The PTAB usually does not provide any explanation of why certain opinions are made precedential. However, it should be noted that the U.S. Supreme Court had decided in *Cuozzo Speed Technologies, LLC v. Lee*, 579 U.S. \_\_\_\_\_ (2016) on June 20th that the BRI is the proper standard for USPTO to use in claim construction under the USPTO's rule making authority. The recent decision by the Supreme Court upholding the use of the BRI by the USPTO may contribute to the PTAB's decision in making the *Ex parte Schulhauser* opinion precedential to illustrate for some patent practitioners how the PTAB applied the BRI standard.

*Ex parte Schulhauser* involved both method claims and device claims. Claim 1 was representative of the method claims directed toward a method for monitoring cardiac conditions. For discussion purposes, instead of reproducing each claim limitations in its entirety, the subject matter of claim 1 is summarized below.

1. A method for monitoring cardiac conditions, comprising
  - (1) collecting physiological data including heart data;
  - (2) comparing the heart data with a criterion;

(3) triggering an alarm if the heart data is not within the criterion; and

(4)-(9) making certain determinations and comparisons if the heart data is within the criterion.

The claims were rejected by the Examiner as obvious over the prior art, which rendered steps (1)-(3) obvious. During the appeal, the applicant argued against the obviousness rejections by pointing out that the prior art did not disclose or suggest steps (4)-(9) and the specific order these steps are performed. The PTAB was not persuaded by the arguments because, under the BRI consistent with the specification, steps (4)-(9) need not be performed if the heart data is not within the criterion. The PTAB noted that the conditions precedent in steps (3) and (4) are mutually exclusive. Thus, with the BRI of claim 1, only steps (1)-(3) are required, and steps (4)-(9) could be ignored when the condition precedent of the heart data being not within the criterion is met in step (3). Because steps (1)-(3) were disclosed or suggested by the prior art, claim 1 was rendered obvious. As a result, the obviousness rejections of the method claims over the prior art were affirmed by the PTAB.

In addition to the method claims, there were device claims in *Ex parte Schulhauser*. However, the PTAB interpreted the device claims differently. The device claims were represented by claim 11, directed toward a system for monitoring cardiac conditions, wherein the system comprises devices for performing the collecting, comparing, triggering, and determining operations with very similar claim limitations and the same conditions precedent as recited in claim 1. Even though the same conditions precedent as in claim 1 were recited in claim 11, the PTAB reversed the obviousness rejection of claim 11 over the same prior art. Regarding claim 11, the prior art taught or suggested a system comprising devices for the collecting, comparing and triggering operations similar to the recitations in steps (1)-(3) of claim 1. Under the BRI, the PTAB interpreted claim 11 to require all the devices for performing all the operations similar to the recitations in steps (1)-(9) of claim 1. In other words, despite the conditions precedent, claim 11 was construed by the PTAB under the BRI to require all the recited devices. Because the prior art did not teach or suggest the devices for performing the operations similar to the recitations in steps (4)-(9) of claim 1, claim 11 was held to be nonobvious over the prior art.

## Takeaway:

Patent practitioners should be careful in how they draft patent claims involving conditions precedent in method claims. The reason is that, under the BRI as applied by the PTAB in *Ex parte Schulhauser*, method steps following a step containing a condition precedent may not be given any patentable weight if the condition precedent is met when mutually exclusive conditions precedent are involved. It would be useful to draft some method claims having a condition precedent recited only in the last step to avoid some of the steps ignored when the claims are construed under the BRI standard. Another lesson learned from *Ex parte Schulhauser* is that, if possible, device or product claims should be submitted in addition to method claims containing conditions precedent because the effects of the conditions precedent could be interpreted differently, so that the device or product claims could survive certain prior art rejections that may render the method claims non-patentable.

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