

Comments Submitted by Robert M. Asher

To : Lead Judge Michael Tierney
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Via email: inter_partes_review@uspto.gov

I am pleased to have this opportunity to present views for consideration with particular regard to the proposed rules setting a broadest reasonable construction standard and to those allowing the Board to allow some grounds and exclude others from review proceedings. These comments relate equally to *inter partes* review and post grant review.

Congress now gives the highly trained judges of the PTAB the ability to make decisions on patent validity with estoppel effect. Such decisions will be based on a claim construction determination. The patent judges should participate through their decisions in shaping the law of claim construction so that all courts may find increased certainty with regard to claim scope. Increased certainty in patent litigation will reduce the overwhelming burden of litigation costs on the economy. The current state of the law has our courts bogged down in the highly unpredictable morass of “specification” construction. (See the split court’s opinions analyzing the meaning of the patent specification in *Marine Polymer Technologies, Inc. v. Hemcon, Inc.*, (Fed. Cir. March 15, 2012)) By working towards a proper claim construction standard that can also be applied in court, the PTAB can help lead the way to greater certainty in claim construction. This can only happen if claim constructions in *inter partes* reviews and post grant reviews are conducted according to a rubric applicable in the courts. As explained below, such a unified approach to claim construction is called for by the AIA.

Rule 42.100(b) -*In re Yamamoto* is inapplicable to post grant reviews and *inter partes* reviews

The decision in *In re Yamamoto* addressed a question not even remotely equivalent to today’s question of claim construction in a post grant or *inter partes* review. In 1984, *In re Yamamoto* applied the broadest reasonable construction to *ex parte* reexaminations as was used in reissue applications. The court emphasized the ability to amend in reissue applications and *ex parte* reexaminations.

The same policies warranting the PTO's approach to claim interpretation when an original application is involved have been held applicable to reissue proceedings because the reissue provision, 35 U.S.C. § 251, permits amendment of the claims to avoid prior art. *In re Reuter*, 651 F.2d at 756, 210 USPQ at 253-54.

In re Yamamoto, 740 F. 2d 1569, 1572 (Fed. Cir. 1984).

The America Invents Act and the rules proposed by the PTO do not offer patent owners in post-grant review and *inter partes* review the full and fair opportunity to amend, which has been afforded to reissue applicants. For the numerous reasons set forth below, the question of claim construction in a post grant and *inter partes* review is a question of first impression.

- Whereas a reissue application is a patent application prosecution, post grant reviews and *inter partes* reviews will be trials.
- Unlike reissue applications, post grant and *inter partes* reviews are not filed by the patent owner. These are challenges to issued patents requested by third parties.
- The reviews are not conducted before a patent examiner, but rather in front of the Patent Trial and Appeal Board.
- Whereas a patent owner unhappy with the progress in a reissue application may file a continuation of the reissue with new and amended claims. In a review, the only recourse is appeal to the Federal Circuit Court of Appeals.
- Whereas a patent applicant in a reissue application may speak with the patent examiner on the phone or in person several times to negotiate acceptable claim language, a patent owner may only speak with the APJ with the challenger's counsel present.
- The examiner in a reissue is responsible for issuing claims with valid and unambiguous scope. The APJ is responsible for deciding between the positions of the challenger and the patent owner.
- It is contemplated that the ability to amend claims and add new claims in a review will be strictly limited. Proposed rule 42.207 states that the patent owner's preliminary response "shall not include any amendment." Rule 42.121 states that "A patent owner may file one motion to amend a patent but only after conferring with the Board. Any additional motions to amend may not be filed without Board authorization."
- Amendments in reissues are made after receiving the examiner's reasoned rejection. In post grant and *inter partes* review, patent owner only has the decision of the PTAB on the petition which might merely identify the grounds from the challenger's petition which will go forward. No insight into the decision maker's thinking may be available.
- Amendments in reissues are made in view of an examiner's construction of a claim as set forth in the rejection or as discussed in an interview. Amendments in post grant and *inter partes* reviews must be made before the PTAB even considers the scope of the challenged claims in the review. Reviews are instituted without consideration of the impact on claim scope of written statements submitted under 35 U.S.C. 301. Any modifications of claim scope resulting from those statements may not be apparent until

the oral hearing and the final written decision. It will be too late for amendments at that point.

- The America Invents Act explicitly treats reissue applications differently from post grant and *inter partes* reviews. Written statements submitted under 35 U.S.C. 301 will only be used to determine claim scope in post grant reviews, *inter partes* reviews and *ex parte* reexaminations, not in reissue applications. 35 U.S.C. 301(d). A bright distinction is raised between patent application prosecutions and challenges to issued patents.

In view of the significant differences between reissue applications and the review proceedings, the claim construction used in reissue applications and original patent application prosecution may be expected to be inapplicable to review proceedings.

Moreover, the standards of construction debated in *In re Yamamoto* are no longer at stake. In that case, the court ruling rejected the applicability in the USPTO of the Ninth Circuit's approach to claim construction in which "[t]he starting point is the rule that patent claims should be construed liberally to uphold the patent's validity rather than to destroy the inventor's right to protect the substance of his invention." This approach is not the starting point for claim construction under current law. For all these reasons, the decision in *In re Yamamoto* is inapplicable to post grant and *inter partes* review proceedings.

As emphasized in *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004), *ex parte* reexaminations seek to produce patents with allowable precise claims:

Giving claims their broadest reasonable construction "serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified." *Yamamoto*, 740 F.2d at 1571; *accord Hyatt*, 211 F.3d at 1372; *In re Zletz*, 893 F.2d 319, 322 (Fed.Cir.1989) ("An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.").

The purpose of post grant review and *inter partes* review to eliminate invalid claims in a cost efficient manner with a strictly limited opportunity to amend a claim puts these procedures in a category quite separate from reissues and *ex parte* reexaminations at the time of *In re Yamamoto* and *In re American Academy of Science Tech Center*.

Rule 42.100(b) Is Inconsistent with the Statute 35 U.S.C. 301(d)

Rule 42.100(b) states that claims will be given their “broadest reasonable construction in light of the specification of the patent.” The rule is based on *In re Yamamoto*, which as explained above is entirely inapplicable to *inter partes* reviews. The case law relates to past practices. The *inter partes* review is an entirely new proceeding created by the America Invents Act. The claim construction approach for *inter partes* reviews should be guided in the first instance by the statute. 35 U.S.C. 301(d) provides:

A written statement submitted pursuant to subsection (a) (2), and additional information submitted pursuant to subsection (c), shall not be considered by the Office for any purpose other than to determine the proper meaning of a patent claim in a proceeding that is ordered or instituted pursuant to section 304, 314, or 324.

Note that the statute does not refer to determining broadest reasonable construction of claims; rather the Office is charged with determining the “proper meaning.”

The proper meaning of a claim has normally been the province of litigation. “To determine the proper meaning of claims, we first consider the so-called intrinsic evidence, i.e., the claims, the written description, and, if in evidence, the prosecution history.” *Digital Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1335, 1344 (1998). “The proper construction of a patent’s claims is an issue of Federal Circuit law. . . To ascertain the scope and meaning of the asserted claims, we look to the words of the claims themselves, the specification, the prosecution history, and any relevant extrinsic evidence. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315-17 (Fed Cir. 2005).” *Absolute Software, Inc. v. Stealth Signal, Inc.*, ___ F.3d ___, 2011 WL 4793149 (Fed. Cir. 2011)

“It is the claims that define the metes and bounds of the patentee's invention. *Phillips*, 415 F.3d at 1313. The patentee is free to choose a broad term and expect to obtain the full scope of its plain and ordinary meaning unless the patentee explicitly redefines the term or disavows its full scope.” *Thorner v. Sony Computer Entertainment America LLC* (Fed.Cir. Feb. 1, 2012)

The judges determining claim validity in *inter partes* reviews should be working under the same body of law as the judges determining claim validity in district court. It is entirely contrary to the integrity of the patent system to interpret a claim one way for invalidating it in an *inter partes* review and interpreting that claim in a different and narrower way when the patentee seeks to enforce the patent in court. For example, as Supreme Court Justice Bradley famously stated:

Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the

purpose of better understanding the meaning of the claim; but not for the purpose of changing it, and making it different from what it is. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. This has been so often expressed in the opinions of this court that it is unnecessary to pursue the subject further.

White v. Dunbar, 119 U.S. 47 (1886).

The new statute grants the Office an opportunity to abide by this fundamental principle of patent law long established in the U.S. Supreme Court. Indeed, the statute goes further to impose the principle on patent owners. Pursuant to 35 U.S.C. 301(d), in-court statements of claim scope by Patent Owner may be used to establish the claim scope in an *inter partes* review, once instituted. Consequently, overbroad assertions of claim scope by the patent owner in court may be used by the Board in evaluating patentability of the claims. The statute recognizes that the claim scope sought to be used to establish infringement ought to be the same as that used to evaluate validity in *inter partes* review.

35 U.S.C.316 (b) provides: “In prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system...” Certainty of claim construction promotes the economy and the integrity of the patent system. A single rubric for claim construction should be applied by the judges of the PTAB and the judges of the district courts.

At this time, it is suggested that the best solution toward providing certainty in claim construction would be to delete Rule 42.100(b) and its counterpart 42.200(b). The claim construction decisions of the judges of the PTAB and the district courts should all lead to the Federal Circuit Court of Appeals which should work harder to create a more certain understanding of patent claims. The Federal Circuit will be enriched and informed by the PTAB judges, instead of relegating their claim constructions to a different status irrelevant to litigation.

Rule 42.108 Should be Modified

Rule 42.108 deprives the Patent Owner of a final determination of validity as to grounds raised by a petitioner, but which are refused review by the Board. In most circumstances, Patent Owner will be pleased that the *inter partes* review has been streamlined. But other Patent Owners will be frustrated by the need to win approval of its claims through completion of an *inter partes* review and yet be faced with the possibility of needing to overcome the excluded challenges in court. Estoppel only applies to the grounds which were raised or could have been raised in the *inter partes* review. The grounds refused review by the Board could not be raised in the *inter partes* review as the rules now stand. The PTO rules should give the Patent Owner the option to

bring into the *inter partes* review the challenges denied entry by the Board. In this way, the Patent Owner can seek a final determination of validity so that success results in a more complete estoppel that will preclude the petitioner from re-litigating these validity questions.

In order to streamline the PGR and IPR procedures, the proposed rules permit going forward with a review only “on all or some of the challenged claims and on all or some of the grounds of unpatentability asserted for each claim.” “Any claim or issue not included in the authorization for review is not part of the review.” (Fed.Reg. vol. 77, no. 28, 7046) The refusal to go forward may be the subject of a request for rehearing before the Board, but the Board’s determination on whether to institute a trial is final and nonappealable.

Estoppel arises from an *inter partes* review of a claim only as to any ground that the petitioner raised or reasonably could have raised during the *inter partes* review. 35 USC 315(c) (2). Presumably, a petitioner prevented by Rule 42.108 from raising a ground or challenging a claim would not be subject to estoppel as to the ground or the claim excluded from the *inter partes* review. While admittedly such challenges would be expected to be weak, it is entirely possible for the petitioner to raise those grounds or challenge that claim in litigation in the courts. Indeed, petitioner could bolster its challenge with live expert testimony thereby imposing the burdens and costs of litigation in court to fight off these additional validity defenses even though the PTAB thought the challenge was unlikely to succeed.

The PTO rules should be modified to allow Patent Owner to accept into an *inter partes* review, challenges to claims or grounds which the PTAB decides fail to meet the reasonable likelihood of prevailing standard. The statute 35 USC 314(a) expressly permits the *inter partes* review to proceed whenever “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

The large majority of Patent Owners will welcome the streamlined *inter partes* review and will happily proceed through the *inter partes* review solely on the claims and grounds permitted by the PTAB. Nevertheless, some Patent Owners may foresee the potential for protracted and expanded patent litigation and the possibility that they will again face the grounds raised by the petitioner but which will not be determined in a final written decision under section 318(a). For example, petitioner challenges independent claim 1 and dependent claims 2-4 and the *inter partes* review only proceeds on claims 1-3. Patent Owner may lose claims 1-3 and seek to stop infringement of claim 4. It is unfair to make Patent Owner fight an entire *inter partes* review on the patent, only to need to revisit validity in court as to the narrow claim that remains infringed. As the PTO has recognized, one goal should be to provide “more coordination between district court infringement litigation and *inter partes* review to reduce duplication of efforts and costs.” Federal Register, vol. 77, no. 28, p. 7055. The PTO rules should give the Patent Owner the option to bring into the *inter partes* review the failed challenges from the petition. In this way, the Patent Owner can receive a final determination of validity resulting in estoppel against the petitioner.