

**From:** Bernard Shay  
**To:** [PTABNPR2018](#)  
**Subject:** PTAB Notice of Proposed Rulemaking 2018  
**Date:** Monday, July 9, 2018 5:46:34 PM

---

Director of the United States Patent and Trademark Office  
Attention: Vice Chief Administrative Patent Judges Michael Tierney & Jacqueline Wright Bonilla  
PTAB Notice of Proposed Rulemaking 2018

To Whom It May Concern,

Earlens Corporation is a medical device startup employing approximately 100 people in California and throughout the United States. Earlens has developed the world's only light-driven hearing technology which delivers the broadest frequency range available for clear, natural sound. The Earlens Hearing Aid uses light and a small Lens is placed in your ear canal to activate your natural hearing system. By using non-visible light to gently vibrate the eardrum, Earlens provides the most complete sound of any hearing aid on the market, with crisp highs and full lows.

As users of the patent system who view our patent portfolio as one of our most important assets, we are writing today to provide comments on the PTAB Notice of Proposed Rulemaking (2018). In particular, we support the proposal of the United States Patent and Trademark Office (Office) to alter its claim construction standard used for interpreting inter parties review (IPR), post-grant review (PGR), and the transitional program for covered business method patents (CBM) proceedings before the Patent Trial and Appeal Board (PTAB). We further support the proposal to replace the broadest reasonable interpretation standard (BRI) for constructing unexpired patent claims that are used by the PTAB in IPR, PGR, and CBM with the Phillips standard, which is the standard the Federal Circuit Courts and International Trade Commission (ITC) use when interpreting patents. As we view it, these changes will promote a "fair and balanced approach, providing greater predictability and certainty in the patent system" which will, in turn, increase judicial efficiency and reduce economic waste.

As you are aware, sound patent policy depends on consistency in interpreting patent claims. Sound patent policy is dependent on interpretive consistency, which is why the Supreme Court ruled that the court, rather than a jury, should be the sole adjudicator in claim construction disputes. It is logical then, that claim construction interpretation would be consistent across adjudicatory bodies. In addition, we believe that ensuring that there is a consistent patent review process will elevate U.S. industry because clarity in patent interpretation provides stability and predictability for patent holders. Further, a predictable patent process will create a level of confidence with innovators, which will make them more likely to bring their patentable inventions to market. Finally, predictability will also diminish risk aversion, and thereby encourage entrepreneurs to invest in new technologies.

Under the current rules, the application of BRI and Phillips standard in different forums unfairly advantages the patent challenger. Challengers can argue for a broad scope before the PTAB then turn around and argue a narrow scope in district court. This ability to shift arguments creates lose-

lose scenario for patent holders. Patent holders must defend their patents in a broad claim construction standard for adjudicating validity in the PTAB, and a narrow claim construction standard when assessing infringement in district court. Further, 86.8 percent of patents at issue with the America Invents Act (AIA) trial proceedings also have been subject to litigation in the federal courts. The current legal standard encourages challengers to bring the same patent holder to court in both forums. Such trends exhibit extreme inefficiency in the courts and extreme waste of patent-holder dollars.

In our view, uniformity of standards will reduce the number of duplicative challenges across forums, therefore freeing court schedules and allowing courts to make more immediate decisions on patent claims. In addition, swifter decision making and an inability to forum shop, or retry a case from another angle, will save entrepreneurial dollars, court time, and promote a more business-friendly environment for those considering filing future patents.

The Phillips standard considers a claim from the standpoint of a person of ordinary skill in the art, in light of the specification and prosecution history of the patents. In contrast, the BRI standard considers the broadest reasonable construction in light of the specification, which at times allows the court to read the patent coverage more broadly than intended upon conception. Because the Phillips standard relies on discovering the actual meaning of the claim, instead of its most expansive meaning, the patent is less likely to give broader coverage than is justified. The Phillips standard makes claim construction more consistent and predictable, and is more appropriate for adjudication of patent validity at the PTAB than the BRI standard. The proposed shift to the Phillips standard should extend to all pending PTAB trial proceedings in which PTAB has jurisdiction in order to discourage tactical filing before or after the rule change.

Thank you for taking the time to consider our input.

Bernard E. Shay  
General Counsel  
Earlens Corporation  
Phone: 650 739-4475

**PRIVILEGED AND CONFIDENTIAL COMMUNICATION** This electronic transmission, and any documents attached hereto, may contain confidential and/or legally privileged information. The information is intended only for use by the recipient named above. If you have received this electronic message in error, please notify the sender and delete the electronic message. Any disclosure, copying, distribution, or use of the contents of information received in error is strictly prohibited.