



June 28, 2018

Attn: Vice Chief Administrative Patent Judges Michael Tierney and Jacqueline Wright Bonilla,  
PTAB Notice of Proposed Rulemaking 2018  
Director of the United States Patent and Trademark Office  
Alexandria, VA 22131-1450

Submitted via email: [PTABNPR2018@uspto.gov](mailto:PTABNPR2018@uspto.gov)

**Re: Proposed Change to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board**

Telefonaktiebolaget LM Ericsson (“Ericsson”) is pleased to submit the following comments on the proposed change to the claim construction standard for interpreting claims in trial proceedings before the Patent Trial and Appeal Board (PTAB). Ericsson’s interest in the proposed change stems from its significant ongoing investment in research and development and patent protection thereof. Ericsson has been a major contributor to the development of global standards for mobile telecommunications for more than 30 years and has invested tens of billions of dollars in this effort. The continued viability of investment in standards development and wireless communication implementations depends upon licensing agreements regarding such patented technology. Accordingly, a fair and balanced approach to America Invents Act (AIA) trial proceedings before the PTAB, providing greater predictability and certainty with respect to claim interpretation, is highly desirable.

The purpose of the proposed change is to replace the Broadest Reasonable Interpretation (BRI)<sup>1</sup> standard for interpreting claim language in *inter partes* review (IPR) and other proceedings before the PTAB with the same standard utilized by Article III federal courts and the International Trade Commission (ITC). As such, the proposed post-grant claim interpretation standard would follow the standard articulated by the United States Court of Appeals for the Federal Circuit in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). Under the framework of *Phillips*, claim language is construed in

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<sup>1</sup> 37 CFR 42.100(b), 42.200(b), and 42.300(b) (“A claim in an unexpired patent that will not expire before a final written decision is issued shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.”)



accordance with the ordinary and customary meaning of a recitation as understood by one of ordinary skill in the art.<sup>2</sup> The patent specification acts as a dictionary when it expressly defines claim terms.<sup>3</sup> Further, prosecution history is used as intrinsic evidence to aid in claim term definition to demonstrate how the inventor(s) understood the invention.<sup>4</sup>

Ericsson agrees with the rationale presented in the proposed change stating that conformance of the claim construction standard of the PTAB with that of federal courts and the ITC provides consistency and predictability of a patent grant. Interpreting granted claim language differently within various fora creates confusion with regards to the scope of patent protection. For example, prior art raised in an IPR using the BRI standard may be completely different from that which is cited in a validity challenge in the district court, depending on the corresponding claim interpretations. The BRI standard results in an unnecessarily broad claim scope interpretation that opens the door to a much larger universe of prior art, as compared to the *Phillips* standard. Thus, a validity challenge in district court requires a completely distinct analysis and/or application of potentially inconsistent prior art, as compared to an IPR proceeding. It follows, therefore, that use of the identical standard in AIA trial proceedings and federal civil litigation should result in greater judicial efficiency, since district court judges can apply the same rationale with respect to claim interpretation as that of the PTAB judge and vice versa.

In addition, the proposed change correctly points out the inherent inequity of applying these distinct interpretation standards: a patent claim could be found invalid by the PTAB using a claim scope that could not be asserted in an infringement proceeding in district court. Therefore, Ericsson agrees with the proposed change and believes that applying the *Phillips* standard provides fair and efficient PTAB trial proceedings resulting in more predictable claim interpretation. We appreciate the opportunity to provide these comments on the and thank the USPTO for their consideration.

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<sup>2</sup> The “words of a claim are generally given their ordinary and customary meaning,” which is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention....” *Phillips*, 415 F.3d at 1312-1313.

<sup>3</sup> The specification is “the single best guide to the meaning of a disputed term and ... acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication.” *Id.* at 1321.

<sup>4</sup> Prosecution history can “inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be.” *Id.* at 1317.



Sincerely,

A handwritten signature in black ink that reads "Roger Burleigh". The signature is written in a cursive style.

Roger S. Burleigh

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