

July 9, 2018

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The Honorable Andrei Iancu
Under Secretary of Commerce for Intellectual Property
Director of the United States Patent and Trademark Office
USPTO Madison Building
600 Dulany Street
Alexandria, VA 22314

Dear Director Iancu:

RE: Proposed Rule Docket No. PTO-P-2018-0036: Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board

The Federal Circuit Bar Association (“FCBA”) appreciates the opportunity to comment on the USPTO’s proposed rule amending the existing rules relating to the USPTO trial practice.

The FCBA, a national bar association, unites the different interests drawn before the Court of Appeals for the Federal Circuit (CAFC) and the tribunals which it reviews. Congress conferred on the Federal Circuit national appellate jurisdiction in a number of complex litigation areas, including matters involving intellectual property. The FCBA seeks to serve the administration of justice in the CAFC by maintaining and raising the standards of proficiency, integrity, and ethics in the practice of law before the Federal Circuit. In the context of this letter, we speak on behalf of our private sector members. Given their own roles, government members have not participated in the preparation or submission of this letter.

The FCBA takes no position on the proposed change from “broadest reasonable interpretation” (BRI) to the *Phillips* standard. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1311 (Fed. Cir. 2005) (en banc). However, the FCBA respectfully suggests that the Office consider the following issues in consideration of the proposed rule. Specifically, we urge the Office: (1) to delete the proposed rule’s characterization of the *Phillips* standard, and also to clarify that the proposed rule refers only to civil actions construing patented claims, and (2) to apply the proposed rule, if adopted, prospectively only.

1. The proposed rule. In pertinent part, the proposed rule states that claims “shall be construed using the same claim construction standard that would be used to construe such claim in a civil action to invalidate a patent under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.”

The FCBA suggests that the language be altered by striking all language after the phrase “a civil action,” and by revising “to construe such claim in a civil claim of a patent in a civil action.” As revised, this text would read: claims “shall be construed using the same claim construction standard that would be used to construe a claim of a patent in a civil action.” There are several reasons why we propose these changes.

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First, changing “to construe such claim in a civil action” to “to construe a claim of a patent in a civil action” excludes 35 U.S.C. §145 civil actions because §145 actions do not involve patents. A “broadest reasonable interpretation” standard has been applied to §145 actions. Revising the proposed rule to refer only to civil actions involving patents excludes §145 actions, and thereby avoids ambiguity as to the proposed rule’s definition of the claim construction standard.

Second, the modifier “to invalidate a patent under 35 U.S.C. 282(b)” risks confusion. The same claim construction standards apply in both civil actions brought to enforce the patent against infringement (whether or not invalidity is asserted as a defense) and also a declaratory judgment action brought to invalidate a patent. This language in the proposed rule appears, however, to refer only to the latter type of civil action. That risks confusion. Also, this language is unnecessary. Without it, the proposed rule will refer clearly to the claim-construction standard applied in both infringement actions and invalidity declaratory judgment actions.

Third, the “including” language risks confusion on how claims are construed in civil actions as discussed below. For example, adding this “including” language, or any other language in its place, could create uncertainty as to whether the Board’s claim construction standard differs from that of district courts even if that is not the proposed rule’s intention. The proposed rule would better achieve its stated purpose of aligning Board claim constructions with district court claim constructions without this “including” language.

The “including” language can be read contrary to controlling Federal Circuit law for means-plus-function limitations that invoke 35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. § 112, sixth paragraph. Such claim limitations are *not* construed in accordance with the ordinary and customary meaning. *See Phillips*, 415 F.3d at 1311 (construing “baffles” under standard claim-construction rules only after determining that the term did not invoke 35 U.S.C. § 112, ¶ 6.)

The “including” language can also be read as contrary to controlling Federal Circuit case law that does not apply the ordinary and customary meaning. Such instances include:

- a) “when a patentee sets out a definition and acts as his own lexicographer.” *Thorner v. Sony Comput. Entm’t Am. LLC*, 669 F.3d 1362, 1365-66 (Fed. Cir. 2012). As the Federal Circuit has explained: “To act as its own lexicographer, a patentee must ‘clearly set forth a definition of the disputed claim term’ other than its plain and ordinary meaning,” and “‘clearly express an intent to’ redefine the term.” *Id.*; *see Phillips*, 415 F.3d at 1316 (“our cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor’s lexicography governs.”);

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- b) “when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” *Thorner*, 669 F.3d at 1365-66. As the Federal Circuit has explained: “The patentee may demonstrate intent to deviate from the ordinary and accustomed meaning of a claim term by including in the specification expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.” *Id.* (quoting *Teleflex, Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002)); see *Phillips*, 415 F.3d at 1316 (“the specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor. In that instance as well, the inventor has dictated the correct claim scope, and the inventor’s intention, as expressed in the specification, is regarded as dispositive.”); *Pacing Techs., LLC v. Garmin Int’l, Inc.*, 778 F.3d 1021, 1024 (Fed. Cir. 2015) (the Federal Circuit has “found disavowal or disclaimer based on clear and unmistakable statements by the patentee that limit the claims, such as ‘the present invention includes ...’ or ‘the present invention is ...’ or ‘all embodiments of the present invention are....’”).

Although the “including” language mentions the prosecution history, it omits mention of the specification’s role in claim construction -- even though “the specification ‘is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.’” *Phillips*, 415 F.3d at 1315 (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). In contrast, “because the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the specification and thus is less useful for claim construction purposes.” *Id.* at 1317.

The “including” language also does not mention extrinsic evidence which may need to be consulted in certain cases. As the Supreme Court has explained: “In some cases, however, the district court will need to look beyond the patent’s intrinsic evidence and to consult extrinsic evidence in order to understand, for example, the background science or the meaning of a term in the relevant art during the relevant time period.” *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 841 (2015).

Further, the “including” language does not make clear that the acontextual customary meaning of claim language, *i.e.* its meaning independent of the patent, is *not* the proper inquiry. As the Federal Circuit has explained, “[p]roperly viewed, the ‘ordinary meaning’ of a claim term is its meaning to the ordinary artisan after reading the entire patent.” *Phillips*, 415 F.3d at 1321.

The “including” language also makes no mention of the patent’s “invention,” even though “[u]ltimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim. The construction that stays true to the claim language and most naturally aligns with the patent’s description of the invention will be, in the end, the correct construction.” *Id.* at 1316 (quoting *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998)); see also *United States v. Adams*, 383 U.S. 39, 49, (1966) (“[I]t is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention.”) (quoted at *Phillips*, 415 F.3d at 1316.).

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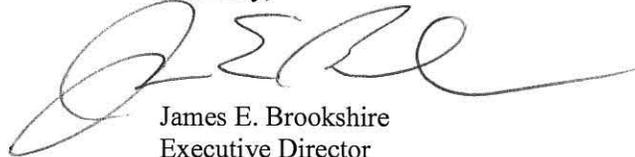
Finally, the “including” language refers to the ordinary and customary meaning “of such claim” rather than to the ordinary and customary meaning of claim terms. Patent claims themselves have no customary meaning.

2. Period of Applicability. If PTO determines to implement the change from BRI to the *Phillips* standard, we support only the prospective application of this standard. The Notice of proposed rulemaking states: “the Office intends that any proposed rule changes adopted in a final rule would be applied to all pending IPR, PGR, and CBM proceedings before PTAB.” Proposed Rule Docket No. PTO-P-2018-0036 at 13.

Application to all pending proceedings, no matter the stage of the proceeding, may raise due process concerns and risk requiring new Final Written Decisions, new Oral Arguments, new briefing, new depositions, new declarations, and even new institution decisions. At the very least, it may cause one or both parties to seek new procedures to account for the new claim-construction standard. This is so even if, in most cases, the final claim construction would not change under the new claim-construction standard, in part because the Board’s *Phillips* claim construction may in effect bind the parties in district court litigation, where the Board’s BRI construction would not. Such disruptions would occur, moreover, close on the heels of the adjustments necessitated by *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018). We therefore recommend, if PTO determines to change the standard, the final version of the proposed rule be applicable to all proceedings for petitions pursuant to 37 CFR Part 42 that are accorded a filing date after the effective date of the proposed rule change.

Thank you for your consideration of our comments. We express our own appreciation to those dedicated members of the Association whose thoughtful reflection led to these comments. If we can provide further information, please do not hesitate to let us know.

Sincerely,



James E. Brookshire
Executive Director