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Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board

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General Comment

This change is a small step toward restoring reliable patent rights. Under current policy, the carefully chosen words - the "claimed invention" - are stretched beyond what was intended (and originally approved by the PTO). The current approach effectively charges the inventor of attempting to claim the prior art, and typically results in the draconian punishment of loss of his patent right. While it is fine to poke and prod and test proposed claim language for ambiguity during examination, it is entirely improper after the patent right has been granted.

Once a patent is granted and published the grand bargain is consummated. The inventor has done his part and shared his discovery. The PTO has done its part and granted the time-limited exclusive right. The time for fussing over the vocabulary and grammar is past, as far as the PTO is concerned.

I note that in the supplementary information the Office has gingerly approved of the Phillips doctrine of construing claims to preserve the validity of the patent, noting that [the court has] certainly not endorsed a regime in which validity analysis is a regular component of claim construction. I submit the cautionary approach here is unwarranted. In fact the PTO should be in the business applying every reasonable effort to defend and uphold its work product. If a claim can be reasonably construed to preserve the validity, and if the patent owner disclaims the broader construction, then the Office should adopt the narrower construction that preserves the validity of the patent. If the petitioner wants to proceed with a construction which the patent owner affirmatively disclaims, then they can do that in the infringement action in district court. The PTO can do its job and serve the public by making a record of the patent owner disclaimer of the broader construction, thereby placing that subject matter clearly into the public domain without

destroying any valid patent rights.

Proponents of BRI point to the importance of forcing clarity through amendment. This is a rabbit hole. The English language, all languages, are inherently subjective. My wife and I have been married for 23 years yet still (occasionally) have disagreements over the meanings of the words we use. In a patent claim words are used describe the limits of the invention. It could be 30 words or 30,000 words. Industry has adopted a rule of thumb that a good claim should be the length of one's thumb. Yet no matter how many words are used, there is going to be some subjectivity with reasonable judgment and sensibility required to ascertain the precise boundary line. The idea of continuously improving the language used during the term of the patent is unworkable. It will never reach perfection. The drafting and negotiation over the language must come to an end. It should not be debated until the end of the patent term, nor the middle of the patent term, nor at the first anniversary of the patent term. It must end at the beginning of the patent term when the grant is signed and sealed!

A petitioner will continuously attempt to broaden the meaning of the words no matter how carefully they have been drafted, revised, and/or amended. They will not stop until the only surviving claims are unduly narrow. Then they are happy because the plain and ordinary meaning of the claim is much narrower than the true invention while the broadened meaning reaches to the prior art. This leaves open the territory rightly belonging to the inventor for use by the petitioner or their beneficiary to practice the invention without authorization, because the BRI policy prevented the inventor from securing his exclusive right.

In light of the above the current policy of applying BRI in disputes over issued patent claims should be ended because it undermines the integrity of the patent system in violation of paragraph (b) of section 326 of the Patent Act.

I also support consideration of prior claim constructions in AIA trials. Moreover, the Office should not only "consider" prior claim constructions, but should expressly adopt them unless the moving party demonstrates a clear error in the prior construction.