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Comment On: PTO-P-2018-0036-0001

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

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Comment on FR Doc # 2018-09821

Submitter Information

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General Comment

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To: United States Patent & Trademark Office

From: Michael Risch, Villanova University Charles Widger School of Law

Re: Request for Comments re Claim Construction in post-grant PTAB Proceedings

Docket No. PTO-P-2018-0036

I respectfully submit my comments in response to the above request for comments. These comments are based in part on an article I published more than a decade ago, but that is still relevant today: Michael Risch, *The Failure of Public Notice in Patent Prosecution*, 21 HARV. J.L. & TECH. 179 (2007).

In *The Failure of Public Notice in Patent Prosecution*, I highlight several reasons why the broadest reasonable construction rule does not, in fact, make patents more clear or otherwise alleviate uncertainty. Some of the suggestions in my paper have since come to fruition, including enhanced description and enablement requirements, as well as an expanded notion of obviousness post-KSR. But I harbor no illusion that the Office will abandon this rule for patent prosecution; those are comments for another day.

That said, it will therefore come as no surprise that I strongly support the abandonment of the broadest reasonable construction method for post-grant proceedings. First, all of the failings of the rule continue in post-grant proceedings, including surprising meanings that the patentee never intended and the potential for over-breadth if a patent does happen to survive.

Second, the benefit of the broadest reasonable construction rule, if there is one, is the ability to sweep in additional prior art during examination, so that the examiner can force narrowing and clarifying amendments by the patent applicant. Through the iterative process, patent clarity and breadth are supposed to be refined by such back and forth.

But these benefits disappear post-grant. There is no iterative process. There is no clarity goal. The only goal is determining patent validity, and the only stakes are later assertion in court under the ordinary meaning standard. Although amendment might be allowed in post-grant proceedings (more so now), intervening rights limit the patentee's assertion ability. As a result, under the current standard, the post-grant review winds up being a one-way opportunity for alleged infringers to invalidate patents on theories of patent breadth that will never be asserted against them, while providing none of the theorized public notice benefits that are supposed to come with the iterative process.

Given that the benefits of broadest reasonable construction are unavailable, and the costs distort the core question at issue whether the patent as asserted is valid in a way that actually matters for infringement I believe that the USPTO should adopt new rules stating that patents are to be interpreted as an ordinary PHOSITA would understand them.

Very truly yours,
Michael Risch