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Via email: PTABNPR2018@uspto.gov

Mail Stop Patent Board
Director of the United States Patent and Trademark Office
P.O. Box 1450 Alexandria, Virginia 22313-1450

Attn: Vice Chief Administrative Patent Judges Michael Tierney and Jacqueline Wright Bonilla,
PTAB Notice of Proposed Rulemaking 2018

Re: Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings
Before the PTAB

I write as a former Solicitor and Administrative Patent Judge to respond to the Office's invitation for comments on its Notice of Proposed Rulemaking regarding Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, published at 83 Fed. Reg. 21221 (PTO-P-2018-0036, May 9, 2018) ("Notice"). I thank the Office for the opportunity to comment on the proposal.

I applaud the Office for its proposal to change the claim construction standard from BRI to that applied by district courts under *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). In many cases, applying these two constructions will yield the same result. Nevertheless, the existence of a difference -- if only in name -- has been relied on to justify all but ignoring how a district court or the Federal Circuit in an earlier appeal has previously construed a claim and to justify ultimately reaching a different result regarding validity. Further, the PTAB's claim constructions have often been based on varying claim construction standards, taking into consideration some factors identified in *Phillips* but not others. That approach has resulted in uncertainty regarding how claims will be construed by the PTAB.

I understand the proposed change is limited to post-grant proceedings under the AIA. Given that IPR petitioners are using *ex parte* reexamination to challenge issued claims when the PTAB has declined to invalidate them in one or more previous IPRs, the Office should also require the CRU to use the *Phillips* claim construction standard in *ex parte* reexaminations (at least in those requested by a third party). Otherwise petitioners will be able to circumvent a prior court claim construction under *Phillips* by using an *ex parte* reexamination rather than an AIA proceeding to invalidate claims thereby frustrating the purposes the Office has identified for applying *Phillips* rather than BRI.

While not part of the Notice, the Office should also consider making other changes in post-grant proceedings that would further harmonize those proceedings with federal court litigation. Those changes include (1) giving issued claims a presumption of validity (necessitating clear and

convincing evidence to invalidate an issued patent claim) and (2) coupled to adopting the presumption, eliminating claim amendments during post-grant review proceedings (including third-party requested reexamination). While such changes likely will require statutory changes, they would make post-grant proceedings a truly fair and effective alternative to federal court litigation. It simply makes no sense to include claim amendments in a trial-like procedure. While the Office does not address this issue in its present proposal, it should consider doing so as part of its ongoing effort to provide “greater uniformity and predictability in the patent system.” 83 Fed. Reg. 21223.

Best Regards,

A handwritten signature in blue ink, appearing to read "Nancy J. Linck". The signature is fluid and cursive, with a long horizontal stroke at the beginning and a distinct loop at the end.

Nancy J. Linck