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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  
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  
invalidates 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,

Nancy J. Linck