

From: Robert Asher
To: [PTABNPR2018](#)
Subject: Comments of Robert M. Asher re: Changes to Claim Construction Standard [Docket No. PTO-P-2018-0036]
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Mail Stop Patent Board
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Attn: Vice Chief Administrative Patent judges Michael Tierney or Jacqueline Wright Bonilla, PTAB
Via email: PTABNPR2018@uspto.gov

Re: **Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board [Docket No. PTO-P-2018-0036]**

I am Robert M. Asher, chair of Sunstein Kann Murphy & Timbers, LLP's Patent Office Litigation Group and co-chair of our Patent Practice Group. I am co-chair of the Patent Litigation subcommittee of the Intellectual Property committee of the Litigation Section of the American Bar Association. My experience with *inter partes* reviews includes designations as lead counsel in 19 *inter partes* reviews and numerous arguments before the PTAB and the Federal Circuit Court of Appeals. The views expressed below are my own individual views and are not to be attributed to any of my clients, firm or associations.

I write to address the confusion that may be caused by a hasty change in the claim construction standard. Particularly troublesome are the statements in the Federal Register Notice of Proposed Rulemaking, which asserts that for ambiguous claim language "consistent with *Phillips* and its progeny, the doctrine of construing claims to preserve their validity would apply to AIA trials." 83 Fed. Reg. 21223.

The Change to District Court Claim Construction

Before addressing the potential problem, let me register my agreement with the attempt to harmonize PTAB claim construction with district court claim construction. As I indicated in my comments submitted when *inter partes* reviews were first introduced, "By working towards a proper claim construction standard that can also be applied in court, the PTAB can help lead the way to greater certainty in claim construction. This can only happen if claim constructions in *inter partes* reviews and post grant reviews are conducted according to a rubric applicable in the courts. ..., such a unified approach to claim construction is called for by the AIA." Thus, I agree it makes sense for the PTAB to apply a district court claim standard when evaluating claims in an AIA trial.

It is also appropriate for the PTAB to consider any prior claim construction determination concerning a term of a patent claim made in a civil action, a proceeding before the International Trade Commission or the PTAB itself. Peculiar to AIA trials, consistency may further be enforced by considering for purpose of claim construction in the AIA trial, any statements made by a patent owner filed in such a prior proceeding in which the patent owner took a position on the scope of any claims of the challenged patent. 35 U.S.C. §301 (d).

Ambiguous Claims Under a New Standard

When it comes to ambiguous claim language, the PTAB is stepping into new territory when it proposes to follow district court claim construction. A district court may find a claim to be insolubly

ambiguous. The court may be unable to produce a reasonably certain claim construction when following the *Phillips* standard. In such situations, the district court need not construe the claim according to *Phillips*, but may instead rule the claim invalid for indefiniteness pursuant to section 112. This is an option unavailable to the PTAB under current law.

In the first several years of AIA proceedings, the PTAB has handled indefinite claims by refusing to institute with respect to those claims deemed indefinite. This was particularly noticeable for means-plus-function claims that lacked corresponding structure in the specification. More recently, the PTAB has been confronted with the impact of *SAS Institute v. Iancu*, 2018 WL 1914661 (U.S. Apr. 24, 2018). Indefinite claims are being thrust back into AIA proceedings after the PTAB adopted the practice of considering all claims challenged in a petition. Using the current broadest reasonable interpretation standard works well enough for interpreting indefinite claims. This is the practice that has been followed by the USPTO for decades in the examination of patent claims. It is addressed in the MPEP at section 2173. Having a claim rejected for indefiniteness and obviousness is not uncommon during prosecution. The applicant has an opportunity to amend and explain the claim to make its scope more clear and distinct over the cited prior art. This furthers the USPTO goal of using the patent prosecution process to establish a clear record of what the applicant intends to claim.

In moving to a district court claim construction standard, the public would not be well served by using *Phillips* to justify construing an insolubly ambiguous claim in a manner that preserves its validity. As indicated by the Office in the Federal Register notice, “Congress intended these administrative trial proceedings to provide “quick and cost effective alternatives” to litigation in the courts.” 83 Fed. Reg. 21223. To give an indefinite claim a free pass through an AIA proceeding would add cost, complexity and uncertainty.

Another undesirable approach would be to deny institution of a petition that includes a challenge to a claim deemed insolubly ambiguous. Such a drastic maneuver could prevent many legitimate challenges from being adjudicated expeditiously in the PTAB.

A **better approach** would be for the PTAB to announce in its institution decision that certain claim language is incapable of construction, and that therefore *Phillips* does not apply. The claim will be given a broad ordinary meaning for the purposes of applying the prior art against the claim. This approach gives the patent owner proper notice so that it may move to amend the claim language as needed. Petitioner is also fairly treated by permitting the challenge to the claim to potentially be resolved in the AIA proceeding rather than forcing it to go back into district court to finally raise an indefiniteness challenge to the claims. Applying a broad ordinary meaning to vague and ambiguous claim language is consistent with moving to a district court claim construction standard because a district court would not have any claim construction for the claim. The claim would be invalidated for indefiniteness. Thus, there is no district court claim construction standard applicable to indefinite claims. The PTAB is the first to be presented with the task of construing claims that cannot be construed with a reasonable certainty. This is a matter of first impression. The PTAB should be free to establish its own approach to such claims under the direction of the Federal Circuit Court of Appeals.

Conclusion

I urge the PTO to announce an approach for its administrative patent judges to take during AIA proceedings with respect to insolubly ambiguous claims and means-plus-function claims lacking corresponding structure in the specification. The resulting consistency will be beneficial to all parties. At the very least, the PTO should clarify that indefinite claims will not be saved by fabricating a claim construction under the guise of applying *Phillips*. If indefinite claims continue to pose problems, it may be useful for the USPTO to lobby Congress for a statutory change that allows all AIA proceedings to rule on patentability pursuant to Section 35 U.S.C. 112 (b).

Respectfully submitted,

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