

To: Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office

From: Rochelle Dreyfuss, Pauline Newman Professor of Law
New York University School of Law

Re: Comments on Proposed Rule “Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board”;
Docket Number PTO-P-2018-0036

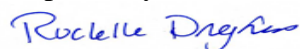
Date: July 6, 2018

Dear Director Iancu:

Thank you for the opportunity to comment on the proposed Patent and Trademark Office (PTO) rule to change the post-grant Patent Trial and Appeals Board (PTAB) standards for claim construction from the “broadest reasonable interpretation” (BRI) of the meaning of the claim terms read in light of the specification to the current methodology for claim interpretation used by the courts in construing issued patent claims in infringement actions – the *Phillips* methodology. See 83 Fed. Reg. 21221, 21226 (May 9, 2018) (proposing revisions to 37 C.F.R. §§ 42.100, 42.200, and 42.300). I am writing to endorse many of the comments made by Joshua Sarnoff and Shubha Ghosh in their July 6, 2018 submission. Like them, I support the idea of a unitary post-grant interpretive standard in the PTO and the courts. However, I believe the better rule is for both the PTO and the courts to use the BRI rather than the *Phillips* standard. If the courts cannot be convinced to move to the BRI, then the USPTO should propose legislation mandating that standard and do so in connection with revisions to the reissue provision to clarify the meaning of “through error” in 35 U.S.C. § 251(a).

In my view, the BRI has several advantages. It retains the error-correction function of post-grant procedures by allowing the PTAB to use the same standard used by examiners. More important, the BRI provides a better bench mark for construing claims because it combines a clear standard—broadest—with a degree of flexibility—reasonable. As Professor Sarnoff and Ghosh explained in their comment, the *Phillips* standard has led to a great deal of uncertainty and a loss of predictability, including disagreement among judges on the interpretation of particular claims. Finally, because the BRI can lead to broader claims and increase the chance of invalidation on account of prior art, its use will discipline future applicants to claim no more than that to which they are entitled. Patent holders can safeguard their interests through amendment in post-grant proceedings or—especially if the standard under § 251 is clarified—through reissue. See generally Rochelle Cooper Dreyfuss, *Giving the Federal Circuit a Run for Its Money: Challenging Patents in the PTAB*, 91 NOTRE DAME L. REV. 235, 268-271 (2015).

Respectfully submitted,



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