

Comments on the “Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act”

These comments present my thoughts and vision as to how the patent system could function more efficiently and predictably in view of the America Invents Act. The suggestions presented herein are my own, and are not those of my firm, any of its clients or anyone else. I understand that the PTO has initially taken a different view of claim construction in post grant and inter partes reviews. These procedures differ greatly from anything the PTO has done in the past, so I ask that the PTO consider the suggestions below with a fresh and open mind.

I. Clarification needed for “proper meaning” of a patent claim

The USPTO discussion of Rules 1.510 and 1.552 should clarify what is meant by “proper meaning of a patent claim.” 35 U.S.C. 301(d) provides:

A written statement submitted pursuant to subsection (a)(2), and additional information submitted pursuant to subsection (c), shall not be considered by the Office for any purpose other than to determine the proper meaning of a patent claim in a proceeding that is ordered or instituted pursuant to section 304, 314, or 324.

Whereas the “proper meaning” of patent claims will hereafter be determined in ex parte reexamination, post grant reviews and *inter partes* reviews, the same is not true for reissue applications which are not mentioned in 301(d). Reissue applications are patent applications filed by the patent owner and shall continue to be examined giving claims their “broadest reasonable construction consistent with the specification.”

The proper meaning of a claim has normally been the province of litigation. “To determine the proper meaning of claims, we first consider the so-called intrinsic evidence, i.e., the claims, the written description, and, if in evidence, the prosecution history.” *Digital Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1335, 1344 ((1998). “The proper construction of a patent’s claims is an issue of Federal Circuit law. . . To ascertain the scope and meaning of the asserted claims, we look to the words of the claims themselves, the specification, the prosecution history, and any relevant extrinsic evidence. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315-17 (Fed Cir. 2005).” *Absolute Software, Inc. v. Stealth Signal, Inc.*, ___ F.3d ___, 2011 WL 4793149 (Fed. Cir. 2011)

Post grant reviews and *inter partes* reviews will be trials. They are not patent applications. Unlike reissues, they are not filed by the patent owner, but rather are challenges to issued patents requested by third parties. The reviews are not conducted before a patent examiner, but rather in front of the Patent Trial and Appeal Board. A patent owner unhappy with the progress in a

reissue application may file a continuation of the reissue with new and amended claims. In a review, the only recourse is appeal to the Federal Circuit Court of Appeals.

It is contemplated that the ability to amend claims and add new claims in a review will be strictly limited. Proposed rule 42.207 states that the patent owner's preliminary response "shall not include any amendment." Rule 42.121 states that "A patent owner may file one motion to amend a patent but only after conferring with the Board. Any additional motions to amend may not be filed without Board authorization." There is little reason to conduct claim construction in a post-grant or *inter partes* review as if it were a patent application rather than a trial.

A. *In re Yamamoto* is inapplicable to post grant reviews and *inter partes* reviews.

For ex parte reexaminations, in 1984, *In re Yamamoto* applied the broadest reasonable construction as used in reissue applications. But the AIA separates out the post grant reissue applications from the other three post grant proceedings in 35 U.S.C. 301(d). *In re Yamamoto* emphasized the ability to amend in reissue applications and ex parte reexaminations.

The same policies warranting the PTO's approach to claim interpretation when an original application is involved have been held applicable to reissue proceedings because the reissue provision, 35 U.S.C. § 251, permits amendment of the claims to avoid prior art. *In re Reuter*, 651 F.2d at 756, 210 USPQ at 253-54.

In re Yamamoto, 740 F. 2d 1569, 1572 (Fed. Cir. 1984). As indicated above, the ability to amend is strictly limited in post-grant and *inter partes* review. The reviews are conducted before the PTAB rather than an examiner. Such restrictions distinguish the review proceedings from reissues.

Moreover, the standards of construction debated in *In re Yamamoto* are no longer at stake. The court ruling rejected the applicability in the USPTO of the Ninth Circuit's approach to claim construction in which "[t]he starting point is the rule that patent claims should be construed liberally to uphold the patent's validity rather than to destroy the inventor's right to protect the substance of his invention." This approach is not the starting point for claim construction under current law. For these reasons, the decision in *In re Yamamoto* is relatively inapplicable to post grant and *inter partes* review proceedings.

B. “Proper Meaning” of a Patent Claim has been Explained by the Federal Circuit

The proper meaning of a patent claim under current law is set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005). This has been recently explained in *Thorner v. Sony Computer Entertainment America LLC*, (Fed.Cir. Feb. 1, 2012):

The words of a claim are generally given their ordinary and customary meaning as understood by a person of ordinary skill in the art when read in the context of the specification and prosecution history. See [*Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 \(Fed. Cir. 2005\) \(en banc\)](#). There are only two exceptions to this general rule: 1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution. [*Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1580 \(Fed. Cir. 1996\)](#). ...

To act as its own lexicographer, a patentee must "clearly set forth a definition of the disputed claim term" other than its plain and ordinary meaning. [*CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 \(Fed. Cir. 2002\)](#). It is not enough for a patentee to simply disclose a single embodiment or use a word in the same manner in all embodiments, the patentee must "clearly express an intent" to redefine the term. [*Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1381 \(Fed. Cir. 2008\)](#); see also [*Kara Tech. Inc. v. Stamps.com*, 582 F.3d 1341, 1347-48 \(Fed. Cir. 2009\)](#). "[T]he inventor's written description of the invention, for example, is relevant and controlling insofar as it provides *clear lexicography* . . ." [*C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 862 \(Fed. Cir. 2004\)](#) (emphasis added). For example, in *3M Innovative Properties Co. v. Avery Dennison Corp.*, we held that the patentee acted as its own lexicographer when the specification stated: "'Multiple embossed' means two or more embossing patterns are superimposed on the web to create a complex pattern of differing depths of embossing." 350 F.3d 1365, 1369, 1371 (Fed. Cir. 2004). Similarly, we limited a patentee to particular examples of solubilizers when it stated in the specification that "[t]he solubilizers suitable according to the invention *are defined below*." [*Astrazeneca AB v. Mutual Pharm. Co.*, 384 F.3d 1333, 1339 \(Fed. Cir. 2004\)](#).

The standard for disavowal of claim scope is similarly exacting. "Where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question." [*Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 \(Fed. Cir. 2001\)](#). "The patentee may demonstrate intent to deviate from the ordinary and accustomed meaning of a claim term by including in the specification expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." [*Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325](#)

[\(Fed. Cir. 2002\)](#); *see also* [Home Diagnostics, Inc. v. LifeScan, Inc.](#), 381 F.3d 1352, 1358 (Fed. Cir. 2004) ("Absent a clear disavowal in the specification or the prosecution history, the patentee is entitled to the full scope of its claim language."). For example, in *Scimed*, the patentee described two different types of catheters in the prior art, those with dual lumens (side-by-side) and those with coaxial lumens. [242 F.3d at 1339](#). In discussing the prior art, the patentee disparaged the dual lumen configuration as larger than necessary and less pliable than the coaxial type. *Id.* at 1342. Further, the specification repeatedly described the "present invention" as a coaxial design. *Id.* Finally, the specification stated: "The intermediate sleeve structure defined above [coaxial design] is the basic sleeve structure for *all embodiments of the present invention contemplated and disclosed herein.*" *Id.* at 1343 (emphasis in original). This court held that collectively this amounted to disavowal of the dual lumen design.

Mere criticism of a particular embodiment encompassed in the plain meaning of a claim term is not sufficient to rise to the level of clear disavowal. [Epistar Corp. v. Int'l Trade Comm'n](#), 566 F.3d 1321, 1335 (Fed. Cir. 2009) (holding that even a direct criticism of a particular technique did not rise to the level of clear disavowal). In *Spine Solutions, Inc. v. Medtronic Sofamor Danek USA, Inc.*, we explained that even where a particular structure makes it "particularly difficult" to obtain certain benefits of the claimed invention, this does not rise to the level of disavowal of the structure. 620 F.3d 1305, 1315 (Fed. Cir. 2010). It is likewise not enough that the only embodiments, or all of the embodiments, contain a particular limitation. We do not read limitations from the specification into claims; we do not redefine words. Only the patentee can do that. To constitute disclaimer, there must be a clear and unmistakable disclaimer.

It is the claims that define the metes and bounds of the patentee's invention. [Phillips](#), [415 F.3d at 1313](#). The patentee is free to choose a broad term and expect to obtain the full scope of its plain and ordinary meaning unless the patentee explicitly redefines the term or disavows its full scope.

Once it is recognized that *In re Yamamoto* is not controlling on the question of the claim construction in post grant review and *inter partes* review, the PTO and the courts will need to address this question as one of first impression. As the PTO has recognized, one goal should be to provide "more coordination between district court infringement litigation and *inter partes* review to reduce duplication of efforts and costs." Federal Register, vol. 77, no. 28, p. 7055. The validity of a patent should not hinge on the difference in claim construction between the PTO and the courts. "The adverse effect on the patent incentive, due to uncertainty as to the validity of a duly granted patent, is notorious, and permeates the hearing record of the recently enacted America Invents Act." *In re Construction Equipment Co.*, 665 F.3d 1254, 1261 (Fed. Cir. 2011) (Newman dissenting)

For the PTO to construe claims with the full scope of their plain and ordinary meaning in view of the claim language, the specification, the prosecution history and extrinsic evidence as set out in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc) and *Thorner v. Sony Computer Entertainment America LLC* would best accomplish the desired coordination and certainty. For the Federal Circuit to issue validity rulings on patents construed under two different approaches complicates the law and can produce inconsistencies which threaten the integrity and credibility of the patent system. So now is the chance to harmonize invalidity proceedings in the PTO and the courts, at least as to claim construction.

The US Patent and Trademark Office should take a leadership role in guiding the United States to a patent system revered throughout the world for its fairness, consistency and credibility. 35 U.S.C.316 (b) provides: “In prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system,…” This is an opportunity for the PTO to steer the courts in the direction of a uniform claim construction for post-grant challenges to patents. The full scope of the plain and ordinary meaning approach is well within the capabilities of the administrative patent judges to apply in a manner that may have a stabilizing effect throughout the PTO and the courts. The AIA calls out the “proper meaning,” thus it is quite appropriate for the PTO to determine proper meaning as taught in the litigation context to evaluate claims in a trial of the validity of a patent.

C. Claim Construction in Ex Parte Reexaminations

As set forth in §1.510, the PTAB should determine the “proper meaning of a patent claim.” 35 U.S.C. 301(d) treats claim construction the same way for ex parte reexamination, post grant review and *inter partes* review. Therefore, the proper meaning of a claim as explained above with respect to post grant review and *inter partes* review will now also be applied in ex parte reexaminations in accordance with the 35 U.S.C. 301(d). This is indicative of a commonly held belief and congressional view and expectation that a patent claim of an issued patent has one proper meaning representing the scope of the inventor’s contribution.

D. Statements of Patent Owner

The PTO should give guidance as to how statements by a patent owner will be used with respect to the proper meaning of a patent claim. Let’s first consider Patent Owner statements seeking to narrow the scope of its claim to distinguish over prior art. When the statements were made during the prosecution to obtain the patent, they will often constitute prosecution disclaimer or prosecution history estoppel. Such statements may have been relied upon by the PTO to decide to allow the patent, therefore the allowable scope of the patent claims was effectively narrowed and should continue to be treated as narrowed. The PTO having knowingly accepted the claim in

view of the prosecution statements, issuance of the patent should not eliminate the effect of those statements. Such Patent Owner statements in the public record of the prosecution have always been used to limit the scope of a patent in litigation. These statements should similarly limit the proper meaning of a patent during the post grant patent challenge procedures.

Narrowing statements made in court, on the other hand, have no relevance to post grant proceedings in the PTO. If the court disagreed with the Patent Owner's statement and ruled that the claim is broader than the patent owner asserts, certainly the PTO should not be using the Patent Owner's discredited claim construction. If a court agrees with the Patent Owner statement regarding a narrowed claim construction, the PTO might follow the narrowed claim construction under its new mandate to apply proper meaning but if it does so it would be because of the court order not the Patent Owner statement.

If Patent Owner statements were made in favor of a broadened claim scope, the PTO should be provided with enough additional information from the proceeding so that it can understand the position that the Patent Owner took. If the Patent Owner took a position asserting an unreasonably broad interpretation for its patent claim, it appears that 35 U.S.C. 301(d) urges the PTO to use that position to broaden the proper meaning for the claim in post grant review, *inter partes* review and ex parte reexaminations. This law will thus contribute to discouraging patent owners from over-aggressively asserting their patents. The PTO will be put in a position to rectify the overbroad assertion of a patent, by cancelling the claims or requiring narrowing amendments to the claims to bring their scope back to reasonable and patentable limits. By explaining the pertinence of patent owner statements to these post grant proceedings, the PTO will help discourage overbroad assertions of patent claims and will provide helpful guidance as to what information should accompany a patent owner statement submitted under 35 U.S.C. 301(d).

E. Why Should the PTO take the Lead on Claim Construction

In re Yamamoto was a Federal Circuit decision, so why not wait for the Federal Circuit to address the question of claim construction in the newly formulated post-grant proceedings? It was the Board of Patent Appeals and Interferences who first addressed the question in *In re Yamamoto* and ruled in favor of broadest reasonable construction. It will be the Patent Trial and Appeal Board who first addresses the question of claim construction in the newly formulated proceedings. The PTO will need to take a position.

The PTO is uniquely qualified to look at the patent system as a whole and make determinations as to how it may be improved to serve the public interest. Courts do not have the luxury of reviewing and considering the system as a whole. Courts may act only on the cases and issues that come before them, one at a time. The Congress for its part simply does not have the

specialized expertise of the PTO. It is the PTO who should come forward with an approach to claim construction in view of the laws, which will support a better patent system.

F. What are the Benefits of a Unified Body of Claim Construction Law?

Prevent wasteful use of judicial resources –Under current practice a court can uphold a patent claim as valid using a proper meaning and the PTO can invalidate that claim as invalid using a broadest reasonable construction. The AIA offers a way out of this embarrassment.

Involvement of the technically trained and highly specialized APJ's of the PTAB in claim construction in a meaningful way

Restore a sense of certainty to claim scope

Provide PTAB claim constructions with persuasive value in the courts

Give precedential value in court to Federal Circuit claim constructions in appeals from post grant proceedings in the PTO

Give Federal Circuit claim constructions in court appeals precedential value in PTO post grant proceedings

Avoiding inconsistent rulings

Prevent the awkward situation for the Federal Circuit in which it interprets the same claim differently in two appeals to reach two different results

It is entirely contrary to the history of the patent system to interpret a claim one way for invalidating it in a post grant proceeding and interpreting that claim in a different and narrower way when the patentee seeks to enforce the patent in court. For example, as Supreme Court Justice Bradley famously stated:

Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim; but not for the purpose of changing it, and making it different from what it is. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. This has been so often expressed in the opinions of this court that it is unnecessary to pursue the subject further.

II. Correction to Rule 1.510(b)(2)

The rule should say for “For each statement of the patent owner and accompanying information submitted pursuant to §1.501(a)(2) which is relied upon ...” The proposed rule instead refers to accompanying information of the patent owner. There is nothing in rule 501 or the statute which limits the accompanying information to information of the patent owner. The information may include documents, pleadings or evidence from the proceeding that address the statement so that the PTO can properly interpret the significance of the patent owner’s statement. The information may come from others involved in the proceeding. The correction should be made to §1.510(b)(2).

III. Rule 1.510(b)(7) Should be Deleted or Amended

Rule 1.510(b)(7) unnecessarily discourages the practice of anonymous filing of ex parte reexaminations. The ability to file ex parte reexamination requests anonymously is valuable for achieving the public policy goal of eliminating invalid patents. A statement identifying the real parties in interest should not be required for filing a request for ex parte reexamination. The goal sought by the PTO could be achieved by demanding that any party receiving a final decision in an *inter partes* review or post grant review either withdraw challenges in a pending ex parte reexamination as to any claims that are the subject of the final decision or certify that neither it nor its privy filed an ex parte reexamination. Another alternative would be to require a requester to provide a statement such as set forth in 510(b)(7) only after an *inter partes* review or a post grant review has resulted in a final decision. Provisions should be made for filing the statement under seal with the PTO so as not to discourage anonymous parties from filing ex parte reexaminations.

Respectfully submitted,

Robert M. Asher, Reg. No. 30,445
Sunstein Kann Murphy & Timbers LLP
125 Summer Street
Boston MA 02110
617 443 9292
rasher@sunsteinlaw.com