

From: Hartz, Blake R.
To: [PTABNPR2018](#)
Subject: Comments on Proposed Rulemaking, Docket No. PTO-P-2018-0036 (83 Fed. Reg. 21221, May 9, 2018)
Date: Friday, May 11, 2018 9:16:05 AM

Dear Sir:

I write regarding the proposed changes to 37 CFR Part 42 regarding claim construction standards in certain PTAB proceedings.

The Notice of Proposed Rulemaking proposes the new language to be as follows:

“shall be construed using the same claim construction standard that would be used to construe such claim in a civil action to invalidate a patent under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. Any prior claim construction determination concerning a term of the claim in a civil action, or a proceeding before the International Trade Commission, that is timely made of record in the post-grant review proceeding will be considered.”

I suggest at least three changes to this language.

First, “in a civil action to invalidate a patent under 35 U.S.C. 282(b)” is an awkward and unclear phrasing, as Section 282 does not itself provide for a civil action. Instead, such actions are typically counterclaims or affirmative defenses in infringement actions (filed under Sections 281, 271) and/or filed as declaratory judgment suits. Furthermore, although the claim construction standards for infringement and validity would generally be treated in the same manner, there is some possibility that by explicitly referring to “a civil action to invalidate a patent” a different set of cases or standards specific to invalidity could be invoked at the PTAB. This would undermine the purpose of the rulemaking of harmonizing the interpretations between PTAB and district courts. A more accurate phrasing may be “in a civil action for infringement of, or to invalidate, the patent” or simply, “in a civil action.”

Second, “as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent” is potentially ambiguous. The grammar of “in the art and the prosecution history” is awkward. The person of skill can consider the prosecution history, but he is not “of ordinary skill in ... the prosecution history.” To the extent specifically mentioning the prosecution history is needed, it would be more in line with the case law (e.g., *Phillips*) to say “as understood by one of ordinary skill in the art pertaining to the patent, considering the specification, prosecution history, and relevant extrinsic evidence concerning scientific principles, technical terms, or the state of the art.” Alternatively or additionally, the temporal component of “at the time of the invention” or “as of the effective filing date of the patent” could be used in the first clause, but this is probably not necessary in view of the consensus on that issue in the cases.

Third, the consideration of prior claim construction determinations should also include prior determinations by the Office, for example in a prior PTAB proceeding. Although these would likely be

available as intrinsic evidence in the prosecution history, for purposes of clarity and completeness (and to avoid the argument that by expressing the civil action and ITC proceedings, other proceedings not mentioned are excluded), including “or the Board” after the “Commission” would make a more complete list.

Accordingly, I would propose the amended language to read as follows:

“shall be construed using the same claim construction standard that would be used to construe such claim in a civil action, including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art pertaining to the patent, considering the specification, prosecution history, and relevant extrinsic evidence concerning scientific principles, technical terms, or the state of the art. Any prior claim construction determination concerning a term of the claim in a civil action, or a proceeding before the International Trade Commission or the Board, that is timely made of record in the post-grant review proceeding will be considered.”

While the above modification is not intended to be a departure from the substantive meaning and intent expressed in the Notice of Proposed Rulemaking, the Rules would have additional clarity (and avoid certain interpretive disputes identified above) if rewritten in this way.

These comments are my personal opinion and are not made on behalf of my firm or any of its clients.

Best regards,
Blake

Blake R. Hartz | Attorney

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