
Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board

On October 11, 2018, the United States Patent and Trademark Office (“PTO”) published a final rule entitled “Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board” (Dkt. No. PTO-P-2018-0036) relating to the patent review mechanisms introduced as part of the America Invents Act of 2011. *Also available at* <https://www.gpo.gov/fdsys/pkg/FR-2018-10-11/pdf/2018-22006.pdf>

Therein, the PTO revises the claim construction standard for interpreting claims in the various patent review mechanisms, including in inter *partes* review (“IPR”) proceedings, from the “broadest reasonable interpretation” standard to the same claim construction standard that is used to construe utility patent claims in federal district court litigation and International Trade Commission (“ITC”) proceedings, which is set forth in the case *Philips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc) and its progeny.

The new standard will be applied to all PTO proceedings filed on or after November 13, 2018.

The PTO had previously faced criticism for promulgating a different standard during patent review proceedings than that used in federal court litigation that would apply to the same patents. The dispute culminated in the Supreme Court case *Cuozzo Speed Technologies, LLC v. Lee*, 136 S.Ct. 2131 (2016), in which the appellant argued that the “broadest reasonable interpretation” standard promulgated by the PTO was outside the authority of the PTO to issue. The Supreme Court held that the statutes authorizing the PTO to enact regulations concerning the patent review mechanisms were silent as to the standards required, and therefore denied *Cuozzo*’s challenges to the patent review regimes.

The PTO claims that, since *Cuozzo* was decided, it has had the benefit of additional examination of the IPR and other review proceeding regimes by the Federal Circuit Court of Appeals and federal district courts and sought to amend the promulgated “broadest reasonable interpretation” standard. Beginning in early 2018, the PTO solicited public comment on the proposed rule change. According to the PTO, the overwhelming response from the received comments was in support of the proposed change.

Claimed benefits of the rule change include (1) addressing the concern that the AIA patent review proceedings were potentially unfair due to the arguably broader standard and (2) better standardization between parallel proceedings in the federal courts and the PTO. This change was implemented over some commentators who expressed the criticism that even with harmonizing the standard for claim construction between the PTO proceedings and the federal courts, there would still inherently be inconsistencies in application and potential grounds for unfairness due to the process of claim construction still being different between the PTO and federal court proceedings.