
Federal Circuit Finds PTAB Can't Cancel Claims for Indefiniteness in IPR Proceedings

Samsung Elecs. Am., Inc. v. Prisia Eng'g Corp., No. 2019-1169, 2020 WL 543427 (Fed. Cir. Feb. 4, 2020)

By: Nick Wheeler & Reid Huefner | February 7, 2020

The Federal Circuit recently ruled the Patent Trial and Appeal Board (“the Board”) may not cancel claims for indefiniteness in an *inter partes* review (“IPR”) proceeding.¹ The Federal Circuit concluded while an IPR petition defines the scope of an IPR proceeding, the Board may not exceed its governing statutory provisions which limit the scope of an IPR to arguments raised under Section 102 (“anticipation”) or 103 (“obviousness”) grounds.

Prisia Engineering Corp. (“Prisia”) owns U.S. patent 8,650,591 (“the ’591 patent”) relating to apparatuses and methods for “generating a displayable edited video data stream from an original video data stream.”² After Prisia accused Samsung Electronics America, Inc. (“Samsung”) of infringement, Samsung petitioned the Board for an IPR on the ’591 patent. The Board, in its final written decision, found claim 11 unpatentable based on obviousness; but the Board did not analyze the patentability of claims 1–4 and 8 under anticipation or obviousness grounds because “the Board could not apply the prior art to the [indefinite] claims,”³ and, as such, the Board held that Samsung had not established that these indefinite claims were unpatentable under any of Samsung’s asserted grounds.

Samsung, on appeal, argued that the Board should have cancelled claims 1–4 and 8 for indefiniteness. The court rejected Samsung’s appeal, in light of the governing statutory provisions and the Supreme Court’s decision in *Cuozzo*, and determined that the Board may not exceed its statutory limits by “cancelling a patent claim for indefiniteness.”⁴ Samsung further asserted that post-institution the Board could hold claims indefinite based on the broad wording of Section 318(a) which directs the Board to “issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 316(d).” The court also found this argument unpersuasive—Section 318(a), in the context of the other IPR statutory provisions, only allows for the Board to issue a final written decision on grounds on which a petitioner may request institution on. The court further explained if the Board cannot determine a claim’s scope, the Board should either decline institution or conclude a decision could not be reached as to the merits of the claim.

Petitioners filing IPR petitions must now account for potentially losing on claims because terms may be deemed indefinite by the Board, thereby rendering the claim’s patentability unresolvable.

¹ *Samsung Elecs. Am., Inc. v. Prisia Eng'g Corp.*, No. 2019-1169, 2020 WL 543427, at *5 (Fed. Cir. Feb. 4, 2020).

² *Id.* at *2.

³ *Id.* at *4.

⁴ *Id.* at *4 (citing *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2141, 195 L. Ed. 2d 423 (2016)).