



**INTELLECTUAL PROPERTY LAW
ASSOCIATION OF CHICAGO**

July 2, 2018

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By electronic mail: PTABNPR2018@uspto.gov

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Attn: Vice Chief Administrative Patent Judges Michael Tierney or
Jacqueline Wright Bonilla

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PTAB Notice of Proposed Rulemaking 2018
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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RE: IPLAC Comments on Changes to the Claim Construction Standard for
Interpreting Claims in Trial Proceedings Before the Patent Trial and
Appeal Board
37 CFR Part 42

Dear Honorable Mr. Tierney and Honorable Ms. Bonilla:

**Paul Kitch
Immediate Past President**

The Intellectual Property Law Association of Chicago ("IPLAC") appreciates the opportunity to provide comments to the US Patent and Trademark Office ("USPTO") regarding the notice and request for comment entitled "Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board," as published on May 9, 2018 in the Federal Register (83 Fed. Reg. 90, 21221).

Founded in 1884, IPLAC is the country's oldest bar association devoted exclusively to intellectual property matters. Located in Chicago, a principal locus and forum for the nation's authors, artists, inventors, scholarly pursuits, arts, creativity, research and development, innovation, patenting, and patent litigation, IPLAC is a voluntary bar association of over 1,000 members with interests in the areas of patents, trademarks, copyrights, and trade secrets and the legal issues they present. Its members include attorneys in private and corporate practices before federal bars throughout the United States, the U.S. Patent and Trademark Office, and the U.S. Copyright Office. IPLAC offers the following comments and suggestions regarding the proposed changes to the rules of representation of others before the Patent and Trademark Office.

As an initial matter, IPLAC's members agree with the proposed rule to adopt the claim construction standard utilized in district court and International Trade Commission (ITC) litigation—i.e., the standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir.



2005) and its progeny—for IPR, PGR, and CBMR review proceedings. That said, IPLAC has identified two points that it believes are worthy of the USPTO’s consideration:

1. IPLAC believes that the last clause of the first sentence of each of 42 C.F.R. §§ 42.100(b), 42.200(b), and 42.300(b) invites confusion. These clauses state the claim construction standard “include[s] 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.” This clause, however, refers to some but not all of the *Phillips* factors. As such, this clause may suggest the recited factors in the proposed rule would take precedence over the remainder of the *Phillips* standard.

For example, *Phillips* states that “the specification is the single best guide to the meaning of a disputed term.” IPLAC is unsure why the proposed rule does not refer to this “single best guide” to a term’s meaning. Thus, rather than specifying some but not all *Phillips* factors in the proposed rule, IPLAC suggests the rule language be amended to either (1) identify all of the relevant factors to be considered (e.g., “including construing the claim using all the intrinsic and extrinsic evidence as permitted 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.”), or, more preferably, (2) simply delete the seemingly-superfluous phrase “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.”

2. IPLAC also believes the *Phillips* standard should be further applied to *ex parte* examination reviews because such proceedings also challenge the validity of an already granted patent just like an IPR. Although the patent owner may amend claims once as of right in an *ex parte* examination, patent holders in such proceedings do not have the full opportunity for the back and forth dialog with examiners and serial revisions that is available to an applicant during regular prosecution because Requests For Continued Examination (RCE) and continuation applications—staples of ordinary prosecution—are not available. Thus, given the limited ability for patent holders to amend claims to preserve the validity of their already granted patent right, IPLAC believes the *Phillips* standard is also appropriate for *ex parte* reexaminations.



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IPLAC thanks the Patent and Trademark Office for considering these comments and would welcome any further dialogue or opportunity to support the Patent and Trademark Office.

A handwritten signature in blue ink that reads "Adam Kelly". The signature is fluid and cursive, with a distinct arrow-like flourish at the end of the word "Kelly".

Adam Kelly
134th President

A handwritten signature in black ink that reads "Reid Huefner". The signature is written in a cursive style with a long horizontal line extending from the end of the name.

Reid Huefner
Irwin IP LLC
US Patent Committee

A handwritten signature in blue ink that reads "Jeffrey A. Chelstrom". The signature is cursive and includes a period at the end.

Jeffrey A. Chelstrom
Honigman Miller Schwarz and Cohn LLP
US Patent Committee