From:	G. Matthew McCloskey
To:	TrialRFC2018Amendments
Subject:	Comment on general motions to amend
Date:	Monday, December 10, 2018 8:00:41 PM

Hi,

Related to the issue of general motions to amend, is a preliminary issue of the Board's handling of potentially indefinite claims in IPR petitions, post-SAS. There is a concern now, post-SAS, that IPR petitions might potentially be denied at the institution decision because of indefinite claims. In other words, one or more hopelessly indefinite claims might doom to failure an otherwise institutable petition.

I see that the Comments in the Office's rulemaking on the recent change in claim construction standard do touch on this subject, and state that the Board will construe claims under Phillips to preserve validity without rewriting the claims:

> *Comment 16:* Some comments opposed using a standard that applies the doctrine of construing claims to preserve their validity.
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> *Response:* In this final rule, the Office fully adopts the federal courts claim construction standard, which is articulated in *Phillips,* for interpreting claims in AIA proceedings. This rule reflects that the PTAB in an AIA proceeding will apply the same standard applied in federal courts to construe patent claims.
>
> To the extent that federal courts and the ITC still apply the doctrine of construing claims to preserve their validity as described in *Phillips,* the Office will apply this doctrine for purposes of claim construction if dictated by the principles of *Phillips* and its progeny, *e.g.,* if those same rare circumstances arise in AIA proceedings. Start Printed Page 51353As the Federal Circuit recognized in *Phillips,* this doctrine is "of limited utility." *Phillips,* 415 F.3d at 1327-28. The Court has not applied that doctrine broadly, and has "certainly not endorsed a regime in which validity analysis is a regular component of claim construction." *Id.* at 1327 (citation omitted). The doctrine of construing claims to preserve their validity has been limited to cases in which "the court concludes, after applying all the available tools of claim construction, that the claim is still ambiguous." *Id.* Moreover, the Federal Circuit "repeatedly and consistently has recognized that courts may not redraft claims, whether to make them operable or to sustain their validity." *Rembrandt Data Techs., LP* v. *AOL, LLC,* 641 F.3d 1331, 1339 (Fed. Cir. 2011); *see also MBO Labs., Inc.* v. *Becton, Dickinson & Co.,* 474 F.3d 1323, 1332 (Fed. Cir. 2007) (noting that "validity construction should be used as a last resort, not first principle").
>
> Even in those extremely rare cases in which the courts applied the doctrine, the courts "looked to whether it is reasonable to infer that the PTO would not have issued an invalid patent, and that the ambiguity in the claim language should therefore be resolved in a manner that would preserve the patent's validity," noting that this was "the rationale that gave rise to the maxim in the first place." *Phillips,* 415 F.3d at 1327 (citing *Klein* v. *Russell,* 86 U.S. (19 Wall.) 433, 466, 22 Led. 116 (1873)). "The applicability of the doctrine in a particular case therefore depends on the strength of the inference that the PTO would have recognized that one claim interpretation would render the claim invalid, and that the PTO would not have issued the patent assuming that to be the proper construction of the term."

> *Id.* at 1328.

And similarly in the Background section given for the rule:

> Additionally, to the extent that federal courts and the ITC apply the doctrine of construing claims to preserve their validity as described in *Phillips,* the Office will apply this doctrine in those rare circumstances in AIA proceedings. *Phillips,* 415 F.3d at 1327-28. As the Federal Circuit recognized in *Phillips,* this doctrine is "of limited utility." *Id.* at 1328. Federal courts have not applied that doctrine broadly and have "certainly not endorsed a regime in which validity analysis is a regular component of claim construction." *Id.* at 1327. The doctrine of construing claims to preserve their validity has been limited to cases in which "the court concludes, after applying all the available tools of claim construction, that the claim is still ambiguous." *Id.* (quoting *Liebel-Flarsheim Co.* v. *Medrad, Inc.,* 358 F.3d 898, 911 (Fed. Cir. 2004)). Moreover, the Federal Circuit "repeatedly and consistently has recognized that courts may not redraft claims, whether to make them operable or to sustain their validity." *Rembrandt Data Techs., LP* v. *AOL, LLC,* 641 F.3d 1331, 1339 (Fed. Cir. 2011); *see also MBO Labs., Inc.* v. *Becton, Dickinson & Co.,* 474 F.3d 1323, 1332 (Fed. Cir. 2007) (noting that "validity construction Start Printed Page 51344should be used as a last resort, not first principle").

But, this rule-making commentary doesn't expressly say what the PTAB will do for IPR petitions that include a mixed bag of grounds and claims that clearly warrant institution and obviously-indefinite claims that might not be unambiguous even if the Board seeks to construe them to preserve patentability. Such as when a claim recites as a means-plus-function element a general purpose computer and there is no related algorithm given in the specification (in violation of the holding of *Finisar Corp. v. DirectTV Group Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008)) Does one "insolubly ambiguous" claim doom an IPR petition with many other clearly definite claims which otherwise warrantt institution? Or will the Board sweep the indefinite claim into the instituted claims per SAS?

Could the Board adopt a practice of accepting a "contingent motion to cancel" a request for IPR review of a particular claim in the event the Board determines that claim to be indefinite? This would seem to be a practical solution (and one that is consistent with Congressional intent of the AIA) to prevent otherwise institution-worthy IPR petitions from being denied due to what is effectively poor application drafting on the part of the patentee.

Thank you.

Best regards,

Matt

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