

From: Marshall, John J. [e-mail address redacted]
Sent: Monday, November 14, 2011 4:06 PM
To: aia_implementation
Cc: Marshall, John J.
Subject: Post grant review

Post Grant Review - Standard of Indefiniteness

35 U.S.C §321(b) authorizes an invalidity challenge based upon a failure to satisfy the requirements of §112(2), referred to in patent parlance as "indefiniteness". An open question is what legal standard the USPTO should apply as the threshold and on the ultimate issue in determining whether a claim is indefinite during Post Grant Review.

The issue arises because the Court of Appeals for the Federal Circuit has adopted an "insolubly ambiguous" standard for proof of indefiniteness invalidity, which preserves the validity of any claim that is amenable to construction, even if the task of construction is difficult and reasonable persons could disagree upon the result. By contrast, the Board of Patent Appeals and Interferences has adopted a different standard wherein a claim that is amenable to two or more plausible claim constructions is deemed indefinite until the applicant resolves the ambiguity. *Ex Parte Miyazaki*, 89 U.S.P.Q. 2d 1207.

The G2 rulemaking for Post Grant Review should adopt the BPAI's Miyazaki standard of indefiniteness invalidity for both the threshold determination and for the ultimate issue, for the following reasons.

(1) The BPAI standard improves the patent notice function of enabling the public to understand the scope of claims. This aspect is discussed in detail in the March 2011 report of the Federal Trade Commission entitled "THE EVOLVING IP MARKETPLACE: Aligning Patent Notice and Remedies with Competition", (see Chapter 3).

(2) The BPAI standard is easier to apply at the pleading stage. The petition for Post Grant Review must identify with particularity the grounds on which the invalidity challenge is made and the evidence which supports each challenge. 35 U.S.C. §322(3). To satisfy this pleading requirement, the petition would need to identify two or more plausible constructions for the same claim element and present evidence by affidavit or otherwise that the alternative constructions are of essentially equal plausibility. The patent owner's preliminary response may resolve the ambiguity, if he chooses to do so, by committing to a specific construction that will be binding in further PTO proceedings and is likely to create a judicial estoppel in civil actions. The Federal Circuit standard, by comparison, would be very difficult to apply at the pleading stage since it is tied to a formal claim construction exercise. While PGR (and other PTO litigation proceedings) may require construction of claim language to determine prior art invalidity, the claim construction process would be conducted only after institution of the review under §324.

(3) The PTAB will presumably continue to apply the BPAI indefiniteness standard in appeals and other PTO proceedings. Adopting this standard as the petition threshold for PGR would mean a uniform application across all PTO proceedings.

For the above reasons, I suggest that the proposed regulations establish that the BPAI's Miyazaki standard will be applied in PGR, and that the PGR pleading threshold is to identify two or more plausible constructions for the same claim element and present supporting evidence that, if not rebutted, would establish that the claim is more likely than not invalid.