IP Alert: New Claim Construction Standard at the PTAB as of November 13, 2018

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The U.S. Patent and Trademark Office has now issued a final rule with a new claim construction standard for claim interpretation during America Invents Act trials and proceedings including inter partes review (IPR), post-grant review (PGR), and the transitional program for covered business method patents (CBM) proceedings before the Patent Trial and Appeal Board (PTAB), effective for petitions filed on or after November 13, 2018.

The U.S. Patent and Trademark Office is doing away with the “broadest reasonable interpretation” standard and replacing it with the claim construction standard applied by courts in civil actions under 35 U.S.C. § 282(b)—the same standard articulated in the noteworthy en banc decision by

the U.S. Court of Appeals for the Federal Circuit, Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005). And, in construing claim terms, the PTAB will now also consider prior claim construction orders from civil actions and the International Trade Commission (ITC), when they are timely submitted in the IPR, PGR, or CBM proceedings.

A majority of the comments received by the U.S. Patent and Trademark Office supported the change. The U.S. Patent and Trademark Office indicated that the revised standard will lead to greater predictability and consistency and harmonization with the federal courts and the ITC. The final rule will not be retroactively applied and only applies to IPR, PGR, and CBM petitions filed on or after November 13, 2018.

Click here for the text of the USPTO final rule.

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