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Coming Soon: New Claim Construction Standard for Many AIA Trial Proceedings

By Paula S. Fritsch, Ph.D.

The U.S. Patent and Trademark Office (USPTO) announced today that it is issuing a final rule that will change the claim construction standard applied during many inter partes review (IPR), post-grant review (PGR), and covered business method patents (CBM) proceedings before the Patent Trial and Appeal Board (PTAB).

Currently, unexpired patent claims and substitute claims proposed in a motion to amend are construed in IPR, PGR, and CBM proceedings under the “broadest reasonable interpretation” standard. The final rule will replace that standard with the federal court claim construction standard that is used to construe a claim in a civil action under 35 U.S.C. § 282(b). Under the new standard, the PTAB will apply the claim construction standard articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny. In particular, the PTAB will construe patent claims and proposed substitute claims based on the record of the IPR, PGR, or CBM proceeding, taking into account the claim language itself and the patent specification, and, if presented, the prosecution history of the patent and relevant extrinsic evidence. The *Phillips* standard is currently used by the PTAB in proceedings involving expired or soon to expire claims, as well as by federal courts and the International Trade Commission (ITC).

The final rule also adds a new provision stating that the PTAB will take into consideration any prior claim construction determination that has been made in a civil action, or a proceeding before the ITC, if that prior claim construction is timely made of record in that IPR, PGR, or CBM.

The final rule is being issued following the USPTO’s May 9, 2018, Notice of Proposed Rulemaking and consideration of 374 comments from individuals, corporations, associations,

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law firms, and law professors in response to that notice. The USPTO's intent in issuing the final rule is greater consistency and harmonization with the federal courts and the ITC, and greater certainty and predictability in the patent system.

Assuming the final rule publishes in the Federal Register on October 11, 2018 as anticipated, the final rule will apply only to IPR, PGR, and CBM petitions filed on or after the effective date of the final rule, which will be November 13, 2018.

The full text of the final rule will be [published in the Federal Register](#).

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