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PTAB Adopts the Phillips Claim Construction Standard in AIA Proceedings

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Today the Patent Trial and Appeal Board **announced** a final rule changing the claim construction standard for interpreting claims in *inter partes* review ("IPR"), post-grant review ("PGR"), and covered business method patent ("CBM") proceedings. The Board retired the broadest reasonable interpretation ("BRI") standard in favor of the standard used to construe patent claims in federal court and the International Trade Commission ("ITC") as articulated in ***Phillips v. AWH Corp***. In doing so, the Board announced that it will now consider prior constructions, either from a federal district court or the ITC, in construing a claim term in an IPR, PGR, or CBM, where such prior constructions are timely made of record. This rule change is another positive development for patent owners and should provide for consistent construction of the same term across multiple tribunals going forward.

Parties may now strategically align claim construction arguments before a district court, the ITC, or the Federal Circuit, which allows for greater consistency across all tribunals and synchronized positions as to validity and infringement. Although the Board is required by statute to employ a different and less strict preponderance of the evidence standard in determining the patentability of a challenged claim—in contrast to the higher clear and convincing standard used in federal court and at the ITC—there is no statute applicable to either the Board or federal courts requiring different standards for claim construction. This rule change results in minimizing the differences between claim construction standards used in different fora, with the intent of providing greater uniformity and predictability of the patent grant. Because a large majority of patents subject to a petition before the Board are also being examined concurrently by another tribunal, considering how another tribunal has already construed the same term should better ensure that the scope of the patent will not depend merely upon the happenstance of which court or governmental agency interprets it.

The change to the *Phillips* standard is a highly anticipated rule change as evidenced by the 374 comments received by the Patent and Trademark Office – a majority of which supported the change. The new rule goes into effect on November 13, 2018, but will not apply to petitions filed before that date. We are therefore likely to see a significant uptick in petitions filed before November 13 as petitioners try to take advantage of the more favorable BRI standard while it still exists.

Authors

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Brad Scheller is more than just a seasoned intellectual property litigator—he's a strategic partner who thrives at the intersection of law, technology, and business. With a reputation for tackling complex trade secret and patent disputes, Brad brings a rare blend of technical insight and courtroom prowess, advocating for clients before judges and juries in United States district courts and the United States Patent and Trademark Office.

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