

ALERT

PTAB Moves to *Phillips* Claim Construction Standard

October 11, 2018

Today, the United States Patent and Trademark Office (USPTO) is publishing its final rule regarding the use of *Phillips* standard for claim construction during *inter partes* review (IPR) proceedings. In short, the USPTO will move to the *Phillips* claim construction standard for unexpired patents—the same standard used by district courts and the International Trade Commission (ITC). The rule is effective as of **November 13, 2018**.

For IPRs filed before November 13, 2018, the Patent Trial and Appeal Board (PTAB) will continue to apply the broadest reasonable interpretation (BRI) standard throughout the proceeding. This was a significant modification from the proposed rule, which proposed applying the *Phillips* standard retroactively to all Petitions pending before the PTAB.

The revision to the final rule lessens the burden for both the PTAB and parties in pending proceedings and creates a narrow window for Petitioners seeking review under the BRI standard. To the extent that those Petitioners believe that the use of the BRI standard will be significant—or even dispositive—of claim construction, they should file any such Petitions before November 9, 2018, as that is the last filing day before the new rule goes into effect (November 10 and 11 are Saturday and Sunday, and November 12 is Veterans Day).

The USPTO also noted in the final rule that any prior constructions issued by a district court or the ITC “will be considered” by the PTAB if “timely made of record.” Thus, both Petitioners and Patent Owners should promptly submit any helpful district court or ITC claim constructions to the PTAB as early in the proceeding as possible.

Authors

Wesley E. Weeks
Partner
202.719.7569
wweeks@wiley.law

Practice Areas

Intellectual Property
Patent