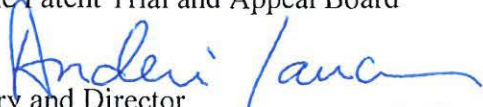




## MEMORANDUM

DATE: January 6, 2021

TO: Members of the Patent Trial and Appeal Board

FROM: Andrei Iancu,   
Under Secretary and Director

Andrew Hirshfeld,   
Commissioner for Patents

Scott R. Boalick,   
Chief Administrative Patent Judge

SUBJECT: APPROACH TO INDEFINITENESS UNDER 35 U.S.C. § 112 IN AIA POST-GRANT PROCEEDINGS

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### Introduction

The office applies the definiteness requirement of 35 U.S.C. § 112 in the context of examination, appeals from examination, and, less frequently, America Invents Act (AIA) post-grant proceedings. As discussed below, in AIA post-grant proceedings, the Patent Trial and Appeal Board (Board) has analyzed claims for indefiniteness under two differing approaches. This memorandum sets forth the office's approach to analyzing claims for indefiniteness in post-grant proceedings under the AIA based on recent changes to the approach to claim construction in these proceedings. This memorandum does not address or affect the office's approach to claim construction or indefiniteness outside of the AIA post-grant proceeding context.

The office and the courts generally approach the definiteness requirement of § 112 as part of the process of construing claims. Until recently, the approaches for both claim construction and indefiniteness used by the office for AIA post-grant proceedings differed from that used by the courts. Consistent with recent changes to the rules of practice on claim construction in post-

grant trial proceedings under the AIA to align the Board's practice with that used by the district courts, the Board shall also use the approach set forth by the Supreme Court in *Nautilus* and used by the district courts for assessing questions of indefiniteness in AIA post-grant proceedings.

This memorandum is being issued under the Director's authority to set forth binding agency guidance to govern the Board's implementation of various statutory provisions, including directions regarding how those statutory provisions shall be applied to sample fact patterns. *See* 35 U.S.C. § 3(a)(2)(A); SOP2 at 1–2.

### Analysis

35 U.S.C. § 112(b) provides:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

Section 112(b)<sup>1</sup> sets forth the requirement for definite claiming. Claims that do not meet this requirement are invalid for indefiniteness. The indefiniteness determination may be made by the office during examination, on appeal from examination, and during post-grant proceedings under the AIA.<sup>2</sup>

In 2014, the Federal Circuit approved the office's long-standing approach for assessing indefiniteness during patent examination. *See In re Packard*, 751 F.3d 1307 (Fed. Cir. 2014) (per curiam). Under *Packard*, “[a] claim is indefinite when it contains words or phrases whose meaning is unclear.” *Id.* at 1310, 1314. In addition to examination, which was the subject of the *Packard* decision, this approach was used agency-wide to analyze questions of indefiniteness,

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<sup>1</sup> In all relevant respects, this provision is nearly identical to pre-AIA § 112, second paragraph.

<sup>2</sup> In post-grant trial proceedings, original claims in a PGR or CBM or substitute claims in any proceeding may be challenged as indefinite.

including those arising in AIA post-grant proceedings. At that time, all proceedings at the office also used the broadest reasonable interpretation approach to claim construction.

That same year, the Supreme Court addressed the standard for questions of indefiniteness arising in the district courts. *See Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014). Under *Nautilus*, a claim of a patent challenged for indefiniteness is unpatentable for indefiniteness if the claim, read in light of the specification delineating the patent, and the prosecution history, fails to inform, with reasonable certainty, those skilled in the art about the scope of the invention. *Id.* at 901.

After *Nautilus*, the office reaffirmed that it would continue to follow *Packard* in the examination context, which includes appeals from original examination, reexamination, and reissue applications. *See Ex parte McAward*, Appeal 2015-006416, 2017 WL 3947829, at \*5 (PTAB Aug. 25, 2017) (Section I.B. designated as precedential). The Board in *McAward* held that during prosecution, “[when] [a]pplying the broadest reasonable interpretation of a claim ... the Office establishes a prima facie case of indefiniteness with a rejection explaining how the metes and bounds of a pending claim are not clear because the claim contains words or phrases whose meaning is unclear.” *Id.* at \*2 (citing *Packard*, 751 F.3d at 1310). The Board explained that “[t]he Office’s application of the broadest reasonable interpretation for pending claims and its employment of an interactive process for resolving ambiguities during prosecution naturally results in an *approach* to resolving questions of compliance with § 112 that fundamentally differs from a court’s approach to indefiniteness.” *Id.* at \*4 (emphasis in original). The Board expressly stated in *McAward* that it did not address the approach to indefiniteness for post-grant trial proceedings under the AIA. *Id.* at \*5 n.4. At the time the office designated *McAward* as precedential, however, the office still employed the broadest reasonable construction standard in



post-grant proceedings for claims in an unexpired patent that would not expire before a final written decision issued. 37 C.F.R. §§ 42.100(b) and 42.200(b) (2017).

In 2018, the office revised 37 C.F.R. §§ 42.100(b) and 42.200(b) to change the claim construction standard used in post-grant trial proceedings to review a claim of a patent, or a claim proposed in a motion to amend, from the broadest reasonable construction standard to the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b)—that is, in a district court. *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 FR 51340 (Oct. 11, 2018) (effective as to all IPR, PGR, and CBM petitions filed on or after Nov. 13, 2018). Among other things, the rule change promotes consistency and efficiency between coordinate branches of the government that analyze the same claims in co-pending proceedings.

Since the 2018 change to the claim construction standard used in AIA post-grant proceedings, the Board has noted confusion as to whether *Nautilus* or *Packard* applies. *See, e.g., BASF Corp. v. Ingevity South Carolina, LLC*, PGR2020-00037, Paper 19 at 12 (PTAB Sept. 10, 2020) (citing both approaches and noting that the Federal Circuit declined previously to decide which applies in the PGR context); *Dong Guan Leafy Windoware Co. Ltd. v. Anli Spring Co., Ltd.*, PGR2020-00001, Paper 7 at 22–23 (PTAB Apr. 20, 2020) (reaching the same result under both approaches and noting that which applies remains an “open issue”). Some parties continue to make arguments under either or both approaches. *See, e.g., Shure Inc. v. ClearOne, Inc.*, PGR2020-00079, Paper 1 at 29 (petitioner arguing both *Nautilus* and *Packard*), Paper 10 at 54 (patent owner arguing *Nautilus*); *One World Techs., Inc. v. Chervon (HK) Ltd.*, PGR2020-00059, Paper 1 at 94 (petitioner arguing *Packard*), Paper 11 at 9 (patent owner arguing *Nautilus*); *BASF*, PGR2020-00037, Paper 3 at 41–42 (petitioner arguing both *Nautilus* and *Packard*).

The office now clarifies that the Board shall follow *Nautilus* in AIA post-grant proceedings. Because the office's claim construction standard in AIA post-grant proceedings now aligns with that used by courts in a civil action, and because indefiniteness questions are generally considered as part of the claim construction process, the office's approach to indefiniteness in AIA post-grant proceedings should likewise align with that used by the courts following the Supreme Court's decision in *Nautilus*. As with the claim construction standard, aligning the indefiniteness approach in AIA post-grant proceedings will promote consistency and efficient decision making among coordinate branches of government that decide similar issues in co-pending proceedings. This memorandum confirms, therefore, that *Nautilus* is the correct approach for analyzing indefiniteness in AIA post-grant proceedings.

#### Conclusion

In summary, as a result of 2018 rule changes to align the Board's approach to claim construction to that used by the district courts, the Board's approach to analyzing indefiniteness in AIA post-grant proceedings will now adhere to the approach used by the district courts, as set forth in *Nautilus*. As with the overall claim construction standards used by the Board in the AIA post-grant proceeding context, eliminating the differences between indefiniteness approaches used in the district courts and before the Board in AIA post-grant proceedings will lead to greater uniformity and predictability, improve the integrity of the patent system, and help increase judicial efficiency.