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Via email only to PTABNPR2018@uspto.gov

Honorable Andrei Iancu
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office.
U.S. Patent and Trademark Office
Department of Commerce
Alexandria, Virginia

Re: Docket No. PTO–P–2018–0036
Notice of Proposed Rulemaking
Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board

Dear Mr. Iancu:

I applaud and support your goal to implement a fair and balanced approach, providing greater predictability and certainty in the patent system, in your Notice of Proposed Rulemaking published on May 9, 2018, at 83 Fed. Reg., No. 90, pages 21221 *et seq*. (referred to as the "Notice" below), by the U.S. Patent and Trademark Office (referred to as the "USPTO" or the "Office" below).

However, your goal would be furthered by the following proposed changes to your proposed rules, to allow each patent applicant an option to have the same patent construction standard that is applied in a civil action, also applied to an application during *ex parte* prosecution.

You have stated that "Minimizing differences between claim construction standards used in the various fora could lead to greater uniformity and predictability of the patent grant." Notice at page 21222. That sentence would be more accurate if "could" was changed to read "should almost certainly" and the Office adopted the following proposed changes.

The following proposed changes to your proposed rules show additions underlined:

§ 1.75 Claims
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(j) Each claim shall be examined under the broadest reasonable interpretation standard, unless Applicant files a request that all claims be examined under the same

claim construction standard that would be used to construe such claim in a civil action to invalidate a patent under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent; *provided that* such request is in writing and timely filed either before the mailing of a first Office action on the merits, or in a Request for Continued Examination. Such timely request shall govern further examination of the application, unless it is revoked in a subsequent Request for Continued Examination.

§ 42.100 Procedure; pendency.

(b) In an inter partes review proceeding, a claim of a patent, or a claim proposed in a motion to amend under § 42.121, shall be construed using the same claim construction standard that would be used to construe such claim in a civil action to invalidate a patent under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. Any prior claim construction determination concerning a term of the claim in *ex parte* prosecution, or in a civil action, or a proceeding before the International Trade Commission, that is timely made of record in the *inter partes* review proceeding will be considered.

§ 42.200 Procedure; pendency.

(b) In a post-grant review proceeding, a claim of a patent, or a claim proposed in a motion to amend under § 42.221, shall be construed using the same claim construction standard that would be used to construe such claim in a civil action to invalidate a patent under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. Any prior claim construction determination concerning a term of the claim in *ex parte* prosecution, or in a civil action, or a proceeding before the International Trade Commission, that is timely made of record in the post-grant review proceeding will be considered.

§ 42.300 Procedure; pendency.

(b) In a covered business method patent review proceeding, a claim of a patent, or a claim proposed in a motion to amend under § 42.221, shall be construed using the same claim construction standard that would be used to construe such claim in a civil action to invalidate a patent under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by

> one of ordinary skill in the art and the prosecution history pertaining to the patent. Any prior claim construction determination concerning a term of the claim in *ex parte* prosecution, or in a civil action, or a proceeding before the International Trade Commission, that is timely made of record in the covered business method patent review proceeding will be considered.

The proposed changes above should further the Office's goal of consistency. You have stated that "The Office has considered using different claim construction standards for IPR, PGR, and CBM proceedings, but, for consistency, the Office proposes the same claim construction to be applied in all IPR, PGR, and CBM proceedings." For those applicants that request the court standard of claim construction in *ex parte* prosecution, the consistency of examination would be increased to include pre-grant as well as post-grant proceedings.

The proposed changes above could be readily implemented by the corps of Examiners who have already demonstrated their collective ability to apply pre-AIA rules and post-AIA rules to examination in co-pending applications since the effective date of the AIA.

The proposed changes above do not require rulemaking with prior notice and opportunity for comment, because they would not change the substantive criteria for patentability. As you have stated, "The changes being proposed in this notice of proposed rulemaking would not change the substantive criteria of patentability." Notice at page 21224. "Accordingly, prior notice and opportunity for public comment are not required ...." *Id*.

The opinions expressed herein are solely those of the undersigned based upon forty years of private practice in patent and trademark cases before the Office, and should not be attributed to the law firm of the undersigned, or to any of the clients of the undersigned.

Very truly yours,
Bacon & Thomas, PLLC

Thomas J. Moore
USPTO Reg. No. 28974

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