

## USPTO Aligns AIA Review Indefiniteness Test With Courts

By **Ryan Davis**

*Law360 (January 6, 2021, 9:37 PM EST)* -- The U.S. Patent and Trademark Office told the Patent Trial and Appeal Board on Wednesday to use the same approach for determining whether a patent is invalid as indefinite in post-grant proceedings that is used in district court, ending the board's use of a different standard.

A binding guidance memo from USPTO Director Andrei Iancu and other agency leaders said that in America Invents Act reviews, the PTAB must use the indefiniteness standard that the U.S. Supreme Court set for courts in its 2014 *Nautilus v. Biosig* ruling.

That decision held that a patent claim is invalid as indefinite if, when read in light of the patent specification and the prosecution history, it fails to inform a person skilled in the art of the invention's scope with reasonable certainty.

The USPTO had long used a different indefiniteness standard, which the Federal Circuit approved in a decision from earlier in 2014 known as *In re: Packard*, that instead said that a claim is indefinite when it contains words or phrases whose meaning is unclear. The board will still use that test in other proceedings, but not AIA reviews, the USPTO memo said.

"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," it said.

Attorneys said that while the *Packard* standard was perceived as making it somewhat easier to invalidate patents than under the *Nautilus* standard, the change is unlikely to make a practical difference in most cases.

Since a claim might not be clear while still providing reasonable certainty to a skilled artisan, "at least in theory easier to invalidate a claim under *Packard* than under *Nautilus*," but that is not often the case in practice, said Joshua Goldberg of Finnegan Henderson Farabow Garrett & Dunner LLP.

"At the margins, there may be cases where the difference in standard potentially has an impact, but I think for the vast majority of cases ... this is really just going to be a simplification of the briefing" since everyone now knows what the correct standard is, he said.

The USPTO's memo noted that in 2018, the PTAB began using the same claim construction standard in district court for AIA reviews. The previously different standards on that issue were a key reason why it also used different indefiniteness standards, but that is no longer the case, the memo said.

"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," the memo said.

It noted that parties and PTAB judges had been unclear on which standard applied in AIA reviews since the claim construction changed, citing decisions where the board said it was an "open issue" and filings where parties made invalidity arguments under both Packard and Nautilus.

"The memo is correct when it points out that there's been a lot of confusion on this issue," Goldberg said. "Just the fact that they picked one, I think that's going to be the most significant impact."

The change in standards is part of a broader effort by the USPTO to ensure that results at the PTAB are more in line with those in district courts, but it won't often lead to different results, said Nicholas Matich of McKool Smith PC, a former acting general counsel of the USPTO.

"I suppose you might be able to come up with a hypothetical case where it would come out differently under one versus the other, but nothing immediately comes to mind," he said.

The most notable result of the memo will be that "it should just promote efficiency in the proceedings by making sure everyone knows what the rule is and how they're supposed to frame their arguments," Matich said.

The effects of the change are further limited because indefiniteness arguments are generally available only in one type of AIA proceeding: post-grant reviews, which are used relatively infrequently. They were also available in covered business method patent reviews, but those were discontinued in September.

In inter partes reviews — by far the most frequently used AIA proceeding — parties challenging patents are not allowed to argue that a patent is indefinite in the main proceeding, although proposed amended claims can be rejected by the board as indefinite.

The memo's most tangible impact will just be to make the PTAB's rules clearer, Matich said.

"Legal systems in general, particularly property systems like the patent system, benefit from clear legal rules," he said. "You can't always have them; sometimes you need a standard that can be a little less certain. But in cases where it's possible to have a clear rule and resolve some level of uncertainty it's good to do that. So this is a good thing to do, but a fairly modest contribution."

--Editing by Adam LoBelia.