



## **PTAB To Use District Court Standard for Indefiniteness**

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PTO leadership clarified approach in Wednesday memo  
Goal is to promote consistency, efficient decision-making

The Patent Trial and Appeal Board will use the standard applied in federal district courts to determine whether a patent claim is indefinite in validity challenges, addressing what attorneys say has been a lingering source of confusion.

Andrei Iancu, the director of the U.S. Patent and Trademark Office, and other agency leaders issued a memo to the PTAB Wednesday explaining the approach that will be used in review proceedings established under the America Invents Act. The memo said it will lead to more predictability, which has been a focus of Iancu's tenure.

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 office said in its memo.

Andrew Hirshfeld, commissioner for patents, and PTAB chief judge Scott Boalick joined Iancu on the memo.

### **Confusion Over Approach**

The memo applies to post-grant review (PGR) and inter partes review (IPR) at the PTAB. It won't affect the office's approach to indefiniteness outside the context of AIA reviews.

Original patent claims can be challenged in PGR as indefinite. That's not an option in IPR, although substitute claims that are proposed in a motion to amend can be challenged as indefinite in either proceeding.

During patent examination, the office's standard for assessing whether a claim is indefinite looks at whether the claim contains words or phrases whose meanings are unclear. The U.S. Court of Appeals for the Federal Circuit approved this approach in a 2014 ruling, *In Re Packard*.

District courts use a less demanding approach, outlined in the U.S. Supreme Court's ruling in *Nautilus v. Biosig*. Under that standard, courts look at whether the claims provide "reasonable certainty" about the scope of the invention.

There has been confusion about which approach applies at the PTAB, particularly after the board in 2018 began using the same standard as district courts to interpret the meaning of patent claims.

Joshua Goldberg, leader of the PTAB trials section at Finnegan Henderson Farabow Garrett & Dunner LLP, said it wasn't uncommon for companies to make their arguments under both approaches.

"The fact that now they are clarifying that we should be using Nautilus is helpful because it will allow parties to know which argument they need to be focusing on," Goldberg said.

The approach isn't expected to have a significant impact on the outcome of cases. The biggest impact, attorneys said, will be reducing confusion.

"The practical difference is probably small but in terms of promoting efficiency in resolving these disputes, it is a good thing for the public and the patent system," said Nicholas Matich, a principal at McKool Smith PC and former acting general counsel of the PTO.