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At the PTAB, Riddle Me This: Is the Lack of a Clear Exclusion its Own Clear Exclusion?

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July 26, 2017 — *Inter partes* reviews (IPRs) at the Patent Trial and Appeal Board (PTAB) may or may not survive a looming constitutional challenge following the U.S. Supreme Court’s future decision in *Oil States v. Greene’s Energy Group*. But now, while IPRs exist and are invalidating U.S. patents, they are fascinating and entertaining in the details and convolutions of their practices and rules. They sometimes involve the classic “riddle wrapped in a mystery, inside an enigma” (said by Winston Churchill in 1939, about Russia). A Licensing Executive Society amicus brief, in the U.S. Supreme Court *Cuozzo* case on broadest reasonable interpretation (BRI) of patent claims in IPRs, described BRI with this analogy:

An equivalent in real estate would be an administrative system that allowed challenges to the titles of land owners and invalidated their titles if their deeds covered the property they claimed but also extended to bits of property owned by surrounding landowners. ... Instead of interpreting deeds as landowners understood and asserted them ..., and as deeds would be interpreted in courts, ... land owners would have their deeds canceled, solely on the technicality that their deeds could be hyper-inflated to cover bits of property never claimed to be owned. A taking would occur, a taking of the land they never claimed to own but also all the land they actually owned ...

While BRI may be difficult to understand, *i.e.*, enigmatic, for patent owners, and problematic for them — IPRs applying BRI have canceled tens of thousands of patent claims — BRI and IPRs remain for now.

This moves us toward our riddle of the day inside BRI. The PTAB applies BRI. As part of that application, it frequently quotes and follows a Federal Circuit rule adopted to tamp down a trend of federal district court case judgments of non-infringement that resulted from courts importing the details of invention embodiments into the patent claims. That adopted rule is referred to as the rule against exclusions: while the patent applicants may act as their own “lexicographers,” *i.e.*, “language creators,” patent owners will have their patents tagged with adverse special definitions of claim terms only when patent applicants *clearly* established meanings for claim terms while the patent application was undergoing examination at the Patent Office. *See e.g., Thorner v. Sony*, 669 F.3d 1362 (Fed. Cir. 2012). So inside claim interpretation is the realm of special definitions and clear exclusions from patents. Inside something enigmatic to some is something mysterious to some as well.

Now to the riddle: At the PTAB, in IPR, is the lack of a clear exclusion its own clear exclusion?

Recall that the rule against exclusions resulted from accused infringers advocating for narrow patent claim interpretations to avoid infringement. Judges frequently adopted the narrow interpretations. IPRs in the PTAB have nothing to do with infringement or non-infringement. Rather, IPRs deal with patent validity or invalidity. In a nutshell, the inquiry is: Is the patent, with its claims given their broadest reasonable interpretation, valid or invalid in view of the petitioner’s cited prior art? But IPRs also involve claim interpretations, and if the rule against exclusions applies in IPR, what is its role? Consider this logic from a recent PTAB IPR final decision:

Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness and precision. *In re Paulson*, 30 F. 3d 1475, 1480 (Fed. Cir. 1994). We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *In re Van Geuns*, 988 F. 2d 1181, 1184 (Fed. Cir. 1993).

... Patent Owner argues that the claims are limited to performing “access control” in hardware rather than software. ... For support, Patent Owner states “[a] key aspect of the ‘577 patent’s invention is the implementation of access control in hardware memory.” *Id.* (citing Ex. 1001 [the patent in IPR], Abstract.) *Patent owner does not assert, and we do not determine, that the cited text from the Abstract is a clear and unmistakable disavowal of implementation using software. Thus, despite the language in the Abstract, we determine that the claims do not require that “access control” occur in hardware memory.*

Arista Networks, Inc. v. Cisco Systems, Inc., IPR2016-00303, slip op., Paper 53 at 10-11, 24 (PTAB May 25, 2017)(The term “[the patent in IPR]” is added, and the ending italics are added).

Think about what happened in *Arista*. The lack of a clear exclusion, *i.e.*, the lack of a clear exclusion from a patent of a software implementation of an invention, despite the language in the patent about implementation in hardware being “key” to the invention, became a

basis for the PTAB to conclude that the patent owner was clearly excluded from an argument, *i.e.*, its argument that its patent claims were limited to its “key” hardware implementation of the invention. The lack of a clear exclusion became a clear exclusion.

This facet of PTAB reasoning, *i.e.*, that (1) the lack of a clear exclusion from patent claims of aspects of the invention, because (2) the language used by the patent applicant did not amount to a clear exclusion of a broader interpretation of the claims, results in (3) a “clear” exclusion of the patent owner from an argument for a narrower interpretation than the one asserted by the IPR petitioner based on the language of the patent application, seems to be one of the more interesting riddles, mysteries, and/or enigmas of PTAB IPR practice.

Whether it represents “a riddle wrapped in a mystery, inside an enigma,” or not, the answer to today’s riddle is that, yes, by example, a lack of a clear exclusion is its own clear exclusion. At least sometimes, if not always, the lack of a clear exclusion of aspects of the invention from patent claims, because the language of the patent applicant did not amount to a clear exclusion of a broader interpretation of the claims, results in a clear exclusion of the patent owner from an argument for an interpretation focused on the “true” invention, even as to its key aspects. So patent owners, if they want to prove that narrow claim interpretations are the right interpretations, need to argue and prove that their patents include clear exclusions. Arguing narrowness without arguing for clear exclusions, will do no good. Petitioners, on the other hand, can argue and prove the broad interpretations they want by arguing and proving the absence of clear exclusions.

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