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Same Claim Construction Standard: Efficiency or More Chaos?

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Yi Zhang



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SAME CLAIM CONSTRUCTION STANDARD: EFFICIENCY OR MORE CHAOS?

Yi Zhang*

INTRODUCTION.....	279
I. BACKGROUND.....	282
A. <i>BRI Standard and Its Use by the PTO</i>	282
B. <i>Phillips Standard and Claim Construction in Court</i>	283
C. <i>Controversy Arising from the Claim Construction Standard</i>	284
II. THE ILLUSION OF UNFAIRNESS.....	286
A. <i>No Substantial Difference between BRI and Phillips</i>	287
B. <i>The Opportunity to Make Amendments</i>	288
C. <i>Existing Mechanisms that Prevent Changing Positions</i>	292
III. THE UNWARRANTED EFFICIENCY.....	292
A. <i>Legislative History of the AIA Proceedings and the Fitness of BRI</i>	293
B. <i>Different Roles of the PTAB and the Courts at the Post-grant Stage</i>	295
C. <i>Tension with Other Proceedings within the PTO</i>	297
IV. CONCLUSION.....	298

INTRODUCTION

On October 11, 2018, the United States Patent and Trademark Office (PTO) published the final draft of its rules for interpreting unexpired patent claims in *inter partes* review (IPR), post-grant review (PGR), and the transitional program for covered business method patents (CBM) proceedings before the Patent Trial and Appeal Board (PTAB).¹ IPR, PGR and CBM enable third-parties to challenge granted patents before the PTO under the Leahy-Smith America Invents Act — these challenges are referred to as AIA proceedings. In prior AIA proceedings, claim construction was based on the broadest reasonable interpretation (BRI) standard. In the final draft of rules, the PTO made the decision to replace

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¹ Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340, 51,358-59 (Oct. 11, 2018) (codified at 37 C.F.R. pt. 42)[hereinafter Changes to the Claim Construction Standard Oct. 2018].

the BRI standard with the same claim construction standard used by Article III federal courts.

The PTO amends 37 C.F.R. § 42.100 by revising its paragraph (b) as follows:

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 the claim in a civil action 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 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.²

The same changes were made to paragraph (b) of 37 C.F.R. § 42.200 and paragraph (b) of 37 C.F.R. § 42.300.³ The new rules took effect on November 13, 2018 and only apply to petitions filed on or after the effective date.⁴

Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) articulates the standard used to consider a claim in a civil action under 35 U.S.C. § 282(b), which is typically referred to as the *Phillips* standard. Under the final rule, the PTAB will adopt the *Phillips* standard in AIA-proceedings.⁵ On top of that, a new provision was added to allow the PTAB to consider prior claim construction determinations made by a court or the International Trade Commission (ITC) under certain conditions.⁶ In addition, the PTAB will apply the *Phillips* standard when interpreting substitute claims proposed by a patent owner to amend an unexpired patent during an AIA proceeding.⁷

In the rule change package, the PTO mainly addressed two concerns behind this move. First, the PTO considers this change a response to stakeholders' concerns of unfairness resulting from the use of different claim construction standards in AIA proceedings and civil litigations.⁸ The arguably broader scope of claims construed under the BRI standard makes

² *Id.* at 51,358.

³ *Id.* at 51,358-59.

⁴ *Id.* at 51,340.

⁵ *Id.* at 51,343.

⁶ *Id.* at 51,342.

⁷ *Id.*

⁸ *Id.*

a patent much more vulnerable before the PTAB than in federal courts.⁹ The PTO alleges that “[m]inimizing differences between claim construction standards used in the various fora will lead to greater uniformity and predictability of the patent grant, improving the integrity of the patent system.”¹⁰ Second, in light of a study showing that “86.8% of patents at issue in AIA proceedings also have been the subject of litigation in the federal courts,” the PTO claims that “using the same standard in various fora will help increase judicial efficiency overall.”¹¹

This paper examines the rule change package and raises doubts as to the reasoning behind the change. On one hand, the unfairness alleged by the PTO is not convincing for three reasons. First, though the BRI standard might have provided more leeway, it shares substantially the same framework and guidance as the *Phillips* standard. The difference in the outcome is too subtle to substantially impair patent owners. Second, because of the opportunity for patent owners to make amendments in AIA proceedings, adopting the BRI standard is the appropriate way to balance the public interest in definite and unambiguous claims with the patent owner’s interest in uniformity across fora. Third, under current case law and statutes, both the PTAB and federal courts consider the parties’ previous and current positions on claim construction regardless of the standard under which the claim was construed. Therefore, it is redundant to change the claim construction standard for the same purpose.

As to efficiency, it might be true that applying the same claim construction will “enhance the ability of federal courts and the ITC to rely upon PTAB claim construction in subsequent proceedings.”¹² However, the PTO does not provide a clear answer regarding how to address the inconsistency between the other post-grant proceedings (such as reissue, ex parte review) and AIA proceedings after the rule change. Also, there is not enough explanation about how the new practice serves to provide an effective second check on unqualified patents. The impaired ability of the PTAB to safeguard patent quality and the likely chaos within the PTO will decrease the overall efficiency of the patent system.

Part I explains the BRI standard and why it was adopted throughout the agency. It will also explain the *Phillips* standard. Part II discusses why the alleged unfairness due to the different standards is not substantial enough to justify the rule change. Part III discusses why the rule change might reduce the overall efficiency of the patent system.

⁹ *Id.*

¹⁰ *Id.*

¹¹ *Id.*

¹² *Id.* at 51,346.

I. BACKGROUND

Claim construction plays a vital role throughout the patent system. When a patent application is under examination before the PTO, the examiner must construe the claim language in order to determine the patentability of the claimed invention in terms of novelty and non-obviousness. When a granted patent is involved in an infringement or invalidity dispute, courts often have to construe the claim language again to determine the proper scope of the patent before they can make any final decisions.¹³ Two different claim construction standards have developed in accordance with the different roles the PTO and courts play in the patent system.

A. BRI Standard and Its Use by the PTO

Before the rule change, the BRI standard was used in all proceedings before the PTO, both before and after a patent is granted.¹⁴ The BRI standard gives claim terms “their broadest reasonable interpretation . . . in light of the specification as it would be interpreted by one of ordinary skill in the art.”¹⁵ In recent decisions, the Federal Circuit has emphasized that the “broadest” interpretation must be reasonable, legally correct, and consistent with both the specification and the understanding of those skilled in the art.¹⁶ When applying the BRI standard in AIA proceedings, the PTO should also consult the prosecution history of the patent.¹⁷

It has long been decided that the claims of a patent bear the objective of giving fair notice to the public about the boundary of patent rights so that the public can act accordingly.¹⁸ The BRI standard facilitates the public notice function of claims in several aspects. First, it effectively helps the examiner determine the outer limit of the claims. When reading the claim terms as broadly as possible, the examiner can explore the scope and breadth of the claim language. This way, the claim is less likely to “be interpreted as giving broader coverage than is justified” after the patent is

¹³ *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996).

¹⁴ 37 C.F.R. §§ 1.75(d)(1), 42.200(b), 42.300(b) (2019).

¹⁵ *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983).

¹⁶ *PPC Broadband, Inc. v. Corning Optical Communs. RF, LLC*, 815 F.3d 747 (Fed. Cir. 2016); *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1297 (Fed. Cir. 2015); *In re NTP, Inc.*, 654 F.3d 1279, 1288 (Fed. Cir. 2011); *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010); *In re Skvorecz*, 580 F.3d 1262, 1267 (Fed. Cir. 2009); *In re Cortright*, 165 F.3d 1353, 1358 (Fed. Cir. 1999).

¹⁷ *Microsoft Corp.*, 789 F.3d at 1297 (noting that “[e]ven under the broadest reasonable interpretation, the Board’s construction cannot be divorced from the specification and the record evidence and must be consistent with the one that those skilled in the art would reach” (internal citation omitted)).

¹⁸ *Merrill v. Yeomans*, 94 U.S. 568, 573 (1876).

granted.¹⁹ Applying the BRI standard can not only “protect the real invention,” but also “prevent needless litigation after the patent has issued.”²⁰ The application of the BRI standard is justified because the applicant has the opportunity to amend his claims.²¹

Second, the BRI standard provides an incentive for the applicant to produce clear patent drafting.²² Broad interpretation of the claim terms exposes ambiguities, and thus, forces the applicant to make clarifications through amendments.²³ The applicant has the responsibility to remove ambiguity.²⁴ Moreover, this interactive process produces valuable written records for the public.

The same reasons warranting the use of the BRI standard during the initial examination also explain its use in the reissue proceeding and the predecessors of AIA proceedings.²⁵ In stipulating the use of the BRI standard in AIA proceedings, the PTO has explicitly stated that “only through the use of the broadest reasonable claim interpretation standard can the Office ensure that uncertainties of claim scope are removed or clarified.”²⁶ It serves the goal of “produc[ing] clear and defensible patents at the lowest cost point in the system.”²⁷

B. Phillips Standard and Claim Construction in Court

Before AIA implemented the proceedings, stakeholders often challenged the validity of a patent was often challenged in federal court in connection with an infringement suit.²⁸ The court must know what the scope of the patent claims is in order to adjudicate whether the patent is valid or whether it was infringed. In 1996, the United States Supreme Court clarified that “[t]he construction of a patent, including terms of art within its claim, is exclusively within the province of the court.”²⁹ Since then, claim construction is always an issue for the judge, not the jury. The question is by which standard shall the judge construe the claim language.

¹⁹ *In re Prater*, 415 F.2d 1393, 1395-96 (C.C.P.A. 1969) (internal citation omitted).

²⁰ *In re Carr*, 297 F. 542, 542 (D.C. Cir. 1924).

²¹ *Id.*

²² *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989).

²³ *Id.*

²⁴ *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004).

²⁵ *In re Reuter*, 651 F.2d 751 (C.C.P.A. 1981) (reissue); *In re Yamamoto*, 740 F.2d 1569 (Fed. Cir. 1984).

²⁶ Office Patent Trial Practice Guide, 77 Fed. Reg. 48,755, 48,764 (Aug. 14, 2012) (codified at 37 C.F.R. pt. 42).

²⁷ *Id.*

²⁸ 35 U.S.C. § 282(b) (2012).

²⁹ *Markman v. Westview Instruments*, 517 U.S. 370, 372 (1996).

In *Phillips v. AWH Corp.*, the Federal Circuit provided detailed guidance on the correct construction of claim terms in court.³⁰ In general, the words of a claim shall be “given their ordinary and customary meaning,” and “the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question . . . as of the effective filing date of the patent application.”³¹ The Federal Circuit considers it an “objective baseline” to begin claim construction by asking “how a person of ordinary skill in the art understands a claim term.”³²

The Federal Circuit emphasizes the important role of “intrinsic evidence” (e.g., specification and prosecution history) in deciding the ordinary meaning of claim language.³³ With respect to the specification, the Federal Circuit notes that even the broad claim interpretation by the PTO is limited within the specification as understood by a person of ordinary skill in the art.³⁴ Therefore, it is “entirely appropriate” for the court “to rely heavily on the written description for guidance as to the meaning of the claims.”³⁵

Furthermore, in construing the meaning of claim terms, the court shall consider the prosecution history of a patent.³⁶ The prosecution history often demonstrates how the inventor and the PTO interpreted the meaning of claim language.³⁷ The court can at least eliminate the interpretation that has been disclaimed during the prosecution. More importantly, the Federal Circuit has held that “statements made by a patent owner during an IPR proceeding can be relied on to support a finding of prosecution disclaimer during claim construction.”³⁸ The doctrine of prosecution disclaimer plays a key role in “promot[ing] the public notice function of the intrinsic evidence and protect[ing] the public’s reliance on definitive statements made during” both prosecution and post-grant proceedings.³⁹

C. Controversy Arising from the Claim Construction Standard

The existence of two different claim construction rules inevitably creates controversy. In challenging a rejection issued by the PTO, one

³⁰ *Phillips v. AWH Corp.*, 415 F.3d 1303, 1311-24 (Fed. Cir. 2005).

³¹ *Id.* at 1312-13.

³² *Id.* at 1313.

³³ *Id.*

³⁴ *Id.* at 1317.

³⁵ *Id.*

³⁶ *Id.* (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995)).

³⁷ *Id.*

³⁸ *Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1359 (Fed. Cir. 2017).

³⁹ *Id.* at 1360 (citing *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1324 (Fed. Cir. 2003)).

applicant has argued that the PTO should “interpret claims in the same manner as courts are required to during infringement proceedings.”⁴⁰ There was a call for uniformity long before the implementation of the AIA proceedings.⁴¹ The general concern is that different interpretation standards cause uncertainty, which undermines the public notice function of claims.⁴² The AIA proceedings push the debate to the top of the controversy, especially because of the troublesome high invalidation rate during these proceedings.⁴³

According to Congress, the PTO received only 53 requests for *inter partes* reexamination, the predecessor of IPR,⁴⁴ as compared to 6,955 requests for IPRs,⁴⁵ during the first 5 years after their respective implementations. For the first few years after IPRs were enacted, from 2012 to 2019, the PTAB invalidated all the instituted claims in the vast majority of cases where a final decision was reached.⁴⁶ The IPR proceeding started to gain the reputation of being a “patent death squad” or “patent killer.”⁴⁷ Some attribute the high invalidation rate to the broad nature of the BRI standard.⁴⁸ This point often contributes to the criticism that the system is unfair to patent owners, which, in turn, led to the rule change to adopt the *Phillips* standard in AIA proceedings.⁴⁹

The PTO claims that the rule change is part of its “continuing efforts to improve AIA proceedings,” and relies on the Supreme Court’s decision in *Cuozzo Speed Techs., LLC v. Lee* for its ability to choose the claim

⁴⁰ *In re Morris*, 127 F.3d 1048, 1053 (Fed. Cir. 1997).

⁴¹ See Michael Risch, *The Failure of Public Notice in Patent Prosecution*, 21 HARV. J. LAW & TECH. 179, 208–20 (2007).

⁴² *Id.* at 209.

⁴³ All or some claims were found unpatentable in 80% of the final written decisions made by the PTAB between Sept. 16, 2012 and Sept. 30, 2019. *Trial Statistics IPR, PGR, CRM, PATENT TRIAL AND APPEAL BOARD* (Sept. 2019), https://www.uspto.gov/sites/default/files/documents/Trial_Statistics_2019-09-30.pdf [<https://perma.cc/UZ8S-GWX6>] [hereinafter *Trial Statistics 2019*].

⁴⁴ H.R. REP. NO. 112-98, pt. 1, at 46 (2011).

⁴⁵ *Trial Statistics IPR, PGR, CRM, PATENT TRIAL AND APPEAL BOARD* (Sept. 2017), https://www.uspto.gov/sites/default/files/documents/Trial_Stats_2017-09-30.pdf [<https://perma.cc/M4SA-J722>].

⁴⁶ *Trial Statistics 2019*, *supra* note 43.

⁴⁷ Matt Levy, *Death to All Patents? Really? Why Inter Partes Review Shouldn't Be Controversial*, IPWATCHDOG, <https://www.ipwatchdog.com/2015/11/06/death-to-all-patents-inter-partes-review/id=62935/> [<https://perma.cc/P3ZL-KTXM>].

⁴⁸ Laura E. Dolbow, *A Distinction Without a Difference: Convergence in Claim Construction Standards*, 70 VAND. L. REV. 1071, 1083 (2017).

⁴⁹ Tom Engellener, *USPTO Responds To Criticism By Promising PTAB Rule Changes That Should Benefit Patent Owners*, POSTGRANT-COUNSEL, <https://postgrant-counsel.com/2015/04/07/uspto-responds-to-criticism-by-promising-ptab-rule-changes-that-should-benefit-patent-owners/> [<https://perma.cc/A4ZL-5ZXD>].

construction standard for AIA proceedings.⁵⁰ Before publishing the final rule, the PTO issued a proposed rulemaking standard in May 2018 and sought comments on the change.⁵¹ According to the PTO, it received 374 comments, most of which support the proposed change.⁵² In the rule change package, the PTO indicated that the broader interpretation of claims under the BRI puts the patent owner in a more vulnerable position before the PTAB.⁵³ The PTO is also concerned since various fora apply different standards, a losing party can challenge the same patent repeatedly, thereby wasting judicial resources and resulting in unfairness.⁵⁴

This rule change also aims to increase efficiency.⁵⁵ According to the PTO, using the same claim construction standard across fora would increase judicial efficiency and reduce cost because parties need only focus their resources on developing a single set of claim construction arguments.⁵⁶ Particularly, the PTO supports its argument with one study that found “86.8% of patents at issue in AIA proceedings also have been the subject of litigation in the federal courts.”⁵⁷ The PTO considers that this “high percentage of overlap” strongly suggests the use of the *Phillips* standard in AIA proceedings.⁵⁸ Finally, the PTO anticipates “a slight reduction in the indirect costs,” because “the parties may be able to leverage work done in the district court.”⁵⁹

II. THE ILLUSION OF UNFAIRNESS

The unfairness alleged by the PTO is not convincing for three reasons. First, though the BRI standard might have provided a little bit more leeway, it shares substantially the same framework and guidance as the *Phillips* standard. The difference in the outcome is too subtle to substantially impair the patent owners. Second, because of the opportunity for the patent owner to make amendments in the AIA proceedings, adopting the BRI standard is the appropriate way to balance public interest in unambiguous claims with the patent owner’s interest in uniformity across fora. Third, there are existing mechanisms that prevent parties from

⁵⁰ Changes to the Claim Construction Standards Oct. 2018, *supra* note 1, at 51,346.

⁵¹ Change to the Claim Construction Standard for Interpreting Claims in Trial Proceeding Before the Patent Trial and Appeal Board, 83 Fed. Reg. 21,221 (May 9, 2018) (codified at 37 C.F.R. pt. 42).

⁵² Changes to the Claim Construction Standards Oct. 2018, *supra* note 1, at 51,345.

⁵³ *Id.* at 51,342.

⁵⁴ *Id.*

⁵⁵ *Id.* at 51,344.

⁵⁶ *Id.*

⁵⁷ *Id.* at 51,342.

⁵⁸ *Id.*

⁵⁹ *Id.* at 51,344.

taking different positions, which makes it redundant to change the claim construction standard for the same purpose.

A. No Substantial Difference between BRI and Phillips

It seems natural to reach the conclusion that the BRI standard will generate a broader scope than the *Phillips* standard because of the word “broadest.” However, this is not the reality. The case law which lays the foundation of the BRI framework has been discussed above. The Manual of Patent Examination Procedure (“MPEP”) can provide us more guidance on how the examiner or PTAB judge would implement the rule:

The broadest reasonable interpretation does not mean the broadest possible interpretation. Rather, the meaning given to a claim term must be consistent with the ordinary and customary meaning of the term (unless the term has been given a special definition in the specification), and must be consistent with the use of the claim term in the specification and drawings. Further, the broadest reasonable interpretation of the claims must be consistent with the interpretation that those skilled in the art would reach.⁶⁰

Comparing the PTO’s interpretive guidance with the language in *Phillips*, the claim construction framework under both standards appear similar.

In *Facebook, Inc. v. Pragmatus AV, LLC*, the Federal Circuit claimed that “[t]he broadest reasonable interpretation of a claim term may be the same as or broader than the construction of a term under the *Phillips* standard. But it cannot be narrower.”⁶¹ The dicta was not about narrower or broader claim scope, but that the Board was not supposed to construe the claim term in an unreasonable manner. The Federal Circuit pointed out that the interpretation by the Board was not consistent with either the plain language of the claim, or the specification.⁶² One could further interpret the opinion to imply that the claim construction by the board was inconsistent with the understanding of those with ordinary skill in the art. In other words, the Board would probably have reached the same interpretation if it strictly followed the rule of BRI. It would have to look for the ordinary and customary meaning consistent with the specification and the understanding of those skilled in the art, just as the Federal Circuit did under *Phillips*.

Empirical studies also show that the outcomes are not very different under BRI or *Phillips*. One study examined the legal authorities cited in all

⁶⁰ U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 2111 (9th ed. 8th rev., 2018) [hereinafter MPEP].

⁶¹ *Facebook, Inc. v. Pragmatus AV, LLC*, 582 F. Appx 864, 869 (Fed. Cir. 2014).

⁶² *Id.* at 867-69.

the PTAB's final written decisions in the IPR proceedings during the one-year period after the 2015 *Cuozzo* decision.⁶³ It concludes that "the two standards look to substantially similar legal authority," which could be explained by the similar guidance underlying each standard.⁶⁴ The study suggests "different conclusions about the same claim terms may be due to the inherent ambiguities in interpretation or litigant behavior rather than a difference between the legal standards."⁶⁵ Another point worth noting is that clear intrinsic evidence often leads to the same outcome no matter which standard is applied, while the same standard could result in different outcomes with less clear intrinsic evidence.⁶⁶ Though the author of the study advocates for convergence in claim construction standards, these results at least show that the dual claim construction system is not the key reason behind the unsupported "high invalidation rate" which tends to unfairly imperil the patent owner.

It is interesting that while the PTO asserts it is unfair for the patent owner to be subject to a broader claim scope in one forum but not the other, it has also acknowledged that the two seemingly different standards reach the same claim interpretation in the vast majority of cases.⁶⁷ The PTO made this point in response to the concern that the change of the claim construction standard "will lead to inconsistency, confusion, and complexity within the Office."⁶⁸ However, the lack of substantial differences between the two standards can also justify a decision to maintain the status quo. In explaining the potential unfairness of the BRI standard, the PTO provided a hypothetical example—a competing product sold after the effective filing date will not be found infringing under *Phillips*, but might be able to invalidate the patent if sold before the effective filing date.⁶⁹ Yet, based on the PTO's own analysis, it is likely that the patent owner will receive a substantially different outcome in reality.

B. The Opportunity to Make Amendments

Because of the opportunity for the patent owner to make amendments in the AIA proceedings, adopting the BRI standard is the appropriate way to balance public interest in certain and unambiguous claims with the

⁶³ Dolbow, *supra* note 48, at 1,085.

⁶⁴ *Id.* at 1,089.

⁶⁵ *Id.* at 1,089.

⁶⁶ *Id.* at 1,101-02.

⁶⁷ Changes to the Claim Construction Standard Oct. 2018, *supra* note 1, at 51,348-49.

⁶⁸ *Id.* at 51,348.

⁶⁹ *Id.* at 51,350.

patent owner's interest in uniformity across fora.⁷⁰ When enacting the AIA, Congress codified the opportunity to amend the patent during the AIA proceedings.⁷¹ In general, the patent owner is allowed to file one motion to amend the patent by cancelling the challenged claim or proposing substitute claims.⁷² Any amendment made must neither enlarge the scope of the claims nor introduce new matter.⁷³

In helping Congress design the AIA proceedings, the PTO has indicated that it is crucial to include amendments in the post-grant proceedings. According to the PTO, “[b]y providing for the possibility of amendment of challenge claims, the proposed system would preserve the merited benefits of patent claims better than the win-all-or-lose-all validity contests in District Court.”⁷⁴ In 2016, the PTO started to apply the *Phillips* standard for expired patents and soon-to-be expired patents in the AIA proceedings.⁷⁵ Because the patent owner is not allowed to amend a claim that expires during prosecution or reexamination, the favorable effects of the BRI standard will no longer exist.⁷⁶

Based on the infrequency of amendments in AIA proceedings, the PTO claims that it “no longer believes that the opportunity to amend in an AIA proceeding justifies the use of BRI.” The PTO mainly relies on data that only 196 motions to amend were decided until June 30, 2018, which seems disproportionate to the number of petitions for AIA proceedings, let alone only 4% of the motions were granted.⁷⁷ The PTO quotes one comment which says patent owners are usually unwilling to make post-issuance amendments due to the concern of “intervening right . . . and the loss of past damages for infringement in a co-pending litigation after amendment.”⁷⁸ Since claim amendments are rare in AIA proceedings and “substantially different than amendments during examination”, the PTO concludes that one of the key reasons to adopt BRI is gone.⁷⁹

⁷⁰ *In re ICON Health & Fitness*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (“as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee.”).

⁷¹ 35 U.S.C. §§ 316(d), 326(d) (2012); 37 C.F.R. §§ 42.121(a)(2), 42.221(a)(2) (2012).

⁷² 37 C.F.R. § 42.121(a).

⁷³ *Id.*

⁷⁴ *Patent Quality Improvement: Post-Grant Opposition: Hearing Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 108th Cong. 6 (2004).

⁷⁵ Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, 81 Fed. Reg. 18,750 (Mar. 10, 2016) (codified at 37 C.F.R. § 42).

⁷⁶ *In re CSB-System Int'l, Inc.*, 832 F.3d 1335, 1341-42 (Fed. Cir. 2016).

⁷⁷ Changes to the Claim Construction Standard Oct. 2018, *supra* note 1, at 51,349.

⁷⁸ *Id.* at 51,348.

⁷⁹ *Id.* at 51,349.

However, concerns with intervening rights are not new. 35 U.S.C. § 318(c) specifies that approved amendments in IPR have the same effect as the amendments in reissued patents. While intervening rights might be a general concern, the comment quoted by the PTO pointed out that the fast speed of the AIA proceedings and “the ability to file a contingent amendment” made patent owners more willing to make amendments in the AIA proceedings, especially among the earlier IPR filings.⁸⁰ The comment also points out that no amendment is allowed for challenged patents which are expired or soon-to-be expired patents, which might also be a factor for the low amendment rate.⁸¹

More importantly, we cannot ignore the heavy burden that was imposed on the patent owners intending to file a motion to amend in AIA proceedings.⁸² In the implementation of the AIA proceedings, the PTAB allocated both the burden of production and the burden of persuasion on the patent owner that proposed substitute claims.⁸³ Particularly, in order to show the amendment did not enlarge the scope of the patent and that no new matter was introduced, the patent owner also had to prove the patentability of the amended claims—not only over the prior art of record, but also those that were known to the patent owner.⁸⁴ These onerous requirements may explain the more than 90% denial rate of the motion to amend before the PTAB.⁸⁵ Thus patent owners might be driven away from making an effort to amend the claims in the AIA proceedings.⁸⁶

However, the trend might change after the Federal Circuit’s en banc decision in *Aqua Products, Inc. v. Matal*.⁸⁷ The decision held that the petitioner shall bear the burden of persuasion with respect to the patentability of amended claims in IPR proceedings.⁸⁸ The court clarified

⁸⁰ Scott McKeown, *Multiple Factors Drive Downtrend in Amendments at PTAB*, PATENTS POST GRANT (Dec. 15, 2014), <https://www.patentspostgrant.com/amendment-efforts-at-ptab-trend-downward/> [<https://perma.cc/TPB3-U46T>].

⁸¹ *Id.*

⁸² See *Idle Free Systems, Inc. v. Bergstrom, Inc.*, No. IPR2012–00027, at 7 (P.T.A.B. June 11, 2013) (“[t]he burden is not on the petitioner to show unpatentability, but on the patent owner to show patentable distinction over the prior art of record and also prior art known to the patent owner.”).

⁸³ *Id.*

⁸⁴ James Glass & Richard Lowry, *IPR Claim Amendments in the Wake of Aqua Products*, LAW360 (March 5, 2018), <https://www.law360.com/articles/1016309/ipr-claim-amendments-in-the-wake-of-aqua-products.html> [<https://perma.cc/37T4-C6EM>].

⁸⁵ *Id.* See also U.S. PATENT & TRADEMARK OFFICE, PATENT TRIAL AND APPEAL BOARD MOTION TO AMEND STUDY (March 31, 2018), <https://www.uspto.gov/sites/default/files/documents/PTAB%20MTA%20Study%20%28Installment%204%20-%20update%20through%2003-31-2018%29.pdf> [<https://perma.cc/8VWM-4YMU>].

⁸⁶ Glass & Lowry, *supra* note 84.

⁸⁷ 872 F.3d 1290 (Fed. Cir. 2017).

⁸⁸ *Id.* at 1290.

that the patent owners only have to meet the burden of production under § 316.⁸⁹ In footnote 6 of the decision, the court considered such distribution of burdens “consistent with other PTO-based proceedings,” including reissue, ex parte reexaminations, pre-AIA *inter partes* reexaminations and interference proceedings; the court indicated that when enacting the AIA, Congress did not intend to “deviate from this well-established rule” or any “certain unexpressed presumptions” in the PTO practice.⁹⁰

After this decision it is easier for patent owners to bring a motion to amend in AIA proceedings since owners do not have to show patentability over prior art. Commentators also anticipate a simpler amendment process if the PTAB follows Judge O’Malley’s suggestion to decide the motion to amend on consideration of the entirety of the IPR record.⁹¹ This way, the patent owner will have less to worry about in a motion limited to twenty-five pages.⁹² In general, motions to amend in AIA proceedings are expected to be more popular than before. The latest statistics provided by the PTO have shown that filings in the first half of 2018 have exceeded 2017, consistent with the expectations.⁹³

With this latest decision in hand, it is too early for the PTO to conclude that the opportunity to amend no longer justifies the use of the BRI standard. In 2015, the PTO began considering a rule change to ease the process for patent owners to amend claims.⁹⁴ Interestingly, the PTO issued a proposed amendment process in response to the *Aqua Products* decision to address high denial rates.⁹⁵ With all the changes that are happening, or about to happen, the rareness of amendments in AIA proceedings is not enough to support the PTO’s position to give up the BRI standard.

⁸⁹ *Id.* at 1305-06.

⁹⁰ *Id.* at 1305, n.6.

⁹¹ Robert M. Asher, *Inter Partes Review and Claim Amendment Strategies after Aqua Products*, AMERICAN BAR ASSOCIATION (Nov. 7, 2017), <https://www.americanbar.org/groups/litigation/committees/intellectual-property/practice/2017/inter-partes-review-and-claim-amendment-strategies-after-aqua-products/> [https://perma.cc/3KCU-G4ZS].

⁹² *Id.*

⁹³ Scott McKeown, *supra* note 80.

⁹⁴ Tom Engellenner, *USPTO Responds to Criticism by Promising PTAB Rule Changes That Should Benefit Patent Owners*, POSTGRANT-COUNSEL BLOG (Apr. 7, 2015), <https://postgrant-counsel.com/2015/04/07/uspto-responds-to-criticism-by-promising-ptab-rule-changes-that-should-benefit-patent-owners/> [https://perma.cc/7PM7-4FWD].

⁹⁵ Request for Comments on Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board, 83 Fed. Reg. 54,319 (Oct. 29, 2018).

C. Existing Mechanisms that Prevent Changing Positions

In the rule change package, the PTO emphasized that the consistency of the claim construction standard prevents parties from taking inconsistent positions in different fora, thus, leading to an equitable patent system.⁹⁶ Some comments note that the opportunity to take different positions under different standards “unfairly advantages the patent challenger.”⁹⁷ The question is how much flexibility is “permit[ted to] patent infringers to aggressively argue inconsistent positions on claim scope in different fora?”⁹⁸

On one hand, the PTO has stipulated that “a party must serve relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency.”⁹⁹ The PTO also clarifies in this rule change package that this is a mandatory disclosure, and “a prior claim construction must be submitted under 37 CFR § 42.51(b), if it is relevant information that is inconsistent with a position advanced by the party during the proceeding.”¹⁰⁰

On the other hand, the Federal Circuit has held that “statements made by a patent owner during an IPR proceeding can be relied on to support a finding of prosecution disclaimer during claim construction.”¹⁰¹ This includes the statements made before the IPR is instituted.¹⁰² Both the PTAB and federal courts will consider the parties’ previous and current positions on claim construction no matter which standard was used. Since both BRI and *Phillips* work under the limitation of claim language, specification, and understanding of person having ordinary skill in the art, neither party can take the position that is diametrically different.

III. THE UNWARRANTED EFFICIENCY

As to the efficiency argument, it might be true that applying the same claim construction will “enhance the ability of federal courts and the ITC to rely upon PTAB claim construction in subsequent proceedings.”¹⁰³ However, the PTO does not provide a clear answer regarding how to address the inconsistencies within the PTO after the rule change. Further, a

⁹⁶ Changes to the Claim Construction Standard Oct. 2018, *supra* note 1, at 51,342.

⁹⁷ *Id.* at 51,350.

⁹⁸ *Id.*

⁹⁹ 37 C.F.R. § 42.51(b)(1)(iii) (2015).

¹⁰⁰ Changes to the Claim Construction Standard Oct. 2018, *supra* note 1, at 51,356.

¹⁰¹ *Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1359 (Fed. Cir. 2017).

¹⁰² *Id.*

¹⁰³ Changes to the Claim Construction Standard Oct. 2018, *supra* note 1, at 51,346.

lack of explanation about how the new practice serves to provide an effective second check on bad patents. The likely chaos within the PTO and its potentially impaired ability to safeguard patent quality might decrease the overall efficiency of the patent system.

A. Legislative History of the AIA Proceedings and the Fitness of BRI

At this point, it is valuable to look back and see why the AIA proceedings were created and how the BRI standard fits in. When enacting the America Invents Act, Congress repeatedly emphasized “patent quality.”¹⁰⁴ The main concern of the legislature was “a growing sense that questionable patents are too easily obtained and are too difficult to challenge.”¹⁰⁵ Congress asserted that “[i]f the United States is to maintain its competitive edge in the global economy, it needs a system that will support and reward all innovators with high quality patents.”¹⁰⁶

Following the same line, Congress held a hearing in 2004 discussing how to strengthen the post-grant opposition process to improve patent quality.¹⁰⁷ Congressman Lamar Smith began the hearing by saying “[a]ll roads should lead to enhanced patent quality. Patents of dubious probity only invite legal challenges that divert money and other resources from more productive purposes.”¹⁰⁸ The AIA proceedings represent a continuous effort by Congress to establish proceedings that focus solely on the validity of already-issued patents “without recourse to expensive and lengthy infringement litigation.”¹⁰⁹ This includes enabling patent owners to “test the validity of United States patents.”¹¹⁰

Among all the AIA-proceedings, the creation of the post-grant review (PGR) proceeding explicitly embodies the goal to improve patent quality. The intent of PGR is “to enable early challenges to patents, while still protecting the rights of inventors and patent owners against new patent challenges unbounded in time and scope.”¹¹¹ Congress expected “this new, early-stage process for challenging patent validity and its clear procedures for submission of art [to] make the patent system more efficient and improve the quality of patents and the patent system.”¹¹²

¹⁰⁴ H.R. REP. NO. 112-98, pt.1, at 39 (2011).

¹⁰⁵ *Id.*

¹⁰⁶ *Id.* at 40.

¹⁰⁷ *Patent Quality Improvement: Post-Grant Opposition: Hearing Before the Subcomm. On Courts, the Internet, and Intellectual Property of the H. Comm. On the Judiciary, supra* note 74, at 1.

¹⁰⁸ *Id.*

¹⁰⁹ H.R. REP. NO. 96-1307 at 4 (1980), as reprinted in 1980 U.S.C.C.A.N. 6460, 6463.

¹¹⁰ *Id.*

¹¹¹ H.R. REP. NO. 112-98, pt.1, at 47-48 (2011).

¹¹² *Id.* at 48.

In adopting the BRI standard in the AIA proceedings, the PTO has echoed Congress' goal to improve patent quality. In a practice guide published by the PTO in 2012 regarding the new proceedings, the PTO commented that:

Only through the use of the broadest reasonable claim interpretation standard can the Office ensure that uncertainties of claim scope are removed or clarified. Since patent owners have the opportunity to amend their claims during IPR, PGR, and CBM trials, unlike in district court proceedings, they are able to resolve ambiguities and overbreadth through this interpretive approach, producing clear and defensible patents at the lowest cost point in the system.¹¹³

In 2016, the PTO again affirmatively sided with the BRI standard with respect to unexpired patents in changing the claim construction standard for expired, or so-to-be expired patents. The PTO explicitly stated:

Applying the broadest reasonable interpretation standard in the proceedings serves an important patent quality assurance function . . . the application of the broadest reasonable interpretation for claims furthers the congressional goal of providing “a meaningful opportunity to improve patent quality and restore confidence in the presumption of validity that comes with issued patents in court.”¹¹⁴

One of the comments received by the PTO indicates that “if the PTO adopts the proposed changes, the PTO should implement procedures that will safeguard the AIA’s goal of improving patent quality and minimize unfairness to the parties.”¹¹⁵ However, the PTO did not address this issue in detail in the rule change package.¹¹⁶ Though the PTO alleges “many of the bases originally advanced in 2012 as justifying the use of BRI,” it only pointed to the rareness of amendments, specifically.¹¹⁷ As discussed above, the opportunity to amend is of value to patent owners considering the fast nature of the AIA proceedings. With the obstacles to making amendments in AIA proceedings substantially reduced, the trend is expected to change.¹¹⁸

¹¹³ Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, at 48,764 (codified at 37 CFR Pt. 42).

¹¹⁴ Amendments to the Rules of Practice for the Trials Before the Patent Trial and Appeal Board, *supra* note 75, at 18,752.

¹¹⁵ Changes to the Claim Construction Standard Oct. 2018, *supra* note 1, at 51,346.

¹¹⁶ *Id.*

¹¹⁷ *Id.* at 51,347.

¹¹⁸ Scott McKeown, *Amendment Efforts at PTAB Trend Downward*, PATENT POST GRANT (December 15, 2014), <https://www.patentspostgrant.com/amendment-efforts-at-ptab-trend-downward/> [<https://perma.cc/PX3P-WXH3>].

B. Different Roles of the PTAB and the Courts at the Post-grant Stage

It is important to remember that the PTAB and the federal courts play different roles at the post-grant stage. Like the PTO, the PTAB bears the obligation to serve as a proxy for the public's interest in access to unpatentable knowledge. Even if the AIA proceedings more closely resemble private litigation than other post-grant proceedings, their major function is to double-check the existing patents to ensure an appropriate grant. By contrast, the federal courts' focus is to adjudicate any disputes around patent rights like any other property right.

First, the AIA proceedings are distinct from judicial proceedings, because the PTAB adopts the standing rule, which allows petitioners to be parties who have not been directly harmed by a patent.¹¹⁹ The Supreme Court holds that the party that initiates the AIA proceeding does not have to remain in the proceeding.¹²⁰ Distinct from a court proceeding, the PTAB can “continue to conduct an *inter partes* review even after the adverse party has settled.”¹²¹

Second, patents in a civil litigation are presumed valid by statute, but there is no such presumption in AIA proceedings.¹²² In 1997, the Federal Circuit affirmed that no presumption of validity attaches before the PTO.¹²³ Congress intentionally left out language in the original proposal for the AIA proceedings which would have imposed a presumption of validity before the PTAB.¹²⁴ This demonstrates that Congress acknowledges that the PTAB is supposed to function in line with the general role of the PTO, rather than a duplicate of court.

Without the presumption of validity, Congress further stipulated a lower evidentiary standard for AIA proceedings than the federal court—“a preponderance of the evidence,” instead of “clear and convincing evidence.”¹²⁵ Following a century of case law, the Supreme Court concluded in 2011 that “the presumption [of validity] encompassed not only an allocation of the burden of proof but also an imposition of a heightened standard of proof,” as compared to “a preponderance standard of proof.”¹²⁶

¹¹⁹ *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2143–44 (2016).

¹²⁰ *Id.*

¹²¹ *Id.*

¹²² 35 U.S.C. § 282(a) (2012).

¹²³ *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

¹²⁴ *See* S. 3600, 110th Cong. § 5(c) (2008) (proposing 35 U.S.C. § 331(a)); 35 U.S.C. § 316 (2012).

¹²⁵ 35 U.S.C. §§ 316(e), 326(e) (2012).

¹²⁶ *Microsoft Corp. v. i4i Ltd. P'ship*, 564 U.S. 91, 100-02 (2011).

Third, unlike district court judges, a PTAB judge is required to have a bachelor or higher technical degree.¹²⁷ The PTAB judges exercise their own judgment to explore the technical truth of a patent independently. While a Federal Circuit judge aims to pick a winner between the claim constructions presented by each party, a PTAB judge often ignores or disagrees with each party and arrives at their own conclusions.

With respect to these features, the Supreme Court concluded that “the purpose of the [IPR] proceedings ‘is not quite the same as the purpose of district court litigation.’”¹²⁸ The Court considers that “the [IPR] proceeding offers a second look at an earlier administrative grant of a patent.”¹²⁹ Following the Court’s reasoning, we can conclude that the PTAB serves a mixed purpose to both “resolve concrete patent-related disputes” like the federal court and “protect the public’s ‘paramount interest in seeing that patent monopolies . . . are kept within the legitimate scope.’”¹³⁰ Unlike the AIA proceedings, private patent litigation is not a mechanism to ensure that high social cost patents are correctly granted.¹³¹

Arguably, the BRI standard has a better chance of allowing the PTAB to achieve the mixed goal than the *Phillips* standard. Though both standards generally follow the same framework, the subtle difference is exactly what the PTAB needs to properly guard the public interest. A former Federal Circuit judge once pointed out:

[T]he putative claim construction standard between courts and the Patent Office is the same—with the one minor difference being that courts may apply disclaimers made by a patent owner during prosecution, even if the claims do not supply a textual hook for such disclaimer, while the Patent Office properly forces an applicant or Patent Owner to put the explicit text in the claims if it is not already there.¹³²

The BRI standard enables the PTAB to further explore the boundaries of the claims and fine-tune the scope of the patent.¹³³ The public interest in having proper notice is also served by the clear record generated from the interactive process. Without the continuing application of the BRI standard at the post-grant stage, the incentive for the applicant to draft clear patents will decrease. The PTAB can only achieve half of its job done under the

¹²⁷ 35 U.S.C. § 6(a).

¹²⁸ *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144 (2016).

¹²⁹ *Id.*

¹³⁰ *Id.*

¹³¹ *Id.*

¹³² Brief in Support of Neither Party of Amicus Curiae Paul R. Michel at 6, *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131 (2016) (No. 15-446).

¹³³ H.R. REP. NO. 112-98 at 48-49 (2011).

Phillips standard. Overall, the public interest in unpatentable knowledge will suffer after the rule change.

C. Tension with Other Proceedings within the PTO

After this rule change, the PTO will apply the BRI standard in all patent applications, as well as reissuance and reexamination proceedings, while applying the *Phillips* standard in AIA proceedings.¹³⁴ When reaffirming its decision to keep using the BRI standard in AIA proceedings in 2016, the PTO noted that “because issued patents can return to the Office through a number of different avenues in addition to AIA trials, it should follow the same claim construction approach in all of its proceedings.”¹³⁵ It expected “difficulties could arise where the Office is handling multiple proceedings with different claim construction standards applicable.”¹³⁶

As indicated by one comment, the current rule change might lead to the result that claims found patentable in an AIA proceeding might be unpatentable over the same prior art in a reexamination.¹³⁷ In response, the PTO first pointed to a recent study, which shows the differences between the BRI and *Phillips* standards do not often lead to a variance in claim interpretation.¹³⁸ In the end, it simply claimed that the PTO will exercise its discretion if different claim constructions are reached in AIA proceedings and reexaminations.¹³⁹

As discussed previously, the difference is subtle, but an examiner in taking a second look at the boundary of a claim is likely to reach a broader scope than a PTAB judge looking for an accurate claim construction in an AIA proceeding. Though the court in *Power Integrations* said that the construction in reexamination under BRI could coincide with that of a court using *Phillips*, it neither required these two to be the same, nor did it preclude a broader construction in reexamination.¹⁴⁰ Rather, it emphasized that the board’s construction must be reasonable.¹⁴¹ While it is reasonable that separate tribunals will reach different conclusions due to different

¹³⁴ 37 C.F.R. § 1.75(d)(1) (2019); Changes to the Claim Construction Standard Oct. 2018, *supra* note 1, at 51,341-42.

¹³⁵ Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, *supra* note 75, at 18,752.

¹³⁶ *Id.*

¹³⁷ Changes to the Claim Construction Standard Oct. 2018, *supra* note 1, at 51,348.

¹³⁸ *Id.*

¹³⁹ *Id.*

¹⁴⁰ *In re Power Integrations, Inc.*, 884 F.3d 1370, 1375 (2018).

¹⁴¹ *Id.*

jurisprudence, it seems more chaotic that the agency granting patent rights provides divergent opinions on the same patent.

While the AIA proceedings received more attention since their implementation, *ex parte* reexamination is still a viable option for third parties to challenge an issued patent and has its own advantages. For example, the *ex parte* proceeding could be anonymous, low-cost and faster than the AIA proceedings.¹⁴² Also, as compared to IPR, the reexamination proceeding has higher institution rates and similar survivability rates, which “may provide a better overall chance of invalidating the claims at issue.”¹⁴³ After the rule change, since the BRI standard is potentially more favorable to the challengers, it is possible that more petitions might be filed for reexamination and the hypothetical difficulty in the comment is likely to become real.

IV. CONCLUSION

Though followed by criticism since the very beginning, the AIA proceedings seem to work fine so far. The statistics do not show an unreasonable invalidation rate in the AIA proceedings.¹⁴⁴ In fact, it is comparable with the number in both US and EU courts.¹⁴⁵ Some commentators pointed out that the implementation of *inter partes* review had helped avoid at least \$2.31 billion dollars in deadweight losses for plaintiffs and defendants.¹⁴⁶ As discussed above, this change of rule is not necessarily going to bring more efficiency. On the contrary, it is more likely to create chaos and confusion.

Overall, the BRI standard might work better to ensure that high social cost patents are correctly granted, and therefore, provide a proper balance between protecting the public interest in unpatentable knowledge and rewarding the patentees for their innovations. The rule change will not

¹⁴² Scott McKeown, *Is There Value To Ex Parte Patent Reexamination After the AIA?*, PATENT POST GRANT (Feb. 14, 2013), <https://www.patentspostgrant.com/is-there-value-in-ex-parte-patent-reexamination-after-the-aia/> [<https://perma.cc/V5CX-K3GN>].

¹⁴³ Aaron J. Capron & Nicholas D. Petrella, *Ex Parte Re-exams: Don't You Forget About Me*, FINNEGAN, <https://www.finnegan.com/en/insights/ex-parte-re-exams-dont-you-forget-about-me.html> [<https://perma.cc/FLD4-TS7M>].

¹⁴⁴ Josh Landau, *A Little More Than Forty Percent: Outcomes At The PTAB, District Court, and the EPO*, PAT. PROGRESS (May 1, 2018), <https://www.patentprogress.org/2018/05/01/a-little-more-than-forty-percent/> [<https://perma.cc/K2LX-N23Q>].

¹⁴⁵ *Id.*

¹⁴⁶ Josh Landau, *Inter Partes Review: Five Years, Over \$2 Billion Saved*, PAT. PROGRESS (Sept. 14, 2017), <https://www.patentprogress.org/2017/09/14/inter-partes-review-saves-over-2-billion/> [<https://perma.cc/Q27P-NDM3>].

necessarily bring the benefits claimed by the PTO, but the ability of the PTAB to double-check the granted patents will be impaired.

