

Section 112 concerns in an IPR at institution and final written decision

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An *inter partes* review (IPR) can only challenge claims of an issued patent on anticipation or obviousness grounds, under 35 U.S.C. §§ 102 and 103, based on patents or printed publications. Patent claims cannot be challenged or cancelled by the Patent Trial and Appeal Board (PTAB) under the definiteness, written description, or enablement requirements of 35 U.S.C. § 112. *Cuozzo Speed Tech. v. Lee*, 136 S. Ct. 2131, 2141-42 (2018).

Section 112 issues, nevertheless, may arise in an IPR where, for example, the challenged claims are written in means-plus-function form (MPF) or recite terms whose meaning may not be determined without speculation or assumption. But if Section 112 cannot serve as a basis to challenge or cancel claims in an IPR, what happens at institution or, more interestingly, post-institution when a claim term implicates Section 112?

At institution

The Director may institute an IPR trial if the petitioner shows that there is “a reasonable likelihood that [it] would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314. Part of this evaluation involves claim construction. When it comes to MPF terms, the PTAB has a very specific rule that requires the petition to “identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.” 37 C.F.R. § 42.104(b)(3).

At this point, one might ask: Why is claim construction so important? The answer is that the difference between the challenged claims and the prior art “cannot be ascertained” if the “scope and meaning of the claims cannot be determined without speculation.” *Micron Technology, Inc. v. Innovative Memory Systems, Inc.*, IPR2016-00324, Paper 11, 8 (June 13, 2016). In other words, without claim construction, the PTAB “cannot conduct a necessary factual inquiry for determining obviousness — ascertaining differences between the claimed subject matter and the prior art.” *Id.* at 8-9.

If the PTAB is unable to define a recited term, it will deny institution. *See, e.g., id.* at 20 (denying institution where the panel was unable to construe MPF terms); *ams AG v. 511 Innovations, Inc.*, IPR2016-01787, Paper 15, 6 (Mar. 15, 2017) (denying institution where the meaning of a term cannot be determined “without considerable speculation ... and assumptions, which in turn, would lead to

an obviousness determination based on such speculations and assumptions.”) (internal quotations omitted).

Post-institution

Once an IPR is instituted, and assuming the IPR is not dismissed, the PTAB must issue a final written decision “with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 316(d).” 35 U.S.C. § 318.

If Section 112 cannot serve as a basis to challenge or cancel claims in an IPR, what happens at institution or, more interestingly, post-institution when a claim term implicates Section 112?

Here again, Section 112 may complicate the PTAB’s duties. There are times where the PTAB may, on the preliminary record, find no issues of indefiniteness or the issue may not even have been raised. Therefore, there may be no initial impediment at institution. As the record is more developed throughout the trial, however, lack of corresponding structure or other indefiniteness concerns may come up.

As with institution, the PTAB cannot conduct an obviousness analysis without completing the obviousness inquiry, which requires the PTAB to ascertain the differences between the claimed invention and the asserted prior art. Section 112 concerns at final written decision may compel the PTAB to find that the Petitioner has not met its burden to show unpatentability of claims that implicate Section 112 because, for example, there is no ascertainable structure corresponding to the functions of MPF terms.

As a result of this, the PTAB “cannot determine whether the prior art includes the corresponding structure or its equivalents.” *Oticon Medical v. Cochlear Bone Anchored Solutions*, IPR2017-01018, Paper 52, 29-30 (Aug. 21, 2018). Indeed, where all the challenged claims implicate Section 112, the PTAB has elected “not [to] proceed to a final written decision” at all because it “cannot conduct a necessary factual inquiry for determining obviousness —

ascertaining differences between the claimed subject matter and the prior art." *BlackBerry Corp. v. MobileMedia Ideas, LLC*, IPR2013-00036, Paper 65, 20 (Mar. 7, 2014).

The U.S. Court of Appeals for the Federal Circuit articulated well this result:

If the specification fails to recite a corresponding structure, then there is a wholly undefined claim element: the claim has what amounts to an inkblot as a required element of the claim. **Such a claim logically cannot be compared to prior art, because an essential claim element has no discernible meaning.** ... The crucial point for purposes of an inter partes review of issued claims is that, in the situation just described, **it is impossible to conduct a prior art analysis because there is a required claim element without meaning.** In this situation, the Board should "conclude that it could not reach a decision on the merits with respect to whether petitioner had established the unpatentability of those claims under sections 102 or 103."

Cochlear Bone Anchored Solutions v. Oticon Medical, 958 F.3d 1348, 1359 (Fed. Cir. 2020). The PTAB, of course, must find, **on its own**, that "impossibility" resulting from Section 112 concerns prevent it from conducting an unpatentability analysis. It is not enough for the PTAB to rely on party admissions that claim terms may be indefinite. *Intel Corporation v. Qualcomm Inc.*, 21 F.4th 801, 812 (Fed. Cir. 2021).

There is also some suggestion that this "impossibility" must be absolute. Indefiniteness of a claim resulting from a mixing of apparatus and method elements in a single claim, per *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005), "does not necessarily preclude the [PTAB] from addressing the patentability of the challenged claims on Section 102

and 103 grounds." *Samsung Electronics America, Inc. v. Prisia Engineering Corp.*, 948 F.3d 1342, 1355 (2020).

Estoppel considerations

Following a final written decision, a Petitioner is estopped from challenging the same claims at the Patent Office, U.S. district court, or at the U.S. International Trade Commission "on any ground that the petitioner raised or reasonably could have raised during that inter partes review." 35 U.S.C. § 315(e). But if the PTAB does not issue a final written decision, as in the *BlackBerry* case above, there can be no estoppel.

Even though Section 112 cannot serve as a basis to challenge claims in an IPR, it can certainly play a prime role.

Where the PTAB issues a final written decision that addresses less than all the claims due to Section 112 concerns, "the petitioner would not be estopped by 35 U.S.C. § 315(e) from challenging those claims under sections 102 or 103 in other proceedings." *Samsung*, 948 F.3d at 1353 n.3; *Cochlear*, 958 F.3d at 1359.

Even though Section 112 cannot serve as a basis to challenge claims in an IPR, it can certainly play a prime role. Practitioners should be cognizant of Section 112 when presenting arguments in an IPR petition and conducting an instituted IPR trial.

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