David McCombs, Theo Foster, Eugene Goryunov and Adam Erickson in Westlaw Today: It's OK to (Silently) Disagree With Proposed Claim Constructions in an IPR

By David L. McCombs, Theodore Foster | September 24, 2020

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David L. McCombs, Theo Foster, Eugene Goryunov and Adam Erickson of Haynes Boone explain the Patent and Trademark Office's claim construction rules for petitioners seeking review of a patent.

Claim construction is a key part of patent litigation in U.S. district court and validity challenges at the Patent Trial and Appeal Board (Board). In both settings, parties propose how to construe disputed terms in the claims at issue. In fact, the Board's rules of practice require this. Litigation defendants often propose narrow constructions to further their noninfringement defenses. The same party, however, may prefer a broader construction in an *inter partes* review (IPR) to more easily show unpatentability over the prior art.

Patent owners have argued — and some Board panels in the past have found — that a petition failed to comply with Rule 42.104(b)(3), which requires a petitioner to identify how disputed terms are to be construed, if the petitioner proposed constructions that it disagreed with or that were different from positions it took in a co-pending district court case. Initially, some panels interpreted Rule 42.104(b)(3) to require a petitioner to "indicate that it agrees with, proposes, or adopts the constructions" in its petition.3 Other panels held that a petitioner satisfied the rule by showing unpatentability under a proposed construction, even if the petitioner expressly disagreed with it.4 An apparent split developed.

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