

Eugene Goryunov, David McCombs, Clint Wilkins, Kristina Smith in *The Patent Lawyer*

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PRACTICES Intellectual Property, Patents, Patent Office Trials

On January 6, 2021, the U.S. Patent and Trademark Office (USPTO) issued a memorandum entitled “Approach to Indefiniteness Under 35 U.S.C. § 112 in AIA Post-Grant Proceedings.” The memorandum sets forth binding guidance outlining the USPTO’s approach to analyzing claims for indefiniteness in all America Invents Act (AIA) post-grant review proceedings: *inter partes* review (IPR), post grant review (PGR), and covered business method review (CBMR).

A uniform “indefiniteness” standard promotes consistency across all forums.

The memorandum clarifies that the Patent Trial and Appeal Board (PTAB) will apply the indefiniteness standard promulgated by the U.S. Supreme Court in *Nautilus, Inc. v. Biosig Instruments, Inc.* There, the Court held that “a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” As of 2018, the claim construction standard is the same for AIA proceedings and civil actions in, for example, U.S. district courts. Adopting the *Nautilus* standard for AIA proceedings would “align” the indefiniteness inquiry across all forums where indefiniteness can be asserted, thereby “promot[ing] consistency and efficient decision-making.”

The Memorandum clarifies the PTAB will use the same indefiniteness standard as the courts.

Because the indefiniteness inquiry is an important part of AIA proceedings, there is a need for consistent legal standards. The Patent Act requires that a patent include “one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.”

Under the AIA regime, indefiniteness can be asserted as an affirmative ground in PGR and CBMR proceedings and can further be asserted to challenge claims proposed in a motion to amend in any AIA proceeding, including IPR. The memorandum notes, however, “confusion” has developed at the Patent Trial and Appeal Board (PTAB) as to the proper indefiniteness standard that is to be applied in AIA proceedings.

Excerpted from *The Patent Lawyer*. To read the full article, click [here](#). (See Page 60)