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PTAB HIGHLIGHTS

New developments in post-issuance proceedings

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PTAB Follows District Court's Claim Construction

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November 10, 2014 – In construing a term in a claim of an expired patent, the PTAB followed the district court in adopting the petitioner's proposed construction.

[IPR2014-00694 – *Visa Inc. v. Leon Stambler* \(Paper 10, October 31, 2014\)](#)

The petitioner filed a petition requesting *inter partes* review of an expired patent. In its petition, the petitioner proposed a construction for a particular claim term. In its preliminary response, the patent owner contested this construction and offered a different construction for the same term. The Board noted that its review of claims in an expired patent is similar to that of a district court's review where claims are construed to give words their ordinary and customary meaning as opposed to construing claims under the broadest reasonable interpretation standard typically applied by the Patent Office for unexpired patents.

After briefly identifying portions of the specification related to the disputed claim term, the Board turned to the claim constructions of the disputed term by district courts. The Board acknowledged that the District Court for the Eastern District of Texas adopted the construction proposed by the petitioner and that other district courts had adopted similar constructions for the disputed term. These district court decisions seemed to heavily influence the Board's decision to adopt the petitioner's proposed claim construction for purposes of deciding whether to institute *inter partes* review. Although the Board followed the district court in accepting the petitioner's proposal, the Board ultimately declined to institute the *inter partes* review.

The Leahy-Smith America Invents Act established new patent post-issuance proceedings, including the inter partes review, post grant review and transitional program for covered business method patents, that offer a less costly, streamlined alternative to district court litigation. With the U.S. Patent and Trademark Office's Patent Trial and Appeal Board conducting a large and increasing number of these proceedings, and with the law developing rapidly,

Banner & Witcoff will offer weekly summaries of the board's significant decisions and subsequent appeals at the U.S. Court of Appeals for the Federal Circuit.



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