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# INDEFINITENESS IN *INTER PARTES* REVIEW: THE EXISTING QUAGMIRE AND A PATH FORWARD

CHRISTOPHER S. GEYER, DANIEL C. TUCKER, JENCY J. MATHEW\*

Under Section 112(b) of the Patent Act, patent claims must satisfy a definiteness requirement by “pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.”<sup>1</sup> Indefiniteness is intertwined with determining a patent’s scope through claim construction.<sup>2</sup> Because determining the scope of challenged claims is a prerequisite to deciding the issues of anticipation and obviousness raised in an *inter partes* review (“IPR”),<sup>3</sup> indefiniteness lurks in the background of IPR proceedings.<sup>4</sup> The relevant statutory provision requiring the Patent Trial and Appeal Board (the “Board”) to issue a final written decision deciding the patentability of any claim challenged in a petition, Section 318, does not expressly limit the statutory bases on which claims may be invalidated,<sup>5</sup> suggesting the possibility that the Board could invalidate claims as indefinite

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1. 35 U.S.C. § 112(b).
2. *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1319 (Fed. Cir. 2008) (“Indefiniteness is a matter of claim construction. . .”).
3. *E.g.*, *Blackberry Corp. v. MobileMedia Ideas LLC*, No. IPR2013-00036, Paper 65 at 7 (P.T.A.B. Mar. 7, 2014) (it “is axiomatic” that the first step in determining anticipation and obviousness is “know[ing] what is being claimed”).
4. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014) (to satisfy the definiteness requirement of “§ 112, ¶ 2. . .[.] a patent’s claims, viewed in light of the specification and prosecution history, [must] inform those skilled in the art about the scope of the invention with reasonable certainty.”).
5. 35 U.S.C. § 318.

in an IPR. Yet the Board has interpreted Section 314, the statutory provision governing the bases for petitioning IPR,<sup>6</sup> and dicta from the Supreme Court's decision in *Cuozzo*,<sup>7</sup> as precluding the Board from canceling claims as indefinite in an IPR.<sup>8</sup> Applying this understanding, the Board has often determined that a claim challenged in an IPR is indefinite though declining to cancel it as such, while simultaneously finding the claim's lack of clarity precludes a determination of the statutorily permissible bases of anticipation and obviousness.<sup>9</sup> The result wastes time and money, leaving everyone unsatisfied. Parties, including potential defendants, face the ongoing uncertainty of a claim that has survived IPR with the black mark of an officially weightless, though perhaps persuasive, agency pronouncement of indefiniteness.

In this article, Part I summarizes several approaches the Board has taken in handling claims it recognizes to be indefinite. Then, Part II examines the text and purpose of the statute to consider whether it precludes the Board from canceling claims as indefinite. Finally, Part III suggests modest amendments to Sections 311 and 318 that would expressly grant the Board statutory authority in IPRs to cancel indefinite claims. Part IV offers brief concluding thoughts.

### I. CURRENT BOARD APPROACH TO ADDRESSING INDEFINITENESS ISSUES DURING IPRs

In passing the America Invents Act ("AIA"), Congress authorized the filing of IPR petitions on a limited number of bases. The "petition provision," Section 311(b), restricts the scope of IPR petitions to anticipation and obviousness grounds, under 35 U.S.C. §§ 102 and 103, respectively: "A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications."<sup>10</sup>

In contrast, the "final written decision provision," Section 318(a), places no limitations on the grounds on which the Board can decide the

6. 35 U.S.C. § 314.

7. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2141–42 (2016).

8. *E.g.*, *Oticon Med. AB v. Cochlear Bone Anchored Sols. AB*, No. IPR2017-01018, Paper 52 at 14 n.9 (P.T.A.B. Aug. 21, 2018) ("[W]e may not cancel a claim in an *inter partes* review by finding that claim indefinite.") (citing *Cuozzo*, 136 S. Ct. at 2141–42).

9. *See infra* Section II.

10. 35 U.S.C. § 311(b).

patentability of the challenged claims: “If an inter partes review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall 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).”<sup>11</sup>

The plain language of Section 318(a) thus gives the Board latitude to decide “the *patentability* of any patent claim challenged by the petitioner,” and is not expressly limited to the grounds petitioned under Sections 102 or 103.<sup>12</sup> The Board, however, has refused to invalidate claims challenged in an IPR on bases other than anticipation and obviousness.<sup>13</sup> This presents problems because the indefiniteness of the challenged claims may prevent a comparison of the claims with prior art.

The Board has repeatedly faced issues of indefiniteness at the institution and trial stages. We divide the Board’s treatment of indefinite claims into three groupings, based on the stage at which the indefiniteness issues are identified and whether the claims can be compared to the prior art. The variety of approaches corresponding to each factual scenario is summarized in the chart below and explained in additional detail in the sections that follow.<sup>14</sup>

Stage of Proceeding	Does Indefiniteness Prevent Comparison to Prior Art?	Board’s Various Approaches to Addressing Indefinite Claims
Institution	Yes	<ul style="list-style-type: none"> <li>• Partial denial of institution (Pre-SAS).</li> <li>• Full institution, including indefinite claims (Post-SAS).</li> </ul>
Trial	Yes	<ul style="list-style-type: none"> <li>• Determine that claims are indefinite and terminate proceedings prior to final written decision.</li> <li>• Determine that claims are indefinite but provide no subsequent decision on patentability. Determine that claims are indefinite and conclude Petitioner failed to meet its burden of showing unpatentability.</li> </ul>
Trial	No	<ul style="list-style-type: none"> <li>• Determine that claims are indefinite and compare challenged claims to prior art.</li> </ul>

11. 35 U.S.C. § 318(a) (emphasis added).

12. *Id.*

13. *E.g.*, eBay Inc. v. Glob. Equity Mgmt. (SA) Pty. Ltd., No. IPR2016-01829, Paper 66 at 5 (P.T.A.B. Oct. 16, 2018).

14. Partial denial of institution has only occurred in proceedings instituted before the Supreme Court’s decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018), in which the Supreme Court held that the Board did not have authority to institute on some but not all claims challenged in a petition.

### A. Indefiniteness Presented at Institution Stage

The Board has addressed indefinite claims at the institution stage, often finding that indefiniteness prevented review of those claims during IPR. As the Board has explained, when claims “are not amenable to construction,” the Board is “unable to conclude that there is a reasonable likelihood that the Petitioner would prevail” in challenging those claims.<sup>15</sup>

Institution decisions have been affected by the *SAS Institute Inc. v. Iancu* decision, in which the Supreme Court held that the Board’s practice of partial institution was statutorily impermissible.<sup>16</sup> Prior to *SAS*, the Board was able to institute on some claims in a petition, while denying institution on any indefinite claims in the same petition. For example, in *Apple Inc. v. Immersion Corp.*, the Board determined that because the specification “fail[ed] to disclose sufficient structure” for a means-plus-function term it was “unable to determine the scope and meaning” of numerous claims.<sup>17</sup> The Board’s inability to determine the meaning of the indefinite claims meant it could not “ascertain [the] differences between the claimed subject matter and the prior art” as to those claims.<sup>18</sup> Consequently, the Board denied institution of the indefinite claims, while instituting review of the non-means-plus-function claims.<sup>19</sup>

However, *SAS*’s holding that partial institution practice is statutorily impermissible foreclosed the possibility that the Board could single out only definite claims for institution.<sup>20</sup> Several cases that were pending when the Supreme Court issued the opinion in *SAS* illustrate this point. For example, in *Oticon Medical AB v. Cochlear Bone Anchored Solutions AB*, the Board selectively instituted the IPR on certain claims challenged by the petitioner, while denying institution on several other claims it deemed to be indefinite under Section 112.<sup>21</sup> But after *SAS*, the Board modified its initial institution decision to include in the IPR the claims for which the Board had previously

15. Facebook, Inc. v. TLI Commc’ns LLC, No. IPR2014-00566, Paper 14 at 13 (P.T.A.B. Sept. 15, 2014) (denying institution of petition because indefinite claim language prevented Petitioner from meeting the reasonable likelihood burden).

16. *SAS*, 138 S. Ct. at 1354 (“[W]hen § 318(a) says the Board’s final written decision ‘shall’ resolve the patentability of ‘any patent claim challenged by the petitioner,’ it means the Board *must* address *every* claim the petitioner has challenged.”) (emphasis in original).

17. No. IPR2016-01372, Paper 7 at 19–20 (P.T.A.B. Jan. 11, 2017).

18. *Id.* at 20.

19. *Id.* at 45.

20. *SAS*, 138 S. Ct. at 1358 (“There is no room in this scheme for a wholly unmentioned ‘partial institution’ power that lets the Director select only some challenged claims for decision.”).

21. No. IPR2017-01018, Paper 7 at 11, 26–27 (P.T.A.B. Sept. 5, 2017).

denied institution.<sup>22</sup> The Board ultimately concluded in its final written decision that the petitioner failed to demonstrate that the indefinite claims were unpatentable by a preponderance of the evidence.<sup>23</sup> Notably, the Board defended its selective institution with a nod to the limitations it perceived as being imposed by Section 318.<sup>24</sup>

Likewise, in *Samsung Electronics Co. v. Huawei Technologies Co.*, the Board *sua sponte* addressed claim indefiniteness in the final written decision.<sup>25</sup> In a pre-SAS decision, the Board originally declined institution of means-plus-function claims because the petitioner did not identify structure associated with those claims, but it instituted review of non-means claims.<sup>26</sup> After SAS, the Board ordered institution on the means claims.<sup>27</sup> In the final written decision, the Board independently reviewed the means claims, concluding that owing to the lack of structure in the specification, it was “unable to construe the meaning” of those claims and, further, was unable to determine whether the claims were obvious over the prior art.<sup>28</sup> Though the Board ultimately concluded that the petitioner “failed to demonstrate by a preponderance of the evidence” that the means-plus-function claims were obvious, the Board’s extensive analysis of the claims, and ultimate conclusion of their indefiniteness,<sup>29</sup> casts at least some doubt on the patent owner’s ability to assert those claims successfully in subsequent district court litigation.<sup>30</sup>

Standing in contrast to these cases, the Board has instituted proceedings despite acknowledging the potential indefiniteness of the challenged claims.

22. Oticon Med. AB v. Cochlear Bone Anchored Sols. AB, No. IPR2017-01018, Paper 33 at 5 (P.T.A.B. May 8, 2018).

23. Oticon Med. AB v. Cochlear Bone Anchored Sols. AB, No. IPR2017-01018, Paper 52 at 88 (P.T.A.B. Aug. 21, 2018).

24. *Id.* at 14 n.9 (“[N]or does our interpretation enable the agency to act outside its statutory limits by, for example, canceling a patent claim for ‘indefiniteness under § 112’ in inter partes review.”) (quoting *Cuozzo*, 136 S. Ct. 2131, 2141–42 (2016)).

25. No. IPR2017-01471, Paper 49 at 44–48 (P.T.A.B. Dec. 4, 2018) (conducting independent search for structure corresponding to means claims before concluding same claims indefinite for failure to disclose such structure).

26. *Samsung Elecs. Co. v. Huawei Techs. Co.*, No. IPR2017-01471, Paper 12 at 27 (P.T.A.B. Dec. 8, 2017).

27. *Samsung Elecs. Co. v. Huawei Techs. Co.*, No. IPR2017-01471, Paper 25 at 2–3 (P.T.A.B. May 8, 2018).

28. *Samsung Elecs. Co. v. Huawei Techs. Co.*, No. IPR2017-01471, Paper 49 at 48 (P.T.A.B. Dec. 4, 2018).

29. *Id.* at 44–48.

30. Jonathan DeFosse & Jonathan Stroud, *Indefinitely Maybe: Raising § 112(B) in Inter Partes Review*, 45 AIPLA Q.J. 351, 375–87 (2017) (discussing general tendency of district courts to refuse to adopt Board’s indefiniteness findings but on occasion relying on those findings to hold claims invalid).

For instance, after *SAS*, in *Amneal Pharmaceuticals LLC v. Alkermes Pharma Ireland Ltd.*, the Board instituted the proceeding despite acknowledging potential issues of “claim clarity—or even indefiniteness” because the claimed element encompassed a range of “values reported in the [prior art]” and was therefore sufficiently broad “to create a reasonable likelihood that it reads on the prior art that is asserted here.”<sup>31</sup> As another example, in an institution decision predating *SAS*, in *Vibrant Media Corp. v. General Electric Co.*, the Board instituted review of independent system claim 9 and two of its dependent claims, even though the dependent claims recited “the *method* of claim 9” when referring to the independent system claim.<sup>32</sup> In the institution decision, the Board instructed the patent owner to “provide sufficient explanation or evidence as to why [the dependent] claims are not indefinite in its patent owner response.”<sup>33</sup> Practitioners should be aware of the Board’s tendency to ignore indefiniteness issues at institution if it determined that the potentially indefinite claims may be invalid under Sections 102 or 103.

### *B. Indefiniteness Presented in Trial Stage and Claims Cannot Be Compared to Prior Art*

Indefiniteness issues may remain hidden at institution, only to arise during trial and impede the Board’s ability to construe one or more claim limitations.<sup>34</sup> Because the scope and meaning of the claims must be ascertained before they can be compared to the prior art,<sup>35</sup> latent indefiniteness issues that arise first during trial have the potential to impact the course of the proceeding significantly. That is, it may be impossible for the Board to identify similarities or differences between the prior art and a claim that does not “particularly point[] out and distinctly claim[]”<sup>36</sup> the subject matter of the invention, pursuant to the definiteness requirement.<sup>37</sup>

31. No. IPR2018-00943, Paper 8 at 12 (P.T.A.B. Nov. 7, 2018).

32. No. IPR2013-00172, Paper 50 at 7–8 (P.T.A.B. July 29, 2013).

33. *Id.* at 48.

34. *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1332 (Fed. Cir. 2010) (“[A] claim cannot be both indefinite and anticipated.”).

35. *TI Grp. Auto. Sys. (N. Am.), Inc. v. VDO N. Am., LLC*, 375 F.3d 1126, 1139 (Fed. Cir. 2004) (“Validity analysis is a two-step procedure: ‘The first step involves the proper interpretation of the claims. The second step involves determining whether the limitations of the claims as properly interpreted are met by the prior art.’”) (citing *Beachcombers, Int’l, Inc. v. WildeWood Creative Prods., Inc.*, 31 F.3d 1154, 1160 (Fed. Cir. 1994)).

36. 35 U.S.C. § 112(b).

37. *TI Grp. Auto. Sys. (N. Am.)*, 375 F.3d at 1139.

On occasion, the Board has declined to resolve the patentability of claims despite acknowledging them to be indefinite, and perhaps owing to that fact. For instance, in *Headbox, LLC v. Infinite Imagineering, Inc.*, the Board reviewed the specification to identify structure corresponding to a single means-plus-function claim, claim 23, and found none.<sup>38</sup> The Board concluded that the absence of sufficient structure “render[ed] claim 23 indefinite.”<sup>39</sup> After analyzing the remaining claims, the Board found all others to be obvious.<sup>40</sup> The final written decision found unpatentable every claim except claim 23, about which it remained silent.<sup>41</sup>

Under some circumstances, the Board has determined during the trial phase that indefiniteness precludes the Board’s ability to compare the challenged claims to the prior art. In these cases, the Board has terminated proceedings with respect to the indefinite claims. To illustrate, in *Blackberry Corp. v. MobileMedia Ideas, LLC*, the Board terminated the proceedings *sua sponte*, reasoning that the indefinite nature of these claims precluded the Board from conducting the necessary factual inquiry under Sections 102 and 103.<sup>42</sup> In *Microsoft Corp. v. Enfish, LLC*, the Board, in a final written decision terminated proceedings with respect to certain instituted claims reasoning that because the claims were indefinite, they were not amenable to construction without speculation.<sup>43</sup>

### *C. Indefiniteness Presented in Trial Stage, but Claims Can Be Compared to Prior Art*

On the other hand, the Board has encountered claims, which it found could be compared to the prior art, notwithstanding underlying indefiniteness issues. For example, in *Apple Inc. v. Valencell Inc.*, the Board held that the claims it identified as indefinite were obvious over the prior art after ascribing a particular meaning to the indefinite claim term.<sup>44</sup> The Board conducted a similar analysis in *HID Global Corp. v. Idemia Identity &*

38. No. IPR2014-00365, Paper 11 at 6–7, 13 (P.T.A.B. May 22, 2015) (“As discussed above, claim 23 is indefinite.”).

39. *Id.* at 7.

40. *Id.* at 8–15.

41. *Id.* at 15.

42. No. IPR2013-00036, Paper 48 at 20 (P.T.A.B. Mar. 7, 2014).

43. No. IPR2013-00559, Paper 65 at 14 (P.T.A.B. Mar. 3, 2015).

44. No. IPR2017-00315, Paper 45 at 49 (P.T.A.B. May 31, 2018) (“[W]e find that, to the extent the proposed substitute claim 13 is understood as reciting a light guide with a flat-faced end surface that has a narrower field of view than a light guide with a rounded end surface, Petitioner has demonstrated that the claim is obvious over the combination of [cited references].”).

*Security USA, LLC*, in which it determined that certain substitute claims were indefinite.<sup>45</sup> Yet, notwithstanding this determination, the Board concluded that substitute indefinite claims “would have been obvious over [the prior art].”<sup>46</sup> Similarly, in the *Vibrant Media* case discussed in Section I.B above, the Board explained in its final written decision that it was “. . . not necessary for [it] to determine whether [the claims] complie[d] with § 112, ¶ 2. . .” because it could “. . .ascertain the scope of each limitation with reasonable certainty.”<sup>47</sup> After comparing the indefinite claims to the prior art, the Board found that the claims were obvious.<sup>48</sup>

Regardless of the timing, postures, and outcomes of these cases, one common theme prevails—the Board frequently makes explicit determinations concerning whether IPR-challenged claims are indefinite, even if it does not cancel claims on that basis.

## II. THE CURRENT STATUTE

As discussed above, the Board has consistently taken the view that it does not have the statutory authority to invalidate claims as indefinite in final written decisions. A closer look at the statutory language and its underlying purpose demonstrates that the issue of whether the Board has the authority during IPRs to cancel claims under 35 U.S.C. § 112(b) is not so clear cut.

In fact, the plain text of the statute does not expressly limit the Board’s authority in this manner. Instead, 35 U.S.C. § 318(a) requires the Board to issue “a final written decision with respect to the patentability of any patent claim challenged by the petitioner.”<sup>49</sup> Standing alone, the section’s broad language—“with respect to the *patentability* of any patent claim”—cannot be limited only to patentability determinations under Sections 102 or 103 because the corresponding section for PGRs uses the same language,<sup>50</sup> and it is undisputed that the Board can cancel a claim as being indefinite in a PGR.<sup>51</sup> Nor does Section 311(b) restrict the broad authority granted to the

45. No. IPR2017-01939, Paper 35 at 108 (P.T.A.B. Mar. 11, 2019).

46. *Id.* at 115, 127.

47. No. IPR2013-00172, Paper 50 at 10–11 (P.T.A.B. July 28, 2017).

48. *Id.* at 17–34, 38–39.

49. 35 U.S.C. § 318(a).

50. 35 U.S.C. § 328(a) (“If a post-grant review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall 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 326(d).”).

51. 35 U.S.C. § 321(b) (scope of PGRs includes invalidity grounds that could be raised under paragraphs (2) and (3) of 282(b)); 35 U.S.C. § 282(b)(3)(A) (listing failure to comply with any requirement of Section 112 except best mode, *i.e.*, including definiteness requirement of Section 112(b));

Board under Section 318(a). While Section 311(b) limits the grounds on which a petitioner can *request* an IPR to Sections 102 and 103,<sup>52</sup> it says nothing about the authority of the Board or Director to cancel claims on particular bases.

Furthermore, in contrast to Section 311, which restricts the *grounds* that may be challenged by the petitioner, Section 318 is *claim* specific and does not restrict the Board's cancellation authority to the proposed grounds. Congress could have written Section 318 to limit the Board's final written decisions to grounds raised by the petitioner but chose not to. Instead, it broadly authorized the Board to issue a final written decision with respect to the patentability of any—*i.e.*, *every*<sup>53</sup>—challenged claim. Indeed, before *Cuozzo*, then-private practitioner Andrei Iancu co-authored an article observing that “the text of the statute potentially grants the Board the power to make final determinations on *any patentability ground*, including indefiniteness[.]”<sup>54</sup>

Despite the statute's broad language, however, one of the few points of agreement between the *Cuozzo* majority and dissent was that the Board may not cancel a claim for indefiniteness in an IPR.<sup>55</sup> In dissent, Justice Alito contended that cancelling a claim as indefinite under Section 112 “would grossly exceed the Patent Office's authority.”<sup>56</sup> The majority did not dispute the point, applying Justice Alito's label of “shenanigans” to the hypothetical agency action of “canceling a patent claim for indefiniteness under § 112.”<sup>57</sup>

The Supreme Court's disdain for canceling indefinite claims during IPR was not lost on the Board. According to the Board, “*Cuozzo* held that in an IPR proceeding the Board may not cancel a claim under Section 112.”<sup>58</sup> But the holding in *Cuozzo* was more circumscribed: the Court held only that the statutory limitation on appeals from institution decisions, 35 U.S.C. § 314(d),

*see also* *Telebrands Corp. v. Tinnus Enter., LLC*, No. PGR2015-00018, Paper 75 (Dec. 30, 2016) (canceling claims as indefinite in a PGR).

52. 35 U.S.C. § 311(b) (“A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent *only on a ground that could be raised under section 102 or 103* and only on the basis of prior art consisting of patents or printed publications.”) (emphasis added).

53. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1353 (2018) (“In this context, as in so many others, ‘any’ means ‘every.’ The agency cannot curate the claims at issue but must decide them all.”).

54. Andrei Iancu, Michael Fleming & C. Maclain Wells, *Indefiniteness in Inter Partes Review Proceedings*, 98 J. PAT. & TRADEMARK OFF. SOC'Y 4, 16 (2016) (emphasis in original).

55. *Compare* *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2141–42 (2016), *with id.* at 2154–55 (Alito, J., dissenting in part).

56. *Id.* at 2154 (Alito, J., dissenting in part).

57. *Id.* at 2142 (quoting Justice Alito's dissent; internal quotation marks omitted).

58. *eBay Inc. v. Glob. Equity Mgmt. (SA) Pty. Ltd.*, No. IPR2016-01829, Paper 66 at 5 (P.T.A.B. Oct. 16, 2018).

precludes judicial review of a “decision to institute *inter partes* review” where “the grounds for attacking the decision . . . consist of questions that are closely tied to the application and interpretation of statutes related to the Patent Office’s decision to initiate *inter partes* review.”<sup>59</sup> The Court’s holding did not extend to whether the Board could cancel claims for indefiniteness. Nor did the Court perform any analysis of Section 318 to support its statements regarding the supposed impropriety of canceling claims as indefinite during IPR. The plain language of Section 318, therefore, appears to provide latitude for the Board to cancel claims as indefinite, even if a petitioner is not permitted to argue for institution based on the indefiniteness of the claims under Section 311.

In addition to the plain language, allowing the Board to cancel indefinite claims in an IPR would help further the fundamental purposes of creating these proceedings in the AIA. In particular, sponsors noted the AIA would help “establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.”<sup>60</sup> The Board already considers claim construction a necessity to any determination of novelty and obviousness.<sup>61</sup> And as the Federal Circuit recognizes, “indefiniteness is a question of law and in effect part of claim construction.”<sup>62</sup> For its part, the Board is presently considering issues of indefiniteness, even while it embraces the notion that it is not statutorily permitted to find the claims unpatentable for this reason.<sup>63</sup> Changing the Board’s practice to permit full consideration of indefiniteness issues would increase the efficiency of testing the validity of challenged claims by leveraging the efforts already expended by the Board and preventing the repeat of the same process at a later date in district court. This change would also obviate the Board’s current toe-in-the-water approach in IPRs of determining the issue of indefiniteness while failing to assign any legal import to that determination.

59. *Cuozzo*, 136 S. Ct. at 2141.

60. 157 CONG. REC. S5327 (daily ed. Sept. 6, 2011) (statement of Sen. Leahy); *see also* 157 CONG. REC. S1360–94 (daily ed. Mar. 8, 2011) (statement of Sen. Schumer); 157 CONG. REC. S1053 (daily ed. Mar. 1, 2011) (statement of Sen. Whitehouse) (“[T]he bill will improve administrative processes so that disputes over patents can be resolved quickly and cheaply without patents being tied up for years in expensive litigation.”).

61. *E.g.*, *Blackberry Corp. v. MobileMedia Ideas LLC*, No. IPR2013-00036, Paper 65 at 7 (P.T.A.B. Sept. 9, 2013) (explaining that a “determination of anticipation and obviousness over prior art begins with claim construction” because “[i]t is axiomatic that we first must know what is being claimed.”) (citing *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998)).

62. *ePlus, Inc. v. Lawson Software, Inc.*, 700 F.3d 509, 517 (Fed. Cir. 2012).

63. *See supra* Section I.

Of course, one counterargument is that allowing the Board to decide indefiniteness in an IPR blurs the distinction between IPRs, where a petitioner cannot challenge a claim on indefiniteness grounds, and PGRs, where a petitioner can make such a challenge.<sup>64</sup> This may be true, but the Board's current practice already blurs this distinction. Moreover, other distinctions such as patent eligibility and written description still distinguish PGRs from IPRs. Those issues do not share the same efficiency rationale as indefiniteness: unlike patent eligibility and written description, the Board is already making the indefiniteness determinations as part of the first (claim construction) step of its prior art invalidity analysis.

Thus, it is not difficult to find justification for authorizing the Board to cancel indefinite claims in an IPR based on the text and the purpose of the AIA.<sup>65</sup> If the Board were to interpret the statute to permit it to do so, this would be a marked departure from the cases discussed in Section I, and the Office would need to ensure that such a change fully comports with due process and the requirements of the Administrative Procedure Act. As an alternative approach, however, Congress could amend the statute to expressly authorize the Board to cancel claims for being indefinite during IPR, effectively endorsing (and assigning legal effect to) the indefiniteness determinations the Board is already making.

### III. A PROPOSED STATUTORY AMENDMENT

The Board is already making indefiniteness determinations, even if it is not expressly statutorily authorized to cancel claims based on its determination. As discussed above, the Board has made express findings that claims are indefinite on a number of occasions.<sup>66</sup> And when the Board does not make such express findings, the Board is still making an implicit determination that the claims are sufficiently definite to allow comparison of claims to the prior art. Permitting the Board to hold claims invalid as indefinite in a final written decision would further Congress's stated justifications for creating the IPR proceedings. In particular, amending Sections 311 and 318 to explicitly authorize the Board to determine patentability under Section 112(b) would alleviate the conflicting directives

64. *Id.*

65. *See supra* notes 49–54, 60 and accompanying text.

66. *See supra* Section I.

under the current statutory interpretation and common law scheme, without having to engage in “shenanigans.”<sup>67</sup>

The following amendments to Sections 311 and 318 would give the Board explicit authority to cancel claims as indefinite, in furtherance of Congress’s intention to provide a more efficient alternative to district court litigation and eliminate duplicative claim construction proceedings:<sup>68</sup>

*35 U.S.C. § 311 (b) Scope.—*

A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102, ~~or 103, or 112(b)~~. *For grounds raised under section 102 or 103, a petitioner may only rely on ~~and only on the basis of~~ prior art consisting of patents or printed publications.*

*35 U.S.C. § 318 (a) Final Written Decision.—*

If an inter partes review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall issue a final written decision with respect to the patentability *under section 102, 103, or 112(b)* of any patent claim challenged by the petitioner and any new claim added under section 316(d).

The statutory amendments would both further the legislative intent behind creating IPRs and increase efficiency in validity determinations associated with infringement litigation.

During the Senate Judiciary Committee’s debates regarding versions of the bill that would later take shape as the AIA, two of the bill’s sponsors touted the speed and cost savings associated with IPRs. Senator Grassley hailed IPRs as “new procedures” that would provide a “faster, less costly alternative[] to civil litigation to challenge patents.”<sup>69</sup> Similarly, Senator Hatch praised that IPR proceedings were “a cost-effective alternative to formal litigation.”<sup>70</sup> Permitting the Board to decide issues of definiteness promotes a speedier resolution of indefiniteness issues because the Board inevitably engages in claim construction to conduct the Sections 102 and 103

67. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2142 (2016).

68. To facilitate identification of proposed changes, additions are shown in italics and deletions in crossed-out text.

69. 157 CONG. REC. S952 (daily ed. Feb. 28, 2011).

70. *Id.* at 951.

patentability analyses.<sup>71</sup> Pursuant to the proposed statutory amendments, the parties would receive a decision on the definiteness of the claims when the final written decision issues, rather than delaying the determination until a district court begins to construe the claims and faces the same questions of indefiniteness that the Board previously encountered.

Expressly permitting the Board to rule on indefiniteness issues arising during the claim construction process has the further advantage of lowering costs to the parties and the judicial system. For instance, this change would shield the parties and the courts from undue litigation resulting from situations in which only indefinite claims survive the IPR or are not challenged in the first place because the present statutory scheme supposedly prevents such challenges. Moreover, because estoppel attaches to any ground the petitioner “raised or reasonably could have raised” in the IPR, patent owners would be assured that a defendant/petitioner in a subsequent proceeding could not raise an indefiniteness challenge against claims that survived IPR, providing litigants more certainty.<sup>72</sup>

#### IV. CONCLUSION

As long as the Board is engaged in claim construction, indefiniteness issues will continue to plague IPR proceedings. The current practice of identifying indefinite claims, yet declining to cancel them, frustrates the efficiencies sought by creating IPRs and leaves all litigants without final resolution on the question of indefiniteness. With two simple statutory amendments, Congress could resolve the difficulties litigants face in dealing with potentially indefinite claims while increasing the efficiency of these proceedings in accord with its original justification for creating IPRs.

71. *See, e.g.*, *MPHJ Tech. Invest., LLC v. Ricoh Ams. Corp.*, 847 F.3d 1363, 1364 (Fed. Cir. 2017) (“To determine the validity of a patented invention, the meaning and scope of the claims are first determined.”) (citing *Smiths Indus. Med. Sys., Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1353 (Fed. Cir. 1999)).

72. 35 U.S.C. § 315(e)(1)–(2).