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PTAB Adopts District Court Indefiniteness Standard

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Under AIA 35 U.S.C. § 112(b), a patent specification "shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention." In determining whether a claim is indefinite under § 112(b), the U.S. Patent & Trademark Office (USPTO) has historically employed a different standard for determining indefiniteness than U.S. district courts. Under the so-called *In re Packard* standard, the USPTO determined indefiniteness issues based on whether the claims contain "words or phrases whose meaning is unclear." The precedential PTAB decision *Ex Parte McAward* clarified (albeit in a somewhat circular manner) that under this standard, "claims are required to be cast in clear—as opposed to ambiguous, vague, indefinite—terms." In contrast, district courts employ the indefiniteness standard outlined by the U.S. Supreme Court in *Nautilus Inc. v. Biosig* Instruments. Under the *Nautilus* standard, "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." These different standards resulted in uncertainty as to which indefiniteness standard was appropriate in post grant proceedings, such as *Inter Partes* Review (IPR) and Post-Grant Review (PGR) proceedings, before the U.S. Patent Trial and Appeal Board (PTAB).

On January 6, 2021, Director Iancu put this issue to rest, releasing a Memorandum clarifying that, going forward, the PTAB will adopt the Supreme Court's *Nautilus* indefiniteness standard in post grant proceedings. In so doing, the Director has aligned the indefiniteness standard used in AIA trials with the district court standard, continuing his push for increased predictability and uniformity in post grant proceedings. Notably, the Director's Memorandum is limited to the indefiniteness standard in post grant proceedings and leaves unchanged the use of the *In re Packard* indefiniteness standard during ex parte examination and appeals to the PTAB.

Practice Tip: By adopting the *Nautilus* standard in post grant proceedings, the burden on petitioners to prove indefiniteness may have increased slightly. As a result, when alleging invalidity based on indefiniteness, whether in a PGR petition or in opposition to a motion to amend in an IPR or a PGR proceeding, petitioners should make every effort to ensure that they have clearly articulated why the specification and prosecution history fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention. The Memorandum should also serve as a reminder to applicants of the importance of carefully scrutinizing their claims during prosecution to ensure that their claims clearly define the subject matter of the invention and are not subject to multiple irreconcilable interpretations.