

CLIENT ALERT

PTAB Did Not Violate APA by Issuing New Claim Construction in Final Written Decision

JULY 11, 2019

TQ Delta, LLC v. Dish Network LLC., No. 2018-1799 (Fed. Cir. July 10, 2019)

The petitioner sought *inter partes* review (IPR) of certain claims of U.S. Patent No. 8,611,404, relating to a method for “establishing a power management sleep state in a multicarrier system’ and efficiently waking up a transmission system utilized on hardware, such as a computer, from sleep mode.” The Patent Trial and Appeal Board (PTAB) issued a final written decision finding that the challenged claims were unpatentable as obvious. The patent owner appealed to the Federal Circuit on three grounds: (i) the PTAB violated the patent owner’s procedural rights by relying on a new claim construction; (ii) the PTAB improperly construed the limitation “without needing to reinitialize”; and (iii) the PTAB’s finding of obviousness was not supported by substantial evidence.

In its final written decision, the PTAB interpreted the claim term “without needing to reinitialize” as being “satisfied if any step of initialization is avoided.” The patent owner argued that neither party advocated for a new claim construction, and because the PTAB sua sponte construed the “without needing to reinitialize” limitation, it was not given an opportunity to meaningfully respond to the PTAB’s understanding of the claim term.

The Federal Circuit disagreed. The court found that in the first instance, the PTAB did not “change course” by construing the limitation in the final written decision because it never construed the term when it decided to institute IPR. Nevertheless, the patent owner had adequate notice of the PTAB’s understanding of the claim term at issue and an opportunity to be heard. For example, the patent owner argued for a narrow interpretation in its response to the petition for IPR, and the PTAB explained that it disagreed with this construction at the Oral Hearing. Thus, the court held that the PTAB did not violate the APA.

As for the patent owner’s remaining bases for an appeal, the Federal Circuit found that the PTAB’s construction of the term “without needing to reinitialize” was supported by the claims and specification. In addition, substantial evidence supported the PTAB’s determination that the challenged claims were obvious over the prior art. As such, the Federal Circuit affirmed the PTAB’s final written decision.

[A copy of the opinion can be found here](#)

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