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PATENT TRIAL AND APPEAL BOARD

Indefiniteness of Claim Language Forces Board to Terminate *Inter Partes* Review Proceeding

Instead of issuing a final written order regarding patentability, a PTAB panel has terminated an *inter partes* review proceeding because it was unable to determine the scope of the claims at issue. In the proceeding, the Board had previously instituted review of 12 petitioned claims, considered the parties responsive and reply briefs, and held an oral hearing. In the order, the Board explained that before determining anticipation and obviousness, it must know with certainty what the patentee claimed. According to the Board, not every patentability analysis ends with a determination with respect to prior art. Instead, in some instances, the language used in a claim may be indefinite and may thus fail to indicate the scope of the claimed invention. Here, the claims at issue had been written in “means-plus-function” form, triggering a statutory *quid pro quo* in which the patentee is permitted to use purely functional language only if the patentee describes in the specification the corresponding structure. In this instance, the Board concluded that the patentee had not done so. That is, because the scope of the claims could not be determined without speculation, the differences between the claimed invention and the prior art could not be ascertained. In such a case, the Board’s analysis begins and ends with the claims, and the Board makes no attempt to apply the claims to the prior art because indefiniteness moots consideration of prior art issues.

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BlackBerry Corp. et al. v. MobileMedia Ideas, LLC, IPR2013-00036 (PTAB March 7, 2013) [Lee (opinion), Turner, Chang]

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