UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

MONAGHAN MEDICAL CORP.,

Petitioner,

v.

SMITHS MEDICAL ASD, INC.,

Patent Owner.

_____

Case No. IPR2018-01466
Patent No. 7,059,324
Issue Date: June 13, 2006
Title: Positive Expiratory Pressure Device With Bypass

PETITIONER'S MOTION FOR LEAVE TO FILE A BRIEF CONSTRUING CHALLENGED CLAIMS UNDER A DISTRICT COURT-TYPE STANDARD

I. INTRODUCTION AND STATEMENT OF RELIEF REQUESTED

In response to Patent Owner Smiths Medical ASD, Inc.'s ("Smiths Medical") request that the Board apply a district court-type claim construction approach in the instance case (Paper 8), Petitioner Monaghan Medical Corp. ("Monaghan") requests leave to file a brief addressing the challenged claims under the district court-type approach. While conferring with Smiths Medical on its motion, Monaghan informed Smiths Medical that it intended to file this request for leave which was reported to the Board in Patent Owner's email of August 29, 2018. (Exhibit 1017). The Board authorized the Parties' filings in its email correspondence of August 29, 2018. (*Id*.)

II. GOVERNING LAWS, RULES, AND PRECEDENT

A claim in an unexpired patent is given its broadest reasonable construction in light of the specification in which it appears. *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1275-76, 1278-79 (Fed. Cir. 2015), *aff'd Cuozzo Speed Techs. v. Lee*, 136 S. Ct. 2131 (2016). Pursuant to 37 C.F.R. § 42.100(b), "[a] party **may** request a district court-type claim construction approach to be applied if a party certifies that the involved patent will expire within 18 months from the entry of the Notice of Filing Date Accorded to [the] Petition." (Emphasis added.)

In promulgating the current version of Rule 37 C.F.R. § 42.100(b), the Patent Office provided commentary shedding light on the rules governing this

optional district court-type claim construction approach. 81 Fed. Reg. 18750, 18750-62. Specifically, the Patent Office explained:

> The Office agrees that procedures to determine which claim construction standard applies to a patent that may expire before the conclusion of a proceeding should minimize the cost and burden to the parties, and also offer a full and fair opportunity for each party to present its case under the appropriate approach. **The Office agrees that it is too burdensome to require a petitioner to submit in its petition a construction under both a broadest reasonable construction and a *Phillips*-type construction if the petitioner determines that the challenged patent may expire before the end of the proceeding.**
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> **The Office agrees with commenters that a motions practice in which the petitioner may be able to brief an alternative construction before patent owner files its preliminary response may be an efficient way to proceed, but such choice is left to the discretion of the panel.**

81 Fed. Reg. 18750, 18753. (Emphasis added.)

III. THE BOARD SHOULD GRANT MONAGHAN LEAVE TO ADDRESS CLAIM CONSTRUCTION ACCORDING TO A DISTRICT COURT-TYPE APPROACH IN THIS PROCEEDING

It is clear that 37 C.F.R. § 42.100(b) provides for an **optional** alternative claim construction approach that differs from the standard approach applied in IPR proceedings. Specifically, the rule requires a party to explicitly request application of this alternative claim construction approach. 37 C.F.R. § 42.100(b). And, although several commenters requested a bright-line rule as to when to a apply a *Phillips*-type construction, the Patent Office rejected such an approach, and instead implemented the current optional approach while acknowledging that petitioners may be permitted to brief alternate constructions. *See* 81 Fed. Reg. 18750, 18752-53.

Monaghan could have speculated as to whether Smiths Medical would elect to invoke the optional provision to change the claim construction approach in the instant IPR proceeding. However, such speculation was unnecessary in view of the Patent Office's rules and guidelines. At the time Monaghan filed its petition, it applied the standard IPR claim construction approach, but Smiths Medical subsequently sought to invoke the **optional** district court-type construction approach permitted under 37 C.F.R. § 42.100(b).

However, invoking the rule does not conclude the matter. Indeed, the Patent Office's express guidelines concerning this rule contemplate the exact relief that

Monaghan now requests – an opportunity to brief the alternate construction. *See* 81 Fed. Reg. 18750, 18753. Requiring Monaghan, at the time it filed its petition, to anticipate whether Smiths Medical would seek to invoke the optional district court-type approach, and thus address both standards in its petition, would have increased the cost and burden to Monaghan. Monaghan's petition includes fourteen different grounds (Paper 2 at ii-vii), and under a dual claim construction approach, Monaghan would have had to either eliminate invalidity grounds or file multiple petitions against the '598 Patent. The Patent Office has already agreed that this is not the intent of its procedures. 81 Fed. Reg. 18750, 18753 (acknowledging "that it is too burdensome to require a petitioner to submit in its petition a construction under both a broadest reasonable construction and a *Phillips*-type construction . . . .")

Moreover, granting Smiths Medical's request for the district court-type claim construction approach while denying Monaghan's request to brief the challenged claims under this approach amounts to an improper shifting of the goalposts. A patent owner should not gain an advantage by requesting claim constructions under a different standard and on an incomplete record. The Patent Office's guidelines make clear that a petitioner should be afforded a "full and fair opportunity" to present its case under the *Phillips* standard even after invocation of the optional alternate claim construction standard. *Id.* This makes sense, because

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