

Problems with HR 3309 and S 1720 for Claims in Covered Business Method Patents that Define a Technological Invention

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Both the Goodlatte bill, HR 3309, and the Leahy bill, S 1720, relieve *codified* post grant reviews from the Broadest Reasonable Interpretation (BRI), instead requiring construction "as such claim would be in a civil action 19 to invalidate a patent under section 282(b)."

But Covered Business Method (CBM) proceedings exist pursuant to AIA section 18, which is *uncodified*. Moreover, the "Technical and conforming amendments" to both bills noted above expressly exclude CBMs from that change in claim construction (by revising section 18(a)(1)(A) of the AIA to expressly exclude applicability of those bills' revised 35 USC 326(a)(13) provisions) in CBM proceedings.

While I have no comment on the public policy as to claims that define a CBM, I question the policy of keeping the BRI for claims in a CBM patent that are limited to a "technological invention" within the meaning of AIA sec. 18(d)(2). That is for claims that are not CBM claims. After all, the PTO does *not* limit its review in CBM proceedings to claims found to lack a "technological invention" Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co., CBM2012-00002, paper 66 (PTAB 1/23/2014)(Opinion by APJ Chang, for a panel consisting of APJs Lee, Chang, and Zecher)("Progressive's argument is based on an erroneous statutory construction that interprets the word "patent" in the statutory provision on what is subject to review as "claim." We decline to adopt such an interpretation.")

Hopefully, someone will point out to the honorable Messrs. Goodlatte and Leahy this Board case law, and how it impacts their pending bills.