

Beware Risks Of Arguing Multiple Constructions In IP Cases

By **Michael Joshi, Blaine Hackman and Katherine Helm** (March 13, 2025)

Defendants who are accused of patent infringement often advocate for a claim construction in district court that favors noninfringement. The same entities may find themselves arguing for a different construction before the Patent Trial and Appeal Board in post-grant proceedings that favor unpatentability.

The PTAB has stated its "rules do not prohibit a petitioner from taking inconsistent claim construction positions before the Board and a district court," in *Cambridge Mobile Telematics Inc. v. Sfara Inc.* in 2024[1]

But, interestingly, the board has recently denied institution in multiple petitions in which petitioners failed to apply their district court constructions in their petition or explain why that construction is not applicable.[2] These recent institution denials seem to be part of a trend, where the board is clamping down on a strategy that has raised concerns of gamesmanship, such as in *Abbott Diabetes Care Inc. v. Dexcom Inc.* in 2022.[3]

Despite the recent Feb. 2 rescindment of the USPTO memorandum, "Interim Procedures for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation," this gamesmanship concern persists.

This situation often arises because an accused infringer may benefit from advancing a narrow construction for purposes of noninfringement in district court, whereas a broader construction may better serve unpatentability arguments in post-grant proceedings. Indeed, petitioners have applied patent owners' district court construction in petitions, while simultaneously disagreeing with that construction.[4]

Recent decisions, such as *Head Sport GmbH v. Vermont Safety Developments LLC* in January, indicate that the board is scrutinizing, and potentially clamping down, on this strategy by rejecting petitions that failed to address petitioner's different constructions.[5]

In *Head Sport*, the board faulted the petitioner for failing to "elaborate on the possibility that [the petitioner's] proffered District Court [means-plus-function] construction ... may be the correct construction." [6]

The board, in fact, adopted the petitioner's district court construction but denied institution because the petition's grounds addressed unpatentability under only the patent owner's district court construction.[7]

In *Cambridge*, relying on the patent owner's district court infringement positions, the petition applied the plain and ordinary meaning that the patent owner had advanced in district court.[8]



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The board denied institution for the petition's failure to set forth "[h]ow the challenged claim is to be construed," as required by Title 37 of the Code of Federal Regulations, Section 42.104(b)(3).[9]

The board found that under the circumstances, where both parties addressed means-plus-function issues in district court, "rule 104(b)(3) mandates that the petition either [address means-plus-function] ... or explain why the [terms at issue] are not subject to a means-plus function construction." [10]

Notably, this issue has been a source of sharp disagreement within the board, resulting in rare institution decision dissents where the petitioner advocated for a different construction in district court than it applied in the petition, such as in *Novartis Pharmaceuticals Corp. v. Regents of the University of Michigan* in 2022.[11]

The Novartis dissent implored that "a petitioner should not seek an inter partes review, as was done here, based exclusively on a construction it considers erroneous but 'adopts' 'solely for purposes of this Petition.'" [12]

Raising the specter of petitioner gamesmanship, the Abbott dissent faulted the "majority opinion [for] neglect[ing] to recognize that the Board is now proceeding to review unpatentability arguments only under a claim construction that Petitioner has already asserted in district court is wrong." [13]

Despite these institution decisions, the trend seems to point toward an increasing risk of institution denials for petitions that inadequately address the petitioner's district court construction.

In 2024 and 2025, out of seven institution decisions citing Rule 104(b)(3), four were denied institution for failure to comply with the rule.[14] Another noted that the petitioner had failed to comply with the rule but denied institution for other reasons.[15] By contrast, between 2020 and 2023, out of 32 institution decisions citing the rule, only nine resulted in denials.

Patent owners and petitioners should carefully consider the implications of the recent discretionary denials, in the face of the rescindment of the guidance that will likely make it more difficult for patent owners to avoid discretionary denials.

For patent owners filing preliminary responses to petitions based on a different claim construction than what the petitioner advanced in district court, Rule 104(b)(3) remains a powerful tool.

To be most effective, the patent owner should explain why resolution of the claim construction issues raised in district court is important for the petition's grounds.[16] Patent owners may also benefit from explaining why a petitioner's arguments fail under the petitioner's district court construction.[17]

For petitioners, the recent discretionary denials do not foreclose establishing unpatentability in a petition under a different construction than advanced in district court.[18] The board's issue was each petitioner's failure to address unpatentability under the construction it had advanced in district court.

Petitioners are not required to argue that a claim construction is correct to provide unpatentability grounds for alternative constructions.

The board held in *10X Genomics Inc. v. Bio-Rad Labs Inc.* in 2020 that a petition complied with Rule 104(b)(3) because, although it did not "express[] subjective agreement" with the patent owner's construction, the petitioner presented at least one ground of unpatentability for multiple alternative constructions.[19]

To avoid discretionary denials, petitioners should consider providing unpatentability arguments under its district court construction in the alternative.

Advancing alternative constructions, however, can make filing an inter partes review or a post-grant review parallel to district court litigation strategically disadvantageous.

For example, if a petitioner is pursuing indefiniteness in district court, such as in connection with means-plus-function claim terms, it may not want to alternatively argue unpatentability under a hypothetically definite claim scope in an IPR petition.

Indeed, at least one board decision that refused to deny institution under Rule 104(b)(3), *Abbott*, [20] recognized that requiring denial in such situations could "impos[e] a duty on Petitioner to make an argument against its interest." [21]

Further, now that the district court and the board apply the same claim construction standard, a claim construction in a final written decision may have a collateral estoppel effect in district court. [22]

A petitioner who advances a patent owner's district court construction in a post-grant challenge could be estopped from seeking a different construction favoring noninfringement position in district court.

If the board's final written decision declines to find unpatentability on all challenged claims, petitioner will be estopped from making arguments it raised or could have raised in its petition. [23] The petitioner could lose its noninfringement and invalidity defenses for district court.

Patent owners and petitioners should be transparent with the board about any differences in claim construction positions taken in the post-grant proceeding and in district court.


When a petitioner relies on a different claim construction than its district court position to make its post-grant unpatentability arguments, that patent owner has a valuable tool with which to argue for a discretionary denial.

When preparing for a post-grant challenge, petitioners must weigh the risk of a discretionary denial versus the risk of addressing unpatentability under alternative constructions resulting in collateral estoppel, and evaluate whether an IPR or PGR proceeding represents its best chance to prevail.


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[1] Cambridge Mobile Telematics, Inc. v. Sfara, Inc. , IPR2024-00966, Paper 12 at 8 (PTAB Dec. 13, 2024).

[2] E.g., *id.*

[3] See Abbott Diabetes Care Inc. v. Dexcom, Inc. , IPR2022-00913, Paper 14, Dissent at 1 (Nov. 3, 2022).

[4] See Hilti Aktiengesellschaft v. Specified Techs. Inc. , IPR2024-00193, Paper 17 at 15 (PTAB May 14, 2024).

[5] See Head Sport Gmbh v. Vermont Safety Developments LLC , IPR2024-01099, Paper 15 (PTAB Jan. 15, 2025); Cambridge, IPR2024-00966, Paper 12; Cambridge Mobile Telematics, Inc. v. Sfara, Inc. , IPR2024-00952, Paper 12 (PTAB Dec. 13, 2024); 10X Genomics, Inc. v. President and Fellows of Harvard Coll. , IPR2023-01299, Paper 15 (PTAB Mar. 7, 2024). In each of the two Cambridge decisions, although addressing petitions involving two different patents, the same panel was faced with the same claim construction issues and provided substantially similar analysis.

[6] Head Sport, IPR2024-01099, Paper 15 at 34-35.

[7] *Id.* at 50.

[8] Cambridge, IPR2024-00966, Paper 12 at 6-7.

[9] *Id.* at 6-9.


[10] Cambridge, IPR2024-00966, Paper 12 at 8. A concurrence in Cambridge explained that denial was not warranted under rule 104(b)(3), instead pointing to indefiniteness concerns as reason for denying the petition. IPR2024-00952, Paper 12, Concurrence at 1-3, 8-9 (Horvath, J.).

[11] See Hilti, IPR2024-00193, Paper 17 at 51 n.10 ("We recognize that [the approach of advancing different constructions in IPR and district court] is not universally accepted by all the Board's judges."); see also *Novartis Pharms. Corp. v. Regents of the University of Michigan*, IPR2023-01346, Paper 8 at 14 (Mar. 13, 2024); *Abbott*, IPR2022-00913, Paper 14 at 12-13.

[12] *Novartis*, IPR2023-01346, Paper 8, Dissent at 2 (Tartal, J.).

[13] *Abbott*, IPR2022-00913, Paper 14, Dissent at 2 (Fitzpatrick J.).

[14] Head Sport, IPR2024-01099; Cambridge, IPR2024-00966; Cambridge, IPR2024-00952; 10X Genomics, IPR2023-01299.

[15] Fervo Energy Co. v. Ormat Techs. Inc. , IPR2024-00665, Paper 8 at 11 (Dec. 18, 2024).

[16] See, e.g., Cambridge, IPR2024-00966, Paper 12 at 8 (finding it compelling that petitioner had called the claim construction issues it raised only in district court potentially "case...dispositive"); 10X Genomics, IPR2023-01299, Paper 15 at 12 (recognizing that

"construing the disputed claim term was necessary to resolve the issues before the Board").

[17] E.g., *Head Sport*, IPR2024-01099, Paper 15 at 50.

[18] See, e.g., *Head Sport*, IPR2024-1099, Paper 15 at 35 ("Our Rules do not preclude Petitioner from submitting more than one construction, including one that it believes is incorrect, such as a patent owner's expected construction."); *Cambridge*, IPR2024-00966, Paper 12 at 8 ("[O]ur rules do not prohibit a petitioner from taking inconsistent claim construction positions before the Board and a district court.").

[19] *10X Genomics, Inc. v. Bio-Rad Labs. Inc.*, IPR2020-00086, Paper 8 at 21-22 (Apr. 27, 2020).

[20] See *Abbott*, IPR2022-00913 at 16.

[21] Petitioners pursuing indefiniteness in district court should be aware that the Board can still resolve unpatentability for some indefinite claims and is obligated to do so unless it is "logically impossible." See *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801, 812-14 (Fed. Cir. 2021).

[22] See *Regents of Univ. of Minnesota v. LSI Corp.*, No. 5:18-CV-00821-EJD, 2023 WL 5520958, at *7 (N.D. Cal. Aug. 25, 2023).

[23] 35 U.S.C. § 315(e)(2); 35 U.S.C. § 325(e)(2).