

PTAB - Into the Details

A Roundtable Discussion

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- Deputy Chief Administrative Patent Judge Scott Boalick
- FCBA PTAB Committee Leadership

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Introduction

- The most significant changes to PTAB AIA petition law since inception of PTAB petitions occurred in the last few months.
- These slides summarize the major changes, to provide a basis for a detailed discussion of the impact of the changes on the Courts, the PTAB, Practitioners, and IP stakeholders.

315(b) Time Bar

- 2012-2018 - The PTAB developed a substantial body of 315(b) case law.
- Early Federal Circuit decisions concluded that 314(d) barred judicial review of PTAB 315(b) determinations.

315(b) Time Bar

- 1/2018 - The en banc Federal Circuit concluded that PTAB 315(b) determinations are subject to judicial review. (*Wi-Fi One v. Broadcom*)
- 4/2018 – The Federal Circuit panel majority generally approved of the PTAB’s criteria for determining real party and privies, for 315(b) time bar determinations. (*Wi-Fi One v. Broadcom*)

315(b) Time Bar Consequence

- “PTAB-settled” 315(b) determinations on fact patterns and issues of law are now unsettled.
- Similar 315(b) fact patterns and issues of law will eventually be reviewed by the Federal Circuit.

315(e) Estoppel

- 315(e) limits estoppel to a claim “that results in a final written decision.”
- 2012-2018 - PTAB institution decisions were made on a claim/ground by claim/ground basis. Redundancy policy applied. (*Liberty Mutual v. Progressive Casualty*)
- 2/2015 - The Federal Circuit concluded that the statute does not require PTAB to address, in the FWD, every claim challenged in the petition. (*Synopsys v. Mentor Graphics*)
- 3/2016 and 4/2016 - The Federal Circuit concluded that the statute precluded estoppel against denied grounds. (*Shaw v Automated Creel; HP v. MPHJ*)

315(e) Estoppel

- 5/2018 – The S.Ct. concluded that PTAB must institute on all claims challenged in a petition, if the PTAB decides to grant the petition. (*SAS v. Iancu*)
- 5/2018 – The PTAB decided to also institute on all grounds, if the PTAB grants a petition.

315(e) Estoppel Consequence

- Prior to *SAS*, 315(e) did not estop Petitioner, RPI, and privies from re-challenging in district court, claims and grounds in a petition for which institution was denied.
- After *SAS*, 315(e) estoppel applies against Petitioner, RPI, and privies, for any claim in a PTAB AIA petition that is not found unpatentable.

BOP - Motions to Amend

- 8/2012 - 37 CFR 42.20 placed the BOP on the movant; and 42.122 regulated motions to amend.
- 6/2015 - The Federal Circuit concluded that 42.20 applied to motions to amend. (*Microsoft v. Proxyconn*)
- 10/2017 - The Federal Circuit *en banc* held that the PTO had not adopted a rule placing the BOP for substitute claims in a motion to amend on the Patent Owner, and could not do so absent notice and comment rulemaking. (*Aqua Products, Inc. v. Matal*).

BOP - Motions to Amend Consequence

- The BOP on substitute claims in a motion to amend flipped from the Patent Owner to the Petitioner (or the PTAB).
- Accordingly, it is now relatively more likely that a motion to amend will be granted.

Claim Construction

- 8/2012 - The PTO adopted rule 42.100(b) (BRI claim construction standard for claims of an unexpired patent).
- 6/2016 - The S.Ct. concluded PTO had power to promulgate a rule specifying a claim construction standard. (*Cuozzo*)
- 5/2018 - The PTO proposed amending 42.100 to switch from BRI to a *Phillips* claim construction standard. (*Docket No. PTO-P-2018-0036*)

Claim Construction Consequence

- This change in claim construction standard from BRI to *Phillips* would make it less likely the PTAB would find a substitute claim unpatentable.
- This change would align claim construction standards for PTAB AIA petitions with district court patent infringement actions.

SAS Institute Inc. v. Iancu

- 4/24/2018 - The S.Ct. decided that PTAB must institute on all claims or none.
- 4/26/2018 - The PTAB announces it will also institute on all grounds, or none. (PTAB website)
- 6/5/2018 - The PTAB posts SAS Q&As. (PTAB website)

SAS Institute Inc. v. Iancu – PTAB Guidance

The PTAB guidance addresses the effect of *SAS*

- On partially instituted on-going proceedings.
- On instituted challenges previously denied for statutory reasons (325(d); 112(f); 315(e)).
- On future challenges that could be denied for statutory reasons (325(d); 314(a); 112(f)).
- On the content of institution decisions.

SAS Consequences

PTAB

- Disruption of ongoing proceedings that were partially instituted.
- Changes to PTAB process for deciding whether to institute.
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Federal Circuit

- Disruption of appeals from partial institutions.
- Unsettled questions of jurisdiction (e.g., *Polaris v. Arctic Cat*, 5/30/2018, remanded without determining jurisdiction question)

District Courts

- Estoppel, stays, PTAB as evidence

Parties

- PTAB petition structure, tactics, strategic decisions

Conclusion

- There have been substantial changes in PTAB law and practice that affect the Courts, the PTAB, Practitioners, and IP stakeholders.

Appendix of Attachments

1. *SAS Institute Inc. v. Iancu*, 16–969 (4-24-2018)
2. *Aqua Products, Inc. v. Matal*, 2015-1177 (Fed. Cir. 10-4-2017)(en banc)
3. *Wi-Fi One, LLC v. Broadcom Corporation*, 2015-1944 (Fed. Cir.1-8-2018)(en banc)
4. PTAB SAS Questions and Answers (6-5-2018)
5. PTAB Guidance on the impact of SAS (4-26-2018)
6. Notice of Proposed Rulemaking, Claim Construction, 42.100(b); 200(b); 300(b)