

Patent Practice in View Of PTAB AIA Proceedings

FOR:

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By:

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Resources

Paper – [PTAB AIA Proceedings in the USPTO](#)

<http://www.neifeld.com/pubs/PTAB%20AIA%20Proceedings%20in%20the%20USPTO.pdf>

Cases - <http://www.neifeld.com/cases.pdf>

PatentInterPartes - <https://groups.yahoo.com/neo/groups/PatentInterPartes/info>

OUTLINE

1. 315(a)/325(a) Venue/Election
2. Potential Infringer Files First
3. Patent Owner (PO) Files First

Election/Venue 315/325(a)

- PTAB Petition Barred by Prior DJ Invalidation Action by Same RPI
- DJ *Automatically Stayed* if Filed On or After RPI Files PTAB Petition
- Civil Action/Counterclaim of Infringement by PO Ends the Automatic Stay

Automatic Stay Impact

- *Plantronics, Inc. v. Callpod, Inc.*, 3:14-cv-04639, document 39 (N.D. Cal. 1/21/2015)
- IPRs on 4 Patents
- DJ on 5 Patents
- (“interest of judicial economy to stay this case”)

Civil Action Stay Factors

- What Remains Undone (*Timing*)
- Simplification Of Issues
(Alignment)
- Prejudice To Non-Movant

Potential Infringer Files

First: Pet1 + DJ

Month

Action

0 Pet1 + DJ + Automatic Stay
(Favorable Venue Secured)

5 Pet1 Institution Decision (ID)

17 Pet1 FWD

(Civil Action Awaits PTAB Resolution)

Potential Infringer Files

First: Pet1 + DJ, Pet2

Month	Action
0	Pet1 + DJ + Automatic Stay (Favorable Venue Secured)
5	Pet1 Institution Decision (ID)
6	Pet2
11	Pet2 ID
17, 23	Pet1, Pet2, FWDs (Civil Action Awaits PTAB Resolution)

Impediments to Pet2 (Later Filed Petitions)

- 315/325(a)(1) Petition Bar – FRCP 41(a)(1) Dismissal W/O Prejudice
- 315(e)/325(e) PTO Estoppel – Joinder; Pet1 Limited Claims and Maximum Grounds
- 325(d) Sub. Same Art, Arguments – Different Claims

Impact of PO Counterclaim

Month	Action
0	Pet. + DJ + Automatic Stay
2	PO Counterclaims
5	IPR Institution Decision (ID)
5	Plaintiff Moves to Stay
	<i>Timing Favors a Stay</i>
17	IPR FWD

Impact of PO Civil Action and Motion to Transfer

- 28 USC 1404(a) Factors
- The First Filer Rule Applies to Patent Case DJs
- *AIA Intent* Was to Allow Petitioner to Select Venue

PO Files First: Civil Action for Patent Infringement

- 315(a)/325(a) Inapplicable
- Impact of PTAB Petition On Stay of Court Action Depends Upon Relative Speeds of PTAB and Applicable District Court

PO Files First

Month	Action
0	PO Files Infringement Action
7	Pet1 Filed
12	Pet1 ID
12	Pet2 Filed
17	Pet2 ID
23, 28	- FWDs

Median Time From Filing (Months)

Court	Trial	IPR Stay Dec.
• E.D. Va.	10	7
• M.D. Fla.	17	9
• E.D. Tex.	23	14
• N.D. Cal.	28	11
• D. Del.	31	15

Petition IDs be In Time to Promote a Stay?

COURT	Trial	Pet1	Pet2
• E.D. Va.	10	12	17
• M.D. Fla.	17	12	17
• E.D. Tex.	23	12	17
• N.D. Cal.	28	12	17
• D. Del.	31	12	17

Final Notes

- The Legal Framework For PTAB Petitions Is Still Uncertain (Joinder, Estoppel, 315(b); Scope of Judicial Review; Standard of Review); Await S.Ct. Review
- Under the Current Framework, the First Filer Has Reduced or Deferred Cost, and Increased Tactical Advantages

THANK YOU!

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Appendix

- The following slides present some additional material readers may find useful. However, they are not being included in the verbal presentation.

PGR Petition Standing

- FITF Patent
- 9 Months of Patent Issuance
- No Estoppel

IQR Petition Standing

- Within 1 year of “served with a complaint alleging infringement of the patent”
- > 9 months after FITF Patent Issuance + PGR Terminations
- No Estoppel

CBM Petition Standing

- CBM Patent
Petitioner, RPI, or Privy “sued for ...
or...charged with infringement under
that patent.”
- > 9 months after FITF Patent
Issuance
- No Estoppel

Petition Grounds

FITI (not FITF) Patents

CBM - 282(b)(2) or (3), except that prior art is limited to Pre-AIA 102(a), (b); excludes (e)

IPR - 102, 103, “prior art ... patents or printed publications”

Petition Grounds

FITF (Not FITI) Patents

- *PGR* - 282(b)(2) or (3)
- *CBM* - 282(b)(2) or (3)
- *IPR* - 102, 103 “prior art ...
patents or printed publications”

USPTO Director Authorized Expanded Joinder

- By Same Party
- On Different Issues
- For IPRs Filed After a 315(b)
1 Year Bar Date

PTO Scope Of Estoppel

- “Reasonably Could Have Raised” (IPR, PGR, CBM)
- Petition, RPI, or Privy cannot “request[] or maintain[] a proceeding” for a claim, after it Gets a FWD on the Claim.

Limiting PTAB Estoppel

- PTAB Institutes Trial ***Only*** on Claims Against Which Petition Meets Threshold
- PTAB Enters Final Written Decisions ***Only On Instituted Claims.***

Estoppel

- Statutory Estoppel Applies *Only* to a Claim that “results in a final written decision.”

Limiting PTAB Estoppel

- No Estoppel Against A Claim, On a Ground in a Petition, *If That Ground Was Denied Institution*
- *Shaw Industries Group v. Automated Creel Systems*, (Fed. Cir. 3/23/2016).

PTAB Proceedings as Evidence

- Motions *in Limine*
- PTAB institution and FWDs
- Issues of Validity and Willfulness