



2018 APPELLATE YEAR IN REVIEW

Since the America Invents Act gave rise to the PTAB and its new post-grant proceedings, the PTAB and its reviewing courts have grappled with the bounds and implications of the new regime. This past year was no different, as the Supreme Court and Federal Circuit rendered many decisions in 2018 that drastically impacted PTAB practice.

The Supreme Court addressed AIA trials twice in the same day. In *Oil States*, the Court sustained inter partes reviews over Article III and Seventh Amendment challenges, while leaving open the possibility of future constitutional challenges. And in *SAS*, the Court disrupted settled PTAB practice by banning the PTAB’s use of partial institution decisions.

The Federal Circuit also shed light onto important aspects of PTAB practice, including its en banc consideration of the scope of the appealability bar in *Wi-Fi One*. It addressed a host of other issues, including Article III standing for PTAB appeals, Administrative Procedure Act challenges to PTAB decisions, and the ability of sovereign entities to claim immunity from post-grant challenges.

But the story doesn’t end there. While these decisions provided much needed clarity, they also left many questions unanswered, which means we’ll be in for another exciting year in 2019!

This Year in Review, presented by the Committee on Appeals from the PTAB, synthesizes the most important appellate decisions of 2018 and puts them into the context of the rapidly evolving PTAB practice, with an eye toward what is to come in 2019 and beyond. We hope you find it interesting and informative.

Disclaimer: The views and opinions set forth in these articles are the personal views and opinions of the authors. They do not necessarily reflect the views or opinions of their law firms or organizations or their clients or members.

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Oil States and Subsequent Constitutional Challenges to Post-Grant Proceedings

By: Craig Countryman¹

Patent owners have challenged the constitutionality of post-grant proceedings ever since they began. Their initial attack was to argue that Congress, by allowing the Patent Office to revisit patentability after patent issuance, had usurped the patentee's right to an Article III court. The Federal Circuit rejected that argument in *MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284 (Fed. Cir. 2015), and the Supreme Court denied *certiorari*, leaving everyone to think the issue was settled. But a couple years later, the Court agreed to address the issue in *Oil States Energy Services, LLC v. Greene's Energy Group, LLC*, 138 S. Ct. 1365 (2018), prompting a year of uncertainty in the patent bar. Was the Supreme Court going to invalidate post-grant proceedings, and, if so, what would become of prior decisions invalidating patents? As it turned out, *Oil States* upheld *inter partes* review (IPR) by a comfortable 7-2 margin.

The issue in *Oil States* evolved in an unusual direction. Parties are entitled to have disputes over "private rights" resolved in Article III court, but disputes over "public rights," i.e., disputes "arising between the government and others," may be resolved by administrative agencies. So the question was ostensibly whether a dispute over the validity of an issued patent involves "private" or "public" rights. But the patentee oddly conceded that prior procedures for reconsidering validity—like *ex parte* reexamination and *inter partes* reexamination—posed no Article III problem. The patentee instead argued that IPR was different because the proceedings were "adversarial," and involved discovery, depositions, cross-examination, and an oral hearing before the PTAB. But this is irrelevant to whether the PTAB was adjudicating "private" or "public" rights, and, indeed, the Court brushed off these arguments.

The Court focused on a straight-forward syllogism. The initial decision to grant a patent is unquestionably a dispute "between the government and others." IPR simply allows the government to take a second look at whether the patent should have been granted, so it too is a matter involving public rights. It doesn't matter that this second look occurs after the patent is granted, because "[p]atent claims are granted subject to the qualification that the Patent Office has the authority to reexamine—and perhaps cancel—a patent claim in an *inter partes* review." And, because the constitution permitted the Patent Office to reconsider its decision outside an Article III court, the patentee also had no Seventh Amendment right to jury trial on the issue either.

Although *Oil States* resolved one constitutional challenge to IPR, it left open others. The Court noted that it was not addressing a "challenge [to] the retroactive application of *inter partes* review, even though that procedure was not in place when [the] patent issued." It also was not considering any "due process challenge" to the adequacy of the IPR procedures. And it cautioned that patents are "property" for purposes of the due process and takings clauses. Those caveats have led patent owners to challenge post-grant proceedings on all of those grounds. The Federal Circuit hasn't addressed those challenges yet, but it will soon enough.

The most significant future challenge to post-grant proceedings, however, may be one not flagged in *Oil States*. Some parties have questioned the IPR procedure under the Appointment Clause, because judges on the PTAB are not appointed by the President and confirmed by the Senate. The Clause requires presidential appointment and Senate confirmation for "Officers of the United States" but allows the appointment of "Inferior Officers" to be made by the "Heads of Departments," as is done for PTAB judges. So the constitutionality of the current process will turn on whether PTAB judges are "Inferior Officers."

There are many reasons to think that the current process is permissible and that PTAB judges are, in fact, Inferior Officers. The Supreme Court has told us that an officer is "inferior" if she has, not surprisingly, a "superior," who can exercise control over at least some aspects of how she does her job.² That authority doesn't have to be absolute, and an officer can have some degree of independence yet still be "inferior"—*Morrison* held that the independent counsel was still an inferior officer, despite his ability to initiate prosecutions without sign-off by superiors.

It would seem that superiors exercise enough authority over PTAB judges to make them "inferior officers." The Director can decide whether to institute any post-grant proceeding, so PTAB judges can't find any claim unpatentable without the Director's approval for the proceeding. It's true that the Director usually delegates institution decisions to the PTAB, but he doesn't have to. The Director also can set the procedures for post-grant proceedings, can make decisions regarding joinder, can select which PTAB judges adjudicate a particular case, can determine which PTAB decisions shall be deemed precedential, and may expand any PTAB panel on rehearing with additional judges of his choosing. The Secretary of Commerce (in consultation with the Director) has hiring and firing power over the PTAB judges, and the Director sets their salaries. That said, once a particular post-grant proceeding is underway, the PTAB issues a final decision, without a direct mechanism for the Director to review it.

The bottom line is that although post-grant proceedings are safe for now after *Oil States*, there are more constitutional challenges to come in 2019.

² *Edmond v. United States*, 520 U.S. 651 (1997) (holding military appellate judges were inferior officers despite their "significant authority," where a superior officer set the procedural rules and could remove the judges, and where the judges' ability to render a final decision was dependent on a superior's assent); *Morrison v. Olson*, 487 U.S. 654 (1988) (holding the independent counsel was an inferior officer despite possessing "a degree of independent discretion," where he had "limited duties" to prosecute "certain federal crimes," had no ability to "formulate policy," was of "limited tenure," and could be removed for good cause).

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SAS Institute v. Iancu: What Do We Know About the PTAB's Discretion?

By: Gregory A. Castanias and Daniel Kazhdan¹

The SAS Decision

In its recent decision in *SAS Institute Inc. v. Iancu*, the Supreme Court dramatically changed the way the Patent Trial and Appeal Board (PTAB) conducts *inter partes* review (IPR).² In Illinois district court, ComplementSoft LLC sued SAS for infringing its patent. SAS responded by petitioning for IPR. The PTAB's practice at the time was to institute partial review, and that is what it did in *SAS*. The PTAB instituted review on nine of the 16 claims challenged in ComplementSoft's patent. The PTAB ultimately upheld one claim, invalidated eight, and, consistent with its institution decision, did not address the others.

SAS argued that the PTAB's partial institution practice contravened the statute and was bad policy, but the PTAB refused to reconsider, and the Federal Circuit affirmed. The Supreme Court, however, agreed to review the case, and, in a 5-4 decision, it reversed. It held that the statute was clear: 35 U.S.C. § 318(a) requires the Patent Office to issue a decision on "any patent claim challenged by the petitioner," and, the Supreme Court concluded, here, "any" means "every." The Supreme Court further noted that everything about the IPR statute suggests that "petitioner, not the Director, . . . gets to define the contours of the proceeding." So, here, that meant that the petitioner gets to decide which claims should be reviewed, and the PTAB has a "binary choice—either institute review or don't."

The PTAB's Interpretation of SAS

SAS created a number of problems for pending cases. What happens to pending PTAB cases where the PTAB only instituted review on some claims? What about partially instituted cases that were on appeal? And, under *SAS*, is the PTAB required to consider all the challenges raised by the petitioner or just all the claims—but, perhaps, under only some of the challenges?

The PTAB and the Federal Circuit quickly set out to try and bring order. Just two days after the Supreme Court handed down *SAS*, the Patent Office issued its Guidance on the Impact of *SAS* on AIA Trial Proceedings.³ First, "[a]s required by the decision," PTAB panels would stop instituting partial review. Second, PTAB panels that had already instituted only partial review would consider supplementing the institution decision to bring the non-instituted claims into the proceeding. Third, the PTAB panels would institute IPRs on all challenges.

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² 138 S. Ct. 1348 (Apr. 24, 2018).

³ Guidance on the Impact of *SAS* on AIA Trial Proceedings (Apr. 26, 2018), available at [https://www.uspto.gov/sites/default/files/documents/guidance_on_the_impact_of_sas_on_aia_trial_proceedings_%20\(april_26,_2018\)](https://www.uspto.gov/sites/default/files/documents/guidance_on_the_impact_of_sas_on_aia_trial_proceedings_%20(april_26,_2018).).

The Federal Circuit's Application of SAS

As the court that reviews the PTAB, it was not long before the Federal Circuit had to deal with the implications of *SAS*. Just days after the decision, the Federal Circuit asked a number of parties to brief the effects of *SAS*.⁴ Most of the Federal Circuit decisions that have had to address *SAS*, including the first few, address partial-institution decisions where the petitioner has asked the Federal Circuit for a remand—generally a simple issue. The Federal Circuit has been uniformly remanding such cases.⁵ In one case, the Federal Circuit agreed to remand a partially instituted IPR that it had previously affirmed—before *SAS*.⁶

It was not long, though, before the Federal Circuit started making substantive pronouncements on the meaning of *SAS*. In *Polaris Industries Inc. v. Arctic Cat, Inc.*, another partially instituted IPR, the Federal Circuit ordered the PTAB to consider "noninstituted claims and grounds"—although the Federal Circuit did not explain why it believed *SAS* required institution on all grounds.⁷

PGS Geophysical AS v. Iancu is the first precedential opinion on the scope of *SAS*.⁸ WesternGeco petitioned for an IPR on one of PGS's patents. The PTAB instituted IPR on only some claims and, even among those, on only some challenges. The PTAB upheld some claims while deeming others unpatentable. Both parties appealed, although WesternGeco withdrew after settlement Director Iancu intervened. No party protested the partial institution. That satisfied the Federal Circuit: *SAS*, it held, was not a jurisdictional problem, so courts were not required to raise *SAS* challenges on their own. Although it arguably could have stopped there, the Federal Circuit proceeded to hold that *SAS* requires both institution on all "claims" and institution on all "grounds." It explained that, although "the primary statutory ground of [the *SAS*] decision[] speaks only of deciding all challenged and added 'claims,'" the Supreme Court indicated more broadly that the petitioner, not the PTAB, gets to decide the scope of the IPR. The PTAB has only a binary "yes-or-no" choice of instituting that petition.

⁴ See, e.g., *PGS Geophysical AS v. Iancu*, No. 16-2470, Doc. 44 (Fed. Cir. May 4, 2018); *PGS Geophysical AS v. Iancu*, No. 17-1582, Doc. 55 (Fed. Cir. May 4, 2018); *BASF Corp. v. Iancu*, No. 17-1425, Doc. 72 (Fed. Cir. May 4, 2018); see also *Yeda Research & Development v. Mylan Pharm.*, No. 17-1594, Doc. 66 (Fed. Cir. Apr. 27, 2018) (ordering the parties to be ready to discuss at oral argument).

⁵ See, e.g., *Ulthera, Inc. v. DermaFocus LLC*, No. 2018-1542, 2018 WL 4087900 (Fed. Cir. May 25, 2018); *Baker Hughes Oilfield Operations, LLC v. Smith Int'l, Inc.*, No. 2018-1754, 2018 WL 4087705 (Fed. Cir. May 30, 2018).

⁶ *Broad Ocean Techs., LLC v. Nidec Motor Corp.*, 727 F. App'x 686 (Fed. Cir. June 14, 2018) (panel agreeing to rehear *Broad Ocean*, 727 F. App'x 686 (Fed. Cir. Apr. 5, 2018), and ultimately remanding).

⁷ 724 F. App'x 948, 950 (Fed. Cir. May 30, 2018).

⁸ 891 F.3d 1354 (Fed. Cir. June 7, 2018).

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SAS Institute v. Iancu: What Do We Know About the PTAB's Discretion?

SAS Institute v. Iancu, continued from page 3

Whether or not PGS needed to reach the issue of non-instituted “grounds,” later cases agreed that the PTAB must consider all “grounds.”⁹ SAS is somewhat in tension with the Supreme Court’s earlier decision in *Cuozzo Speed Technologies, LLC v. Lee*.¹⁰ Recall that under SAS, the “petitioner, not the Director, . . . gets to define the contours of the proceeding.” Thus, for example, it would “not be proper for the Board to deviate from the grounds in the petition and raise its own obviousness theory.”¹¹ But, as the Supreme Court seemed to hold in *Cuozzo*, the PTAB is given unreviewable discretion in deciding what the grounds in the petition are.

The *Cuozzo* case began when Garmin petitioned for IPR of all 20 claims of one of *Cuozzo*’s patents. Garmin raised different grounds for the different claims. It challenged claim 17 as obvious over the Aumayer, Evans, and Wendt patents. Although claim 17 depended from claims 10 and 14, Garmin had not expressly challenged claims 10 and 14 on that ground. Nonetheless, the PTAB decided that Garmin had “implicitly” challenged claims 10 and 14 on those grounds, it therefore instituted review on those grounds, and, ultimately, it cancelled claims 10 and 14 on those grounds. *Cuozzo* argued that the PTAB had overstepped the petition in relation to claims 10 and 14.

The Federal Circuit, however, held that the decision to institute was “nonappealable” under 35 U.S.C. § 314(d), and the Supreme Court affirmed. Thus, although SAS holds that the PTAB must institute an IPR, if at all, precisely as the petitioner has asked, under *Cuozzo* the PTAB would seem to have enormous discretion, at least in deciding what it is that the petitioner asked.

There is no small amount of tension between *Cuozzo*’s holding that the PTAB’s decision to expand Garmin’s petition to claims “implicitly” but not explicitly challenged by the petitioner, and SAS’s holding that the “petitioner, not the Director, . . . gets to define the contours of the proceeding.” Perhaps *Cuozzo* is limited to cases where it can be fairly said that the petitioner “implicitly” challenged unenumerated claims, and the petitioner acquiesces in the scope of that PTAB institution. But what if, for example, the petitioner did not wish for the additional claims to be instituted? What if the claims added by the PTAB cannot be said to have been “implicitly” challenged in the petition? The line between *Cuozzo* and SAS has not yet been addressed by the Federal Circuit, and it will be interesting to see how the court draws the line between an unreasonable but nonappealable Patent Office interpretation of a petition and a reversible Patent Office decision to replace the petition’s arguments with its own.

9 *Adidas AG v. Nike, Inc.*, 894 F.3d 1256 (Fed. Cir. July 2, 2018); *Nestle Purina Petcare Co. v. Oil-Dri Corp.*, No. 2017-1744, 2018 WL 4087894, at *1 (Fed. Cir. June 11, 2018); *Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1371 n.1 (Fed. Cir. June 11, 2018), 10 136 S. Ct. 2131 (2016).

11 *Sirona Dental Sys. GmbH v. Institut Straumann AG*, 892 F.3d 1349, 1356 (Fed. Cir. 2018).

Wi-Fi One Appealability of Time-Bar Issues and Related Developments

By: Pauline Pelletier¹

In the aftermath of the Supreme Court's decision in *Cuozzo Speed Techs., LLC v. Lee*, which upheld the non-appealability of "questions that are closely tied to the application and interpretation of statutes related to the Patent Office's decision to initiate inter partes review," parties began exploring potential exceptions to the statutory bar against appealing issues decided at the institution stage.² Indeed, *Cuozzo* expressly left open the possibility for such challenges, noting "we need not, and do not, decide the precise effect of § 314(d) on appeals that implicate constitutional questions, that depend on other less closely related statutes, or that present other questions of interpretation that reach, in terms of scope and impact, well beyond 'this section'" and "we do not categorically preclude review of a final decision where a petition fails to give 'sufficient notice' such that there is a due process problem with the entire proceeding, nor does our interpretation enable the agency to act outside its statutory limits."³ The Supreme Court further observed that "[s]uch 'shenanigans' may be properly reviewable in the context of § 319 and under the Administrative Procedure Act."⁴ While the precise definition of what qualifies as a "shenanigan" is continuing to evolve, the Federal Circuit's en banc decision in *Wi-Fi One, LLC v. Broadcom Corp.*, decided in January of 2018, established the appealability of one institution-stage determination having great practical significance: the time-bar of 35 U.S.C. § 315(b).⁵

The PTAB may not institute *inter partes* review (IPR) "if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent."⁶ This statutory provision is commonly referred to as the one year time-bar. In *Achates Reference Publishing, Inc. v. Apple Inc.*, decided in 2015, a panel of the Federal Circuit held that the PTAB's initial time-bar determinations are not appealable under § 314(d).⁷ In 2017, the full court granted rehearing en banc in *Wi-Fi One* to consider whether *Achates* should be overruled.

In *Wi-Fi One*, the patent owner argued that the IPR was time-barred because at least one party sued for infringement more than one year prior to the IPR filing was in privity with the petitioner, or was a real party in interest to the proceeding. The panel in *Wi-Fi One* declined to reach the issue, deeming it non-appealable consistent with *Achates*. On rehearing en banc, a 9-4 majority overruled *Achates*. The majority first evaluated how application of the time-bar differs from the PTAB's statutory discretion to institute trial. The majority reasoned: "The time bar is not merely about preliminary procedural requirements that may be corrected if they fail to reflect real-world facts, but about real-world facts that limit the agency's authority to act under the IPR scheme."⁸ The majority also considered the presumption in favor of judicial review of agency decisions, holding "[e]nforcing statutory limits on an agency's authority to act is precisely the type of issue that courts have historically reviewed."⁹

Judges Lourie, Bryson, Dyk, and Hughes dissented on grounds that the appeal bar of § 314(d) should be regarded as "absolute" and that § 315(b) should be subject to it and thus not appealable.¹⁰ Ultimately, *Wi-Fi One* defined the time-bar as a hard limit on the PTAB's authority and therefore within the realm of initial decisions not immunized from appeal under § 314(d) and the Supreme Court's holding in *Cuozzo*. Since *Wi-Fi One* opened the door for review of the PTAB's time-bar determinations, the Federal Circuit has issued several decisions on the subject, the most significant of which are discussed below.

Most notable is an en banc footnote that appeared sua sponte in the court's opinion in *Click-To-Call Techs., LP v. Ingenio, Inc., YellowPages.com, LLC*.¹¹ Click-to-Call had sued Ingenio's predecessor-in-interest and certain other appellees for infringement of the challenged patent more than one year before the filing date of the petition. The PTAB nonetheless instituted trial, concluding that the petitioners were not time-barred because Click-to-Call's complaint had been dismissed without prejudice, thereby rendering it a "nullity" for purposes of § 315(b). A majority of the Federal Circuit overturned the PTAB in an en banc footnote, holding that the statute does not contain any such exception. The majority reasoned that "the text of § 315(b) clearly and unmistakably considers only the date on which the petitioner, its privy, or a real party in interest was properly served with a complaint" and "does not contain any exceptions or exemptions for complaints served in civil actions that are subsequently dismissed, with or without prejudice."¹² Judges Dyk and Lourie dissented from the en banc decision, agreeing with the PTAB that the dismissal of a complaint without prejudice renders the complaint a nullity. Based on its en banc ruling in *Click-to-Call*, the Federal Circuit has since reversed the PTAB's time-bar determinations in other cases involving complaints dismissed without prejudice.¹³

In *Applications in Internet Time, LLC v. RPX Corporation*, the Federal Circuit addressed the standard for what qualifies as a "real party in interest."¹⁴ In doing so, the court vacated a ruling by the PTAB that evidence suggesting that a member company (SalesForce.com) of the petitioner (RPX) was a time-barred real party in interest was insufficient to meet the standard set forth in the Office's Trial Practice Guide. The court faulted the PTAB for disregarding various types of circumstantial evidence, explaining that "[d]etermining whether a non-party is a 'real party in interest' demands a flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the pe-

¹⁰ *Id.* at 1380 (Hughes, J., dissenting).

¹¹ *Click-To-Call Techs., LP v. Ingenio, Inc., YellowPages.com, LLC*, 899 F.3d 1321 (Fed. Cir. 2018) (n.3 en banc).

¹² *Id.* at 1332.

¹³ *Luminara Worldwide, LLC v. Iancu*, 899 F.3d 1303, 1306 (Fed. Cir. 2018) (vacating decision "because the section 315(b) time-bar applies when the underlying complaint alleging infringement has been voluntarily dismissed without prejudice"); *Bennett Regulator Guards, Inc. v. Atlanta Gas Light Co.*, 905 F.3d 1311, 1315 (Fed. Cir. 2018) (differing "from *Click-to-Call* only in that Bennett's complaint was involuntarily dismissed without prejudice" and noting that "[j]ust as the statute includes no exception for a voluntarily dismissed complaint, it includes no exception for an involuntarily dismissed complaint").

¹⁴ *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336 (Fed. Cir. 2018).

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² *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2141 (2016).

³ *Id.*

⁴ *Id.* at 2142.

⁵ *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364 (Fed. Cir. 2018) (en banc).

⁶ 35 U.S.C. § 315(b).

⁷ *Achates Reference Publ'g, Inc. v. Apple Inc.*, 803 F.3d 652 (Fed. Cir. 2015).

⁸ *Wi-Fi One*, 878 F.3d at 1374.

⁹ *Id.*

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Wi-Fi One Appealability of Time-Bar Issues and Related Developments

Wi-Fi One Appealability, continued from page 5

itioner.”¹⁵ The court additionally noted that the Trial Practice Guide, regardless of the merits of the guidance it provides, “is not binding on Board panel members” and is therefore “at best, ‘entitled to respect’ under *Skidmore*”¹⁶

In *WesternGeco LLC v. ION Geophysical Corp.*, the Federal Circuit affirmed the PTAB’s determination that the petitioner (PGS) was not time-barred based on privity with the joined petitioner ION, who was sued for infringement more than one year prior.¹⁷ ION and PGS had a customer-manufacturer relationship relating to the accused product, including an agreement that ION would indemnify PGS for infringement liability. PGS had been served with a third-party subpoena in the litigation, appeared through counsel, and served discovery responses. The PTAB found that the parties were not in privity with respect to the IPR. It also determined that the existing business relationship between PGS and ION, without more, was insufficient to establish that ION controlled the IPR or that PGS had control over the prior litigation. The Federal Circuit agreed with the PTAB, reasoning that “[p]rivacy is essentially a shorthand statement that collateral estoppel may be applied in a given case,” further noting that “privity cannot extend beyond the limits of due process.”¹⁸ The court emphasized that the privity inquiry should focus on the “relationship between the named IPR petitioner and the party in the prior lawsuit.”¹⁹ Regarding the requirement for control, the court specifically noted: PGS had opposed ION’s motion to join the inter partes review; ION did not share any prior art with PGS for the IPR; ION did not contribute financially to the IPR; and the parties were represented by different counsel. Further, PGS’s limited involvement in the prior litigation did not afford it a “full and fair opportunity to litigate” the validity of claims in that litigation.²⁰ As a general observation about the analysis, the court notably observed: “[A] common desire among multiple parties to see a patent invalidated, without more, does not establish privity.”²¹

In *Worlds Inc. v. Bungie, Inc.*, the Federal Circuit clarified the burden-shifting framework for challenging and defending a real party in interest identification.²² The patent owner (Worlds) had challenged the petitioner’s (Bungie) identification of itself as the sole real party in interest. Specifically, Worlds sought discovery and offered evidence tending to show that an unnamed, barred party (Activision), was a real party in interest to the petition. Specifically, Worlds offered a software publishing and development agreement between Bungie and Activision as support for its real party in interest challenge and request for discovery. The PTAB denied the motion for discovery and determined that Worlds had not demonstrated that Activision was an unnamed real party in interest. Worlds appealed, arguing that the PTAB had erroneously placed the ultimate burden on the patent owner, rather than the petitioner Bungie. The court agreed with Worlds, holding that the petitioner bears the ultimate burden of persuasion to show that its petition is not time-barred. The court noted, however, that the petitioner’s identification can be taken at face value unless competently challenged by the patent owner who must provide “some evidence” that another party should have been named.²³ In this case, the court concluded that Worlds had furnished sufficient evidence to dispute the identification, vacating and remanding the PTAB’s decision for it to properly consider whether Bungie had carried its ultimate burden.

15 *Id.* at 1351.

16 *Id.* at 1345 n.2 (internal citations and quotations omitted).

17 *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308 (Fed. Cir. 2018).

18 *Id.* at 1318-19.

19 *Id.* at 1319.

20 *Id.* (internal quotations and citations omitted).

21 *Id.* at 1321.

22 *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237 (Fed. Cir. 2018).

23 *Id.* at 1242, 1244.

Challenges at the Federal Circuit Involving the Administrative Procedure Act

By: Melissa Brand¹

The Leahy-Smith America Invents Act (AIA) was a major piece of legislation signed into law in 2011. Perhaps the most widely discussed change brought about by the AIA was the establishment of the Patent Trial and Appeal Board (PTAB) to oversee post-grant patent opposition proceedings at the United States Patent and Trademark Office. Less widely discussed, though arguably the most important to patent applicants and patent owners, is that the AIA included 17 provisions of law requiring the Patent Office to promulgate new regulations, conduct studies on implementation, and establish new programs.²

With legislation of such massive scale and the daunting task of implementation unsurprisingly came a number of challenges from dissatisfied PTAB participants particularly with respect to the conduct of post-grant opposition procedures. Enter the Administrative Procedure Act (APA) – a sometimes overlooked federal statute that grants the judiciary oversight over agency actions and establishes the means through which agencies may establish rules and regulations. The patent bar saw some widely reported APA challenges soon after the first post-grant opposition challenges were making their way through the appeals process. Notably, the Supreme Court relied in part on the APA in ruling on the appealability of institution decisions in mid-2016.³ In 2017, the APA featured prominently in the Federal Circuit’s long-awaited *en banc* ruling on the claim amendment process.⁴

We continue to see APA challenges to the Patent Office’s implementation of the AIA at the Federal Circuit. This article reviews some of the noteworthy cases from 2018.

Notice and Fairness

Patent owners are entitled to notice and a fair opportunity to address the grounds of potential claim cancellation, including when the theories for cancellation change midstream. The Federal Circuit recently clarified that this threshold may not be quite as high as some patent owners would prefer. In *Anacor Pharmaceuticals, Inc. v. Iancu*,⁵ the PTAB cancelled all claims of the patent at issue, including a dependent claim directed to a method of treating an infection caused by a particular type of fungus. On appeal, the court rejected the patent owner’s argument that it had no opportunity to respond to a purported switch in theories set forth in petitioner’s reply and adopted by the PTAB. Instead, the court reiterated that the introduction of new evidence is to be expected in these proceedings if done in legitimate response to evidence presented by the patent owner. Moreover, a patent owner cannot claim lack of notice and opportunity to respond where it addressed some of the evidence in its own response and the new references were discussed in deposition.

In yet another arguably pro-petitioner decision, the court further

explained how fairness principles should be applied where circumstances change mid-proceeding. In *Ericsson, Inc. v. Intellectual Ventures I LLC*,⁶ the PTAB promulgated initial claim constructions utilizing the broadest reasonable interpretation standard in its institution decision, but the parties later agreed that the terms should be construed using the *Phillips* standard. After the parties essentially agreed on the new *Phillips* construction, Ericsson argued in its reply that the prior art references taught the newly construed limitation. While acknowledging that the PTAB may strike arguments improperly raised in reply, the court nevertheless held that the PTAB erred in striking the relevant portion of Ericsson’s reply. Because of the PTAB’s own evolving understanding of the relevant claim limitations and because the relevant portion of the reply “expressly follow[ed] from the[] contentions raised in the Petition” the PTAB had committed reversible error.

PTAB Discretion That Does Not Violate the APA

The Federal Circuit also took the opportunity to provide some clarification to the PTAB on the scope of its discretionary powers. For example, in *Dell Inc. v. Acceleron, LLC*,⁷ the court emphasized the robust power of the PTAB to decline to consider new evidence or arguments presented for the first time at oral argument. In a prior appeal, the court found that the PTAB had erred in relying on an argument first presented at the oral hearing and remanded for further proceedings consistent with the APA. In this second appeal, the court agreed that while the PTAB could have considered the new argument on remand, it was not required to do so. Finally, in *Paice LLC v. Ford Motor Company*,⁸ the court clarified the requirements placed on the PTAB by *Securities & Exchange Commission v. Chenery Corp.*⁹ While under *Chenery* the PTAB must provide a reasoned explanation of its decision, it is appropriate for the PTAB to cite portions of a petitioner’s papers as the basis for the PTAB’s decision if those citations render the “Board’s analysis [] readily discernible.” This is particularly true where the PTAB’s analysis is commensurate in scope with the arguments raised by the patent owner.

Conclusion

We can expect APA challenges to post-grant opposition proceedings to continue. These proceedings are widely popular with those facing claims of patent infringement and those who seek to benefit from the harms resulting to patent owners from institution. Yet for these reasons and for others outside the scope of this article, the proceedings remain quite controversial. It seems likely that the Federal Circuit will continue to hear these types of challenges throughout 2019 and beyond.

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² Study and Report on the Implementation of The Leahy-Smith America Invents Act, available at https://www.uspto.gov/sites/default/files/documents/Report_on_Implementation_of_the_AIA_September2015.pdf.

³ *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131 (2016).

⁴ *Aqua Products v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017).

⁵ 889 F.3d 1372 (Fed. Cir. 2018).

⁶ 901 F.3d 1374 (Fed. Cir. 2018).

⁷ 884 F.3d 1364 (Fed. Cir. 2018).

⁸ 881 F.3d 894 (Fed. Cir. 2018).

⁹ 318 U.S. (1943).

Federal Circuit Cases Applying the Test for “Printed Publication” Status

By: Jihong Lou¹

In *inter partes* reviews (IPR), a ground of unpatentability must be based on “prior art consisting of patents or printed publications.”² A petitioner bears the burden of establishing that a non-patent reference qualifies as a printed publication.³ Whether a reference constitutes a printed publication is a legal conclusion based on underlying factual determinations, such as its public accessibility.⁴ “A reference is considered publicly accessible if it was disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.”⁵ In 2018, several Federal Circuit decisions addressed the issue of public accessibility of a printed publication.

In *Medtronic v. Barry*,⁶ the court vacated the PTAB’s finding that a video and related slides distributed at conferences were not publicly accessible and therefore not “printed publications.” Because the video and slides were not stored for public access after the conferences, the question there was whether the materials were “sufficiently disseminated at the time of their distribution.”⁷ The court found several factors to be relevant, including (1) “the size and nature of the meetings and whether they are open to people interested in the subject matter”; (2) any “expectation of confidentiality between the distributor and the recipients of the materials”; and (3) even if there was “no formal, legal obligation of confidentiality,” any “policies or practices” that would give rise to an expectation of confidentiality.⁸ Because the PTAB failed to consider all those factors, the court vacated its decision and remanded.

In *Jazz Pharmaceuticals v. Amneal*,⁹ the court affirmed the PTAB’s finding that certain FDA advisory committee meeting materials were publicly accessible as supported by substantial evidence. In that case, the FDA announced the advisory committee meeting in the Federal Register, which provided a hyperlink to an FDA website where the meeting materials were posted and instructions on how to access the materials.¹⁰ The court noted that “whether a reference is a ‘printed publication’ is a ‘case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public.’”¹¹ The court then considered factors including (1) the breadth of dissemination, including whether “the disseminated material[s] [are] addressed to or of interest to persons of ordinary skill”; (2) the length of time the materials were available online; and (3) any expectation of confidentiality.¹² The court affirmed the PTAB because the FDA materials were “broadly disseminated to interested persons of ordinary skill for a substantial time with no expectation of confidentiality.”¹³

In *Nobel Biocare v. Intradent*,¹⁴ the court likewise affirmed the PTAB’s finding that a product catalog was publicly accessible as supported by substantial evidence. The parties disputed whether the catalog, disclosing certain dental implants, was distributed at a particular trade show. The petitioner submitted declarations from two individuals testifying that one of them asked another to collect dental implant catalogs from the trade show, among which was the catalog at issue.¹⁵ The court conducted a “rule of reason” analysis finding the testimony sufficiently corroborated by the evidence of record.¹⁶

In *GoPro v. Contour*,¹⁷ the reference at issue was again a catalog distributed at a trade show. There, the patents at issue relate to cameras that may be used on action sports vehicles, including point-of-view cameras.¹⁸ The petitioner submitted a declaration as evidence showing that a catalog disclosing such a camera was distributed at a trade show attended by dealers of action sports vehicles.¹⁹ The PTAB, however, found that the catalog did not qualify as a “printed publication” because (1) the dealer trade show was open only to dealers and not to the general public, and (2) a person ordinarily skilled in the art would not be interested in the dealer show for action sports vehicles.²⁰ The court reversed, faulting the PTAB for narrowly focusing on the expertise of the target audience.²¹ The court explained that other factors—such as “the nature of the conference or meeting; whether there are restrictions on public disclosure of the information; expectation of confidentiality; and expectations of sharing the information”—should also be considered.²²

Lastly, in *Acceleration Bay v. Activision Blizzard*,²³ the court affirmed the PTAB’s finding that a technical report posted on a website was not publicly accessible. In that case, the PTAB found that the website allowed a user to view a list of technical reports indexed only by author or year, and that the website’s advanced search form was deficient and did not allow a user to reliably search by keywords.²⁴ The court agreed with the PTAB that “public accessibility requires more than technical accessibility.”²⁵ The court affirmed the PTAB because the technical report at issue was “not *meaningful* indexed such that an interested artisan exercising reasonable diligence would have found it.”²⁶

A key take away from these cases is that public accessibility is a fact specific inquiry that varies from case to case. A number of factors may be relevant to this inquiry.

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2 35 U.S.C. § 311(b).

3 See, e.g., *Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1380 (Fed. Cir. 2018) (citing *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1350–51 (Fed. Cir. 2016)).

4 *Id.*

5 *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 772 (Fed. Cir. 2018) (internal quotation marks and citation omitted).

6 *Medtronic, Inc. v. Barry*, 891 F.3d 1368 (Fed. Cir. 2018).

7 *Id.* at 1380.

8 *Id.* at 1382.

9 *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 895 F.3d 1347 (Fed. Cir. 2018).

10 *Id.* at 1351, 1356.

11 *Id.* at 1356 (quoting *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004)).

12 *Id.* at 1357–59.

13 *Id.* at 1360.

14 *Nobel Biocare Servs. AG v. Intradent USA, Inc.*, 903 F.3d 1365 (Fed. Cir. 2018).

15 *Id.* at 1372–73.

16 *Id.* at 1378 (citing *Woodland Tr. v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1371 (Fed. Cir. 1998)).

17 *GoPro, Inc. v. Contour IP Holding LLC*, 908 F.3d 690 (Fed. Cir. 2018).

18 *Id.* at 691–92.

19 *Id.* at 692.

20 *Id.* at 694.

21 *Id.*

22 *Id.*

23 *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765 (Fed. Cir. 2018).

24 *Id.* at 773.

25 *Id.* (internal quotation marks omitted).

26 *Id.* at 774.

Standing to Appeal from a Final Written Decision to the Federal Circuit

By: Ben Saidman¹

Article III of the U.S. Constitution limits federal judicial power to resolving “Cases” and “Controversies.”² Although Article III standing is not required to petition for *inter partes* review (IPR), once a party seeks review at the Federal Circuit, the constitutional requirement that a party have standing becomes a barrier to entry. And as the Federal Circuit’s prior decisions in *Consumer Watchdog v. Wisconsin Alumni Research Foundation*, 753 F.3d 1258 (Fed. Cir. 2014) and *Phigenix, Inc. v. Immunogen, Inc.*, 845 F.3d 1168 (Fed. Cir. 2017) showed, not all petitioners will be able to satisfy that constitutional requirement.

Under Supreme Court precedent, the standing requirement consists of three elements. An appellant must have (1) suffered an injury in fact, (2) that is fairly traceable to the challenged action, and (3) that is likely to be redressed by a favorable judicial decision. To establish injury in fact, an appellant must show an invasion of a legally protected interest that is concrete and particularized and actual or imminent, not conjectural or hypothetical.³ In 2018, the Federal Circuit shed further light on what is necessary to demonstrate injury in fact, especially as it relates to cases between practicing competitors.

In *Altaire Pharmaceuticals, Inc. v. Paragon Biotech, Inc.*, the Federal Circuit held that the appellant/petitioner had standing to appeal from an adverse final written decision.⁴ Under an agreement between the parties, the petitioner could not manufacture a competing (infringing) product until the agreement was terminated. The Federal Circuit found that because the patent owner was actively seeking a declaratory judgment to terminate the agreement early, and because the petitioner intended to file an ANDA for the product once the agreement terminated, injury to the petitioner was inevitable. According to the court, the petitioner’s injury was further compounded by the likelihood that it would be estopped from arguing that the patent was obvious on the same grounds that it had argued in the underlying proceeding. Judge Schall dissented, arguing the petitioner lacked the imminent harm required for standing because it could not infringe the patent until the agreement was terminated. Judge Schall also noted that estoppel does not constitute an injury in fact when the appellant is not engaged in any activity that would give rise to a possible infringement suit.

In *JTEKT Corp. v. GKN Automotive LTD.*, the Federal Circuit held that the appellant/petitioner failed to demonstrate injury in fact.⁵ The court noted that the petitioner alleged standing based on

declarations describing a product in development with a “potential risk of infringement.” The court found, however, that the petitioner did not establish that, at this stage of the development, its product created a concrete and substantial risk of infringement or would likely lead to claims of infringement. In denying standing, the court reiterated that estoppel provisions do not constitute injury in fact when the appellant is not engaged in any activity that would give rise to a possible infringement suit. The appellant JTEKT filed a petition for a writ of certiorari with the Supreme Court on December 7, 2018.

In *E.I. DuPont de Nemours & Co. v. Synvina C.V.*, the Federal Circuit held that the appellant/petitioner succeeded in demonstrating injury in fact because it “currently operates a plant capable of infringing the challenged patent.”⁶ To demonstrate standing, the petitioner submitted evidence that “the process conducted at its plant uses the same reactants to generate the same products using the same solvent and same catalysts as the [challenged] patent.” The court found that the evidence indicates that the appellant is engaged, or will likely engage, in an activity that would give rise to a possible infringement suit.

As a result, in 2018, the Federal Circuit shed more light on the evidence necessary to establish an injury in fact where the appellant/petitioner is a practicing competitor of the patent owner/appellee. In *JTEKT*, products in development were insufficient to create a substantial risk of infringement, but in *DuPont*, an operating plant that practiced many of the features of the challenged patent was sufficient. And in *Altaire*, the court provided an example of how to satisfy the requirement of “imminent” harm. Notably, in each of these cases, the parties submitted evidence for the first time on appeal. Questions still remain as to the limits of each of these cases, but the Federal Circuit has already demonstrated that the right to appeal from a final written decision is not a right that is extended to all petitioners—including practicing competitors.

Lastly, the Federal Circuit also resolved any question about whether the Director of the Patent Office has standing to intervene in an appeal from a PTAB decision in *Knowles Elecs. LLC v. Iancu*.⁷ Over a dissent from Judge Newman, the majority concluded that the Director has an unconditional statutory right to intervene in an appeal from a PTAB decision.

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² U.S. Const. art. III, § 2.

³ *Spokeo, Inc. v. Robins*, 136 S. Ct. 1540, 1548 (2016) (quotation omitted).

⁴ 889 F.3d 1274, 1283 (Fed. Cir. 2018), vacated in part pursuant to settlement, 738 F. App’x 1017 (Fed. Cir. 2018).

⁵ 898 F.3d 1217 (Fed. Cir. 2018).

⁶ 904 F.3d 996 (Fed. Cir. 2018).

⁷ 886 F.3d 1369 (Fed. Cir. 2018).

Sovereign Immunity from Post-Grant Challenges Before the PTAB

By: Daniel Tucker¹

Sovereign immunity protects sovereign entities from private suits without their consent. Two types of sovereign entities have recently claimed immunity from PTAB trials: Native American tribes and state governments. The Supreme Court has recognized that tribes enjoy sovereign immunity, provided that it is not waived by the tribe or abrogated by Congress.² State governments also enjoy sovereign immunity rooted in the states' retention of all rights not expressly transferred to the federal government during our nation's founding and expressly protected by the 11th Amendment of the Constitution.

The wrinkle affecting the applicability of sovereign immunity to PTAB trials is that they are administrative actions, not purely private suits. However, quasi-judicial administrative proceedings are, of course, not unique to patent law, and the courts have addressed sovereign immunity issues in similar administrative agency contexts prior to the AIA. One particular case, *Federal Maritime Commission v. South Carolina State Ports Authority*, 535 U.S. 743 (2002) ("*FMC*") is important to this year's cases addressing the availability of sovereign immunity at the PTAB.

In *FMC*, a cruise company filed a complaint with the Federal Maritime Commission, alleging that the South Carolina State Ports Authority improperly denied its request to berth a gambling boat in a popular port. The Supreme Court held that sovereign immunity barred the agency from adjudicating complaints filed by a private party against a nonconsenting state. The Court distinguished adjudicative proceedings initiated by a private party (where immunity exists) from agency-initiated enforcement proceedings (where no immunity exists). The Court lamented that "[t]he Framers, who envisioned a limited Federal Government, could not have anticipated the vast growth of the administrative state," and reasoned that whether sovereign immunity applies depends on "whether the [agency adjudications] are the type of proceedings from which the Framers would have thought the States possessed immunity when they agreed to enter the Union." The Court reasoned that the state was immune from the *FMC* action because the *FMC*'s agency proceedings were overwhelmingly similar to civil litigation.

Against that backdrop, two important sovereign immunity issues arose at the Federal Circuit this year.

St. Regis v. Mylan — No Tribal Immunity at the PTAB

In 2017, facing PTAB challenges to its Restasis[®] patents, Allergan struck a deal with the St. Regis Mohawk Tribe to try to immunize its patents from PTAB review. Under the terms of the deal, Allergan assigned its rights in the patents to St. Regis. It then paid St. Regis a lump sum of \$13.5M and an annual royalty of \$15M/year. In exchange, Allergan became the exclusive licensee of the patents. Allergan's reasoning was simple—the PTAB had recently held, in a separate case that was not appealed to the Federal Circuit, that state sovereign immunity applied to PTAB trials,³ and Allergan believed that the same result should apply to tribes. Allergan therefore moved to terminate the

IPRs. When the PTAB denied Allergan's motion, Allergan appealed.

The Federal Circuit held that tribal immunity cannot be asserted in PTAB trials.⁴ Noting that *FMC* was a state immunity case, the court reasoned that "although the precise contours of tribal sovereign immunity differ from those of state sovereign immunity, the *FMC* analysis is instructive." Applying *FMC*, the court reasoned that "IPR is more like an agency enforcement action than a civil suit brought by a private party" for at least three reasons. First, the Patent Office Director acts as a "gatekeeper" with broad discretion on whether to institute review. Second, the PTAB can continue proceedings, and the Director can participate in appeal, even if the petitioner withdraws. And third, Patent Office procedures differ from the Federal Rules of Civil Procedure applied in litigation.

The court declined to reach two other issues. First, it recognized but did not address Appellees' alternative argument—that the tribe waived sovereign immunity by filing suit. Second, it "[le]ft for another day the question of whether there is any reason to treat state sovereign immunity differently."

We may hear more from this dispute in 2019, as St. Regis has filed its petition for a writ of certiorari to the Supreme Court. The question presented is "[w]hether *inter partes* review before the [PTAB] is the type of proceeding in which tribal sovereign immunity may be asserted."

UMN v. Ericsson — Should State Immunity Apply?

The pending appeal of *UMN v. Ericsson* trails a few months behind *St. Regis* and will likely provide the Federal Circuit with the opportunity to squarely address state immunity.⁵ Before the PTAB, UMN sought to invoke sovereign immunity to dismiss IPR petitions filed by Ericsson. An expanded PTAB panel denied the dismissal *before* the Federal Circuit issued its opinion in *St. Regis*. The PTAB held that state sovereign immunity is available in PTAB trials based on the differences between IPRs and civil litigation. In this case, however, the PTAB found that UMN had waived immunity by filing suit in district court.

UMN appealed, and during the parties' briefing the Federal Circuit issued its opinion in *St. Regis* finding no tribal immunity. The parties in *UMN* disputed the relevance of *St. Regis*. Ericsson argued that *St. Regis* is dispositive because the court applied *FMC*—a state sovereign immunity case—which applies with even greater force here. UMN countered that *St. Regis* does not apply because it dealt with common-law tribal immunity (which Congress can abrogate), not constitutionally provided state immunity (which Congress cannot). The parties also disputed whether UMN waived any available immunity at the PTAB by filing suit in federal court.

It remains to be seen how the court will decide this pending case. If the court determines that state law immunity applies, how will it square that holding with *St. Regis*, which was based on the nature of the *proceedings*—not the nature of the *sovereign*—and which relied so heavily on *FMC*, a state sovereign immunity case? Will it affirm the PTAB on waiver grounds and attempt to sidestep the larger issue of immunity altogether? We'll know the outcome soon, as briefing is now complete and the appeal is scheduled for oral argument in March.

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² *Okla. Tax Comm'n v. Citizen Band of Potawatomi Tribe of Okla.*, 498 U.S. 505 (1991).

³ *Covidien LP v. Univ. of Fla. Research Found. Inc.*, IPR2016-01274, Paper 19 (PTAB Jan. 25, 2017).

⁴ *Saint Regis Mohawk Tribe v. Mylan Pharms. Inc.*, 896 F.3d 1322 (Fed. Cir. 2018).

⁵ *Regents of the Univ. of Minn. v. Ericsson, Inc.*, Appeal No. 18-1559 (lead).

2018 Cases-in-Brief and Supreme Court Cases to Watch

By: Jihong Lou¹

In addition to the cases and issues discussed in the previous articles, the Federal Circuit and the Supreme Court rendered a number of opinions in 2018 with notable holdings, some of which are summarized below.

Before the Federal Circuit

In *In re Janssen Biotech, Inc.*, 880 F.3d 1315 (Fed. Cir. 2018), the court held that a patentee cannot use *ex parte* reexamination to change a continuation-in-part to a divisional to invoke the benefits of the safe harbor of 35 U.S.C. § 121.

In *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345 (Fed. Cir. 2018), the court affirmed the PTAB's entry of adverse judgment under 37 C.F.R. § 42.73(b) after the patentee disclaimed all challenged claims before the issuance of an institution decision in an IPR.

In *Paice LLC v. Ford Motor Co.*, 881 F.3d 894 (Fed. Cir. 2018), the court held that a patent's incorporation by reference with particularity of a prior publication may provide sufficient written description to support an earlier priority date.

In *Polaris Industries, Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056 (Fed. Cir. 2018), the court elaborated on issues relating to evidence of commercial success in the context of IPRs, including the presumption of nexus and what is required to rebut such a presumption.

In *DDS Technology Management, Inc. v. Apple Inc.*, 885 F.3d 1367 (Fed. Cir. 2018), the court reversed the PTAB's obviousness determination because it relied only on "ordinary creativity" of skilled artisans when analyzing a limitation missing from the prior art references.

In *Praxair Distribution, Inc. v. Mallinckrodt Hospital Products IP Ltd.*, 890 F.3d 1024 (Fed. Cir. 2018), the court affirmed the PTAB's application of the "printed matter" doctrine in concluding that certain claim limitations are not entitled to patentable weight.

In *Sirona Dental Systems GmbH v. Institut Straumann AG*, 892 F.3d 1349 (Fed. Cir. 2018), the court vacated and remanded as to proposed substitute claims in an IPR because the PTAB placed the burden on the patentee to prove the patentability of those claims.

In *In re Maatita*, 900 F.3d 1369 (Fed. Cir. 2018), the court held that a design patent is indefinite if an ordinary observer would not understand the scope of the claimed design with reasonable certainty in view of the visual disclosures, and that a single, two-dimensional drawing of the claimed design may be sufficient to satisfy the definiteness requirement.

In *Regents of University of California v. Broad Institute, Inc.*, 903 F.3d 1286 (Fed. Cir. 2018), the court affirmed the PTAB's determination of no interference-in-fact between the application of the University of California and patents of the Broad Institute, both relating to the CRISPR/Cas9 gene-editing technology.

In *E.I. DuPont de Nemours & Co. v. Synvina C.V.*, 904 F.3d 996 (Fed. Cir. 2018), the court applied its precedent on determining obviousness of overlapping ranges—where the claimed ranges overlap with prior-art ranges, such overlap creates a presumption of obviousness, and the patentee bears the burden of production to come forward with evidence of teaching away, unexpected results, criticality, or other objective indicia of nonobviousness.

In *Yeda Research & Development Co. v. Mylan Pharmaceuticals Inc.*, 906 F.3d 1031 (Fed. Cir. 2018), the court held that an expert may rely on a non-prior-art reference published after the priority date, in addition to prior art references he relied on, to support his opinions.

In *Arista Networks, Inc. v. Cisco Systems, Inc.*, 908 F.3d 792 (Fed. Cir. 2018), the court, applying its en banc decision in *Wi-Fi One*, held that it has jurisdiction to review the question of whether assignor estoppel would apply in IPRs, and, on the merits, held that 35 U.S.C. § 311(a) expresses Congress's clear intent that assignor estoppel should not apply in IPRs.

Before the Supreme Court

In *Return Mail, Inc. v. U.S. Postal Service*, No. 17-1594 (U.S.), the Supreme Court granted Return Mail's petition for certiorari, with oral argument scheduled on February 20, 2019. The question presented is whether the government is a "person" who may petition to institute review proceedings under the AIA. See 35 U.S.C. §§ 311(a), 321(a); AIA § 18(a)(1)(B).

In *RPX Corp. v. ChanBond LLC*, No. 17-1686 (U.S.), the Supreme Court invited the Solicitor General to file a brief expressing the views of the United States. The question presented is: can the Federal Circuit refuse to hear an appeal by a petitioner from an adverse final decision in an IPR on the basis of lack of a patent-infringed injury in fact when Congress has (i) statutorily created the right to have the Director of the Patent Office cancel patent claims when the petitioner has met its burden to show unpatentability of those claims, (ii) statutorily created the right for parties dissatisfied with a final decision of the Patent Office to appeal to the Federal Circuit, and (iii) statutorily created an estoppel prohibiting the petitioner from again challenging the patent claims?

In *Ariosa Diagnostics, Inc. v. Illumina, Inc.*, No. 18-109 (U.S.), the Supreme Court invited the Solicitor General to file a brief expressing the views of the United States. The question presented is: do unclaimed disclosures in a published patent application and an earlier application it relies on for priority enter the public domain and thus become prior art as of the earlier application's filing date, or, as the Federal Circuit held, does the prior art date of the disclosures depend on whether the published application also claims subject matter from the earlier application?

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About the PTAB Bar Association:

The PTAB Bar Association seeks to preserve and promote the highest professional and ethical standards among lawyers and stakeholders who appear before the PTAB. The Association is dedicated to helping secure the just, speedy, and inexpensive resolution of every PTAB proceeding, and to maintaining or improving the reputation and stature of the legal profession and community associated with the PTAB. The Association fulfills its vision through education, outreach, collaboration, and advocacy. It serves as an avenue for constructive dialogue between the bar community, the PTAB, and other stakeholders.

Membership in the PTAB Bar Association is open to all those interested in PTAB trial practice and offers different types of memberships. For more information, please visit www.ptabbar.org/membership-information/