
Current Issues and Best Practices for Appeals from the PTAB to the Federal Circuit

Presented by the Industry and Appeals from the PTAB
Committees, PTAB Bar Association

Sept. 9, 2021

Moderators



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Panelists



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DISCLAIMER

The discussion today is meant for informational purposes only and is not meant as a substitute for legal advice on any specific scenario.

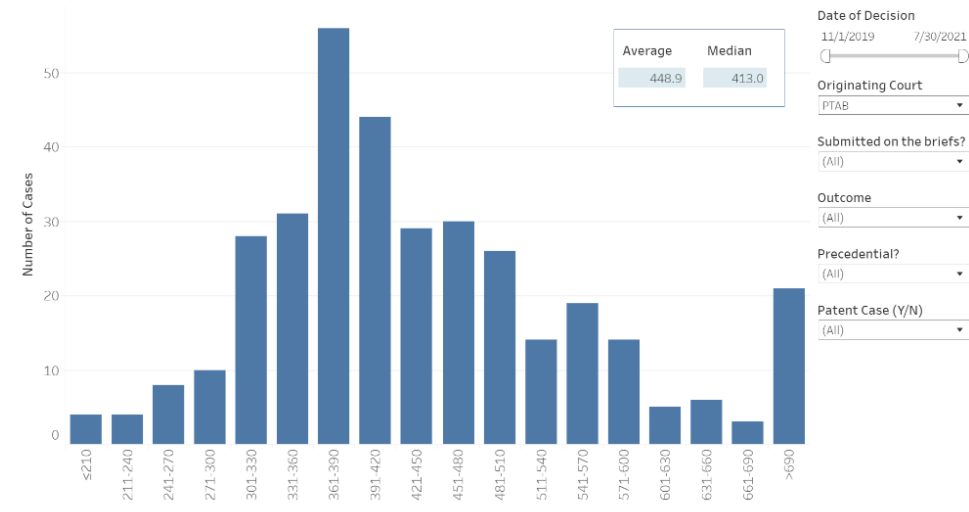
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Federal Circuit Appeals: What to Expect

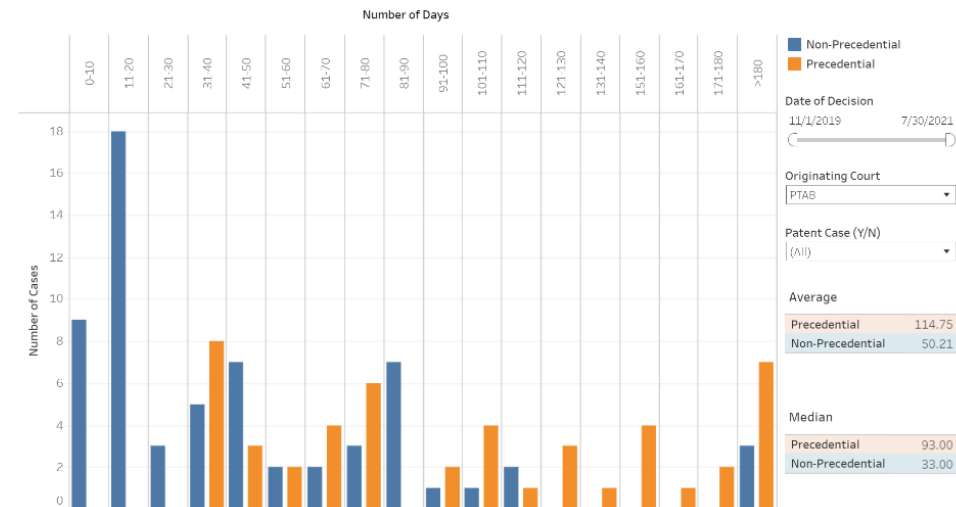
- Timing
 - 15 month average total time from notice to decision
 - 4 month average from briefing end to argument
 - Precedential decision takes ~4 months after argument; non-precedential written decision takes ~7 weeks
 - Many factors can affect timing in a specific case

*Stats from federalcircuitry.mofo.com

Days from Notice of Appeal to Decision



Days from Argument to Decision (excludes Rule 36)

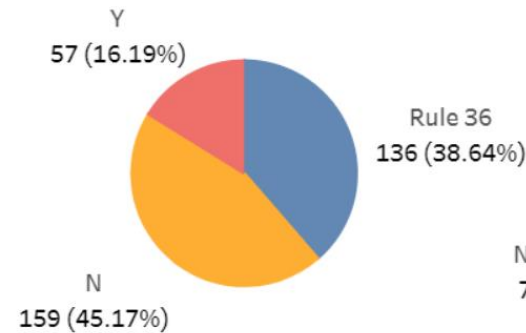


Federal Circuit Appeals: What to Expect

- Appeal outcomes

- ~80% affirmance rate
 - 85% for patent owner appeals; 68% for petitioners
- 39% of appeals from PTAB affirmed without opinion
- Only 16% of PTAB appeals lead to precedential decision

Precedential (Y/N) or Rule 36



Date of Decision

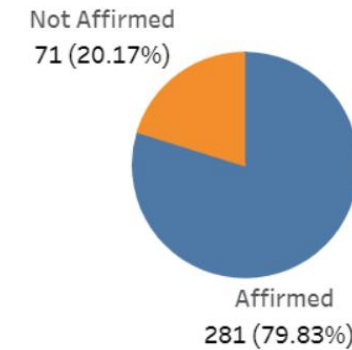
11/1/2019 7/30/2021



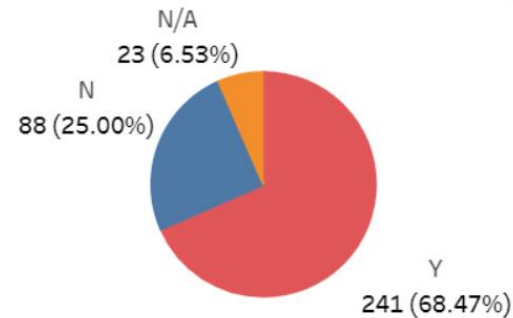
Originating Court

PTAB

Outcome

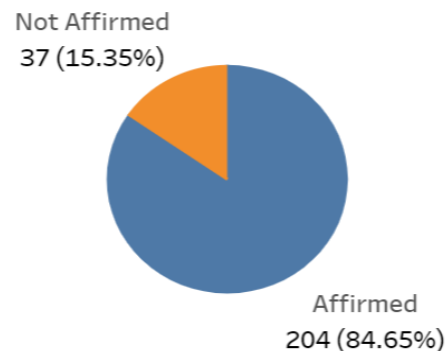


Appeal filed by Patent Owner? (Y/N)



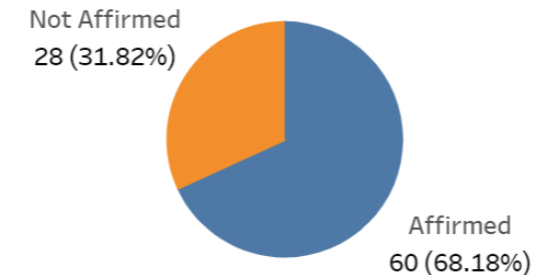
Appeal filed by patent owner? (Y/N)

Y



Appeal filed by patent owner? (Y/N)

N



*Stats from federalcircuitry.mofo.com

Case List

Forum Selection Clause Cases

- **Supreme Court - generally**
- *Atlantic Mar. Const. Co. v. U.S. Dist. Ct.*, 571 U.S. 49 (2013) (Forum-selection clauses are presumptively enforceable and may be disregarded only in “extraordinary circumstances.”)
- **Federal Circuit – arising out of district court**
- *Dodocase VR, Inc. v. Merchsource, LLC*, 767 F. App’x 930 (Fed. Cir. 2019)
- *Kannuu v. Samsung*, No. 21-1638 (argued July 2020 court week)
- **Federal Circuit – arising out of PTAB**
- *New Vision Gaming & Development, Inc. v. SG Gaming, Inc.* (Fed. Cir. May 13, 2021)
- *In re: MaxPower Semiconductor, Inc.*, No. 21-146 (Fed. Cir. Sept. 8, 2021)
- **Ninth Circuit – arising out of district court**
- *Nomadix Inc. v. Guest-Tek Interactive Ent., Ltd.*, (9th Cir. Sept. 3, 2021)
- **PTAB – exemplary cases**
- *USA, LLC v. Maxpower Semiconductor, Inc.*, IPR2020-01674 to -0167 (PTAB)
- *Dot Hill Sys. Corp. v. Crossroads Sys., Inc.*, IPR2015-00822, Paper 18 at 7–8 (PTAB Sept. 17, 2015)

Case List (cont'd)

Standing Cases

- **Cases finding standing**
- *Amerigen Pharm. Ltd. v. UCB Pharma GmbH*, 913 F.3d 1076 (Fed. Cir. 2019)
- *Samsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363 (Fed. Cir. 2019)
- *Adidas AG v. Nike, Inc.*, 963 F.3d 1355 (Fed. Cir. 2020)
- **Cases terminating appeal for lack of standing**
- *Phigenix Inc. v. ImmunoGen, Inc.* 845 F.3d 1168 (Fed. Cir. 2017)
- *Gen. Elec. Co. v. United Techs. Corp.*, 928 F.3d 1349 (Fed. Cir. 2019)
- *AVX Corp. v. Presidio Components, Inc.*, 923 F.3d 1357 (Fed. Cir. 2019)
- *Momenta Pharm., Inc. v. Bristol-Myers Squibb Co.*, 915 F.3d 764 (Fed. Cir. 2019)

Case List (cont'd)

Estoppel Cases

- *Uniloc 2017 LLC v. Facebook Inc.*, 989 F.3d 1018 (Fed. Cir. 2021)
- *Network-1 Techs. v. Hewlett-Packard Co.*, 981 F.3d 1015 (Fed. Cir. 2020)
- *Wasica Fin. GmbH v. Schrader Int'l, Inc.*, 432 F. Supp. 3d 448 (D. Del. 2020)
- *General Access Sols., Ltd. v. Virgin Mobile USA, L.P.*, Case No. 2-20-cv-00007 (E.D.Tex. Jul. 21, 2021)

Questions?