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## FEDERAL CIRCUIT SUMMARIES

Contributors: Knobbe Martens

### **PTAB May Invalidate Claims on Reconsideration Based on Grounds Raised in the Institution Decision that Were Not Originally Instituted**

In [AC Technologies S.A., V. Amazon.Com, Inc., Blizzard Entertainment, Inc.](#), Appeal No. 2018-1433, the Federal Circuit held that the PTAB correctly invalidated claims on reconsideration, based on a ground raised in the instituted petition that was not addressed in the final written decision.

Amazon and Blizzard petitioned for IPR of a patent owned by AC. The petition presented three grounds. In ground 1, petitioners argued all claims were obvious if the claims were construed narrowly. If the claims were construed broadly, petitioners argued some claims were anticipated (ground 2) and other claims were obvious (ground 3). The PTAB adopted the broad construction, but instituted review only on grounds 1 and 2. In the final written decision, the PTAB rejected ground 1 and adopted ground 2 based on the broad construction. Petitioners requested rehearing by arguing that the PTAB should have considered ground 3. The PTAB permitted additional discovery, granted the request for rehearing, and adopted ground

3. Thus, the PTAB held all claims were invalid as anticipated or obvious under grounds 2 and 3. AC appealed.

The Federal Circuit affirmed. In *SAS v. Iancu*, the Supreme Court held that if the PTAB institutes an IPR, it must issue a final written decision addressing all challenged claims. The final written decision must also address all grounds of unpatentability raised by the petitioner. Thus, not only did the PTAB properly grant reconsideration to consider ground 3, failing to do so would have been error. The Federal Circuit also rejected AC's due process challenge because the parties received adequate notice and had an opportunity to conduct additional discovery on ground 3.

### **PTAB Does Not Have an Obligation to Find Motivation to Combine When a Claim Is Determined to Be Invalid Under §103 Based on a Single Reference**

In [Realtime Data, LLC. v. Iancu](#), Appeal No. 2018-1154, the Federal Circuit held that the PTAB did not err in concluding a claim was invalid under §103 based on a single reference.

### **MORE INSIDE:**

**PTAB Happenings—p. 8**

**Internet Sightings—p. 10**

**From our February Special Event—p. 11**

**OCIPLA Committees—p. 12**

# FEDERAL CIRCUIT CASE SUMMARIES

Hewlett Packard (“HP”) sought inter partes review of a patent owned by Realtime Data, LLC. The patent at issue described a system and method for lossless data compression using dictionary encoding. HP alleged that the claims were obvious over a U.S. patent (“O’Brien”) in view of Nelson, a data compression textbook. HP argued that O’Brien disclosed all claim elements. Although O’Brien did not use the claim term “dictionary,” HP relied on Nelson to explain that a person of ordinary skill in the art would have recognized that the algorithm disclosed in O’Brien was a dictionary algorithm. The Board held that the claims would have been unpatentable under § 103 over O’Brien alone or, alternatively, in view of Nelson. Realtime appealed on two grounds: (1) that the Board erred in its determination that a person of ordinary skill would have been motivated to combine the teachings of O’Brien and Nelson, and (2) that the Board erred by failing to construe the “maintaining the dictionary” limitation and in finding that O’Brien disclosed the limitation.

The Federal Circuit affirmed the Board’s findings. First, the Board had no obligation to find a motivation to combine the two references because the Board did not rely on Nelson for the disclosure of a particular element or teaching, instead finding that O’Brien alone disclosed all claim elements. HP’s primary argument relied on Nelson merely to explain that O’Brien’s algorithm was a dictionary algorithm, which Realtime conceded was correct. The Federal Circuit also rejected Realtime’s proposed construction of “maintaining the dictionary,” which attempted to add additional unstated elements to the claim term.

## **A Stipulated Final Judgment for Reasonable Royalties Cannot Be Set Aside Merely Because the Underlying Patents Are Subsequently Found to Be Invalid**

In *WesternGeco L.L.C. v. ION Geophysical Corp.* [OPINION ON REMAND], Appeal Nos. 2013-1527, 2014-1121, 2014-1526, 2014-1528, the Federal Circuit held that even though the issue of the jury’s

award of lost profits was still pending, the defendant could not reopen the issue of a reasonable royalty award based on the subsequent invalidation of a subset of asserted patent claims because the reasonable royalty award was the subject of a stipulated final judgment resolving all issues except for lost profits.

In 2009, WesternGeco sued ION for patent infringement. After a jury trial, the asserted patent claims were found valid and infringed under § 271(f)(1) and (2). The jury awarded a reasonable royalty and lost profits. ION appealed, and the Federal Circuit reversed the lost profits award as being based on an unauthorized extraterritorial application of the patent laws. WesternGeco petitioned for certiorari, which the Supreme Court granted. The Supreme Court vacated the Federal Circuit’s decision and remanded for consideration of the decision in *Halo Elecs. v. Pulse Elecs.*, 136 S.Ct. 1923. The Federal Circuit reinstated its earlier opinion including a reversal of lost profits, but vacated the district court’s denial of enhanced damages and remanded for consideration of the Halo decision. At the district court, the parties entered a stipulated final judgment pursuant to Fed. R. Civ. P. 58, in which the parties agreed to a reasonable royalty amount. The only issue exempt from the stipulation was the lost profits award. In 2018, the petition for certiorari relating to the lost profits award was granted. In its opinion in *WesternGeco*, the Supreme Court held that a patentee may recover foreign lost profits when an infringer has violated § 271(f)(2) by exporting from the United States a component of a patented invention. While that case was pending at the Supreme Court, the Federal Circuit affirmed the PTAB’s unpatentability determination for four of WesternGeco’s six asserted patent claims. The Supreme Court then remanded to the Federal Circuit on the issues of (1) the impact of the intervening invalidation of those patent claims on the fully paid reasonable royalty award, and (2) the impact of the invalidation of those claims on the lost profits award.

Ion argued that a judgment cannot be final for pur-

# FEDERAL CIRCUIT CASE SUMMARIES

poses of intervening patent invalidations if any part of the litigation remains pending, and here the lost profits award continues to be litigated. The Federal Circuit disagreed, holding that the parties' stipulated final judgement resolving all issues but lost profits barred Ion from reopening the issue of the reasonable royalty award, which was satisfied and paid in full.

As for the lost profits award, the jury instructions and verdict form did not instruct the jury to award damages separately based on infringement of each of the asserted claims, and thus the jury did not do so. Due to the intervening invalidation, Ion requested that the Federal Circuit hold either lost profits are not recoverable, or remand for a new trial. Regarding whether a new trial on lost profits was merited, the Federal Circuit noted that the general rule is when a jury is told it can rely on any of two or more independent legal theories to support a damages award, one of which is defective, the general verdict must be set aside. However, the Federal Circuit stated that a new trial on the issue of lost profits was not automatically required. If the record establishes that there was no dispute that the technology covered by a remaining claim was required to perform the infringing activities, then a new trial on lost profits would not be required because the harmless-error standard would apply. The Federal Circuit remanded to the district court to make a determination as to whether there was evidence in the record that the technology covered by a remaining claim was required to perform the infringing activities.

## **A Generic Pharmaceutical Company May Appeal a PTAB IPR Decision Even if the Company Could Not Maintain a Parallel Hatch-Waxman Lawsuit**

In *Amerigen Pharmaceuticals v. UCB Pharma GmbH*, Appeal No. 2017-2596, the Federal Circuit held that a generic pharmaceutical company had standing to appeal the PTAB's IPR decision, even though the generic pharmaceutical company would be incapable of maintaining a parallel Hatch-Waxman suit, because it demonstrated a controversy traceable to the patent and redressable by the Court.

Mylan Pharmaceuticals sought inter partes review of claims in a patent owned by UCB Pharma GmbH ("UCB") which relates to a compound called fesoterodine. Fesoterodine is an antimuscarinic drug marketed as Toviaz® to treat urinary incontinence. Mylan alleged that the claims were obvious based on prior art. After institution, Amerigen joined as a party to the proceeding. The Board held that the claims were patentable, and Amerigen appealed to the Federal Circuit. UCB moved to dismiss for lack of standing.

The Federal Circuit considered the issue of standing, first noting that although the Federal Circuit has jurisdiction to review a final decision of the PTAB, an appellant must meet "the irreducible constitutional minimum of standing," even if there is no such requirement to appear before the administrative agency being reviewed. The Federal Circuit found that Amerigen had standing because the invalidation of UCB's patent would advance the final approval and launch of Amerigen's product.

UCB argued that Amerigen lacked standing to appeal because the FDA would not approve Amerigen's ANDA until the expiration of UCB's patent in 2022, which was previously upheld in a separate suit in the District of Delaware. Amerigen had initially filed a Paragraph IV certification against the patent, and Pfizer and UCB sued Amerigen for patent infringement in the District of Delaware. In that case, Amerigen stipulated to infringement, and the district court held the patent was valid. Amerigen waived its right to appeal, and the district court's holding resulted in the conversion of Amerigen's Paragraph IV certification to a Paragraph III certification. Thus, the FDA will only approve Amerigen's ANDA after the patent has expired; UCB contended that Amerigen was foreclosed from infringing the patent on this basis.

Amerigen responded by stating that it had secured tentative approval from the FDA, that the patent delays entry of its competing product, and that invalidating the claims of the patent would advance the launch of its product. If the patent was held unpatentable through reversal of the Board's decision, then UCB would have to notify the FDA that the patent may no longer be listed in the FDA's Or-

# FEDERAL CIRCUIT CASE SUMMARIES

ange Book entry for Toviaz®. The FDA would then remove the patent from the list “if there is no first applicant eligible for 180 day exclusivity based on Paragraph IV or after the 180 day exclusivity period of a first applicant based on that patent has expired or been extinguished.” Amerigen represented that its ANDA had received tentative approval, and it would be able to obtain final approval for launch in 2019 if the patent was invalidated. Thus, there was a three-year period in which Amerigen’s sales would be blocked by the patent. The Federal Circuit agreed that Amerigen had a concrete economic interest in advancing the sale of its tentatively approved drug and that Amerigen had therefore demonstrated a controversy of sufficient immediacy and reality for Article III.

UCB’s argument that Amerigen lacked standing was premised on the Hatch-Waxman Act. Under the Hatch-Waxman Act, a Paragraph IV certification is the fundamental jurisdictional basis for enabling parties to litigate Orange Book listed patents in Article III courts; without that basis there can be no injury in fact. However, this case did not arise under the Hatch-Waxman Act. Amerigen did not rely on a risk of infringement liability as a basis for injury. Instead, Amerigen contended that the mere listing of the patent in the Orange Book inflicts concrete commercial injury redressable by the Court. While the Federal Circuit found that Amerigen had standing, the Federal Circuit affirmed the Board’s finding that the claims were not obvious.

## **TTAB Must Consider All DuPont Factors of Record When Determining Likelihood of Confusion**

In *In Re: Guild Mortgage Company*, Appeal No. 2017-2620, the Federal Circuit held that the TTAB must consider an applicant’s evidence and argument as to an absence of actual confusion during the period of concurrent use of allegedly confusing marks.

Guild Mortgage Co. (“Guild”) applied to the PTO to register the mark “GUILD MORTGAGE COMPANY.” The Examiner refused the registration, citing a likelihood of confusion with the registered mark “GUILD INVEST-

MENT MANAGEMENT.” Guild responded by arguing that “it and Registrant have coexisted in business [in Southern California] for over 40 years without any evidence of actual confusion” (DuPont factor 8). Guild submitted a declaration by its President and CEO in support of this argument. The examiner rejected this argument in a final office action. The TTAB affirmed the examiner’s refusal to register Guild’s mark. In its opinion, the Board did not mention DuPont factor 8 and failed to address Guild’s argument and evidence directed to this factor.

The Federal Circuit vacated and remanded the decision. The Federal Circuit clarified that its previous holding in *Majestic Distilling* with respect to “the seventh DuPont factor,” that uncorroborated statements of no known instances of actual confusion are of little evidentiary value, does not extend to the eighth DuPont factor. The Federal Circuit noted that Guild “presented evidence of concurrent use of the two marks for a particularly long period of time ... in which the two businesses operated in the same geographic market ... without any evidence of actual confusion.” The Federal Circuit held that the Board, in determining the likelihood of confusion, must consider Guild’s “absence of actual confusion” evidence and argument and balance the evidence against other DuPont factors.

## **District Court Judgment Was a Non-Final, Non-Appealable Voluntary Dismissal Because It Did Not Determine that Plaintiff Was Unable to Establish an Element of Its Claim**

In *Princeton Digital Image Corp. v. Office Depot Inc. et al.*, Appeal Nos. 2017-2597, -2598, -2600, -2602, -2605, -2606, -2609, -2611, -2612, -2627, -2628, -2629, -2630, -2631, -2632, -2633, -2634, 2018-1006, the Federal Circuit held that it lacks jurisdiction to hear an appeal from a district court judgment that is non-final because it does not foreclose a litigant’s ability to establish an element of its claim.

Adobe, Inc. obtained a license from Princeton Digital for patented image-encoding technology. The license agreement included a promise by Princeton Digital not

# FEDERAL CIRCUIT CASE SUMMARIES

to sue Adobe or its customers for infringement of the patented technology. When Princeton Digital brought lawsuits against Adobe's customers, Adobe intervened and asserted a claim against Princeton Digital for breach of contract. Adobe sought damages consisting of (1) its attorneys' fees expended in connection with defending its customers and responding to customers' indemnity requests and (2) its fees expended in bringing the breach-of-contract claim itself. On summary judgment, the district court held that Adobe could only recover fees associated with defending its customers, as opposed to the affirmative claim for breach of contract.

The district court ordered Adobe to submit a supplemental report and a letter disclosing its defense fees. But the court struck both the report and the letter because it ruled they did not properly separate defense fees from affirmative fees. Adobe then asked the court to enter judgment for Princeton Digital, on the grounds that it did not have evidence of damages to present at trial, which it contended was an element of its claim. The district court granted Adobe's request, but specifically stated that there were defensive damages that could be proven on the existing record. Adobe appealed.

The Federal Circuit held that it lacked jurisdiction to hear the appeal, reasoning that the district court's order was not a final judgment on the merits. The Federal Circuit relied on the Supreme Court's ruling in *Microsoft v. Baker*, 137 S. Ct. 1702 (2017), for the principle that "unless the district court has conclusively determined . . . that the plaintiff has failed to satisfy a required element of the cause of action, a voluntarily [sic] dismissal lacks finality." Here, the district court had not determined that Adobe was unable to prove an element of its breach-of-contract claim. Thus, the judgment was non-final and the Federal Circuit lacked jurisdiction

## **Patent Office Cannot Reduce Patent Term Adjustment by a Period in Which There Were No Identifiable Efforts That Could Have Been Undertaken by Applicant**

In *Supernus Pharmaceuticals, Inc. et al. v. Iancu*, Appeal No. 2017-1357, the Federal Circuit held that the USPTO is only authorized to reduce Patent Term Adjustment (PTA) for applicant-attributable delay equal to a period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution.

Supernus filed patent applications for osmotic drug delivery systems in both the US and Europe. Supernus filed an RCE in the U.S. application in February 2011. In September 2012, Supernus received notice that an opposition had been filed to its European patent. Supernus submitted an IDS in November 2012, informing the USPTO of the opposition and providing relevant documents. The U.S. patent issued in June 2014, reflecting 1,260 days of PTA. The USPTO had reduced the PTA by 886 days for applicant-attributable delay, including the 546-day period between filing of the RCE and the notice of the EPO opposition. Supernus filed a request for reconsideration of the PTA to the USPTO. After the USPTO rejected the request, Supernus appealed the decision in district court. On summary judgment, the district court held that the PTA calculation by the USPTO was correct.

Supernus appealed to the Federal Circuit, challenging the regulation as arbitrary and capricious, and contrary to the statute. The statute provides that "[t]he period of adjustment of the term of a patent under paragraph (1) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application." 35 U.S.C. § 154(b)(2)(C)(i) (emphasis added).

The Federal Circuit had previously held in *Gilead Sciences, Inc. v. Lee*, 778 F.3d 1341 (Fed. Cir. 2015), that the regulation was a reasonable interpretation of the statute. The Federal Circuit distinguished *Gilead* because, unlike the applicant in *Gilead*, Supernus had no knowledge of the opposition during the 546-day period. Therefore, the

# FEDERAL CIRCUIT CASE SUMMARIES

Federal Circuit concluded that there was nothing Supernus could have done to advance prosecution. Applying the Chevron analysis, the Federal Circuit further concluded that the language of the statute was clear and established an unambiguous rule that the USPTO could determine “reasonable efforts” but not reduce PTA beyond the statutory “equal to” limitation. Having concluded that the district court erred in granting summary judgment, the Federal Circuit reversed the order and remanded for further proceedings.

## **Federal Circuit Finds That Testing Outside the Critical Date May Not Trigger the Public Use Bar If Follow-Up After the Critical Date Is Required**

In *Barry v. Medtronic, Inc.*, Appeal No. 2017-2463, the Federal Circuit held that, under pre-AIA law, an invention may not be known to work for its intended purpose and therefore “ready for patenting” until it has been tested in a variety of settings.

Dr. Barry sued Medtronic for infringing patents related to correcting spinal column anomalies such as scoliosis. From 2002 to 2003, Dr. Barry developed a surgical tool that was the subject of the asserted patents. In August and October 2003, he used the tool in three surgeries. Dr. Barry had post-surgical visits with each patient—two visits in November 2003 and one in January 2004. Dr. Barry filed for his patent on December 30, 2004, making December 30, 2003 the critical date for purposes of the public-use bar under pre-AIA law. During trial, Medtronic asserted that Dr. Barry successfully used his invention and knew his invention worked before the critical date. Dr. Barry argued that, although he used his invention in three surgeries, he did not know his invention would work until his last follow-up visit in January 2004. The jury found for Dr. Barry.

The Federal Circuit affirmed, noting that substantial evidence supported the jury’s verdict. The Federal Circuit acknowledged that Dr. Barry knew he had successfully performed two surgeries before the critical date. But Dr. Barry did not determine his invention

would work for its intended purpose until after his final follow-up visit, which was after the critical date. The Federal Circuit held that an inventor may not know his invention works for its intended purpose until it has been tested in a variety of real-world settings. Here, the three surgeries represented the three most common types of scoliosis. Because each type of scoliosis represented a different setting in which Dr. Barry’s invention would operate, Dr. Barry did not know his invention would work for its intended purpose until he was sure it could treat all three common types of scoliosis.

Chief Judge Prost dissented, writing that the decision improperly broadened the scope of “intended purpose.” According to Chief Judge Prost, a patent’s intended purpose should be defined by the patent’s claims and specification. Chief Judge Prost believed the intended purpose was to adjust a patient’s vertebrae, which Dr. Barry achieved twice before the critical date. Requiring a third successful surgery went beyond what was stated in the claims and specification.

## **A Person Is a Joint Inventor of a Prior-Art Reference if That Person’s Contributions to the Anticipating Portion of the Reference Are Significant in View of the Invention as a Whole**

In *Duncan Parking Technologies v. IPS Group, Inc.*, Appeal No. 2018-1205, -1360, the Federal Circuit found that a person is a joint inventor of the anticipating portions of a reference for the purposes of 35 U.S.C. § 102(e) if the person’s contributions to that anticipating portion are significant in view of the invention as a whole.

IPS Group (“IPS”) filed suit in district court against Duncan Parking Technologies (“DPT”), alleging infringement of the ’310 and ’054 patents. DPT filed for inter partes review, alleging that the ’310 patent claims were anticipated by portions of the ’054 patent under 35 U.S.C. § 102(e). Although the claims of the patents are similar, the ’310 patent named King and three others as inventors, while the ’054 patent named King and Schwarz as inventors. IPS argued that both the ’310 patent claims and the anticipating portions of the ’054 patent were solely King’s

# FEDERAL CIRCUIT CASE SUMMARIES

invention, and thus the '054 patent was not that “of another” under 102(e). The Board agreed with IPS, finding that the inventions were that of King alone. DPT appealed.

The Federal Circuit disagreed with the Board, finding that Schwarz was a joint inventor of the relevant portions of the '054 patent. The Federal Circuit explained that Schwarz’s contribution to the invention defined by the '310 patent, as disclosed in the '054 patent, was significant in light of the invention as a whole. Because the anticipating embodiment was the joint invention of King and Schwarz, a different inventive entity than that of the '310 patent, it was prior art under 102(e). Accordingly, the Federal Circuit reversed the Board’s decision and held the claims of the '310 patent unpatentable as anticipated by the '054 patent.

Concurrently with the Board proceedings, the district court granted summary judgment of non-infringement of the '310 and '054 patents, which IPS appealed. In this combined opinion, the Federal Circuit affirmed the district court’s grant of summary judgment of non-infringement of the '310 patent and vacated the district court’s grant of summary judgment of non-infringement of the '054 patent, remanding the case for further proceedings consistent with the claim construction it set forth in the opinion.



## **PTAB Has Authority to Modify Initial Institution Decision in Light of SAS**

by Andrew Schreiber, Matthew George Hartman & Rubén H. Muñoz, Akin Gump  
*Cisco Sys. Inc. v. Oyster Optics, LLC*, IPR2017-01720,  
Paper No. 31 (PTAB Jan. 22, 2019).

Patent Trial and Appeal Board, Inter Partes Review

In a recent final written decision, the Patent Trial and Appeal Board (PTAB) has determined that it was not unlawful for it to modify its institution decision following the SAS Supreme Court case.

In the PTAB proceeding, Petitioners Cisco Systems and Oclaro filed a petition for inter partes review (IPR) of nearly all claims of Patent Owner Oyster Optics' patent directed to a secure fiber optic telecommunications system—U.S. Patent No. 6,594,055 (the "'055 patent"). At the outset, Petitioners sought a review of Claims 1-13, 15-23 and 27 of the '055 patent. The PTAB, however, instituted IPR on only a subset of the challenged claims, namely Claims 17-23 and 27, and only on some of the grounds that Petitioners asserted against Claim 27. Following institution, the Supreme Court ruled in SAS that "the Patent Office must 'issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner.' 35 U.S.C. § 318(a). In this context, as in so many others, 'any' means 'every.' The agency cannot curate the claims at issue but must decide them all." In response to SAS, the PTAB issued a modified institution decision that included all claims and grounds that Petitioners originally asserted in their petition.

Patent Owner responded by challenging the PTAB's ability to issue a final written decision on all claims and grounds. In particular, Patent Owner argued that the PTAB's modification of its initial institution decision was done without statutorily mandated rulemaking and therefore improperly attempted to address how to govern a proceeding covering all challenged claims, including those claims for which Petitioners failed to show a reasonable likelihood of prevailing. Patent

Owner also argued that the PTAB had no authority to modify its institution decision outside the statutory time frame for issuance.

As to the first argument, Patent Owner cited Patent Office regulations to demonstrate that the PTAB had the authority to "proceed on all or some of the challenged claims," and "deny some or all grounds for unpatentability for some or all of the challenged claims' prior to institution of inter partes review." 37 C.F.R. §§ 42.108(a)-(b). Further, Patent Owner pointed to 37 C.F.R. § 42.108(c), which details how an IPR cannot be instituted, unless the PTAB "decides that the petition supporting the ground would demonstrate that there is a reasonable likelihood that at least one of the claims challenged in the petition is unpatentable." In its final written decision, the PTAB found that its current rules adequately covered post-SAS scenarios where all petitioned claims and grounds are included at institution. The PTAB noted that "[n]one of these referenced parts of 37 CFR § 42.108 requires exclusion of any claim or ground for an instituted proceeding," including claims or grounds for which Petitioner had not shown a reasonable likelihood of establishing unpatentability (emphasis added). Indeed, the PTAB highlighted an occasion, in *FMC Techs., Inc. v. OneSubsea IP UK Ltd.*, when it instituted review on all challenged claims and grounds upon a finding of reasonable likelihood of success as to one claim. IPR2016-00378 (PTAB June 30, 2016). Accordingly, the PTAB determined that the procedural rules governing the IPR were valid and that it had the ability to issue a final written decision on all claims.

In addition, the PTAB determined that it had not violated the statutory due date for determining whether to implement an IPR as set forth in 35 U.S.C. § 314(b). That statutory provision states that the determination of whether to institute an IPR must occur within three months from the date that a patent owner files a preliminary response. Patent Owner argued that it filed a preliminary response on October 31, 2017, so the due date for the PTAB's IPR institution decision was January 31, 2018. However, because the PTAB modified its determination in the aftermath of SAS, Patent Owner

## PTAB HAPPENINGS

contended that the PTAB did not make a full determination until May 3, 2018. The PTAB noted that its institution decision occurred on January 23, 2018—within the appropriate time frame—and its modified order on May 3 did not change the fact that the PTAB decided to institute review by January 23. Further, the PTAB responded to Patent Owner’s argument that SAS nullified partial institution decisions and explained that “the Court in SAS simply recognized that the Board instituted review, but incorrectly limited the scope of the review.” In sum, according to the PTAB, its modified institution decision did not violate IPR timing requirements because the initial institution decision was filed before the deadline.

**Practice tip:**

Post-SAS, patent owners may find it difficult to convince the PTAB that modified institution decisions violate the statutes or regulations governing IPR proceedings; therefore, patent owners should balance the effort expended in those types of procedural challenges (including as a means to preserve issues for appeal) vis-à-vis substantive challenges directed squarely to patentability.



# INTERNET SIGHTINGS

by Frederic M. Douglas and James  
E. Hawes

This column highlights some of the more notable recent online notices, newsletters, and blogs dealing with IP prosecution issues.

**IPWatchdog** – a patents and patent law blog –  
[IPwatchdog.com](http://ipwatchdog.com)

\* On February 22, 2019, IPWatchdog remarked that bipartisan meetings in Congress are searching for legislative solutions to the Section 101 patent eligibility problems involving biotechnology, medical diagnostics, and software-related inventions. (<http://www.ipwatchdog.com/2019/02/22/ip-news-roundup-barks-bites-friday-february-22/id=106615>).

\* On February 5, 2019, Hans Sauer discussed the recent *Helsinn v. Teva* ([https://www.supremecourt.gov/opinions/18pdf/17-1229\\_2co3.pdf](https://www.supremecourt.gov/opinions/18pdf/17-1229_2co3.pdf)), Supreme Court opinion regarding secret sales as public use bars. This article maintains that the scope of prior art is now uncertain instead of what was thought to confirm longstanding law. (<http://www.ipwatchdog.com/2019/02/05/helsinn-v-teva-creates-inscrutable-uncertainty-scope-prior-art-instead-confirming-longstanding-law/id=105953/>).

**Patent Docs** – A patent blog – [patent-docs.typepad.com/patent\\_docs](http://patent-docs.typepad.com/patent_docs)

\* In the February 6, 2019 post, Donald Zuhn mentioned that the USPTO issued its Fiscal Year 2018 “Performance and Accountability Report” (<https://www.uspto.gov/sites/default/files/documents/USPTOFY18PAR.pdf>) providing statistics and describes agency goals. (<https://www.patentdocs.org/2019/02/uspto-releases-performance-and-accountability-report-for-fy-2018.html>).

\* Donald Zuhn’s February 17, 2019 post noted that the USPTO extended the Cancer Immunotherapy Pilot

Program to June 30, 2020, but the Extended Missing Parts Pilot Program ended on January 2, 2019. (<https://www.patentdocs.org/2019/02/uspto-extends-one-pilot-program-but-declines-to-extend-another.html>).

**AIPLA** – the profession’s national organization – see [AIPLA.org](http://AIPLA.org)

\* AIPLA will hold its 2019 Annual Meeting October 24-26, 2019 in Washington, D.C. More information on this meeting and other events is available at <https://www.aipla.org/list/events>.

**Miscellaneous** –

\* The Chisum Patent Academy holds an upcoming patent law seminar in Seattle, Washington on August 8-9, 2019. Complete syllabi for all Chisum seminars are available at <http://chisum-patent-academy.com/past-seminars/>. There are a possible 18 CLE credits for these seminars. Each seminar is limited to ten attendees. More info at <https://chisum-patent-academy.com/upcoming-patent-law-seminars/>.

For more information about any of the patent topics mentioned consult Patent Application Practice. Trademark topics are discussed in Trademark Registration Practice. Both are published by West and updated twice a year. For patent prosecution or litigation questions, contact Fred Douglas at 949/293-0442 or by email at [fdouglas@cox.net](mailto:fdouglas@cox.net).



# FROM OUR FEBRUARY SPECIAL EVENT



**OCIPLA**  
ORANGE COUNTY INTELLECTUAL PROPERTY LAW ASSOCIATION

The OCIPLA, in collaboration with co-sponsors LAIPLA and USC, is proud to present this  
**SPECIAL EVENT!**

**Latest Developments at the USPTO:  
A Conversation with Director  
Andrei Iancu**

A presentation followed by a Q&A session—  
*Bring your best questions!*

Thursday, February 21, 2019, 3:30 - 5:30 pm  
2040 Main St, Irvine, CA 92614  
*Dinner will be served.*



# JOIN AN OCIPLA COMMITTEE!

## **AMICUS COMMITTEE**

This committee shall: a) scrutinize judicial decisions which involve significant issues of law or practice which affect intellectual property, (b) recommend to the Board of Directors that amicus curiae briefs be filed in appropriate cases, and (c) draft OCIPLA amicus curiae briefs.

## **PROFESSIONAL PROGRAMS COMMITTEE**

This committee shall identify and recommend curricula to the Board of Directors and assist in coordinating educational programs to be conducted during regular monthly meetings or at other times on topics which: (1) are of interest and benefit to the OCIPLA members; or (2) pertain to the professional activities of OCIPLA members and are of interest to others. The Committee will also assist the Board of Directors in obtaining speakers and otherwise preparing for the presentation of approved educational programs. The Professional Programs Committee shall include a litigation and prosecution subcommittees.

## **CORPORATE PRACTICE COMMITTEE**

This committee shall develop and disseminate information that is particularly useful to in-house attorneys, and promote efficient exchanges of best practices among in-house attorneys. *Co-chairs:*

- **MICHAEL KLINE**, [michaelkline@clevelandgolf.com](mailto:michaelkline@clevelandgolf.com)
- **MARK KERTZ**, [mark.kertz@medtronic.com](mailto:mark.kertz@medtronic.com)

## **MEMBERSHIP COMMITTEE**

This committee shall focus on expanding and diversifying the membership of OCIPLA, and shall work closely with other Committees and the Board of Directors to provide insights as to what IP practitioners in our IP community want from a legal organization and how OCIPLA can better the local IP community.

## **NEW LAWYERS COMMITTEE**

This committee shall focus on members in their first ten years of practice. The Committee shall provide educational and networking opportunities to new lawyers at OCIPLA. In addition, the Committee shall work closely with other Committees to provide new lawyers with opportunities to become more involved in the association, including participating in planning for OCIPLA meetings, coordinating networking events and other social activities for OCIPLA, assisting in research & writing projects, and developing educational materials.

***OCIPLA seeks volunteers to serve on Association Committees, whose respective missions are set forth on this page. If you have a few hours a month, we invite you to contact a member of our Board of Directors or the Committee Chairs (identified below) to discuss opportunities to help strengthen the OCIPLA community.***

# MAKE OCIPLA EVEN BETTER!

## **LAW STUDENT COMMITTEE**

This committee shall serve the law students in the local community, with particular focus on communicating their concerns to the Board of Directors and to welcome more law students to join the association as active members. The Committee shall also work closely with other Committees to provide law students with opportunities to become more involved in the association, including participating in planning for OCIPLA meetings, coordinating networking events and other social activities for OCIPLA, assisting in research & writing projects, and developing educational materials.

## **NEWSLETTER COMMITTEE**

This committee shall identify, recommend to the Board of Directors and prepare high quality, educational material for the OCIPLA Newsletter. *Co-Chairs:*

- **BROCK WILSON**, [bfwilson@akingump.com](mailto:bfwilson@akingump.com)
- **CLARK GORDON**, [cgordon@akingump.com](mailto:cgordon@akingump.com)

## **TRADEMARK PRACTICE COMMITTEE**

This committee shall consider all aspects of the practice of trademark law before the United States Patent and Trademark Office, aid in the institution of improvements in the administration of the trademark laws by the USPTO; monitor proposed changes in the USPTO Rules of Practice relating to trademark law and, with the advice and consent of the Board of Directors, inform the USPTO as to the position of the Association regarding such proposed changes; receive and coordinate views of members in connection with any existing problems or suggestions for improvements in the USPTO administration, and with the advice and consent of the Board of Directors, forward these views to the USPTO, and make recommendations to the Board of Directors regarding these duties.

## **COPYRIGHT PRACTICE COMMITTEE**

This committee shall consider all aspects of the practice of copyright law before the Copyright Office of the Library of Congress, and to make recommendations to the Board of Directors regarding same.

## **FORMER PRESIDENT'S COMMITTEE**

- **EHAB SAMUEL**, [esamuel@mannatt.com](mailto:esamuel@mannatt.com)
- **MATT LAPPELL**, [matt@lappellubell](mailto:matt@lappellubell)

## **WOMEN IN IP COMMITTEE**

This committee shall promote the role of women in IP law practice in and around Orange County. Membership and participation are open to men as well.

All committees shall consist of members appointed by the Board of Directors for a two-year term.



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# OCIPLA 2019 Board of Directors

<b>President</b>	Lauren Keller Katzenellenbogen	(949) 721-6365	lauren.katzenellenbogen@knobbe.com
<b>Vice President</b>	Nate Camuti	(949) 275-7852	ncamuti@gmail.com
<b>Secretary</b>	Mark Kertz	(949) 680-1313	mark.kertz@medtronic.com
<b>Treasurer</b>	Marin Cionca	(949) 334-3036	marin@cioncaip.com
<b>Third Year Director</b>	Sarah Bro	(949) 757-6001	sbro@mwe.com
<b>Second Year Director</b>	Nicole Townes	(949) 721-5261	nicole.townes@knobbe.com
<b>First Year Director</b>	Vishwanath Mohan	(949) 829-2186	vkmoan@onellp.com
<b>Immediate Past President</b>	Matt Lapple	(949) 756-4889	matt@lappleubell.com

## OCIPLA Newsletter

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We hope that the Newsletter is informative, entertaining, and interesting. Comments, ideas, announcements, proposed articles, suggestions and any other communications concerning the content, form or other aspect of this Newsletter may be directed to:

Sarah Bro  
2019 OCIPLA Newsletter Editor

