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FEDERAL CIRCUIT SUMMARIES

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Collateral Estoppel Is Applicable in IPRs When the Question of Patentability Is the Same

In *Google LLC v. Hammond Development International, Inc.*, Appeal No. 21-2218, the Federal Circuit held that Google filed an IPR on Hammond's '816 patent, which related to and shared a specification with Hammond's '483 patent. The PTAB determined that Google failed to meet its burden to show that Claim 18 of the '816 patent was unpatentable.

Google had successfully challenged Hammond's '483 patent in another IPR, including Claim 18 of that patent. The PTAB's decision in the '483 patent IPR became final during the pendency of the '816 patent IPR. Claim 18 of the '816 patent was identical to Claim 18 of the '483 patent, except for "language describing the number of application servers."

Google appealed the PTAB's decision regarding the '816 patent IPR, arguing that the PTAB's determination that Claim 18 of the '483 patent was unpatentable rendered Claim 18 of the '816 patent unpatentable based on collateral estoppel.

The Federal Circuit agreed. The court reasoned that collateral estoppel had long applied to IPR proceedings and

that patent claims need not be identical for collateral estoppel to apply. The court reasoned that collateral estoppel may apply even if the claim language in the two patents is different, so long as "the difference[s] between the unadjudicated patent claims and adjudicated patent claims do not materially alter the question of invalidity." The court agreed with Google that Claim 18 of the '816 patent and Claim 18 of '483 patent presented identical issues of patentability, finding that the differences between the claims would have been obvious and therefore did not materially alter the patentability analysis. Accordingly, the court reversed the PTAB's determination as to Claim 18 of the '816 patent.

Claim Directed to Specific, Hardware-Based Data Structure That Enables Technological Improvement Is Patent-Eligible Under § 101

In *Adasa Inc. v. Avery Dennison Corporation*, Appeal No. 22-1092, the Federal Circuit held that a claim directed to a specific, hardware-based data structure that enables technological improvements is more than an abstract idea and is patent-eligible under 35 U.S.C § 101.

ADASA sued Avery Dennison for patent infringement in the District of Ore-

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gon. The district court granted summary judgment in favor of ADASA that the asserted claim was not ineligible under 35 U.S.C § 101 and was neither anticipated nor obvious. Following trial, the district court entered a financial sanction against Avery Dennison for discovery violations, including failing to disclose a number of infringing products until after the jury verdict. Avery Dennison appealed.

The Federal Circuit affirmed the district court's holding that the asserted claim was directed to eligible subject matter under § 101. Avery Dennison argued that the claim, which recited a system for assigning a serial number to a RFID chip, was directed to the abstract idea of "assigning meaning to a subsection of a data field[.]" The Federal Circuit disagreed and found instead that, setting aside conventional hardware components, the claim is directed to a specific, hardware-based data structure designed to enable technological improvements, and not a mere mental process. The Federal Circuit relied in particular on the way the claimed system provided unique serial numbers.

The Federal Circuit reversed the district court's grant of summary judgment of no anticipation or obviousness. In particular, the Court held that triable issues of fact existed despite linguistic differences between prior references and the claim. The Federal Circuit also upheld the award of financial sanctions against Avery Dennison, but remanded for reconsideration of the amount because the District Court awarded sanctions based on the total number of infringing products, rather than the number of infringing products that were untimely disclosed.

Factual Disputes Preclude Grant of Summary Judgment of Improper Inventorship

In *Plastipak Packaging, Inc. v. Premium Waters, Inc.*, Appeal No. 21-2244, the Federal Circuit held that

an overwhelming amount of evidence in favor of summary judgment is not sufficient if the nonmoving party presents evidence on which a reasonable factfinder could rely.

Plastipak sued Premium Waters for infringement of various Plastipak patents. Premium Waters moved for summary judgment of invalidity, asserting that the patents were invalid for failure to name Falzoni as a joint inventor. The district court evaluated two groups of patents, each of which contained at least one of two limitations Premium Waters argued Falzoni contributed to. The district court cited an overwhelming amount of evidence pointing to Falzoni's contributions, including a 3D model Falzoni sent to the named inventors

before they filed the patents. The 3D model arguably disclosed both limitations. The district court concluded that any reasonable factfinder would find that Falzoni was an inventor and granted Premium Waters' motion.

On appeal, the Federal Circuit reversed and remanded. Reviewing de novo, the Federal Circuit concluded that a reasonable factfinder, taking the evidence in the light most favorable to Plastipak as the nonmoving party, could find Falzoni was not an inventor. For one limitation, there was some evidence on record that the named inventors could have conceived of their inventions independent of Falzoni's 3D model. And with respect to the other limitation, the Federal Circuit found a genuine dispute of material fact as to whether Falzoni contributed anything other than what was already known in the prior art. Thus, a reasonable factfinder could find that Falzoni did not meaningfully contribute to the patents and was not an inventor.

Evidence of Actual Physician Practice Is Relevant in Determination of Direct Infringement

In *Genentech, Inc. v. Sandoz Inc.*, Appeal No. 22-1595, the Federal Circuit held that the district court did not clearly err in considering evidence of actual physician practice when determining whether a generic drug's instructions encouraged, recommended, or promoted infringement.

Genentech brought a Hatch-Waxman suit against Sandoz for infringement of its patents directed to dose modification methods for managing side effects when using pirfenidone to treat idiopathic pulmonary fibrosis (IPF). The district court concluded that Genentech's liver function test (LFT) patents were unpatentable as obvious and the sale of Sandoz's generic product would not directly infringe Genentech's drug-drug interaction (DDI) patents. Genentech appealed.

The Federal Circuit held that the district court properly found that the dose modifications claimed in the LFT patents would have been obvious over the prior art in view of well-known, standard medical practices. The district court's analysis of the prior art properly relied on extensive record evidence including expert testimony and FDA guidance. The Federal Circuit also found Genentech's evidence of objective indicia of nonobviousness unpersuasive since Genentech did not provide evidence showing skepticism or an unmet need for the claimed methods.

Regarding the DDI patents, the Federal Circuit

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held that the district court did not clearly err in weighing all relevant evidence, including Sandoz's proposed label and physician practice. Genentech argued that there was no evidence to negate the language of the proposed label, which encourages, recommends, and promotes infringement. The Federal Circuit explained that evidence of actual physician practice suggested that Sandoz's instructions would not result in direct infringement of the DDI patents. Thus, the Federal Circuit concluded that the district court "did not clearly err by considering physician evidence, weighing it against the language in Sandoz's proposed label, and finding that Genentech failed to prove direct infringement." Accordingly, the Federal Circuit affirmed the district court's findings of obviousness and noninfringement.

Restrictive Definitions Incorporated by Reference Do Not Necessarily Control for Later Patents in the Same Family

In *Finjan LLC v. Eset, LLC*, Appeal No. 21-2093, the Federal Circuit held that specific definitions provided in an earlier application in a patent family incorporated by reference into a later patent do not restrict the later patent if that patent does not include the definition.

Patent owner Finjan, LLC, sued Eset, LLC for infringement. The district court held a *Markman* hearing to determine the definition of the term "downloadable" in the asserted patents. In the hearing, the district court relied on a definition of the term from a non-asserted patent in the same family incorporated by reference into the asserted patents. Based on this definition, the court construed the term to mean "a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer." With the narrow definition in place, Eset moved for summary judgment of invalidity based on indefiniteness. The court granted the motion, finding the asserted patents indefinite based on the word "small." Finjan appealed.

On appeal, the Federal Circuit reversed the district court's claim construction. The Federal Circuit explained that, though incorporation by reference does include the incorporated patent into the body of the host patent, the disclosure of the host patent controls how the incorporated patents are viewed. Here, the incorporated patents contained more and less restrictive definitions of the term "downloadable," but the asserted patents used the term in its broader sense by listing examples of downloadables that are not small. Thus, the Federal Circuit reversed the district court's ruling adopting the more restrictive construction, vacated the district court's grant of summary judgment, and

remanded the case for further proceedings.

Failure to Vacate Adverse Standing Decision Upon Settlement Stops Subsequent Suits

In *Uniloc USA, Inc. v. Motorola Mobility LLC*, Appeal No. 21-1555, the Federal Circuit held that failure to vacate an adverse ruling regarding a lack of standing when settling a prior suit collaterally estopped the patentee in subsequent suits for lack of standing.

Uniloc sued Motorola in the U.S. District of Delaware for patent infringement. The district court dismissed, holding that Uniloc lacked Article III standing because it had granted Fortress Credit Co. a license and right to sublicense the asserted patent, pursuant to a default under a revenue sharing agreement. In a related case, Uniloc sued Blackboard Inc. for patent infringement of two other patents, both of which were subject to the same agreement between Uniloc and Fortress. There, the district court dismissed for lack of standing, applying the *Motorola* decision as a matter of collateral estoppel.

On appeal, Motorola and Blackboard defended the district court's decision by asserting that a decision in another Uniloc case against Apple established that Uniloc lacked standing as a matter of collateral estoppel. In the *Apple* case, Uniloc asserted a patent that was subject to the same agreement with Fortress and the district court dismissed the *Apple* case for lack of standing, finding that: (1) Uniloc had granted Fortress a license and the right to sublicense; and (2) that Uniloc lacked exclusionary rights in the asserted patent, thereby depriving Uniloc of standing. Uniloc appealed the *Apple* decision, but the parties reached a settlement agreement before the appeal was decided and the district court's judgment was not vacated.

Against this backdrop, the Federal Circuit affirmed the dismissal of the Motorola and Blackboard cases for lack of standing. The Federal Circuit rejected Uniloc's argument that Motorola waived the defense of collateral estoppel at the district court, indicating that waiting for the Apple appeal to conclude before raising the issue did not constitute waiver. The Federal Circuit also rejected the argument that because the *Apple* case incorrectly found a lack of standing, such an incorrect decision should prevent the application of collateral estoppel. Thus, the Federal Circuit concluded that the *Apple* decision was a valid and final prior judgment precluding relitigation of the standing issue even though granting a license generally does not deprive a patentee of Article III standing.

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Standing Cured by Revoking an “Irrevocable” License Prior to Commencing Suit

In *Uniloc 2017 LLC v. Google LLC*, Appeal No. 21-1498, the Federal Circuit held that an “irrevocable” patent license could be terminated by mutual agreement and such a license was not a right that by its nature would fall within a survival provision of a termination agreement.

Uniloc sued Google for patent infringement and Google moved to dismiss for lack of standing under the theory that Uniloc lacked standing because it had granted Fortress Credit Co. a license and right to sublicense the asserted patents pursuant to a default provision in a revenue sharing agreement. Uniloc argued that even if it had granted such a license to Fortress, any license was eliminated by a termination agreement executed between Uniloc and Fortress prior to the suit against Google. The district court granted the motion to dismiss, finding that an “irrevocable” license had been granted, that it survived the termination agreement, and that it deprived Uniloc of standing.

The Federal Circuit indicated that (1) the sole issue was whether the termination agreement eliminated any license Fortress had and (2) if this license was eliminated, then the parties had agreed that Uniloc had standing in this case. Turning to the language of the termination agreement, the Federal Circuit noted that the agreement appeared to terminate Fortress’s license by stating that the license and any rights “shall terminate.” The Federal Circuit then explained that the district court misunderstood the meaning of “irrevocable” in the license agreement. The term meant that the license was “irrevocable” by the unilateral actions of the licensor, but that this did not suggest that the license was “irrevocable” by mutual agreement as occurred in the termination agreement. The Federal Circuit also rejected Google’s reliance on a survival provision in the termination agreement, distinguishing the Fortress license from other rights that by their nature make them survive termination. Thus, the Federal Circuit reversed and remanded to the district court.

The Statutory Presumption of Validity of a Federally Registered Trade Dress Applies Even Where the Trademark Examiner May Not Have Followed PTO Procedures

In *Soclean, Inc. v. Sunset Healthcare Solutions, Inc.*, Appeal No. 21-2311, the Federal Circuit held that, a trademark is entitled to a statutory presumption of validity even if the trademark examiner did not follow Patent and

Trademark Office procedures during prosecution.

SoClean, Inc. sued Sunset Healthcare Solutions, Inc. (“Sunset”) for trade dress infringement, among other claims. The trade dress registration at issue was the configuration of replacement filters for Continuous Positive Airway Pressure (“CPAP”) sanitizing devices. The district court granted, in part, SoClean’s motion to preliminarily enjoin Sunset, enjoining Sunset from marketing its filters using an image alone. The district court ordered Sunset’s marketing to prominently display the Sunset brand. Sunset appealed, challenging the district court’s treatment of the likelihood-of-success factor in the preliminary injunction analysis.

On appeal, the Federal Circuit affirmed the preliminary injunction. Sunset argued the district court abused its discretion by affording too much weight to the presumption of validity of the trademark because the examiner violated procedures when it did not require additional evidence that the product design had acquired secondary meaning. The Federal Circuit held that the “presumption of validity is not conditional.” The Federal Circuit concluded that the district court did not abuse its discretion by declining “to revisit the examiner’s actions and alter the statutory presumption of validity.” Sunset further argued the district court erred by considering the availability of alternative filter designs after finding SoClean’s trade dress was functional. But the district court never found the filter design was functional. Rather, the district court found SoClean was likely to defeat Sunset’s functionality challenge because the trade dress comprises *both* functional and non-functional features. The Federal Circuit held alternative designs are a relevant consideration in the functionality analysis and there was no error.

IPR Disclaimers May Not Be Used to Shapeshift Claims

In *Cupp Computing as v. Trend Micro Inc.*, Appeal No. 20-2262, the Federal Circuit held that patent Owners cannot attempt to narrow claims by disclaiming claim scope during an IPR proceeding.

Trend Micro filed IPR petitions challenging three CUPP patents related to addressing malicious attacks aimed at mobile devices. During the IPR proceedings, CUPP disclaimed embodiments that did not include a “security system processor” that was remote from a mobile device. CUPP then argued that Trend Micro’s prior art reference did not disclose a “security system processor.” The PTAB rejected CUPP’s attempt to narrow the claims through an IPR

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disclaimer and held that the challenged claims were obvious. CUPP appealed.

On appeal, the Federal Circuit affirmed the Board's decision to ignore CUPP's disavowal. The Federal Circuit explained that allowing a patentee to tailor challenged claims through disclaimer during IPR proceedings would "substantially undermine the IPR process." The court noted that Congress designed IPR proceedings to allow the Patent Office to "revisit and revise earlier patent grants." Allowing patentees to disclaim subject matter would instead force the Patent Office to "focus on claims the patentee now wishes it had secured." Furthermore, the Federal Circuit explained that Congress created a specialized process for patentees to amend their claims in an IPR, and that the amendment process includes safeguards that would be circumvented with a disclaimer. As an example, the Court explained that the amendment process gives "accused infringers 'intervening rights' protection for substantively amended claims, ensuring that such claims have only prospective effect." Additionally, since IPR petitioners can only challenge claims under § 102 or § 103, accepting disclaimers would allow patentees to modify their claims free of scrutiny for compliance with § 101 requirements. Thus, the Federal Circuit held that disclaimers in IPR proceedings "are not binding in the proceeding in which they are made." However, the Court emphasized that a disclaimer by the patentee during an IPR is binding in later proceedings.

Once You're In, You're In: Amending Claims Addressing an Instituted Ground Allows for More Unrelated Amendments.

In *American National v. Sleep Number Corporation*, Appeal No. 21-1321, the Federal Circuit held that once a patent owner includes at least one amendment that is responsive to an instituted unpatentability ground, the patent owner may include more amendments to address other non-instituted grounds, such as potential § 101 and § 112 issues.

American filed IPRs challenging certain Sleep Number patent claims. The Board found claims that included a limitation requiring a "multiplicative pressure adjustment factor" patentable, while finding claims that did not include such limitation unpatentable. In response, Sleep Number amended the unpatentable claims by adding the multiplicative pressure adjustment factor limitation to them. Sleep Number also included additional amendments addressing other non-instituted grounds that were intended to "correct potential § 112 errors." Sleep Number alleged that its proposed amendments were made "to achieve consistency and accuracy in terminology and

phrasing" and the Board allowed the amendments.

American argued that the Board erred in allowing these amendments because they would invite due process and Administrative Procedure Act violations by unilaterally addressing issues that are: (1) better handled in examinations or reexaminations, and (2) could not be raised as an IPR ground (i.e. § 112 issues). The Federal Circuit disagreed, and held that the Board did not err. It held that "once a proposed claim includes amendments to address a prior art ground in the trial, a patent owner also may include additional limitations to address potential § 101 or § 112 issues, if necessary." The Federal Circuit recognized that although IPR petitions cannot challenge claims under § 112, it is well-established that the petitioner can challenge any amendments that are made to address § 112 issues, and American actually made such a challenge.

American also argued that one of Sleep Number's proposed amendments did not fix an enablement issue due to an unchanged typographical error in the patent specification. American argued that the proposed amended claim was still unpatentable due to a lack of enablement in part because the error was not obvious as it went unnoticed during the original examination process. The Federal Circuit affirmed the Board's decision against American and held that the error was obvious, regardless of whether the error was brought up in any prior examination.

American further argued that one of Sleep Number's proposed amendments adding a "valve enclosure" limitation created an inventorship issue that made the proposed claim facially invalid. American specifically argued that because another Sleep Number patent involved "valve enclosures" and had different named inventors, the different named inventors should be the named inventors to the amended claims. The Federal Circuit also rejected this argument, recognizing that the patents at issue clearly incorporate the prior patent and indicate that valve enclosures are well-known structures.

Expert Testimony Inconsistent with Agreed-Upon Claim Construction is Properly Stricken

In *Treehouse Avatar LLC v. Valve Corporation*, Appeal No. 22-1171, the Federal Circuit held that the district court did not abuse its discretion in striking expert testimony inconsistent with the court's claim construction. Nor did the district court err in granting summary judgment of non-infringement after striking the expert testimony.

Treehouse sued Valve for infringement of patent claims that required "character enabled (CE) network sites." The parties agreed upon a specific construction of the CE limitation, and the district

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court adopted the same construction. However, Treehouse's infringement expert report relied upon the plain and ordinary meaning of the CE limitation rather than the agreed-upon construction. Valve moved to strike portions of the expert testimony that relied on the plain and ordinary meaning, and for summary judgment of non-infringement based on the CE limitation. The district court granted both motions, and Treehouse appealed.

The Federal Circuit held that the plain and ordinary meaning used in the expert opinion was inconsistent with the agreed-upon construction. The Federal Circuit explained that "the grant of a motion to strike expert testimony is not improper when such testimony is based on a claim construction that is materially different from the construction adopted by the parties and the court." With the expert opinion stricken, Treehouse failed to offer any admissible evidence that the accused products satisfied the CE limitation. Accordingly, the Federal Circuit affirmed the district court's summary judgment of noninfringement.

Avoiding § 101 Eligibility Issues in Internet-Centric Method Claims

In *Weisner v. Google LLC*, Appeal No. 21-2228, the Federal Circuit held that the specific implementation of an abstract idea, such as improving Internet functionality, can be a patent-eligible concept.

Google moved to dismiss patent infringement claims brought by Sholem Weisner as claiming patent-ineligible subject matter. All four asserted patents shared a specification. Two patents claimed methods for logging a mobile device user's location data for use in optimizing a search (the "travel log patents"), while the two other patents claimed methods for using travel histories to improve search results (the "search optimization patents"). Although the district court only analyzed the travel log patents under *Alice*'s two-part test, it dismissed both the travel log patents and the search optimization patents as patent-ineligible.

On appeal, the Federal Circuit affirmed the district court's findings regarding the travel log patents. However, the Federal Circuit reversed the district court's determination of patent ineligibility regarding the search optimization patents. The Federal Circuit determined that the claims of the search optimization patents were directed to an abstract idea. However, the specific implementation of this abstract idea to solve a problem unique to the Internet transformed the claimed subject matter into patent-eligible subject matter. Specifically, the implementation of physi-

cal-travel-history data from a "reference person" to prioritize search results, when conventional search ordering methodologies defaulted to using virtual visitation data to order search results, solved the Internet-specific problem of searches providing impersonal search results. The Federal Circuit likened the search optimization's claims to *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), which similarly solved an Internet-specific problem by overriding conventional Internet sequences with patented methodology.

Judge Hughes dissented, arguing that the claims recited routine and conventional algorithms for search engine optimization, thus leaving only the abstract idea of using location data to improve search results. Judge Hughes also argued the problem of search engine optimization is not particular to the Internet, since people in the past have used a reference person's physical-travel data for recommendations before, like asking friends which restaurants they have visited before.

A Computer Method Claim Must Improve the Functions of the Computer to Survive § 101

In *International Business Machines Corp. v. Zillow Group, Inc.*, Appeal No. 21-2350, the Federal Circuit held that a patentee's allegation that computer method claims made data analysis more efficient, without reference to the function or operation of the computer itself, was not sufficient to overcome a challenge under 35 U.S.C. § 101.

International Business Machines ("IBM") sued Zillow for infringement of several patents directed to the graphic display of data on a computer. Zillow moved for judgment on the pleadings, arguing that several of the asserted patents were directed at ineligible subject matter under 35 U.S.C. § 101. The district court granted Zillow's motion as to two patents, finding the patents ineligible. After applying the two-step framework in *Alice*, the district court found the patents were "directed to abstract ideas, contain[] no inventive concept, and fail[] to recite patentable subject matter." IBM appealed.

On appeal, IBM argued that the district court erred in finding that the claims lacked an inventive concept under the second step of the *Alice* framework. IBM pointed to an expert declaration stating that the claimed method allowed for better visualization of data, which in turn resulted in more efficient data analysis. The Federal Circuit disagreed, finding that any improved efficiency came from the mere application of an abstract idea rather than an

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improvement to the functions of the computer itself, as the claims could be performed by hand and would yield the same improved efficiency. Accordingly, the Federal Circuit affirmed the district court's finding that the two patents were ineligible under 35 U.S.C. § 101.

Judge Stoll dissented in part, arguing that IBM had adequately alleged that two of the claims were patent eligible. Judge Stoll reasoned that the claims addressed physical limitations with computer displays wherein large datasets would be "densely packed" and rendered "incomprehensible."

Expert's Unanswered Questions Do Not Make Claims Indefinite

Nature Simulation Systems Inc. v. Autodesk, Inc., Appeal No. 20-2257, the Federal Circuit held that "unanswered questions" raised about asserted claim terms did not render asserted claims indefinite, in light of the specification, prosecution history, and other relevant evidence.

Nature Simulation Systems brought suit against Autodesk in the Northern District of California for infringement of two patents. The district court held the claims at issue invalid on the ground of indefiniteness. The district court recited several "unanswered questions" that Autodesk's expert raised about terms in the asserted claims. It explained that, even if the questions were answered in the specification, the definiteness requirement was not met because the questions were not answered in the claims. Nature Simulation Systems appealed.

The Federal Circuit reversed. It reiterated that claims are to be read and understood in light of the specification, the prosecution history, and other relevant evidence. The court explained that claims define the metes and bounds of the invention, but they are not intended to repeat the detailed explanations contained in the specification. Here, the Court stated that the specification described relevant prior art that gave clarity to the claim language. The Federal Circuit also noted that the district court gave no weight to prosecution history showing resolution of an earlier indefiniteness rejection.

Judge Dyk dissented. He argued that the asserted claims should be held invalid as indefinite. Judge Dyk reasoned that the district court properly applied the standard set forth in *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014), by reading the patent's claims in light of the specification and prosecution history to determine whether the claims would inform those skilled in the art about the scope of the invention with reasonable certainty. According to Judge Dyk, there was nothing in the record to

suggest someone of skill in the art would have understood the language at issue.

Seeing Clearly: An Ordinary Observer Must Look Through the Lens of the Prior Art

In ABC Corporation I v. The Partnership and Unincorporated Associations, Appeal No. 22-1071, the Federal Circuit held that time's up! The hourglass shape that is the dominant feature in both the asserted design patents and accused hoverboard products does not support a preliminary injunction because it was in the prior art.

Hangzhou Chic Intelligent Technology Co., Ltd. and Unicorn Global, Inc. ("plaintiffs") sued several sellers of Gyroor-branded hoverboards ("defendants") for infringement of four design patents and moved for a preliminary injunction. Plaintiffs asserted that the accused hoverboards infringed the patented designs because they all had an integrated "hourglass" body shape. Defendants argued that the plaintiffs' infringement analysis failed to account for a prior art reference that included an hourglass shape for a hoverboard. The district court granted the preliminary injunction, finding that the plaintiffs had shown a likelihood of success on the merits because a trial would likely be required to resolve the infringement dispute and the accused products were not "sufficiently dissimilar" or "plainly dissimilar" from the patented design.

The Federal Circuit reversed, holding that the district court erred in finding a likelihood of success on the merits for four independent reasons. First, the Federal Circuit held the court applied the wrong legal standard, and that an injunction cannot be granted merely because a trial is required to establish dissimilarity. Second, the Federal Circuit held the court erred by not conducting the ordinary observer analysis through the lens of the prior art. Applying *Egyptian Goddess*, the Federal Circuit held that where a dominant feature of the patent design and the accused products—here an hourglass shape—appears in the prior art, the infringement analysis should be based on other features of the design. Third, the Federal Circuit held the court erred because the products all differed, and the court did not carry out a product-by-product analysis. Fourth, the Federal Circuit held the preliminary injunction was overbroad because it generally enjoined any future product and not just the products found likely to infringe and products only colorably different from the products found likely to infringe.

Lack of Advance Notice Vacates District Court's Orders

In ABC Corporation I v. Partnership And Unincorporated Associations, Appeal No. 22-1071, the Federal Circuit held that time's up!

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rated Associations, Appeal No. 22-2150, the Federal Circuit held that failure to provide advance notice under Federal Rule of Civil Procedure 65(a) required vacatur of a preliminary injunction.

ABC Corporation (“ABC”) asserted four design patents against several business entities selling hoverboards online. ABC identified the defendants through a Schedule A (which changed over time) attached to the original and amended complaints. On November 24, 2020, the district court entered a preliminary injunction against the then-named defendants, which included Gyroor-US, a party that had not yet been served with process. On May 24, 2020, the district court granted ABC’s motion to amend Schedule A to add GaodeshangUS, Fengchi-US, and Urbanmax as defendants bound by the preliminary injunction. None of these entities had been served with process or received a Rule 65(a) notice. These entities (collectively, “Defendants”) sought relief from the preliminary injunction, citing inadequate notice under Rule 65(a). The district court denied relief and the defendants appealed.

On appeal, the Federal Circuit vacated the 2020 Preliminary Injunction from its issuance and as well as the May 24 Order insofar as it added defendants to the 2020 Preliminary Injunction. After finding no jurisdictional obstacles, the court noted that Defendants, before the entry of the 2020 Preliminary Injunction, received no advance notice or opportunity to oppose. ABC argued that there was advance notice to Gyroor-US when Amazon “froze” Gyroor-US’s accounts. However, the court concluded that Amazon’s action did not provide notice of the pendency of a motion for a preliminary injunction. The court then turned to the May 24 Order. ABC argued GaodeshangUS received notice through counsel representing both GaodeshangUS and Gyroor-US based on an electronic notice of ABC’s May 6 motion to amend Schedule A. The court found that GaodeshangUS was (1) not a party at the time of the May 24 Order and (2) counsel did not enter an appearance for GaodeshangUS until May 24. Thus, any notice to counsel did not meet the required notice to GaodeshangUS. The court also found that Fengchi-US and Urbanmax were not provided advance notice or an opportunity to oppose the May 24 Order. The Court therefore vacated the 2020 Preliminary Injunction and May 24 Order for violating Rule 65(a).

Duplicative-Litigation Doctrine: Proper Motion Practice is Essential to Avoid Dismissal of Duplicative Complaints

In *Arendi S.A.R.L. v. LG Electronics Inc.*, Appeal

No. 21-1967, the Federal Circuit held that under the duplicative-litigation doctrine, a party cannot maintain two separate actions involving the same subject matter, at the same time, in the same court, and against the same defendant.

Arendi S.A.R.L. (“Arendi”) sued LG Electronics (“LG”) for infringement of various patents. Pursuant to the Local Patent Rules, Arendi served its initial infringement contentions. However, Arendi provided a claim chart for only one product – LG’s Rebel 4 phone. LG informed Arendi that the singular claim chart failed to comply with the Local Patent Rules, which required a claim chart for each accused product. Arendi never supplemented its contentions to include additional products or explained how the Rebel 4 was representative of other LG products. LG moved to strike portions of Arendi’s expert report that included infringement allegations for non-Rebel 4 products. The district court granted LG’s motion because Arendi did not timely disclose those contentions. Arendi filed a second complaint, asserting that non-Rebel 4 products infringed the same patent. LG moved to dismiss the second complaint as duplicative. The district court granted LG’s motion and Arendi appealed.

Applying the Third Circuit’s standard of review, the Federal Circuit affirmed. The Federal Circuit held that the district court did not abuse its discretion in finding that Arendi’s second case was improperly duplicative. Under the duplicative-litigation doctrine, a party cannot bring two separate actions involving the same subject matter, at the same time, in the same court, and against the same defendant. Patent cases involve the same subject matter when the same patent is asserted and the accused products are at least essentially the same or identical. Arendi argued that there is no overlap between the accused products because the district court granted LG’s motion to strike portions of Arendi’s expert report. The Federal Circuit disagreed, noting that the district court granted the motion to strike due to Arendi’s failure to fulfill its discovery obligations. The Federal Circuit held that Arendi litigated the non-Rebel 4 products in the first case, noting that Arendi listed the accused products in its infringement contentions, served interrogatories about the accused products, and received discovery related to those products.

Patent Term Adjustment Under 35 U.S.C. 154(b)(1)(C)(iii) Requires Reversal of Adverse Determination of Patentability

In *Sawstop Holding LLC v. Vidal*, Appeal No. 21-1537, the Federal Circuit held that when a pa-

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tent claim is subject to adverse determinations of patentability first before the PTO and again after appeal, the claim is not entitled to patent term adjustment for the period of the appeal even if the claim eventually issues after post-appeal prosecution and amendment.

SawStop filed two patent applications with the PTO. After the Examiner rejected claims from both patents, SawStop appealed the rejections to the Patent Trial and Appeal Board. For the first patent, the Board held that the Examiner did not make initial fact findings required to demonstrate a prima facie case of obviousness, but ultimately affirmed rejection of the relevant claim on a new ground. For the second patent, the Board affirmed rejection of the relevant claim on grounds of anticipation and double patenting.

SawStop appealed to the district court, challenging rejection of the second patent based on anticipation. SawStop did not address rejection of the first patent or the double patenting rejection of the second patent. The district court reversed the challenged anticipation rejection. Claims from both patents were further amended and eventually issued.

SawStop requested a patent term adjustment for each patent under 35 U.S.C. 154(b)(1)(C)(iii). The PTO denied the request for one claim of each patent. SawStop appealed those denials in district court. After cross-motions for summary judgement, the district court found that neither patent claim was entitled to patent term adjustment, reasoning that neither application issued after an adverse determination of patentability was reversed. SawStop appealed the district court's ruling.

The Federal Circuit affirmed. It held the portion of the patent term adjustment statute at issue, 35 U.S.C. 154(b)(1)(C)(iii), requires that the patent issue under a decision reversing an adverse determination of patentability. The Federal Circuit held that there was no such reversal for either patent. With regard to the first patent, the claims were held unpatentable both before and after review by the Board, even though the Board's reasoning for unpatentability differed from the Examiner's. With regard to the second patent, the claims were still unpatentable even after review by the district court because that review did not address the PTO's double-patenting rejection.

The Applicant-Action (or Inaction) Exception

In *Gilbert P. Hyatt v. United States Patent And Trademark Office*, Appeal No. 21-2324, the Federal Circuit held that for a patent application filed but not yet granted before the Uruguay Rounds Agreement Act (which changed patent terms to

be 20 years from the effective filing date instead of 17 years from the grant date), a patentee's failure to disclose species-altering amendments for decades triggered the applicant-action exception. Therefore, the Examiner was within his authority to impose a restriction requirement under that exception.

The term for U.S. patent protection was amended to 20 years from the effective filing date instead of 17 years from the grant date by the Uruguay Rounds Agreement Act (URAA). The change in law left a gap for "transitional" applications – those filed but not yet granted before the URAA took effect on June 8, 1995. USPTO Rule 129 addresses that situation, and in particular, states that no restriction requirements may be made or maintained for transitional applications after June 8, 1995, "**except where ...** the examiner has not made a requirement for restriction in the present or parent application prior to April 8, 1995, **due to actions by the applicant.**" (emphasis added).

Hyatt's application was transitional. The PTO completed an initial examination of the application's claims in 2003, but stayed examination until 2012, due to pending litigation. When examination resumed, the Examiner issued a non-final rejection. Hyatt responded with significant claim amendments, in some instances, rewriting the entire claim apart from the preambular "A" and "comprising." The examiner determined that the amendments shifted claims to a different species and issued a restriction requirement.

Hyatt filed a complaint in the Eastern District of Virginia protesting this restriction requirement, arguing that it violated the Administrative Procedures Act since restriction requirements are generally not permitted for transitional applications under Rule 129. The district court granted the PTO's motion for summary judgment, determining that Hyatt's withholding of claims to a separate invention that was not disclosed prior to the April 8, 1995 cut-off date constituted an action that brought the Application under the applicant-action exception to Rule 129.

On appeal, Hyatt argued that his withholding was not an "action" for purposes of the applicant-action exception, but an "inaction." The Federal Circuit rejected this argument and affirmed the district court's decision that the restriction requirement was appropriate. It held that the applicant-action exception was applicable because "whether Hyatt's actions are characterized as a failure to disclose or an act of withholding an entirely new species, it was that conduct of Mr. Hyatt that prevented the Examiner from entering a restriction requirement."

Vacated Vacatur Terminates Termination

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In *Polaris Innovations Limited v. Brent*, Appeal No. 19-1483, the Federal Circuit affirmed the Board's decision not to terminate a case remanded under *Arthrex I* and upheld the Board's claim construction.

Polaris Innovations Limited ("Polaris") appealed the Patent Trial and Appeal Board's finding of unpatentability regarding two petitions brought by NVIDIA Corporation. However, the Federal Circuit vacated and remanded in view of its decision in *Arthrex I*. On remand, Polaris and NVIDIA jointly moved for termination. While the motion was pending, the Supreme Court decided *Arthrex II*, vacating the Federal Circuit's vacatur. In view of this, the Board denied the motion to terminate. With the Board's initial determinations of unpatentability now before the Federal Circuit again, Polaris added an appeal of the denied motion to terminate.

On appeal, the Federal Circuit affirmed the PTAB's decisions. Reviewing the Board's decision not to terminate *de novo*, the Federal Circuit found because the Supreme Court's decision in *Arthrex II* vacated the Federal Circuit's vacatur, the Board had reached a final decision. Termination was, therefore, not required under Section 317 of Title 35. Moreover, Section 317(a) only requires termination with respect to the petitioner (NVIDIA). The Federal Circuit noted even if there was no final decision, the Board would have been within its discretion to proceed to a final written decision without a petitioner.

The Federal Circuit also affirmed the PTAB's construction of terms from each of the two patents at issue. Reviewing claim construction *de novo* and underlying facts for substantial evidence, the Federal Circuit agreed "memory chips" could encompass both packaged and unpackaged dies. Likewise, the Federal Circuit agreed the broadest reasonable interpretation of "resource tag buffer" was "single buffer." Finally, reviewing the Board's findings regarding the scope and content of the prior art for substantial evidence, the Federal Circuit found the Board's conclusion that the prior art disclosed a "single buffer" adequately supported.

Judicial Review: The PTAB Must Offer Reasonably Discernible Logic

In *Provisur Technologies, Inc. v. Weber, Inc.*, Appeal No. 21-1942, the Federal Circuit held that the PTAB has an obligation to ensure the PTAB's logic is reasonably discernible from the record.

Weber petitioned for *inter partes* review of Provisur's patent, arguing that the claims were invalid as obvious over multiple references. In

its reply brief, Weber also submitted evidence that the digital camera disclosed in Weber's references was the same type of camera claimed by Provisur's patent.

Provisur asked the Board to exclude this evidence as untimely. In the Final Written Decision, the PTAB found that Weber's reply evidence was properly submitted rebuttal evidence and found that the digital camera limitation was disclosed by Weber's references. The PTAB also found that Provisur Technologies did not dispute that Weber's references taught all the other limitations of the claims. Rather than providing its own analysis on these limitations, however, the PTAB simply adopted Weber's arguments and evidence as its own.

On appeal, the Federal Circuit found that Provisur Technologies had argued that the references did not teach an additional limitation of the independent claims and that the PTAB erred by not addressing Provisur's other arguments. The Federal Circuit also found that the PTAB's adoption of Weber's arguments and evidence precluded the Federal Circuit from engaging in meaningful appellate review. However, the Federal Circuit affirmed the PTAB's decision that Weber's reply evidence was properly submitted, explaining that reply evidence did not change Weber's invalidity theories or fill any holes in Weber's petition. The Federal Circuit then remanded back to the PTAB for the PTAB to consider Provisur's remaining arguments.

Plausible Factual Allegations Concerning Inventive Concepts Preclude Motion to Dismiss

In *Cooperative Entertainment, Inc. v. Collective Technology, Inc.*, Appeal No. 21-2167, the Federal Circuit held that plausible allegations of an inventive concept in a complaint precluded a motion to dismiss for lack of patent eligibility because determining whether such a concept was well-understood, routine, or conventional was a question of fact that could not be resolved at the Rule 12(b)(6) stage.

Cooperative patented a system and method of structuring a peer-to-peer network for distributing large files and accused Collective of infringement. Collective moved to dismiss under Rule 12(b)(6), alleging that all claims were ineligible under § 101. Cooperative filed an amended complaint, which led Collective to refile its motion to dismiss, which the district court granted. On appeal, the Federal Circuit reversed the district court's dismissal and remanded for further proceedings.

Applying the Supreme Court's two-step *Alice* framework to analyze patent eligibility, the

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Federal Circuit proceeded directly to step two to determine if the amended complaint plausibly alleged that the claims recited an inventive concept. The Federal Circuit concluded that there were at least two alleged inventive concepts that should have precluded dismissal for lack of eligibility: (1) the use of peer nodes to communicate outside of a content distribution network and (2) the use of trace routes in data content segmentation. Without determining whether these concepts were actually inventive, the Federal Circuit noted that Cooperative's complaint alleged that these concepts were distinctions and improvements over the prior art and provided benefits to the technical field. The Federal Circuit also reasoned that the determination of whether the claimed network was well-understood, routine, or conventional was a question of fact that could not be resolved at the Rule 12(b)(6) stage. Accordingly, the Federal Circuit held that plausible factual allegations regarding inventive concepts precluded dismissal for lack of patent eligibility and remanded for further proceedings.

A Skilled Artisan Cannot "At Once Envisage" Each Member of a Large Class

In *Mylan Pharmaceuticals Inc. v. Merck Sharp & Dohme Corp.* Appeal No. 21-2121, the Federal Circuit held that a party arguing inherent anticipation cannot argue that a skilled artisan would "at once envisage" each member of the class where the class is large rather than limited.

Mylan petitioned for an *inter partes* review of a patent owned by Merck. The patent at issue claimed particular molecules. Mylan argued that the claims were expressly or inherently anticipated by a Merck-owned reference (Edmondson) or would have been obvious over Edmondson in view of additional references. The Board found that the claims would not be anticipated because Edmondson did not expressly disclose all the claimed limitations. "Mylan could not fill in the gaps by arguing that a skilled artisan would 'at once envisage' what is missing" because of the number of compounds in the class. The Board therefore rejected inherent anticipation. The Board also determined that Merck reduced its invention to practice prior to Edmondson, making Edmondson a Section 102(e) prior art reference, not a Section 102(a) reference. Because of the common ownership between Edmondson and the Challenged Patent, the Board held that Edmondson could not be used in an obviousness challenge for most claims under Section 103(c)(1). For the remaining claims, the Board found that Mylan failed to demonstrate a motivation to combine Edmondson with other references. Mylan appealed to the Federal Circuit.

The Federal Circuit affirmed the Board's deci-

sion. The Federal Circuit affirmed the Board's determination that Edmondson did not expressly disclose all the limitations of the challenged claims. The Federal Circuit also agreed that a class of 957 compounds, "some of which may not even form under experimental conditions," is not a limited class such that the skilled artisan could "at once envisage each member." Therefore, the Federal Circuit affirmed the determination of a lack of inherent anticipation.

The Federal Circuit also affirmed the determination that Edmondson was prior art under Section 102(e), not Section 102(a), and due to common ownership with the challenged patent, could not be used in an obviousness challenge for most claims under Section 103(c)(1). Finally, the Federal Circuit affirmed the Board's finding of non-obviousness because substantial evidence supported the determinations that Mylan failed to demonstrate a motivation to combine the references, that Mylan advanced no expected or theoretical benefit from making the claimed invention, and that unexpected results undermined Mylan's obviousness challenge.

Federal Circuit Denies Mandamus Regarding Venue Dispute with Remote Workers

In *Re: Monolithic Power Systems, Inc.* Appeal No. 22-153, the Federal Circuit denied mandamus for a factual-laden dispute on whether remote work employees met the requirement of a "regular and established place of business."

Bel Power Solutions Inc. ("Bel Power") sued Monolithic in the Western District of Texas for patent infringement by selling power modules to original equipment manufacturers. Monolithic moved to dismiss or transfer for lack of venue, arguing that as a Delaware corporation, it did not reside in the Western District. Monolith further argued it did not own or lease any property in the district, and that the presence of four fulltime remote employees in the Western District was not sufficient to constitute a "regular and established place of business" under Section 1400(b).

Judge Albright denied the motion to transfer, finding that Monolith had a "regular and established place of business" under Section 1400(b), noting that (1) Monolith solicited employment in the Western District to serve local customers and (2) Monolith provided and stored property in the Western District at the homes of remote employees that was used to service Monolith customers in the Western District.

The Federal Circuit denied mandamus, holding that "the district court's ruling does not involve the type of broad, fundamental, and recurring legal question or usurpation of judicial power that might warrant immediate *mandamus* review." Finding that venue analysis is necessarily

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a fact-specific inquiry, and that “this case may present an idiosyncratic set of facts,” the Federal Circuit held that Monolithic did not demonstrate the type of concerns that warranted mandamus review. Judge Lourie dissented, reasoning the Federal Circuit should have granted mandamus to prevent confusion regarding the significance of employee homes in the “regular and established place of business” analysis, particularly in view of the increased prevalence of remote work.



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New Patent Cases Filed in Waco Will Be Randomly Assigned Among Western District of Texas Courts and Divisions

by Daniel L. Moffett, Andy Rosbrook & Hannah D. Price

July 28, 2022

District Court, Patent Litigation, Federal Circuit

In response to the recent concentration of patent cases filed in a single court in Waco, Texas, all new patent cases filed in the Western District of Texas's Waco Division will be distributed among the district's various courts and divisions.

On July 25, 2022, Chief U.S. District Judge Orlando Garcia issued an Order Assigning the Business of the Court as it Relates to Patent Cases, ordering that all patent cases filed in the Western District's Waco Division be randomly assigned to 12 judges across the district, including to courts in San Antonio, Austin and El Paso. New patent cases filed in the Western District's other divisions are not subject to this random assignment.

Chief Judge Garcia's order responds to the explosion in patent filings in District Judge Alan Albright's court. Since Judge Albright's confirmation as the sole district judge in the Waco division in 2018, the number of patent cases filed in the Western District has grown dramatically, from less than 100 per year to nearly 1000 new case filings in 2021. Almost all of those cases have landed in Judge Albright's court. As a result, Judge Albright currently oversees about 20 percent of all pending U.S. patent cases, more than any other district court judge in the country.

This consolidation of patent cases into a single court has drawn criticism from both the Federal Circuit and the Senate's intellectual property subcommittee. Over the last two years, the Federal Circuit has granted multiple mandamus petitions overturning Judge Albright's denials of transfer motions. And in November 2021, Senators Patrick Leahy and Thom Tillis sent a letter to Chief Justice John Roberts expressing their concern about the concentration of patent cases in a single court, saying that it "creates an appearance of impropriety" that is "unseemly and inappropriate."

The new random assignment process addresses these criticisms by limiting plaintiffs' ability to deliberately choose Judge Albright's court over other venues. Now, patent plaintiffs who file in Waco hoping to have their case heard by Judge Albright will have only a one-in-twelve

chance of seeing that happen. Instead, patent cases filed in the Waco division are far more likely to land elsewhere in the district, including the San Antonio division, where five of the 12 district judges identified in Chief Judge Garcia's order sit.

Chief Judge Garcia's order does not affect the hundreds of patent cases already on Judge Albright's docket, but it is expected to substantially curtail the number of new patent cases filed in Waco. The extent of the impact remains to be seen, however, and will likely depend on whether other courts within the Western District of Texas adopt some or all of Judge Albright's standing orders and guidelines pertaining to patent cases.

IPR Petition Denied Due to Expert's Lack of Relevant Experience

by Matthew George Hartman & Rubén H. Muñoz

September 12, 2022

Patent Trial and Appeal Board, Inter Partes Review, Obviousness, Medical Devices, Expert Testimony

A recent board decision denying *inter partes* review serves as a reminder that an expert opining on obviousness must at least meet the definition of an ordinarily skilled artisan.

The patent at issue related to a tele-presence system that allows a physician at a remote location to view a surgical procedure and to provide instructions and mentoring to personnel at the surgical site via video conference. The tele-presence system includes a cart with an overhead camera mounted on an arm or "boom" that can be extended or rotated. This allows the overhead camera to be placed in different positions, including inside the sterile operation field, in order to provide a desirable view of the patient and operating procedure. Petitioner filed a petition for *inter partes* review, alleging that the claims would have been obvious in view of several prior art combinations.

In assessing whether to institute IPR, the board considered, as a preliminary matter, whether petitioner's expert had the requisite level of skill to testify from the perspective of a skilled artisan. The board found that the definition of a skilled artisan, which was advanced by petitioner, required "at least two years of research or work experience in designing or engineering teleconferencing systems, such as those used in telemedicine." The board further found that although petitioner's expert had advanced degrees in electrical engineering, he lacked specific experience researching or engineering teleconferencing systems. In reaching this conclusion, the board found the expert's vague reference to "numerous *experiences with teleconferencing*" and to having performed "design reviews of telemedicine devices"

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insufficient to establish himself as a skilled artisan. Therefore, the board gave no weight to testimony by petitioner's expert on any issue analyzed through the lens of an ordinarily skilled artisan, including what a skilled artisan would have derived from the prior art technology.

Nevertheless, the board found that even if petitioner's expert had been a skilled artisan, his testimony was a "carbon copy" of the petition, neither of which explained sufficiently a motivation for combining the asserted references to arrive at the claimed tele-presence system. Thus, the board found that petitioner failed to establish why a skilled artisan would have modified a mobile robot disclosed in the prior art to include a camera attached to the robot by an adjustable boom. According to the board, petitioner failed to address patent owner's contention that coupling a camera to the prior art robot would complicate the steering and balance which could cause the mobile robot to tip over or contact objects, such as patients. Because the board found the deficiencies in the petition dispositive, it declined to institute IPR.

Practice Tip: When relying on an expert to provide opinions from the perspective of an ordinarily skilled artisan, including before the PTAB, it is critical to ensure that the selected expert meets, at a minimum, the applicable definition of a skilled artisan, which needs to be backed up by evidence and not conclusory statements.

PTAB Applies Director's Guidance and Holds That Compelling Evidence of Unpatentability Precludes *Fintiv* Denial

by Megan R. Mahoney, Jason Weil & Rubén H. Muñoz

September 13, 2022

Patent Trial and Appeal Board, Inter Partes Review, Expert Testimony

In an IPR institution decision issued shortly after the USPTO issued interim guidance on discretionary denials, the PTAB held that the petition presented "compelling evidence of unpatentability," foreclosing a *Fintiv* discretionary denial.

The petitioner challenged several claims of a patent as obvious over a single prior art reference and supported its positions with expert testimony. In response, the patent owner declined to address the merits, instead requesting that the PTAB exercise its discretion to deny institution under 35 U.S.C. § 314(a) because of the accelerated schedule of parallel litigation pending in district court, and under 35 U.S.C. § 325(d) because the asserted prior art reference

was considered during prosecution.

The PTAB addressed each challenged claim limitation and determined that the petition and supporting expert testimony sufficiently established that the prior art reference taught the limitations. For each claim limitation, the PTAB observed that the patent owner did not address the merits of petitioner's contentions. Despite the co-pending district court litigation, the PTAB instituted review based on the petition's presentation of compelling evidence of unpatentability. In coming to its conclusion, the PTAB relied on the USPTO's recent interim guidance, which explains that a "compelling unpatentability challenge" alone forecloses the PTAB's discretion to deny institution under *Fintiv*. The guidance defines a "compelling unpatentability challenge" as one where the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence. The PTAB concluded that the standard was met and therefore could not exercise its discretion to deny institution under *Fintiv*. The PTAB also refused to exercise its discretion to deny institution under 35 U.S.C. § 325 (d), finding that petitioner's compelling unpatentability challenge likewise demonstrated that the patent examiner erred during prosecution in a manner material to patentability of the challenged claims.

Practice Tip: Following the USPTO's recent interim guidance on discretionary *Fintiv* denials, patent owners seeking discretionary denial should address the merits of the petition and explain why the petition and any accompanying evidence fails to show that the challenged claims are unpatentable.

STMMicroelectronics, Inc. v. The Trustees of Purdue Univ., IPR2022-00309, Paper 14 (PTAB Jul. 6, 2022).

PTAB: Statements About Device Not Disclosed in a Video Are Not Prior Art; Concurrency: Video Itself—If Publicly Available—Is Prior Art

by Caitlin E. Olwell, Rubén H. Muñoz, Lisa Hladik (Law Clerk)

October 12, 2022

Patent Trial and Appeal Board, Inter Partes Review, Obviousness, 35 U.S.C. § 311(b)

The Patent Trial and Appeal Board denied a petition to institute *inter partes* review, finding there was no reasonable likelihood that petitioners would prevail on their obviousness challenges. In rendering its decision, the PTAB rejected petitioners' proposed claim construction as being contrary to plain meaning and being improperly grounded in irrelevant embodiments. The PTAB also declined to rely on statements concerning a

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device depicted in a video because those statements fell outside the ambit of prior art under 35 U.S.C. § 311(b). Finally, while the majority opinion declined to address the issue of whether the video itself was a printed publication, one judge found, in concurrence, that a publicly accessible video can qualify as a printed publication under the statute. More details regarding those rulings are provided below.

Petitioners challenged several claims directed to an apparatus and method for skin treatments using electrical stimulation as being obvious in view of the prior art. Petitioners and patent owner disagreed on the construction of a claim term directed to causing coagulation around each electrode. The patent owner argued that petitioners' proposed construction improperly introduced additional limitations into the claims, which was contrary to the plain and ordinary meaning. The PTAB agreed, finding that petitioners impermissibly attempted to read structures present in inapplicable embodiments into the language of the challenged claims.

Petitioners grounded their obviousness arguments on prior art consisting of a YouTube® video that described a handheld device with microneedling capabilities (the "INTRAcel device"). However, the petitioners' obviousness argument was predicated on screenshots from the video in conjunction with other statements made about the INTRAcel device that were not included in the video itself. The patent owner argued that such statements made outside the video should be disregarded. The PTAB agreed with the patent owner because those statements were not disclosed in the prior art and, thus, did not qualify as a "printed publication" under 35 U.S.C. § 311(b). The PTAB panel majority noted that even if the INTRAcel device itself contained all of the required claim limitations, this was not the proper analysis for the obviousness inquiry. Rather, the issue that petitioners should have addressed was whether the printed publication disclosed every limitation.

In a footnote, the majority also explained that it was unnecessary to address whether the video qualified as a printed publication, as that issue was not in dispute. One of the judges in the panel, in a concurring opinion, took up this issue. He noted that the patent owner only conceded that the video was a "publication," rather than a printed publication—the latter of which is disseminated in a manner that is accessible to the public interested in the art prior to the critical date of the challenged patent. He also examined well-established precedent holding that text, images, and audio of a video qualified as a "printed publication." The concurring judge further noted that the "printed publication" concept has evolved with an emphasis on accessibility to the public—not whether it is "printed"

in the strictest sense of the word. Based on the foregoing rationale, the judge concluded that if the video was publicly accessible, it qualifies as a printed publication falling within the PTAB's review.

Practice Tips:

While claims should be read in light of the specification, the majority opinion serves as a reminder that unrelated embodiments from the specification cannot be used to add limitations into those claims. Furthermore, if relying on videos of devices to support an obviousness argument, petitioners should be mindful that physical devices themselves are not prior art under 35 U.S.C. § 311(b). The relevant inquiry is whether the printed publication discloses the limitations of a challenged claim, not whether the device itself (as may be established through non-prior art evidence alone) contains the claim limitations. Finally, petitioners seeking to rely on non-patent literature as prior art should shore up evidence in the petition demonstrating public accessibility prior to the critical date.

USPTO Director Issues Sua Sponte Precedential Decision Addressing Abuse of IPR Process

by [Caitlin E. Olwell](#), [Rubén H. Muñoz](#), [Lisa Hladik](#) (Law Clerk)

November 10, 2022

Patent Trial and Appeal Board, Inter Partes Review, Infringement

In a precedential 52-page *sua sponte* decision, the United States Patent and Trademark Office (USPTO) Director Katherine Vidal addressed several issues of first impression relating to sanctionable misconduct in *inter partes* review proceedings. As set forth in more detail below, the Director ultimately determined that the petitioner had engaged in abuse of process. The Director banned the petitioner from any further participation in the proceeding, and allowed a joined petitioner to step into the role of lead petitioner. The Director then instructed the Patent Trial and Appeal Board to determine whether the IPR petition met the compelling-merits standard for institution, which is a higher standard than the reasonable likelihood standard typically required for IPR institution.

Background: Petitioner OpenSky Industries, LLC's IPR petition challenged claims of a patent owned by VLSI Technology LLC. The petition was largely copied from portions of an IPR petition previously filed by Intel Corporation challenging the same patent claims. Intel had filed its IPR petition after being sued for patent infringement by VLSI. There, the board declined to institute IPR based on the progression of the ongoing litigation between Intel and VLSI, and the overlap

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between the issues in the litigation and the petition. Ultimately, the trial resulted in a \$2 billion jury verdict against Intel. Shortly thereafter, OpenSky was formed and filed a “copycat” IPR petition. Unlike Intel, OpenSky had not been sued for patent infringement. Intel later joined the proceeding with OpenSky, but OpenSky’s conduct prompted Director review on questions relating to an abuse of process.

OpenSky’s Conduct: Sanctionable misconduct includes an “abuse of process” (see 37 CFR § 42.12(a)(6)). However, the regulations do not give any additional guidance as to what conduct rises to the level of an “abuse of process.” As such, the determination is highly case-specific and fact-based. Here, the Director found OpenSky’s conduct to be an abuse of process based on the following case-specific considerations: (1) petitioner’s interest in the IPR proceeding, (2) the recent trial damages verdict, (3) the proximity between the formation of petitioner’s business and the jury verdict, (4) petitioner’s attempts to obtain compensation from parties on both sides of the IPR dispute, (5) petitioner’s failure to meaningfully pursue the merits of the patentability challenge, and (6) petitioner’s filing of a “copycat” petition.

Board’s Analysis: Regarding the first consideration, the Director noted that it is not *per se* improper for a party to petition for IPR if that party is not a defendant in a patent infringement suit. But where a petitioner has not been sued for infringement, and is a non-practicing entity, there may be legitimate questions regarding whether that petition was filed for an improper purpose. Here, OpenSky’s actions were at odds with any proper interest, including an interest in preserving the integrity of the patent system. Tellingly, OpenSky failed to comply with the Director’s mandated discovery relevant to this factor. For instance, through interrogatories, the Director sought information pertaining to OpenSky’s business purpose, whether it believed it would be sued for patent infringement, and its policy reasons for filing an IPR petition. Rather than providing straightforward responses, OpenSky skirted around the call of the interrogatories, providing non-responsive answers.

With respect to the second and third considerations, the recent jury verdict against Intel was substantial, and there was a close proximity between that verdict and OpenSky’s formation as a business. OpenSky formed as an entity only seven weeks following the verdict against Intel, and OpenSky filed an IPR petition six weeks thereafter.

Regarding the fourth consideration, OpenSky sought compensation from both Intel and VLSI. While attempts at settlement are typical and often encouraged, it is unusual for one party to

solicit compensation from both a joined petitioner and the patent owner. OpenSky’s actions underscored its goal to extract money from whatever party was willing to give it, and indicated that OpenSky’s interest was not for a legitimate purpose of challenging the patent.

Discussing the fifth consideration, the Director reiterated that OpenSky showed no interest in pursuing a patentability challenge on its merits. The Director pointed to OpenSky’s continued efforts at seeking payment from Intel, its failure to request oral argument, and its failure to meaningfully participate in oral hearing at all.

Lastly, OpenSky’s “copycat” petition further established that its conduct was an abuse of process. Using a “copycat” petition on its own is not *per se* improper, but taken in conjunction with the other factors and circumstances, that use pointed to an abuse of process. OpenSky’s filing not only copied Intel’s IPR petition, it also copied Intel’s expert declaration. OpenSky never notified the expert nor negotiated for his services, which indicated that OpenSky lacked control over a key witness that could jeopardize the entire case. This factor evidenced OpenSky’s goal of filing an IPR with the lowest possible cost in an effort to generate leverage to extract payment.

Based on the foregoing, the Director found that the sum total of OpenSky’s actions amounted to sanctionable abuse of process.

Resulting Sanctions: 35 U.S.C. § 316 gives the Director the authority to sanction parties, and determining the type of sanctions that should be imposed is a case-dependent, fact-intensive inquiry. Under 37 CFR § 42.12, there are a number of possible sanctions that the PTAB may impose. Those relevant to the present case and noted by the Director include: (1) an order holding facts to have been established in the proceeding, (2) an order expunging a party from filing a paper, and (3) an order providing for compensatory expenses, including attorney’s fees.

For its failure to comply with the Director’s discovery mandate and to prevent OpenSky from benefiting from its discovery misconduct, the Director determined that one appropriate sanction was an adverse inference holding disputed facts as established against OpenSky. Other sanctions levied against OpenSky included precluding OpenSky from participating in the underlying IPR proceeding, prohibiting OpenSky from filing further papers into the record or presenting evidence, and ordering OpenSky to show cause as to why it should not be ordered to pay compensatory damages. Due to OpenSky’s preclusion, Intel was elevated to the lead petitioner.

Finally, because the Director has an obligation to secure reliable patent rights and remove patents that do not support innovation, the Director de-

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clined to terminate the IPR proceeding outright. This IPR will continue only if the PTAB panel, on remand, determines that the unpatentability challenge meets the “compelling-merits” standard as of the time of institution and on the record that then-existed.

Practice Tip: The USPTO will not permit the use of PTAB proceedings to extort money from interested parties. Nor will the USPTO allow conduct that flagrantly disregards discovery mandates and orders. While there is no standing requirement for IPR, entities that have not been sued for infringement should proceed cautiously and think carefully about their motivations before filing a petition. Those entities should also be prepared (financially and otherwise) to fully litigate the proceeding, including retaining an expert. Conversely, patent owners faced with IPR petitions filed by uninterested parties should scrutinize thoroughly the petitioner’s motives. Petitioners found to have engaged in improper gamesmanship before the USPTO risk severe sanctions, including removal from the proceeding and the petition being held to a higher standard for institution.

Case: *OpenSky Industries, LLC v. VLSI Technology LLC*, IPR2021-01064, Paper 102 (PTAB Oct. 4, 2022)

PTAB Reverses Course and Finds Challenged Patent Claims Unpatentable in Light of Applicant Admitted Prior Art

by **Hannah D. Price, Matthew George Hartman & Rubén H. Muñoz**

December 2, 2022

Patent Trial and Appeal Board, Inter Partes Review, Prior Art, Obviousness

The Patent Trial and Appeal Board granted a request for rehearing of a final written decision in which it had originally determined that the challenged were not unpatentable. On rehearing, the board found that petitioner’s reliance on applicant admitted prior art (AAPA) was proper because it was not the sole basis of any ground in the *inter partes* review proceeding.

Petitioner’s obviousness grounds in the IPR relied on one or more prior art references in combination with AAPA, which included admissions in the specification of the challenged patent about prior art photo voltaic systems. Relying on a Guidance Memo from the USPTO Director, a PTAB panel found that because the petition relied on AAPA, and therefore did not rely on patents and printed publications to teach all the limitations, petitioner had not shown that the challenged claims were unpatentable.

Petitioner filed a request for rehearing and argued that its use of AAPA was consistent with

the Director’s Updated Guidance, which states that “[i]f an IPR petition relies on admissions in combination with reliance on one or more prior art patents or printed publications, those admissions do not form ‘the basis’ of the ground and *must be considered by the Board in its patentability analysis.*” In opposition, patent owner argued that petitioner’s use of AAPA in this proceeding was not proper because “it forms the basis of Petitioner’s arguments” and because “there is no evidence that the asserted AAPA was known in the prior art.” The PTAB panel sided with petitioner and in doing so explained that “AAPA is not the basis of this *inter partes* review proceeding” because the grounds “involve a combination of AAPA and prior art patents(s),” where the “AAPA is being properly used to supply the missing claim limitation.” In support of this finding, the PTAB panel stated that the Federal Circuit “has held ‘it is appropriate to rely on admissions in a patent’s specification when assessing whether that patent’s claims would have been obvious’ in an *inter partes* review proceeding” (quoting *Qualcomm, Inc. v. Apple, Inc.*, 24 F.4th 1367, 1375 (Fed. Cir. 2022)). After considering petitioner’s AAPA, the PTAB panel determined that the challenged claims were unpatentable.

Notably, in finding the claims unpatentable, the PTAB disregarded patent owner’s argument that there was “no evidence that the asserted AAPA was generally known in the prior art or was within the knowledge of an ordinarily-skilled artisan at the time of the invention.” Petitioner challenged the board’s consideration of this argument because patent owner did not make this argument in either its Response or Sur-Reply. Instead, it waited until the hearing to “re-characterize its admissions” to say that the AAPA was only known to the applicant, and was not known to a person of ordinary skill in the art. Here, the PTAB agreed with petitioner and did not consider patent owner’s argument because “no new arguments” can be made at an oral hearing.

Practice Tip: Petitioners and patent owners in IPR proceedings should remain vigilant regarding the use of AAPA before the PTAB. AAPA can play a critical role in the ultimate determination by the board regarding the patentability of challenged claims. Under the PTAB’s current guidance, AAPA may be properly used in combination with prior art patents and publications in order to provide missing limitations. But AAPA cannot alone form the basis of any ground in an IPR.

Solaredge Tech. Ltd. v. SMA Solar Tech. AG, IPR2020-00021, Paper 31 (PTAB October 25, 2022).



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.

Patently-O – a patent law blog – Patentlyo.com

* **Replying All to Email Messages** – On November 7, 2022, David Hricik discussed the recent ABA ethics opinion Formal Ethics Opinion 503 (Nov. 2, 2022) (https://www.americanbar.org/content/dam/aba/administrative/professional_responsibility/aba-formal-opinion-503.pdf) regarding permission to communicate with opposing counsel's client when the opposing counsel cc's the client to an email message. Generally, the opinion suggests that responding to the email message in a "reply all" mode should be interpreted as "invited" by opposing counsel, note that an ABA ethics opinion lacks authority in most states, so be careful. (<https://patentlyo.com/hricik/2022/11/opinion-replying-opposing.html>).

* **Prosecution Disclaimers** – On November 16, 2022, Professor Dennis Crouch discussed the Federal Circuit's decision in *Cupp Computing AS v. Trend Micro Inc.*, Nos. 2020-2262, 2020-2263, 2020-2264, slip opinion (Fed Cir., Nov. 16, 2022) (http://cafc.uscourts.gov/opinions-orders/20-2262.OPINION.11-16-2022_2034079.pdf). The opinion discussed prosecution disclaimers, wherein patentees are not permitted to recapture through claim interpretation specific meanings disavowed during prosecution. However, the disavowal must be clear and unmistakable to preclude such recapture. The opinion also held that prosecution disclaimer in an IPR proceeding is binding in later proceedings, before the USPTO or in court. (<https://patentlyo.com/patent/2022/11/disclaimer-now-later.html>).

* **Patent Law Year in Review** – On January 7, 2023, Professor Dennis Crouch gave a presentation of significant developments in patent law from 2022.

Key points:

Director Review and Ex Parte Lobbying: Exercising the constitutional right to petition the government via shadow request for director review.

Full Scope Enablement and Written Description: Increased focus by both the USPTO and the Federal Circuit. Pending SCOTUS cases of *Amgen v. Sanofi* and *Juno v. Kite*.

Patents as Commodity: Many folks are treating it as such.

Broad IPR Estoppel: *CalTech v. Broadcom/Apple*. Pending before the Supreme Court.

Who is the Inventor: AI and Corporation as

the inventor. *Thaler v. Vidal* cert petition likely in January 2023.

Eligibility: *Tropp* and *Interactive Wearables* are not great vehicles for Supreme Court review. Hopefully, IBM petitions its case from *IBM v. Zillow*.

Patent Venue: Lots still happening in W.D.Tex. IMO, parties arguing inconvenient venue don't really care about convenience. Their basic concern is that they want to escape from Judge Albright's courtroom and raise costs on to the patentee.

You can review the slides of the presentation at <https://cdn.patentlyo.com/media/2023/01/Patent-Year-in-Review.pdf>. <https://patentlyo.com/patent/2023/01/patent-year-review.html>.

United States Patent and Trademark Office – The U.S. agency for patents and trademark registrations – [uspto.gov](https://www.uspto.gov)

* **Cancer Moonshot Expedited Examination Pilot Program** – The USPTO announced on December 8, 2022 that beginning February 1, 2023 a new program will expedite patent applications pertaining to a broad scope of technologies to prevent cancer and cancer mortality. The program is capped at a total of 1,000 grantable petitions. This program replaced the USPTO's Cancer Immunotherapy Pilot Program, which pertained to methods of treating a cancer using immunotherapy, and terminates on January 31, 2023. (<https://www.uspto.gov/about-us/news-updates/uspto-announces-cancer-moonshot-expedited-examination-pilot-program>).

Patent Docs – A patent blog – patentdocs.typepad.com/patent_docs

* On January 8, 2023, Donald Zuhn mentioned that the USPTO issued a notice (<https://www.uspto.gov/sites/default/files/documents/filingreceipts.pdf>) for applicants to review filing receipts issued between March 2022 and mid-October 2022 as a switch of systems may have introduced errors involving foreign filing license notifications and publication information. Register notice (<https://www.gpo.gov/fdsys/pkg/FR-2017-01-12/pdf/2017-00568.pdf>) seeking public comments on whether the accelerated examination program should be discontinued. (<https://www.patentdocs.org/2023/01/uspto-issues-notice-regarding-certain-filing-receipts-issued-between-march-and-october-2022.html>).

AIPLA – the profession's national organization – see [AIPLA.org](https://www.aipla.org)

* AIPLA's Mid-Winter Institute will be held on January 31 to February 3, 2023; the 2023 Spring Meeting on May 10 to 13, 2023; and AIPLA 2023 Annual Meeting from October 19 to 21, 2023. More information is available at <https://www.aipla.org>

INTERNET SIGHTINGS

www.aipla.org/events.

* The Chisum Patent Academy scheduled to hold one seminar in 2020, Boston, Massachusetts on October 1-2, 2020. Instead, the Boston seminar was then scheduled for a time in 2021, due to you-know-what. Well, that didn't happen. Maybe 2023? For now, the landing page states, "Due to the Covid-19 pandemic, the Chisum Patent Academy has postponed its live seminars." Check the website for updates and more information at <https://chisum-patent-academy.com/>.

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.



OCIPLA EVENTS

January 25, 2023 Luncheon—IP Ethics

Emil J. Ali, McCabe & Ali, LLP

**Emil J. Ali,
Partner
McCabe & Ali,
LLP**

OCIPLA

**WEDNESDAY
JANUARY 25, 2023
5:30PM -7PM
THE BOARDWALK
IRVINE**

THIS MONTH: IP ETHICS

November 18, 2022 Luncheon—"IP Challenges of In-House Counsel"

*Jason Weintraub, Chief Legal Officer, Jacuzzi Group Worldwide, and
Neha Jaiswal, Director, International at Domino's Pizza*

Jason Weintraub

Neha Jaiswal

OCIPLA

**FRIDAY
NOV 18, 2022
12:00 PM - 1:00 PM
ANDREI'S CONSCIOUS
CUISINE, IRVINE**

**TOPIC: PROTECTING
POPULAR BRANDS**

OCIPLA EVENTS

October 20, 2022 Luncheon—"In-House Panel"

Christina Zabat-Fran, General Counsel/CLO, ST. JOHN

John Conniff, Chief Legal Officer, Amada North America, Inc.

Mark Blake, Senior Director - Litigation, Intellectual Property and Strategy, Edwards Lifesciences

Michael Kline, Senior Corporate Counsel, Director of IP, Cleveland Golf



OCIPLA

**OCTOBER
LUNCHEON**

IN-HOUSE PANEL

THURSDAY, OCTOBER 20
ANDREI'S CONSCIOUS CUISINE
IRVINE

The graphic features a large orange ring with a green leaf on top, set against a black and yellow background. The text is white and arranged in a clean, modern font.

September 15, 2022 Luncheon—An Overview of the USPTO Pro Bono Program



OCIPLA

THURSDAY
SEPTEMBER 15, 2022
12:00 PM - 1:00 PM
ZOOM

TOPIC: AN OVERVIEW OF
THE USPTO PATENT PRO
BONO PROGRAM


Dahlia George, USPTO

The graphic has a blue background. On the left, there is a circular portrait of Dahlia George. On the right, the OCIPLA logo and event details are displayed in white text. The topic is listed at the bottom right.

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

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
- **CLARK GORDON**, 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

- **MATT LAPPLE**,
matt@lappellubell.com
- **LAUREN KELLER KATZENELLENBOGEN**, *lauren*.
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- **MARK KERTZ**,
mark.kertz@medtronic.com
- **Marin Cionca**,
marin@cioncaip.com

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.



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.

JOB ANNOUNCEMENT

DLA Piper has announced a job opportunity for a Paralegal Specialist in Patent Litigation. Interested persons can contact bosstaffrecruitment@us.dlapiper.com for more information.

OCIPLA 2023 Board of Directors

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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:

Brock F. Wilson
2023 OCIPLA Newsletter Editor

