

# Post-Grant for Practitioners

## Estoppel, Broadest Reasonable Interpretation, and Appeals of Institution Decisions

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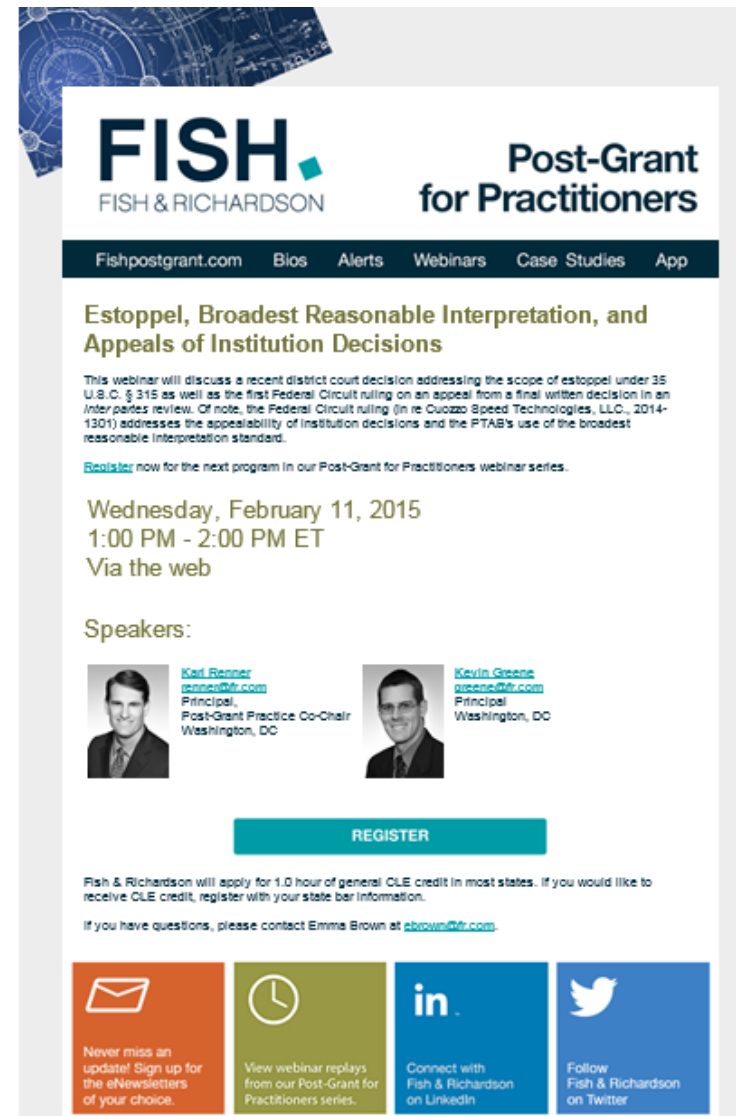


- I. Overview of Webinar Series
- II. Statistics
- III. Scope of Estoppel
  - a. Star Envirotech Inc v. Redline Detection LLC et al. 8:12-cv-01861-JGB-DFM (C.D. Ca.)
- IV. Broadest Reasonable Interpretation and Appeal/Review of Institution Decisions
  - a. In re Cuozzo Speed Technologies, LLC, No. 2014-1301 (Fed. Cir. 2015)
- V. Post-Grant Resources



# Overview of Webinar Series

- Where? ... see invitation
- How often? ... monthly
- When? ... 2<sup>nd</sup> Wednesday
- Topics? ...
  - Important decisions
  - Developments
  - Practice tips
- Housekeeping
  - CLE
  - Questions
  - Materials
    - <http://fishpostgrant.com/webinars/>



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### Estoppel, Broadest Reasonable Interpretation, and Appeals of Institution Decisions

This webinar will discuss a recent district court decision addressing the scope of estoppel under 35 U.S.C. § 315 as well as the first Federal Circuit ruling on an appeal from a final written decision in an *inter partes* review. Of note, the Federal Circuit ruling (in re Cuozzo Speed Technologies, LLC., 2014-1301) addresses the appealability of Institution decisions and the PTAB's use of the broadest reasonable interpretation standard.


[Register](#) now for the next program in our Post-Grant for Practitioners webinar series.

**Wednesday, February 11, 2015**  
1:00 PM - 2:00 PM ET  
Via the web

**Speakers:**



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Fish & Richardson will apply for 1.0 hour of general CLE credit in most states. If you would like to receive CLE credit, register with your state bar information.


If you have questions, please contact Emma Brown at [ebrown@fr.com](mailto:ebrown@fr.com).




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Statistics



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- **IPR's Filed?**

- **2,451** filed through February 5, 2015
- **100** filed in January 2015

- **CBM's Filed?**

- **296** filed through February 5, 2015
- **14** filed in January 2015

- **FWD's on the Merits Issued So Far**

- IPR: **224** through February 5, 2015
- CBM: **30** through February 5, 2015




# Scope of Estoppel

- District court denied the plaintiff's motion to strike the defendant's preliminary invalidity contentions
  - Plaintiff filed motion in view of defendant's failed IPR
- Central to the issue was the scope of estoppel under 35 U.S.C. § 315(e)(2)
  - The petitioner in an inter partes review of a claim in a patent . . . that results in a final written decision . . . may not assert [in a district court] that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review



- Preliminary invalidity contentions were based on an actual machine
- IPRs are limited to patents and printed publications
  - 35 U.S.C. § 311(b): A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications

- The defendants argued that the machine formed new grounds that could not have been presented in the IPR
- The plaintiff argued that the defendants had the machine's owner manual and could have submitted that in the IPR
- The Court found that estoppel did not apply because “the physical machine itself discloses features claimed in the [patent] that are not included in the instruction manual, and it is therefore a superior and separate reference.”



**Broadest Reasonable  
Interpretation and  
Appeal/Review of Institution  
Decisions**

- Grounds of Appeal
  - PTAB's decision to institute based on grounds not proposed in the petition
  - PTAB's use of the broadest reasonable interpretation and the resulting interpretation under that standard
  - PTAB's finding of obviousness
  - PTAB's denial of Cuozzo's motion to amend

- Federal Circuit's Decision
  - Institution decision not reviewable on appeal of final written decision
  - No error in applying broadest reasonable interpretation or in resulting interpretation
  - Obviousness finding supported by substantial evidence
  - No error in denying motion to amend since the motion enlarged the claims

- No review as part of interlocutory appeal or appeal from final written decision
  - In re Cuozzo; St. Jude Medical, Cardiology Div. v. Volcano Corp., 749 F.3d 1373 (Fed. Cir. 2014); ZOLL Lifecor Corp. v. Philips Electronics, No. 2014-1588 (Fed. Cir. 2014)
- No review under Administrative Procedures Act
  - Dominion Dealer Solutions, LLC. v. Lee, No. 3:13CV699 (E.D. Va. 2014)
  - Versata Development Corp. v. Rea, 959 F. Supp. 2d 912 (E.D. Va. 2013) (involved a CBM, but statutory language the same)

- No review under mandamus prior to final written decision
  - In Re Dominion Dealer Solutions, LLC, No. 2014-109 (Fed. Cir. 2014)
  - In Re Proctor & Gamble, No. 2014-121 (Fed. Cir. Apr. 2014)
- Potential review under mandamus after final written decision
  - In re Cuozzo (Fed. Cir. expressly left open possibility)

# Broadest Reasonable Interpretation

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- In re Cuozzo approved the PTO's use of BRI in IPRs
- Justification for BRI relies on ability to amend
- What about when the patent expires during an IPR?



- Patent expires prior to institution decision
  - PTAB has applied Phillips construction throughout proceeding
    - Facebook Inc., et al. v. Software Rights Archive, IPR2013-00478
- Patent expires after institution but prior to final written decision
  - PTAB has applied BRI at institution but Phillips at final written decision
    - Clearwire Corp. and Clear Wireless LLC v. Mobile Telecommunications Technologies LLC, IPR2013-00306

- Patent expires after final written decision but before appeal decision
  - No case with this fact pattern observed yet
  - Fed. Cir. considered similar issue in context of *inter partes* reexamination
    - Facebook Inc. v. Pragmatus AV LLC, 2014 U.S. App. LEXIS 17678, \*3 (Fed. Cir. Sept. 11, 2014)
  - Board applied BRI but Fed. Cir. applied Phillips

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# Post-Grant Resources

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- In Fish & Richardson’s initial 7-part webinar series titled “Challenging Patent Validity in the USPTO,” we explored details regarding several of the post grant tools, with 3 sessions dedicated to Inter Partes Review (IPR), and a final session walking through several hypotheticals, to help listeners understand how these apply to common situations.
- Audio and slides for these webinars are posted online at:  
<http://fishpostgrant.com/webinars/>
- If you listen to these webinars, you will be well positioned to engage in a conversation over whether and when to use those tools and how to defend against them.

- F&R web sites:
  - Post-Grant for Practitioners: <http://fishpostgrant.com/webinars/>
  - General: <http://fishpostgrant.com/>
  - IPR: <http://fishpostgrant.com/inter-partes-review/>
  - PGR: <http://fishpostgrant.com/post-grant-review/>
  - Rules governing post-grant: <http://fishpostgrant.com/>
  - Post-Grant App: <http://fishpostgrant.com/app/>
- USPTO sites:
  - AIA Main: [http://www.uspto.gov/aia\\_implementation/index.jsp](http://www.uspto.gov/aia_implementation/index.jsp)
  - Inter Partes: [http://www.uspto.gov/aia\\_implementation/bpai.jsp](http://www.uspto.gov/aia_implementation/bpai.jsp)

# Thank You!

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