

February 11, 2015

Post-Grant for Practitioners

Estoppel, Broadest Reasonable Interpretation, and Appeals of Institution Decisions

Karl Renner
*Principal, Post-Grant Practice
Co-Chair*

Kevin Greene
Principal



- 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? ... 2nd Wednesday
- Topics? ...
 - Important decisions
 - Developments
 - Practice tips
- Housekeeping
 - CLE
 - Questions
 - Materials
 - <http://fishpostgrant.com/webinars/>

The screenshot shows the website for Fish & Richardson's Post-Grant for Practitioners. The header includes the firm's logo and navigation links for Fishpostgrant.com, Bios, Alerts, Webinars, Case Studies, and App. The main content area features a webinar titled "Estoppel, Broadest Reasonable Interpretation, and Appeals of Institution Decisions". It provides a brief description of the webinar's focus on U.S.C. § 315 and Federal Circuit rulings. A "Register" link is provided for the next program in the series. The date and time are listed as Wednesday, February 11, 2015, from 1:00 PM to 2:00 PM ET, available via the web. Two speakers are introduced: Karl Renner, Principal and Post-Grant Practice Co-Chair in Washington, DC, and Kevin Greene, Principal in Washington, DC. A prominent "REGISTER" button is displayed. Below the button, it states that Fish & Richardson will apply for 1.0 hour of general CLE credit in most states, and users should register with their state bar information. Contact information for Emma Brown is provided. At the bottom, there are four social media and newsletter icons: an envelope for newsletters, a clock for webinar replays, LinkedIn for connecting with the firm, and Twitter for following the firm.



FISH.

- **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

#FishWebinar
@FishPostGrant

- 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

#FishWebinar
@FishPostGrant

Post-Grant Resources

FISH.

- 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
 - Inter Partes: http://www.uspto.gov/aia_implementation/bpai.jsp

Thank You!

#FishWebinar
@FishPostGrant

Karl Renner
*Principal, Post-Grant
Practice Co-Chair*
Washington, DC
Renner@fr.com
202-626-6447

Kevin Greene
Principal
Washington, DC
Greene@fr.com
202-626-6376

© Copyright 2014 Fish & Richardson P.C. These materials may be considered advertising for legal services under the laws and rules of professional conduct of the jurisdictions in which we practice. The material contained in this presentation has been gathered by the lawyers at Fish & Richardson P.C. for informational purposes only, is not intended to be legal advice and does not establish an attorney-client relationship. Legal advice of any nature should be sought from legal counsel. Unsolicited e-mails and information sent to Fish & Richardson P.C. will not be considered confidential and do not create an attorney-client relationship with Fish & Richardson P.C. or any of our attorneys. Furthermore, these communications and materials may be disclosed to others and may not receive a response. If you are not already a client of Fish & Richardson P.C., do not include any confidential information in this message. For more information about Fish & Richardson P.C. and our practices, please visit www.fr.com.