

PTAB Strategies and Insights

April 2019



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The *PTAB Strategies and Insights* newsletter provides timely updates and insights into how best to handle proceedings at the USPTO. It is designed to increase return on investment for all stakeholders looking at the entire patent life cycle in a global portfolio.

This month, we cover three topics:

- We discuss (somewhat tongue in cheek) the murky situation surrounding subject matter eligibility – particularly in light of a recent Federal Circuit decision that appears to contradict recent USPTO guidance regarding 101;
- Three recent precedential decisions provide criteria for a petitioner to change RPI during trial; and
- We explore the USPTO's guidance regarding stays of reissues and reexams during parallel AIA trials.

We welcome feedback and suggestions about this newsletter to ensure we are meeting the needs and expectations of our readers. So if you have topics you wish to see explored within an issue of the newsletter, please reach out to me.

To view our past issues, as well as other firm newsletters, please click [here](#).

Best,
Jason Eisenberg

Editor & Author:



Jason D. Eisenberg
Director

IN THIS ISSUE

[Supreme Court Sua Sponte Reverses Alice... We Wish](#)

[Petitioners Can Change RPI After 315\(b\) Bar Date](#)

[USPTO Provides Guidance on Reissue and Reexam Stays During AIA Trials](#)

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SUPREME COURT SUA SPONTE REVERSES ALICE... *WE WISH*

By: [Jason D. Eisenberg](#)

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By: [Jason D. Eisenberg](#)

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USPTO PROVIDES GUIDANCE ON REISSUE AND REEXAM STAYS DURING AIA TRIALS

By: [Jason D. Eisenberg](#)

The USPTO issued [guidance](#) regarding procedures to stay when reissue or reexaminations are pending during a parallel AIA proceeding. The basic factors that will be considered are:

- Whether the claims challenged in the AIA proceeding are the same as or depend directly or indirectly from claims at issue in the concurrent parallel Office proceeding;
- Whether the same grounds of unpatentability or the same prior art are at issue in both proceedings;
- Whether the concurrent parallel Office proceeding will duplicate efforts within the Office;

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Today the U.S. Supreme Court announced that it is reversing its infamous 2014 decision on patent eligibility in *Alice Corp. v. CLS Bank* and remanding. The court took the action sua sponte without the filing of any motion by either party. After determining that the U.S. Constitution vests within the U.S. Supreme Court the power to change its own final judgment after five years, the Court explained the defect in its original opinion. “The repeated use of the term ‘abstract idea’ in the original opinion doesn’t make sense. Every idea is abstract! And every invention makes use of *some* idea, right?” It remanded the case to the Federal Circuit to devise a clearer test for patent eligibility.

Editor’s note: Happy April Fool’s Day!

We could only wish. Several 101 related decisions have recently been issued by the Federal Circuit, one in particular baffling many readers.

The baffling case in which the patent in suit was found ineligible was [ChargePoint](#), where the patents were directed to electric vehicle charging stations that connected to a network. The claims included “An apparatus, comprising ... a control device ...; a transceiver ... ; and a controller.” Apparently this was not enough to keep it from a 101 challenge and invalidation as the Federal Circuit stated “[b]ut network control is the abstract idea itself” and “a claimed invention’s use of the ineligible concept to which it is directed cannot supply the inventive concept that renders the invention ‘significantly more’ than that ineligible concept.”

Around this same time three cases found subject matter to be eligible: [Endo](#), [Natural Alternatives](#), and [SRI](#). And, one additional case did not: [Trading Technologies](#)

Perhaps most troubling to patent practitioners was reasoning in some of these cases that was contradictory to the [USPTO’s recently released guidelines](#) on this same issue. The USPTO guidelines indicated it was summarizing and compiling the Federal Circuit precedent.

Given the continued murky situation around subject matter eligibility, it looks like we will all be in for more ‘wait and see.’ Meanwhile, several members of [Congress](#) also appear ready to take up this issue.

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The important take away is that unless there are bad acts (e.g., known facts at the time of filing leading a reasonable person to believe the RPI was wrong) a petitioner can change the real party in interest during trial. The Board considered factors such as (1) avoiding 315(b) bar or estoppel rules; (2) prejudice to patent owner as a result of the delay; (3) bad faith; and (4) gamesmanship.

These four decisions do not necessarily go into the underlying RPI determination itself, just the ability to change RPI during trial. An informative decision on the RPI determination itself [Magna](#), discusses the basic agency principles required to show whether an RPI is correct or incorrect – funding, directing, and controlling.

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- Whether the same grounds of unpatentability or the same prior art are at issue in both proceedings;
- Whether the concurrent parallel Office proceeding will duplicate efforts within the Office;
- Whether the concurrent parallel Office proceeding could result in inconsistent results between proceedings (e.g., whether substantially similar issues are presented in the concurrent parallel Office proceeding);
- Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding;
- The respective timeline and stage of each proceeding;
- The statutory deadlines of the respective proceedings;
- Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot.

More interesting, the memo seems to add to the discretionary denial factors stating, “The Board also may deny institution under 35 U.S.C. 325(d) of a requested AIA trial proceeding if a parallel Office proceeding, for example, is in a more advanced stage and involves overlapping issues with the proposed AIA trial proceeding.”

The memo also provides factors for lifting a stay:

- Whether factors considered when ordering the stay (i.e., factors indicating good cause) have changed from when the stay was ordered;
- Whether the patent owner has requested adverse judgment or canceled all claims at issue in the AIA trial proceeding;
- Whether the patent owner is requesting rehearing or appealing the final written decision in the AIA trial proceeding to the Federal Circuit;
- Whether the patent owner agrees to abide by the estoppel provisions set forth in 37 CFR 42.73(d)(3) (i.e., not obtain a claim patentably indistinct from a claim cancelled or found unpatentable during an AIA trial proceeding); and

- Whether lifting the stay would be in the interests of the efficient administration of the Office and integrity of the patent system (cf. 35 U.S.C. 316(b)).

Ultimately, the Office does not believe it is changing any procedures, just summarizing what has already been decided through the years.

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