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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:

- The Federal Circuit further clarifies prior art date for non-patent publications;
- U.S. Patent and Trademark Office Patent Trial and Appeal Board announced three new precedential decisions on RPI and Joinder; and
- U.S. Patent and Trademark Office Patent Trial and Appeal Board issued a final rule regarding institution, sur replies, and presumptions.

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 D. Eisenberg

Editor & Author:

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Director

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Federal Circuit Further Clarifies Prior Art Date for Non-Patent Publications

New Precedential PTAB Decisions

New Final Rules Implementing *SAS*, Removing Presumptions for Petitioner in Certain Circumstances, and Formalizing Sur Replies

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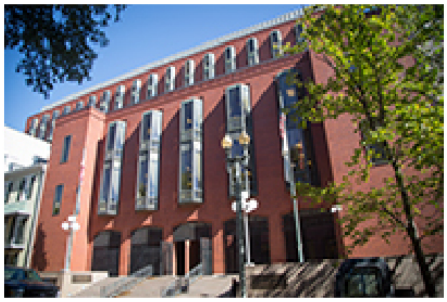
FEDERAL CIRCUIT FURTHER CLARIFIES PRIOR ART DATE FOR NON-PATENT PUBLICATIONS



By: Jason D. Eisenberg

In *Vidstream v. Twitter*, the Federal Circuit affirmed unpatentability of Vidstream's patent in view of a book even though the copyright page of the version submitted had a later copyright date. *Vidstream, LLC. v. Twitter, Inc.,* Case. 2019-00734, 00723 (Fed. Cir. Nov. 25, 2020). The Court stated whether a document is prior art under 35 U.S.C. § 102(a) is a legal determination, based on the specific facts. So it performed both de novo and substantial evidence review. *Id.*, Slip Op. at 5-6.

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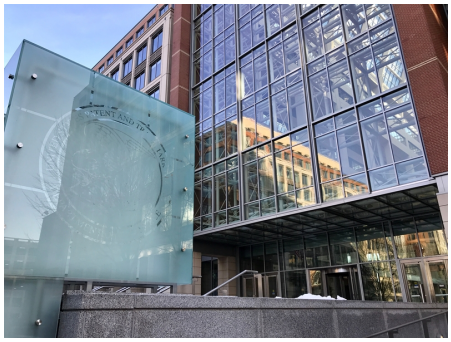
U.S. PATENT AND TRADEMARK OFFICE PATENT TRIAL AND APPEAL BOARD ANNOUNCED THREE NEW PRECEDENTIAL DECISIONS ON RPI AND JOINDER



By: Jason D. Eisenberg

The U.S. Patent and Trademark Office Patent Trial and Appeal Board has elevated three panel decisions to precedential this month.

- *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 (Oct. 2, 2020) (precedential)
- *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 (Oct. 6, 2020) (precedential)
- *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (Oct. 28, 2020) (precedential)

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U.S. PATENT AND TRADEMARK OFFICE ISSUES FINAL RULES AND COMMENTS IMPLEMENTING *SAS*, REMOVING PRESUMPTIONS FOR PETITIONER IN CERTAIN CIRCUMSTANCES, AND FORMALIZING SUR REPLIES

By: Jason D. Eisenberg

The U.S. Patent and Trademark Office Patent Trial and Appeal Board issued a final rule regarding institution, sur replies, and presumptions.

First, the Board changes 37 C.F.R. §§ 42.108 and 42.208 to implement *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018) by noting that "the Board will authorize the review to proceed on

all of the challenged claims and on all grounds of unpatentability asserted for each claim." And these rules also state "the Board may deny all grounds for unpatentability for all of the challenged claims." Finally, all presumptions in favor of petitioner for patent owner evidence submitted with a patent owner preliminary response have been removed from the rules.

A final major change is a formalization of the sur reply and its formatting. This can be found in rules §§ 42.23 and 42.24.

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Finally, the Court also addressed the timeliness of Twitter's evidence because it was not submitted with the Petition. Vidstream provided many arguments as to untimeliness, the Board acting improperly in considering the alleged late-filed evidence, that Vidstream had no fair opportunity to respond, and that the Board failed to grant a motion to exclude. *Id.,* Slip Op. at 6-8. Without much explanation for why the evidence did not need to be submitted with the Petition, the Court held "[w]e conclude that the Board acted appropriately, for the Board permitted both sides to provide evidence concerning the reference date of the Bradford book, in pursuit of the correct answer." *Id.,* Slip Op. at 8.

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***RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 (Oct. 2, 2020) (precedential)**

RPX focuses on real party in interest and the 35 U.S.C. § 315(b) time bar. Here, the Chief, Deputy Chief, and Vice Chief Judge of the Board issued the decision. In terminating and IPR, the Board noted that the Federal Circuit remanded this case after holding the petitioner was time-barred because the petitioner's client was an unnamed real party-in-interest that had been served with an infringement complaint more than one year before filing the petition.

***SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 (Oct. 6, 2020) (precedential)**

SharkNinja also focuses on real party in interest. Here the Board instituted and held that it does not need to resolve real party in interest if that decision does not impact the Board's institution decision. The Board held the parties need to provide the real party(ies) in interest in good faith.

***Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (Oct. 28, 2020) (precedential)**

This case focuses on joinder petition. The USPTO stated "This decision denying institution and the petitioner joinder motion applies the factors set forth in *General Plastic* to a copycat petition that the petitioner filed against the challenged patent after its first petition was denied institution."

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