

# PTAB Strategies and Insights

February 2021



VISIT WEBSITE

CONTACT US

SUBSCRIBE

FORWARD TO A FRIEND

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.

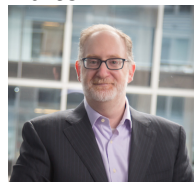
This month we cover:

- An excellent overview of the latest printed publication jurisprudence and a reminder that the Board is bound by the APA; and
- Time-bar challenges under 35 U.S.C. § 315(b) by reviewing *Acoustic Technology, Inc. v. Itron Networked Solutions, Inc.*

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.

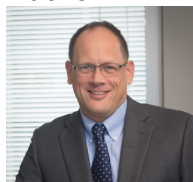
Best,  
 Jason D. Eisenberg

**Editor:**



**Jason D. Eisenberg**  
 Director  
[jason@sternekessler.com](mailto:jason@sternekessler.com)

**Author:**



**Jon E. Wright**  
 Director  
[jwright@sternekessler.com](mailto:jwright@sternekessler.com)

**Author:**



**Kathleen Wills**  
 Associate  
 (licensed only in MD and supervised by D.C. Bar member Dallin Glenn)  
[kwills@sternekessler.com](mailto:kwills@sternekessler.com)

**IN THIS ISSUE**

[M&K Holdings v. Samsung](#)

[Acoustic Technology, Inc. v. Itron Networked Solutions, Inc., 949 F.3d 1366 \(Fed. Cir. 2020\)](#)

**DOWNLOAD**

## M&K Holdings v. Samsung

By: [Jon E. Wright](#)

Samsung sought *inter partes* review of M&K's U.S. Patent No. 9,113,163. The Board held all claims unpatentable. M&K appealed, arguing that the Board erred by relying on references that do not qualify as prior art printed publications under 35 U.S.C. § 102. In addition, M&K argued that the Board erred by finding claim 3 anticipated when the petition for *inter partes* review asserted only obviousness as to that claim. The Court affirmed the Board's decision with respect to the printed-publication issue, holding that the Board's decision was supported by substantial evidence. But the Court agreed with M&K with respect to claim 3 and vacated and remanded the Board's decision. This case provides an excellent overview of the latest printed publication jurisprudence and a reminder that the Board is bound by the APA.



[Read More](#)

## Acoustic Technology, Inc. v. Itron Networked Solutions, Inc., 949 F.3d 1366 (Fed. Cir. 2020)

By: Kathleen Wills

Acoustic sued Itron for infringement of its patent, and the two parties settled, with Itron taking a license to the patent. Acoustic later sued Silver Spring for infringement. Silver Spring petitioned for *inter partes* review (IPR) of the patent, while also discussing a potential merger with Itron. The Patent Trial and Appeal Board subsequently instituted review, and Silver Spring and Itron completed their merger. The Board ruled against Acoustic.

[Read More](#)

The information contained in this newsletter is intended to convey general information only, and should not be construed as a legal opinion or as legal advice. Sterne, Kessler, Goldstein & Fox P.L.L.C. disclaims liability for any errors or omissions, and information in this newsletter is not guaranteed to be complete, accurate, and updated. Please consult your own lawyer regarding any specific legal questions.

© 2021 Sterne, Kessler, Goldstein & Fox P.L.L.C

[Click Here](#) to opt-out of this communication

**Technical Minds. Legal Muscle.**

# PTAB Strategies and Insights

February 2021



[VISIT WEBSITE](#)

[CONTACT US](#)

[SUBSCRIBE](#)

[FORWARD TO A FRIEND](#)

## M&K Holdings v. Samsung

By: [Jon E. Wright](#)

Samsung sought *inter partes* review of M&K's U.S. Patent No. 9,113,163. The Board held all claims unpatentable. M&K appealed, arguing that the Board erred by relying on references that do not qualify as prior art printed publications under 35 U.S.C. § 102. In addition, M&K argued that the Board erred by finding claim 3 anticipated when the petition for *inter partes* review asserted only obviousness as to that claim. The Court affirmed the Board's decision with respect to the printed-publication issue, holding that the Board's decision was supported by substantial evidence. But the Court agreed with M&K with respect to claim 3 and vacated and remanded the Board's decision. This case provides an excellent overview of the latest printed publication jurisprudence and a reminder that the Board is bound by the APA.

### Public accessibility of printed publications is highly fact-dependent

On the printed publication issue, Samsung's petition relied on three references – WD4-v3, Park, and Zhou. These documents were generated in connection with the work of a joint industry standard-setting task force. The task force consisted of representatives from technology companies, universities, and research institutions. It held quarterly meetings at which members submit and discuss input documents that propose changes to the standards. If the task force members agree to the proposed changes, those changes are incorporated into a working-draft document. WD4-v3 is a working-draft document, while Park and Zhou are input documents. All three references were uploaded to the task force's website before the earliest priority date of the '163 patent. M&K challenged whether WD4-v3, Park, and Zhou constituted printed publications under 35 U.S.C. § 102. M&K contended that none of the three references were publicly accessible, i.e., that interested persons of ordinary skill could not have accessed any of those references by exercising reasonable diligence.

Whether a reference qualifies as printed publication under §102 is a question of fact and the Court determined that substantial evidence supported the Board's decision. In affirming, the Court recognized two separate lines of cases dealing with public accessibility. One line of cases relates to the presentation of documents at a conference, trade show, or group meeting. Another line of cases relates to documents that are available in a repository, whether on the Internet or at a brick-and-mortar location such as a library.

Synthesizing those lines of cases, the Court found the following Board findings to be relevant: (1) Park and Zhou, were presented at task force development meetings, (2) those meetings were attended by between 200 and 300 interested persons, (3) the conferees had discussed Park and Zhou at the meetings, (4) the task force meeting reports summarized the Park and

Zhou discussions, (5) those discussions and summaries were conducted without any expectation of confidentiality, (6) full copies of the Park and Zhou references were made available to interested persons by no later than the time of the development meetings, (7) distribution of the documents was accomplished through the public taskforce website, which hosted downloadable copies of the Park and Zhou references, (8) the task force had a policy that input documents should be uploaded before development meetings “to ensure that [they are] available for review by other participants,” and (9) the task force meeting reports directed readers to the task force’s website, and (10) the Board found that the taskforce website had title-search functionality and that the Park and Zhou references had descriptive titles, thus enabling routine searching of those references by subject matter. More generally, the Board also found that the task force was prominent in the community, such that its activity was reported in a highly influential trade journal. The Board thus found that skilled artisans would have learned of the task force website by word of mouth or upon the endorsement of other prominent organizations, and would have been motivated to track the task force website to ensure that their products and services were consistent with the developing standards.

M&K’s arguments on appeal centered on the structure and search capabilities of the task force website. But against the wealth of evidence recited above, the Court found those arguments unpersuasive. The Court explained that “M&K’s argument emphasizing the lack of full-content-search capability on the JCT-VC website also misses the mark. A factor relevant to public accessibility is whether a repository indexes its documents or otherwise categorizes them by subject matter.” It was thus sufficient that the documents in question on the meeting pages of the task force website were effectively indexed by subject matter, that the website had title-search functionality, and that Park and Zhou featured descriptive titles.

This case highlights the fact that public accessibility is highly fact-dependent. A party seeking to prove the public accessibility of a printed publication should advance as many supporting facts as possible in its petition. If the Board is convinced, it will likely be affirmed on appeal given the substantial-evidence standard of review.

### **The Board cannot find a claim to have been anticipated if the petition advances only an obviousness ground.**

M&K’s second argument on appeal is that the Board committed procedural error when it held claim 3 unpatentable based on anticipation when Samsung’s petition challenged claim 3 only on a theory of obviousness. M&K argued that the Board’s reliance on anticipation deprived it of the notice it was due with respect to the ground on which the Board held claim 3 unpatentable. Samsung argued, in response, by framing the Board’s analysis as a simpler path to invalidating claim 3, and that the anticipation result was inherent in Samsung’s obviousness theory because a reference that anticipates a claim also renders that claim obvious. Samsung argued that M&K was on notice of the prior art the Board used to invalidate claim 3, and therefore was not denied notice of the ground on which the Board held that claim unpatentable.

The Court agreed with M&K. It observed that “[i]n a formal adjudication, such as an *inter partes* review, the Administrative Procedure Act (“APA”) imposes particular procedural requirements on the Board.” To comply, the Court said, “[t]he Board must timely inform the patent owner of ‘the matters of fact and law asserted’ and ‘give all interested parties the opportunity to submit and consider facts and arguments.’” The key question, according to the Court, is whether “the Board departed markedly from the evidence and theories presented by the petition or institution decision, creating unfair surprise.” After reviewing the facts, the Court found the Board’s anticipation result to be inconsistent with Samsung’s own arguments, and thus a marked departure from Samsung’s petition to which M&K did not have the opportunity to respond.

The information contained in this newsletter is intended to convey general information only, and should not be construed as a legal opinion or as legal advice. Sterne, Kessler, Goldstein & Fox P.L.L.C. disclaims liability for any errors or omissions, and information in this newsletter is not guaranteed to be complete, accurate, and updated. Please consult your own lawyer regarding any specific legal questions.



# PTAB Strategies and Insights

February 2021



[VISIT WEBSITE](#)

[CONTACT US](#)

[SUBSCRIBE](#)

[FORWARD TO A FRIEND](#)

## **Acoustic Technology, Inc. v. Itron Networked Solutions, Inc., 949 F.3d 1366 (Fed. Cir. 2020)**

By: Kathleen Wills

Acoustic sued Itron for infringement of its patent, and the two parties settled, with Itron taking a license to the patent. Acoustic later sued Silver Spring for infringement. Silver Spring petitioned for *inter partes* review (IPR) of the patent, while also discussing a potential merger with Itron. The Patent Trial and Appeal Board subsequently instituted review, and Silver Spring and Itron completed their merger. The Board ruled against Acoustic.

On appeal, Acoustic asserted that the IPR was time-barred under 35 U.S.C. § 315(b). This provision provides that an IPR may not be instituted if the petition is filed more than one year after the date on which “the petitioner, real party in interest, or privy of the petitioner” is served with a complaint alleging patent infringement. Specifically, Acoustic argued that Itron became a real party in interest before the petition was filed because Itron discussed merging with Silver Spring. Acoustic also argued that the Board had post-institution authority to reevaluate § 315(b) when a real party in interest arises to prevent parties from waiting to initiate corporate deals until after institution to avoid time-bar challenges. Itron countered that Acoustic waived this challenge by not raising it before the Board and that Itron was not a real party in interest because it did not merge with Silver Spring until after the Board instituted the IPR. Itron also argued that the Board lacked authority to reevaluate the provision after institution.

The Federal Circuit held that, if it allowed Acoustic’s challenge for the first time on appeal, it would provide appellants with the unfair advantage of allowing them to wait for the Board’s decision on the merits and, if unfavorable, to challenge the Board’s jurisdiction on appeal. Since Acoustic knew about the merger months before the Board issued its final written decision, Acoustic’s failure to provide any reason for its untimely § 315(b) challenge deprived the court “of the benefit of the [Board’s] informed judgment.”

The Federal Circuit declined to decide whether the Board has the “authority or obligation” to reevaluate this statutory provision post institution. While this decision did not resolve whether pre-merger activities render a party a real party in interest, the court reiterated that real parties in interest include relationships arising before institution and those arising after a petition is filed. The court stated that it maintains “case-by-case” discretion over whether to apply waiver.

Since time-bar challenges under 35 U.S.C. § 315(b) are not immune from waiver, parties should raise this issue before the Board.

## RELATED CASE

- *Power Integrations, Inc. v. Semiconductor Components Indus.*, 926 F.3d 1306 (Fed. Cir. 2019) (the real-party-in-interest determination includes relationships arising after the petition is filed and before institution).

---

*This article first appeared in the [Federal Circuit Appeals from the PTAB and ITC: Summaries of Key 2020 Decisions](#) report.*

The information contained in this newsletter is intended to convey general information only, and should not be construed as a legal opinion or as legal advice. Sterne, Kessler, Goldstein & Fox P.L.L.C. disclaims liability for any errors or omissions, and information in this newsletter is not guaranteed to be complete, accurate, and updated. Please consult your own lawyer regarding any specific legal questions.

© 2021 Sterne, Kessler, Goldstein & Fox P.L.L.C

[Click Here](#) to opt-out of this communication

**Technical Minds. Legal Muscle.**