

PTAB Strategies and Insights

January 2020



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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 you will find three articles covering:

- A discussion of the chaos that has emerged at both the PTAB and the Federal Circuit in the wake of the Federal Circuit's decision in *Arthrex* and the Supreme Court's refusal to pick-up any of the cases that could help clarify its *Alice* decision;
- A review of *Personal Audio v. CBS Corp.* in which the Federal Circuit upheld a district court dismissal of a jury verdict because the patent was *later* invalidated at the PTAB;
- A preview and link to our appellate practice's annual round-up of the most important PTAB cases decided on appeal at the Federal Circuit.

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:

Author:

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CHAOS ALL AROUND - ARTHREX AND ALICE

By: [Jason D. Eisenberg](#) and [Lestin L. Kenton, Jr.](#)

The only real answers we are hearing from the patent community is that no one knows what to do or what might happen next --- post Arthrex.

As a quick reminder – the Federal Circuit ruled (1) the current PTAB judges were unconstitutionally appointed but (2) the Court could cure that by striking a small sentence in the statute.

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IPR KILLS ANOTHER JURY VERDICT

By: [Jason D. Eisenberg](#)

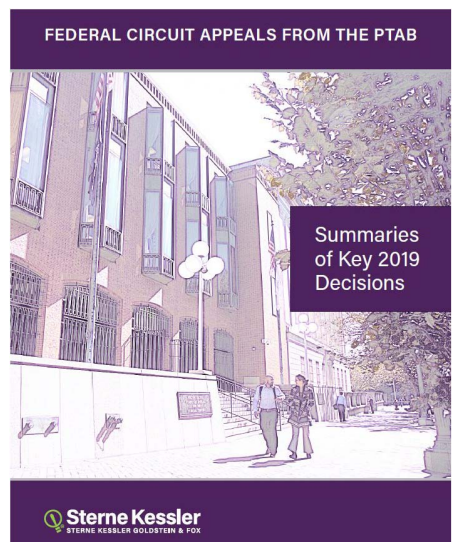
In *Personal Audio*, the Federal Circuit upheld a district court judgment dismissal of a jury verdict for patent owner throwing out a \$1.3 million judgement because the patent was *later* invalidated at the PTAB. Patent owner argued that “overturning the verdict of a jury with a later IPR proceeding” was unconstitutional and that “the IPR should not be given collateral estoppel effect.”

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FEDERAL CIRCUIT APPEALS FROM THE PTAB: SUMMARIES OF KEY 2019 DECISIONS

Our annual round-up of the most important decisions at the Federal Circuit related to PTAB proceedings is now available in print and electronic formats. You can find the electronic version at [this link](#). Please contact me or send an email to info@sternekessler.com if you would like a print copy of the report.

Finally, be on the lookout for our round-up of all developments at the PTAB – slated to be published electronically and in print form next month.



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The only real answers we are hearing from the patent community is that no one knows what to do or what might happen next --- post Arthrex.

As a quick reminder – the Federal Circuit ruled (1) the current PTAB judges were unconstitutionally appointed but (2) the Court could cure that by striking a small sentence in the statute.

As simple and easy as that sounds – not all the Court agrees with this panel’s ruling.

And while the U.S. government has vowed to challenge the ruling as far as they can go because the panel is wrong, the USPTO appears to disagree with the U.S. government and has decided the ruling cures all ails and they can continue with all pending trials without skipping a beat.

For practitioners and parties, the result has been nothing but chaos.

Some Federal Circuit panels have remanded cases regardless of whether issues were raised or the stage of the proceeding – including reexaminations and PTAB proceedings.

Other panels have found the Arthrex panel’s remedy to be incorrect – so they march on with their cases and want to hear what other remedies are available for consideration.

Some panels are finding the issues waived if not raised at the PTAB or in opening briefs. Others find the change of law allows the issued to be raised at any time.

The Arthrex parties are requesting en banc review, and many amicus are lining up to weigh in.

The fight for what to do with pending AIA proceedings, reexaminations, and appeals is also being waged at the USPTO. Motions to stay, to terminate and other remedies are being filed both as PTAB pleadings and Rule 181 petitions at the Commissioner’s doorstep, as well as in other appeal proceedings at the Board. Some parties are discussing bring suit against the USPTO under the Administrative Procedure Act (APA) in district court to either stay or terminate their pending proceedings at the Board.

Some are mounting a grass roots campaign for Precedential Opinion Panel (POP) review or Commissioner review. What everyone seems to question is – without a Federal Circuit mandate

– how can the USPTO rightly hold trials since their unconstitutionality has not yet been cured. Additional questions circle around how the U.S. government can disagree with the Arthrex panel remedy while the USPTO seems to find it acceptable. Are the two bodies in direct contradiction?

While we strive to provide benchmark advice and thought leadership recommendations – we are left in the same limbo as others. Look out for our further analysis and critical review of positions over the coming months.

In other news creating chaos in the practice --- the Supreme Court ignored the recommendation of the Solicitor General and denied cert for several cases, including *HP Inc. v. Berkheimer*, *Hikma Pharmas v. Vanda Pharmas*, *Athena Diagnostics, Inc. v. Mayo Collaborative*, *ChargePoint*, and *Trading Technologies* requesting the Court clarify *Alice* and patentable subject matter.

2020 promises to be a particularly interesting and pivotal year in the evolution and maturation of the PTAB. And we look forward to bringing clarity to the chaos as the year proceeds.

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