

PTAB Strategies and Insights

June 2019



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Dear ,

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 two topics and direct your attention to two recent alerts from Sterne Kessler:

- We discuss the Supreme Court decision that the government cannot bring AIA challenges because they are not persons under the law;
- We discuss the expansion of St Regis to all state owned patents where states, like tribes, cannot use sovereign immunity to bar AIA actions;
- We highlight a recent firm alert regarding 315b issues arising from post filing RPI status changes;
- We highlight a recent firm alert summarizing recent 101 legislations and hearings, which may lead to real patent reform on patentable subject matter.

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:

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Summary of 101 Congressional Testimony for May 22nd 101 Reform

DOWNLOAD



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SUPREME COURT ELIMINATES GOVERNMENT AS A PARTY WHO CAN FILE AIA ACTION AT PTAB



By: [Jason D. Eisenberg](#)

In [Return Mail, Inc. v. U.S. Postal Serv.](#), 17-1594, Justice SOTOMAYOR wrote for the majority to overturn a Federal Circuit decision that the U.S. Postal Service had standing to petition for covered business method review.

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STATES MUST FACE IPR CHALLENGES SIMILAR TO TRIBES

By: [Jason D. Eisenberg](#)

In [Regents of the Univ. of Minn. v. LSI Corporation](#), Fed. Cir., No. 18-01559, the Federal Circuit extended the inability to stand behind 11th Amendment Sovereign Immunity to patents owned by individual states, such that they can be cancelled via inter partes review (IPR). [Robert Greene Sterne](#) also recently [published](#) on this case.

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FEDERAL CIRCUIT CLARIFIES THAT A POST-FILING CHANGE IN RPI STATUS CAN TRIGGER THE §315(b) TIME-BAR



As Sterne Kessler [recently reported](#), On June 13, 2019, the Court of Appeals for the Federal Circuit (“CAFC”) vacated a final written decision by the Patent Trial and Appeal Board (“Board”) in an inter partes review (“IPR”) proceeding as time-barred under 35 U.S.C. § 315(b) because of a change in privity and real party in interest (“RPI”) status arising after the petition filing but before institution. The Court also found that issue preclusion did not bar the patent owner’s appeal of the Board’s § 315(b) determination. Both aspects of this decision are important to those facing or considering filing petitions for IPR.

SUMMARY OF 101 CONGRESSIONAL TESTIMONY FOR MAY 22nd 101 REFORM

According to our "[IP Hot Topic](#)" alert published earlier this week, on May 22, 2019, U.S. Senators Thom Tillis (R-NC) and Chris Coons (D-DE), Chair and Ranking Member of the Senate Judiciary Subcommittee on Intellectual Property, and Representative Doug Collins (R-GA-9), Ranking Member of the House Judiciary Committee, Hank Johnson (D-GA-4), Chairman of the House Judiciary Subcommittee on Intellectual Property and the Courts, and Steve Stivers (R-OH-15) released a bipartisan, bicameral draft bill that would reform §101 of the Patent Act. The draft bill text comes after the Senate Judiciary Subcommittee received feedback from stakeholders, industry representatives, and individual inventors after releasing its §101 reform framework back in April and initiated three days of testimony this month on much needed reform. The alert provides a digest of both the draft bill and the subsequent testimony.

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SUPREME COURT ELIMINATES GOVERNMENT AS A PARTY WHO CAN FILE AIA ACTION AT PTAB

In [Return Mail, Inc. v. U.S. Postal Serv., 17-1594](#), Justice SOTOMAYOR wrote for the majority to overturn a Federal Circuit decision that the U.S. Postal Service had standing to petition for covered business method review. The Supreme Court stated that the AIA lacks a definition for “a person” and thus interpreted this term in the statute to mean a person or a company, but not the government. In doing so, the Court distinguished the ability of the government to pursue patents and ex parte reexamination from being able to be third-party challenger in an adversarial proceeding. Justice BREYER filed a dissenting opinion joined by Justices GINSBURG and KAGAN.

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