

PTAB Strategies and Insights

September 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 we cover:

- How the Federal Circuit treats APA challenges differently;
- The Federal Circuit's recent reissue of its original March 2020 decision in *Facebook v. Windy City*; and
- We look at two recent exemplary cases that are illustrative of current trends for petitioner estoppel.

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

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DOES THE FEDERAL CIRCUIT TREAT APA CHALLENGES DIFFERENTLY IF BROUGHT BY PETITIONER VS. PATENT OWNER? YES.

By: [Karen Wong-Chan](#), [Trent W. Merrell](#), and [Jason D. Eisenberg](#)

Last month's [newsletter](#) discussed *Alacritech, Inc. v. Intel Corp*, where **patent owner** Alacritech appealed a final written decision (FWD) of the Patent Trial and Appeal Board ("Board") for *inter partes* review (IPR) IPR2017-01410 alleging Administrative Procedure Act (APA) violations—**and won**. This month we compare that decision to *FanDuel, Inc. v. Interactive Games LLC*, where **petitioner** FanDuel appealed a FWD of IPR2017-01491 alleging similar APA violations—**and lost**.

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By: [David W. Haars](#) and [Jason D. Eisenberg](#)

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By: [Sean C. Flood](#) and [Jason D. Eisenberg](#)

This month we first refresh our readers on *Shaw* and *SAS*, and then we will look at two recent exemplary cases that we feel are illustrative of the current trends for petitioner estoppel.

We will show that the trend in the district courts for 35 U.S.C. §§ 315(e) and 325(e) estoppel analysis generally follows a two prong inquiry — *first*, whether the petitioner



knew of the references (i.e., subjective prong), and *second*, whether a skilled searcher reasonably could have discovered the references through a diligent search (i.e., objective prong).

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In both cases, appellant essentially argued the Board raised and answered its own issues in the FWD without addressing issues raised by either appellee (*FanDuel*) or both parties (*Alacritech*). Yet the Court rendered opposite decisions. So we ask—are these outcomes due to different burdens and requirements on petitioners and patent owners? No in *Alacritech* and yes in *FanDuel*. We discussed *Alacritech* last month. This month we focus on *FanDuel* and petitioner appeals.

In *FanDuel*, the Board found all challenged claims unpatentable except claim 6.[i] FanDuel's appeal alleged that the Board violated the APA because the Board's obviousness findings for claim 6 were not based on issues that the patent owner raised during the proceeding. FanDuel also argued that, because the Board based its decision on Board-raised issues, FanDuel was entitled to notice and an opportunity to respond before the Board could issue a FWD.

The Federal Circuit disagreed with FanDuel and affirmed the Board. Judge Hughes held that under the APA "the petitioner shall have the burden of proving a proposition of unpatentability." [ii] The Federal Circuit further determined that "the Board complied with the APA and its obviousness findings are supported by substantial evidence." [iii]

First, the Court held that different standards of proof are required to institute an IPR versus to invalidate a patent. The different standards allow the Board to adopt an initial view versus a final decision without notifying the parties. To institute an IPR, the Board needs only a reasonable likelihood that a petitioner will succeed. But to invalidate a patent, the petitioner has the burden of proving a proposition of unpatentability by a preponderance of evidence. [iv]

Second, the Court held that "because the IPR petitioner is the party seeking an order from the Board, § 556(d) [of the APA] requires the petitioner to bear the burden of persuasion." [v] FanDuel asserted in its petition that claim 6 was obvious in view of a three-reference

combination. Patent owner did not have to submit any response to a petition before or after institution.[vi] So to require patent owner to develop a post-institution record, e.g., on whether claim 6 is rendered obvious, “effectively and impermissibly” shifts the burden of persuasion to the patent owner to defend a claim’s patentability. [vii]

Finally, because petitioners and patent owners have different burdens of persuasion to bear, the APA was not violated by the Board confirming the claim even under its own theories.

In contrast, as discussed in last month’s article, the Court in *Alacritech* held that under the APA “[the Federal Circuit’s] review of a patentability determination is confined to ‘the grounds upon which the Board actually relied.’”[viii] And that under the APA “the agency [has an]... obligation to develop an evidentiary basis for its findings.”[ix] The Board’s FWD was vacated and remanded because it did not “articulate a satisfactory explanation for its action including a rational connection between the facts found and the choice made.”[x]

Summary: In an IPR, the burden of persuasion is borne by the petitioner whose petition defines the scope of litigation from institution to final decision. The patent owner’s responses are optional and do not limit the issues the Board can address in the FWD when finding a claim valid. Yet the Board is always obligated to articulate a satisfactory explanation when invalidating a claim.

[i] *FanDuel, Inc. v. Interactive Games LLC*, No. IPR2017-01491, 2018 WL 6112966 (P.T.A.B. Nov. 20, 2018).

[ii] 35 U.S.C. § 316(e).

[iii] *FanDuel, Inc. v. Interactive Games LLC*, 966 F.3d 1334 (Fed. Cir. 2020).

[iv] *See In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1376 (Fed. Cir. 2016) (“[T]he decision to institute and the final written decision are ‘two very different analyses,’ and each applies a ‘qualitatively different standard.’” (quoting *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016))).

[v] *See Magnum Oil*, 829 F.3d at 1375 (stating that the petitioner bears the burden to prove unpatentable the challenged claims); *see also Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 (Fed. Cir. 2018.)

[vi] 37 C.F.R. §§ 42.107(a).

[vii] *See Magnum Oil*, 829 F.3d at 1376 (“[I]t is inappropriate to shift the burden to the patentee after institution to prove that the patent is patentable.”); *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (“In an inter partes review, the burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence,’ 35 U.S.C. § 316(e), and that burden never shifts to the patentee.”).

[viii] *Alacritech, Inc. v. Intel Corp.*, 966 F.3d 1367, 1372 (Fed. Cir. 2020) (citing *TQ Delta v. Cisco Sys., Inc.*, 942 F.3d 1352, 1358 (Fed. Cir. 2019) (quoting *Power Integrations, Inc. v. Lee*, 797 F.3d 1318, 1326 (Fed. Cir. 2015))).

[ix] *Id.* (quoting *Lee*, 277 F.3d at 1344).

[x] *Id.* at 1373 (citing *In re NuVasive, Inc.*, 842 F.3d 1376, 1382 (quoting *Motor Vehicle Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43 (1983))).

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In *Windy City I*, the court held that “the Board erred in allowing Facebook to join itself to a proceeding in which it was already a party, and also erred in allowing Facebook to add new claims to the IPRs through that joinder.”[iv] A month after this decision, the Supreme Court issued its *Thryv* decision, which held that § 314(d) precludes judicial review of many institution phase issues, including the PTO's application of § 315(b)'s one year time-bar. In view of *Thryv*, the Federal Circuit invited the *Windy City I* parties to brief the issue of whether § 314(d) also precludes judicial review of the PTO's application of joinder under § 315(c). In *Windy City II*, the court held that it had “jurisdiction to review the Board's joinder decisions in this case to determine whether the Board (on behalf of the Director) acted outside any statutory limits under § 315(c).”[v]

In *Windy City I*, the Federal Circuit held that the clear and unambiguous language of § 315(c) does not allow same-party or new issue joinder. The court held that the Director's authority under the statute to join “any person” as a party to an inter partes review does not refer to “persons who were already parties.” [vi] The court reasoned that “[i]t would be an extraordinary usage of the term ‘join as a party’ to refer to persons who were already parties.” [vii] The court held that the Board's conclusion in *Proppant*[viii] allowing same-party joinder was thus “incorrect under the unambiguous meaning of the statute.” [ix] The court further held that § 315(c) does not authorize a joined party “to bring new issues from its new proceeding into the existing proceeding.” [x] According to the court, this is because “the language in 315(c) does no more than authorize the Director to join 1) a person 2) as a party, 3) to an already instituted IPR.”[xi]

In the supplemental briefing, **Facebook** argued that, because § 315(c) requires a request for joinder to be accompanied by a petition for IPR, “Windy City’s attack on joinder is that the follow-on IPRs should not have been instituted at all.” [xii] Facebook argued that § 314(d) thus precludes judicial review of Board joinder. The **PTO** took a narrower approach, arguing that § 314(d) does not preclude all judicial review of Board joinder, but only where a petition filed with a request for joinder would otherwise have been untimely.[xiii] Conversely, **Windy City** argued that § 314(d) does not preclude judicial review because the Board’s joinder decisions are “a separate procedural process with separate requirements and a different purpose than institution.” [xiv] Windy City further argued that its appeal challenged the issue of whether the Board “exceeded the scope of its statutory authority under § 315(c) by granting Facebook’s motions for joinder.” [xv]

The Federal Circuit agreed with Windy City.

In *Windy City II*, the Federal Circuit determined that § 314(d) did not overcome the “strong presumption” favoring judicial review of joinder decisions under 315(c).[xvi] The court reasoned that § 315(c) requires two separate determinations: (1) whether the joinder applicant’s petition for IPR “warrants” institution under § 314, and (2) whether the applicant should be joined “as a party” to the inter partes review (i.e., the “joinder decision”).[xvii] Citing *Thryv*, the court stated that it may not review the first determination, whether for timeliness or to consider whether the petitioner is likely to succeed on the merits.[xviii] But the court held it could review the second determination because “the statute makes clear that the joinder decision is made after a determination that a petition warrants institution, thereby affecting the manner in which an IPR will proceed.”[xix] The court determined that nothing in § 314(d), nor any other statute, overcomes the strong presumption that it has jurisdiction to review the joinder decision, which is a “separate and subsequent decision to the institution decision.”[xx]

The court further reasoned that Windy City’s appeal was akin to the reviewable challenge in *SAS* because it “concerned whether the PTO had exceeded its statutory authority as to the manner in which the already-instituted IPR proceeded.”[xxi] On the same note, the court held that Windy City’s appeal was unlike the unreviewable challenges in *Cuozzo* and *Thryv* because, unlike here, those challenges “specifically sought review of petitions that the Board had instituted and the decisions to institute those petitions, which therefore were barred by § 314(d).”[xxii]

Having found that it had jurisdiction to review the Board’s decision, the Federal Circuit maintained its *Windy City I* decision in *Windy City II*, reaffirming that the Board erred in implementing same-party and new issue joinder.[xxiii] The court thus vacated-in-part the Board’s decision regarding the claims that were added through the improper joinder. With respect to those claims, the court remanded to the Board, in order for the Board to consider whether the termination of the instituted proceedings related to the two late-filed petitions finally resolves those proceedings.

It would appear Facebook is not left with many options, as any issues that could have been raised in its first petition for rehearing or en banc may be waived. A cert petition to the Supreme Court may be the only hope for further review of these issues. Assuming the Supreme Court will not take up the issue of which institution stage issues are appealable after just deciding *Thryv*, it appears the Federal Circuit may have effectively killed same-party and new issue joinder going forward. Questions will remain whether *Proppant* is good law since the *Windy City II* decision maintained the Federal Circuit’s “additional views” that the Precedential Opinion Panel (POP) decision in *Proppant* is not entitled to any deference.[xxiv]

[i] *Thryv, Inc v. Click-To-Call Techs., LP*, 140 S. Ct. 1367 (2020).

[ii] *Facebook, Inc. v. Windy City Innovations, LLC*, 953 F.3d 1313, 1318 (Fed. Cir. 2020).

[iii] *Facebook, Inc. v. Windy City Innovations, LLC*, Appeal No. 2018-1400, 2020 WL 5267975, (Fed. Cir. Sept. 4, 2020).

[iv] *Windy City I*, at 1318.

[v] *Windy City II*, at 7.

[vi] *Windy City I*, at 1324.

[vii] *Id.*

[viii] *Proppant Express Invs., LLC v. Oren Techs., LLC*, No. IPR2018-00914, Paper 38 (P.T.A.B. Mar. 13, 2019).

[ix] *Windy City I*, at 1324.

[x] *Id.*, at 1325.

[xi] *Id.*

[xii] *Windy City II*, at 6.
[xiii] *Id.*
[xiv] *Id.*
[xv] *Id.*
[xvi] *Id.*
[xvii] *Id.*
[xviii] *Id.*
[xix] *Id.*
[xx] *Id.*
[xxi] *Id.*, at 7.
[xxii] *Id.*
[xxiii] *Id.*, at 12.
[xxiv] *Id.*, at 20.

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We will show that the trend in the district courts for 35 U.S.C. §§ 315(e) and 325(e) estoppel analysis generally follows a two prong inquiry – *first*, whether the petitioner knew of the references (i.e., subjective prong), and *second*, whether a skilled searcher reasonably could have discovered the references through a diligent search (i.e., objective prong).

Background - Shaw and SAS

In *Shaw Indus. Grp., Inc. v. Automated Creel Sys., Inc.*[i], the Federal Circuit held since the “IPR does not begin until it is instituted,” only arguments made after institution are made “during” that IPR. Therefore, petitioner estoppel did not apply to non-instituted grounds.[ii]

After *Shaw*, the Supreme Court issued its *SAS Inst., Inc. v. Iancu*[iii] decision holding that the Board could not continue its practice of partial institutions, finding that 35 U.S.C. § 318(a) means the Board’s institution decision “must address every claim the petitioner has challenged.” But the Court did not explicitly rule that the Board must “institute” review on every ground asserted in the petition. Nonetheless, the Federal Circuit later observed that “[e]qual treatment of claims and grounds for institution purposes has pervasive support in SAS.”[iv] And the Board has effectively stopped the practice of having non-instituted grounds.[v] For example, if a majority of grounds should fail, the Board has denied institution on the entire petition. On the other hand, if a minority of the grounds should fail, the Board has instituted the petition and noted which grounds were strong and which were weak and would most likely not survive in the final written decision.

Palomar Techs., Inc. v. MRSI Sys., LLC – No Petitioner Estoppel

In *Palomar Techs., Inc. v. MRSI Sys., LLC*[vi], Patent Owner Palomar Technologies, Inc. moved for summary judgment by invoking IPR estoppel. The court denied their motion and ordered a bench trial on whether Petitioner MRSI was estopped from applying the references based on the two-prong inquiry. The court held that a prior-art reference not raised in an IPR is subject to IPR estoppel if: the petitioner actually knew of the reference (subjective prong) **or** if a skilled searcher conducting a diligent search reasonably could have been expected to discover the

reference (objective prong).

Here, the court held IPR estoppel did not preclude a petitioner from asserting two prior art references not previously asserted in an IPR against a patent. In doing so, the Court rejected the argument that “courts should be particularly cautious about accepting a hindsight analysis” in the IPR estoppel context. In *Palomar*, the court addressed IPR estoppel under the scope established by the U.S. Supreme Court’s *SAS* decision[vii].

Under the subjective prong, the court found that there was no evidence to suggest that the petitioner actually knew of the references at the time of the IPR.

Under the objective prong, the court set forth several inquiries in assessing the evidence, including: (1) the difficulty of conducting a prior art search, (2) where the search is compounded by the large number of claims in the involved patent, (3) the lack of overlap of classes/subclasses and of principal search terms between the patent and the prior-art references at issue, and (4) whether the search itself produces useful results.

Ultimately, the court found that after a reasonably diligent searcher (a) spent more than 30 hours searching and (b) located invalidating prior art against all of the claims of the patent, they would have stopped searching. And the court found that reasonably diligent searcher may have stopped searching before finding the two pieces of prior art asserted in the litigation. So the defendant petitioner was not estopped from using the new prior art.

Gree, Inc. v. Supercell OY – Petitioner Estoppel

In *Gree, Inc. v. Supercell OY*[viii], the court held that PGR estoppel precludes defendant-petitioner Supercell from using two known prior art references under the subjective prong and two newly discovered references under the objective prong.

The court barred Supercell’s own documents under the subjective prong. Defendant-petitioner Supercell conceded that it was aware of its own Clash of Clans and Mastermind references before filing its November 2017 PGR petition. But Supercell argued that the references should not be barred under estoppel because § 325(e) estoppel does not apply to non-petitioned grounds as opposed to non-instituted grounds, relying on *Shaw*. [ix] The court disagreed and applied the estoppel analysis under *SAS* concluding that “for the words ‘reasonably could have raised’ to have any meaning at all,” they must refer to non-petitioned grounds.[x] Therefore, the court found that Supercell was estopped from raising the “non-petitioned” references at trial.

The court also barred Supercell from using newly discovered documents under the objective prong. The court held that Supercell could have found the new documents through a diligent search if they had performed one before filing its PGR petition. The court relied on two key pieces of evidence: (1) Supercell did not conduct a pre-petition prior art search and instead petitioned only under 35 U.S.C. §101 (subject matter ineligibility) grounds and (2) when Supercell performed a prior art search post-PGR it was able to find the references. So, deciding to raise only § 101 arguments in a petition did not excuse a failure to perform a pre-petition search or a failure to raise prior art arguments in the petition.

Finally, the court rejected Supercell’s argument that the relevance of the newly discovered references only became apparent in light of patent owner Gree’s infringement contentions. Instead, the court held that when a reference is found in a later prior art search there is a reasonable inference that it could have been found earlier by a skilled searcher.[xi]

Thus, petitioner Supercell was estopped from raising the new and old prior art references at trial pursuant to § 325(e)(2).

Key Takeaways

The scope of § 315(e)/325(e) petitioner estoppel has broadened under *SAS* under both the objective and subjective prongs. Under the subjective prong, since PTAB institution will effectively institute all raised and could have been raised grounds, a failure to raise known references can result in estoppel under §§ 315(e)/325(e). Under the objective prong, a diligent prior art search should not be deferred until district court trial, but rather should be conducted pre-petition and all relevant references should be relied on in the petition to avoid potential petitioner estoppel.

- [i] *Shaw Indus. Grp., Inc. v. Automated Creel Sys., Inc.*, 817 F.3d 1293, 1300 (Fed. Cir. 2016)
- [ii] *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1052-53 (Fed. Cir. 2017)
- [iii] *SAS Inst., Inc. v. Iancu*, 138 S.Ct. 1348, 1354 (2018)
- [iv] *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018); see also *BioDelivery Sci. Int'l, Inc. v. Aquestive Therapeutics, Inc.*, 898 F.3d 1205, 1209 (Fed. Cir. 2018) (“We agree that SAS requires institution on all challenged claims and all challenged grounds.”)
- [v] See U.S. Patent & Trademark Office, Guidance on the Impact of SAS on AIA Trial Proceedings (Apr. 26, 2018), <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial> (“the PTAB will institute on all challenges raised in the petition”)
- [vi] *Palomar Techs., Inc. v. MRSI Sys., LLC*, Case No. CV 18-10236-FDS, 2020 WL 2115625 (D. Mass. May 4, 2020).
- [vii] *SAS Inst.*, 138 S.Ct. 1348 (2018).
- [viii] *GREE, Inc. v. Supercell Oy*, Case No. 2:19-cv-00071-JRG-RSP, 2020 WL 3893697 (E.D. Tex. Jul. 9, 2020).
- [ix] *Shaw Indus. Grp.*, 817 F.3d 1293 (Fed. Cir. 2016)
- [x] *Biscotti Inc. v. Microsoft Corp.*, Case No. 2:13-CV-01015-JRG-RSP, 2017 WL 2526231, *6 (E.D. Tex., May 11, 2017) (finding this understanding consistent with the legislative history of the America Invents Act); *Wi-LAN Inc. v. LG Elecs., Inc.*, 421 F. Supp. 3d 911, 924 (S.D. Cal. 2019) (finding all post-SAS cases have held the same); *Palomar Techs., Inc. v. MRSI Sys., LLC*, 373 F. Supp. 3d 322, 331 (D. Mass. 2019) (collecting cases); *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 15-CV-1067, 2017 WL 3278915, *7-8 (N.D. Ill. Aug. 2, 2017); see also *Return Mail, Inc. v. U.S. Postal Serv.*, 139 S. Ct. 1853, 1867 n.10 (2019) (discussing how AIA estoppel precludes people from relitigating issues in subsequent proceedings before the Board and district court)
- [xi] Citing *Wi-LAN*, 421 F. Supp. 3d at 925-26 (S.D. Cal. 2019) (“Evidence that [petitioner-defendant] discovered these references through a prior art search is clear evidence that [petitioner-defendant] reasonably could have discovered these references through a diligent search.”)

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