

PTAB Spotlight Series with Jason Eisenberg

Recently named [U.S. Post-Grant Firm of the Year](#), Sterne Kessler has industry-leading experience in all proceedings before the Patent Trial and Appeal Board (PTAB). In our PTAB Spotlight Series, attorneys will share their valuable insights on PTAB practice today, the challenges and opportunities clients face, and the trends practitioners should follow.

[Jason D. Eisenberg](#) is a director in Sterne Kessler's Electronics Practice Group and a Practice Leader for the Reexamination and Reissue Practice. He was previously a Practice Group Leader in the Electronics Practice Group. Jason provides strategic counsel for global portfolio building, reissue (over 100 projects and as a litigation expert), reexamination (over 100), inter partes and post grant review (over 250), Federal Circuit (20) and Supreme Court appeals (cert petitions and amici briefs), opinions (over 100), diligence, enforcement, and defense from nearly thirty years of patent experience.

Jason was recently ranked in the top 50 of the "100 Best Performing Attorneys Overall" before the PTAB in the [2023 Patexia PTAB Intelligence Report](#), which evaluated the performance of thousands of attorneys over the five-year period from July 1, 2018, through June 30, 2023. The report also ranked Jason in the top 50 (#4) of the "100 Best Performing Attorneys Representing Patent Owners" before the PTAB as well as the "100 Most Active Attorneys Representing Patent Owners" and the "100 Most Active Attorneys Overall" before the PTAB.

Jason was the Editor in Chief and a frequent author running Sterne Kessler's monthly [PTAB Strategies and Insights](#) newsletter for over five years. The newsletter covered major issues and cases affecting all post grant proceedings at the Office. Jason won a JD Supra Reader's Choice Award for this work in 2020. He was also a co-editor, along with Robert Greene Sterne, and author of several chapters of the [Second Edition of Patent Office Litigation](#) (Thomson Reuters, 2017).

Jason taught Patent Office Litigation at both George Mason and University of Baltimore law schools.

What is the biggest challenge your clients are facing today?

My post grant practice balances cases pending in the Central Reexamination Unit and the Patent Trial and Appeal Board, so I view the challenges to my clients through a wide lens. As I highlight in reexamination articles published in the firm's [2021](#) and [2024](#) PTAB Year in Review, reexamination practice has changed a lot over the years, with requestors needing to meet additional and higher burdens to grant their requests. For example, the AIA statute brought 35 U.S.C. § 325(d), which also applies to reexaminations and requires requestors to avoid using substantially the same art and arguments in their request. This is in addition to meeting the substantial new questions requirements under the reexamination statute. With respect to § 325(d), *In re Vivint* (14 F.4th 1342 (Fed. Cir. 2021)), a precedential Federal Circuit case I worked on, made providing analysis under § 325(d) a strict requirement of the Office in their decision whether to grant. Similarly, the bar has been raised for Patent Owners who want to succeed at the CRU. Statistics in my articles show that amendments to patent claims and submission of new, narrower claims may be necessary to move a reexamination proceeding to an issuance of a reexamination certificate in the Patent Owner's favor. This is in contrast to past practice, where a strategic Examiner interview and carefully articulated reply arguments directed to claim construction to distinguish prior art were enough to remove asserted rejections without

needing to amend claims. So, the Patent Owner's counsel really needs to understand how to walk the line to avoid intervening rights and reduced damages while getting a patent out of reexamination.

What are some recent trends you're seeing at the PTAB?

The pendulum for institution decisions continues to swing in a Patent Owner's favor. With the meaning of "reasonable likelihood to succeed" becoming harder to prove under the merits, as well as the teeth being given to both Section 314 (e.g., *Fintiv*) and Section 325 (e.g., *Advanced Bionics*), Petitions have to be carefully drafted. In view of the tight word limits, this makes petition drafting more of an art best suited for skilled PTAB practitioners at boutiques rather than inexperienced general litigation firms. As we now know, the Petition has to hold through Supreme Court scrutiny and cannot be corrected or expanded during the PTAB trial. So there is a lot of pressure to get it right. Similarly, for the Patent Owner, a skilled practitioner who truly understands the nuances of what should and should not be argued in a Patent Owner Preliminary Response is required to avoid PTAB trial. And statistics show that avoiding a PTAB trial may be the only way to save a patent from invalidity. For example, the POPR should usually avoid raising factual disputes and rather be limited in scope to arguments regarding legal and procedural disputes. In the PTAB trial, both parties have to be concerned with building an appeal record through pursuing both substantive and procedural issues and need to avoid only thinking the parties are making the record for the PTAB judges and their final written decision.

What makes your PTAB practice unique?

What I have enjoyed most about my post grant practice – including both reexamination and AIA trials – is having clients that allowed my Sterne Kessler team to challenge current thinking and make new law. Several of our reexamination and PTAB cases have resulted in both Board precedential and informative decisions and Federal Circuit precedential and non-precedential decisions. These decisions have allowed our clients to clarify and change either legal interpretation or how procedures are implemented by the Office examining core, CRU, and PTAB. Some of our cases are even quoted in the Board's Trial Practice Guide as to why additional briefings are required (i.e., a ranking document) if a Petitioner wants to file more than one Petition against a patent. It takes courage for clients to be on cases that associate their company's names with pushing at the fringes of the law, resulting in how we practice in front of the Office. And the Sterne Kessler team enjoys and is up for those difficult challenges.