

PTAB Strategies and Insights

October 2018



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 three topics:

- *Dupont v Synvina*: Burden Can Shift To Patent Owner At The PTAB And Petitioner Must Meet Threshold To Have Standing To Appeal
- November 13th PTAB change to Phillip's standard for claim construction
- PTAB changes to SOP1 (Assignment of Judges) and SOP2 (Precedential and Informative Decisions)

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](#).

Thank you.

IN THIS ISSUE

DuPont v Synvina

USPTO Changes Claim Construction Standard in Post-Grant Proceedings

PTAB Revises Standard Operating Procedures

[DOWNLOAD](#)

Best regards,
Jason

Editor & Author:



Jason D. Eisenberg
Director
jasone@sternekessler.com

Author:



Deborah Sterling, Ph.D.
Director
dsterling@sternekessler.com

DUPONT V SYNVINA: BURDEN CAN SHIFT TO PATENT OWNER AT THE PTAB AND PETITIONER MUST MEET THRESHOLD TO HAVE STANDING TO APPEAL

By: [Deborah Sterling, Ph.D.](#)

A recent Federal Circuit decision (*DuPont v. Synvina*) addressed two key issues in PTAB proceedings: burden shifting and standing to appeal.

[Read More](#)



USPTO CHANGES CLAIM CONSTRUCTION STANDARD IN POST-GRANT PROCEEDINGS

By: [Jason D. Eisenberg](#)

The PTAB has now officially released the launch date, Nov. 13th, of *Phillips* claim construction for AIA proceedings, doing away with BRI. But the patent bar has more questions than answers. For example, why should an arbitrary date of release of new rules basically changing the law be only proactive? How could the Board have been correctly applying the law one day, and the very next day that same application is wrong? Will this be an appealable issue for all PTAB decisions? And most concerning – will this really change the Board’s mind on critical claim construction for disputed claim terms? Seems we may not know for a while.

Read our recent client alert discussing the rule change [here](#).

PTAB REVISES STANDARD OPERATING PROCEDURES

By: [Jason D. Eisenberg](#)

We will address the PTAB’s updated Standard Operating

Procedures in greater depth in a future issue of this newsletter. Meanwhile, we want our readers to be aware of two important revisions to the PTAB Standard Operating Procedures as follows:



- Revised SOP1 – Assignment of Judges
 - Explains panel assignment and reassignment practices
 - Explains process for expanding panels, with the approval of the director
- Revised SOP2 – Precedential and Informative Decisions
 - Creates Precedential Order Panel
 - Will rehear matters in PTAB trials and appeals deemed to be of exceptional importance
 - Will assist the director in determining when to designate a decision precedential or informative—expect more precedential decisions
 - Expected to replace the practice of expanded panel rehearing

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.

© 2018 Sterne, Kessler, Goldstein & Fox P.L.L.C

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

Technical Minds. Legal Muscle.

PTAB Strategies and Insights

October 2018



VISIT WEBSITE

CONTACT US

SUBSCRIBE

FORWARD TO A FRIEND

DUPONT V SYNVINA: BURDEN CAN SHIFT TO PATENT OWNER AT THE PTAB AND PETITIONER MUST MEET THRESHOLD TO HAVE STANDING TO APPEAL

By: [Deborah Sterling, Ph.D.](#)

A recent Federal Circuit decision (*DuPont v. Synvina*) addressed two key issues in PTAB proceedings: burden shifting and standing to appeal.

Burden shifting

Previous decisions, *Dynamic Drinkware* and *Magnum Oil*, held that in post-grant proceedings, the burden to show unpatentability lies with the petitioner. But in *DuPont* the Federal Circuit held that burden shifting is appropriate in IPRs in obviousness arguments involving overlapping ranges.

In the IPR, the challenged claims were directed to a one-step method of preparing 2,5-furandicarboxylic acid (FDCA) — an organic compound that can be made from plant-sugars and then used to make plastic. One-step methods were already in the art, but disclosed different ranges of temperature and pressure than those claimed.

Long-standing Federal Circuit precedent has held that a “*prima facie* case of obviousness” exists when ranges within the prior art overlap with that of the claimed invention. A patentee may overcome that *prima facie* case by proving some criticality of the claimed amount or range, typically by providing evidence of unexpected results, for example. But in the underlying IPR proceeding, the PTAB did not apply this burden-shifting approach — rather, the Board cited *Dynamic Drinkware* and *Magnum Oil* as prohibiting burden-shifting in IPRs.

On appeal, however, the Federal Circuit held that the traditional obviousness burden-shifting associated with obviousness of overlapping ranges equally applies to IPR proceedings:

While a patentee technically has no “burden” to do anything to defend the validity of its patent other than hold the patent challenger to its own burden of persuasion, that burden of persuasion is necessarily satisfied when there is no evidentiary reason to question the prior art’s disclosure of a claimed range. Magnum Oil is not to the contrary.

Moving forward, Patentees are now on notice that they have the burden to make the case for why the patent is not obvious, when the prior art discloses overlapping ranges.

Standing to appeal

While any person other than the patent owner or inventor can file a petition for an IPR, not every petitioner has the ability to appeal an unfavorable final written decision to the Federal Circuit. Previous decisions (*Phygenix* and *JTEKT Corp*, for example) have informed the public about what is not enough to provide standing to appeal, but in *DuPont*, the Federal Circuit found activity that is enough.

Here, the Federal Circuit held that DuPont had standing because it has "concrete plans" to engage in activity that could give rise to infringement. DuPont had announced plans for a plant that can produce the chemical covered by the patent, and the facility opened while the appeal was pending. The court also noted that the Patent Owner accused DuPont of copying its patented invention during the IPR and refused to grant DuPont a covenant not to sue.

This decision is fact specific, but gives a data point to petitioners who are still in the pre-launch development stage, but are seeking to create more assurances around freedom-to-operate through IPRs.

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.

© 2018 Sterne, Kessler, Goldstein & Fox P.L.L.C

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

Technical Minds. Legal Muscle.