

The background features abstract, overlapping geometric shapes in various shades of green, ranging from light lime to dark forest green. The shapes are primarily triangles and polygons, creating a dynamic, layered effect. The overall composition is clean and modern, with the text centered in a white space.

# Delving Into Complex and Less-Common Issues in PTAB Practice

March 23, 2018

# Panelists

- ▶ Honorable Jacqueline Wright Bonilla
  - ▶ Vice Chief Administrative Patent Judge Patent Trial and Appeal Board US Patent and Trademark Office
- ▶ Matthew Anderson
  - ▶ Chief IP Litigation Counsel, Medtronic
- ▶ Paul Margolis
  - ▶ IP Litigation Counsel, General Motors
- ▶ James Sherwood
  - ▶ Senior Litigation Counsel, Google
- ▶ Sara Tonnies Horton (moderator)
  - ▶ Partner, Jenner & Block LLP

# Topics

- ▶ Remand after vacatur by the Federal Circuit
- ▶ Estoppel considerations
- ▶ Motions to amend
- ▶ Joinder

# Remand After Vacatur

- ▶ SOP 9
- ▶ When is it appropriate to request briefing?
- ▶ Strategic considerations and evidentiary issues: reversal or remand?

# Default Trial Procedures for Common Remand Scenarios

	Remand Scenario	Additional Briefing?	Additional Evidence?	Oral Argument?
1	Erroneous claim interpretation	Yes, unless the claim interpretation to be applied on remand was proposed by one of the parties and the effect has been fully briefed	No, unless evidence of record is insufficient to afford due process	No
2	Failure to consider the evidence	Yes, unless the evidence was fully briefed on the record	No	No
3	Inadequate explanation by the Board	No, unless the briefing on the issues is inadequate for the Board to have made a decision in the first instance	No	No
4	Erroneous application of law	Yes, unless the law was fully briefed on the record but not reflected in Board decision	No	No
5	Law of due process/denial of APA rights	Yes	Yes, for parties whose rights have been violated, unless additional briefing on evidence of record is sufficient to afford due process	Yes, if necessary to afford due process
6	Improper consideration of the arguments	Yes, unless argument is fully briefed in the record	No	No



# Estoppel

- ▶ 35 U.S.C. § 315(e)
  - ▶ Narrow?
  - ▶ Broad?
  - ▶ *Shaw Industries*
- ▶ Strategic considerations
- ▶ PTO estoppel considerations
  - ▶ 37 CFR § 42.73(d)

# Estoppel

## 35 U.S.C. § 315(e)

(e)ESTOPPEL.

(1)PROCEEDINGS BEFORE THE OFFICE.—The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner *raised or reasonably could have raised* during that inter partes review.

(2)CIVIL ACTIONS AND OTHER PROCEEDINGS.—The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not assert either in a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner *raised or reasonably could have raised* during that inter partes review.

# Estoppel

## 37 CFR § 42.73(d)

§ 42.73 Judgment.

(d) Estoppel.

(1) Petitioner other than in derivation proceeding. A petitioner, or the real party in interest or privy of the petitioner, is estopped in the Office from requesting or maintaining a proceeding with respect to a claim for which it has obtained a final written decision on patentability in an inter partes review, post-grant review, or a covered business method patent review, on any ground that the petitioner raised or reasonably could have raised during the trial, except that estoppel shall not apply to a petitioner, or to the real party in interest or privy of the petitioner who has settled under 35 U.S.C. 317 or 327.

(2) In a derivation, the losing party who could have properly moved for relief on an issue, but did not so move, may not take action in the Office after the judgment that is inconsistent with that party's failure to move, except that a losing party shall not be estopped with respect to any contested subject matter for which that party was awarded a favorable judgment.

(3) Patent applicant or owner. A patent applicant or owner is precluded from taking action inconsistent with the adverse judgment, including obtaining in any patent:

- (i) A claim that is not patentably distinct from a finally refused or canceled claim; or
- (ii) An amendment of a specification or of a drawing that was denied during the trial proceeding, but this provision does not apply to an application or patent that has a different written description.



# Motions to Amend

- ▶ *Post-Aqua Products*
  - ▶ PTO issues guidance
  - ▶ Strategies for Petitioner
  - ▶ Strategies for Patent Owner
  - ▶ Policy considerations

# Joinder

- ▶ Status of “me too” petitions
- ▶ Timing
- ▶ Mechanics

Thank you

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