Sterne Kessler
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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:

- Joinder petitioners having different § 315(e)(2) Estoppel than original petitioner;
- How petitioners must be aware and comply with all USPTO rules relating to prior art;
- Five Things to Know About the Supreme Court's Grant of Certiorari in Arthrex; and
- The release of the firm's new IP Hot Topics Podcast.

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

Editor & Author:

Jason D. Eisenberg
Director
jasone@sternekessler.com

IN THIS ISSUE

DOWNLOAD

Author:

William H. Milliken
Associate
wmilliken@sternekessler.com

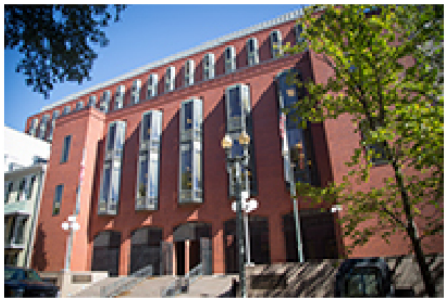
Podcast Co-Host:

Trey Powers
Director
tpowers@sternekessler.com

Podcast Co-Host:

Eldora Ellison
Director
eellison@sternekessler.com

JOINDER PETITIONER HAS DIFFERENT § 315(E)(2) ESTOPPEL THAN ORIGINAL PETITIONER



By: Jason D. Eisenberg

In *Network-1 Technologies, Inc. v. Hewlett-Packard Company*, the Federal Circuit vacated and remanded the district court's holding that joinder petitioner Hewlett Packard ("HP") (1) could have tried to raise new grounds in its joinder petition and thus (2) was estopped from using those unraised positions during district court trial. *Network-1 Techs. v. Hewlett-Packard Co.*, Case No.18-2338, Slip Op. at 17-21 (Fed. Cir. Sept. 24, 2020). The issue of joinder petitioner estoppel reached the Federal Circuit on appeal from a JMOL on invalidity. *Id.*

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PETITIONER BEWARE - NO CURE FOR MISSED FILING REQUIREMENTS

By: Jason D. Eisenberg

Petitioners beware – the Board holds you to what is submitted on filing day for required documents. In *Shenzhen Aurora Technology Company, Ltd. v. Putco, Inc.*, IPR2020-00670, "[t]he Petition relies on foreign language references in support of its asserted grounds of unpatentability, but fails to provide affidavits attesting to the accuracy of the submitted translations of these references." Paper 10, 5. But "[w]hen a party relies on a document or is required to produce a document in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation must be filed with the document." *Id.*, citing to 37 C.F.R. §§ 42.63(b), 42.1, 1.68. Here, Petitioner failed to provide this required affidavit or declaration after relying on machine translations of Japanese and Taiwanese documents.

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FIVE THINGS TO KNOW ABOUT THE SUPREME COURT'S GRANT OF CERTIORARI

The U.S. Supreme Court has granted certiorari in *Arthrex v. Smith & Nephew* to review the Federal Circuit's decision regarding the constitutionality of the appointment of USPTO Patent Trial and Appeal Board (PTAB) judges.

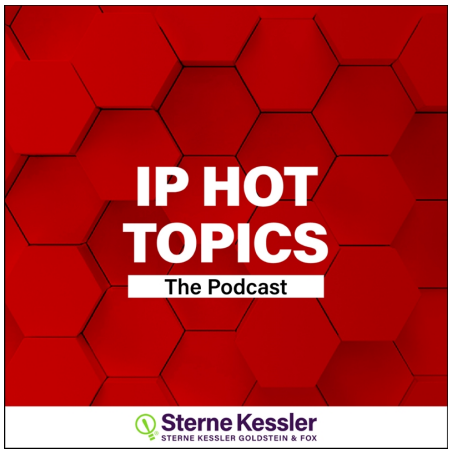
Read our analysis published by *Law360* on the five things practitioners and litigants should know as the Supreme Court considers this case.

1. The Court will review both the merits of the constitutional issue and the propriety of the Federal Circuit's remedy.

2. The Court will not review the issue of whether Arthrex forfeited its Appointments Clause challenge by raising it for the first time in the court of appeals.
3. Cases remanded to the Board following *Arthrex* will likely remain stayed, and several pending petitions on the Appointments Clause issue will likely be held pending the Court's disposition of *Arthrex*.
4. *Arthrex* will present the Supreme Court with an opportunity to clarify the line between "principal" and "inferior" officers.
5. The disposition of *Arthrex* will not necessarily affect the constitutionality of other administrative adjudication regimes.

To read the full article, authored by William H. Milliken, please click here.

NEW! IP Hot Topics Podcast



Looking for a new podcast to listen to? Check out our brand new podcast "IP Hot Topics!" Episodes explore timely and trending topics in intellectual property law ranging from ground-breaking cases in the courts and industry innovations to changes in regulations at the U.S. Patent and Trademark Office.

For our first two episodes, renowned author and Tulane University Professor of History **Walter Isaacson** joined Sterne Kessler Directors Trey Powers and Eldora Ellison for a discussion about historical perspectives on innovation. Subscribe on Apple Podcasts, Spotify, or SoundCloud!

Episode 1 **Episode 2**

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In the underlying case, the district court held "in contrast to the Fisher system, which was not a patent or printed publication that HP 'reasonably could have raised' in the IPR, HP could have reasonably raised its remaining invalidity arguments during the IPR—i.e., the Fisher patents, Woodmas, and Chang." *Id.* at 18. The district court explained "the fact that HP sought joinder with Avaya's [inter partes review (IPR)] does not mean that HP could not have reasonably raised different grounds from those raised by Avaya" and that "allowing HP to raise arguments 'that it elected not to raise during the IPR would give it a second bite at the apple and allow it to reap the benefits of the IPR without the downside of meaningful estoppel.'" *Id.*

The Federal Circuit disagreed stating "the joinder provision does not permit a joining party to bring into the proceeding new grounds that were not already instituted." *Id.* (internal citations omitted.) The Court explained "a party is only estopped from challenging claims in the final written decision based on grounds that it 'raised or reasonably could have raised' during the IPR. Because a joining party cannot bring with it grounds other than those already instituted, that party is not statutorily estopped from raising other invalidity grounds [in district court]." *Id.* at 19. "HP first filed a motion to join the Avaya IPR with a petition requesting review based on grounds not already instituted. The Board correctly denied HP's request. The Board, however, granted HP's second joinder request, which petitioned for only the two grounds already instituted." *Id.*

The Court also explained "HP, however, was not estopped from raising other invalidity challenges [in district court] against those claims because, as a joining party, HP could not have raised with its joinder any additional invalidity challenges. Thus, contrary to the district court's suggestion, permitting HP to challenge the asserted claims of the '930 patent as obvious over the Fisher patents, Woodmas, and Chang does not give HP a 'second bite at the apple' to challenge the '930 patent…because HP could not have raised such a challenge in the Avaya IPR." *Id.* at 20. "Accordingly, we conclude that HP was not statutorily estopped under § 315(e)

from challenging the asserted claims of the ’930 patent based on the Fisher patents, Woodmas, and Chang, which were not raised in the Avaya IPR and which could not have reasonably been raised by HP.” *Id.*

Take away: Joinder petitioners seem to have a free pass at the district court to assert new invalidity challenges not found in the Petition they joining if any claims survive the underlying AIA proceeding.

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After evaluating this issue, along with a noticeable incompleteness of the documents, the Board held that "[a]s the [foreign language documents are] relied upon for all asserted grounds of unpatentability…and Petitioner failed to comply with the Board's rule requiring an affidavit attesting to the accuracy of a translation, the Petition has not established a reasonable likelihood of prevailing as to at least one challenged claim. We deny the Petition and do not institute inter partes review because Petitioner has not filed affidavits attesting to the accuracy of foreign language references relied upon to show unpatentability." Paper 10, 6.

Both parties should be aware of all USPTO Rules relating to prior art, and must comply with those rules on the date of filing of a Petition. The Board has time and again held that these type of missteps in the Petition filing are not curable before or after trial. So measure twice and cut once.

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