

Morgan Lewis

ANNUAL PTAB DIGEST

2017 PTAB DIGEST:
THE LATEST TRENDS AND DEVELOPMENTS
IN POST-GRANT PROCEEDINGS

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INTRODUCTION

When the America Invents Act went into effect in 2012, it introduced new post-grant proceedings conducted by a new forum—the Patent Trial and Appeal Board (PTAB or the Board)—to resolve issues of patent validity. Since then, the popularity of post-grant proceedings has skyrocketed, with the number of new PTAB cases jumping from 111 new cases in 2012 to nearly 1,800 new cases in 2015.

Recognizing early on the transformative effect of post-grant proceedings on patents and the litigation landscape, Morgan Lewis created a PTAB Working Group consisting of 31 lawyers focused on aggregating the firm’s PTAB experience, sharing best practices, and developing innovative and successful approaches to PTAB proceedings. Not only did we handle the second-ever inter partes review conducted before the PTAB, but we continue to regularly handle post-grant proceedings before the PTAB, including reexaminations, post-grant reviews, inter partes reviews, and covered business method reviews. More recently, we joined forces with a number of other firms to establish the PTAB Bar Association, were ranked third in Juristat’s annual Top 100 patent firm list, and earned a Tier 1 designation in US News & World Report’s Best Law Firm rankings.

Morgan Lewis was also recently recognized by Docket Navigator as one of the most active firms in PTAB proceedings. For 2016, we were ranked among the top 15 firms for the number of PTAB representations by firm, and ranked number two for firms that were most successful in defending PTAB challenges. These results are a testament to the impact of the PTAB Working Group in facilitating greater cross-office and cross-practice training and collaboration among our teams.

Due to recent patent reform legislation, rule changes, and significant changes in case law, post-grant proceedings are constantly evolving. To help clients stay on top of new developments, the PTAB Working Group compiles an annual PTAB digest that offers clients the most up-to-date and well-informed approaches to PTAB proceedings.

This year’s PTAB digest highlights several significant paradigm-shifting statistics, trends, and rule changes that will impact strategies for patent owners and petitioners alike. As always, we invite you to reach out to us with any comments or questions.

If you would like to receive a hardcopy of this PTAB Digest, please contact **Gail Sobha Lynes** at gail.sobhalynes@morganlewis.com or **Olive To** at olive.to@morganlewis.com.

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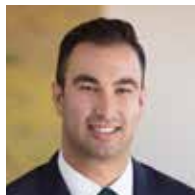
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THE CHANGING LANDSCAPE OF PATENT DISPUTES



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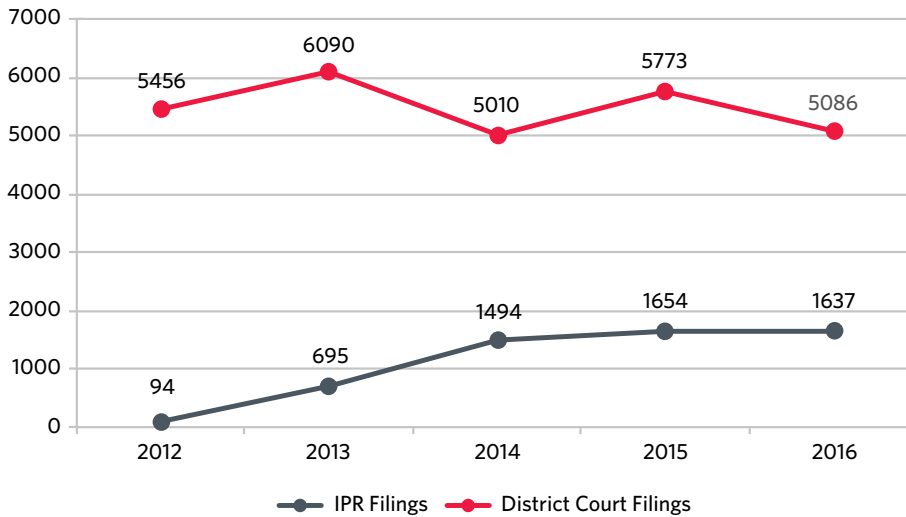


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Dissatisfied companies targeted by patent litigation have enthusiastically made use of the AIA's newly created *inter partes* review (IPR) and other post-grant proceedings. Our review of these proceedings has revealed several significant trends, summarized below.¹

IPR FILINGS REMAIN CONSISTENTLY HIGH

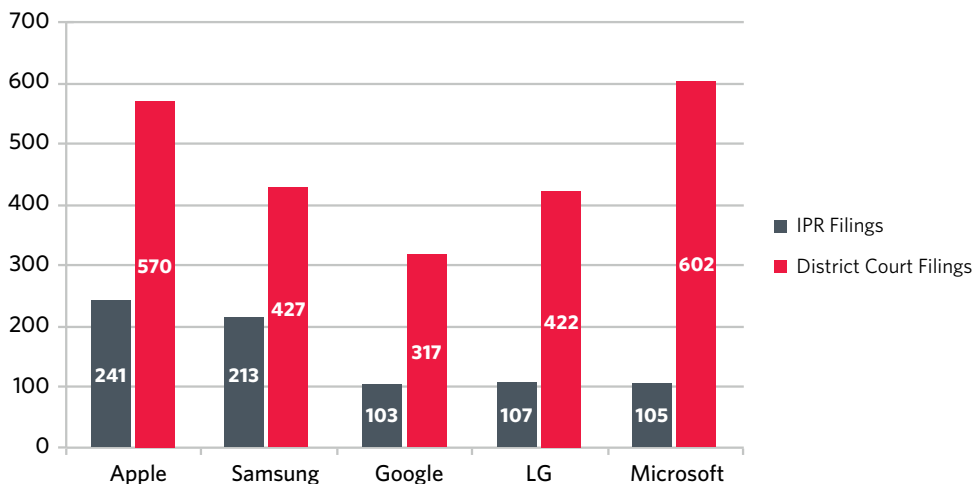
From 2013, when the proceedings were introduced, the number of IPR petition filings increased yearly. By 2015, however, the steady rise in filings appeared to level off. Although still a significant number, IPR filings saw a slight dip in 2016. District court patent litigation saw a similar decline in 2016.



Despite the slight slowdown, IPR proceedings continue to play a prominent role in the patent landscape, as evidenced by the high number of filings each year.

TECH FIRMS CONTINUE TO EMBRACE IPRs

Technology firms have embraced IPRs as a vehicle for patent dispute management and resolution. IPRs are a less expensive alternative to prolonged litigation because they offer an opportunity to invalidate asserted patents or negotiate settlement. Unsurprisingly, tech firms with the busiest patent litigation dockets are also the most prolific IPR filers.

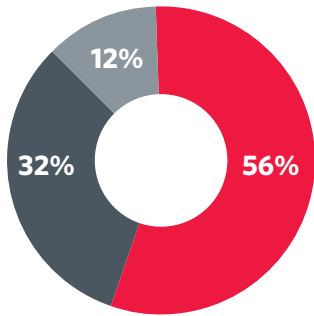


¹ We compiled these statistics using Docket Navigator. They should be treated as estimates throughout.

THE ROLE OF A PATENT OWNER'S PRELIMINARY RESPONSE

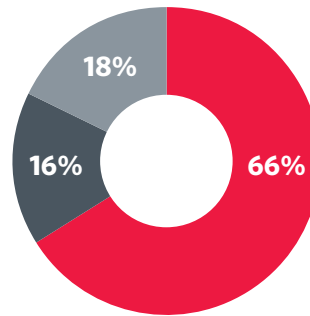
Patent owners may address the invalidity grounds set forth in a petition by filing a preliminary response. If a patent owner's preliminary response opposing the petition is successful, institution of some or all of the challenged claims may be avoided. Although not all patent owners take advantage of this mechanism, institution is less likely when a patent owner has filed a preliminary response.

No Preliminary Response Filed



■ Instituted ■ Not Instituted ■ Partially Instituted

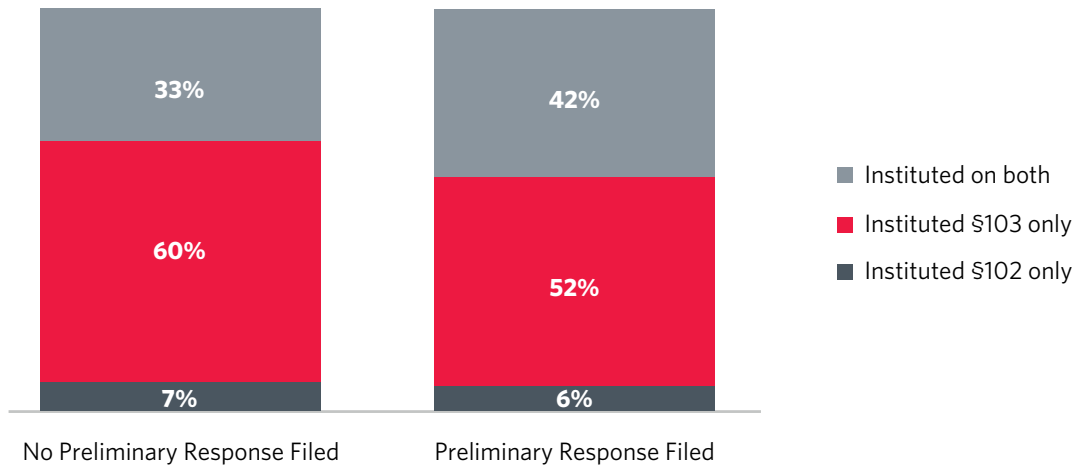
Preliminary Response Filed



■ Instituted ■ Not Instituted ■ Partially Instituted

Moreover, as shown below, the grounds on which trial is ultimately instituted statistically shift when a preliminary response is filed.

INSTITUTION BY GROUND CHALLENGED



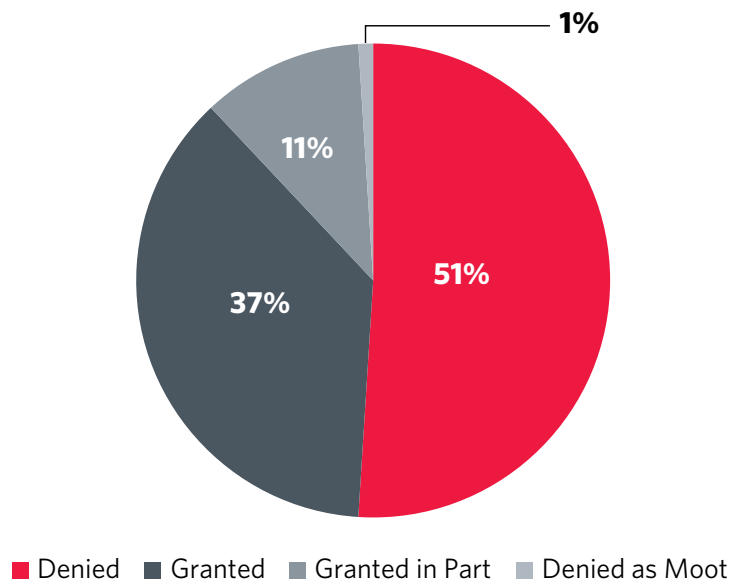
Now, with new rules that went into effect on May 2, 2016, a patent owner may submit testimonial evidence with its preliminary response, which was previously prohibited. But a corresponding change provides that “a genuine issue of material fact created by such testimonial evidence will be viewed in the light most favorable to the petitioner solely for purposes of deciding whether to institute a post-grant review.” 37 C.F.R. § 42.208. As such, although this added opportunity theoretically allows patent owners to strengthen their preliminary responses, any significant effect on institution rates in light of this rule has yet to be seen.

ADDITIONAL DISCOVERY

“Routine” discovery is allowed in all proceedings. This includes exhibits cited in papers or in testimony, cross-examination of testimonial witnesses, and “relevant information that is inconsistent with a position advanced” by a party to the proceeding. See 37 C.F.R. § 42.51(b)(1). Additional discovery may be available if the moving party shows that it is in the “interests of justice.” 37 C.F.R. § 42.51(b)(2). In *Garmin International, Inc. v. Cuozzo Speed Technologies LLC*, IPR2012-00001, 2013 WL 11311697, at *3-8 (P.T.A.B. Mar. 5, 2013) (citing Paper 20, at 2-3), the Board set forth five factors that it will consider to determine whether additional discovery is in the “interests of justice”: (1) more than a possibility and mere allegation; (2) litigation positions and underlying basis; (3) ability to generate equivalent information by other means; (4) easily understandable instructions; and (5) requests not overly burdensome to answer.

The May 2016 rules described the five-factor *Garmin* approach as “informative” and compared it to standards used in other post-grant review proceedings. Moreover, the Patent Office noted that “[t]he list of factors set forth in *Garmin* is not exhaustive.”

MOTIONS FOR ADDITIONAL DISCOVERY



Based on our review of the statistics, although the Board has been willing to grant some additional discovery beyond the “routine” categories, motions for additional discovery are more often denied than granted.

Snap-On Inc. v. Milwaukee Electric Tool Corp., IPR2015-01242, IPR2015-01243, Paper 40 (P.T.A.B. May 26, 2016), is one example where the Board granted a motion for additional discovery. In *Snap-On*, the petitioner sought additional discovery of 12 documents, which the petitioner asserted would “demonstrate that the subject matter of the challenged claims was conceived and reduced to practice by” persons other than the named inventors. *Id.* at 3. The petitioner argued that the additional discovery was in the interests of justice, because the documents were relevant to the patent owner’s assertion that a specific prior art patent was not available as prior art in the proceedings. *Id.*

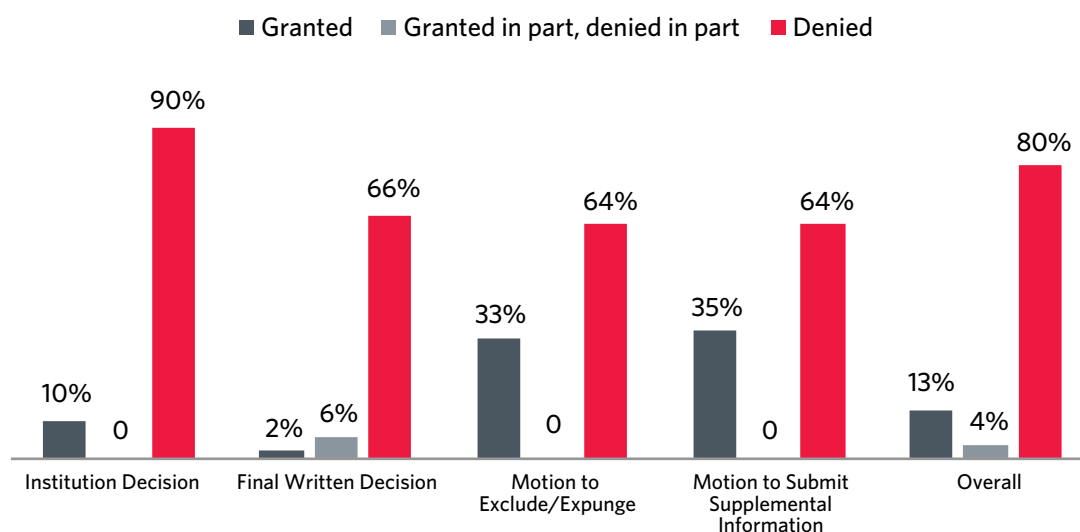
The Board determined that the *Garmin* factors favored granting the petitioner’s request. First, the motion, which aimed to antedate the prior art patent, raised more than a possibility that useful evidence would be discovered, because it sought relevant information as to whether and when the named inventors conceived and reduced to practice the claimed inventions, and whether conception was coupled with due diligence before the filing of a patent application. *Id.* at 3-4. Second, no litigation position would be revealed by the requested discovery, because the patent owner had already produced the 12 documents to the petitioner in related district court litigation. *Id.* at 4. The third *Garmin* factor was neutral, because the petitioner asserted that the patent owner possessed the requested documents, and the patent owner countered that the petitioner could secure the documents from the nonparty whose employees were alleged to have contributed to the invention. *Id.* Fourth, the Board concluded that the discovery requests reflected easily understandable instruction. *Id.* And fifth, the Board determined that the petitioner’s request was not unduly burdensome where the patent owner itself had inserted the antedating issue into the proceedings and the antedating issue was potentially dispositive. *Id.* at 4-5. Therefore, because it would further the interests of justice by facilitating development of a fuller record on the antedating issue, the Board granted the motion for additional discovery. *Id.* at 5; see also *Seadrill Am., Inc. v. Transocean Offshore Deepwater Drilling, Inc.*, IPR2015-01929, IPR2015-01989, IPR2015-01990, Paper 67 (P.T.A.B. Oct. 27, 2016) (granting the petitioner’s motion for sealed transcript portions of patent owner’s Fed. R. Civ. P. 30(b)(6) designee’s deposition); *Brunswick Corp. v. Cobalt Boats, LLC*, IPR-2015-01060, Paper 20 (P.T.A.B. Dec. 28, 2015) (granting the patent owner’s motion for information already available to it in the co-pending federal district court case but subject to a protective order).

REQUESTS FOR REHEARING

The Board’s decision regarding institution of IPR is “final and nonappealable.” 35 U.S.C. § 314(d); see also 37 C.F.R. § 42.71(c) (“A decision by the Board on whether to institute a trial is final and nonappealable.”). As such, the only remedy available to a party dissatisfied with the Board’s decision is to file a request for rehearing. 37 C.F.R. § 42.71.

A request for rehearing is akin to a motion to reconsider in district courts in that no formal rehearing is conducted. Rather, the decision on the reconsideration itself is the “rehearing.” The request must identify specifically all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed previously. 37 C.F.R. § 42.71(d). A request for rehearing is not an opportunity to present new arguments or evidence that could have been presented in the petition. *Foursquare Labs, Inc. v. Silver St. Intellectual Techs., Inc.*, IPR2014-00159, 2014 WL 3945911, at *4 (P.T.A.B. Aug. 1, 2014).

But requests for rehearing are rarely granted, and outcomes vary based on the grounds for the request. Specifically, the Board granted a mere 10% of all requests for rehearing on an institution decision and granted a paltry 2% of motions for rehearing on a final written decision. Requests for rehearing on motions to exclude or expunge and motions to submit supplemental information fared slightly better with the Board granting 33% and 35%, respectively.



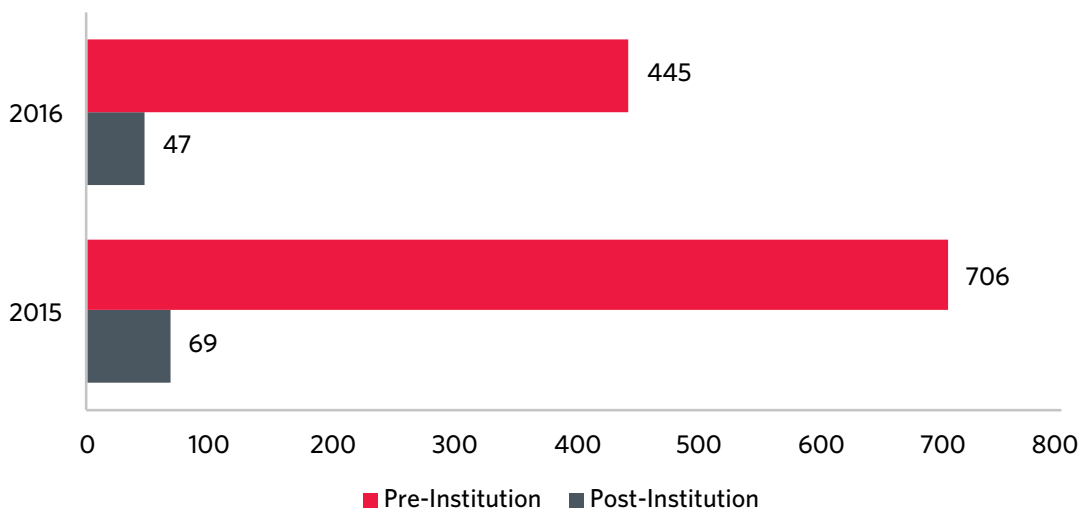
One possible reason for the low success rate is the movant’s high burden. The movant must show that “the Board misapprehended or overlooked” matters in its previous ruling. 37 C.F.R. § 42.71(d). Still, a request for rehearing may be a party’s best or only option after receiving an unfavorable decision.

TERMINATION

Parties to an IPR proceeding may agree to settle any issue in a proceeding by filing a joint motion to terminate the proceeding. 35 U.S.C. § 317; 37 C.F.R. § 42.74(a). A party must first obtain Board authorization to file a motion. 37 C.F.R. § 42.20. The joint motion must be in writing and a true copy should be filed with the Board before the termination of the trial. 37 C.F.R. § 42.74(b). Unsurprisingly, settlement motions are more prevalent before the institution decision occurs, when parties can curb additional time and cost.

But the Board reserves the right to “independently determine any question of jurisdiction, patentability, or Office practice.” *Id.* The Board is more likely to grant a joint motion to terminate proceedings when the case is in the preliminary proceeding stage and no decision whether to institute trial has been made. See, e.g., *Cisco Sys., Inc. v. Spherix Portfolio Acquisition II, Inc.*, IPR2015-00999, 2015 WL 9599207, at *1 (P.T.A.B. Dec. 4, 2015) (“These proceedings are in their early stages. For example, Patent Owner has not filed a Patent Owner Response. As a result, we have not yet decided the merits of these proceedings. Under these circumstances, we determine that it is appropriate to terminate these proceedings as to both Petitioner and Patent Owner without rendering a final written decision.”); *Masimo Corp. v. Mindary DS USA, Inc.*, IPR2015-01240, 2015 WL 9599224, at *2 (P.T.A.B. Nov. 18, 2015) (“The trial phase of this proceeding is in its early stages, as Patent Owner has not yet filed a Patent Owner Response and Petitioner has not yet filed a Reply. Under these circumstances, we are persuaded that it is appropriate to terminate this proceeding with respect to both Petitioner and Patent Owner.”).

UNOPPOSED MOTIONS TO TERMINATE FILINGS



Conversely, the Board is less likely to grant a joint motion to terminate proceedings where the request is filed late in the proceedings at a time when there is a public interest in resolving the issues. *See, e.g., Apple, Inc. v. OpenTV, Inc.*, IPR2015-00969, IPR2015-00980, Paper 28 (P.T.A.B. Sept. 10, 2016) (denying joint motion to terminate proceedings where the parties completed all briefing, the Board held oral hearings, the Board deliberated and decided the merits of each proceeding before the request was filed, the agreements involved signatories not identified as real parties in interest, and each party acknowledged that it individually was not aware of some of the agreements' contents); *Apple, Inc. v. Smartflash, LLC*, CBM2015-00015, Paper 49, 6 (P.T.A.B. Nov. 4, 2015) ("There is a public interest in resolving the issues raised by these challenges because the record is fully developed."). Therefore, the earlier that the parties file their joint motion to terminate proceedings, the more likely the Board is to grant the motion.

CONCLUSION

As we look to 2017, IPR proceedings remain ever prevalent in IP dispute resolutions. Statistics compilation and case law analysis provide insight into successful avenues before the PTO that may guide future IPR strategies. We continually build upon this knowledge of IPR proceedings to offer focused services and positive outcomes for our clients.



PTAB DEVELOPMENTS

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USPTO PUBLISHES NEW RULES FOR PTAB TRIALS



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THE NEW RULES, WHICH WENT INTO EFFECT ON MAY 2, 2016, WILL IMPACT STRATEGIES FOR PETITIONERS AND PATENT OWNERS ALIKE.

On April 1, the US Patent and Trademark Office (Office) published a set of new rules for post-grant proceedings conducted by the Patent Trial and Appeal Board (PTAB or the Board), which include *inter partes* review, post-grant review, covered business method review, and derivation proceedings.

The new rules largely track the Office's proposed rules from August 2015 and address, among other things, the claim construction standard for PTAB trials, testimonial evidence submitted with a patent owner's preliminary response, Rule 11-type certification for practitioners, and word-count limitations for major briefing. These rule changes took effect on May 2, 2016 and apply to "all AIA petitions filed on or after the effective date and to any ongoing preliminary proceeding or trial before the Office."

OVERVIEW OF NEW RULE CHANGES

- **Parties May Request a *Phillips*-Type Claim Construction Standard for Patents That "Will Expire" During Proceedings.** For patents that will expire within 18 months of the Notice of Filing Date Accorded to Petition, the new rules allow either party to request, by a motion filed no later than 30 days from the filing of the petition, that the Board give the challenged claims a "*Phillips*-type construction" rather than the broadest reasonable construction normally used in post-grant proceedings. Filing the motion triggers a conference call with the Board to discuss (1) whether such a motion is appropriate under the circumstances, and (2) whether any other briefing is necessary for each party to adequately address the appropriate claim construction standard. As a result, a petitioner may be afforded an opportunity to address a *Phillips*-type construction before the patent owner is required to file its preliminary response.
- **Patent Owner May Submit Testimonial Evidence with Preliminary Response.** The new rules allow a patent owner to file with its preliminary response new testimonial evidence (e.g., expert declaration testimony) without any limit on scope. There is no limit on the number of declarations that may be submitted. But since the expedited nature of post-grant proceedings prohibits cross-examination of a declarant before institution as of right, the rules add a caveat: any factual dispute created by testimonial evidence that is material to the institution decision will be resolved in favor of the petitioner. That being said, the Board may, in some circumstances, exercise its discretion to order limited discovery, including cross-examination of a witness before institution. And where good cause is shown, the Board may afford petitioners the right to reply.

- **Parties Must Include a Rule 11-Type Certification with All Filed Papers.** In addition to an existing rule (37 C.F.R. § 42.12) that provides sanctions for “advancing a misleading or frivolous argument or request for relief,” the new rules require practitioners to include a Rule 11-type certification for all papers filed with the Board with a provision for sanctions for noncompliance.
- **Patent Owner May Raise a Real Party-in-Interest or Privity Challenge Any Time During the Proceeding.** The new rules permit a patent owner to raise a challenge regarding a real party-in-interest or privity at any time during a trial proceeding. But where a late challenge could have been raised earlier in the proceeding, the Board will consider the impact of such a delay on a case-by-case basis, including whether the delay is unwarranted or prejudicial.
- **Patent Owner Must Argue Over the Prior Art of Record in Motion to Amend.** Where a patent owner files a motion to amend, the new rules require that the patent owner argue for the patentability of the proposed amended claims over the prior art of record, which includes (a) any material art in the prosecution history of the patent; (b) any material art of record in the current proceeding, including art asserted in grounds on which the Board did not institute review; and (c) any material art of record in any other proceeding before the Office involving the patent. The patent owner must still distinguish over any art provided in light of the patent owner’s duty of candor as well as any other prior art or arguments supplied by the petitioner.
- **Parties May Request to Present Live Testimony in an Oral Hearing.** The new rules permit the Board to continue its present practice of considering requests to present live testimony at an oral hearing on a case-by-case basis, but note that such live testimony will not be required in every case where there is conflicting testimony. The Board will permit live testimony where it believes live testimony will be helpful in making a determination.
- **Page Limits Replaced with Word Limits for Major Briefing.** The new rules replace page limits with word-count limitations for petitions, patent owner preliminary responses, patent owner responses, and petitioner replies. For all other briefing, the new rules maintain a page limit. The word count or page limit does not include the table of contents, table of authorities, claim listing, grounds for standing, mandatory notices, certificate of service, or appendix of exhibits.

CONCLUSION

Practice before the PTAB has grown significantly since the America Invents Act went into effect more than three years ago. Indeed, the Office last reported that 4,600+ PTAB petitions have been filed as of February 2016. Although the new rules themselves may not affect the growing popularity of these proceedings, they will certainly impact strategies for petitioners and patent owners alike.

FEDERAL CIRCUIT CARVES OUT EXCEPTION TO IPR ESTOPPEL PROVISIONS



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ON MARCH 23, THE US COURT OF APPEALS FOR THE FEDERAL CIRCUIT FOUND THAT A PETITIONER IN AN *INTER PARTES* REVIEW (IPR) WOULD NOT BE ESTOPPED FROM RAISING IN FUTURE PROCEEDINGS A NONINSTITUTED GROUND THAT THE PATENT TRIAL AND APPEAL BOARD (THE BOARD) REJECTED AS “REDUNDANT” EVEN THOUGH THE BOARD HAD INSTITUTED OTHER GROUNDS FOR REJECTING THE SAME CLAIMS.

Instead, the Federal Circuit held that the estoppel provisions would not apply because the noninstituted ground never became part of the IPR proceeding. So long as the noninstituted grounds were properly asserted in the petition, the court’s decision affords petitioners a second bite at the apple by allowing district court consideration of any noninstituted grounds deemed “redundant” by the Board or otherwise denied without meritorious consideration.

THE DECISION

In *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, petitioner Shaw filed a petition for IPR proposing 15 grounds for rejecting Automated Creel System’s patent, which relates to “creels” for supplying yarn and other stranded materials.¹ Although the Board instituted IPR on all but one of the challenged claims, it refused to institute IPR on all 15 grounds argued by Shaw. Rather, the Board explained that one of these grounds—alleging that the “interposing claims”² were anticipated by a prior art patent issued to Payne (the Payne-based ground)—was “denied as redundant in light of our determination that there is a reasonable likelihood that the challenged claims are unpatentable based on the grounds of unpatentability on which we institute an *inter partes* review.”³ In so holding, the Board made no substantive determinations of the Payne-based ground other than finding that the ground was “redundant” of the other two grounds of unpatentability for the interposing claims.

¹ See generally *Shaw Indus. Grp. Inc. v. Automated Creel Sys., Inc.*, IPR2013-00132, 2013 WL 8563792 (P.T.A.B. July 25, 2013) (First Institution Decision).

² Automated Creel System’s patent generally disclosed two types of claims: “noninterposing claims”—which involve creel magazines with two packages of stranded material at each level—and “interposing claims”—which involve creel magazines with more than two packages of standard material at each level.

³ *Id.* at *20 (citing 37 C.F.R. § 42.108).

After the Board issued a final written decision concluding that only the noninterposing claims were unpatentable based on the instituted grounds,⁴ Shaw appealed the Board’s decision not to institute the Payne-based ground. In relevant part, Shaw petitioned for a writ of mandamus instructing the US Patent and Trademark Office (PTO) to reevaluate its redundancy decision and to institute IPR based on the Payne-based ground. The PTO also submitted a brief and presented oral argument on this issue as an intervener.⁵

On appeal, the Federal Circuit found that “Shaw’s argument is predicated on its concern that the statutory estoppel provisions would prevent it from raising the Payne-based ground in future proceedings.”⁶ Section 315(e) of Title 35 provides:

SECTION 315(E)(1)	SECTION 315(E)(2)
Proceedings Before the Office	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) . . . 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.	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) . . . may not assert in either 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.

The PTO, however, argued that Shaw’s interpretation of the estoppel provision was incorrect because the denied ground never became part of the IPR proceeding. According to the PTO, section 315(e) would not estop Shaw from bringing its Payne-based arguments in subsequent proceedings because Shaw did not raise those arguments “during” the IPR proceeding. Although Shaw raised its Payne-based ground in its petition for IPR, the Board did not institute IPR on that ground. And, because an IPR does not begin until it is instituted,⁷ Shaw’s Payne-based argument never became part of the proceeding. Adopting the PTO’s reasoning, the Federal Circuit found that the estoppel provisions would not apply under these circumstances because “Shaw did not raise—nor could it have reasonably raised—the Payne-based ground *during* the IPR.”⁸ So long as the petitioner properly raised the noninstituted ground in its initial petition, it will not be estopped from asserting that ground in future proceedings.

⁴ In its final written decision, the Board held that Shaw had failed to show by a preponderance of the evidence that the interposing claims were unpatentable based on the instituted grounds. *Shaw Indus. Grp. Inc. v. Automated Creel Sys., Inc.*, IPR2013-00132, IPR2013-00584, 2014 WL 3725531 (P.T.A.B. July 24, 2014) (Final Decision).

⁵ See 35 U.S.C. § 143 (“The Director shall have the right to intervene in an appeal from a decision entered by the Patent Trial and Appeal Board in a derivation proceeding under section 135 or in an inter partes or post-grant review under chapter 31 or 32.”).

⁶ *Shaw Indus. Grp. Inc. v. Automated Creel Sys., Inc.*, Nos. 2015-1116, 2015-1119, 2016 WL 1128083, at *5 (Fed. Cir. Mar. 23, 2016).

⁷ See *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1272 (Fed. Cir. 2015), cert. granted sub nom. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 890 (US Jan. 15, 2016) (No. 15-446).

⁸ *Shaw Indus. Grp.*, 2016 WL 1128083, at *5.

FUTURE IMPLICATIONS

The Federal Circuit's decision in *Shaw* emphasizes the difficulty in striking the right balance between preserving the efficiency of IPR proceedings and protecting a petitioner's right to have a reasonable number of grounds considered by the PTO. As the *Shaw* court recognized, "[w]e can see the benefit in the PTO having the ability to institute IPR on only some of the claims and on only some of the grounds, particularly given the Board's statutory obligation to complete proceedings in a timely and efficient manner."⁹ But the Board also owes petitioners, like *Shaw*, a duty to consider properly pleaded grounds, especially where the estoppel rules would preclude meritorious consideration of any noninstituted grounds. The *Shaw* court relaxed the tension between these two competing interests by adopting a transitive reading of section 315(e)—one that removes the estoppel effect from any grounds raised in the petition but ultimately denied by the Board without making any substantive determinations. To hold otherwise would have empowered the PTO to forever bar properly asserted grounds—disclosure of which is required by statute—from meritorious consideration simply by deeming them redundant.

Ultimately, the *Shaw* decision underscores the importance of including all potential grounds of rejection in the petition. Because petitioners will be estopped from asserting in a subsequent proceeding any grounds omitted from their petition, petitioners should—without compromising their strongest arguments for unpatentability—raise all potential grounds of rejection in their initial petition. Where the Board, without making a substantive determination, denies institution on any ground properly asserted in the petition, petitioners will be free to raise those noninstituted grounds in future proceedings.

⁹ *Id.* at *4

FEDERAL CIRCUIT REVERSES PTAB PATENT INVALIDATION BASED ON LACK OF APA DUE PROCESS



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INTER PARTES REVIEW (IPR) PETITIONERS MUST ENSURE ADEQUATE NOTICE OF ARGUMENTS AGAINST VALIDITY; PATENT OWNERS MUST PRESERVE RIGHTS TO DEFEND AGAINST ALL ARGUMENTS RAISED BY PETITIONERS—EVEN WHEN THEY ARISE LATE IN THE PROCESS.

The US Court of Appeals for the Federal Circuit recently decided a case (*In re: NuVasive, Inc.*)¹ in which the patent owner had claims invalidated during IPR but did not have an opportunity to respond to an argument first raised in the petitioner’s reply brief. The Federal Circuit held that this violated the Administrative Procedure Act (APA)—even though the argument had arisen in a related but separate proceeding—and reversed the Patent Trial and Appeal Board (PTAB or the Board).

PTAB AND FEDERAL CIRCUIT DECISIONS

NuVasive involved two IPR proceedings brought by Medtronic to challenge patents directed toward implants for spinal fusion surgery.² The Board issued separate decisions invalidating the patents as obvious in view of the prior art in the field. In the Federal Circuit’s words, the Board “relied heavily” on an earlier patent (Michelson) that it found to meet the requirement of *NuVasive*’s patent that the spinal implant be both long and narrow. In one IPR, Medtronic successfully advanced the Michelson argument. In the other IPR, however, Medtronic did not make a similar Michelson argument until the reply brief (even though it had made other arguments involving that particular patent). Despite requests from *NuVasive*, the Board did not allow a sur-reply to address the newly raised Michelson argument or let *NuVasive* rebut the point during oral argument.

¹ *In re: NuVasive, Inc.*, 841 F.3d 966 (2016).

² Medtronic later settled with *NuVasive* and did not participate in the appeal, leaving the US Patent and Trademark Office (PTO) to intervene in order to defend the PTAB’s rulings.

The Federal Circuit upheld the Board's invalidity decision in the first IPR since NuVasive had "at least minimally sufficient" opportunity to respond to the Michelson argument. The court reversed the second IPR ruling, though, holding that the agency "violated NuVasive's rights under the Administrative Procedure Act" by not allowing NuVasive to respond to material called out in the reply that was relied upon by the Board in making its determination. The Federal Circuit rejected the PTO's arguments that

- NuVasive had notice because of the parallel review; and
- NuVasive's submission of "observations"—based on the cross-examination of Medtronic's expert made after the denial of both a sur-reply and a motion to strike—sufficed for opportunity to respond to the Michelson argument. The court held that, because the Board conducted two separate proceedings, notice of the argument in one of them does not provide notice in the other. Additionally, the filing of "observations" is "tightly circumscribed" and does not "substitute for the opportunity to present arguments and evidence."

CONSIDERATIONS FOR FUTURE PTAB LITIGATION

This case is instructive for petitioners and patent owners alike. First, petitioners should ensure that the patent owner has adequate notice of all arguments that will be raised in a proceeding, i.e., they need to present their entire case in the petition. At the same time, petitioners should not be afraid to raise arguments late in a proceeding but should allow the patent owner an opportunity to respond to late-raised arguments (e.g., via a sur-reply).

As this case shows, neither the PTAB nor the Federal Circuit struck the argument that was not made until the reply brief, and the Federal Circuit specifically said that the Board was not precluded "from considering the import of Michelson's Figure 18 after giving NuVasive a full opportunity to submit additional evidence and arguments on that point."

In addition, patent owners should be vigilant of their due process rights and take all steps to preserve their rights on appeal, e.g., by requesting authorization to file a sur-reply or a motion to exclude or strike, as well as raising any new issues at the hearing. Had NuVasive not taken those steps in this case, it seems likely that the Federal Circuit would have held the challenge waived.

FEDERAL CIRCUIT TOSSES PTAB DECISION



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IPR PARTIES TAKE HEED: RAISING NEW FACTS AT ORAL ARGUMENT MAY RESULT IN A PTAB DECISION THAT IS INDEFENSIBLE ON APPEAL

The Federal Circuit recently vacated a decision by the PTAB for relying on facts raised for the first time at oral argument.

On March 15, 2016, the US Court of Appeals for the Federal Circuit vacated a decision by the Patent Trial and Appeal Board (PTAB or the Board) cancelling a claim in an *inter partes* review because the Board based its decision on an assertion raised by the petitioner for the first time at oral argument.¹ The decision underscores the importance of raising all essential facts and arguments in the papers presented to the Board prior to oral argument and signals that the Federal Circuit will likely look with disfavor upon any Board decision that purports to rest on new arguments raised at oral argument.

THE DECISION

In *Dell Inc. v. Accelaron, LLC*, the Petitioner sought *inter partes* review of Accelaron, LLC's blade server patent, contending, among other things, that a prior art patent anticipated a challenged claim by disclosing the required "caddie" claim element. In its petition, Petitioner argued that the prior art reference's articulating door performed the same function as the caddie limitation. The Federal Circuit, however, found that Petitioner subsequently advanced two additional invalidity arguments relating to this limitation that were not articulated in its initial petition. As the Federal Circuit explained in its decision, one of these arguments was raised for the first time in Petitioner's reply to the patent owner's arguments and evidence, and the second was raised for the first time during oral argument before the Board. In its decision, the Board relied on the argument raised during oral argument to find the challenged claim invalid as anticipated over the prior art reference.

On appeal, the Federal Circuit vacated the Board's ruling, holding that the Board could not properly rely upon arguments that were not raised in the papers. The court noted that the Administrative Procedural Act imposes particular requirements on the US Patent and Trademark Office (PTO) for conducting administrative trials. An agency must (1) "timely inform[] the patent owner of matters of fact and law asserted," (2) "provide all interested parties opportunity for the submission and consideration of facts [and] arguments," and (3) "allow a party . . . to submit rebuttal evidence . . . as may be required for a full and true disclosure of the facts."²

¹ See generally *Dell Inc. v. Accelaron, LLC*, Nos. 2015-1513, 2015-1514, 2016 WL 1019075 (Fed. Cir. Mar. 15, 2015).

² *Id.* at *6 (internal quotations and citations omitted).

Quoting the Office Patent Trial Practice Guide, the court found that the PTO's procedural rules reflect these fundamental requirements by prohibiting parties from presenting evidence or arguments not relied upon in any previously submitted papers:

[A] party . . . may only present arguments relied upon in the papers previously submitted. No new evidence or arguments may be presented at the oral argument.³

The court found that without receiving notice prior to oral argument, a patent owner is not given an adequate opportunity to present rebuttal evidence. Because the Board relied on a contention raised for the first time at oral argument, the court vacated the Board's decision.

FUTURE IMPLICATIONS

The Federal Circuit's decision gives teeth to the Board's rules designed to prevent parties from gaining an unfair tactical advantage by making last-minute changes to their contentions. The decision also demonstrates the Federal Circuit's willingness to police situations where a party does not receive fair notice and an opportunity to respond. Although the court did not address what circumstances, if any, permit an argument to be raised for the first time in a reply, the Federal Circuit's decision suggests that it would look with disfavor on any Board decision resting on newly raised arguments where a patent owner was not afforded a meaningful opportunity to respond.

In light of this decision, parties participating in an IPR proceeding should consider objecting to any newly raised arguments by seeking early intervention by the Board. The Board has indicated that the proper procedure for raising such an objection is to first schedule a call with the Board to address any arguments raised outside the initial papers, as the patent owner did in *Dell*. During that call, the objecting party may seek relief in multiple ways,⁴ including, for instance, seeking permission to move to strike the newly raised arguments or, in the alternative, permission to file a sur-reply. Even if the Board denies its request, the objecting party will have, at the very least, preserved the objection for appeal.

Ultimately, the Federal Circuit's decision serves as a reminder to all *inter partes* review parties of the importance of fully developing their contentions at the outset to ensure that all essential facts and arguments are included in their initial papers.

³ *Id.* (quoting Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012)).

⁴ See *Belden Inc. v. Berk-Tech LLC*, 805 F.3d 1064, 1081-82 (Fed. Cir. 2015) (noting that "if the petitioner submits a new expert declaration with its Reply, the patent owner can respond in multiple ways"); see also *id.* ("The tribunal has broad discretion to regulate the presentation of evidence under Fed. R. Evid. 611(a).").



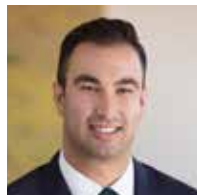
AVOIDING A PATENT WAR ON TWO FRONTS



WHILE IPR AND CBM REVIEW CONTINUE TO GROW IN POPULARITY, THE UNCERTAINTY OF OBTAINING A STAY IN THE UNDERLYING DISTRICT COURT PROCEEDING MAY LEAVE DEFENDANTS WAGING A WAR ON TWO DIFFERENT FRONTS.



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Since the enactment of the America Invents Act of 2011 (AIA), defendants have increasingly employed *inter partes* review (IPR) and covered business method (CBM) review proceedings to combat patent infringement claims.

While their reduced cost, expedited timeline, and high invalidity rates make IPR and CBM review attractive litigation strategies, their appeal often hinges on a defendant's ability to obtain a stay of the underlying district court action after filing an IPR/CBM petition. But this is far from guaranteed. Quite the opposite; stay motions are often met with mixed results because district courts apply the three stay factors inconsistently: (1) whether the proceedings are at an advanced stage; (2) whether a stay will simplify the issues in question; and (3) whether a stay would unduly prejudice or present a clear tactical disadvantage to the nonmoving party.¹ As a result, it is difficult for defendants to estimate their likelihood of obtaining a stay accurately, and all too often find themselves waging a war on two different fronts.

To determine the success rate for motions to stay pending IPR/CBM review, we analyzed every district court order on these motions up to June 15, 2016,² amounting to a total of 884 decisions. For the 752 decisions on stay requests pending IPR, we found that roughly 70% of these requests—529 in total—were granted, reflecting a higher success rate than we originally expected. Upon closer examination, however, the data revealed that nearly 45% of these stay requests were stipulated. Once the stipulated requests were removed, the grant rate for the stay motions dropped to 58%. Simply put, only 290 contested motions to stay pending IPR have been granted to date. And while the total number of stay requests pending CBM review trails significantly behind that of IPR (one-fifth that number to be exact), the success rate for contested motions to stay pending CBM review came out to 61%—just 3% percent higher than IPR.

Our study also identified several factors—other than three enumerated above—that contribute to a higher likelihood of success. For instance, parties who stipulate to a stay enjoy a 97% grant rate—38% higher than those who do not. But parties seeking a contested stay can also increase their odds by reconsidering the procedural timing and jurisdiction in which the motion is filed. Indeed, as explained below, litigants can maximize the success rate for contested motions to stay pending IPR/CBM review by considering these two additional factors.

CONTESTED STAY REQUESTS ARE MORE SUCCESSFUL WHEN FILED AFTER INSTITUTION

Timing—i.e., whether a party requests a stay before or after the Patent Trial and Appeal Board (PTAB or the Board) issues its institution decision—also impacts the likelihood of success. Although the Board has up to six months from the filing of the petition to issue an institution decision,³ we found that litigants who waited to request a stay until after the Board instituted trial significantly increased their chances of obtaining a stay. For example, while only half of all contested motions to stay pending IPR filed *before* the institution decision were granted, the grant rate for those motions jumped to 71% when filed *after* institution.

The same holds true for contest stay requests pending CBM review: those who delay moving for a stay until after the Board institutes trial benefit from a 71% success rate—18% higher than those who do not.

¹ *TAS Energy, Inc. v. San Diego Gas & Elec. Co.*, No. 12-cv-2777, 2014 WL 794215, at *3 (S.D. Cal. 2014). In the context of CBM review, Congress codified this three-factor test and added a fourth factor, which requires courts to consider “whether a stay, or the denial thereof, will reduce the burden of litigation on the parties and on the court.” America Invents Act of 2011 (AIA) § 18(b)(1), Pub. L. No. 112-29, 125 Stat. 284,331 (2011).

² The data and figures discussed herein are current as of June 1, 2016. Although care has been taken to ensure the data's accuracy, these statistics should be viewed as estimates. As the basis for all data gathered prior to September 1, 2015, this article relies on the findings from the following publication: Amy E. Simpson et al., *Trends on Requests to Stay Pending IPR/CBM Review*, Inter Partes Review Proceedings: A Third Anniversary Report (Perkins Coie, San Diego, Cal.), Sept. 2015, at 41-36.

³ Trial Practice Guide, 77 Fed. Reg. 48,756, 48,757 (Aug. 14, 2012).

SUCCESS RATE OF MOTIONS TO STAY PENDING IPR/CBM REVIEW BASED ON TIMING

District Court Order	Requests to Stay Pending IPR	Requests to Stay Pending CBM
Total	752	132
Stays GRANTED	529	91
Granted <u>Before</u> Institution Decision	301	53
<i>Contested</i>	151	32
<i>Stipulated</i>	150	21
Granted <u>After</u> Institution Decision	228	38
<i>Contested</i>	139	30
<i>Stipulated</i>	89	8
Stays DENIED	215	41
Denied <u>Before</u> Institution Decision	153	29
<i>Contested</i>	150	28
<i>Stipulated</i>	3	1
Denied <u>After</u> Institution Decision	62	12
<i>Contested</i>	57	12
<i>Stipulated</i>	5	0
Automatic Stays Under 315 (a)(2)	2	0

These findings may be explained by the long-standing practice of certain districts to deny stay requests until the PTAB makes an institution decision. The Eastern District of Texas, for example, has adopted a “universal practice” to “postpone[] ruling on stay requests or [] den[y] stay requests when the PTAB has not yet acted on the petition for review.”⁴ As Federal Circuit Judge Bryson explained, “the most important factor in determining whether to stay litigation pending inter partes review [is] whether the PTAB has acted on the defendants’ petition for review.”⁵

But not all districts have adopted this practice. Several districts have found that the expedited nature of IPR/CBM proceedings along with the PTAB’s high institution rate favors staying the case once the petition is filed.⁶ That being said, more districts may begin subscribing to the “universal practice” if the PTAB’s institution rate continues to trend downward—which has fallen to 51% for IPR petitions and 55% for CBM petitions as of June 30, 2016.⁷ Nevertheless, litigants can increase their odds by moving for a contested stay after institution.

⁴ *Trover Grp., Inc. v. Dedicated Micros USA*, 2015 WL 1069179, at *5-6 (E.D. Tex. Mar. 11, 2015)

⁵ *Id.* at *4.

⁶ See, e.g., *Irori Techs., Inc. v. Luminex Corp.*, No. 3:13-cv-2647, Dkt. 41 at 5-6 (S.D. Cal. July 16, 2014).

⁷ United States Patent and Trademark Office, Patent Trials and Appeal Board Statistics, June 30, 2016, at 10, 11: <http://www.uspto.gov/sites/default/files/documents/2016-6-30%20PTAB.pdf> (<http://www.uspto.gov/sites/default/files/documents/2016-6-30%20PTAB.pdf>) (last accessed July 30, 2016).

SUCCESS RATES ALSO VARY BY JURISDICTION

Certain jurisdictions continue to be more favorable venues for seeking a stay, with an overall higher success rate for contested stays pending IPR than other districts. The table below presents the four most favorable districts and their categorical rankings based on this metric. Notably, while the Northern District of California continues to be the most active district, it also ranks second in terms of success rate for contested stay requests.

FAVORABLE JURISDICTIONS FOR CONTESTED STAYS PENDING IPR					
Overall Ranking	District Court	Total Stay Requests	Stipulated Requests	Contested Stays Granted	Contested Stays Grant Rate
1	N.D. Ill.	34	12	18	82%
2	N.D. Cal.	104	32	53	74%
3	S.D. Ohio	10	1	6	67%
4	D. Mass.	23	5	11	61%

Other districts, however, are much less likely to grant contested stay requests. The Eastern District of Texas, for instance, holds true to its plaintiff-friendly reputation by boasting a mere 25% success rate for contested stay requests pending IPR—33% lower than the national average—despite having one of the busiest patent litigation dockets in the country.

UNFAVORABLE JURISDICTIONS FOR CONTESTED STAYS PENDING IPR					
Overall Ranking	District Court	Total Stay Requests	Stipulated Requests	Contested Stays Granted	Contested Stays Grant Rate
1	E.D. Tenn.	6	1	5	0%
2	E.D. Tex.	64	24	24	25%
3	D.N.J.	11	3	5	27%
4	S.D. Ind.	10	2	5	30%

Although the likelihood of success for each motion to stay will vary based on the facts at hand, parties can still maximize their chances by stipulating to a stay whenever possible. For contested stay requests, litigants can increase their odds by requesting a stay after the Board institutes trial. To minimize any burdens caused by this delay, defendants should also consider petitioning for IPR/CBM review as soon as possible, rather than at the tail-end of the one-year time bar.



PATENT REFORM INCREASINGLY RISKS DEADLOCK



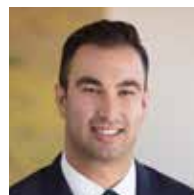
FOR THE LAST DECADE, IP LEGISLATION WAS A BRIGHT SPOT FOR A CONGRESS OTHERWISE MIRED IN PARTISAN GRIDLOCK. BUT NOW, THE BIPARTISAN ENGINE OF IP REFORM SEEMS TO HAVE PETERED OUT.



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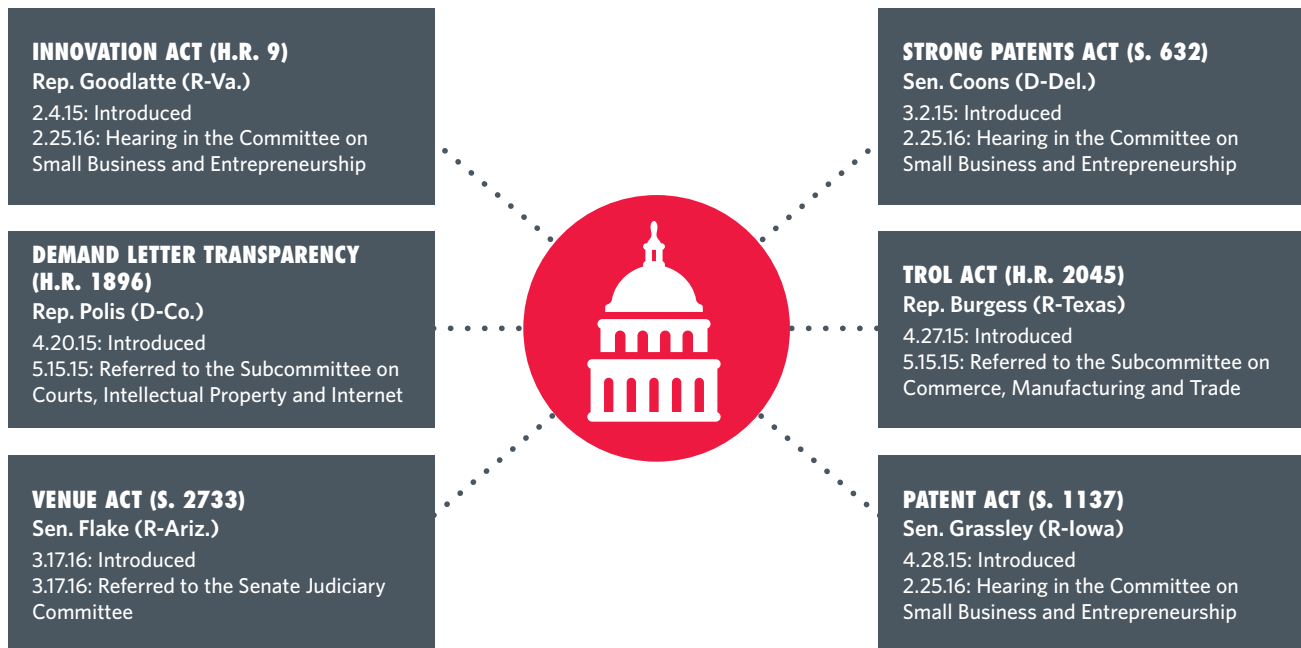


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For the last decade, intellectual property legislation was a bright spot for a Congress otherwise mired in partisan gridlock. In 2011, Democrats and Republicans in Congress united to pass the Leahy-Smith America Invents Act (AIA). And just this last May, President Barack Obama signed into law the Defend Trade Secrets Act, which modernizes and strengthens trade secret law by adding new federal civil trade secret remedies and increasing the maximum criminal penalties for misappropriation.

But now, the bipartisan engine of intellectual property reform seems to have petered out. Why this loss of steam? While there is no single answer, two reasons are common: first, judicial changes to the law have obviated the need for many of the contemplated reforms; second, Patent Assertion Entities (PAEs) and other IP owners have been successful in countering patent reform advocates and maintained a legislative stalemate.

While patent reform has languished in Congress, it has moved at a relatively blistering pace in the courts. Since passage of the AIA, the Supreme Court has heard and decided 20 patent cases. These decisions have expanded the district court's power to grant attorney fees, *Highmark Inc. v. Allcare Health Management Systems Inc.*, 134 S. Ct. 1744 (2014), and award treble damages, *Halo Electronics, Inc. v. Pulse Electronics Inc.*, 136 S. Ct. 993 (2016), much as the Patent Act (S. 1137) and Strong Patents Act (S. 632) would have. Similarly, the Supreme Court, through its annual revisions to the Federal Rules of Civil Procedure, eliminated the form pleadings (Supreme Court of the United States, Order Regarding Amendments to the Federal Rules of Civil Procedure (Apr. 29, 2015)), in effect raising the patent pleading requirements from bare-bones complaints to the heightened plausibility standard articulated in *Bell Atlantic v. Twombly*, 550 U.S. 544 (2007), and *Ashcroft v. Iqbal*, 556 U.S. 662 (2009). A similar amendment to the pleading standard would have been effectuated by the Innovation Act.



But many of the goals of patent reformers are yet to be achieved. For instance, several of the proposed reforms address the asymmetrical discovery burdens and expenses that exist in patent disputes. Currently, plaintiffs can satisfy the pleading requirements and compel discovery without much cost, while defendants are forced to incur discovery costs by providing responsive information that plaintiffs could have obtained through their own pre-filing investigation. The Patent Act alters the cost and structure of discovery by requiring a court to stay discovery pending the resolution of motions to dismiss, transfer venue, and sever accused infringers. And if the claims need to be construed by the court, the Innovation Act (H.R. 9) limits discovery to information necessary for the court to determine the meaning of the terms used in the patent claim. While amended Federal Rule Civil of Procedure 26(b)(1) limits discovery “proportional[ly] to the needs of the case”—potentially easing the litigation burden on both sides—these legislative reforms would directly benefit defendants by changing the timing for discovery and ultimately affording greater leverage to settle cases against PAEs by avoiding lopsided discovery costs early in litigation.

One force stopping patent reform is an increasingly fractured community, and much of the debate has been increasingly driven by public pressure rather than academic and industry discourse. On July 22, 2011, “This American Life” ran an hour-long documentary titled “When Patents Attack,” focusing on the disproportionate litigation costs and pressure that PAEs bring against small businesses. On April 19, 2015, late night news host and comedian John Oliver ridiculed the state of the nation’s venue laws and discussed the large number of cases filed in the Eastern District of Texas. In addition, advocacy groups like the Electronic Frontier Foundation and Public Knowledge have spearheaded a campaign dedicated to driving a mass movement to radically reform the patent system.

But PAEs and similarly aligned think tanks and organizations have not sat idly by. One of the competing pieces of legislation, the Strong Patents Act, sits philosophically opposed to the innovation and patent acts. It focuses on empowering patent holders by weakening post-issuance review. As one example, it would add a “presumption of validity” to *inter partes* review and similar proceedings. It would also block all review proceedings by persons without Article 3 standing, and prohibit anonymous petitions. Outside of the Patent Trial and Appeal Board, the Strong Patents Act would expand the doctrine of indirect infringement by legislatively overruling the Supreme Court’s holding in *Limelight Networks Inc. v. Akamai Technologies Inc.*, 134 S. Ct. 2111 (2014), and allowing a finding of induced or contributory infringement even where a patented process is not practiced by a single entity.

With two increasingly vocal sides to the patent reform debate, this once bipartisan issue increasingly risks deadlock. But not all hope for reform is lost. Skeptics should recall that even when debate is less rancorous, reform can move very slowly. The lauded AIA was largely modeled after the Patent Reform Act of 2009, which in turn was modeled after the Patent Reform Act of 2007 and so on, back to the Federal Trade Commission recommendations from 2003. Even if not passed this term, today’s bills could still be tomorrow’s laws.

ADDITIONAL INSIGHTS ON POST-GRANT PROCEEDINGS



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