

# PTAB Strategies and Insights

December 2019



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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 you will find two articles covering:

- A potentially winning strategy for gaining approval to amend claims during an IPR proceeding – a recent decision in *Lectrosonics v. Zaxcom* suggests that amendments directed toward objective indicia can win Board approval for amending claims;
- An important precedential decision out of the PTAB's Precedential Opinion Panel highlighting standards for printed publications at the institution and final written decision milestones in IPRs.

This is the last newsletter for 2019, but we will be back with fresh cases and strategic guidance in 2020. In addition, you should look for our year-in-review publications early in 2020. The first will cover the most important PTAB cases decided at the Federal Circuit in 2019. The second will cover the most important developments at the PTAB itself.

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 Eisenberg

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## **AMENDING CLAIMS IN IPR: OBJECTIVE INDICIA MAY BE A STRATEGIC GUIDE POST**

By: Johannes K. Buhl and [Trey Powers, Ph.D.](#)

As PTAB practitioners know, statistics on successful motions to amend are quite dismal[1]. But in a recent case, the PTAB shed light on what may be a successful strategy for patent owners to amend their claims in an *Inter Partes* Review.

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## **PTAB PRECEDENTIAL OPINION PANEL CLARIFIES THE STANDARD FOR ESTABLISHING A REFERENCE AS A PRINTED PUBLICATION AT INSTITUTION**

By: [Pratibha Khanduri, Ph.D.](#)

In a recent precedential decision, *Hulu, LLC v. Sound View Innovations, LLC*[1], the Patent Trial and Appeal Board's Precedential Opinion Panel (POP) clarified the standard for establishing a reference as a "printed publication" at the time of institution of an *inter partes* review. The POP held that at the institution, a petitioner must establish a *reasonable likelihood* that a reference is a printed publication.[2]

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By: Johannes K. Buhl and [Trey Powers, Ph.D.](#)

As PTAB practitioners know, statistics on successful motions to amend are quite dismal[1]. But in a recent case, the PTAB shed light on what may be a successful strategy for patent owners to amend their claims in an *Inter Partes* Review.

In *Lectrosonics v. Zaxcom*, the PTAB found all of the claims of the challenged patent invalid as anticipated or obvious over prior art, but granted the patent owner's Contingent Motion to Amend. The PTAB found that the proposed amended claims had a sufficient nexus to Zaxcom's objective indicia of non-obviousness, and were therefore patentable.

Following an infringement suit, Lectrosonics sought an IPR, which the PTAB instituted. The challenged claims recited systems and methods for "combining" locally recorded audio data with remotely recorded audio data using a wearable device. In its case-in-chief, Zaxcom proffered evidence of objective indicia of non-obviousness including industry praise, long felt need, and failure of others. However, the PTAB did not find this evidence sufficient because, the PTAB found that the proffered evidence related to the elimination of "dropouts," which are caused by, e.g. a loss of audio data when a recording source moves out of wireless range. In contrast, the challenged claims were broader, encompassing situations where audio data is merely "combined," without necessarily having any tie to a drop out event.

Before considering the patentability of the substitute claims, the Board determined that Zaxcom had met the statutory and regulatory requirements for the motion to amend, first set forth in a precedential case involving the same parties in march 2019. The board found that Zaxcom met the requirements as they: (1) proposed a reasonable number of substitute claims, (2) showed that the proposed substitute claims respond to a ground of unpatentability involved in the trial, and (3) these substitute claims did not enlarge the scope of the claims or introduce new subject matter.

Subsequently, the PTAB held that Zaxcom's amended claims, as a matter of fact, *did* have a sufficient nexus to the praise its commercial embodiment received. The amended claims specifically recited "replacing" audio data with locally recorded audio data. According to the PTAB, Zaxcom received industry praise for the "replacing" feature. Indeed, Zaxcom showed that its inventors received a technical Emmy award from the National Academy of Television Arts and Sciences for its commercial product. The Emmy related to the product's ability to eliminate

“dropouts” by “replacing” audio data and thereby dramatically simplify the recording process. And both parties’ experts agreed that the industry praise related to the elimination of “dropouts” afforded by the invention.

### **Take-home-message**

This case provides a strategy for patent owners seeking a motion to amend. By tailoring substitute claims so they have a sufficient nexus to objective indicia, patent owners may increase their chances of prevailing. Accordingly, patent owners should consider not just the prior art in preparing substitute claims. They should also determine whether they can craft valuable substitute claims with a nexus to any potential objective indicia of non-obviousness.

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[1]Patent Trial and Appeal Board Motion to Amend Study, Installment 4: Update through March 31, 2018, page 7, found [here](#).

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The POP, applying the statutory “reasonable likelihood” standard for institution under 35 U.S.C. § 314(a), held that at the institution stage, the petition must identify, with particularity, evidence sufficient to establish a reasonable likelihood that a reference was publicly accessible before the critical date to qualify as a printed publication.[3] The POP emphasized that this standard is higher than a typical notice pleading standard but lower than the preponderance of the evidence standard required to prevail in a final written decision.[4] Although the POP stated that the reasonable likelihood and preponderance of the evidence standards are “qualitatively different,” it did not articulate the precise scope of that difference.[5] Thus, if an IPR is instituted, the petitioner must ultimately prove that the reference is a printed publication by a preponderance of the evidence to prevail in a final written decision.[6] The POP also rejected any presumption in favor of institution or in favor of finding a reference to be a printed publication under 37 C.F.R. § 42.108(c) or any other authority at the institution stage.[7]

Adopting a flexible approach, the POP stated that the accessibility indicia (e.g., conventional markers of publication, such as a copyright date, edition identifies, publication by a commercial publisher, publication date, and the assignment of an ISBN number) are considered as part of the totality of the evidence.[8] While refusing to hold any particular accessibility indicia *per se* sufficient at the institution stage, the POP pointed out some past cases where it found that the petition provided strong indicia establishing reasonable likelihood that a reference was publicly accessible[9], and where the petition failed to do so.[10]

In the case at hand, the POP reversed the Board, finding that the petitioner, Hulu, had established a reasonable likelihood that the reference-at-issue, Dougherty, is a printed publication that was publicly accessible before the critical date. The copy of Dougherty submitted as evidence with the petition had a copyright date, a printing date, and an ISBN date—all of which were before the critical date. In addition, Dougherty was a textbook from an

established publisher and a well-known book series. The Board found that this was sufficient evidence to establish a reasonable likelihood that Dougherty is a printed publication that a publisher made available to the pertinent public prior to the critical date.[11]

While Hulu had submitted a different version of Dougherty (with an earlier copyright date, printing date, and ISBN date) with a librarian's affidavit to establish public accessibility prior to the critical date, the Board found that the affidavit was not necessary to meet the burden at this stage. Moreover, even if the affidavit was considered, it did not change the Board's decision as it accompanied an earlier version of Dougherty.[12]

## Take Away

Although the POP adopted the reasonable likelihood evidentiary standard at institution, petitioners should still err on the side of presenting strong evidence in the petition to be able to meet the preponderance of the evidence standard, which will be required to prevail in a final written decision.

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[1] IPR2018-01039, Paper 29 (December 20, 2019).

[2] *Id.* at 21.

[3] *Id.* at 13.

[4] *Id.*

[5] *Id.* at 13–14 (citing *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016)).

[6] *Id.* at 21.

[7] *Id.* at 16.

[8] *Id.* at 17–18.

[9] *Id.* at 18–19 (citing *Syncro Soft SRL v. Altova GmbH*, IPR2018-00660, Paper 6 at 8–10 (PTAB Sept. 5, 2018); *Sandoz Inc. v. Abbvie Biotechnology Ltd.*, IPR2018-00156, Paper 11 at 8–13 (PTAB June 5, 2018); *Seabery N. Am. Inc. v. Lincoln Global, Inc.*, IPR2016-00840, Paper 11 at 7–8 (PTAB Oct. 6, 2016)).

[10] *Id.* at 19 (citing *In-Depth Geophysical, Inc. v. Conocophillips Co.*, IPR2019-00849, Paper 14 at 4–13 (PTAB Sept. 6, 2019); *Argentum Pharm. LLC v. Research Corp. Tech., Inc.*, IPR2016-00204, Paper 19 at 8–12 (PTAB May 23, 2016)).

[11] *Id.* at 19–20.

[12] *Id.* at 20.

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