

# Patent Practice in View Of PTAB AIA Proceedings

FOR: NVPLC Meeting, Tysons Corner, VA  
May 4<sup>th</sup>, 2016

By: Rick Neifeld, Neifeld IP Law, PC

<http://www.Neifeld.com>

# Resources

Paper – [PTAB AIA Proceedings in the USPTO](#)

Cases - <http://www.neifeld.com/cases.pdf>

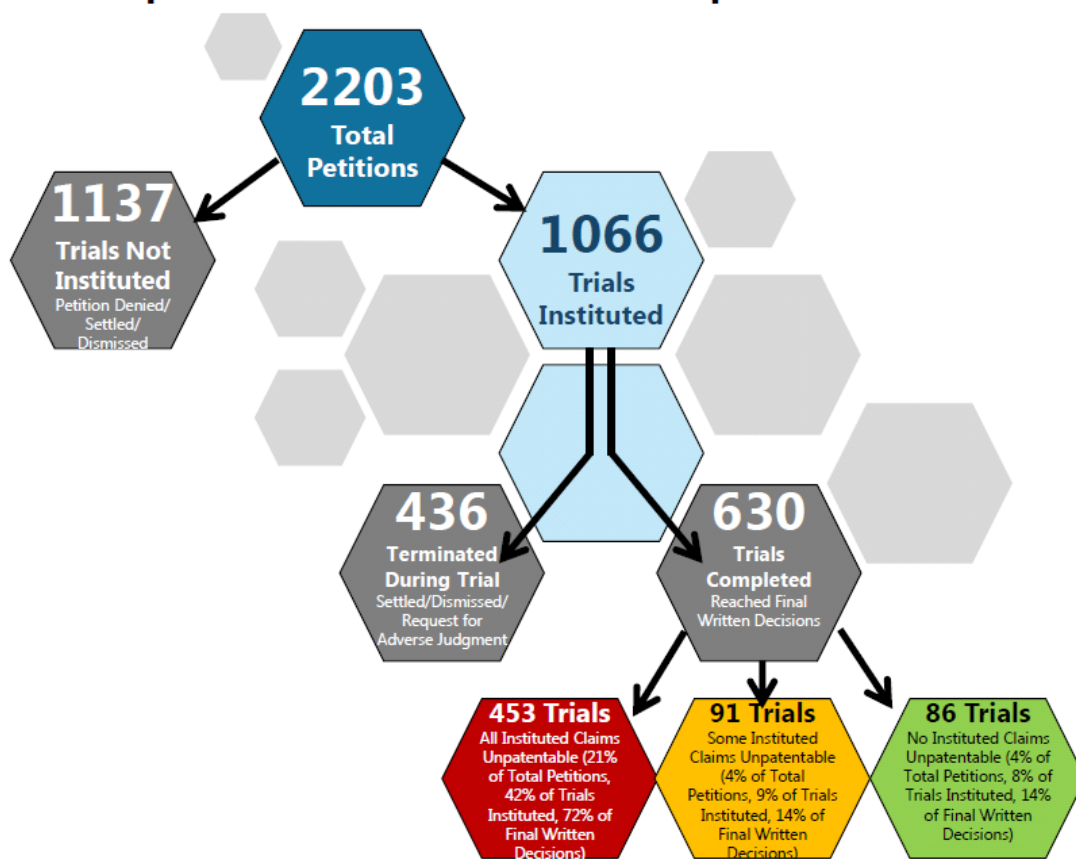
PatentInterPartes - <https://groups.yahoo.com/neo/groups/PatentInterPartes/info>

# OUTLINE

- Importance
- Impact On Practice  
(From Invention Through Patent  
Dispute)

# Importance

## Disposition of IPR Petitions Completed to Date\*



### Narrative:

This graph shows a stepping stone visual depicting the outcomes for all IPR petitions filed to-date that have reached a final disposition.

\*Data current as of: 10/31/2015



# Importance on D.Ct. Action

- *Relative* Claim Kill Probability
- *Relative* Speed
- Stays, Estoppel, PTAB  
Evidentiary Value

# PTAB Impact On Practice

- Time Of Invention
- Potential Infringement
- Civil Actions and PTAB Filings

# Time of Invention

- Claim Diversity
- Continuing Applications
- Specification Admissions and Background Teachings
- Prosecution Disavowal

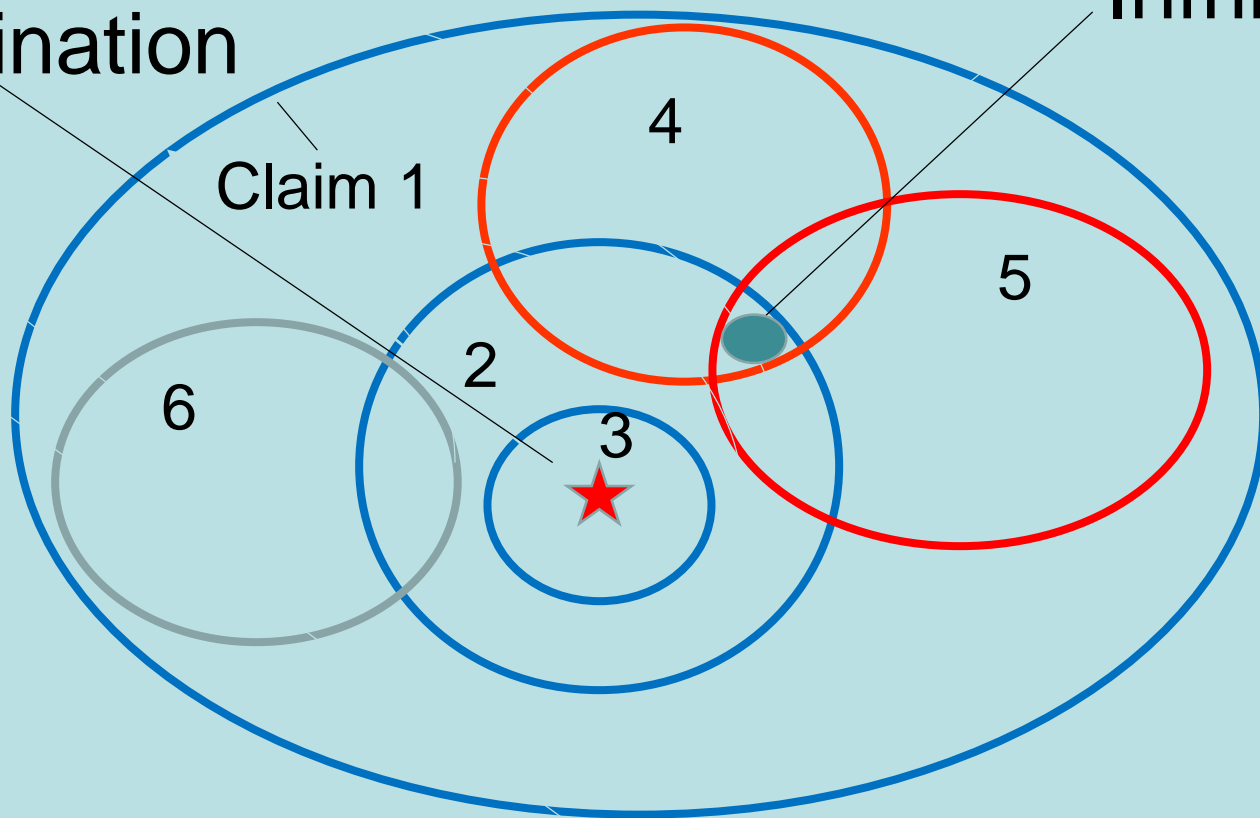
# Claims Versus Petition Grounds

Prior art

Combination

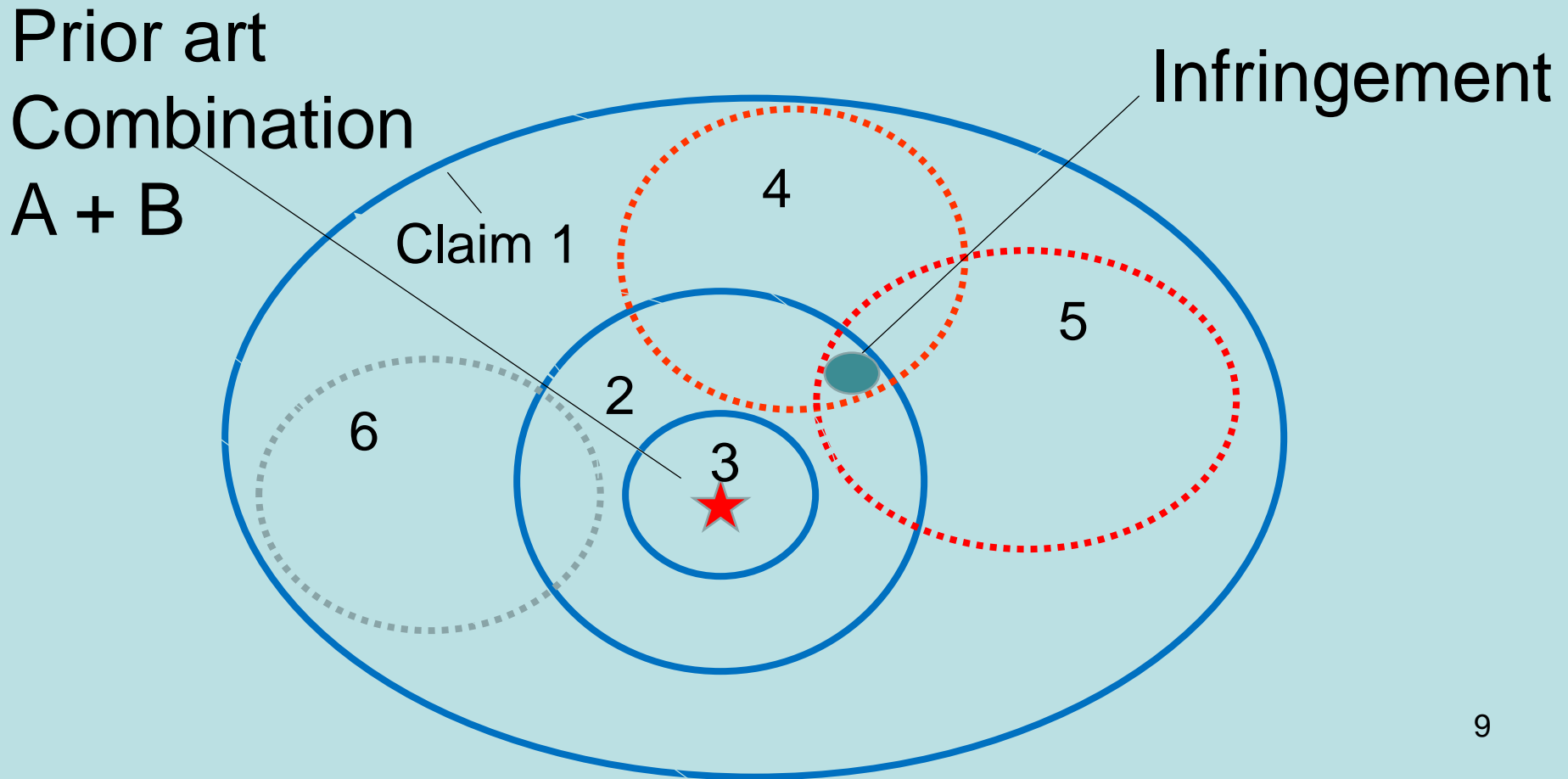
A + B

Infringement





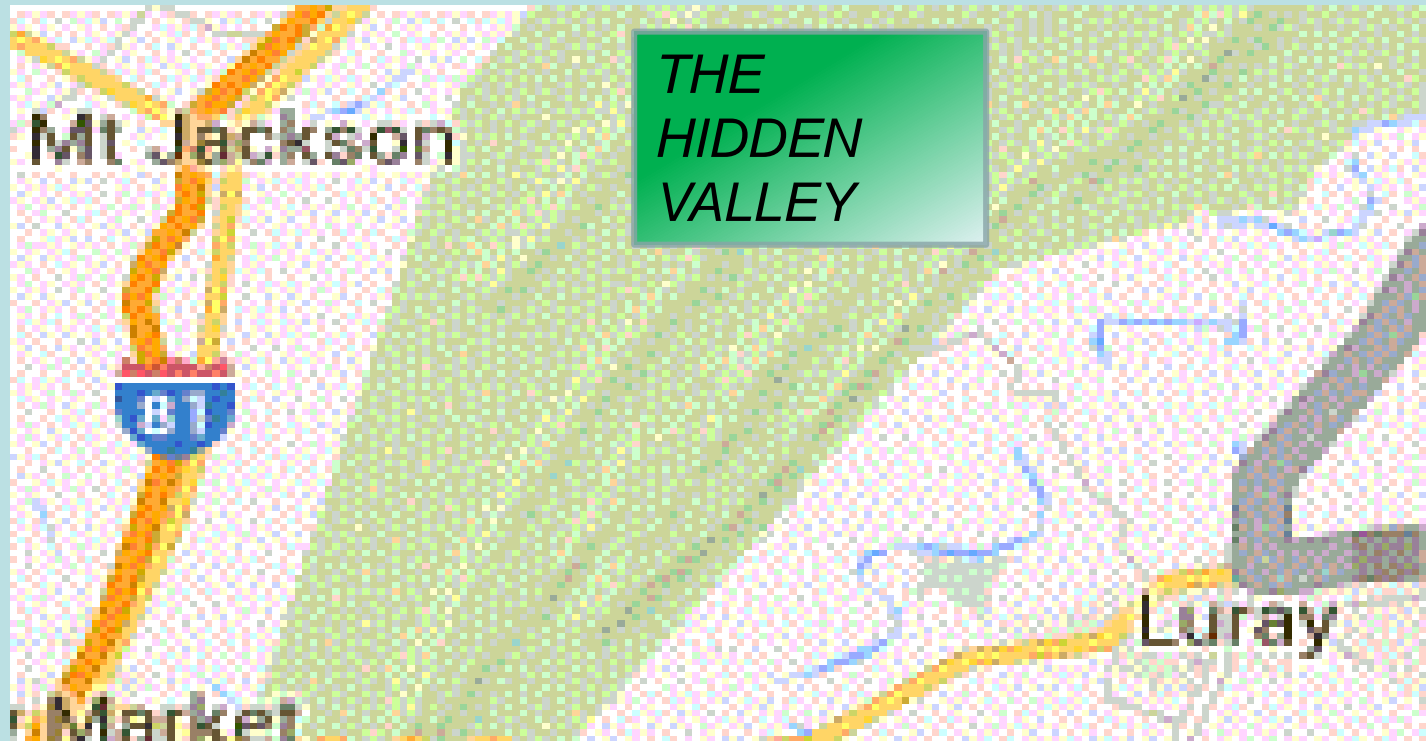
# Patented Claims Versus Mot. To Am.



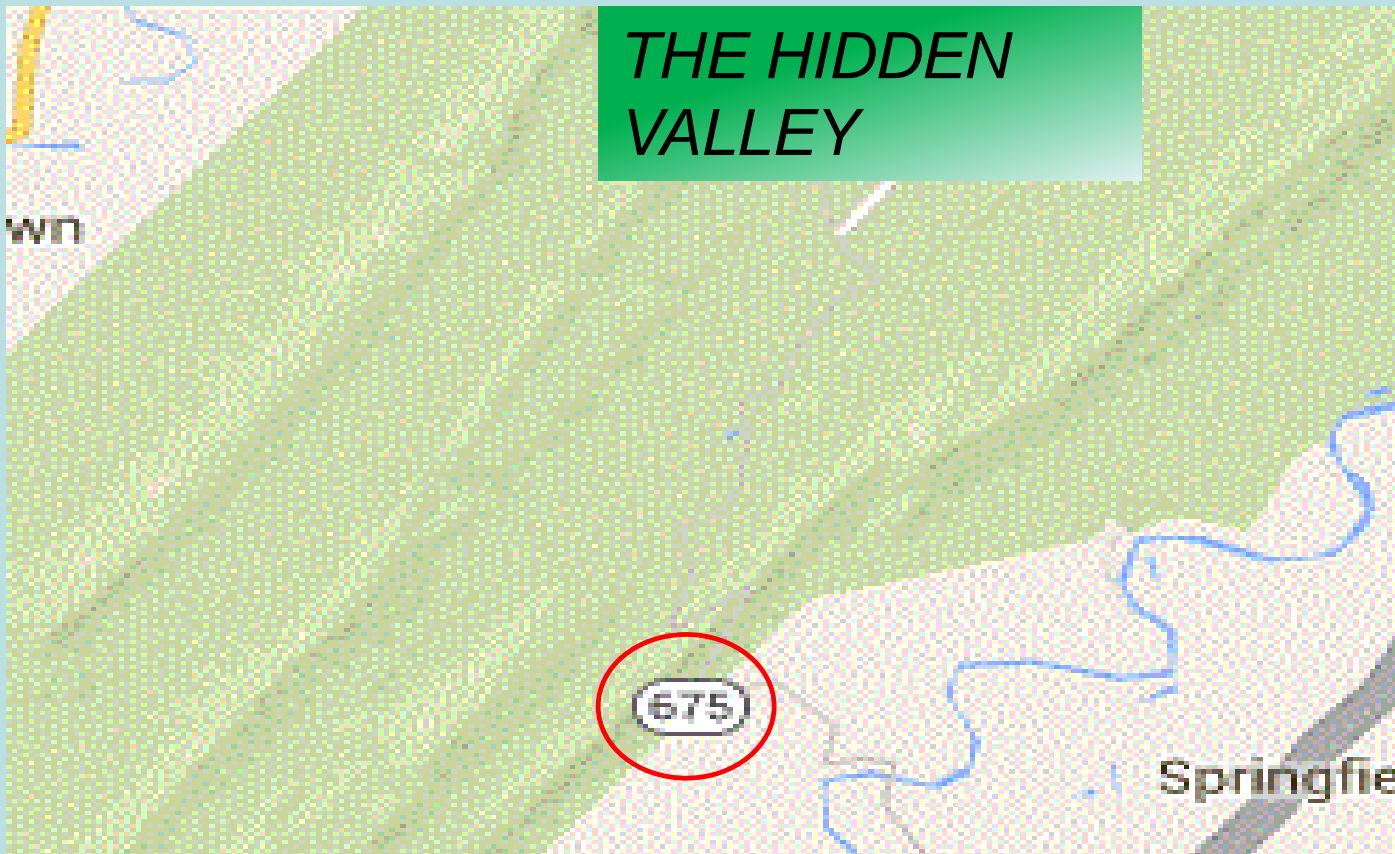
# Conclusion

Patent Claim Diversity Makes it  
More Difficult to Challenge a  
Patent with PTAB Petitions

# Hidden Valley



# Specification Blaze Marks



# Conclusion

Identification In the  
Specification of State of the Art  
and Problems in the Art Make it  
Easier to Show Claim  
Unpatentability

# Prosecution History Disavowal

- *Microsoft Corporation v. Proxyconn* (CAFC 6/16/2015) (BRI includes record evidence; prosecution history)
- Ford Motor Company v. TMC Fuel Injection Systems, LLC, IPR2014-00272, paper 15 (PTAB 6/22/2015) (“In light of Applicant's **unequivocal statements during prosecution**, we determine that there is an express disclaimer of pressure regulators and other forms of incremental regulation as a flow constraint for issued claims 38 and 40.”)

# Conclusion

Prosecution history disavowal  
is a *tool*; use it appropriately.

# TIME OF DISPUTE



# Civil Actions and PTAB Filings

- *Strike First Because Time Is Your Enemy*
- Election/Venue AIA Provisions
- Petition Limitations
- PTAB/Court Timing

# Election/Venue 315/325(a)

- IPR/PGR Barred by DJ Invalidation Action
- DJ Invalidation Action Filed After IPR/PGR is *Automatically Stayed*
- Civil Action/Counterclaim of Infringement Ends the Stay

# Election/Venue 315/325(a)

- The First Filer Rule Applies to Patent Case DJs
- *AIA Intent Was to Allow Petitioner to Select Venue*

# PTAB Petition Limitations - What a Mess!

- FITF or not FITF? *IPR or PGR*
- CBMP? *IPR or CBM*
- CBM pre AIA? Only 102 (a), (b)  
Applies (maybe)

# PTAB Petition Limitations - What a Mess!

- 315(b) Time Bar: “served with a complaint alleging infringement”
- 18(a)(1)(B): “sued for .. or charged with infringement”

# PTAB Petition Limitations - What a Mess!

- Joinder Statutory Issues
- Same Party; Different Issues; and 315(b) Bar Nullification
- Is there Judicial Review?

# CAFC on PTAB Institution Decisions

- CAFC: Institution Decisions and Everything Relating to Them are None of Our Business (!)
- *But see, Cuozzo*, question 2

# Limiting PTAB Estoppel

- Estoppel Applies ***Only*** to a Claim that “results in a final written decision.” (Statute)
- PTAB Enters Final Written Decisions ***Only On Instituted Claims.***



# Limiting PTAB Estoppel

- No Estoppel Against A Claim, On a Ground *Presented* in a Petition, *If That Ground Was Denied Institution*
- *Shaw Industries Group v. Automated Creel Systems*, (Fed. Cir. 3/23/2016); *HP Inc. v. MPHJ Tech. Invs.*, (Fed. Cir. 4/5/2016).

# Design Your Petition To Limit Estoppel

- Limit Claims Challenged
- Unlimited Grounds For Each Petitioned Claim
- (Noting CBM Exception Outside PTO)

# When Will a Court Stay in View of PTAB?

- CAFC Early Guidance
- Statutory CBM Stay Factors
- What Remains Undone; Alignment of PTAB Claims with Issues; *Timing*

# Timing: PTAB vs. D.Ct.

- Slow District Courts Benefit the Defendant/Petitioner, on Validity
- Outcomes Depend Upon Venue

# Median Times from Filing to Trial, Civil Actions (Months)

- E.D. Va. 10
- M.D. Fla. 16.6
- E.D. Tex. 22.9
- D. Del. 30.8
- N.D. Cal. 28
- D. Nev. 35.8
- PTAB Petition ID: 6 And FWD: 17

# Timing: PTAB vs. D.Ct.

- Civil Action Discovery
- Infringement Contentions
- PTAB Petitions
- PTAB institution Decisions

# PTAB Follow-On Petitions

- Can Petitioner Really Learn From Her Mistakes?
- Uncertainty in: 325(d);  
Redundancy; Joinder/315(b)

# PTAB Follow-On Petitions

- In Slow Courts, Follow-On Petitions Will Count
- In Fast Courts, Only Initial Petitions Might Count



# PTAB Proceedings as Evidence

- Motions *in Limine*
- PTAB institution and FWDs
- Issues of Validity and Willfulness

# Conclusions

- PTAB AIA Proceedings Have Changed How We Should Prosecute And Assert Patents
- The Legal Framework For PTAB Petitions Is Still Uncertain (Joinder, Estoppel, 315(b); Scope of Judicial Review; Standard of Review);
- Awaiting S.Ct. Review.

# THANK YOU!

RICK NEIFELD

NEIFELD IP LAW, PC - [www.Neifeld.com](http://www.Neifeld.com)

Email: [rneifeld@Neifeld.com](mailto:rneifeld@Neifeld.com)

TEL: 1-703-415-0012