Post-Grant Patent Webinar

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Mr. Richards is co-chair of the firm’s Post-Grant Patent Practice. He has more than 20 years’ combined experience spanning many areas of intellectual property law including litigation, prosecution and client counseling. He has extensive experience handling both U.S. patents and international patents in software, business methods, pharmaceuticals and chemical processes. He has been involved with interference and post-grant proceedings for software patents and chemical process patents.

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Recent Developments in AIA Proceedings
PTAB Petitions Level Off

- IPR about 140/mo.
- CBM about 12/mo.
- PGR about 1/mo.

*Source: USPTO PTAB Statistics 10/31/2015*
AIA Technologies

- Bio/Pharma seeing big increases
- In Oct 2015, bio/pharma petitions were 17%
- Hedge funds
- ANDA challengers

1897 Total AIA Petitions in FY 15*
(Technology Breakdown)

- Electrical/Computer - TCs 2100, 2400, 2600, 2800
- Mechanical/Business Method - TCs 3600, 3700
- Chemical - TC 1700
- Bio/Pharma - TC 1600
- Design - TC 2900

* Source: USPTO PTAB Statistics 9/31/2015
Disposition of IPR Petitions Completed to Date*

2203 Total Petitions

1137 Trials Not Instituted
Petition Denied/ Settled/ Dismissed

1066 Trials Instituted

436 Trials Terminated During Trial
Settled/Dismissed/ Request for Adverse Judgment

630 Trials Completed
Reached Final Written Decisions

453 Trials
All Instituted Claims Unpatentable (21% of Total Petitions, 42% of Trials Instituted, 72% of Final Written Decisions)

91 Trials
Some Instituted Claims Unpatentable (4% of Total Petitions, 9% of Trials Instituted, 14% of Final Written Decisions)

86 Trials
No Instituted Claims Unpatentable (4% of Total Petitions, 8% of Trials Instituted, 14% of Final Written Decisions)

For CBMs: 65 11 3

* Source: USPTO PTAB Statistics 10/31/2015
**CBMs:**
Instituted
2384
Unpatentable
1369

*Source: USPTO PTAB Statistics 10/31/2015*
Proving Prior Art Priority Date: Dynamic Drinkware v. National Graphics


  - “Molded Articles Having a Surface Bearing a Lenticular Image”

- Dynamic Drinkware files petition for IPR.

‘196 Patent
- Filed Nov. 22, 2000.
- Provisional filed June 12, 2000.

‘555 patent
- Filed May 5, 2000.
- Provisional filed Feb. 15, 2000.
Dynamic Drinkware (cont’d)

PTAB:
- Dynamic failed to prove ‘555 patent was entitled to provisional filing date.
- Dynamic only compared claim 1 of the ‘196 patent to the ‘555 provisional application.

CAFC affirms:
- Dynamic argued the ‘555 patent had presumption of priority to provisional.
- Dynamic argued that National Graphic had burden to prove no priority.
- Dynamic argued that claim charts showing claims of ‘196 patent disclosed in ‘555 patent and ‘555 provisional satisfied proof.
- CAFC held that the burden of production may shift throughout the trial but not the burden of persuasion.
Dynamic Drinkware Shifting Burdens of Production

- Petitioner met its initial burden of production by arguing that the ‘555 patent anticipated the asserted claims of the ‘196 patent, shifting the burden to the Patentee.

- Patentee met its burden of production by producing evidence that the invention of the patent at issue was reduced to practice prior to the ‘555 patent filing date and contending that the claims were entitled to a date of invention prior to the ‘555 patent, shifting the burden back to the Petitioner.

- Petitioner had the burden of production to prove that either the invention was not reduced to practice or that the ‘555 patent was entitled to the benefit of the provisional filing date prior to the date of the Patentee’s reduction to practice.

- A provisional application’s effectiveness as prior art depends on its written description support for the claims of the issued patent.
Takeaways from *Dynamic Drinkware*

- Understand the burdens of persuasion and the burdens of production required at trial.

- Provisional as prior art: Be prepared to prove that your prior art reference is entitled to the earlier filing date. Include in Petition.
  - Prior disclosure in a provisional application is not enough.
  - Identify a claim in the published prior art reference that is entitled to the filing date and the claimed priority/provisional date.
  - Show that the claim in the published prior art finds § 112 support in the priority provisional.

- Of note, under post-AIA rules, the Petitioner would have prevailed in Dynamic because the provisional filing date of the ‘196 patent was after both the provisional and non-provisional filing dates of the anticipatory reference.
Estoppel in Related PTAB Proceedings


- 35 USC § 325 (e)(1):
- (e) Estoppel.—
  - (1) Proceedings before the office.— The petitioner in a post-grant review of a claim in a patent under this chapter that results in a final written decision under section 328(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 post-grant review.

- Two months earlier in an earlier CBM on the same patent, a final written decision concluded that the same claims were unpatentable under 35 USC § 103(a).
Estoppel (Cont’d)

- PTAB *sua sponte* asked parties to brief whether Apple is estopped from arguing claims unpatentable under 35 USC § 101.

- Apple asserted it could not have reasonably raised § 101 issue because the earlier CBMs were filed before the Supreme Court decision in *Alice*.

- PTAB decided that *Alice* merely clarifies the jurisprudence under 35 USC § 101 and did not create a new ground of invalidity. Apple reasonably could have raised § 101 issue relying upon pre-Alice case law some of which Apple cited in its papers.

- Apple argued it was not “maintaining” the proceeding, since the record was already closed it was not actively participating while the record was open, and only participation in the oral argument remained.
Estoppel (Cont’d)

- PTAB ruled that participating in oral argument was “maintaining” a proceeding.
- PTAB dismissed Apple from the proceedings but refused to terminate.
- PTAB held that 35 USC § 325 (e)(1) prohibits Petitioners from maintaining proceeding, but does not prohibit the Board from reaching its decision.

Takeaways:
- Timing: Do not rely upon filing multiple serial IPRs/CBMs for additional grounds. PTAB may dismiss later filed proceedings.
- PTAB will not terminate proceedings late in the trial.
CLE Code #1

December 2nd
Ms. Shin is a shareholder of the firm and has substantial experience in post-grant proceedings including *inter partes* review and *ex parte* and *inter partes* reexamination, particularly in the electrical, computer and mechanical arts.

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Motions to Exclude Presented to the PTAB
Motions to Exclude - Overview

- Motions to Exclude evidence are available during a PTAB trial to exclude evidence from consideration by the Board.
  - Dispute admissibility of certain exhibits under the Federal Rules of Evidence (e.g., Relevance, Hearsay, Authentication, etc.).

- Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be filed in the form of an exhibit. 37 CFR § 42.63(a).

  - 37 CFR § 42.20(c): The moving party has the burden of proof to establish that it is entitled to the requested relief.
Motions to Exclude – Relevant Authority

- The Federal Rules of Evidence apply to PTAB trials. (37 CFR § 42.62(a)).

- 37 CFR, e.g., § 42.61, § 42.62, § 42.63, § 42.64


- PTAB decisions
Objections

- A party challenging admissibility of evidence **must** make a timely objection and preserve the objection via a motion to exclude. (37 C.F.R. § 42.64.

- With respect to exhibits filed before the Board has instituted a trial, objections to exhibits must be filed within **10 business days** from the institution of the trial. 37 CFR § 42.64(b)(1).

- Once the Board has instituted a trial, objections to exhibits must be filed within **5 business days** of the exhibit’s submission. 37 CFR § 42.64(b)(1).

- Objections to Deposition evidence must be made **during deposition.** 37 CFR § 42.64(a).
Objections

- Objections must identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence. 37 CFR § 42.64(b)

- Supplemental evidence must be served within 10 business days of service of objection. 37 CFR § 42.64(b)
Motions to Exclude: Details

- Filing timing is set in the Scheduling Order
- Prior authorization by the Board is not required
  - 37 CFR § 42.64 – “The motion may be filed without prior authorization from the Board.”
- Page limits (37 CFR § 42.24)
  - Motions to exclude - 15 pages;
  -Oppositions to motions – 15 pages
  - Replies – 5 pages
Motions to Exclude: Details

- A motion to exclude evidence must:
  a) Identify where in the record the objection originally was made;
  b) Identify where in the record the evidence sought to be excluded was relied upon by an opponent;
  c) Address objections to exhibits in numerical order; and
  d) Explain each objection

- Focus is inadmissibility and not the sufficiency of evidence
  - A motion to exclude must explain why the evidence is not admissible (e.g., relevance or hearsay) but may not be used to challenge the sufficiency of the evidence to prove a particular fact. (Office Patent Trial Practice Guide, 77 Fed. Reg. at 49767 (col. 3) (Aug. 14, 2012).
Motion to Exclude: Filing Tips

- Sample Motion to Exclude Provided by PTAB:
  1. Identity of the exhibit and portion thereof sought to be excluded: test data described in Exhibit 1005, example 1.
  3. An objection was made in an Objection to Evidence, filed [state date filed]. See Ex. 2011, page x, lines y-z.
  4. Petitioner relies on the objected data on pages 5-6 of the Petition.
  5. The relied upon data is Hearsay. Petitioner has not presented the testimony of any individual having first-hand knowledge of the testing described in Example 1.

Motion to Exclude: Filing Considerations

- A Motion to Exclude is:
  - Proper to address the admissibility of previously filed evidence.
  - Another vehicle when attempting to remove a reference as prior art evidence. (Must follow proper procedure of filing timely objection then filing motion to exclude to challenge prior art reference; *ABB, Inc. v. Roy-G-Biv Corporation*, IPR2013-00063, Paper 71, pp. 8-9).

- A Motion to Exclude is not:
  - Proper to challenge the sufficiency of the opposing parties evidence; or
Motions to Exclude: Denial Likely

- Motions to Exclude: Denial Highly Likely
  - Public policy concern: It is better to have a complete record of the evidence submitted by the parties than to exclude particular pieces for public access.
    - IPR2013-00053, Paper 66 (May 1, 2014)
Motions to Exclude: Statistics

(Source: Docket Navigator)
Motion to Exclude: When have they been Granted?

- Motions to Exclude have been granted when:
  - Evidence failed to meet standards of the FRE
  - Failure to make an expert available for cross-examination.
  - Evidence is untimely filed
  - Failure to provide information or English translations relied on
Motions to Exclude: Caution

- Timely Objections
  - Review filed evidence carefully and preserve your rights to file Motions to Exclude evidence by timely filing objections.

- Compliance with Format
  - Follow the Motion to Exclude sample template provided by the Board.

- Focus on Inadmissibility of Evidence
  - The Board is a tribunal of judges of competent legal knowledge and scientific ability. Therefore, a Motion to Exclude should not argue the sufficiency of evidence or the weight a party wants the Board to assign evidence.
Motion to Exclude: Strategies

- **Strategic considerations:**
  - Party Filing Evidence
  - Party Filing Motions to Exclude
    - **Denial Likely:** Thus far, the Board has denied almost all motions to exclude evidence either outright for being improper/deficient, or “as moot.”
CLE Code #2

Post-Grant Proceedings
Mr. Parrish’s practice includes evaluating, obtaining, and litigating patents on behalf of clients, with an emphasis on post-grant practice and post-grant appeals. Daniel has worked on multiple Federal Circuit appeals of PTAB decisions, been involved in numerous post-grant proceedings, and prosecuted dozens of patent applications. Before transitioning into law full-time, Daniel spent six years as an engineer and patent agent in the medical device space.

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Prior Art Publications that Require Authentication
Prior Art Publications Requiring Authentication

- Statutory basis
- General rules
- PTAB case law
- Practice tips
- Questions
IPRs Limited in Scope

- “A petitioner in an *inter partes* review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and *only* on the basis of prior art consisting of *patents or printed publications*.” 35 U.S.C. § 311(b) (emphasis added).

- Petition must show “that there is a *reasonable likelihood* that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (emphasis added).
General Rules

- Case-by-case basis:
  - “The decision whether a particular reference is a printed publication must be approached on a case-by-case basis.” *In re Cronyn*, 890 F.2d 1158, 1161 (Fed. Cir. 1989).

- Key inquiry:
  - “[T]he key inquiry is whether or not a reference has been made ‘publicly accessible.’” *In re Klopfenstein*, 380 F.3d 1345, 1348 (Fed. Cir. 2004).

- Sufficiently accessible to the public interested in the art:
  - Party “should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.” *In re Wyer*, 655 F.2d 221, 227 (CCPA 1981).
Reliance on Publication Date is Insufficient


- Patent Owner Response:
  - ISBN may be obtained before work published
  - No evidence of how ISBN relates to public accessibility
  - Work stated “can be obtained only from the author,” reproduction required “written permission of the author,” and figures were “confidential.”
- Board: Petitioner failed to carry burden; did not demonstrate “public accessibility.”
Bare Assertion of Publication Date Insufficient


- **Petition:**
  - Reference was “published as an Internet-Draft in June 1999”; no other evidence re public accessibility

- **Patent Owner Response:**
  - Draft was “valid” for only a limited time and was deemed inappropriate for citation

- **Board**
  - “Naked assertion that [reference] was published is not supported by the record, which fails to identify the circumstances and manner in which persons interested and ordinarily skilled in the subject matter could locate the reference.”
Expert must do more than parrot petition


- **Petition & Expert:**
  - Reference “was published in 1988”; “1/88” on title page

- **Patent Owner Response:**
  - “1/88” does not suggest publication or dissemination
  - Date on title page could be publication/creation/copyright

- **Board:**
  - Little, if any, weight given to expert testimony that does not disclose underlying facts or data.
  - References not “printed publications”
Sufficient Evidence of Indexing Required


- **Petition:**
  - “[T]hesis states that it was completed and approved by faculty members and a [University] Dean . . . more than one year before the [critical date.]”

- **Patent Owner Response:**
  - No testimony of indexing or deposit, at any date
  - No evidence that thesis accessed by public

- **Board:**
  - Contrasted *w/In re Hall*, where university librarian testified about indexing, cataloguing, and shelving.
Sufficient Evidence of Indexing Required II


- Petition:
  - Technical report published by University
  - Author testified “published and publicly available” before critical date and “publicly available for viewing and downloading.”
  - Appeared on author’s “publications list” with download link

- Patent Owner Response:
  - Unindexed, internal departmental technical report (not journal)
  - No evidence of how interested person could locate paper

- Board:
  - No “explicit reference” to report/link within author’s publications
  - Analogized to unshelved thesis and FTP-subdirectory cases
Sufficient Evidence of Indexing Required III


- **Petition:**
  - Russian Thesis; English translation; Catalog entry evidence
  - Russian State Library “by definition established to share the information that it houses with any interested person.”
  - Subsequent journal article summarized thesis (pre-critical date)

- **Patent Owner Response:**
  - No evidence that “Imprint Moscow 1994” = catalogued/indexed

- **Board:**
  - No challenge to admissibility/authenticity of catalog entry
  - Patent owner “does not explain why a library . . . would take more than seven years to catalog and index a thesis.”
Globalfoundries Russian Library Catalog Entry

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Conference Presentations Require Evidence of Public Accessibility


- **Petition:** PowerPoint “prepared for” public conference

- **Patent Owner Response:**
  - No evidence this version actually presented
  - Expert testified that PowerPoint was “prior art” but not whether a “printed publication” or how published

- **Board:**
  - Contrasted with *In re Klopfenstein*, where poster displayed for 2 days, open for public view/reproduce
  - See also *M.I.T. v. AB Fortia* (oral presentation to about 500 people plus 6+ copies of paper distributed)
Wayback Machine printouts excluded when original website information not authenticated


- Expert declaration:
  - “Personal knowledge of retrieval” (download)

- Patent Owner Response:
  - No personal knowledge of website (e.g., webmaster)

- Board:
  - “When offering a printout of a webpage into evidence to prove the website’s contents, the proponent of the evidence must authenticate the information from the website itself, not merely the printout.”

- Practice tip: Obtain an affidavit from Internet Archive
Website printouts need testimony of someone with knowledge of website

- **EMC Corp. v. Personalweb Techs., LLC**, Case IPR2013-00084, slip op. at 45-49 (PTAB May 15, 2014) (Paper 64) (technology archivist expert testified that he personally verified authenticity of software, additionally noting CD-ROM qualified as “ancient document”).
“Drafts” may be printed publication if sufficient evidence of public accessibility


- Petitioner’s Expert:
  - Draft standards “published up to four times a year”
  - POSITA would “be aware of the publication and availability of the GSM, GPRS, & UMTS standards”
  - Public “could even sign up for email distribution lists”

- Patent Owner:
  - “Public Enquiry” notation indicates “working drafts” were “not yet ready for public dissemination”

- Board: credited petitioner’s expert
  - “Public Enquiry” or draft status does not indicate pre-publication state; drafts can be publicly available
How does “interested person” access publication?


- **Petitioner’s expert on Draft Standard:**
  - Available “to anyone who wanted to view it”
  - Available on Working Group “email list” & at meeting

- **Patent Owner Response:**
  - Password protected; distribution limited to “interested individuals, as opposed to the entire Internet.”
  - Non-members of the Working Group could not access Draft Standard or know about meetings

- **Board:** not printed publication
  - No evidence of how individual could add themselves to email list or learn about working group meetings
Practice Tips

- Include expert declaration with step-by-step description of how expert would have found the reference at the time of publication.

- Include why an “interested person” would look where the expert looked

- Expert should have personal knowledge of public accessibility and/or dissemination

- The Wayback Machine may be helpful for online archives/publications
  - Even if archived after critical date, may still provide corroborating evidence
CLE Code #3

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Questions?

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