



Post-Grant for Practitioners Webinar: Post-Grant Appeals

November 3, 2022

Meet The Speakers



John Dragseth
Senior Principal



Nitika Gupta Fiorella
Principal

Overview

- **Topics**

- Important decisions
- Developments
- Practice tips

- **Housekeeping**

- CLE
- Questions
- Materials

- <http://fishpostgrant.com/webinars/>

FISH.

+ Complimentary CLE Webinar

Protecting Your Femtech IP

SIGN ME UP



DATE

Wednesday,
November 30, 2022



TIME

1:30 – 2:30 p.m. ET/
10:30 – 11:30 a.m. PT

Webinar | Protecting Your Femtech IP

Femtech is a growing industry that develops solutions to women's healthcare issues that historically have been underfunded, under researched, and misunderstood. It focuses primarily on conditions that present differently in women, predominantly affect women, or are unique to women. These sex differences and the growing awareness of them are the driving force behind femtech, which aims to preserve wellness, prevent illness, and close the treatment gap through education and innovations in software, pharmaceuticals, medical devices, and consumer products.

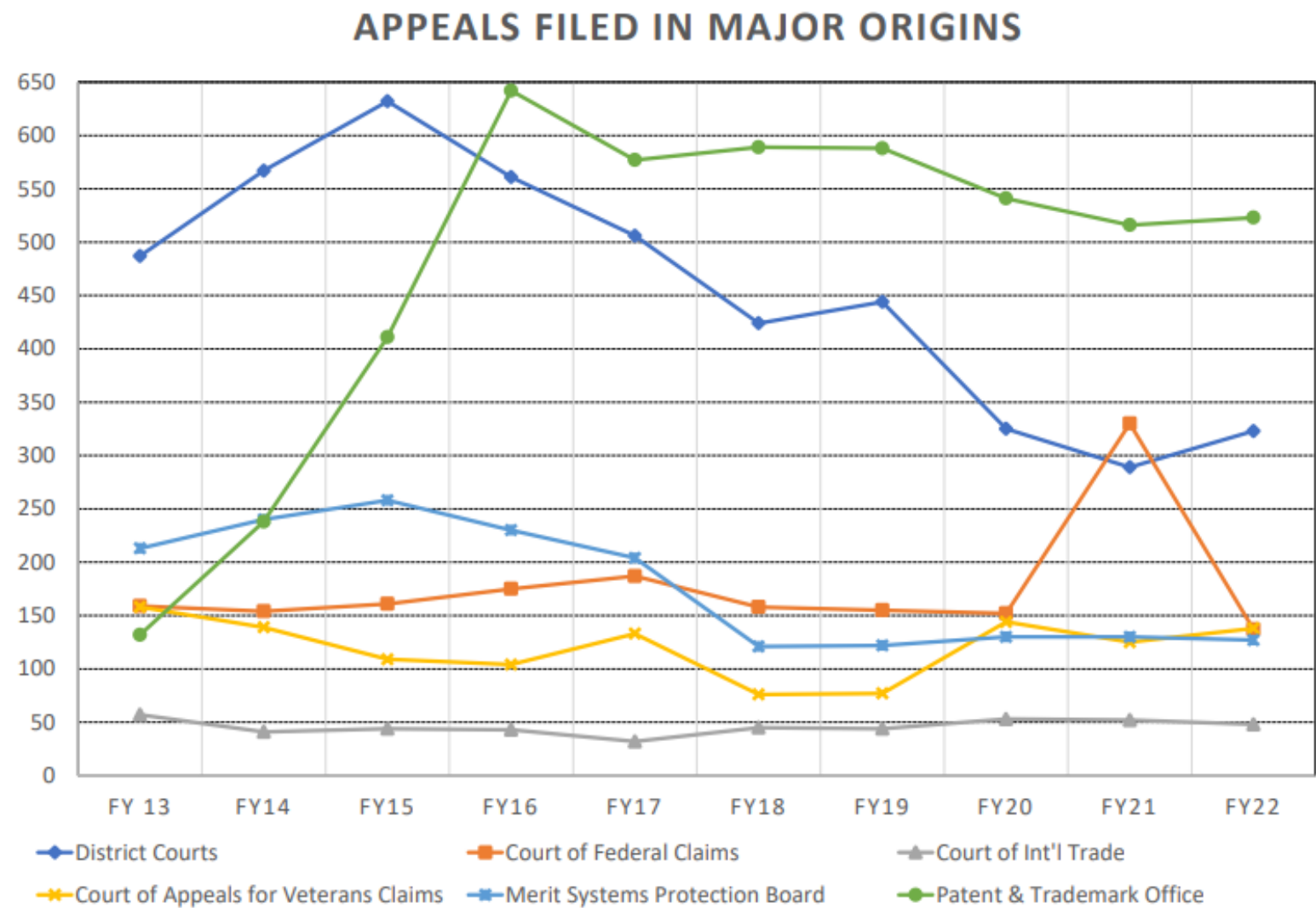
Agenda

- **Introduction and Overview**
- **Best Practices**
- **Important Recent Case Developments**
- **Outstanding Issues**

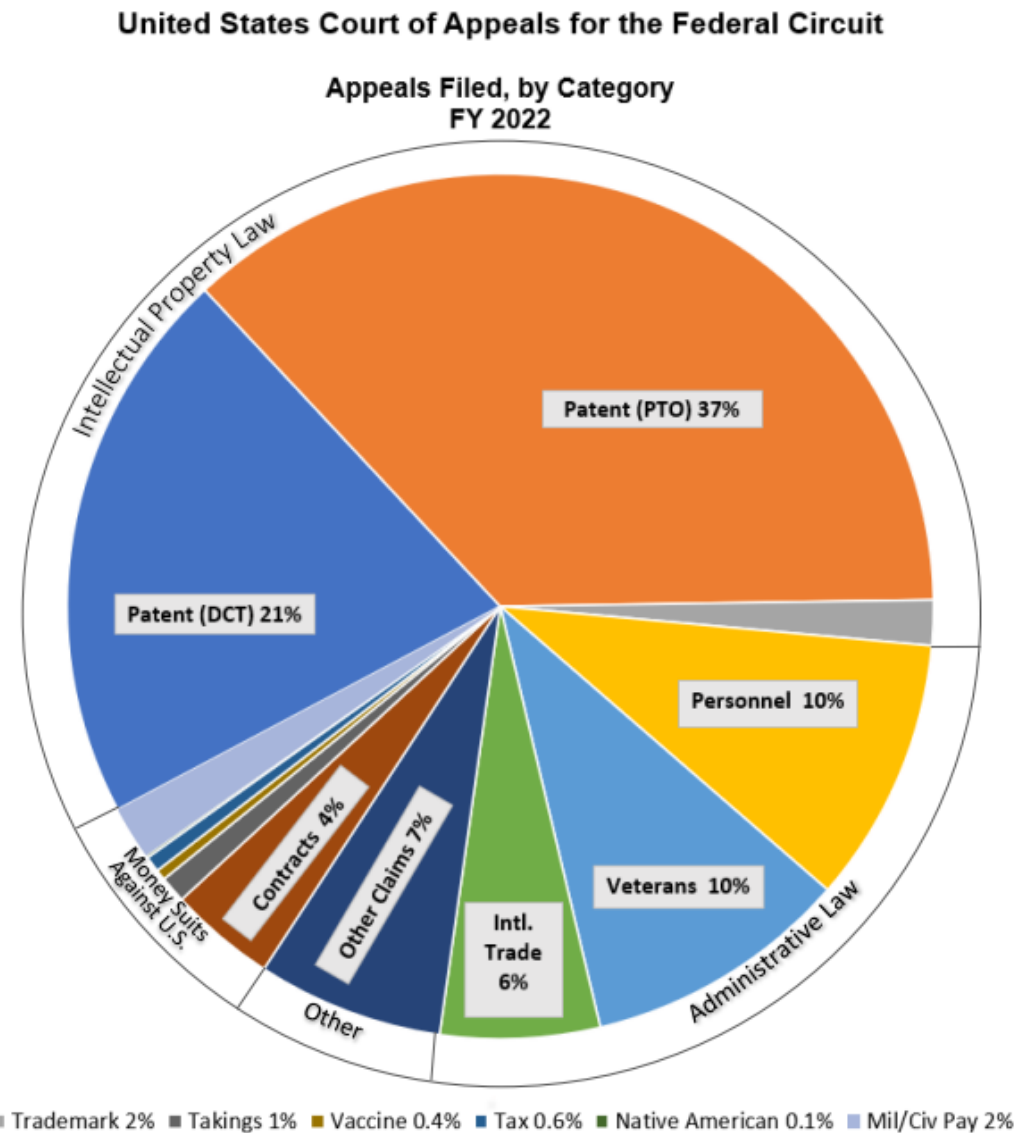


Introduction & Overview

Appeals Filed in Major Origins

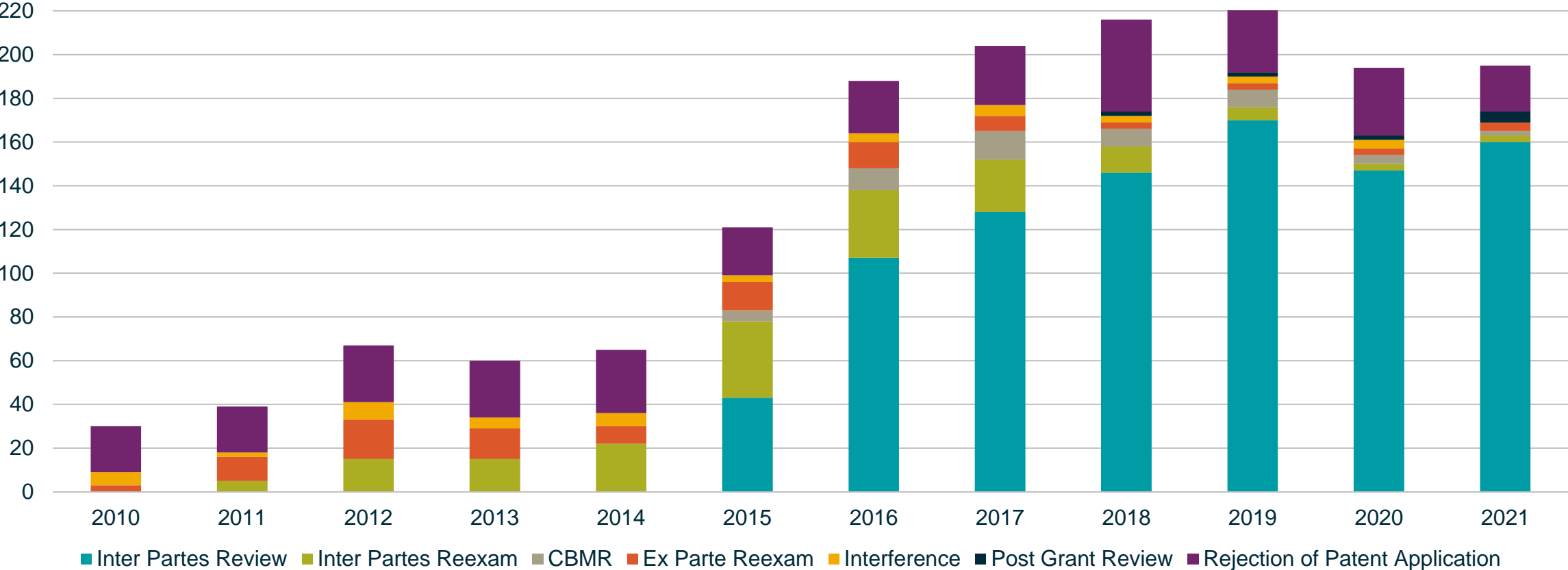


2022 Cases by Origin

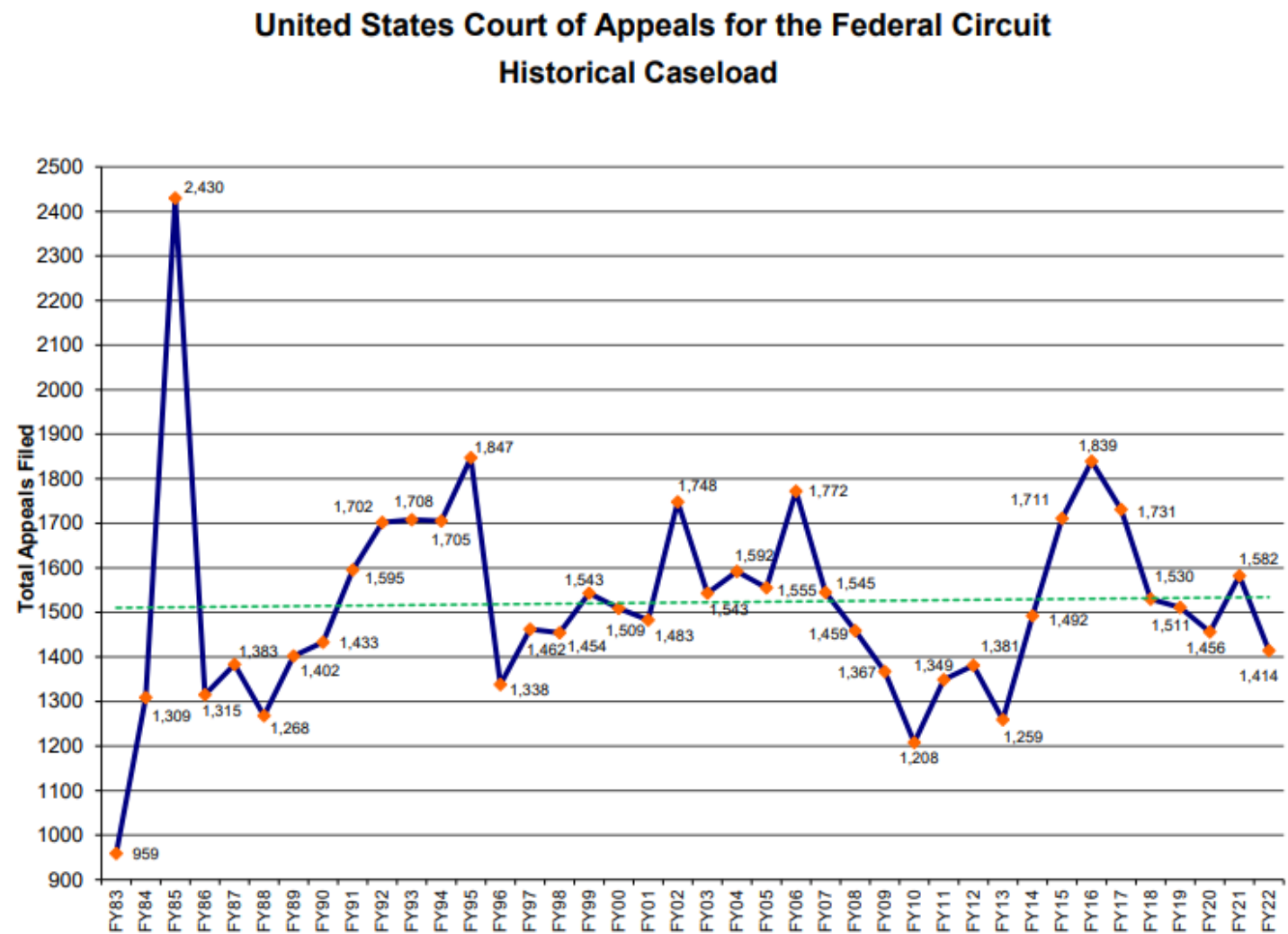


Breaking It Down Further

Federal Circuit Opinions and Rule 36 Affirmances in Appeals Arising from the USPTO (2010-2021)



Historical Caseload – Overall



Note: Includes reinstated, cross- and consolidated appeals.

Median Time to Disposition

Median Time to Disposition in Cases Terminated After Hearing or Submission¹

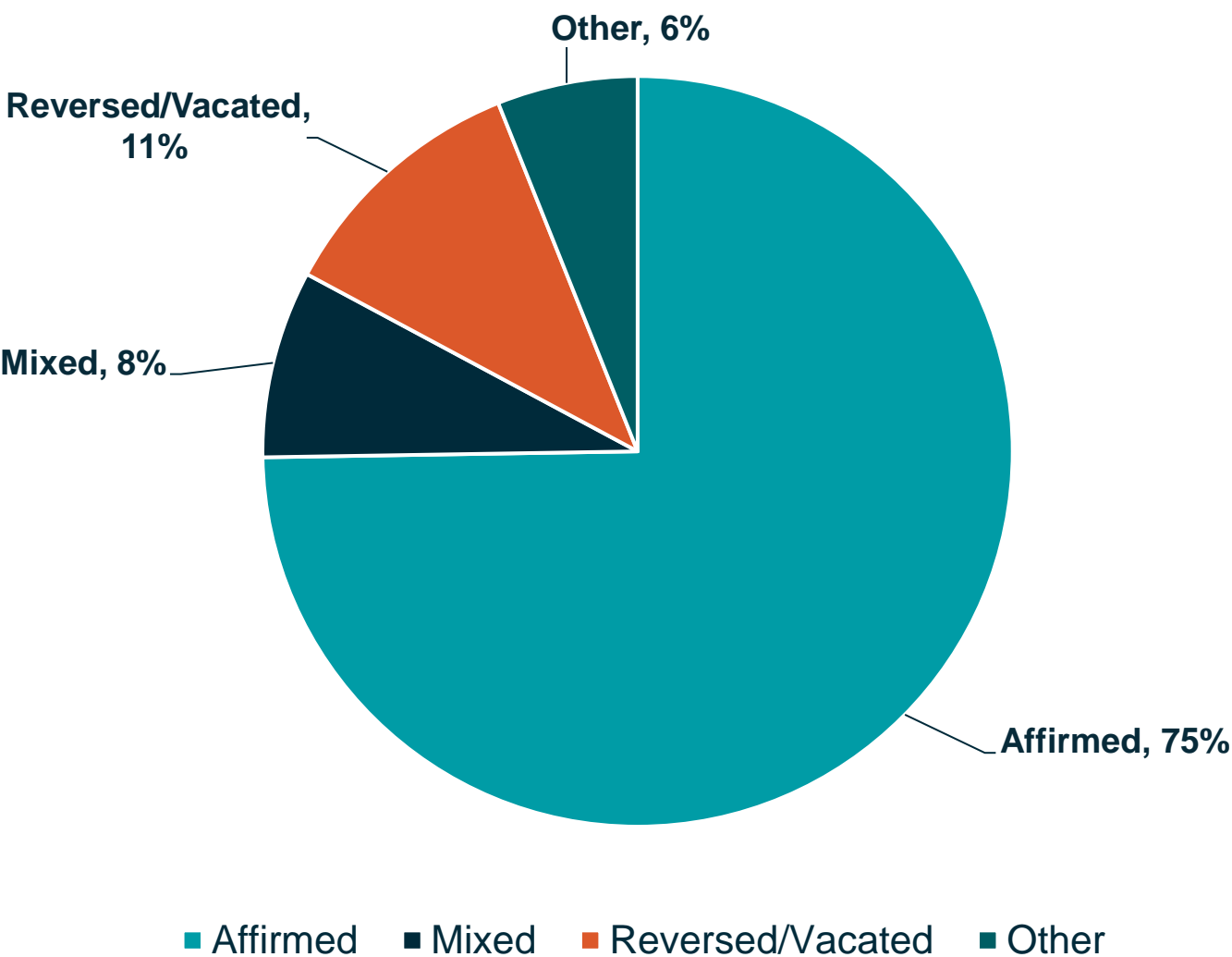
Docketing Date² to Disposition Date, in Months

	<u>FY 13</u>	<u>FY 14</u>	<u>FY 15</u>	<u>FY 16</u>	<u>FY 17</u>	<u>FY 18</u>	<u>FY 19</u>	<u>FY 20</u>	<u>FY 21</u>	<u>FY 22</u>	<u>Overall Median per Origin</u>
District Court	11.8	12.0	12.0	13.0	13.0	14.0	16.0	13.0	12.0	12.0	12.5
Court of Federal Claims	10.4	10.0	10.0	9.0	9.0	11.0	12.0	15.0	12.0	18.0	10.7
Court of International Trade	12.4	13.0	12.0	13.0	15.0	14.0	14.0	15.0	13.0	13.0	13.0
Court of Appeals for Veterans Claims	11.2	10.0	7.0	7.5	6.0	14.0	12.0	7.5	10.0	10.0	10.0
Board of Contract Appeals	13.3	16.0	10.0	10.0	9.0	13.5	16.0	14.0	11.5	13.0	13.2
Department of Veterans Affairs	n/a	n/a	16.0	13.0	17.0	19.0	17.0	15.5	28.0	20.0	17.0
Department of Justice	9.7	12.0	5.9	12.0	13.0	12.0	15.0	11.5	4.5	7.5	11.8
International Trade Commission	13.7	16.0	13.0	17.0	13.0	11.0	17.0	17.0	14.5	18.0	15.3
Merit Systems Protection Board	7.4	6.0	6.5	7.0	6.0	12.0	12.5	11.0	10.0	10.0	8.7
Office of Compliance	n/a	n/a	n/a	n/a	n/a	14.0	13.0	n/a	n/a	n/a	13.5
Patent and Trademark Office	10.1	10.0	11.0	11.0	13.0	15.0	15.0	14.0	14.0	15.0	13.5
Government Accountability Office	n/a	n/a	n/a	11.0	n/a	n/a	n/a	n/a	n/a	n/a	11.0
Overall Median per Fiscal Year	11.2	12.0	10.5	11.0	13.0	14.0	15.0	14.0	12.0	13.0	12.5

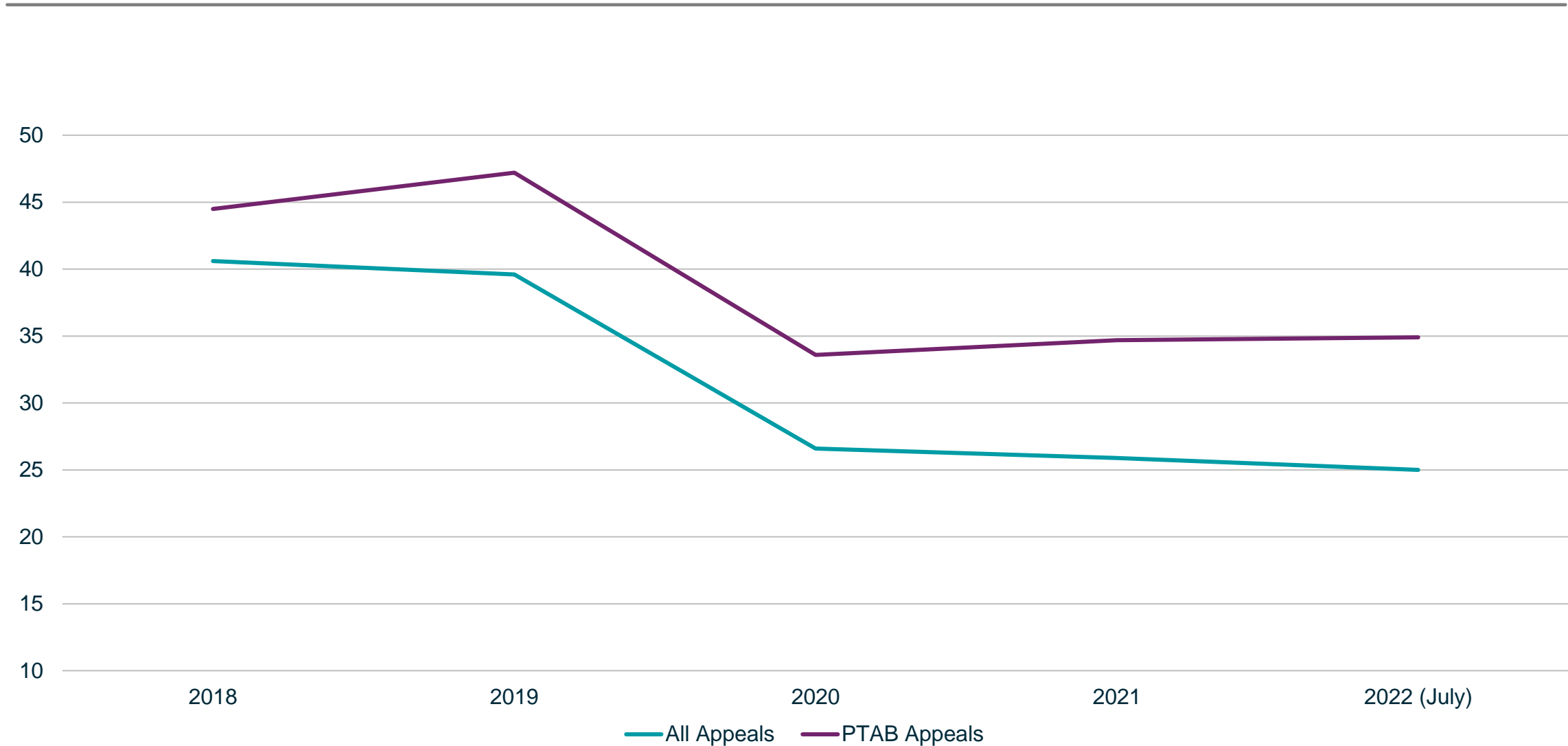
¹ Excludes cross and consolidated appeals, writs, and OPM petitions

² Calculated from Date of Docketing or Date of Reinstatement, whichever is later

Dispositions of CAFC Post-Grant Appeals



Rule 36 Affirmances as a Percentage of all Opinions





Best Practices

Before the Federal Circuit

- **Issue Selection**
- **Issue Framing (with standard of review)**
- **Clarity**
- **An appellant's approach is very different from an appellee's**



Before the Board – Prepare for Appeal

- **An appeal will likely happen – they are cost-efficient**
- **Think about issues that might be appealed**
 - Highlight appealable issues in briefing before the Board preemptively
 - Consider case-specific strategy as to whether you want to propose explicit claim constructions
 - Creates a legal issue to appeal, which may or may not be good
 - Look for opportunities to create “legal” issues
 - Procedural Issues
 - Anticipation / Obviousness
 - Identifying Prior Art
 - Think about the decision you want the Board to write, and how you want to win
- **Have your expert provide some technology background you can cite on appeal**



Case Law Developments: Standing

Standing to Appeal

- **The Board is not a court—standing is not required to file a Post-Grant petition**
- **Anyone but the patent owner can file an IPR or PGR**
 - 35 U.S.C. § 311(a) (“[A] person who is not the owner of a patent may file with the Office a petition to institute an *inter partes* review of the patent.”)
 - 35 U.S.C. § 321(a) (“[A] person who is not the owner of a patent may file with the Office a petition to institute a post-grant review of the patent.”)
- **But a party appealing a Final Written Decision must have Article III standing**
 - Injury-in-fact (Concrete, imminent, particularized)
 - Causation
 - Redressability

How Likely is Infringement Suit?

Apple Inc. v. Qualcomm Inc., 17 F.4th 1131 (Fed. Cir. Nov. 10, 2021)

- The Court found Apple lacked standing to appeal from an adverse IPR because it had since settled its litigation with Qualcomm
- In a previous appeal, the Court similarly found Apple lacked standing to appeal because of the settlement and because Apple's supporting declarations were insufficient
- The only new argument Apple raised in the current appeal was that it might be sued if it stops paying the ongoing royalty, but the Court said that was too speculative and it was bound by stare decisis

**United States Court of Appeals
for the Federal Circuit**

APPLE INC.,
Appellant

v.

QUALCOMM INCORPORATED,
Appellee

2020-1683, 2020-1763, 2020-1764, 2020-1827

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2018-01276, IPR2018-01281, IPR2018-01282, IPR2018-01460.

Decided: November 10, 2021

LAUREN ANN DEGNAN, Fish & Richardson P.C., Washington, DC, argued for appellant. Also represented by CHRISTOPHER DRYER; BRIANNA LEE CHAMBERLIN, ROBERT COURTNEY, Minneapolis, MN; OLIVER RICHARDS, San Diego, CA; LANCE E. WYATT, JR., Dallas, TX.

JONATHAN S. FRANKLIN, Norton Rose Fulbright US LLP, Washington, DC, argued for appellee. Also represented by PETER B. SIEGAL; STEPHANIE DEBROW, EAGLE

How Likely is Infringement Suit?

Intel Corp. v. Qualcomm Inc., 21 F.4th 784 (Fed. Cir. Dec. 28, 2021)

- Petitioner had standing where the patentee had sued the petitioner's customer and mapped the claims to petitioner's part
- The Court said it did not matter that the suit was not against Intel because Intel "need not face a specific threat of infringement"—it was enough that Intel was engaging in activity that would give rise to a possible infringement suit
- The Court also said that it did not matter that the customer suit eventually settled because Intel was not a party to the settlement

**United States Court of Appeals
for the Federal Circuit**

INTEL CORPORATION,
Appellant

v.

QUALCOMM INCORPORATED,
Appellee

2020-1664

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2018-01429.

Decided: December 28, 2021

GREGORY H. LANTIER, Wilmer Cutler Pickering Hale and Dorr LLP, Washington, DC, argued for appellant. Also represented by DAVID LANGDON CAVANAUGH, THOMAS SAUNDERS; BENJAMIN S. FERNANDEZ, Denver, CO; JASON KIPNIS, Palo Alto, CA; CRISTINA SALCEDO, Los Angeles, CA.

JONATHAN S. FRANKLIN, Norton Rose Fulbright US LLP, Washington, DC, argued for appellee. Also represented by PETER B. SIEGAL; STEPHANIE DEBROW, EAGLE HOWARD ROBINSON, Austin, TX; DANIEL LEVENTHAL, RICHARD STEPHEN ZEMBEK, Houston, TX.

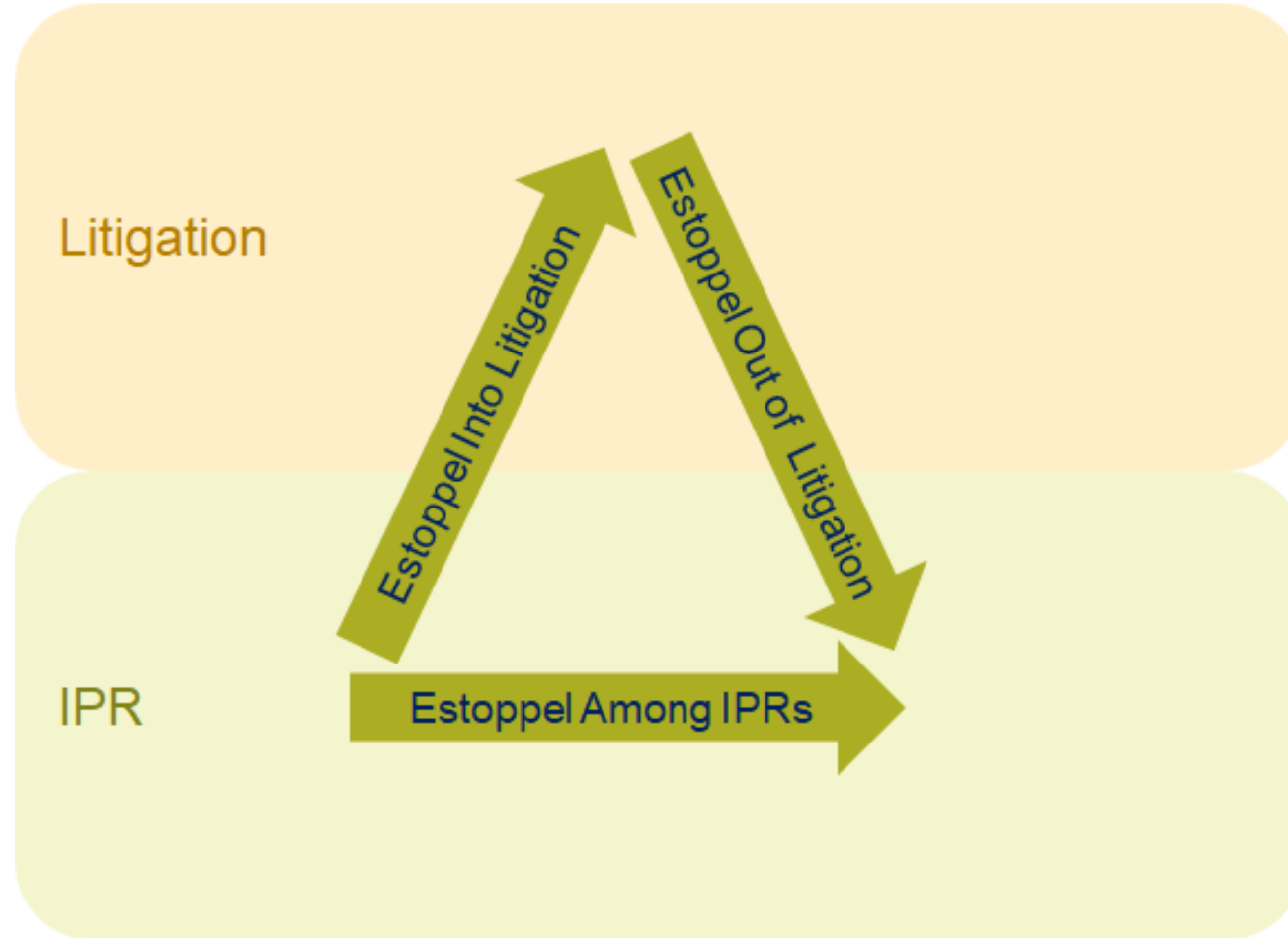
Practice Pointers

- Analyze standing at the start of any appeal (and before)
- Case law seems to focus on ***likelihood*** of suit
- Declarations are key – as petitioner, make them specific and detailed; as patent owner, attack them for what they omit
- As a petitioner, it is good practice to advise your client that you may be done at the PTAB if you aren't currently being sued for infringement



Case Law Developments: Estoppel

Three Directions of Estoppel



"Could Have Been Asserted"

CalTech v. Broadcom, 25 F.4th 976 (Fed. Cir. Feb. 4, 2022)

- Court overruled *Shaw* in view of the more-recent SAS
- “[E]stoppel [into litigation] applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, but to all grounds not stated in the petition but which reasonably could have been asserted against the claims included in the petition.”

United States Court of Appeals
for the Federal Circuit

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Plaintiff-Appellee

v.

BROADCOM LIMITED, NKA BROADCOM INC.,
BROADCOM CORPORATION, AVAGO
TECHNOLOGIES LIMITED, NKA AVAGO
TECHNOLOGIES INTERNATIONAL SALES PTE.
LIMITED, APPLE INC.,
Defendants-Appellants

2020-2222, 2021-1527

Appeals from the United States District Court for the
Central District of California in No. 2:16-cv-03714-GW-
AGR, Judge George H. Wu.

Decided: February 4, 2022

KATHLEEN M. SULLIVAN, Quinn Emanuel Urquhart &
Sullivan, LLP, Los Angeles, CA, argued for plaintiff-appel-
lee. Also represented by JAMES R. ASPERGER; BRIAN P.
BIDDINGER, EDWARD J. DEFranco, New York, NY; TODD
MICHAEL BRIGGS, KEVIN P.B. JOHNSON, Redwood Shores,
CA; DEREK L. SHAFFER, Washington, DC; KEVIN
ALEXANDER SMITH, San Francisco, CA.

IPR-to-IPR Estoppel Bites Hard

Intuitive Surgical v. Ethicon, 25 F.4th 1035 (Fed. Cir. Feb. 11, 2022)

- Court affirmed a Board finding that a petitioner was estopped in a second-decided IPR by the existence of a first-decided IPR on the same patent
- This was true even though the IPRs were filed on the same day and the Board acted to make them serial in their conclusions.

United States Court of Appeals
for the Federal Circuit

INTUITIVE SURGICAL, INC.,
Appellant

v.

ETHICON LLC,
Appellee

ANDREW HIRSHFELD, PERFORMING THE
FUNCTIONS AND DUTIES OF THE UNDER
SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND DIRECTOR OF
THE UNITED STATES PATENT AND TRADEMARK
OFFICE,
Intervenor

2020-1481

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in No. IPR2018-
01248.

Decided: February 11, 2022

Practice Pointers

- Talk about **potential estoppels** in advance
- Consider case sequencing and chances to affect sequencing (stays and delays)
- Carefully consider how your case with "**real art**" differs from your case with "**paper art**"



Case Law Developments: Obviousness

Motivation/Reason to Combine

Intel Corp. v. Qualcomm Inc., 21 F.4th 784 (Fed. Cir. Dec. 28, 2021)

- Court reversed non-obvious finding of substitute claims related to radio frequency communication devices
- Board found Intel's theory on motivation to combine—to improve energy efficiency—too generic
- Court disagreed, noting that motivations with broad applicability aren't necessarily insufficient
 - Conclusory expert testimony isn't enough, but Intel's expert's testimony was anything but
 - One of the references expressly flagged power consumption as a consideration

**United States Court of Appeals
for the Federal Circuit**

INTEL CORPORATION,
Appellant

v.

QUALCOMM INCORPORATED,
Appellee

2020-1664

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2018-01429.

Decided: December 28, 2021

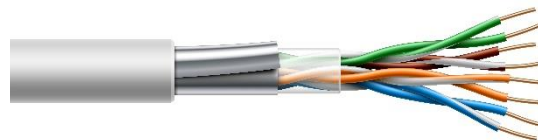
GREGORY H. LANTIER, Wilmer Cutler Pickering Hale and Dorr LLP, Washington, DC, argued for appellant. Also represented by DAVID LANGDON CAVANAUGH, THOMAS SAUNDERS; BENJAMIN S. FERNANDEZ, Denver, CO; JASON KIPNIS, Palo Alto, CA; CRISTINA SALCEDO, Los Angeles, CA.

JONATHAN S. FRANKLIN, Norton Rose Fulbright US LLP, Washington, DC, argued for appellee. Also represented by PETER B. SIEGAL; STEPHANIE DEBROW, EAGLE HOWARD ROBINSON, Austin, TX; DANIEL LEVENTHAL, RICHARD STEPHEN ZEMBEK, Houston, TX.

Motivation/Reason to Combine

Chemours Co. v. Daikin Industries, 4 F.4th 1370 (Fed. Cir. July 22, 2021)

- Claims covered a polymer used to coat communication cables with a high melt flow rate, which allows it to be coated onto wires faster
- The Board it would be obvious to modify the prior art polymer, which had a lower melt flow rate
- The Court reversed, finding that the Board did not adequately explain why a skilled artisan would have been motivated to increase the prior art polymer's melt flow rate, when the known ways for doing so would go against the prior art's teachings



United States Court of Appeals for the Federal Circuit

CHEMOURS COMPANY FC, LLC,
Appellant

v.

DAIKIN INDUSTRIES, LTD., DAIKIN AMERICA,
INC.,
Appellees

ANDREW HIRSHFELD, PERFORMING THE
FUNCTIONS AND DUTIES OF THE UNDER
SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND DIRECTOR OF
THE UNITED STATES PATENT AND TRADEMARK
OFFICE,
Intervenor

2020-1289, 2020-1290

Appeals from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in Nos. IPR2018-
00992, IPR2018-00993.

Decided: July 22, 2021

NITIKA GUPTA FIORELLA, Fish & Richardson, PC, Wil-
mington, DE, argued for appellant. Also represented by
MARTINA TYREUS HUFNAL; TIMOTHY RAWSON, San Diego,

Motivation/Reason to Combine

Fleming v. Cirrus Design Corp., 28 F.4th 1214 (Fed. Cir. Mar. 10, 2022):

- Court affirmed the Board's finding that claims directed to aircrafts with ballistic parachute systems were obvious
 - Claims require specific flight maneuvers (e.g. increase pitch, reduce roll, change altitude) to be initiated by autopilot when parachute is to be deployed
 - Neither prior art reference fully disclosed the claimed flight maneuvers
 - Court held that the Board properly found that those limitations were nonetheless disclosed by a combination of the references
 - Noted that a POSITA is a person of ordinary creativity and the prior art suggested certain safety measures, similar to the claimed flight maneuvers



Reasonable Expectation of Success

Eli Lilly & Co. v. Teva Pharmaceuticals International GmbH, 8 F.4th 1331 (Fed. Cir. Aug. 16, 2021):

- Claims directed to methods of treating vasomotor systems, including migraines, with humanized antibodies that inhibit CGRP proteins
- Court affirmed the Board's non-obviousness finding because there was no reasonable expectation of success for combining prior art
 - Court rejected Lilly's contention that the Board required anticipation-level clinical data from the prior art
 - Instead, the Board properly required proof that a skilled artisan would have expected *some* effect on the migraine symptoms sought to be resolved by the invention

**United States Court of Appeals
for the Federal Circuit**

ELI LILLY AND COMPANY,
Appellant

v.

TEVA PHARMACEUTICALS INTERNATIONAL
GMBH,
Appellee

2020-1876, 2020-1877, 2020-1878

Appeals from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in Nos. IPR2018-
01710, IPR2018-01711, IPR2018-01712.

Decided: August 16, 2021

WILLIAM BARRETT RAICH, Finnegan, Henderson,
Farabow, Garrett & Dunner, LLP, Washington, DC, ar-
gued for appellant. Also represented by PIER DEROO, ERIN
SOMMERS, YIEYIE YANG; SANJAY M. JIVRAJ, MARK STEWART,
Eli Lilly and Company, Indianapolis, IN.

WILLIAM M. JAY, Goodwin Procter LLP, Washington,
DC, argued for appellee. Also represented by ELAINE
BLAIS, EDWINA CLARKE, ALEXANDRA LU, Boston, MA;
NATASHA ELISE DAUGHTREY, Los Angeles, CA; WILLIAM

Objective Indicia of Success

Auris Health, Inc. v. Intuitive Surgical Operations, Inc., 32 F.4th 1154 (Fed. Cir. Apr. 29, 2022)

- The court (2-1) faulted the Board for finding a lack of motivation to combine based on *general* surgeon skepticism about the field of invention, robotic surgery, rather than on skepticism that was *specific* to the particular claimed invention
- Though framed as a “motivation” issue, this is the same sort of “skepticism” evidence that is used for objective indicia

Chemours Co. v. Daikin Industries, 4 F.4th 1370 (Fed. Cir. July 22, 2021)

- The Court found the Board erred in disregarding the objective evidence where the Board:
 - Incorrectly found no nexus simply because the claimed polymer was a combination of known elements
 - Improperly required market share evidence to show commercial success
 - Misapplied the “blocking patents” doctrine to the challenged patents themselves

Practice Pointers

- Don't get stuck in formulaic approaches to obviousness – be practical and persuasive
- Avoid generalized “make it better” explanations for motivation to combine/modify – find a way to make it specific to the teachings in the art
- Explain the benefit that would lead to the motivation **and also** explain that the skilled artisan at the time would have known of such benefit
- As patentee, look at entire prior art reference for all it teaches to see if there are contradictory teachings that underlie the claimed motivation
- Button down any arguments on objective indicia of nonobviousness



Case Law Developments: Interesting Cases

Applicant Admitted Prior Art (in IPR)

Qualcomm v. Apple, 24 F.4th 1367 (Fed. Cir. Feb. 1, 2022)

- Court reversed a finding of invalidity, holding that Applicant-Admitted Prior Art (AAPA) was not “prior art” for an IPR.
- But.....it could be used in an IPR to inform a skilled artisan’s knowledge and skill level.



Contracting Out of IPR by Accident

Kannuu PTY Ltd. v. Samsung, 15 F.4th 1101 (Fed. Cir. Oct. 7, 2021)

- Court held that a forum selection clause in an NDA could not prevent one party from filing an IPR because the underlying point of the NDA didn't have any real relation to an effort to invalidate patents (unlike, for example patent licensing agreements).

Maxpower Semiconductor, Inc. v. Rohm Semiconductor, Inc., 13 F.4th 1348 (Fed. Cir Sept. 8, 2021)

- Dismissed, as non-appealable, appeals from PTAB institution of IPRs—where the patentee argued that the parties had agreed to have all such disputes arbitrated.
- Judge O'Malley in partial dissent would have granted mandamus because 35 U.S.C. § 294 contains no exception for arbitration that takes place during an IPR.

Go Big and Go Home

Mobility Workx, LLC v. Unified Patents, LLC, 15 F.4th 1146 (Fed. Cir. Oct. 13, 2021)

- Court held that a patentee could raise constitutional challenges to the Board's structure and funding for the first time on appeal
- But its due process rights were not violated simply because the PTO collects more fees from institution than from non-institution --> the relevant APJs don't have a role in PTO finances or have a significant personal financial interest, and Congress controls the PTO's budget.

Thank You!

Please send your NY/NJ CLE forms to mcleteam@fr.com

Any questions about the webinar, contact Emma Horsey at horsey@fr.com


A replay of the webinar will be available for viewing at fr.com/webinars



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