

Post-Grant 2023 Year in Review

January 17, 2024

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Meet the Speakers

Karl Renner

Principal



renner@fr.com

David Holt

Principal



DTH@fr.com

Grace Kim

Principal



gkim@fr.com

Topics

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SUBSTANTIAL/SIGNIFICANT RELATIONSHIP – Slide 53

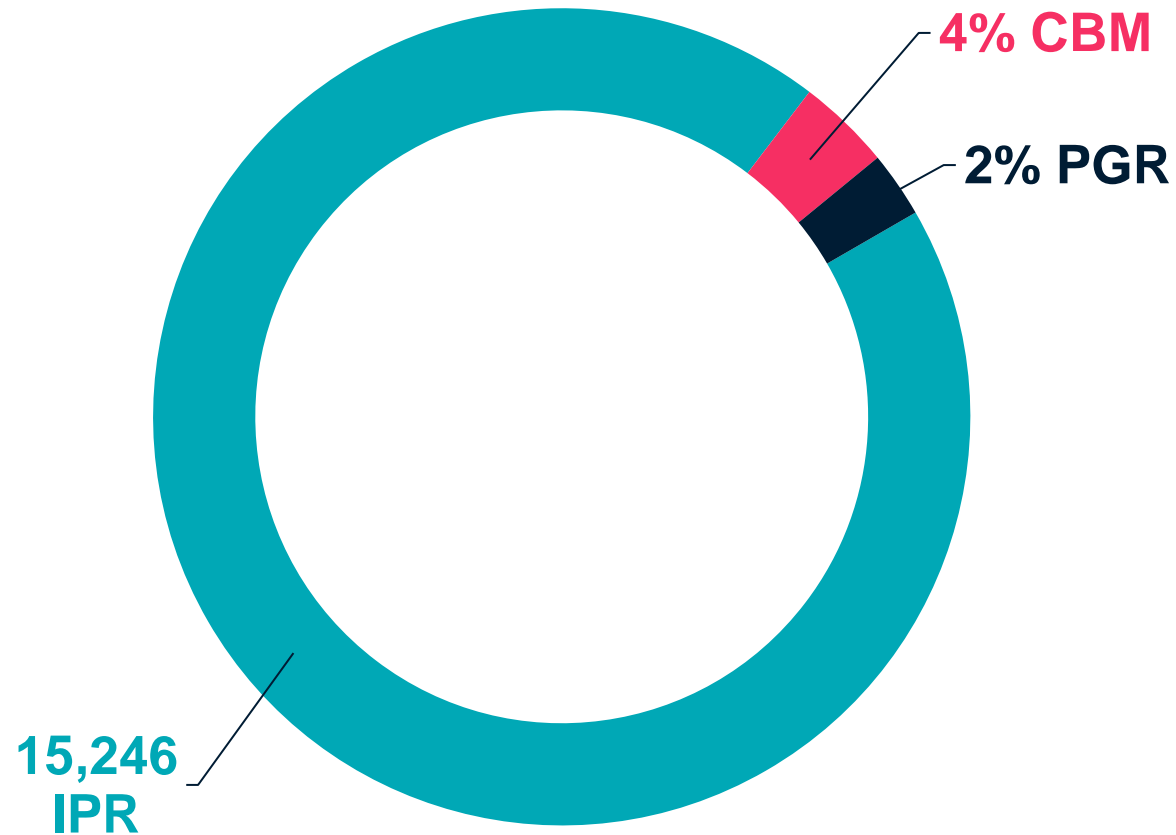
Statistics

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AIA Petitions

16,447

AIA Petitions
FILED SINCE 2012



Source: Lex Machina as of January 2024
DER petitions make up <1% of remaining petitions

PTAB – The Most Active Forum

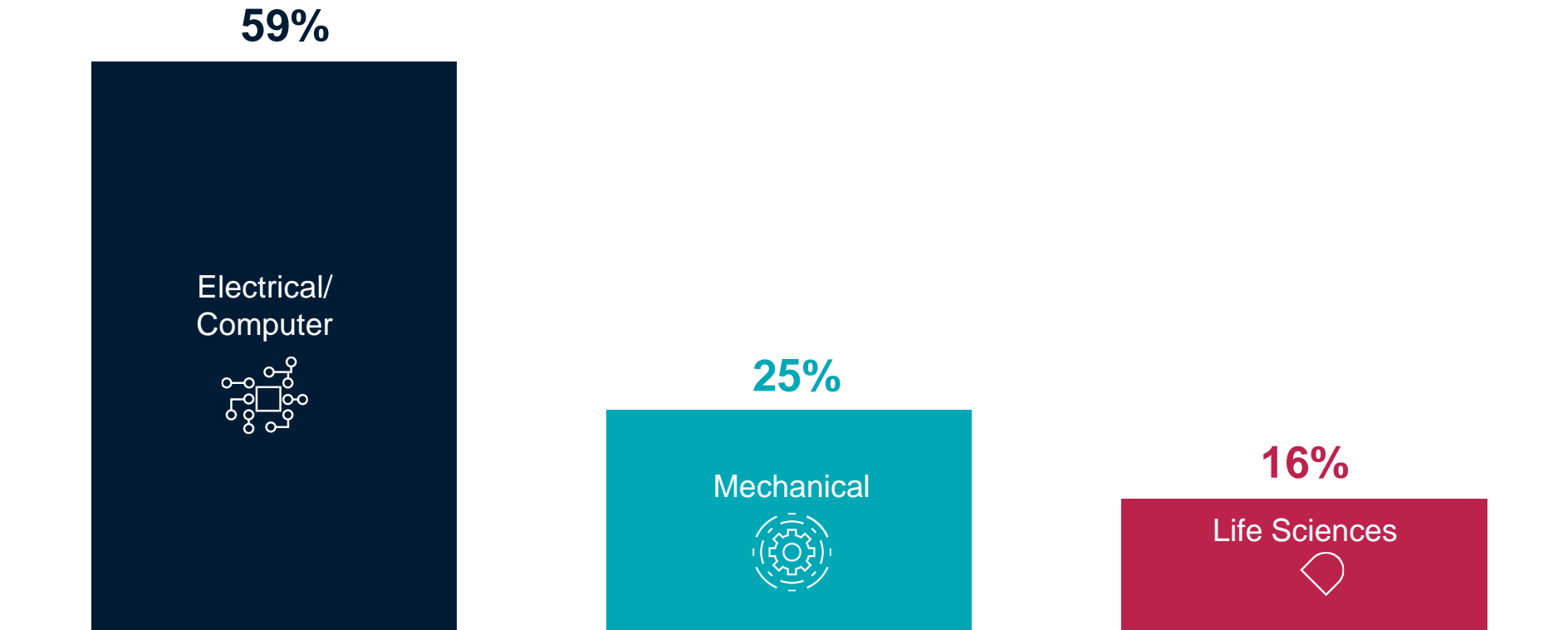
Most active courts by number of patent cases

	2019	2020	2021	2022	2023
PTAB	1322	1538	1386	1358	1,191
EDTX	332	397	449	472	627
WDTX	265	859	969	866	519
DDEL	1001	741	889	668	428

Source: Lex Machina as of 1/2/2024

Technology Breakdown by USPTO Tech Center

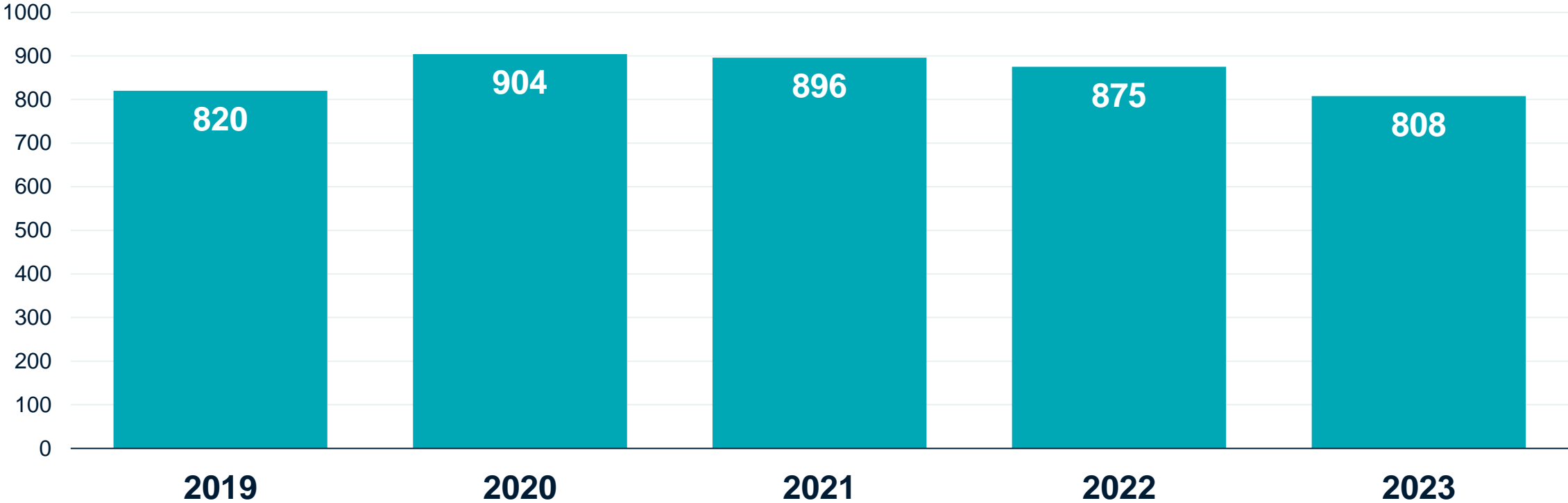
2012-2023



*Design Patents make up <1% of remaining petitions
Source: Lex Machina as of 1/2/2024*

Electrical/Computer IPR Filings

**IPRs Filed in Technology Centers
2100, 2400, 2600, AND 2800
2019 - 2023**



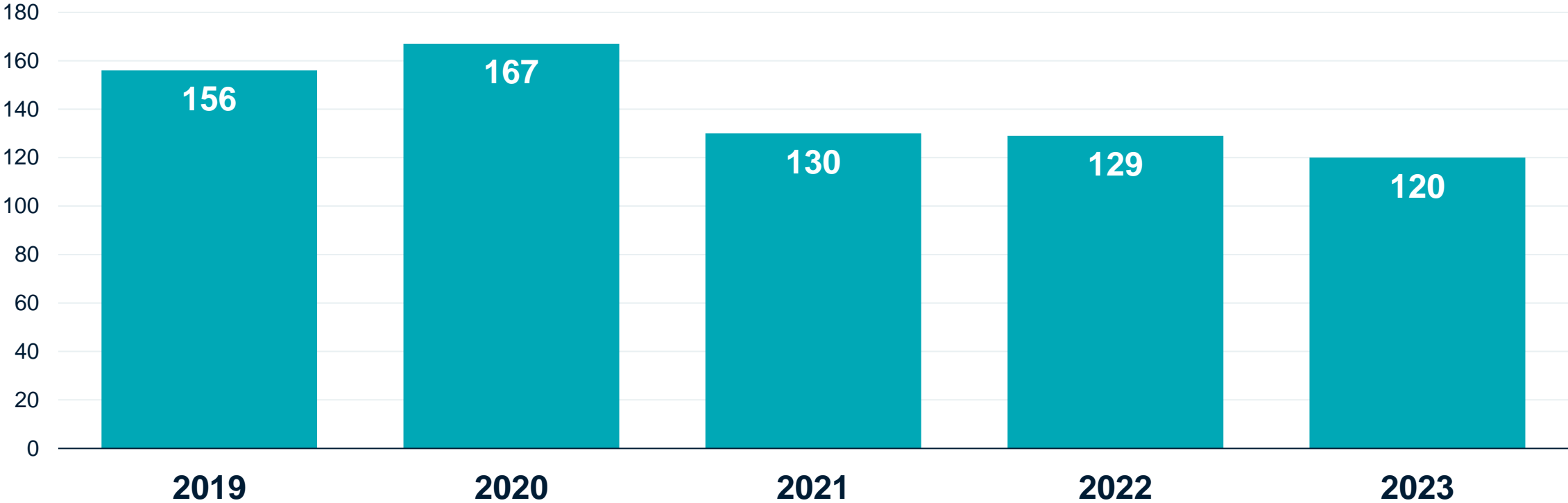
Source: Lex Machina, data pulled 1/4/2024

Life Sciences IPR Filings

IPRs Filed in Technology Centers

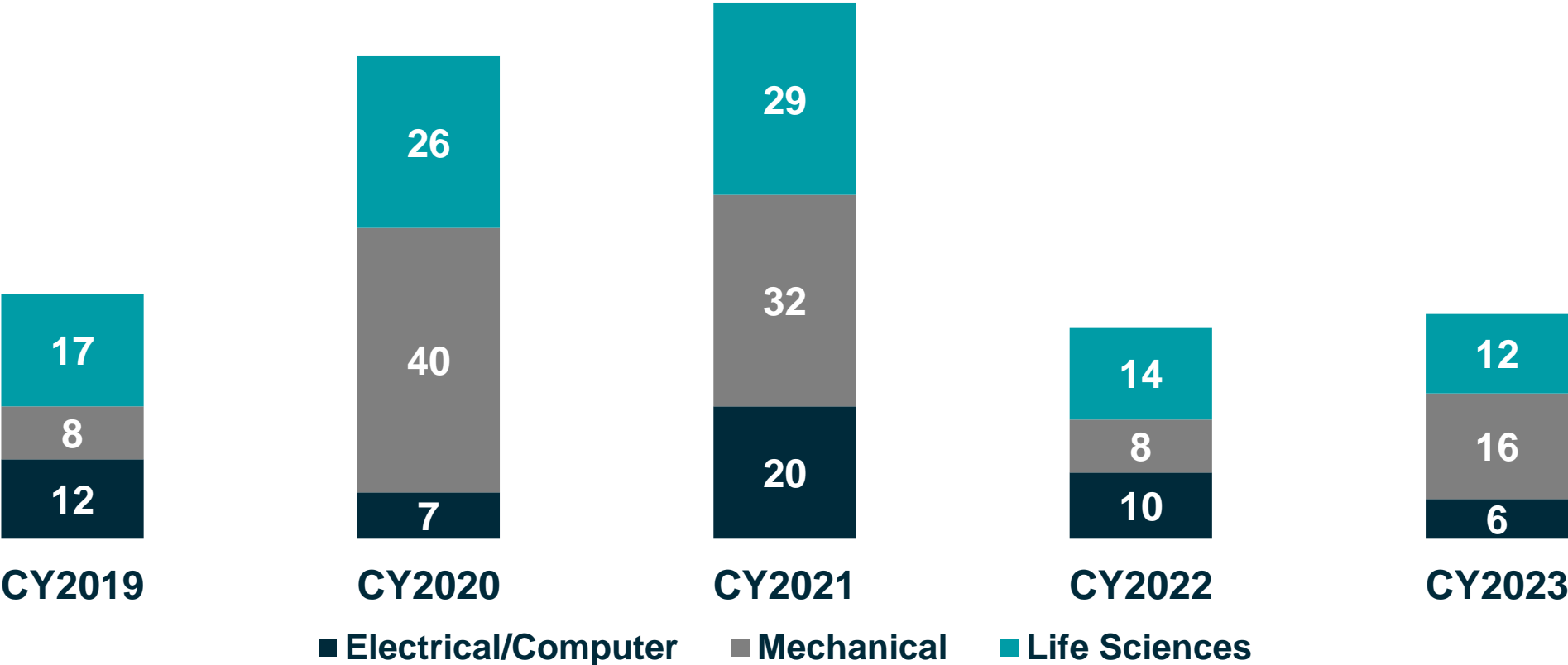
1600 + 1700

2019 - 2023



Source: Lex Machina, data pulled 1/4/2024

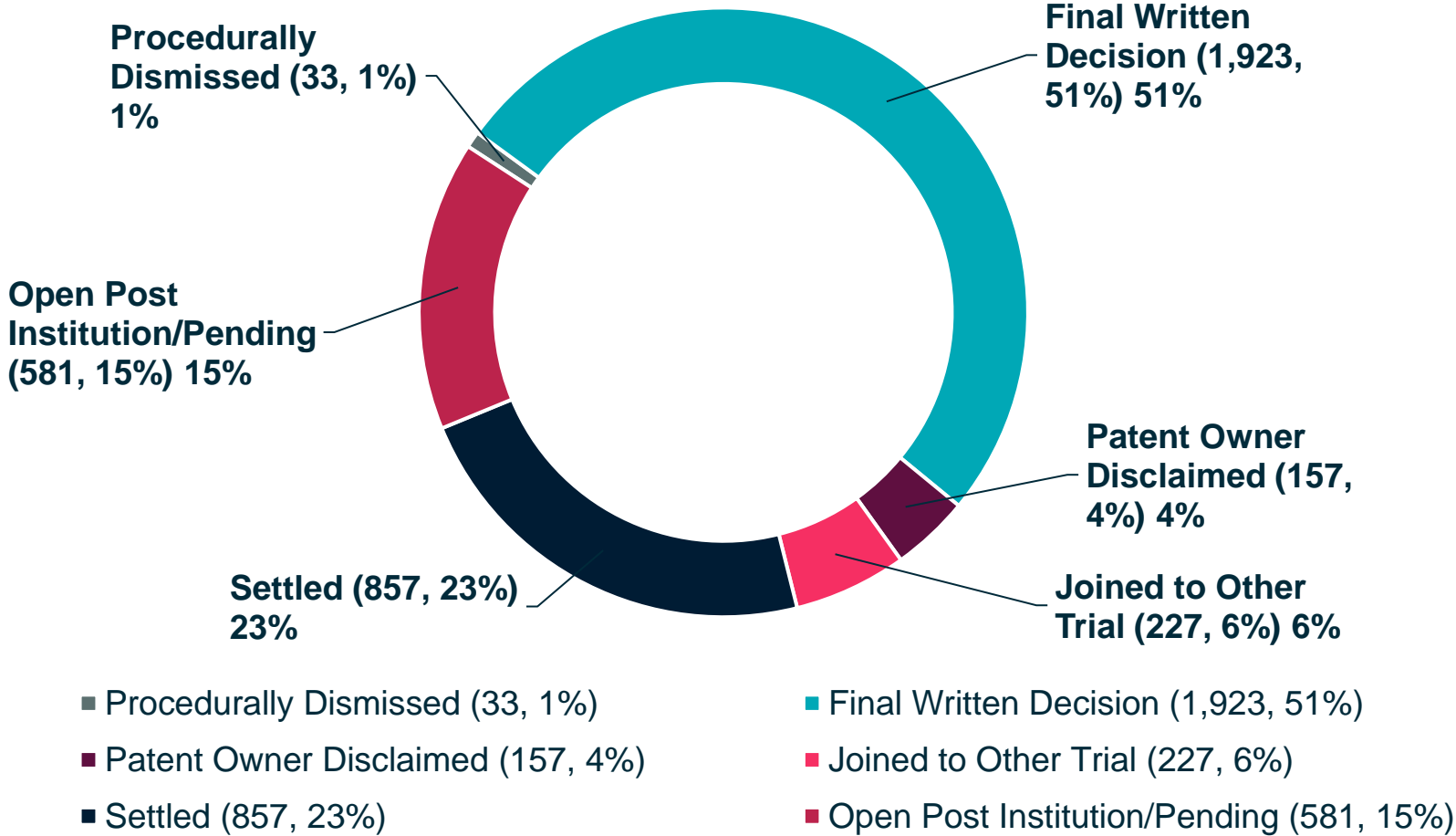
PGR Filings



Source: Lex Machina as of 1/8/2024
Design Patents make up ~6% of total PGR filings since 2019

Instituted IPR Petitions 2019 – 2023

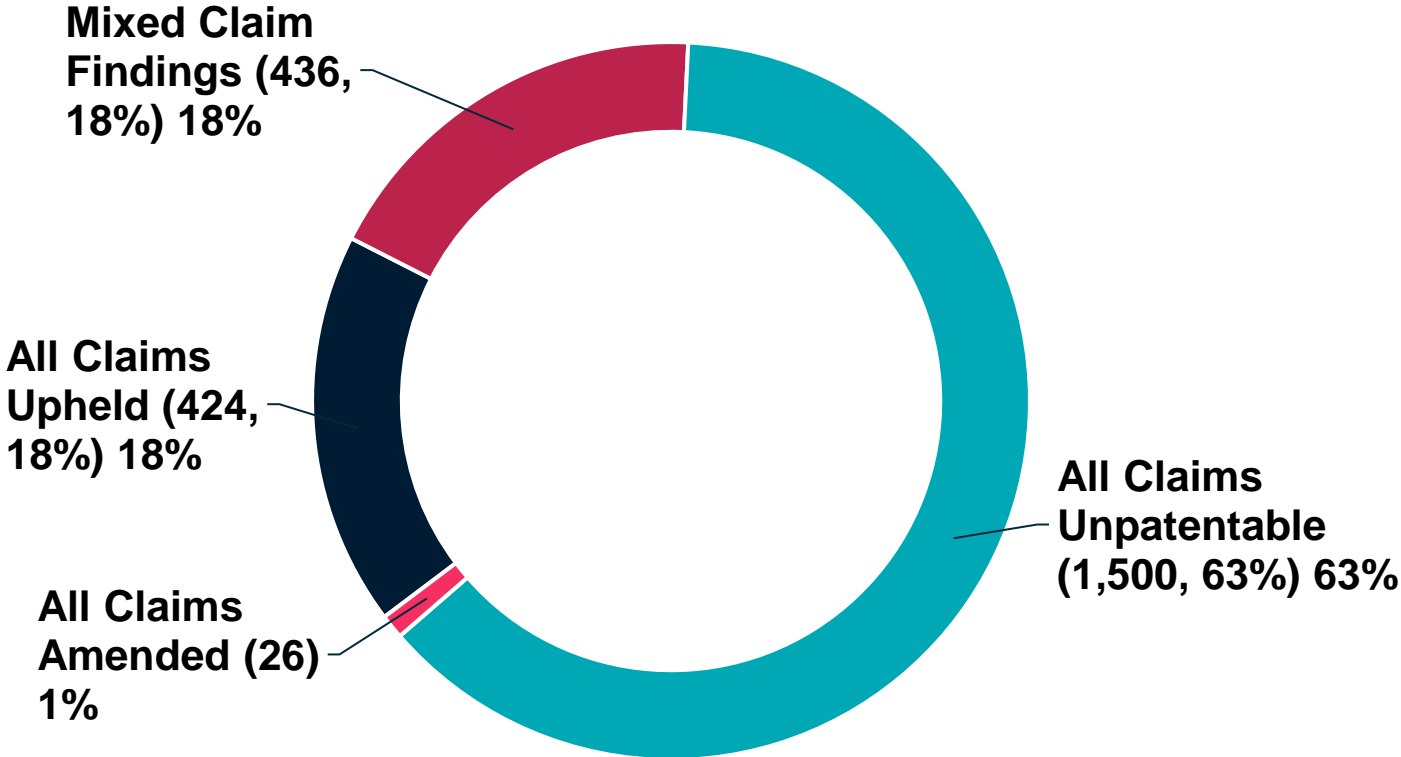
3,731 (72%)
IPR Petitions
Instituted
between 2019 – 2023



Source: Lex Machina as of 1/8/2024; IPRs reaching an institution decision between 2019 – 2023.

Final Written Decisions 2019 – 2023

2,386
IPR Petitions
Reached FWD
between 2019 – 2023



- All Claims Upheld (424, 18%)
- Mixed Claim Findings (436, 18%)
- All Claims Unpatentable (1,500, 63%)
- All Claims Amended (26)

Source: Lex Machina as of 1/8/2024; IPRs reaching an institution decision between 2019 – 2023.

IPR/CBM/PGR Federal Circuit Decisions

5,192

PTAB Cases Appealed
between 2012 – 2023

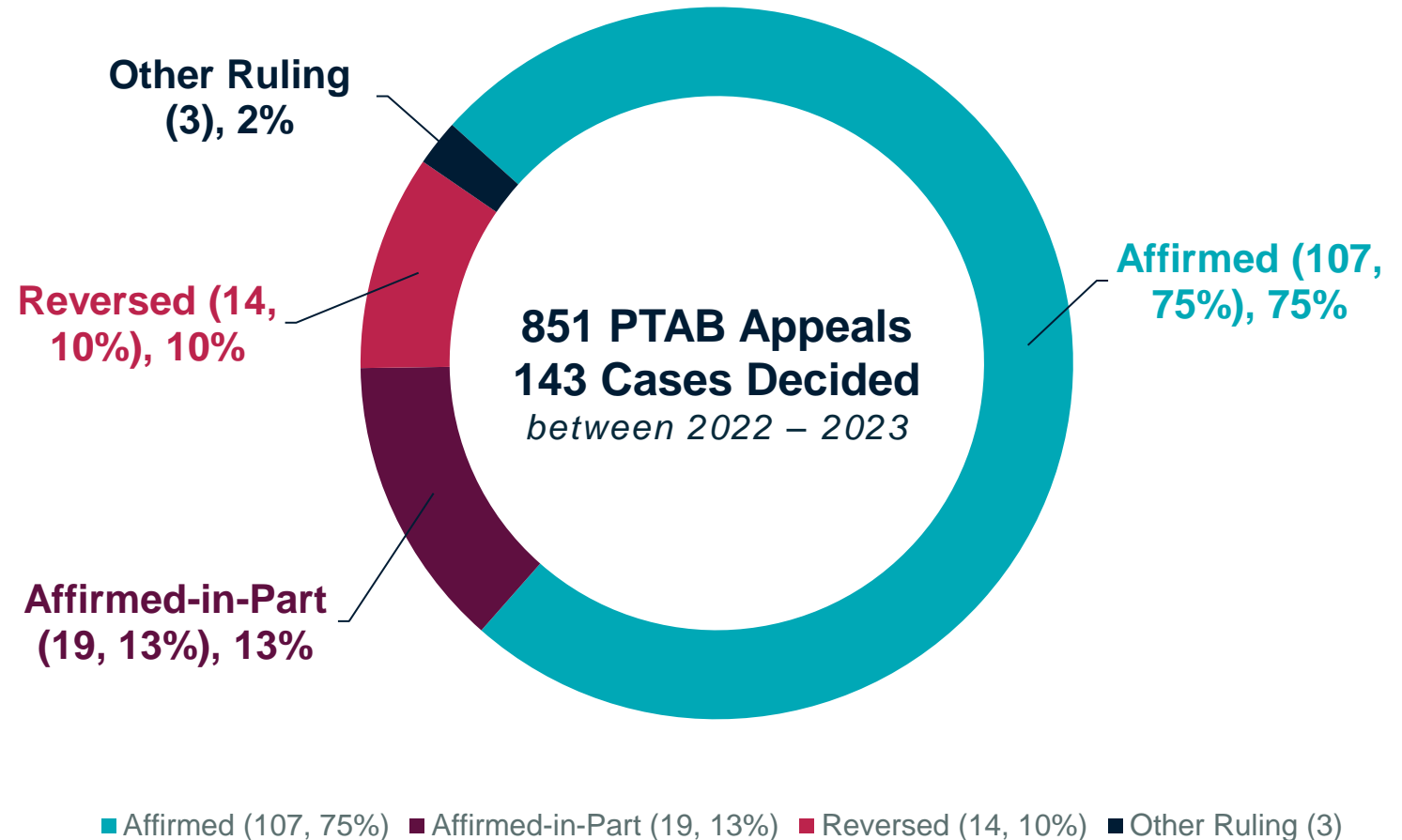
2,917 Cases Decided (56%)

2,201 Affirmed (76%)

313 Affirmed-in-Part (11%)

333 Reversed (11%)

59 Other Ruling (2%)

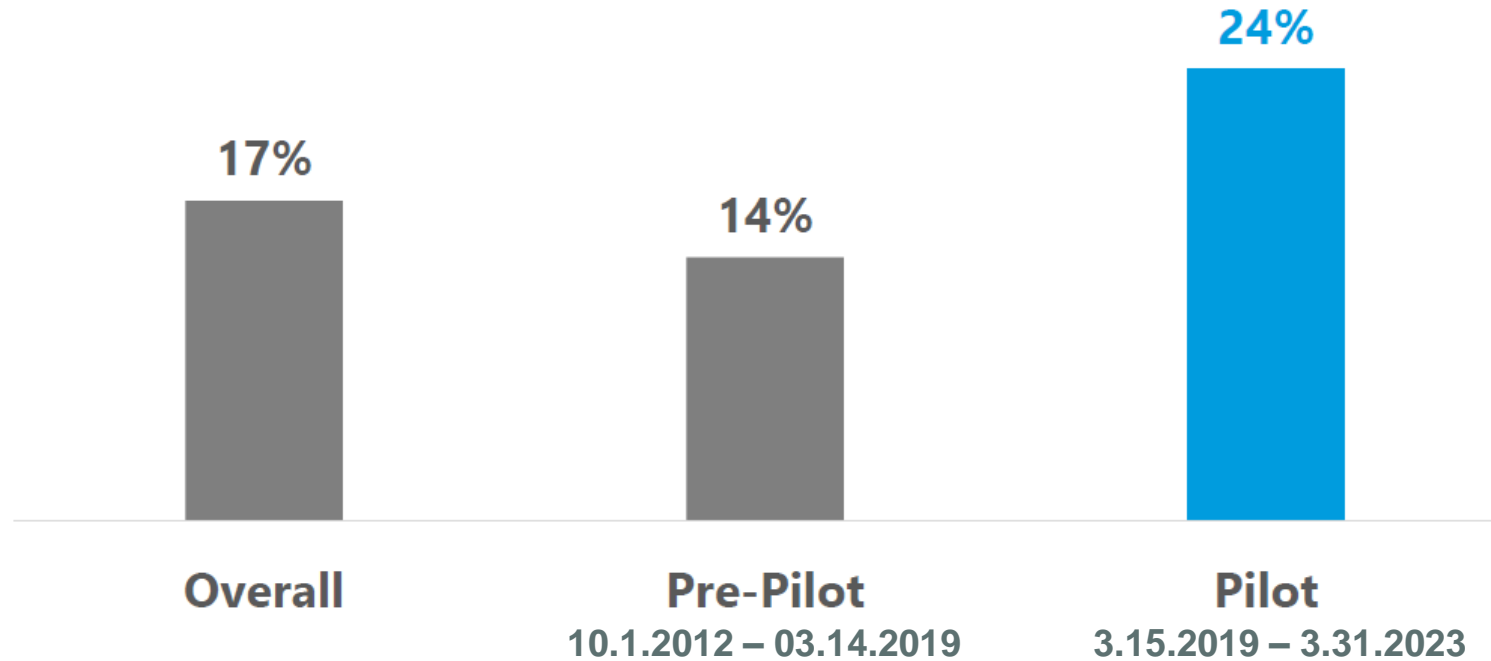


Source: Lex Machina as of 1/16/2024
For resolved cases filed between 1/1/2022 – 12/31/2023

Motions to Amend in 2023

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Motion to Amend (MTA) Grant Rates – 17% Overall

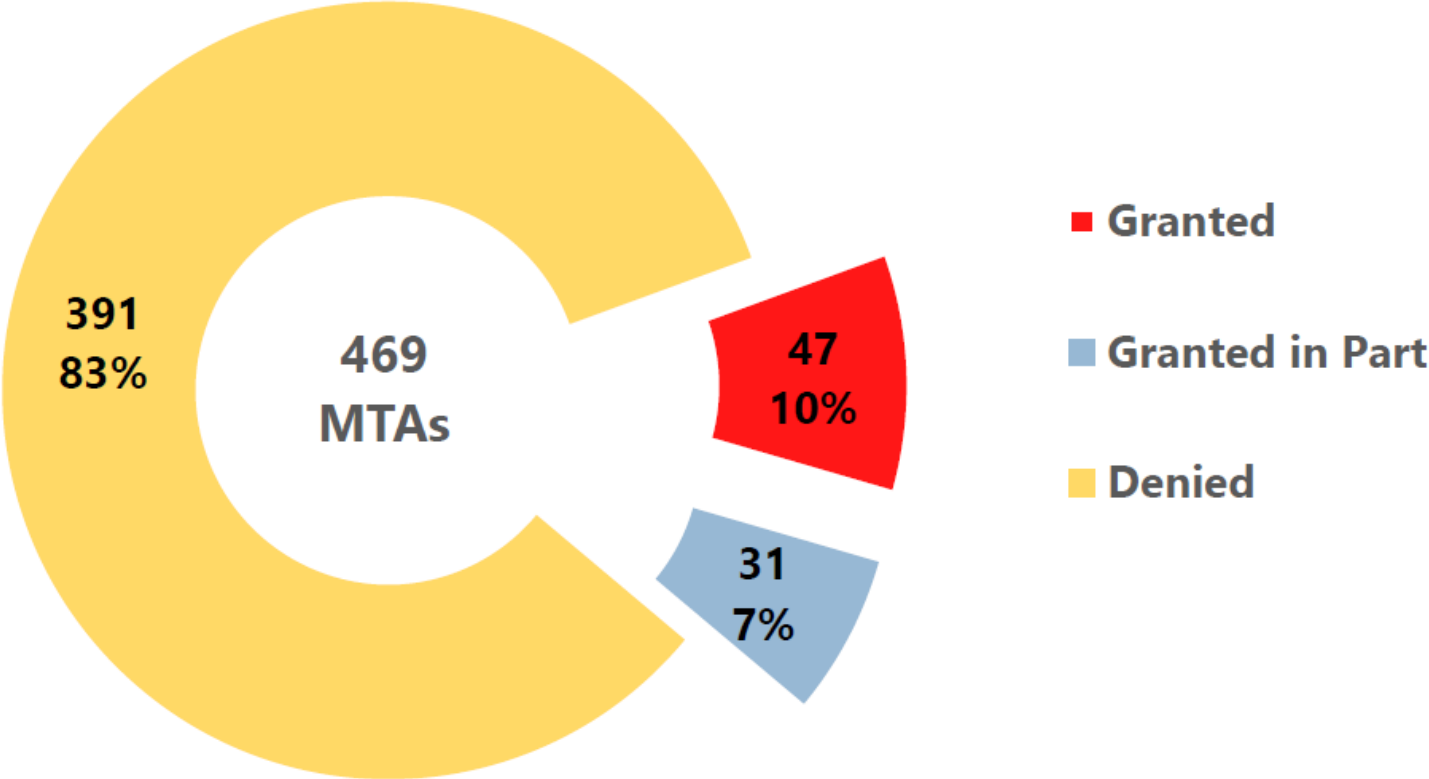


Grant rate calculated as the percent of MTA dispositions granted or granted in part.



Source: PTAB, data as of 1/15/2024

Disposition of all MTAs

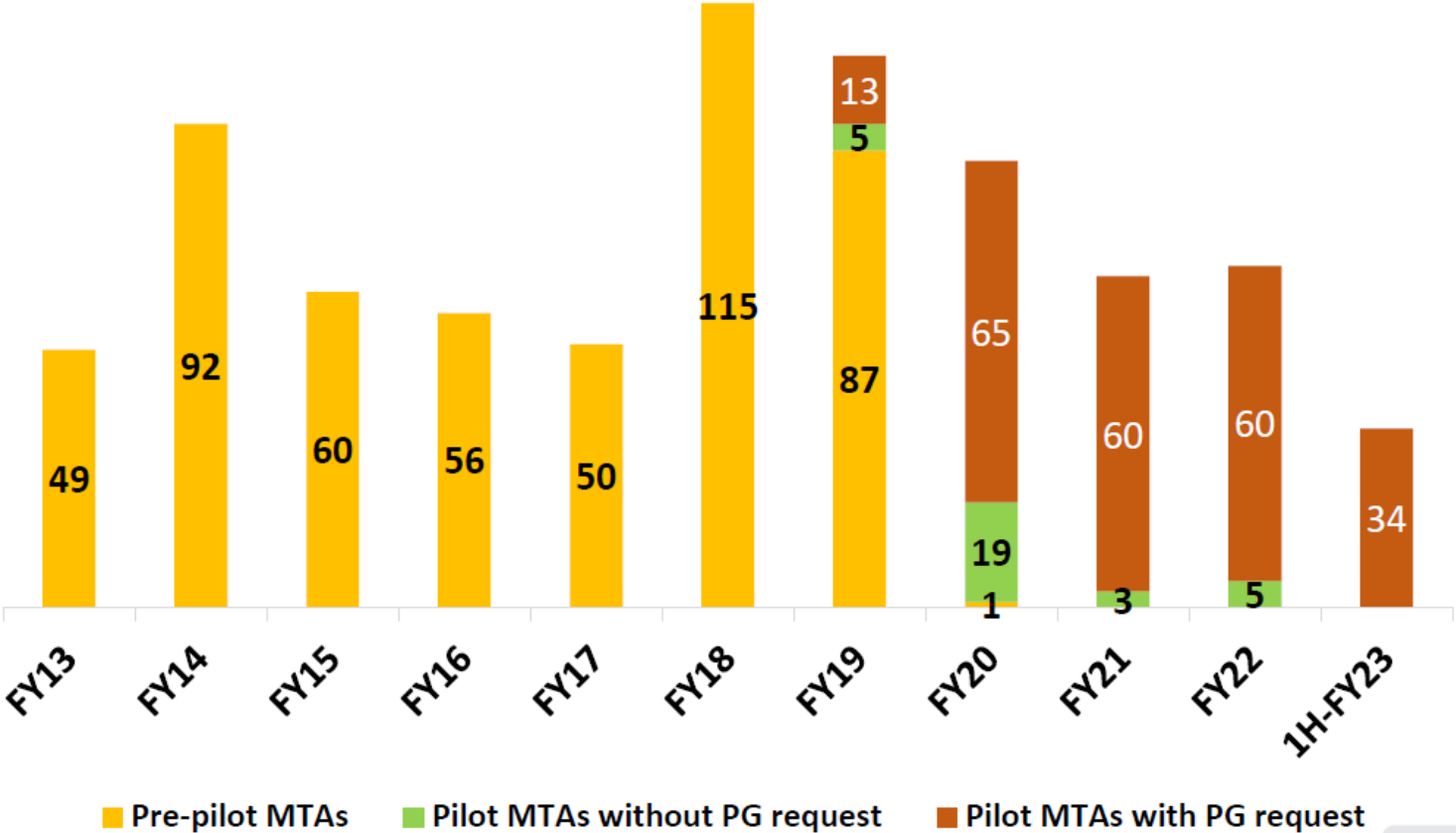


Dispositions reflect MTAs substituting claims.
10.1.2012 – 03.31.2023



Source: PTAB, data as of 1/15/2024

MTAs Filed by Fiscal Year



The one pre-pilot MTA filed in FY20 is a corrected MTA of an MTA originally filed in FY19.



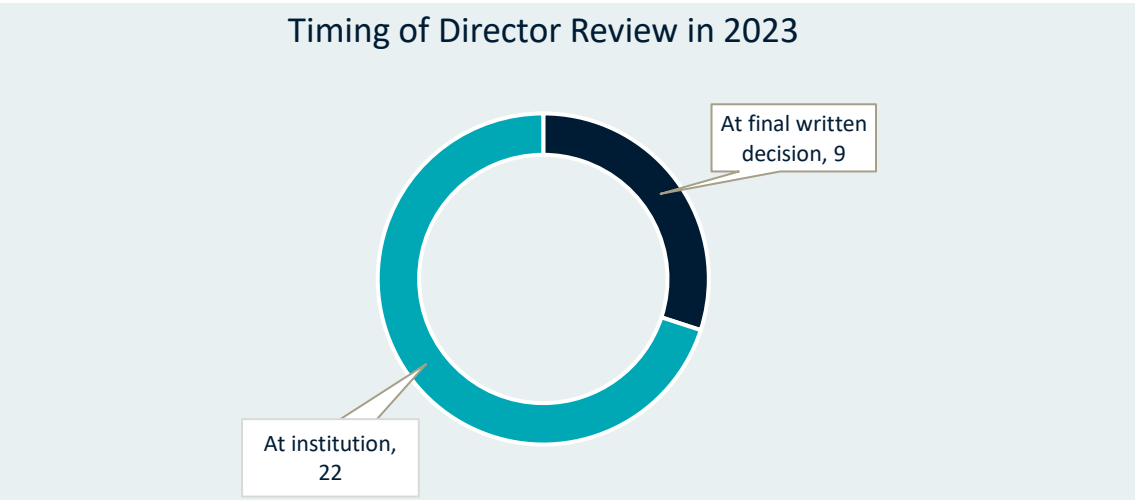
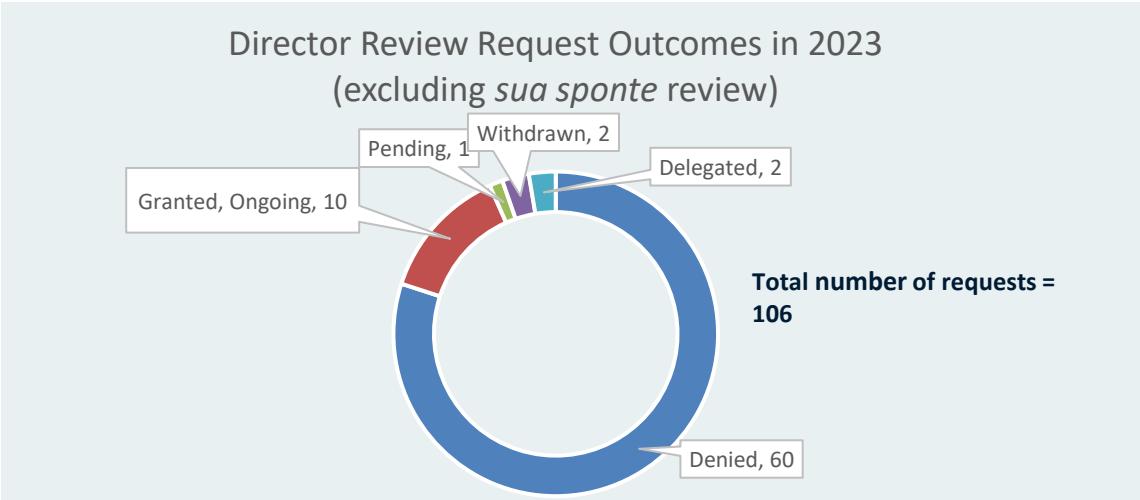
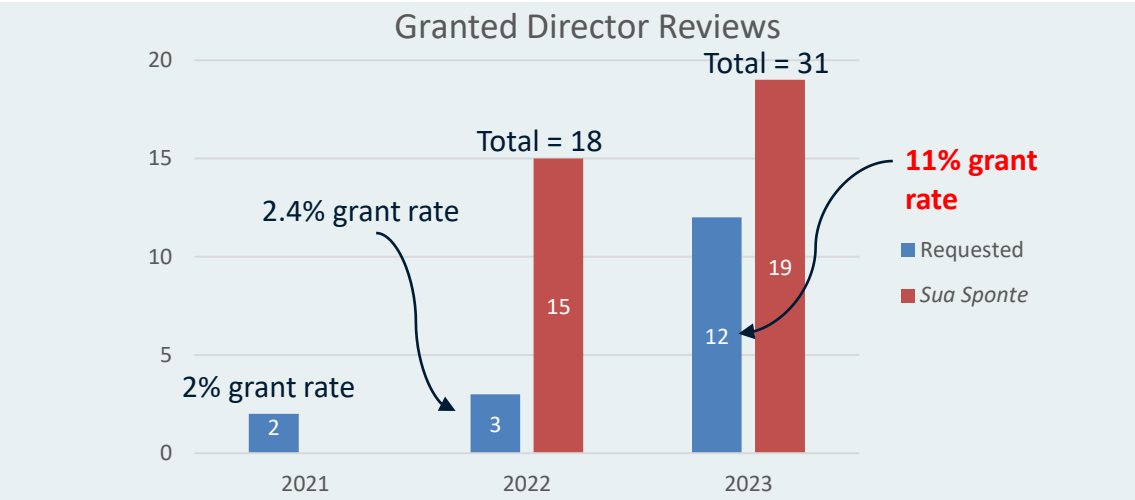
Source: PTAB, data as of 1/15/2024

Director Review in 2023

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Overview

Director Review in 2023



Developments in Director Review in 2023

- **Expanded scope of director review (July 24, 2023)**
 - DR of institution decisions
 - Establishment of Appeals Review Panel (ARP), providing for *sua sponte* review of decisions in *ex parte* appeals, re-examination appeals, and reissue appeals.
 - See www.uspto.gov/patents/ptab/decisions/appeals-review-panel-status
 - Establishment of Delegated Review Panel (DRP)
 - See www.uspto.gov/patents/ptab/decisions/delegated-rehearing-panel

Requests Granted Director Review (excludes *sua sponte* review)

Parties	Case No.	Status	Key Issue(s) Addressed
<i>Weber Inc v. Provisur Technologies Inc.</i>	IPR2022-00599	Vacated and remanded	May the Board ignore contested evidence for non-obviousness when finding claims unpatentable?
<i>Unified Patents LLC v. MemoryWeb LLC</i>	IPR2021-01413	Vacated-in-part	Under what circumstances must the Board address RPI issues?
<i>Vector Flow Inc v. HID Global Corp.</i>	IPR2023-00353	Vacated and remanded	When must Petitioner be afforded the opportunity to file a Reply to address 314(a) issues raised by Patent Owner's Preliminary Response?
<i>Resmed Corp v. Cleveland Medical Devices Inc.</i>	IPR2023-00565	Vacated and remanded	Similar issue to <i>Vector Flow</i>
<i>DK Crown Holdings Inc. V. Diogenes Limited</i>	IPR2023-00268	Delegated to DRP	Was denial of institution based on <i>sua sponte</i> construction of claim term appropriate?
<i>Synaffix B.V. v. Hangzhou Dac Biotech Co., Ltd.</i>	IPR2022-01531	Delegated to DRP	Did denial of institution rely on misapprehension of claimed chemical formulas, patent examples, and prosecution history?

Source: PTAB, data as of 1/15/2024

Weber Inc. v. Provisur Technologies Inc., IPR2022-00599

- **Provisur argued against a motivation to combine**
 - Several exhibits were provided to support these arguments
 - Weber filed a Motion to Exclude these exhibits (hearsay, etc.)
- **The Board did not consider the exhibits**
 - The Board stated only that “[w]e do not, in this Final Written Decision, rely on any of the contested evidence. Accordingly, Petitioner’s motion [to exclude] is dismissed as moot.”
- **Director Vidal vacated the judgement and remanded for the Board to address the contested exhibits**
 - “Having found the claims unpatentable as obvious, it was incumbent on the Board ***either to consider and address Patent Owner’s properly submitted evidence, or to exclude the exhibits*** based on Petitioner’s Motion to Exclude”
 - “On remand, the Board shall address Exhibits 2024, 2026–2028, 2035–2037, 2052–2058, 2060, 2061, 2065, 2066, 2070, and 2075. I leave it to the Board to determine whether this evidence should be excluded or considered.”

Vector Flow Inc v. HID Global Corp., IPR2023-00353

- **The district court’s Claim Construction Order and Scheduling Order were issued after the Petition was filed but before the POPR**
 - Patent Owner also provided statistics regarding time-to-trial
 - Petitioner requested authorization to file a reply addressing Patent Owner’s 314(a) arguments
- **The Board denied Petitioner’s request to file a reply**
 - “if Petitioner wished to provide a more complete *Fintiv* analysis for us to consider, it should have done so in the Petition”
- **Director Vidal authorized filing of the reply and remanded to the Board**
 - “The Petition ***could not have addressed the scheduled trial date or the claim construction order***, both of which issued after the Petition was filed but before the Preliminary Response was due. [] Moreover, ***Petitioner did not have the opportunity to address Patent Owner’s evidence*** on median time-to-trial for civil actions in the District of Delaware and the statistics and arguments related to Judge Williams specifically”
- Director Review in *Resmed Corp v. Cleveland Medical Devices Inc.*, IPR2023-00565, was similarly related to *Fintiv*-related issues.

DK Crown Holdings Inc. V. Diogenes Limited, IPR2023-00268

- **After Board denied institution of IPR, Petitioner sought Director Review**
 - **Denial relied on Board's *sua sponte* construction of the term "continuously"**
 - "Although the parties do not propose any terms for construction, this ***Decision turns on interpretation of "continuously"*** as used in the claims of the '779 patent. As explained in more detail in section II.E below, we interpret "continuously" performing a task to exclude performing that task at discrete time points. No further claim interpretation is needed." [Paper 9, 10 ("Decision Denying Institution")]
 - APJ Saidon dissented from the decision
- **Director Vidal delegated DR to a Delegated Review Panel (DRP) because of "the fact-intensive issues presented in this case."** [Paper 11, 2 ("DRP Delegation Order")]
 - "The DRP shall review the Decision and determine whether the record demonstrates that the Decision misapprehended or overlooked any issue raised in the Director Review request. See Delegated Rehearing Panel §§ 2.C–D; accord 37 C.F.R. § 42.71(d)." [Paper 11, 2 ("DRP Delegation Order")]
 - DRP has not yet issued any decision

Synaffix B.V. v. Hangzhou DAC Biotech Co., Ltd, IPR2022-01531

- **After Board denied institution of IPR, Petitioner sought Director Review of multiple issues**
 - "Whether...the Decision should be reviewed and vacated based on the misapprehension and fundamental errors contained in its assessment of the claimed chemical formulas, patent examples and prosecution history." [EX3100, 1 ("Director Review Request")]
 - "[W]hether the very amendment and remarks relied upon in the Decision to find a disavowal of claim scope can support the Decision's findings even when they (as well as additional, later prosecution history) show an opposite intent by the Applicant." [EX3100, 2 ("Director Review Request")]
- **Director Vidal delegated DR to a Delegated Rehearing Panel**
 - "I have considered the request and determine that the Decision warrants review by an independent Delegated Rehearing Panel ("DRP") to review the issues presented in this case" [Paper 19, 1 ("DRP Delegation Order")]
- **Delegated Rehearing Panel issued order allowing Patent Owner the option for limited response to the Petitioner's Request for Director Review**
 - DRP has not yet issued any decision following Patent Owner's submission

Requests Granted Director Review (excludes *sua sponte* review) – Pending

Parties	Case No.	Status	Key Issue(s) Addressed
<i>Nearmap US, Inc. v. Eagle View Technologies, Inc.</i>	IPR2022-00734	Granted / Ongoing	Implications of Board failure to address disputed claim constructions in finding non-obviousness based on secondary considerations
<i>American Honda Motor Co., Inc. v. Neo Wireless, LLC</i>	IPR2023-00797	Granted / Ongoing	Whether Petitioner participation in a JDG or MDL may serve as the principal reason for discretionary denial under <i>General Plastic</i>
<i>Ford Motor Company v. Neo Wireless, LLC</i>	IPR2023-00763	Granted / Ongoing	Whether Petitioner participation in MDL with competitors selling different products implicates a "significant relationship" in §314(a) Factor 1 analysis
<i>Nokia of America Corporation v. Alexander Soto et al</i>	IPR2023-00680, -00681, -00682	Granted / Ongoing	Whether references can be considered cumulative for §325(d) analysis when they cover the same limitations as prior combinations
<i>MAHLE Behr Charleston Inc. v. Frank Amidio Catalano</i>	IPR2023-00861	Pending	In review

Source: PTAB, data as of 1/15/2024

Sua Sponte Cases Granted Director Review

Parties	Case No.	Status	Key Issue(s) Addressed
<i>Xerox Corp. v. Bytemark, Inc.</i>	IPR2022-00624	Affirmed	Whether Board is permitted to give little weight to an expert
<i>Volvo Penta of the Americas, LLC v. Brunswick Corporation</i>	IPR2022-01366 to -01369, -01424	Vacated and remanded	Whether a claim is "finally adjudicated" when the district court decision is under appeal
<i>Spectrum Solutions LLC v. Longhorn Vaccines & Diagnostics LLC</i>	IPR2021-00847, -00850, -00854, -00857, -00860	Pending additional briefing	Implications when a party withholds relevant factual evidence
<i>Samsung Electronics Co., Ltd. et al v. Netlist, Inc.</i>	IPR2022-00615	Vacated, Remanded	Whether Petition was time-barred under §315(b) because of third-party RPI
<i>CommScope Technologies LLC et al v. Dali Wireless, Inc.</i>	IPR2022-01242	Vacated, Remanded	When should compelling merits determination be considered in §314(a) analysis
<i>Google LLC f/k/a Google Inc. v. Valtrus Innovations LTD</i>	IPR2022-01197	Vacated, Remanded	Whether §325(d) issue raised in POPR was reasonably foreseeable
<i>Wolfspeed, Inc. f/k/a Cree, Inc. v. The Trustees of Purdue University</i>	IPR2022-00761	Vacated, Remanded	Whether prior art was substantially the same under §325(d) analysis
<i>SolarEdge Technologies Ltd. v. SMA Solar Technology AG</i>	IPR2020-00021	Modified-in-part	Availability of AAPA for use in Petition as "known" in the art
<i>Neurocrine Biosciences, Inc. v. Spruce Biosciences, Inc</i>	PGR2021-00088, -00025	Vacated, Remanded	Reliance on references as evidence of inherency in anticipation analysis and adequate disclosure of genus in written description analysis
<i>Keysight Technologies, Inc. v. Centripetal Networks, LLC</i>	IPR2022-01421	Vacated, Remanded	Implications to §325(d) analysis of Examiner failure to explain patentability of claims over FWD of related claims with significant overlap

Select *Sua sponte* Cases in 2023

- ***Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624**
 - “I determine that the Board was correct in giving little weight to Petitioner’s expert because the expert declaration merely offered conclusory assertions without underlying factual support and repeated, verbatim, Petitioner’s conclusory arguments.”
- ***Volvo Penta of the Americas, LLC v. Brunswick Corporation*, IPR2022-01366 to –01369, –01424**
 - A claim is not “finally adjudicated to be invalid” if the district court decision ruling it invalid is under appeal
 - The Board must consider *Fintiv* factors when a district court ruling is under appeal in parallel litigation
- ***Spectrum Solutions LLC v. Longhorn Vaccines & Diagnostics LLC*, IPR2021–00847, –00850, –00854, –00857, –00860**
 - What are the ramifications when the Board determines that a party has withheld relevant factual evidence during an AIA proceeding?
 - Briefing is ongoing

Stipulations in 2023

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Sotera Stipulations

- **Scope of Sotera Stipulation**

- If the PTAB institutes inter partes review, Petitioner "will not pursue in [the District Court] the specific grounds identified above [in the table] in connection with the referenced patent(s) and claim(s) as originally issued on the instituted *inter partes* review petition, or on any other ground for a given patent . . . that was raised or could have been reasonably raised in an IPR (i.e., any ground that could be raised under §§ 102 or 103 on the basis of prior art patent or printed publications.)" *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Exhibit 1038 at 1–7.

- **Under Director Vidal's June 2022 Fintiv Guidance, Sotera stipulation dispenses with *Fintiv* analysis**

- **One thing to note is that some panels have begun questioning the claims encompassed in the Sotera stipulation—not just claims in IPR but perhaps all asserted claims or even all claims in the patent**

PTAB Treatment of non-Sotera Stipulations - Representative cases

Parties	FWD vs. Trial	Case No.	Stipulation	Outcome
<i>Samsung Elecs. Co., Ltd. v. Dodots Licensing Solutions LLC</i>	FWD ~3M after Trial (per schedule) FWD ~1M before Trial (MTTT)	IPR2023-00701	Sand Revolution (will not “pursue primary references” at Trial) (<i>Pet.</i> , 104)	Instituted F2: “neutral” F4: “slightly against” denial (<i>Board</i>)
<i>Lifecore Fitness, Inc. v. Woodway USA, Inc.</i>	FWD >1yr before Trial (MTTT)	IPR2023-00849	Sand Revolution (“will not raise at Trial ... any Ground raised here”) (<i>Pet.</i> , 112)	Instituted
<i>Google LLC v. Flypsi, Inc.</i>	FWD ~6M after Trial (per schedule) FWD ~2M after Trial (MTTT)	IPR2023-00360	Sand Revolution (“will not pursue the IPR grounds in the district court litigation”) (<i>Pet.</i> , 71)	Instituted F2: “slightly favors [] denial” F4: “slightly against [] denial” F6: N/A (<i>Board</i>)
<i>Cisco Systems, Inc. v. Orckit Corp.</i>	FWD ~6M after Trial (per schedule) FWD ~7M after Trial (MTTT)	IPR2023-00554	Sand Revolution (“will cease asserting” the same “combination of references” at Trial) (<i>Pet.</i> , 77)	Instituted F2: “favor[s] ... denial” F4: “only marginally against [] denial” F6: “the Petition presents compelling merits ” (<i>Board</i>)

PTAB Treatment of non-Sotera Stipulations - Representative cases

Parties	FWD vs. Trial	Case No.	Stipulation	Outcome
<i>Ericsson Inc. v. Koninklijke KPN N.V.</i>	FWD ~6M after Trial (per schedule, no MTTT stats mentioned)	IPR2023-00582	All Applied Art (“will not pursue ... same grounds” or “references” at Trial) (<i>Paper 7</i> , 4-5)	Instituted F2: “favors [] denial” F4: “slightly against [] denial” F6: N/A (<i>Board</i>)
<i>Roku Inc. v. Ioengine LLC</i>	FWD ~6M after Trial (MTTT)	IPR2022-01551	All Applied Art (will not pursue “the same grounds” or “references that form the” grounds) (<i>Paper 9</i> , 1)	Denied F2: “heavily in favor of []denial” F4: “somewhat against” denial F6: “does not weigh against [] denial” (<i>Board</i>)
<i>Samsung Elecs. Co. Ltd. v. California Institute of Tech.</i>	FWD ~8M after Trial (per schedule) FWD ~5M after Trial (MTTT)	IPR2023-00130	All Applied Art (will not “rely on any reference used in [Petition] grounds”) (<i>Pet. Reply</i> , 1)	Denied F2: “favors ... deny[ing] institution” F4: “somewhat against” denial F6: “neutral” (<i>Board</i>)

Source: PTAB, data as of 1/13/2024

Notable Commentary Re non-Sotera Stipulations

- **Google LLC v. Flypsi, Inc., IPR2023-00360, Paper 9**
 - FWD expected ~6M **after** scheduled Trial date (MTTT only 2M) - **INSTITUTED** (Sand Revolution)
 - “Neither party explains which claims and references are at issue in the District Court Litigation. See Pet. 53; Prelim. Resp. 17; Reply 2–3; Sur-reply 2. Thus, on this record, **we cannot determine whether there is overlap between issues raised in the Petition and District Court Litigation**. Nonetheless, **Petitioner’s stipulation** that it will not pursue the grounds asserted in the Petition in the District Court Litigation **mitigates to some degree concerns of duplicative efforts and potentially conflicting decisions**. Pet. 53; see *Sand Revolution II, LLC v. Continental Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24 at 12 (PTAB June 16, 2020) (informative).” (p. 37)
 - “Specifically, **we determine that Petitioner’s stipulation** and the parties’ minimal investment in the District Court Litigation as to issues of unpatentability **outweigh the projected trial date**. As a result, we need not decide whether Petitioner presents a compelling unpatentability challenge. See *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4–5 (PTAB Feb. 27, 2023) (decision on Director review) (precedential).” (p. 38)

Notable Commentary Re non-Sotera Stipulations

- ***Ericsson Inc. v. Koninklijke KPN N.V.*, IPR2023-00582, Paper 10**
 - FWD expected ~6M **after** scheduled Trial date (no MTTT stats mentioned) - **INSTITUTED** (All Applied Art)
 - “Petitioner’s invalidity contentions in the District Court Litigation also address claims 1 and 6–8, and rely on Angelot and 3GPP TR 32.816. Ex. 2015, 1, 11. Nonetheless, **Petitioner’s stipulation that it will not rely on the grounds or references asserted in the Petition in the District Court Litigation mitigates to at least some degree concerns of duplicative efforts and potentially conflicting decisions.** Reply 4–5; see *Sand Revolution II, LLC v. Continental Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24 at 12 (PTAB June 16, 2020) (informative).” (p. 13)
 - “Specifically, we **determine that Petitioner’s stipulation** and reasonable diligence in filing the Petition as well as the parties’ minimal investment in the District Court Litigation **outweigh the projected trial date.**” (p. 14)
 - “As a result, we need not decide whether Petitioner presents a compelling unpatentability challenge.” (p. 14)

Notable Commentary Re non-Sotera Stipulations

- ***Roku Inc. v. Ioengine, LLC*, IPR2022-01551, Paper 11**
 - FWD expected ~6M **after** scheduled Trial date (MTTT) - **DENIED** (All Applied Art)
 - “Roku’s stipulation, however, falls far short of a **Sotera-type stipulation** that would bar Roku from pursuing any grounds in the parallel district court proceeding that could have reasonably been raised before the Board. Thus, while Roku’s stipulation would prevent some overlap between this proceeding and the parallel district court proceeding, the scope of the stipulation does not rise to the level contemplated in the *Fintiv* Memo.” (pp. 13-14)
 - “Thus, although we find that the fourth *Fintiv* factor weighs somewhat against discretionary denial of institution, this does not end our analysis because Roku has declined to submit a **Sotera-type stipulation**.” (p. 14)

Notable Commentary Re non-Sotera Stipulations

- ***Samsung Elecs. Co. Ltd. v. California Institute of Tech.*, IPR2023-00130, Paper 10**
 - FWD expected ~5M **after** scheduled Trial date (MTTT) - **DENIED** (Sand Revolution +)
 - “Patent Owner argues that **Petitioner can still put forth district court invalidity arguments based on references that are “integral to” the asserted grounds**, including “Lin/Costello and MacKay.” PO Sur-reply 1; see *also* Prelim. Resp. 46 (similar argument).” (p. 19)
 - “Petitioner’s stipulation is not as expansive as the stipulation discussed in *Sotera Wireless Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 13 (PTAB Dec. 1, 2020) (precedential) (“Sotera”), because Petitioner does not relinquish all grounds that it reasonably could have raised in this inter partes review. **Nevertheless, it is broader to some degree than the stipulation discussed in *Sand Revolution* because it precludes Petitioner from relying in the district court on any of the same references listed in the statement of the grounds in the Petition, and is not limited to only the same grounds. See *Sand Revolution*, Paper 24 at 11–12.**” (p. 19)
 - “Petitioner **has not presented a compelling, meritorious challenge to the claims of the ’710 patent**. Thus, this consideration is neutral as to whether we should exercise our discretion to deny the Petition.” (p. 21)

2023 Observations Re non-Sotera Stipulations

- **Sotera or nothing? Not necessarily.**
 - Non-exhaustive review of 2023 cases indicates general utility in non-*Sotera* stips
 - Sand Revolution, Sand Revolution +, All Applied Art
 - Carefully balance stip selection against date of FWD relative to Trial date
 - Non-Sotera stip appears useful if FWD < 4M **after** Trial (MTTT)
 - Strongly consider Sotera stip if FWD > 4M **after** Trial (MTTT)
 - Non-Sotera stip appears viable **with compelling merits**
- **MTTT stats matter - more persuasive than scheduled trial date**
 - Use “the **most recent statistics on median time-to-trial** for civil actions in the district court in which the parallel litigation resides.” *Samsung Elecs. Co. Ltd.*, IPR2023-00701, Paper 10, p. 11 (*citing to Fintiv Memo*, 8-9)

Compelling Merits in 2023

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Director Vidal's Original Guidance

- **June 21, 2022 – Memorandum on Interim Procedure For Discretionary Denials In AIA Postgrant Proceedings With Parallel District Court Litigation**
 - A finding of compelling merits **alone** demonstrates that institution should not be denied
 - Standard for compelling merits: “Compelling, meritorious challenges are those in which the evidence, if unembuted in trial, would **plainly lead to a conclusion** that one or more claims are **unpatentable by a preponderance of the evidence.**”
- **October 4, 2022 – *OpenSky Indus., LLC v. VLSI Tech. LLC, IPR2021-01064, Paper 102***
 - “To be clear, a compelling-merits challenge is **a higher standard than the reasonable likelihood** required for the institution of an IPR under 35 U.S.C. § 314(a). A challenge can only “plainly lead to a conclusion that one or more claims are unpatentable” [] if it is **highly likely that the petitioner would prevail with respect to at least one challenged claim**”

Director Vidal's Updated Guidance

- **February 27, 2023 – *CommScope Technologies, LLC v. Dali Wireless Inc.*, IPR2022-01242, Paper No. 23**
 - The Board is to ***first*** analyze *Fintiv* factors 1-5; the compelling merits analysis is ***only*** to be performed when factors 1-5 favor denial of institution
 - The compelling merits analysis must be articulated and distinct from the § 314(a) analysis:
 - “the Board must provide reasoning sufficient to allow the parties to challenge that finding and sufficient to allow for review of the Board’s decision.”
 - “Merely pointing to its analysis under the lower institution standard is insufficient to demonstrate that the Petition presents a compelling unpatentability challenge”

Overview of Compelling Merits in 2023

- **In 2023, the Board provided a substantive compelling-merits analysis in 34 cases**
 - Of those, institution was granted in 17 and denied in 17
 - The Board's reasoning tends to be highly case-specific

Relevant 2023 Institution Decisions for Petitioners

- **Anticipation or single-reference obviousness grounds may simplify analysis**
 - *CommScope Technologies LLC et al v. Dali Wireless, Inc.*, IPR2022-01293: Institution **granted** because “[w]e find the merits of this case to be compelling. First, the anticipation and single-reference obviousness grounds set forth by Petitioner using the Wu reference, on the present record, are clear and persuasive. The single-reference obvious ground buttresses the anticipation ground. In addition, the single-reference obviousness ground does not rely on a combination of references, which simplifies the showing needed for obviousness.”
- **Specifically argue for compelling merits**
 - *Roku, Inc. v. IOENGINE, LLC*, IPR2022-01552: Institution denied; Board notes that “Roku does not specifically contend that its Petition presents a compelling, meritorious challenge”

Relevant 2023 Institution Decisions for Petitioners

- **Avoid inconsistent construction arguments between the PTAB and litigation**
 - ResMed Corp. v. Cleveland Medical Devices, Inc., IPR2023-00565: Institution **denied** because “by providing inconsistent positions regarding the proper construction of the claims, Petitioner is not being transparent. [] We are thus left with the choice between alternative claim constructions that would either potentially lead to inconsistent rulings or lead to Petitioner’s arguments set forth in the Petition becoming inapposite or otherwise failing to provide sufficient evidentiary basis to support institution. For this reason, the Petition fails to meet the compelling merits standard”
 - Note: this decision was vacated by Director Vidal for separate reasons
- **But, inconsistent constructions may not always be a problem**
 - Netflix, Inc. v. GoTV Streaming, LLC, IPR2023-00758: Institution **granted** because “whether Petitioner’s reliance on 'plain and ordinary meaning' in this proceeding conflicts with Petitioner’s position in the California case **has no bearing** on whether Petitioner presents compelling evidence of unpatentability in this proceeding.”

Relevant 2023 Institution Decisions for Patent Owners

- **Consider making your strongest limitation the centerpiece of your anti-compelling-merits argument – Board can focus on that feature**
 - *Roku, Inc. v. IOENGINE, LLC*, IPR2022-01553: Institution **denied** because “[t]he preliminary record does not plainly show that Alger or the other references teach or disclose a portable device and a separate terminal with processing capabilities sufficient to facilitate a key exchange between the terminal and the portable device”
 - *Samsung Electronics Co., Ltd. v. California Institute of Technology*, IPR2023-00130: Institution **denied** because “we do not find compelling Petitioner’s showing for at least the component of the formula of independent claim 1 that ‘is the value of a sum of ‘a’ randomly chosen irregular repeats of the message bits.’”

Relevant 2023 Institution Decisions for Patent Owners

- **Consider characterizing some issues as at least “close”**
 - *Roku, Inc. v. IOENGINE, LLC*, IPR2022-01551: Institution **denied** because “[i]n light of IOENGINE’s preliminary arguments, we find the issue of whether Ozawa discloses a ‘portable device’ to be **a close issue**. [] Because the ‘portable device’ limitation is part of all challenged claims, Roku would need to prevail on this issue to prevail on any claim at trial.”
- **Not enough to argue that the merits are non-compelling because of reliance on §103 as opposed to §102**
 - *Apple Inc. v. Sonrai Memory Limited*, IPR2023-00819: Institution **granted** because “[w]e find unavailing Patent Owner’s argument that “Petitioner has not presented a ‘particularly strong’ case of unpatentability because it is based solely on alleged obviousness and not anticipation.” [] Patent Owner does not provide any basis for this argument. [] To the contrary, ‘[a] petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent . . . on a ground that could be raised under section 102 or 103.’”

Relevant 2023 Institution Decisions for Patent Owners

- **Make specific, substantive arguments against invalidity grounds**
 - *Bright Data Ltd. f/k/a Luminati Networks Ltd. v. Oxylabs, UAB*, IPR2023-00185: Institution **granted** because “[f]or most claim limitations, Patent Owner provides no rebuttal to Petitioner’s analysis. [] Instead of addressing most specific claim limitations, Patent Owner relies on more general arguments in response to Petitioner’s analysis.”
- **Be sure to address all relevant issues**
 - *Cisco Systems, Inc. v. Orckit Corporation*, IPR2023-00401: Institution **granted** because “[f]or most of the claim limitations, Patent Owner provides no rebuttal to Petitioner’s analysis. Patent Owner’s arguments directed to a claim element [1.6] summarized in Section III.D.2.e, are not commensurate in scope with the limitations of the claim 1. In short, we determine that, on this preliminary record, Petitioner’s challenge to claim 1 meets the ‘compelling merits’ standard.”

Real Party-in-Interest in 2023

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Unified Patents, LLC v. MemoryWeb, LLC, IPR2021-01413

Unified Patents, LLC Real Party-in-Interest

Unified Patents filed an IPR against MemoryWeb's patent listing Unified Patents as the only RPI

MemoryWeb argued that third parties Apple and Samsung were also RPIs

- MemoryWeb POPR: "[P]ublicly available information confirms that **Samsung and Apple are member companies, and as acknowledged by Unified**, it is aware of related district court proceedings involving both Apple and Samsung." [Paper 8, 22 ("Patent Owner's Preliminary Response")]

The Board instituted the IPR as to all challenged claims on all grounds, noting that as there were no "allegations of a time bar or estoppel based on unnamed RPI" that Board need not deal with the issue at the time

- "[A]s Petitioner points out, there is no allegation in this proceeding of a time bar or estoppel based on an unnamed RPI. See Reply 1. Therefore, **we need not address whether Apple and Samsung are unnamed RPIs because, even if either were, it would not create a time bar or estoppel under 35 U.S.C. § 315.** Under the Board's precedential decision in *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 at 18 (PTAB Oct. 6, 2020) (precedential), an RPI analysis is not required at institution absent allegation of a time bar or estoppel based on an unnamed RPI." [Paper 15, 13 ("Institution Decision")]

Unified Patents, LLC v. MemoryWeb, LLC, IPR2021-01413

Board's Order

After additional briefing by the parties, the Board issued an Order finding Apple and Samsung were RPIs

- The Board's Order (Paper 56) is not publicly available, but Unified Patents' Updated Mandatory Notice references the Order
 - "Pursuant to 35 C.F.R. § 42.8(b)(1), Unified Patents, LLC ('Unified' or 'Petitioner') certifies that Unified is the sole real party-in-interest and certifies that no other party exercised control or could exercise control over Unified's participation in this proceeding, filing this petition, or conduct in any ensuing trial. On March 8, 2023, **the Board issued an order finding 'that Apple, Inc. And Samsung Electronics Co., Ltd. Are Real Parties in Interest to this Proceeding[.]'** Paper 56, 34. Unified disagrees with this finding and is in the process of seeking review of it. The Order required Petitioner to update its mandatory notices consistent with the order. *Id.* This filing is a response to that requirement." [Paper 57, 1 ("Petitioner's Updated Mandatory Notices")]
- The Board issued a Final Written Decision finding all challenged claims unpatentable
- Unified Patents sought Director Review of the Board's RPI determination

Unified Patents, LLC v. MemoryWeb, LLC, IPR2021-01413

Board's RPI Determination Vacated on Director Review

The Director Granted Review of the Board's RPI Determination (May 22, 2023)

- In her Decision, the Director confirmed that *SharkNinja* extends to final written decisions and that RPI arguments need not be addressed in a final written decision unless an estoppel or time bar is alleged.
 - **"The precedential *SharkNinja* decision held that it best serves the Office's interest in cost and efficiency to not resolve an RPI issue when 'it would not create a time bar or estoppel under 35 U.S.C. § 315' in that proceeding.** *SharkNinja*, Paper 11, 18. *SharkNinja* further acknowledged that patent owners 'should not be forced to defend against later judicial or administrative attacks on the same or related grounds by a party that is so closely related to the original petitioner as to qualify as a real party in interest,' but held that was not the case before the Board. *Id.* At 20 (quoting *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1350 (Fed. Cir. 2018))." [Paper 76, 4 ("Decision Granting Director Review (Public)")]
 - "The Board can and should make a determination of the real parties in interest or privity in any proceeding in which that determination may impact the underlying proceeding, for example, but not limited to, a time bar under 35 U.S.C. § 315(b) or an estoppel under 35 U.S.C. § 315(e) that might apply. **That is not the situation here.** The Board should not have determined whether Apple and Samsung are RPIs in this proceeding given that determination was not necessary to resolve the proceeding." [Paper 76, 5 ("Decision Granting Director Review (Public)")]

Apple v. MemoryWeb, LLC, IPR2022-00031

MemoryWeb tried to raise RPI and Estoppel issues in an IPR filed subsequently by Apple following issuance of the Board's Order in the *Unified Patents* proceeding

- In *Apple v. MemoryWeb, LLC*, the Board found that MemoryWeb had forfeited its right to raise the RPI or estoppel issues in the IPR, because they first introduced the issue too late and did not provide prior notice to Apple that they would be raising the issue
 - "After considering the evidence and the arguments of the parties, we determine that the weight of the evidence establishes that Patent Owner has forfeited and/or waived any right it may have had to raise the RPI issue or assert estoppel under 35 U.S.C. § 315(e)(1) in this proceeding." [Paper 85, 20 ("Final Written Decision – Public Version")]
 - "Patent Owner's argument that it 'does not contend that Apple failed to name Unified as an RPI in this proceeding,' and '[t]hus, there was nothing for MemoryWeb to respond or object to in its Response in this proceeding,' misses the point. Paper 49, 4. The point is whether ***Patent Owner should have put Apple on notice in its Patent Owner Response that it was contesting that Apple was an unnamed RPI in the Unified proceeding, so that Apple would have been put on notice and be in a position to respond.***" [Paper 85, 22 ("Final Written Decision Public Version")]

Samsung Electronics Co., Ltd., v. MemoryWeb, LLC, IPR2022-00222

MemoryWeb tried to raise RPI and Estoppel issues in an IPR later filed by Samsung following issuance of the Board's Order in the *Unified Patents* proceeding

- In *Samsung v. MemoryWeb*, the Board found that MemoryWeb had not forfeited/waived its right to raise the RPI or estoppel issues in the IPR, but applying the factors discussed in *RPX Corp v. Applicants in Internet Time* found that Samsung was not an RPI to the earlier *Unified* proceeding
 - "The ***evidence further shows that Unified's business model was designed to comply with RPI rules and to maintain its independence from its membership.***" [EX2121, 45 ("Redacted PTAB Final Written Decision")]
 - "Considering all of the evidence before us in this record, including the testimony and evidence pertaining to Petitioner's business model that was not before us in the *Unified* proceeding, the evidence indicates that although Unified has a strong financial incentive to serve its members needs by filing actions which may benefit its members, ***Unified structured its business model to avoid its members being named real parties in interest in Unified's inter partes review proceedings. This evidence leads to the inference that Petitioner is not a RPI in the Unified proceeding.***" [EX2121, 46 ("Redacted PTAB Final Written Decision")]

Substantial/Significant Relationship in 2023

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Origin of "Substantial/Significant Relationship"

- **General Plastic Factors Originally About Multiple Filings by Same Petitioner**
 - "[W]hether the same petitioner previously filed a petition directed to the same claims of the same patent"
- **Valve / Precedential Opinion Expands General Plastic Factor 1 to Related Parties**
 - "[W]hen different petitioners challenge the same patent, we consider any relationship between those petitioners when weighing the General Plastic factors."
 - "Valve and HTC were co-defendants in the District Court litigation and were accused of infringing the '934 patent based on the same product, namely HTC's VIVE devices that incorporate technology licensed from Valve."
 - "Indeed, in that lawsuit, Valve represented that 'HTC's VIVE devices incorporate certain Valve technologies under a technology license from Valve,' and that 'Valve employees did provide HTC with technical assistance during the development of the accused VIVE devices.'"
 - "The complete overlap in the challenged claims and the significant relationship between Valve and HTC favor denying institution."

What is a "Significant/Substantial Relationship"?

- ***Illumina, Inc. V. Ravgen, Inc.*, IPR2021-01271, Paper 12 (PTAB Jan. 26, 2022)**
 - "[A]lthough Illumina, Natera, Quest, and Labcorp are each defendants accused of infringing the '720 patent, unlike *Valve*, they are not co-defendants in the same case."
 - "[T]he 'significant relationship' in *Valve* turned in large part on the fact that co-defendants and serial petitioners in that case, HTC and Valve, were each accused of infringement based on the same device—HTC's VIVE device. Indeed, there was evidence that Valve not only licensed its technology to HTC but also that Valve helped HTC design the accused VIVE device. Here, by contrast, Illumina and, for example, Natera were sued based on their own alleged infringing pre-natal tests."
- ***Facebook, Inc., v. Express Mobile Inc.*, IPR2021-01455, Paper 11 (PTAB Mar. 4, 2022)**
 - "Nothing in the present record indicates any such relationship between Petitioner and Google. Rather, they were sued by Patent Owner on the same day—as part of a myriad of similar filings against dozens of other defendants."

What is a "Significant/Substantial Relationship"?

- ***Twitter, Inc., v. Palo Alto Rsch. Ctr.*, IPR2021-01458, Paper 11 (PTAB Apr. 6, 2022)**
 - Patent Owner contended that "Facebook, Snap, and Twitter coordinated their invalidity contention work and served overlapping invalidity contentions in the parallel district court cases."
 - Board found that the Valve I "considerations do not exist here," noting that there was "no evidence in the record that Twitter coordinated with Snap or Facebook in their respective petitions."
- ***Qualcomm Inc. v. Monterey Rsch., LLC*, IPR2020-01492, Paper 9 (PTAB Mar. 8, 2021)**
 - Patent Owner contended that two petitioners were joint defendants in parallel litigation, both accused of infringing patents based on same type of standardized memory devices, and were part of a JDG
 - "Factor 1 weighs strongly against denying institution because Petitioner and AMD are not co-defendants and are not accused of infringement based on the same products. . . . Even if Petitioner and AMD are in a joint-defense group, that does not establish a relationship that counsels for denying institution."

Potential Expansion of "Significant/Substantial Relationship"?

- ***American Honda Motor Co., Inc. v. Neo Wireless LLC*, IPR2023-00797, Paper 14, (PTAB Nov. 9, 2023)**
- ***Ford Motor Co. v. Neo Wireless, LLC*, IPR2023-00763, Paper 17, (PTAB Nov. 9, 2023)**
 - "As also discussed above, [Honda] and Volkswagen are co-defendants in the Multidistrict Litigation, are accused of infringing the '302 patent based on products that allegedly comply with the same technical standards on which the '302 patent allegedly reads, and were ordered to jointly submit invalidity and unenforceability contentions (and have done so), which requires cooperation concerning the identification and application of asserted prior art. Thus, a significant relationship exists . . ."
 - "Although [Ford] and Volkswagen are not co-defendants in same the district court litigation where Patent Owner asserted the '450 Patent against Volkswagen nor the same district court case where Patent Owner asserted the '450 Patent against [Ford], there is sufficient evidence indicating that [Ford] and Volkswagen have a significant relationship due to the filing of joint claim construction and invalidity contentions."

Supplemental Information

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Precedential PTAB Decisions in 2023

Parties	Case & Paper Nos.	Case Details
<i>Penumbra, Inc. v. RapidPulse, Inc.</i>	IPR2021-01466, Paper 34 (March 10, 2023)	Clarifying the distinction between pre-AIA 35 U.S.C. § 102(e) and AIA 35 U.S.C. § 102(d) and holding that the requirement in <i>Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.</i> , 800 F.3d 1375, 1378 (Fed. Cir. 2015) that under pre-AIA 35 U.S.C. § 102(e), a reference patent's claims must have written description support in its provisional application in order to be entitled to the filing date of the provisional application, does not apply to AIA 35 U.S.C. § 102(d)]
<i>CommScope Techs. LLC. v. Dali Wireless, Inc.</i>	IPR2022-01242, Paper 23 (February 27, 2023)	Ordering rehearing, vacating decision granting institution, and remanding proceeding to the Board; the Board must first address <i>Fintiv</i> factors 1-5, and should engage the compelling merits question only if that analysis favors discretionary denial; when addressing compelling merits, the Board must provide reasoning, beyond pointing to its analysis under the lower institution standard, to explain and support its determination, sufficient to allow for review of that decision]
<i>Nested Bean, Inc. v. Big Beings Pty Ltd.</i>	IPR2020-01234, Paper 42 (February 24, 2023)	35 U.S.C. § 112, fifth paragraph – granting rehearing and modifying the Final Written Decision, addressing the treatment of multiple dependent claims]
<i>Xerox Corp. v. Bytemark, Inc.,</i>	IPR2022-00624, Paper 9 (August 24, 2022) (designated: February 10, 2023)	Denying institution – holding declaration is entitled to little weight when it contains an exact restatement of the petition's unsupported, conclusory assertions without any additional supporting evidence or reasoning]
<i>Apple Inc. v. Zipit Wireless, Inc.,</i>	IPR2021-01124 et al., Paper 14 (December 21, 2022) (designated: January 4, 2023)	Vacating adverse judgments and remanding proceedings to confirm whether Patent Owner is indeed abandoning the contest or to issue a final written decision addressing the patentability of the challenged claims] (sua sponte Director Review decision)

Source: PTAB, data as of 1/16/2024

Rules in 2023

- **April 21, 2023** - Advanced Notice of Proposed Rulemaking: “Changes Under Consideration to Discretionary Institution Practices, Petition Word-Count Limits, and Settlement Practices for America Invents Act Trial Proceedings Before the Patent Trial and Appeal Board”
- **May 23, 2023** - Request for Comments Regarding PTAB’s Motion to Amend Pilot Program and rules related to amendments during PTAB proceedings
- **July 2023** - Updated interim director review process so that parties can now ask the Director to review the PTAB’s decision on whether or not to institute a proceeding.
- **Oct. 6, 2023** - Notice of Proposed Rulemaking: “Rules Governing Pre-Issuance Internal Circulation and Review of Decisions Within the Patent Trial and Appeal Board,” new SOP 4, SOP 3

Proposed PTAB Legislation in 2023

- **July 10, 2023** - Promoting and Respecting Economically Vital American Innovation Leadership (PREVAIL) Act



Karl Renner
Principal
renner@fr.com



David Holt
Principal
DTH@fr.com



Grace Kim
Principal
gkim@fr.com

Thank You!

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

Any questions about the webinar, contact the Events team eventsteam@fr.com

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