

District Court Litigation Post-SAS: Is It a Game Changer?

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SAS v. Iancu

- Holding: When the PTAB institutes an IPR, it must decide the patentability of all of the claims the petitioner has challenged (or none at all).
- 5-4 decision, argued and issued same days as *Oil States v. Greene's Energy*.
- Majority opinion by Justice Gorsuch; dissents filed by Justices Ginsburg and Breyer.

35 U.S.C. § 318(a)

- “If an inter partes review is instituted . . . the Patent Trial and Appeal Board *shall issue* a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added [by amendment].”
 - “The word ‘shall’ generally imposes a nondiscretionary duty.” (Slip Op. at 5)
 - “[T]he word ‘any’ naturally carries an expansive meaning,” and when used “in this way implies every member of the class or group.” (Slip Op. at 4-5)

Near-Term Impact of SAS

- PTO implementation of SAS: “As required by the decision, the PTAB will institute as to all claims or none. At this time, if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition.” (Apr. 26, 2018 Interim Guidance)
- Before SAS, institution rate of approximately 65%
- After SAS, institution rate fell to 56% (albeit in a small sample)

Key Issues and Strategies

- Estoppel: A petitioner may not later assert a claim is “invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review” (35 U.S.C. § 315(e)(2))
 - Because IPRs are limited to printed publications under 102/103, on sale/public use prior art and 101/112 arguments not subject to estoppel (§ 311(b))
- Stays pending IPR more prevalent post-SAS?

Parallel Developments

- Time bars: “An inter partes review may not be instituted if the petition . . . is filed more than 1 year after the date on which the *petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.*” (35 USC § 315(b))
 - Time bar decisions were not reviewable until the Federal Circuit’s en banc decision in *Wi-Fi One v. Broadcom* (Fed. Cir. 2018)
- Article III standing for appellate review

Time Bars

- *Click to Call v. Ingenio* – en banc footnote!
 - “[W]hen an IPR petitioner was served with a complaint for patent infringement more than one year before filing its petition, but the district court action in which the petitioner was so served was voluntarily dismissed without prejudice. . . . § 315(b)’s time bar applies”
- *Applications in Internet Time v. RPX*
 - “Determining whether a non-party is a ‘real party in interest’ demands a flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner.” (Slip Op. at 26)

Standing to Appeal

- *RPX v. ChanBond* (Cert Petition 17-1686)
 - CVSG issued on October 1, 2018
- 35 USC § 141(c) provides that “[a] party to an inter partes review or a post-grant review who is dissatisfied with the final written decision of the Patent Trial and Appeal Board . . . may appeal the Board’s decision [to] the Federal Circuit.”
- But Article III standing currently limits Federal Circuit appeals to parties sued for infringement or that can show injury-in-fact
 - Federal Circuit has held that estoppel provisions of § 315(e) do not, without more, create injury-in-fact.