

WILSON SONSINI

A teal-colored background featuring a pattern of interlocking gears of various sizes, some in sharp focus and others blurred. A white rectangular box with a thin orange vertical bar on its left side is positioned in the lower-left quadrant of the image.

2020 PTAB YEAR IN REVIEW

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Introduction

Wilson Sonsini Goodrich & Rosati is pleased to present our *2020 PTAB Year in Review*.

We begin with a review of 2020 petition filings at the Patent Trial and Appeal Board (PTAB) and then take a closer look at the impact of the precedential *Fintiv* decision on discretionary denials of institution. We also provide a summary of recent precedential decisions and administrative directives.

Subsequently, we explore important appellate decisions relating to PTAB trials, provide an update on the PTAB's

Motion to Amend Pilot Program, and address the continuing dispute over whether PTAB judges are constitutionally appointed.

We hope you find our *2020 PTAB Year in Review* to be a useful resource for insight on the most meaningful developments from the past year. As always, should you have any questions or comments on any of the matters discussed in this report, please contact a member of the firm's post-grant practice or your regular Wilson Sonsini attorney.

Notable Developments at the PTAB

2020 was another eventful year at the Patent Trial and Appeal Board (PTAB). Petition filings and institution rates generally held steady. The PTAB designated a dozen additional decisions as precedential and two decisions as informative, and issued administrative guidance on the standard of definiteness to use in America Invents Acts (AIA) trials. Below is a brief elaboration of some of these developments.

2020 AIA Post-Grant Proceedings Filing and Institution Rates

Over the past three fiscal years, petition filings have held steady and institution rates have hovered around 60 percent. The PTAB, however, has increasingly embraced various discretionary bases for denying petitions. To date, fully half of institution denials for FY20 petitions have been for discretionary reasons.¹

	Petitions	Institution Rate	Denial of Institution	
			Merits	Discretion
FY17	1,904	61%	25%	13%
FY18	1,522	60%	26%	14%
FY19	1,467	57%	23%	19%
FY20 ²	1,514	58%	21%	21%

The July 2019 Trial Practice Guide Update described several situations in which the PTAB might deny institution on a discretionary basis, including: follow-on petitions challenging the same patent as an earlier-filed case, multiple parallel petitions against the same patent, petitions where the same or substantially the same prior art or

Tech Center	FY19		FY20 ²	
	Total Petitions	Institution Rate	Total Petitions	Institution Rate
2600 – Communications	337	62%	342	60%
2800 – Semiconductors	206	54%	264	61%
2400 – Computer Networks	218	50%	181	64%
3600 – Transportation	148	57%	176	55%
1600 – Biotechnology	133	56%	78	55%
3700 – Mechanical Engineering	191	69%	210	54%
2100 – Computer Architecture	165	50%	124	64%
1700 – Chemical and Material Engineering	53	54%	98	46%
Miscellaneous	16		41	

arguments were previously presented to the U.S. Patent and Trademark Office (USPTO), and instances where a parallel district court proceeding is expected to reach a validity determination prior to the PTAB issuing a Final Written Decision. The latter situation was addressed in the institution decision for *Apple, Inc. v. Fintiv, Inc.*³ and made precedential on May 5, 2020. The substance of the decision and

For example, several high-volume petitioners (e.g., Apple, Google, and Intel) had multiple petitions denied in the months following *Fintiv*.

Institution rates for the various technology centers remained variable in FY20, with rates ranging from 46 to 64 percent. Chemistry has long been the most difficult center to gain institution and remained so in FY20 with an institution rate of 46 percent. Computer Networks and Computer Architecture have the highest institution rate of 64 percent—well above the average rate of 58 percent for all technology centers.

The Continuing Impact of *Fintiv*

The PTAB issued its precedential decision in *Fintiv*⁴ on March 20, 2020. In that decision, the PTAB set forth factors it will consider in determining whether it should exercise its discretion under 35 U.S.C. §314(a) to deny institution based on a parallel patent invalidity proceeding, such as a district court trial. Those factors include:⁵

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;

application of the *Fintiv* factors will be discussed elsewhere in this report.

Despite becoming precedential midway through FY20, *Fintiv* is a major factor in the rise of discretionary denials. *Fintiv* was cited in support of denial of institution for more than 70 petitions—including in cases that were filed before *Fintiv* was made precedential.

2. Proximity of the court’s trial date to the Board’s projected statutory deadline for a Final Written Decision;
3. Investment in the parallel proceeding by the court and the parties;
4. Overlap between issues raised in the petition and in the parallel proceeding;
5. Whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. Other circumstances that impact the Board’s exercise of discretion, including the merits.

In evaluating the factors, “the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.”⁶

Fintiv has had a significant impact on institution outcomes. Between May 13, 2020, and December 31, 2020,⁷ 203 PTAB institution decisions analyzed *Fintiv* in determining whether trial should be instituted. Of those 203 decisions, 131—or 64.5 percent—were instituted and 72—or 35.5 percent—were denied. Here, we look at how the PTAB applied the *Fintiv* factors when it denied institution.

All 72 decisions that were denied under *Fintiv* had at least three things in common. The first, considered under factor 2, was that the trial date in the parallel proceeding was scheduled to be before the projected statutory deadline for the Final Written Decision. The second, considered under factor 5, was that the petitioner and defendant in the parallel proceeding were the same parties. The third, considered under factor 1, was that the court had not granted a stay and there was no

significant evidence that a stay would be likely if the proceeding was instituted.⁸

Much of the variability in institution outcomes under *Fintiv* may be traced to two remaining factors. The bulk of the PTAB decisions in which institution was denied under *Fintiv* concluded that factor 3, investment in the parallel proceeding by the court and the parties, favored denial. But there were a handful of decisions in which the PTAB determined that factor 3 was neutral, or even favored institution.⁹ One difficulty for prospective parties is knowing exactly how the PTAB will evaluate this factor. In *Supercell Oy*, for example, the PTAB concluded that factor 3 only weighed minimally in favor of denying institution even though the trial court had issued a claim construction order, given the amount of activity that remained to be performed and the PTAB’s familiarity with the claimed subject matter from reviewing related patents.¹⁰

For factor 4, the overlap between the issues in the petition and in the parallel proceeding, outcomes again were mixed. However, a petitioner stipulation that it would not pursue the same grounds in the co-pending litigation as before the PTAB was often helpful for obtaining institution. In *Google LLC v. Personalized Media Communications, LLC*,¹¹ for example, the PTAB concluded that factor 4 weighed marginally against exercising discretion to deny institution because the petitioner stipulated that it would withdraw identical grounds from the district court to eliminate any overlap in issues.¹² The PTAB stated, however, that if the petitioner had made a broader stipulation that it would not pursue any grounds raised or grounds that reasonably could have been raised, it “might have better addressed these concerns in a much more substantial way.”¹³ Petitioners thus retain a significant ability to impact the *Fintiv* analysis depending on whether or not

they enter such a stipulation and based on the scope of such a stipulation they choose to make.

In summary, PTAB institution denials under *Fintiv* are characterized by a parallel trial involving the same parties that is likely to conclude before the PTAB issues a final decision and there is no showing that the parallel trial is likely to be stayed pending the PTAB trial. Institution may be denied under *Fintiv* even though very little substantive work has been completed in the parallel proceeding by the time of the PTAB institution decision. However, petitioners may be able to mitigate the remaining factors through a stipulation eliminating overlap between the PTAB trial and the parallel proceeding.

Recent Precedential Decisions and Administrative Directives

After issuing a flurry of precedential and informative decisions in the first half of 2020 (discussed in prior issues of *The PTAB Review*), it seemed as if the PTAB was taking a break for the remainder of the year. But then, in December 2020, the PTAB issued five additional precedential decisions. One new precedential decision is directed to joinder practice, two are directed to addressing real-party-in-interest, and two are directed to discretionary denial of institution based on co-pending litigation under *Fintiv*.

In *Apple Inc. v. Uniloc 2017 LLC*,¹⁴ the PTAB extended consideration of the factors as set forth in *General Plastic Indus. Co. v. Kanon Kabushiki Kaisha*¹⁵ to a joinder petition. Apple had filed a previous IPR against the same patent at issue in the proceeding it was seeking to join, which the Board declined to institute.¹⁶ Microsoft then filed a petition against the same patent, which was instituted by the PTAB.¹⁷ Apple

then filed a second petition that was substantially identical to the petition filed by Microsoft, as well as a motion for joinder.¹⁸ The PTAB, however, applying *General Plastic Industrial Co., Ltd. v. Canon Kabushika Kaisha*,¹⁹ declined to institute Apple's copycat petition and join Apple to Microsoft's proceeding.²⁰ The PTAB's holding in *Apple* demonstrates that it is important to always file the best possible petition in the first instance, as there will most likely not be a second opportunity, even if another party succeeds in getting a petition instituted.

Next, in *SharkNinja Operating LLC v. IRobot Corp.*,²¹ the PTAB addressed the issue of real-party-in-interest. The patent owner argued that the PTAB should deny institution because the petitioner did not name all of the real-parties-in-interest.²² The PTAB disagreed.²³ In particular, the patent owner argued that the ultimate parent of all three petitioners should have been named as a real-party-in-interest.²⁴ The PTAB concluded, however, that it need not reach the issue.²⁵ The patent owner had not alleged that the ultimate parent was estopped under 35 U.S.C. § 315 or that the petitioners had failed to name it to gain any advantage.²⁶ Moreover, citing its precedential decision in *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*,²⁷ the PTAB noted that its jurisdiction was not dependent on all of the correct real-parties-in-interest being identified.²⁸ Thus, the PTAB concluded that if the ultimate parent should have been listed as a real-party-in-interest, it was merely a correctable procedural requirement.²⁹

In *RPX Corp. v. Applications in Internet Time, LLC*,³⁰ Chief Judge Boalick authored a decision on remand from the U.S. Court of Appeals for the Federal Circuit for a panel that also included Deputy Chief Judge Bonilla and Vice Chief Judge Weidenfeller, "the most senior administrative patent judges available."³¹ The PTAB determined that Salesforce was a real-party-in-

interest in the proceeding.³² The PTAB noted that it was the petitioner's burden to demonstrate that it was not time-barred.³³ Quoting the Federal Circuit's decision, the PTAB noted that determining a real-party-in-interest requires "a flexible approach that takes into account both equitable and practical considerations," and asks if the non-party "is a clear beneficiary that has a pre-existing, established relationship with the petitioner."³⁴ Even though the PTAB had found that Salesforce was an unnamed real-party-in-interest and ultimately declined to determine whether Salesforce was in privity with RPX, it stated that "if Salesforce is an RPI, it typically will qualify as being in privity with RPX."³⁵ Finally, the PTAB concluded that the petitions warranted exercise of its discretion under 35 U.S.C. §314 to deny institution, even while noting this conclusion was not necessary to its analysis.³⁶

SharkNinja and *RPX Corp.* essentially set the boundaries of how the PTAB will approach its real-party-in-interest analysis. If there is an unnamed real-party-in-interest, but that possible party would not present any time bar or estoppel concerns, the PTAB need not undertake an exhaustive real-party-in-interest analysis. However, if the possible real-party-in-interest and/or privity does present time bar and/or estoppel concerns, the PTAB will undertake that analysis using a flexible approach, taking into account both equitable and practical considerations. Thus, petitioners need to be aware of possible time bar and estoppel considerations arising not only from their own activities, but also those whom it may be argued would also be a real-party-in-interest or privity.

On December 17, 2020, the PTAB designated two additional decisions as precedential, both relating to its exercise of discretion under 35 U.S.C. §314 to deny institution on the basis of co-pending litigation as addressed

by its precedential decision in *Fintiv*. In *Fintiv*, the PTAB set forth a series of factors it will consider in deciding whether it will exercise its discretion to deny institution. Those factors include, *inter alia*, whether the district court has or is likely to grant a stay and the overlap between issues raised in the petition and in the district court.³⁷ *Sotera* and *SNAP*, discussed in detail below, show facts and circumstances in which the Board may decline to exercise its discretion to deny institution when there is co-pending district court litigation.

In *Sotera Wireless, Inc. v. Masimo Corp.*,³⁸ the PTAB declined to exercise its discretion under *Fintiv* to deny the IPR petition. Even though the petition was filed only two weeks before the statutory deadline, the petitioner had filed a broad stipulation in district court stating that it would not raise any grounds at the district court that were raised or reasonably could have been raised in an IPR, which "weighs strongly in favor of not exercising discretion to deny institution under 35 U.S.C. § 314(a)."³⁹ On taking a holistic view of all the factors, the PTAB was not persuaded that "the interests of the efficiency and integrity of the system would be best served by denying institution."⁴⁰ *Sotera* demonstrates that a petition may be instituted even if it is filed close to the statutory deadline if the petitioner stipulates to not pursue any grounds that are before the district court.

In *SNAP, Inc. v. SRK Tech. LLC*,⁴¹ the PTAB also declined to exercise its discretion under § 314(a) to deny institution where the district court already had stayed the case pending a non-institution decision or a Final Written Decision.⁴² Not only was the grant of a stay a factor favoring institution, but the stay also impacted other factors favoring institution (e.g., how much work was already done in the district court, the trial date, and inefficiency from overlap between the district court case and the PTAB

trial).⁴³ The PTAB considered and rejected the patent owner's argument that the petitioner was in control of information relating to secondary considerations that was more readily accessible through the liberal discovery procedures available in district court.⁴⁴ The PTAB also considered the merits of the challenge and concluded they supported institution. Accordingly, the PTAB's *Fintiv* analysis did not result in discretionary denial. *SNAP* thus shows the importance of a stay if one can be obtained before the filing of a petition.

Finally, on January 6, 2021, USPTO Director Andrei Iancu, in conjunction with Andrew Hirshfeld, the Commissioner for Patents, and Scott Boalick, the Chief Administrative Patent Judge, issued a memorandum addressing the USPTO's approach to indefiniteness under 35 U.S.C. § 112 in AIA post-grant proceedings. Specifically, the memorandum noted that the indefiniteness standard set forth by the U.S. Supreme Court in *Nautilus, Inc. v. Biosig Instruments, Inc.*⁴⁵ would be used in post-grant proceedings. The memorandum acknowledged the USPTO's long-standing policy of following *In re Packard*.⁴⁶ The memorandum then noted that once the claim construction standard in AIA post-grant review proceeding was changed to the plain and ordinary meaning, consistent with the claim construction standard used by district courts, confusion remained as to what indefiniteness standard should be applied in post-grant reviews, that is, *Packard* or *Nautilus*. Given that the claim construction standard is aligned with that used by the district courts, and that indefiniteness is often determined as part of claim construction, the USPTO concluded that indefiniteness should also be aligned with the standard used by the district court.

Appellate Review of AIA Post-Grant Proceedings

Notable Federal Circuit Cases

PTAB Joinder

The Federal Circuit issued two decisions this year clarifying the scope and effect of joinder in PTAB proceedings. As discussed in the October 2020 [issue of *The PTAB Review*](#), the Federal Circuit concluded in *Facebook, Inc. v. Windy City Innovations, LLC*⁴⁷ that the PTAB lacks authority under 35 U.S.C. § 315(c) to join new issues to an existing IPR to avoid the statutory bar.⁴⁸ In so doing, the court repudiated the decision of the PTAB's Precedential Opinion Panel in *Proppant Express Investments v. Oren Techs.*,⁴⁹ which held that 35 U.S.C. § 315(c) permitted both same-party joinder and joinder of new issues.⁵⁰ In *Fitbit, Inc. v. Valencell, Inc.*,⁵¹ the court addressed a question representing the flip side of *Windy City*: When a joinder party petitions against fewer claims than the original petition, can it appeal regarding the claims it failed to challenge if the original party drops out? The Federal Circuit concluded that yes, any party joined in an IPR can appeal with regard to any claim challenged in that IPR, regardless of which claims their petition challenged.⁵²

In *Valencell*, Apple originally filed an IPR petition challenging one set of claims, which was granted partial institution.⁵³ Fitbit later filed a joinder petition challenging only the instituted subset of the claims challenged by Apple.⁵⁴ During trial, the Supreme Court banned partial institution,⁵⁵ and the Board responded by reinstating the claims that had been denied under partial institution.⁵⁶ The Board then issued a Final Written Decision

holding the originally instituted claims unpatentable but the remaining claims patentable.⁵⁷

Apple declined to appeal, but Fitbit appealed regarding the claims not held unpatentable.⁵⁸ In response, Valencell argued that Fitbit did not have the right to appeal on those claims because its petition had not challenged them.⁵⁹ The court disagreed, observing that Fitbit had been joined as a party under 35 U.S.C. § 315(c), and that the right to be a party to an appeal from an IPR is granted to "any party" of the IPR by 35 U.S.C. § 319.⁶⁰ The court rejected Valencell's argument that a person may be joined as a party only to a portion of an IPR, holding that Fitbit's joinder constituted a joinder to the entirety of the proceedings.⁶¹ The court then reached the merits of the appeal, vacated the Board's decision for the uncanceled subset of claims, and remanded.⁶²

Read together, *Windy City* and *Valencell* provide new boundaries on the scope and effect of joinder. Under *Windy City*, joinder is limited to the joining of parties, and cannot add new issues to an IPR. But under *Valencell*, the scope of a joinder party's petition can be effectively broadened to the scope of the original petition for purposes of appeal, if for some reason a joinder party files a narrower petition than the original petition. Thus, joinder remains an option for parties, including those otherwise time-barred, to join existing proceedings and pursue them through appeal in case of settlement by the original petitioner. Though not effected by joinder, the addition of new issues to an instituted proceeding remains possible through consolidation under 35 U.S.C. § 315(d).

IPR Can Reach Unpatentability for Some Indefinite Claims

The Federal Circuit clarified the scope of IPR patentability determinations in *Samsung Electronics America, Inc.*

*v. Prisia Engineering, Inc.*⁶³ In *Prisia*, the Board instituted review against six claims of a Prisia patent, but in its Final Written Decision it held only one claim unpatentable, because it concluded that the other five claims were indefinite and declined to reach questions of obviousness or anticipation.⁶⁴ The specific type of indefiniteness involves the combination of two statutory classes of invention, such as a process and a machine.⁶⁵

Samsung advanced two arguments on appeal for reversing the Board's decision not to address the anticipation or obviousness of the claims. First, Samsung argued that the Board should have canceled the claims for indefiniteness.⁶⁶ Second, Samsung argued that the Board should have assessed the claims' patentability notwithstanding their indefiniteness.⁶⁷ The court rejected the first argument but agreed with the second.⁶⁸

For the first argument, Samsung argued that although 35 U.S.C. § 311(b) limits the scope of an IPR petition to certain grounds of obviousness or anticipation, Section 318(a), covering Final Written Decisions, lacks such a limitation, merely requiring that the Board "issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 316(d)."⁶⁹ Patentability, Samsung argued, encompasses grounds beyond what were raised in the petition.⁷⁰

The court disagreed, concluding instead that the term "patentability" in Section 318(a) encompassed a different range of grounds for different claims.⁷¹ For new claims, "patentability" encompasses a wider range of grounds than challenged claims, which can only be held unpatentable on grounds set forth in 35 U.S.C. § 311(b).⁷²

However, the court agreed with Samsung's second argument. Although neither party disputed that the claims

were indefinite, Samsung argued that the Board should nevertheless have reached the question of unpatentability.⁷³ The court agreed, concluding that at least this type of indefiniteness was an exception to the more general rule that "a claim cannot be both indefinite and anticipated," since this type of indefiniteness only affects infringement determinations, not the scope of claims.⁷⁴

Prisia thus represents an instance along the spectrum of when indefiniteness will prevent the Board from reaching questions of anticipation or obviousness: when the indefiniteness relates to determining infringement, but does not affect the scope of the claims, it does not preclude a finding of anticipation or obviousness.

Small Differences in Claim Language Can Render Preamble Limiting

*Shoes by Firebug LLC v. Stride Rite Children's Group, LLC*⁷⁵ provides an interesting example of the application of claim construction principles to a claim's preamble. The case involved IPRs of two patents with nearly identical independent claims. Independent claim 1 of each patent recited an "internally illuminated textile footwear compris[ing]" numerous near-identical limitations.⁷⁶ One patent's claims had an additional limitation that was missing from the other: it expressly recited "a footwear." Each patent also included a limitation referring to "the footwear." The patent owner argued that the preamble of each claim was limiting, requiring the footwear to be "textile."⁷⁷ The Board had found that neither preamble was limiting and that each claim was obvious.⁷⁸ The Board also held in the alternative that the claims were obvious even if the preambles were limiting.⁷⁹

On appeal, the Federal Circuit held that even though the claims were near identical, their small difference made one preamble limiting and one not

limiting. Specifically, the court held that the claim reciting "a footwear" did not have a limiting preamble, but the other claim did.⁸⁰ The court reasoned that because the former claim recited a "structurally complete invention," its preamble was not limiting.⁸¹ By contrast, the latter claim did not recite a complete invention because it included a term ("the footwear") whose only source of antecedent basis was in the preamble.⁸²

This produced a surprising result: the claim that recited an additional limitation was broader than the claim omitting that limitation because the footwear recited in the preamble was a "textile footwear," while the footwear recited in the body was simply "footwear." Despite this change of scope, the court ultimately affirmed the Board's decision because the Board's alternative holding that the claims would remain obvious even if limited by the preamble was supported by substantial evidence.⁸³

Firebug thus provides both a rare example of a limitation whose addition broadens a claim and a reminder of the importance of incorporating alternative grounds or arguments to address the possibility that a preamble will be found limiting.

Venues for Hatch-Waxman Cases Substantially Narrowed

In *Valeant Pharmaceuticals North America LLC v. Mylan Pharmaceuticals, Inc.*,⁸⁴ the Federal Circuit narrowed the venue sites available for plaintiffs bringing Hatch-Waxman suits against domestic entities. Under *TC Heartland*, venue for patent cases is governed by 35 U.S.C. § 1400(b), rather than 35 U.S.C. § 1391's general venue provisions.⁸⁵ Section 1400(b) limits venue to (1) the defendant's state of incorporation or (2) a district "where the defendant has committed acts of infringement and has a regular and established place of business." In *Valeant*, the plaintiff brought suit in the District of New Jersey, which was not the defendant's

state of incorporation.⁸⁶ Accordingly, venue depended on whether the defendant had (1) committed an act of infringement in the district and (2) had a regular and established place of business in the district.⁸⁷ The district court dismissed for lack of proper venue, holding that the defendant had not committed an act of infringement in New Jersey by filing an ANDA application.⁸⁸ It did not reach the question of a regular and established place of business.⁸⁹

On appeal, the plaintiff argued that the filing of an ANDA application constituted a nationwide act of infringement if a defendant intended to subsequently sell the patented drug nationwide.⁹⁰ The Federal Circuit disagreed, concluding that venue in Hatch-Waxman cases may be predicated only on past acts of infringement, not future acts.⁹¹ Specifically, the Hatch-Waxman Act identifies a single act of infringement for an ANDA application: the filing of the application.⁹² Although this may involve more than one district if submission of the application involved acts in more than one place, it does not encompass any planned future acts. Rather, venue “is proper only in those districts that are sufficiently related to the ANDA submission.”⁹³

As a final wrinkle, the court found that this rule only applies to domestic defendants, not foreign defendants. The Federal Circuit has previously held that Section 1400(b) does not apply to foreign entities and that venue is proper under Section 1391(c)(3) for such defendants in any district where they are subject to personal jurisdiction.⁹⁴ Thus, the court found venue was proper in *Valeant* for a foreign co-defendant, and only improper for the domestic defendants.⁹⁵ This development likely will cause more parallel proceedings in ANDA-related post-grant proceedings, possibly complicating petition-timing, privity, and real-party-in-interest issues.

Notable Supreme Court Cases

No Review of Any Aspect of PTAB Institution Decisions

In *Thryv, Inc. v. Click-to-Call Technologies, LP*,⁹⁶ the Supreme Court reviewed the Federal Circuit’s decision⁹⁷ reversing a PTAB Final Written Decision on the basis that the PTAB had improperly instituted review in the first place. The Federal Circuit disagreed with the PTAB’s interpretation of a time bar in 35 U.S.C. §315(b), which bars institution if the petition was filed more than one year after the petitioner was served with a complaint alleging infringement of the challenged patent. The PTAB concluded the time bar did not apply because the complaint was dismissed without prejudice. The Federal Circuit disagreed. The Supreme Court granted certiorari on the scope of review available in light of the statutory appeal bar.

The Supreme Court vacated the Federal Circuit’s decision and remanded with orders to dismiss for lack of appellate jurisdiction.⁹⁸ The Court held that 35 U.S.C. § 314(d) precludes any review of the Board’s institution decisions, including the Board’s determination that it had authority to institute review in the first place.⁹⁹ As the Court had held in *Cuozzo*, Section 314(d) bars review of “matters ‘closely tied to the application and interpretation of statutes related to’ the institution decision.”¹⁰⁰ Although the Federal Circuit had held that timeliness determinations under Section 315(b) were not “closely related” to institution decisions,¹⁰¹ the Supreme Court disagreed, observing that timeliness decisions were integral to institution decisions, and that Section 315(b) related only to such decisions.¹⁰²

The patent owner urged the Court to adopt a narrower construction of Section 314(d)’s bar against appellate review,

barring appeal only of the Board’s threshold determination of whether the petitioner had demonstrated a reasonable likelihood of succeeding on the merits.¹⁰³ Justices Gorsuch and Sotomayor agreed in a dissent, arguing that both the plain language of Section 314(d) and the presumption in favor of judicial review favored appellate jurisdiction.¹⁰⁴ However, the Court observed that *Cuozzo* had held that the Section 314(d) bar was not so limited, extending to the Board’s application of Section 312(a)(3) as well.¹⁰⁵ Thus, the Court held that the provision encompasses the entire institution determination, including application of the time-bar provision.

The Court’s decision in *Thryv* points toward a broad interpretation of the bar on appellate review of matters related to the institution decision. Although the Court left the door open for mandamus relief in extraordinary cases,¹⁰⁶ that too may be foreclosed, and in any event would apply only rarely. As more recent Federal Circuit cases have indicated, the fight in the future may shift to assessing which other decisions are also sufficiently related to the institution decision to avoid appellate review.¹⁰⁷

Granted Cert. Petitions

The Supreme Court has recently granted petitions for certiorari in two patent-related cases.

In *United States v. Arthrex*, the court granted certiorari to answer two questions: (1) whether PTAB judges are principal or inferior officers and (2) whether, if they are principal officers, the Federal Circuit properly cured any appointments clause defect by severing the application of 5 U.S.C. § 7513(a). Oral argument is scheduled for March 1, 2021.

On January 8, 2021, in *Minerva Surgical Inc. v. Hologic Inc.*, the Court granted certiorari to consider whether

to abandon the doctrine of assignor estoppel, under which assignors of a patent or persons in privity with such assignors are estopped from later challenging the patent's validity in court.

Questions Loom as Supreme Court Considers Appointments Clause Challenge

Once again, the constitutionality of post-grant challenges is before the Supreme Court, this time as a challenge against the constitutionality of Administrative Patent Judges (APJs) appointments. Late last year, a Federal Circuit panel issued a decision finding that APJs of the PTAB were "principal" officers who were not properly appointed and confirmed by the Senate under the Appointments Clause.¹⁰⁸ The panel reasoned that, because the Director of the USPTO lacked authority to directly review Final Written Decisions from APJs or to remove APJs without cause, the Director did not possess sufficient control over APJs for APJs to be considered "inferior" officers. To remedy the issue, the panel held that the removal statute that applied to APJs would be "severed" so it no longer applied to APJs, allowing the Director to remove APJs for any or no reason. The Federal Circuit remanded the case to a new panel that would be considered properly appointed under its decision.

Following the panel's decision, the Federal Circuit further limited the remedy to cases where the patent owner raised an Appointments Clause challenge prior to, or in, its opening brief—otherwise, the party had forfeited the argument.¹⁰⁹ Petitioners also were held to have waived any Appointments Clause challenge by selecting the

USPTO as the forum to challenge patents.¹¹⁰ Earlier this year, a fractured Federal Circuit declined to rehear the case *en banc*, with the *per curiam* order accompanied by five separate concurrences and three separate dissents.

Given the Supreme Court's recent interest in Appointments Clause challenges,¹¹¹ the Court met expectations by granting review of *Arthrex* last October. The Court granted review on two issues: whether APJs are "inferior officers" and, if not, whether the Federal Circuit properly severed the removal for cause provisions in the statute to remedy the Appointments Clause defect. The Court did not grant review to the government's presented question of whether the Federal Circuit erred in considering the Appointments Clause challenge despite *Arthrex* not having raised it before the PTAB. The Court also has denied or held in abeyance petitions for certiorari brought by other parties seeking review of the Federal Circuit's application of forfeiture doctrine to those who failed to raise the issue in their opening brief.

The Supreme Court has set oral argument for March 1, 2021. As the Court prepares to hear *Arthrex*, questions still loom regarding all three issues (constitutionality, remedy, and forfeiture).

Constitutionality of APJs

The Federal Circuit's holding in *Arthrex* that APJs are principal officers came down to its finding of a "lack of any presidentially-appointed officer who can review, vacate, or correct [Final Written] [D]ecisions by the APJs combined with the limited removal power [of said APJs]."¹¹² The Federal Circuit did consider some of the powers that the Director holds, including the ability to decline institution for any case, the ability to assign or add hand-picked

APJs to any PTAB panel, the ability to form a Precedential Opinion Panel to rehear and reverse any decision, and the ability to designate any decision as precedential, but reasoned that regardless of these powers, the Director "cannot, on his own, *sua sponte* review or vacate a Final Written Decision."¹¹³ Thus, the Federal Circuit found that the oversight and supervisory authority held by the Director was "not sufficient to render [APJs] inferior officers [and t]he lack of control over APJ decisions does not allow the President to ensure the laws are faithfully executed."¹¹⁴

These findings, however, have not gone without dispute. In the denial for rehearing *en banc*, four Federal Circuit judges questioned whether or even disputed that the Director's powers did not constitute sufficient control over APJs. Judge Dyk, joined by Judges Newman and Wallach, opined that the Director could create a constitutionally sound rehearing panel consisting of the Director as well as the Deputy Director and the Commissioner of Patents, two additional officers who are removable at-will by the Secretary of Commerce.¹¹⁵ He also opined that, as the Independent Counsel challenged in *Morrison v. Olsen*,¹¹⁶ APJs "have no such role" in the "articulation of agency policy."¹¹⁷

Judge Hughes, joined by Judge Wallach, went a step further and opined that the Director's ability to promulgate procedural regulations and issue binding policy guidance interpreting patent law "provide[s] the Director with control over the process and substance of Board decisions."¹¹⁸ APJs who failed to follow such guidance would "risk discipline or removal under the efficiency of the service standard."¹¹⁹ The Director's ability to control which APJs constitute a panel was also "a quintessential method of directing and controlling a subordinate."¹²⁰ Judge Hughes criticized the original *Arthrex* decision for "miss[ing] the practical influence

the Director wields with the power to hand-pick a panel, particularly when the Director sits on that panel.”¹²¹

These points were raised in the United States brief before the Supreme Court, and the position of the United States often has significant influence over the Supreme Court. Moreover, the notion that the Director does in fact hold significant power over the policy direction of the PTAB may resonate with an unlikely ally. Justice Gorsuch has previously expressed similar sentiment about the Director’s powers, though as a criticism against him. For example, Justice Gorsuch recently described AIA trials as “before a panel of agency employees that the Director also has the means to control [because t]he AIA gives the Director the power to select which employees, and how many of them, will hear any particular inter partes challenge” and because the Director has “the power to decide how much they are paid.”¹²² Justice Gorsuch also has criticized the Director for not being “bashful about asserting these statutory powers to secure the ‘policy judgments’ he seeks.”¹²³

Still, petitioner Smith & Nephew likely has an uphill climb to convince the Supreme Court to reverse the Federal Circuit on the merits. Five of the current justices (including the aforementioned Justice Gorsuch) joined the majority in *Lucia v. S.E.C.*,¹²⁴ which held that SEC ALJs are principal officers because, much like APJs (and the special tax judges in *Freytag v. Commissioner*¹²⁵), they have significant “duties and powers ... in conducting adversarial inquiries.”¹²⁶ And even though the SEC had the ability to review ALJ decisions (unlike the Director with respect to APJ decisions), if they decline to do so, the ALJ decision “becomes final and is deemed the action of the Commission,” which gives the ALJ “last-word capacity” that “must” make them principal officers.¹²⁷

Severance and New Hearing as Proper Remedy

As discussed, the Federal Circuit’s remedy for the constitutional defect was severing the statute that limits the Director’s power to remove APJs and granting a new hearing with a new panel of APJs to patent owners who timely raised the issue.¹²⁸ *Arthrex* filed its own petition for certiorari, arguing that severance was contrary to congressional intent, and the propriety of the Federal Circuit’s remedy was one of the questions the Supreme Court will review. Although the United States did not weigh in on this issue in its opening brief, the United States has argued in favor of the severance remedy before the Federal Circuit.

The Federal Circuit in *Arthrex* opted for the severance remedy because they believed it “was the narrowest revision to the scheme intended by Congress for reconsideration of patent rights, is the proper course of action and the action Congress would have undertaken.”¹²⁹ Severing unconstitutional employment protections from a statute appears to be a remedy favored by the current Supreme Court. For example, in *Seila Law*, six of the current justices were part of the majority that agreed to sever the CFPB Director’s removal protections. However, Justices Thomas and Gorsuch would have refrained from deciding severability in *Seila Law*, an approach similar to that taken by some of the Federal Circuit judges who dissented in *Arthrex II*. Judge Dyk, joined by three other judges, would have allowed Congress or the PTO an opportunity to correct the deficiency first.

Forfeiture of Appointments Clause Arguments

In the original *Arthrex* decision, the Federal Circuit panel ruled that the patent owner’s Appointments Clause

challenge had not been forfeited despite not being raised before the Board, because “the Board could not have corrected the problem.”¹³⁰ Following the decision, the Federal Circuit issued several orders that Appointments Clause challenges were forfeited if not raised at the first opportunity on appeal.¹³¹ Thus, the applicability of *Arthrex* was limited to Final Written Decisions issued before *Arthrex* where the patent owner timely raised an Appointments Clause challenge on appeal.

The United States had sought review of the Federal Circuit’s decision to consider the challenge, and many different patent owners sought review of the Federal Circuit’s decision to limit consideration of the issue to those who had raised it in, or prior to, their Opening Brief on appeal. Several patent owners have argued that forfeiture cannot apply when there is an intervening change of law.¹³² However, the Supreme Court so far has not granted (or outright denied) review of all of these forfeiture issues.

Given the Federal Circuit’s position on forfeiture, numerous decisions will have been issued affirming the PTAB’s pre-*Arthrex* decisions canceling patent claims. Moreover, since *Arthrex* purports to cure the constitutional deficiency, many post-*Arthrex* Final Written Decisions also have been affirmed. If the Supreme Court were to disagree with the Federal Circuit’s severability analysis and consider AIA reviews as a whole to be unconstitutional, this may result in enforcement of a Final Written Decision being dependent on the timing of an issuance of a Federal Circuit decision affirming the Board. For example, all appeals likely would be exhausted by now for an affirmed Final Written Decision issued just after *Arthrex*. But a later Final Written Decision issued just before the Supreme Court’s opinion may end up being reversed if the Supreme Court disagrees with the Federal Circuit’s severability analysis. A desire to

avoid these difficult administrative issues may weigh in favor of the Supreme Court affirming the severability of APJ employment protections or producing some other remedy that largely preserves the status quo.

Conclusion

Although the Federal Circuit's decision in *Arthrex* held that the ability of APJs to issue unreviewable Final Written Decisions rendered them unconstitutionally appointed principal officers, the Federal Circuit limited the effect of its potentially wide-ranging decision through severance of APJ employment protections and judicious use of forfeiture doctrine. The Supreme Court's decision to consider the Appointments Clause issue and the severance remedy could potentially upend the Federal Circuit's careful and deliberate path. Recent precedent suggests the Supreme Court will affirm the Federal Circuit on the merits, but given that review was granted, the Court may modify the remedy in some fashion.

Update on Motion to Amend Pilot Program

Over the past year, the PTAB has issued several Final Written Decisions from AIA trials involving new amendment practice under the USPTO's Pilot Program Concerning Motion To Amend Practice. This program was promulgated on March 15, 2019. Back then, the USPTO altered amendment practice on a pilot basis, and the pilot program is ongoing. These changes have increased the likelihood of a patent owner leaving an AIA trial with enforceable claims, as commenters inside and outside the USPTO have observed. But many patent owners and petitioners alike have yet to consider the strategic implications of the new procedures now involved in amendment practice. By analyzing

2020's Final Written Decisions on amendment practice, patent owners and petitioners can glean tactics to better manage the new procedures.

In creating post-grant trials before the USPTO, the America Invents Act also established an opportunity for patent owners to amend their challenged patents.¹³³ Yet, patent owners have viewed amendment practice dimly, and for good reason. According to the USPTO, the PTAB granted or granted-in-part motions to amend in only 14 percent of cases where one was filed, for post-grant trials instituted before March 15, 2019. Concerned that patent owners lacked a real opportunity to amend their claims in AIA trials, the USPTO reformed amendment practice with the Pilot Program.

On March 15, 2019, the USPTO announced the Pilot Program, which created two procedural changes to amendment practice for AIA trials instituted after that date.¹³⁴ First, it allowed patent owners to request Preliminary Guidance from the PTAB. Preliminary Guidance provides an initial assessment of the Motion to Amend, including whether the patent owner has conformed to certain statutory and regulatory requirements for its proposed claims and whether the petitioner has shown those proposed claims unpatentable. Second, under the Pilot Program, patent owners may file a Revised Motion to Amend, presenting new proposed claims in response to the Preliminary Guidance or the petitioner's opposition to the Motion to Amend. At the patent owner's option, these new procedures may be pursued separately or together. Because the USPTO believes that this pilot is providing a more robust amendment practice, it is likely to continue these procedures at least in the near term.

Patent owners have embraced these procedures. According to the USPTO, nearly 80 percent of patent owners

have requested Preliminary Guidance and a similar proportion has filed Revised Motions to Amend. Through these procedures, patent owners have increased the rate at which at least one proposed claim is granted in amendment practice to 36 percent. Because of this more than doubling of the rate of successfully proposed claim amendments under the USPTO's pilot, we can expect intense lobbying over whether to codify the pilot in regulation during the new administration. If codification plays out, patent owners and petitioners should keep in mind that the PTAB has issued many Final Written Decisions applying the new procedures. In analyzing these decisions, certain trends and emerging strategies are evident.

As a basic starting point, patent owners generally should request Preliminary Guidance. To be sure, the Board does not always find in the patent owner's favor when Preliminary Guidance is issued. But where the Board changes its view between its Preliminary Guidance and its Final Written Decision, more than 80 percent of those changes favored the patent owner. Petitioners thus would be well-advised to limit their reliance on the PTAB's preliminary conclusions in the Preliminary Guidance.

Patent owners may find that Preliminary Guidance does not always address in detail all issues they might want addressed when considering whether to file a Revised Motion to Amend. For example, the PTAB tends to avoid providing a detailed rationale in Preliminary Guidance about references asserted for the first time in the petitioner's opposition to the Motion to Amend without first receiving an adversarial response from the patent owner as to these new references.¹³⁵ Patent owners thus should be particularly diligent about evaluating any Revised Motion to Amend in light of the references asserted by the petitioner for the first time in the opposition

to the Motion to Amend even if the Preliminary Guidance seems to take no issue with such references.

Although Preliminary Guidance is non-binding on the PTAB, the PTAB treats Preliminary Guidance as somewhat authoritative.¹³⁶ Parties are well-advised to restate points on which the PTAB has agreed with them in Preliminary Guidance. Parties can even use the reasoning offered in Preliminary Guidance to effectively argue for or against different claims submitted in a Revised Motion to Amend.¹³⁷

The Board has even applied waiver when a party fails to dispute or sufficiently engage the Preliminary Guidance. For example, in *Unified Patents, LLC v. Varatec, LLC*, the PTAB “adopt[ed] our preliminary findings and determinations” on several issues because a party did “not address any of the shortcomings that were identified in the Preliminary Guidance.”¹³⁸ In fact, the PTAB has justified a ruling by reasoning, “In any event, Petitioner’s arguments against the Revised Motion to Amend do not respond to the analysis we provided in the Preliminary Guidance on this issue.”¹³⁹ Parties should thus consider characterizing their opponent’s arguments as non-responsive to or otherwise failing to address Preliminary Guidance.

Preliminary Guidance, however, should not be relied on fully. Final Written Decisions reach the opposite conclusions of Preliminary Guidance when a more complete “review of all of the evidence and arguments” justifies the changed outcome.¹⁴⁰ In one case, different results were justified by the patent owner identifying a technical but material error in the Preliminary Guidance.¹⁴¹ It remains unclear whether and how a party can remedy prejudice from abrogated or erroneous Preliminary Guidance.

Despite the above examples, the PTAB usually provides a reasoned explanation, more than boilerplate, for departures from Preliminary Guidance. Should the Board depart from its Preliminary Guidance, the aggrieved party should carefully compare the Board’s reasoning between its Preliminary Guidance and its Final Written Decision.

When the PTAB is unsure about an issue, it can, in Preliminary Guidance, “invite the parties to explore” that issue—and explore it they should.¹⁴² Parties should prioritize explaining these issues in briefing responsive to the Preliminary Guidance because, on these issues, the PTAB is more likely to change its initial position. For example, in *Unified Patents*, the PTAB issued such an invitation in Preliminary Guidance. Although the PTAB found against the patent owner in Preliminary Guidance, the PTAB reversed itself in its Final Written Decision, adopting and relying on the patent owner’s expanded argument presented in responsive briefing. To indicate these critical issues, the PTAB sometimes uses language like, “For the purposes of this Preliminary Guidance, we accept.”¹⁴³

The PTAB also now allows for Revised Motions to Amend, in addition to requests for Preliminary Guidance. Patent owners should not submit a Revised Motion to Amend without first requesting Preliminary Guidance. Although the particulars of the cases vary, Revised Motions to Amend can pose risks for patent owners—risks having to do with revised claim terms raising new issues like inadequate support and indefiniteness.¹⁴⁴ Conversely, petitioners should focus their description and indefiniteness arguments on new claim terms proposed in a Revised Motion to Amend.

A Revised Motion to Amend, however, can be a wise move for the patent owner when Preliminary Guidance

discloses that the PTAB is likely to deny the initial Motion to Amend. In *Jiangu SmartSens Technology Co. v. OmniVision Technologies, Inc.*, when faced with Preliminary Guidance forecasting a likely denial on both obviousness and lack of description, the patent owner filed a Revised Motion to Amend.¹⁴⁵ In that motion, the patent owner substituted a claim that more closely hewed to the patent’s figures, replacing more conceptual language. This Revised Motion to Amend had two effects that carried the day for the patent owner. First, it addressed the disclosure issue. Second, it scuttled the petitioner’s prior-art argument, effectively requiring new references that ultimately failed to make obvious the newly proposed claim. For patent owners, a well-crafted Revised Motion to Amend can reset the amendment practice.

It is vitally important for petitioners’ success that they address the patent owner’s Revised Motion to Amend rather than simply incorporating their earlier arguments against the earlier proposed amended claims. As the PTAB has expressed, “We are doubtful that this manner of merely referring to arguments presented in an earlier brief, which opposed an earlier and different version of the motion to amend, is sufficient[.]”¹⁴⁶ Patent owners thus may succeed by attacking petitioners’ responsive briefing to the Revised Motion to Amend for, among other things, not being self-contained.

When faced with a Revised Motion to Amend, though, petitioners need not concede a fresh start to patent owners. To be sure, petitioners should oppose the Revised Motion to Amend in a self-contained filing, keyed to the revised proposed amendments. But petitioners also can argue that the revised proposed claims are not patentably distinct from the earlier proposed claims. For example, in *Ely Holdings Ltd. v. O’Keefe’s, Inc.*, the PTAB found, “Other than rearranging

the elements, substitute proposed claims 13–19 in the Revised Motion to Amend are the same as those in the original Motion to Amend.”¹⁴⁷ Petitioners also should carefully screen the Revised Motion to Amend for amendments not responsive to the Preliminary Guidance

or to petitioner’s opposition to the initial Motion to Amend.¹⁴⁸ On these technical defects, petitioners can move to strike a Revised Motion to Amend.

The Pilot Program has changed amendment practice significantly and

largely in the favor of patent owners. The program is relatively new, so the PTAB and parties are still adapting and its strategic implications will continue to play out over time.

About Wilson Sonsini’s Post-Grant Practice

The professionals in Wilson Sonsini Goodrich & Rosati’s post-grant practice are uniquely suited to navigate the complex trial proceedings at the USPTO as well as on appeal at the Federal Circuit. We have extensive experience before the PTAB, representing clients in numerous AIA trial proceedings and in countless reexaminations and patent interference trials. Our practice includes professionals with decades of experience at the PTAB, including former PTAB personnel. Our core team leverages firmwide intellectual property expertise to provide comprehensive IP solutions for clients that cover strategy, prosecution, licensing, enforcement, and defense.

Endnotes

- 1 PTAB institution data in this report was obtained using Lex Machina and includes discretionary denials of institution.
- 2 FY2020 numbers reflect institution decisions entered on or before December 28, 2020.
- 3 IPR2020-00019, Paper 11 (Mar. 20, 2020).
- 4 *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019 (PTAB Mar. 20, 2020).
- 5 *Id.* at 5-6.
- 6 *Id.* at 6.
- 7 Institution decisions citing *Fintiv* but indicating that the *Fintiv* factors need not be reached because the petition was denied on other grounds were not included. Rehearing requests analyzing *Fintiv* factors also were not included.
- 8 For example, in *Intel Corp. v. VLSI Tech. LLC*, the PTAB found factor 1 to be neutral, as neither party had produced evidence that a stay had been requested, or had argued that a stay may be requested. IPR2020-00526, Paper 18, at 10 (PTAB Aug. 18, 2020). In *Supercell Oy v. Gree, Inc.*, the PTAB concluded that this factor was neutral, as the record was devoid of evidence suggesting a stay had been granted, or that it may be granted upon institution. PGR2020-00053, Paper 12, at 10 (PTAB Oct. 9, 2020).
- 9 *Philip Morris Products, S.A. v. RAI Strategic Holdings, Inc.*, IPR2020-00921, Paper 9, at 16-18 (PTAB Nov. 16, 2020) (denying institution under *Fintiv* despite concluding factor 3 favored institution because the district court had not issued any substantive orders).
- 10 PGR2020-00053, Paper 12, at 10, 13-15.
- 11 IPR2020-00719, Paper 16 (PTAB Aug. 31, 2020).
- 12 *Id.* at 13-14.
- 13 *Id.* (citing *Sand Revolution II, LLC v. Continental Intermodal Group-Tracking, LLC*, IPR2019-01393, Paper 24 at 12 n.5 (PTAB Jun. 16, 2020) (informative)); *see also Samsung Electronics Co., LTD. v. Bell Northern Research, LLC*, IPR2020-00718, Paper 12, at 11 (PTAB Oct. 6, 2020).
- 14 IPR2020-00854, Paper 9 (PTAB, Oct. 28, 2020).
- 15 IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i).
- 16 *Apple* at 2.
- 17 *Id.*
- 18 *Id.* at 2-3.
- 19 IPR2016-01357, Paper 19 at 16 (PTAB, Sept. 6, 2017).
- 20 *Apple* at 13.
- 21 IPR2020-00734, Paper 11 (PTAB Oct. 6, 2020).
- 22 *Id.* at 16.
- 23 *Id.* at 20.
- 24 *Id.* at 16.
- 25 *Id.* at 18.
- 26 *Id.* at 18.
- 27 IPR2015-00739, Paper 38 at 6 (PTAB, Mar. 4, 2016).
- 28 *SharkNinja* at 18 (citing *Mayne Pharma Int'l Pty. Ltd. v. Merck Sharp & Dohme Corp.*, for the proposition that under 35 U.S.C. §312(a)(2) the “Director can, and does allow the petitioner to add a real party in interest”).
- 29 *Id.* at 18-19.
- 30 IPR2015-01750, Paper 128 (PTAB Oct. 2, 2020).
- 31 *Id.* at 6.
- 32 *Id.* at 1-2.
- 33 *Id.* at 7.
- 34 *Id.* at 8.
- 35 *Id.* at 37.
- 36 *Id.* at 38.

Endnotes (cont.)

- 37 *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 5-6 (PTAB Mar. 20, 2020).
- 38 IPR2020-01019, Paper 12, (PTAB Dec. 1, 2020).
- 39 *Id.* at 17, 19.
- 40 *Id.* at 20-21.
- 41 IPR2020-00820, Paper 15, (PTAB Oct. 21, 2020).
- 42 *Id.* at 8-9.
- 43 *Id.* at 9, 15-16.
- 44 *Id.* at 16-18.
- 45 572 U.S. 898 (2014).
- 46 751 F.3d 1307 (Fed. Cir. 2014) (*per curiam*); *see also Ex parte McAward*, Appeal 2015-006416 (PTAB Aug. 25, 2017) (Section I.B. designated as precedential) (noting that, because the USPTO applies a broadest reasonable interpretation standard, a prima facie case of indefiniteness is established when it is explained how the meted and bounds of a pending claim are not clear because the claim contains words or phrases that are unclear).
- 47 973 F.3d 1321 (Fed. Cir. 2020).
- 48 *Id.* at 1325.
- 49 IPR2018-00914, Paper 34 (P.T.A.B. Mar. 13, 2019).
- 50 *See Windy City*, 973 F.3d at 1335.
- 51 964 F.3d 1112 (Fed. Cir. 2020).
- 52 *Id.* at 1115.
- 53 *Id.* at 1114.
- 54 *Id.*
- 55 *See SAS Inst. Inc. v. Iancu*, 584 U.S. ___, 138 S. Ct. 1348, 1359-60 (2018).
- 56 *Valencell*, 964 F.3d at 1114.
- 57 *Id.*
- 58 *Id.*
- 59 *Id.*
- 60 *Id.* at 1115 (quoting 35 U.S.C. § 319).
- 61 *Id.*
- 62 *Id.* at 1116-20.
- 63 948 F.3d 1342 (Fed. Cir. 2020).
- 64 *Id.* at 1345.
- 65 *See IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005).
- 66 *Prisua*, 948 F.3d at 1345.
- 67 *Id.*
- 68 *Id.* at 1353, 1355.
- 69 *Id.* at 1351 (quoting 35 U.S.C. § 318(a)).
- 70 *Id.*
- 71 *Id.* at 1352.
- 72 *Id.*
- 73 *Id.* at 1353.
- 74 *Id.* at 1355 & n.5.
- 75 962 F.3d 1362 (Fed. Cir. 2020).

Endnotes (cont.)

- 76 *Id.* at 1365-66.
- 77 *Id.* at 1366-67.
- 78 *Id.* at 1366.
- 79 *Id.* at 1367.
- 80 *Id.* at 1367-68.
- 81 *Id.*
- 82 *Id.* at 1368.
- 83 *Id.* at 1369.
- 84 978 F.3d 1374 (Fed. Cir. 2020).
- 85 *TC Heartland LLC v. Kraft Food Group Brands LLC*, 581 US ___, 137 S. Ct. 1514, 1517 (2017).
- 86 *Valeant*, 978 F.3d at 1376.
- 87 *Id.* at 1378 & n.5.
- 88 *Id.* at 1377-78.
- 89 *Id.* at 1378 n.5.
- 90 *Id.* at 1381, 1383.
- 91 *Id.* at 1381.
- 92 *Id.* at 1384.
- 93 *Id.*
- 94 *See In re HTC Corp.*, 889 F. 3d 1349, 1354 (Fed. Cir. 2018).
- 95 *Valeant*, 978 F.3d at 1384-85.
- 96 590 U.S. ___, 140 S. Ct. 1367 (2020).
- 97 *Click-to-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321 (Fed. Cir. 2018).
- 98 *Thryv*, 140 S. Ct. at 1377.
- 99 *Id.*
- 100 *Id.* at 1373 (quoting *Cuozzo Speed Techs. LLC v. Lee*, 579 U.S. ___, 136 S. Ct. 2131, 2141 (2016)).
- 101 *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364, 1367 (Fed. Cir. 2018) (*en banc*).
- 102 *Thryv*, 140 S. Ct. at 1373-74.
- 103 *Id.* at 1375.
- 104 *See id.* at 1380-87 (Gorsuch, J., dissenting).
- 105 *Id.* at 1375.
- 106 *Id.* at 1374 n.6.
- 107 *See, e.g., Windy City*, 973 F.3d 1321.
- 108 *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019) (“*Arthrex*”).
- 109 *See Customedia Technologies, LLC v. Dish Network Corp.*, Nos. 18-2239 & 19-1001 (Fed. Cir. Nov. 1, 2019).
- 110 *Ciena Corp. v. Oyster Optics, LLC*, No. 2019-2117 (Fed. Cir. Jan. 28, 2020).
- 111 *See, e.g., Lucia v. S.E.C.*, 138 S. Ct. 2044 (2018); *Financial Oversight and Management Board for Puerto Rico v. Aurelius Investment, LLC*, 140 S. Ct. 1649 (2020); *Seila Law LLC v. Consumer Financial Protection Bureau*, 140 S. Ct. 2183 (2020).
- 112 *Arthrex*, 941 F.3d at 1335.
- 113 *Id.* at 1329.
- 114 *Id.*
- 115 *Arthrex, Inc. v. Smith & Nephew, Inc.*, 953 F.3d 760, 774-75 (Fed. Cir. 2020) (“*Arthrex II*”).
- 116 487 U.S. 654 (1988).

Endnotes (cont.)

- 117 *Arthrex II*, 953 F.3d at 781.
- 118 *Id.* at 782.
- 119 *Id.*
- 120 *Id.* at 783.
- 121 *Id.* at 784.
- 122 *Thryv, Inc. v. Click-to-Call Techs., LP*, 140 S. Ct. 1367, 1388 (2020) (Gorsuch, J., dissenting).
- 123 *Oil States Energy v. Greene's Energy Group*, 138 S. Ct. 1365, 1381 (2018) (Gorsuch, J., dissenting).
- 124 138 S. Ct. 2044 (2018).
- 125 501 U.S. 868 (1991).
- 126 *Lucia*, 138 S. Ct. at 2053.
- 127 *Id.* at 2054.
- 128 *See Arthrex*, 941 F.3d at 1338-40.
- 129 *Arthrex*, 941 F.3d at 1338.
- 130 *Arthrex*, 941 F.3d at 1328.
- 131 *See, e.g., Customedia*.
- 132 *See, e.g., Duke University v. Biomarin Pharmaceutical Inc.*, No. 19-1475 (petition denied); *Sanofi-Aventis Deutschland GmbH v. Mylan Pharmaceuticals Inc.*, No. 19-1451 (petition denied).
- 133 35 U.S.C. §§ 316(d), 326(d); *see also* 37 C.F.R. § 42.121.
- 134 84 Fed. Reg. 9,497 (Mar. 15, 2019).
- 135 *See, e.g., American National Manufacturing, Inc. v. Sleep Number Corp.*, IPR2019-00497, Paper 77, at 6.
- 136 *L&P Prop. Mgmt. Co. v. Remarco Mach. & Tech. (Wujiang) Co.*, IPR2019-00255, Paper 37 at 54-55.
- 137 *Id.*; *see also Becton, Dickinson & Co. v. Baxter Corp.*, IPR2019-00121, Paper 63, at 89 n.10.
- 138 IPR2019-01276, Paper 39, at 58.
- 139 *AFD Petroleum (Texas) Inc. v. Frac Shack Inc.*, IPR2019-00995, Paper 32.
- 140 *Compare UD Electronic Corporation v. Pulse Electronics, Inc.*, IPR2019-00511, Paper 21, at 17 *with* IPR2019-00511, Paper 33, at 57-59.
- 141 *Compare Smartmatic USA Corp. v. Election Sys. & Software, LLC*, IPR2019-00531, Paper 23, at 10 (PTAB Feb. 3, 2020), *with* IPR2019-00531, Paper 42, at 41 (PTAB July 17, 2020).
- 142 *See* IPR2019-01276, Paper 28, at 16-17.
- 143 *See, e.g.,* IPR2019-01276, Paper 28, at 16-17.
- 144 *E.g., Volkswagen Group of America, Inc. et al. v. Michigan Motor Technologies LLC*, IPR2019-01274, Paper 47, at 69.
- 145 IPR2019-01263, Paper 48, at 50-52 (PTAB Dec. 18, 2020).
- 146 *AFD Petroleum (Texas) Inc. v. Frac Shack Inc.*, IPR2019-00995, Paper 32, at 18 (PTAB Oct. 15, 2020) (citing 37 C.F.R. § 42.6(a)(3)).
- 147 PGR2019-00025, Paper 50, at 3.
- 148 84 Fed. Reg. at 9,498.

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