



PTAB Newsletter

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Q&A with Arnold & Porter PTAB Practitioner **Jessica Kaiser**

Jessica recently joined Arnold & Porter's IP practice in March 2022 after more than seven years as an administrative patent judge (APJ) with the Patent Trial and Appeal Board (PTAB).

How would you describe your practice?

My practice focuses on patent disputes. Such disputes often proceed simultaneously in multiple forums, including the PTAB (where I was formerly a judge), the district courts, the ITC, and the Federal Circuit. My practice also spans a broad variety of technologies. At the PTAB, I focused on AIA proceedings in the electrical arts, but as a litigator, I have also represented clients in patent cases involving medical devices and pharmaceuticals.

How long have you been practicing in front of the USPTO and in front of the PTAB?

I was an APJ at the PTAB from 2014 until early 2022. During that time, I presided over numerous AIA trials and ex parte appeals on original prosecution. I also interfaced with various other parts of the USPTO on issues of policy, including the Director's Office, the Solicitor's Office, and the Central Reexamination Unit.

What's the biggest difference between being in private practice and being an APJ?

Private practice requires solving a more complicated puzzle. As an APJ, I was a neutral

decisionmaker, and on each case, I focused on reaching the correct outcome based on the record before me. On the other hand, in private practice, many other factors can be at play beyond the cold record of a case. Depending on the scope of the dispute, this can include strategies across multiple forums (e.g., PTAB and district court), client needs, and future implications of taking a given position in litigation. Thinking through these complicated strategic puzzles is very different from my work as an APJ, but probably the part of private practice I enjoy the most.

What do you enjoy about practicing at Arnold & Porter?

The people. When I joined Arnold & Porter in March 2022, I didn't know any of the attorneys. In just six months, I have become fast friends with several. In my view, our people not only do fantastic legal work, but they are outstanding people. Practicing with people who I respect, admire, and enjoy spending time with makes the job fun.

What do you like to do in your spare time?

I enjoy spending time with my husband, my two children, and our dog. I also enjoy spending time in the Colorado mountains, camping, hiking, and stand-up paddleboarding. As a family, we enjoy traveling, and we are planning to visit the Galactic Starcruiser at Walt Disney World in October during the kids' fall break.



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with Arnold & Porter PTAB Practitioner

Atanas Baitchev

Atanas has been part of Arnold & Porter's IP practice for 4 years.

How would you describe your practice?

My practice focuses on patent litigation in the district courts and assisting in IPR proceedings, which are often directly related to the district court litigation. The PTAB is increasingly the preferred venue for our clients, so a larger portion of my practice has been focused on preparing IPRs very quickly after a district court case is initiated in order to increase the likelihood of obtaining a stay pending resolution of the IPR. Balancing considerations of infringement and invalidity in the district court, on the one hand, and invalidity before the PTAB, on the other, are also an important aspect for my practice.

How long have you been practicing in front of the USPTO and in front of the PTAB?

I was fortunate enough to start work on my first IPR as a first year associate, and I have had a hand in over a dozen IPRs since.

What's the biggest difference between practicing in front of the PTAB and a district court?

The biggest difference is your audience. In the district court, you have to assume that the judge, and eventually the jury, does not have any background in the subject matter of the disputed patent(s). You have to frame your arguments in a way that is understandable to a lay person, and you further have to change your internal assessment of some arguments that may be technically correct but practically too complex for a lay person to understand. In front of the PTAB, your audience generally has some background in the subject matter of the patents, so you are more free to make nuanced arguments.

Why were you interested in practicing before the PTAB, and how did you get involved in the practice?

I started assisting on IPRs as a first year associate, so my initial interest was based on trying to get exposed to as many aspects of patent law as possible. Subsequently, the difference in audience, as well as the predictable and relatively short statutory timelines are what have kept me coming back for more PTAB work.

How would you like to grow your practice before the PTAB?

I would like to continue progressing my involvement in PTAB proceedings and take on more real-time roles such as expert depositions and oral argument as I progress in seniority. For example, I hope that I can take advantage of the PTAB's Legal Experience and Advancement Program (LEAP), which provides extra time for oral argument to less experienced patent practitioners.

What do you enjoy about practicing at Arnold & Porter?

The people at Arnold & Porter are all fantastic! Everyone, from staff, to associates, to counsel and partners, is incredibly smart, hard-working, and talented. There is always an opportunity to learn or advance a skill by collaborating with others, and people go out of their way to teach you. I couldn't ask for a better environment to develop my legal skills.

What do you like to do in your spare time?

I have a 16-month-old son, so the vast majority of my spare time in the last year and a half has been family time. I also recently moved back to southern California after spending four years in Washington, DC, and I am getting back into ocean sports such as surfing and spearfishing.



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Recent USPTO Leadership Changes

On August 15, 2022, the USPTO [announced](#) new staff additions to the senior team in the Office of the Under Secretary. The announcement provides the following changes to the senior team:

- **Shirin Bidel-Niyat** was elevated to chief of staff (previously serving as a senior advisor);
- **Russell Lopez** joined the agency as its new chief communications officer; and
- **Dede Zecher** was promoted to chief advisor to the Director (previously acting chief of staff and special advisor)

Recent PGR/IPRs Involving Director Review

A. Director Review of Decision Denying PGR Institution: *Boehringer Ingelheim Animal Health USA Inc. v. Kansas State University Research Foundation*, PGR2022-00021

On August 12, 2022, the Director [initiated review](#) of the PTAB's [Decision Denying Institution of Post Grant Review](#) in *Boehringer Ingelheim Animal Health USA Inc. v. Kansas State University Research Foundation*, PGR2022-00021. The *Boehringer* PGR petition raised written description, enablement, and obviousness challenges. The patent owner did not file a preliminary response.

Regarding the written description and enablement challenges, the panel exercised its discretion under 35 U.S.C. § 325(d) because the asserted arguments were substantially the same as those previously presented to the Office and Petitioner failed to demonstrate that the Office erred. The panel also rejected three of the obviousness challenges under § 325(d) because those grounds were conditioned on the written description challenge. Finally, as to the last obviousness challenge, the panel found the petitioner did show it was more likely than not that it would prevail in establishing unpatentability.

The Director's order initiating *sua sponte* review states "this case raises issues of particular importance to the Office and the patent community," but did not explicitly identify the issues of interest. In addition, the order states a further order will issue setting the schedule for Director review.

B. IPR Involving Interference Estoppel: *Zynga, Inc. v. IGT*, IPR2022-00199

On August 22, 2022, the Director [ordered review](#) of the PTAB's [Institution Decision](#) in *Zynga, Inc. v. IGT*, IPR2022-00199. In instituting review, the panel waived any effects of 37 C.F.R. § 41.127 and determined that the petitioner was not barred from pursuing *inter partes* review of the challenged patent based on interference estoppel.

The Director *sua sponte* granted Director review and affirmed the Board's Institution Decision. In particular, the Director found that interference estoppel under 37 C.F.R. § 41.127(a)(1) does not apply to trial and preliminary proceedings before the PTAB. Moreover, the Director held that even if interference estoppel did apply, such estoppel would not apply in this case because the Board terminated the interference based on the threshold issue of written description. Accordingly, the Director remanded the matter to the original merits panel for further proceedings.

C. IPRs Involving Multiple, Serial Petitions: *Code200, UAB v. Bright Data, Ltd.*, IPR2022-00861 & IPR2022-00862

On August 23, 2022, the Director *sua sponte* [ordered review](#) of the PTAB's [Decisions Denying Institution and denying joinder](#) in *Code200, UAB v. Bright Data, Ltd.*, IPR2022-00861 & IPR2022-00862. In denying institution

and joinder, the panel analyzed the *General Plastic* factors because the petitioner had previously filed a petition which was denied for discretionary reasons. The panel determined to exercise its discretion to deny institution under 35 U.S.C. § 314(a), and denied joinder because the petition did not warrant institution.

The Director vacated the panel's decision denying institution and remanded to the panel for further proceedings. Specifically, the Director stated: "Where the first-filed petition under factor 1 was discretionarily denied or otherwise was not evaluated on the merits, factors 1–3 only weigh in favor of discretionary denial when there are 'road-mapping' concerns under factor 3 or other concerns under factor 2." The Director also disagreed with the panel's determination that it would be inefficient to expend the Board's resources on the proceeding because the Board's mission of improving patent quality outweighed the effect on Board resources of evaluating the petition. Accordingly, the Director vacated the Decisions Denying Institution and remanded to the panel to consider the patent owner's remaining arguments including for discretionary denial under *Fintiv* and as to the merits of the patentability challenges.

D. IPR Involving *Fintiv* Analysis Where Co-Pending Proceeding Invalidated The Underlying Patent Under § 101: *Aviagames, Inc. v. Skillz Platform Inc.*, IPR2022-00530

On August 26, 2022, the Director *sua sponte* [ordered review](#) of the PTAB's [Decision Denying Institution](#) in *Aviagames, Inc. v. Skillz Platform Inc.*, IPR2022-00530. The panel had determined not to institute based on *Fintiv*. About a month after the IPR petition was filed, the district court in co-pending litigation found the claims of the challenged patent to be directed to patent-ineligible subject matter under 35 U.S.C. § 101. Although the panel found the *Fintiv* analysis to be a poor fit for such circumstances, the panel found those factors supported denying institution.

The Director *sua sponte* initiated review, finding the case "raises issues of particular importance to the Office and the patent community." The Director stated that an order or decision on Director review would be issued in due course.

E. IPR Involving Stipulation Offered After Institution Denial Based on *Fintiv*: *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556

On September 7, 2022, the Director [ordered review](#) of the PTAB's [Institution Decision](#) in *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556. The panel had denied institution under *Fintiv*. After that denial, the petitioner requested rehearing and among other issues, submitted, for the first time, a stipulation agreeing that it would not pursue any grounds based on the primary references if trial was instituted. The panel noted that the petitioner could have offered this stipulation prior to the decision denying institution but chose not to do so.

The Director *sua sponte* granted Director review and affirmed the panel's decision denying rehearing. Specifically, the Director held that the panel "correctly determined that a stipulation, offered by a petitioner for the first time after a decision denying institution, is not a proper basis for granting rehearing of the decision on institution."

F. IPR Involving Applicant Admitted Prior Art: *MED-EL Elektromedizinische Geräte Ges.m.b.H. v. Advanced Bionics AG*, IPR2020-01016 & IPR2021-00044

On August 22, 2022, the Director [issued a decision](#) on Director review Granting Rehearing, Vacating the [Final Written Decision](#), and Remanding to the PTAB Panel for Further Proceedings. The Director had previously [initiated Director review](#) on June 1, 2022 to clarify the Office's guidance on the treatment of Applicant Admitted Prior Art (AAPA) in IPRs.

The panel in *MED-EL* had applied the Office's 2020 Guidance on AAPA, and found that the petitioner had improperly relied on AAPA as the "basis" of its unpatentability ground. Following the Federal Circuit's decision in *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367 (Fed. Cir. 2022), the Director issued new AAPA Guidance on June 9, 2022. Applying the 2022 AAPA Guidance, the Director determined the petitioner's reliance on AAPA was not improper. The Director remanded to the panel to "issue a new final written decision consistent with the above determination that the Petition did not improperly rely on AAPA."

Recent Notable Federal Circuit Decisions

A. Federal Circuit decision regarding estoppel: *Click-to-Call Techs. LP v. Ingenio, Inc.*, No. 2022-1016, 2022 WL 3443656, (Fed. Cir. Aug. 17, 2022)

On August 17, 2022, the Court in [*Click-to-Call Techs. LP v. Ingenio, Inc.*](#), No. 2022-1016, 2022 WL 3443656 (Fed. Cir. Aug. 17, 2022) addressed an appeal from a District Court decision declining to apply estoppel under 35 U.S.C. § 315(e)(2).

In *Click-to-Call*, the PTAB had partially instituted an IPR involving the patent at issue in 2013—prior to the Supreme Court’s decision in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018). The District Court case was then stayed pending the outcome of the IPR. Notably, the PTAB’s partial institution decision declined to institute Ingenio’s ground challenging claim 27. Subsequently, the Board issued a final written decision finding other challenged claims unpatentable. Click-to-Call appealed the final written decision based on a time-bar dispute, and the Board’s decision later became final in 2020. Notably, Ingenio never sought remand under SAS during the pendency of the appeal. Subsequently, the District Court lifted the stay in 2020, and Ingenio sought summary judgment that claim 27 was invalid based on a prior art reference that was at issue in the IPR. Click-to-Call argued that Ingenio was estopped from pressing invalidity of claim 27 based on the prior art reference due to IPR estoppel under 35 U.S.C. § 315(e)(2). The District Court rejected Ingenio’s estoppel argument and granted summary judgment of invalidity, and Click-to-Call appealed.

On appeal, the Federal Circuit reversed and remanded, finding that estoppel applied to claim 27 as a matter of law. In reaching this conclusion, the Federal Circuit noted that Ingenio included claim 27 in its petition, and the IPR did result in a final written decision. Further, the Federal Circuit found that the fact that the Board—due to a legal error corrected by SAS—failed to include claim 27 in its final written decision did not absolve Ingenio of the estoppel triggered by its choice to challenge claim 27 at the Board.

B. Federal Circuit Decision Regarding Director Review: *In re Palo Alto Networks, Inc.*, 44 F.4th 1369 (Fed. Cir. 2022)

On August 16, 2022, the Court in [*In re Palo Alto Networks, Inc.*](#), 44 F.4th 1369 (Fed. Cir. 2022) found that the opportunity to obtain Director review is not guaranteed. Indeed, the Federal Circuit held that the delegation of authority as to whether to institute IPR and PGR proceedings to the Board and the Director’s policy refusing to accept party requests for Director review of decisions not to institute do not violate the Appointments Clause.

Recent District Court Decision Regarding Stay Where Co-Pending IPR Brought By Third-Party: *Aire Tech., Ltd. v. Garmin Int., Inc.*, Case No. 8-22-1027, (C.D. Cal. Aug. 16, 2022)

On August 16, 2022, the Court in *Aire Tech., Ltd. v. Garmin Int’l*, No. 8:22-cv-01027 (C.D. Cal. June 6, 2022) granted a motion to stay based, in part, on the fact that an IPR has been brought (pre-institution) against the same underlying patent. Notably, while the co-pending IPR was brought by a third-party, the Court found that Garmin’s agreement to be bound by any final written decision issued by the PTAB favors a stay (albeit slightly).

Recent PTAB Case Regarding *Fintiv* Analysis In Light Of Director's June 21, 2022 *Fintiv* Memorandum: *Nokia of America Corp., Ericsson Inc. v. Godo Kaisha IP Bridge 1*, IPR2022-00446

On August 25, 2022, the PTAB instituted IPR review on a patent currently at issue in two District Court cases in [*Nokia of America Corp., Ericsson Inc. v. Godo Kaisha IP Bridge 1*](#), IPR2022-00446. The Director's recent Memorandum sought to clarify the PTAB's application of *Fintiv* to discretionary institutions when there is parallel litigation and set forth that the PTAB will not rely on the *Fintiv* factors to discretionarily deny institution "where a petition presents compelling evidence of unpatentability." While the patent owner argued that institution should be denied under 35 U.S.C. § 314(a) because a trial in a parallel district court proceeding was scheduled to take place "less than a month from the institution deadline," the PTAB determined that the petitioner's invalidity grounds, "if unrebutted at trial, would plainly lead to a conclusion that [the] claims . . . are unpatentable by a preponderance of the evidence" and that instituting IPR review under these circumstances "strikes a balance among the competing concerns of avoiding potentially conflicting outcomes, avoiding overburdening patent owners, and strengthening the patent system by eliminating patents that are not robust and reliable."

Questions/Comments?

Contact a member of our Editorial Committee



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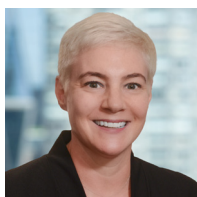
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