



PTAB Newsletter

In This Issue:

- Q&A with Arnold & Porter PTAB Practitioner Aaron Bowling
- Q&A with Arnold & Porter PTAB Practitioner Victoria Reines
- Recent MPEP Updates
- Recent Director Review Decisions

IPR Involving Fintiv Analysis and Compelling Merits: *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242

IPR Involving Fintiv Analysis Where Co-pending Proceeding Invalidated the Underlying Patent Under § 101: *AviaGames, Inc. v. Skillz Platform, Inc.*, IPR2022-00530

IPR Involving Multiple Dependent Claiming: *Nested Bean, Inc. v. Big Beings Pty. Ltd.*, IPR2020-01234

PGR Involving Enablement: *Boehringer Ingelheim Animal Health USA Inc. v. Kansas State University Research Foundation*, PGR2022-00021

- **Federal Circuit Precedential Decision: Sets Bar for ‘Motivation-to-Combine’ Challenges — Motivation To Combine Only Requires Showing That the Prior Art Addressed the Issue, Not That It Improved on the Issue**
- **Events and Speaking Engagements**

Highlights From Recent 2023 PTAB Bar Association Annual Conference (held March 8-10, 2023)

Upcoming Events and Speaking Engagements

Q&A with Arnold & Porter PTAB Practitioner **Aaron Bowling**

Aaron joined Arnold & Porter's IP practice in November 2021 after more than eight years of practice, including a judicial clerkship with Judge Jimmie V. Reyna of the U.S. Court of Appeals for the Federal Circuit.

How would you describe your practice?

I've had the good fortune of working on our Nike litigation team for many years, assisting on patent and trademark litigations in district court, appellate court, the PTAB, and the International Trade Commission. Thanks to the Nike team's leadership, those litigations have provided a wealth of fantastic opportunities, from the deposition room to counsel table to boardrooms on Nike campus. Aside from Nike, I focus mostly on appellate work. Leveraging my prior clerkship experience, I've joined a variety of teams litigating appeals at the federal circuit — assisting with both brief writing and oral argument preparation. I've also been fortunate to assist with several pro bono cases before the U.S. Supreme Court.

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

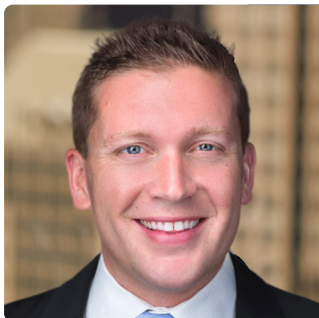
I first began practicing before the PTAB in 2014 (which is somehow nine years ago). Since then, I've worked on dozens of IPR proceedings, including six petitions currently pending before the PTAB.

What do you enjoy about practicing at Arnold & Porter?

I'm constantly impressed with the breadth of knowledge and talent at Arnold & Porter. We seem to have experts in every corner of the legal field, and it has been great to learn from such accomplished individuals. Because of this, our firm has proven to be an excellent place to grow as an attorney. With the help of our IP group's leadership, I've been able to pursue a number of exceptional opportunities in the appellate space and with professional organizations like the Federal Circuit Bar Association.

What do you like to do in your spare time?

I love traveling and spending time outdoors. I enjoy golfing, running, hiking, skiing, and doing anything near or on the water. We're taking our kids (ages 5 and 2) skiing for the first time in Big Sky, Montana next month, and my wife and I are celebrating our ten-year anniversary in the fall on the Argentario Coast of Tuscany, Italy.



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Q&A with Arnold & Porter PTAB Practitioner **Victoria Reines**

Victoria has been part of Arnold & Porter's IP practice for seven years (briefly with Kaye Scholer before they merged with Arnold & Porter). She was also a summer associate with Kaye Scholer in her second year in law school.

How would you describe your practice?

My practice is complex patent litigation with a focus on life sciences and biotechnology. Most of my matters relate to large molecules, but I also have experience with small molecules and medical devices. I have worked on cases before the Federal Circuit, United States district courts, Patent Trial and Appeal Board, International Trade Commission, and most recently before the U.S. Supreme Court.

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

I've been practicing before the USPTO and PTAB for six years.

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

The firm is currently involved in a significant number of PTAB proceedings. I would like to continue

working on matters before the PTAB and gain exposure to more administrative patent judges. I also look forward to arguing before the PTAB.

What do you enjoy about practicing at Arnold & Porter?

I love the people at Arnold & Porter. I have built amazing relationships with so many colleagues. The firm also provides associates with substantive opportunities. Instead of adhering to a strict hierarchy, the group seeks out opportunities for associates to, for example, take and defend depositions and argue motions, regardless of class year. Multiple partners have encouraged me to argue motions before district court judges as a mid-level associate, and although I was initially intimidated, they turned out to be wonderful experiences.

What do you like to do in your spare time?

I enjoy spending time with my 15-month-old son and husband — usually chasing my son around the house and neighborhood now that the weather is getting nicer. I also love traveling and look forward to traveling more as my son gets older.



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Recent MPEP Updates

On March 3, 2023, the USPTO (Office) [announced](#) publication of a revised version of the Manual of Patent Examining Procedure (MPEP) in the Federal Register. The revised MPEP (ninth edition, revision 07.2022) is retroactive to July 2022.

[Changes to the MPEP](#), which largely clarify guidance and incorporate recent changes in the extant case law, affect chapters 100, 200, 400, 500, 600, 700, 800, 900, 1000, 1100, 1200, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2400, 2500, 2700, 2800, 2900, and FPC (Form Paragraph Book). For example, chapter 700 was revised to clarify Request for Continued Examination (RCE), interview, suspension of action practices, amendment practice under 37 C.F.R. § 1.312, affidavit and declaration practice under 35 C.F.R. § 132, and submission of other evidence traversing rejections.

Minor updates were also made to the Foreword, Introduction, Subject Matter Index, Appendix II, Appendix L, Appendix R, Appendix AI, and Appendix T. These changes largely relate to inclusion of the rules, laws, and cases current as of July 2022.

Recent Director Review Decisions

IPR Involving *Fintiv* Analysis and Compelling Merits: *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242

[CommScope Techs. LLC v. Dali Wireless, Inc.](#), IPR2022-01242, Paper No. 23 (PTAB Feb. 27, 2023)

On February 27, 2023, Director Vidal (Director) [sua sponte issued a Decision on Director review](#) of the PTAB's (Board) [Institution Decision](#) in IPR2022-01242. The Director focused on two points from her *Fintiv* Guidance Memo: analysis for discretionary denial under *Fintiv* and the compelling merits standard.

The Director noted that the compelling merits standard is a higher standard than the standard for institution set by statute. Citing [OpenSky Indus., LLC v. VLSI Tech. LLC](#), IPR2021-01064, Paper 102, 49-50 (PTAB Oct. 4, 2022) (precedential), the Director stated that a compelling merits 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. The intention of a higher standard to overcome considerations that would lead to discretionary denial is to strike a balance among avoiding potentially conflicting outcomes, avoiding wasteful parallel proceedings, protecting against patent owner harassment, and strengthening the patent system by allowing the review of patents challenged with a sufficiently strong initial merits showing of unpatentability.

In addition, the Director stated that PTAB panels should consider compelling merits only if they first determine that *Fintiv* factors 1-5 favor a discretionary denial. If the Board determines that the other *Fintiv* factors 1-5 do not favor discretionary denial, the Board shall decline to discretionarily deny under *Fintiv* without reaching the compelling merits analysis. Where the Board's analysis of *Fintiv* factors 1-5 favors denial of institution, the Board shall then assess compelling merits and provide sufficient reasoning to the parties to allow for challenges to the finding and review of that determination.

In this case, the Director found that there was insufficient reasoning regarding compelling merits in the panel's decision, and remanded the proceeding to the Board to revisit its *Fintiv* analysis pursuant to the provided steps: the Board should first assess *Fintiv* factors 1-5; if that analysis supports discretionary denial, the Board should engage the compelling merits question. If the Board reaches the compelling merits analysis and finds compelling merits, it shall provide reasoning to explain its determination.

The Director ordered the PTAB to make its remand determination within three weeks, and on March 17, 2023, [the PTAB did so](#), finding that *Fintiv* factors 1-5 favored denial of institution but that the petitioner had presented a compelling, meritorious challenge.

IPR Involving *Fintiv* Analysis Where Co-pending Proceeding Invalidated the Underlying Patent Under § 101: *AviaGames, Inc. v. Skillz Platform, Inc.*, IPR2022-00530

[AviaGames, Inc. v. Skillz Platform, Inc., IPR2022-00530, Paper No. 14 \(PTAB Mar. 2, 2023\)](#)

On August 26, 2022, the Director [sua sponte initiated Director review](#) of IPR2022-00530 after the Board denied institution of *inter partes* review under 35 U.S.C. § 314(a). [In its determination to exercise discretion to deny institution](#), the Board considered the *Fintiv* factors and reasoned that “because a district court determined that the challenged claims were invalid under § 101, ‘the interests of efficiency and integrity of the system would be best served by invoking 35 U.S.C. § 314(a) to deny institution.’”

On March 2, 2023 the Director vacated the Board’s decision and remanded the proceeding to the Board to determine whether the record before the Board prior to institution “presents a compelling, meritorious challenge.” The Director explained that the district court judgment under § 101 was based on a ground that could not have been raised in an IPR. Therefore, according to the Director, the Board should not deny institution in view of this judgment if the record prior to institution meets the compelling merits standard. The Director also stressed that “the compelling merits standard is a higher standard than the standard for institution set by statute,” and “it is only a finding under this higher standard that would compel the Board to review claims for the public benefit when other considerations favor discretionary denial.”

The Board was ordered to make a determination within four weeks, and on March 22, 2023, [the Board did so](#), finding that the petition did not present a compelling, meritorious challenge and again denying institution.

IPR Involving Multiple Dependent Claiming: *Nested Bean, Inc. v. Big Beings Pty. Ltd.*, IPR2020-01234

[Nested Bean, Inc. v. Big Beings Pty Ltd., IPR2020-01234, Paper 42 \(PTAB Feb. 24, 2023\)](#)

On June 17, 2022, the Director [ordered review](#) of the [Final Written Decision](#) in IPR2020-01234. The Nested Bean IPR involves a multiple dependent claiming issue. Specifically, the PTAB’s Final Written Decision found unpatentable several dependent claims that depend from “claim 1 or 2.” Notably, the PTAB’s Final Written Decision found claim 2 unpatentable, but did not find claim 1 unpatentable. The Director found review appropriate to address whether the PTAB legally erred when it found the dependent claims unpatentable if either version of the dependent claims (the version depending from claim 1 or the version depending from claim 2) is described by the prior art. Because the IPR presented a unique legal issue, the Director authorized additional briefing. Patent Owner argued 35 U.S.C. § 112(5) requires the Board to separately consider the patentability of alternative dependencies of a multiple dependent claim. Petitioner argued that if the Board finds any version of a multiple dependent claim unpatentable over the prior art, then the Board should find all versions of a multiple dependent claim unpatentable.

On February 24, 2023, the Director adopted Patent Owner’s interpretation of 35 U.S.C. § 112(5) to “require that the Board consider separately the limitations of each claim incorporated by reference into the multiple dependent claim.” Moreover, the Director found the Board had erred in its analysis of multiple dependent claims 3-16 by failing to separately consider whether those claims were patentable by their dependency upon patentable claim 1.

The Director modified the Final Written Decision accordingly.

PGR Involving Enablement: *Boehringer Ingelheim Animal Health USA Inc. v. Kansas State University Research Foundation*, PGR2022-00021

[Boehringer Ingelheim Animal Health USA Inc. v. Kansas State University Research Foundation, PGR2022-00021, Paper 11 \(PTAB Feb. 24, 2023\)](#)

On August 12, 2022, the Director [sua sponte initiated review](#) of the PTAB's [Institution Decision](#) in PGR2022-00021. The *Boehringer* PGR raises written description, enablement, and obviousness challenges. Regarding the written description and enablement challenges, the PTAB held under the *Advanced Bionics* framework that the asserted arguments were substantially the same as those previously presented to the Office and Petitioner failed to demonstrate that the Office erred. The Director found review to be appropriate, but did not identify the specific issues for Director Review.

On February 24, 2023, the Director vacated and remanded the proceeding to the Board to provide its rationale regarding “whether § 325(d) applies to . . . (enablement) based upon the written description arguments presented during original prosecution.” The Director specifically held that, in exercising discretion under 35 U.S.C. § 325(d), to the extent the Board found that Petitioner’s enablement challenge constituted the same or substantially the same arguments previously presented to the Office on written description, “the Board must set forth its rationale in sufficient detail to inform the parties and the public and allow for review.” Moreover, the Director stressed that while written description and enablement often rise and fall together, the written description and enablement requirements involve different considerations, such that an argument made regarding one requirement does not necessarily equate to an argument made regarding the other.

The Board was ordered to make a determination within one month, and on March 22, 2023, [the Board did so](#), exercising § 325(d) discretion as to the written description ground and finding the enablement and obviousness grounds did not meet the institution standard on the merits.

Federal Circuit Precedential Decision: Sets Bar for ‘Motivation-to-Combine’ Challenges — Motivation To Combine Only Requires Showing That the Prior Art Addressed the Issue, Not That It Improved on the Issue

In [Intel Corporation v. Pakt XPP Schweiz AG, No. 22-1037 \(Fed. Cir. March 13, 2023\)](#), the U.S. Court of Appeals for the Federal Circuit reversed and remanded the Board’s finding that Intel failed to show that the challenged claim of PACT’s patent was unpatentable as obvious in light of two prior art references and concluded that “if there’s a known technique to address a known problem using ‘prior art elements according to their established functions,’ then there is a motivation to combine.”

Before the Board, Intel had asserted that a person of ordinary skill in the art would have been motivated to combine the two prior art references — Kabemoto and Bauman — because they related to the same field and addressed the same problem. Intel then reasoned that a person of ordinary skill in the art would have used Bauman’s technique to address the same problem in Kabemoto. The Board rejected Intel’s known technique argument concluding that if Kabemoto already addressed the known problem through the use of the known technique similar to that of Bauman’s, then a person of ordinary skill in the art would not regard Bauman’s technique as an obvious improvement to Kabemoto’s.

On appeal, the Federal Circuit found that there was motivation to combine and that because “Kabemoto and Bauman address the same problem and that Bauman’s cache was a known way to address that problem is precisely the reason that there’s a motivation to combine under KSR and our precedent.” The Federal Circuit concluded that it was “enough for Intel to show that there was a known problem [in the art, that Bauman’s [technique] helped address that issue, and that combining the teachings of Kabemoto and Bauman wasn’t beyond the skill of an ordinary artisan. Nothing more is required to show a motivation to combine under *KSR*.”

Events and Speaking Engagements

Highlights From Recent 2023 PTAB Bar Association Annual Conference (held March 8-10, 2023)

The annual PTAB bar association conference this year was one of the best yet! With many practitioners and APJs in attendance, the great sense of community was felt across all members of the PTAB Bar.

A highlight of the conference was a “fireside chat” with the Director of the USPTO, Kathi Vidal. Director Vidal provided insightful answers to pressing questions from the moderator and attendees. A few key takeaways from the Director’s remarks include: her support for initiatives that promote diversity in all areas of patent law practice; insight and information on the Director review process; and perspective on internal and external policy goals that have driven recent and forthcoming changes to practicing before the USPTO.

The conference’s very full schedule of sessions provided insight into the PTAB and best practices for proceedings before the PTAB. Interesting sessions to note included:

1. “Hot Topics Before the PTAB” where a panel, including Arnold & Porter’s Jessica Kaiser, provided their thoughts on and strategies for the PTAB.
2. “Ethics Before the PTAB” where the panel presented some very interesting ethical issues before the PTAB.

Additionally, the PTAB Bar Association Women’s Committee had a “Walk for STEM” event followed by a breakfast to fundraise for Camp Invention. Participants enjoyed a great time connecting with each other while contributing to a good cause. Arnold & Porter’s Jessica Kaiser is a co-chair and Alice Ho is a vice-chair of this committee.

Upcoming Events and Speaking Engagements

Upcoming Arnold & Porter Webinar

Arnold & Porter’s Jessica Kaiser, Patrick Hall, Betsy Long, and Estayvaine Bragg will be presenting on “Patent Disputes: Building a Solid Foundation Without Breaking the Bank.” The presentation will discuss early strategies companies can put into place when facing patents asserted against them, including ways to minimize litigation spend.

The webinar will be on April 12 at noon-1 p.m. EDT. More details and registration information can be found [here](#).

Upcoming Virtual Patent Gateway Panel Discussion

Arnold & Porter partner Jessica Kaiser will be part of a panel discussing “PTAB Motion to Amend: A Niche Within a Niche.” The panel discussion will focus on the trends and lessons learned by PTAB practitioners over the years and aims to provide practice tips for both patent owners and petitioners dealing with Motions to Amend.

The panel discussion will be on April 18 at 1:00-2:15 p.m. EDT via Zoom. More details and registration information can be found [here](#).

Upcoming Patent Law Institute 2023: Conference on Critical Issues and Best Practices

Arnold & Porter partner Jessica Kaiser will be presenting on a panel with the focus: “A Look at PTAB Proceedings as We Enter Decade Two.” Specific panel topics include:

- Latest statistics on PTAB proceedings
- Rise and fall (or not) of Fintiv
- Procedural and caselaw changes impacting PTAB practices
- Tips and insights for practicing before the PTAB

The April 27-28 conference is in San Francisco and will be webcast live at www.pli.edu. More details and registration information can be found [here](#).

Upcoming 21st Annual Rocky Mountain Intellectual Property & Technology Law Institute

The Annual Rocky Mountain Intellectual Property & Technology Law Institute brings together prominent government officials and private practitioners to discuss hot topics across the various aspects of IP law. The conference starts with a day dedicated to IP fundamentals on May 31, and then proceeds to the two-day IP Institute on June 1-2. In the IP Institute, participants can choose among sessions in four tracks: Patents/Patent Litigation, Trademarks/Copyrights, Tech Transactions and Licensing, and In House.

For the Trademarks/Copyrights track, Arnold & Porter partner Evan Rothstein will be presenting on a panel on Copyright Updates, addressing recent developments in copyright law over the last year. This panel discussion will be on June 1 at 2:40-3:30 p.m. MDT.

For the Patents/Patent Litigation track, Arnold & Porter partner Jessica Kaiser will be presenting on a panel on “A Litigator’s View of Claim Drafting.” The panel discussion will focus on correlating claim breadth to damages, ensuring enablement, and the post-Alice need for computational granularity and will be on June 2 at 11:10 a.m.-12:00 p.m. MDT.

This conference will take place in Westminster, Colo. and via webcast. More details and registration information can be found [here](#).

Upcoming Federal Circuit Bar Association Bench and Bar Conference

The Federal Circuit Bar Association’s Bench and Bar Conference is celebrating its 25th anniversary this summer. This conference brings together judges on the Court of Appeals for the Federal Circuit with adjudicators whose decisions are appealed to the Federal Circuit, government policy makers, and top private practitioners to discuss important issues confronting the Federal Circuit community.

Arnold and Porter is an FCBA Leaders Circle Sponsor. During the Bench and Bar Conference, Arnold & Porter partner Abigail Struthers will be presenting on a panel on June 30, titled “Claim Construction — Do We Need Phillips 2.0?” The next day (July 1), Arnold & Porter partner Jessica Kaiser will be moderating the PTAB panel.

The June 28-July 1 conference is at the Broadmoor in Colorado Springs. More details and registration information can be found [here](#).

Questions/Comments?

Contact a member of our Editorial Committee



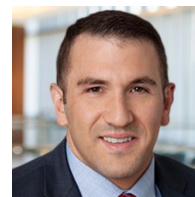
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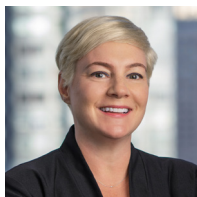
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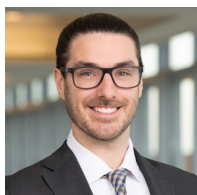
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