

Trends, Developments, and Issues in PTAB Proceedings: Practical Tips and Strategies to Avoid Pitfalls

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Michael assists biotech and pharmaceutical companies with patent litigation, portfolio management, patent prosecution and patent licenses. He also helps clients with all aspects of patent monetization or acquisition, including due diligence, strategy development, negotiation, drafting and execution of agreements.

His clients are innovator companies whose products include technologies related to antibodies, vaccines, pharmaceuticals, chemicals, nutrition and medical devices. He is experienced in litigation under the Hatch-Waxman Act (ANDA) as well as the Biologics Price Competition and Innovation Act (BPCIA).

Michael has extensive experience in inter partes proceedings before the Trademark Trial and Appeal Board and has represented clients in U.S. district courts, before the International Trade Commission and in appeals before the United States Court of Appeals for the Federal Circuit.



Brief Speaker Bio:



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In any America Invents Act (AIA) trial proceeding, the Patent Trial & Appeal Board (PTAB) has been consistent in holding that assignor estoppel is subject to abrogation by the AIA statutes. Affirming this stand, the Federal Circuit held in *Arista Networks, Inc. v. Cisco Systems, Inc.* that assignor estoppel is not applicable in *inter partes* review (IPR) proceedings. However, other equitable defenses, such as judicial estoppel, can be considered and applied by PTAB so long as they do not contradict with AIA statutes.

Join PTAB trial expert, Mr. Michael O'Shaughnessy in a LIVE Webcast as he provides an in-depth discussion of the fundamentals as well as updates on how PTAB treats equitable defenses. Mr. O'Shaughnessy will also identify significant risk issues and challenges surrounding this topic and provide best practices in leveraging equitable defenses before the PTAB.

Key issues covered in this course are:

- America Invents Act
- Equitable Defenses?
- Assignor Estoppel at the PTAB
- Judicial Estoppel
- Patent Owner Estoppel

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America Invents Act

Goal:

- Streamline patent system
- Reduce Litigation
- Eliminate bad patents

Result:

- Multiple Proceedings
- Running in parallel



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Equitable defenses?

- Assignor Estoppel
- Judicial Estoppel
- Patent Owner Estoppel



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Assignor Estoppel

Shamrock Technologies, Inc. v. Medical Sterilization, Inc., 903 F.2d 789 (Fed. Cir. 1990)

- Luniewski, employed by Shamrock, invented apparatus and method for processing PTFE.
- Required to assign to employer.
- Left Shamrock and joins Medical Sterilization, where they began making PTFE by Luniewski's method.
- Shamrock sued for infringement.
- Medical Sterilization counterclaimed that patents (invented by Luniewski) were invalid

“[T]he doctrine of assignor estoppel ... precludes a patent assignor and those in privity with the assignor from contending that the patent is a nullity.”



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Assignor Estoppel at the PTAB

***Athena Automation Ltd. v. Husky Injection Molding Syt. Ltd.*, Case IPR2013-00290 (PTAB Oct. 25, 2013)**

- "[W]e are not persuaded that assignor estoppel, an equitable doctrine, provides an exception to the statutory mandate that any person who is not the owner of a patent may file a petition for an *inter partes* review."

***Oticon Medical AB v. Cochlear Bone Anchored Solutions AB*, Case IPR2017-01018 (PTAB Aug. 21, 2018)**

- "In a precedential opinion, binding on this panel [Athena], the Board rejected the applicability of the doctrine of assignor estoppel to *inter partes* review proceedings."

***Arista Networks, Inc. v. Cisco Systems, Inc.*, 750 Fed. Appx. 1000 (Fed. Cir. 2018) appealed from Case No. 2016-00303 (PTAB May 25, 2017)**

- Under the AIA [35 USC § 311(a)], "a person *who is not the owner of a patent* may file with the Office a petition to institute an *inter partes* review of the patent. "

We are cognizant of the specter of forum shopping, but we agree with the Board's prior statement that, "Congress has demonstrated that it will provide expressly for the application of equitable defenses when it so desires." *Redline*, Paper 40, slip op. at 4 (PTAB Oct. 1, 2013) (citing *Intel Corp. v. Int'l Trade Comm'n*, 946 F.2d 821, 836-38 (Fed. Cir. 1991)). Accordingly, we decline to apply assignor estoppel to this *inter partes* review proceeding.



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Concerns about Assignor Estoppel

Forum Shopping



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Judicial Estoppel

35 U.S.C 301(a)(2):

“statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of a particular patent” may be submitted to the office at any time. And, that this information be utilized to “determine the proper meaning of a patent claim in a proceeding that is ordered or instituted pursuant to section 304, 314, or 324.”



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Judicial Estoppel

ARISTOCRAT TECHNOLOGIES, INC. v. IGT, Case IPR 2016-00252 ([PTAB Feb. 24, 2016](#))

- The doctrine of judicial estoppel prohibits Aristocrat from engaging in this kind of double-speak. Judicial estoppel "prevents a party from prevailing in one phase of a case on an argument and then relying on a contradictory argument to prevail in another phase." "Judicial estoppel applies just as much when one of the tribunals is an administrative agency as it does when both tribunals are courts."

Illumina, Inc. v. Columbia University, Case No. IPR 2018-00787, 2018 Pat. App. LEXIS 9246 (PTAB Oct. 26, 2018)

- Illumina's position in this proceeding is clearly inconsistent with its prior positions; Illumina persuaded the Examiner during the ['465](#) reexamination to accept its position that Tsien did not disclose the allyl capping group, Ex. 2065 at 101 (Examiner concluding that "Tsien et al. do not teach explicitly a [nucleotide] with a 3'-allyl protective group"); and allowing Illumina to maintain its new position in this proceeding would impose an unfair detriment on Columbia.



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Risks Relating to Judicial Estoppel

- Discovery Requirements
- Prosecution Considerations
- Litigation Considerations



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Overcoming Judicial Estoppel

Establish that positions are not directly contradictory

Distinguish claims

Distinguish record

John R. Wilson v. Gregory R. Martin, Patent Interference No. 106,060, 2017, Pat App.
LEXIS 11683 (PTAB March 25, 2018)



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Patent Owner Estoppel

Cancellation of non-distinct claims may preclude arguments

37 CFR 42.73(d)(3)(i)

(3) Patent applicant or owner. A patent applicant or owner is precluded from taking action inconsistent with the adverse judgment, including obtaining in any patent:

(i) A claim that is not patentably distinct from a finally refused or canceled claim

Illumina, Inc. v. Columbia University, Case No. IPR 2018-00787, 2018 Pat. App. LEXIS 9246 (PTAB Oct. 26, 2018)

- The challenged claim was specifically drafted to be narrower than the claims previously found unpatentable. Illumina argues that the challenged claim is the same as cancelled claim 16 of the ['869 patent](#) (IPR2018-00291, -00385) or cancelled claim 21 of the ['869 patent](#) (IPR2018-00318, -00322). But the challenged claim has many features not present in cancelled claims 16 or 21 of the ['869 patent](#).

SDI Techs., Inc. v. Bose Corp., Case No. IPR 2014-00343, [2015 Pat. App. LEXIS 6154 \(PTAB June 11, 2015\)](#)

- Nevertheless, we agree with Patent Owner that Rule 42.73(d)(3) does not apply in this case, at least because Patent Owner's appeal rights in IPR-350 have not been exhausted. As Patent Owner argues, the Patent Office has explained in its discussion accompanying the Final Rule that Rule 42.73(d)(3) applies estoppel against a party whose claim has been cancelled and not merely held unpatentable:



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Overall Conclusions

Privity does not equal preclusion

Be careful what you say. Anything you say can, and will, be held against you in a court of law



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Know

Q&A



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