

# The Federal Circuit on PTAB Patent Trials: An Overview of Recent Decisions

12th Annual Advanced Patent Law Institute

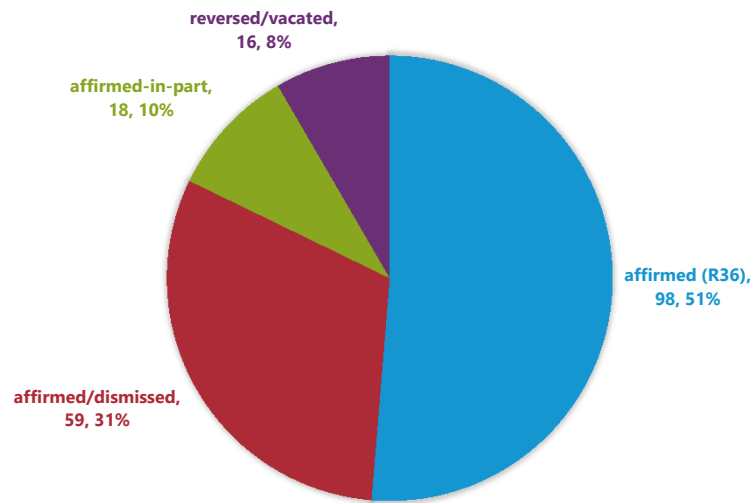
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## Statistics (as of Mar. 8, 2017)

- One Supreme Court decision (*Cuozzo*)
  - One grant-vacate-remand (*Click-to-Call*)
  - Notable cert. denials:
    - *MCM Portfolio*, *Cooper 1 & 2*
    - *Ethicon v. Covidien*, *LifeScan v. Pharmatech*
- 202 Federal Circuit decisions
  - 11 mandamus decisions (100% denied)
  - 191 decisions in PTAB appeals/APA challenges

### 191 FEDERAL CIRCUIT DECISIONS



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### ***PPC Broadband, Inc. v. Corning Optical Communications RF, LLC***

- 815 F.3d 734
- In district court, nexus for commercial success evidence is presumed:
  - The patent owner must show that a product is “the invention disclosed and claimed in the patent.”
  - If so, courts presume that any commercial success is due to the patented invention.
  - This is true even if the product includes additional, unclaimed features.
- In ex parte PTAB cases, nexus is not presumed because the USPTO cannot gather evidence to support or refute the applicant’s/patent owner’s evidence.
- The presumption **does** apply in AIA trials, so the petitioner must rebut the patent owner’s evidence, as in the court.

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### ***Phigenix, Inc. v. ImmunoGen, Inc.***

- 845 F.3d 1168
- 35 U.S.C. § 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.”
  - No standing requirement to petition for or participate in an IPR.
- 35 U.S.C. § 319: “A party dissatisfied with” an IPR FWD “may appeal” to the Federal Circuit.
- But Article III imposes an “irreducible constitutional minimum” that must be met for the courts to have jurisdiction over a dispute.

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### **Standing Requirements**

- Injury in fact
  - Injury must be concrete and particularized
  - The harm must actually exist or be “imminent”
- The injury must be fairly traceable to the other party’s conduct
- A favorable judicial decision would likely redress the injury

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