

# IPR Practice Strategies Panel

Advanced Patent Law Institute: Austin, Texas  
November 5, 2020

Scott McKeown, Ropes & Gray LLP, Washington, DC  
Emily Whelan, WilmerHale, Boston, MA  
David OBrien, Haynes and Boone LLP, Austin, TX

## Drafting Petitions in view of Litigation

### Claim Construction

**Inconsistent Claim Construction Positions:** *Orthopediatrics Corp. v. K2M, Inc.*,  
*IPR2018-01547, Paper 9 (Feb. 22, 2019)*

#### Adopting Patent Owner's Construction May Be Inconsistent

- At district court, petitioner argued that a term was in means-plus-function form
- At PTAB, petitioner argued that the same term did not need construction and based its challenge on constructions urged by Patent Owner to the court
- PTAB denied institution
  - PTAB held that Petitioner bears the burden to offer its own constructions, and not merely rely on those proposed by Patent Owner
  - Petitioner should have provided a construction or explained why, contrary to its argument in the district court, the term does not invoke § 112, ¶ 6.

# Drafting Petitions in view of Litigation

## Status as Printed Publication

**Required showing in petition:** *Hulu LLC v. Sound View Innovations LLC*, Case IPR2018-01039 (PTAB Dec. 20, 2019) (designated precedential)

### Setting the standard to be applied at institution

- There is no presumption in favor of finding that a reference is a “printed publication”
- “At the institution stage, the petition must identify, with particularity, evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent and therefore that there is a reasonable likelihood that it qualifies as a printed publication.”
- Indicia such as copyright dates is unlikely to be sufficient.

3

# Drafting Petitions in view of Litigation

## Use of Applicant Admitted Prior Art

**Permissible Uses of AAPA in a petition:** *Binding guidance dated August 18, 2020*

### AAPA may not be the basis for the IPR

- “[A]dmissions by the applicant in the specification of the challenged patent standing alone cannot be used as the basis for instituting an IPR, under either § 102 or § 103.”
- “The generally-understood meaning of ‘basis’ supports reading § 311 (b) to require that at least one prior-art patent or printed publication form the “foundation or starting point” of the IPR, but not to foreclose consideration of other pertinent patentability information.”

4

# Drafting Petitions in view of Litigation

## Use of Applicant Admitted Prior Art

**Permissible Uses of AAPA in a petition:** *Binding guidance dated August 18, 2020*

### Permissible uses

- “Permissible uses of general knowledge of one having ordinary skill under § 103 include
  - (1) supplying missing claim limitations that were generally known in the art prior to the invention (for pre-AIA patents) or the effective filing date of the claimed invention (for post-AIA patents);
  - (2) supporting a motivation to combine particular disclosures; or
  - (3) demonstrating the knowledge of the ordinarily-skilled artisan at the time of the invention (for pre-AIA patents) or the effective filing date of the claimed invention (for post-AIA patents) for any other purpose related to patentability.”

5

5

## Discussion – Drafting Petitions in View of Litigation

6

6

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](https://utcle.org/elibrary)

Title search: IPR Practice Strategies Panel

Also available as part of the eCourse

[2020 Advanced Patent Law \(Austin\) eConference](#)

First appeared as part of the conference materials for the  
25<sup>th</sup> Annual Advanced Patent Law Institute session  
"PTAB Practice Strategies"