

## The Changing Landscape of AIA Proceedings



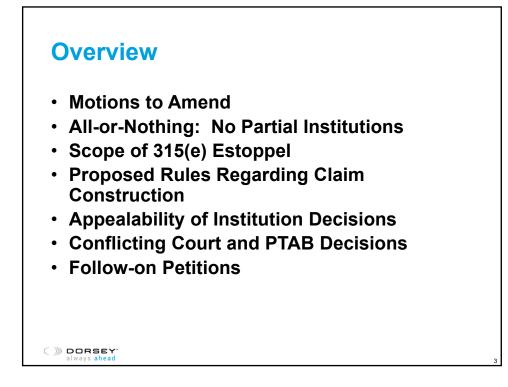
Gina Cornelio Partner, Patent

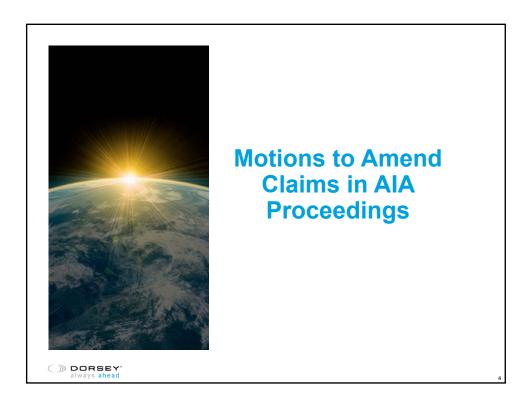


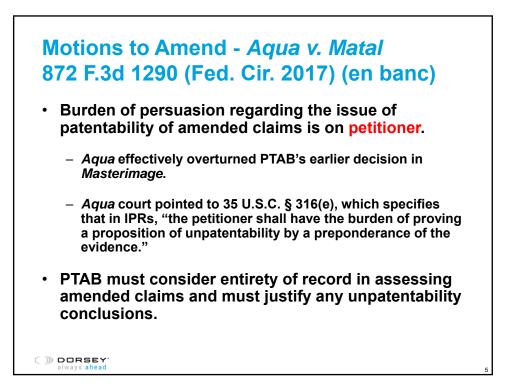
Clint Conner Partner, IP Litigation

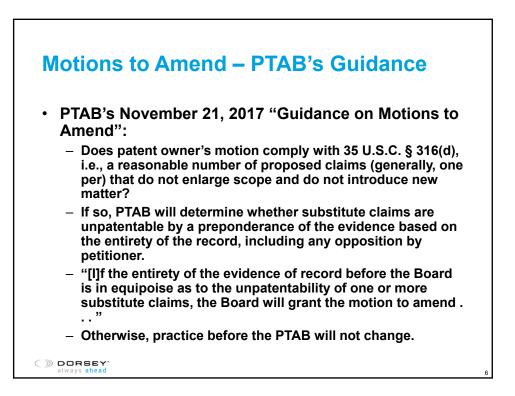
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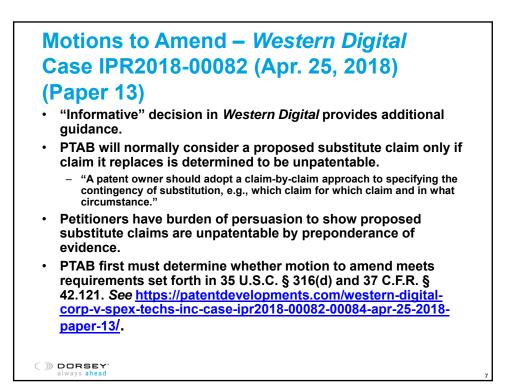
C DORSEY always ahead

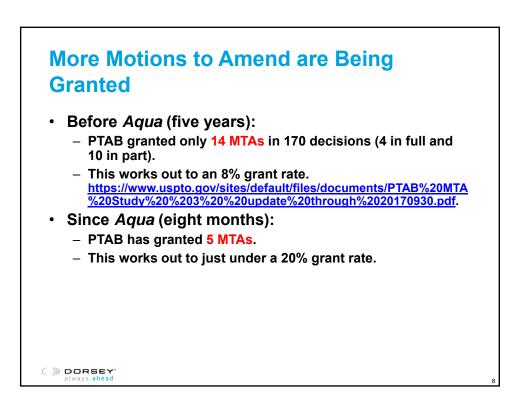


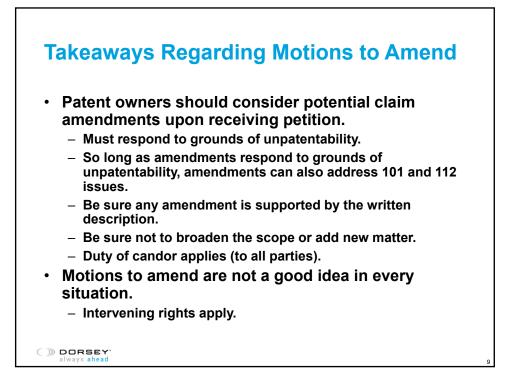


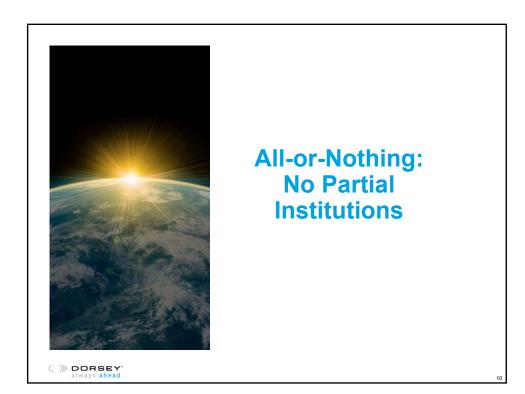


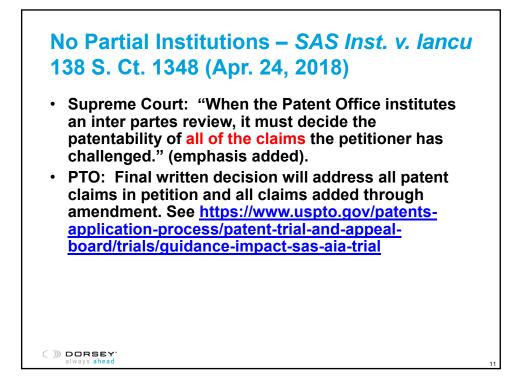


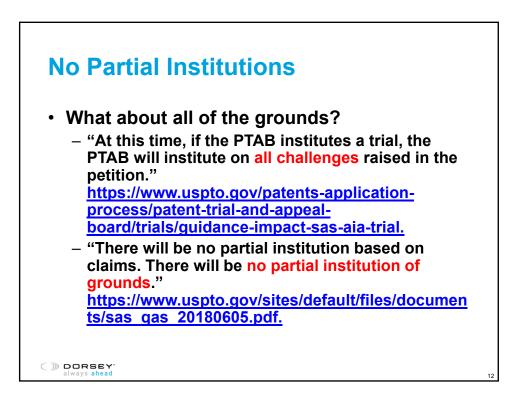


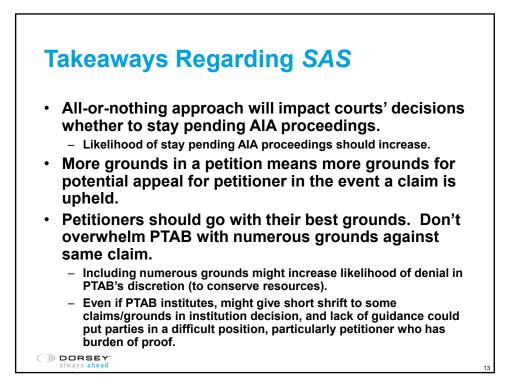


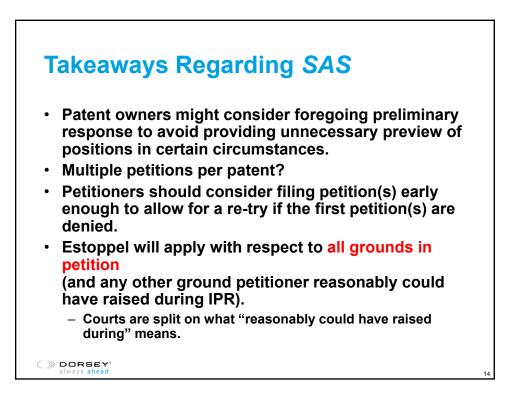




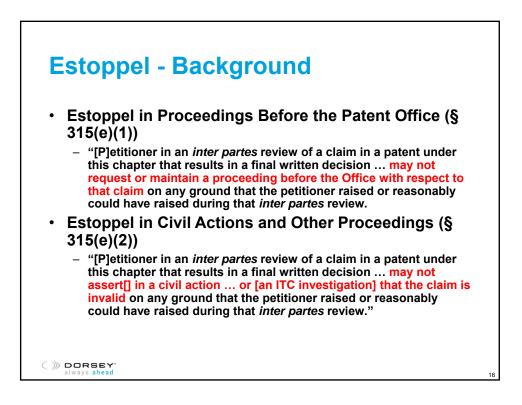


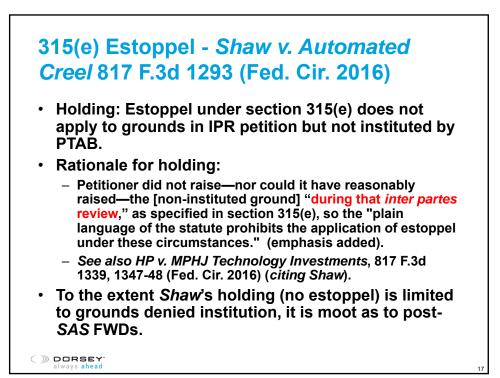


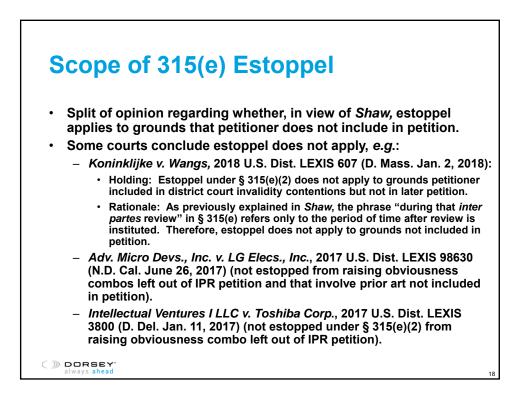


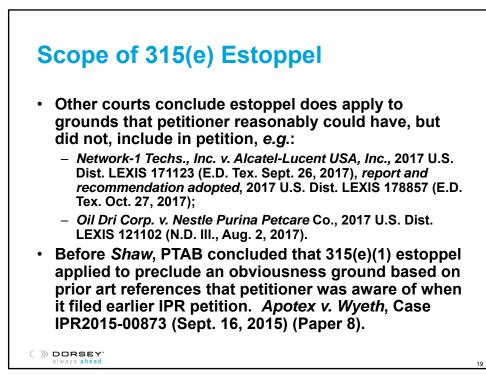


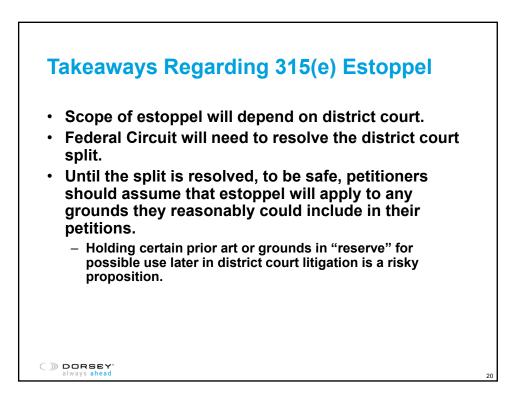




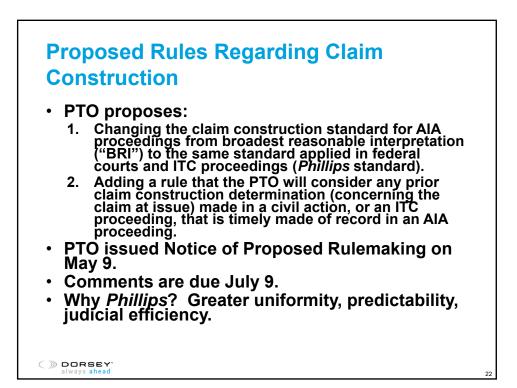


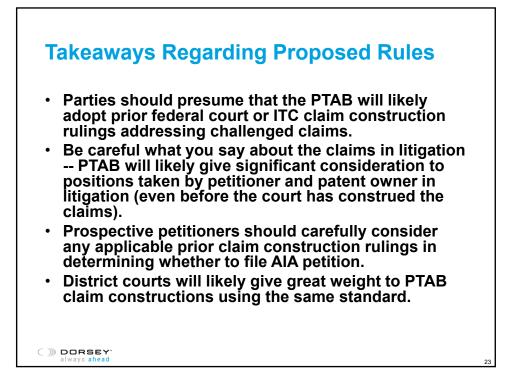


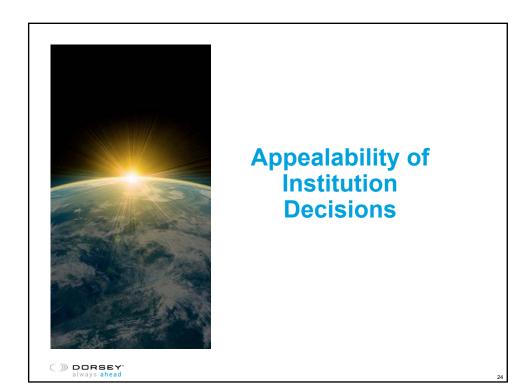


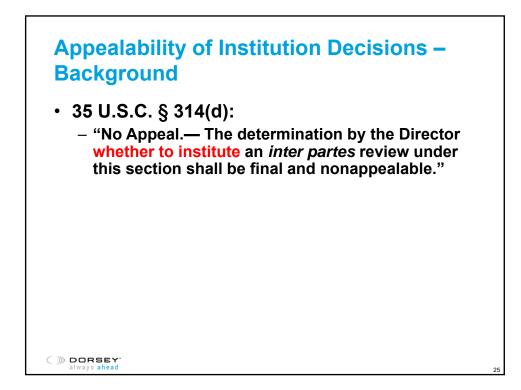


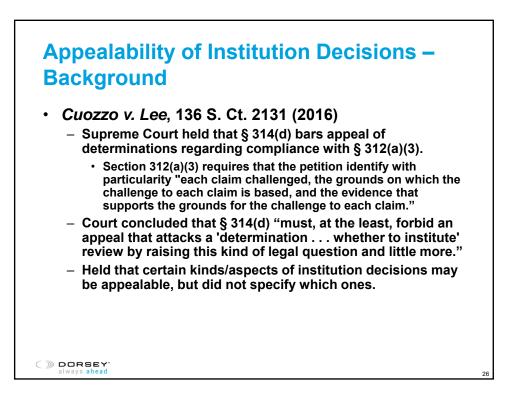








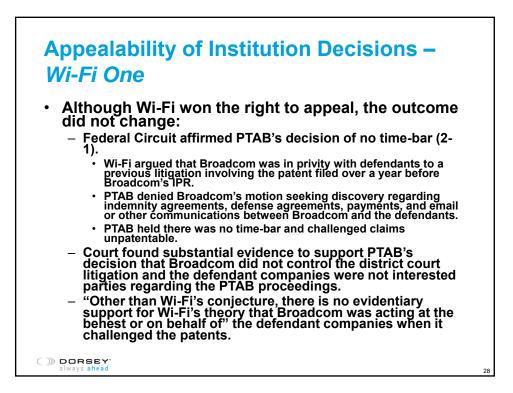


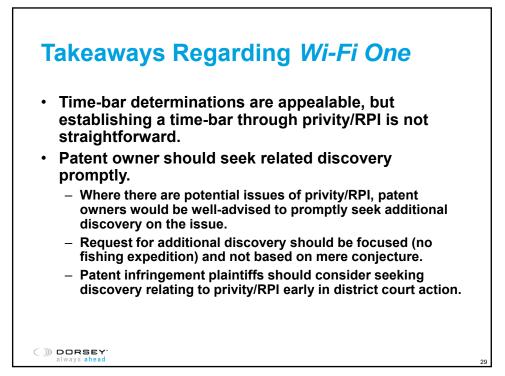


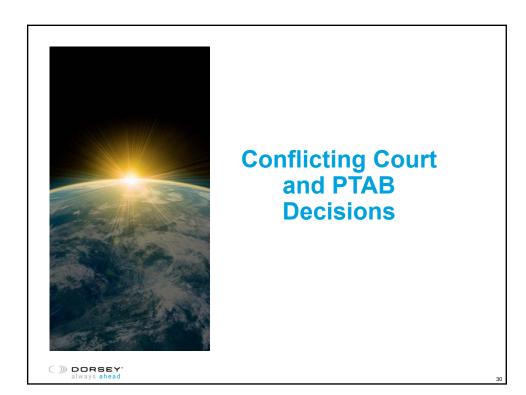


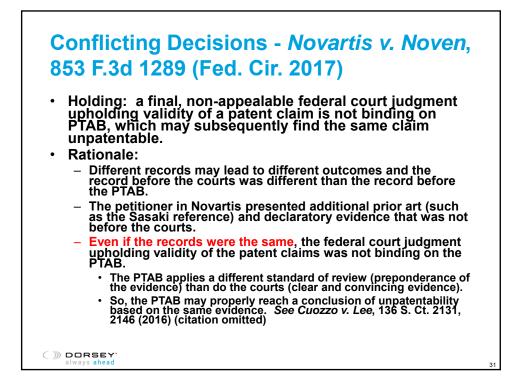
- Holding (en banc): time-bar determinations under § 315(b) in an institution decision are appealable
  - Overruling the contrary conclusion in Achates v. Apple, 803
    F.3d 652 (Fed. Cir. 2015).
- Rationale for holding:
  - To overcome strong presumption in favor of judicial review of agency actions, Congress must clearly and convincingly indicate intent to prohibit review.
  - No clear, convincing indication of intent to bar appeal of such rulings.
  - Natural reading of § 314(d) limits its application to determinations whether a petition demonstrates a reasonable likelihood that petitioner would prevail with respect to at least 1 claim.
  - A time-bar determination is not directed to substantive merits.

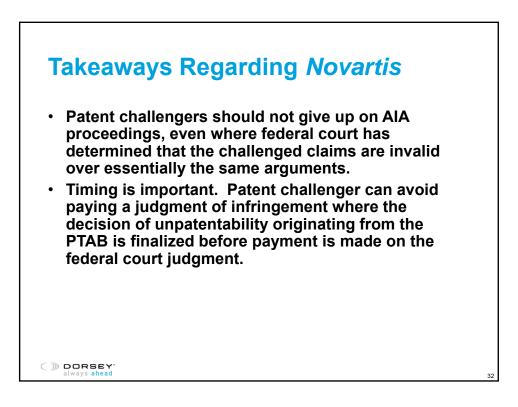
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## Follow-on Petitions - General Plastic v. Canon Case IPR2016-01357 thru -01361 (Sept. 9, 2017)

- PTAB has broad discretion to deny "follow-on" petitions under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a).
- Expanded panel held that when determining whether to institute follow-on petitions, the PTAB should consider the seven NVIDIA factors.
  - whether same petitioner previously filed a petition directed to same patent claims;
    whether at time of filing first petition petitioner knew of the prior art asserted in the second petition or should have known of it;
  - whether at time of filing of second petition petitioner already received patent owner's preliminary response to first petition or received PTAB's decision on whether to institute review of first petition;
  - length of time that elapsed between time petitioner learned of the prior art asserted in second petition and filing of second petition;
  - whether petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to same claims of same patent;
  - finite resources of PTAB; and
  - the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after date on which the Director notices institution of review.

