

**Patent Trial and Appeal Board
(PTAB) 2018 Update**
美国专利审理和上诉委员会2018
最新动态

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Agenda/纲要

- Introduction to PTAB/专利审判和上诉委员会(PTAB)简介
- Reasons for choosing PTAB/选择 PTAB的理由
- Latest developments in PTAB/ PTAB最新发展
 - Burden of proof by *Aqua Products* (举证责任)
 - Specification by *Smith International* (对权利要求的解释)
 - PTAB to adopt Philips Standard (解释权利要求的新标准)
 - Legal burden faced by *Phigenix* (在联邦法院的上诉资格)
- Summary (总结)
- Other U.S. cases law development (其他美国专利法案例)

PTAB/专利审判和上诉委员会



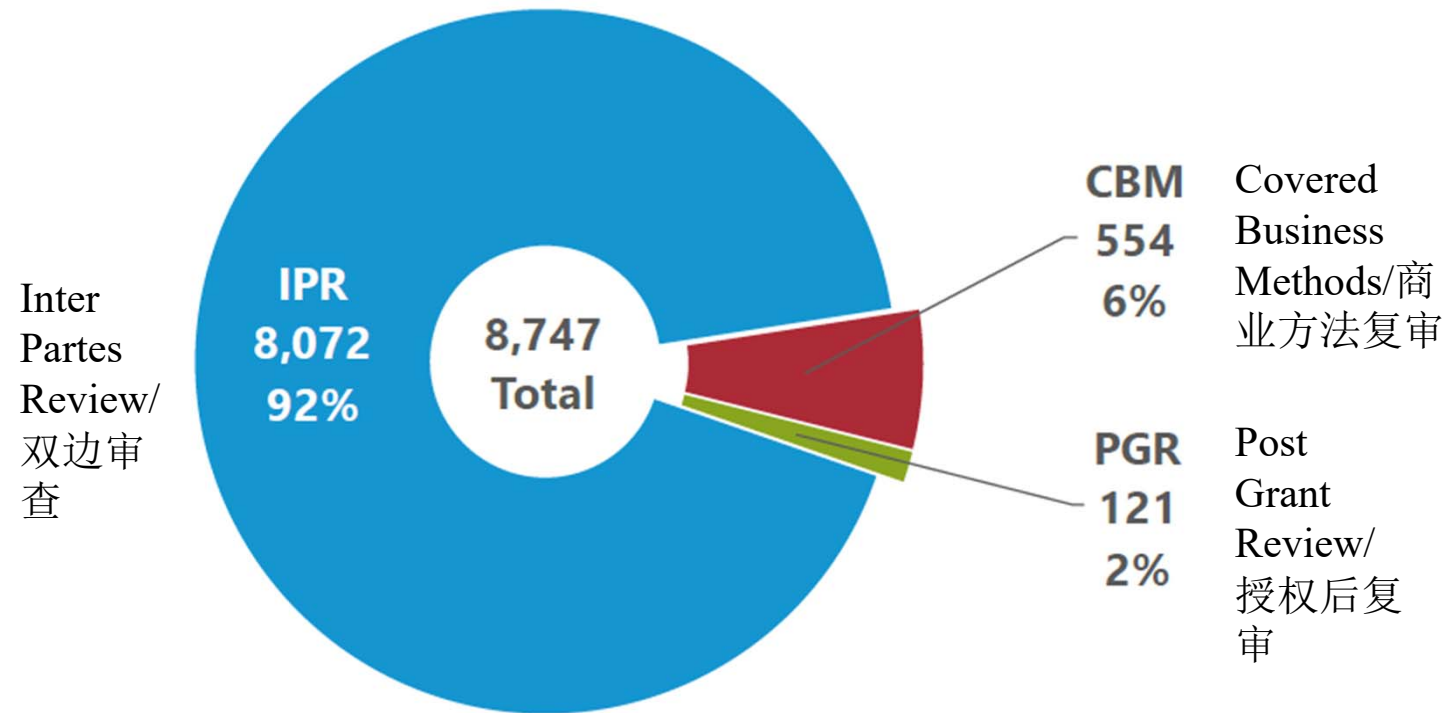
- Under USPTO/隶属于美国专利商标局
- Created on September 16, 2012 /于2012年9月16日成立
- PTAB is a federal tribunal/PTAB是一个联邦行政法庭

Reasons for choosing PTAB/选择PTAB的原因

- Cost-effective for validity challenge /挑战专利有效性的经济手段
 - District court: Stay the case, pending adjudication by PTAB./ 地方法院将搁置案件，等待PTAB的裁决
 - Patent invalid (by PTAB), alleged infringer off the hook / PTAB如发现该专利无效，地区法院将会撤销侵权案
- Within 12 months vs. 36 months + /12个月内审结 vs. 三年以上
- \$300K - \$500K vs. \$Millions + /30万美元至50万美元 vs. 数百万美元

Petitions by Trial Type 依据审理类型分类

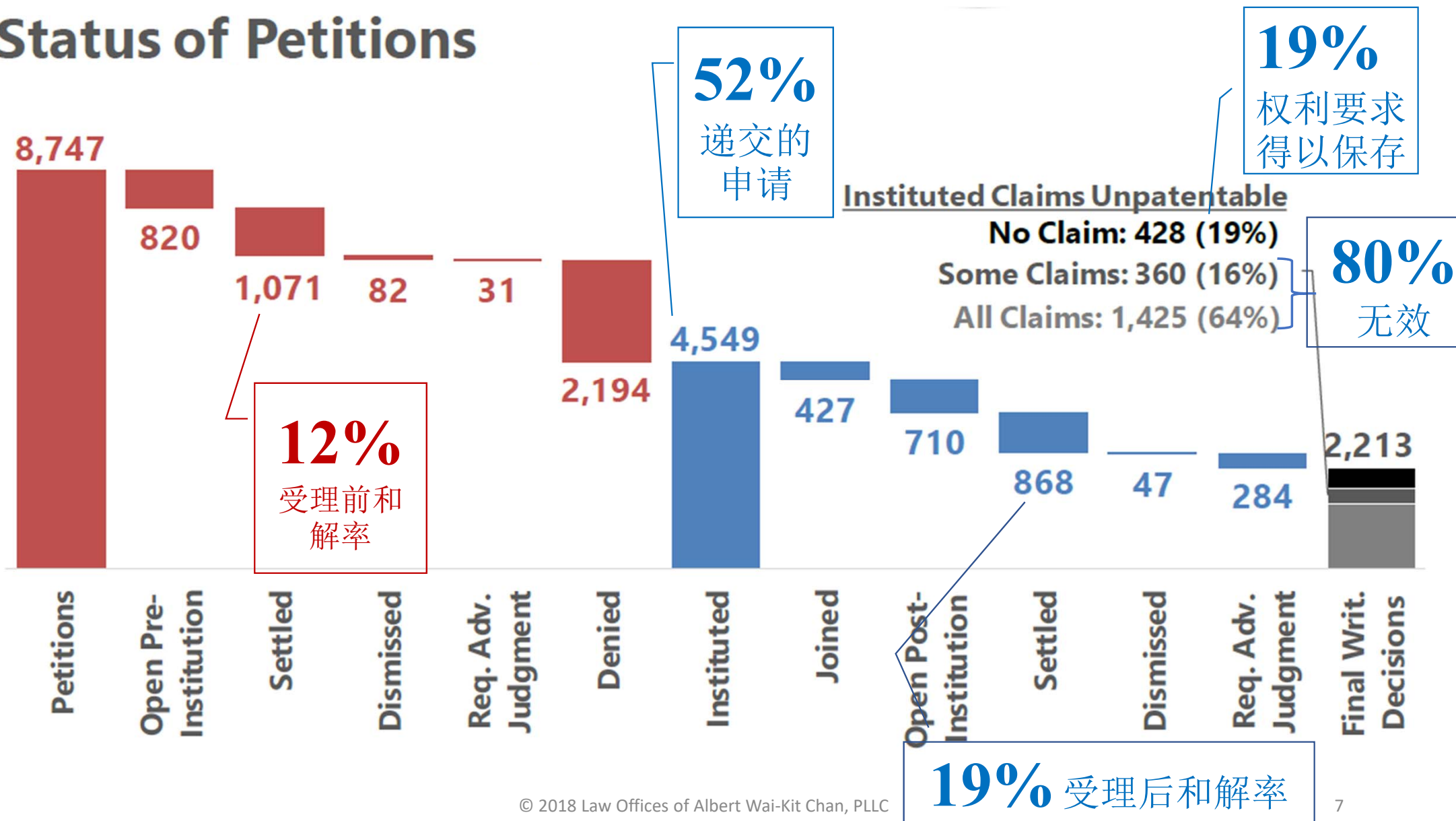
(All Time: 9/16/12 to 6/30/18)



Trial types include Inter Partes Review (IPR), Post Grant Review (PGR), and Covered Business Method (CBM).



Status of Petitions

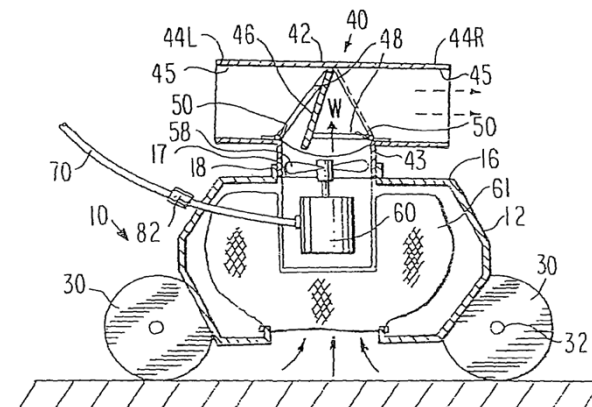


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Credit: USPTO, Trial Statistics IPR, PGR, CBM Patent Trial and Appeal Board June 2018

1. *Aqua Prods. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017)

- Petitioner/请求人: Zodiac Pool Systems, Inc.
- Patent Owner/ 专利权人 : Aqua Products, Inc.
- U.S. Patent/ 美国专利 No. 8,273,183: Claims 1-14, 16, and 19-21/权利要求1-14, 16和19-21项



Inter Partes Review (IPR)/双边审查

- Aqua: Replace claims 1, 8 and 20 with substitute claims 22-24_35 U.S.C. § 316(d)/Aqua以美国专利法第316款 (d) 条为依据替代权利要求
- The Board denied/ PTAB 否决Aqua的动议



1. Issue under Review/ 上诉争议焦点

1. Section 316(d)(1) provides that a patent holder in an IPR “may file 1 motion to amend the patent,” either by cancelling any challenged patent claim or by “propos[ing] substitute claims.” /316款(d)条规定，双边审查中的专利权人「可提出动议，通过取消任何受质疑的权利要求或『提出替代权利要求』的方式，修改专利」。
2. Section 316(e) provides that “[i]n an inter partes review...the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”/316款(e)条规定，「在双边审查中.....请求人有义务通过优势证据证明权利要求不具专利性。」

1. Which party is responsible for proving the (un)patentability?/ 哪方对权利要求的可专利性具有举证责任?

Aqua petitioned for *en banc* review of the panel's decision. /Aqua 请求全席复审三人庭的决定。

- a) May PTO require the patent owner to bear the burden of proving patentability of the amended claims? /专利局是否可要求专利人承担证明修改后权利要求具有可专利性的举证责任?
- b) May the Board *sua sponte* raise patentability challenges to such a claim if petitioner does not challenge the patentability of a proposed amended claim, or the Board thinks the challenge is inadequate? /PTAB本身是否有权，在请求人未质疑，或其认为请求人质疑不足时，主动质疑该修改后权利要求的可专利性?

1. CAFC Decision/ CAFC判决

- 6-5 *en banc* found Section 316(e) requires the petitioner to prove all unpatentability, including for amended claims. /CAFC全席法官6比5认为, 316条(e)款明确要求请求人证明任何权利要求不可专利性的主张, 包括修改后的权利要求
- In the absence of anything, the majority held that PTO may not place that burden on the patentee. /多数法官认为, 在没有任何依据的情况下, 美国专利局不应将举证责任强加给专利权人
- Majority declined to answer whether the Board may raise patentability challenges *sua sponte*. /多数法官拒绝回答PTAB是否有权主动质疑修改后权利要求的可专利性

1. Takeaways/启示



Petitioner has the burden of proving unpatentability of amended claims requested by patent owner. /在PTAB审查中，请求人应承担证明修改后的权利要求不可专利性的举证责任。

2. *In re Smith Int'l, Inc.*, 871 F.3d 1375 (Fed. Cir. 2017)

- In re Smith International
- U.S. Patent/美国专利 No.6,732,817 :
A downhole drilling tool / 专利涉及钻井工具
- CAFC reversed PTAB's affirmance of an Examiner's rejections /
CAFC 推翻了 PTAB 的驳回意见

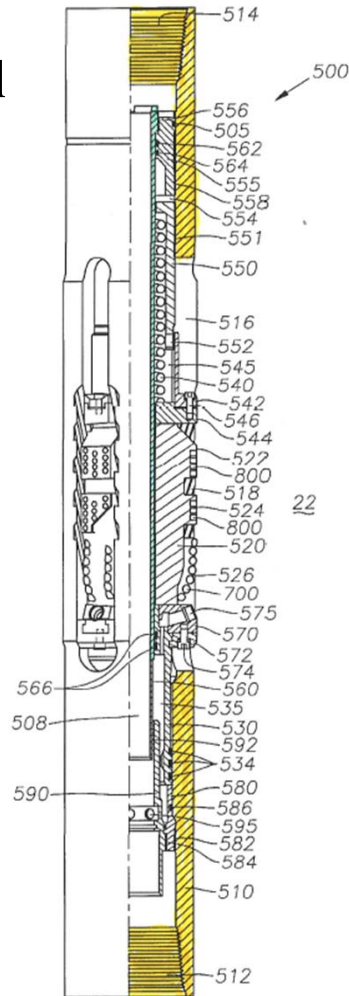
2. Examiner Rejection/驳回意见

- Each of the three independent claims in question required a tool arm that engaged a "body." /所讨论的三个独立权利要求中的每一个都需要一个与 “body”（机身/主体）接合的工具臂
- All of the claims are anticipated by, or obvious over WO 00/31371 (“Eddison”) which disclosed a downhole tool with radially extendable members. /所有权利要求的新颖性和创造性均被WO 00/31371（“Eddison”）摧毁，Eddison公开了一种具有径向延伸构件的井下工具。

2. Drawing Comparison/图样对比

In re Smith International US 6,732,817

The '817 patent describes that “one or more pocket recesses 516,” which “include angled channels 518,” are “formed in the body 510” to “provide a drive mechanism for the moveable tool arms 520 to move axially upwardly.”



Eddison WO 00/31371

Eddison discloses a drilling tool having a “mandrel 16” that “extends through the body 18” and “provides mounting for a cam sleeve 28,” which “cooperates with three extendable members in the form of cutters 30 mounted in respective body ports 32.”

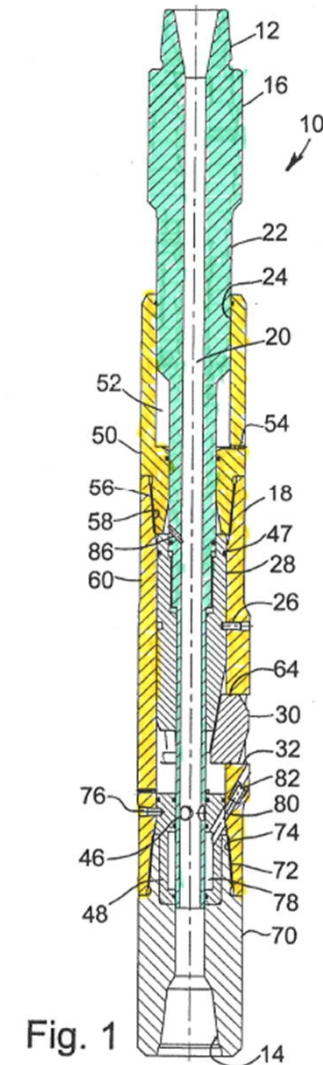


Fig. 1

2. Debate/争议

Examiner's interpretation/维持审查员的意见:

1. "Body" as a broad term that may encompass other components such as "mandrel" and "cam sleeve"/将“body”一词理解为一个广义的术语，即可以包括其他部件，如“心轴”和“凸轮套筒”
2. Only the term "body" is recited in the claims without further limiting features/权利要求中仅列出“body”一词而未对其作进一步限制
3. Specification neither defines the term "body" nor prohibits the examiner's broad reading of it/说明书中既没有定义“body”这一术语，也没有禁止审查员赋予其宽泛的解释

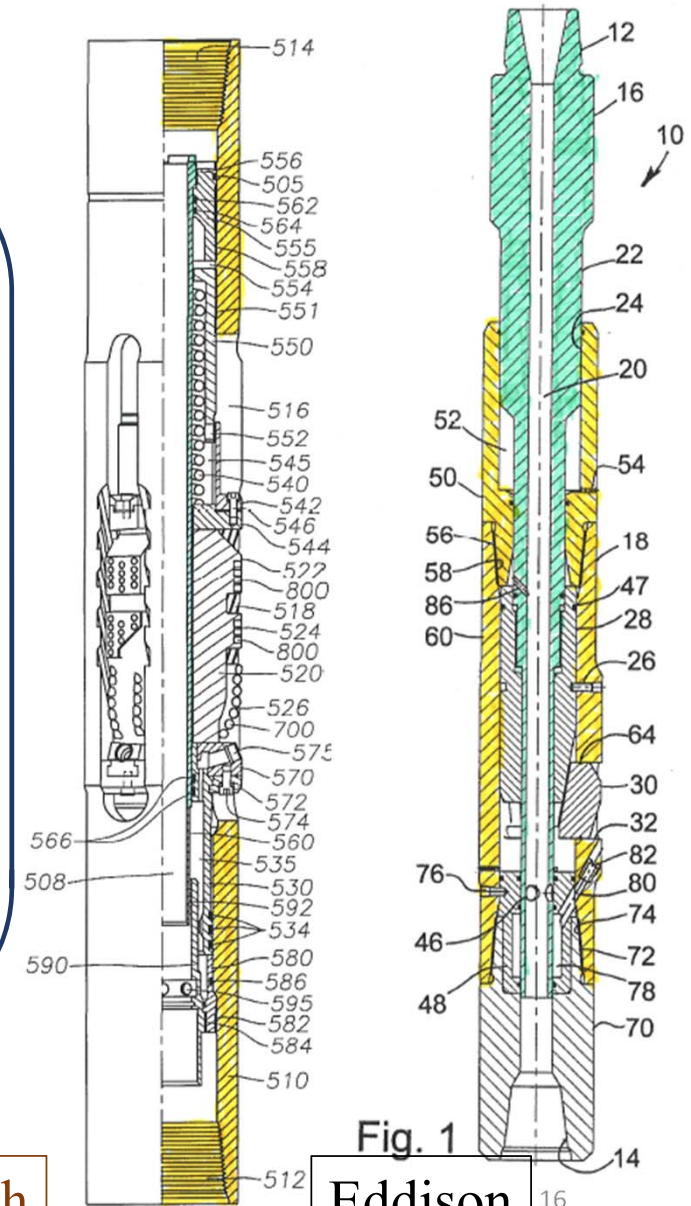


Fig. 1

Eddison

16

Smith Appeal/史密斯上诉

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Smith

PTAB

Appeal:

1

1. Whether the Examiner's interpretation was reasonable. / 审查员的解释是否合理
2. Including Eddison, used the term "*body*" to refer to a drilling tool's outer housing. / 包括Eddison在内的在先技术使用术语“body”来指钻具的外壳

Smith

3
There was nothing in the specification itself which would "proscribe the Examiner's construction/说明书本身没有任何内容禁止审查员的解释

1. Term "body" was used in some of the claims without any further elaboration 2
虽然“body”一词在没有进一步限定的情况下被使用在一些权利要求中
2. Remainder of the specification referred to the body as a component distinct from other components/但说明书始终将“body”作为单独部件，与其他部件区分开来。

1. Disagreed /不认同 4
2. Correct inquiry: whether such interpretation corresponds with what and how the inventor describes his invention in the specification/法院认为本质问题应是审查员的解释是否与发明人在说明书中描述其发明的内容和方式相一致。

PTAB

1

Argue:

Nothing in the specification would disallow the Examiner's interpretation, which would thus be "reasonable." /既然发明人未定义“body”，说明书中的任何内容亦未排除审查员作出的解释，因此该解释是“合理的”

PTAB

2

Following such reasoning: Any description falling short of an express definition in the specification → the broadest possible interpretation, rather than the broadest reasonable interpretation. /假若遵循这样的逻辑，任何说明书中没有明确定义的描述都将导致最宽泛的可能解释（broadest possible interpretation），而非最宽泛的合理解释（broadest reasonable interpretation）

CAFC reversed Board's decision/CAFC推翻了PTAB的决定

CAFC



2. Takeaways/启示

- 1) ER must consider whether the term was used in the same sense as being used in the spec./审查员必须考虑术语是否与说明书中使用的术语具有相同的意义
- 2) Draft spec carefully/ 仔细准备说明书
- 3) Be consistent/ 保持一致
- 4) Number key terms/ 对关键术语进行编号
- 5) Don't use same term of different meanings/不要赋予相同的术语不同的含义
- 6) Mind translation/注意翻译造成的混淆

3. PTAB to adopt Philips Standard/ PTAB将采用菲利普斯标准

May 8, 2018

- USPTO proposed to change PTAB’s claim construction standards from the **Broadest Reasonable Interpretation (BRI)** to District court’s **Phillips Standard**. / 美国专利商标局提议修改其规则，将PTAB的权利要求解释标准从“最宽泛的合理解释”改为地区法院的现行“菲利普斯标准”
- Claims are constructed: intrinsic evidence e.g. the claim language, specification and prosecution history. / 对于权利要求的解释: 应基于内部证据，如权利要求的语言、说明书和专利申请记录等。

3. BRI VS Phillips Standard/标准比较

Broadest Reason Interpretation

- A claim term is given its broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.”/权利要求术语为“可被本领域普通技术人员根据说明书解读”而赋予的最广泛的合理解释

Phillips Standard

- A claim term is given the “ordinary and customary meaning” it would have to “a person of ordinary skill in the art ... at the time of the invention.” / 权利要求术语被赋予“在本发明产生时本领域普通技术人员.....”所知晓的”普通的和习惯意义”

3. CAFC's Explanation/ CAFC的解释

1. CAFC: “broadest reasonable interpretation of a claim term may be the same as or broader than the construction of a term under the Phillips standard. But it cannot be narrower.” / CAFC: “针对一个权利要求的术语的最广泛的合理解释可能与其在菲利普斯准则下的解释一样或者更为广泛，但其范围绝不可能更小”
2. Accordingly, in theory, the **BRI standard can be boarder**/因此，从理论上，同样的权利要求在BRI标准下的覆盖范围更广。

3. **Most cases/大多数情况**

BRI standard and Philips standard → **Same** result /BRI标准和菲利普斯标准→相同的结果

1. A claim could be found invalid in an IPR based upon a claim construction which patentee cannot apply in a district court. /权利要求在双边审查（IPR）中根据BRI准则可能被裁定无效，而专利权人不能在地区法院使用同样的标准。
2. The proposed harmonization is expected to close such gap. /专利局的提议为消除两者之间差异。



3. Implications/我们的解读

1. Harder to invalidate a patent claim./无效专利的难度增加
2. District courts: stay the infringement proceeding until PTAB proceeding is over./地区法院: 搁置侵权诉讼, 直至PTAB诉讼程序结束
3. PTAB's claim construction is more likely binding in district courts./ PTAB对权利要求的解释更可能在随后的地区法院诉讼中有约束力

The cementation period has ended by July 8, 2018. Stay tuned./
评论期已于2018年7月8日结束。敬请关注。

4. *Phigenix, Inc. v. ImmunoGen, Inc.*, 845 F.3d 1168 (Fed. Cir. 2017)

- To seek judicial review of a PTAB decision, a party must establish so-called Article III standing, which means it **must** have **suffered an injury in fact**. /对PTAB裁决进行司法审查，请求人必须建立美国宪法第三款下的上诉资格，即请求人因为裁决遭受实际伤害。
- Injury must be concrete and particularized: **actual or imminent**, not conjectural or hypothetical. /这种伤害必须是翔实的和具体，必须是实际的或迫在眉睫的，而非推测的或假设的。

4. Inter Partes Review (IPR) 双边审查

- Petitioner/请求人: Phigenix
- Patent Owner/专利权人: ImmunoGen
- US Patent/美国专利No. 8,337,856: Claims 1-8, directed to methods of cancer treatment. / 1-8项权利要求, 用于治疗癌症的方法
 1. Phigenix does not manufacture any products/ Phigenix 本身不生产任何产品
 2. Purportedly has developed an IP portfolio, covering ImmunoGen's patent.
/Phigenix已开发了一个知识产权组合, 其中包括一些专利涵盖了ImmunoGen专利的保护范围。
 3. After PTAB decided the claims were not invalid, Phigenix appealed to CAFC./ 在PTAB认定 ImmuoGen的权利要求有效后, Phigenix向CAFC提出上诉。



4. Injury in Fact?/遭受实际损害？

Showing injury

The existence of ImmunoGen patent “encumber[ed] Phigenix’s licensing efforts,” costing it millions of dollars in potential licensing revenue. /

证明实际损害

Phigenix声称ImmunoGen专利的存在“阻碍了其专利许可证的谈判和发放”，因此损失了潜在的，数百万美元许可证收入。

1. No evidence: same parties that licensed the ImmunoGen patent/没有证据显示Phigenix许可证发放给那些获得ImmunoGen专利许可的机构
2. Licensing injury hypothetical and supported only by conclusory statements from its own witness/权利金损失仅是基于其假设，Phigenix的观点仅获得其自身证人结论性声明的支持

4. Right to Appeal & Estoppel ≠ Injury/ 上诉的权利和禁止反言并不构成实际伤害

Did not contend that it faced the risk of infringing the ImmunoGen patent, or it was an actual or prospective licensee of such patent/并未主张其具有面临侵犯ImmunoGen专利的风险，或它是ImmunoGen专利的实际或潜在的许可证持有者

Phigenix

Determined that a statutory right to appeal an IPR decision does not give the Article III standing/对PTAB行政裁定提出上诉的法定权利并未赋予上诉人在根据宪法第三条设立的 联邦法院 起诉的法律资格。

CAFC

The estoppel effect of the PTAB's decision to later proceeding cannot constitute an injury in fact./PTAB裁决对后续诉讼所具有的禁止反言的效力不构成实际伤害



4. Takeaways/启示

- 1) The right to file IPR or appeal to CAFC does not automatically confer Article III standing./向PTAB提起双边审查或向CAFC就PTAB裁决提起上诉的权利并不会自动赋予请求人在联邦法院起诉/上诉的法律资格
- 2) To avail such standing, patentee cannot sit on its patents and do nothing/为了获得该法律资格，专利权人不能手持专利而无所作为
- 3) For petitioners, time your IPR wisely, wait until your own commercialization starts. /对于请求人，提起双边审查的时机必须合理，即，应等到自身商业化开始后再递交请求

Summary/最后总结

- 1) PTAB —cost-effective alternative /PTAB - 解决专利侵权的替代场所
- 2) Petitioner has the burden of proving the unpatentability of amended claims/请求人具有证明专利权人提出的修订权利要求不具专利性的举证责任
- 3) Draft specifications carefully/仔细准备说明书
- 4) Do not use same term of different meanings/不要赋予相同的术语不同的含义
- 5) Harder to invalidate a patent claim in PTAB/无效专利的难度可能增加
- 6) PTAB's claim construction is more likely binding in district courts/PTAB对权利要求的解释更可能在随后的地区法院诉讼中有约束力
- 7) For petitioners, time your IPR wisely, wait until your own commercialization starts/对于请求人，提起双边审查的时机必须合理

Other Cases/其他案例

- 1) *Credit Acceptance Corp., v. Westlake Services*, 859, F.3d 1044 (Fed. Cir. 2017)
- 2) *Berkheimer v. HP Inc.*, 881 F. 3d 1360 (Fed. Cir., Feb. 8, 2018)
- 3) *Oil States Energy Services, LLC v. Greene's Energy Group, LLC*, 584 U.S. ____ (2018)

THANK YOU FOR YOUR TIME

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