The IP Beacon, June 2017

June 13, 2017 Brian Kwok, Andrew Cohn, Jason Whitney

PRACTICES Intellectual Property Litigation, Patent Office Trials, Patents, Trademark and Advertising, Advertising, Marketing and Promotional Law, Intellectual Property

View the PDF version of the June 2017 IP Beacon.

Supreme Court Ruling Reins in Patent Infringement Forum Shopping
By Brian Kwok and Jason W. Whitney

On Monday, May 22, 2017, the U.S. Supreme Court in *TC Heartland LLC v. Kraft Foods Group Brands LLC*, No. 16-341 unanimously overruled a longstanding Federal Circuit decision that allowed patent infringement suits to be filed in nearly any U.S. state or jurisdiction. The effect of the TC Heartland ruling is expected to be immediate, drastically limiting where patentees may bring suit and reshaping the landscape of patent infringement actions.
Read more.

Is the One Year Time Bar for Filing an IPR Subject to Appellate Review?
By Paul Dietze, Ph.D., Whitney Remily, and Yongjin Zhu, Ph.D.

On May 4, 2017, the en banc Federal Circuit heard oral arguments in *Wi-Fi One, LLC v. Broadcom Corp.,* Appeal 2015-1944 (Fed. Cir. Sept. 16, 2016) to consider whether the findings of the Patent Trial & Appeals Board ("PTAB") regarding 35 U.S.C. § 315(b), which governs the timeliness of filing a petition for *inter partes review* ("IPR"), are subject to judicial review on appeal. Specifically, the Federal Circuit is considering whether it should overrule its panel decision in *Achates Reference Publishing Inc. v. Apple Inc.*, 803 F.3d, 652 (Fed. Cir. 2015), cert. dismissed, 136 S. Ct. 998 (2016) that judicial review is unavailable to challenge a determination by the PTAB that the petitioner satisfied the requirement of 35 U.S.C. § 315(b). Whether Achates is upheld or overruled will hinge on how broadly the Court construes the scope of 35 U.S.C. § 314(d).
Read more.

AIA On-Sale Bar and USPTO's Practices After Helsinn
By Thomas Kelton and Pranay Pattani

On May 1, 2017, the Federal Circuit decided *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.,* tackling the issue of when on-sale bars can apply under the America Invents Act. No. 2016-1284 (Fed. Cir. May 1, 2017). Although the decision addresses situations involving public sales of inventions, questions about situations involving private or secret sales remain open.
Read more.

The Biologics Tango: Reading Tea Leaves on the Patent Dance and Pre-Marketing Notice Requirements
By Scott Cunning, Elizabth Crompton, Ph.D., Yifang Zhao, and Yongin Zhu, Ph.D.

On Wednesday, April 26, 2017, the Supreme Court heard oral argument in *Sandoz Inc. v. Amgen Inc. et al.*, a landmark case that many hope will provide clarity and guidance for consumers and the

pharmaceutical industry on the regulatory approval pathway for biosimilar drugs under the Biologics Price Competition and Innovation Act of 2009 ("BPCIA" or "Biosimilars Act").

Biosimilars refer to complex biologic drugs made within cells or organisms that are highly similar to medicines already approved by the FDA. The two questions to be decided by the high court are (1) whether the BPCIA requires the biosimilar applicant (*i.e.*, the company seeking approval of a biosimilar) to engage in the "patent dance" by providing the reference product sponsor (*i.e.*, the company that markets the original biologic drug) a copy of its biologics license application and certain related manufacturing information, and (2) whether the BPCIA's 180 days' pre-marketing notice requirement can be made only after the biosimilar applicant has obtained FDA approval.
Read more.

Differing Burdens of Proof in the PTAB and District Courts Can Allow Patent Challengers a Second Bite at the Apple
By Elizabeth Crompton, Ph.D.

The different burdens of proof in the Patent Trial and Appeal Board ("PTAB") and in district court means that the PTAB may find patent claims unpatentable even after the claims were held valid over the same evidence in litigation. *Novartis AG v. Noven Pharm. Inc.*, No. 2016-1678, 2016-1679 (April 4, 2017).
Read more.

Anything You Say May Be Used Against You In A Court Of Law
By Andrew Cohn

For patent practitioners, prosecution disclaimer is an often forgotten patent law principle that can find its way back into the formalistic claim construction adhered to in many Federal Circuit decisions. In some cases, patentees must take care to avoid disclaiming more than is necessary to overcome cited art during prosecution. An overbroad disclaimer was exactly the situation in *Technology Properties Ltd. v. Huawei Tech, et al.* (Case Numbers 2016-1306, 2016-1307, 2016-1309, 2016-1310, and 2016-1311, Fed. Cir. March 3, 2017), where a patentee's remarks during prosecution ultimately led to narrowing limitations being read into the issued claims.
Read more.