

Jarratt in Law360: Fed. Circ. Guidance For PTAB In MaxLinear

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PRACTICES Patents, Patent Prosecution and Counseling, Intellectual Property

In *MaxLinear Inc. v. CF Crespe LLC.*, No. 2017-1039, 2018 U.S. App. LEXIS 1930 (Fed. Cir. Jan. 25, 2018), the Federal Circuit vacated and remanded the Patent Trial and Appeal Board's final written decision in IPR2015-00592 (the '592 IPR). The PTAB had found that all instituted claims were not shown to be unpatentable, but during the pendency of the appeal, the Federal Circuit affirmed a decision in another *inter partes* review finding the same patent's independent claims unpatentable. The Federal Circuit then held that collateral estoppel applied and vacated the board's decision. Because the PTAB focused solely on the now-invalid independent claims in its decision, the court ordered the PTAB to consider on remand whether the dependent claims were "patentably distinct." However, the Federal Circuit's guidance on this point presents logical and procedural uncertainties for the PTAB, as it has been directed to consider prior art not of record in the underlying IPR. ...

In light of this precedential decision, practitioners should consider the preclusive effect of a finding of unpatentability by the Federal Circuit in an IPR proceeding. First, because collateral estoppel applies not only to the specific claims invalidated in an IPR, but also to claims that are not patentably distinct, similar claims in related patents and pending applications are also potentially at risk. For patent owners, this may counsel toward securing settlement before an IPR appeal reaches finality. For petitioners, the court's willingness to broadly apply collateral estoppel to related claims appears to provide ammunition for follow-on challenges to other members of a patent family. Second, given the court's instruction to the board regarding waiver of unargued dependent claims, patent owners should err on the side of caution during an IPR and present argument as to why each challenged dependent claim is separately patentable over its independent claim.

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