

IP Year in Review: *TC Heartland* and IPRs

Frank L. Bernstein

Partner, Singularity LLP

Presentation to LES-Silicon Valley Chapter

December 13, 2017



Patent Venue – *TC Heartland*

- Supreme Court narrowed definition of venue in patent cases
- EDTX tried to broaden the definition (“regular and established place of business”)
- Fed. Cir. said no (*In re Cray*)

Patent Venue – *TC Heartland*

- Defendants tried to raise or resurrect their venue defenses
- Some district courts found defendants had waived; other district courts did not
- *In re Micron Technology* – Fed. Cir. said *TC Heartland* an intervening change in law

IPRs – Claim Interpretation

- *In re Smith Int'l*: Broadest reasonable interpretation must be consistent with the specification

IPRs – Claim Amendments

- Permitted, in theory (BRI in PTO), but the great majority have been refused
 - Many patent owners haven't even bothered to try
 - PTAB has required patent owners to justify their proposed claim amendments
- *Aqua Products* removed that burden from patent owners

IPRs - Constitutionality

- *Oil States*: Are IPRs unconstitutional?
 - Who gets to invalidate patent claims?
- *SAS*: Can PTAB decide what it will decide?
 - Scope of estoppel

Thank you!

Frank L. Bernstein

Singularity LLP

555 Twin Dolphin Drive

Redwood Shores, CA 94065

(650) 720-4588

fbernstein@ipsingularity.com

<http://www.ipsingularity.com>

<http://ipsingularity.com/frank-l-bernstein/>

