

The Federal Circuit Judges You Want On Your PTAB Appeal

By **Matthew Bultman**

Law360, New York (March 1, 2017, 12:10 PM EST) -- It's no secret that getting a Patent Trial and Appeal Board decision overturned at the Federal Circuit can be an uphill battle. But if the court's decisions in 2016 are any indication, there are some judges that an appealing party might rather see on the appellate panel than others.

A Law360 analysis of the Federal Circuit's decisions over the past year found the overall affirmance rate in patent appeals was relatively constant across the 12 judges who heard at least 75 patent cases. In total, about 74 percent of all patent decisions are affirmed.

But the affirmance rate is more irregular when looking just at the PTAB, and specifically at appeals arising from America Invents Act review proceedings. The data indicate that some judges seem to be significantly less inclined to affirm the board than others.

Leading that camp is U.S. Circuit Judge Raymond T. Chen. Though Judge Chen voted to affirm 79 percent of patent appeals arising from district court, that rate was much lower for AIA appeals, where his affirmance rate was 48 percent.

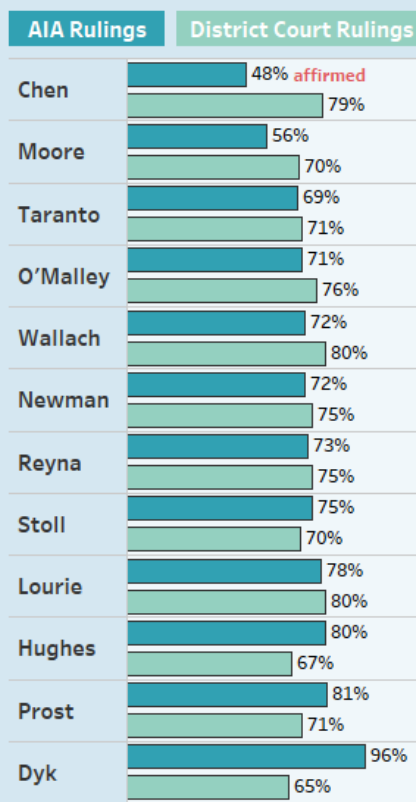
In contrast, U.S. Circuit Judge Timothy B. Dyk voted to affirm about 96 percent of the AIA appeals — despite an affirmance rate of around 65 percent in district court patent cases.

Generally speaking, the numbers suggest that a party appealing a PTAB decision in an AIA review would prefer to face Judge Chen than Judge Dyk, and further that Judge Chen gives greater deference to district courts than to the PTAB. But he is not alone.

Eight of the 12 judges whose decisions were analyzed had lower affirmance rates in patent cases arising from AIA

Where Judges Stand On PTAB Appeals

Some Federal Circuit judges are more likely to vote to affirm the PTAB than others. Moore and Chen are the most likely to vote to reverse or vacate a PTAB decision, while Dyk and Prost more frequently back the PTAB.



reviews at the PTAB than from the district court.

After Judge Chen, U.S. Circuit Judges Kimberly Ann Moore and Evan J. Wallach had the district court affirmance rates that surpassed their AIA affirmance rates by the largest amounts.

Judge Moore voted to affirm in nearly 70 percent of patent appeals from district court, but only in 56 percent of AIA appeals. Judge Wallach's affirmance rates were 80 percent and 72 percent, respectively.

But it's not just how the judges voted as members of a panel. The differential — particularly between Judge Chen and Judge Dyk — holds true in opinion writing as well.

Judge Dyk, a former partner at Jones Day Reavis & Pogue who was appointed to the bench in 2000 by President Bill Clinton, wrote five opinions in PTAB appeals last year, four of which affirmed the board's findings.

The fifth denied a rehearing to Medtronic Inc., which sought review of a PTAB decision to terminate its challenge to two Robert Bosch Healthcare Systems Inc. patents because it didn't name all the interested parties. The Federal Circuit said it didn't have jurisdiction to review the PTAB's decision to terminate an inter partes review.

Meanwhile, Judge Chen did not write an opinion in 2016 that entirely affirmed a board decision. Of the seven opinions by Judge Chen in appeals from the PTAB — four of which were designated precedential — one reversed the board, another vacated its decision and five were mixed outcomes.

And he often didn't mince words.

In one precedential opinion, the PTAB was ordered in February to reconsider a case involving a Nike Inc. footwear patent. Judge Chen wrote that the board's decision not to allow Nike to amend claims "lacks a discussion, or even an acknowledgement," of certain evidence Nike had presented.

In another, the court upheld part of PTAB decisions in AIA reviews that invalidated numerous claims in five Blue Calypso LLC advertising patents. However, it reversed the board's decision that certain claims were invalid for lack of adequate written description.

The 46-page opinion took particular issue with the PTAB's finding that two terms in the claims of Blue Calypso's patents lacked written description support because they were not found in the patent's specification, saying that was no reason to find the claims invalid.

Judge Chen noted that the court has held that when examining written description support, the exact terms in the claims do not need to be used in the specification in so many words.

"We are therefore troubled by the fact that the board did not cite any evidence other than the fact that the terms were not present in the specification to support its finding," he wrote.

Judge Chen's affirmance rate in PTAB appeals might be surprising to some, given that prior to his appointment to the bench in 2013 he spent more than a decade at the patent office, first as an assistant solicitor and later as the deputy general counsel for intellectual property law and as solicitor.

Prior to that, Judge Chen, who holds a law degree from the New York University School of Law and a

bachelor's degree in electrical engineering, served as a technical assistant at the Federal Circuit and some spent some time working at Knobbe Martens Olson & Bear LLP.

John Dragseth, a former Federal Circuit clerk who is a principal at Fish & Richardson PC, said that given Judge Chen's experience, he is an example of somebody who has a built-in feel for USPTO cases.

"With Chen's experience, he probably has a pretty inherent view of what's out of line and what's not out of line," Dragseth said. "When he closes his eyes and looks out at the world, he has a lot of data points where he can place these cases into."

It's unlikely any of this will change the way attorneys brief cases or prepare for oral arguments.

The Federal Circuit is somewhat unique in that the court does not announce the panel of judges who will be hearing an appeal before the morning of scheduled arguments. Other circuit courts release the names of the judges in advance.

In the Ninth Circuit, for instance, the names of the judges on each panel are released on the Monday of the week preceding arguments. The Second Circuit posts the names of panel members each Thursday for cases scheduled on the argument calendar for the following week.

"It's not as if anybody is drafting a brief toward a particular judge," said Jon Wright, co-chair of the appellate practice at Sterne Kessler Goldstein & Fox PLLC. "That would be a mistake. You have to brief it to the court based on the law."

--Editing by Katherine Rautenberg and Mark Lebetkin.

Methodology: Law360 analyzed votes by Federal Circuit judges who voted in at least 75 panel decisions in patent cases last year. This analysis excludes any en banc decisions, and counts each judge who did not dissent from an opinion as having the same vote as the majority. Any judge who authored a dissent was scored as voting according to the position he or she took in the dissenting opinion.