

Akin Gump
STRAUSS HAUER & FELD LLP

IP Newsflash



05.02.14

DISTRICT COURT CASES

Statistics on *Inter Partes* Review Proceedings Found Persuasive by Court in Granting Stay

A district court in California has granted a defendant's motion to stay a patent infringement litigation pending institution of an *inter partes* review (IPR). In its analysis of the motion the court considered three factors: 1) whether the stay would simplify the case; 2) whether discovery was complete and 3) whether a stay would unduly prejudice the plaintiff. As to the first factor, in opposing the motion, the plaintiff argued that entry of a stay would be premature because the Patent Office had not yet decided whether or not to institute the IPR. The court disagreed, and noted that based on evidence submitted by the defendant, for all but three of the 40 final written decisions issued in IPR proceedings, all claims were cancelled. According to the court, given the high rate at which the Patent Office grants petitions, a petition with no obvious deficiencies is likely to simplify the issues of the case. As to the factor related to the stage of discovery, the court explained that even though *Markman* briefing had been submitted, no order had yet been issued and that expert discovery was ongoing. And as to the prejudice factor, the court found that, as a non-practicing entity, the plaintiff could not demonstrate irreparable harm. The court, therefore, stayed the case pending an institution decision by the Patent Office and stated that the stay would be extended through the date of issuance of a final written decision if the petition is granted.

Author: [Rubén H. Muñoz](#)

Brixham Solutions Ltd. v. Juniper Networks, Inc., 13-cv-00616 (N.D. Cal. April 28, 2014) (Spero)

PATENT TRIAL AND APPEAL BOARD

Impermissible Enlargement of Claim Scope Undermines Motion to Amend

A PTAB panel has found that the sole claim of a design patent covering a drinking cup is invalid and the patent owner ("owner") has not met its burden of proof on a motion to amend. During an *inter partes* review, an owner may amend the challenged claim(s) if the following requirements are met. First, the proposed amendment must be responsive to a ground of unpatentability at issue in trial. Second, the amendment may not enlarge the scope of the claim(s) or introduce new subject matter. In its final written decision, the Board determined that a claim covering the ornamental design for a drinking cup was obvious in view of the prior art and, in so finding, denied the owner's motion to amend the claim. In its analysis, the Board noted that the owner's motion to amend met the first requirement of being responsive to a ground of unpatentability because it "seeks to amend the claim such that it would be supported by the disclosure of [an earlier application], in order to disqualify [the prior art]." However, the Board ultimately denied the owner's motion to amend because it impermissibly enlarged the scope of the challenged claim. Specifically, the Board compared the original and amended drawings and concluded that "the amended claim is broader than the issued claim...with respect to racetrack-shaped spout tips and raised rim vents, even though it may be narrower with respect to [other features]." Since the proposed amended claim was broader in some aspects compared to the original claim, the owner's motion to amend was denied.

Author: [Matthew G. Hartman](#)

Munchkin, Inc. v. Luv N' Care, Ltd., IPR2013-00072 (PTAB April 21, 2014) [Bisk, Wood, Fitzpatrick (opinion)]

www.akingump.com



© 2014 Akin Gump Strauss Hauer & Feld LLP. All rights reserved. Attorney advertising. This document is distributed for informational use only; it does not constitute legal advice and should not be used as such. IRS Circular 230 Notice Requirement: This communication is not given in the form of a covered opinion, within the meaning of Circular 230 issued by the United States Secretary of the Treasury. Thus, we are required to inform you that you cannot rely upon any tax advice contained in this communication for the purpose of avoiding United States federal tax penalties. In addition, any tax advice contained in this communication may not be used to promote, market or recommend a transaction to another party.

[Update](#) your preferences | [Subscribe](#) to our mailing lists | [Forward](#) to a friend | [Opt out](#) of our mailing lists