

2019 Phoenix Issues

The Naples Roundtable

Phoenix Issue I.

Has the value of US patents decreased over the last 10 years and are there ways to strengthen and improve the Patent System? What can and should be done to improve the process? Are the pending proposals in Congress needed and if so will they help? Do some of the AIA provisions need to be scrapped or modified? A recent Federal Register notice by the PTO sets forth proposed for the first time in the history of our patent system, a practitioner fee and CLE requirements; should these be imposed?

Phoenix Issue II.

Is patent litigation being abusively utilized today or have unjustified actions been significantly curbed? Have IPRs, changes in venue selection and the more frequent award of attorneys' fees helped? Are changes needed in the IPR process and what changes are in the works; will such changes help? What is the impact of recent and proposed changes — considering all claims and proposed grounds of invalidity and claim interpretation standards?

Phoenix Issue III.

Is there a problem with Section 101 decisions and will there likely be any legislative fix? If not, then what if anything can be done? Is it easier in foreign countries to obtain patents on subject matter considered abstract and unpatentable in the US? What if any impact is this having on innovation in the US?

Phoenix Issue IV.

Should deference (under Chevron) be given to the PTAB decisions and to what extent? Should any change in deference also impact ITC decisions? What is the level of review that should be done by the Federal Circuit on various issues (e.g. claim construction and assignor estoppel)?

Phoenix Issue V.

Is the current law of damages and injunctions adequate in protecting rights of patent holders? What is the impact of investing in and promoting innovation? How does the handling of damage and injunction issues in the US compare to countries in Europe and Asia?

Phoenix Issue VI.

Is there a current conflict between implementation of the patent laws and antitrust laws?

Phoenix Issue VII.

To what extent is the patent system well-served by the extra-territorial enforcement of competition and intellectual property laws?

Phoenix Issue VIII.

Is there a need to substantially revise the rules to bring the content of patent applications in line with modern precedent, new types of technologies (e.g. AI) and to impose reasonable limits on the size of specifications and the number of claims that should be allowed in an application? For example, should the requirement for a section entitled “Background of the Invention” be replaced by sections covering “The Scope and Content of the Prior Art’ and “The Level of Ordinary Skill in the Art?” Should the USPTO resurrect its once prevalent use of “undue multiplicity” rejections? Should the Office require applicants to state whether they intend for the preamble of their claims to be construed as a limitation on the scope of the claims? Should the Office require applicants to state whether they intend for their claims to be interpreted as means-plus-function claims?

Phoenix Issue IX.

To protect against willful infringement allegations after Halo, should parties obtain opinions from counsel and what waiver issues arrive?

Phoenix Issue X.

Understanding the conflict of positions in the SEP/FRAND issues both in the US and Internationally and can the conflicts be resolved?