

2020 Phoenix Issues

The Naples Roundtable

Phoenix Issue I. PTAB:

- Should the IPR Model be used to assess all issues of patentability whenever a defense to infringement is patent invalidity? And if so, then how should the IPR process be changed to accomplish this objective?
- Have the recent changes in the PTAB Rules and Decisions had a positive impact in strengthening the patent system? What further administrative changes in the IPR process should the PTO consider?
- Would the changes proposed in the recently introduced “[STRONGER \(Support Technology & Research for Our Nation’s Growth and Economic Resilience\) Patents Act of 2019](#)” improve or strengthen the patent system?

Phoenix Issue II. Is there a current conflict between the goals and implementation of the patent laws and antitrust laws that is impeding the effectiveness of the U.S. patent system’s ability to promote investment in developing and marketing new technology?

Phoenix Issue III. Can the Courts and the parties agree on how to determine patent damages and valuation for licensing of SEP/FRAND patents? Is there a need to clarify the current law and adopt a consensus approach? If so then what form should the model take?

Phoenix Issue IV. Section 101 –Will Congress find a politically viable legislative fix to address its Mayo/Alice jurisprudence or alternatively should the Supreme Court provide a way to clarify and correct the issues and if so, then how should the Court do so? If the cert on this issue is taken by the Supreme Court, then what recommendations should be presented to the Supreme Court as a ground for resolution? Do you think that the Supreme Court will take a 101 case and tackle the issue?

Phoenix Issue V. International Patent Issues — What should be the future direction of harmonization efforts in connection with the substantive law among the top 5 patent offices (the IP5). What are the priority areas for substantive law harmonization? Compare patent validity challenges in the Federal German Patent Court, JPO, CNIPO to provide a comparison on stats and trends globally?

Phoenix Issue VI. Is the patent litigation being abusively utilized today or have “Troll” actions been significantly curbed? Have IPRs, recent Court decisions, changes in venue selection and the more frequent award of attorneys’ fees helped? What actions should be taken to improve the quality of the patents that are issued?

Phoenix Issue VII. Damages and injunctions – Are the current tests for obtaining injunctions after eBay supportive or an obstruction to innovation? What is the impact in investing in and promoting and marketing new technologies? Does the current damages law put too great a burden on plaintiffs or too little to reach the right result? Are Daubert motions being properly used by the parties and the Courts? Have the limits on damages impacted innovation in the U.S.?

Phoenix Issue VIII. Coping with issues arising from Litigation Funding; Does such funding models play a roll in encouraging and rewarding innovation?

- **Ethics and issues around litigation funding in view of the old issues of barratry, champerty, usury, and maintenance**
- **Discovery Issues**
- **Disqualification Issues**
- **Waivers**
- **Conflicts**