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Sterne Kessler
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June 2021

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Dear ,

The PTAB Strategies and Insights newsletter provides timely updates and insights into how best to handle proceedings at the USPTO. It is designed to increase return on investment for all stakeholders looking at the entire patent life cycle in a global portfolio.

This month we cover:

- PTAB filing and outcome statistics as of June 2021;
- Review the High Court's ruling in favor of a high school students First Amendment dispute;
- Provide a thorough analysis of the Supreme Court's decision in *Arthrex;* and
- Provide you with our most recent client alert regarding the Supreme Courts decision in *Minerva.*

Also, we want to make our readers aware of the USPTO's notice on implementing the Supreme Court's decision in Arthrex (see here).

We welcome feedback and suggestions about this newsletter to ensure we are meeting the needs and expectations of our readers. So if you have topics you wish to see explored within an issue of the newsletter, please reach out to me.

Best,

Jason D. Eisenberg

IN THIS ISSUE

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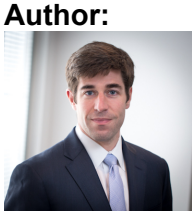

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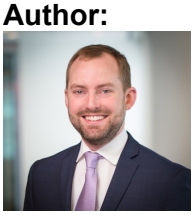

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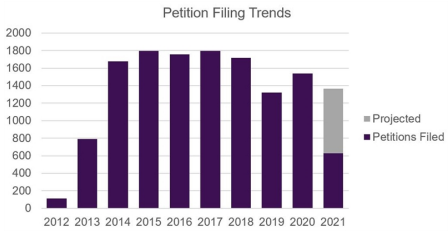
PTAB FILING AND OUTCOME STATS UPDATE - JUNE 2021[i]



By: Patrick Murray, Jae Bandeh, and Jason D. Eisenberg

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Currently, the number of petitions is on pace to approach 1,400, which would narrowly edge the total from 2019.

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THE BIG F WORD: THE [F]IRST AMENDMENT

By: Risa Rahman and Jason D. Eisenberg

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The U.S. Supreme Court recently held that a school district violated a teenager's First Amendment rights when school administrators suspended the teenager, B.L., from the junior varsity cheerleader team for cursing about the team and school on social media. *Mahanoy Area Sch. Dist. v. B.L. (Mahanoy)*, No. 20-255 (June 23, 2021). B.L. used the F-word to vent her frustrations about not making the varsity cheerleading team nor receiving an offer for the right fielder position on the softball team. *Mahanoy*, slip op. at 2. One Snapchat post displayed B.L. flashing her middle finger at the camera with text stating, "F*** school f*** softball f*** cheer f*** everything." *Id*. The other Snapchat post displayed text in which she lamented, "Love how we get told we need a year of JV before we make varsity but that doesn't matter to anyone else?" *Id*.

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5 PRACTICAL TAKEAWAYS FROM HIGH COURT ARTHREX RULING

By: William H. Milliken

On June 21, the U.S. Supreme Court issued its decision in the closely watched U.S. v. Arthrex Inc. case, which involved the constitutionality of administrative patent judge appointments.

A five-member majority, led by Chief Justice John Roberts, concluded that APJs' ability to render final

decisions in inter partes reviews on behalf of the executive branch is "incompatible with their status as inferior officers."

This article was originally published by Law360. © 2021, Portfolio Media, Inc.

Read the full article

WHAT YOU SHOULD KNOW ABOUT THE SUPREME COURT'S DECISION IN MINERVA

By: William H. Milliken

This morning, the US Supreme Court issued its decision in *Minerva Surgical, Inc. v. Hologic, Inc.*, concerning the fate of the patent-law doctrine of assignor estoppel—i.e., estoppel against a patent owner who assigns his rights to another. Generally speaking, assignor estoppel—at least as it has recently been applied by the Federal Circuit—prohibits the assignor of a patent or patent application from later challenging the validity of the patent or patents stemming from the application. The question presented in *Minerva* was whether the Supreme Court should uphold the doctrine of assignor estoppel, narrow its scope, or discard the doctrine entirely. Minerva argued for overruling the doctrine; Hologic argued that the doctrine should be retained in its present form; and the United States, appearing as amicus, argued for a middle ground under which the doctrine would be upheld but narrowed.

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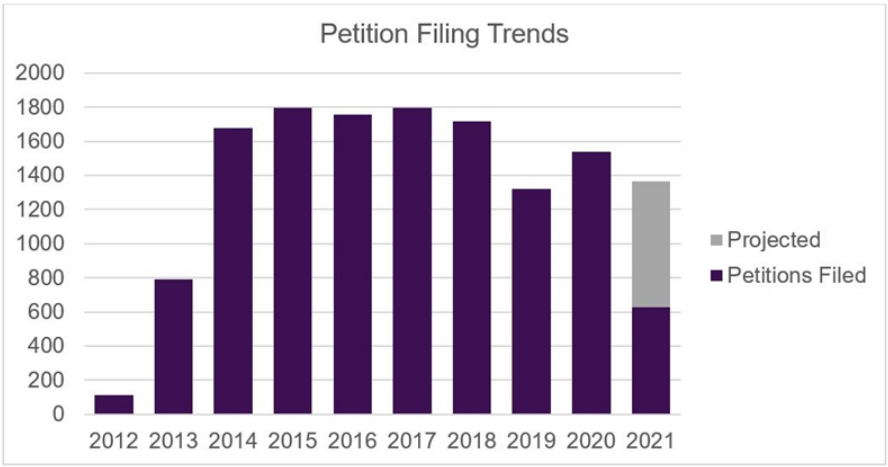
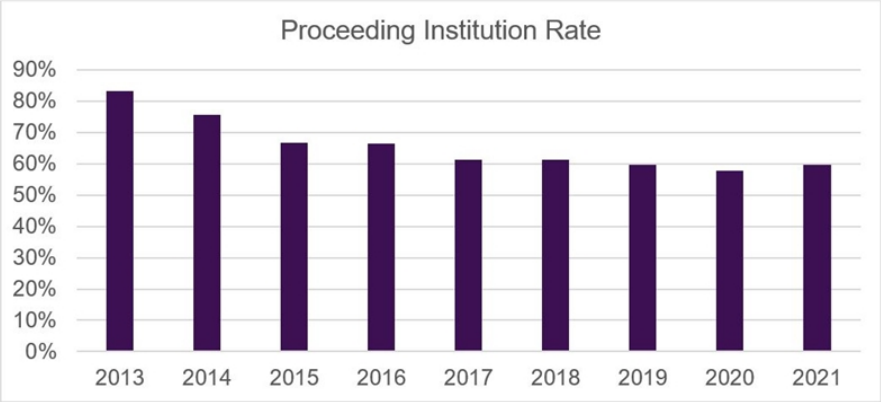


Currently, the number of petitions is on pace to approach 1,400, which would narrowly edge the total from 2019.

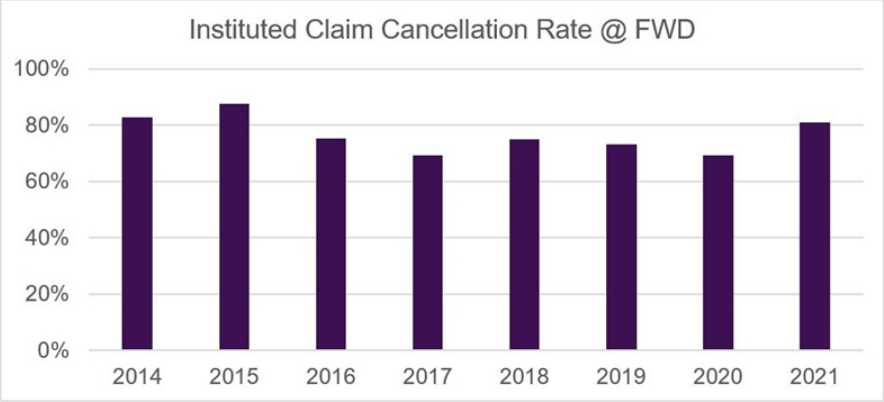
Regardless of how 2021 ends up stacking up to 2019, it seems clear that the overall volume of PTAB petitions has dropped off from its 2015-2018 peak. No year since 2018 has seen more than 1,600 petitions filed, while petitions filed in each of the five years from 2014-18 eclipsed that mark.

Proceeding Institution Rate



Over the last five years, the proceeding institution rate has remained remarkably stable, and 2021 has been no exception – the Board continues to institute trial in about 60% of petitions.

Claim Cancellation at Final Written Decision



Bucking recent stability trends, the Board's claim cancellation rate at final written decision ticked up to around 80% in the first half of 2021. If this cancellation rate holds, it would be the cancellation rate most favorable to petitioners since 2015.

One word of caution – the Board has issued notably fewer FWDs in the first half of the year as compared to years past. There have been fewer than 200 FWDs that have addressed patentability of existing claims in 2021. This compares to nearly 300 such decisions a year ago. So we'll watch to see if the claim cancellation rate comes closer into line with previous years as 2021 plays out.

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[i] Stats through June 15, 2021

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THE BIG F WORD: THE [F]IRST AMENDMENT

By: Risa Rahman and Jason D. Eisenberg

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Public school students have limited First Amendment protection for their on-campus speech. Even though public school students "do not shed their constitutional rights to freedom of speech or expression at the schoolhouse gate," their rights "are not automatically coextensive with the rights of adults in other settings." *Tinker v. Des Moines Indep. Cmty. Sch. Dist.*, 393 U.S. 503, 506 (1969). First Amendment jurisprudence directs schools to strive for a "balance between protecting the safety and well-being of their students and respecting those same students' constitutional rights." *LaVine v. Blaine Sch. Dist.*, 257 F.3d 981, 987 (9th Cir. 2001). Accordingly, public schools can sometimes stand *in loco parentis*, i.e., in the place of parents, to advance the legitimate interests of the school. *Mahanoy*, slip op. at 5.

Several appellate courts have held that this same authority can be applied to off-campus speech. For example, schools can regulate serious or severe bullying or harassment targeting particular individuals, threats aimed at teachers or students, or the failure to follow rules. *Mahanoy*, slip op. at 6. *See also Wynar v. Douglas Cty. Sch. Dist.*, 728 F.3d 1062, 1069 (9th Cir. 2013) (finding the school was within their authority to discipline a student sending instant messages threatening to shoot specific classmates); *Kowalski v. Berkeley Cty. Sch.*, 652 F.3d 565, 573 (4th Cir. 2011) (finding the school had authority to suspend a student who ridiculed another student through derogatory slurs on an online hate page). These cases are clear examples of severe bullying and threats to other students, so the courts found that the schools acted within their authority to promote student safety.

However, there may be cases that are not so clear-cut. With the increase of social media

usage, there is a proportional increase in the democratization of ideas. These ideas may include curse words, unpopular or controversial opinions, or ideas that may make others feel uncomfortable. And, of course, public school students are key members in this new marketplace for ideas. So, to what extent can schools regulate a student's off-campus speech that the school finds a bit… uncouth?

In his majority opinion, Justice Breyer set forth specific categories of student speech that schools may regulate: (1) "indecent," "lewd," or "vulgar" speech uttered during a school assembly on school grounds, (2) speech, uttered during a class trip, that promotes "illegal drug use,"; and (3) speech that others may reasonably perceive as "bear[ing] the imprimatur of the school[.]" *Mahanoy*, slip op. at 5. Moreover, according to the *Tinker* standard, schools have a special interest in regulating speech that "materially disrupts classwork or involves substantial disorder or invasion of the rights of others." *Id*.

Without defining off-campus speech, the Court provided three features of off-campus speech that often, even if not always, distinguish schools' efforts to regulate that speech from their efforts to regulate on-campus speech. *Mahanoy*, slip op. at 7. First, "a school, in relation to off-campus speech, will rarely stand in loco parentis…off-campus speech will normally fall within the zone of parental, rather than school-related, responsibility." *Id*. Second, "courts must be more skeptical of a school's efforts to regulate off-campus speech, for doing so may mean the student cannot engage in that kind of speech at all. When it comes to … speech that occurs outside school or a school program or activity, the school will have a heavy burden to justify intervention." *Id*. Third, "America's public schools are the nurseries of democracy" that only thrive "if we protect the 'marketplace of ideas,'" including unpopular ideas. *Id*.

The Court found the speech here was legal criticism, not crude, obscene, or fighting speech. *Mahanoy*, slip op. at 8. Aside from the vulgar language, the Court found that a listener of B.L.'s speech would hear criticism of the team, the team's coaches, and the school. *Id*. Even within the context of vulgar language, this is the type of language B.L. would be able to freely use if she were an adult. *Id*. For a school to justify prohibition of a student's particular opinion, the Court asserts that the school must have "something more than a mere desire to avoid the discomfort and unpleasantness that always accompany an unpopular viewpoint." *Mahanoy*, slip op. at 10.

Within the context of school administrators standing in the place of parents, Justice Alito's concurring opinion stated, that "it is not reasonable to infer [B.L.'s parents] gave the school the authority to regulate [B.L.'s] choice of language when she was off school premises and not engaged in any school activity. And B.L.'s school does not claim that it possesses or makes any effort to exercise the authority to regulate the vocabulary and gestures of all its students 24 hours a day and 365 days a year." *Mahanoy*, slip op. at 18-19.

Justice Alito concluded, "If today's decision teaches any lesson, it must be that the regulation of many types of off-premises student speech raises serious First Amendment concerns, and school officials should proceed cautiously before venturing into this territory." *Mahanoy*, slip op. at 19.

So it's ok to say, "F*** school f*** softball f*** cheer f*** everything."

Glad our kids can be kids.