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VIA ECF

May 6, 2020

Hon. Peter R. Marksteiner
Circuit Executive and Clerk of Court
United States Court of Appeals for the Federal Circuit
717 Madison Place NW, Room 401
Washington, DC 20439

RE: Fed. R. App. P. 28(j) Citation of Supplemental Authority in
Uniloc 2017 LLC v. Hulu, LLC, Netflix, Inc., No. 2019-1686.

Dear Colonel Marksteiner:

In the pending *Uniloc v. Hulu* appeal, the USPTO contends that the America Invents Act directs the Patent Trial and Appeal Board to assess the “patentability” of new substitute claims, 35 U.S.C. § 318(a), which is a broader inquiry than the more limited set of prior-art issues that may be considered with respect to original claims. *See* 35 U.S.C. § 311(b).

On April 9, 2020, this Court decided *Nike, Inc. v. Adidas AG*, 955 F.3d 45 (Fed. Cir. 2020), which held that “the Board may sua sponte identify a patentability issue for a proposed substitute claim based on the prior art of record,” *id.* at 51—something that the Board may *not* do with respect to a petitioner’s challenge to original claims. *See Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1335 (Fed. Cir. 2020). As *Nike* explains, “[i]t makes little sense to limit the Board, in its role within the agency responsible for issuing patents, to the petitioner’s arguments in th[e] context [of motions to amend].” *Nike*, 955 F.3d at 51. “Rather, based on consideration of the entire record, the Board must determine whether the patent owner’s newly-presented, narrower claims are ‘supported by the patent’s written description’ and ‘unpatentable in the face of the prior art cited in the IPR.’ [*Aqua Prods., Inc. v. Matal*, 872 F.3d 1290, 1314 (Fed. Cir. 2017)] (citing 35 U.S.C. § 316(d)(3)).” *Id.* at 51-52.

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Nike's holding and reasoning are consonant with the USPTO's view that the AIA recognizes the special challenges posed by new substitute claims, which would issue without previously having been examined by the agency—and that the Act thus authorizes a broader, more searching review of such claims than is permitted in a challenge to original claims.

Respectfully submitted,

/s/ Joseph Matal
Joseph Matal
Associate Solicitor
United States Patent and Trademark Office

cc (via CM/ECF): Counsel of Record