

Skilled in the Art: Washington Goes Back to the Future on Patents + McKool Smith and Loeb & Loeb Add New Partners

Law.com

Scott Graham

February 19, 2021

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Welcome to Skilled in the Art. I'm Law.com IP reporter Scott Graham. Here's what's shaking in an abbreviated newsletter this week:

- Leadership changes on the Senate and House IP subcommittees don't point in a happy direction for patent owners.
- Tech companies that have been denied IPRs due to NHK-Fintiv are finding success (and stays of district court litigation) with ex parte reexamination.
- **Alan Whitehurst, a veteran of smartphone wars at Quinn Emanuel, joins McKool Smith.**
- Loeb & Loeb and Harrity & Harrity add new lawyers too.

It's Back to the Future for Patents in Washington

The Supreme Court is expected to decide this spring whether the USPTO's process for appointing administrative patent judges is constitutional. One possible outcome is that Congress may have to tweak the PTAB structure slightly to keep it running.

The fix would probably be simple enough. It's more a question of political will. Given Senator Chris Coons' prominent role on the Senate Judiciary's IP Subcommittee, and his sponsorship of the STRONGER Patents Act, it seemed natural that the price of such a fix might be enacting some of his proposals to soften IPRs. Indeed, on the House side, IP subcommittee ranking member Martha Roby proposed such a bargain at a 2019 hearing.

But new leadership has been unveiled at those subcommittees this month, and the path to a simple fix now looks a little clearer. First, as Gene Quinn and Eileen McDermott reported this week at IP Watchdog, Senator Patrick Leahy—and not Coons—will be wielding the gavel at the Senate IP Subcommittee. That's Leahy as in the Leahy-Smith America Invents Act.

Coons remains on the committee and will probably continue playing an active role on patent issues. But, as Quinn and McDermott put it, “the architect of the PTAB is in control of patent policy in the Senate.”

On the House side, there's been another change that might be jarring to patent owners. Rep. Darrell Issa is returning to the House Subcommittee on Courts, Intellectual Property and the Internet, and he'll be taking Roby's place as ranking member.

Issa chaired the subcommittee from 2015 through 2018. An inventor and entrepreneur, he's taken a keen interest in patents, sponsoring the legislation that became the federal court Patent Pilot Program. Issa also has been an outspoken critic of patent abuse by non-practicing entities. He introduced legislation that would have expanded covered business method review at the PTAB. He cheered the Supreme Court's TC Heartland decision. And he was among the Republicans who encouraged President Trump to keep Michelle Lee as PTO director. Some patent owner groups openly celebrated when Issa announced he would not seek reelection in 2018.

It might be time to make up. Issa ran for and won a vacant seat in California's 50th district last fall.

He said in a written statement earlier this month that the United States is “at the center of world innovation and creativity” and that he is committed to “building consensus solutions to emerging challenges.”

Tech May Have End-Around Discretionary Denials

Tech companies appear to have hit on a new strategy for slowing down patent infringement trials while the PTO takes a second look at validity. Cisco Systems in January and Google, Samsung and Waze in February persuaded U.S. District Judge Rodney Gilstrap to stay upcoming trials after the PTO agreed to ex parte reexamination of the patents-in-suit.

Cisco and Google had initially sought IPR, but the PTAB denied institution last year, in part because of the pending trial dates. But there's no NHK-Fintiv hurdle for ex parte reexamination.

Gilstrap ruled that because the PTO has found a substantial question of patentability, there's now a high likelihood that the asserted claims will be modified, dropped or canceled. That was enough to grant the stays.

Apple is pursuing a similar strategy before U.S. District Judge Robert Schroeder. It's seeking to postpone its March 22 trial with Maxell, as I reported earlier today here.



IP Lateral — McKool Smith

McKool Smith has added another principal to its Washington office. Alan Whitehurst joins the firm from Quinn Emanuel Urquhart & Sullivan.

Whitehurst focuses on intellectual property and unfair competition litigation and specializes in telecom-related disputes. He was part of Quinn Emanuel teams that represented Samsung Electronics in the famous Apple v. Samsung litigation and that defended Samsung against standard-essential patent claims by Huawei Technologies. Whitehurst also has represented Verizon Communications and Motorola Mobility in suits over video transmission technology.

“Alan has decades of experience guiding industry-leading companies through a broad range of complex patent disputes involving cutting-edge technologies in and outside of the telecom sector,” said David Sochia, McKool Smith’s managing principal, in a written statement. “Our clients will benefit significantly from his technical skills and deep trial experience.”

“As a patent trial lawyer, I’ve always had a significant amount of respect for McKool Smith,” said Whitehurst. “I have seen many of the firm’s lawyers in the courtroom and know first-hand the technical expertise and trial prowess that they bring to every case.”

In December McKool Smith added Nick Matich, the former acting general counsel of the USPTO, to its Washington office.

IP Lateral – Loeb & Loeb

Jorge Arciniega has joined Loeb & Loeb as a partner in Los Angeles after 20 years at McDermott Will & Emery. Arciniega focuses on complex trademark and copyright matters, and has represented clients in the entertainment and media, technology, retail, hospitality, health care and financial services industries.

“Jorge is well known in the global trademark community and has worked extensively in Loeb’s

core industry verticals,” said Alyse Pelavin, managing partner of Loeb’s Los Angeles office, in a written statement. “We are delighted to welcome such a seasoned practitioner to Loeb.”

“I’m thrilled to join this established team as they continue to help their clients protect and exploit their brand assets,” Arciniega said.