

PTAB Highlights | Takeaways from Recent Decisions in Post-Issuance Proceedings

By Matt Becker and Scott Burow

In this installment of the PTAB Highlights, Banner Witcoff attorneys examine recent decisions at the PTAB featuring: the Board finding an operating manual and thesis in a library database qualified as printed publications, the importance of supporting a motivation to combine with rational underpinnings, the Board refusing to apply collateral estoppel, and more!

No identical claim limitations, no collateral estoppel. *Rimfrost AS v. Aker Biomarine Antartic AS*, IPR2020-01534, Paper 25 (May 18, 2022) (Mitchell, joined by Franklin and Tornquist) (finding that Petitioner did not establish collateral estoppel applied where the Board's prior IPR decisions involving patents related to challenged patent did not decide an identical issue because the challenged patent included a limitation that was not previously litigated or resolved by the Board).

Timing is everything. *F5 Networks, Inc. v. WSOU Investments, LLC*, IPR2022-00238, Paper 11 (May 19, 2022) (Hudall, joined by Dang and Weinschenk) (denying institution under § 314(a) where a district court trial involving the challenged claims was scheduled to start six months before the deadline for the PTAB's final written determination, and rejecting Petitioner's argument that, because there was a pending motion to modify the district court case schedule that would delay the district court trial, the PTAB should proceed with the IPR anyway).

Operating manual sent to dealers and customers was a "printed publication." *Godbersen-Smith Construction Co. v. Guntert & Zimmerman Const. Div., Inc.*, IPR2020-01698, Paper 80 (April 12, 2022) (Mayberry, joined by Scanlon and Hung) (finding that operating manual for paver equipment was a printed publication because it was sufficiently accessible to the public: it had been distributed to dealers and customers and the equipment had been used in plain sight of the public).

Sounds good in theory, but not good enough for the Board. *Microchip Technology Incorporated v. HD Silicon Solutions LLC*, IPR2021-01420, Paper 13 (May 12, 2022) (Engels, joined by Peslak and Ippolito) (denying institution and rejecting the Petitioner's assertion that the claims at issue would have been obvious, explaining that, although the Petitioner showed that combining a 1990

data book with a 2000 conference presentation was a “theoretical” possibility, the Petitioner ultimately failed to show why a skilled artisan would have in fact been motivated to do so).

A filed petition creates an “active dispute.” Unified Patents, LLC v. K.Mizra LLC, IPR2022-00166, Paper 8 (May 16, 2022) (Weatherly, joined by Engels and Melvin) (granting institution, and rejecting Patent Owner’s argument that the PTAB should not institute because no active dispute exists between the parties and none is contemplated, the PTAB stating that the filing of the Petition initiates an active dispute).

Check those library databases. A POSA would. Haas Automation, Inc. v. Olati LLC, IPR2021-00146, Paper 29 (May 13, 2022) (Scanlon, joined by Worth and Melvin) (determining that challenged claims were unpatentable and finding that a thesis found on a library database was a printed publication, because a reasonably diligent researcher in the field of CNC machining would have been inclined to “electronically search” the library’s database).

As a leader in post-issuance proceedings, Banner Witcoff is committed to staying on top of the latest developments at the Patent Trial and Appeal Board (PTAB). This post is part of our PTAB Highlights series, a regular summary of recent PTAB decisions designed to keep you up-to-date and informed of rulings affecting this constantly evolving area of the law.

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