

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

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So, what's happening at the PTAB? A new process for considering discretionary denial, using expert declaration to shine a new light on old reference, considering whether prior art is analogous, and more!

Fintiv Framework Applied to Already-Invalidated Claims. Hulu, LLC v. Piranha Media Distribution, LLC, IPR2024-01252, Paper 27 (April 17, 2025) (Stewart, Acting Under Secretary of Commerce for IP and Acting Director of USPTO) (vacating decision granting institution where district court already determined claims were invalid under 35 USC 101, citing efficiency and integrity factors encouraged by Fintiv framework even though framework generally addresses on-going parallel proceedings).

Expert Declaration Shines New Light on Old Reference. Therabody, Inc. v. Hyperice IP Subco, LLC, PGR2024-00053, Paper 8 (April 21, 2025) (Fredman, joined by Marschall and Finamore) (instituting post-grant review based on prior art reference cited but not relied upon during prosecution, because examiner did not appreciate the pertinence of the reference, and in view of expert declaration explaining pertinence and providing convincing evidence supporting conclusion of examiner error).

It's Obvious Even if Not the Most Obvious Choice. Google LLC v. Nariste Networks Pty. Ltd., IPR2023-01374, Paper 27 (April 9, 2025) (Wood, joined by Hoskins and Marschall) (finding claims directed to power conservation for GPS-enabled devices unpatentable where the primary reference suggested calculating distance moved based on current position, even if other computational methods also would have been obvious).

What You Say (in Your Patent) Can and Will Be Used Against You. Jiangsu Favored Nanotechnology Co., Ltd. v. P2i Ltd., IPR2024-00380, Paper 28 (April 11, 2025) (McGee, joined by Obermann and Ross) (in rejecting the Patent Owner's argument of non-analogous art, the PTAB noted that the patent broadly identified "protective coatings for electronic or electrical devices" as

the field of endeavor, not just coatings formed via a plasma polymerization process as the Patent Owner argued).

It's a Close Call but We'll Take It. Samsung Electronics Co., Ltd. v. SiOnyx, LLC, IPR2024-01431, Paper 28 (April 10, 2025) (Range, joined by Obermann and Ross) (granting institution despite some factors favoring discretionary denial, finding that the petition presented strong merits and that a concurrent ITC investigation would not resolve key issues presented).

As a leader in post-issuance proceedings, Banner Witcoff is committed to staying on top of the latest PTAB developments. Our PTAB Highlights series is designed to keep you up-to-date and informed of rulings affecting this constantly evolving area of the law.

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Posted: May 1, 2025