

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

By Lydia Deaton and Simon Lasker

So, what's new at the PTAB? Director reviving an IPR held to be abandoned, reliance on expert experiences, simultaneously using and criticizing a claim construction, and more!

The Director swooped in as the Board jumped the gun. Shenzhen Xinzexing E-Commerce Co., Ltd. v. Shenzhen Carku Technology Co., Ltd., IPR2024-00222, Paper 7 (July 10, 2024) (Vidal) (Director Vidal vacating the Board's Adverse Judgment against Patent Owner as being premature even though Patent Owner failed to timely file mandatory notice information and failed to respond to the Board's emails).

Personal stories of expert hold little water. Easebon Services, Ltd. v. Spin Master, Inc., IPR2023-01339, Paper 12 (July 9, 2024) (Vidal) (reversing and remanding the Board's decision to deny institution because the Board too heavily relied on an expert's personal experiences and did not address other evidence including simultaneous invention evidence).

Careful with that construction—it's a tripping hazard! Samsung Elecs. America, Inc. v. Cobblestone Wireless, LLC, IPR2024-00319, Paper 16 (June 24, 2024) (Cass, joined by Angles and Beamer) (denying institution partly because Petitioner based its showing of obviousness on a claim construction it ascribes to Patent Owner and simultaneously criticized as being inconsistent with the challenged patent).

The three most important rules of secondary considerations, nexus, nexus, nexus. Apple Inc v. Spacetime3D, Inc., IPR2023-00343, Paper 47 (July 2, 2024) (McShane, joined by McKone and Laney); (rejecting Patent Owner's for objective indicia of non-obviousness for failing to show a "nexus" between the secondary consideration and the claims); see also Viking Drill & Tool, Inc. v. Hongjia Wang, IPR2023-00473, Paper 82 (July 5, 2024) (Saindon, joined by Mayberry and Murphy) (same).

Grasping at a strawman. Viking Drill & Tool, Inc. v. Hongjia Wang, IPR2023-00474, Paper 89 (July 5, 2024) (Saindon, joined by Mayberry and Murphy) (rejecting Patent Owner's arguments that the

proposed modifications changed a reference's principle of operation by creating an unrelated undesirability when the proposed modification would still result in a working product).

Amend carefully or risk rejection by the Board. *AliveCor, Inc. v. Apple, Inc.*, IPR2023-00950, Paper 26 (July 11, 2024) (Kinder, joined by Barrett and Cocks) (issuing preliminary guidance finding Patent Owner's Motion to Amend unsatisfactory because amended claims contained new features and altered claim hierarchy, and thus were not substitute claims under 37 C.F.R § 42.121(a)(3)).

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