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

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So, what's new at the PTAB? Expert qualifications, proving reduction to practice, and denial of a motion to withdraw, and more!

General Relativity: Lack of experience in narrowly defined subject matter is not a reason to exclude an expert when the expert has general expertise in the area. Unified Patents, LLC v. Ideahub, Inc., IPR2020-01338, Paper 48 (February 7, 2022) (Moore, joined by Ullagaddi and Cygan) (rejecting Patent Owner's argument that an expert witness should be disqualified "based on an alleged distinction between the claimed technologies and [the expert's] experience," because the expert "exceeds the undisputed qualifications for one having ordinary skill in the pertinent art in this proceeding").

Empty Promises – of reduction to practice – are never good. Western Digital Corp. v. Martin Kuster, IPR2020-01410, Paper 49 (February 10, 2022) (Khan, joined by Giannetti and McKone) (finding that Patent Owner failed to show that an earlier reduction to practice antedated a reference, and explaining that the inventor's uncorroborated testimony that he completed a prototype was insufficient where his unwitnessed notebooks showed only that he sketched some elements of the invention and did not discuss the purported working prototype).

Petitioner can't break up with the PTAB before Valentine's Day: motion to withdraw denied. Innovex Downhole Solutions, Inc. v. Baker Hughes Oilfield Operations, LLC, IPR2019-00158, Paper 51 (February 11, 2022) (Flax, joined by Weatherly and DeFranco) (on remand from the Federal Circuit for the Board to give Patent Owner an opportunity to respond to obviousness theories for some dependent claims, the Board denied Petitioner's motion to withdraw because Petitioner did not request adverse judgment and the Board believed it was prudent for Petitioner to remain a party in the event that any issues arise with incorporating limitations of the independent claim into the dependent claims).

Want to take home the Gold in your obviousness-challenge? Then use caution when relying on statements in the background section to provide motivation for obviousness. Lumenis

Be Ltd. v. BTL Healthcare Technologies A.S., IPR2021-01275, Paper 8 (February 8, 2022)(Parvis, joined by Yang and Cotta) (finding that teachings in the background section of a reference pertained to only commercial available devices as opposed to a device according to the reference's invention and thus did not provide motivation for modifying the invention of the reference, and declining to institute trial).

Connect the motivation dots: Petitioner must show how the alleged advantages of adding a secondary reference would motivate the PHOSITA to combine it with the primary reference. Dish Network LLC v. Sound View Innovations, LLC, IPR2020-01276, Paper 40 (February 8, 2022) (Hudalla, joined by Lee and Stephens) (determining claims were not unpatentable, because Petitioner failed to show how alleged advantages for the secondary reference's system (an on-demand system) applied to the primary reference's system (a live streaming system)).

Flattery might get you nowhere: Graham **factors may require more than just industry praise.** Dolby Labs v. Intertrust Tech. Corp., IPR2020-00665, Paper 29 (February 1, 2022)(Zecher, joined by Khan and Ogden) (finding that evidence of industry praise—even if there is a nexus—"does not outweigh the other evidence considered as part of the Graham factors").

Houston, we have the wrong problem: A motivation to combine may need to have some relationship to the problem addressed by the target patent. Media Tek Inc. v. Nippon Telegraph and Telephone Corp. IPR2020-01404, Paper 31 (February 3, 2022) (Anderson, joined by Boudreau and Beamer) (finding that, when the problem addressed by the target patent was "cross-channel leakage [and] not speed of communication," a motivation to combine two references based on an alleged increase in speed was "broad and conclusory and lack[ed] specific evidence to support the motivation").

Houston, we have different solutions to the problem: Petitioner must articulate why a PHOSITA would combine two references that each already solve the same problem but in different ways. Helen of Troy Ltd. v. TOMY Int'l Inc., IPR2021-01208, Paper 8 (February 7, 2022) (Barrett, joined by Ippolito and Moore) (rejecting Petitioner's assertion that a PHOSITA would be motivated to look to a secondary reference in order to "avoid the disadvantages of a completely 'flexible' container," because the primary reference already addressed those same disadvantages in its own unique way—therefore the Petitioner failed to adequately articulate why the PHOSITA would be motivated to make the proposed modification to the primary reference).

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