

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

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Protective orders, secondary considerations, and the PTAB's new anonymous online form are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

Protective Orders. The Board declined to enter the proposed Protective Order when it did not expressly state that the Office may access "Outside Counsel Eyes Only–Protective Order Material." *NXP USA, Inc. v. Impinj, Inc.*, IPR2020-00544, Paper 11 (Sept. 28, 2020) (Weinschenk, joined by McNamara and Trock).

Secondary Considerations. The Board gave little weight to Patent Owner's secondary considerations of non-obviousness because: (i) the Patent Owner did not show a nexus between the claimed invention and the objective indicia of non-obviousness; and, (ii) the Patent Owner was not entitled to a presumptive nexus where it did not show that the evidence was tied to a specific product that is coextensive with the challenged claims. *Ingenico Inc. et al v. Ioengine, LLC*, IPR 2019-00929, Paper 53 (Sept. 21, 2020) (Roesel joined by McShane and Howard)

Correcting a Petition. The Board denied Petitioner's motion to correct alleged clerical errors in declarations supporting its petition where the errors were substantive in nature and would improve Petitioner's anticipation argument while prejudicing Patent Owner. *SweeGen, Inc. v. PureCircle Sdn Bhd*, PGR 2020-00070, Paper 9 (Sept. 22, 2020) (Wisz, joined by Mitchell and Chagnon).

Termination Granted Despite Real Parties in Interest Issue. The Board granted Petitioner's motion to terminate the proceedings prior to determining institution even though Patent Owner argued that termination of the proceeding would be prejudicial because it did not have the opportunity to determine whether Petitioner properly identified the real parties in interest and Petitioner may act as a proxy for its members. *Unified Patents, LLC v. Motion Offense, LLC*, IPR 2020-00705, Paper 14 (Sept. 23, 2020) (Boucher joined by McGraw and Khan)

Claim Construction. The Board denied Petitioner's request for rehearing when Petitioner's contention is recast under new claim construction, finding that a rehearing is not an opportunity for

Petitioner to recast its Petition. *MaxLite, Inc. v. Jiaxing Super Lighting Electric Appliance Co., Ltd.*, IPR2020-00181, Paper 9 (Sept. 29, 2020) (Moore, joined by Bisk and Dirba).

Supplemental Evidence. The Board denied Patent Owner's request to admit as evidence a declaration filed in another proceeding and found Patent Owner's request, made 18 days before the due date for the Final Written Decision, was untimely because it did not provide sufficient time for Petitioner to cross-examine the declarant, both parties to brief the significance of the declaration, and the Board to consider the new evidence and argument. *Apple Inc. v. Omni MedSci, Inc.*, IPR2019-00916, Paper 38 (Oct. 2, 2020) (Horvath, joined by Obermann and Fenick).

Nominating Precedential and Informative Decisions

In addition to the highlights above, we note that the PTAB recently introduced an anonymous online form that members of the public can use to nominate Board decisions to be designated as precedential or informative.

Precedential decisions establish binding" authority concerning major policy or procedural issues, or other issues of exceptional importance, including constitutional questions, important issues regarding statutes, rules, and regulations, important issues regarding case law, or issues of broad applicability to the Board.

Informative decisions provide Board norms on recurring issues, guidance on issues of first impression to the Board, guidance on Board rules and practices, and guidance on issues that may develop through analysis of recurring issues in many cases.

Previously, the public was required to submit nominations in writing with identifying information. The new anonymous form may be accessed at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/decisions>.

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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