

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

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Claim constructions for non-limiting terms, clerical mistakes in a petition, and good cause for a motion to expunge are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

Obviousness. When the actual disclosure in the prior art is unrelated to the claimed elements, mere attorney reasoning inconsistent with the actual disclosure in the prior art is insufficient to establish obviousness. *Zillow Group, Inc. et al v. International Business Machines Corp.*, IPR2020-01658, Paper 9, (March 22, 2021) (Cherry, joined by Kaiser and Peslak).

Claim Construction. Phrases beginning with “for instance,” “where some,” and “some” are “merely exemplary and non-limiting” in a claim construction analysis. *Juniper Networks, Inc. et al v. Packet Intelligence LLC*, IPR2020-00336, Paper 30, (March 22, 2021) (White, joined by Boudreau and Hamann).

Correction of Clerical Mistake. The Board granted petitioner's motion to file corrected petitions for inter partes review because the errors were clerical and correction would cause patent owner no prejudice. *Qualcomm Incorporated v. Monterey Research, LLC*, IPR2021-00120, Paper 12, (March 23, 2021) (Melvin, joined by Droesch and Horvath).

Business Method Review. Where the scope of the claims is centered on the idea of “currency trading” without sufficiently explaining how the specific steps recited in the claim are associated with the decision-making process inherent within “currency trading,” the idea of “currency trading” is deemed extremely broad and fails to recite patent-eligible subject matter under 35 U.S.C. § 101. *Gain Capital Holdings, Inc. v. Oanda Corporation*, CBM2020-00021, Paper 10, (March 18, 2021) (Arbes, joined by Medley and Mitchell).

Written Description. Claims discussing a multi-stage interconnection network that are in actuality comprised of a single stage interconnection network are rejected as failing to comply with the

written-description requirement under 35 U.S.C. § 112. Flex Logix Technologies Inc. v. Venkat Konda, PGR2019-00037, Paper 37, (March 16, 2021) (Boucher, joined by Boudreau and Beamer).

Motion to Expunge. Where documents contain confidential information, a party must show good cause for the motion to expunge by demonstrating that the party's interest in expunging outweighs the public's interest in maintaining a complete and understandable file history. Tetra Tech Canada Inc. v. Georgetown Rail Equipment Company, IPR2019-00619, Paper 45, (March 19, 2021) (Lorin, joined by Wood and Kalan).

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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