

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

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What's new at the PTAB? The effects of transferring parallel litigation, impacts of Patent Owner delays on Fintiv analysis, standing issues, and more!

A new court, a new trial schedule, no Board discretion? Google LLC v. Ikorongo Technology LLC et al., IPR2021-00205, (Paper 16) (January 25, 2022) (Moore, joined by Fenick and Belisle) (granting Petitioner's request for rehearing of discretionary denial of institution, and granting institution because Federal Circuit transferred parallel litigation out of the WDTX).

Those who live in glass houses... Uber Technologies, Inc. d/b/a Uber v. AGIS Software Development LLC, IPR2021-01306, (Paper 13) (January 26, 2022) (Ahmed, joined by Boudreau and Galligan) (denying request for rehearing and finding Patent Owner's argument — that the Petitioner should have filed its petition sooner— “unreasonable” because the Patent Owner took almost 4 months to file its asserted claims in the parallel district court litigation).

Disagreeing with the Board isn't enough. Google LLC f/k/a Google Inc. et al v. AGIS Software Development LLC, IPR2020-00871, (Paper 27) (January 26, 2022) (Laney, joined by Jefferson and Boudreau) (the Board did not overlook or misapprehend facts because a district court's willingness to consider a temporary stay at a hearing is not evidence it would stay the lawsuit and “mere disagreement” with the Board's opinion “is not a valid basis for reconsideration”).

Whatever you think it might make of you and me, the Board can make assumptions. Miami International Holdings, Inc. et al v. FTEN, Inc. et al, CBM2018-00020, CBM2018-00021, CBM2018-00031, (Paper 95) (January 27, 2022) (Sawert, joined by Kim, Petravick, Tornquist, Ippolito, and Trock) (denying request for rehearing because the Board did not err in assuming that the first step of analysis was satisfied in order to proceed to evaluating the second step).

Know the law: A claim can be broader than the disclosed embodiments. PNC Bank, N.A. v. United Services Automobile Assoc., IPR2021-01071, (Paper 21) (January 20, 2022) (McMillin, joined by Droesch and Dirba) (denying institution, and rejecting Petitioner's argument that the

challenged claim was not supported by the priority parent specification: a claim can be broader than embodiments disclosed in the priority specification).

Oh, you say a POSA would be skeptical, do you? Skepticism irrelevant if not tied to claim limitations. Slayback Pharma LLC v. Sumitomo Dainippon Pharma Co., Ltd., IPR2020-01053, (Paper 32) (January 20, 2022) (Yang, joined by Mitchell and Sawert) (determining all challenged claims unpatentable, according proper weight to commercial success evidence, but determining that other objective indicia of non-obviousness, such as skepticism regarding drug safety, while desirable, was not a claimed limitation and thus irrelevant).

Scour those archived databases for prior art. A POSA would. Cradlepoint, Inc., et. al. v. Sisvel Int'l S.A., IPR2020-01103, (Paper 46) (January 18, 2022) (Moore, joined by McMillin and Ullagaddi) (determining all challenged claims unpatentable, crediting prior art found on a standards organization website as a printed publication, because a POSA working in the field would have been aware of the website, looked to it as a repository of relevant information, and located the relevant materials with reasonable diligence).

Talking out of both sides of your mouth, Petitioner? Might work on ownership issues. Trienda Holdings LLC v. Desgagnés, Brown ET Associés Inc., IPR2021-01295, (Paper 10) (January 25, 2022) (Mayberry, joined by Derrick and Abraham) (granting institution, rejecting Patent Owner's argument that Petitioner lacked standing because it asserted ownership of the patent in the parallel district court litigation, and holding that the Patent Owner—and not Petitioner – was the registered owner of the patent when Petitioner filed the Petition).

Incomplete excerpts won't cut it. 3Shape A/S et al. v. Align Technology, Inc., IPR2021-01240, (Paper 15) (January 27, 2022) (Mayberry, joined by Jung and Powell) (granting institution because Patent Owner relied on incomplete excerpt from Notice of Allowance that ignores other language establishing prosecution history does not demonstrate PTO already found the prior art fails to disclose certain claim limitations).

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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