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

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In this installment of the PTAB Highlights, Banner Witcoff examines recent decisions at the PTAB featuring: motions for additional discovery, the co-pendency requirement for claiming priority, joinder, and more!

Motions for Additional Discovery—Make 'Em Narrow, Specific, and Targeted. Wolfspeed, Inc. v. Cao Lighting, Inc. , IPR2022-00847, Paper 27 (Dec. 21. 2022) (Range, joined by Obermann and Kaiser) (weighing the five Garmin factors and denying motion for additional discovery of four requests for documents related to the petitioner's products accused of infringement in parallel district-court litigation because requests were ambiguous, overly broad, not related to claimed features, and directed to publicly available information).

No Break In The Co-Pendency Chain—Potential Anticipation Avoided. Tesla, Inc. v. Arsus, LLC, IPR2022-01216, Paper 9 (Dec. 23, 2022) (Jung, joined by Marschall and Melvin) (finding the petition's cited reference, a U.S. patent, did not qualify as prior art because it was in the familial chain of the challenged patent; and finding that the co-pendency requirement was not broken and that a non-published U.S. application was not statutorily abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii), even though a PCT application filed the next day included the same drawings and embodiments, because the PCT application did not reference the U.S. application and included additional disclosure not present in the U.S. application).

Why waste time when efficiency favors joinder. MSN Laboratories Private Limited et al v. Bausch Health Ireland Limited, IPR2023-00016, Paper 15 (December 14, 2022) (Valek, joined by Hulse and Hardman) (granting Petitioner's motion to join an existing IPR that was instituted less than one month prior and that raised the same unpatentability grounds as the instant petition because "[e]fficiency favor[ed] addressing these challenges in a joined proceeding").

Don't Suppress Any Limitations When Challenging a Noise-Suppression Patent. Apple, Inc. v. Jawbone Innovations, LLC, IPR2022-01147, Paper 11 (Dec. 27, 2022) (Repko, joined by Braden and Dirba) (denying institution when challenged claims recited "generating at least two transfer functions," when the primary reference disclosed only one transfer function, and the petition failed to explain why it would have been obvious to use two transfer

functions instead of one, or why using two transfer functions would have enhanced the primary reference).

Early stage litigation will not derail inter partes review**.** Nearmap US, Inc. v. Eagle View Technologies, Inc., IPR2022-01009, Paper 7 (December 14, 2022) (Cass, joined by Giannetti and Baer) (granting institution of inter partes review where Patent Owner argued that institution should be denied because of a related district court litigation but that litigation was in the early stages and the district court trial would likely occur after the PTAB final written decision).

IPR's can be instituted over previously considered art. Matsing, Inc. v. All.Space Networks Limited f/k/a Isotropic Systems, Ltd., IPR2022-01108, Paper 9 (December 14, 2022) (Jurgovan, joined by Easthom and Zecher) (granting institution of inter partes review over Patent Owner's argument that the Examiner had already considered the subject matter of the asserted art, crediting Petitioner's argument that the Office overlooked or misapprehended any alleged cumulative teachings of the asserted art).

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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Posted: January 17, 2023