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

By Roshan Bhattarai and Craig Kronenthal

Using dictionary definitions, expert's refusal to be deposed, and machine translations are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

Dictionary Definitions and Installation Instructions Not Hearsay in IPR Proceedings. The Board held that dictionary definitions and installation instructions offered as evidence of the meaning of terms as understood by a person of ordinary skill should not be excluded as hearsay. These definitions and instructions were not offered for truth of any statement or assertion and were similar to prior art, which is not considered hearsay when offered to provide what it describes as the state of the art. Trend Micro Inc., v. Cupp Computing AS, IPR2019-00764, Paper 34 (Aug. 25, 2020) (Giannetti, joined by Baer and Fenick).

Circumstances Impacting Discretion to Deny Institution. Extensive prosecution history and high number of claim constructions (10) in related district court litigation were contributing factors to Board's balancing of the Finitiv factors and finding that it would be an inefficient use of resources to institute trial. Google LLC v. Personalized Media Communications, LLC, IPR2020-00719, Paper 16 (Aug. 31, 2020) (Braden, joined by Jurgovan and Horvath).

Expert's Refusal to Be Deposed Leads to Exclusion of Declaration. To support the authenticity and public accessibility of two industry standards, Petitioner submitted a declaration that was obtained, in a related district court litigation, by subpoenaing a third party witness from Norway. Patent Owner sought to depose the declarant, but he refused to be deposed before the Patent Owner Response deadline and Petitioner could not compel him to appear. The Board granted Patent Owner's motion to exclude the declaration as inadmissible hearsay given that Petitioner

failed to make the declarant available for cross-examination. Adobe Inc., v. RAH Color Technologies LLC, IPR2019-00627, Paper 124 (Aug. 31, 2020) (Ippolito, joined by Engels and Hudalla).

Institution Denied Where Board Finds Prosecution History Indicates Examiner Considered Written Description Support. Petitioner relied on the great-grandparent publication to challenge all claims and asserted that the claims were not supported. The Board reasoned that the examiner considered the issue of written description support in the great-grandparent based on the examiner's interview summary indicating that claims were discussed in view of the specification and the examiner's amendment entering the claims. The Board then exercised its discretion to deny institution on the basis that the art and arguments are the same or substantially the same as those made during original prosecution. Apple, Inc., v. Seven Networks, LLC, IPR2020-00425, Paper 10 (Sept. 1, 2020) (Dang, joined by Easthom and Chang).

Institution Denied for Failure to Provide Affidavit Attesting to Accuracy of Submitted Translations. Petitioner relied on foreign language references in support of the asserted grounds of patentability. Petitioner submitted machine translations of the foreign language references without providing affidavits attesting to the accuracy of the translation under 37 CFR § 42.63(b). The Board denied institution because the Petitioner did not establish a reasonable likelihood of prevailing as to at least one challenged claim due to the lack of the required affidavits. Shenzhen Aurora Technology Co., Ltd., v. Putco, Inc., IPR2020-00670, Paper 10 (Aug. 27, 2020) (McMillin, joined by Arbes and Haapala).

Some Overlap Between Prior Art Arguments in Prosecution and in IPR Petition Does Not Preclude IPR Institution. Patent Owner contended that there were similarities between the prior art arguments made during prosecution of the patent and the arguments being presented in the IPR petition. The Board held that some overlap is to be expected because the same claims are being analyzed in both cases. The Board instituted IPR because there were salient differences between the arguments despite the overlap. Netflix, Inc., v. Divx, LLC, IPR2020-00558, Paper 10 (Aug. 26, 2020) (Turner, joined by Gerstenblith and Ahmed).

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