

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

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Scope of Petitioner's Reply, enablement arguments in post-grant review, and supplemental information are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

Scope of Petitioner's Reply. Statements made by Patent Owner in two telephone conferences, which occurred after Patent Owner's Response had been filed, do not broaden the scope of Petitioner's Reply to Patent Owner's Response. *Lenovo Holding Company, Inc., et al v. DoDots Licensing Solutions LLC*, IPR2019-01278, IPR2019-01279, Paper 25 (Sept. 9, 2020) (Fenick, joined by Worth and Hagy).

Enablement in PGR. Arguments that merely focus on the inventor's state of mind when interpreting the specification, while ignoring the knowledge of a person of ordinary skill in the art, do not establish lack of enablement. *BASF Corporation v. Ingevity South Carolina, LLC*, PGR2020-00035, Paper 11 (Sept. 10, 2020) (Heaney, joined by Crumbley and Kaiser).

Claim Construction. Patent Owner contended that the word "computer" introduced in the construction of a claim element leads to ambiguity because the "computer" could be either a portable device or terminal. The Board held that not specifying a single computer for claim construction does not add ambiguity into the claims. *Ingenico Inc. et al v. IOENGINE, LLC*, IPR2019-00416, Paper 62 (Sept. 10, 2020) (Howard, joined by Roesel and McShane).

Discretionary Denial. The Board denied institution under 35 U.S.C. § 314(a) because the district court trial concluded more than one year before the Board would reach a final decision if inter

partes review was instituted and because considerable effort was expended in preparing for and conducting the district court trial. *Apple Inc. v. Optis Wireless Technology, LLC*, IPR2020-00466, Paper 13 (Sept. 15, 2020) (Parvis, joined by Pettigrew and Pinkerton).

Supplemental Information. The Board denied Patent Owner's motion to submit standards as supplemental information because Patent Owner was aware of the standards for some time and because Petitioner would not have an opportunity to respond. *Polycom, Inc. v. directPacket Research, Inc.*, IPR2019-01235, Paper 56 (Sept. 14, 2020) (Cass, joined by Moor and McShane).

Real Party in Interest. The Board rejected Patent Owner's argument that the petition failed to identify all real parties in interest because mere establishment of parent-company status is insufficient to render a non-party an RPI. *Syngenta Crop Protection AG v. FMC Corporation*, PGR2020-00028, Paper 8 (Sept. 15, 2020) (Hardman, joined by Mitchell and Yang).

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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