

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

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So, what's new at the PTAB? Denying speculative discovery, using prior art cited in a child application to dodge institution, hypothetical future litigation, and more!

Hey, what do you have there!? Just because your adversary's witness has a document with them while testifying, doesn't mean you get that document in discovery.

Shenzhen Buxiang Network Tech. Co., Ltd. v. Ideal Time Consultants Ltd., IPR2021-00080, (Paper 36) (January 13, 2022) (Scanlon, joined by Barrett and Browne) (denying Petitioner's Motion for Additional Discovery seeking two documents that Patent Owner's witness had with him while testifying, holding that the Petitioner failed to show that the witness's reliance on the first document influenced his testimony (as required under Federal Rule of Evidence 612(a)(1)); that discovery of the second document, even if the second document influenced his testimony, is in the interest of justice (as required under Federal Rule of Evidence 612(a)(2)); or that the two documents would ultimately provide useful information (as required under the Garmin factors for determining if additional discovery is appropriate)).

Timing is everything: It's when **"previously presented" prior art is presented that matters, not** whether **it was presented during prosecution of a related patent application.** *IronSource Ltd. v. Digital Turbine Inc.*, PGR2021-00096, (Paper 14) (January 6, 2022) (Ahmed, joined by Deshpande and Ullagadi) (refusing to deny petition under 35 U.S.C. § 325(d), and rejecting Patent Owner's argument that Petitioner had already "previously presented" (under § 325(d)) the same art to the Office when it cited art presented during prosecution of a child patent application, the Board finding that the prior art was presented during prosecution of the child application after the petition at issue had already been filed, and thus Petitioner had not "previously presented" that art under § 325(d), as that term only refers to art presented to the Office before the filing of the petition at issue).

You can stop looking into your crystal ball, Patent Owner: A "hypothetical" future district court litigation won't stop an IPR. *Fresenius Kabi USA, LLC v. Chugai Seiyaku Kabushiki Kaisha, Inc.*, IPR2021-01024, (Paper 23) (January 6, 2022) (Franklin, joined by New and Yang) (rejecting the Patent Owner's request to deny institution under 35 U.S.C. § 314(a) where there was no currently existing parallel litigation between the parties and despite the Patent Owner's contention that future litigation was all but guaranteed).

Patent Owners: You can't prevent IPR institution simply by raising real parties-in-interest issues. *Unified Patents, LLC v. Dolby Laboratories Licensing Corp.*, IPR2021-00275,

(Paper 37) (January 11, 2022) (Fenick, joined by Moore and Ahmed) (denying Patent Owner's Request for Rehearing on decision to institute IPR, rejecting Patent Owner's argument that institution should be denied because the Petitioner failed to identify all relevant RPis, holding that the RPI issue can be decided after institution).

Oh, you disagree with the Board's analysis, do you? Too bad! Disagreement is an insufficient basis for a Rehearing. Schaeffler Group USA, Inc. v. BorgWarner Ithaca LLC , IPR2020-01482, (Paper 15) (January 11, 2022) (Meyers, joined by Scanlon and Finamore) (denying Petitioner's Request for Rehearing because Petitioner failed to show that the Board misapprehended the evidence and the Petitioner's mere disagreement with the Board's analysis was not enough to show that the Board abused its discretion).

There's always room for improvement: Petitioners can rely on two references to show obviousness even though they teach the same thing so long as the second reference offers an improvement. DraftKings Inc. v. Interactive Games, LLC , IPR2020-01107, (Paper 39) (January 4, 2022) (Barett, joined by Hoskins and Laney) (determining all challenged claims unpatentable, rejecting Patent Owner's argument that a POSA would not have looked to a secondary reference because the secondary reference taught the same functionality as the primary reference and the primary reference's teaching was sufficiently adequate, the Board holding that a POSA would have looked to the secondary reference because it nevertheless improved on the relevant functionality).

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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