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

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So, what's new at the PTAB? Discretionary denial based on experts' unwillingness to participate, granting institution of multiple petitions, denial of a delayed petition, and more!

Is your expert on board? The Board can deny your IPR petition if it appears that your expert witness will not be willing to participate in the proceeding. OpenSky Industries, LLC v. VLSI Technology LLC, IPR2021-01056, Paper 18 (December 23, 2021) (Melvin, joined by Giannetti and McNamara) (The Board denied institution of inter partes review under 35 U.S.C. § 314(a) because the Board did not consider the Petitioner's expert likely to be a willing participant in the proceeding because the Patent Owner has shown that the Petitioner's expert has agreed to work exclusively for a party other than the Petitioner, and the Petitioner has not provided any factual support from the Petitioner's expert or the other party showing that the Petitioner's expert would be released from his obligation to the other party).

Patent Owner can add new claims. NXP USA, Inc. f/k/a NXP Semiconductors USA, Inc. v. Impinj, Inc., IPR2020-01062, Paper 31 (December 13, 2021) (Barrett, joined by Weinschenk and Trock) (granting Patent Owner's motion to add substitute claims where the claims did not broaden the scope and were supported by the written description).

If you want your motion to amend granted, your proposed substitute claims better be patentable. Wirtgen America, Inc. et al v. Caterpillar Paving Products, Inc., IPR2018-01200, Paper 47 (December 20, 2021) (Browne, joined by Mayberry and Marschall) (On remand, the Board again denied

Patent Owner's motion to amend because the proposed substitute claims were unpatentable under 35 U.S.C. § 103).

You better have a darn good reason: In seeking rehearing, the Petitioner must sufficiently establish that there is a reasonable likelihood that the claims are unpatentable. TCL Industries Holdings Co., Ltd. v. Koninklijke Philips NV, IPR2021-00547, Paper 12 (December 23, 2021) (Cass, joined by Turner and White) (The Board denied Petitioner's request for rehearing of the decision denying institution of inter partes review because the Petitioner failed to establish that the Board had incorrectly rejected the Petitioner's motivation-to-combine arguments in the Petition).

File away! Filing multiple petitions can be OK. Hanwha Solutions Corporation f/k/a Hanwha Q CELLS & Advanced Materials Corp. II et al v. REC Solar Pte Ltd., IPR2021-00989, Paper 12 (December 13, 2021) (Range, joined by Obermann, and Kaiser) (granting institution of multiple petitions where each petition was strong on the merits and the two petitions were not overly burdensome for the Patent Owner to respond to).

Time is of the essence: Delaying filing your additional petitions can doom them. Micron Technology, Inc. et al v. Unification Technologies LLC, IPR2021-00940, Paper 14 (December 15, 2021) (Ogden, joined by Arbes and McMillin) (denying institution of inter partes review of a second petition directed to the same claims as a first petition where the second petition was filed after the Patent Owner had filed its preliminary response to the first petition and where the Petitioner had been aware of the prior art asserted in the second petition for at least ten months before filing the second petition).

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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