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

By Yousef AlMesad and Hayden Kunz

So, what's new at the PTAB? In this installment of the PTAB Highlights, Banner Witcoff examines recent PTAB decisions featuring: proving a reference constitutes prior art, institution denial in view of parallel litigation, reliance on art similar to what was considered during prosecution, and more!

Don't just declare it, bring exhibits! Sophos Ltd. and Sophos Inc. v. Open Text Inc., IPR2023-00731, Paper 23 (November 2, 2023) (Raevsky, joined by Arbes and Parvis) (denying institution because Petitioner failed to meet its burden of showing the reference alleged to be prior art was publicly accessible before the priority date of the patent at issue by not filing webpage links as exhibits and relying on expert declaration that did not cite adequate evidence of public accessibility).

A picture is not always worth a thousand words—put the proof in writing. Guangdong Laitu Imaging Technology Co., Ltd. v. Really Right Stuff, LLC, IPR2023-00853, Paper 13 (October 25, 2023) (O'Hanlon, joined by Browne and Daniels) (denying institution because Petitioner attempted to establish that publication dates of multiple references preceded critical date by screen capturing modifiable date entries and failed to use expert declaration to establish reliability of data—Petitioner also failed to clearly map every claim element to surviving references and relied exclusively on attorney argument to establish obviousness).

Don't put all your eggs in one basket. Zhuhai CosMx Battery Co., Ltd. V. Ningde Amperex Technology Ltd., IPR2023-00585, Page 12 (October 24, 2023) (Kalan, joined by Praiss and Abraham) (denying institution because parallel district court trial date was about eight months before PTAB statutory deadline and investment in parallel district court proceeding at time of the institution decision was great).

You can't play the greatest hits twice! Nokia of America Corp. v. Alexander Soto and Walter Soto, IPR2023-00680, Paper 10 (November 3, 2023) (Dang, joined by Boucher and Baer) (denying institution because Petitioner presented substantially the same art and arguments previously analyzed during prosecution, and failed to show the Office erred during prosecution).

That word does not mean what you think it means. Telefonaktiebolaget LM Ericsson et al v. K. Mizra LLC, IPR2022-00730, Paper 23 (October 26, 2023) (Ahmadi, joined by Engels and Moore) (holding claims not unpatentable under 35 U.S.C. § 102 because Petitioner's reference only taught using single input at a time, but patent claim referred to processing three inputs at the same time).

This time there was no lack of motivation. Abbott Diabetes Care Inc. v. Dexcom, Inc., IPR2022-00921, Paper 45 (November 2, 2023) (Weatherly, joined by Tartal and Laney) (finding all challenged claims unpatentable in part because Petitioner demonstrated that an ordinarily skilled artisan would have been motivated to combine the teachings of the prior art references proposed by Petitioner).

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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