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

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In this installment of the PTAB Highlights, Banner Witcoff examines recent decisions at the PTAB featuring: inconsistent arguments in a petition, finding written description support in figures, the Board instituting review despite an earlier trial date in related litigation, and more!

Inconsistent Arguments Sink Petition! Guardant Health, Inc. v. University of Washington Through its Center for Commercialization, IPR2022-00450, Paper 13 (August 1, 2022) (Yang, joined by New and Hulse)(institution denied where Petitioner sought to combine distinct prior art embodiments to teach one claim limitation but argued elsewhere in the petition that "it is not allowable to create an artificial starting point by mixing & matching features from distinct embodiments to create an undisclosed hybrid.")

A picture is worth a thousand words. IronRidge Inc. v. Pegasus Solar Inc., PGR2022-00024, Paper 9 (August 10, 2022) (Jeschke, joined by Melvin and Daniels) (institution denied where Petitioner asserted lack of written description of a structure as claimed, finding figures adequately show the structure and that the inventors had possession of the subject matter).

Two bites of the same apple; IPR and the district court's concurrent proceedings. Google LLC v. Ecofactor, Inc., IPR2022-00473, Paper 7 (August 3, 2022) (Howard, joined by Korniczky and Dougal) (declining to exercise authority to deny institution despite an earlier anticipated trial date after analyzing six Fintiv factors and instituting an inter partes review, finding a reasonable likelihood of success in proving at least one claim unpatentable).

Thinking about not filing a preliminary response? Think again. Amazon.com, Inc. v. M2M Solutions LLC, IPR2022-00260, Paper 8 (August 3, 2022) (Laney, joined by McKone and Easthom)

(granting institution for an inter partes review where the Patent Owner waived its right to file a preliminary response to the petition and the Board accepted Petitioner's contention that the challenged claims did not present materially different questions of patentability than claims in a related patent that the Board previously found unpatentable).

Priority in the Specification saves the day. Thorne Research, Inc. v. Trustees of Dartmouth College, IPR2021-00491, Paper 48 (August 10, 2022) (Schneider, joined by Mitchell and Paulraj) (finding priority claim in the specification to an earlier application satisfied 35 U.S.C. §120 and finding claims not unpatentable because the references relied on in the Petition were not available as §102(a) or (3) prior art as Petitioner failed to establish the references were "the work of another").

Hear me out: no rehearing. Revance Therapeutics, Inc. v. Medy-Tox, Inc., IPR2021-01204, Paper 13 (August 4, 2022) (Yang, joined by Majors and Newman) (denying Petitioner's request for rehearing due to Petitioner's lack of showing that the Board misapprehended or overlooked claim language, prior art teachings, or expert testimony).

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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