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

By Paul Ansani and Leon Cao

In this installment of the PTAB Highlights, Banner Witcoff summer associates examine recent decisions at the PTAB featuring: the interplay between PGR and IPR, Board discretion to consider a new ground against a substitute claim, the consequences of translation errors, and more!

No two bites at the PTAB apple. Home Depot USA, Inc. v. Lynk Labs, Inc. , IPR2022-00143, Paper 17 (May 27, 2022) (Ullagaddi, joined by Tornquist and Raevsky) (denying institution of an IPR under § 314(a) because there was a post-grant review (PGR) applying the same prior art combinations that had already been instituted, explaining that instituting both the PGR and the IPR could lead to potentially inconsistent records on identical prior art challenges).

Examiner missed a piece of prior art? Not their problem. Code200, UAB et al v. Bright Data Ltd., IPR2022-00103, Paper 7 (June 1, 2022) (McShane, joined by Giannetti and Cass) (instituting IPR where a relevant piece of prior art was missed in the prosecution of a patent suggesting a material error by the USPTO and weighing in favor of the PTAB's discretion to grant institution.)

It's important for petitioners to tell a story. Synthego Corporation v. Agilent Technologies Inc., IPR2022-00403, Paper 12 (May 31, 2022) (Valek, joined by Pollock and Cotta) (instituting IPR because the Petitioner told a compelling story about how a newly relied-on reference undermined the arguments that the Applicant had made during prosecution of the patent to overcome the Examiner's rejection).

Request for a rehearing of a final written decision is not an opportunity to reargue. Analog Devices, Inc. v. Xilinx, Inc. et al . IPR2020-01606, Paper 65 (June 3, 2022) (Galligan, joined by Horvath and Cass) (denying Petitioner's request for rehearing of the final written decision and granting patent owner's motion to amend where Petitioner argued that the Board had discretion to apply a ground of unpatentability based on five references against a substitute claim even though Petitioner did not challenge that claim based on such ground).

A good investment? Pointing to a claim construction order from a parallel proceeding may not be enough to deny institution. Unified Patents, LLC v. Mirror Imaging, LLC, IPR2022-00184, Paper 9 (May 26, 2022) (Cygan, joined by Easthom and Arbes) (granting institution and rejecting Patent Owner's argument that the district court's

"investment" of time and resources in issuing a claim construction ruling in a parallel proceeding weighed against institution, explaining that the claim construction order did not in fact show a "high level of investment of time and resources").

Lost in translation. Yita LLC v. MacNeil IP LLC, IPR2020-01142, Paper 82 (May 26, 2022) (Woods, joined by Weatherly and Peslak) (determining that challenged claims were not unpatentable, explaining that Petitioner's reliance on its translator's interpretation of a French Patent Document as teaching the claimed "sides" limitation was misplaced because the translator mistranslated a term from the French Patent Document to mean "sides" when the correct translation of the term was "flanges").

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.

Banner Witcoff is recognized as one of the best performing and most active law firms representing clients in inter partes review (IPR) proceedings. To learn more about our team of seasoned attorneys and their capabilities and experience in this space, click here.

Posted: June 14, 2022