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

By Jordan Bodner and Scott Burow

In this installment of the PTAB Highlights, Banner Witcoff examines recent decisions at the PTAB featuring: references previously considered, enablement of amended claims, ownership challenge estoppel, discretionary denial and more!

Reference not meaningfully addressed during prosecution. ironSource Ltd. v. Digital Turbine, Inc., PGR2022-00053, Paper 10 (March 17, 2023) (Ahmed, joined by Deshpande and Ullagaddi) (granting institution based on reference previously considered after allowance, finding that Office erred by failing to "meaningfully address" asserted reference, as evidenced by Examiner's "cursory statement" about the reference and the reference's "compelling" disclosure).

Not different enough to obtain institution. Ivantis, Inc. et al v. Sight Sciences, Inc.,IPR2022-01533, (Paper 14) (March 27, 2023) (Jenks, joined by Mitchell and Yang) (denying institution, and rejecting Petitioner's argument that the asserted prior art reference was not considered during prosecution by finding that the Examiner considered other similar references).

If you tell the Board a claim is impossible, you'd better back it up. Simpson Strong-Tie Company Inc. v. Columbia Insurance Company, PGR2021-00109, Paper 73 (March 15, 2023) (Belisle, joined by Daniels and Powell) (granting in part Patent Owner's motion to amend claims, finding that claims were enabled despite Petitioner's argument that substitute claims lacked critical feature and were therefore "impossible," and where Petitioner did not sufficiently address broad disclosure that omitted the allegedly critical feature).

No estoppel with patent title challenge. ecobee Technologies ULC d/b/a ecobee v. Causum Enterprises, Inc., IPR2022-01339, (Paper 20) (March 22, 2023) (Quinn, joined by McNamara and

Hudalla) (granting institution, and rejecting Patent Owner's argument that judicial estoppel applied based on Petitioner's ITC challenge to Patent Owner's title claim by finding that Petitioner's filing of the IPR does not mean Petitioner is contradicting itself from the ITC proceeding).

Winning once not good enough. Salem Fabrication Technologies Group, Inc. v. Uniglass Engineering Oy, IPR2022-01517, (Paper 9) (March 22, 2023) (Praiss, joined by Roesel and McGee) (denying institution on discretionary grounds, and determining that it is not efficient use of the Board's time and resources if the Petitioner has a chance of winning, at best, one out of 46 challenges, one out of 15 claims and one out of seven grounds).

Time is (not) on your side. Google LLC v. Jawbone Innovations, LLC, IPR2022-00889, Paper 14 (March 20, 2023) (Dirba, joined by Braden) (denying rehearing where Petitioner argued that a later-entered decision in a related IPR was inconsistent, because Board "cannot have abused [its] discretion by failing to consider a decision that had not yet issued.") (Repko dissenting).

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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