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

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So, what's new at the PTAB? Mental process steps combined with practical application patentable under 35 § USC 101, delaying the filing of an IPR until after the PGR deadline, the need for corroborating evidence in support of provisional application drafting, and more!

Rock-solid concept. DynaEnergetics Europe GmbH v. QinetiQ Limited, PGR2023-00003, Paper 19 (April 11, 2024) (Capp) (DeFranco, concurring) (Saindon, dissenting) (claims that recite mental process steps followed by a "forming" step are not unpatentable over 35 § USC 101, because the claimed forming is directed to the concept of "forming an actual, physical 3-dimensional liner that can be used with an explosive charge to perforate a rock structure," which "can hardly be considered insignificant extra-solution activity that is merely ancillary to performing a mental process" and "which is a practical application of the abstract ideas").

PTAB moves forward given uncertainty of related litigation. Google LLC et al. v. Multimodal Media LLC, IPR2024-00056, Paper 9 (April 12, 2024) (Raevsky, joined by Saindon and Powell) (declining to exercise discretion to deny institution in view of related District Court litigation, despite litigation having an earlier trial date than PTAB's statutory deadline and not currently under stay, due to "uncertainty of that trial date, the current lack of progress of the District Court litigation, and the lack of overlapping issues").

Unspoken error. Dexcom, Inc. v. Abbott Diabetes Care Inc. f/k/a TheraSense, Inc., IPR2023-01409, Paper 10 (April 15, 2024) (Hardman, joined by New and Flax) (declining to exercise discretion to deny institution of petition relying on references made of record during prosecution, despite Petitioner not specifically stating that examiner erred in failing to reject claims over those references, because Petitioner made a showing of material error in view of the record as a whole).

Design choice could be the wrong choice for showing obviousness. Dexcom, Inc. v. Abbott Diabetes Care Inc., IPR2023-01396, Paper 13 (April 16, 2024) (New, joined by Flax and Hardman) (declining institution and finding unpersuasive Petitioner's argument that it would have been an obvious design choice to implement two spaced apart recesses instead of one).

Ok to delay filing petition to choose IPR over PGR. Bazooka-Farmstar, LLC v. Nuhn Industries Ltd., IPR2024-00004, Paper 12 (April 16, 2024) (Meyers, joined by Petravick and Dougal) (declining to exercise discretion to deny institution and not faulting Petitioner for waiting to file its petition as an IPR instead of a PGR even though Petitioner delayed the filing until after Patent Owner filed a preliminary response in an IPR for a related patent).

Do your diligence. Tesla, Inc. v. Charge Fusion Technologies, LLC, IPR2023-00062, Paper 35 (April 16, 2024) (Plenzler, joined by Petravick and DeFranco) (rejecting Patent Owner's attempt to establish constructive reduction to practice to antedate a reference that was filed less than one month before a provisional application of the subject patent because Patent Owner failed to provide corroborating evidence of diligence during the drafting of the provisional).

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