

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: PTAB jurisdiction over expired patents, the impact of certificates of correction after a final written decision, institution grant analysis and more!

Expired patent may be subject to IPR. Google, LLC f/k/a Google Inc. et al v. Robocast. Inc. , IPR2023-00590, Paper 12 (September 18, 2023) (McKone, joined by Boucher and Cygan) (rejecting Patent Owner’s argument that the Board lacked jurisdiction because the patent being petitioned was expired, and denying institution on other grounds).

Retroactive certificate of correction does not impact a final written decision. Sonos, Inc. v. Implicit, LLC, IPR2018-00766, Paper 67 (Sept. 19, 2023) (McShane, joined by Wormmeester and Khan) (finding that judicial estoppel and waiver defeated the retroactive effect of certificates of correction and holding that the certificates of correction had no impact on the final written decisions finding all challenged claims unpatentable).

That’s a weak stipulation. Crowdstrike, Inc. v. Open Text Inc. , IPR2023-00556, Paper 9 (September 12, 2023) (Baer, joined by Moore and Raevsky) (granting institution, and declining to discretionarily deny institution even though Petitioner’s stipulation not to pursue parallel issues in related litigation fails to rise to the level required by Interim Procedure, with mitigating factors including that the litigation is in early discovery stages and some claims addressed in the Petition are not addressed in the litigation).

But that’s just your normal, everyday evidence. Nespresso USA, Inc. v. K-Fee System GmbH, IPR2023-00485, Paper 9 (September 13, 2023) (Tornquist, joined by Obermann and Mayberry) (granting institution despite petition asserting references already cited during prosecution, and despite determining that an expert declaration alleging examiner error vis-à-vis the references does not constitute “additional evidence and facts” warranting reconsideration of prior art or arguments set forth in Becton Dickinson factor (f); such a declaration is merely “the type of additional evidence that is part of most inter partes review proceedings”).

Whether a priority application confers written description support can be a razor-thin line. The Gillette Co. LLC v. Sphere USA, LLC , PGR2022-00030, Paper 31 (Sept. 19, 2023) (Mayberry, joined by Lorin and Jung) (vacating institution decision sua sponte and crediting Patent Owner’s expert’s testimony in finding that the challenged patent was entitled to the

priority of a grandparent application).

Patent Owner's silence can be deadly when responding to Petitioner. NetNut Ltd. et al v. Bright Data Ltd. f/k/a Luminati Networks Ltd., IPR2021-01493, Paper 55 (Sept. 25, 2023) (McShane, joined by Giannetti and Cass) (finding all claims unpatentable in a final written decision, several of which Patent Owner did not address in response to Petitioner's arguments).

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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