

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

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So, what's new at the PTAB? In this installment of the PTAB Highlights, Banner Witcoff examines recent PTAB decisions featuring: Reliance upon terms defined or not defined by the specification, prior art, and more!

Expectations Matter! *Eli Lilly and Company v. Teva Pharmaceuticals International GmbH*, IPR2022-00796, Paper 45 (October 11, 2023) (Cotta joined by Majors and Wisz) (holding claims of patent directed to a treatment method for migraines in difficult to treat patients unpatentable as obvious because the person of skill in the art had a reasonable expectation of success from combining prior art compounds).

“Defining” the defined terms of a claim within reason. *Apple Inc. v. Cpc Pat. Techs. Pty, Ltd*, IPR2022-00600, Paper 22 (Oct. 13, 2023) (Daniels, joined by Hagy and Laney) (rejecting Petitioner’s arguments that the words “find” and “identifying” explain the term “define,” where Patent Owner argued that “defining” means “setting” or “establishing.” “We don’t take issue with the alternative words specifically, but we observe that considering all the alternatives is repetitive and can lead to confusion because there are now 24, i.e., (4x3x2x1) permutations of the words/terms ‘setting,’ ‘establishing,’ ‘contingent upon,’ and ‘determined by,’ apparently deemed necessary to understand, what on its face, is not a particularly unwieldy claim recitation.”).

“Firmly” established that additional construction is unnecessary. *Arthrex, Inc. v. P Tech, LLC*, IPR2022-00717, Paper 27 (Oct. 13, 2023) (Hardman, joined by Snedden and Wormmeester) (Board declined to include “firmly” in construction of claim term “secure” because this additional qualification was unnecessary “to resolve the disputes pertinent to [the] Decision,” citing *Realtime Data, LLC*, 912 F.3d at 1375 (the Board need construe terms “only to the extent necessary to resolve the controversy”)).

Bathroom Teachings. *Safran Cabin Inc. f/k/a C&D Zodiac, Inc. v. B/E Aerospace, Inc.*, IPR2022-00749, Paper 28 (October 18, 2023) (Marschall, joined by Daniels, and DeFranco) (Board found claims unpatentable because Patent Owner failed to identify where cited reference actually taught away from claimed bathroom wall shape by criticizing or discouraging it).

Integrate to Differentiate. *Google LLC, Petitioner, v. Mira Advanced Tech. Sys., Inc.*, IPR2022-00742, Paper 28 (Oct. 20, 2023) (White, joined by Hudalla, and Kenny) (Board found claims of a patent directed to a personal organizer with GPS locator unpatentable in part

because the patent did not claim “integration” or necessarily require “integration” as described in the specification and, therefore did not distinguish the claims from the prior art.)

Traffic Jam. Cerebras Systems Inc. v. Rex Computing, Inc., IPR2022-00741, Paper 37 (October 11, 2023) (Cygan, joined by Zecher and Dirba) (holding challenged claims for a multi-core processor having a router retain data in a traffic condition patentable because Petitioner failed to present evidence or reasoning why the combined teachings would lead a skilled artisan to the claimed processor.)

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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Posted: October 31, 2023