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

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So, what's happening at the PTAB? Director Review regarding reliance on previously cited art, collateral estoppel, successful use of secondary considerations, and more!

Death by a thousand cites. Ecto World, LLC v. RAI Strategic Holdings, Inc., IPR2024-01280, Paper 13 (May 19, 2025) (Director Stewart) (The Director granted review, vacated the denial of institution, and clarified that Petitioner must do more than rely on IDS-listed references to avoid § 325(d) denial. Even when prior art was buried in a 1,000-reference IDS, Petitioner must still explain how the Examiner materially erred under the second part of Advanced Bionics and Becton, Dickinson factors (c), (e), and (f). The Director remanded for further briefing on both § 325(d) and Fintiv, noting that Petitioners cannot expect the Board to "scour the record" to make their case for them.).

Already been there, already lost that. Samsung Elecs. Co. v. Netlist, Inc., IPR2025-00002, Paper 17 (May 15, 2025) (Beamer, joined by McShane and Szpondowski) (The Board instituted review and found Patent Owner collaterally estopped, as prior IPRs had already litigated and decided the same art combinations. Because the issue was identical, necessarily adjudicated, and fully contested, the Board held Netlist estopped from relitigating the obviousness of claims 1–20 of the '319 patent.).

Too late to review, too weak to matter. Innolux Corp. v. Phenix Longhorn LLC, IPR2025-00043, Paper 10 (May 15, 2025) (Turner, joined by Strauss and McKone) (The Board denied institution under Fintiv and § 314(a), pointing to a district court trial set four months before the final written decision deadline and a petition that recycled previously rejected grounds. Further citing weak

merits and unresolved claim construction disputes, the Board concluded the fast-approaching trial date tipped the Fintiv balance toward denial.).

Et tu, Brute? Your own witnesses may have other thoughts. Provisur Technologies, Inc. v. Textor Maschinenbau GmbH, IPR2024-00224, Paper 58 (March 18, 2025) (DeFranco, joined by Plenzler and Melvin) (denying Patent Owner's motion to amend and finding certain proposed substitute claims unpatentable in part because Patent Owner's own witnesses confirm that a feature was not a significant contributor to the overall commercial success of the invention).

No lenience for copiers. College Products, Inc. v. Intirion Corporation, PGR2024-00004, Paper 49 (April 9, 2025) (Daniels, joined by Meyers and Dougal) (Patent Owner's evidence of copying by Petitioner supports nonobviousness and outweighs Petitioner's evidence of obviousness and thus supports a finding that patent's owner's claims are not unpatentable).

Millions of dollars in sales is good only if in the right context. Bazooka-Farmstar, LLC v. Nuhn Industries Ltd., IPR2024-00098, Paper 49 (May 5, 2025) (Dougal, joined by Petravick and Meyers) (finding patent claims unpatentable in part because 90 million dollars in revenue over 9 years by itself is not sufficient evidence to show commercial success unless further evidence shows size of market, major players, market share of major players, etc.).

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