

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

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So, what's new at the PTAB? Disqualifying prior art for being inventor's own work, public accessibility of software, interpretation of claimed ranges, and more!

In Differences, Find Similarity. Bluebird bio, Inc. v. Sloan Kettering Institute for Cancer Research, IPR2023-00070, Paper 49 (April 22, 2024) (Snedden, joined by Worth and Hardman) (the Board rejected Petitioner's argument that a published thesis, authored by one of the inventors of the '179 patent, constituted prior art "because it has a different inventive entity than the '179 patent," instead agreeing with Patent Owner that the thesis showed the inventor's own work, and was thus disqualified as prior art).

A pertinent problem. Meta Platforms, Inc. f/k/a Facebook, Inc. v. Angel Technologies Group LLC, IPR2023-00060, Paper 40 (May 3, 2024) (Cygan, joined by Quinn and Fenick) (in rejecting Patent Owner's position that the Robertson reference was not analogous art to the '480 patent because "the problems of the '480 patent and of Robertson are different," the Board agreed with Petitioner's position that "contact management is reasonably pertinent" to the same problem that is to be solved by the '480 patent given that the '480 patent indicates that contact management "provides the most relevant people for identification or search").

Any way you "slice" it: evidence of public accessibility of software discussed in documentation not enough. Medivis, Inc. v. Novarad Corp., IPR2023-00042, Paper 37 (April 23, 2024) (Raevsky, joined by Quinn and Zecher) (denying rehearing because, although Petitioner presented evidence that "3D Slicer" software was publicly accessible and commonly used before the priority date of the challenged patent, there was insufficient evidence that the documentation for such software was also publicly accessible and thus the documentation could not be used to invalidate the challenged patent).

Out of range: a broad described range pertains to a different invention than a narrower claimed range. Lam Rsch. Corp. v. Inpria Corp., IPR2024-00033, Paper 13 (April 24, 2024) (Obermann, joined by Kalan and Dennett) (granting institution while making a preliminary determination that a claimed coating with a thickness in the range of 5-25nm was not supported by an earlier disclosure of a coating with a thickness in a broader, subsuming range of 1-50nm because of disclosure indicating a coating with a thickness of 35 nm behaves differently than a coating with a thickness of 30nm).

The limits of "corresponding." Aylo Freesites Ltd. v. Dish Techs. L.L.C., IPR2024-00147,

Paper 9 (April 25, 2024) (Dirba, joined by Dang and Hudalla) (denying institution because Petitioner failed to show a reference describing storing different versions of video with corresponding content that “can be presented as a replacement” for each other taught a claim limitation of storing “multiple different copies of the video encoded at different bitrates”).

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