

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: joinder timing issues, identifying members in a party before the PTAB, Board decisions following Director's sua sponte review and more!

No joinder after IPR terminates. Amazon.com, Inc. et al v. Intent IQ, LLC et al., IPR2023-00227, (Paper 10) (June 5, 2023) (Droesch, joined by Giannetti and White) (denying institution, and rejecting Petitioner's attempt at joinder after the existing proceeding was terminated, and also finding that even if joinder was timely, Petitioner failed to explain how the requested joinder would not create additional burden on the Board or Patent Owner).

Subscription members are real parties in interest. Unified Patents, LLC v. MemoryWeb, LLC, IPR2021-01413, (Paper 56) (public version released June 9, 2023) (Trock, joined by Browne and Beamer) (ordering the Petitioner to update its mandatory notices to identify as real parties in interest its subscription members because they are "clear beneficiaries to this proceeding" and Petitioner is "representing their interests").

Don't get too excited about a Director's Order remanding a Board's discretionary denial of institution. Google LLC v. Valtrus Innovations Ltd., IPR2022-01197, Paper 18 (June 13, 2023) (McGee, joined by Abraham and Trock) (after Director Vidal's sua sponte review and order for the Board to redo its § 325(d) analysis, the Board maintained its discretionary denial because Petitioner relied on the same or substantially the same art that was presented to the Office during prosecution and the Petitioner did not show the Office erred in issuing the challenged claims).

What constitutes an error during prosecution? Not commenting on a reference that was relied on to reject similar claims. Yita LLC et al. v. MacNeil IP LLC, IPR2023-00172, Paper 12 (June 13, 2023) (Peslak, joined by Worth and Woods) (finding that the Examiner's failure to even comment on a reference that was relied on to reject claims in another application that are similar to the challenged claims indicates a material error occurred during prosecution).

If you need to rely on the provisional filing date of a reference, you better show that the provisional supports the reference. Apple Inc. v. R.N Nehushtan Trust Ltd., IPR2023-00230, Paper 8 (June 14, 2023) (Dougal, joined by Calve and Moore) (denying institution because Petitioner merely provided citations to the provisional application of its primary

reference and failed to explain how the citations provided written description support for the teachings of the reference relied upon to allege unpatentability of the challenged claims).

Transposing claim terms won't save the day. Apple Inc. v. MemoryWeb, LLC, IPR2022-0006, (Paper 41) (June 7, 2023) (Repko, joined by Browne and Trock) (in a final written decision, the Board found certain claims unpatentable for lack of written description and rejected Patent Owner's attempt to transpose the claim terms so that they encompass disclosed subject matter).

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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