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

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So, what's new at the PTAB? Using double patenting rejections to leverage other IPR decisions, expectation of success, real party-in-interest considerations, and more!

Double Patenting rejections can be a tool for IPR Petitioners. Dr. Reddy's Laboratories SA et al. v. Eye Therapies, LLC, IPR2024-00467, Paper 14 (August 13, 2024) (Yang, joined by Pollock and Flax) (granting institution after finding the Examiner erred by issuing a double patenting rejection based on a commonly owned patent and failing to take into consideration the references relied on in the Board's final written decision holding that commonly owned patent's claims unpatentable).

You better know your stuff. Honeywell International Inc. v. DSM IP Assets, BV, IPR2024-00493, Paper 7 (August 21, 2024) (Franklin, joined by Tornquist and Mayberry) (denying institution where Patent Owner successfully rebutted Petitioner and Petitioner's expert's testimony that attempted to show that a skilled artisan would have a reasonable chance of success in combining prior art).

The art of defining the relationship. Assa Abloy AB et al. v. CPC Patent Technologies Pty, Ltd., IPR2022-01006, Paper 64 (August 13, 2024) (Grossman, joined by Daniels and Hagy) (following review by the Director, determining a third-party was not a real party-in-interest and/or in privy with the Petitioner, despite its substantial commercial relationship with the Petitioner and that the third-party would economically benefit from an outcome favoring the Petitioner).

Who are they? Never heard of them. Jeisys Medical Inc. v. Serencia, LLC, IPR2024-00463, Paper 20 (August 20, 2024) (DeFranco, joined by Snedden and Hulse) (Board found no significant relationship and granted institution despite Petitioner being a co-respondent with a third party in a

related ITC proceeding where the same third party was denied an earlier IPR petition against the same patent).

Mind readers not allowed. PLR Worldwide Sales Ltd. v. Flip Phone Games Inc., IPR2024-00133, Paper 12 (August 22, 2024) (Vidal) (Director vacating Board's decision denying institution because the Board's claim construction analysis was improperly based on the subjective perspective of a user).

It's always in the last place you look. Aylo Freesites Ltd. v. DISH Technologies L.L.C., IPR2024-00512, Paper 12 (August 13, 2024) (Hudalla, joined by Dang and Dirba) (denying institution after finding that the Petitioner should have known of the primary reference when filing an earlier IPR since the primary reference asserted shared the same inventors and substantial identical language as a reference listed on the patent-in-suit).

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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