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

By Leon Cao and Jake Webb

So, what's new at the PTAB? In this installment of the PTAB Highlights, Banner Witcoff examines recent PTAB decisions featuring: reliance on prior art previously presented in another IPR, diligence in reduction to practice, accessibility of prior art, and more!

Let's try this again…but differently. Amazon.com, Inc. v. Lexos Media IP, LLC, IPR2023-01000, Paper 9 (December 12, 2023) (Fenick, joined by Kauffman and Smith) (granting institution of IPR despite the prior art being presented in a previous IPR because the arguments in the new Petition were not previously considered by the Office).

Just like in school it's always important to show your work. Envirotainer AB v. DoubleDay Acquisitions LLC d/b/a CSafe Global, IPR2022-00292, Paper 79 (November 28, 2023) (Marschall, joined by Barret and Jeschke) (holding that Patent Owner was able to demonstrate that inventors had conducted reasonably continuous activity to reduce to practice the invention claimed in the issued patent where Patent Owner provided "voluminous records" to corroborate the inventors' diligent work during relevant time frame).

An established publication lets the proverbial cat out of the bag. Nearmap US, Inc. v. Eagle View Technologies, Inc., IPR 2022-01009, Paper 28 (December 14, 2023) (Cass, joined by Giannetti and Baer) (finding claims unpatentable in view of prior art that was published by an established publisher and therefore created a presumption of public accessibility prior to the filing of the patent at issue).

If it can be thought, it can be done. Uber Technologies, Inc. d/b/a Uber v. LBT IP II LLC, IPR2022-00880, Paper 29 (December 6, 2023) (Belisle, joined by Boudreau and Hudalla) (rejecting

Patent Owner's argument that an ordinary skilled artisan would not have physically combined two pieces or prior art, instead patent owner should have addressed what the combined teachings would have fairly suggested to an ordinary skilled artisan).

No Funny Business Here. Arista Networks, Inc. v. Corrigent Corporation, IPR2023-00839, Paper 9 (December 7, 2023) (Boudreau, joined by Droesch and Ogden) (granting institution where two different parties challenged the same claims and included certain of the same arguments, because the second petition was filed before the patent owner's preliminary response was filed in the first petition, and there is no evidence of a relationship between the two filing parties).

What are the odds? Sony Interactive Entertainment LLC v. Quantum Imaging LLC, IPR2023-00996, Paper 11 (December 11, 2023) (Daniels, joined by Cherry and Mayberry) (granting institution where "holistic" view of Finitiv factors weighed against discretionary denial and discussing statistics regarding average time to trial in district court).

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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