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: satisfying the written description requirement to establish priority, whether a relationship is significant enough for discretionary denial, effects of prosecution history in related applications, and more!

Shedding light on prior art date—prior art entitled to provisional date even when exact terms are lacking. Samsung Electronics Co. v. Lynk Labs, Inc., IPR2021-01575, Paper 38 (May 10, 2023) (Tornquist, joined by Belisle and Raevsky) (finding, in a dispute about light bulbs, Petitioner satisfied its burden under the written description requirement of 35 U.S.C. § 112 to demonstrate that the prior art reference was entitled to the date of its provisional even though the provisional failed to disclose the specific terminology relied on to invalidate the claim at issue).

The insignificance of membership—"significant relationship" required to apply General Plastic **factor 1 to different parties.** Tesla, Inc. v. Charge Fusion Technologies, LLC, IPR2023-00062, Paper 13 (May 11, 2023) (Plenzler, joined by DeFranco and Korniczky) (finding that Petitioner's membership in an organization that had previously filed an IPR against the contested patent did not favor discretionary denial of institution because membership in an organization is not necessarily "significant" enough to warrant applying General Plastic factor 1).

Your family's sins are not your own. EVE Energy Co., Ltd. v. VARTA Microbattery GmbH, IPR2023-00121, Paper 12 (May 12, 2023) (Crumbley, joined by Kokoski and Kaiser) (declining to exercise discretionary denial under § 325(d) where asserted art had been applied during the prosecution of a patent related to the patent at issue because "the fact that the [patent at issue] and the [related patent] share a common yet distant ancestor is [not] sufficient to establish that art

and arguments considered during the prosecution of the [related patent] were considered during prosecution of the [patent at issue] for purposes of § 325(d)").

Jury verdicts do not commercial success make. OpenSky Industries, LLC v. VLSI Technology LLC, IPR2021-01064, Paper 135 (May 12, 2023) (Melvin, joined by Giannetti and McNamara) (rejecting Patent Owner argument that a jury verdict against a third party is evidence of commercial success because the jury verdict alone "does not reflect whether the infringing device represented an increase in market share over a prior, noninfringing device or any other aspect that would allow us to place the verdict's amount in context").

I'm going to play both sides, so that I always come out on top! Truist Bank v. United Services Automobile Association, IPR2023-00144, Paper 15 (May 16, 2023) (McMillin joined by Droesch and with a dissenting opinion by Dirba) (giving no weight to expert that offered contradictory testimony "on the same issue relating to the same patent on the same day").

How much dough did that run ya? Probably a baker's dozen. The Data Company Techs. Inc. v. Bright Data Ltd., IPR 2022-00138, Paper 52 (May 16, 2023) (McShane joined by Giannetti and Cass) (finding claims anticipated because one component can operate in different roles at different times).

Where's the beef? Weber Inc. v. Provisur Techs., Inc., IPR2019-01466, Paper 46 (May 17, 2023) (Weatherly joined by Ippolito and Jurgovan) (finding claims directed to an optical grading system for a food slicer obvious where prior art did not disclose a camera but did disclose a sensor for measuring the surface area of meat slices).

I used two locks, so it's super secure….Yeah, but don't they both use the same key? Microsoft Corp. v. Virtru Corp., IPR2023-00017, Paper 12 (Saindon joined by Wood and O'Hanlon) (denying institution on claims for separately verifying and authenticating a user because Petitioner failed to explain how it would be obvious to provide a user name and password login twice—with the first serving as verification and the second as authentication).

Mom! I'm not on my computer, I'm playing Minecraft on my phone…smh. Truist Bank v. United Services Automobile Association, IPR2023-00143, Paper 15 (May 16, 2023) (McMillin joined by Droesch and with a concurring opinion by Dirba) (denying institution because prior art disclosing the use of a personal computer did not teach or suggest using a mobile device as required by the claims).

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

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