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: challenging priority to open door for prior art, public accessibility of prior art, denial of supplemental information, and more!

Happy Halloween! Examiner's failure to analyze priority raises cited reference from the grave. Samsung Electronics Co., Ltd. V. Netlist, Inc., IPR2022-00615, Paper 20 (Oct. 19, 2022) (Jurgovan, joined by Galligan and Khan) (IPR instituted based, in part, on a reference of record that the Examiner previously rejected as not being prior art, where Petitioner carried its initial burden to show that Patent Owner's continuation claim was not entitled to its priority date, making the reference prior art, and the Examiner never analyzed the priority issue).

Not all databases are public databases. Corning Optical Communications LLC v. Dali Wireless, Inc., IPR2021-00762, Paper 37 (October 11, 2022) (Fenick, joined by Haapala and Easthom) (excluding reference as prior art because its upload to an FCC database did not enable a person of ordinary skill to find the reference absent a priori knowledge of the reference).

Delay filing a supplemental declaration at your own peril. SharkNinja Operating LLC f/k/a Euro-Pro Operating LLC et al v. iRobot Corporation., IPR2021-00544, Paper 70 (October 17, 2022) (McMillin, joined by Grossman and Melvin) (refusing entry of a supplemental declaration filed after oral argument, when the supplemental declaration was new testimony–not clarifying testimony–and filing party had notice of the issues in dispute at earlier stages of the proceeding).

Oral argument is not the time to raise new arguments. Ohio Farmers Insurance Company d/b/a Westfield et al v. Guada Technologies, IPR2022-00217, Paper 18 (Oct. 24, 2022) (McNeill, joined by Quinn and McGraw) (Patent Owner's argument waived where it was raised for the first time at a hearing instead of in the Patent Owner's Response).

Highway to … Institution? Kerr Machine Co. v. SPM Oil & Gas Inc. f/k/a SPM Control, Inc. , IPR2022-00882, Paper 10 (Oct. 24, 2022) (Weatherly, joined by Cherry and Wieker) (instituting IPR where Petitioner stipulated not to pursue "the same grounds as in the petition or any grounds that could have reasonably been raised in the petition" in parallel district court litigation).

New guidance, same result: Earlier Fintiv **denials unlikely to be revisited**. Philip Morris Products SA v. RAI Strategic Holdings, Inc., IPR2020-00919, Paper 15 (October 13, 2022) (Kosoki, joined by Roesel and Range) (rehearing denied where the previous decision denying institution was outside the 30 day rehearing request window and guidance clarifying application of Fintiv to ITC investigations only applied to pending decisions; see also OpenSky Indus., LLC v. VLSI Tech. LLC, IPR2021-01064, Paper 102 at 49 n.19, which is declared precedential).

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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