PTAB Highlights | Takeaways from Recent Decisions

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So, what's new at the PTAB? Failure to support long-felt but unsolved need, commercial success identified by a jury not persuasive enough, patent owner obtaining a denial of institution despite not filing a preliminary response, typographical errors should not be disregarded, and more!

Be wary of "printed matter doctrine" in objective indicia analysis! Nearmap US, Inc. v. Eagle View Technologies, Inc., IPR2022-00734, Paper 51 (July 15, 2024) (Baer, joined by Giannetti and Cass) (rejecting Patent Owner's arguments of commercial success for failing to establish a nexus with the invention's merit because the purported evidence of commercial success (i.e., sale of reports) is tied to printed matter or features already known in the art).

Fulfilling a long-felt need requires more than self-serving statements. Shanghai Hongene Biotech Corp. v. ChemGenes Corp., IPR2023-00490, Paper 35 (July 18, 2024) (New, joined by Yang and Hardman) (rejecting Patent Owner's arguments of objective indicia of non-obviousness because Patent Owner, in an attempt to establish satisfying a long-felt but unsolved need, fails to (i) point to any statements from any "independent third-party" related to the purported long-felt need and (ii) persuasively show any prior failure to make the claimed product).

Commercial success may have less probative value in a crowded field. Geotab USA, Inc. v. Omega Patents, LLC, IPR2023-00504, Paper 45 (July 18, 2024) (Hagy, joined by Grossman and Dougal) (rejecting Patent Owner's arguments of commercial success because (i) the prior jury's finding of "commercial success" in a verdict form collectively refers to multiple patents; and (ii) preclusion from market entry by blocking patents weakens the inference of non-obviousness of the asserted claims).

Petitioner: "I'm just joining my friend who is already inside." Board: "Back of the line." Micron Tech., Inc. v. Netlist, Inc., IPR2024-00370, Paper 8 (July 23, 2024) (McShane, joined by

Jurgovan and Szpondowski) (denying joinder with a "substantively identical" Samsung IPR because the Board denied institution of Petitioner's earlier petition challenging the same claims on different grounds and joinder would allow Petitioner to improperly use the prior decision as a roadmap).

Don't worry patent examiner, we all make mistakes. Dropbox, Inc. v. Motion Offense, LLC, IPR2024-00286, Paper 12 (July 25, 2024) (Beamer, joined by Giannetti and Raevsky) (finding the Examiner erred and declining to exercise its discretion to deny the petition under § 325(d) where the three prior art references in the Petition, as well as, three IPR petitions that relied on two of the prior art references were considered by the Examiner before the patent was allowed).

Winning strategies: the do nothing defense. Apple Inc. v. THL Holding Co., LLC, IPR2024-00397, Paper 6 (July 25, 2024) (McShane, joined by Kaiser and Reagan) (despite the Patent Owner not filing a preliminary response, denying institution because Petitioner did not present sufficient evidence that the prior art taught a particular graphical user interface limitation and Petitioner's expert testimony was conclusory).

"I'm telling mom what you did and she won't stand for it!" Hesai Tech. Co. Ltd. v. Ouster, Inc., IPR2023-01458, Paper 14 (July 25, 2024) (Vidal) (vacating and remanding denial of institution where the Board improperly disregarded the teachings of a patent Figure due to an apparent typographical error in the Figure).

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Posted: August 7, 2024