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

By Jesse Dyer and Sydney Huppert

So, what's happening at the PTAB? Using videos as printed publications, instituting despite advanced stage of litigation, denying institution for mapping to the specification instead of the claim, and more!

Video killed the radio star and the vehicle-mounted elevated access system patent. Mission Integrated Techs., LLC v. Clemente, IPR2023-01285, Paper 25 (Feb. 19, 2025) (Grossman, joined by Meyers and Peslak) (in a Final Written Decision, finding that two of Petitioner's YouTube videos showing a vehicle-mounted access system anticipated all claims except one dependent claim).

It's a bold strategy—let's see if it pays off for them. Motorola Solutions, Inc. v. Stellar LLC, IPR2024-01206, Paper 11 (Feb. 13, 2025) (McNamara, joined by Kinder and Khan) (instituting IPR despite advanced stage of district court litigation because Patentee presented over 850 infringement claim charts and Petitioner stipulated that they would not pursue any grounds that could have been raised during IPR, thereby simplifying the district court litigation).

When you challenge a claim, you best not miss the claim. AT&T Services, Inc. v. Innovative Sonic Ltd., IPR2024-01143, Paper 15 (Feb. 11, 2025) (Courtenay, joined by Zecher and Ogden) (denying institution because Petitioner compared two terms in prior art reference to similar terms in specification of challenged patent, but not to the language recited by the claims, and therefore failing to show why claims were obvious).

A picture is worth a thousand words. Spectrum Solutions, LLC v. DNA Genotek Inc., IPR2023-01424, Paper 45 (Feb. 19, 2025) (Browne, joined by Kaiser and Wisz) (in denying Patent Owner's motion to amend for seeking to enlarge claim scope, the Board was persuaded by figures created

by Petitioner clearly illustrating the language of the proposed claim encompassed more than the original claim).

Lack of evidence = lack of success. Howard Indus., Inc. v. Capsa Solutions LLC, IPR2023-01274, Paper 27 (Feb. 18, 2025) (Peslak, joined by Gerstenblith and Meyers) (disregarding objective indicia of non-obviousness where Patent Owner cited no supporting evidence—such as sales information, market share, testimony from customers, competitor product documents—and instead relied only on the declaration from its Senior Vice President).

Shoot your seven shots. Apple Inc. v. Smith Interface Techs., LLC, IPR2024-01114, Paper 9 (Feb. 13, 2025) (Dirba, joined by Engels and Fenick) (instituting three IPRs, but denying institution for remaining four of seven IPR petitions against the same patent and based on the same prior art references because "Petitioner cannot justify a large number of petitions by claiming that it needed additional words for analysis" when Petitioner was not concise in common sections).

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.

Banner Witcoff is recognized as one of the best performing and most active law firms representing clients in inter partes review (IPR) proceedings. To learn more about our team of seasoned attorneys and their capabilities and experience in this space, click here.

Banner Witcoff's PTAB Highlights are provided as information of general interest. They are not intended to offer legal advice nor do they create an attorney-client relationship.

Posted: March 4, 2025