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

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So, what's new at the PTAB? Defeating the purpose of a prior art reference, combining references to produce a missing limitation, denying institution because of a cumulative reference, and more!

Did your prior art lose its purpose? No problem. Samsung Electronics Co., Ltd. v. Memoryweb, LLC , IPR2022-00222 (Dec. 22, 2023) (Browne, joined by Beamer and Trock) (agreeing with Petitioner that even though a combination would defeat the stated purpose of one prior art reference, it would not prevent the person of ordinary skill in the art from weighing other advantages of the proposed combination against the benefits lost).

Missing a limitation? Keep looking. Apple Inc. v. Mozido Corfire-Korea, Ltd., IPR2022-01149 Paper 24 (Dec. 27, 2023) (Droesch, joined by Zecher and Korniczky) (Patent Owner's argument that a claim limitation is missing from one of the two cited prior art references did not prevent a finding obviousness where the asserted grounds of obviousness were based upon the combined teachings of the references).

What's new around here? Parse Biosciences, Inc. v. 10X Genomics, Inc. , IPR2023-01033, Paper 8 (December 19, 2023) (Snedden, joined by Newman; Fitzpatrick, dissenting) (exercising discretion to deny institution after finding that the only reference not before the examiner during prosecution was cumulative to a reference that the examiner did consider and that Petitioner relied on in the alternative to show the same teaching as a "new" reference).

Context is key. Samsung Bioepis Co., Ltd. v. Alexion Pharmaceuticals, Inc., IPR2023-01070, Paper 9 (December 19, 2023) (Flax, joined by Hulse and

Pollock) (granting institution after finding that, although certain references Petitioner relied on to show obviousness were previously disclosed during prosecution, the examiner materially erred by not expressly considering one of them in the context of the others, which would have helped the examiner appreciate the significance of their disclosures).
Run it past legal. PPC Broadband, Inc. v. Times Fiber Communications, Inc., IPR2022-00946, Paper 46 (December 6, 2023) (Ippolito, joined by Gerstenblith and Hoskins) (finding that Patent Owner failed to establish a presumption of nexus between its commercial product and the challenged claims because Patent Owner's marketing materials highlighted multiple unclaimed features as part of the product's "innovative design").

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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