

# 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: the prior public disclosure exception, the number of substitute claims permitted in a motion to amend, weighing of new evidence and arguments in sur-reply, and more!

**A picture is worth... not enough...** Kaijet Tech. Intl. Ltd., Inc. d/b/a j5create v. Sanho Corp., IPR2021-00886, Paper 55 (October 25, 2022) (Chang, joined by Barrett and Galligan) (finding that Patent Owner failed to show the inventor publicly disclosed the subject matter of the challenged claim prior to effective filing date of a prior art reference because the only prior public photograph did not disclose the same subject matter as the prior art reference).

**Be mindful: Substitute claims can only replace challenged claims.** Ericsson Inc v. Koninklijke KPN N.V., IPR2022-00068, Paper 21 (December 2, 2022) (Beamer, joined by Turner and Cass) (determining in the Preliminary Guidance that Patent Owner failed to propose a reasonable number of substitute claims, because statute does not permit Patent Owner to propose substitute claims to replace unchallenged claims).

**No Weight to New Evidence and Argument.** Johnson & Johnson Surgical Vision Inc., v. Alcon Inc., IPR2021-01053, Paper 52 (December 5, 2022) (Obermann, joined by Kaiser and Wisz) (arguments and evidence that were non-responsive to information raised in the Response deemed “new” and given less weight or found unpersuasive in unpatentability analysis).

**Don’t practice? Don’t worry!** Unified Patents, LLC v. Flexiworld Technologies, Inc., IPR2022-00775, Paper 10 (November 8, 2022) (Ogden, joined by McMillen and Dougal) (rejecting Patent Owner’s argument that Board should exercise discretion to deny petition because the Petitioner did not practice the patent or would not be subject to an infringement lawsuit, finding arguments irrelevant to Congress’ statutory scheme for who may be a petitioner).

**The “Why?” matters.** Honeywell International Inc. et al v. 3G Licensing SA, IPR2021-00908, Paper 54 (November 14, 2022) (Cass, joined by Moore and Ullgaddi) (finding that Petitioner failed to show why one of ordinary skill would have been motivated to swap just the last two bits of the prior art’s 20-bit codeword to arrive at the challenged patent’s 20-bit

codeword in view of recognized tradeoffs in performance resulting from different codewords and evidence of disagreements among experts in the field as to what constituted the best codeword).

**“Weak”: Secondary considerations won’t influence obviousness conclusions.** Hanwha Solutions Corp. et al v. Rec Solar PTE. Ltd., IPR2021-00988, Paper 40 (December 9, 2022) (Range, joined by Obermann and Kaiser) (secondary considerations consisting of a prospective licensing of a counterpart European patent and an industrial award with a loose relationship to the claimed invention did “not heavily weigh against obviousness”).

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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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