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

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So, what's happening at the PTAB? Director Squires vacating decisions, unrebutted testimony, licensing creating settled expectations, and more!

Ensure an expert's testimony is worth the money. Interactive Comms. Int'l, Inc. v. Blackhawk Network Inc., IPR2024-00465, Paper 39 (Oct. 1, 2025) (Director Squires) (granting Patent Owner's request for review and vacating the adverse final written decision based on multiple material contradictions found in Petitioner's expert's testimony).

Good experts are key. Boeing Company v. Regents of Univ. of Cal., IPR2024-00761, Paper 44 (Oct. 2, 2025) (Finamore, joined by Bisk and Hudalla) (rejecting Petitioner's lack of novelty arguments because (i) Petitioner failed to demonstrate persuasively an element being taught and (ii) Patent Owner presented credible expert testimony that was unrebutted).

A comprehensive review of the prosecution history would help the fight against discretionary denial. Carbyne, Inc. v. Tritech Software Systems, IPR2025-00959, Paper 11 (Oct. 3, 2025) (Deputy Director Stewart) (denying Patent Owner's request for discretionary denial of institution because Petitioner provided persuasive reasoning and "sufficiently demonstrated" that the USPTO committed a material error during examination).

Unsettled disputes and settled expectations. Docker Inc. v. Intellectual Ventures II LLC, IPR 2025-00840, Paper 9 (Sept. 19, 2025) (Deputy Director Stewart) (denying institution because challenged patent is already subject to an ongoing IPR, is asserted based on overlapping grounds in district court, and has been in force for about 12 years thus creating strong settled expectations).

Try the office down the hall. Intel Corp. v. USTA Tech., LLC, IPR 2025-00838, Paper 10 (Sept. 19, 2025) (Deputy Director Stewart) (denying institution despite Petitioner's argument that Examiner in co-pending reexamination proceeding did not consider Petitioner's primary reference listed on an IDS because the "most efficient process for the Office" is for Petitioner to file a reexamination request with the primary reference).

When age fails, licensing can create settled expectations. Alliance Laundry Sys., LLC v. Payrange LLC, IPR 2025-00950, Paper 11 (Sept. 19, 2025) (Deputy Director Stewart) (denying institution even though a final written decision would issue before co-pending district court trial because two previous petitions challenging the same patent were denied on the merits, one of which relied on the same primary reference as the present petition, and licensing the challenged patent created "some" settled expectations despite being in force for less than 5 years).

As a leader in post-issuance proceedings, Banner Witcoff is committed to staying on top of the latest PTAB developments. Our PTAB Highlights series is designed to keep you up-to-date and informed of rulings affecting this constantly evolving area of the law.

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