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

By Zach Getzelman and Chloe Johnson

So, what's happening at the PTAB? Banner Witcoff attorney Zach Getzelman and summer associate Chloe Johnson examine the recent decisions in post-issuance proceedings, including: discretionary denial despite different parties, allegations of unfair dealings, stipulations to obtain institution, and more!

A family divided is still a family. Intel Corp. et al. v. Collision Commc'ns, Inc., IPR2025-00301, Paper 11 (May 28, 2025) (Gerstenblith, joined by Boudreau and Trock) (in denying institution, the Board agreed with the Patent Owner that, despite being different parties, there was substantial overlap between the petitioning manufacturers and their parent and holding company–the defendant in the litigation).

Don't ignore those pesky decisions calling out your weak arguments. Samsung Bioepis Co. Ltd. v. Regeneron Pharm., Inc., IPR2025-00176, Paper 12 (June 2, 2025) (Valek, joined by Mitchell and Wisz) (denying institution based on the district court already issuing nearly a thousand pages of substantive decisions directed at claim construction and the validity of the patent, including weaknesses in the motivation to combine arguments that the Petitioner did not address).

I get it, you're angry, but this is not the venue. Tessell, Inc. v. Nutanix, Inc., IPR2025-00298, Paper 11 (June 2, 2025) (Lee, joined by Arbes and Murray) (declining to exercise discretionary denial based on allegations of unfair dealings done by the Petitioner, which was co-founded by two of the named inventors who had assigned their rights to the Patent Owner).

You can't have your cake and eat it to. Amazon, Inc. et al. v. NL Giken Inc., IPR2025-00050, Paper 12 (May 23, 2025) (Ahmed, joined by Trock and Wormmeester) (granting institution, in part,

after Petitioner stipulated to not rely on the same prior art and withdrew its indefiniteness claims in district court).

So many dates, so little interest. Charter Communications, Inc. and Plume Design, Inc. v. Adaptive Spectrum and Signal Alignment, Inc., IPR2025-00088, Paper 10 (May 22, 2025) (Trock, joined by Turner and Lee) (exercising discretionary denial despite trial venue not being set, but all the potential trial dates, based on the median time-to trial data, occurred before the projected deadline for a final written decision).

Sometimes the longest shots are the ones that pay off the most. TCL Electronics Holdings Ltd. et al. v. Maxell, Ltd., IPR2025-00120, Paper (May 20, 2025) (Melvin, joined by Hudalla and McMillin) (granting institution based on strength of the challenge, weakness of the opposition, and a stipulation to avoid overlap with district court case, despite fact and expert discovery already being closed and a trial would complete eight months prior to a final written decision).

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.

To learn more about the seasoned attorneys on our PTAB practice team, and their capabilities and experience in this space, visit our website.

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