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

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So, what's new at the PTAB? Foreign policy considerations at the institution stage, parallel petitions, improper hindsight, and more!

Maybe petition the DoD first? Tiktok Inc. v. CellSpin Soft, Inc., IPR2024-00767, Paper 9 (Oct. 1, 2024) (Hardman, joined by Anderson and Valek) (declining to discretionarily deny the petition as 35 U.S.C. § 316(b) doesn't extend to foreign policy or national security considerations).

Petitioners: When claims are lengthy and the Board's burden is minimized, consider multiple petitions. Meta Platforms, Inc. f/k/a Facebook, Inc. v. SitNet LLC, IPR2024-00528, Paper 10 (September 11, 2024) (Szpondowski, joined by Powell and Belisle) (granting institution of parallel IPR petitions because the patent claims are relatively lengthy and the overlap of petitions (i.e., the prior art asserted) mitigates the potential of a substantial burden on the Board or Patent Owner).

The risk of failing to stitch together the art of combination. Iriusrisk, Inc. v. Threatmodeler Software Inc., IPR2023-00656, Paper 33 (Oct. 2, 2024) (Belisle, joined by Turner and Hamann) (finding impermissible hindsight when the only support for the combination was the applicant's disclosure, which only reinforced the patent's novelty).

A JDG isn't always that significant. Monolithic Power Systems, Inc. v. Greenthread, LLC, IPR2024-00550, Paper 20 (Sep. 25, 2024) (Ullagaddi, joined by Tornquist and Heaney) (declining to discretionarily deny the petition, ruling that the Petitioner lacked a significant relationship with a party who had previously filed on the same patent, despite both being part of a joint defense group).

Patent Owners: Do your job! Hindsight allegations and generalized allegations Rejected. Nintendo Co., Ltd. et al v. American GNC Corporation, IPR2024-00667, Paper 10 (September 10, 2024) (McNamara, joined by Daniels and Tsang) (granting institution where Patent Owner made generalized allegations and failed to identify any knowledge Petitioner relied on that was gleaned only from the disclosure of the patent at issue).

Every word matters – especially when the reference is a translation. MOM Enterprises, LLC d/b/a Mommy's Bliss v. R Vieth et al, IPR2023-00726, Paper 112 (September 27, 2024) (Hardman, joined by New and Snedden) (in a final written decision, the Board found a later translation of a reference that added a key phrase to be more accurate than an earlier translation of the reference and rejected Patent Owner's allegations that the later translation was doctored).

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Posted: October 14, 2024