

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: Director order about mischaracterizations; public accessibility to qualify as prior art; reliance on a provisional for a priority date, obviousness and more!

My mischaracterizations don't cost a thing. Intel Corp. v. VLSI Tech. LLC, IPR2021-01064, Paper 138 (June 27, 2023) (Vidal) (admonishing an attorney but not awarding attorneys' fees after the attorney "negligently and carelessly advanced arguments" that mischaracterized the Institution Decision and caselaw).

Has it been indexed? Counting the clicks. Apple Inc. v. MemoryWeb, LLC, IPR2022-00032, Paper 42 (June 30, 2023) (Repko, joined by Browne and Beamer) (finding an online software manual was publicly accessible when it only took five clicks to find on Apple.com).

The early bird gets the worm. Mercedes-Benz USA, LLC v. Westport Fuel Systems Canada Inc., IPR2023-00351 (June 20, 2023) (Ippolito, joined by Powell and DeFranco) (denying institution because the written disclosures of the earlier provisional support the present fuel injection claims so the Patent Owner is entitled to an early priority date).

It's obvious to combine art that relies on a standard with art outlining the protocols of the standard. Apple Inc. v. BillJCo, LLC, IPR2022-00310, Paper 33 (June 27, 2023) (Dang, joined by Browne and Baer) (finding it obvious to combine a prior art reference that relied on Bluetooth communication

with a reference that explained how Bluetooth actually worked).

Petitioner says: Don't be so lateral! Life Spine, Inc. v. Globus Medical, Inc., IPR2022-01603 (June 12, 2023) (Valek, joined by Sawert and Hardman) (denying institution because: (1) the claims require ramps with lateral wedges; and (2) the cited prior art only discloses longitudinal wedges.

Where do you think you're going? Cite relevant art. Apple Inc. v. Mullen Industries LLC, IPR2023-00098 (June 7, 2023) (Engels, joined by Smith and Mayberry) (denying institution because the references do not teach or even suggest requesting location access rights from users as claimed in Patent Owner's remote device location detection patent).

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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