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

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In this installment of the PTAB Highlights, Banner Witcoff summer associates examine recent decisions at the PTAB featuring: the PTAB's discretion to deny institution for petitions raising substantially the same prior art and follow-on petitions, anticipation, privity, and more!

Watch out for patent parents! Substantially the same art as previously considered by the patent office? Vital Connect, Inc. v. Bardy Diagnostics, Inc., IPR2023-00381, Paper 7 (July 11, 2023) (finding a Petitioner-cited reference was substantially the same art as its parent application which was considered by the USPTO during prosecution and that a second Petitioner-cited reference was "substantially the same" as references having a common inventor cited during prosecution).

Staggering IPR petition filings against the same patent? Make sure you have a reason. 3M Company v. Bay Materials, LLC, IPR2023-00243, Paper 8 (July 7, 2023) (Institution denied where the Petition, filed about five months after another petition challenging the same claims, failed to provide any reasoning under the General Plastic factors, which are used to evaluate follow-on petitions).

Institute once, good for you. Institute twice, burden on me. PainTEQ, LLC v. Orthocision, Inc., IPR2023-00477, Paper 8 (July 14, 2023) (Valek, joined by Worth) (denying institution of second-ranked parallel petition challenging same patent claims as first-ranked petition because the only issue—whether a reference qualifies as prior art in view of the patent's priority date—of substantial difference between the petitions has been resolved because Patent Owner stipulated that it would not dispute that the reference qualifies as prior art).

Take it as it is – adapting prior art does not render claims anticipated. Otsuka Medical Devices Co., Ltd. et al. v. Medtronic Ireland Manufacturing Unlimited Co. et al., IPR2022-00431, Paper 32 (July 14, 2023) (Jeschke, joined by Saindon and Finamore) (prior art device that must be modified to perform a claimed function cannot anticipate).

Sharing is caring, just don't make plans. Samsung Electronics Co., Ltd. v. Netlist, Inc., IPR2022-00615, Paper 64 (July 13, 2023) (Jurgovan, joined by Galligan and Szpondowski) (evidence of Petitioner sharing status and requests for litigation information in a pre-existing relationship was not enough to hold a third-party in privity with Petitioner).

System components capable of multiple functions? Just make sure it does not simultaneously **serve as more than one device in a claim**. Code200, UAB et al v. Bright Data Ltd., IPR2022-00353, Paper 38 (July 6, 2023) (finding that a single component can serve multiple roles with different functions at different times so long as it is not simultaneously serving more than one function at the same time).

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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