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

By Sydney Huppert and Elizabeth Rielley

So, what's new at the PTAB? In this installment of the PTAB Highlights, Banner Witcoff examines recent PTAB decisions featuring: Director guidance on when the Board must consider evidence, an effective Sand stipulation, real party in interest considerations, and more!

Board Can't Slice and Dice Evidence. Weber, Inc. v. Provisur Technologies, Inc., IPR2022-00599, Paper 74 (November 29, 2023) (Director Vidal) (vacating the Board's decision to render Patent Owner's evidence of patentability moot because the Board did not rely on said evidence when determining unpatentability, and remanding to Board to issue a ruling on whether such evidence can be considered before determining patentability).

Sand **stipulation good enough for the win**. Netflix, Inc., v. GOTV Streaming, LLC, IPR2023-00757, Paper 11 (November 7, 2023) (Amundson, joined by Lebovitz and McNamara) (granting institution based, in part, because Petitioner's Sand stipulation (that it will not pursue the petitioned ground before the district court) weighed against discretionary denial during a Fintiv factor 4 analysis).

Safety first. United Services Auto. Ass'n v. Auto Telematics LTD., IPR2023-00770, Paper 10 (November 7, 2023) (Ippolito, joined by Hoskins and O'Hanlon) (denying institution under § 314(a) because classifying data as "safe" or "unsafe" did not sufficiently explain how secondary reference would improve navigation driving safety recited in the primary reference).

Show me who your friends are… Ford Motor Co. v. Neo Wireless LLC., IPR2023-00763, Paper 17 (November 9, 2023) (Droesch, joined by Jung and Belisle) (first General Plastic factor favored

denial of institution after determining that Ford and Volkswagen created a significant relationship under Valve by previously filing a joint claim construction statement and invalidity contentions for the same claims in suit).

No IPR For You! International Business Machines Corp. v. Digital Doors, Inc., IPR2023-00968, Paper 7 (December 1, 2023) (Roesel, joined by Dang and Giannetti) (Fintiv factor 2 favored denying institution because the Board's deadline for a written decision would be three months after the scheduled jury selection and the average time-to-trial in the Eastern District of Texas showed that trial would likely be underway before the Board's deadline).

Compatible, Not Controlling. Assa Abloy AB v. CPC Patent Technologies Pty, Inc., IPR2022-01006, Paper 47 (November 30, 2023) (Grossman, joined by Daniels and Hagy) (infringement suit against Apple more than one year prior to Petition filing did not time-bar Petitioner's request for inter partes review because Petitioner's and Apple's substantial business relationship did not make Apple a real party in interest or privy of Petitioner).

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.

Banner Witcoff is recognized as one of the best performing and most active law firms representing clients in inter partes review (IPR) proceedings. To learn more about our team of seasoned attorneys and their capabilities and experience in this space, click here.

Banner Witcoff's PTAB Highlights are provided as information of general interest. They are not intended to offer legal advice nor do they create an attorney-client relationship.

Posted: December 15, 2023