

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

**By Hengyi Jiang and Andy Kim**

In this installment of the PTAB Highlights, Banner Witcoff examines recent decisions at the PTAB featuring: stipulations to avoid discretionary denial, burden of proof on § 325(d), illustrating prior art modifications, and more!

**Just say the word!** Vantage Specialty Chemicals, Inc. v. Cargill, Inc., IPR2023-00589, Paper 11 (September 13, 2023) (Majors, joined by Snedde and Valek) (declining to deny institution under § 314(a) where the Board found the Petitioner’s stipulation not to “pursue prior art invalidity in court on any grounds based entirely on prior art patents or publications, including the grounds in this Petition” mitigates concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB).

**Board says No to shifting the burden on § 325(d).** Masimo Corporation v. Apple Inc., IPR2023-00734, Paper 11 (October 5, 2023) (Barrett, joined by Cocks, and Kinder) (granting institution and holding that Petitioner is not required to address a § 325(d) issue in the petition or prior to the filing of a Patent Owner’s preliminary response).

**Do not overfit!** Masimo Corporation v. Apple Inc., IPR2023-00728, Paper 10 (September 18, 2023) (Cocks, joined by Barrett and Kinder) (finding unpersuasive images of “modified” prior art which appeared, to the Board, to be manufactured to simulate the appearance of the patented design rather than adhering to a design that would have been conveyed to a designer of ordinary skill in the art based on modification to the prior art).

**Bury everything into one claim chart?—Not a good idea.** Uber Technologies, Inc. v. SurgeTech, LLC, IPR2023-00737, Paper 7 (October 6, 2023) (Woods, joined by Tartal and Flax) (denying institution because omnibus claim chart, which addressed twelve unpatentability grounds, including over nineteen thousand alternative positions, did not present each unpatentability ground “with particularity” as required by § 312(a)(3)).

**Facts, facts, and facts.** Metacluster LT,UAB v. Bright Data Ltd., IPR2022-00687, Paper 38 (October 4, 2023) (Droesch, joined by Giannetti, and Cass) (holding all claims of a patent directed to network communication speed unpatentable partly because the expert’s commercial success testimony was not supported by sufficient underlying factual basis to establish a nexus with claimed invention).

**Aim for a later trial date.** MOM Enterprises, LLC d/b/a Mommy’s Bliss v. Vieth et al. , IPR2023-00726, Paper 10 (September 15, 2023) (Hardman, joined by New and Snedden) (trial date in the parallel litigation after the projected statutory deadline for a final written

decision weighed against discretionary denial of institution under § 314(a)).

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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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