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: reconsideration of institution decision based on Director's Interim Procedure, showing examiner error during prosecution to obtain IPR institution, public accessibility of a reference, and more!

Second chance but same result: institution denied. Google LLC v. EcoFactor, Inc., IPR2021-01578, Paper 15 (September 23, 2022) (Howard, joined by Derrick and Abraham) (initial discretionary denial lifted in view of intervening guidance from the Director, but Petition denied on the merits because the asserted art is missing a required claim limitation and Petitioner's non-industry evidence in response (primarily prosecution history and ITC rulings) is not persuasive).

No discretionary denial where Petition evidences Examiner error in consideration of cited prior art. Autostore System, Inc. v. Ocado Innovation Ltd., IPR2022-00673, Paper 7, (September 14, 2022) (Marschall, joined by Lorin and Tornquist) (instituting IPR where Petitioner successfully asserted that Examiner who signed-off on IDS references failed to properly consider their combination).

Public accessibility shown two ways. TCT Mobile (US) Holdings, Inc v. Sisvel SpA, IPR2021-00678, Paper 47 (September 22, 2022) (Quinn, joined by Lee and Moore) (reference held to be publicly accessible prior art based on (1) unrebutted presumption flowing from publication by an established publisher and (2) unrebutted testimony from a professional librarian establishing when the book would have been labeled and on a public university library shelf).

Rationale for combining references must explain why**.** Apple Inc. v. Telefonaktiebolaget LM Ericsson, IPR2022-00349, Paper 7 (September 21, 2022) (Engels, joined by Medley and Braden) (institution denied where Petitioner asserted conclusory motivations to combine prior art under 35 U.S.C. § 103, including that POSITA would allegedly combine because she would be familiar with the references).

"May" and "could" are not the same as "would have." Intel Corp. v. Health Discovery Corp., IPR2021-00554, Paper 36, (September 16, 2022) (Baer, joined by Browne and Laney) (Petitioner failed to show the challenged claims are unpatentable because the evidence

showed only that POSITA may have understood that the art could be combined, not that POSITA would have been motivated to pick out the particular asserted references and combine them).

Fintiv **applied: Weighing and balancing to reach holistic determinations.** Apple, Inc. v. Scramoge Tech. Ltd., IPR2022-00529, Paper 9, (September 1, 2022) (Kalan, joined by McNamara and Wormmeester). (Board must weigh and balance all six Fintiv factors to determine "whether efficiency and integrity of the system are best served by denying or instituting review" in view of parallel litigation; here, the factors weigh against discretionary denial and IPR is instituted).

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Posted: October 4, 2022