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

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In this installment of the PTAB Highlights, Banner Witcoff attorneys examine recent decisions at the PTAB featuring: application of Director Vidal's recent Memorandum on the Fintiv analysis, the rebuttable presumption that a claim is obvious if its range overlaps with a range taught by the prior art, relying on the date of a blog post, and more!

Patent owners would be wise to include merits arguments with their pre-institution Fintiv analysis given the Director's new memorandum. STMicroelectronics, Inc. v. Purdue University, IPR2022-00309, Paper 14 (July 6, 2022) (Kokoski, joined by Obermann and Abraham) (Relying on Director Vidal's recent Fintiv guidance, Board institutes IPR because Patent Owner did not address merits of Petitioner's compelling challenge).

It's too late to make the opposite argument on rehearing. Apple, Inc. v. Taction Tech., Inc., IPR2022-00057; IPR2022-00058; IPR2022-00059, Paper 15 (July 7, 2022) (Howard, joined by Arbes and Raevsky) (denying Petitioner's request for rehearing of the decision denying institution because Petitioner argued in the petition that the rebuttable presumption of E.I. DuPont—that a claim is obvious if its range overlaps with a range taught by the prior art—applies, and in its rehearing request, the opposite argument that there is no such presumption when the prior art teaches a species of a claimed genus).

Claims using "module" can be difficult for Patent Owners to defend. Micron Tech., Inc. v. Unification Tech. LLC., IPR2021-00343, Paper 42 (July 8, 2022) (Arbes, joined by McMillin and Ogden) (claims to managing data in a storage device held to be obvious, in part, because the word "module" in the claim term "request receiver module" could be interpreted to cover more than one component, including those found in the prior art).

Don’t blow smoke: You must particularly explain your arguments. Jupiter Research, LLC v. VPRBrands, LP, IPR2022-00299, Paper 12 (July 12, 2022) (Kokoski, joined by Derrick and Heaney) (denying IPR institution where Petitioner made conclusory statements about e-cigarette patent and did not explain with particularity how a claimed electric airflow sensor was disclosed in the prior art as required under 37 C.F.R. § 42.104(b) and 35 U.S.C. § 312(a)(3)).

Don’t skip claim terms, let alone, twice! Samsung Electronics Co., Ltd. v. Blaze Mobile, Inc. et al, IPR2021-01569, Paper 18 (July 14, 2022) (Engels, joined by Jung and O’Hanlon) (denying petitioner’s request for rehearing of decision denying IPR institution where Petitioner repeated its previous failure to address the scope and meaning of an important claim term).

Prove your prior art dates. Content Square SAS v. Medallia, Inc., IPR2022-00316, Paper 13 (July 14, 2022) (Daniels, joined by Petravick and Laney) (denying IPR institution where Petitioner relied on a date in a blog post to prove that a disclosure was prior art, but provided “no other evidence or explanation, not even an affidavit from an officer of the Internet Archive” to show the disclosure was actually prior art).

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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