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

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So, what's happening at the PTAB? Instituting despite a §101 invalidity ruling, denying institution for recycled prior art, instituting a copied petition, and more!

Patent Owners beware—§101 alone won't shut the door on Inter Partes Review. Hulu, LLC v. Piranha Media Distribution, LLC, IPR2024-01252, Paper 16 (March 4, 2025) (Easthom, joined by Moore and Kazhdan) (declining discretionary denial despite district court §101 invalidity ruling, as PTAB focused on §103 obviousness, a distinct issue).

Same art, same arguments, same outcome—no do-overs. Ecto World, LLC v. RAI Strategic Holdings, Inc., IPR2024-01280, Paper 10 (Mar. 6, 2025) (Kokoski, joined by Kaiser and Range) (denying institution —Board found the prior art was already considered, and Petitioner failed to show Examiner error. Argument that references weren't "seriously considered" wasn't persuasive.)

Copying a winning strategy? Smart move. Qualcomm Inc. v. Cobblestone Wireless, LLC, IPR2024-01336, Paper 15 (Mar. 7, 2025) (Cass, joined by Easthom and Beamer) (granting institution despite Patent Owner's arguments, finding no road-mapping or inefficiency where petition copied an already-instituted IPR that later settled).

PTAB Draws the Line on Double Dipping – Second Later-Filed IPR Petition Challenging Additional Claims Denied Institution. Apple Inc. v. Proxense, LLC, IPR2024-01485, Paper 10 (February 26, 2025) (McKone, joined by Dang and Turner) (Different invalidity grounds and challenging more claims are insufficient justifications for instituting a later filed petition when the first petition was already instituted).

Not Impressed with Flashy Awards. Permian Global Inc. et al. v. Fuel Automation Station, LLC, IPR2023-01236, Paper 42 (February 26, 2025) (DeFranco, joined by Marschall and Dougal) (Arguments for commercial success based on Patent Owner's award for being "Industry Leader" are not persuasive as there is no evidence tying the award to the claimed invention).

No Dynamic Drinkware Drama for Prior Art under AIA § 102. Align Technology, Inc. v. Dental Monitoring SAS, IPR2023-1369, Paper 42 (March 3, 2025) (Homere, joined by Zecher and Szpondowski) (The Dynamic Drinkware ruling on written description support doesn't apply to post-AIA references; under Penumbra, Inc. v. RapidPulse, Inc., a non-provisional application is prior art under post-AIA as of its provisional application's filing date if the provisional application describes the non-provisional's subject matter).

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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