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

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So, what's new at the PTAB? No Fintiv for Co-Petitioner, fatally inconsistent arguments, failure to tie patent claims to commercial product to establish commercial success, and more!

No reason to Fintiv me! Google LLC et al v. Multimodal Media LLC, IPR2024-00053, Paper 10 (June 5, 2024) (Jung, joined by Saindon and Powell) (granting institution and agreeing with Petitioners that Fintiv does not apply to Co-Petitioner who is not involved in the co-pending litigation involving the Patent Owner and other Co-Petitioners).

Markman keeps IPRs away! T-Mobile USA, Inc. et al v. Cobblestone Wireless LLC, IPR2024-00136, Paper 18 (June 5, 2024) (Cass, joined by Engels and Beamer) (denying institution because district court Markman hearing will be completed prior to the deadline for institution decision and finding that Patent Owner disagrees with Petitioner's claim construction in the Preliminary Response).

You have a greater chance of shooting yourself in the foot if you keep firing bullets! Dropbox, Inc. v. Entangled Media LLC, IPR2024-00285, Paper 7 (June 6, 2024) (Daybell, joined by Wormmeester and Hudalla) (denying institution because Petition points to two different features in the prior art reference for teaching a feature of the challenged claim and therefore Petition is "fatally inconsistent").

Connect your claims to your commercial product to prove commercial success. The NOCO Company, Inc. v. Pilot, Inc., IPR2023-00167, Paper 23 (June 11, 2024) (Abraham, joined by Heaney and Amundson) (in a final written decision finding all challenged claims unpatentable, the Board found that Patent Owner failed to tie any claim of its patent, directed to an automatic charger

with a safe power supply, to any safety feature of the commercial charger to establish commercial success).

No stronger evidence of obviousness than anticipation. Samsung Bioepis Co., Ltd. v. Regeneron Pharmaceuticals, Inc., IPR2023-00442, Paper 55 (June 14, 2024) (New, joined by Mitchell and Pollock) (in a final written decision finding all challenged claims unpatentable, the Board found that the challenged claims were anticipated, and therefore it did not need to consider Patent Owner's arguments concerning evidence of secondary considerations of nonobviousness).

A co-pending reissue proceeding does not bar granting an IPR petition. Oxylabs LT UAB v. Bright Data Ltd., IPR2024-00126, Paper 9 (June 14, 2024) (Droesch, joined by McShane and Cass) (granting institution and rejecting Patent Owner's argument that institution should be denied based on a co-pending reissue proceeding).

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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