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

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In this installment of the PTAB Highlights, Banner Witcoff attorney Elizabeth Rielley and summer associate Abby O'Neill examine recent decisions at the PTAB featuring: the scope of analogous prior art, POSITAs are not automatons, effective filing dates, and more!

Caution! Scope of analogous art may be broader than it appears. OsteoMed LLC v. Stryker European Holdings LLC, IPR2022-00488, Paper 35 (August 8, 2023) (Mitchell, joined by Jung and Valek) (finding a reference is considered to be analogous art if it is in the "same field of endeavor" as the patent at issue).

PHOSITAs are not robots. Scientific Design Company, Inc., v. Saint-Gobain Ceramics & Plastics, Inc, IPR2022-00433, Paper 25 (August 3, 2023) (Abraham, joined by Kalan and Roesel) (agreeing with Petitioner that a PHOSITA is not an "automaton" and may compare and infer data without identifying matching testing parameters).

Support your local claims. Home Depot U.S.A., Inc., v. Lynk Labs, Inc., PGR2023-00016, Paper 8 (August 4, 2023) (Belisle, joined by Peslak and Raevsky) (analyzing effective filing date of claims to determine applicability of AIA and finding the patent eligible for post grant review because only the parent—not the grandparent—provided written description support for all claims).

Don't bet on it! Bring in a backup reference to address weak points. DK Crown Holdings Inc. v. Diogenes Limited, IPR2023-00268, Paper 9 (August 11, 2023) (O'Hanlon, joined by Jung and with a dissenting opinion by Saindon) (denying institution because the allegedly anticipatory reference teaches discrete rather than "continuous" retrieval of data).

No substitutions (without motivation), please. DISH Network Corporation et al v. Entropic Communications, LLC, IPR2023-00392, Paper 7 (August 11, 2023) (Scanlon, joined by Browne and Jurgovan) (denying institution where Petitioner's proposed combination required replacing an input device with a server without explaining why one of ordinary skill in the art would be motivated to do so).

Director states that's a no-go. Patent Quality Assurance, LLC v. VLSI Technology LLC, IPR2021-01229, Paper 131 (August 3, 2023) (Vidal) (finding sanctionable conduct – misrepresentations of fact – and ordering further briefing on whether party should be admonished and/or ordered to pay compensatory expenses).

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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