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: Patent Owner's burden to establish priority to foreign application, expert qualifications, how licensing impacts obviousness, and more!

Better put your money (and a translation) where your mouth is when foreign priority is important. Apple Inc. v. Scramoge Technology Ltd., IPR2022-00351, Paper 32 (July 27, 2023) (Wormmeester, joined by Lee and Easthom) (relying on foreign priority application, Patent Owner bore burden to show—with a translation—how a challenged claim was supported by the foreign application to predate prior art reference).

Experts don't necessarily need to be time travelers. Extractiontek Sales LLC v. Gene Pool Technologies, Inc., IPR2022-00625, Paper 39 (July 26, 2023) (Hardman, joined by Fredman and Wisz) (experience qualifying an expert in the art can be acquired after the effective filing date of a challenged patent).

It's not a license to drive away from an IPR! Apple Inc. v. Billjco LLC, IPR2022-00427, Paper 41 (July 18, 2023) (Dang, joined by Browne and Baer) (mere existence of licenses to challenged patent could not, without showing nexus to the invention, overcome a convincing case of obviousness).

Don't just look at the pictures. Skywalker Holdings, LLC v. Board & Batten Int'l Inc., IPR2023-00350, Paper 10 (July 18, 2023) (Murphy, joined by Saindon and Cherry) (even though the examiner considered a reference during prosecution, the Office erred by overlooking non-illustrated embodiments described in the reference; IPR instituted based on the reference).

Mentioning a reference isn't enough to avoid IPR. Oracle Corp. v. Parking World Wide LLC, IPR2023-00385, Paper 8 (July 19, 2023) (Wood, joined by Saindon and Silverman) (patent not insulated from IPR based on a reference just because the patent specification mentions the reference).

Enough is enough! T-Mobile USA, INC., v. VoIP-Pal.com, Inc., IPR2023-00638, IPR2023-00639, IPR2023-00640, IPR2023-00641, Paper 11 (July 28, 2023) (Weatherly, joined by McMillin and Ogden) (denying institution of a second petition because the Petitioner already used the Board's finite resources in connection with its first set of petitions and the Board agreed that "enough is enough!").

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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Posted: August 7, 2023