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

By Hengyi Jiang and Pei Wu

So, what's new at the PTAB? No adverse judgment despite disclaimer of all claims, reversing institution decision after claims are dropped from parallel litigation, improper use of AAPA, and more!

No IPR will be instituted based on disclaimed claims. Microsoft Corporation v. LiTL LLC et al, IPR2021-01011, Paper 11 (April 5, 2022) (Baer, joined by Ankenbrand and Range) (The Board denied petitioner's request for rehearing of the decision denying institution after Patent Owner disclaimed all claims and rejected Petitioner's argument that the Board should have entered adverse judgment because no inter partes review will be instituted based on disclaimed claims under 37 C.F.R. § 42.107(e)).

Second chance for PGR if claims are dropped from the parallel district court litigation. Daiichi Sankyo, Inc. et al v. Seagen Inc. f/k/a Seattle Genetics, Inc., PGR2021-00042, Paper 18 (April 7, 2022) (Snedden, joined by Franklin and Kaiser) (The Board granted Petitioner's request for rehearing of a decision in which the Board had denied post-grant review based on the fact that the trial date in a parallel district court case was set for four months before the date for the Board to issue a final written decision, because the Patent Owner subsequently ended up dropping the challenged claims from the parallel district court litigation).

Applicant Admitted Prior Art ("AAPA") cannot form the "basis" for IPR. MED-EL Elektromedizinische Geräte GmbH v. Advanced Bionics AG, IPR2020-01016, Paper 42 (March 31, 2022) (Jeschke, joined by Daniels and Marschall) (The Board denied institution of an IPR because the basis for the ground was AAPA. The Board concluded that AAPA constituted the "basis" of a ground because Petitioner relied on only AAPA for several "structural and functional limitations" in a

claim directed to a cochlear implant system and relied on a printed publication for only one additional electrical system limitation in the claim).

Printed but not published: Operating manuals distributed to ten unique entities with implied confidentiality requirement are not printed publications. Weber, Inc. v. Provisur Technologies, Inc., IPR2020-01556, Paper 67 (March 31, 2022) (Jurgovan, joined by Weatherly and Ippolito) (The Board held that two operating manuals that had been distributed to ten unique customers were not printed publications because ten unique customers did not exceed "a limited number of entities" and because both the inscription and a terms and conditions clause associated with the sale of the product prohibited disclosure of the manuals without the distributor's consent, which effectively constituted a confidentiality agreement).

Bueller? Bueller? Bueller? Repeated petitions against the same patent are discouraged. Apple Inc. v. Koss Corp., IPR2022-00053, Paper 10 (April 4, 2022) (Beamer, joined by Scanlon and Mckone) (The Board denied institution of an IPR and Petitioner's Motion for Joinder because the General Plastic factors weighed against institution where it was the Petitioner's third petition against the same patent and the Petitioner failed to explain the timing of its third petition and its knowledge of the asserted prior art).

New art can be sufficient for IPR institution. Esdec, Inc. et al v. Unirac, Inc., IPR2021-01566, Paper 13 (April 5, 2022) (Gerstenblith, joined by Grossman and Peslak) (The Board granted institution of inter partes review of a patent directed to mounting solar panels on a roof and, in doing so, rejected the Patent Owner's argument that institution should be denied under 35 U.S.C. § 325(d)—which permits the Patent Office to reject the petition if the "same or substantially the same prior art or arguments previously were presented to the Office"—finding that the Petitioner had cited new prior art that was not substantially the same as previously presented 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.

Banner Witcoff is recognized as one of the best performing and most active law firms representing clients in inter partes review (IPR) proceedings. To learn more about our team of seasoned attorneys and their capabilities and experience in this space, click here.

Banner Witcoff's PTAB Highlights are provided as information of general interest. They are not intended to offer legal advice nor do they create an attorney-client relationship.

Posted: April 18, 2022