

# 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: the impact of prosecution history on IPR institution, the recommended ranking paper for parallel petitions, proving commercial success, and more!

**Don't overlook the Examiner's reasons for allowance if you need to distinguish previously considered art.** Alarm.com, Inc. v. Vivint, Inc., IPR2022-00728, Paper 6 (November 1, 2022) (Boudreau, joined by Zecher and Ahmed) (denying institution under 35 U.S.C. § 325(d) where Examiner's reasons for allowance establish that the petition presents substantially the same prior art and arguments previously considered, even though none of the references were the same).

**An ex parte appeal decision can be evidence of Examiner error.** Exactech, Inc. v. Zimmer, Inc., IPR2022-00836, Paper 15 (November 8, 2022) (O'Hanlon, joined by Parvis and Moore) (instituting IPR where Petitioner successfully showed that Examiner erred in failing to consider a secondary reference in view of appeal decision establishing that the Examiner erred in applying a primary reference, thereby demonstrating that § 325(d) denial was unwarranted and the previously considered, secondary reference could be applied in the petition).

**2 petitions, no ranking paper...no problem.** Micron Technology, Inc. v. Netlist, Inc., IPR2022-00744, Paper 15 (November 1, 2022) (Khan, joined by Jurgovan and Galligan) (instituting two parallel petitions challenging different claims of the same patent even though Petitioner did not submit the ranking paper recommended in the PTAB's Trial Practice Guide because Patent Owner asserted a large number of claims (29) in district court and because Petitioner explained that it needed a second petition to address an additional limitation in one of the independent claims).

**Using a reference that operates in a different manner can make a difference in your petition.** Docusign, Inc. v. Paul C. Clark, IPR2022-00923, Paper 8 (November 1, 2022) (Cygan, joined by Khan and Melvin) (finding Petitioner's reference not cumulative to reference cited during prosecution where the two references operate "in a different manner" that is relevant to the claims, and declining to exercise discretion under 35 U.S.C. § 325(d)).

**Anchor obviousness rationale to intrinsic evidence to avoid the appearance of impermissible hindsight reconstruction.** STMicroelectronics, Inc. v. The Trustees of Purdue University, IPR2022-00723, Paper 9 (November 8, 2022) (Obermann, joined by

Kokoski and Abraham) (denying institution on the merits because the petition “relies largely on extrinsic opinion testimony and background publications” and the obviousness rationale “is not tethered adequately to any intrinsic disclosure within the four corners of the reference”).

**Evidence of commercial success must clearly show all claim features.** Kaijet Technology International Limited, Inc. d/b/a j5create v. Sanho Corporation, IPR2021-00886, Paper 55 (October 25, 2022) (Chang, joined by Barrett and Galligan) (finding no nexus between the asserted evidence of secondary consideration and the claims where the commercial product does not clearly show all claim features and relies on annotations and conclusory statements from expert).

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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: November 17, 2022**