PTAB Highlights | Six Quick Takes from Recent Decisions in Post-Issuance Proceedings

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First ever Director review, the real problem with assumptions, and unique circumstances for refiling a petition are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

First ever Director review granted, decision vacated, case remanded. Ascend Performance Materials Operations LLC v. Samsung SDI Co., Ltd., IPR2020-00349, Paper 57 (November 1, 2021) (Hirshfeld) (This case marks the first time that the USPTO Director has exercised his authority to review the Board's final written decisions under the U.S. Supreme Court's Arthrex decision – the Director vacated the Board's final written decision and remanded the case back to the Board to address the patentability of certain claims that the Board previously failed to specifically address).

The real problem with assumptions: you can't challenge them without pointing to an error. Volkswagen Group of America, Inc. v. Stratosaudio, Inc., IPR2021-00718, Paper 16 (October 25, 2021) (Jung, joined by Arbes and Trock) (exercising discretion to deny institution because, in part, it is assumed an examiner considered all references on an IDS, but Petitioner merely noted that a relied-upon reference was cited among 183 references and failed to point out any error in the examiner's evaluation of the relied-upon reference).

It is NOT better to ask the PTAB for forgiveness, than permission. Ice Castles, LLC v. James Youngstrom, IPR2021-01179, Paper 8 (October 26, 2021) (Goodson, joined by Dougal and Finamore) (Board denied and expunged Petitioner's motion seeking leave to file a reply to preliminary response because Petitioner didn't first obtain authorization for the motion).

Unique circumstances can warrant refiling a Petition after it was discretionarily denied. Regeneron Pharmaceuticals, Inc. v. Novartis Pharma AG, IPR2021-00816, Paper 13 (October 26, 2021) (Kinder, joined by Franklin and Sawert) (PTAB discretionarily denied Petitioner's first petition due to ITC trial date, but instituted refiled petition after Patent Owner dropped the ITC case right before trial.)

To be helpful, Patent Owner's commercially successful product must be coextensive with Patent Owner's claims. Atlas Copco Tools and Assembly Systems LLC et al v. Wildcat Licensing WI LLC, IPR2020-00891, Paper 56 (November 1, 2021) (Jung, joined by Browne and Tartal) (holding Patent Owner's evidence of secondary consideration insufficient because Patent Owner fails to show its commercially successful product includes every limitation of the claim).

No bad faith, no problem to amend mandatory notices to add real parities-in-interest. One World Technologies, Inc. d/b/a Techtronic Industries Power Equipment v. Chervon (HK) Limited, IPR2020-00884, Paper 55 (November 3, 2021) (Mayberry, joined by Grossman and Finamore) (granting Petitioner's motion to amend Mandatory Notices to add real parties-in-interest because Patent Owner fails to identify any way that Petitioner may benefit from not naming the disputed entities earlier and the mere fact that Petitioner was aware of the disputed entities is not sufficient to indicate bad faith or gamesmanship).

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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