

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

By Blair Silver and Hugh Warren

Denials of institution despite stipulations, relying on art not listed in grounds, and denial of a motion to extend the statutory deadline are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

Discretionary Denial Despite Stipulation Not to Pursue Invalidity. Stipulation not to pursue invalidity in district court does not avoid discretionary denial under Fintiv because stipulation only reduced, but did not eliminate, concerns of overlapping issues and district court trial date was substantially in advance of final written decision of the Board. Philip Morris Products S.A. v. RAI Strategic Holdings, Inc., IPR2020-00921, Paper 9 at 19-20, 28-29 (Nov. 16, 2020) (Per Curiam: Kokoski, Roesel, and Ankenbrand).

Ambiguous Conditional Stipulation Does Not Favor Institution. Conditional stipulation not to pursue invalidity in district court does not place the fourth Fintiv factor in favor of institution where the stipulation is ambiguous and the trial date is set for seven months before issuance of a final written decision. Google, LLC, et al. v. Agis Software Development, LLC, IPR2020-00873, Paper 16 at 12–15 (Nov. 25, 2020) (Jefferson, joined by Boudreau and Laney).

Denying Institution for Relying on Art Not Listed in Ground. Denying institution in a post-grant review because Petitioner relied on additional references in the petition not identified in the grounds of unpatentability to establish claim elements, requiring the Patent Owner and the Board to guess how the references apply to each ground. Eton Pharmaceuticals, Inc. v. Exela Pharma Sciences, LLC, PGR2020-00064, Paper 12 at 14 -17 (Nov. 18, 2020) (Jenks, joined by Mitchell and Paulraj).

Discretionary Denial – ITC Proceeding. Denying institution in light of parallel ITC case despite the fact that Petitioner filed the petition only one month after Patent Owner filed its complaint in the ITC. Philip Morris Products SA v. RAI Strategic Holdings, Inc., IPR2020-00919, Paper 9 at 12-13 (Nov. 16, 2020) (Per Curiam: Kokoski, Roesel, and Ankenbrand).

Denial of Good Cause Extension of Final Written Decision. The Board rejected Petitioner's argument that the volume of information submitted by Patent Owner in 11 related proceedings rendered the schedule unworkable and denied Petitioner's request for a three-month extension. Medtronic, Inc., et al. v. Teleflex Innovations S.A.R.L., IPR2020-00126, Paper 75 at 5 (Nov. 25, 2020) (Snedden, joined by Tornquist and Paulraj).

Claim Construction Requirements. A petition complies with the claim construction requirements of 37 C.F.R. § 42.104(b)(3)–(4) where the petition identifies that "any claim term not expressly discussed should be interpreted under their ordinary and customary meaning as understood by one of ordinary skill in the art" and also identifies where each element of the claims is alleged to be found in the prior art. Glux Visual Effects Tech (Shenzhen), et al. v. Ultravision Technologies, LLC, IPR2020-01052, Paper 9 at 13 (Nov. 23, 2020) (Pothier, joined by Daniels and Kinder).

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