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

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.

Here are takeaways from recent decisions of interest relating to PTAB proceedings:

- The Supreme Court vacated and remanded the Federal Circuit's decision and held that under 35 U.S.C. § 314(d), PTAB's § 315(b) institution determination is not appealable because § 314(d)'s text does not limit the review bar to § 314(a).
  Thryv, Inc. v. Click-To-Call Technologies, LP, U.S., No 18-916 (April 20, 2020) (Ginsburg, joined by Roberts, Breyer, Kagan, and Kavanaugh, joined by Thomas and Alito, except as to Part III-C, and dissented by Gorsuch and Sotomayor).

- PTAB granted petitioner's motion for additional discovery, from patent owner and third party, of employment agreements and invention disclosures related to the challenged patents but denied petitioner's motion for additional discovery of financial interest documents.
  Google LLC v. IPA Technologies Inc., IPR2019-00730, Paper No. 55 (April 14, 2020) (Jefferson, joined by Barrett and Gerstenblith).

- PTAB granted institution of inter partes review after considering the General Plastic factors because the prior IPR petition was independently filed by a different party having no overlap or cooperation with the petitioner and there was no showing of undue delay or abusive filing of the petition.
  Microsoft Corp. v. Uniloc 2017 LLC, IPR2020-00023, Paper No. 7 (April 14, 2020) (Quinn, joined by Medley and O'Hanlon).

- PTAB denied a motion to stay continuation reissue applications of the challenged reissue patent because the continuation reissue applications did not involve the challenged reissue patent under 35 U.S.C. § 315(d).
  Cirrus Design Corp. v. Hoyt Augustus Fleming, IPR2019-01566, Paper No. 38 (April 13, 2020) (Cocks, joined by Moore and Belisle).

- PTAB granted institution of IPR, finding that patent owner (then-applicant) did not overcome combined teachings of prior art references during prosecution by persuading examiner to allow proposed claims based on secondary considerations of nonobviousness supported by inventor's declaration disclosing unexpected results. Board concluded the petitioner's declaration, supported by evidence concerning state of the art at time of invention, is more credible than the unsupported opinions of the inventor's declaration that led to allowance.
  Prollenium US Inc. et al v. Allergan Industrie SAS et al, IPR2020-00084, Paper 12 (April 10, 2020) (New, joined by Snedden and Pollock).

- PTAB granted institution of IPR and petitioner's motion for joinder with a prior-instituted IPR that relies on the same prior art analysis and declaration from the same expert, finding that the newly-instituted IPR does not present any ground or matter not already at issue in the prior-instituted IPR, that a "copycat" petition accompanied by a motion to join an earlier proceeding is not a repeated attack on a patent, and that the joinder will not put additional burden on the Board because petitioner represents it will agree to a "completely inactive" role.
  Apple Inc. v. Uniloc 2017 LLC, IPR2020-00224, Paper 10 (April 6, 2020)(Medley, joined by Deshpande and Weinschenk).

- PTAB granted institution of IPR, finding that with respect to prior art previously presented to the Office, the record suggests material error under the second part of the Advanced Bionics framework during prosecution of the challenged patent.
  HTC Corporation et al v. Motiva Patents, LLC, IPR2019-01665, Paper 9 (April 3, 2020) (Pettigrew, joined by Ullagaddi and Ahmed).

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