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

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Uncertainty of district court trial, parallel IPRs, and Patent Owner's financial circumstances are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

Uncertainty of District Court Trial Due to COVID-19 Pandemic is Not Enough to Grant Institution. The Board was not persuaded by Petitioner's argument that the COVID-19 pandemic created substantial uncertainty as to the trial date at the District Court and denied institution as there would be a high possibility of an overlap between the issues raised in the Petition and the parallel litigation in the District Court. Samsung Electronics Co., Ltd. v. Ancora Technologies, Inc., IPR2020-01184, Paper 11 at 12-13 (Jan. 8, 2021) (Chang, joined by Dang and Cherry).

Stipulation Against Parallel Invalidity Challenge Weighs Strongly in Favor of Institution. Citing the recent precedential PTAB decision in Sotera Wireless, Inc. v. Masimo Corporation, IPR2020-01019, Paper 12 (Dec. 1, 2020), the Board instituted based in part on Petitioner's stipulation not to pursue invalidity in district court using "any ground raised or that could have been reasonably raised" in the Petition. The Board allowed the stipulation to be filed after Patent Owner's Preliminary Response and found that the stipulation weighed strongly in favor of institution. Samsung Electronics Co. v. Acorn Semi, LLC, IPR2020-01206, Paper 22 (Jan. 13, 2021) (McNamara, joined by Kenny and Moore).

Priority Dispute Justifies Institution of Parallel IPRs. The PTAB found that instituting parallel IPRs is justified when one petition relies on a reference that is indisputably prior art and the other petition challenges the patent's priority date and relies on an intervening reference. The Board found that instituting both petitions would beneficially allow the issues to be addressed separately.

Samsung Electronics Co. v. Acorn Semi, LLC, IPR2020-01206, Paper 22 (Jan. 13, 2021) (McNamara, joined by Kenny and Moore).

"The Effect of the Economy" in 35 U.S.C. § 316(b) Does Not Include Patent Owner's Financial Circumstances. The Board denied Patent Owner's request for rehearing of the decision to grant institution by rejecting the Patent Owner's argument that the Board overlooked its duty under 35 U.S.C. § 316(b) to consider the effect of the economy by granting institution. The Board reasoned that the extrapolation of the Patent Owner's own financial circumstances to the economy as a whole lacks sufficient evidentiary support, and the Patent Owner's current financial circumstances are not sufficient reason to preclude Petitioner from pursuing its statutory rights to challenge the patentability of the claims. Microsoft Corporation v. Dareltech, LLC, IPR2020-00483, Paper 26 at 8-9 (Jan. 5, 2021) (McNamara, joined by Trock and Melvin).

SAS **Requires Addressing All Challenged Claims on Remand.** After a Federal Circuit decision affirming invalidity of claim 11 and vacating the PTAB's holding that claims 1-4 and 8 were indefinite, the PTAB on remand held that claims 1-4 and 8 were also invalid. Swatting down Patent Owner's argument that the IPR should be terminated after a validity verdict in district court, the PTAB quoted the Supreme Court's SAS holding that "[petitioner] is entitled to a final written decision addressing all of the claims it has challenged." Samsung Electronics America, Inc. v. Prisua Eng. Corp., IPR2017-01188, Paper 86 (Jan. 14, 2021) (Parvis, joined by White and McMillin).

Obviousness: Could Modify vs. Would be Motivated to Modify. The Board denied institution stating that the Petitioner failed to provide sufficient reason for a skilled artisan to modify the prior art to arrive at the claimed invention. The Petitioner's sole assertion that the proposed modification represented a design choice failed to provide a sufficient reason for obviousness. Globus Medical, INC. v. Moskowitz Family LLC, IPR2020-01305, Paper 7 at 25-28 (Jan. 8, 2021) (Mayberry, joined by Petravick and Powell).

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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