

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

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Timeliness of motions, failure to respond to a ground of unpatentability in a motion to amend, and witness credibility are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

Timeliness of Motions. Budgetary constraints do not necessarily constitute good cause for delay in filing. [Square, Inc. v. Electronic Receipts Delivery Systems, LLC](#), CBM2020-00015, Paper 23 (April 21, 2021) (Quinn, joined by Arbes and Pettigrew).

Analogous Art. A reference is “reasonably pertinent” to a problem if it “logically would have commended itself to an inventor’s attention in considering his problem.” [Google LLC v. Hammond Development International, Inc.](#), IPR2020-00020 Paper 38 (April 12, 2021) (Wormmeester, joined by Hagy and Sawert).

Credibility of Witness. Corroborative evidence negates any supposed self-interest that may taint an inventor’s testimony, and the sufficiency of corroborative evidence is determined by a rule of reason analysis. [LSI Corporation et al v. Regents of the University of Minnesota](#), IPR2017-01068, Paper 58 (April 14, 2021) (Bisk, joined by Weinschenk and Boudreau).

Failure to Respond to a Ground of Unpatentability. In determining whether a proposed substitute claim responds to a ground of unpatentability, the responsiveness analysis requires reviewing the entirety of the record to determine whether a patent owner’s amendments respond to a ground of unpatentability and it is not required that the analysis be made on a claim-by-claim basis. [Renesas Electronics Corporation v.](#)

[Broadcom Corporation](#), IPR2019-01040 Paper 41 (April 15, 2021) (Giannetti, joined by Boucher and Beamer).

Anticipation Based on Provisional Patent. A provisional patent does not necessarily form part of a corresponding non-provisional application for purposes of anticipation where the non-provisional fails to identify the subject matter of the provisional with particularity. [NeuMoDx Molecular, Inc. v. HandyLab, Inc.](#), IPR2020-01133, Paper 21 (April 19, 2021) (Kokoski, joined by Snedden and Paulraj).

Request for Rehearing. A motion that has not been filed prior to issuance of an institution decision will not be considered, and cannot be misapprehended or overlooked by the Board. [Amazon.com, Inc., et al v. VB Assets, LLC](#), IPR2020-01374, Paper 12 (April 19, 2021) (O'Hanlon, joined by Kinder and Moore).

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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