

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).

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