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

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So, what's new at the PTAB? Applying prior art considered during prosecution, expert qualifications, and failure to address secondary considerations, and more!

Cited art is not necessarily evaluated **art**. Satco Products, Inc. v. The Regents of the University of California, IPR2021-00662 (November 8, 2021) (Bisk, joined by Crumbley and Amundson) (finding Examiner erred in not evaluating cited references, which were initialed as being "considered," in the same way as a reference used to reject a claim).

Expert doesn't need to have been qualified during **relevant time frame**. BMW of North America, LLC et al v. Paice LLC et al., IPR2020-00994 (November 10, 2021) (Peslak, joined by Medley and Deshpande) (finding Expert not obtaining his bachelor's degree until after September 1999 irrelevant to whether expert was qualified to offer testimony from the perspective of one of ordinary skill in the art as of September 1999).

Stop me if you've heard this one before: A real party-in-interest walks into a time bar … or does it? Unified Patents, LLC f/k/a Unified Patents Inc. v. B# On Demand LLC, IPR2020-00995 (November 10, 2021) (Peslak, joined by Chang and Braden) (rejecting the Patent Owner's argument that the Petitioner's failure to name an RPI created a jurisdiction issue, and finding that although the alleged RPI was time barred as of the date of the final written decision, the alleged RPI was not time barred as of the date that the Petition was filed).

Patent Owners Beware: Don't let your no-anticipation arguments go up in smoke**—you must rely on** evidence**, not attorney argument.** Phillip Morris Prods SA v. RAI Strategic Holdings, Inc., IPR 2020-00920 (Nov. 15, 2021) (Kokoski joined by Roesel and Ankenbrand) (finding certain

challenged claims unpatentable for anticipation under 35 U.S.C. § 102 where Petitioner provided credible expert testimony on how a PHOSITA would have understood the asserted reference, and Patent Owner provided only attorney argument instead of evidence).

Hey, let's be objective **here: The Board must address objective evidence "secondary considerations" of nonobviousness.** Proppant Express Investments, LLC et al. v. Oren Technologies LLC et al., IPR2018-00733 (Nov. 18, 2021) (Hirshfeld) (Director vacating and remanding the Board's final written decision because the Board failed to address the Patent Owner's objective evidence of nonobviousness).

Better Late Than Never? The Board has authority to issue a Final Written Decision over three years after institution. Collegium Pharmaceutical, Inc. v. Purdue Pharma et al., PGR2018-00048 (Nov. 19, 2021) (Newman joined by Paulraj and Sawert) (denying Patent Owner's motion to terminate the proceedings and finding that, under the unique circumstances at issue (including a stay triggered by the Patent Owner's bankruptcy proceeding), the Board was not divested of its statutory authority to issue a final written decision over three years after institution, and subsequently finding all challenged claims unpatentable).

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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