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

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So, what's new at the PTAB? Determining whether references are analogous art, translations providing new evidence, claim differentiation, improper reliance on patent drawings, and more!

Similar technical features alone do not qualify a reference as analogous prior art. Mito Red Light v. JOOVV, IPR2024-00621, Paper 7 (September 19, 2024) (Lorin, joined by Peslak and O'Hanlon) (The Board denied institution because a cited reference was not analogous prior art. Even though there were overlapping technical aspects, the reference was in a different field of endeavor and not reasonably pertinent to the problem the challenged patent was trying to solve.).

Translations of previously examined references may qualify as new prior art. Champion Laboratories v. Hengst SE, IPR2024-00603, Paper 9 (September 18, 2024) (McGee, joined by McGraw and Roesel) (The Board declined to deny institution under § 325(d) because Petitioner cited an English translation of a reference which was presented to an Examiner only in Japanese. The Board found that the English translation provided additional, more readily discernible information and therefore was not the same or substantially same art that was previously presented to the Office.).

Identification is not a requirement for relevant and analogous art. Nespresso USA, INC. v. K-FEE System GMBH, IPR2023-00485, Paper 26 (September 10, 2024) (Tornquist, joined by Obermann and Mayberry) (a prior art reference need not identify or discuss another reference for that reference to be deemed relevant or analogous art, even if the two references have a common owner and a common inventor and the second was filed days after the first and without mentioning the first).

Two separately recited claim terms can still overlap. Microsoft Corp. v. Lemko Corp., IPR2023-00531, Paper 31 (September 10, 2024) (Raevsky, joined by Ippolito and Range) (the mere fact that a claim separately recites two different claim terms (e.g., "a DMA server" and "a legacy communications network") does not guarantee that one of those terms excludes the other).

It quacks like a duck. But is it actually a duck? Masimo Corp. v. Apple Inc., IPR2023-00664, Paper 46 (September 11, 2024) (Kinder, joined by Barrett and Cocks) (holding that the possibility that an object shown in a drawing could perform a function is speculation and, without more, does not render a claimed feature obvious).

Looking to file an IPR while litigating in district court? Make sure your trial date is not too close. Pharaoh energy services v. flex-chem holding company, IPR2024-00822, Paper 6 (September 20, 2024) (Jeschke, joined by Marschall and Peslak)(The Board denied institution of an IPR in view of the timeline in the parallel district court litigation, noting that the planned district court trial would start months before a final written decision).

Use references to support an expert's testimony on key claim limitations. Xilinx v. Sentient Sensors, IPR2023-00195, Paper 36 (September 18, 2024) (Zado, joined by Jurgovan and McShane)(The Board found obviousness based on expert testimony that cited numerous references as support for statements about a key limitation of the claims).

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