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

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So, what's happening at the PTAB? Settled expectations, the effects of ITC Investigations, additional discovery, and more!

Just old enough. With age comes wisdom and stronger settled expectations. Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc., IPR2025-00435, Paper 11 (June 27, 2025) (Acting Director Stewart) (granting discretionary denial because the challenged patent in the current case belongs to a family that has stronger settled expectations because it has been in force between seven and nine years as opposed to a related case's family of patents being in force for a shorter duration of time).

Have you settled down yet? If so, your patent could be safe from IPR. Dabico Airport Solutions Inc. v. AXA Power ApS., IPR2025-00408, Paper 21 (June 18, 2025) (Acting Director Stewart) (discretionarily denying institution because the "challenged patent has been in force almost eight years, creating settled expectations").

Do your investigation. If there's an ITC Investigation, then there's no IPR. Ecto World, LLC v. RAI Strategic Holdings, Inc., IPR2024-01280, Paper 16 (June 25, 2025) (Kokoski, joined by Kaiser and Range) (on remand from Acting Director Stewart to determine whether to institute IPR based on her Director Review Decision, denying institution because, in part, the corresponding ITC Investigation is at an advanced stage—discovery and claim construction are complete and an evidentiary hearing was held).

Not so fast. Must be quicker than the District Court. Cellco Partnership d/b/a Verizon Wireless et al v. Pegasus Wireless Innovation LLC, IPR2025-00138, Paper 17 (June 26, 2025) (Deshpande)

(granting discretionary denial because a written decision from the Office is unlikely to be issued before the district court's trial date therefore hearing the case is not appropriate).

Even the Board slips up. decision to fix discovery errors. Sua Sponte Semiconductor Components Industries, LLC d/b/a onsemi v. Greenthread, LLC, IPR2024-00263, Paper 61 (June 27, 2025) (Obermann, joined by Ullagaddi, Droesch, Praiss, and Heaney) (Board, sua sponte, authorized post-hearing discovery and briefs limited to a privity dispute with a non-party because the Board's earlier decision in a first round of cases between the parties denied additional discovery, thereby failing to illuminate a correct result regarding the privity issue).

Read closely…this takeaway is not moot. Apple, Inc. v. Proxense, LLC, IPR2024-00233, Paper 35 (June 17, 2025) (McKone, joined by Dang and Turner) (holding claims unpatentable based on an argument that an examiner initially made in an ex parte reexam and later stated was moot because the examiner's statement that it was "moot" does not mean the Patent Owner successfully refuted the argument).

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