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

Here are takeaways from recent decisions of interest relating to PTAB proceedings:

Motion to Amend. In a case in which the PTAB's pilot program for motions to amend practice and procedure was applied, a contingent motion to amend was granted as to the claim reached. Notably, this result favorable to the patent owner was obtained after the Board initially expressed patentability concerns over the amended claim in its Preliminary Guidance. The patent owner's reply to the petitioner's opposition to the motion to amend "overcame the patentability concerns expressed in the Preliminary Guidance."
Koa Corp. v. Vishay Dale Electronics, LLC, IPR2019-00201, Paper 30 (May 7, 2020) (Droesch, joined by Kaiser and Hagy).

Discretionary Petition Denial. An IPR petition was discretionarily denied under 35 U.S.C. § 314(a) in view of the late stage of parallel district court litigation. Citing to its prior decision in NHK Spring Co., Ltd. v. Intri-Plex Tech., Inc., IPR2018-00752, Paper 8 (Sept. 12, 2018) (precedential), the Board referenced as key factors leading to its decision: that the trial date set was substantially before (more than seven months) the Board would issue a final written decision; both the parties and the court having invested substantial time and resources, including in connection with discovery (fact discovery closed) and claim construction; the similarity of evidence and grounds of invalidity asserted in the petition and in the district court litigation; and the overlap of claims at issue in the two proceedings.
Vizio, Inc. v. Polaris PowerLED Technologies, LLC, IPR2020-00043, Paper 30 (May 4, 2020) (Szpondowski, joined by Kauffman and Deshpande)

Discretionary Petition Denial. An IPR petition was discretionarily denied under 35 U.S.C. § 314(a) in view of the late stage of parallel district court litigation. The Board cited to Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5 (March 20, 2020) (precedential) as support for balancing

the following non-exclusive factors pursuant to its precedential NHK decision: (1) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted; (2) proximity of the court's trial date to the Board's projected statutory deadline for a final written decision; (3) investment in the parallel proceeding by the court and the parties; (4) overlap between issues raised in the petition and in the parallel proceeding; (5) whether the petitioner and the defendant in the parallel proceeding are the same party; and (6) other circumstances that impact the Board's exercise of discretion, including the merits. Addressing each factor in turn, the Board determined that "[o]n balance, based on the facts presented, particularly the advanced stage of the [] litigation, a currently scheduled trial date approximately seven months before the would-be deadline for a final written decision, and the overlap between the issues presented there and in the Petition, we find that it would be an inefficient use of the Board, party and judicial resources to institute the present proceeding."
Intel Corp. v. VLSI Technology LLC, IPR2020-00106, Paper 17 (May 5, 2020) (Gerstenblith, joined by Dang and McGraw).

No Discretionary Petition Denial for Concurrent District Court Litigation. Where concurrent district court litigation between the same parties had not set a date for trial and had not decided Markman issues, the Board declined to exercise discretion to deny the petition under 35 U.S.C. § 314(a).
Church & Dwight Co., Inc. v. Randall Batinkoff, IPR2020-00168, Paper 11 (May 15, 2020) (Marschall, joined by Brown and Weatherly).

No Impermissible Hindsight. In denying patent owner's request for rehearing of a final written decision, the PTAB found no improper hindsight where the Board highlighted reasons, advanced by the petitioner, for combining prior art teachings—the PTAB further noting that improper hindsight is inferred when the principle underlying a POSITA's motivation to make the proposed combination has not been explained.
Wirtgen America, Inc. et al v. Caterpillar Paving Products, Inc., IPR2018-01201, Paper 34 (May 11, 2020) (Browne, joined by Mayberry and Marschall).

Failure to Teach Successful Result of Combination. IPR institution denied where petitioner failed to show the prior art combination similar to the patented composition would also demonstrate the claimed chemical stability.
Reckitt Benckiser LLC v. GEMAK Trust, IPR2020-00186, Paper 8 (May 15, 2020) (Abraham, joined by Kaiser and Derrick).

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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