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

A precedential opinion on the Board's limits to deny a motion to amend, collateral estoppel, and using multiple petitions to address means-plus-function claim terms are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

Limits on Denial of Motion to Amend. The Precedential Opinion Panel (POP) vacated the Board's denial of a motion to amend based on a ground of unpatentability that the Board raised sua sponte against substitute claims proposed in the motion to amend. The POP noted that the Board may, in certain rare circumstances, raise a ground of unpatentability that a petitioner did not advance, or insufficiently developed, against substitute claims proposed in opposing a motion to amend, but those circumstances are limited to situations in which the adversarial process fails to provide the Board with potential arguments of patentability with respect to the proposed substitute claims. The POP further noted that when the Board raises such a new ground of unpatentability, the Board needs to provide notice to the parties, so that the parties can have an opportunity to respond to the new ground of unpatentability. Hunting Titan, Inc. v. DynaEnergetics Europe GmbH, IPR2018-00600, Paper 67 (July 6, 2020) (Boalick, joined by Iancu and Hirshfeld).

Collateral Estoppel. Asserting additional references or an additional embodiment does not prevent at least some previously litigated issues from being collaterally estopped. Alphatec Holdings, Inc. v. NuVasive, Inc., IPR2019-00361, Paper 59 (July 8, 2020) (Jung, joined by Pothier and McShane).

Multiple Petitions to Address Means-Plus-Function. The presence of alleged indefinite means-plus-function terms does not justify a second petition. Google, LLC. v. Uniloc 2017 LLC, IPR2020-00448, Paper 11 (July 9, 2020) (Raevsky, joined by Weinschenk and Ullagaddi).

Motion for Joinder. The Board granted petitioner's motion for joinder, joining petitioner as a party to a related IPR, when joinder would not adversely impact the trial schedule, briefing, or discovery in the related IPR. Lenovo (United States) Inc. et al. v. Neodron Ltd., IPR2020-00682, Paper 10 (June 29, 2020) (Boucher, joined by Quinn and Ogden).

Request for Rehearing. The Board denied petitioner's request for rehearing of the decision to deny institution of inter partes review of a patent for failing to prove a reference was prior art, and rejected petitioner's new arguments that the reference was prior art, when the arguments were not presented in the petition or in an authorized reply to patent owner's preliminary response, but rather were presented for the first time in the request for rehearing. Axis Communications AB et al. v. Avigilon Fortress Corporation, IPR2019-00235, Paper 24 (June 26, 2020) (McGraw, joined by Braden and Kaiser).

Balancing the Fintiv Factors. Concerns about inefficiency of presenting arguments in the petition that are the same as the underlying litigation are outweighed by the fact that a trial date has not yet been set and petitioner intends to seek a stay. International Business Machines Corporation v. Trusted Knight Corporation, IPR2020-00323, Paper 15 (July 10, 2020) (Khan, joined by Giannetti and Mcnamara).

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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