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

Analogous art, priority dates, and part-time anticipation are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

Indefiniteness in Litigation. District court litigation strategy regarding indefiniteness does not impact the Board's conclusions regarding obviousness. Amneal Pharmaceuticals LLC et al v. Almirall, LLC et al., IPR2019-00207 (July 23, 2020) (Flax, joined by Mitchell, Paulraj).

Petition Limits. The PTAB did not abuse its discretion in instituting three petitions filed against the same patent owner (deemed appropriate under the circumstances where each petition challenged a different independent claim of the subject patent). Intel Corporation v. VLSI Technology LLC, IPR2019-01198, 01199, 01200 (July 17, 2020) (McGraw, joined by Dang and Pettigrew).

Priority Date. A reference patent is not entitled to the priority date of a provisional application in the absence of demonstrated support in the Petition for the claims in the provisional application. Sirius XM Radio Inc. v. Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V., IPR2018-00690 (July 23, 2020) (Smith, joined by White and Wormmeester).

"Part-Time" Anticipation. "Part-time" satisfaction of software aspects in an apparatus claim is sufficient to establish anticipation. Webpower Inc., v. WAG Acquisition LLC, IPR2016-01238 (July 16, 2020) (Boucher, joined by Jefferson and McNamara).

Definiteness. The understanding of a person of ordinary skill in the art can provide a standard to define claim terms that could otherwise be unclear or ambiguous. U.D. Electronic Corp. v. Pulse Electronics, Inc., IPR2019-00511 (July 22, 2020) (Turner, joined by Bain and McKone)

Analogous Art. No requirement to identify a problem in a primary reference solved by a secondary reference to consider them analogous art. Unified Patents Inc. v. Carrum Technologies, LLC,

IPR2019-00481 (July 15, 2020) (Browne, joined by Scanlon and Tornquist).

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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Posted: July 30, 2020