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

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.

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

- Request for rehearing was denied as additional evidence provided to substantiate a prior art reference as a printed publication was determined to be a new argument, which is inappropriate on a request for rehearing.
  In-Depth Geophysical, Inc. & In-Depth Compressive Seismic, Inc. v. Conocophillips Co., IPR2019-00849, Paper 17 (March 30, 2020) (Daniels, joined by Tartal and Moore).

- PTAB determined that testimony of inventors was sufficient to corroborate a patent priority date where additional testimony and verification by non-inventors, as well as dates and facts of the patent file further corroborated the inventors' testimony.
  Apple Inc. v. Qualcomm Inc., IPR2018-01460, Paper 50 (March 12, 2020) (Wormmeester, joined by Wieker and Moore).

- Institution of IPR was denied where petitioner's arguments overlapped with examiner's findings during prosecution.
  Regeneron Pharm., Inc. v. Kymab Ltd., IPR2019-01577, Paper 9 (April 1, 2020) (Yang, joined by Sawert and Valek).

- The PTAB denied institution of an IPR since petitioner had not shown a reasonable likelihood that two references, a video and an online user manual, were sufficiently publicly accessible and therefore the references did not qualify as prior art printed publications.
  Guardian Alliance Technologies, Inc. v. Tyler Miller, IPR2020-00031, Paper 23 (March 26, 2020) (McKone, joined by Medley and Kenny).

- Institution of an IPR granted after PTAB determined the General Plastic factors weighed in favor of granting the petition despite the existence of another, earlier-filed petition for an IPR challenging a claim of the same patent. Netflix, Inc. et al v. Uniloc 2017 LLC, IPR2020-00041, Paper 10 (March 25, 2020) (Dirba, joined by Boudreau and Galligan).

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