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

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So, what's new at the PTAB? Trusting public accessibility of a prior art reference, providing analysis of a product practicing the claimed invention, relying on a foreign patent office's views of a reference, and more!

You just can't trust the reference these days. Medivis, Inc. v. Novarad Corp., IPR2023-00042, Paper 35 (Mar. 6, 2024) (Raevsky, joined by Quinn and Zecher) (finding Petitioner failed to establish the public accessibility of a prior art reference after relying on the reference's claim that it was available online and that seven publications cited the reference).

Timing really matters for a long felt need. Arthrex, Inc. v. Gelfand, M.D., IPR2023-00014, Paper 45 (Mar. 11, 2024) (Jeschke, joined by Jenks and Snedden) (finding Patent Owner failed to show a long-felt need by failing to provide any analysis that the products addressing the need actually practiced the claimed invention as well as citing prior art techniques that already satisfied the need).

Show Real Parties Head-on! Intel Corporation v. AX Wireless LLC, IPR2023-01136, Paper 10 (Feb. 14, 2024) (McMillin, joined by Droesch and Hamann) (granting institution and dismissing Patent Owner's late arguments against institution based on HP and Acer's district court proceedings and lack of evidence linking HP and Acer as real-parties-in-interest).

USPTO is not in China. SharkNinja, Inc. et al v. Dyson Technology Limited, IPR2023-01322, Paper 7 (Feb. 27, 2024) (Tartal, joined by Ippolito and Meyers) (granting institution and finding that the use of references in prior examination and invalidation proceedings in China does not demonstrate that the same art or arguments were previously presented to the USPTO).

Distinct Details Matter. Permian Global Inc. et al v. Fuel Automation Station, LLC, IPR2023-01236, Paper 11 (Feb. 28, 2024) (DeFranco, joined by Marschall and Dougal) (granting institution and finding unpersuasive Patent Owner's argument that Petitioner's reference was cumulative because the reference provided distinct details not covered by the other references).

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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