



# PTAB HIGHLIGHTS

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## Takeaways From Recent Decisions in Post-Issuance Proceedings

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Motion to amend, swearing behind, and motion for additional discovery are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

**Discretionary Denial.** Split panel exercised its discretion to deny the petition due to the advanced stage of the parallel district court proceeding. Factors weighing in favor of denial included: the deadline for a final written decision was six months after trial was scheduled to begin, pre-trial invalidity contentions based on the same prior art and obviousness grounds had been filed, and pre-trial claim construction briefing and hearing that addressed the same claim construction issues was complete.

[\*Cisco Systems, Inc. v. Ramot at Tel Aviv University Ltd.\*](#), Nos. 2020-00122 and -00123, Papers 15 and 14 (May 15, 2020) (Repko, joined by Ullagaddi; Crumbley, dissenting)

**Motion for Additional Discovery.** Panel granted the patent owner's motion seeking additional discovery related to secondary indicia of nonobviousness, specifically commercial success and copying. Factors warranting additional discovery included: the requested documents were already available in the parallel district court proceeding and concerns about confidentiality could be easily addressed using the board's procedures for filing motions to seal and protective orders.

[\*Quanery Systems, Inc. v. Velodyne LiDAR, Inc.\*](#), Nos. 2018-00255-00256, Papers 62 and 66 (May 21, 2020) (Defranco, joined by Pinkerton and Woods)

**Incorporation by Reference.** Patent owner's voluminous citations to 150 paragraphs of its expert's declaration to support its arguments of a presumption of nexus between the challenged claims and its objective evidence of nonobviousness were not an improper

incorporation by reference because of the necessity for its expert to conduct a detailed analysis of how the challenged claims compared to the patent owner's products.

[Intel Corp. v. Tela Innovations, Inc.](#), Nos., 2019-01520, -01521, -01522, Paper 24 (May 18, 2020) (Kokoski, Kalan, and Derrick)

**Swearing Behind.** Panel found challenged claims unpatentable based on § 102(e) prior art after determining the patent owner's evidence of earlier conception and reduction to practice was not persuasive.

[Fidelity Information Services, LLC v. Groove Digital, Inc.](#), No. 2019-00050, Paper 65 (April 30, 2020) (public version available May 27, 2020) (Moore, Beamer, and Margolies)

**Secondary Considerations.** Panel found challenged claims unpatentable under § 103(a) and rejected the patent owner's argument that secondary considerations demonstrated nonobviousness because the patent owner failed to provide specific, persuasive evidence of long-felt need beyond a conclusory statement that the invention fulfilled a long-felt need in the oncology community.

[Foundation Medicine, Inc. v. Caris MPI, Inc.](#), No. 2019-00164, Paper 55 (May 28, 2020) (Paulraj, Sawert, and Cotta)

**Motion to Amend.** Panel's preliminary guidance on the patent owner's motion to amend indicated the proposed substitute claims were reasonably likely to respond to a ground of unpatentability and were not unpatentable under § 112, but that it was reasonably likely the proposed substitute claims added new subject matter and were likely to be found unpatentable under § 103.

[Renesas Electronics Corp. v. Broadcom Corp.](#), No. 2019-01040, Paper 19 (May 29, 2020) (Beamer, Boucher, and Giannetti)

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