



PTAB HIGHLIGHTS

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Takeaways From Recent Decisions in Post-Issuance Proceedings

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PTAB's handling of Federal Circuit remand, prosecution history with overlapping prior art, and level of skill in the art are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

Motion to Dismiss Denied Despite Federal Circuit Remand. Motion to dismiss denied when Federal Circuit remanded IPR proceeding to dismiss as time-barred, but the Federal Circuit's judgment was subsequently vacated by the Supreme Court. PTAB explains "regardless whether we technically have jurisdiction, we conclude that it would be imprudent to act in advance of the Federal Circuit addressing the Supreme Court's order."

[*Atlanta Gas Light Company v. Bennett Regulator Guards, Inc.*](#), IPR2015-00826, Paper 51 (June 5, 2020) (Boucher, joined by Bisk and Quinn)

Motion to Exclude. Motion to exclude inventor testimony is denied even when the named inventor is not qualified as an expert in the field because the inventor nonetheless testified, from a marketing standpoint, with personal knowledge of at least some aspects of the claimed invention, including its alleged conception and diligence towards reduction to practice, and because an *inter partes* trial is before factfinders rather than a jury, and the risk that a decision will be unfairly affected by the admission of arguably unqualified testimony is far less than in a jury trial.

[*Fidelity Information Services, LLC et al v. Groove Digital, Inc.*](#), IPR2019-00050, Paper 65 (April 30, 2020) (Beamer, joined by Moore and Margolies)

Level of Skill in the Art. In its decision instituting trial, PTAB explains that education and experience are but two of the numerous aspects to be considered to determine the level of skill in the art, including type of problems encountered in the art, prior art solutions to those problems, rapidity with which innovations are made, sophistication of the technology, etc.,

and the level of skill in the art is only useful if tied to an obviousness analysis.

[Intel Corporation v. XMTT, Inc.](#), IPR2020-00145, Paper 11 (May 20, 2020) (Kauffman, joined by Wormmeester and Dougal)

Motion for Joinder. Motion for joinder granted when petitioner showed that the petition (1) is substantively identical to the petition in the instituted IPR, (2) contains the same grounds based on the same evidence, and (3) relies on the same declaration. Petitioner has also agreed to join the IPR as a passive understudy and granting petitioner's joinder motion does not create an additional proceeding.

[Samsung Electronics America, Inc. v. Uniloc 2017 LLC](#), IPR2020-00340, Paper 10 (May 27, 2020) (Dirba, joined by Chung and Boudreau)

Institution Despite Prosecution History. No discretionary denial of institution when the same reference that was discussed in the background section of the patent at issue and discussed by the examiner in the notice of allowance was asserted as the primary reference for all grounds, but was combined with two other references that taught the elements that the examiner found to be missing.

[Volkswagen Group of America, Inc. v. Michigan Motor Technologies LLC](#), IPR2020-00169, Paper 8 (June 2, 2020) (O'Hanlon, joined by Weatherly and Tartal)

Rehearing. Request for rehearing denied when basis for rehearing request was an allegedly incorrect claim construction of a claim term that had no express construction proposed by either party, only an implied construction relied upon by petitioner.

[Chemco Systems, L.P. v. RDP Technologies, Inc.](#), IPR-2019-01562, Paper 13 (June 4, 2020) (Tornquist, joined by Abraham and Heaney)

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