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

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In this installment of the PTAB Highlights, Banner Witcoff attorneys examine recent decisions at the PTAB featuring: late notice of deposition, correcting clerical errors in a petition, the overlooked or misapprehended standard for a request for rehearing, and more!

Being late can sometimes be excused. IronSource LTD. V. Digital Turbine Inc., PGR2021-00096, Paper 36 (August 31, 2022) (Ahmed, joined by Ullagaddi)(denying motion to quash untimely notice of deposition because both parties knew of the deposition even though notice of deposition was late because of a docketing error).

Correction! Clerical error fixed. ResMed Inc. v. New York University, IPR2022-0989, Paper 10 (September 1, 2022)(Tartal, joined by Gerstenblith and Peslak)(granting Petitioner's motion to file a corrected petition to correct a clerical error by removing a sentence and adding a missing description of an exhibit).

Thumbnails qualify as "presentation data" and render claims obvious. Sling TV, L.L.C. v. Uniloc 2017 LLC, IPR2019-01363, Paper 39 (September 7, 2022) (Bisk, joined by Turner and Powell)(finding claims directed to aggregating and providing audio and visual presentations through a computer network were obvious after construing "presentation data" to encompass thumbnail images in prior art references).

Twitter and Google successfully target advertising to a computer user claims. Twitter, Inc. v. B.E. Technology, LLC., IPR2021-00484, Paper 32 (September 7, 2022) (Powell, joined by Quinn and Ahmed) (finding Petitioners Twitter and Google demonstrated by a preponderance of the evidence that all claims under review of the patent at issue, which related to advertising to a computer user via the internet, were obvious, and thus, unpatentable.)

Netflix got chilled on each of its obviousness theories. Netflix, Inc. v. Avago Technologies Int'l Sales PTE. Ltd., IPR2021-00542, Paper 34 (Sept 6, 2022) (Droesch, joined by Begley and Engels) (institution denied because an "executable installation file" in the prior art is distinguishable from "image instances of software applications.")

Repeating the same arguments? No rehearing. New World Medical, Inc. v. MicroSurgical Technology, Inc., IPR2020-01573, Paper 70 (Flax, joined by Tartal and Pollock)(denying request for rehearing where final written decision addressed the same arguments Patent Owner raised in rehearing petition, finding no showing that the Board misapprehended or overlooked any matter in the Final Decision).

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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