

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

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In this installment of the PTAB Highlights, Banner Witcoff examines recent decisions at the PTAB featuring: evidentiary challenges and best practices, the Board's treatment of late filings, the importance of clarity when combining analyses for independent and dependent claims, and more!

Whodunnit doesn't matter. *Medtronic Vascular, Inc. et al. v. TMT Sys., Inc.*, IPR2021-01532, Paper 56 (March 7, 2023) (Hardman, joined by Tartal and Flax) (Patent Owner's request that an exhibit of annotated figures be excluded under FRE 901 was rejected despite its assertion that the "identity of the person who created the annotated figures is unknown." The Board reasoned that the Petitioner's contention that the exhibit represented "an annotated version of Figures 13H–N of the [challenged] patent" was supported by expert testimony, and that the identity of the person who created the annotated figures "is not required to authenticate the document.").

Hearsay is A-Okay. *Canfield Sci., Inc. v. QuantifiCare S.A.*, IPR2021-01511, Paper 61 (March 9, 2023) (Range, joined by McNamara and Hamann) (Patent Owner's motion to exclude expert witness testimony to the extent it relied on statements in a reference that were allegedly hearsay was denied despite the reference being "factually incorrect in some respects," as an expert's reliance on a prior art reference "for what the . . . reference teaches to a person having ordinary skill in the art at the relevant time" is proper. The Board further found that an expert may rely on facts and data that "need not be admissible," including hearsay.).

Let the Board trust and verify. *Halliburton Energy Servs., Inc. v. U.S. Well Servs., LLC*, IPR2021-01538, Paper 31 (February 28, 2023) (Browne, joined by Hoskins and O'Hanlon) (Patent Owner's reliance on press releases, including one of its own, about an alleged license without entering the license into the record prevented the Board from "evaluat[ing] the veracity" of the press releases or "determin[ing] if the [challenged] patent is included in the asserted license" and thus "violate[d] the best evidence rule," leading the Board to find the "evidence of commercial success to be weak evidence of non-obviousness").

Just say the word. *Google LLC v. Jawbone Innovations, LLC*, IPR2022-00604, Paper 17 (March 3, 2023) (Dirba, joined by Braden and Repko) (in denying Petitioner's rehearing request, reiterating the point that Petitioner "failed to clearly state that its analysis of [dependent] claim [11] should be considered in connection with independent claim 1" and

noting that “[w]hen evaluating claim 11, we would have considered claim 1’s analysis, but we disagree with Petitioner’s argument that the reverse should also be true” (footnote and citation omitted)).

A day late and a dollar short. PainTEQ, LLC v. Orthocision, Inc., IPR2022-00335, Paper 27 (March 6, 2023) (Woods, joined by Worth and Valek) (in connection with its Revised Motion to Amend, Patent Owner’s untimely filing of a Reply that incorporated arguments by reference from an unauthorized Appendix and, when combined with the Appendix, exceeded the page limit, justified the Board in taking the “rare” step of granting a request for the “exceptional remedy” of striking the Appendix).

Too late, but not too little. ExtractionTek Sales LLC v. Gene Pool Techs., Inc., IPR2022-01011, Paper 23 (March 7, 2023) (Hardman, joined by Fredman and Wisz) (granting Patent Owner’s Motion to Excuse Late Filing of its Response filed one day after the deadline finding “the prejudice to Petitioner from Patent Owner’s one-day delay is relatively minimal,” whereas “[t]he prejudice to Patent Owner from striking the Patent Owner Response, on the other hand, would be significant,”).

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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