

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

**By Simon Lasker and Craig Kronenthal**

In this installment of the PTAB Highlights, Banner Witcoff examines recent decisions at the PTAB featuring: several Director review decisions, PTAB jurisdiction when a claim is invalidated in district court, procedures for obtaining adverse judgment, and more!

**Swaddling suit patent helps PTO Director put issue of first impression to bed.** *Nested Bean, Inc. v. Big Beings Pty Ltd.*, IPR2020-01234, Paper 42 (February 24, 2023) (Director Vidal) (in a precedential decision on rehearing, Director Vidal explains that the Board must consider each separately incorporated claim limitation in determining patentability of multiple dependent claims and, here, patentability of one of the independent claims incorporated by reference in multiple dependent claims renders those multiple dependent claims patentable as well).

**PTO Director reins in previous Fintiv guidance by requiring Board to consider Fintiv factors before applying compelling merits test.** *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 (February 27, 2023)(Director Vidal) (on sua sponte review, Director Vidal vacated an institution decision where Board failed to consider Fintiv factors 1-5 before finding compelling merits to institute; on remand, the panel must first consider whether Fintiv factors 1-5 favor discretionary denial and, if they do, then perform the compelling merits analysis).

**Save \$\$\$ and time – don't publicly file information that was designated private.** *Patent Quality Assurance, LLC v. VLSI Technology LLC* , IPR2021-01229, Paper 117 (February 23, 2023) (Director Vidal) (ordering VLSI to show cause why it should not be sanctioned for publicly filing information previously designated confidential to the parties and Board, and after the Director denied a request to make the information public).

**Nothing left to cancel.** *Volvo Penta of the Americas, LLC v. Brunswick Corporation* , IPR2022-01424, Paper 12 (February 16, 2023) (Silverman, joined by DeFranco and Szpondowski) (denying IPR institution because the Board lacked jurisdiction to cancel a claim invalidated under section 101 in an earlier district court decision).

**Differing testimony is no way to show definiteness of claim terms.** *Halliburton Energy Services, Inc. v. US Well Services, LLC*, IPR2021-01316, Paper 44 (February 17, 2023) (O'Hanlon, joined by Browne and Hoskins) (denying the Motion to Amend where Patent Owner's own witnesses gave differing meanings to term in the substitute claims (different but overlapping values for "high pressure")).

**You don't need to do that; they already did it.** Early Warning Services, LLC v. Fintech Innovation Associates, LLC, PGR2022-00046, Paper 18 (February 17, 2023) (Kinder, joined by Barrett and Gerstenblith) (denying Petitioner's request for leave to file a motion for adverse judgment where the Patent Owner previously filed a statutory disclaimer resulting in an adverse judgment against it).

---

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.

Banner Witcoff is recognized as one of the best performing and most active law firms representing clients in inter partes review (IPR) proceedings. To learn more about our team of seasoned attorneys and their capabilities and experience in this space, click [here](#).

Banner Witcoff's PTAB Highlights are provided as information of general interest. They are not intended to offer legal advice nor do they create an attorney-client relationship.

**Posted: March 6, 2023**