

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: the reach of a POSITA's knowledge, evidence of industry praise, supporting numerical ranges, and more!

POSITAs are never so regimented that their knowledge can't switch regimes. Becton, Dickinson and Company v. Sage Products, LLC, IPR2021-01201, Paper 41 (Jan. 9, 2023) (Cotta, joined by Tartal and Braden) (finding that a POSITA would have understood the meaning of "sterile" in a paper regarding a medical product from the UK, even though that same product was considered "nonsterile" by the FDA in the USA).

Need to combine two references? Put Sherlock POSITA on the case. Home Depot USA, Inc. v. Lynk Labs, Inc., IPR2021-01370, Paper 46 (Jan. 18, 2023) (Raevsky, joined by Tornquist and Ullagaddi) (finding that a POSITA would have investigated implementation details to combine two pieces of prior art despite this not being express in the cited art).

Participation trophy or industry-wide praise? Halliburton Energy Services, Inc. v. US Well Services, LLC, IPR2021-01037, Paper 41 (Jan. 18, 2023) (Browne, joined by Hoskins and O'Hanlon) (finding that a declaration by the Patent Owner's President and CEO that just listed awards without further explanation was not persuasive evidence of industry-wide praise).

Motion to Amend Denied – Claim's numerical ranges are not supported by a mere disclosure of a high pressure. Halliburton Energy Services, Inc. v. US Well Services, LLC, IPR2021-01066, (Paper 41) (January 24, 2023) (Hoskins, joined by Browne and O'Hanlon) (denying Patent Owner's motion to amend because numerical pressure ranges recited in proposed substitute claims found not supported by disclosure of "high pressure" in the application and constituted new matter).

Que Sera, Sera: PTAB doesn't care about unnamed real party-in-interest who isn't time-barred. Motorola Mobility LLC v. Largan Precision Co., Ltd., IPR2022-01170, (Paper 11) (January 26, 2023) (Khan, joined by Jurgovan and Beamer) (granting institution of inter partes review regardless of whether a party is an unnamed real party-in-interest or not because Patent Owner does not dispute Petitioner's assertion that the party is not time-barred).

I saw it online. Valve Corporation v. Ironburg Inventions Ltd., IPR2017-01928, (Paper 53) (January 26, 2023) (Weatherly, joined by Kauffman and Petravick) (crediting witness

testimony that he reviewed a product review online in finding that product review was a prior art printed publication).

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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