

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: a PO's response to the Board's Order to Show Cause, costly typographical errors, the different effects of actual and likely trial dates of related litigation, and more!

Get out what you put in – PTAB considers request, but not merits, of incomplete Patent Owner's Statement. *NOCO Co. v. Pilot, Inc.*, IPR2021-01235, Paper 14 (Jan. 09, 2023) (Heaney, joined by Abraham and Amundson) (declining to enter adverse judgment based on abandonment or consider Patent Owner's response where Patent Owner responded to an Order to Show Cause by identifying deficiency in Petition, but elected not to file a complete Response).

Lethal Typos and Limitations – the Board may not correct a typographical error that pervades a filing. *CloudFlare, Inc. v. Sable Networks, Inc.*, IPR2021-00909, Paper 46 (Jan. 09, 2023) (White, joined by Droesch and Baer) (refusing to grant rehearing on the basis of an alleged "typographical error" in an unpatentability ground based on combination of references where Petition expressly challenged claims over a single reference even though the Board raised the possibility that the reference's omission was a "typographical error").

Set in stone – Fintiv Factors Requires Set Trial Date. *Beckman Coulter, Inc. v. Sirigen II Ltd.*, IPR2022-01203, Paper 12 (Jan. 06, 2023) (Crumbley, joined by Tornquist and Range) (clarifying that the facts and reasoning of *Apple Inc. v. Fintiv* used to determine whether discretionary denial under 35 U.S.C. § 314(a) is warranted "are, at a minimum, only applicable to cases in which the district court has actually set a trial date in a copending litigation.").

Stats 101 – statistical evidence of likely trial date weighed in Fintiv analysis. *Apple Inc. v. Aire Tech. Ltd.*, IPR2022-01135, Paper 11 (Jan. 04, 2023) (Smith, joined by McNamara and Quinn) (Board considered Petitioner's statistical evidence of likely trial date, which was later than the set trial date, in Fintiv analysis).

Getting motivated is like starting the engine of your car. *Meridian Wildlife Services, LLC v. Safe Haven Wildlife Removal and Property Management Exerts LLC*, IPR2022-01254, Paper 11 (January 10, 2023) (Shah, joined by Powell and Woods) (denying institution where Petitioner showed that having multiple devices would have been obvious to a skilled artisan, but Petitioner failed to show a sufficient reason to combine or modify the asserted references).

PTAB looking at Copyright? Unified Patents, LLC f/k/a Unified Patents Inc. v. 2BCom, LLC , IPR2020-00996, Paper 65 (January 10, 2023) (Fenick, joined by Wormmeester and Hudalla) (copyright registration of a printed publication can indicate public accessibility of the publication).

Don't point at the Examiner. Guardant Health, Inc. v. University of Washington , IPR2022-01158, Paper 19 (January 13, 2023) (Yang, joined by New and Hulse) (rejecting Patent Owner's § 325(d) argument that the Examiner in related applications addressed the issue of written-description support for the limitations in the challenged patent that Petitioner alleged was not entitled to a priority date predating the alleged anticipatory reference).

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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