

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

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So, what's new at the PTAB? The Director vacating institution decision for improper § 325(d) analysis, re-using references applied to canceled claims, expert testimony parroting Petitioner's arguments, and more!

Back to the patent drawing board: when similar isn't quite the same! Nokia of America Corp. v. Alexander Soto et al., IPR2023-00680, IPR2023-00681, IPR2023-00682, Paper 18 (March 28, 2024) (Vidal) (the Director vacating a decision denying institution because the PTAB erred in focusing on the similarity of the claim limitation mapping without addressing whether the arguments raised in the Petition were substantially similar to the specific arguments previously presented to the Office).

Order up: institution with previous prior art on toast. Toast, Inc. v. Gratuity, LLC, IPR2023-01408, Paper 11 (March 27, 2024) (Murphy, joined by Petravick and Melvin) (granting institution because, although the asserted prior art references were previously presented to the Office, the asserted prior art references related to the Examiner's rejections against claims that were subsequently canceled and not included in the issued patent).

No cracker for ZimVie: parroted expert testimony given limited weight. ZimVie, Inc. v. Roger P. Jackson, IPR2023-01432, Paper 8 (April 1, 2024) (Yang, joined by Jenks and Snedden) (denying institution because the expert's testimony was insufficient to support Petitioner's argument as the testimony merely repeated, nearly verbatim, Petitioner's arguments without any explanation or other evidentiary support).

The story ends when the entire "Matrix" is not occupied. Samsung Elecs. Co. v. Slyde Analytics, IPR2024-00002, Paper 13 (April 5, 2024) (Lee, joined by Courtenay and with Horvath dissenting) (denying institution and finding Petitioner's prior art failed to show scrolling widgets occupying the whole "digital matrix" of a wristwatch display as required by the claims with dissent disagreeing that the claims require the whole matrix).

Check the schedule. NetSkope, Inc. v. Fortinet, Inc., IPR2023-00030, Paper 37 (April 8, 2024) (Calve, joined by Gianetti and Ogden) (rejecting Patent Owner's arguments that the prior art's dynamic scheduling to validate firewall policies at a specific time would delay implementation and finding validating firewall policies at off-peak hours was an efficient, obvious implementation to avoid disruptions in determining challenged claims unpatentable).

Not detailed enough. *Alivacor, Inc. v. Apple Inc.*, IPR2023-01434, Paper 8 (April 3, 2024) (Barrett, joined by Cocks and Daniels) (denying institution and finding prior art reference did not display a single “detailed view” of an interface with both a graph representation of data and a selectable data sharing option).

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