

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: Director review regarding interference estoppel, untimely supplemental evidence, subsidiary's merger causing IPR to be time-barred, and more!

The call stands: Director confirms interference that didn't consider prior art doesn't bar IPR. *Zynga Inc. v. IGT*, IPR2022-00199, Paper 17 (Aug. 22, 2022) (Vidal) (on sua sponte review, affirming Board's decision that interference proceeding terminated based on written description issues and that didn't consider patentability in view of prior art doesn't trigger interference estoppel to bar IPR).

Rebuttals and elaborations are not new evidence. *TCT Mobile (US) Inc. et al v. Fundamental Innovation Systems International LLC.*, IPR2021-00599, Paper 34 (PTAB Aug. 23, 2022) (Peslak, joined by Kokoski and Tornquist) (finding Petitioner's argument properly within the scope of a Reply because it elaborates on the contentions in the Petition and directly responds to Patent Owner's argument).

Timing is everything for supplemental evidence. *NXP USA, Inc. f/k/a NXP Semiconductors USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 20 (PTAB Aug. 25, 2022) (Barrett, joined by Weinschenk and Trock) (denying Petitioner's untimely request to supplement the record with documents that predated the decision denying institution).

PTAB won't exercise discretion to deny institution where timing of parallel proceeding is speculative. *Evolution Well Services, LLC v. BJ Energy Solutions, LLC f/k/a TES Asset Acquisition, LLC.*, IPR2022-00399, Paper 10 (PTAB Aug. 24, 2022) (O'Hanlon, joined by Scanlon and Melvin) (granting institution and refusing to discretionarily deny institution based on a parallel proceeding that had not yet entered a scheduling order).

Strange bedfellows: subsidiary's merger with fellow accused infringer sinks IPR. *Commscope, Inc. v. TQ Delta, LLC*, IPR2022-00352, Paper 13 (Aug. 19, 2022) (Chang, joined by Chagnon and Weinschenk) (finding IPR petition time-barred under 35 U.S.C. § 315(b) where, prior to filing, Petitioner's subsidiary merged with entity that had been sued under the challenged patent over one year before Petition was filed).

Six degrees of "readily moveable": terms of degree need objective baseline to be definite. *Halliburton Energy Servs. v. U.S. Well Servs., LLC*, IPR2021-01238, Paper 31 (Aug. 22, 2022) (O'Hanlon, joined by Browne and Hoskins) (offering preliminary guidance that

“readily moveable” is likely indefinite where the specification, despite including an example, did not provide an “objective baseline” to differentiate a “readily moveable” transmission line from a “moveable” one).

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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