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

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So, what's new at the PTAB? Amending a declaratory judgment complaint after filing a petition to circumvent the 315(a)(1) bar, motion to strike vs. motion to exclude, how the Petitioner-customer relationship impacts multiple petitions, and more!

With careful timing, petitioners can have their cake and eat it too: adding invalidity count to DJ complaint after filing petition does not relate-back to original complaint filing date under § 315(a)(1). Google, LLC f/k/a Google Inc. v. Sonos, Inc., IPR2021-01563 (April 12, 2022) (Zecher, joined by McMillin and Baer) (denying Patent Owner's motion to dismiss under § 315(a)(1) after Petitioner amended a declaratory judgment action that was filed before the petition to include an invalidity challenge of the patent-at-issue in the petition).

Archived copies of webpages are admissible. Analog Devices, Inc. v. Xilinx, Inc. et al., IPR2020-01596 (April 13, 2022) (Horvath, joined by Galligan and Cass) (denying Patent Owner's motion to exclude archived webpages based on the inherent reliability of the Wayback Machine and corroborating evidence showing the archived webpages to be a regularly conducted business activity).

That motion to exclude could be construed as a motion to strike. Laboratoire Francais du Fractionnement et des Biotechnologies SA v. Novo Nordisk Healthcare AG, IPR2017-00028 (April 13, 2022) (Franklin, joined by Mitchell and Paulraj) (granting, in-part, Patent Owner's motion to exclude evidence after finding that a motion to exclude is not the appropriate vehicle for considering whether a party has improperly raised new arguments and construing the request as a motion to strike).

Parallel proceedings can derail an IPR. NXP USA, Inc. f/k/a NXP Semiconductors USA, Inc. v. Impinj, Inc., IPR2021-01556 (April 21, 2022) (Trock, joined by Barrett and Weinschenk) (denying institution where the related district court trial was scheduled to begin two months before the Board's deadline to reach a final decision and because "the Petition challenges all of the '198 patent claims asserted in the parallel proceeding, and also asserts the same prior art combinations in both proceedings").

Update your relationship status. Streck Laboratories, Inc. v. Ravgen, Inc., IPR2021-01577 (April 22, 2022) (Majors, joined by Yang and Cotta) (granting institution even though earlier Petitions involving the same patent were filed by Petitioner's customers because the Board determined that Petitioner's relationship with its customers did not rise to the level of "significant relationship" contemplated in an earlier decision in Valve Corp. v. Elec. Scripting Prods., Inc., IPR2019-00062 (April 2, 2019)).

Fun fact: your expert won't survive without them! Unified Patents, LLC v. Smart Path Connections, LLC, IPR2021-01551 (April 25, 2022) (McKone, joined by Engels and Amundson) (denying institution where Petitioner's expert provided conclusory testimony that lacked factual bases and "suffer[ed] from hindsight bias")

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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