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

By Scott Burow and Biswash Adhikari

So, what's happening at the PTAB? Attorney Scott Burow and summer associate Biswash Adhikari summarize recent decisions, including: Discretionary denial for unfair dealings, simultaneous proceedings, granted Director Review, and more!

Unfair Dealings Can Lead to Petition Denial. Tessell, Inc. v. Nutanix, Inc., IPR2025-00322 (Paper 14) (June 12, 2025) (Coke Morgan Stewart, Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the USPTO) (discretionarily denying institution finding patent owner's equity arguments persuasive and stating that although assignor estoppel does not apply in inter partes reviews she can consider "unfair dealings" by the inventors who now advocate unpatentability when deciding whether to deny the petition).

Simultaneous Ex Parte **and** Inter Partes **Reviews are OK.** ResMed Corp. v. Cleveland Medical Devices, Inc., IPR2025-00160, (Paper 11) (June 13, 2025) (Sneden, joined by Powell and Hardman) (granting IPR institution and stating there is nothing inappropriate about parallel ex parte and inter partes challenges from the same petitioner nor is there anything wrong with serial challenges).

Don't Give Up – Director Review Remands Final Written Decision. Mastercard, Inc. v. OV Loop, Inc., IPR2023-01289, (Paper 41) (June 10, 2025) (Coke Morgan Stewart, Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the USPTO) (granting director review of the final written decision and remanding to the Board with directions to further consider patent owner's arguments).

Structural talk is not enough. Show us the goods. Merck Sharp & Dohme LLC v. Halozyme, Inc. PGR2025-00004, Paper 26 (June 11, 2025) (Fredman, joined by Mitchell and Hardman) (instituting PGR on written-description and enablement grounds where Halozyme's 'modified PH20 polypeptide' genus was defined only by vague structural recitations and no roadmap to make or test the full scope).

Format trick, but the board sticks to substance. Abbott Labs v. Miracor Medical, IPR2025-00115, Paper 13 (June 11, 2025) (Reimers, joined by Tartal and Hamann) (acknowledging Abbott's word-count gymnastics like jamming citations together, avoiding necessary spaces, and leaning heavily on a 630-page expert declaration instead of plain-spoken claim charts, as "not warranted," yet instituting review because the petition prevailed on at least one claim under §103).

As a leader in post-issuance proceedings, Banner Witcoff is committed to staying on top of the latest PTAB developments. Our PTAB Highlights series is designed to keep you up-to-date and informed of rulings affecting this constantly evolving area of the law.

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