

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: the impact of district court patent ineligibility findings on IPRs, showing nexus for secondary considerations, using applicant's admitted prior art, and more!

No termination of IPR proceeding even though patent is invalid under § 101. *Tile, Inc. v. Linquet Technologies, Inc.*, IPR2021-00927, (Paper 52) (November 16, 2022) (Belisle, joined by White and Amundson) (denying motion to dismiss IPR proceeding as moot, despite patent being found invalid under 35 U.S.C. § 101 in parallel district court proceeding).

No presumption of nexus? Better tie evidence to the claim limitations. *TCL Industries Holdings Co., Ltd. et al v. ParkerVision, Inc.*, IPR2021-00985, Paper 44 (November 17, 2022) (Gerstenblith, joined by Zecher and Ahmed) (determining all challenged claims unpatentable, and criticizing Patent Owner for not making any attempt to establish a nexus between the evidence of secondary considerations and the specific challenged claim elements based on co-extensiveness).

Be careful what you admit during prosecution because applicant admitted prior art may be used against you in a future IPR. *Apple Inc. v. Qualcomm Incorporated*, IPR 2018-01315, Paper 40 (November 10, 2022) (Howard, joined by Galligan and Jefferson) (finding claims of a patent directed to multiple supply-voltage power-up detectors unpatentable under 35 U.S.C. § 103 and concluding that Petitioner's partial use of applicant admitted prior art during prosecution was appropriate. The Board applied the USPTO Director's Updated Guidance on the treatment of statements of the applicant in the challenged patent in IPR under §311. In doing so, the Board found that the Petitioner's reliance on the cited prior art patents—forming the basis of its unpatentability ground—combined with applicant admitted prior art to fill in the missing limitations was an appropriate and successful unpatentability argument.)

Mixing and matching won't cut it. *WhiteWater West Industries, Ltd. v. American Wave Machines, Inc.*, IPR2022-01035, Paper 8 (November 17, 2022) (Wood, joined by DeFranco and Finamore) (denying institution, and finding problematic Petitioner's mixing and matching of distinct and different prior art embodiments to achieve the challenged claim limitations)

Petitioner's should not overlook the preamble – it may be limiting even if the claims are otherwise broad. *Celltrion, Inc. v. Regeneron Pharmaceuticals, Inc.*, IPR2022-00258,

Paper 94 (November 9, 2022) (Franklin, joined by New and Mitchell) (determining a preamble to be limiting based on a specification that repeatedly characterized the invention as a method for treating angiogenic eye disorders, but ultimately finding the patent invalid under 35 U.S.C. § 102 after concluding the art nevertheless disclosed the preamble features as construed).

Prior art listed on the face of the patent may not be enough to persuade the Board to deny institution under 35 U.S.C. § 325(d). Lightspeed Commerce Inc. v. CloudofChange, LLC, IPR2022-01143, Paper 8 (November 10, 2022) (Plenzler, joined by Lorin and DeFranco) (granting institution of IPR and rejecting Patent Owner’s argument for denial under 35 U.S.C. § 325(d) where the same prior art was raised during prosecution of the challenged patent. The prior art at issue included a first reference not applied in any claim rejection, and a second reference applied in a claim rejection but not to a feature disputed by the Patent Owner.)

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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