

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: ghost-writing in expert declarations, conspiratorial allegations of circumventing the one-year time bar, abuse of the IPR process, and more!

Adduce, Reuse, Recycle. PTAB ain't afraid of no ghost-writers. The Noco Company, Inc. v. Pilot, Inc., IPR2021-00777, Paper 22 (October 3, 2022) (Abraham, joined by Heaney and Amundson) (Finding that Expert A's re-use of material that they ghostwrote while employed under Expert B in a prior proceeding was acceptable where Expert A confirmed suitability for the current proceeding and supplemented the re-used material with language and citations directed to the facts and exhibits of the current proceeding.)

PTAB sees the forest through the trees when it comes to 103 arguments. Ringcentral, Inc., v. Estech Systems Ip, Llc, IPR2021-00574, Paper 30 (October 3, 2022) (Giannetti, joined by Boudreau and Jurgovan) (Finding that a non-obviousness argument based on an omission of a claim limitation from a single figure in a single prior art reference failed to consider the teachings of that reference as a whole and what the combined teachings of all references would have suggested to the POSITA.)

Everyone loves a conspiracy theory . . . except for the PTAB. Nokia of America Corporation v. TQ Delta, LLC, IPR2022-00665, Paper 10 (October 3, 2022) (Weinschenk, joined by Chang and Pettigrew) (Dismissing conspiratorial allegations that the Petitioner filed at the behest of a 35 USC 315(b) time-barred real party in interest. Although the Patent Owner had not filed a complaint against Petitioner about the patent at issue, they had given the Petitioner many reasons to file by sending claim charts alleging infringement, demanded licensing, and suing Petitioner regarding similar patents.)

Priority documents must contain sufficient written description. Dell Technologies Inc. et al v. VideoLabs, Inc., IPR2022-00629, Paper 10 (October 4, 2022) (Smith, joined by Easthom and Boucher) (denying institution of IPR of a patent where the Board determined that the Japanese application that it claimed priority to provided sufficient written description to place the priority date of the patent earlier than the asserted prior art.)

The Petitioner must explain their petition. ADT LLC v. Vivint, Inc., IPR2022-00634, Paper 7 (October 4, 2022) (Zechner, joined by Lee and Ahmed) (denying institution of IPR where the Petitioner relied on a combination of prior art references but mapped those references

independently to the challenged claims and expected the Board to “scour the prior art references and piece together an obviousness ground” based on the references.)

Petitions filed by non-practicing entities that abuse process will be questioned.

OpenSky Industries, LLC v. VLSI Technology LLC , IPR2021-01064, Paper 102 (October 4, 2022) (Vidal) (Sua sponte instituting Director Review of institution of an IPR filed by a non-practicing entity, determining that the Petitioner “abused the IPR process by filing this IPR in an attempt to extract payment from [the Patent Owner] and [a] joined Petitioner . . . , and expressed a willingness to abuse the process in order to extract the payment” and finding that the Petitioner “engaged in abuse of process and unethical conduct by offering to undermine and/or not vigorously pursue this matter in exchange for a monetary payment.”)

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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