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

By Scott Burow and Christian Wolfgram

So, what's new at the PTAB? Failure to separately address a disputed claim term, the on-sale bar, submitting evidence with a sur-reply, and more!

Side-stepping is not a good move before the Board. Samsung Electronics Co., Ltd. v. Blaze Mobile, Inc., IPR2021-01569, (Paper 16) (March 22, 2022) (Engels, joined by Jung and O'Hanlon) (denying institution, and faulting Petitioner for relying on an implicit interpretation of a claim term rather than directly addressing the meaning of it and for further failing to address the term separate from other terms).

Wrong place, wrong time. Askeladden LLC v. AuthWallet LLC, IPR2021-00005, (Paper 23) (March 23, 2022) (Browne, joined by Cherry and Peslak) (determining that all challenged claims are unpatentable, and rejecting Patent Owner's attempt to read into the claim a simultaneous time and place transaction requirement).

On-sale? Nope. Failure of launch date. Ideavillage Products Corp. v. Koninklijke Philips NV f/k/a Koninklijke Philips Electronics NV, PGR2021-00116, (Paper 6) (March 24, 2022) (Barrett, joined by Obermann and Paulraj) (denying PGR institution under the on-sale bar, and criticizing Petitioner for (a) ambiguous evidence of a supposed product introduction and launch date and (b) failure to show the purported on-sale product embodies the claimed design).

Not unless you have a subpoena. CQV Co., Ltd. v. Merck Patent GmbH, PGR2021-00054 (March 2, 2022) (Franklin, joined by Kokoski and Tornquist) (denying Petitioner's motion for additional discovery—which sought documents from a real party-in-interest who was not a named

party in the case—because there was no precedent for treating a real party-in-interest as a party, and a subpoena was not requested or warranted).

Broad scope and diligence in filing Petition favors moving forward with an IPR despite multiple parallel litigations. STMicroelectronics, Inc. v. Ocean Semiconductor LLC, IPR2021-01349 (March 4, 2022) (Kalan, joined by Kaiser and Cotta) (instituting inter partes review and declining to exercise discretion under 35 U.S.C. § 314(a) despite 10 parallel district court litigations—including one involving the same parties as the IPR—in part because the Petition covered a broader scope of claims than the district court cases and the Petition was filed four months before the statutory bar date).

Patent Owner only gets one chance to submit evidence against a Petition. Liquidia Technologies, Inc. v. United Therapeutics Corporation, IPR2021-00406 (March 3, 2022) (Kaiser, joined by Franklin and Cotta) (denying Patent Owner's motion to submit evidence with its sur-reply because, under 37 C.F.R. § 42.23(b), the sur-reply may not include new evidence (other than cross-examination transcripts of any reply witness), additional evidence might cause resolution of the IPR to exceed the one-year threshold, and Patent Owner could not show why an exception to the rules was necessary).

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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