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 duty of candor, timeliness of IPR petitions, discretionary denials and more!

A day late and a duty violated. Google LLC v. Parus Holdings, Inc., IPR2022-00805, Paper 26 (Sep. 5, 2023) (Boucher, joined by McKone and Mayberry) (ordering Patent Owner's counsel to show cause why they did not violate duty of candor provisions by stating that the patent at issue was entitled to claim priority to a provisional patent application where application was filed one day after the provisional application expired, breaking the priority chain).

The full package. Lightricks Ltd. v. Plotagraph, Inc., IPR2023-00153, Paper 9 (Sep. 5, 2023) (Ahmed, joined by Scanlon and Boudreau) (finding petition timely filed within a year of Petitioner filing a waiver of service and that the Patent Owner's service of a complaint without the exhibits was improper service and did not trigger § 315(b) time bar).

Contentions ain't all that. Ericsson, Inc. v. Koninklijke KPN NV, IPR2023-00581, Paper 8 (Sep. 7, 2023) (Weinschenk, joined by Turner and Beamer) (finding service of invalidity and infringement contentions a minimal investment as to issues of unpatentability thateighed against discretionary denial of institution).

Keep it logical. Apple, Inc. v. Logantree, LP, IPR2022-00037, Paper 29 (Aug 30, 2023) (Scanlon, joined by Weatherly and Worth) (finding claims not shown unpatentable where Petitioner's combination resulted in an illogical order of steps).

Don't Forget You Need A Reason. Snap, Inc. v. You Map, Inc., IPR2022-00568, Paper 37 (Aug. 31, 2023) (Repko, joined by Deshpande and Boucher) (finding Petitioner had not shown substitute

claims were obvious because Petitioner's arguments lacked a reason to modify the primary reference to include a feature, despite several secondary refences showing the identified feature).

Think you're extraordinary? Better back it up. Lifescan, Inc. v. Facet Technologies, LLC, IPR2023-00713, Paper 13 (Sep. 1, 2023) (Tartal, joined by Jenks and Cotta) (denying institution of the second of two petitions challenging overlapping and nonoverlapping claims because mere assertion that "different primary references and different obvious combinations" were required is insufficient to show an extraordinary situation where a second petition is warranted).

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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