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

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So, what's new at the PTAB? Reliance on IEEE documents, relationships in district court vs. relationships at the PTAB, showing error during prosecution history, and more!

Tradeshow and professional conference papers may be prior art. Intel Corporation v. FG SRC LLC, IPR2020-01449 (March 1, 2022) (Szpondowski, joined by Deshpande and Anderson) (rejecting Patent Owner's arguments that documents from The Institute of Electrical and Electronics Engineers, Inc. (IEEE) were not publicly accessible and did not qualify as printed publications because Petitioner provided evidence that the IEEE documents were distributed to conference attendees and were catalogued by several university libraries thus qualifying as prior art references).

A picture is worth a thousand words. PNC Bank, NA v. United Services Automobile Association, IPR2021-01381 (March 2, 2022) (Dirba, joined by Droesch and McMillin) (rejecting Petitioner's argument that a claim directed to a system for the remote depositing of a check using a mobile device with a camera was not supported by the priority application and noting that "[A] claim can be broader than the embodiments disclosed") (emphasis added)).

District court litigation may not establish a relationship between common defendants under the General Plastic **factors for discretionary denial.** Facebook, Inc. v. Express Mobile, Inc., IPR2021-01456 (March 3, 2022) (Hagy, joined by Smith and Moore) (granting institution of IPR and rejecting Patent Owner's argument that institution should be denied because Petitioner and Google developed a significant relationship in the related district court litigation by working together under the veil of common interest privilege to coordinate their positions with respect to the patent at issue

—the PTAB noted that the Patent Owner failed to provide evidence of such a relationship that would implicate General Plastic).

It's not **just a matter of opinion: Petitioner cannot obtain review by providing an expert declaration that merely comes to the opposite conclusion of the Patent Owner's own expert; the Petitioner's expert must also show that the Patent Owner's expert somehow erred.** Apotex Inc. et al v. Auspex Pharmaceuticals, Inc., IPR2021-1507 (March 9, 2022) (Obermann, joined by New and Paulraj) (denying review because, even though the Petitioner's expert opined that combining prior art references would not yield unexpected results, he nevertheless failed to explain how the Patent Owner's own expert declarations—which the Patent Owner offered during the original prosecution of the patent at issue; which reached the opposite conclusion on unexpected results; and which the patent examiner had relied on in issuing the patent—were unreliable).

You've got some Gullwing, Petitioner, asking for rehearing without telling us what we did wrong. Mercedes-Benz USA, LLC et al v. Stragent, LLC, IPR2021-00425 (March 11, 2022) (Repko, joined by White and Galligan) (denying the Petitioner's request for rehearing because the Petitioner only presented arguments disagreeing with previous decision and failed to identify what the Board had previously misapprehended or overlooked).

Petitioner Beware: You must explain how teachings from different embodiments of a single reference would have been combined. Lumenis Be Ltd. et al v. BTL Healthcare Technologies AS, (March 9, 2022) (IPR2021-1280) (per curiam) (denying a Petition for failing to explain how one skilled in the art would have combined teachings from multiple embodiments of the same reference).

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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