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

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So, what's happening at the PTAB? Allowing discovery on privity, denial when patent is dismissed from litigation, incorporation by reference, and more!

A question for the Board to discover: privity? Cirrus Logic, Inc. et al v. Greenthread LLC, IPR 2024-00001 and 2024-00016, Paper 89 (July 23, 2025) (Stewart, Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office) (vacating Board decision that denied discovery on privity issues and shifted the burden of proving privity to Patent Owners, allowing "narrowly tailored" discovery by the Board into the privity issue consistent with a similar set of IPRs).

If patent is dropped from the litigation, your IPR might be dropped too. SAP America, Inc. v. Valtrus Innovations Ltd., IPR2025-00417, Paper 9 (July 10, 2025) (Stewart, Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office) (discretionarily denying institution because, in part, the patent was dismissed from the litigation and therefore IPR would be an inefficient use of Board resources).

All aboard…other APJs are on board with denying institution based on settled expectations. Google LLC v. VirtaMove, Corp., IPR2025-00487, Paper 11 (July 11, 2025) (Deshpande, Acting Deputy Chief Administrative Patent Judge) (even though Acting Director Stewart was recused, the APJ stepping in for her discretionarily denied institution because of settled expectations even where there was no trial date set).

Incorporation by reference in its entirety saves the day. Cisco Systems, Inc. v. UMBRA Technologies Ltd., IPR2024-00344, Paper 31 (July 11, 2025) (Courtenay, joined by Zecher and

Anderson) (finding, in a final written decision holding all claims unpatentable, that Petitioner properly relied on subject matter of the primary reference that was in a provisional application that was incorporated by reference in its entirety even though the primary reference omitted some of the subject matter).

All it takes is a librarian to establish a decades-old prior art. Dish Network LLC v. Entropic Communications, LLC, IPR 2024-00393, Paper 42 (July 22, 2025) (Jurgovan, joined by Howard and Moore) (finding an article published in 1994 technical convention as prior art available to the public when Petitioner presented a librarian's declaration that they retrieved a Machine-Readable Catalog (MARC) indicating the library acquired and made public the article in 1995).

Not so fast – trial date is of the essence! Samsung Electronics Co. Ltd. v. Headwater Research LLC, IPR 2024-01396 and 2024-01407, Paper 21 (July 22, 2025) (Stewart, Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office) (vacating Board decision to institute IPR when the trial date in the parallel proceeding was six months before the final written decision, noting that the Board did not give sufficient weight to factor 2 and despite the merits of the Petition).

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