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

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In this installment of the PTAB Highlights, Banner Witcoff attorneys examine recent decisions at the PTAB featuring: the Board striking evidence due to Petitioner production delays, the importance of known state of the art for single reference obviousness, the Board refusing to substitute a replacement Petitioner, and more!

Fail to produce timely and translate documents and the Board will strike! Samsung Electronics America, Inc. v. Kannuu Pty, Ltd., IPR2020-00738, Paper 100 (PTAB Jul. 22, 2022) (Chung, joined by Droesch and Kaiser) (finding Petitioner's delay in production prejudicial and striking exhibits and associated testimony where exhibits were produced solely in foreign language a day prior to party's corporate witness deposition).

Single Reference Obviousness Challenge? Explain motivation. AutoStore Sys. Inc. v. Ocado Innovation Limited, IPR2022-00443, Paper 7 (PTAB Jul. 20, 2022) (Marschall, joined by Melvin and Flax) (denying institution where reference did not expressly disclose all claim limitations and Petitioner did not explain a POSA's motivation for modifications).

Are you really an understudy Petitioner if you are the only Petitioner? Major Data UAB v. Bright Data Ltd. f/k/a Luminati Networks Ltd., IPR2022-00915, Paper 14 (July 29, 2022) (Cass, joined by Giannetti and McShane) (denying Petitioner's motion for joinder to another IPR when, due to settlement, no Petitioner currently exists in the IPR).

Non-obviousness evidence should concern the challenged patent. Weatherford US, LP v. Eventure Global Tech., Inc., IPR2021-00107, Paper 39 (PTAB Jul. 21, 2022) (Jung, joined by Petravick and Powell) (finding Patent Owner's licensing evidence, on its own, does not show

objective evidence of non-obviousness where only familial patents, and not the challenged patent, were part of the licensing agreements).

PTAB can rely on prior art not cited in the institution decision to show state of art. Slayback Pharma LLC v. Sumitomo Dainippon Pharma Co., Ltd., IPR2020-01053, Paper 35 (July 26, 2022) (Yang, joined by Mitchell and Wisz) (denying Patent Owner's request for rehearing noting that the Board did not rely on a secondary reference to show obviousness (improper new ground of unpatentability) but rather to show the known state of the art at the time of the invention).

Explain how amended claim language does not broaden claim. Facebook, Inc. v. Palo Alto Research Center Inc., IPR2021-01294, Paper 28 (July 28, 2022) (McShane, joined by Easthom and Ogden) (preliminary guidance indicating potential denial of Patent Owner's motion to amend to add new claims under 35 U.S.C. § 316(d)(3), because Patent Owner's amended claims substituted language in the original claims without explaining whether the substituted language is narrower or equivalent to the removed language).

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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