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: sua sponte Director review to revive IPRs, institution of multiple petitions based on priority dispute, fixing service defects and more!

Nothing Spontaneous About Reviving Five IPRs. Volvo Penta of the Americas, LLC v. Brunswick Corporation, IPR2022-01366, Paper 15 (May 2, 2023) (Vidal, Under Secretary of Commerce for Intellectual Property and Director of the USPTO) (initiating sua sponte review to vacate five PTAB decisions denying institution because PTAB erred in (1) its § 311(b) analysis which used collateral estoppel principles to find that district court's invalidity determination was final despite pending appeal and (2) failing to apply Fintiv analysis despite the pending appeal).

Priority disputes can multiply the proceedings. BJ's Wholesale Club Holdings Inc v. Walmart Apollo LLC, IPR2022-01564, Paper 9 (April 11, 2023) (Scanlon, joined by Powell and Weatherly) (granting institution on multiple petitions challenging the same patent, because a dispute about priority dates of the challenged claims requires arguments under multiple prior art references).

Joinder no workaround for one-year time bar. Commscope Inc v. TQ Delta LLC, IPR2023-00064, Paper 14 (April 25, 2023) (Weinschenk, joined by Pettigrew and Trock) (denying institution and joinder where the prior IPR had been terminated, and there are no pending proceedings in the prior IPR for Petitioner to join and, thereby, avoid one-year time bar).

Statutory compliance with filing deadline met with regulatory fix for service defects. Dynaenergetics GMBH v. QinetiQ Limited, PGR2023-00003, Paper 8 (April 13, 2023) (Capp, opinion concurring filed by Saindon and Opinion Dissenting filed by DeFranco) (denying motion to

dismiss petition filed on the last day in the 9-month statutory period, because failure to serve Patent Owner's counsel at correct law firm address was mere regulatory defect that can be cured as a matter of course and does not depend on exercise of discretion by the Board).

Last word on newly raised arguments won't be stricken. Streck, Inc. et al v. Ravgen, Inc., IPR2021-01577, Paper 62 (April 18, 2023) (Majors, joined by Cotta and Yang) (Denying motion to strike portions of sur-reply as new arguments because they respond to arguments raised for the first time in reply).

Priority challenge saves Petition. Bluebird Bio, Inc. v. Sloan Kettering Institute for Cancer Research, IPR2023-00070, Paper 8 (April 24, 2023) (Franklin, joined by Snedden and Worth) (Instituting IPR where Petitioner persuasively argued that provisional applications did not satisfy 35 U.S.C. § 112 written description requirements for challenged claims, and thus, Examiner likely misapprehended the proper priority date for those claims).

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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Posted: May 15, 2023