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

By Kirk Sigmon and Pei Wu

Contingent motions to amend, secondary considerations and written descriptions are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

Contingent Motions to Amend. Amendments contingent on unpatentability of certain claims were granted given the reasonable number of substitute claims, support in the original disclosure, response to a ground of unpatentability involved at trial, and sufficient scope. Polygroup Limited MCO v. Willis Electric Co., Ltd., IPR2016-01610, Paper 211 at 26-37 (Oct. 8, 2020) (Plenzler, joined by Saindon and Parvis).

Obviousness. When a specific problem is disclosed in one prior art reference and a specific solution to this problem is disclosed in another prior art reference, there is sufficient reason for one of ordinary skill in the art to combine the identified disclosures in an obviousness analysis. BMW of North America, LLC, et al. v. Carrum Technologies, LLC et al., IPR2019-00903, Paper 24 (Oct. 9, 2020) (Tornquist, joined by Browne and Scanlon).

Written Description. Patent Owner's motion to amend was denied by the PTAB because the proposed amendment introduced new matter. Specifically, the proposed substitute claims include a specific "percentage + range" limitation that was not described or indicated in the originally filed application or its priority document in a manner that would "allow one skilled in the art to immediately discern" the "percentage + range" limitation. Red Diamond, Inc. v. Southern Visions, LLP, Paper 38 (Oct.13, 2020) (Kennedy, joined by Crumbley and Abraham).

Secondary Considerations. Secondary considerations of non-obviousness were considered, but the PTAB found that they were insufficient to demonstrate the non-obviousness of the claims. FMC

Technologies, Inc. et al. v. OneSubsea IP UK Limited, IPR2019-00935, Paper 45 (Oct. 14, 2020) (Tartal, joined by Droesch and Cherry).

Motions to Exclude Expert Testimony. Patent Owner could not use the Federal Rules of Evidence's Rule 106 to request inclusion of, and argue against, portions of Petitioner's expert testimony, particularly where those portions were already in the record. Argentum Pharm. LLC v. Novartis AG, IPR2017-01078, Paper 12 at 27-29 (Oct. 5, 2020) (Crumbley, joined by Pollock and Sawert).

IPRs Filed by Different Petitioner. Discretionary denial not warranted where an earlier-filed petition challenged different claims and was filed by a different party (albeit an industry organization of which one of the later-filing petitioners was a member), and also where the PTAB could consider both petitions effectively simultaneously. LG Electronics Inc. v. Jenam Tech, LLC, IPR2020-00845, Paper 16 at 4-12 (Oct. 8, 2020) (Galligan, joined by Howard and Repko).

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.

Banner Witcoff is recognized as one of the best performing and most active law firms representing clients in inter partes review (IPR) proceedings. To learn more about our team of seasoned attorneys and their capabilities and experience in this space, click here.

Banner Witcoff's PTAB Highlights are provided as information of general interest. They are not intended to offer legal advice nor do they create an attorney-client relationship.

Posted: October 22, 2020