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

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IPR claim constructions, establishing printed publications as prior art, and numerous real parties-in-interest are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

Institution Denied Based on Claim Construction. The PTAB denied institution of IPR because Petitioner advanced an incorrect claim construction where, without explanation, the Petitioner renamed the plain words of a claim (construed "bottom perimeter portion" as "protrusion"). Fellowes, Inc. v. Treefrog Developments, Inc., IPR2020-00869, Paper 16 (Oct. 29, 2020) (Obermann, joined by Braden and Trock).

Printed Publication Established as Prior Art. The Board found that a specification developed by the Foundation for Intelligent Physical Agents (FIPA) qualified as a prior art printed publication under § 102(a) (pre-AIA). FIPA was a Swiss non-profit association created to promote agent-based technology and develop open standards. FIPA began developing its FIPA97 specification in 1996 and posted drafts of the specification to the homepage of FIPA's website throughout 1997, with an "initial" version posted on Oct. 10, 1997. Anyone could access the FIPA97 specification without a password. Shortly thereafter, other publications reported FIPA's approval of the FIPA97 specification and directed readers to FIPA's website for the text of the specification. The Board found that the FIPA97 specification was publicly accessible and disseminated to the relevant public who could locate the specification exercising reasonable diligence. Thus, the FIPA97 specification qualified as a printed publication under § 102(a). Microsoft Corporation v. IPA Technologies Inc., IPR2019-00837, Paper 42 (PTAB Oct. 22, 2020) (Pettigrew, joined by Chung and Trock).

Failure to Prove Publication is Prior Art. Petitioner alleged that a press release from Business Wire qualified as prior art publication under § 102(a). Petitioner relied solely on the text "Copyright

1998 Business, Wire, Inc." as the basis for printed publication status. The Board found that Petitioner failed to prove that the reference qualified as a printed publication because Petitioner failed to establish a reasonable likelihood that the reference was publicly accessible before the critical date. Thus, the Board denied institution. Victoria's Secret Stores LLC v. Andra Group, LP, IPR2020-00853 (PTAB Oct. 22, 2020), Paper 12 (Jeschke, joined by Horner and Worth).

Numerous Real Parties-In-Interest. The PTAB granted institution of IPR and did not find it overly burdensome where Petitioner identified about a dozen real parties-in-interest. NRG Energy, Inc. et. al. v. Midwest Energy Emissions Corp., IPR2020-00832, Paper 17 (Oct. 16, 2020) (Kalan, joined by Kaiser and Ross).

Motion to Reconsider. The PTAB denied Petitioner's request for rehearing of the decision to deny institution of IPR and rejected Petitioner's argument that the Board misapprehended a claim term that was previously construed in another IPR for the same patent and related district court case. Amazon.com, Inc. v. Rensselaer Polytechnic Institute, IPR2019-01068, Paper 12 (Oct. 30, 2020) (Jefferson, joined by Cocks and Quinn).

Analogous Prior Art. The Board found that a patent (Schmitt) directed to vehicle stability and traction control qualified as analogous prior art to a patent claiming adaptive cruise control. In particular, the Board found that Schmitt related to the same field of endeavor as the challenged patent—vehicle control systems—and that both were concerned with operator comfort and safety. BMW of North America, LLC, et al. v. Carrum Technologies, Inc., IPR2019-00903, Paper 9 (PTAB Oct. 19, 2020) (Tournquist, joined by Browne, Scanlon)

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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