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

By Anthony J. Denis and Garfield B. Simms, Ph.D.

Using Applicant's Admitted Prior Art as a basis in an IPR challenge, requirements of joint motions to terminate, and discretionary denial of institution based on ITC investigation are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

Institution Denied Where Petitioner Impermissibly Relied on Applicant-Admitted Prior Art as "Basis" of Challenge. The Board applied guidance from Director Iancu's August 2020 Memorandum setting forth the USPTO's interpretation of 35 U.S.C. § 311(b) relative to statements referred to as Applicant-Admitted Prior Art (AAPA). AAPA cannot form the "basis" of a ground of unpatentability because AAPA does not qualify as "prior art consisting of patents or printed publications" under § 311(b). Rather, AAPA "may be considered only for more limited purposes," such as evidence of general knowledge possessed by a person with ordinary skill in the art. Because the Board determined that the Petitioner relied on AAPA as the "basis" of, i.e., the "foundation or starting point" for, its sole ground challenging the claim, institution was denied. Unified Patents, LLC v. Godo Kaisha IP Bridge 1, IPR2020-01433, Paper 12 (Jan. 27, 2021) (Deshpande, joined by Weidenfeller and Horner).

ITC Schedule Outpaces PTAB Decision Causing Board to Deny Institution of Inter Partes **Review.** The Board denied institution of inter partes review of a patent directed to a small volume syringe under 35 U.S.C. § 314(a). The Board argued that obtaining a stay in a parallel ITC investigation was unlikely, and as a result, the ITC proceeding would conclude prior to the Board being able to deliver its decision. Focusing on the ITC schedule, the Board stated, "[A] stay of the ITC Investigation is unlikely given that the hearing in the ITC Investigation is scheduled to occur in April 2021…The evidentiary hearing in the ITC Investigation is set for April 19, 2021, and the proceeding will reach a final determination on or before November 29, 2021. Our final written

decision is due about two months later in January 2022." Despite Petitioner's "diligence in bringing [the] IPR proceeding," investment by the parties and the ITC have been considerable. The ITC "expended considerable resources to date on the ITC investigation, in the form of addressing claim construction, completing substantial fact discovery, and preparing for expert reports and discovery. … Petitioner's narrow stipulation, which only applies to the ITC Investigation, does not alleviate concerns of duplication given the Petitioner's ability to rely on substantially the same prior art by slightly varying the combinations." Consequently, "instituting review in this proceeding will do little to resolve the disputes between the parties and achieve efficient resolution." Regeneron Pharmaceuticals, Inc. v. Novartis Pharmaceuticals Corp. et al., IPR2020-01317, Paper 15 at 11-13, 17 (Jan. 15, 2021) (Kinder, joined by Franklin and Sawert).

Board Denies Institution of Inter Partes **Review When Petitioner Fails to Show That "Less Than 50 Milliseconds" Teaches "a Few Milliseconds."** The Board denied institution of inter partes review of a patent directed to processing real-time events. The Board found that the expressions "less than 50 milliseconds" and "a few milliseconds" to be significantly different, and that Petitioner failed to persuasively show that an ordinarily skilled artisan would have considered "less than 50 milliseconds" to teach "a few milliseconds" in the context of the recited real-time analysis engine. The Board further found that Petitioner's cited teachings, which mentioned processing applications with "much lower latency," failed to teach receiving and processing events within the required "few milliseconds." DISH Network L.L.C. et al. v. Sound View Innovations, LLC, IPR2020-01035, Paper 19 (Jan. 19, 2021) (Hudalla, joined by Stephens and Galligan).

Joint Motion to Terminate Denied Where Parties Filed Redacted Settlement Agreements. In support of a Joint Motion to Terminate, the parties filed settlement agreements that included redactions. The Board denied the Joint Motion, finding that the submissions were not true copies of the settlement agreements and thus did not meet the requirements of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). Samsung Electronics Co. v. Neodron Ltd., IPR2020-00308, Paper 31 (Jan. 26, 2021) (Quinn, joined by Boucher and Ogden).

Petition Challenging 15 Claims, Including Seven Challenged on All Five Grounds, Did Not Assert Excessive Redundant Grounds. The Petition challenged 15 claims, asserted a total of five grounds of unpatentability, and relied on a total of seven references (but no more than three references per ground). Specifically, the Petition relied on multiple grounds to challenge fourteen claims, seven of which were challenged on all five grounds. In granting institution, the Board rejected the Patent Owner's argument that the Petition asserted "excessive redundant grounds" and found no reason to require the Petitioner "to explain why it chose not to assert fewer grounds." Favored Tech Corp. v. P2i Ltd., IPR2020-01198, Paper 9 at 47-48 (Jan. 27, 2021) (Kaiser, joined by Kalan and Abraham).

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: February 5, 2021