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

By Matt Becker and Rebecca (Xuechen) Ding

Failure to comply with requirements for a motion to amend claims, indefiniteness, and level of skill in the art are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

Preliminary Guidance on Motion to Amend. Preliminary guidance finding that Patent Owner did not show a reasonable likelihood that it satisfied the statutory and regulatory requirements associated with filing a motion to amend. The Board found that the amendments added new subject matter and Petitioner established a reasonable likelihood that the amended claims are unpatentable because the amended claims (i) lacked written description support, (ii) were indefinite, (iii) were not enabled, and (iv) would have been obvious over the references cited in the Opposition. YKK Corporation v.3M Innovative Properties Co., IPR2020-00699 (Apr. 8, 2021) (Meyers, joined by Grossman and Cherry).

Indefiniteness. Board held claims reciting "usable feedback torque values with a ratio between 4:1" indefinite because the limitation suggested a range of ratios but recited only one ratio ("4:1") and also did not reasonably specify which two of five specified torque ratios are compared. Dong Guan Leafy Windoware Co. Ltd. v. Anli Spring Co., Ltd. , et al., PGR2020-00001 (Apr. 8, 2021) (Hoskins, joined by Woods and Moore).

Disavowal of claim scope during prosecution: A statement made by Patent Owner during prosecution can be used in claim construction to "import[] requirements … beyond the plain and ordinary meaning of th[e] term" only if "clear and unequivocal evidence" is found. Board construed "'key code signal' as 'a signal containing a modulated key code,' without the additional exclusion of a codeset from the same signal," regardless of the fact that, during prosecution, Patent Owner repeatedly stated, "[c]laim 2 [of the parent application] recites transmitting a key code signal to the remote control device and does not recite transmitting a codeset to the remote control device." (emphasis added). Roku, Inc. v. Universal Electronics, Inc., IPR2019-01613 (Mar. 29, 2021) (Boucher, joined by Chung and Fenick).

Level of Skill in the Art: Board held the person of ordinary skill in the art ("POSITA") is "not the user of the [claimed] device, but the designer of that device." Therefore, a POSITA of an invention concerning a radiation therapy device "capable of rotationally manipulating a linear accelerator in three dimensions oriented in a variety of approach angles with high geometrical accuracy" does not need to be someone who has "five years of experience in radiation imaging and therapy." A POSITA of this invention is a mechanical engineer having

"several years of experience designing [such type of system]" because of the "predominately mechanical engineering aspects of the pertinent field." ZAP Surgical Systems, Inc. v. Elekta Limited, IPR2019-01659 (Mar. 30, 2021) (Beamer, joined by Moore and Bisk).

Reasonably Pertinent to Problem: A reference qualifies as prior art for an obviousness determination under § 103 so long as "it is reasonably pertinent to the problem with which the inventors were involved," even if the reference and the instant patent application are "not from the same field of endeavor." Red Diamond, Inc. v. Southern Visions, LLP , IPR2020-00001 (Mar. 31, 2021) (Abraham, joined by Crumbley and Kennedy).

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