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

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.

Here are takeaways from recent decisions of interest relating to PTAB proceedings:

- No denial under 35 U.S.C. § 325(d) where petitioner pointed out sufficiently how the examiner materially erred in evaluating the prior art reference.
  Roku, Inc. v. Universal Electronics Inc., IPR2019-01615, Paper 12 (April 17, 2020) (Fenick, joined by Boucher and Chung).

- Institution of IPR denied where petitioner used the challenged patent's teaching as a guide to combine the teachings of the prior art.
  Vanguard Products Group, Inc. d/b/a Vanguard Protex Global v. InVue Security Products Inc., IPR2020-00014, Paper 10 (April 21, 2020) (Zecher, joined by Parvis and Hardman).

- No denial under 35 U.S.C. § 314(a) where some claim limitations overlap with limitations of other related patents.
  Apple Inc. v. Omni MedSci, Inc., No. 2020-00029 (April 22, 2020) (McNamara, joined by Horvath and Fenick).

- Institution of IPR granted after PTAB determined that petitioner did not present substantially the same arguments that were previously presented to the office where four of five references that form the basis of the asserted grounds were not previously presented.
  Square, Inc. v. 4361423 Canada Inc. d/b/a AnywhereCommerce, IPR2019-01649, Paper 11 (April 27, 2020) (Weinschenk, joined by Lee and Trock).

- PTAB cites lack of authority to determine if a mistake is of minor character or occurred in good faith in granting motion to request a certificate of correction.
  Arkema Inc. et al v. Honeywell International, Inc., IPR2016-00012, Paper 57 (April 27, 2020) (Sawert, joined by Tierney and Obermann).

- Institution of IPR denied because mistaken filing of a duplicate power of attorney instead of a petition is not a clerical error and does not constitute a petition filed before the one-year deadline imposed by 35 U.S.C. § 315(b). Varian Medical Systems, Inc. v. Best Medical International, Inc., IPR2020-00075, Paper 13 (May 1, 2020) (Easthom, joined by Saindon and Hudalla).

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