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

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So, what's new at the PTAB? An admitted mistake by the Board, the necessity of using consistent prior art publication dates, the consequences of overstatements, and more!

It takes a big Board to admit when it made a mistake. Samsung Elecs. Co. v. Neonode Smartphone LLC, IPR2021-00144 (December 3, 2021) (Ankenbrand, joined by Szpondowski and Ogden) (granting Petitioner's request on rehearing and granting institution where Petitioner showed Board misapprehended prior art's teachings).

Change can be hard, especially when it comes to prior art dates. Unified Patents, LLC v. 2BCom, LLC, IPR2020-00996 (November 30, 2021) (Wormmeester joined by Hudalla and Fenick) (finding challenged claims not unpatentable after Petitioner changed prior art's date of public availability without explanation and provided inconsistent testimony that undermined expert librarian's credibility).

Additional art, without more, may not be enough to justify parallel petitions. Microsoft Corp. v. D3D Techs., Inc., IPR2021-00877 (December 2, 2021) (Lee joined by Parvis and Raevsky) (exercising discretion to deny parallel petition relying on alternative primary reference deemed to lack sufficiently material differences).

Do not OVERSTATE! BlueCatBio MA Inc. v. Yantai Ausbio Laboratories Co., Ltd., PGR2020-00051 (Dec. 9, 2021) (Roesel, joined by Crumbley and Kokoski) (Petitioner's overstatements undermined reliability of its positions and the Board found no challenged claims unpatentable).

Selective citation, not abuse of discretion. Unified Patents, LLC v. Cedar Lane Technologies Inc., IPR2020-00006 (Dec. 8, 2021) (Kaiser, joined by Beamer and Howard) (denying Petitioner's

request for rehearing of a final written decision because Board's citation to one paragraph of expert testimony doesn't mean it overlooked three other paragraphs).

Act now! Do not delay. Apple, Inc. v. AliveCor, Inc., IPR2021-00970 (Dec. 8, 2021) (Pollock, joined by Jeschke and Cotta) (institution granted where Petitioner filed petition before response deadlines in co-pending Texas litigation and ITC investigation, weighing against discretionary denial).

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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