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

Enablement, indefiniteness, and privity are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

Enablement of Provisional. IPR institution denied after Board applies a provisional date, disqualifying asserted art. The Board cited Petitioner argument regarding what was known in the art as evidence of enablement for the Patent Owner's provisional application. GEMoaB Monoclonals GMBH v. University of Maryland, Baltimore, IPR2020-00233, Paper 16 (Jun. 17, 2020) (Hulse, joined by Tornquist and Majors).

Board Declines to Give Advisory Opinion on Indefiniteness. IPR institution denied because Petitioner provided string cites to alleged structure for means-plus-function claims without specifying alleged structure. Board held it "in effect, seeks an advisory opinion from the Board as to whether the challenged claims are indefinite." Callminer, Inc. v. Mattersight, Inc., No. IPR2020-00272, Paper 8 (Jun. 18, 2020) (McShane, joined by Turner and Arbes).

Privity. IPR institution denied for failure to file within one year of a privy of Petitioner being served with a complaint. Petitioner agreed to indemnify district court defendants. The Board held that Petitioner had the opportunity to control the district court litigation, was in privity with the district court defendants for purposes of § 315(b), and failed to file the Petition within one year of its privy being served with the complaint. Ericsson, Inc. v. Regents of the University of Minnesota, No. IPR2017-01186, Paper 58 (Jun. 19, 2020) (Weinschenk, joined by Bisk and Boudreau).

IPR Instituted based on Fintiv **Factors.** IPR instituted even when similar issues are being litigated in parallel district court cases. Applying the Fintiv factors, see Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential, designated May 5, 2020), the Board determined that the district court litigations were at early stages and that the resolution of the

similar issues by the Board in the IPR proceedings may be beneficial to the district court proceedings. Medtronic, Inc. et al v. Teleflex Medical Devices S.A.R.L., IPR2020-00127, Paper 20 (Jun. 26, 2020) (Snedden, joined by Tornquist and Paulraj).

IPR Institution Denied based on Fintiv **Factors.** IPR institution denied when the petition presented substantially overlapping invalidity issues presented in a parallel district court proceeding. Applying the Fintiv factors, the Board determined that because the district court and the parties already invested substantial resources for the district court proceeding and because the jury trial was scheduled to begin eleven months before the statutory deadline for the Board's decision, an institution would likely create a duplication of effort and a potential for inconsistent results. Supercell Oy v. GREE, Inc., IPR2020-00513, Paper 11 (Jun. 24, 2020) (Wieker, joined by Kim and Browne).

IPR Institution Denied for a Lack of Particularity. IPR institution denied when the petition failed to identify with particularity what disclosure was relied on from each of the cited references, failed to describe how the disclosures would be combinable, and failed to describe why the proposed combination would have been obvious to a person ordinary skill in the relevant technology. Although the Board determined that only four out the twenty grounds did not satisfy the particularity requirement, it infected the proceeding sufficiently to deny an IPR institution on all grounds. EIK Engineering Sdn. Bhd. v. Wilco Marsh Buggies & Draglines, Inc.,IPR2020-00344, Paper 7 (Jun. 23, 2020) (Grossman, joined by Browne and Moore).

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: July 2, 2020