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

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So, what's new at the PTAB? Technicalities for termination, expert declaration length, requests for rehearing, and more!

A joint request takes two. Tesla, Inc. v. Unicorn Energy GmbH, IPR2022-00110, Paper 19 (February 17, 2022) (McMillin, joined by Jurgovan and Khan) (finding that no joint request to terminate was made because Petitioner's email to the Board merely requested to file an "unopposed motion" to terminate the proceeding and did not indicate that the Patent Owner joined in a request to terminate, and ultimately denying Patent Owner's motion to dismiss the petition and terminate the IPR proceeding).

"Extensive explanation" not burdensome in complex case. Volkswagen Group of America, Inc. v. Arigna Technology Limited, IPR2021-01321, Paper 10 (February 15, 2022)(Baer joined by Fenick and Ahmed) (declining to exercise discretion to deny petition on the basis that Petitioner's filings were "voluminous" – long expert declaration and large number of exhibits were acceptable given the patent's complex subject matter and two distinct challenges for each challenged claim is not overly burdensome).

Your guess is as good as mine… Netflix, Inc. v. Avago Technologies International Sales Pte. Limited, IPR2021-01343 (February 23, 2022) (Engels, joined by Droesch and Dirba) (granting institution because although the Board was not persuaded by Petitioner's speculation as to how and why a person of ordinary skill in the art would combine the references, Petitioner did sufficiently demonstrate a reasonable likelihood of prevailing with respect to at least one claim).

Out with the old and in with the new? Turns out a Patent Owner's arguments are not that easy to overlook. Philip Morris Products SA v. RAI Strategic Holdings, Inc., IPR2020-01094 (February 25, 2022) (Roesel, joined by Abraham and Ankenbrand) (denying request for rehearing because: (1) although the decision did not explicitly cite the prosecution history, it does not mean the Board overlooked the Patent Owner's prosecution history arguments; and (2) the Board did not overlook or misapprehend the Patent Owner's arguments. The Board noted that in the Patent Owner's haste to demonstrate something had been overlooked, the Patent Owner changed its prior arguments, thereby abandoning its position on the claims at issue.)

Patent Owners: When all else fails, don't try and try again (without meeting the standard of review). Samsung Electronics Co., Ltd. et al v. Power2B, Inc., IPR2021-01190 (February 25, 2022) (McShane, joined by Parvis and Hamann) (denying request for rehearing following the Board's decision to institute IPR because the Patent Owner failed to demonstrate the Board abused its discretion and used the request to merely reargue its case).

One petition per patent is A-OK. Halliburton Energy Services, Inc. v. US Well Services, LLC, IPR2021-01238, Paper 9 (February 16, 2022) (O'Hanlon, joined by Petravick and Browne) (refusing to exercise discretion to deny petition, which is one of 15 petitions filed by Petitioner against 15 of Patent Owner's patents, even though the challenged patent is not yet asserted because Petitioner "expresses reasonable concern that Patent Owner may initiate additional litigation regarding its as-yet unasserted patents").

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