PTAB Highlights | The Top Ten Takeaways of 2022

As we usher in a new year, Banner Witcoff takes a look back at the top ten PTAB Highlights from 2022. From the showing of error under the Advanced Bionics framework to the effects of transferring parallel litigation, take a look at what caught the eye of your colleagues during 2022:

Hold your horses! The PTAB won't consider if the Office erred under the Advanced Bionics **framework until a definitive determination in the other proceeding has been made**. Samsung Electronics. Co., Ltd v. Lynk Labs, Inc., IPR2022-00051, Paper 19 (June 7, 2022) (Tornquist, joined by Chagnon and Raevsky) (granting institution under 35 U.S.C. §325(d) and rejecting the patent owner's argument that, under the Advanced Bionics framework, institution should be denied because the references and arguments set forth are cumulative of art already being considered by the Board, the PTAB finding that the relevant art had not yet been fully considered in the other IPR such that there is no reference point to determine whether the Office erred).

No two bites at the PTAB apple. Home Depot USA, Inc. v. Lynk Labs, Inc., IPR2022-00143, Paper 17 (May 27, 2022) (Ullagaddi, joined by Tornquist and Raevsky) (denying institution of an IPR under § 314(a) because there was a post-grant review (PGR) applying the same prior art combinations that had already been instituted, explaining that instituting both the PGR and the IPR could lead to potentially inconsistent records on identical prior art challenges).

Second chance but same result: institution denied. Google LLC v. EcoFactor, Inc., IPR2021-01578, Paper 15 (September 23, 2022) (Howard, joined by Derrick and Abraham) (initial discretionary denial lifted in view of intervening guidance from the Director, but Petition denied on the merits because the asserted art is missing a required claim limitation and Petitioner's non-industry evidence in response (primarily prosecution history and ITC rulings) is not persuasive).

No IPR will be instituted based on disclaimed claims. Microsoft Corporation v. LiTL LLC et al,

IPR2021-01011, Paper 11 (April 5, 2022) (Baer, joined by Ankenbrand and Range) (The Board denied petitioner's request for rehearing of the decision denying institution after Patent Owner disclaimed all claims and rejected Petitioner's argument that the Board should have entered adverse judgment because no inter partes review will be instituted based on disclaimed claims under 37 C.F.R. § 42.107(e)).

Don't contradict the art! STMicroelectronics, Inc. v. The Trustees of Purdue University, IPR2022-00252, Paper 13 (June 22, 2022) (Obermann, joined by Kokoski and Abraham) (denying institution of IPR because asserted combination of references was expressly refuted by those references and, thus, the petition smacked of impermissible hindsight).

Hey, what do you have there!? Just because your adversary's witness has a document with them while testifying, doesn't mean you get that document in discovery. Shenzhen Buxiang Network Tech. Co., Ltd. v. Ideal Time Consultants Ltd., IPR2021-00080, (Paper 36) (January 13, 2022) (Scanlon, joined by Barrett and Browne) (denying Petitioner's Motion for Additional Discovery seeking two documents that Patent Owner's witness had with him while testifying, holding that the Petitioner failed to show that the witness's reliance on the first document influenced his testimony (as required under Federal Rule of Evidence 612(a)(1)); that discovery of the second document, even if the second document influenced his testimony, is in the interest of justice (as required under Federal Rule of Evidence 612(a)(2)); or that the two documents would ultimately provide useful information (as required under the Garmin factors for determining if additional discovery is appropriate)).

General Relativity: Lack of experience in narrowly defined subject matter is not a reason to exclude an expert when the expert has general expertise in the area. Unified Patents, LLC v. Ideahub, Inc., IPR2020-01338, Paper 48 (February 7, 2022) (Moore, joined by Ullagaddi and Cygan) (rejecting Patent Owner's argument that an expert witness should be disqualified "based on an alleged distinction between the claimed technologies and [the expert's] experience," because the expert "exceeds the undisputed qualifications for one having ordinary skill in the pertinent art in this proceeding").

No termination of IPR proceeding even though patent is invalid under § 101. Tile, Inc. v. Linquet Technologies, Inc., IPR2021-00927, (Paper 52) (November 16, 2022) (Belisle, joined by White and Amundson) (denying motion to dismiss IPR proceeding as moot, despite patent being found invalid under 35 U.S.C. § 101 in parallel district court proceeding).

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).

A new court, a new trial schedule, no Board discretion? Google LLC v. Ikorongo Technology LLC et al., IPR2021-00205, (Paper 16) (January 25, 2022) (Moore, joined by Fenick and Belisle) (granting Petitioner's request for rehearing of discretionary denial of institution, and granting institution because Federal Circuit transferred parallel litigation out of the WDTX).

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.

Banner Witcoff is recognized as one of the best performing and most active law firms representing clients in inter partes review (IPR) proceedings. To learn more about our team of seasoned attorneys and their capabilities and experience in this space, click here.

Banner Witcoff's PTAB Highlights are provided as information of general interest. They are not intended to offer legal advice nor do they create an attorney-client relationship.

Posted: January 19, 2023