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

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So, what's happening at the PTAB? Means-plus-function interpretation, issues with incorporations by reference, abstract ideas, and more!

The Board can Choose its own Adventure… and Construction. Head Sport GmbH v. Vermont Safety Developments LLC, IPR2024-01099, Paper 15 (January 15, 2025) (Grossman, joined by Weatherly and Silverman) (denying institution for Petitioner's failure to meet its burden to establish a reasonable likelihood that it would prevail with respect to at least one of the claims challenged in the petition based on the Board's construction of the disputed term "release logic" as a means-plus-function term, which was a different construction than any of the parties' constructions proposed to the Board or in district court litigation).

Incorporating a 3GPP standard specification is okay, but please tell how expressly! AT&T Services, Inc. et al v. Innovative Sonic Limited et al, IPR2024-01145, Paper 12 (January 24, 2025) (Courtenay, joined by Zecher and Ogden) (denying institution of inter partes review of a patent directed to implementing small cell enhancements in a wireless communication system under 35 U.S.C. § 102, because Petitioner did not persuasively show how the prior art expressly incorporates a particular part of the 3GPP standard specification by: (1) identifying with detailed particularity what specific material the prior art incorporates; and (2) clearly indicating where that material is found in the 3GPP standard specification).

Fundamental is fundamental, no matter how it applies to modern technologies. Crusoe Energy Systems, LLC v. Upstream Data Inc., PGR2023-00039, Paper 45 (January 21, 2025) (Meyers, joined by Jung and Mayberry) (finding claims directed to a blockchain mine at an oil or gas facility unpatentable under 35 U.S.C. § 101, because using otherwise wasted energy to

generate an inexpensive power supply for blockchain mining is a “fundamental and long prevalent” practice, and thus, is an abstract idea).

Following the Leader towards Institution, with Strings Attached. Bombardier Recreational Products Inc. v. MHL Custom, Inc., IPR2024-01107, Paper 10 (January 15, 2025) (Cherry, joined by Gerstenblith and Woods) (granting institution and joinder because Petition was substantially identical to an already instituted IPR, and Petitioner agreed to act “solely as an understudy” in the proceedings by “refrain[ing] from advancing any arguments,” and “binding itself to any discovery agreements, and limiting its deposition time to the time already allotted” in the joined IPR).

Board: Fool us Once, Shame on the Examiner; Fool us Twice, Shame on Patent Owner. Sony Corporation v. Optimum Imaging Technologies, LLC, IPR2024-01046, Paper 11 (January 17, 2025) (Horvath, joined by Baer and Cass) (granting institution and rejecting Patent Owner’s pleas for discretionary denial under (1) 35 U.S.C. § 314(a) due to Petitioner’s stipulation that it would not pursue in the related district court litigation the same grounds raised in the Petition or that reasonably could have been raised, and (2) 35 U.S.C. § 325(d) because the Petitioner established the Examiner erred in failing to reject a challenged claim over previously submitted, but “overlook[ed],” prior art).

Cache (cache states), cache (cache-state transitions), and cache again (cache coherence operations), motivation to combine…Mercedes-Benz USA, LLC v. Daedalus Prime LLC, IPR2023-01344, Paper 31, (January 24, 2025) (Anderson, joined by Calve and Peslak) (finding claims of a patent directed to multiprocessor (MP)-socket computer systems unpatentable under 35 U.S.C. § 103, because “a person of ordinary skill in the art would have been motivated to look to the cache-state transitions during cache coherence operations in Tang to understand the cache states listed in Sinharoy”).

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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