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

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In this installment of the PTAB Highlights, Banner Witcoff examines recent decisions at the PTAB featuring: sanctions issued by the Director, expert credibility, unnecessary stipulations, and more!

Abusing IPR proceedings leads to sanctions. OpenSky Industries, LLC v. VLSI Technology LLC., IPR2021-01064, Paper 127 (Feb. 3, 2023) (Vidal) (vacating an earlier decision to dismiss Petitioner, but affirming sanctions (attorney fees) against Petitioner for abusing IPR proceedings by attempting to extract payment from Patent Owner).

My expert's got more experience than your expert! PTAB: That's not how we assess credibility. Google v. EcoFactor, IPR 2021-01218, Paper 22 (Feb. 6, 2023) (Howard joined by Derrick and Abraham) (declining to find one expert more credible than the other based on years of experience; explaining that credibility is judged based on corroboration, consistency with prior art, and cross examination; and faulting both experts for substantially parroting the parties' filings without elaboration)

If you can't raise it at the Board, you don't need to stipulate it away to avoid discretionary denial of institution. Samsung v. Hardin, IPR2022-01327, Paper 13 (Feb. 7, 2023) (Gerstenblith joined by Wormmeester and Peslak) (granting institution and finding that Petitioner did not need to stipulate that it would not pursue a written description defense in a parallel district court proceeding just because written description was also implicated in its priority date arguments at the Board)

You can't beat something with nothing. Flowco Production Sols. v. Well Master Corp., IPR2022-01384, Paper 7 (Jan. 20, 2023) (Jeschke joined by Calve and Scanlon) (denying institution where

Patent Owner's expert provided testimony against the combination of two prior art references and Petitioner submitted only attorney argument unsupported by an expert declaration)

Which argument you make matters. … MED-EL Elektromedizinische Geraete GmbH v. Advanced Bionics AG, IPR2020-01016, Paper 48 (Feb. 3, 2023) (Jeschke joined by Daniels and Marschall) (finding Petitioner's references analogous prior art and therefore applicable in part due to Patent Owner failing to challenge Petitioner's evidence; instead Patent Owner argued design differences based on technical reasons).

The more, the merrier. Liquidia Technologies, Inc. v. United Therapeutics Corporation, IPR2021-00406, Paper 82 (Feb. 2, 2023) (Kaiser joined by Franklin and Cotta) (finding Petitioner's reference to be a prior art printed publication as the reference was disseminated to over twenty thousand people, including journalists and expert professionals, with no expectation of confidentiality in preparation for and during a conference).

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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