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

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.

Here are takeaways from recent decisions of interest relating to PTAB proceedings:

- Institution of an IPR denied when expert invoked "common sense" to supply a missing claim limitation in a 35 U.S.C. § 103(a) analysis.
  ARRIS Solutions, Inc. et al. v. Realtime Adaptive Streaming LLC, IPR2019-01586, Paper 7 (March 16, 2020) (Braden, joined by Andersen and Jivani).

- PTAB denied institution of IPR when the district court was set to complete trial well before a final written decision on the IPR.
  Edward Lifesciences Corp et al. v. Evalve, Inc., IPR2019-01546, Paper 7 (March 19, 2020) (Mitchell, joined by Snedden and Cotta).

- Institution of IPR denied under 35 U.S.C. § 325(d) when PTAB found that the teachings of the prior art reference asserted by the Petitioner "largely overlap[ped]" with arguments presented during prosecution of the challenged patent.
  Regeneron Pharmaceuticals, Inc. v. Kymab Ltd., Nos. 2019-01579, Paper 9 (March 20, 2020) (Sawert, joined by Yang and Valek).

- PTAB denied institution of PGR because instituting based on 35 U.S.C. § 112(b) arguments for only 3 dependent claims would be an inefficient use of PTAB resources and the same issue was before the district court.
  RetailMeNot, Inc., v. Honey Science Corp., PGR2019-00060, Paper 17 (March 10, 2020) (Horner, joined by Scanlon and Dougal).

- PTAB granted Patent Owner's motion to cede jurisdiction to correct the priority claim and authorized Patent Owner to file a petition to the Director to claim priority to provisional application.
  Guardian Alliance Technologies, Inc., v. Tyler Miller, IPR2020-00031, Paper 22 (March 10, 2020) (McKone, joined by Medley and Kenny).

- On remand after Federal Circuit vacated PTAB's determination of unpatentability because the PTAB erred in evaluating evidence of prior conception, the PTAB reversed its previous decision and instead found that Petitioner did not show reference was prior art and held claims not unpatentable.
  Motorola Mobility LLC, v. Intellectual Ventures II LLC, IPR2014-00504, Paper 84 (March 13, 2020) (Scanlon, joined by Kim and Kalan).

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Posted: March 26, 2020