

By Alex Bruening[1] and Eric Zelepugas

A granted request for rehearing, failure to prove public accessibility, and a motion to reconsider granting of an earlier motion to reconsider are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

Request for Rehearing Based on an Alternative Primary Reference. Petitioner asserted three obviousness grounds based on a number of references: Varenna 2012, Varenna 2016, and/or Manara, optionally combined with Bruehl and one or more of Gatti, La Montagna, and/or Muratore (Ground 5); Varenna 2012, Varenna 2016 and/or Manara in combination with Manicourt (Ground 6); and Varenna 2012, Varenna 2016, and/or Manara in combination with Schwarzer, and optionally in further combination with Bruehl and Gatti, La Montagna, and/or Muratore (Ground 7). While the Board initially determined that the Petitioner failed to show that Varenna 2016 and Manara were prior art, Petitioner argued the Board failed to consider Varenna 2012 as an alternative primary reference. The Board agreed and granted Petitioner's request for rehearing. Grunenthal GmbH, v. Antecip Bioventures II LLC „ PGR2018-00092, Paper 29 (Nov. 10, 2020) (Snedden, joined by Obermann and Kaiser).

Board Rejects Assertion That It Misapprehended Evidence. Petitioner requested rehearing arguing that the Board misapprehended evidence by viewing Figures 8, 9, and 11 individually and in isolation and only relying on Figure 8 in its decision. Board rejected that argument as its Decision expressly discussed Petitioner's reliance on Figures 8, 9, and 11 and how Petitioner's evidence failed to satisfy its burden of proof. Satco Products, Inc. v. Seoul Semiconductor Co., Ltd. , IPR2020-00151, Paper 9 (Nov. 9, 2020) (Abraham, joined by Franklin and Roesel).

Failure to Prove Publication is Prior Art. Petitioner argued that, to access a Working Draft 4 (WD4) of the High-Efficiency Video Coding (HEVC) standard developed by the Joint Collaborative Team on Video Coding (JCT-VC), an ordinarily skilled artisan could have and would have joined a JCT-VC listserv in order to receive a listserv email containing WD4. Petitioner argued that a skilled artisan would have joined the listserv "given the importance and prominence of the emerging HEVC Standard" and because "the JCT-VC's work was widely publicized." The Board disagreed, finding that Petitioner failed to demonstrate that a skilled artisan would have even known about the JCT-VC listserv or how to subscribe to it. Samsung Electronics Co., Ltd. v. InfoBridge Pte. Ltd., IPR2017-00099,-00100, Paper 41 (Nov. 13, 2020) (Pinkerton, joined by Crumbley and Boucher).

Institution Denied Due to Trial Proximity. On Sept. 3, 2020, the Board denied institution based on a trial in a parallel proceeding scheduled for Dec.7, 2020, approximately nine months before Final Written Decision would have been due. This gap in time created a cognizable risk of inconsistent results and duplication of efforts. The Board denied Petitioner's request for rehearing of the decision to deny institution finding that even if the trial in the parallel proceeding was delayed by two months, the proximity of the trial date to the Final Written Decision would still favor denying institution. SuperCell Oy v. Gree, Inc., PGR2020-00034, Paper 17 (Nov. 2, 2020) (Wieker, joined by Browne and Jung).

Petitioner Fails to Timely Disclose New References. The Board denied Petitioner's request for rehearing of a Final Written Decision. It rejected Petitioner's argument that the Board should consider new references that Petitioner admittedly was aware of prior to the Final Written Decision. The Board found that Petitioner relied on the Board's emphasis

of certain limitations as important to the patentability of proposed substitute claims in its decision to bring the new references forward. ClearOne, Inc. v. Shure Acquisition Holdings, Inc., IPR2019-00683, Paper 96 (Nov. 3, 2020) (Jurgovan, joined by Zecher and Margolies).

Motion to Reconsider a Motion to Reconsider. A joined petitioner moved to act as lead petitioner, which the Board denied. That joined petitioner requested a rehearing of that decision, which the Board granted. The Patent Owner then moved for a rehearing of that decision. The Board denied Patent Owner's request because the Patent Owner did not point to any precedent that prohibits the Board's action, nor did the Patent Owner explain how any of the cited Board decisions present an analogous factual scenario. ZTE (USA) Inc. et al. v. CyWee Group Ltd ., IPR2019-00143, Paper 71 (Nov. 4, 2020) (Ogden, joined by Boucher and Jivani).

Real Parties in Interest. The Board rejected Patent Owner's argument that institution should be denied because Petitioner failed to identify all real parties in interest. Instead, the issue of whether a non-party is a real party in interest is better evaluated in the context of a completed trial, when the record has been fully developed and, for instance, the parties have had the opportunity to cross-examine declarants. One World Technologies, Inc. d/b/a Techtronic Industries Power Equipment v. Chervon (HK) Limited, IPR2020-00886, Paper 21 (Nov. 6, 2020) (Horner, joined by Grossman and Finamore).

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[1] Alex has taken the bar exam in Illinois and is awaiting results.

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