

**Akin Gump**  
STRAUSS HAUER & FELD LLP

# IP Newsflash



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## PATENT TRIAL AND APPEAL BOARD

### For the First Time, PTAB Rules for Patent Owner After *Inter Partes* Review Trial Instituted

A PTAB panel has held, for the first time, that all challenged claims of a patent are valid following completion of an *inter partes* review (IPR) trial. In its challenge, the petitioner argued that claims covering a system that facilitates the creation of hardware-independent motion control software were obvious in view of the prior art. The parties submitted dueling expert declarations from scientists working in the same lab. In rejecting the petitioner's challenge, the Board credited testimony from patent owner's (owner) expert that certain elements in the patent claims are not present in the prior art relied on by the petitioner. In contrast, the Board found unpersuasive rebuttal expert testimony submitted by petitioner in its reply. Specifically, the Board found that the petitioner's expert's summary "did not list the four claim elements [owner's expert] testifies are missing from the references, and does not directly address them in his testimony." Similarly, for another prior art reference, the Board noted that petitioner's experts failed to "directly address the [owner's expert's] assertion that the reference lacks a teaching" of the claim element. After determining that this rebuttal testimony was insufficient to discredit the owner's expert, the Board held that the petitioner failed to prove by a preponderance of the evidence that the challenged claims are unpatentable.

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*ABB Inc. v. ROY-G-BIV Corp.*, IPR2013-00062 and -00282 (PTAB April 11, 2014) [Giannetti (opinion), Bisk, Plenzler]

### Extension Granted to Petitioner in IPR Proceeding to Submit Supplemental Evidence of Prior Art

A PTAB panel has granted a petitioner's request for an extension of time to serve supplemental evidence related to a prior art reference whose publication date was challenged by the patent owner. The reference in question was a Japanese publication, which the petitioner asserted in its petition qualified as prior art under 35 U.S.C. § 102(b). Relying on this assertion, the Board instituted the IPR. Following institution, the patent owner timely served evidentiary objections under 35 C.F.R. § 42.64(b)(1) challenging the publication date of the Japanese reference. In response, the petitioner timely served supplemental evidence of prior art, including a witness declaration attesting to the publication date of the reference in question. In addition, the petitioner also made a request to a Japanese agency for certification of the reference's date of publication. That certification, however, was not immediately available, prompting the petitioner to request an extension. According to the Board, such a request must be supported by a showing of good cause pursuant to 37 C.F.R. § 42.5(c)(2). In its analysis, the Board concluded that the instant request was appropriate because of the inherent delays expected from a foreign governmental agency. In addition, because the late service would not impact the overall trial schedule nor the patent owner's ability to file a timely motion to exclude the evidence, the Board granted the extension.

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*CaptionCall, LLC v. Ultratec, Inc.*, IPR2013-00540 (PTAB April 9, 2014) [Chang (opinion), Saindon, Benoit, Pettigrew]

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