

Printed, incentivised to combine? Evident(ial) challenges on *inter partes* review proceedings

In September 2018, the Patent Trial and Appeal Board (which hears *inter partes* review proceedings, analogous to EPO oppositions) established a “Precedent Opinion Panel”. The idea is to identify cases which could be regarded as have value in harmonising the approaches of different panels, an issue which is well known from the EPO. **Brooke Wilner** and **Tim McAnulty** discuss three recent cases considered by the panel, all taking a critical look at what is “sufficient evidence”. The first looks at what amounts to proof that a publication is a printed publication made available to the public by a specific date, and although specific to printed publications (a specifically US characterisation) also highlights that simple indicia such as a copyright notice with a date may, on their own not be enough. The second and third look at when it is legitimate to combine references – perhaps bringing US practice closer to the approach applied elsewhere. All three remind practitioners that evidence matters.¹

Since its inception in September 2012 as part of the America Invents Act, the Patent Trial and Appeal Board (PTAB) has sometimes rendered inconsistent judgments.² These inconsistencies exist at least in part because every routine decision, i.e., every panel decision that is not otherwise designated by the US Patent and Trademark Office (USPTO), is binding only on the parties in that particular case.³ While a routine decision from one panel may be persuasive to other panels, there is no obligation for different panels to adopt the same approach or reach the same outcome. Generally, the merits of each particular case are typically unique to the challenged patent and asserted prior art, however, individual panels also address issues that affect overall practice before the PTAB. Even in its eighth year (and after significant impact from the Federal Circuit and Supreme Court through numerous appeals), the PTAB is still addressing jurisdictional, procedural, and substantive issues that implicate the overall practice before the PTAB.

In September 2018, the PTAB created the Precedential Opinion Panel (POP) to help address this concern. The POP is intended to serve two functions. First, it is tasked with rehearing

matters in pending cases (including IPR, PGR, and CBM trials, as well as *ex parte* appeals from prosecution) that raise issues of “exceptional importance”, including constitutional issues; important issues regarding statutes, rules, regulations, or binding or precedential case law; and issues of “broad applicability to the Board [PTAB]”.⁴ Second, it can help promote consistency by resolving conflicting PTAB decisions where different panels reached different outcomes.⁵ This latter function allows the panel to assist the Director in designating PTAB decisions as precedential or informative.⁶ A precedential decision establishes binding authority for all panels, while an informative decision provides helpful but non-binding guidance on both issues of first impression and recurring issues.⁷ In addition to designation by the POP, a PTAB decision can be designated informative or precedential by a nomination process,⁸ suggested by a committee of PTAB judges,⁹ or at the discretion of the Director.¹⁰

A POP may be convened in one of three ways: the Director may convene a panel to determine whether to order rehearing of a case *sua sponte*; a party in a given proceeding may request POP review of a request for rehearing; or a member of the PTAB itself may recommend review.¹¹ Once convened, the panel assists the

Director in deciding if the case should be heard by the POP.¹² If the panel agrees to hear a case, its decision will be binding on the particular case and designated precedential for the PTAB. The POP can also “rehear” issues that were previously designated as precedential or informative and provide new precedent in view of changes and decisions from the Federal Circuit or Supreme Court.¹³ Previously designated decisions can also be de-designated outside of the POP. For example, the PTAB de-designated¹⁴ two precedential decisions, *MasterImage 3D, Inc. v RealD Inc.*,¹⁵ and one informative decision, *Idle Free Sys., Inc. v Bergstrom, Inc.*,¹⁶ relating to motions to amend after the Federal Circuit’s en banc decision in *Aqua Prods., Inc. v Matal*,¹⁷ which changed the PTAB’s allocated burdens of proof.

The PTAB is quickly making an impact on its goal of increased consistency. In 2019 alone, through the various avenues discussed above, the PTAB designated 13 decisions as informative and 19 decisions as precedential.¹⁸ These decisions are starting to provide a more consistent approach by PTAB to a range of issues. Some clarified what is required to show a skilled artisan’s motivation to combine references.¹⁹ Others discussed discretionary issues like the factors panels will consider at institution of the *inter partes* review to determine if the asserted challenges have already been vetted by the USPTO in another proceeding²⁰ or are improper serial attacks²¹ warranting denial. Others set forth the type and scope of grounds that can be raised by petitioners against substitute claims proposed by patent owners in motions to amend.²² And others discussed time bar issues like when petitioners can file IPR petitions after being served with a complaint for patent infringement in district court,²³ an issue that the Supreme Court will resolve²⁴ later this year.

In this article, we discuss the details of three recently designated decisions. A precedential decision from the POP addresses the evidentiary proof necessary to show an asserted reference is prior art at institution and ultimately prove claims are unpatentable at final decision. Two informative decisions address evidence and rationale needed to show an ordinary artisan would have been motivated to combine teachings from the asserted prior art.

[Hulu I — Petitioners may have some leeway in showing a reference is a “printed publication” at institution](#)

The most recent precedential decision clarified what is required for a petitioner to show a reference is a printed publication to warrant institution. The issue is an important one for petitioners — the PTAB has denied institution where it found the petitioner had not sufficiently shown that the references cited were publicly available as of the critical date of the challenged claims.²⁵ However, before *Hulu*, the PTAB took varying positions on the issue. Some panels held that a copyright notice was *prima facie* evidence that the reference was publicly available warranting institution (if all substantive issues were also sufficiently shown).²⁶ Other panels found that such a notice would only be

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enough if the publisher was well-known and often published in the United States.²⁷ Some panels held that a petitioner needed only to provide evidence to show a reference was reasonably likely to be a printed publication at institution,²⁸ while others appeared to indicate that a petitioner needed to meet a higher burden.²⁹

In May 2018, Hulu filed an IPR petition challenging certain claims of a patent owned by Sound View Innovations.³⁰ The patent had a 1995 priority date, and Hulu relied in part on a textbook with a copyright date of 1990. The original panel found that the copyright date only established that 1990 was “the date the work was fixed in a tangible medium of expression.”³¹ Without any showing by Hulu that the textbook was publicly available before the critical date of the patent, the panel denied institution.³²

To warrant institution, an IPR petitioner must show there is a “reasonable likelihood” that it will prevail on proving at least one of the challenged claims is unpatentable.³³ Before *Hulu*, it was not clear if this standard applied to the substantive showing of unpatentability and the evidence relied on to make that showing or if it applied to only the substantive showing. As mentioned above, different panels viewed the issue differently, assessed evidence differently, and reached disparate outcomes. Hulu filed a request for rehearing and a request for POP review.³⁴ The POP decided to review the panel’s decision to determine “[w]hat is required for a petitioner to establish that an asserted reference qualifies as ‘printed publication’ at the institution stage” and invited amicus briefing.³⁵

In its decision, the POP held that the threshold necessary to warrant institution applies equally to both the substantive showing of unpatentability alleged by the petitioner as well as the evidence relied on to make that showing. That is, to warrant

institution, a petitioner must provide enough evidence to show there is a reasonable likelihood it will prevail in proving an asserted reference is a printed publication and provide sufficient rationale to show there is a reasonable likelihood it will prevail in proving the challenged claims are unpatentable. The POP also addressed the merits of Hulu's rehearing and found that the petition established a reasonable likelihood that Hulu could prove the textbook was a printed publication.³⁶ Thus, the POP granted Hulu's request for rehearing and remanded the petition back to the panel to determine if Hulu also made the necessary showing on the merits.³⁷

In reaching its decision, the POP first looked to the statute and the Director's limited authorization to institute review. The POP referenced AIA §§312(a)(3), 314(a), which require a petitioner to show it is "reasonably likely" to prevail in proving unpatentability of the challenged claims.³⁸ There has been little debate that this standard applies to the substantive issues evaluated at institution, e.g., assessing whether the petitioner provided sufficient claim construction for the challenged claims and accounted for all of the claim elements in the asserted prior art. In *Hulu*, the POP saw no reason why this standard should be limited to substantive issues and held applies equally to any evidence supplied to show that the prior art relied upon qualifies as prior art.³⁹ In other words, at institution, a petitioner must provide enough evidence to show that it is "reasonably likely" to prevail in proving the reference is a printed publication.⁴⁰

This itself is not necessarily controversial; the patent owner and several *amici* agreed that the "reasonable likelihood" standard applied to substantive as well as evidentiary issues at institution.⁴¹ However, the patent owner argued that this standard can only be met when a petitioner makes its evidentiary case in chief in its petition.⁴² That is, because a petitioner can only respond to arguments made by a patent owner after filing its petition, and cannot raise new issues or grounds, curing an evidentiary deficiency would be improper. However, the POP disagreed.

In its decision, the POP emphasized that "reasonably likely" standard was a higher than a notice pleading, but lower than the "preponderance of the evidence" standard required to succeed in a final written decision.⁴³ It also explained that a petitioner does have "limited opportunities to submit additional evidence" after filing its petition indicating that the lower threshold at institution made sense. That is, a petitioner cannot completely reopen the record, for example to change its theory of unpatentability, and submit entirely new evidence,⁴⁴ but a petitioner has procedural opportunities to submit additional evidence to strengthen its original position. The POP reasoned that these opportunities allow a petitioner to respond to a patent owner's arguments and evidentiary challenges. For example, a petitioner can provide additional evidence in a reply to a patent owner's response (post-institution) or in a separate motion to file supplemental information. These opportunities provide avenues, post-petition and post-institution, for a petitioner to submit evidence in response to a patent owner's challenge to a reference's status as a

printed publication.⁴⁵ Thus, a petitioner can meet the reasonable likelihood standard for institution without necessarily meeting the higher standard to prove unpatentability at a final decision and bolster its evidence during the proceeding. However, petitioners may be well served to provide as much evidence as reasonably possible with their petitions to reduce the risk that additional evidence may not be allowed post institution.

Some *amici* argued that there was (or should be) a presumption generally in favor of institution and thus a presumption in favor of finding that an asserted reference is a printed publication.⁴⁶ The POP disagreed, emphasizing that there is no presumption in favor or against institution and, notably, reaffirmed that the burden is on the petitioner to present evidence sufficient to show a reasonable likelihood that the asserted reference qualifies as a printed publication.⁴⁷ And in *Hulu*, the petitioner was required to provide evidence sufficient to establish that the textbook on which it relied was reasonably likely to have been publicly accessible before the critical date of the challenged patent.

The POP then turned to the effect of indicia, like copyright dates, edition identifiers, commercial publication, and assignment of an International Standard Book Number (ISBN) that a petitioner may rely on at institution.⁴⁸ The parties and *amici* proposed a variety of presumptions and standards for the use of indicia. The petitioner argued that the "reasonable likelihood" showing is made where a publication "bears conventional markers of publication," like a copyright date and the assignment of an ISBN number.⁴⁹ The patent owner argued that printed stamps and dates alone are not enough to establish sufficient public availability, and additional evidence, like supporting declarations, should be required.⁵⁰ Each of these standards found some support from one or more *amici*. Instead of selecting any of the proposed standards, the POP provided several examples of prior decisions finding certain indicia sufficient and other indicia insufficient and simply held that no particular indicia are per se sufficient at the institution stage.⁵¹ Rather, indicia are considered as part of the totality of the evidence. Thus, if the petitioner has shown, based on a totality of the evidence, that an asserted reference is reasonably likely to be a printed publication, then it has met the threshold of proof required at institution – regardless of the type or kind of indicia.

Turning to the merits in *Hulu*, the petition included the textbook's copyright date, a printing date, and an ISBN assignment date, all predating the challenged patent's critical date. And the textbook was published by an established publisher as part of a well-known book series. The POP found these indicia sufficient to meet the threshold for institution and the POP granted Hulu's motion for a rehearing.⁵² The case was remanded to the original merits panel to consider whether to institute a trial.

A limit on the reach of *Hulu* is that it specifically addresses printed publications and the institution threshold for IPRs. Other AIA trial proceedings, like post-grant reviews (PGRs) and covered business method proceedings (CBMs), require that petitioners show it "more likely than not" that a challenged claim is unpatentable for institution.⁵³ The PTAB has regularly

discussed this threshold as being close to (if not the same) as a preponderance of the evidence standard.⁵⁴ Thus, while the rationale of *Hulu* might be extended to PGRs and CBMs, petitioners and patent owners should be cognizant of the different standards and how the limited opportunities for petitioners to supplement evidence may impact those proceedings.

Hulu II — Mere suggestions of improvement may not be sufficient to show motivation to combine

In a different but related IPR, *Hulu* challenged another Sound View patent asserting certain claims would have been obvious over, among other things, a combination of two references.⁵⁵ The first reference was a patent directed to a method for providing prepaid cellular telephone services, which created and augmented call detail records while the calls took place.⁵⁶ The second was a book chapter discussing solutions to problems relating to real-time database systems.⁵⁷ *Hulu* reasoned that an ordinary artisan would have combined the two references and asserted that the “tight timing requirements” of “telephone routing and billing systems,” which it argued were described in the primary reference, would have motivated an ordinary artisan to seek out the solutions provided by the secondary reference.

But the PTAB found that the asserted references suggested otherwise. The PTAB reasoned that the method disclosed in the prior art patent would have been capable of processing responses within that patent’s own stated timing requirements, a conclusion supported by the Petitioner’s own expert.⁵⁸ The PTAB found that an ordinary artisan would not have been motivated to implement even faster information processing, like that allegedly disclosed in the second reference, just to increase speed.⁵⁹ And, according to the PTAB, even if an ordinary artisan considered the teachings in the secondary reference, the petitioner’s proposed modifications based on them would not have affected the processing time of the system disclosed in the primary reference.⁶⁰

At oral argument, the Petitioner advanced another theory for combining the two references, suggesting the teachings of the second reference could easily be merged with the teachings of the first reference, i.e., the two could be combined in a “plug-and-play” fashion.⁶¹ The PTAB rejected this argument as well. It reasoned that even if the two references could easily be combined, that is not a reason that would motivate an ordinary artisan to combine them. Instead, the PTAB explained, that rationale is a statement of anticipated success in the proposed combination, not a motivation to make the combination in the first place.⁶² In other words, the fact that the combination could have been successful does not show a skilled artisan’s motivation to actually make the combination.⁶³

In view of these findings, among others, the PTAB concluded that the petitioner had not stated a persuasive reason for combining its proposed prior art references, and

thus had not established that the challenged claims were obvious.⁶⁴ *Hulu II* is designated as informative, not precedential (like *Hulu I*), and simply provides guidance to a panel that it may or may not be persuaded by. However, by designating *Hulu II*, the PTAB is suggesting a heightened scrutiny of proposed obviousness combinations and asserted rationales, especially those addressing motivations to combine references. Thus, petitioners should specifically address not only where each claim element can be found in the asserted prior art but also why and how an ordinary artisan would have been motivated to combine the teachings with a reasonable expectation of success. General allegations that an artisan would (or could) combine references, even if those references teach all claim elements, may not be sufficient for the PTAB to institute review.⁶⁵

Johns Manville — Merely showing references are analogous may not be sufficient to show a motivation to combine

On the same day that *Hulu II* was designated informative, the PTAB also designated *Johns Manville*, another case addressing the issue of combining prior art references.⁶⁶ *Johns Manville* challenged claims in a patent owned by Knauf directed to various thermosetting chemical binders used in various fabrication applications, as well as the materials made with those binders.⁶⁷ One ground alleged that the challenged claims were obvious over a combination of two references.⁶⁸ Each of the two references disclosed a binder composition comprised of the same subcomponents but in different amounts.⁶⁹ The petition alleged that the two references were analogous and, because they were, an ordinary artisan would have been motivated to combine them.⁷⁰ The PTAB disagreed. In doing so, the PTAB recognised that the two references may be analogous art, but explained that is merely a threshold inquiry assessing whether a reference could be considered in an obviousness analysis.⁷¹ Without more, a demonstration that two references are analogous or compatible is not enough to show that a skilled artisan would have had a reason to combine them.⁷² That is, “mere compatibility of the references” is not sufficient.⁷³

The petitioner also argued that both references were useful as a thermosetting composition, and thus that a skilled artisan would select teachings from the compositions and methods disclosed in each to reach the composition claimed in the challenged patent.⁷⁴ The PTAB again disagreed and focused on the different utilities the two references disclosed. The PTAB found that the first reference explained its composition was useful in the context of creating a fiberglass insulation product and the second reference explained that its composition was useful in the context of making shell molds or cores.⁷⁵ According to the PTAB, the petitioner’s argument assumed that the thermoset binder disclosed in the second reference would be useful in the fiberglass insulation context. But the PTAB found the petitioner failed to support this modification in part because the objective of each reference was distinct.⁷⁶ Instead, the PTAB considered the references to teach “considerably

Notes and references

- 1 Editor's note
2. *Compare, e.g., SkyHawke Techs., LLC v L&H Concepts, LLC*, IPR 2014-01485 (Mar. 20, 2015) (Paper 13) (denying joinder to a petitioner's second petition, concluding that only a person who is not already a party to the proceeding could be joined under 35 §315(c) with *Zhongshan Broad Ocean Motor Co., Ltd. v Nidec Motor Corp.*, IPR2015-00762 (October 5, 2015) (Paper 16) (allowing joinder of a new issue by the same party under §315(c)).
3. PTAB Standard Operating Procedure 2 (Revision 10), p. 3.
4. *Id.* at 3–4.
5. *Id.*
6. *Id.* at 10–11.
7. *Id.* at 9, 11.
8. *Id.* at 9.
9. *Id.* at 10.
10. *Id.* at 11 n.4.
11. *Id.* at 5–6.
12. *Id.* at 10–11.
13. Previously designated decisions can also be through its rule making procedures.
14. “PTAB de-designates Idle Free and Master Image and designates new informative order providing guidance on motions to amend,” USPTO (1 June 2018), <https://content.govdelivery.com/accounts/USPTO/bulletins/1f442f5>.
15. Case IPR2015-00040 (PTAB July 15, 2015) (Paper 42).
16. Case IPR2012-00027 (June 11, 2013) (Paper 26).
17. 872 F.3d 1290 (Fed. Cir. 2017).
18. *Precedential and informative decisions*, USPTO, www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/precedential-informative-decisions.
19. *See, e.g., Johns Manville Corp. v Knauf Insulation, Inc.*, IPR2018-00827, Paper 9 (Oct. 16, 2018) (informative); *Hulu, LLC v Sound View Innovations, LLC*, IPR2018-00582, Paper 34 (Aug. 5, 2019) (informative).
20. *Becton, Dickinson & Co. v B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017) (precedential; interpreting AIA §325(d)).
21. *General Plastic Industrial Co., Ltd. v Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017) (precedential, interpreting AIA §314(a)).
22. *Focal Therapeutics, Inc. v SenoRx, Inc.*, IPR2014-00116, Paper 19 (July 21, 2014) (precedential; interpreting AIA §316(a) (5)); *Adello Biologics LLC v Amgen Inc.*, PGR2019-00001, Paper 11 (Feb. 14, 2019) – precedential; interpreting AIA §322(a)(2).
23. *Infiltrator Water Techs., LLC v Presby Patent Trust*, IPR2018-00224, Paper 25 (Oct. 1, 2018) (precedential), interpreting AIA §315(b)); *Cisco Sys., Inc. v Chrimar Sys., Inc.*, IPR2018-01511, Paper 11 (Jan. 31, 2019) (precedential, interpreting AIA §315(b)).
24. *Thryv, Inc. v Click-To-Call Techs., LP*, No. 18-916 (OT 2019) (oral argument heard Dec. 9, 2019).
25. *See, e.g., Intel Corp. v Alacritech, Inc.*, IPR2017-01402, Paper 8 (Nov. 6, 2017).
26. *See, e.g., Universal Remote Control, Inc. v Universal Elecs., Inc.*, IPR2013-00127 (Jul. 16, 2013) (Paper 13).
27. *See, e.g., CIM Maint. Inc. v P&RO Sols. Grp., Inc.*, IPR2017-00516 (Jun. 22, 2017) (Paper 8).
28. *See, e.g., Provepharm Inc. v Wista Laboratories Ltd.*, IPR2018-00182 (Jul. 5, 2018) (Paper 16).
29. *See, e.g., Microsoft Corp v Corel Software, LLC*, IPR2016-01300 (Jan. 4, 2017) (Paper 13).
30. *Hulu, LLC v Soundview Innovations LLC*, IPR2018-01039 (May 8, 2018) (Paper 1).
31. *Hulu, LLC v Soundview Innovations LLC*, IPR2018-01039 (Dec. 3, 2018) (Paper 12).
32. *Id.*
33. 35 U.S.C. §314.
34. *Hulu, LLC v Soundview Innovations LLC*, IPR2018-01039 (Apr. 3, 2019) (Paper 15).
35. *Id.* at 2.
36. *Id.*
37. *Id.*
38. *Id.* at 13.
39. *Id.*
40. *Hulu, LLC v Soundview Innovations LLC*, IPR2018-01039, Paper 29, at 12 (Dec. 20, 2019).
41. *Id.* at 13–14.
42. *Id.*
43. *Id.* at 13–14.
44. *Id.* at 15.
45. *Id.* at 14–15.
46. *Id.* at 16.
47. *Id.*
48. *Id.* at 17.
49. *Id.*
50. *Id.*
51. *Id.* at 17–19.
52. *Id.* at 19–20.
53. 35 U.S.C. §324(a).
54. *See, e.g., 77 Fed. Reg. 48680, 48702, Response to Comment 59* (Aug. 14, 2012).
55. *Hulu, LLC v Sound View Innovations, LLC*, IPR2018-00582 (Aug. 5, 2019) (Paper 34).
56. *Id.* at 9–11.
57. *Id.* at 11–12.
58. *Hulu, LLC v Sound View Innovations, LLC*, IPR2018-00582, at 16–17.
59. *Id.* at 17.
60. *Id.* at 17–18.
61. *Id.* at 22.
62. *Id.*
63. *Id.* at 22.
64. *Id.* at 32.
65. *Precedential and informative decisions*, USPTO, www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/precedential-informative-decisions.
66. *Johns Manville Corp. v Knauf Insulation, Inc.*, IPR2018-00827 (Oct. 16, 2018), Paper 9.
67. *Id.* at 4.
68. *Id.* at 9.
69. *Id.* at 9–10.
70. *Id.*
71. *Id.* at 10–11.
72. *Id.*
73. *Id.*
74. *Id.* at 11.
75. *Id.* at 11–12.
76. *Id.*
77. *Id.* at 12.
78. *Id.* at 14–16.
79. *Id.* at 14–16.
80. *Id.* at 18–19.
81. *Id.* at 19–21.
82. In addition to *Hulu I*, the POP addressed joinder in *Proppant Express Invs., LLC v Oren Techs. LLC.*, Paper 86 (P.T.A.B. Feb. 13, 2019) and serial challenges in *Valve Corp. v Electronic Scripting Prods.*, IPR2019-00062, Paper 10 (P.T.A.B. May 1, 2019).
83. *Hunting Titan, Inc. v Dynaenergetics GmbH & Co. KG*, IPR2018-00600, Paper 46 (P.T.A.B. Nov. 7, 2019); *see also* “POP Review Granted – Proceedings,” USPTO, www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/precedential-opinion-panel.

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different” systems for chemical binding that the petitioner did not adequately address.⁷⁷ Without more explanation or a deeper rationale for making the proposed combination, the PTAB found the petition did not sufficiently show how or why an ordinary artisan would combine teachings from the different references.

In the remaining grounds of its petition, the petitioner selected disclosures from various prior art references and matched them to the limitations of the challenged patent.⁷⁸ The PTAB also found this approach deficient. Each of the petitioner’s prior art references were directed to different objectives and were useful in different contexts.⁷⁹ The PTAB found that the petitioner’s assumption that all thermoset binders were useful in the same context was unsupported, and the petitioner’s limited additional reasons for combining these references were not enough to show an ordinary artisan would have actually combined them.⁸⁰

Overall, the PTAB credited the petitioner with showing the references were analogous art, and further showing that an ordinary artisan *could* have combined them — but the PTAB concluded that the petitioner did not sufficiently show that an ordinary artisan *would* have combined them.⁸¹ By designating this decision, along with *Hulu II*, the PTAB is suggesting that it is looking for more detailed analysis of the prior art and asserted obviousness grounds in a petition. And a petitioner’s basic argument that merely suggests two or more references could be combined runs the risk that the PTAB may risk a decision denying institution (like in *John Mansfield*) or a finding that the claims are not unpatentable (like in *Hulu II*). In other words, merely identifying the different claim elements in (analogous or even closely related) prior art may not be enough to show how or why an ordinary artisan would have combined their teachings to meet the claims. Going forward, petitioners should consider providing detailed and thorough analysis of the asserted references and making specific arguments about why an ordinary artisan not only *could* but *would* have combined the asserted references.

Conclusion

Since 2018, the PTAB has designated 36 decisions as either precedential or informative. In only its first full calendar year of existence, the POP has already heard three cases⁸² and is currently hearing another relating to the PTAB’s role in evaluating substitute claims proposed in motions to amend.⁸³ Many practitioners expect the PTAB, through the POP and other methods, to continue designating decisions as precedential or informative as part of its continued effort to increase consistency in PTAB practice. Stay tuned as we continue to follow the ever-evolving practice before the PTAB and share updates. [D](#)

Brooke Wilner is an Associate in the Atlanta office and Tim McNulty a Partner in the Washington, DC office of Finnegan.