

PTAB Strategies and Insights

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The PTAB Strategies and Insights newsletter provides quarterly updates and insights into how best to handle PTAB trial proceedings at the USPTO. It is designed to increase return on investment for all stakeholders looking at the entire patent life cycle in a global portfolio.

In this issue, we address collateral estoppel, expert qualifications, and provide some case highlights of recent PTAB precedential and Director review decisions.

We welcome feedback and suggestions about this newsletter to ensure we are meeting the needs and expectations of our readers. So if you have topics you wish to see explored within an issue of the newsletter, please reach out to us.

Finally, we want to thank outgoing Editor [Jason D. Eisenberg](#) for his service as editor of this newsletter for the past several years.

Kind Regards,



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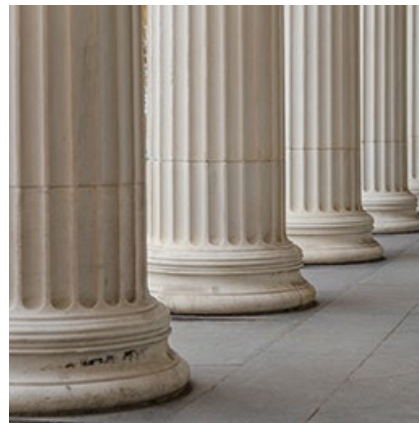
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Beware of Collateral Estoppel at the PTAB

By: [Ivy Attenborough](#) and [Jason A. Fitzsimmons](#)

When thinking about estoppel and the PTAB, the § 315(e) estoppels—relating to grounds a petitioner raised or reasonably could have raised—are likely the first to come to mind. However, other types of estoppel, such as collateral estoppel, also can apply to IPR proceedings.[1] The Federal Circuit recently issued a precedential opinion holding that collateral estoppel may apply to unpatentability findings for claims in different, related patents, when they share identical issue(s) of patentability and the other requirements for collateral estoppel are present.[2]



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Kyocera and the Brewing Debate Over Expert Qualifications at the PTAB

By: [David Haars](#) and [Dan Block](#)

Technical experts play a key role in patent litigation, including in PTAB litigation. Indeed, experts are often the only witnesses to provide testimony in PTAB proceedings, and final written decisions often hinge on which party's expert the PTAB panel finds more credible. This article explores recent developments in the required qualifications of a technical expert and an important, unresolved question: to qualify as a technical expert and provide opinions from the perspective of a skilled artisan, is the expert required to have possessed ordinary skill **at the time of the invention?**

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CASE HIGHLIGHTS

PTAB Precedential and Informative Decisions, Director Review Decisions, and Precedential Opinion Panel Decisions

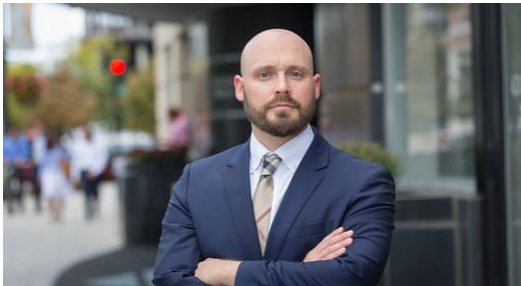
By: [Jennifer Meyer Chagnon](#)

This recurring feature highlights any new PTAB precedential and/or informative decisions, any new substantive Director review decisions, and any new substantive decisions issued by the Precedential Opinion Panel (POP). The current issue includes decisions entered (or designated as precedential) between January 1, 2023 and March 31, 2023.



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