



Withholding Data That PTAB Would Deem Relevant to Patentability Supports Adverse Judgment in an IPR

July 19, 2023

Reading Time : **2 min**

By: Karina J. Moy, Jason Weil, Rubén H. Muñoz

The Patent Trial and Appeal Board (PTAB) granted Petitioner's motions to sanction Patent Owner for failure to meet its duty of candor and fair dealing in five related *inter partes* review proceedings. The PTAB found that Patent Owner had improperly withheld the results of scientific testing that was material to the challenged patent claims.

The challenged patents relate to methods and compositions for killing pathogens and isolating populations of nucleic acids from biological samples. In its decisions to institute *inter partes* review, the PTAB rejected what it considered Patent Owner's overly narrow construction of the terms "kill pathogens" and "not degrade nucleic acids," construing each term to have its plain meaning. In the patent owner response and motion to amend, patent owner relied on test data and its proposed constructions to argue that the primary prior art reference did not anticipate the challenged claims.

Petitioner deposed Patent Owner's testing witnesses, but Patent Owner instructed those witnesses not to answer questions about undisclosed testing on the basis of attorney work product protection. Petitioner disagreed with Patent Owner's instruction that such underlying data were protected, and the parties held a conference call with the PTAB. The PTAB authorized additional briefing on the issue and ultimately ordered limited additional discovery, including production of any relevant inconsistent experimental results and additional deposition time for questioning about undisclosed testing. Petitioner discovered that Patent Owner had withheld data related to additional testing from the same time period that contradicted the testing on which Patent Owner had relied.

The PTAB issued a final written decision finding the challenged claims unpatentable and, on the same day, issued an order granting the sanction of **judgment in the trial** as to all challenged claims in the five IPRs. The PTAB explained that it was improper for Patent Owner to rely on its proposed (narrow) claim construction to limit the scope of its obligatory disclosures to the Office and Petitioner. Although the PTAB's claim construction in its institution decision was preliminary, the PTAB clearly indicated the scope of what it deemed relevant to patentability in these proceedings. And ultimately, the PTAB found that the testing was relevant under either construction. By withholding these results until compelled by the Board, the Patent Owner had failed to comply with its duty of candor and good faith. However, the Board stopped short of ordering Patent Owner to compensate Petitioner, including by paying attorney fees. The Board reasoned that invalidation of the challenged claims would sufficiently deter such misconduct, while a monetary penalty would not.

On June 12, 2023, in each of the five IPR proceedings, the Director granted *sua sponte* review of both the Board's final written decision and the order granting sanctions. As of the writing of this article, Director review remains pending.

Practice Tip: The duty of candor in a PTAB proceeding requires a party to disclose data that are material to patentability. At a minimum, this includes data that a party might consider not relevant under its own theory of the case, but that could be relevant under a broader theory of patentability, particularly where the PTAB's institution decision expressly contemplates such a broader scope.

Spectrum Solutions LLC v. Longhorn Vaccines & Diagnostics, LLC, IPR2021-00847, Paper 107, IPR2021-00850, Paper 111, IPR2021-00854, Paper 110, IPR2021-00857, Paper 108, IPR2021-00860, Paper 109 (PTAB May 3, 2023).

Categories

Patent Trial & Appeal Board

Inter Partes Review

Patent Litigation

Patentability

© 2025 Akin Gump Strauss Hauer & Feld LLP. All rights reserved. Attorney advertising. This document is distributed for informational use only; it does not constitute legal advice and should not be used as such. Prior results do not guarantee a similar outcome. Akin is the practicing name of Akin Gump LLP, a New York limited liability partnership authorized and regulated by the Solicitors Regulation Authority under number 267321. A list of the partners is available for inspection at Eighth Floor, Ten Bishops Square, London E1 6EG. For more information about Akin Gump LLP, Akin Gump Strauss Hauer & Feld LLP and other associated entities under which the Akin Gump network operates worldwide, please see our Legal Notices page.