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Federal Circuit to PTAB: No Short Cuts Allowed

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Today, the Federal Circuit, vacated-in-part and remanded the Patent Trial and Appeal Board's obviousness determination regarding a Securus Technologies patent directed to systems and methods for reviewing conversation data for certain events and bookmarking portions of the recording when something of interest is said, finding that the Board failed to provide any explanation for its decision with respect to certain challenged claims.

*Securus Techs., Inc. v. Global Tel*Link Corp.* (Appeal Nos. 2016-1992 and -1993) involved the appeal of two *inter partes* review ("IPR") proceedings initiated by Global Tel*Link Corp. against Securus Technologies, Inc.'s U.S. Patent No. 7,860,222 (the "'222 Patent"). The Board issued a Final Written Decision in both IPRs, finding all claims of the '222 Patent unpatentable as obvious over the cited prior art references. In finding some of the dependent claims to be obvious, the Board provided only a generic sentence: "After consideration of the language recited in the [the claims], the Petition, the Patent Owner Response, and the Petitioner's Reply, as well as the relevant evidence discussed in

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those papers, we find that one of ordinary skill in the art [“POSITA”] would have considered these dependent claims obvious over [the asserted art].” Slip Op. at 5-6.

On appeal, Securus argued, among other things, that the Board failed to articulate any reason supporting its decision that certain dependent claims were unpatentable. The Federal Circuit agreed.

The Court first reiterated that the Board must “make the necessary findings and have an adequate evidentiary basis for its findings” and “examine the relevant data and articulate a satisfactory explanation for its action including a rational connection between the facts found and the choice made.” Slip Op. at 13-14 (internal citations omitted). While perfect explanations are not required, “it is not adequate to summarize and reject arguments without explaining why the [Board] accepts the prevailing argument.” *Id.* at 14. That is, the “Board must provide some reasoned basis for finding the claims obvious in order to permit meaningful review by this court.” *Id.* As such, the Federal Circuit held that the Board’s failure to provide *any* reasoning for its decision that certain dependent claims were unpatentable was insufficient and, therefore, remanded the case for further proceedings.

This case highlights the importance of the Board to adequately explain its findings. Practitioners should take extra care in reviewing decisions by the Board in post-grant review proceedings to ensure all of the Board’s findings are adequately explained, as a failure by the Board to provide adequate explanations could create an issue ripe for appeal.

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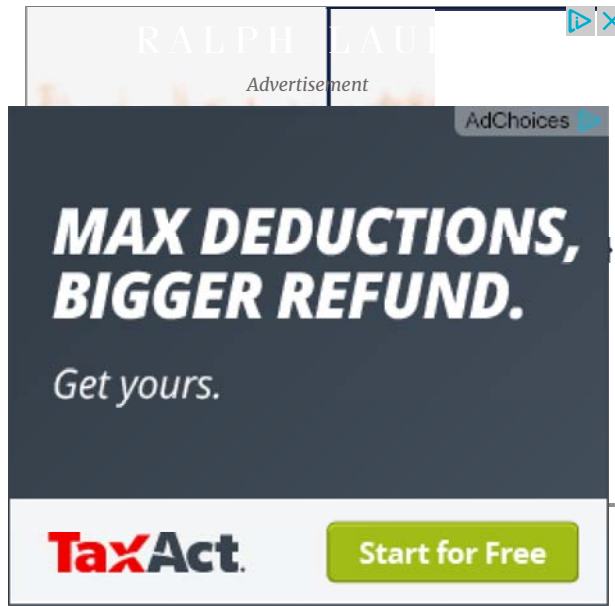
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