

PTAB May Disregard New Evidence Presented at Oral Argument

Wednesday, April 25, 2018

The US Court of Appeals for the Federal Circuit concluded that the Patent Trial and Appeal Board (PTAB) is not required to consider evidence presented for the first time at oral argument in an *inter partes* review (IPR). *Dell Inc. v. Accelaron, LLC*, Case No. 17-1101 (Fed. Cir., Mar. 19, 2018) (Reyna, J).

This appeal concerned a challenged claim of Accelaron's patent, which is directed to a computer network appliance that includes caddies, which provide air flow in the chassis. Dell contended that a prior art reference disclosed the claimed caddies, but Accelaron responded that the reference disclosed, at most, a single caddy, while the claim required plural caddies to be provided. At oral argument, Dell raised a novel argument equating the slides in the chassis with the claimed caddies. Accelaron objected that Dell's argument was not timely raised, but the PTAB denied Accelaron's objection. In its final written decision, the PTAB found the challenged claim unpatentable, relying on Dell's argument regarding the slides in the chassis.

Accelaron appealed, arguing that the PTAB violated the Administrative Procedures Act (APA) by not giving Accelaron a fair opportunity to respond to Dell's novel "slides" argument. The Federal Circuit agreed with Accelaron that the PTAB had violated the APA, and vacated the PTAB's cancellation of the challenged claim, remanding the case to the PTAB. On remand, the PTAB decided not to consider the slides argument because it was new and non-responsive to Accelaron's response. This time, the PTAB found the challenged claim to not be anticipated by the prior art reference. Dell appealed.

Dell argued that the PTAB should have considered the slides argument and provided Accelaron an opportunity to address the argument, but the Federal Circuit disagreed. The Court's remand order in the first appeal only set out the requisite procedure that would be applied had the PTAB actually considered Dell's new evidence. Dell further argued that ignoring evidence of unpatentability is against public policy, but the Court concluded that due process and preserving the PTAB's discretion outweigh any negative effects of not invalidating a patent claim.

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