

Patent Trial and Appeal Board - Multi-Petition Challenges of a Patent

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Background – Multiple Petitions

Multiple Petition Filings in PTAB Trials (IPR/PGR/CBM)

- The statutes for IPR, PGR and CBM do not provide many limits on filing of petitions
 - Numerous patents have been challenged by more than one petition, sometimes filed by the same petitioner
 - The USPTO has provided examples where multiple petitions can be filed. Fed. Reg. 77, 48612 at 48635 (Sep. 2012)
- In practice, the Board’s decisions in multiple petition cases vary significantly

Multi-Petition Strategies

-Why would Petitioner file multiple petitions against the same patent?

- Responsive to prior adverse Board institution decision
- Extend page limit/increase number of challenges
- Challenge additional claims
- Assert newly discovered art
- Seek joinder with earlier petition

-What concerns do Patent Owners have?

- Clarity on number of challenges and timing
- Taking positions in early proceeding that could be used against them in later proceedings

Statistics

Number of Patents Challenged by Secondary Petition

-1282 total patents challenged in IPR

-307 (24%) patents subject to multiple petitions

-224 (17%) patents subject to multiple petitions by same petitioner

Number of Secondary Petitions Filed

-1,842 total IPR petitions filed

-560 (30%) were secondary (2nd, 3rd, etc.) petition on same patent

-344 (19%) were secondary petition by same petitioner

PTAB: The Statute Addresses Multiple Petitions

35 U.S.C. § 325(d):

“In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”

Informative Decisions on 35 U.S.C. § 325(d)

- September 2014: the Board designated *seven* decisions as **Informative Opinions** interpreting 35 U.S.C. § 325(d)
- “Informative opinions and orders are not binding, but illustrate norms of Board decision-making for the public, the patent examining corps, and future Board panels. Informative opinions and orders may explain best practices, address recurring problems . . .”

–OG Notice 23 January 2007

Seven Informative Decisions

- All seven were denials of petition based on Board's invocation of 35 U.S.C. § 325(d)
- Five of the seven decisions were denials of later-filed petitions to same petitioner
- Intelligent BioSystems v. Illumina*: Petitioner described prior art reference in second petition using “exactly the same language” used to describe prior art references in prior granted petition. IPR2013-00324, Paper 19 at 6
- Medtronic v. Nuvasive*: Denying petition because petition cited the same art from prior petition, and proposed challenges were “nearly identical” to the prior petition. IPR2014-00487, Paper 8 at 6

Seven Informative Decisions

- *Medtronic v. Bosch Healthcare Systems* : Denying later petition with “substantial overlap” of arguments and prior art as prior petition earlier petitioner that was acquired by later petitioner. IPR2014-00436, Paper 17 at 11-12
- *Unilever v. Procter & Gamble*: “no argument or evidence that the seven newly cited references were not known or available to it at the time of filing the [first petition].” IPR2014-00506, Paper 17 at 6
- *ZTE Corp. v. ContentGuard Holdings*: “should not act as an entry ticket, and a how-to guide, for the same Petitioner who filed an unsuccessful” petition IPR2013-00454, Paper 12 at 6

Subsequent Decisions

- Numerous subsequent decisions have considered 35 U.S.C. § 325(d):
 - However, at least *six* decisions declined to invoke 35 U.S.C. § 325(d)
 - One decision addressed the Patent Owner's citation to an Informative Decision (*Medtronic, Inc., v. NuVasive, Inc.*, Case IPR2014-00487):

Subsequent Decisions

“The citation of a single case does not demonstrate what the Board has consistently held. Also, the case cited is **not precedential** and does not set forth a ‘requirement’ that a petitioner must explain adequately why a follow-on petition is not redundant . . . there is no per se rule that a Petitioner must demonstrate how the Petition is not redundant to any prior art and argument presented to the Office. Rather, 35 U.S.C. § 325(d) is **discretionary**, stating only that the Board ‘may’ consider whether the same or substantially the same prior art or arguments were previously presented to the Office.” - *Valeo North America, Inc. v. Magna Electronics, Inc.*, IPR2014-01208, Paper 13 at 13 (emphasis added).

Joinder Decision for Same Petitioner

- 35 U.S.C. § 315(b) bars institution of IPR when petition is filed >1 year after service of complaint alleging infringement
- 35 U.S.C. § 315(c) Permits IPR petition filed after the 1-year statutory bar to be joined to earlier IPR
- *Target Corp. v. Destination Maternity Corp.*, Case No. IPR2014-00508, Paper 18
 - Enlarged panel, 3:2 split
 - Majority: 35 U.S.C. § 315(c) does not permit a petitioner to join their own earlier petition
 - Decision is not precedential, inconsistent decisions persist

What have we learned

- No absolute guidance for knowing when 35 U.S.C. § 325(d) will be invoked
- Factors:
 - Same/different:
 - Claims
 - Petitioner
 - Prior Art
 - Declarant
 - Explanation of difference from previous/other petition
 - Petition filed after one-year period (requiring joinder)

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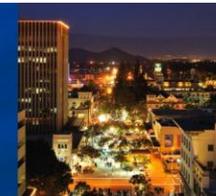
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