

Post-Grant for Practitioners

The PTAB's Discretion under 35 U.S.C. § 325(d)

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- II. Statistics
- III. The PTAB's Discretion
 - Prevent a Second Bite at the Apple
 - Require a "New" Challenge
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- IV. Post-Grant Resources



Overview of Webinar Series

Overview

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- Where? ... see invitation
- How often? ... monthly
- When? ... 2nd Wednesday
- Topics? ...
 - Important decisions
 - Developments
 - Practice tips
- Housekeeping
 - CLE
 - Questions
 - Materials
 - <http://fishpostgrant.com/webinars/>

The screenshot shows the website for Fish & Richardson's Post-Grant for Practitioners. The main heading is "Stays, Finality, and Estoppel – Timing a Post-Grant Attack to Maximize Litigation Benefit". Below this, there is a brief description of the topic, a "Register" button, and the date and time of the webinar: Wednesday, November 12, 2014, from 1:00 PM to 2:00 PM ET. The speakers listed are Dorothy Whelan, Neil Banner, and James Donohue. At the bottom, there are social media icons for email, a clock, LinkedIn, and Twitter, each with a short description of the service.

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Stays, Finality, and Estoppel – Timing a Post-Grant Attack to Maximize Litigation Benefit


PTSD proceedings almost always involve concurrent litigation. The interplay between PTSD proceedings and district court litigation can be complex, and various strategic objectives can be achieved through a PTSD challenge. Join us as we discuss how timing of a PTSD proceeding impacts concurrent litigation.


[Backlog](#) now for the next program in our Post-Grant for Practitioners webinar series.

Wednesday, November 12, 2014
1:00 PM - 2:00 PM ET
Via the web

Speakers:

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REGISTER


Fish & Richardson will apply for 1.0 hour of general CLE credit in most states. If you would like to receive CLE credit, register with your state bar information.

If you have questions, please contact Emma Brown at ebrown@fishr.com.

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 View webinar replays from our Post-Grant for Practitioners series.

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- IPR's Filed?
 - **2,323** filed through January 8, 2015
 - **177** filed in December 2014
 - Many more than the PTO expected. See General Administrative Trial Final Rules, 77 Fed. Reg. 48612, 48651 (Aug. 14, 2012) (estimating receipt of 470 and 510 AIA petitions in FY 2013 and 2014, respectively)
- Application of Threshold: Reasonable Likelihood of Success
 - IPR continues to be instituted in most petitions evaluated (76% in 2014 v. 87% in 2013)
 - In many cases, however, IPR was ordered on only a subset of the grounds requested

Statistics (CBM)

- CBM's Filed?
 - **279** filed through January 8, 2015
 - **15** filed in December 2014
- Application of Threshold: More Likely Than Not
 - CBM also instituted in vast majority of Petitions evaluated (72% for 2014 v. 82% for 2013)
 - Here too, CBM is often ordered on only a subset of petitioned grounds and/or claims

Statistics (Final Written Decisions)

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- FWD's on the Merits Issued So Far
 - IPR: **200** through January 8, 2015
 - CBM: **27** through January 8, 2015
- Most have found all challenged claims unpatentable
- Two motions to amend claims granted to date



The PTAB's Discretion

- PTAB has interpreted the statutes and rules as giving it broad discretion as to whether to institute *inter partes* review
- 35 U.S.C. § 314(a) provides that the Director may not institute an IPR unless certain conditions are met
 - “The Director may not authorize an inter partes review to be instituted unless the Director determines that . . . there is a reasonable likelihood that the petitioner would prevail”

The PTAB's Discretion

- 35 U.S.C. § 325(d) provides a specific grant of discretion
 - “[T]he 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.”
- Seven informative opinions were posted by PTAB in September
 - <http://www.uspto.gov/ip/boards/bpai/decisions/inform/>
- Each one denies a petition for *inter partes* review under 35 U.S.C. § 325(d)

Three categories:

1. Prevent a second bite at the apple
2. Require a “new” challenge
3. Control the number of proceedings



Prevent a Second Bite at the Apple

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Prevent a Second Bite at the Apple

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- ZTE Corp. v. ContentGuard Holdings, Inc., Paper 12, No. IPR2013-00454 (25 September 2013)
- Unilever, Inc. v. Procter & Gamble Co., Paper 17, No. IPR2014-00506 (7 July 2014)
- Medtronic, Inc. v. Nuvasive, Inc., Paper 8, No. IPR2014-00487 (11 September 2014)

Prevent a Second Bite at the Apple

- In each case, the petitioner:
 - Failed to obtain institution for certain grounds in first petition
 - Relied on same primary reference(s) used in first petition
 - Added new evidence or prior art to specifically address the failings in the prior petition

- ZTE Corp. v. ContentGuard Holdings, Inc., Paper 12, No. IPR2013-00454 (25 September 2013)
 - “The Board is concerned about encouraging, unnecessarily, the filing of petitions which are partially inadequate. A decision to institute review on some claims should not act as an entry ticket, and a how-to guide, for the same Petitioner . . . for filing a second petition to challenge those claims which it unsuccessfully challenged in the first petition.”

Prevent a Second Bite at the Apple

- **Unilever, Inc. v. Procter & Gamble Co., Paper 17, No. IPR2014-00506 (7 July 2014)**
 - “Based on the information presented, we are persuaded that the instant Petition uses our prior Decision on Institution to bolster challenges that were advanced, unsuccessfully, in the [prior] Petition.”
- **Medtronic, Inc. v. Nuvasive, Inc., Paper 8, No. IPR2014-00487 (11 September 2014)**
 - “According to Petitioner, it is responding to ‘a noted deficiency,’ and is providing new evidence and argument as to how the previously supplied prior art renders the challenged claims obvious.”

Prevent a Second Bite at the Apple

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- Takeaway/Observations
 - Petitioner
 - Patent Owner



Require a “New” Challenge

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Require a “New” Challenge

- Prism Pharma Co., Ltd. v. Choongwae Pharma Corp., Paper 14, No. IPR2014-00315 (8 July 2014)
 - During original prosecution, petitioner sent patentee a declaration
 - Declaration alleged that the pending claims failed to meet the written description requirement and, as a result, were anticipated by an intervening reference
 - Patentee submitted the declaration and reference to the examiner
 - Examiner rejected the claim as lacking written description support

Require a “New” Challenge

- Prism Pharma Co., Ltd. v. Choongwae Pharma Corp., Paper 14, No. IPR2014-00315 (8 July 2014)
 - Patentee amended and submitted its own declaration explaining the written description support for the amended claims
 - Examiner withdrew the rejection and allowed the claims
 - Petition alleged the claims lacked written description support and were therefore invalid over the same reference
 - PTAB denied the petition because the same prior art and substantially the same arguments (lack of written description) formed the basis of the petition

Require a “New” Challenge

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- Takeaway/Observations
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Control the Number of Proceedings

Control the Number of Proceedings

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- Intelligent Bio-Systems, Inc. v. Illumina Cambridge Limited, Paper 19, No. IPR2013-00324 (21 November 2013)
- Medtronic, Inc. v. Robert Bosch Healthcare Systems, Inc., Paper 17, No. IPR2014-00436 (19 June 2014)
- Unified Patents, Inc. v. PersonalWeb Techs., LLC, Paper 13, No. IPR2014-00702 (24 July 2014)

Control the Number of Proceedings

- Intelligent Bio-Systems, Inc. v. Illumina Cambridge Limited, Paper 19, No. IPR2013-00324 (21 November 2013)
 - All grounds of first petition granted
 - Second petition simply swaps the primary reference with another primary reference
 - PTAB denied second petition because:
 - The petitioner did not provide “any justification for filing the instant petition, other than its representation that it became aware of the [new primary reference] after the filing of the [first petition]” and
 - The petitioner would be able to address the new primary reference in the first proceeding in response to a motion to amend

- Medtronic, Inc. v. Robert Bosch Healthcare Systems, Inc., Paper 17, No. IPR2014-00436 (19 June 2014)
 - Cardiocom filed a first petition and review was instituted for certain claims
 - Medtronic later acquired Cardiocom
 - Medtronic filed a second petition that requested review of instituted claims
 - Two of the three total references in the second petition were the same as the first petition but used in different combinations
 - PTAB denied institution on already instituted claims because:
 - Two of three references were the same and were used in the same way
 - No justification was provided for the second petition
 - Medtronic was a real party-in-interest in the prior proceeding and was involved in that proceeding

Control the Number of Proceedings

- Unified Patents, Inc. v. PersonalWeb Techs., LLC, Paper 13, No. IPR2014-00702 (24 July 2014)
 - Two prior petitions filed by third parties
 - First of those on appeal to Fed. Cir. based on a finding that all challenged claims are unpatentable
 - Second petition granted on same art grounds but with an additional, dependent claim
 - Current petition was the same as the second petition and sought joinder
 - PTAB denied institution because:
 - All but one challenged claim had been found unpatentable based on the same grounds and that decision was on appeal to the Fed. Cir.
 - All of the challenged claims were the subject of an instituted proceeding on the same grounds

- Unified Patents, Inc. v. PersonalWeb Techs., LLC, Paper 13, No. IPR2014-00702 (24 July 2014)
 - Some additional factors seem to be at play
 - Petitioner is “a first-of-its-kind company whose sole purpose is to deter NPE litigation”
 - Patent Owner indicated it would seek additional discovery into real party-in-interest issues
 - There were other instituted IPRs for related patents and the various schedules were coordinated

Control the Number of Proceedings

- Takeaway/Observations
 - Petitioner
 - Patent Owner

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Post-Grant Resources

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- In Fish & Richardson’s initial 7-part webinar series titled “Challenging Patent Validity in the USPTO,” we explored details regarding several of the post grant tools, with 3 sessions dedicated to Inter Partes Review (IPR), and a final session walking through several hypotheticals, to help listeners understand how these apply to common situations.
- Audio and slides for these webinars are posted online at:
<http://fishpostgrant.com/webinars/>
- If you listen to these webinars, you will be well positioned to engage in a conversation over whether and when to use those tools and how to defend against them.

- F&R web sites:
 - Post-Grant for Practitioners: <http://fishpostgrant.com/webinars/>
 - General: <http://fishpostgrant.com/>
 - IPR: <http://fishpostgrant.com/inter-partes-review/>
 - PGR: <http://fishpostgrant.com/post-grant-review/>
 - Rules governing post-grant: <http://fishpostgrant.com/>
 - Post-Grant App: <http://fishpostgrant.com/app/>
- USPTO sites:
 - AIA Main: http://www.uspto.gov/aia_implementation/index.jsp
 - Inter Partes: http://www.uspto.gov/aia_implementation/bpai.jsp

Thank You!

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