

## 5 Factors To Consider When Filing Multiple Petitions At PTAB

By **Alex Yap and Jean Nguyen** (April 24, 2020, 3:10 PM EDT)

Since the inception of the Leahy-Smith America Invents Act, the Patent Trial and Appeal Board has been refining its approach to handling multiple inter partes review petitions filed on the same claims of a patent.

Most recently, the PTAB's trial practice guide provided guidance on the filing of multiple petitions. While the PTAB generally considers a single petition to be sufficient, it recognizes certain circumstances where multiple petitions may be appropriate. In the past year, for proceedings in which multiple petitions were filed challenging the same patent, the PTAB instituted reviews of at least 50% of those petitions.

Here are five factors to consider when filing multiple petitions to challenge a patent at the PTAB, as well as recent case examples that provide insight into how the trial practice guide will be implemented on multiple petitions in 2020.

### 1. Large Number of Asserted Claims in Litigation

The trial practice guide recognizes that in situations with a large number of asserted claims, it may be appropriate for a petitioner to file multiple petitions. For example, Microsoft Corp. filed a total of five petitions challenging 89 claims of U.S. Patent No. 6,851,115.[1]

The PTAB instituted review of all five petitions challenging the '115 patent. In granting the petitions, the PTAB rejected the patent owner's arguments that the petitions were duplicative or similar to each other.

Instead, the PTAB was persuaded by the petitioner's explanation that filing multiple petitions was justified "because it did not at the time know which claims would be asserted against it in district court and it could not reasonably fit its analysis in fewer petitions." [2] The PTAB also noted that the patent owner did not offer a stipulation that certain claim limitations are not disputed.



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## **2. Disputes Regarding Priority Date**

When there is a dispute over priority date that would require arguments for prior art references that can be antedated and prior art references that cannot, the PTAB recognizes that it may be appropriate to file multiple petitions.

For example, Chegg Inc. filed two petitions on the same day challenging the same claims of U.S. Patent No. 9,978,107.[3] In one petition, the grounds of unpatentability were based on a 102(e) primary prior art reference to inventor Collins, having a priority date that preceded the date of the challenged patent's provisional application by less than three weeks. In the second petition, the priority date of the primary prior art reference to inventor Beaudoin, was more than three years before the patent's provisional application.

The petitioner argued that filing two petitions was appropriate because the patent owner may attempt to antedate Collins. The patent owner, however, argued that having to defend against two petitions created an undue burden and inefficiencies for the PTAB. The PTAB sided with the petitioner, noting that the patent owner had declined to stipulate that the priority dates were not disputed, thus foregoing its opportunity to avoid additional petitions.

By contrast, Rovi Guides Inc. did just that for U.S. Patent No. 9,232,254.[4] Comcast Cable Communications LLC filed three petitions challenging the same claims of the '254 patent using different combinations of prior art references. The petitioner ranked the petitions and argued that the multiple petitions were necessary because the prior art references in the lower ranked petitions cannot be antedated. In response, the patent owner Rovi represented it "will not present an argument in this proceeding to antedate the asserted art." In light of this representation, the PTAB instituted review on only one petition.

Thus, if a petitioner has references that can put the priority date of the challenged patent in play, it should consider filing a separate petition with those references to tee up the priority date issue at the PTAB.

## **3. Independent Claims Having Different Classes of Subject Matter**

When the claims asserted in litigation are independent claims having different classes of subject matter, the petitioners should consider filing multiple petitions. This is exactly what Intel Corp. did. Intel filed a total of three petitions challenging a patent having only 20 total claims, four of which are independent claims.[5]

In granting the three petitions, the PTAB rejected the patent owner's arguments that institution was improper because the trial practice guide stated it is unlikely for three or more petitions to be appropriate. Instead, the PTAB noted that the filing of multiple petitions was appropriate given that each petition is directed to a different independent claim. In other words, the independent claims are

each directed to different classes of subject matter and contain different claim terms and claim construction issues.

This is unlike the situation for the petitioner Comcast, who challenged the same claims of the '254 patent in each of three petitions.[6] Unsurprisingly, the PTAB denied institution of two of the three petitions (i.e., the PTAB instituted on just one of the three petitions). Although each petition involved different prior art, the PTAB reasoned that institution of the petition that “Petitioner prioritized as first for consideration of institution, sufficiently serves the efficient administration of the office, the integrity of the patent system, and the timely completion of proceedings.”

#### **4. Means-Plus-Function Claims**

For patents that contain a large number of means-plus-function claims, practitioners should consider filing two petitions with one addressing solely the means-plus-function claims and the other addressing the remaining claims.

The U.S. Court of Appeals for the Federal Circuit has previously held that because the PTAB has unappealable discretion to institute petitions, it need not institute on post-SAS remand even if it previously found a reasonable likelihood that a petitioner would prevail.[7] Thus, even if a petition has strong grounds that merit institution, but also weaker grounds that do not, the PTAB may deny the entire petition in the interest of administrative efficiency.

This is precisely what happened to Intex for U.S. Patent No. 8,863,771.[8] The PTAB denied institution given the petitioner’s position that “seven of the ten challenged claims [were] not amenable to construction” because these means-plus-function claims were indefinite and could not be construed properly.[9], [10]

The PTAB declined to institute based on the remaining three non-means-plus-function claims because “instituting a trial with respect to all ten challenged claims based on evidence and arguments directed to only three claims would not be an efficient use of the PTAB’s time and resources.”[11]

#### **5. Timing**

If petitioners decide to file multiple petitions, they should do so on the same day. For U.S. Patent No. 6,826,694, the petitioner International Business Machines Corp. filed two petitions five months apart against its sole claim. [12] The PTAB issued a final written decision for the first IPR but exercised its discretion to terminate the second IPR prior to its statutory deadline for the final written decision.

The patent owner argued that the petitioner reasonably could have raised the prior art reference in the second IPR at the time the first IPR was filed. The PTAB agreed, reasoning that because a final written decision had been issued in the first IPR on the challenged claim, the petitioner was estopped from maintaining the second IPR under subsection 315(e)(1).

## Conclusion

As shown, the PTAB has allowed petitioners to file multiple petitions challenging the same patent in a variety of circumstances, such as when a challenged patent involves independent claims with different classes of subject matter or several means-plus-function claims, or when a priority date dispute involves antedated and nonantedated prior art.

When faced with these or similar circumstances, petitioners should consider their options carefully in light of the factors above. Just be sure to file all the petitions on the same day to avoid estoppel claims from the patent owner.

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[1] See Microsoft Corp. v. IPA Tech., Inc., IPR2019-00810, Paper No. 12, (PTAB Oct. 16, 2019); see also IPR2019-00811, Paper No. 12, (PTAB Oct. 16, 2019); see also IPR2019-00812, Paper No. 12, (PTAB Oct. 16, 2019); see also IPR2019-00813, Paper No. 12, (PTAB Oct. 16, 2019); see also IPR2019-00814, Paper No. 12, (PTAB Nov. 6, 2019).

[2] Microsoft Corp. v. IPA Tech., Inc., IPR2019-00810, Paper No. 12 at 12, (PTAB Oct. 16, 2019).

[3] See Chegg, Inc. v. Netsoc, LLC, IPR2019-01165, Paper No. 14, (PTAB Dec. 5, 2019); see also IPR2019-01171, Paper No. 14, (PTAB Dec. 5, 2019).

[4] See Comcast v. Rovi, IPR2019-01413, Paper No. 13, (PTAB Jan. 31, 2020); see also IPR2019-01414, Paper No. 10, (PTAB Jan. 31, 2020); see also IPR2019-01415, Paper No. 10, (PTAB Jan. 31, 2020).

[5] See Intel Corp. v. VLSI Tech., IPR2019-01198, Paper No. 19, (PTAB Feb. 6, 2020); see also IPR2019-01199, Paper No. 19, (PTAB Feb. 6, 2020); see also IPR2019-01200, Paper No. 19, (PTAB Feb. 6, 2020).

[6] See Comcast v. Rovi, IPR2019-01413, Paper No. 13, (PTAB Jan. 31, 2020); see also IPR2019-01414, Paper No. 10, (PTAB Jan. 31, 2020); see also IPR2019-01415, Paper No. 10, (PTAB Jan. 31, 2020).

[7] See BioDelivery Sciences, Int'l v. Aquestive Therapeutics Inc., 935 F.3d 1362 (Fed. Cir. 2019).

[8] See *Intex Recreation Corp. v. Team Worldwide Corp.*, IPR2019-00243, Paper No. 7, (PTAB May 8, 2019); see also IPR2019-00244, Paper No. 7, (PTAB May 8, 2019).

[9] *Intex Recreation Corp. v. Team Worldwide Corp.*, IPR2019-00243, Paper No. 7 at 24, (PTAB May 8, 2019).

[10] See *Samsung Electronics America, Inc. v. Prisia Engineering Corp.*, No. 19-1169, 2020 WL 543427 at \*8 (Fed. Cir. Feb. 4, 2020) (holding that the PTAB erred by not conducting prior art analysis on a claim that was deemed indefinite under *IPXL Holdings*).

[11] *Intex Recreation v. Team Worldwide Corp.*, IPR2019-00244, Paper No. 7 at 25 (PTAB May 8, 2019), (emphasis in original).

[12] See *IBM Corp. v. Intellectual Ventures LLC*, IPR2014-00587, Paper No. 13, (PTAB Sept. 24, 2014); see also IPR2014-001465, Paper No. 32, (PTAB Nov. 6, 2015).