

Petitioner and His Money are Soon Parted: Separate Fee Payments Do Not Reduce Risk of Non-Institution of Redundant Grounds

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The PTAB has recently begun pushing back on (alleged) attempts to circumvent the PTAB's policy against including "redundant grounds" in IPR trials.

The PTAB's redundancy policy is not new. Within a month of opening its doors, the PTAB [made it clear that it will not allow](#) an IPR petitioner to make multiple similar arguments challenging the validity of the same claims within an IPR petition, *i.e.*, the PTAB will not entertain "redundant" grounds of invalidity raised in an IPR petition:

Petitioner asserts four hundred and twenty two (422) grounds of unpatentability over prior art . . . averaging more than 21 grounds per claim. . . . [M]ultiple grounds, which

distinction between them, are contrary to the regulatory and statutory mandates, and therefore are not all entitled to consideration.

See CBM2012-00003, No. 7 Notice at 2 (P.T.A.B. Oct. 25, 2012). The PTAB reasoned that allowing a petitioner to challenge a patent with redundant arguments would frustrate Congress' intent to establish the PTAB as a "just, speedy, and inexpensive" tribunal to resolve patent disputes. *Id.* at 2 (citing 35 U.S.C. § 325(b)).

It has been over two years since the PTAB first refused to permit redundant IPR grounds to be included in an instituted trial. Since then, Petitioners have tried a variety of tactics to avoid having grounds be found to be "redundant." For example, Petitioners are now more likely to explain exactly how one ground of invalidity "is better in some respect" than another. *Id.* at 3.

Another strategy that developed, which may be viewed as simply throwing money at the problem, was to file multiple petitions for IPR against the same claims of a patent, with invalidity grounds spread across the petitions. Some petitioners may have been under the impression that the PTAB reviews IPR petitions independently of one another – even with respect to those filed by the same petitioner. Petitioners may have believed that redundancy would not apply across IPR petitions because a separate filing fee must be paid for each IPR petition, thus, resources are provided to the PTAB to ensure a speedy resolution of the trial.

Despite being an initially popular, and arguably successful, strategy the PTAB appears to be clamping down on petitioners who file multiple IPR petitions against the same claims of the same patent. This past March, Canon Inc. filed three IPRs against a single patent owned by Intellectual Ventures. See IPR2014-00535, 00536, and 00537. Each petition sought review of all 31 claims of the patent, but relied on different prior art and grounds of invalidity. In its decision regarding institution, [the PTAB considered the grounds of all three petitions together](#):

In each of [the three petitions], Petitioner challenges all of the claims of the '406 patent. Specifically, through no fewer than 49 grounds, Petitioner asserts multiple challenges to each claim of the '406 patent across three separate petitions. Petitioner, however, does not address the duplicative nature of its arguments across Petitions.

We note that Petitioner's analysis does not distinguish among the three Petitions, for Petitioner relies on the same Carley declaration in support of all three. . . . [The] failure by Petitioner's expert to explain his generic approach further convinces us that the three Petitions should be considered together.

IPR2014-00535, No. 9 Institution Decision at 19 (P.T.A.B. Sep. 24, 2014). The PTAB initiated trial with respect to only one of the three petitions. In declining to institute trial with respect to the other two petitions, the PTAB stated it was not convinced that the grounds

Id. at 20.

In its [decision on Canon's rehearing request](#), the PTAB made clear that paying additional fees to file separate IPRs does not circumvent the PTAB's authority to decline to institute trial on petitions that rely on grounds it finds to be redundant: "Petitioner's separate fee payments, however, did not assure them that three separate trials would be instituted." See IPR2014-00536, 00537, Request for Rehearing at 4 (Nov. 5, 2014).

As simply throwing money at the problem appears to no longer be a viable option, Petitioners may need to come up with more creative strategies to get multiple, parallel bites at the invalidity apple.

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