



Priority Dispute Is Not Carte Blanche to Challenge Same Patent with Multiple IPR Petitions

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The petitioner concurrently filed two IPR petitions challenging the same claims of a patent. In one petition, the petitioner challenged the claims with prior art that predated the filing date of the patent's provisional application. In the other petition, the petitioner challenged the claim of priority to the provisional application and asserted prior art postdating the filing date of the provisional application. According to the petitioner, "[d]ue to the large number of claims and the volume of discussion on the priority deficiencies, these grounds could not be presented in a single filing."

The Board instituted trial on the petition that did not challenge the priority date. The Board denied the other petition under 35 U.S.C. § 314(a) and found that the petitioner had failed to demonstrate the need for more than one petition to challenge the same patent claims.

In exercising its discretion, the Board first noted that the Trial Practice Guide (the "Guide") states that "a substantial majority of patents have been challenged with a single petition." And although, as the petitioner argued, the Guide expressly contemplates that multiple petitions directed to the same patent may be appropriate where "there is a dispute about priority date requiring arguments under multiple prior art references," the Guide further instructs that "this should be rare." In view of the Guide's instruction, the Board explained that a petitioner is not automatically entitled to multiple reviews of the same patent claims whenever a priority issue arises. In this instance, the Board determined that the petitioner's failure to adequately explain how this was one of those "rare" circumstances requiring the filing of two petitions weighed against institution.

The Board found the petitioner’s additional arguments equally unpersuasive to justify two petitions. Specifically, the Board held that the petitioner’s assertion that the petitions present “alternative arguments” that are “not cumulative challenges” did not provide a sufficient explanation of the differences between the petitions or the reasons why the Board should institute additional petitions if it identifies one that meets the institution requirements. The Board also rejected the argument that the large number of claims and volume of discussion on the priority deficiencies warranted two petitions. The Board determined that the 18 challenged claims was “not a significantly large number of claims to address in a single petition,” as evidenced by the fact that the petitioner was able to assert multiple grounds against all 18 claims in the instituted proceeding. The Board also found that, regardless of the alleged volume of discussion on priority deficiencies, the petitioner still failed to explain adequately why, if the Board institutes review on a petition where priority is not an issue, a second review that involves a priority dispute is necessary.

Practice Tip: When filing more than one *inter partes* review petition to address a dispute about the priority date of challenged claims, a petitioner should explain: (1) the differences between the petitions, (2) why the issues addressed by the different petitions are material and (3) why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies the institution standard. The petitioner should also explain how the circumstances surrounding its challenges, including a priority dispute, are “rare” and require multiple petitions.

Square, Inc., v. 4361423 Canada Inc., IPR2019-01626, Paper 14 (PTAB March 30, 2020)

Categories

Patent Trial & Appeal Board

Inter Partes Review

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