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PTAB Institutes Trial on a "Follow-On" IPR Petition Following Two Previous Denials

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The PTAB has the discretion under § 314(a) to deny institution of an IPR for multiple follow-on petitions. The PTAB detailed seven factors in *General Plastic Indus. Co. Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper No. 19 (PTAB Sept. 6, 2017) (precedential) that it looks to "when determining whether to exercise that discretion." The PTAB has previously exercised its discretion to deny so-called "follow-on petitions" that stage arguments in multiple petitions to use petitioner's preliminary responses as a "roadmap" to gain institution. The *General Plastic* factors that the PTAB weighs are non-exhaustive and principally include:

- whether the same petitioner previously sought review of the same patent claims;
- whether, at the time of the first petition filing, the petitioner knew about the prior art listed in the second petition; and
- whether, at the time of the second petition filing, the petitioner had received the patent owner's preliminary response from the first petition.

The Patent Owner argued that Petitioners had not met the *General Plastic* factors because their petition challenged the same patent claims, Petitioners knew of the prior art references, and Petitioners had already received the Patent Owner's preliminary response. Nonetheless, the PTAB declined to exercise its discretion to deny institution of the IPR.

The PTAB's decision to not exercise its discretion turned on Petitioners' belated discovery that the Patent Owner had endorsed two prior art methods for practicing a claim element in a parallel European Patent Office proceeding. Upon discovering this potentially invalidating art, Petitioners immediately hired experts to conduct testing. Petitioners then filed the third IPR petition only eight days after they completed testing. The PTAB determined that

Petitioners' efforts to investigate and complete testing on a matter not at issue in the two initial petitions was reasonable. Petitioners' diligent actions stood in stark contrast to the disallowed practice from *General Plastic* wherein a petitioner "strategically stage[d] [its] prior art and arguments in multiple petitions, using [Patent Owner's preliminary response] as a roadmap, until a ground is found that results in the grant of review." IPR2016-01357, slip op. at 17.

Relatedly, the PTAB has discretion to decline IPR institution under 35 U.S.C. § 325(d) if "the same or substantially the same prior art or arguments previously were presented to the [Patent] Office." The PTAB considered this threshold issue in this proceeding, and its analysis tracked the above § 314(a) reasoning. The PTAB determined that, because the patent examiner did not have Petitioners' new testing evidence, the Patent Office had not considered the same prior art.

Ultimately, Petitioners demonstrated a reasonable likelihood that they would prevail on both of the unpatentability grounds. This case suggests that the PTAB may allow "follow-on" petitions in some cases if a Petitioner is diligent in filing the petition and has a reasonable basis for not raising the grounds in an earlier Petition..

Sanofi-Aventis U.S. LLC v. Immunex Corp., IPR2017-01884, Paper No. 14 (PTAB Feb. 15, 2018)

Categories

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