

PTAB Denies IPR Institution Where Petitioner Used Same Prior Art and “Substantially Similar” Arguments

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By: Andy Rosbrook, Matthew George Hartman, Rubén H. Muñoz

The Petitioner, ZTE (USA) Inc., filed an IPR petition challenging U.S. Patent No. 7,397,431 (the “431 Patent”), directed to a multilevel antenna structure. This was not the first time the ‘431 Patent had been challenged—it was previously the subject of an earlier IPR petition, four *inter partes* reexamination proceedings, one *ex parte* reexamination proceeding, three district court lawsuits, and a Federal Circuit appeal.

The Petitioner relied on three prior art references from the earlier *ex parte* and *inter partes* reexaminations. Petitioner, however, presented these references to the Board in a new way by (i) combining previously uncombined references and (ii) arguing that the ‘431 Patent was obvious under 35 U.S.C. § 103 in light of a reference that was previously used as anticipatory prior art (under § 102). Petitioner also submitted new and detailed evidence about the characteristics of the patented antenna, including plots, graphs, and an expert declaration to explain them.

The Board first considered whether to exercise its discretion under 35 U.S.C. § 325(d) to deny institution because the asserted prior art was previously presented to the Patent Office. In doing so, the Board weighed six non-exclusive “*Becton Dickinson*” factors:

1. the similarities and material differences between the asserted prior art and the art from the earlier examinations;
2. the cumulative nature of the asserted prior art and the art evaluated during the earlier examination;

3. the extent to which the currently-asserted art was evaluated during the earlier examination;
4. the extent of the overlap between arguments in the current and earlier proceedings;
5. whether a petitioner has explained how the Patent Office erred when evaluating the art in the earlier proceeding; and
6. the extent to which additional evidence and facts presented in the petition warrant reconsideration of the earlier-asserted art and arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, Case IPR2017-01586, slip op. at 17-18 (PTAB Dec. 15, 2017) (Paper 8) (informative).

The Board found that the first five factors all weighed in favor of denying institution. The first and second factors were analyzed briefly. The references were identical to the ones previously considered, and so were necessarily cumulative. The third factor—the extent to which the art was previously examined—also favored denying institution. The Board walked through the record of the earlier *ex parte* and *inter partes* reexaminations and determined that the references were presented substantively to the Patent Office and considered during those proceedings.

In considering the fourth factor, the Board compared the principal arguments made by Petitioner as to what the prior art taught, and found that those arguments were “substantially similar in many respects” to the previously presented arguments. Accordingly, the Board found that this factor weighed in favor of denying institution. The Board did note that the references were being presented as a new combination and under § 103, but these facts appear to have played little or no role in the Board’s evaluation of the fourth factor.

The fifth factor also weighed in favor of denying institution because the Petitioner did not identify any errors in the Patent Office’s earlier analysis.

The sixth factor was the only one the Board found to weigh in favor of institution. In particular, the Board found that presentation of additional evidence about the characteristics of the antenna, supported by an expert declaration, weighed in favor of additional consideration by the Board.

The Board weighed all six factors as a whole and determined that the first five factors—all dealing with the similarity of the prior art and arguments—outweighed the Petitioner’s

presentation of additional evidence.

Although the Board could have stopped there, it also exercised its discretion to deny institution under 35 U.S.C. § 314(a) on the grounds that an IPR would be cumulative of a co-pending district court proceeding. That co-pending case was likely to go to trial before the Board would issue a final written decision and the same prior art and arguments were already under consideration by the district court. Thus, the Board found that instituting IPR “would be contrary to the goal of the AIA to provide an efficient alternative to district court litigation” and denied institution under § 314(a) as well.

ZTE (USA) Inc. v. Fractus, S.A., Case IPR2018-01451 (PTAB Feb. 19, 2019) (Paper 12).

Practice Tip:

Where a patent has survived previous challenges at the Patent Office, a Petitioner will want to carefully differentiate the asserted prior art and arguments from those at issue in earlier proceedings, using the *Becton Dickinson* factors as a guide. Presenting the same art in different combinations or under different sections of the Patent Act (e.g., § 103 instead of § 102) may not be enough to justify institution.

Categories

Patent Trial & Appeal Board

Prior Art

35 U.S.C. § 102

35 U.S.C. § 103

Inter Partes Review

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