Estoppel Versus Discretion: How Is The PTAB Deciding Multiple Petitions Against The Same Patent?

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The PTAB has denied petitions filed by the same petitioner against the same claims, even where the subsequent petition relied upon completely different prior art (IPR2014-00506), reasoning that a petitioner should not hold back its best references for a subsequent attempt. But what happens when the same petitioner files a new petition (after a first petition is denied) against a different claim or claims of the same patent based on the same or similar prior art? According to the decision in IPR2015-00881, the PTAB may decide to institute if it finds a reasonable likelihood that one or more of the newly challenged claims is unpatentable. Understanding the different outcomes of PTAB decisions on multiple petitions against the same patent requires an examination of the underlying statute.

Estoppel Versus PTAB Discretion To Deny Based On Prior Proceedings

Statutory estoppel under section 315 (section 315(e) is the estoppel provision for IPR, while section 325(e) relates to estoppel for PGR) only prevents unsuccessful petitioners where the PTAB already instituted as to a particular claim and issued a final written decision as to that claim upholding patentability (emphasis supplied):

“The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318 (a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.”

By contrast, section 325(d) broadly gives the PTAB discretion to deny any petition in a situation where “substantially the same prior art or arguments previously were presented to the Office” in another proceeding. This provision is broader than 315 because it is not party-specific, it is not claim-specific, and it is not proceeding-specific. At the same time it is discretionary because the PTAB “may” choose to apply it or not apply it.

PTAB Refuses To Exercise Discretion To Deny

In IPR2015-00881, the PTAB declined to use its discretion to deny the petition, even though it involved the same prior art except for one reference. The primary reason appears to be the focus on a different claim in the subsequent petition, although the decision also cites the existence of a new reference. As noted above, estoppel would not apply here because the earlier petition did not result in a final written decision, since it was denied. Understanding the interplay of estoppel and PTAB discretion to deny under 325(d) based on prior proceedings is critical for both petitioners and patent owners who are confronting situations with multiple petitions.