

## Same Claim, Different Petitioner: Second IPR Permitted During Pendency of First

---

Friday, March 29, 2019

Addressing discretionary denial of institution of a new *inter partes* review (IPR) petition where the challenged claim is already the subject of an instituted IPR proceeding, the Patent Trial and Appeal Board (PTAB) decided not to exercise its discretion to deny a new IPR petition because the already-instituted IPR proceeding involved a different entity relying on different prior art. *Samsung Elecs. Co., Ltd. v. Iron Oak Techs., LLC*, Case No. IPR2018-01554 (PTAB Feb. 13, 2019) (Peslak, APJ).

Iron Oak owns a patent directed to the automated selection of a communication path in mobile communications. Samsung filed a petition for IPR challenging a claim of Iron Oak's patent. Iron Oak's patent is the subject of numerous civil actions, and the challenged claim was the subject of an already-instituted IPR proceeding. In its preliminary responses, Iron Oak argued that the new IPR petition should be denied because institution of a second IPR on the same claim, even on different grounds, would not preserve the PTAB's resources, and that a final written decision in favor of the patent owner could result in a resolution where a number of validity challenges continued to be raised, including challenges based on the identical art and arguments contained in the petition.

Interpreting Iron Oak's argument as a request for the PTAB to exercise its discretion in denying institution, the PTAB applied the factors set forth in *General Plastics* for evaluating follow-on petitions. The PTAB found that because Samsung was a different entity than the petitioner in the already-instituted IPR and was relying on different prior art, these factors did not weigh in Iron Oak's favor. In rejecting Iron Oak's argument, the PTAB noted the potential prejudice to Samsung if institution was denied and the already-instituted IPR was later terminated. The PTAB also noted that the multiple petitions were a direct consequence of Iron Oak's own litigation activity. Thus, the PTAB decided not to exercise its discretion to deny institution.

© 2019 McDermott Will & Emery

**Source URL:** <https://www.natlawreview.com/article/same-claim-different-petitioner-second-ipr-permitted-during-pendency-first>

The logo for McDermott Will & Emery, featuring the firm's name in a green, sans-serif font. The text is arranged in two lines: "McDermott" on the top line and "Will & Emery" on the bottom line.

Article By [McDermott Will & Emery](#)  
[Joseph Speyer](#) IP Update

[Intellectual Property](#)  
[Litigation / Trial Practice](#)  
[All Federal](#)