Addressing whether to institute an inter partes review (IPR) based on a third petition by the same petitioner against the same patent claims, the Patent Trial and Appeal Board (PTAB) denied institution both as an exercise of its discretion and because the petition relied on substantially the same prior art as the previous petition. Duncan Parking Techs., Inc. v. IPS Group, Inc., Case No. IPR2016-00145 (PTAB, Nov. 21, 2016) (Kim, APJ).

IPS Group sued Duncan Parking Technologies in district court for allegedly infringing two patents directed to electronic parking meters. Shortly after receiving the district court complaint, Duncan Parking filed two IPR petitions against each patent. The PTAB denied both petitions with respect to one of the patents. Then, one month prior to the one-year IPR filing deadline, Duncan filed a third petition, adding two new references to a prior art combination presented in one of the denied petitions.

IPS Group filed a preliminary response that contested unpatentability on the merits, and also argued that the new petition should be denied for citing substantially the same prior art as the previous petition. IPS Group characterized the third petition as “incremental petitioning” (i.e., relying on the PTAB’s denial to fix the identified
deficiencies and mounting another attack). The PTAB agreed and denied the new petition on procedural grounds.

The PTAB first noted that institution of an IPR is discretionary. In this case, three of the five references in the new petition were already used as a combination in a prior petition. As for the two “new” references, both were discussed in a prior petition, both were of record during original prosecution, and one of the two was even incorporated by reference into one of the three references from the prior petition.

In denying institution, the PTAB explained that its primary concerns were fundamental fairness to the parties and its own limited resources. The PTAB cautioned petitioners not to expect automatic acceptance of multiple petitions against the same claims using substantially the same prior art, where the petitions are filed after the petitioner has an opportunity to study the patent owner’s response and the PTAB’s decision in connection with previous petitions on the same claims. The PTAB found this concern particularly important where, as here, a petitioner knows about the newly asserted prior art. The PTAB also emphasized that the onus to provide the rationale for multiple petitions lies with the petitioner, noting that this petitioner’s boilerplate statement that the new combination had not been previously applied was not sufficiently convincing.

The PTAB also set forth alternate grounds for denial based on 35 USC § 325(d)’s guidance that the institution decision can take into account the fact that the same or substantially the same prior art or arguments were previously presented. The PTAB concluded that the connections between the new art and the previous art were enough to consider the new petition as relying on substantially the same art as the prior petition.

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