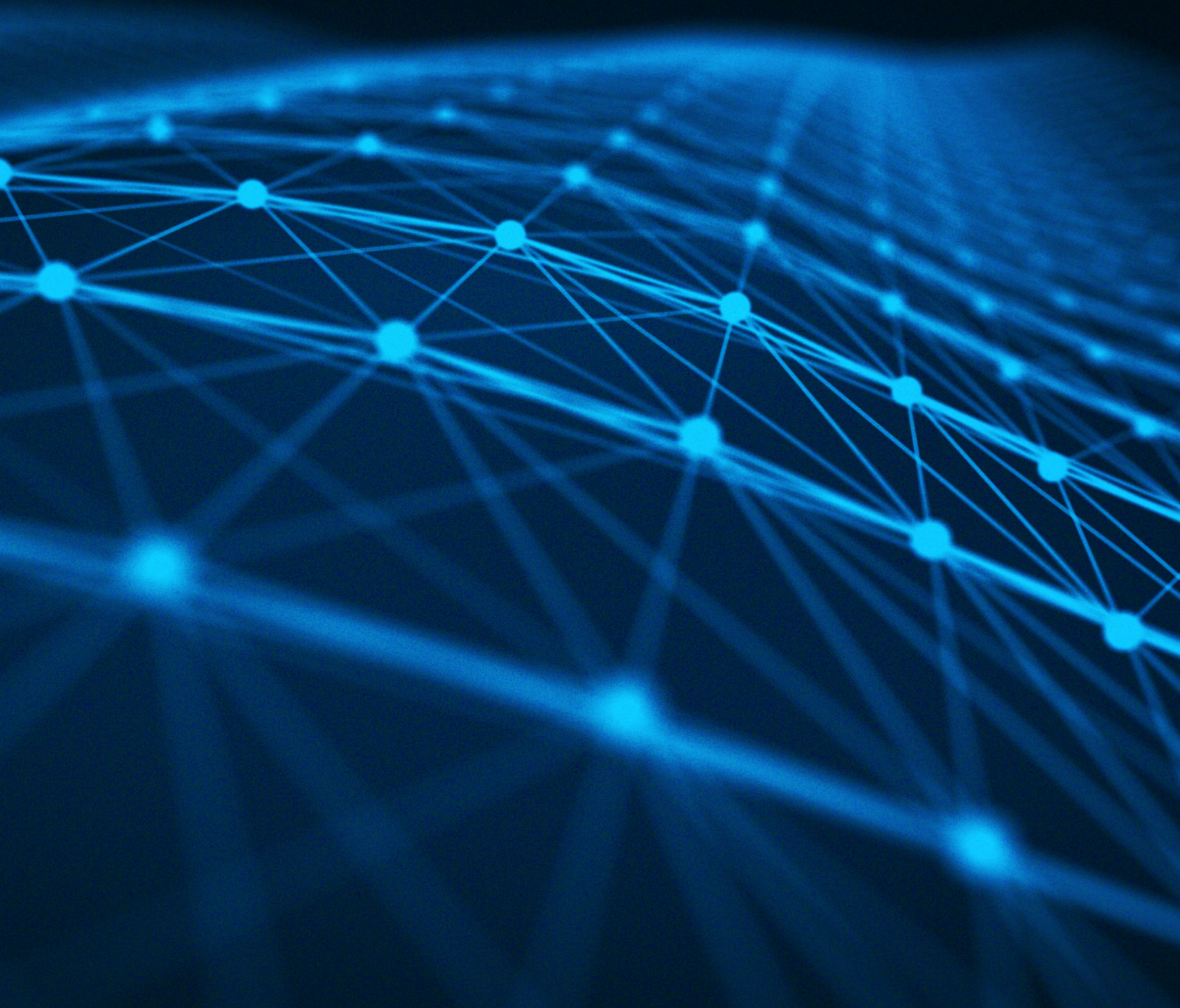


# IPR Evolution:

Decisions and Developments Shaping *Inter Partes* Review Practice

*Volume I, March 2020*

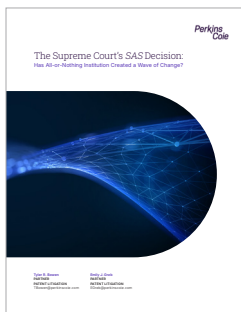


When the America Invents Act (AIA) became law more than seven years ago, it established *inter partes* review (IPR) as a process for challenging patents at the Patent Trial and Appeal Board (Board) within the U.S. Patent and Trademark Office. Since then, the federal courts and the Board have refined the process and issued many decisions and copious guidance affecting IPR practice.

We have followed the growth and evolution of IPRs from the beginning. In the past year, we have continued adding to our published analysis of noteworthy decisions and their potential practical effects for parties and lawyers alike. This inaugural volume of our *IPR Evolution* guide presents, in a single collection, articles we have published since 2019.

This compilation provides a quick reference resource filled with need-to-know information about recent shifts in IPR practice. Look for additional volumes as we continue to track the evolution of IPR practice. In Volume I, we address three important trends in IPR practice.

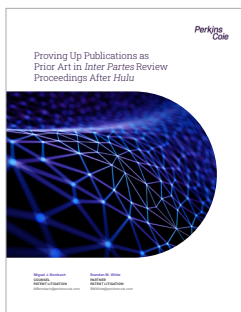
## In This Edition



PAGE 4

The U.S. Supreme Court decided in 2018 that the Board must institute review of all claims raised in an IPR petition or none of them. **“The Supreme Court’s SAS Decision: Has All-or-Nothing Institution Created a Wave of Change?”** explores the effects of that decision. Our original research analyzed over 800 institution decisions issued by the Board from April 2018 through February 2019, and the data reveal important trends and themes.

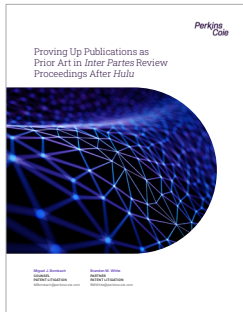
We conclude the Supreme Court’s decision did not cause the sea change some predicted. Even so, we identify lessons from the Board’s reaction that should guide IPR strategy and set expectations going forward.



PAGE 13

In the second article, **“Proving Up Publications as Prior Art in Inter Partes Review Proceedings After Hulu,”** we evaluate the Board’s December 2019 precedential decision in *Hulu, LLC v. Sound View Innovations, LLC*, which deals with the issue of showing that references qualify as prior art. *Hulu*, confusion reigned because different Board panels required varying types of evidence to show that a reference qualifies as a printed publication.

The *Hulu* decision provided some clarity by specifying a threshold—evidence must be “sufficient to establish a reasonable likelihood” of public accessibility. But the decision also left many questions unanswered. We provide practical tips to navigate the resulting landscape.



PAGE 20

The Board continues to take a tougher stance on multiple IPR petitions filed against a single patent, which is the subject of our third article, **“Fewer Bites at the IPR Apple? Impact of Recent Decisions and Guidance on Multiple Petitions.”** We probe the Board’s recent application of the test for determining whether to deny follow-on IPR challenges after an initial challenge to the same patent. The Board has taken a more expansive approach, denying institution even when a different petitioner files a subsequent challenge.

In the article, we also review November 2019 changes to the Board’s *Consolidated Trial Practice Guide* that discourage a petitioner from filing multiple petitions on the same patent at the same time. We assess the practical impact of these developments for petitioners.

---

We invite you to discover more in our research and analysis, and we welcome your questions on the issues we raise here as well as on the ongoing evolution of the *inter partes* review process.



**Tyler R. Bowen**  
**PARTNER**  
**IPR COMMITTEE CHAIR**  
Phoenix  
TBowen@perkinscoie.com  
+1.602.351.8448

# The Supreme Court's *SAS* Decision: Has All-or-Nothing Institution Created a Wave of Change?



**Tyler R. Bowen**  
PARTNER  
PATENT LITIGATION  
TBowen@perkinscoie.com

**Emily J. Greb**  
PARTNER  
PATENT LITIGATION  
EGreb@perkinscoie.com

When the U.S. Supreme Court decided *SAS Institute Inc. v. Iancu* in the spring of 2018, it held that the Patent Trial and Appeal Board must institute *inter partes* review on either all claims raised in a petition or none of them. The ruling triggered anticipation of a major shift in the Board's approach to institution of *inter partes* review.

Did the expected wave of change occur?

To find out, we conducted original research into the impact of *SAS*. In the following analysis, we separate the hype from reality and consider the implications for *inter partes* review practice.

# The Supreme Court's SAS Decision: Has All-or-Nothing Institution Created a Wave of Change?

**In April 2018, the U.S. Supreme Court held in *SAS Institute Inc. v. Iancu* that the Patent Trial and Appeal Board (Board or PTAB) must institute *inter partes* review (IPR) on either all claims raised in a petition or none of them.[1]**

In interpreting the mandate for the Board to “issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner,” the Supreme Court ruled that the “Board *must* address *every* claim the petitioner has challenged.”[2] In other words, “[r]ather than contemplate claim-by-claim institution,” the statute “anticipates a regime where a reasonable prospect of success on a single claim justifies review of all.”[3]

Prior to the SAS ruling, the Board often adopted a piecemeal approach, instituting review on some claims while denying review on others. Now that approach is no longer an option. In guidance issued after the Supreme Court's ruling, the Board clarified that it “will institute as to all claims or none.”[4]

## Institution Rates Before and After SAS

In the aftermath of the SAS decision, practitioners were left to wonder about the impact the case would have on the Board's approach to institution.

Some speculated the Board would seize on language from the Supreme Court's opinion and grant institution after finding a single ground or claim having a “reasonable likelihood” of success without addressing the remaining grounds or claims. Doing so would lighten the Board's burden and remain true to the Supreme Court's instructions.

Others predicted that institution rates might decline because the Board would elect to deny petitions liberally where weak grounds outnumbered stronger ones, which would also conserve the Board's time and resources.

In practice, however, the Board's post-SAS approach to institution has remained much the same as before, except in certain narrow circumstances. The SAS decision has not caused the sea change that many expected.

As a general matter, institution rates have increased only slightly since the SAS decision. Statistics published by the U.S. Patent and Trademark Office indicate that institution rates since the inception of IPRs and other similar proceedings for challenging a patent have steadily declined.[5] For example, the institution rate for petitions decided by the Board in fiscal year 2015 was 68%. That rate declined to 60% in fiscal year 2018.[6] In fiscal year 2019, which began several months after the Supreme Court issued the SAS decision, the institution rate increased to 64%, as of the

**In the aftermath of the SAS decision, practitioners were left to wonder about the impact the case would have on the Board's approach to institution.**

end of April 2019.[7] Thus, SAS did not create a wild swing in institution rates either way, although the decision may have generally encouraged the Board to institute, which reversed the long decline in institution rates.

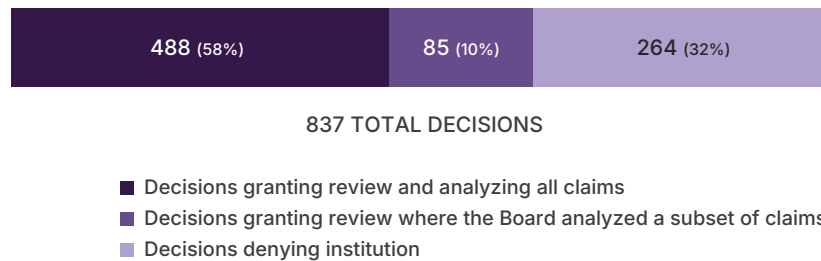
### Detailed Data on the Impact of SAS

To tease out other trends and themes from Board institution decisions issued since SAS, we collected and analyzed hundreds of decisions.

First, we searched Lex Machina’s decision database for IPR proceedings to identify Board institution decisions issued between April 25, 2018—the day after the Supreme Court decided SAS—and February 20, 2019. That search returned a total of 837 decisions (excluding joinder decisions).

Next, we analyzed those decisions to determine whether the Board granted or denied institution and to understand how the Board approached institution, including whether it addressed all, or fewer than all, grounds and claims in the decision. The graph below shows the overall results of the analysis.

### POST-SAS INSTITUTION AND SCOPE OF ANALYSIS



In 264 of the 837 decisions, the Board denied institution; in the remaining 573 decisions, the Board instituted review. The institution rate based on these data is 68.5%, slightly higher than the 64% rate calculated by the Patent Office for fiscal year 2019 through the end of April. Where the Board instituted review, our analysis revealed that the Board considered all grounds and claims in 488 of 573 decisions. Conversely, the Board addressed only a subset of grounds or claims in 85 of those 573 decisions.

### Implications for IPR Practice

Our analysis yielded observations relevant for practitioners involved in IPR proceedings.

1. Since SAS, the Board has largely continued to analyze all grounds and claims raised in a petition. In doing so, even though the Board institutes on either all grounds or none, it has signaled to petitioners when their arguments do not meet the “reasonable likelihood” standard for proving unpatentability in an IPR.[8] That gives petitioners some indication that they are unlikely to succeed, or at least that they face an uphill battle, in showing unpatentability during the trial phase of the IPR.

# 64%

**FISCAL YEAR 2019  
INSTITUTION RATE**  
*(as of April 2019)*

SAS did not create a wild swing in institution rates either way, although the decision may have generally encouraged the Board to institute, which reversed the long decline in institution rates.

2. Occasionally, the Board has taken the liberty to analyze only a subset of petitioners' arguments while ultimately granting institution on all claims.
3. The Supreme Court's guidance on institution has spurred the Board to deny institution in rare circumstances where most of the challenged grounds do not meet the "reasonable likelihood" standard and far outweigh others that do.

Overall, despite the hype and speculation following the decision, SAS does not appear to have radically shifted the Board's approach to analyzing grounds and claims for institution. Although the Board is now more likely to institute than before SAS, it uses the "reasonable likelihood" standard to point out to petitioners where their arguments are likely to fail during the IPR trial.

### **Analysis of All Claims and Grounds Remains the Norm**

The Board's current claim-specific analysis during the institution phase is largely consistent with its pre-SAS approach.

As described briefly above, approximately 85% of post-SAS Board decisions granting institution continued to analyze all grounds and claims raised in the petition (488 of 573 decisions granting institution). This indicates that, despite SAS describing institution based on a single claim, the Board typically applies its pre-SAS approach of analyzing all grounds and claims.

Moreover, the Board often uses the "reasonable likelihood" standard to provide petitioners with an indication of their chances of eventual success on each ground and claim raised. For example, in IPR2018-00479, petitioner asserted three grounds of unpatentability. The Board determined that petitioner demonstrated a reasonable likelihood of success for two of those grounds. With respect to the third ground, however, the Board stated that "Patent Owner's arguments and [expert] testimony cast some doubt on certain elements of Petitioner's analysis."<sup>[9]</sup> The Board nevertheless instituted on all grounds because SAS required it to do so.<sup>[10]</sup> This example is typical of other cases where the Board identified grounds or claims that seemed questionable or failed to meet the "reasonable likelihood" standard, but the Board instituted review anyway in compliance with the Supreme Court's instructions in SAS.

**Despite SAS describing institution based on a single claim, the Board typically applies its pre-SAS approach of analyzing all grounds and claims.**

As shown in the "Decisions Granting Review: With and Without Doubts" graph below, of the 488 Board decisions granting institution that addressed all grounds and claims, nearly 30% (143) included statements by the Board that it had doubts about some arguments or that some arguments did not meet the "reasonable likelihood" standard.



## DECISIONS GRANTING REVIEW: WITH AND WITHOUT DOUBTS



In practice, the Board’s institution decisions have remained much the same as they were before SAS, insofar as they find a reasonable likelihood of success on some grounds and claims but not on others. Ultimately, SAS may have simply changed the form of the Board’s ruling. Before, the Board could partially deny institution on claims that did not meet the “reasonable likelihood” standard. Now, if the petitioner shows a “reasonable likelihood” of success for at least one claim challenged in a petition, the Board must institute. But the Board still tells the petitioner where arguments are wanting and therefore unlikely to succeed at trial.

It remains to be seen how frequently the Board might change its mind on these preliminary assessments when issuing final written decisions at the end of trial. In any event, the Board’s institution decision provides petitioners with at least a rough idea of which claims are likely to succeed and which are not. That indication might affect trial preparation and strategy, including whether to devote time and resources to grounds or claims about which the Board seems skeptical.

### Sometimes the Board Reviews Fewer Than All Claims

Notwithstanding the general trend described above, the institution decision data also include examples where the Board reviews a subset of claims challenged in a petition (perhaps only one) and then concludes its analysis. The SAS decision and its all-or-nothing approach to institution offer cover to the Board when pursuing this strategy, which decreases review burden and increases efficiency. Based on the Supreme Court’s opinion, the Board can review a subset of the challenged claims, find that the petitioner carried its burden on that subset, and then institute on all grounds and claims.

As described above and illustrated below in the “Decisions Granting Review: Scope of Grounds Reviewed” graph, in roughly 15% of the trials instituted during the relevant time frame (85 out of a total of 573 decisions granting institution), the Board instituted review despite analyzing only a subset of grounds or claims. In approximately two-thirds of those decisions (54 out of 85), the Board instituted review after expressly reviewing only a single ground or claim to determine that the petitioner was likely to succeed.

**Based on the Supreme Court’s opinion, the Board can review a subset of the challenged claims, find that the petitioner carried its burden on that subset, and then institute on all grounds and claims.**

## DECISIONS GRANTING REVIEW: SCOPE OF GROUNDS REVIEWED



One example of single-claim review is IPR2018-01053.[11] There, petitioner Moen filed a petition requesting IPR of claims 7-16 of a patent. Patent owner Kohler disclaimed claims 7 and 8, leaving claims 9-16 for analysis. Moen asserted that claims 9-16 were obvious over the Lu and Bors references. The petition included a claim-by-claim, and limitation-by-limitation, comparison of the prior art references to the claims of the challenged patent. The Board proceeded to analyze Moen’s unpatentability arguments for just claim 9, noting that Kohler did not substantively respond to those arguments.[12]

The Board concluded that Moen “established that there is a reasonable likelihood that [it] would prevail in challenging claim 9.”[13] The Board then instituted IPR of claims 9-16 on the obviousness ground without examining any additional claims.

In sum, it is relatively uncommon for the Board to analyze a subset of grounds or claims when deciding to institute review—the Board applied that approach in about one out of every six decisions to institute in the applicable data set. To account for that possibility, it makes sense for petitioners to lead with claims where the arguments are most likely to meet the “reasonable likelihood” standard. Doing so may convince the Board that it need look no further before deciding to institute. In that case, petitioners might avoid unhelpful statements from the Board in the institution decision stating that other arguments do not meet the “reasonable likelihood” standard, instead leaving that determination for trial.

### Good Arguments for Relatively Few Grounds or Claims Cannot Save an Otherwise Doomed Petition

While the Board has been true to the SAS directive, it has also indicated that SAS cannot save a petition that fails to show a reasonable likelihood of success for most claims. In particular, the Board recently designated as informative two decisions where it denied institution as an inefficient use of resources because a large proportion of the challenges were unlikely to succeed:

**IPR2018-00923:** In this case, the petitioner argued that 20 claims were unpatentable over the prior art. The Board found the petitioner had demonstrated “at most, a reasonable likelihood of prevailing with respect to two dependent claims.”[14] The Board denied the petition, concluding that “instituting a trial with respect to all twenty challenged claims based on evidence and argument directed to dependent claims 3 and 4 is not an efficient use of the Board’s time and resources.”[15]

**IPR2018-01310:** In this challenge, the petitioner contended that 23 claims were unpatentable based on four asserted grounds. After analyzing the asserted grounds, the Board denied the petition, finding that the petitioner demonstrated “a reasonable likelihood of success with respect to only two claims on one asserted ground.”[16] As it did in IPR2018-00923, the Board concluded that “instituting a trial with respect to all twenty-three claims and on all four grounds based on evidence and arguments directed to only two claims and one ground would not be an efficient use of the Board’s time and resources.”[17]

These cases illustrate that, despite the Board’s general propensity to follow the letter of SAS and institute on all claims and all grounds, it can deviate from that general rule. When a petitioner fails to meet its burden on the vast majority of the grounds and claims raised, the Board may exercise its discretion to deny institution, rather than blindly applying SAS. But the circumstances must be relatively extreme for the Board to adopt this approach. As demonstrated by the large number of decisions where the Board institutes review despite noting there are grounds unlikely to succeed, a small number of problematic arguments will not render a petition fatally infirm. The informative decisions described above suggest a potential rule of thumb of 10%. That is, the Board is likely to deny the petition where no more than 10% of the grounds are likely to succeed. Practitioners should take note that weaker arguments are not likely to lead to denial so long as stronger arguments predominate.

### **Conclusion: The Ripple Effect of SAS on IPR Practice**

Based on our review of post-SAS institution decisions, the Board, in following the Supreme Court’s instructions, has typically continued to provide petitioners with detailed analyses of each of the asserted grounds. That might include an indication that the Board believes that some grounds do not meet the “reasonable likelihood” standard for IPRs.

The Board’s prevalent approach provides petitioners with an opportunity to adapt their IPR strategy. They can attempt to convince the Board on reply that any initial negative findings may not have been warranted. Or they might choose to focus on the arguments the Board found more persuasive during the institution phase.

The Board’s opinions might also be useful for petitioners and patent owners alike when considering settlement, because they provide an overview of the Board’s thinking on the merits early in the case, much as partial institution decisions did before the advent of SAS. The data also show that the Board may institute review after evaluating only a subset of claims; petitioners should organize their arguments accordingly.

Finally, the Board’s recent informative opinions serve as cautionary tales to petitioners: SAS’s all-or-nothing approach does not ensure institution where numerous weak grounds crowd out a few stronger ones. On the other hand, that imbalance must be severe to push the Board toward non-institution, and a minority of weaker arguments will not lead to denial, a fact that might encourage petitioners to take some risks.

Our analysis indicates that while the SAS decision changed the form of the Board’s institution practice, the substance is largely the same. The Supreme Court’s directive has not prevented the Board from continuing to provide practitioners with an early view into the Board’s thinking on all claims. Knowing the subtle effects the Supreme Court’s decision has had on Board institution practice gives practitioners the chance to alter their strategy and tactics to achieve the desired outcome, whether institution or denial.

*This article was co-written by Perkins Coie attorneys Tyler R. Bowen and Emily J. Greb. They were assisted by firm colleagues Gene W. Lee, Bryan D. Beel and Maria A. Stubbings.*

## Practice Tips

It makes sense for petitioners to lead with claims where the arguments are most likely to meet the “reasonable likelihood” standard.

The Board’s prevalent approach provides petitioners with an opportunity to adapt their IPR strategy. They can attempt to convince the Board on reply that any initial negative findings may not have been warranted.

Or they might choose to focus on the arguments the Board found more persuasive during the institution phase.

## ENDNOTES

- [1] SAS Inst. Inc. v. Iancu, 138 S. Ct. 1348, 1359–60 (2018).
- [2] 35 U.S.C. § 318(a); SAS Inst., 138 S. Ct. at 1354.
- [3] SAS Inst., 138 S. Ct. at 1356.
- [4] Guidance on the impact of SAS on AIA trial proceedings, USPTO (Apr. 26, 2018), <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>.
- [5] Trial Statistics, IPR, PGR, CBM, Patent Trial & Appeal Board (Apr. 2019) (“Board Trial Statistics”), at 6, [https://www.uspto.gov/sites/default/files/documents/trial\\_statistics\\_apr\\_2019.pdf](https://www.uspto.gov/sites/default/files/documents/trial_statistics_apr_2019.pdf).
- [6] *Id.*
- [7] *Id.*
- [8] 35 U.S.C. § 314(a).
- [9] IPR2018-00479, Paper 7 at 16–17 (P.T.A.B. Aug. 8, 2018).
- [10] *Id.* at 27–28 (“In light of SAS, the USPTO Guidance, and our above-described determination that Petitioner has met its burden [as to another ground], we . . . determine that it is appropriate to institute inter partes review with respect to [this] challenge.”).
- [11] IPR2018-01053, Paper 7 (P.T.A.B. Aug. 13, 2018).
- [12] *Id.* at 7-14.
- [13] *Id.* at 14.
- [14] IPR2018-00923, Paper 9 at 11 (P.T.A.B. Nov. 7, 2018).
- [15] *Id.*
- [16] IPR2018-01310, Paper 7 at 43 (P.T.A.B. Jan. 24, 2019).
- [17] *Id.*

# Proving Up Publications as Prior Art in *Inter Partes* Review Proceedings After *Hulu*



**Miguel J. Bombach**  
COUNSEL  
PATENT LITIGATION  
MBombach@perkinscoie.com

**Brandon M. White**  
PARTNER  
PATENT LITIGATION  
BMWhite@perkinscoie.com

## Imagine The Following Scenario.

A product manual contains disclosures that mirror the claims of a patent that a competitor has been using to threaten your company. The cover of the reference bears a 2010 copyright date, which is a full two years before the competitor filed its patent. If this manual is provided in an *inter partes* review (IPR) against your competitor's patent, it would need to be proven up as prior art. How do you do that?

In *Hulu, LLC v. Sound View Innovations, LLC*, the U.S. Patent and Trademark Office Patent Trial and Appeal Board offered a precedential opinion on the topic. Here we examine that decision and its implications for IPR practitioners.

# Proving Up Publications as Prior Art in *Inter Partes* Review Proceedings After *Hulu*

## Prior Art in *Inter Partes* Reviews

Any third party can petition the Patent Trial and Appeal Board at the United States Patent and Trademark Office (the Board) to review the patentability of a United States patent based on whether the invention was previously described in a patent or a printed publication. *See, e.g.*, 35 U.S.C. § 311(b).

It is conventional wisdom that a petitioner needs to lay all its evidentiary cards on the table in the petition. That includes evidence demonstrating that the relied-upon reference qualifies as prior art. The difficulty in proving up prior art depends on whether the reference is a patent or a publication. Patents and patent applications are easy—they are self-authenticating, and their listed publication date is taken as correct. For books, journal articles, product manuals, and other printed publications, however, the issue is far more complicated and unpredictable. Board panels have taken this issue on a case-by-case basis, and their opinions have varied widely.

## Board Guidance in Proving Prior Art

Recently, the Board provided a precedential opinion on the topic. In *Hulu, LLC v. Sound View Innovations, LLC*, the Board addressed the question, “[w]hat is required for a petitioner to establish that an asserted reference qualifies as [a] ‘printed publication’ at the institution stage?” (IPR2018-01039, Paper 29, at 2 (P.T.A.B. Dec. 20, 2019) (precedential)), answering:

“[A]t the institution stage, the petition must identify, with particularity, evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent and therefore that there is a reasonable likelihood that it qualifies as a printed publication.”

*See Hulu*, IPR2018-01039, Paper 29, at 13. The Board stated that this standard is higher than “mere notice pleading,” *i.e.*, where a theory merely needs to be articulated, but lower than the “preponderance standard,” *i.e.*, more likely than not, and further stated that a petitioner bears the burden to identify its evidence, with particularity, because there is no presumption that a reference qualifies as prior art.

*Id.* at 13, 16.

Turning to the specific circumstances in *Hulu*, the Board found that the petitioner’s showing was sufficient. The petitioner provided a publication from a well-known book series and publisher (O’Reilly), which bore copyright, printing, and ISBN dates. *Id.* at 19. The Board also found that a declaration showing that an earlier version of the book was collected and cataloged at a library demonstrated that the book in question was collected and cataloged. *Id.* at 20. Altogether, this evidence established a reasonable likelihood that the printed publication was made available to the pertinent public and qualified as prior art. *Id.*

## Prior Panel Disparity in Dealing with Publications as Prior Art

The Board provided *Hulu* as a precedential opinion because of prior conflicting panel decisions, which required varying amounts of evidence to prove up a reference as prior art. *Hulu*, however, does not clear up all conflicts with its standard based on “evidence sufficient to establish a reasonable likelihood.” Post-*Hulu*, it is important to be aware of the panel disparities because they may provide guidance to future panels weighing the *Hulu* standard.

Numerous panels have accepted a reference, and its publication, at face value. As an example, in *Arista Networks, Inc. v. Cisco Systems, Inc.*, the Board found that a copyright notice on a Juniper Networks API guide met the institution threshold to demonstrate that it was prior art. IPR2016-00244, Paper 10, at 18–19 (P.T.A.B. May 25, 2016). The Board cited numerous panel decisions holding that “a copyright notice” alone is “prima facie evidence of publication.” *Id.* at 19.

**Post-*Hulu*, it is important to be aware of the panel disparities because they may provide guidance to future panels weighing the *Hulu* standard.**

Some panels have applied this lower threshold even if the patent owner provided evidence challenging dissemination. For example, a panel held that a *New York Times* article qualified as prior art for the purposes of institution even though the patent owner submitted a declaration from a librarian contesting whether the article was indexed and searchable. *Shenzhen Zhiyi Tech. Co. Ltd. v. iRobot Corp.*, IPR2017-02137, Paper 9, at 19–20 (P.T.A.B. Apr. 2, 2018).

Further still, some panels have applied a low evidentiary threshold at final written decision, where the preponderance of evidence standard applies. In *Ericsson Inc. v. Intellectual Ventures I LLC*, one panel held that an Institute of Electrical and Electronics Engineers (IEEE) article bearing a copyright and an ISSN code—with no other evidence—qualified as prior art on its face. IPR2014-00527, Paper 41, at 10–11 (P.T.A.B. May 18, 2015).

Other panels have demanded more than what is described on a reference’s face to meet the institution threshold.

In *Alarm.com Inc. v. Vivint, Inc.*, a Honeywell engineering manual was rejected as prior art, even though it had a copyright date and a Library of Congress Catalog Card Number. IPR2016-00155, Paper 14, at 10–12 (P.T.A.B. Apr. 28, 2016). This panel found that a copyright date was insufficient to demonstrate public accessibility—it merely described a claim of ownership. *Id.* at 11–12. The Board deemed a Library of Congress Catalog Card Number insufficient because it did not explain how the manual “was cataloged or indexed in a meaningful way, such that it could be located by the public interested in the art.” *Id.* at 12. Such a Board panel may still find that the 2010 product manual described above, without additional evidence, does not meet the evidentiary threshold for institution post-*Hulu*.

Compounding the pre-*Hulu* confusion, some panels reached the exact opposite conclusion on the same type of evidence. In one final written decision, a panel held that an IEEE article’s copyright and ISBN are not probative of publication and are insufficient



to establish that the article is prior art. *TRW Auto. U.S. LLC v. Magna Elecs., Inc.*, IPR2014-01347, Paper 25, at 8 (P.T.A.B. Jan. 6, 2016). This is the opposite of the holding in *Ericsson Inc. v. Intellectual Ventures I LLC* on the same type of evidence—an IEEE article with a copyright date and ISSN. The above is just one example of diametrically opposed rulings.

There have been significant inconsistencies across panels, and there is still some unpredictability post-*Hulu* regarding how the Board will handle references at the institution stage.

### Filing a Petition Today

Although *Hulu* provides guidance, the Board did not adopt the petitioner's proposed bright-line rule that a conventional marker of publication, such as a copyright date alone, should be sufficient to qualify a reference as prior art at the petition stage. *Hulu*, IPR2018-01039, Paper 29, at 17. Instead, the Board held that "indicia on the face of the reference . . . are [to be] considered as part of the totality of the evidence." *Id.* at 17–18.

But this raises the question, what level of evidence is sufficient to establish a reasonable likelihood that a reference is prior art? The Board answered that question for a book from a well-known series and publisher—copyright, printing, and ISBN dates are likely sufficient. *Hulu*, IPR2018-01039, Paper 29, at 19.

However, with other published materials that parties often seek to use as prior art (for example, a product manual), the answer remains murky, and petitioners should be cognizant of negative decisions such as *Alarm.com* and *TRW Auto* that may still be persuasive to the Board after *Hulu*.

When addressing published materials like a product manual to show that the reference is prior art, a petitioner should consider providing evidence to the Board demonstrating:

- how the reference was publicly disseminated;
- the individuals it was disseminated to; and
- how those individuals could obtain it.

This evidence should ideally take the form of a declaration from someone with personal knowledge of dissemination. Providing this evidence will be helpful to avoid negative decisions like *Alarm.com* when the question of public accessibility of a reference is not so clear.

Although decided before *Hulu*, *Stryker Corp. v. Karl Storz Endoscopy-America, Inc.* provides guidance for proving up a reference like a product manual as prior art. IPR2015-00677, Paper 15 (P.T.A.B. Sept. 2, 2015). The *Stryker* panel instituted trial but rejected the notion that a copyright notice by itself demonstrates public accessibility. *Id.* at 18–19. The petitioner, however, presented three declarations—from those with personal knowledge—demonstrating that the product manual was publicly disseminated and specifying the individuals to whom it was disseminated. *Id.* at 19–22. One declarant testified that the manual was shipped with the product. *Id.* at 21. Another testified that the manual was given to engineers at training sessions and to any customer who requested it. *Id.* In totality, this showing likely qualifies as "evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible."

What level of evidence is sufficient to establish a reasonable likelihood that a reference is prior art? The answer remains murky for several published materials used as prior art.

When declarations are not available to prove public accessibility, a petitioner should present any evidence it can obtain. As the Board noted in *Hulu*, it will look at the “totality of the evidence” in assessing whether a reference is prior art. *Hulu*, IPR2018-01039, Paper 29, at 17–18. As an example, a petitioner submitted dated Amazon.com reviews to support that a reference was publicly disseminated. *CIM Maint. Inc. v. P&RO Sols. Grp., Inc.*, IPR2017-00516, Paper 8, at 18–20 (P.T.A.B. June 22, 2017). This type of evidence would be helpful in demonstrating that the public had access to a publication.

### Declaration Submissions in Post-*Hulu* Cases

A handful of post-*Hulu* cases have demonstrated that declarations should be submitted to prove up prior art. Two have found that a reference qualifies as prior art because of supporting declarations. See *Lenovo Holding Co., Inc. v. Dodots Licensing Solutions LLC*, IPR2019-01279, Paper 7, at 9 (P.T.A.B. Jan. 9, 2020) and *Polycom, Inc., v. Directpacket Research, Inc.*, IPR2019-01234, Paper 19, at 37 (P.T.A.B. Jan. 13, 2020).

In *Lenovo*, the author of the prior art in question submitted a declaration, and, in *Polycom*, a declarant from the SANS Institute testified about the routine business practices surrounding publication (*i.e.*, availability, accessibility, and time of publication) of articles at the SANS Institute.

**When declarations are not available to prove public accessibility, a petitioner should present any evidence it can obtain. As the Board noted in *Hulu*, it will look at the “totality of the evidence” in assessing whether a reference is prior art.**

Another panel rejected a manual—which bore a confidential footer—as prior art when the petitioner failed to provide additional evidence, such as a supporting declaration. See *Garrett M. Salpeter v. ARP Mfg., LLC*, IPR2019-01382, Paper 13 (P.T.A.B. Dec. 27, 2019). Post-*Hulu*, panels are likely to react positively to supporting declarations.

### Responding to a Challenged Reference

The *Hulu* panel also provided some guidance regarding how a petitioner might remedy patent owner challenges to the prior art status of a reference. The Board stated that “if the patent owner challenges a reference’s status as a printed publication, a petitioner may submit a supporting declaration with its reply.” *Hulu*, IPR2018-01039, Paper 29, at 15. However, the *Hulu* panel spoke only to the ability of petitioners to submit supporting declarations in reply. *Id.*

Submitting additional evidence is simple when filing a reply after institution, which a petitioner can do as a matter of right. If a patent owner raises issues before institution, however, the situation is more opaque. The Board allows a petitioner to file a reply to a patent owner’s pre-institution preliminary response only for good cause (see 37 C.F.R. § 42.108(c), *Huawei Device Co. v. Optis Cellular Tech., LLC*, IPR2018-00816, Paper 19, at 3–4 (P.T.A.B. Jan. 8, 2019) (precedential)). And the *Hulu* panel did not specifically indicate whether a patent owner challenge to prior art availability constitutes good cause. *Hulu*, IPR2018-01039, Paper 29, at 14–15.

It is uncertain whether the Board will allow petitioners to file pre-institution replies to address challenges to a publication’s prior art status. Prior panels have held that addressing the

sufficiency of the evidence does not constitute good cause (see *Mylan Pharms., Inc. v. Bristol-Myers Squibb Co.*, IPR2018-00892, Paper 22, at 4 (P.T.A.B. Sept. 17, 2018)), and that good cause does not exist when a petitioner seeks to address evidence that could have been raised in the petition (see, e.g., *Facebook, Inc. v. Sound View Innovations*, IPR2017-00985, Paper 13, at 4 (P.T.A.B. July 20, 2017)). Moreover, additional supporting evidence in the form of "supplemental evidence" cannot be submitted before institution. See *Azure Gaming Macau, Ltd. v. MGT Gaming, Inc.*, IPR2014-01288, Paper 9, at 3 (P.T.A.B. Dec. 4, 2014). Nonetheless, petitioners faced with a challenge to the prior art status of printed publications should seek permission from the Board to file a pre-institution reply and declaration supporting the prior art status of their references. Otherwise, the Board may deny institution based on deficiencies in showing that a reference qualifies as prior art.

After institution, beyond a reply, petitioners have additional options for providing more support to show a reference qualifies as prior art. "[I]f a patent owner does not challenge the reference's status as a printed publication, the petitioner may move to submit the declaration through the supplemental information process." *Hulu*, IPR2018-01039, Paper 29, at 15 (citing 37 C.F.R. § 42.123). But submitting additional evidence does not mean a petitioner can change its theories. *Id.* Furthermore, although not specifically addressed by the *Hulu* panel, petitioners can serve supplemental evidence in response to patent owner objections to evidence. See 37 C.F.R. § 42.64(b)(2). A patent owner will often object to evidence in order to preserve its ability to file a motion to exclude that evidence. See 37 C.F.R. § 42.64(c). That opens the door for the petitioner to provide supplemental evidence. The previously served supplemental evidence may later be filed if a patent owner files a motion to exclude. See Trial Practice Guide Update 16 (Aug. 2018), [https://www.uspto.gov/sites/default/files/documents/2018\\_Revised\\_Trial\\_Practice\\_Guide.pdf](https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf).

### Practice Tip

Despite opportunities to cure deficiencies in proving up prior art, petitioners should avoid pre-trial and post-trial evidentiary problems by presenting as much evidence as possible with the petition. That evidence might include a declaration from the author of a printed publication, such as a product manual, or from someone who publicly disseminated the manual, or perhaps both. In collecting and submitting evidence to establish a reference as a printed publication, it is truly better to be safe than sorry.

# Fewer Bites at the IPR Apple?

Impact of Recent Decisions and Guidance  
on Multiple Petitions



**Olivia T. Nguyen**  
ASSOCIATE  
PATENT LITIGATION  
ONguyen@perkinscoie.com

**Evan S. Day**  
SENIOR COUNSEL  
PATENT LITIGATION  
EDay@perkinscoie.com

## What can you expect when multiple *inter partes* review petitions are filed against the same patent?

Recent decisions from the U.S. Patent Trial and Appeal Board indicate it may in some cases deny later “serial” IPR petitions even when filed by petitioners different from those responsible for an initial petition on the same patent.

The Board has also changed its IPR practice guide to announce that it will scrutinize multiple “parallel” petitions filed by the same petitioner simultaneously. This article discusses these recent developments relating to serial and parallel IPR petitions and offers practical tips for practitioners.

# Fewer Bites at the IPR Apple?

## Impact of Recent Decisions and Guidance on Multiple Petitions

Recent guidance and decisions show that the U.S. Patent Trial and Appeal Board (Board) intends to take a tougher stance on multiple *inter partes* review (IPR) petitions filed against any single patent. The hardened position applies not only when a single petitioner files “serial” petitions against the same patent but also when different petitioners challenge the same patent, as well as when a single petitioner files multiple, “parallel” petitions regarding the same patent at the same time. Additionally, the Board’s *Consolidated Trial Practice Guide*, issued in November 2019, warns petitioners filing multiple simultaneous petitions that they must justify doing so and identify which petition has the highest priority.

### Board’s Discretion to Deny

The U.S. Congress granted the Board broad discretionary power to deny institution of America Invents Act (AIA) proceedings, which includes IPRs, under 35 U.S.C. § 314(a). Denial is discretionary because the statute “does not specify any particular circumstance in which review *must* be authorized.”[1]

Therefore, the Board may deny a petition under § 314(a) even if the petition shows a reasonable likelihood that at least one claim is unpatentable or even if the Board has not conducted a substantive analysis of the petition at all. In either case, a discretionary denial under § 314(a) is nonappealable under § 314(d): “No Appeal.—The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.”

#### WHAT IS A DISCRETIONARY DENIAL?

When the Board denies institution based on discretionary factors even where a petition shows a reasonable likelihood that at least one claim is unpatentable or the Board has not conducted a substantive analysis.

## General Plastic Denial of Serial Petitions Under Section 314(a)

While there is no per se rule barring follow-on petitions, the Board may use its discretion under 35 U.S.C. § 314(a) in certain cases to deny institution of petitions against patents that have already been challenged. In its 2017 decision in *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, the Board identified certain nonexclusive factors that it may consider in deciding whether to invoke its discretion to deny institution. Those *General Plastic* factors are:

### GENERAL PLASTIC FACTORS

- 1 Whether the same petitioner previously filed a petition directed to the same claims of the same patent
- 2 Whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it
- 3 Whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition
- 4 The length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition
- 5 Whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent
- 6 The finite resources of the Board
- 7 The requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.[2]

In formulating the factors, the Board warned that there must be restrictions on follow-on petitions to prevent petitioners from “strategically stag[ing] their prior art and arguments in multiple petitions, using [the Board’s] decisions as a roadmap, until a ground is found that results in the grant of review.”[3]

Specifically, the Board noted that its intent “was to take undue inequities and prejudices to Patent Owner into account.”[4] In particular, factors 2, 4, and 5 allow the Board “to assess and weigh whether a petitioner should have or could have raised the new challenges earlier.”[5] Factor 3 is “directed to Petitioner’s potential benefit from receiving and having the opportunity to study Patent Owner’s Preliminary Response, as well as our institution decisions on the first-filed petitions, prior to its filing of follow-on petitions.”[6] Factor 1 responds to congressional concerns about balancing the goal of “remov[ing] current disincentives to current administrative processes” without allowing AIA post-grant reviews to be “used as tools for harassment.”[7] Factors 6 and 7 are directed at the Board’s efficiency.

Previous Board decisions have been split on whether the factors are relevant in situations where a new petitioner files a petition for IPR of a patent that has already been challenged by another. In some decisions, the Board declined to weigh the *General Plastic* factors. In one such case, the Board stated:

Whether it is the *same* petitioner that is bringing a second petition is at the heart of the *General Plastic* factors. In particular, the Board, in formulating the factors, “recognize[d] the potential for abuse of the review process by repeated attacks on” a patent by the same petitioner. . . . In our view, these same staging concerns have less persuasive value when the second petition is filed by a different petitioner, absent evidence of cooperation between the first and second petitioners.[8]

Other decisions have applied all the *General Plastic* factors but weighed factor 1 (“whether the same petitioner previously filed a petition”) in favor of considering the petition.[9]

### **Applying *General Plastic* to Petitions Filed by Different Petitioners**

Although *General Plastic* originally applied to subsequent petitions filed on the same patent by the same petitioner, as the first *General Plastic* factor explicitly states, the Board has nevertheless shifted its approach to apply the *General Plastic* factors even when different petitioners file subsequent petitions on the same patent.



In *Shenzhen Silver Star Intelligent Technology Co. v. iRobot Corp. (Silver Star)*, the Board denied institution of later petitions filed by different petitioners from an initial petition based on *General Plastic*.<sup>[10]</sup>

**Dispute Background.** The petitioner filed an IPR petition after the Board had denied institution of an earlier IPR petition filed by another party who had been sued by the patent owner at approximately the same time as the petitioner and was a co-respondent in the International Trade Commission (ITC) investigation.

**Application of *General Plastic*.** The Board found that the first *General Plastic* factor weighed in favor of institution because the petitioner was not the “same petitioner” as the earlier petition. However, the Board weighed the second through fifth factors against institution because both petitioners were co-respondents in the ITC investigation.

In particular, the Board found that the later petitioner likely knew of the prior art asserted in the earlier petitions based on invalidity contentions filed in the ITC, could have taken advantage of the “opportunity to strategically stage [its] prior art and arguments,” and failed to explain its delay in filing after the first petition.<sup>[11]</sup> Accordingly, the Board exercised its discretion under 35 U.S.C. § 314(a) to deny institution.

In 2019, the Board took the reasoning in *Silver Star* a step further by relying on the *General Plastic* factors to deny IPR petitions filed by a former defendant in a related litigation. The case was *Valve Corp. v. Electronic Scripting Products, Inc.*<sup>[12]</sup>

Under a narrow interpretation of the Board’s decisions, an earlier-sued defendant’s IPR petition could preclude later petitions by other defendants. But the Board has insisted that its approach is not so rigid.

**Dispute Background.** In *Valve Corp.*, the later petitioner had been dismissed from underlying litigation in the U.S. District Court for the Northern District of California because of venue issues before its co-defendant (HTC America) filed IPR petitions against two asserted patents. A few months after that, the U.S. Court of Appeals for the Federal Circuit ruled in an unrelated case, *Click-to-Call Technologies, LP v. Ingenio, Inc.*, that the one-year time limit of 35 U.S.C. § 315(b) for IPRs filed by petitioners who had been served with a patent infringement lawsuit applied even to parties who had been sued and then saw the suit dismissed.<sup>[13]</sup> The later petitioner filed IPR petitions a few weeks after that decision; however, in the meantime, the Board had instituted one of two petitions filed by HTC America, but it denied the other based on a narrow claim construction urged by the patent owner.

**Application of *General Plastic*.** In its decisions addressing the later-filed petitions, the Board found that the first *General Plastic* factor weighed against institution despite the difference in petitioners because both the earlier and later petitioners had been accused of infringement in the related litigation based on the same accused product.

The Board stated that a *General Plastic* discretionary denial “is not limited solely to instances when multiple petitions are filed by the same petitioner. Rather, when different petitioners challenge the same patent, [the Board] consider[s] any relationship between those petitioners when weighing the *General Plastic* factors.”<sup>[14]</sup> According to the Board, the two petitioners were similarly situated and shared a “significant relationship . . . with respect to Patent Owner’s assertion” of the patent at issue, and factor 1 weighed against institution.<sup>[15]</sup> Additionally, the

Board noted that the later petitioner relied on the Board's previous institution decision because it addressed a narrower claim construction adopted by the Board in the earlier proceeding.

### Recent Board Decisions Involving Different Petitioners

At first glance, the recent cases on multiple petitions may appear to create an inequity for later-sued defendants, given that patent-owner plaintiffs can, and often do, stagger the filing of their complaints for patent infringement in district courts. Under a narrow interpretation of the Board's decisions, an earlier-sued defendant's IPR petition could preclude later petitions by other defendants. But the Board has insisted that its approach is not so rigid. For example, the Board has stated that it will "decline to wield [the patent owner's] own litigation activities as a shield in [an] *inter partes* review."<sup>[16]</sup> In addition, the Board has stated that complaints about serial petitions are unpersuasive "when the volume [of petitions] appears to be a direct result of [the patent owner's] own litigation activity."<sup>[17]</sup>

The Board designated the *Valve* decision precedential in April 2019. Since then, many of the Board's decisions citing that opinion have distinguished the case on its facts. For example, the Board has found no "significant relationship" between competitors<sup>[18]</sup> or petitioners who are defendants in "separate lawsuits in separate federal courts."<sup>[19]</sup> In addition, the Board has found no significant relationship where the patent owner has not alleged one.<sup>[20]</sup>

By contrast, the Board has found a significant relationship between an indemnitor and indemnitee,<sup>[21]</sup> a supplier and a buyer,<sup>[22]</sup> and co-defendants in consolidated cases.<sup>[23]</sup> However, the Board has indicated that the existence of a significant relationship cannot be negated by arguments that the petition was filed without contribution or cooperation from the prior petitioner.<sup>[24]</sup>

The Board has also closely scrutinized patent owner arguments concerning gamesmanship. As explained above, the Board has found no gamesmanship when the delay in filing resulted from a patent owner's litigation activity. And when considering whether a petitioner has received an unfair advantage from seeing a prior filing or proceeding, the Board has found no unfair advantage in situations where the preliminary response "did not include substantive arguments"<sup>[25]</sup> or was "extremely reference-specific" and not relevant to the prior art in the petition.<sup>[26]</sup> Nor has the Board found an unfair advantage where the petitioner filed a substantively identical petition with a motion for joinder (i.e., a "copycat" or "me too" petition)<sup>[27]</sup>. In sum, the Board requires a patent owner to provide clear evidence of gamesmanship.<sup>[28]</sup>

### Multiple Parallel Petitions

In the new *Consolidated Trial Practice Guide*, the Board addressed petitions challenging claims of the same patent at the same time filed by the same petitioner. In a significant shift, the Board also stated that "[b]ased on the Board's experience, one petition should be sufficient to challenge the claims of a patent in most situations," including in parallel petition situations—i.e., where the same petitioner files multiple petitions to the same patent simultaneously.<sup>[29]</sup> Focusing on institution equities, the Board explained that "[t]wo or more petitions filed against the same patent at or about the same time (e.g., before

the first preliminary response by the patent owner) may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns.”[30] It further noted that “multiple petitions by a petitioner are not necessary in the vast majority of cases.”[31]

Where a petitioner files more than one petition against the same patent, the Board stated that going forward the petitioner should identify (in the petition or a separate paper):

- a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions; and
- a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner’s burden under 35 U.S.C. § 314(a).

**Equitable considerations for denying institution will play a central role in patent owner preliminary responses after *Valve Corp.***

The *Consolidated Trial Practice Guide* gives two examples of situations in which more than a single petition may be necessary:

- when the patent owner has asserted a large number of claims in litigation, and
- when there is a dispute about priority date requiring arguments under multiple prior art references.

However, these examples are not exhaustive. Since the Board issued its updated guidance, the Board has also instituted multiple petitions that provide “different unpatentability arguments to account for different claim interpretations,”[32] where multiple defendants in district court proceedings filed only two consolidated petitions,[33] where a petitioner “[f]aced with word count limitations and a large number of challenged claims” chose to “distribute its analysis of those claims among a number of petitions,”[34] and in situations with various combinations of these factors.

By contrast, filing parallel petitions on different references, without an explanation of the materiality of those differences, may not be sufficient.[35] The Board now looks to the petitioner to justify instituting more than one IPR of a single challenged patent, and that explanation should come in (or be filed concurrently with) its petition.

On the other side, a patent owner should consider submitting a response that explains why the Board should not exercise its discretion to institute more than one petition (if it institutes at all). For example, the patent owner may explain why differences identified by the petitioner are “directed to an issue that is not material or not in dispute.”[36] In this scenario, the patent owner’s position may be strengthened where it has proffered the necessary stipulations, e.g., that claim limitations are not disputed or that certain references qualify as prior art. The Board has considered a patent owner’s unwillingness to narrow issues identified by the petitioner as a factor favoring institution of multiple petitions.[37]

## Practical Impact of Multiple Petition Guidance and Cases

The Board appears willing to wield its broad discretion under 35 U.S.C. § 314(a) to address criticisms alleging “harassment” of patent owners and “unfair” follow-on petitions that purportedly make inefficient use of the Board’s limited resources. Prospective petitioners should be mindful that equitable considerations for denying institution will play a central role in patent owner preliminary responses. Apparent gamesmanship (such as using a previous decision as a roadmap or test case) may be an aggravating factor, but it will not be presumed if the delay is due to the patent owner’s own litigation activities.

As for patent owners, the Board’s guidance on multiple IPR petitions, whether serial or parallel, provides a useful tool to defeat IPR petitions. However, patent owners should be prepared to explain in their preliminary responses why the multiple petitions represent gamesmanship or would otherwise give the petitioner an unfair advantage.

Patent owners should also ensure that their own litigation strategies do not increase the chance that the Board will consider multiple IPR challenges, such as when litigation is staggered against multiple defendants. Additionally, patent owners facing multiple parallel petitions may face a strategic choice whether to stipulate on certain issues or face an increased likelihood of defending against multiple instituted IPRs.

### Practice Tips

**Petitioners filing more than one IPR petition against the same patent should rank their petitions and explain why the differences between them are material.**

**Whenever a patent has been or will be challenged in an IPR more than once, consider the following:**

- The petitioner should have a strong justification for why the Board should institute multiple petitions and explain that justification up front in the petition or a separate paper.
- If a petitioner believes that more than one petition is necessary, it should consider filing all challenges on the same day, so petitions are viewed as parallel petitions instead of follow-on petitions.
- Petitioners in multidefendant cases should be mindful of earlier petitions filed by other defendants, even if they are not coordinated. They should also closely consider the *General Plastic* factors before filing a further petition on a patent that has been previously challenged.
- Petitioners should exercise particular caution when a previous IPR has reached either a patent owner preliminary response or an institution decision.

## ENDNOTES

- [1] *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 18-19 (P.T.A.B. Sept. 6, 2017) (emphasis added).
- [2] *Id.* at 16 (emphasis added).
- [3] *Id.* at 17.
- [4] *Id.*
- [5] *Id.* at 18.
- [6] *Id.* at 17.
- [7] *Id.* (citation omitted).
- [8] *Toshiba Am. Info. Sys., Inc. v. Wallelex Microelectronics Ltd.*, IPR2018-01538, Paper 11 at 19-20 (P.T.A.B. Mar. 5, 2019) (citations omitted).
- [9] *See, e.g., NetApp, Inc. v. Realtime Data LLC*, IPR2017-01195, Paper 9 at 10-11 (P.T.A.B. Oct. 12, 2017) (applying all *General Plastic* factors but noting that factor 2 is directed to situations involving the same petitioner and therefore neutral in the context of a different petitioner).
- [10] IPR2018-00761, Paper 15 (P.T.A.B. Sept. 5, 2018).
- [11] *Id.* at 11-13 (citation omitted).
- [12] IPR2019-00062, -00063, -00084, Paper 11 (P.T.A.B. Apr. 2, 2019) (precedential). The Board issued a virtually identical opinion in *Valve Corp. v. Electronic Scripting Products, Inc.*, IPR2019-00064, -00065, -00085, Paper 10 (P.T.A.B. May 1, 2019), denying petitions filed against related U.S. Patent No. 8,533,935 (“the ‘935 patent”), and citing the denial in the earlier *Valve* case.
- [13] 899 F.3d 1321 (Fed. Cir. 2018), *cert. granted in part sub nom. Dex Media, Inc. v. Click-to-Call Techs., LP*, 139 S. Ct. 2742 (2019).
- [14] *Valve Corp.*, Paper 11 at 2.
- [15] *Id.* at 10.
- [16] *Samsung Elecs. Co. v. Iron Oak Techs., LLC*, IPR2018-01554, Paper 9 at 31 (P.T.A.B. Feb. 13, 2019).
- [17] *Samsung Elecs. Am., Inc. v. Uniloc Lux. S.A.*, IPR2017-01797, Paper 8 at 33 (P.T.A.B. Feb. 6, 2018).
- [18] *See Found. Med., Inc. v. Guardant Health, Inc.*, IPR2019-00652, Paper 12 at 30 (P.T.A.B. Aug. 19, 2019).
- [19] *See Apple Inc. v. UUSI, LLC*, IPR2019-00358, Paper 12 at 14 (P.T.A.B. Aug. 5, 2019).
- [20] *See Microsoft Corp. v. Uniloc 2017 LLC*, IPR2019-01188, Paper 9 at 7-8 (P.T.A.B. Dec. 9, 2019).
- [21] *See Choirock Contents Factory Co. v. Spin Master Ltd.*, IPR2019-00901, Paper 17 at 16-17 (P.T.A.B. Sept. 26, 2019).
- [22] *See PayPal, Inc. v. IOENGINE, LLC*, IPR2019-00887, Paper 21 at 10-11 (P.T.A.B. Oct. 3, 2019).
- [23] *Id.*
- [24] *Id.* at 11.
- [25] *Cook Inc. v. Medtronic, Inc.*, IPR2019-00123, Paper 11 at 36 (P.T.A.B. June 11, 2019) (inadequate allegation that petitioner benefited from prior patent owner’s preliminary response).
- [26] *Google LLC v. Realtime Adaptive Streaming LLC*, IPR2019-01037, Paper 9 at 19-20 (P.T.A.B. Dec. 4, 2019) (same).
- [27] *See Choirock*, Paper 17 at 17.
- [28] *See, e.g., Google LLC v. Realtime Adaptive Streaming LLC*, IPR2019-01036, Paper 9 at 14 (P.T.A.B. Nov. 13, 2019).
- [29] Patent Trial & Appeal Bd., *Consolidated Trial Practice Guide* 59 (Nov. 2019).
- [30] *Id.*
- [31] *Id.*
- [32] *See Facebook, Inc. v. BlackBerry Ltd.*, IPR2019-00516, Paper 7 at 35 (P.T.A.B. Aug. 5, 2019).
- [33] *See Chegg Inc. v. Netsoc, LLC*, IPR2019-01165, Paper 14 at 9 (P.T.A.B. Dec. 5, 2019).
- [34] *See Microsoft Corp. v. IPA Techs., Inc.*, IPR2019-00813, Paper 12 at 13 (P.T.A.B. Oct. 17, 2019).
- [35] *See Nalox-1 Pharms., LLC v. Opiant Pharms., Inc.*, IPR2019-00686, Paper 11 at 10 (P.T.A.B. Aug. 27, 2019).
- [36] Patent Trial & Appeal Bd., *Consolidated Trial Practice Guide* 61 (Nov. 2019).
- [37] *See Microsoft*, Paper 12 at 14.

**Looking for more insights on *Inter Partes* review?**

Perkins Coie offers customized CLEs on IPRs for in-house teams. Each presentation may be eligible for 1-1.5 hours of CLE credit. Our lunch-and-learn sessions dive deeper and cover such popular topics as:

- Drafting a Winning IPR Petition
- Top 5 Strategy Considerations for the IPR Petition
- Top 5 Defense Strategies for the Patent Owner

Please contact us to schedule a customized CLE:



**Tyler R. Bowen**  
**PARTNER**  
**IPR COMMITTEE CHAIR**  
Phoenix  
TBowen@perkinscoie.com  
+1.602.351.8448