

BANNER&WITCOFF

PTAB HIGHLIGHTS

New developments in post-issuance proceedings

bannerwitcoff.com

What's the "Stock" Way to Organize an IPR Petition?

Cover, Tables, Introduction, Mandatory Notices, Payment of Fees, Certification of Standing, Top-Level Identification of Challenges, Summary of the Challenged Patent, Level of Skill, Claim Construction, Overview of the Prior Art, Specifics of the Challenges, Other Certifications

By Charles W. Shifley

May 25, 2017 — *Inter partes* reviews (IPRs) have canceled hundreds of patents. IPRs have proved their value to patent challengers. By latest statistics, from March 2017, they have canceled 16,688 patent claims by decision of the Patent and Trial Appeal Board (PTAB) and another 2,674 claims canceled or disclaimed by patent owners, for a total of 19,362 patent claims gone.

From surveying these successes, what content in what order is good for a winning petition? The answer from most advocates writing petitions is the answer of the caption above: Cover, Tables, Introduction, Mandatory Notices, Payment of Fees, Certification of Standing, Top-Level Identification of Challenges, Summary of the Challenged Patent, Level of Skill, Claim Construction, Overview of the Prior Art, Specifics of the Challenges, Other Certifications.

In reality, of course, the contents of petitions could conceivably be quite variable, and all of them could be successful, although there are basic minimums. On minimums, the petitioner must certify its grounds for standing, see 37 C.F.R. § 42.104(a), state the relief requested for each claim challenged, see §§ 42.22(a) and 42.104(b), give a full statement of reasons for the relief requested,

including an explanation of the evidence and governing law, see 42.22(a), provide “mandatory” notices of the real party-in-interest, related judicial or administrative matters, and the identity of counsel, if any, see 42.8, effect service of the petition, 42.105(a) and 42.106(a), and be accompanied by the required fee, see 42.15(a) and 42.106(a). See also 35 U.S.C. § 312 and *Macauto USA v. Baumeister & Ostler GmbH*, IPR2012-00004 (September 21, 2012) (notice of defective petition).

More specifically on certifying grounds for standing, the petition must certify the patent is available for IPR and that the petitioner is not barred or estopped from making an IPR challenge on the grounds stated in the petition. See *Dell Inc. v. Electronics and Telecommunications Res. Inst.*, IPR2015-00549 Paper 10 (March 26, 2015). More specifically on stating the explanation, the petition must specify whether a challenge is grounded in 35 U.S.C. § 102 or 103, what references are relied on for each ground, how the claims are to be construed, where each element of each claim is found in the references, and which portions of which exhibits support the challenges. The petition, of course, must prove a reasonable likelihood the petition will be successful. See 35 U.S.C. §314. And it cannot rely on incorporation by reference from other documents. See *Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR2014-00454 Paper 12 (August 29, 2014).

On possible variations for petition contents, petitions may challenge claims claim-by-claim, or group them. See 77 Fed. Reg. 48696, Response to Comment 25. A petition may assert one claim construction, or alternative constructions. See 77 Fed. Reg. 48700, Response to Comment 40. Claim construction may be a simple statement that claim terms should have their broadest reasonable interpretation to a person of ordinary skill. See 77 Fed. Reg. 48764. Petitions may include or refrain from claim charts. *Id.* They may include or refrain from a statement of material facts. *Id.*

But nothing in the law, PTAB rules, or precedent requires one order of presentation or another in a petition. Or “court-style” or “Patent Office style” phrasings, such as “would have been obvious from the combined disclosures of the prior art, including the ‘123 patent and the ‘456 publication” versus “should be canceled over Smith in view of Jones” (where the numbers are the last three numbers of the patent numbers, and “Smith” and “Jones” are the names of the lead inventors of the prior art references). Or one level of formality or another. The “parties are given wide latitude in how they present their cases.” *Id.*

Still, by an informal survey of many IPR petitions from a variety of companies and law firms, a “stock” way to organize petitions has developed. In short, a consensus has developed among IPR filers to organize petitions in a specific manner. The organization may or may not best suit the PTAB, but it has become the convention of petitions. Petitioners include a cover page and follow it on pages starting italic “i” with a table of contents, a table of authorities, and a table of exhibits. The petition then truly begins, on its Arabic page “1,” with a few sentences stating who the petitioner is, and what they want (claims x-y of Patent 1,234,567 canceled). The introduction is followed by the required mandatory notices, under the heading “Mandatory Notices.” Next are a statement that the fees are paid, under a heading “Payment of Fees,” and a certificate of standing, under a heading to match the certificate.

The challenges to the subject patent then really begin. A top-level identification of the challenges is first in this new beginning, in the form of a table that has a column to identify claims, a column to identify whether the challenge is 102 or 103, and a column to identify the prior art relied on, by short-

hand name, such as “Smith, Jones.” Some tables vary — but slightly. Where there are multiple combinations of claims, references, and uses of 102 and 103, the petitions organize them as “grounds,” as in these table rows:

Ground 1	Claims x-y	102	Smith
Ground 2	Claims xx-yy	103	Smith and Jones

Almost all petitions turn next to a summary of the challenged patent. The summary usually does not include a technology tutorial, before plunging into the disclosure of the patent, and the claims, although a few do. (There are a few fun tutorials, such as in the petition of new IPR2017-01380, with old photos of Model T cars being made.) The summaries often include descriptions of “APA,” the “admitted prior art,” or more specifically, whatever prior art is acknowledged to have existed in the Background of the Invention portion of the patent. The summaries of the patent include explanations of continuation-in-part status, or the content of earlier patents and publications incorporated by reference, if those are matters to be discussed relative to the dates of the prior art references relied on. Most summaries relative to the claims include only a description of one or a few representative claims, which may be a surprise. A few petitions describe the grouping of the claims, for example by identifying which are the independent claims, which dependent claims are similar to each other, and the like, but not many petitions do this.

Next, a description of the level of skill in the art is provided under its own heading. But usually, the description is perfunctory, simply stated, and not justified except by reference to paragraphs of an expert declaration.

Claim construction is also usually brief, with statements of the constructions provided, and again, not much justification other than a few references to usages in the patent, or perhaps an expert declaration.

The overview of the prior art has that caption, *i.e.*, “Overview of the Prior Art,” but is a one-by-one short march through each prior art reference used in the petition’s challenges, not truly an “overview” such as a tutorial.

The meat of the petition is the section that provides the specifics of the challenges. Most such sections are straightforward. Under headings 1a, 1b, 1c, 2a, 2b, 2c, etc., with such a heading for each claim element of each challenged claim, and with each claim element stated *verbatim* in its heading, most sections include short statements that use the last names of the inventors of each prior art reference, and state which prior art reference includes the element. For example, with Smith and Jones, and headings 1a, 1b, the short statements are in the nature of “Smith discloses a [repetition word-of-word of the claim element of 1a],” and “Jones discloses a [same for 1b].” Usually, the only other thing in these descriptions is a pinpoint citation to the specific place the referenced prior art item includes the disclosure, or a pinpoint citation to paragraphs of an expert declaration, or both.

Obviousness challenges must have more, and do have more. They include short explanations of reasons for motivation for the combinations of references relied on. These statements are often quite brief. They are usually done claim by claim, not element by element. Some simply state the motivation was the known desire of persons of ordinary skill to improve upon the prior art. That has been an accepted motivation in some cases. *See, e.g., In re Peterson*, 315 F.3d 1325, 1330 (Fed. Cir. 2003)

(“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages.”). Some state the motivation is that the references address the same problems. Very few provide elaborate explanations, such as working through all the steps of one or more of the rationales of MPEP 2143.

Almost none of the petitions include claim charts. It may be that the PTAB scared petitioners away from claim charts by being highly critical of claim charts several times. The PTAB has been critical of claim charts as not being explanatory enough. *See e.g., GN Resound A/S v. Oticon A/S*, IPR2015-00103 Paper 13 (June 18, 2015). They have been critical of claim charts that included anything more than claim limitations and citations and quotations from references. *See B/E Aerospace, Inc. v. Mag Aerospace, Inc.*, IPR2014-01510 Paper 3 (October 2, 2014). The PTAB was also critical of a petition that had claim charts that “omit[ted] arguments from where they are expected.” *See Microstrategy, Inc. v. Zillow, Inc.*, IPR2013-00034 Paper 23 at 3 (April 22, 2103). Petitioners probably learned too much from the cases, however, as the PTAB criticisms were at a time of page lengths for petitions, while lengths have changed to word lengths. When lengths changed to word lengths, the U.S. Patent and Trademark Office stated it would not object to claim charts with arguments.

Petitions conclude with their other certifications. They certify their appropriate length, and service on the patent owner.

Is this the right content in the right order for a winning petition? Most advocates seem to think it is. And the order they have adopted is: Cover, Tables, Introduction, Mandatory Notices, Payment of Fees, Certification of Standing, Top-Level Identification of Challenges, Summary of the Challenged Patent, Level of Skill, Claim Construction, Overview of the Prior Art, Specifics of the Challenges, Other Certifications. (For an interesting variation on this order, see the recent petition in IPR2017-01439.)

For more Banner & Witcoff *PTAB Highlights*, please click [here](#).

The Leahy-Smith America Invents Act established new patent post-issuance proceedings, including the inter partes review, post grant review and transitional program for covered business method patents, that offer a less costly, streamlined alternative to district court litigation. With the U.S. Patent and Trademark Office’s Patent Trial and Appeal Board conducting a large and increasing number of these proceedings, and with the law developing rapidly, Banner & Witcoff will offer frequent summaries of the board’s significant decisions and subsequent appeals at the U.S. Court of Appeals for the Federal Circuit.



www.bannerwitcoff.com

© Copyright 2017 Banner & Witcoff, Ltd. All Rights Reserved. The opinions expressed in this publication are for the purpose of fostering productive discussions of legal issues and do not constitute the rendering of legal counseling or other professional services. No attorney-client relationship is created, nor is there any offer to provide legal services, by the publication and distribution of this edition of PTAB Highlights.