In a decision issued on October 20, 2014, the Patent Trial and Appeal Board (PTAB) declined to institute inter partes review based on a petition filed by Conopco, Inc. d/b/a Unilever. According to the board, the petition raised “substantially the same” argument as a petition previously filed by Unilever and rejected by the board. The instant petition was the second petition filed by Unilever against the same claims in the same patent. The first petition filed by Unilever was rejected because the prior art put forth did not make a sufficient showing. In declining to institute based on the instant petition, the board did not squarely address the merits of the newly asserted grounds. Instead, the board acknowledged that Unilever advanced some new prior art, but nevertheless rejected the petition, citing 35 U.S.C. § 325(d), which indicates the board may consider whether “the same or substantially the same prior art or arguments” were previously presented to the office in determining whether to institute a proceeding. The board found that even though the prior art in the instant petition was different, “the two petitions are based on ‘substantially the same’ argument; namely, that the prior art identifies, with anticipatory specificity, [the claimed element].” In other words, the board was persuaded by the patent owner that the argument was the same across petitions even though the prior art that was relied upon was different.

The PTAB’s order does not require that every later-filed petition by the same party on the same claims using different prior art be denied institution. First, Unilever did not address 35 U.S.C. § 325(d) in its petition, and did not attempt to distinguish the instant petition from the first petition. Second, some of the primary references asserted
in the second petition were listed on the face of the patent-at-issue, which, according to the board, implicated other language of 35 U.S.C. § 325(d), i.e., that some of the prior art was “the same or substantially the same prior art [...] previously presented to the office.” Third, the board also indicated that Unilever did not explain why the references asserted in the later petition could not have been filed in the first petition. Thus, according to the board, the “interests of fairness, economy, and efficiency support declining review—a result that discourages the filing of a first petition that holds back prior art for use in successive attacks.”


- Author: Patrick Reidy

CONTACT INFORMATION

If you have any questions regarding this issue of IP Newsflash, please contact—

Todd Eric Landis
tlandis@akingump.com
214.969.2787

Michael Simons
msimos@akingump.com
512.499.6253

www.akingump.com

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