

Petitioners Cannot Respond to Substantive Issue Raised in Preliminary Response

Article By:

Intellectual Property Practice Group

VTech, Inc. v. Spherix Inc.

Addressing whether a petitioner in an inter partes review (IPR) can respond to a patent owner's preliminary response, the U.S. Patent and Trademark Office's (PTO) Patent Trial and Appeal Board (PTAB or Board) denied the petitioner's motion to submit supplemental information after the patent owner filed a Preliminary Response, finding that the request amounted to a prohibited reply. *VTech, Inc. v. Spherix Inc.*, Case No. IPR2014-01432 (PTAB, Jan. 21, 2015) (Chang, APJ).

The petitioners, VTech and Uniden, filed a petition for IPR challenging the validity of a patent owned by Spherix. The patent owner filed a Preliminary Response arguing that the Board should not institute IPR because there was no reasonable likelihood that petitioners would prevail.

The patent owner contended, among other things, that certain claims of a prior art patent cited by the petitioners could not constitute prior art because the petitioners failed to establish whether the challenged claims were part of the initial application or whether the claims were part of a preliminary amendment filed well after the filing date of the patent owner's patent.

During a conference call with the Board, the petitioner requested authorization to file a motion to submit supplemental information. More specifically, the petitioner sought permission to file the patent prosecution history of the prior art patent to show that the cited claims were supported by the original disclosure, and therefore, qualified as prior art.

The patent owner opposed the petitioner's request citing 37 C.F.R. §§ 42.64 and 42.123, and argued that filing supplemental information, prior to institution, is not allowed. The Board agreed with the patent owner and stated that the patent owner's "proposed submission essentially would amount to a reply to Spherix' Preliminary Response on a substantive issue, and such a reply is not permitted."

Practice Note: When filing a petition for IPR, it would be prudent to confirm the claims of cited prior art patents are supported by the original disclosure, and to include the prosecution history of the cited references.

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