

Attacking A Patent By Filing Multiple Inter Partes Review Petitions

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Challenging the validity of a patent sometimes requires raising multiple grounds that cannot be developed adequately in a single petition for ***inter partes* review (“IPR”)**. Filing multiple IPRs against a single patent is permitted under the statutes and rules governing AIA Trials and parties increasingly have used this strategy to challenge a patent’s validity.

There are a number of circumstances where filing multiple IPRs against a single patent can be beneficial to a petitioner. For example, the 60-page limit and formatting requirements under the rules impose a practical limit to the number of claims and grounds that can be fully developed in a single petition. In some circumstances, complexity of the technology at issue may require distinct legal analyses under different prior art references that can be presented more effectively in multiple petitions. In these circumstances, a petitioner can divide IPRs based on claim groups, invalidity arguments, or prior art references. Grouping IPRs in this way can help focus issues while still allowing a petitioner to present all possible invalidity grounds.

Care must be taken when filing multiple IPRs, however, as the Patent Trial and Appeal Board (“Board”) has increasingly exercised the power to deny all or parts of petitions that it deems are redundant with or “substantially the same” as pending or prior petitions. Although filing multiple IPRs increases costs, proper management of the proceedings can still keep the cost low compared to district court litigation.

In this newsletter, we discuss some of the considerations of when to file multiple petitions, strategies for filing multiple petitions, risks associated with filing multiple petitions, and managing the cost of

prosecuting multiple petitions.

A. Strategies for Filing Multiple IPRs

When it is impractical or ineffective to address all potentially challenged claims with all grounds of invalidity available within the IPR petition's 60 page limit, filing multiple IPRs is the best strategy. The following are different strategies to attack the validity of a patent with multiple petitions.

1) Challenge Different Groups of Claims in Separate Petitions

One approach is to divide the challenged claims into groups that cover similar subject matter in separate IPR petitions when the prior art references are the same or overlap. For example, the same prior art references can be used to assert obviousness grounds against two different groups of claims in the same patent. The first petition would be directed to the first group of claims, and the second petition would be directed to the second group of claims.

2) Assert Different Grounds in Separate Petitions

When there are distinct grounds of unpatentability, another approach is to divide the grounds of unpatentability into groups that are asserted in separate IPR petitions. For example, a first petition based solely on obviousness grounds and a second petition based solely on anticipation grounds can be filed against the same claims in a patent.

Another way to divide the unpatentability grounds can be based on the prior art references presented. For example, anticipation and obviousness grounds based on one reference and an alternative obviousness ground based on second reference can be asserted in a first petition. A different obviousness ground based on a third reference not presented in the first petition can be asserted in a second petition.

3) Stagger Petitions by Challenging Representative Claims in the First Petition and Follow up With a Second Petition to Challenge Additional Claims

Another approach is to select a few representative claims to challenge in the first petition. For example, a petitioner might select the broadest apparatus claim, the broadest method claim, and a dependent apparatus claim to challenge in the initial petition. After the Board institutes trial, the petitioner can challenge additional claims based on the same grounds raised in the first petition. If the timing works out, a petitioner could even try to join the two proceedings, which will expedite the resolution of the second petition and reduce the overall cost of the two proceedings.[\[1\]](#)

These strategies provide several advantages that might increase the likelihood of cancelling the claims of a patent. First, multiple petitions alleviate page limit constraints imposed by the rules. Second, each petition can be tailored to claims that have similar subject matter, that require similar prior art references, or that require similar expert declarations. This narrows the scope of each petition and makes it easier for a petitioner to focus on the strongest arguments in each area. Third, by challenging representative claims in a first petition, the petitioner can save costs if the first petition is unsuccessful.

B. Beware of the Board's Discretion to Deny "Similar" Petitions

Filing multiple IPR petitions, however, is not without risk. The Board has broad discretion to stay, consolidate, or terminate IPR petitions where there is more than one proceeding involving a single patent. Increasingly, the Board is using this discretion to deny petitions or arguments that it views as redundant or substantially the same as those raised in previous petitions. Although the Board often exercises this discretion over later-filed petitions that attempt to cure deficiencies in a previously denied petition, it has also used its discretion to deny or consolidate multiple petitions filed simultaneously for the same patent. For example, in one instance, a petitioner filed three IPR petitions against the same patent. The Board issued a single decision instituting the first petition and denying the other two petitions. The Board noted that the petitioner did not address the duplicative nature of the arguments across the three petitions and that the analysis across the three was not distinguished. When simultaneously filing multiple IPR petitions, it is therefore important to try to eliminate overlap, providing, where possible, separate and distinct evidence and arguments in each petition. It is also important to provide clear reasons why multiple grounds are being presented in different petitions and explain why the Board should consider all grounds.

C. Managing the Costs of Multiple IPRs

Despite the advantages, it is important to remember the associated cost with filing multiple IPR petitions. Along with attorney's fees to prepare the petitions, the minimum filing fee for each petition is \$23,000. The costs of parallel proceedings also need to be taken into consideration. While the Board can join similar proceedings, and reduce the attendant costs, petitioners must be prepared with an efficient strategy to streamline separate proceedings if the Board declines to do so. For example, this can involve grouping the petitions to efficiently utilize expert witnesses.

D. Practice Tips

- Identify all potentially infringed claims and all grounds of unpatentability early on.
- Determine evidence needed to support invalidity and identify and consult with potential experts before grouping claims or grounds of unpatentability.
- Avoid redundant petitions by using different art, arguments, and/or evidence in each petition.
- Provide clear reasons why grounds are being presented in multiple petitions and why each of those grounds should be considered.
- Be prepared for joint or separate proceedings.

Trends at the Board

AIA Trials remain popular and the Board continues to issue final written decisions within the one-year statutory requirement. Recently, the Director of the USPTO announced upcoming changes to the rules that should improve patent owners' ability to succeed on a motion to amend. Some of the changes involve increasing the page limits for a motion to amend to 25 pages.

IPR Trends at the Board Sept. 2012 — Mar. 2015

Petitions Filed	3,040
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Petitions Denied	457
Trials Instituted	1,295
Trials Dismissed/Settled	605
Final Written Decisions	344
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