

PTAB: On Second Thought, Your IPR Is Instituted

Article By:

G. Matthew McCloskey

In what could be a first, the Board granted-in-part a petitioner's rehearing request, reversing its earlier decision not to institute an *inter partes* review (IPR). In reversing, the majority of the Board acknowledged that the petition and supporting declaration had in fact explained how the primary prior art reference taught a key term under the board's construction. **AVX Corp. v. Greatbatch Ltd.**, Case IPR2015-00710 (PTAB, Jan. 13, 2016) (Tornquist, APJ) (Rose, APJ, dissenting).

AVX filed a petition seeking *inter partes* review (IPR) of Greatbatch's patent directed to capacitors having hermetic seals and structure allowing for testing of those seals, with the capacitors intended use being for electromagnetic interference (EMI) shielding in implantable medical devices. After reviewing the petition, the supporting evidence and Greatbatch's preliminary response, the Board initially declined to institute the IPR. Central to the Board's initial decision was its construction of the claim term "laminar delamination gap," which relates to the testing structure. The Board construed the term to mean, under the broadest reasonable interpretation (BRI) claim construction standard, "a very thin space between layers of material allowing passage of helium gas to the outer edges of the capacitor," just as the district court had done in the related litigation. In making its decision, the Board stated that AVX had not convincingly shown that the primary prior art reference, relied upon by AVX for teaching the testing structure for all asserted grounds of unpatentability, disclosed the "laminar delamination gap."

In the rehearing decision, the Board agreed that it had indeed overlooked AVX's argument that the "gas flow passage" depicted in one of the primary prior art reference's figures disclosed the "very thin space" required by its construction for "laminar delamination gap." The Board rejected Greatbatch's argument that the size of the gap between the depicted insulator and washer of the prior art would be "substantial," noting that Greatbatch's own exhibit—relied upon as purportedly teaching that brazing as taught by the prior art reference would necessarily result in a substantial gap—actually taught that "[a] braze fillet should ideally be very small." In granting the rehearing request, the Board made it clear that overlooking a key material statement in a petition is sufficient grounds to grant rehearing and reverse a prior denial of institution.

Also unusual was the inclusion of a dissent. According to the dissent, the majority relied upon argument and evidence that were not present in the petition. In particular, the dissent noted that AVX's petition, by advancing a claim construction without any "very thin" limitation, "gives short shrift" to showing anticipation under a claim construction requiring the "lamination delamination gap" to be "very thin." The dissent also pointed out that the petitioner's rehearing petition advanced a

new argument, to the effect that the primary prior art reference disclosed the “laminar delamination gap” by describing certain gaps as “minute.” The dissent also noted the inclusion in the rehearing motion of an annotated version of a drawing from the primary prior art reference, the annotations being absent in the original petition. The majority, however, considered the visual annotations to effectively correspond to the arguments in the petition without constituting new argument or evidence.

Practice Note: Despite the debate about whether the BRI standard currently used by the Board is the correct standard to use for America Invents Act (AIA) reviews and the fact that the Board is not generally bound by prior judicial construction of a claim term, the Board in this case adopted the district court’s claim construction from the parallel litigation. The Board’s review of that district court’s claim construction is consistent with the Federal Circuit’s decision in *Power Integrations, Inc. v. Lee* ([IP Update, Vol. 18, No. 9](#)), which found that the Board had an obligation to evaluate the claim construction of the parallel litigation and to determine whether it was consistent with the BRI of the claim terms at issue.

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National Law Review, Volume VI, Number 55

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