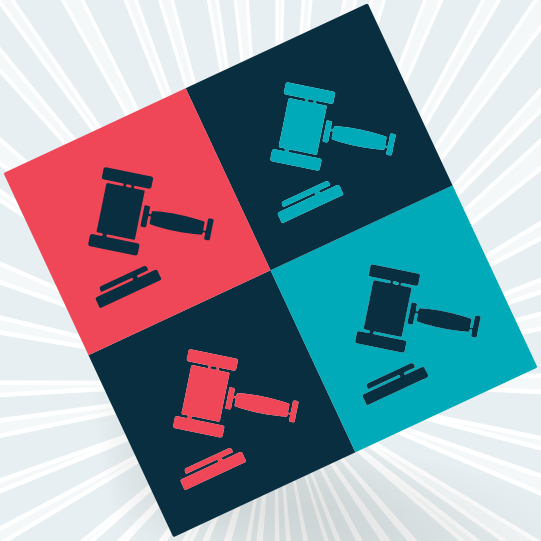
Multiple Petitions Study



EXECUTIVE SUMMARY
(FY 2021–FY 2022 Update)

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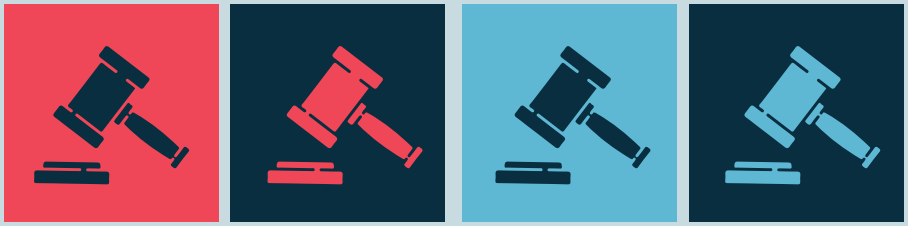

Executive Summary—Multiple Petitions Study (FY 2021–FY 2022 Update)

Background

Under the Leahy-Smith America Invents Act[1] (AIA), a petitioner may file multiple *inter partes* review (IPR) or post-grant review (PGR) petitions challenging the same patent. The Director of the United States Patent and Trademark Office (USPTO) has discretion to deny such petitions.[2] The USPTO has conducted several studies to determine the frequency at which petitioners file multiple petitions, and to what extent such petitions are effective.[3]

Multiple AIA petitions fall into two categories: serial and parallel. Serial petitions are petitions filed more than 90 days apart. Parallel petitions are petitions filed 90 days or fewer apart.

For both categories, the Office has issued guidance to help provide an appropriate balance between diverging interests of petitioners and patent owners, while ensuring that decisions are rendered in a consistent manner.

For serial petitions, in fiscal years 2016 and 2017, the Patent Trial and Appeal Board (PTAB) issued decisions providing guidance that identified factors to be considered when determining whether to deny institution when more than one petition is filed, including: (1) the extent of claim overlap between the original petition and the serial petition; (2) when the petitioner knew or should have known about prior art used in the serial petition; (3) whether the patent owner had filed a preliminary response, or the PTAB had rendered a decision on institution, with respect to the original petition; (4) the length of any delay between the petitioner learning about prior art used in the serial petition and the filing of the serial petition; and (5) the adequacy of the petitioner's explanation for the time elapsed between filing multiple petitions directed to the same claims of the patent.[4]

For parallel petitions, in fiscal year 2019, the PTAB began requiring that petitioners rank the petitions and provide a succinct explanation as to (1) why the parallel petitions are materially different (rather than cumulative) and (2) why the PTAB should exercise its discretion to consider the additional petitions.[5]

Through such guidance, the PTAB has indicated that petitioners "cannot expect automatic acceptance of multiple petitions for consideration."[6]

1 Pub. L. 112-29, 125 Stat. 284.

2 35 U.S.C. §§ 314(a), 315(d), 325(d).

3 Hons. David P. Ruschke and William V. Saindon, *Chat with the Chief: An Analysis of Multiple Petition study*, available at https://www.uspto.gov/sites/default/files/documents/Chat_with_the_Chief_Boardside_Chat_Multiple_Petition_Study_20171024.pdf (Oct. 24, 2017); *Analysis of multiple petitions in AIA Proceedings*, available at https://www.uspto.gov/sites/default/files/documents/multiple_petition__mta_study.pdf (Dec. 2020 update).

4 *See NVIDIA Corp. v. Samsung Elecs. Co.*, IPR2016-00134, Paper 9, at 7 (PTAB May 4, 2016) (setting forth factors in deciding whether to exercise discretion to deny review); *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 7 (PTAB Sept. 6, 2017) (designed precedential as to section II.B.4.i on Oct. 18, 2017). The PTAB also considers practical, administrative factors such as the finite resource of the PTAB and the statutory requirement to issue a final decision within one year of a trial institution. *See, e.g.*, 35 U.S.C. § 316(a)(11).

5 *See Comcast Cable Commc'ns, LLC v. Rovi Guides, Inc.*, IPR2019-00224, Paper 10, at 4 (PTAB Apr. 3, 2019); *Consolidated Trial Practice Guide* (November 2019), USPTO, at 27, available at https://www.uspto.gov/TrialPracticeGuideConsolidated.

6 *See NVIDIA, supra* note 4, at 7–8 (emphasizing the potential unfairness of proceeding on a second petition filed after "Petitioner received the benefit of having studied Patent Owner's Preliminary Response in the first petition or the Board's decision on whether to institute review in the first petition" or based on references the petitioner had been aware of or should have been aware of when the first petition was filed).

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Intent of Study

The USPTO recognizes that "[t]wo or more petitions filed against the same patent . . . may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns."[7] The USPTO further recognizes, however, "that there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references."[8] "Thus, more than one petition by a petitioner may be needed, although this should be rare."[9] With this in mind, the USPTO conducted, and has recently updated, an analysis of multiple petitions to understand how USPTO's guidance has affected multiple petition filings and institutions.

Study Results

Serial Petitions

The study reviewed serial petitions filed during fiscal years 2015 through 2022.[10] The study shows that after the PTAB issued guidance in both *NVIDIA* (FY 2016) and *General Plastic* (precedential, FY 2018), serial petition filing attempts markedly decreased from 99 attempts (9% of challenges to a patent by a petitioner) in fiscal year 2015 to 17 attempts (1.7% of all challenges to a patent by a petitioner) in fiscal year 2022. *See* Figure 1.

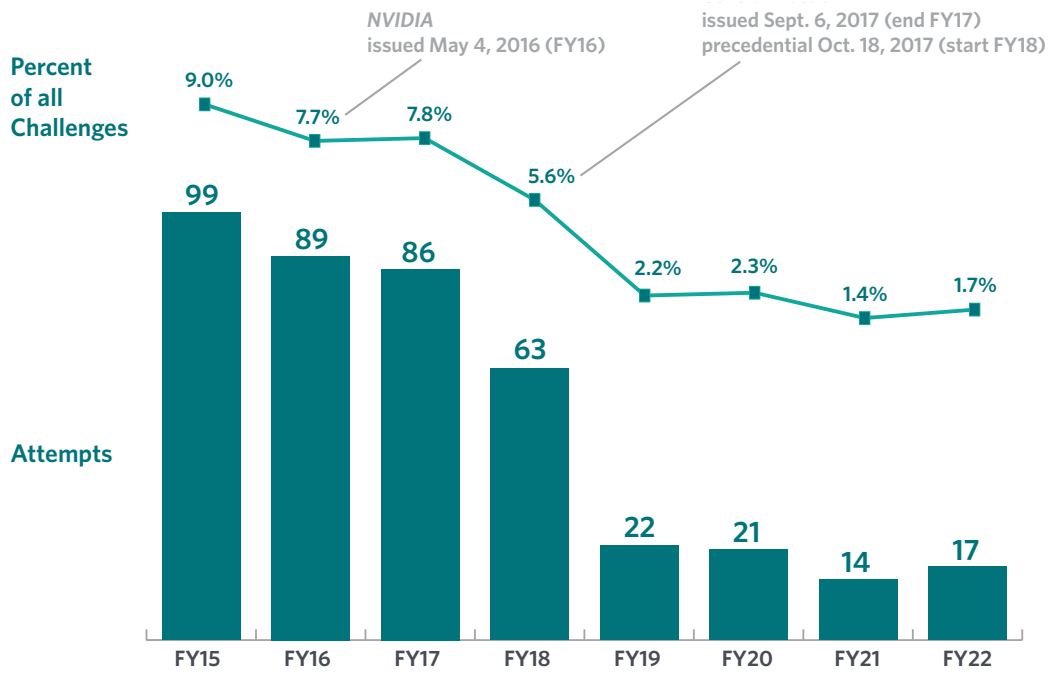

Figure 1. Serial petitions: attempts per fiscal year (FY15 to FY22: October 1, 2014, to September 30, 2022).

7 *Consolidated Trial Practice Guide, supra* note 5, at 59.

8 *Id.*

9 *Id.*

10 Joined petitions were excluded from the study.

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During that same time period, the "success rate" of serial petitions, i.e., the number of instituted AIA trials based on serial petitions, also declined from 46 institutions (4% of all challenges to a patent by a petitioner) in fiscal year 2016 to only 3 institutions (0.3% of all challenges to a patent by a petitioner) in fiscal year 2022. See Figure 2. In other words, in recent years, serial petition filings have been quite low and successful serial petitions have been rare.

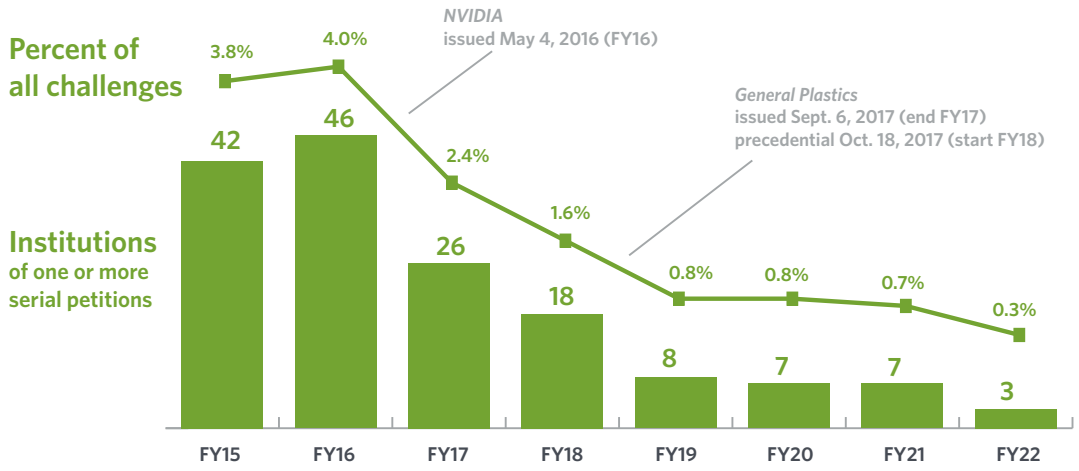

Figure 2. Serial petitions: instituted trials on one or more serial petitions per fiscal year (FY15 to FY22: October 1, 2014, to September 30, 2022).

Looking at the rare instances where it had occurred, the study analyzed the reasons justifying the decisions instituting a trial based on a serial petition filed in fiscal years 2021 and 2022. In some cases, the patent owner did not contest the filing of the serial petition.[11] In other cases, the serial petition challenged claims that the patent owner had newly asserted in related district court or International Trade Commission (ITC) proceedings.[12] In some cases, the large number of claims in the challenged patent was cited as a reason for instituting a trial.[13] Other cases involved a priority date issue,[14] intervening USPTO guidance,[15] or the termination of an ITC investigation.[16]

Parallel Petitions

The study reviewed parallel petitions filed during fiscal years 2015 through 2022.[17] After the USPTO issued guidance as it pertains to parallel petitions in fiscal year 2019, petitioners filed fewer parallel petitions, both in terms of absolute numbers and as a percentage of all challenges to a patent by a petitioner, from a high of 206 attempts representing about 20 percent of all challenges (fiscal year 2019) to a low of 76 attempts representing about 7 percent of all challenges (fiscal year 2022). *See* Figure 3.

11 *See, e.g., Netflix, Inc. v. Avago Techs. Int'l Sales PTE. Ltd.*, IPR2021-00431, Paper 8, at 3 (PTAB June 25, 2021).

12 *Id.*

13 *See, e.g., Apple Inc. v. Seven Networks, LLC,* IPR2020-00707, Paper 11, at 20 (PTAB Oct. 22, 2020).

14 *See, e.g., Apple Inc. v. Koss Corp.*, IPR2021-00600, Paper 9, at 10 (PTAB Sept. 1, 2021).

15 *See Med-El Elektromedizinische Geräte GES.M.B.H. v. Advanced Bionics AG*, IPR2021-00044, Paper 14, at 16–18 (PTAB Apr. 6, 2021) (discussing the impact of intervening guidance, Andrei Iancu, *Treatment of Statements of the Applicant in the Challenged Patent in Inter Partes Reviews under § 311*, available at https://www.uspto.gov/sites/default/files/documents/signed_aapa_guidance_memo.pdf (PTAB Aug. 18, 2020)).

16 *See, e.g., Regeneron Pharm, Inc., v. Novartis Pharma AG*, IPR2021-00816, Paper 13, at 3–4 (PTAB Oct. 26, 2021).

17 Joined petitions were excluded from the study.

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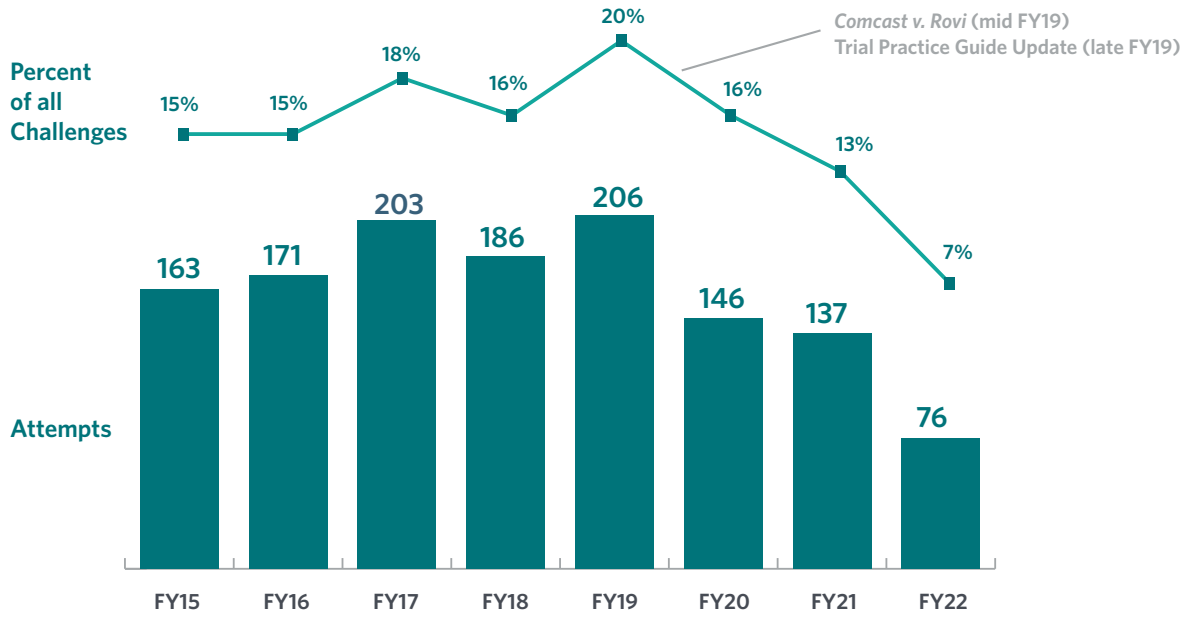

Figure 3. Parallel petitions: attempts per fiscal year (FY15 to FY22: October 1, 2014, to September 30, 2022).

During that same time period, the "success rate" of parallel petitions, i.e., the number of groups of parallel petitions resulting in multiple instituted trials, also declined from a high of 112 institutions (about 11% of challenges to a patent by a petitioner) in fiscal year 2019 to a low of 35 petitions (about 3.4% of challenges to a patent by a petitioner) in both fiscal years 2021 and 2022. Thus, parallel petition filings and their success rates have notably dropped since fiscal year 2019 and remain low today. *See* Figure 4.

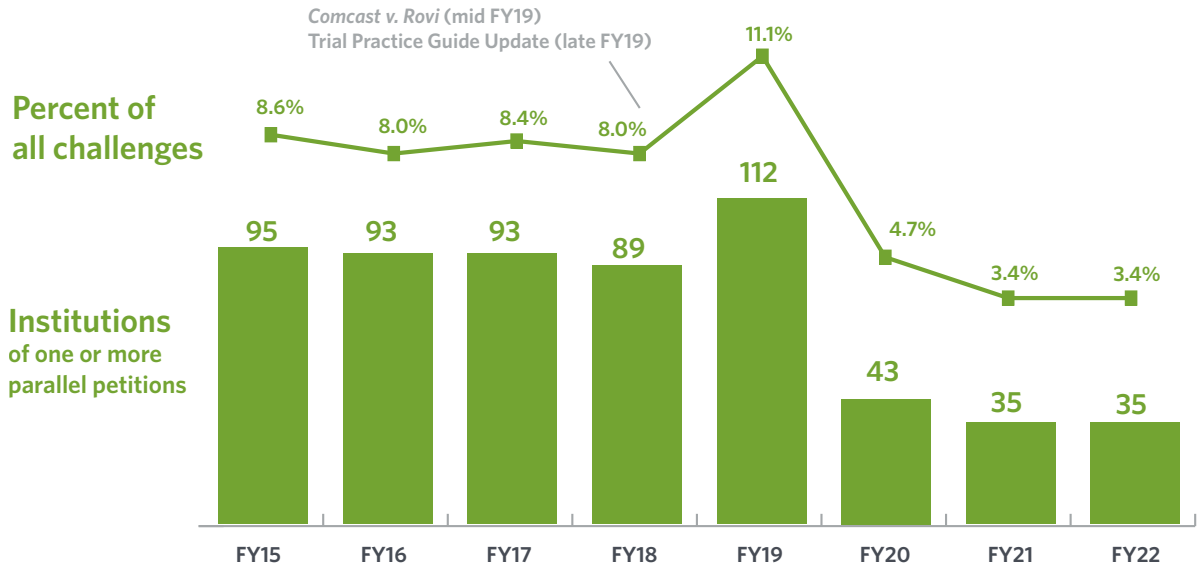

Figure 4. Parallel petitions: multiple instituted trials on parallel petitions per fiscal year (FY15 to FY22: October 1, 2014, to September 30, 2022).

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The study analyzed the groups of parallel petitions in which the PTAB instituted at least two trials. In most of those cases, the patent owner did not contest the filing of the parallel petitions.[18] In other cases, the patents included a large number of claims or the claims were complex,[19] the parties disputed whether references qualified as prior art,[20] or the parallel petitions challenged different claims.[21]

Overall Trends—Petitions Filed By Any Challenger

The study analyzed the number of patents that were challenged more than once, regardless of the petitioner. *See* Figure 5. The study indicates that most recently, in fiscal year 2022, 90% of challenged patents involved only one or two AIA petitions from any challenger. In addition, in fiscal year 2022, a significant majority (72%) of challenged patents were challenged only once, while 9% of patents were challenged more than twice.

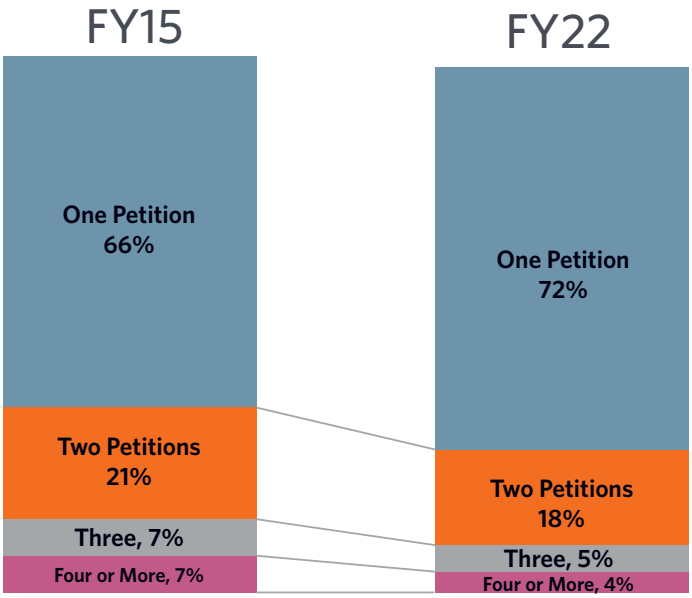

Figure 5. Single and multiple petitions from any challenger, overall trends, fiscal years 2015 (October 1, 2014, to September 30, 2015) and 2022 (October 1, 2021, to September 30, 2022). Due to rounding, percentages may not add up to 100%.

Summary

In AIA proceedings, most patents are challenged by only one petition. Moreover, institution of AIA trials based on multiple petitions are rare. Understanding that some circumstances may warrant more than one challenge, the USPTO has issued guidance detailing factors that PTAB panels consider when deciding whether to institute a trial based on a serial or parallel petition. This guidance has provided greater clarity and certainty as to how the PTAB analyzes such petitions and makes it clear that such serial or parallel petitions should be rare. After the USPTO issued guidance, petitioners have filed fewer multiple petitions, and the PTAB has instituted fewer AIA trials based on such petitions, and only under certain circumstances.

18 *See, e.g., Uber Techs., Inc. v. Agis Software Dev. LLC*, IPR2021-01308, Paper 11, at 13–14 (PTAB Jan. 7, 2022).

19 *See, e.g., Epic Games, Inc. v. Ingenioshare, LLC*, IPR2022-00295, Paper 11, at 17–20 (PTAB June 7, 2022).

20 *See, e.g., Samsung Elecs Co., Ltd. v. Lynk Labs, Inc.*, IPR2022-00051, Paper 19, at 25–26 (PTAB June 7, 2022); *Samsung Elecs. Co., Ltd. v. Lynk Labs, Inc.*, IPR2022-00052, Paper 20, at 6–7 (PTAB June 7, 2022).

21 *See, e.g., Solaredge Techs. Ltd. v. Koolbridge Solar, Inc.*, IPR2022-00007, Paper 10, at 12–13 (PTAB Apr. 19, 2022).

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