

Seyfarth PTAB Blog

A legal look at Patent Trial and Appeal Board decisions and trends



PTAB Grants Request for Rehearing

By *Patrick T. Muffo*

The PTAB rarely grants a request for rehearing on its decision to deny institution of a covered business method (CBM) or *inter partes* review (IPR). It is common for petitioners to request such rehearings, but exceedingly rare for the Board to grant them. The case of *Milwaukee Electric Tool Corp. v. Irwin Industrial Tool Co.*, case IPR2015-01462, (January 15, 2016) illustrates just how difficult it is to convince the PTAB to change their mind.

In *Milwaukee Tool*, the PTAB relented on its earlier decision to deny the *inter partes* review of certain claims of a patent directed to a hole cutter due to a typographical error in the original petition. Specifically, Milwaukee Tool petitioned for rehearing because the Petition included “a typo[graphical error] in the heading [that] might have caused the Board to overlook claims 21-30 in Ground 2 of the Petition.”

The Board went a step further by instituting the IPR for the inadvertently overlooked claims: “we are also persuaded that Petitioner has established a reasonable likelihood of prevailing in its challenge of claims 21-30 under Ground 2.”

Takeaway

As noted above, the Board rarely grants such Petitions on substantive grounds, and appears to have granted this Petition because it entirely overlooked the claims being challenged. In fact, granting such Petitions is so rare that the docket listing identified the order as a Decision **Denying** Rehearing, perhaps out of habit. This is also a rare case of the PTAB forgiving a petitioner for a typographical error or failure to follow the strict procedures set forth in the federal rules or Patent Trial Practice Guide.

[Patrick T. Muffo](#) is Editor of the Seyfarth PTAB Blog and senior associate in the firm’s Chicago office. For more information, please contact a member of the [Patent Practice Group](#), your Seyfarth Shaw LLP attorney or Patrick T. Muffo at pmuffo@seyfarth.com.
www.seyfarth.com

Attorney Advertising. This One Minute Memo is a periodical publication of Seyfarth Shaw LLP and should not be construed as legal advice or a legal opinion on any specific facts or circumstances. The contents are intended for general information purposes only, and you are urged to consult a lawyer concerning your own situation and any specific legal questions you may have. Any tax information or written tax advice contained herein (including any attachments) is not intended to be and cannot be used by any taxpayer for the purpose of avoiding tax penalties that may be imposed on the taxpayer. (The foregoing legend has been affixed pursuant to U.S. Treasury Regulations governing tax practice.)

Seyfarth Shaw LLP PTAB Blog | February 2, 2016

©2016 Seyfarth Shaw LLP. All rights reserved. “Seyfarth Shaw” refers to Seyfarth Shaw LLP (an Illinois limited liability partnership). Prior results do not guarantee a similar outcome.