

Seyfarth PTAB Blog

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



If at First You Don't Succeed... Change Your Petition

By Patrick T. Muffo

The PTAB declined to institute an *inter partes* review (IPR) proceeding after a petitioner challenged a patent for a second time and with substantially the same arguments. In the eyes of the Board, the second petition did nothing more than try to remedy the first, deficient petition using the same prior art, a process frowned upon by the PTAB.

The case of *Whole Space Industries, Ltd. v. Zipshade Industrial (BVI) Corp.*, (Case IPR2015-01632, January 29, 2016 Dec. Den. Inst.) involves a control system and method for raising and lowering window shades. The invention raises and lowers pleated window shades and Venetian blinds without requiring the manipulation of a cord or string.

Just how similar were the two petitions? The second petition challenged the same claims, involved the same parties, submitted mostly the same prior art with basically the same grounds of patentability, and included testimony from the same expert, whose declaration was identical in both petitions.

The petitions were not entirely identical, of course, but the second petition appeared to try to “plug the holes” of the first petition by citing other portions of the same prior art. The PTAB was not persuaded, and cited precedent supporting the principle that a first Board decision cannot serve as a roadmap for a second petition:

[A] first Board decision ‘should not act as an entry ticket, and a how-to guide, for the same Petitioner ... for filing a second petition to challenge those claims which it unsuccessfully challenged in the first petition.’ The Board also considers ‘the burden and inequity on the Patent Owner if it is forced to defend the same claims twice from attack by the same Petitioner.’

Applying the same principles, the Board exercised their discretion in declining to institute the IPR.

Takeaway

The Board has discretion whether to decline institution based on a second petition being substantially the same as the first. In this case, the similarities were glaring, but the dissimilarities related only to the deficiencies identified in the first Board decision. The PTAB made clear that the second petition cannot simply plug the holes of the first petition with the same prior art. When seeking a second bite at the apple, petitioners should focus on different prior art to avoid the Board denying institution based on “the same or substantially the same prior art” as set forth in 35 U.S.C. §325(d).

[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 post 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 23, 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.