

Seyfarth PTAB Blog



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

Second Attempt Inter Partes Review Petition Successful

By Christopher A. Baxter

William Edward Hickson, a nineteenth century British writer, once said “if at first you don’t succeed, try, try, try again.” This adage has recently come to fruition regarding Inter Partes Review (“IPR”) petitions. World Bottling Cap, LLC (“WBC”) petitioned for IPR of U.S. Patent No. 8,550,271 (the “’271 patent”) titled “Low Gauge Crown Cap,” and owned by Crown Packaging Technology, Inc. While the Patent Trial and Appeal Board (“PTAB”) denied institution of IPR based on a first filed petition, the PTAB nonetheless decided to institute IPR based on a second petition.

On November 24, 2014, WBC filed a petition for IPR of the ‘271 patent. *World Bottling Cap, LLC v. Crown Packaging Technology, Inc.*, IPR2015-00296, Paper No. 1 (PTAB November 24, 2014). In the petition, WBC argued the claims of the ‘271 patent were obvious in view of multiple references, and combinations thereof. *Id.* The PTAB denied institution of IPR based on the first petition, stating the prior art cited by WBC failed to teach a “shell formed of a [material/metal] comprising steel having an average hardness of greater than 62 on the 30T scale.” *World Bottling Cap, LLC v. Crown Packaging Technology, Inc.*, IPR2015-00296, Paper No. 6 (PTAB May 14, 2015). Thereafter, on July 31, 2015, WBC filed a second petition for IPR of the ‘271 patent. *World Bottling Cap, LLC v. Crown Packaging Technology, Inc.*, IPR2015-00296, Paper No. 1 (PTAB July 31, 2015). This time, the PTAB instituted IPR, finding WBC had established there was a reasonable likelihood WBC would prevail with regard to various claims of the ‘271 patent. *World Bottling Cap, LLC v. Crown Packaging Technology, Inc.*, IPR2015-00296, Paper No. 6 (PTAB February 11, 2016).

Whether IPR may be instituted based upon a second, follow-on petition is contingent on whether the two petitions contain the same or substantially the same prior art or arguments. 35 U.S.C. § 325(d) states, in relevant part, “[i]n determining whether to institute or order [an IPR], the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”

Whether IPR may be instituted based upon a second, follow-on petition is also contingent on whether the grounds of invalidity contained in the second petition were raised or reasonably could have been raised in the first petition. The estoppel provision of 35 U.S.C. § 325(e)(1), states the “petitioner in a post-grant review of a claim in a patent . . . that results in a final written decision under section 328(a) . . . may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that post-grant review.”

According to WBC's second petition, the prior art cited, in the first instance, in the second petition independently (i.e., without being combined with another reference) remedies the deficiency of WBC's first petition. *World Bottling Cap, LLC v. Crown Packaging Technology, Inc.*, IPR2015-00296, Paper No. 1, p. 2 (PTAB July 31, 2015). WBC also stated the prior art first cited in the second petition was not known to WBC prior to denial of the first petition by the PTAB because, despite previous prior art searches by multiple search firms, none of the searches identified the prior art reference first cited in the second petition. *World Bottling Cap, LLC v. Crown Packaging Technology, Inc.*, IPR2015-00296, Paper No. 1, p. 2-3 (PTAB July 31, 2015). While not explicitly stating so, the PTAB must have agreed with WBC's statements, because the PTAB decided to institute IPR based on the second petition.

Takeaways

Follow-on petitions may be filed to institute IPR on the same patent provided the prior art relied upon and the arguments in each petition are not the same or substantially the same, and provided the petitioner has a reasonable basis why newly cited prior art in the second petition was not raised in and could not have reasonably been raised in the first petition. However, petitioners should be cautioned about filing more than one petition due to the filing costs and attorney's fees associated with the preparation of each petition. As such, the petitioner may be well served to allocate more resources than expected to prior art searching in the first instance. Such additional prior art searching will likely be well less than the expenses of preparing and filing a second petition.

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Seyfarth Shaw LLP PTAB Blog | March 8, 2016

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