

April 7, 2020

Via email: [PTAB\\_Decision\\_Nomination@uspto.gov](mailto:PTAB_Decision_Nomination@uspto.gov)

The Honorable Andrei Iancu  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
Madison Building  
600 Dulany Street  
Alexandria, VA 22314

Chief Judge Scott R. Boalick  
Patent Trial and Appeal Board  
United States Patent and Trademark Office  
Madison Building  
600 Dulany Street  
Alexandria, VA 22314

Executive Judges Committee  
Patent Trial and Appeal Board  
United States Patent and Trademark Office  
Madison Building  
600 Dulany Street  
Alexandria, VA 22314

Dear Director Iancu, Chief Judge Boalick, and members of the Executive Judges Committee:

In accordance with Standard Operating Procedure 2, the High Tech Inventors Alliance (HTIA) writes to nominate five decisions of the Board for designation as precedential, and one decision for designation as informative. Each of those decisions relates to the institution of an Inter Partes Review (IPR) proceeding under 35 U.S.C. § 314(a).

To date, all but one of the precedential and informative decisions on IPR institution under 35 U.S.C. § 314(a) and § 325(d) have related to *denials* of institution. The imbalance in these precedents misleadingly suggests that the Board should err on the side of denying institution where a question under § 314(a)/325(d) arises. No such presumption is present in the statute or regulations, nor should it be. Further, the one-sided corpus of designations has created inconsistency among panels, as some rely heavily on these precedential and informative decisions, while others look to a broader range of appropriate factors not discussed in those decisions. Finally, institution decisions that do not consider a broader range of factors than the ones set forth in the currently designated decisions risk allowing invalid patent claims to survive merely because of one-sided procedural concerns. This result plainly undermines the Congressional mandate that IPR play an important role in improving patent quality. The full body of precedential and informative decisions must present a more balanced set of factors and analysis to future panels.

Moreover, in the currently designated cases, the Board has evaluated only the activities of the *petitioner* in connection with the § 314(a)/325(d) analysis. We believe this one-sided approach is inappropriate. The activities and behavior of both the petitioner and the patent owner are relevant and must be considered in making an institution decision. Below, we propose decisions for designation that address how the activities of the *patent owner* should also be evaluated. Because the vast majority of patents challenged in an IPR are also asserted in a co-pending district court case,<sup>1</sup> the patent owner's conduct in co-pending litigation has a direct impact on an IPR petitioner's ability to present its case to the Board. For instance, a petitioner's options will be shaped by the patent owner's decision to sue multiple parties on the same patent, either in parallel or serially; its assertion of large numbers of claims and refusal to narrow those claims in a timely fashion; and its request for unreasonably broad claim constructions in the early stages of a litigation.

The Board should weigh patent owner activity against petitioner activity *equally* when deciding whether to exercise its discretion to deny a petition. Indeed, several non-precedential decisions are in line with this approach. For instance, among the decisions HTIA is nominating for designation as precedential is *Microsoft Corp. v. IPA Techs., Inc.*, Case IPR2019-00814, Paper 12 (Nov. 6, 2019) ("*Microsoft-IPA*"). In instituting the petition, *Microsoft-IPA* details how a patent owner's litigation conduct of asserting a substantial number of claims and failing to narrow issues is just as relevant to the inquiry as the petitioner's decision to file multiple petitions.

In sum, despite the critical importance of a balanced institution analysis to the efficacy of the IPR system, not a single precedential or informative decision deals with a situation where an IPR proceeding was instituted after consideration of a patent owner's behavior in co-pending litigation. To remedy that imbalance, HTIA respectfully requests that the Board designate all or a significant subset of the cases listed below as precedential or informative.

## **I. Nominations for Precedential Designation**

### **1. *Microsoft Corp. v. IPA Techs., Inc.*, Case IPR2019-00814, Paper 12 (Nov. 6, 2019)**

In declining to exercise its discretion to deny institution under 35 U.S.C. § 314(a), the Board found that multiple petitions may be appropriate in circumstances where the patent owner has asserted a substantial number of claims in litigation and has declined to narrow issues. The Board also found that discretionary denial of institution is not warranted where an earlier petition challenged the same patent but the later petition is filed by an unrelated party and addresses different claims, as was the case in *Microsoft-IPA*. Further, the Board found that, where a petition advances an obviousness combination in which the primary reference, but not the secondary reference, was considered by the examiner during prosecution, *Becton-Dickinson* factors 1-3 weigh against denial under § 325(d).

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<sup>1</sup> See USPTO, "[An Analysis of Multiple Petitions in AIA Trials](https://www.uspto.gov/sites/default/files/documents/Chat%20with%20the%20Chief%20Boardside%20Chat%20Multiple%20Petition%20Study%2020171024.pdf)," available at <https://www.uspto.gov/sites/default/files/documents/Chat with the Chief Boardside Chat Multiple Petition Study 20171024.pdf>, slide 10.

2. *Google LLC v. Realtime Adaptive Streaming LLC*, Case IPR2019-01035, Paper 10 (Nov. 13, 2019) (“*Google-Realtime*”)

In declining to exercise its discretion to deny institution under 35 U.S.C. § 314(a), the Board found that the first *General Plastic* factor “strongly favors” institution where a prior petition challenged different claims, where the prior petition was dismissed before a final written decision, and where no significant relationship between the prior petitioner and the later petitioner exists. Under the fourth *General Plastic* factor, purported delay in filing an IPR petition that is in fact attributable to the patent owner’s own litigation decisions and conduct, including its decision to file staggered patent infringement lawsuits, does not weigh against institution.

3. *Intel Corp. v. VLSI Tech. LLC*, Case IPR2019-01192, Paper 15 (Jan. 9, 2020) (“*Intel-VLSI*”)

In declining to exercise its discretion to deny institution under 35 U.S.C. § 314(a), the Board found a petitioner’s decision to file an IPR petition on the “eve” of the one-year statutory deadline was appropriate where the petitioner waited until a patent owner narrowed the asserted claims in a co-pending district court proceeding and filed the IPR two months thereafter.

4. *Apple, Inc. v. UUSI, LLC d/b/a Nartron*, Case IPR2019-00358, Paper 12 (Aug. 5, 2019); Case IPR2019-00359, Paper 12 (Aug. 5, 2019)

In these proceedings, the petitioner filed two petitions on the same day for different claim sets of the same patent. The challenged patent was subject to an earlier IPR filed by another petitioner also defending allegations of infringement of the challenged patent. In declining to exercise its discretion to deny institution under 35 U.S.C. § 314(a), the Board evaluated the first *General Plastic* factor and found no significant relationship between the current and previous petitioner with respect to the patent at issue, unlike in *Valve Corp. v. Elec. Scripting Prod., Inc.*, Case IPR2019-00062, Paper 11 (Apr. 2, 2019) (precedential) (“*Valve*”). On the third *General Plastic* factor, the Board found that there was no policy reason for discretionary denial of institution where a petitioner takes into account prior proceedings that occurred before it was sued.

5. *Facebook, Inc. v. Blackberry Ltd.*, Case IPR2019-00516, Paper 7 (Aug. 5, 2019); Case IPR2019-00528, Paper 8 (Aug. 5, 2019)

In these proceedings, the petitioner filed two petitions four days apart on the same patent. In declining to exercise its discretion to deny institution under 35 U.S.C. § 314(a), the Board found that multiple petitions may be appropriate when each petition addresses alternative unpatentability arguments to account for different claim interpretations that may be advanced by the patent owner or adopted by the Board. Moreover, the Board found that discretionary denial under § 325(d) was inappropriate, even though individual references

overlapped, because the combinations and arguments in the two petitions were distinct and persuasive.

## II. Nominations for Informative Designation

1. *SolarEdge Techs. Ltd. v. SMA Solar Tech. AG*, Case IPR2019-01224, Paper 10 (Jan. 23, 2020)

This institution decision provides useful guidance for a petition on preparing a ranked list of petitions, and explaining the differences between multiple petitions filed against a single patent, as required by the Trial Practice Guide.

2. *Ingenico Inc. v. IOENGINE, LLC*, Case IPR2019-00929, Paper 16 (Sept. 26, 2019)

In these proceedings, the petitioner and another party were both involved in litigation with the patent owner, and the petitioner was indemnifying the other party. The petitioner and its indemnitee each filed two IPRs on the challenged patent. The Board, in declining to exercise its discretion under 35 U.S.C. § 314(a), found that the first *General Plastic* factor weighed strongly against the exercise of discretion to deny when different sets of claims were being challenged. The Board also found that the third *General Plastic* factor weighed against denial because the patent owner's preliminary response and the Board's decision were not received before filing the petition.

Thank you in advance for your careful consideration of these nominations for precedential and informative designation. If you have any questions or requests for additional information to aid you in assessing the nominated decisions, please do not hesitate to contact me by email at [dwjones@hightechinventors.com](mailto:dwjones@hightechinventors.com) or by phone at 425-681-7166.

Sincerely,



David W. Jones  
Executive Director  
High Tech Inventors Alliance

## Attachment

**List of Decisions Nominated for Designation**

<b>Case</b>	<b>Designation</b>
<i>Microsoft Corp. v. IPA Techs., Inc.</i> , Case IPR2019-00814, Paper 12 (Nov. 6, 2019)	Precedential
<i>Google LLC v. Realtime Adaptive Streaming LLC</i> , Case IPR2019-01035, Paper 10 (Nov. 13, 2019)	Precedential
<i>Intel Corp. v. VLSI Tech. LLC</i> , Case IPR2019-01192, Paper 15 (Jan. 9, 2020)	Precedential
<i>Apple, Inc. v. UUSI, LLC d/b/a Nartron</i> , Case IPR2019-00358, Paper 12 (Aug. 5, 2019); Case IPR2019-00359, Paper 12 (PTAB Aug. 5, 2019)	Precedential
<i>Facebook, Inc. v. Blackberry Ltd.</i> , Case IPR2019-00516, Paper 7 (Aug. 5, 2019); Case IPR2019-00528, Paper 8 (PTAB Aug. 5, 2019)	Precedential
<i>SolarEdge Techs. Ltd. v. SMA Solar Tech. AG</i> , Case IPR2019-01224, Paper 10 (Jan. 23, 2020)	Informative
<i>Ingenico Inc. v. IOENGINE, LLC</i> , Case IPR2019-00929, Paper 16 (Sept. 26, 2019)	Informative