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New developments in post-issuance proceedings

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Voluminous Declaration Leads to PTAB Denial of IPR Petition

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August 28, 2014 – In a decision of interest, the PTAB denied institution of *inter partes* review due to the Petitioner’s excessive reliance on a voluminous supporting declaration:

[IPR2014-00491 – Fidelity National Information Services, Inc. v. Datatrans Corp. \(Paper 9\)](#)

In this decision denying institution of an *inter partes* review, the Board refused to consider information contained in a supporting declaration, but not sufficiently presented in the petition itself. Under 37 C.F.R. § 42.22(a)(2) a petition must include a “full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence....” Here, Petitioner submitted a claim-by-claim analysis for nine grounds of unpatentability, alleging the prior art teaches or suggests each element of the claim. Petitioner chiefly cites to a 287 page declaration containing 1,278 paragraphs. In those paragraphs, the declarant points “almost exclusively to a 1,003 page, single-spaced, claim chart in landscape format appended to [the] Declaration as Exhibit A.” The claim chart then cites to the references themselves. Through this three-level incorporation technique – the petition incorporating the declaration, the declaration incorporating the claim chart, and the claim chart incorporating from the references – the Petitioner impermissibly sought to greatly expand its arguments in support of the petition.

The Board ruled that the “petition’s extensive reliance on citations to the ... Declaration in lieu of citations to the references themselves amounts to an incorporation by reference of arguments made in the ... Declaration into the Petition, thereby circumventing the page limits that apply to petitions.” The Board refused to consider the information found only in the declaration. Arguments made in a supporting document may not be incorporated by reference into a petition, pursuant to 37 C.F.R. § 42.6(a)(3).

The Leahy-Smith America Invents Act established new patent post-issuance proceedings, including the inter partes review, post grant review and transitional program for covered business method patents, that offer a less costly, streamlined alternative to district court litigation. With the U.S. Patent and Trademark Office's Patent Trial and Appeal Board conducting a large and increasing number of these proceedings, and with the law developing rapidly, Banner & Witcoff will offer weekly summaries of the board's significant decisions and subsequent appeals at the U.S. Court of Appeals for the Federal Circuit.



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