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PTAB Refuses to Give Petitioner a Second Chance to Articulate Reasons for Invalidity

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November 10, 2014 – In a decision denying institution of *inter partes* review, the PTAB executes its discretion under 35 U.S.C. § 325(d) to refuse to give a petitioner a second chance to provide invalidity arguments.

[IPR2014-01080 – Zimmer Holdings, Inc. and Zimmer, Inc. v. Bonutti Skeletal Innovations LLC \(Paper 17, October 31, 2014\)](#)

In a prior case, the petitioner filed a petition requesting *inter partes* review of several claims of a patent. The Board instituted *inter partes* review for all but one of the challenged claims. With respect to the excluded claim, the Board found that the petitioner did not demonstrate a reasonable likelihood of prevailing because the petitioner’s obviousness arguments merely addressed why the references would have been combined by asserting that the references are analogous art. In this case, the petitioner filed a second petition requesting *inter partes* review of the previously excluded claim and a motion seeking joinder of this case with the prior case.

In this case, the petitioner sought to remedy its insufficient arguments by providing additional reasoning to show obviousness. The Board noted that the asserted ground of unpatentability in this case is the same as that in the prior case. The Board also pointed out that the “Petitioner simply presents an argument now that it could have made in [the prior case], had it merely chosen to do so.” The Board characterized the request for this *inter partes* review as a request for “a second chance,” and rejected the petitioner’s policy argument that it was in the public’s interest to have the claim invalidated. Instead, the Board cited 37 C.F.R. § 42.1(b) (which emphasizes the goal of securing a “just, speedy, and inexpensive resolution of every

proceeding”) and explained that “permitting second chances...ties up the Board’s limited resources.” The Board then exercised its discretion to decline to institute *inter partes* review for the previously excluded claim under 35 U.S.C. § 325(d), which allows the Office to reject a request because “the same or substantially the same prior art or arguments previously were presented to the Office.”

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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