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PTAB Continues to Deny IPR Petitions, Based on Arguments Incorporated By Reference

By [Michael S. CuvIELLO](#)

September 22, 2014 – For the second time in a month (see our previous PTAB Highlight regarding IPR2014-00491 [here](#)), the PTAB has refused to consider arguments incorporated by reference into an IPR petition.

[IPR 2014-00454 – Cisco Systems, Inc. v. C-Cation Technologies, LLC \(Paper 12\)](#)

In this decision denying institution of an *inter partes* review, the PTAB held that the practice of using footnotes in the IPR petition to cite large portions of an expert declaration without sufficient explanation of those portions amounted to impermissible incorporation by reference. The Board cited several examples of incorporation by reference, including: a seven-page invalidity argument of claim 1 in the petition incorporating 17 pages of the expert declaration, the petition claim charts incorporating other claim charts in the expert declaration, and conclusory statements in the petition being supported only by footnote references to the expert declaration.

The PTAB panel of judges in this decision applied nearly identical reasoning as applied by a different panel of judges in the previous [IPR2014-00491](#). The Board in this case explained: “In the Petition before us, incorporation by reference of numerous arguments from Dr. Roy’s 250-page Declaration into the Petition serves to circumvent the page limits imposed on petitions for inter partes review, while imposing on our time by asking us to sift through over 250 pages of Dr. Roy’s Declaration (including numerous pages of claim charts) to locate the specific arguments corresponding to the numerous paragraphs cited to support Petitioner’s assertions.”

Without the incorporated expert declaration, the Board refused to institute the *inter partes* review, finding that the petition did not: “(1) specify sufficiently where each element of the

claims is found in the applied references, and (2) include a detailed explanation of the significance of the quotations and citations from the applied references. See 37 C.F.R. §§ 42.104(b)(4), 42.22(a)(2).”

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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