

4 Mistakes That Can Doom AIA Petitions

By Ryan Davis

Law360, New York (August 25, 2014, 5:49 PM ET) -- America Invents Act proceedings can be a powerful tool for invalidating patents, but only if the petitioner persuades the Patent Trial and Appeal Board to hear the case. Here, attorneys identify some common errors that have caused the board to reject petitions — and how to avoid them.

Overloading the Petition

Filing a petition seeking review under the AIA inter partes review or business method patent review programs involves striking a delicate balance. Petitioners must make their entire invalidity case in the initial filing, but the board has made clear that including every possible ground for invalidity in the petition is frowned upon.

For instance, in a July decision, the board denied Zetec Inc.'s petition challenging a Westinghouse Electric Co. LLC data analysis patent, ruling that it "would place a significant burden on the board" to fully evaluate the 127 possible grounds of invalidity cited in the petition, since it contained only sparse analysis of them.

Decisions like that serve as a stark reminder that to have any hope of the board instituting a review, petitioners must make clear, well-defined invalidity arguments that the board can get its arms around, attorneys say.

"Petitioners are going to have to be very diligent in clearly showing the reasons why prior art renders claimed inventions unpatentable to ensure that the board doesn't have to sift or search through the petition to find them," said Timothy Bianchi of Schwegman Lundberg & Woessner PA.

Petitioners often want to get as much into their initial filing as possible, but petitions are limited to 60 pages. Cramming numerous cursory arguments into that space seems to be a good way to alienate the board.

"The lesson there for practitioners is to limit the number of grounds to what you really think is helpful to your case," said David Cavanaugh of WilmerHale.

Giving the Board Too Little to Work With

At the same time, narrowing the invalidity arguments too much could also cause the board to reject the

petition. Relying on only one prior art reference to argue a patent is invalid is often not enough to persuade the board to review the patent, no matter how compelling the petitioner may consider the reference to be, attorneys say.

"We don't put all our eggs in one basket and try to have at least two different ways the claims can be found invalid," said Cavanaugh, chairman of WilmerHale's post-grant patent proceedings group, which has worked on nearly 100 AIA petitions.

While a single very strong reference might seem sufficient in some cases, including multiple grounds on which the patent can be invalidated can be more compelling for the board and "help create the story of unpatentability that you want to be able to tell," he said.

"You have to strike the right balance and recognize that the person reading the petition needs to have a sufficient amount of detail," he said.

Failing to Give Arguments Enough Support

The board has not been shy about rejecting petitions it has decided do not provide a strong evidentiary basis for the invalidity arguments, so petitioners should make sure to back up their positions with expert testimony, attorneys say.

For instance, the board has refused to institute reviews when the petitioner argues that a patent is an obvious combination of two prior art references, but fails to explain why it would be obvious to a skilled artisan to combine them.

"Just teeing up the references with broad claims of unpatentability is not enough," Bianchi said. "You must show how it would be obvious to one skilled in the art."

As a result, an expert declaration with a strong, technical rationale for combining the references can greatly enhance the petitioner's case.

"Having an expert who is able to explain why someone would combine the references is important to avoiding denial," Cavanaugh said.

Similarly, the board has not looked kindly on petitions that rely on a so-called inherency argument that lacks proper support. Inherency is when a petitioner argues that the prior art reference inherently includes a feature that would render the patent invalid, even though the feature is not expressly disclosed in the prior art.

Again, including an expert declaration to support such arguments can help petitioners make their cases, Bianchi said.

If the board is going to declare a patent invalid, it needs to provide an explanation of that outcome on the record, so "if you haven't given them any justification or evidence, it's hard for the board to give you what you want," he said.

Not Making a Claim Construction Case

As in other types of patent cases, the outcome of an AIA review can often hinge on how the claims of

the patent are construed, so it's important for petitioners to lay out their view on claim construction in the petition, attorneys say.

Many petitioners have opted not to include claim construction arguments in their petitions, or else to include only broad statements that the claims should be given their plain and ordinary meaning, without any more detail. But that can put them at a disadvantage, says Gilberto Espinoza of Michael Best & Friedrich LLP.

"One of the mistakes I have seen in petitions that are not granted is that the petitioner doesn't do an adequate job on claim construction," he said.

Omitting a claim construction argument from the petition means the patent owner will have the first opportunity in its preliminary response to define what the claims mean. Its view — likely substantially different from the petitioner's — could influence the board.

Making a claim construction argument in the petition, even if it is just to say that claims should be given their plain and ordinary meaning and then describing what that should be, gives the petitioner a way to get their views on the record early, Espinoza said. As a result, they won't have "come from behind" and argue against the patent owner's interpretation of the claims, he said.

"When you file the petition, you really get the first shot at taking control of the proceeding," he said.

--Editing by Kat Laskowski and Katherine Rautenberg.