

MAY/JUNE 2014  
VOLUME 20 NUMBER 3

DEVOTED TO  
INTELLECTUAL  
PROPERTY  
LITIGATION &  
ENFORCEMENT

*Edited by Gregory J. Battersby  
and Charles W. Grimes*

# IP *Litigator*



Wolters Kluwer  
Law & Business

---

# Four Important Strategic Considerations for Inter Partes Review Proceedings

David L. Cavanaugh, Christopher R. O'Brien,  
Heather Schafroth, Michael H. Smith, Vic Souto,  
and Michael J. Twomey, WilmerHale

*David L. Cavanaugh is a partner and Christopher R. O'Brien, Heather Schafroth, and Michael H. Smith are senior associates at WilmerHale in Washington, DC. Vic Souto is a special counsel at WilmerHale in New York, NY. Michael J. Twomey is a partner at WilmerHale in Boston, MA.*

Among the changes to the US patent law from the 2011 America Invents Act (AIA) is the *inter partes* review (IPR) proceeding. An IPR allows a third party, who has not previously filed a civil action challenging the validity of a claim of the patent, to petition for a review of the patentability of claims under 35 U.S.C. §§ 102, 103 on the basis of prior art patents or printed publications. The IPR is conducted before a panel of three Administrative Patent Judges on the Patent Trial and Appeals Board (PTAB).<sup>1</sup> This article explores four important strategic considerations for IPRs: (1) Claim Construction, (2) Discovery, (3) Cumulative Grounds for Institution, and (4) Real Parties-in-Interest and Privies. While this list is in no way exhaustive, our hope is to share some helpful insights on IPR practice.

## Claim Construction

When the same patent claims are at issue in both a district court and an IPR, predicting how each forum's claim constructions might affect the other's is a key strategic question. Each forum applies a different claim construction standard and uses a different claim construction procedure. This could lead to different constructions of the same claim in a district court litigation and an IPR. Despite these differences and potential conflicts—or because of them—each forum is likely to consider the constructions of the other.

## Different Claim Construction Procedures

The process for determining claim constructions in a district court is different from the process used in an IPR.

District court litigation provides opportunities for the parties to propose constructions and argue for their constructions through briefing and a hearing known as a *Markman* hearing.<sup>2</sup> The district court then issues a claim construction opinion during the course of the litigation.

In an IPR proceeding, the parties may provide less detailed claim construction arguments than in a district court. The petitioner challenging the patent claims at least must identify “[h]ow the challenged claim is to be construed.”<sup>3</sup> The petitioner may decide to satisfy this requirement by “merely provid[ing] a statement that the claim terms are presumed to take on their ordinary and customary meaning,” as well as “point[ing] out any claim term that has a special meaning and the definition in the specification.”<sup>4</sup> However, the petitioner often provides some analysis of claim construction, especially where it can expect the patentee to argue for narrower claim constructions. The patentee is not required to propose any claim constructions in an IPR proceeding, but often argues for narrow constructions in view of the identified prior art. The PTAB may or may not rely on the parties for claim constructions.

## Different Claim Construction Standards

District courts and the PTAB apply different claim construction standards. District courts use the “ordinary and customary meaning” claim construction standard provided by the Federal Circuit in *Phillips v. AWH Corp.*<sup>5</sup> In IPR, the PTAB uses the “broadest reasonable construction” standard.<sup>6</sup> This difference results from the ability of a patentee to amend its claims in an IPR proceeding but not in a district court.<sup>7</sup>

A district court construes a patent claim in light of the claim language, specification, prosecution history, and appropriate dictionary definitions.<sup>8</sup> A district court must presume that an asserted patent claim is valid.<sup>9</sup> Clear and convincing evidence is required to invalidate a patent claim in a district court.<sup>10</sup>

---

In an IPR proceeding, the PTAB must give a claim “its broadest reasonable construction in light of the specification of the patent in which it appears.”<sup>11</sup> The PTAB does not presume a patent is valid, and requires only a preponderance of the evidence to invalidate a claim.<sup>12</sup>

## Observations

The different claim construction standards used in an IPR and in a district court may result in claim constructions of different breadth. The IPR claim construction standard generally results in a broader construction than the district court standard.

This tension between district court and IPR claim constructions requires strategic analysis and tradeoffs. Although a broad construction might increase the prior art that is available for invalidating a claim, a broad construction also could increase the chance that a product might infringe the claim. A petitioner may have to take a claim construction position in an IPR proceeding without knowing what the patentee’s infringement position in the related district court litigation will be.

## Discovery

The rules governing IPR proceedings provide for discovery by the parties. The discovery provided for IPRs, however, is much less than is allowed in district court.

The AIA distinguishes between “routine” discovery and “additional” discovery. Routine discovery includes:

1. production of exhibits cited in a paper or testimony;
2. cross-examination of opposing declarants; and
3. “noncumulative information that is inconsistent with a position advanced during the proceeding.”<sup>13</sup>

All other discovery is considered “additional discovery.” The parties may agree to provide any requested additional discovery. If the parties cannot agree, however, the party seeking discovery may file a motion seeking additional discovery by showing that its requests are “in the interests of justice.”<sup>14</sup>

The “interests of justice” standard is not new to US Patent and Trademark Office (PTO) proceedings. The Board of Patent Appeals and Interference (BPAI), the predecessor to the PTAB, has addressed requests for additional discovery under the “interests of justice” standard since the PTO’s Rules of Practice were amended to provide for discovery in 1971 in certain PTO proceedings.<sup>15</sup>

During the first year of the IPR process, the PTAB addressed the standard for additional discovery in several decisions that provide additional guidance on what discovery the PTAB may allow under the standard.<sup>16</sup>

## Applications of the “Interests of Justice” Standard

### *Garmin v. Cuozzo*

The first decision is *Garmin International, Inc., et al. v. Cuozzo Speed Technologies LLC*. In *Garmin*, the patent owner Cuozzo filed a motion for additional discovery related to its potential assertion of secondary considerations of nonobviousness.<sup>17</sup> The PTAB listed five factors that it considers in authorizing a motion for additional discovery under the “interests of justice” standard. The five factors the PTAB identified were

1. the request is based on more than a possibility and mere allegation,
2. the request does not seek litigation positions and underlying basis,
3. the information must be not reasonably available through other means,
4. the request is easily understandable, and
5. the request is not overly burdensome to answer.<sup>18</sup>

In *Garmin*, the PTAB focused on the first factor: “The mere possibility of finding something useful, and the mere allegation that something useful will be found, are insufficient” to satisfy the “interests of justice” standard. Significantly, the PTAB indicated that “[t]he party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.”<sup>19</sup>

The PTAB noted that “useful” in this context does not mean merely relevant and/or admissible, but rather “favorable in substantive value to a contention of the party moving for the discovery.”<sup>20</sup> The PTAB rejected the patent owner’s requests, finding that Cuozzo’s motion lacked a threshold amount of evidence or reasoning required under an “interests of justice” standard.<sup>21</sup>

### *Microsoft v. Proxyconn*

The second decision is *Microsoft v. Proxyconn*. In *Microsoft*, the PTAB denied the patent owner Proxyconn’s request for additional discovery on the issue of secondary considerations. The PTAB began its analysis by citing the portion of the AIA legislative history to show that the “interests of justice” were “limited to minor discovery and special circumstances.”<sup>22</sup>

In denying the request, the PTAB noted that the law for establishing secondary considerations was well established and required the patentee to demonstrate “that the sales were a direct result of the unique characteristic of the claimed invention.”<sup>23</sup> Despite Proxyconn’s arguments that requiring such proof of such a nexus was “premature,” the PTAB explained that “a showing of relevance

---

[must] be made by the party seeking additional discovery before the request is granted.”<sup>24</sup>

### **Corning v. DSM IP Assets**

The third decision is *Corning Inc. v. DSM IP Assets B.V.* In *Corning*, the PTAB reviewed three separate requests by the patent owner for additional discovery: (1) Laboratory notebooks containing information and test results relied on in the proceeding, which was granted, (2) samples of compositions prepared by petitioner, and (3) “any test results inconsistent” with petitioner’s positions about the properties of the compositions, both of which were denied.<sup>25</sup>

In granting the request for additional discovery on the laboratory notebooks, the PTAB was persuaded that the information was “per se useful” under the guidance of *Garman* because the petitioner proffered expert testimony which relied on the details in the laboratory notebooks. The PTAB didn’t identify any of the other factors used in *Garman* as being a basis to deny the request for discovery.

The PTAB denied DSM’s remaining requests for additional discovery.<sup>26</sup> The PTAB noted that it limited the additional discovery to data underlying the compositions that were relied on in the petition, and DSM failed to explain “why it needed the information” and “provide[d] no indication that it is in possession of information tending to show beyond speculation that in fact something useful will be uncovered by the request.”<sup>27</sup>

### **Observations**

Based on a review of these PTAB decisions, it is apparent that the “interests of justice” standard places a high bar for patent practitioners to obtain additional discovery in *IPR* proceedings. Indeed, the PTAB’s additional discovery decisions should be viewed in the context of the statutory deadline imposed on the PTAB to complete patent trials within one year of a decision on an *IPR* petition, as discussed in *Garmin*:

Limited discovery lowers the cost, minimizes the complexity, and shortens the period required for dispute resolution. There is a one-year statutory deadline for completion of *inter partes* review, subject to limited exceptions. What constitutes permissible discovery must be considered with that constraint in mind.<sup>28</sup>

In view of the PTAB’s determinations thus far, discovery in *IPR* proceedings will likely include “routine discovery” and such “additional discovery” that the parties agree on. Only in rare circumstances will the parties have sufficient facts to meet the “interests of justice” standard for nonagreed on additional discovery. However, as demonstrated by the *Corning* case, there likely will be some circumstances, perhaps rare, where the PTAB will find

that the “interests of justice” standard is met and will allow additional discovery.

## **Cumulative Grounds for Institution**

In *IPR* proceedings, a party seeking to challenge the validity of a patent files a petition identifying one or more grounds of unpatentability. The PTAB, using a reasonably likely to prevail on at least one ground standard, evaluates the petition (and a Patent Owner preliminary response if filed) and makes a Decision on Institution, including a determination of what grounds of unpatentability will be part of the post grant proceeding. The PTAB may use the Decision on Institution to limit the number of issues in the proceeding by denying some grounds on the basis that they are “redundant” or “cumulative” to issued grounds.<sup>29</sup>

Two general types of grounds frequently have been determined to be cumulative: several primary references with largely overlapping disclosures or teachings; and/or multiple secondary references that are used in a ground alleging a claim is obvious. In denying some petitioner grounds for invalidity as “redundant” or “cumulative,” and limiting the grounds of unpatentability that become the subject of the proceeding to fewer than all the grounds proffered in the petition, the PTAB has emphasized that considering multiple rejections for the same issue would unnecessarily consume time and resources of all the parties involved.<sup>30</sup> Often, while explaining why the grounds were redundant, the PTAB indicates that the petitioner did not adequately describe differences between the instituted grounds and the redundant grounds.<sup>31</sup> Also, the PTAB mentions that narrowing the issues to exclude any redundant grounds can assist them in complying with their statutory mandate that the proceedings be completed within one year from institution.<sup>32</sup>

### **Avoiding “Cumulative” Grounds When Preparing a Petition**

Anyone who has prepared a petition for a post grant proceeding knows too well the practicality of keeping the petition within the page limit.<sup>33</sup> This requires discipline in the petition drafting process that was not a part of the *inter partes* reexamination request preparation process. To ensure a petition presents multiple, noncumulative grounds, thoughtful selection of grounds presented is critical. Thus, it is important to provide strategic distinctions between the references in a petition to increase the likelihood that the PTAB will institute proceedings on multiple grounds.

A careful and succinct explanation of the differences between references may identify that some grounds would be applicable based on alternative claim

construction presented earlier in the petition. In other circumstances it may be because some references could be subject to being antedated while others could not. The PTAB has shown that it will carefully review the petition but they cannot read the petitioner's mind.

## Strategic Challenges for the Petitioner

What can a petitioner do after a finding of cumulative grounds? There are limited options. The petitioner may file a Request for Rehearing.<sup>34</sup> The dissatisfied party bears the burden of showing that the decision should be modified and must "specifically identify" all the matters that the PTAB "overlooked" or "misapprehended."<sup>35</sup> The PTAB considers the request and issues an opinion. To date such Requests almost universally are denied and do not lead to a modification of the grounds of unpatentability.<sup>36</sup> There are no other avenues to challenge the Board decision on institution, as the AIA statute specifically excludes a right to appeal the decision on institution.<sup>37</sup>

There may be other ways to bring denied grounds and cumulative references into the proceeding. If the patent owner files a motion to amend the patent, the petitioner may respond with references, including references previously found to be cumulative, that challenge the validity of any new or amended claims.<sup>38</sup> Other circumstances to introduce the references may present themselves based on the particular merits of a proceeding.

## Observations

The decision on institution is a substantial milestone in the post grant proceeding. The PTAB has shown that it carefully reviews references and the challenged claims while applying its claim construction. The number of petitions filed suggests that stakeholders are optimistic that the PTAB will apply the law and, when proper, invalidate a challenged claim. The decisions on institution made to date suggest that the process is on track. As additional final written opinions are issued from the PTAB the patent community will have a better sense of the overall outcome of the process.

## Real Parties-in-Interest and Privies

The PTAB will not institute an IPR unless the petition includes an identification of "each real party-in-interest" for the petition.<sup>39</sup> This requirement is important because final written decisions in IPRs act to estop the real parties-in-interest, as well as the privies of the petitioner, from asserting claims the "petitioner raised or reasonably could have raised

during that *inter partes* review," both in proceedings before the PTO<sup>40</sup> and in civil actions and other proceedings.<sup>41</sup>

## Identifying Real Parties-in-Interest

At a minimum, a real party-in-interest is "the party or parties at whose behest the petition has been filed."<sup>42</sup> In its Office Patent Trial Practice Guide (Practice Guide), however, the PTO cautions that whether a party is a real party-in-interest is a "highly fact-dependent question."<sup>43</sup> To determine whether a party is a real party-in-interest, the PTO applies traditional common law principles with the goals of "identifying potential conflicts" and "assur[ing] proper application of the statutory estoppel provisions."<sup>44</sup>

Although determining the real parties-in-interest is highly fact-specific, the Practice Guide and related decisions provide some helpful guidance.

1. *Funding and Control*: Where a party funds and directly controls an IPR, it is likely that the party would be found to be a real party-in-interest.<sup>45</sup> The Practice Guide states that "a party that funds and directs and controls an IPR or PGR petition or proceeding constitutes a 'real party-in-interest,' even if that party is not a 'privy' of the petitioner."<sup>46</sup>
2. *Membership in a Joint Defense Group (JDG)*: Mere participation in a JDG is unlikely to make a defendant a real party-in-interest.<sup>47</sup> Rather, the PTAB will consider factors such as a party's relationship to the petitioner, a party's relationship to the petition itself, the nature and/or degree of involvement in the filing, and the nature of the entity filing the petition to make the fact-specific determination whether the party is a real party-in-interest.<sup>48</sup>

The Practice Guide also cites *Taylor v. Sturgell*, in which the Supreme Court gave a nonexhaustive list of circumstances in which a nonparty to a lawsuit can be bound by a judgment in that suit.<sup>49</sup> The six *Taylor* examples are:

1. agreement to be bound by a judgment;
2. "substantive legal relationships" such as "preceding and succeeding owners of property, bailee and bailor, and assignee and assignor";
3. a nonparty was adequately represented in a "representative suits" such as "properly conducted class actions ... and suits brought by trustees, guardians, and other fiduciaries";
4. a nonparty that "assumed control over the litigation in which that judgment was rendered" even though it was not formally represented in the litigation;
5. "a person who did not participate in a litigation later brings suit as the designated representative of a person who was a party to the prior adjudication"; and

- 
6. statutory preclusion, such as in bankruptcy or probate proceedings, as long as the statute is “consistent with due process.”<sup>50</sup>

Given potential estoppel issues, if members of a JDG are considering an IPR, members who do not want to participate in the IPR should be careful to avoid certain interactions with other members that could create an estoppel. To reduce estoppel risk, defendants should avoid reviewing or commenting on any draft IPR petitions, directly or indirectly contributing to the funding of the IPR, or communicating with other members of the JDG concerning the IPR petition or IPR process.

## Identifying Privies

The Practice Guide states that the “notion of ‘privity’ is more expansive, encompassing parties that do not necessarily need to be identified in the petition as a ‘real party-in-interest,’” and depends on whether, applying equitable considerations established under federal case law, the “relationship between the purported ‘privity’ and the relevant other party is sufficiently close such that both should be bound by the trial outcome and estoppels.”<sup>51</sup> The Practice Guide also notes that “the legislative history of the AIA [] indicates that Congress included ‘privies’ within the parties subject to the statutory estoppel provisions in an effort to capture ‘the doctrine’s practical and equitable nature,’ *in a manner akin to collateral estoppel.*”<sup>52</sup>

Because the real party-in-interest and privity analyses draw on collateral estoppel principles that are issues of regional circuit law, attorneys should carefully study the law regarding collateral estoppel in the court where the litigation is pending.

## Challenging the Identification of Real Parties-in-Interest

Although the PTAB generally will accept the petitioner’s identification of the real parties-in-interest,<sup>53</sup> the patent owner may challenge the identification by providing objective evidence that the petitioner failed to properly identify each real party-in-interest.<sup>54</sup> When the patent owner raises sufficient concerns regarding the petitioner’s certifications, the PTAB may authorize additional discovery related to the challenge.<sup>55</sup> The PTAB is unlikely, however, to grant additional discovery based on “mere allegation and speculation.”<sup>56</sup> Rather, the patent owner must provide evidence that there is something additional to discover.<sup>57</sup>

Challenges to a petitioner’s identification of the real parties-in-interest should be submitted before or with the filing of the patent owner’s preliminary response.<sup>58</sup>

Bringing such challenges earlier can increase the likelihood that the PTAB will allow the patent owner to take pertinent discovery.<sup>59</sup> After the patent owner’s preliminary response, the PTAB is less likely to authorize additional discovery because the PTAB must determine whether to institute the review within three months of the preliminary response.<sup>60</sup>

## Board Decisions on Real Parties-in-Interest

The Board’s initial decisions shed additional light on considerations for identifying the real parties-in-interest and challenging those identifications. Additionally, the Board’s decisions illustrate the strategic implications of real parties-in-interest with respect to the procedural requirements, statutory bars, and estoppel provisions.

In *Intellectual Ventures Management, LLC v. Xilinx, Inc.*,<sup>61</sup> the PTAB was not persuaded by Xilinx’s argument that Intellectual Ventures failed to identify 63 entities contained in a certificate of interested entities in an unrelated district court proceeding as real parties-in-interest. The PTAB acknowledged that the certificate identified parties that may have a financial interest in that proceeding, but declined to find those entities as real parties-in-interest to the IPR proceeding. Particularly, the PTAB noted that the considerations for being an interested entity (*e.g.*, a public corporation owning 10 percent or more of stock) were not the same as real parties-in-interest in IPR proceedings.

In *Innolux Corporation v. Semiconductor Energy Laboratory Co., Ltd.*,<sup>62</sup> Semiconductor Energy Laboratory (SEL) asserted that Innolux failed to identify all real parties-in-interest by not listing codefendants in a related litigation. Particularly, SEL argued that Innolux’s codefendants were real parties-in-interest based on their participation in filing a joint motion to stay the litigation in view of the IPR proceeding.

The PTAB disagreed. The PTAB stated that SEL had not shown that the codefendants “necessarily co-authored the Petition or otherwise exerted control over its contents, or will exert control over the remaining portions of this proceeding” or “provided funding for the instant Petition.” The PTAB further stated that an agreement by codefendants to be bound by a decision in an IPR does not dictate that they are real parties-in-interest.

The PTAB also denied SEL’s motion for additional discovery to support its contention.<sup>63</sup> The PTAB concluded that SEL had not demonstrated that the requested additional discovery was likely to uncover useful information and was thus not in the interest of justice. The PTAB also noted that Innolux had certified that it was the only real party-in-interest and was under an ongoing obligation to disclose any conflicting information.

The PTAB considered whether certain contractual agreements gave rise to a real party-in-interest relationship in *Apple Inc. v. Achates Reference Publishing, Inc.*<sup>64</sup> The PTAB disagreed with Achates' argument that Apple's codefendants in a related litigation were real parties-in-interest based largely on a software development agreement. The PTAB noted that the agreement did not give the codefendants the right to intervene or control the petitioner's defense for patent infringement. The PTAB also noted that the petitioner and its codefendants had distinct interests in the related litigation. Accordingly, the PTAB found that the petitioner would still be exposed to an adverse judgment in the related litigation based on its own actions, even if a judgment was obtained against one of the codefendants.

The PTAB rejected an argument that a petitioner should be statutorily barred from filing a petition in *Chi Mei Innolux, Corp. v. Semiconductor Energy Laboratory Co., Ltd.*<sup>65</sup> The PTAB disagreed with SEL that Chi Mei Innolux's (CMI) petition was barred because its codefendants were served with a complaint more than one year before filing. The Board concluded that CMI's codefendants were not real parties-in-interest because there had been no showing that the codefendants had any control over the content of the petition. The PTAB stated that simply accusing parties together of separate infringements of a single patent does not join such parties as real parties-in-interest. The PTAB reiterated that additional factors such as control and/or funding must be established.

These initial decisions, consistent with the Trial Practice Guide, suggest that the PTAB will consider

many factors when determining whether a nonparty is a real party-in-interest but will focus primarily on control and funding. The PTAB also will require a moving party to present strong evidence to support any argument that the ongoing disclosure obligation of the other party is not being satisfied. Further, the PTAB appears unlikely to grant motions for additional discovery to determine whether a party did indeed fail to disclose all real parties-in-interest.

## Observations

Potential petitioners must carefully consider the type and closeness of relationships with third parties well before preparing a petition, to determine whether those parties may qualify as real parties-in-interest. Petitioners should consider any contractual agreements (e.g., customer/supplier and licensee/licensor), participation in related litigation (e.g., joint defendants/joint defense agreements), involvement in the preparation of the petition, control over the petition, and any funding of the petition by the third party. Based on this analysis, petitioners must prepare not only for the procedural requirements of identifying the real parties-in-interest but must contemplate whether the activities of a real party-in-interest may statutorily bar or estop the proceeding.

Over the first year, the PTAB has repeatedly instituted IPR proceedings over objections relating to the real party-in-interest disclosure requirement and the statutory bar provisions. However, these provisions should not be discounted as they can still raise strong defenses to institution given the correct circumstances.

---

1. The PTAB is the new name for the Board of Patent Appeals and Interferences.  
2. See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (1995).  
3. 37 C.F.R. § 42.104(b)(3).  
4. Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,679, at 48,700 (Aug. 14, 2012); see also PTO trial practice guide, 77 Fed. Reg. 48764 ("where a party believes that a specific term has meaning other than its plain meaning, the party should provide a statement identifying a proposed construction of the particular term and where the disclosure supports that meaning").  
5. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-1318 (Fed. Cir. 2005) (en banc) (describing the claim construction standard in district court litigation).  
6. 37 C.F.R. § 42.100(b) (providing the claim construction standard for *inter partes* reviews).  
7. See 35 U.S.C. § 326(d).  
8. See *Phillips*, 415 F.3d at 1312-1318.  
9. See 35 U.S.C. § 282(a).  
10. See *Microsoft Corp. v. i4i Ltd. P'ship*, 131 S. Ct. 2238, 2243 (2011) ("[35 U.S.C. § 282 creates a presumption that a patent is valid and imposes the burden of proving invalidity on the attacker. That burden is constant and never changes and is to convince the court of invalidity by clear evidence." (quoting *Am. Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1360 (Fed. Cir. 1984))).  
11. 37 C.F.R. § 42.100(b).  
12. 35 U.S.C. § 316(e).  
13. See 37 CFR §§ 42.51(b)(1)(i)-(iii).  
14. See Rule 41.51(b)(2)(i).  
15. A full discussion of these early decisions is beyond the scope of this article. Additional discussion can be found in McKelvey, "Discovery Before the

Board of Patent Interferences," 58 *J.P.O.S.* 186 (1976), where former Chief Administrative Patent Judge McKelvey provides examples of requests for additional discovery in patent interference proceedings where the PTAB determined whether a request satisfied the "in the interest of justice" standard.  
16. It is important to note that PTAB panel decisions are not binding on other PTAB panels.  
17. *Garmin Int'l, Inc., et al. v. Cuozzo Speed Technologies LLC*, IPR2012-00001, March 5, 2013, Paper No. 26 at 8. Note that Cuozzo first argued that all of its requests were routine, because they merely sought discovery about inconsistent positions. The PTAB rejected that argument because the requests were not narrowly directed to information known to the petitioner to be inconsistent with positions taken in the petition. They were instead broadly directed at general categories of information that could include, but were not limited to, discovery about inconsistent positions.  
18. *Garmin* at 6-7.  
19. *Id.* at 6.  
20. *Id.* at 7.  
21. *Id.* at 8.  
22. *Microsoft v. Proxycorr*, IPR2012-00026 & IPR2013-00109, March 8, 2013, Paper No. 32 at 4.  
23. *Id.*  
24. *Id.* at 5 (emphasis in original).  
25. *Corning Inc. v. DSMIP Assets B.V.*, IPR2013-0043-50, 52 and 53, June 21, 2013, Paper No. 25 at 2.  
26. *Id.* at 5-7.  
27. *Id.* at 7.  
28. *Garmin* at 5-6, internal citations omitted.  
29. See, e.g., IPR2013-00011; CBM2012-00003; CBM2012-000007 and IPR2012-00014.

30. *See, e.g.*, IPR2013-2011.
31. *See, e.g.*, CBM2012-00003, IPR2013-00088.
32. *See, e.g.*, IPR2013-00057.
33. 37 C.F.R. § 42.24 (a) “the following page limits for petitions apply... (i) Petition requesting inter partes review: 60 pages ... (iii) Petition requesting covered business method patent review: 80 pages.”
34. 37 C.F.R. § 42.71 (d) “A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the PTAB.”
35. *Id.*
36. The Board of Patent Appeals and Interferences had a similar reluctance to modify the outcome of a decision in Ex Parte prosecution.
37. 35 U.S.C. § 314 (d) No Appeal.—The determination by the director whether to institute an IPR under this section shall final and nonappealable. *See also*, 35 U.S.C. § 324 (e) No Appeal.—The determination by the director whether to institute a post-grant review under this section shall final and nonappealable.
38. 37 C.F.R. § 42.121(a) Motion to amend. A patent owner may file one motion to amend a patent, but only after conferring with the PTAB.
39. 37 CFR § 42.8(b)(1).
40. With regard to proceedings before the Office, 35 U.S.C. § 315 (e)(1) provides: “The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party-in-interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review”; *see also* 37 CFR § 42.73(d).
41. With regard to civil actions and other proceedings, 35 U.S.C. § 315(e)(2) provides: “The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party-in-interest or privy of the petitioner, may not assert either in a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.”
42. Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48759 (Aug. 14, 2012).
43. *Id.*
44. *Id.*
45. *Id.* at 48760.
46. *Id.*
47. Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48760 (Aug. 14, 2012).
48. *Id.*
49. Taylor v. Sturgell, 553 U.S. 880, 894 (2008).
50. *Id.* at 893-895.
51. Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48759 (Aug. 14, 2012).
52. *Id.* (emphasis added).
53. Changes to Implement Inter Parties Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, Final Rule, 77 Fed. Reg. 48680, 48685 (Aug. 14, 2012).
54. *Id.*
55. *Id.*
56. Apple v. Achates Reference Publishing, Cases IPR2013-00080 and -00081 Decision on Achates Motion for Additional Discovery at 7 (April 3, 2013) (“The evidence and argument presented by Achates amount to only a mere allegation and speculation that one or more of the co-defendants are real parties-in-interest or privies of Apple, and do not convince us that the requested additional discovery is likely to uncover information useful to the instant proceedings. Achates therefore has not met its burden to demonstrate that additional discovery is in the interests of justice.”)
57. *See id.* Additionally, if a patent also is asserted in a district court litigation, a party may be able to obtain discovery related to the identification of real parties-in-interest through the district court. *See, e.g.*, Bortex Industry Co., Ltd. v. Fiber Optic Designs, Inc., Docket No. 12-4228 (E.D. Penn. 2013) (allowing discovery relating to the financial contributions of a party toward a post grant proceeding prepared and filed by another party).
58. Changes to Implement Inter Parties Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, Final Rule, 77 Fed. Reg. 48680, 48685 (Aug. 14, 2012).
59. *Id.*
60. *Id.*
61. Intellectual Ventures Management, LLC v. Xilinx, Inc., IPR2012-00018, January 24, 2013, Paper No. 12.
62. Innolux Corporation v. Semiconductor Energy Laboratory Co., Ltd., IPR2013-00038, March 21, 2013, Paper No. 12.
63. *See* Innolux Corp. v. SEL, IPR2013-00038, May 21, 2013, Paper No. 25.
64. *Apple Inc.* Paper No. 22.
65. Chi Mei Innolux, Corp. v. Semiconductor Energy Laboratory Co., Ltd., IPR2013-00028, March 21, 2013, Paper No. 14.