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PATENTS

The authors review PTAB decisions on follow-on petitions challenging issued patents and provide practice tips for both petitioners and patent owners.

The Prevailing Uncertainty of a Second Bite at the Apple at the PTAB Under § 325(d) in Multiple Proceeding Cases



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After filing a first post-grant proceeding, whether an inter partes review, a covered business method proceeding or a post-grant review petition challenging certain claims of a patent, the same petitioner may decide to file a follow-on petition challenging the same claims of the same patent. The reasons for filing another petition may vary, for example: (1) the first petition was denied and the Patent Trial and Appeal Board panel identified certain deficiencies that the petitioner would like to correct in a second petition; (2) the peti-

tioner would like to raise new grounds or new prior art that the petitioner did not raise in the first instance; or (3) the law changed since the petitioner filed its first petition. Under any of these circumstances, can a petitioner expect a PTAB panel to consider its second petition on the merits?

Under 35 U.S.C. § 325(d), Multiple Proceedings, Congress gave the Patent and Trademark Office director—and by extension the Board—discretion to deny a follow-on petition in a multiple proceedings case: “In determining whether to institute or order a proceeding under this chapter [post-grant review], . . . or chapter 31 [inter partes review], the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office” (emphasis added). Not only is the Board’s authority to deny a petition discretionary, but the criteria for rejecting the petition under § 325(d) is vague (“whether . . . the same or substantially the same prior art or arguments previously were presented to the Office”) (emphasis added). Thus, it is not surprising that the Board’s decisions in multiple proceedings cases have varied significantly.

There have been almost 90 cases through Nov. 22, 2015, where the same Petitioner has filed follow-on proceedings under chapter 31 (inter partes review) or chapter 32 (post-grant review).¹ In a majority of those cases (roughly 48 times), the Board has granted peti-

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¹ This number does not reflect cases where § 325(d) was raised where “similar or substantially the same” prior art or arguments were before the PTO during prosecution of the patent or reexamination. This number also does not reflect cases where a petitioner brings a petition on claims that were already challenged by a different petitioner in a prior petition, unless the petitioner also filed a prior petition on the same claims.

tioners a second chance and considered the petitioners' unpatentability challenges. In the remaining cases, the Board has refused to consider the merits of the petitioners' unpatentability challenges, based on the Board's discretionary authority under § 325(d).

This article explores PTAB panel decisions in granting or denying multiple petition cases under chapter 31 and chapter 32 and examines any driving principles that determine which petitioners are likely to succeed in getting their follow-on petitions considered.

Conditions Favorable to Follow-On Petitions

Considering first those cases where PTAB panels were willing to consider a follow-on petition on the merits, and not exercise its authority under § 325(d) to deny institution for a follow-on petition, certain patterns recur:

(1) PTAB panels seem amenable to reviewing a follow-on petition when a PTAB panel did not consider the merits of the unpatentability arguments raised in the first petition. For example:

■ In *JP Morgan Chase & Co. v. Maxim Integrated Products, Inc.*, the PTAB panel declined to invoke § 325(d) to deny review of the follow-on petition because the PTAB panel “did not reach the merits of the unpatentability arguments” in the prior petition.² The prior petition was filed by both JP Morgan Chase (the current petitioner) and a co-petitioner.³ Because the co-petitioner had filed a civil action challenging the validity of the claims of the underlying patent, it was precluded from filing a CBM petition under § 325(a)(1) and the PTAB panel denied the first petition without addressing the merits of the asserted unpatentability grounds.⁴

■ In several cases, where the petitioner did not demonstrate that the patent qualified as a “covered business method patent” in the first petition, the PTAB panels would not exercise their authority under § 325(d) to deny institution in the follow-on petition. Because the PTAB panel had declined to institute review for lack of jurisdiction in the first instance and never reached the merits of the asserted grounds of unpatentability, the PTAB panel was therefore willing to review the asserted grounds of unpatentability in the second instance, even though identical arguments were raised in the first petition.⁵

² CBM2014-00179, Paper 11 at 15 (P.T.A.B., Decision Granting Institution, Feb. 20, 2015).

³ *Id.*

⁴ *Id.*; see also *JP Morgan Chase & Co. v. Maxim Integrated Products, Inc.*, CBM2014-00180, Paper 14 (P.T.A.B., Decision Granting Institution, Feb. 20, 2015).

⁵ See, e.g., *Par Pharm., Inc. v. Jazz Pharms., Inc.*, IPR2015-00546, Paper 25 (P.T.A.B., Decision Granting Institution, July 28, 2015), IPR2015-00547, Paper 25 (P.T.A.B., Decision Granting Institution, July 28, 2015), IPR2015-00548, Paper 19 (P.T.A.B., Decision Granting Institution, July 28, 2015), IPR2015-00551 joined with 00554, Paper 19 and 20 (P.T.A.B., Decision Granting Institution, July 28, 2015); *Amneal Pharms., LLC v. Jazz Pharms., Inc.*, IPR2015-00545, Paper 25 (P.T.A.B., Decision Granting Institution, July 29, 2015); *CME, Inc. v. 5th Market*, CBM2015-00061, Paper 9 (P.T.A.B., Decision Granting Institution, July 16, 2015); *Motorola Mobility v. Intellectual Ventures*, CBM2015-00004, Paper 9 (P.T.A.B., Decision Grant-

■ In *Apotex Inc. v. Wyeth LLC*, the PTAB panel would not exercise its authority under § 325(d) to decline review in a follow-on petition when the PTAB panel, in the first petition, found the ground “redundant to the ground upon which trial was instituted,”⁶ and never considered the underlying merits of the ground in the first petition.

(2) PTAB panels seem willing to consider a follow-on petition when a new ground is raised that was not included in the first petition. For example, in *CME, Inc. v. 5th Market*, CME raised a § 112 ¶ 2 ground that was not raised before. The PTAB panel refused to foreclose review of the claims simply because petitioner had the opportunity to assert the same ground in a prior case.⁷

(3) PTAB panels also are willing to revisit the Petitioner's original arguments presented in a second petition when the law has changed. In *Westlake Svcs., LLC v. Credit Acceptance Corp.*, the PTAB panel was willing to revisit the petitioner's arguments, regardless of the similarities to the first petition that was denied, because the PTAB panel's original decision not to institute was based significantly on a precedent that had been reversed.⁸ In particular, the PTAB panel's original decision not to institute was based significantly on the U.S. Court of Appeals for the Federal Circuit's precedent in *Ultramercial II*,⁹ which was vacated by the Supreme Court and reversed by the Federal Circuit in *Ultramercial III*.¹⁰

(4) Finally, PTAB panels seem willing to review a follow-on petition when the arguments are identical to a petition filed by a different petitioner and the petition does not address deficiencies identified in an earlier petition filed by petitioner. For example, in *Oracle Corp. v. Crossroads Systems, Inc.*,¹¹ petitioner filed a petition that it copied verbatim from a third party petition and also requested joinder to that petition. The PTAB panel found that because Petitioner copied the third-party petition verbatim, which was filed well before the institution decision in petitioner's first petition, the follow-on petition could not “address issues raised in the institution decision in that earlier case.”¹² Because the petitioner was raising identical challenges to a third-party petition and sought to join that petition, the PTAB panel reasoned that instituting the follow-on petition and granting joinder “would not prevent ‘the just, speedy,

ing Institution, March 27, 2015), CBM2015-00005, Paper 10 (P.T.A.B., Decision Granting Institution, March 27, 2015).

⁶ IPR2015-00873, Paper 8 at 8 (P.T.A.B., Decision Denying Institution, September 16, 2015, not based on § 325(d)).

⁷ *CME v. 5th Market*, CBM2015-00061, Paper 9 (P.T.A.B., Decision Granting Institution, July 16, 2015).

⁸ CBM2014-00176, Paper 15 (P.T.A.B., Decision Granting Institution, Feb. 9, 2015).

⁹ *Ultramercial, Inc. v. Hulu, LLC*, 722 F.3d 1335, 2013 BL 164761, 107 U.S.P.Q.2d 1193 (Fed. Cir. 2013) (86 PTCJ 455, 6/28/13) (*Ultramercial II*).

¹⁰ *Ultramercial, LLC v. Hulu, LLC*, 772 F.3d 709, 112 U.S.P.Q.2d 1750 (Fed. Cir. 2014) (89 PTCJ 166, 11/21/14) (*Ultramercial III*).

¹¹ IPR2015-00854, Paper 14 (P.T.A.B., Decision Granting Institution, Sept. 15, 2015).

¹² *Id.* at 5.

and inexpensive resolution’ ” of either the follow-on petition or the third-party proceeding.¹³

Thus, a petitioner filing a follow-on petition can reasonably expect a PTAB panel to consider its petition on the merits under the following circumstances: (1) the merits of the petitioner’s unpatentability challenges were not considered in the first petition; (2) new grounds are asserted in the second petition; (3) the law has changed between the petitioner’s first petition and its second petition; or (4) the follow-on petition is identical to a petition filed by a third party and does not try to address the deficiencies identified in a first petition filed by petitioner.

Conditions Unfavorable to Follow-On Petitions

Conversely, PTAB panels seem to consistently disapprove of follow-on petitions where the petitioner is merely presenting additional reasoning to support its assertion of unpatentability over the same prior art that the petitioner presented in the original petition. For example, in *Zimmer Holdings, Inc. v. Bonutti Skeletal Innovations, LLC*, the PTAB panel denied petitioner’s follow-on petition, because the petitioner had presented the same art before and was simply bolstering the motivation to combine, which the PTAB panel had found deficient in the original petition.¹⁴

Similarly, the PTAB panel denied a follow-on petition in *Travelocity.com L.P. v. Cronos Tech., LLC*, because the “[p]etitioner simply recasts the facts in the context of the same legal arguments.”¹⁵

In these cases, the PTAB panels were concerned that these types of petitions unnecessarily encourage the filing of partially inadequate petitions and “permitting second chances without constraint ties up a Board’s limited resources.”¹⁶

Similar Conditions Yielding Different Outcomes

PTAB panel decisions show less of a pattern when a follow-on petition raises a second round of challenges based on prior art. For example, a petitioner files a first petition asserting certain prior art references, alone or in combination, to challenge the validity of several

claims of a patent. If a PTAB panel denies institution of the challenged claims, then the petitioner may decide to file a second petition challenging the claims that were denied in the first petition. Sometimes the petitioner will assert completely new art in the second petition, or the petitioner will assert a new prior art combination that includes some art that was not previously before a PTAB panel and some art that was. In many of these cases, the PTAB panel’s treatment of follow-on petitions has been very case-specific.

Comparing the different outcomes in cases with similar underlying facts, underscores the PTAB panels’ application of their discretionary authority under § 325(d). One example of a pair of cases that illustrate this disparity is *Valeo North America, Inc. v. Magna Electronics*¹⁷ and *BLD Services, LLC v. LMK Tech., LLC*.¹⁸ In *Valeo*, the petitioner filed a second petition on claims that were denied institution in its first petition. In its second petition, the petitioner presented art that was previously before the Office, as well as new art. However, the exact same prior art combinations were not previously before the PTAB panel. Likewise, in *BLD Services*, the petitioner filed a second petition on claims that were denied institution in a first petition. The petitioner raised three pieces of new prior art that were not before the PTAB panel in the prior proceeding. Despite the similarities, in *Valeo* the PTAB panel was willing to review the follow-on petition on the merits, while in *BLD Services* the PTAB panel invoked § 325(d) and refused to institute review.

Cases Where PTAB Panels Reviewed Follow-On Petitions

In the instances where a PTAB panel has declined to exercise its authority under § 325(d) and has reviewed the challenges brought in a follow-on petition, asserting completely new art or a new prior art combination, the PTAB panel has either determined (1) that the prior art is not “the same or substantially the same”¹⁹ as the art or arguments previously presented to the Office or (2) that the art or arguments may be “the same or substantially the same,” but § 325(d) does not mandate denying review.²⁰ In one instance, the PTAB panel even acknowledged that there was some overlap in the prior art and arguments.²¹

However, in granting these follow-on petitions, the PTAB panels have provided little guidance as to why they were willing to give these petitioners a second chance to raise prior art arguments against the same claims of the same patent that were previously challenged. In some cases the petitioner had already asserted the base reference in a first petition and used the

¹³ *Id.*

¹⁴ IPR2014-01080, Paper 17 at 4 (P.T.A.B., Decision Denying Institution, Oct. 31, 2014) (“To bolster the prior reasoning that we deemed insufficient, Petitioner, in this proceeding, ‘ha[s] more fully articulated the reasons why it would have been obvious to a person of ordinary skill in the art to combine these references.’”).

¹⁵ CBM2015-00047, Paper 7 (P.T.A.B., Decision Denying Institution, June 15, 2015); see also, *Samsung Electronics Co., Ltd. v. Rembrandt Wireless Tech., LP*, IPR2015-00118 (P.T.A.B., Decision Denying Institution, Jan. 28, 2015) (the petitioner had merely presented additional reasoning to support the assertion of unpatentability over the same prior art it presented in the first petition); *NetApp Inc. v. Crossroads Systems, Inc.*, IPR2015-00772, Paper 12 at 7 (P.T.A.B., Decision Denying Institution, Sept. 3, 2015) (The Board did not allow petitioner to use the institution decision for its first petition “as a guide for preparing the Present Petition.”).

¹⁶ *Samsung Electronics Co., Ltd. v. Rembrandt Wireless Tech., LP* IPR2015-00118, Paper 14 at 6 (P.T.A.B., Decision Denying Institution, Jan. 28, 2015).

¹⁷ IPR2014-01208, Paper 13 (P.T.A.B., Decision Granting Institution, Dec. 23, 2014).

¹⁸ IPR2015-00723, Paper 7 (P.T.A.B., Decision Denying Institution, Aug. 24, 2015).

¹⁹ *Facebook, Inc. v. TLI Communications, LLC*, IPR2015-00778, Paper 17 (P.T.A.B., Decision Granting Institution, Aug. 28, 2015).

²⁰ *Wavemarket Inc. d/b/a Location Labs v. Locationet Sys. Ltd.*, IPR2014-00920, Paper 11 (P.T.A.B., Decision Granting Institution, Dec. 16, 2014).

²¹ *Facebook, Inc. v. TLI Commc’ns, LLC*, IPR2015-00778 Paper 17 (P.T.A.B., Decision Granting Institution, Aug. 28, 2015).

second petition to present a new combination, which it believed overcame the deficiencies of the original combination.²²

When PTAB panels do provide reasons for granting a second chance, the reasons are often policy based, rather than targeted at the specific facts of the case. In particular, PTAB panels have justified allowing multiple petitions subjecting a patent owner to serial attacks on its patent because the harm is mitigated by: (1) the estoppel effect of a final decision;²³ and (2) the limited window that a petitioner has to file an IPR petition after a federal lawsuit is filed.²⁴ In addition, the cost of filing multiple petitions, as well as the relatively rushed time frame for presenting its case, may further deter a petitioner from using multiple petitions as a tool to harass the patent owner. Although these reasons might apply in all cases, PTAB panels have denied follow-on petitions under § 325(d) in over 40 cases.

Cases Where PTAB Panels Denied Review of Follow-On Petitions

In many instances where a PTAB panel has denied institution of a follow-on proceeding and has refused to reach the merits of the underlying unpatentability grounds based on its authority under § 325(d), the fact patterns appear very similar to the instances where PTAB panels allowed a follow-on petition.²⁵ While the PTAB panels ultimately concluded in the cases that they denied that “the same or substantially the same prior art or arguments were presented to the Office,” the PTAB panels seemed to be applying § 325(d) strictly, often relying on policy reasons to reject the second petition.

The different policy reasons used by PTAB panels to invoke § 325(d) to deny review of a follow-on petition have included:

- The petitioner presented no argument or evidence that the newly cited references were not known or available to it at the time of filing.²⁶

²² See e.g., *Valeo N. Am., Inc. v. Magna Elecs., Inc.*, IPR2014-01208, Paper 13 (P.T.A.B., Decision Granting Institution, Dec. 23, 2014); *Oxford Nanopore Tech. Ltd. v. Univ. of Washington*, IPR2015-00057, Paper 28 (P.T.A.B., Decision Granting Institution, April 27, 2015).

²³ *Oxford Nanopore Tech. Ltd. v. Univ. of Washington*, IPR2015-00057, Paper 28 at 21 (P.T.A.B., Decision Granting Institution, April 27, 2015) (“Once a Final Decision issues in this proceeding, the Petitioner... will be estopped from ‘request[ing] or maintain[ing] 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.’ 35 U.S.C. § 315(e).”).

²⁴ *Silicon Lab., Inc. v. Cresta Tech. Corp.*, IPR2015-00615, Paper 9 at 25 (P.T.A.B., Decision Granting Institution, Aug. 14, 2015) (“We are not persuaded that it would be a prudent exercise of the discretion granted by § 325(d) to truncate the ability of a petitioner to make full use of the one-year window Congress expressly provided through § 315(b).”).

²⁵ See, e.g., *Roche Molecular Systems Inc. v. Illumina, Inc.*, IPR2015-01091, Paper 18 (P.T.A.B., Decision Denying Institution, Oct. 30, 2015) (the Board denied the petition even though new art was asserted).

²⁶ *Conopco, Inc. dba Unilever v. Procter and Gamble Co.*, IPR2014-00507, IPR2014-00506, Paper 17 at 6 (P.T.A.B., Decision Denying Institution, July 7, 2014) (“Unilever, however, presents no argument or evidence that the seven newly cited

- The petitioner should not be allowed to use a prior PTAB panel decision as a roadmap to remedy a prior, deficient challenge.²⁷

- The Board’s resources are limited and should not be tied up in offering petitioners second chances.²⁸

- Congress did not intend the Leahy-Smith America Invents Act to be used “‘as tools for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent. Doing so would frustrate the purpose of the section as providing quick and cost effective alternatives to litigation.’”²⁹

Like the reasons for allowing a follow-on petition, these reasons for denying a follow-on petition are policy-based and could apply in almost all cases with a follow-on petition.

Further, in a couple of decisions, PTAB panels denied the follow-on petition even for claims that were not challenged in the prior petition. For example, in *Ford Motor Co. v. Paice LLC & Abell Foundation, Inc.*, the PTAB panel denied review of newly challenged claims,

references were not known or available to it at the time of filing” of the earlier petition); see also *Ebay Inc. v. Moneycat Ltd.*, CBM2015-00008, Paper 9 (P.T.A.B., Decision Denying Institution, May 1, 2015).

²⁷ *Butamax Advance Biofuels LLC v. Gevo, Inc.*, IPR2014-00581, Paper 8 (P.T.A.B., Decision Denying Institution, Oct. 14, 2014). See also *CustomPlay, LLC v. ClearPlay, Inc.*, IPR2014-00783, Paper 9 at 9 (P.T.A.B., Decision Denying Institution, Nov. 7, 2014) (“A decision to institute review on some claims in a first *inter partes* review, however, should not act as a how-to guide for the same Petitioner filing a second petition for *inter partes* review challenging the claims that it unsuccessfully challenged in the first petition or claims that it reasonably could have challenged in the first petition.”); *Google Inc., v. Simpleair, Inc.*, CBM2014-00170, Paper 13 (P.T.A.B., Decision Denying Institution, Jan. 22, 2015) (The Board will not institute review when Petitioner admits to “refram[ing]” the prior ground in the instant petition based on the Board’s prior Decision); *Travelocity.com L.P. v. Cronos Techs., LLC*, CBM2015-00047, Paper 7 at 13 (P.T.A.B., Decision Denying Institution, June 15, 2015) (“A decision on a petition for covered business method review is not simply part of a feedback loop by which a petitioner may perfect its challenges through a subsequent filing.”); *BLD Svcs., LLC v. LMK Tech., LLC*, IPR2015-00721, Paper 9 at 11 (P.T.A.B., Decision Denying Institution, Aug. 24, 2015) (“We do not reach the merits of Petitioner’s additional reasoning, crafted with the benefit of our institution decision in the 768 proceeding.”)

²⁸ *Samsung Elecs. Co. v. Rembrandt Wireless Techs., LP*, IPR2015-00118, Paper 14 at 6 (P.T.A.B., Decision Denying Institution, January 28, 2015) (“Permitting second chances without constraint ties up the Board’s limited resources; we must be mindful not only of this proceeding, but of ‘every proceeding.’”).

²⁹ *Square, Inc. v. Think Computer Corp.*, CBM2015-00067, Paper 14 (P.T.A.B., Decision Denying Institution, July 2, 2015) quoting H.R. Rep. No. 112-98, pt. 1 at 48 (2011); *Butamax Advance Biofuels LLC v. Gevo, Inc.*, IPR2014-00581, Paper 8 at 13 (P.T.A.B., Decision Denying Institution, Oct. 14, 2014) (“Allowing similar, serial challenges to the same patent, by the same petitioner, risks harassment of patent owners and frustration of Congress’s intent in enacting the Leahy-Smith America Invents Act.”); *Conopco, Inc. dba Unilever v. Procter & Gamble Co.*, IPR2014-00628, Paper 21 at 11 (P.T.A.B., Decision Denying Institution, Oct. 20, 2014) (“P&G raises a legitimate concern that Unilever will continue to mount serial attacks against the ‘155 patent claims, until a ground is advanced that results in the institution of review.”).

because they appeared to be of similar scope as the previously challenged claims: “[T]he express language of 35 U.S.C. § 325(d) does not mention claims as being a factor in deciding whether to institute trials. Rather, 35 U.S.C. § 325(d) is concerned only with whether a petition presents the ‘same or substantially the same prior art or arguments.’”³⁰

Conclusion

There are some general principles that PTAB panels use fairly consistently when declining to invoke § 325(d) and allowing a follow-on petition, namely: (1) the merits of the petitioner’s unpatentability challenges were not considered in the first petition; (2) new grounds are asserted in the second petition; (3) the law has changed between the petitioner’s first petition and its second petition; or (4) the follow-on petition is identical to a petition filed by a third party and does not try to address the deficiencies identified in a first petition. Further, PTAB panels will reliably apply § 325(d) and deny review when a petitioner is merely bolstering its assertion of unpatentability over the same prior art that the petitioner presented in its first petition filed by petitioner.

However, there are many cases where no clear governing principle seems to guide PTAB panels’ application or non-application of § 325(d). In these cases, which usually raise a second round of challenges based on prior art that was not presented in the first petition (at all or in part), the PTAB panels seem to decide the outcome on a case-by-case basis, often relying on policy grounds that could apply broadly.

Practice Tips

Based on the PTAB panels’ decisions to date, below are some practice tips for evaluating the appropriateness of filing a follow-on petition.

³⁰ *Ford Motor Co. v. Paice LLC*, IPR2015-00767, Paper 14 at 7 (P.T.A.B., Decision Denying Institution, August 18, 2015) (emphasis in original); see also, *Travelocity.com L.P. v. Cronos Tech.*, CBM2015-00047, Paper 7 (P.T.A.B., Decision Denying Institution, June 15, 2015).

For a petitioner:

(1) Examine if the factors favoring a successful second petition apply, namely (a) the first petition was not considered on the merits, (b) the petition raises new grounds, and/or (c) the law has changed since filing the first petition. If so, highlight these factors in the follow-on petition.

(2) Evaluate whether the new art that would be presented in a follow-on petition actually provides a new disclosure or simply discloses the same features that were already presented to a PTAB panel in a different piece of prior art. Where applicable, specifically point out why the art and arguments being presented in the second petition are not redundant of the art and arguments that were presented in a prior petition.³¹

(3) Provide any reasons why the prior art was not available at the time of filing a first petition.

(4) Present policy reasons for why a second petition should be allowed and why it would not harass the patent owner or burden the Board’s limited resources.

For a patent owner, considering these points and including applicable points in a preliminary response can be helpful in convincing a PTAB panel to invoke § 325(d) to deny the follow-on petition. In particular, the patent owner could highlight, where applicable, how the petitioner has used the rejections of a prior petition as a “roadmap” to prepare the later petition.

Additionally, the patent owner can raise the other policy factors that have swayed PTAB panels, including the absence of evidence that the art or arguments raised were not available at the time of the prior filing, that the Board’s resources are limited, and that post-grant proceedings should not be used to harass patent owners.

³¹ In some instances, the PTAB panel has engaged in a lengthy discussion of why the prior art is “the same or substantially the same.” In those instances, it seems had the art really been different (e.g., disclosing the claimed limitation differently than the original prior art), the panel might have entertained it. In other cases, the panel’s rejection of the art is a principled rejection because it does not want to give the Petitioner a second bite at the apple.