

Two Bites at the Apple in IPRs

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One of the principles of law is that you only get to make your case once. Get it right the first time, because you do not get a second chance. No second bite at the apple. However, in IPR2012-00022, a panel of the PTAB concluded you can get a second bite at the apple in an IPR.

IPR2012-00022 and IPR2013-00250 involve the same parties and patent. A panel of the Board instituted IPR2012-00022's (Paper 24) on some claims and some grounds, but denied institution as to claim 8 on the ground of "claim 8 ...[being] anticipated by Kazakov." This was because the petitioner, Ariosa Diagnostics, failed to carry their burden of proof in the IPR2012-00022 petition on that ground. But Ariosa Diagnostics filed a subsequent petition, IPR2013-00250. In the IPR2013-00250 petition, Ariosa Diagnostics again requested institution on the ground of claim 8 being anticipated by Kazakov, the same ground previously denied in by the PTAB panel, and also moved to join the IPR2013-00250 proceeding with the IPR2012-00022 proceeding. The motion for joinder was necessary because IPR2013-00250 was filed more than one year after Ariosa Diagnostics had been sued for patent infringement by the patent owner, Isis Innovation Limited. Pursuant to 35 USC 315(b) and (c), IPR2013-00250 was time barred unless the motion for joinder was granted, and 315(c) provides that grant of such a joinder motion is discretionary.²

The PTAB panel, exercising its discretion, instituted IPR2013-00250 (paper 25) as to claim 8 on the ground of claim 8 being anticipated by Kazakov, and joined the two proceedings. Ariosa Diagnostics got two bites at the apple on the ground of claim 8 being anticipated by Kazakov, and the second bite paid off.

Isis Innovation Limited requested rehearing on the PTAB's grant of the joinder motion. The PTAB panel's response to that request, Ariosa Diagnostics v. Isis Innovation Limited, IPR2012-00022, paper 104 (PTAB 10/31/2013)(Opinion by APJ Prats, for a panel consisting of APJs Green, Prats, and Robertson) is enlightening as to how the PTAB exercises its discretion under 315(c). There, the panel stated:

Isis argues that granting joinder of the ground of unpatentability proposed against claim 8, anticipation by Kazakov (Ex. 1014), which previously had been proposed but rejected, see Decision to Institute at 26, IPR2012-00022; Paper 24, improperly gives Ariosa a second bite at the apple for claim 8, and thus subverts the intent of the estoppel provisions in 35 U.S.C. § 315(e)(1). Motion to Rehear Joinder Grant at 12-13. Moreover, Isis argues, the language of the section of the America Invents Act (AIA) relating to consolidation of post grant review proceedings, section 325(d), as well as the Office's public statements regarding that section, demonstrate the AIA's intent in, and appropriateness of, denying petitions that submit the same prior art and arguments as previously presented to the Office. Motion to Rehear Joinder Grant at 13.

Regarding the potential subversion of the AIA's estoppel provisions, as is evident from the language of the statute, the estoppel bar applies to a petitioner in an inter partes review "that results in a final decision under section 318(a)," 35 U.S.C. § 318(e)(1), an event which has not occurred yet in this proceeding. While

we are mindful of concerns about undue harassment of patent owners, as noted above, the decision to grant joinder is discretionary, and thus is not automatic. In this instance, we based our original decision not to institute review of claim 8 as allegedly anticipated by Kazakov because exhibits to the Kazakov Declaration, supposedly supporting the inherent amplification of paternally inherited non-Y chromosome nucleic acid, had not been included in the original petition papers. See Decision to Institute at 26, IPR2012-00022; Paper 24. We are not persuaded that allowing Ariosa to correct this single minor oversight within one month of the decision to institute rises to the level of patent owner harassment, such that our decision to allow joinder of that ground to the instant proceeding would be considered an abuse of discretion.

As the panel noted, "the decision to grant joinder is discretionary" with the Board. The Board has now exercised its discretion to allow correction of deficiencies in a petition's ground of rejection by the filing of a subsequent petition by the same party that filed the first petition. That is, the Board will grant an IPR petitioner two bites at the apple.

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2. 37 CFR 41.122(b) limits the time in which an IPR joinder motion can be filed to "no later than one month after the institution date of any inter partes review for which joinder is requested."