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Ranking Parallel Petitions Before the PTAB: A Survey

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RANKING PARALLEL PETITIONS BEFORE THE PTAB: A SURVEY

MONICA GREWAL, HEATHER PETRUZZI, AND WENLI GU*

INTRODUCTION

On November 10, 2018, Comcast Cable Communications, LLC (Comcast) filed six *inter partes* review (“IPR”) petitions, each challenging claims 1–28 of Rovi Guides, Inc.’s (Rovi’s) U.S. Patent No. 7,827,585.¹ In an unprecedented move, the panel requested that the Petitioner file a notice to (1) rank the six Petitions in the order in which it wished the panel to consider the merits, and (2) provide a succinct explanation of the differences between the Petitions.² The Board also afforded the Patent Owner the opportunity to respond to the Petitioner’s ranking notice and offer its views as to “whether the differences identified by Petitioner are material and in dispute.”³ Ultimately, the Board instituted the first ranked petition and denied the other five.⁴

Subsequently, different PTAB panels requested similar ranking notices when the Petitioner challenged the same patent in multiple concurrently filed petitions.⁵

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1. Comcast Cable Commc’ns, LLC v. Rovi Guides, Inc., Nos. IPR2019-00224, 00225, 00226, 00227, 00228, 00229, Paper 1 at 2 (P.T.A.B. Apr. 3, 2019).

2. *Id.* at 4.

3. *Id.*

4. Comcast Cable Commc’ns, LLC v. Rovi Guides, Inc., Nos. IPR2019-00225, 00226, 00227, 00228, 00229, Paper 14 at 6 (P.T.A.B. June 3, 2019). “We determine that the integrity of the system is sufficiently served by our institution of *inter partes* review of all challenged claims of the ‘585 patent in IPR2019-00224.”

5. The Board did not request the Notice in all parallel petition cases. In some cases, The Board did not request a ranking of the petitions, but only requested (1) a succinct explanation of the differences between the five Petitions and (2) an explanation of the circumstances in these proceedings that may justify Petitioner’s filing of multiple Petitions, *e.g.*, whether Patent Owner has asserted a large number of claims of the ‘115 patent against Petitioner in litigation. *See* Microsoft

Years earlier in a 2017 web tutorial (a “Boardside Chat”), the PTAB presented their multi-year study of multiple petitions, finding that the petitioners filed only one petition for 67% of the patents challenged at the PTAB.⁶ The PTAB suggested that one petition is generally sufficient to challenge the claims of a patent in most situations.⁷ On July 16, 2019, the USPTO published a “July Update” to the PTAB’s Trial Practice Guide for America Invents Act (AIA) proceedings.⁸ It also published the same document in the Federal Register, though it did not observe notice and comment rulemaking procedures for the July Update.⁹ The July Update devoted a section entitled “Parallel Petitions Challenging the Same Patent” to provide guidance for proceedings filed by “a Petitioner” that involve “[t]wo or more petitions filed against the same patent at or about the same time (*e.g.*, before the first preliminary response by the patent owner).”¹⁰ Expanding from earlier individual orders from the Board, the July Update advised that each Petitioner, when “fil[ing] two or more petitions challenging the same patent . . . *in its petitions or in a separate paper filed with the petitions*, identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies Petitioner’s burden under 35 U.S.C. § 314(a).” (emphasis added).¹¹ The July Update did not provide citation to or support for the reasoning behind the change.

Since the publication of the July Update, PTAB petitioners have followed the Update’s guidance, and have ranked almost all parallel petitions at filing. A survey of the ranked parallel petitions is presented in the next section.

Corp. v. IPA Techs. Inc., Nos. IPR2019-00810, 00811, 00812, 00813, 00814, Paper 8 at 5 (P.T.A.B. Aug. 21, 2019).

6. USPTO, *An Analysis of Multiple Petitions in AIA Trials*, Oct. 24, 2017, Slide 14, https://www.uspto.gov/sites/default/files/documents/Chat_with_the_Chief_Boardside_Chat_Multiple_Petition_Study_20171024.pdf.

7. *Id.*

8. USPTO, Trial Practice Guide Update (July 2019), <https://www.uspto.gov/sites/default/files/documents/trial-practice-guide-update3.pdf?MURL=> (“July Update”) (last visited on Feb. 23, 2020) [hereinafter July Update].

9. Federal Register, Office Patent Trial Practice Guide, July 2019 Update (July 16, 2019), <https://www.federalregister.gov/documents/2019/07/16/2019-15083/office-patent-trial-practice-guide-july-2019-update> (last visited on Mar. 9, 2020).

10. July Update, *supra* note 8 at 26-28.

11. *Id.* at 27.

METHODOLOGY AND RESULTS

To understand the trends in recent ranking practice, this article analyzes a subset of ranked parallel petitions that received an institution decision before or on February 20, 2020.¹² Using a search filter in Docket Navigator¹³ to locate multiple petitions challenging the same patent, the authors identified 39 occurrences of ranked parallel petitions that challenge the same claims of the same patents, as well as 2 occurrences of ranked parallel petitions that challenge different claims of the same patent.¹⁴

12. The earliest parallel petitions we include were the *Comcast v. Rovi* IPRs, Comcast Cable Commc'ns, LLC v. Rovi Guides, Inc., Nos. IPR2019-00224, 00225, 00226, 00227, 00228, 00229, in which the Board requested a ranking notice for the first time (and which were cited in the July Update). Because of the focus of this survey, we do not include petitions that have not yet received an institution decision and petitions that were terminated before an institution decision.

13. DocketNavigator, <https://brochure.docketnavigator.com/>. Our search includes only petitions filed by the same petitioner challenging the same patent, where at least two of the parallel petitions were filed on the same day and where the parallel petitions were ranked by the Petitioner.

14. These petitions were filed between November 10, 2018 and August 15, 2019, and have a decision regarding whether to institute review of the petition. The cutoff date of August 15, 2009 was chosen because none of the later filed petitions had received institution decisions as of February 20, 2020.

Patent	Filing	Petitioner	Patent Owner	#1	#2	#3	#4	#5	#6
7,827,585	10-Nov-18	Comcast	Rovi	IPR2019-00224 claims 1-28	IPR2019-00229 claims 1-28	IPR2019-00225 claims 1-28	IPR2019-00226 claims 1-28	IPR2019-00227 claims 1-28	IPR2019-00228 claims 1-28
9,869,741	12-Nov-18	Comcast	Rovi	IPR2019-00221 claims 1-26	IPR2019-00213 claims 1-26				
7,779,011	12-Nov-18	Comcast	Veveo	IPR2019-00237 claims 1-24	IPR2019-00239 claims 1-24	IPR2019-00238 claims 1-24			
9,621,956	12-Nov-18	Comcast	Rovi	IPR2019-00281 claims 1-20	IPR2019-00282 claims 1-20	IPR2019-00280 claims 1-20	IPR2019-00279 claims 1-20	IPR2019-00283 claims 1-20	
9,578,363	12-Nov-18	Comcast	Rovi	IPR2019-00284 claims 1-20	IPR2019-00285 claims 1-20	IPR2019-00286 claims 1-20	IPR2019-00287 claims 1-20	IPR2019-00288 claims 1-20	IPR2019-00289 claims 1-20
7,937,394	12-Nov-18	Comcast	Veveo	IPR2019-00290 claims 1-11	IPR2019-00292 claims 1-11	IPR2019-00291 claims 1-11	IPR2019-00293 claims 1-11		
9,294,799	12-Nov-18	Comcast	Rovi	IPR2019-00299 claims 1-28	IPR2019-00304 claims 1-28	IPR2019-00303 claims 1-28	IPR2019-00300 claims 1-28	IPR2019-00305 claims 1-28	
9,668,024	10-Jan-19	Comcast	Rovi	IPR2019-00555 claims 1-20	IPR2019-00556 claims 1-20	IPR2019-00557 claims 1-20	IPR2019-00558 claims 1-20		
9,211,253	19-Feb-19	Nalco-1	Opliant	IPR 2019-00685 claims 1-29	IPR 2019-00687 claims 1-29	IPR 2019-00686 claims 1-29			
9,468,747	19-Feb-19	Nalco-1	Opliant	IPR 2019-00688 claims 1-45	IPR 2019-00690 claims 1-45	IPR 2019-00689 claims 1-45			
9,561,177	19-Feb-19	Nalco-1	Opliant	IPR 2019-00691 claims 1-30	IPR 2019-00693 claims 1-30	IPR 2019-00692 claims 1-30			
9,629,965	19-Feb-19	Nalco-1	Opliant	IPR 2019-00694 claims 1-30	IPR 2019-00696 claims 1-30	IPR 2019-00695 claims 1-30			
9,775,838	19-Feb-19	Nalco-1	Opliant	IPR 2019-00697 claims 1-46	IPR 2019-00699 claims 1-46	IPR 2019-00698 claims 1-46			
10,003,553	18-Mar-19	Flex Logix	Venkatesh Konda	IPR2019-00037 claims 1-20	IPR2019-00040 claims 1-20, 25, 27-29	IPR2019-00042 claims 1-20, 25, 27-29			
8,539,047	29-Mar-19	PayPal	Ioengine	IPR2019-00884 claims 1-9, 12-16, 19-31	IPR2019-00885 claims 1-4, 6-9, 12-16, 19-31	IPR2019-00886 claims 1-4, 6-9, 12-16, 19-31	IPR2019-00887 claims 1, 7, 9-11, 14, 16-17		
8,209,634	4-Apr-19	Facebook	Blackberry	IPR2019-00925 claims 1, 4-7, 10-13, 16-18	IPR2019-00924 claims 1, 4-7, 10-13, 16-18				
9,059,969	4-Apr-19	PayPal	Ioengine	IPR2019-00906 claims 1-22, 24-29	IPR2019-00907 claims 1-22, 24-29				
9,774,703	8-Apr-19	PayPal	Ioengine	IPR2019-00930 claims 90-92, 94-95, 97-99, 81-87, 89-90, 92-94, 100-101, 108-121, 123-124, 126-129	IPR2019-00931 claims 90-92, 94-95, 97-99, 81-87, 89-90, 92-94, 100-101, 108-121, 123-124, 126-129				
7,925,416	20-Apr-19	BMW	Cerrum	IPR2019-00905 claims 1-14	IPR2019-00904 claims 1-14	IPR2019-00928 claims 1-14			
7,512,475	20-Apr-19	BMW	Cerrum	IPR2019-00903 claims 1-12	IPR2019-00902 claims 1-12	IPR2019-00927 claims 1-12			
8,812,437	2-May-19	Dropbox	Whitserve	IPR 2019-01019 claims 1-20	IPR 2019-01018 claims 1-20				
9,422,345	6-May-2019 (04027-28) 9-Aug-2019 (01478)	Pfennex	GSK	IPR 2019-01028 claims 1, 2, 4, 6, 8, 12-14, 17-19, 21	IPR 2019-01027 claims 1, 2, 4, 6, 8, 12-14, 17-19, 21	IPR 2019-01478 claims 1, 2, 4-14, 16-21			
8,718,543	20-May-19	Volkswagen	Carcel	IPR2019-01108 claims 10, 12-13, 18-21, 23, 25, 26, 44-45, 48-53	IPR2019-01106 claims 10, 12-13, 18-21, 23, 25, 26, 44-45, 48-53				
9,173,436	6-Jun-19	FirstGear	Lineweight	IPR2019-01170 claims 1-15	IPR2019-01169 claims 1-15				
9,978,107	6-Jun-19	Chegg, Inc.	NetScoc	IPR2019-01171 claims 1-11	IPR2019-01168 claims 1-11				
7,949,966	19-Jun-19	Intel Corp.	Tela	IPR2019-01228 claims 2, 81-83, 85	IPR2019-01220 claims 2, 81-83, 85	IPR2019-01221 claims 2, 81-83, 85 (dismissed)			
7,948,012	20-Jun-19	Intel Corp.	Tela	IPR2019-01255 claims 2, 8, 11, 13, 26-28, 30	IPR2019-01256 claims 2, 8, 11, 13, 26-28, 30	IPR2019-01234 claims 2, 8, 11, 13, 26-28, 30 (dismissed)			
8,068,108	21-Jun-19	Google	Virentem Ventures	IPR2019-01189 claims 1, 3, 5, 7	IPR2019-01238 claims 1, 3, 5, 7				
9,785,400	21-Jun-19	Google	Virentem Ventures	IPR2019-01245 claims 1-4, 7, 12-15, 18	IPR2019-01242 claims 1-4, 12-15, 18				
8,345,050	21-Jun-19	Google	Virentem Ventures	IPR2019-01237 claims 1-4, 8, 20, 25, 31-32, 34, 36, 40-43, 45	IPR2019-01236 claims 1-4, 8, 20, 25, 31-32, 34, 36, 40-43, 45				
7,816,881	9-Jul-19	SolarEdge	SMA Solar Tech	IPR2019-01223 claims 1-18	IPR2019-01224 claims 1-18	IPR2019-01225 claims 1-18	IPR2019-01226 claims 1-18	IPR2019-01227 claims 1-18	
7,370,358	11-Jul-19	Fortinet	British Telecom	IPR2019-01218 claims 1-4, 7-11, 19-20, 24-29, 32-38, 44-45, 49-50	IPR2019-01217 claims 1-2, 4, 6, 14-18, 21, 23, 29-27, 29-31, 34, 39-43, 45, 48				

Table 1

Table 1: Ranked parallel Petitions challenging the same claims of the same patent, filed before the July Update. Each row documents one set of parallel petitions, arranged in the order of Petitioner’s ranking.¹⁵

15. Among the four parallel petitions in PayPal, Inc. v. Ioengine, LLC, the Petitioner ranked the 00884 and 00885 petitions ahead of the 00886 and 00887 petitions but did not rank between the 00884 and 00885 petitions, or the 00886 and 00887 petitions. The 00884 and 00886 petitions challenge a different set of claims from the 00885 and 00887 petitions. See No. IPR2019-00885 Paper 16 at 1 (P.T.A.B. Oct. 3, 2019). All four of these petitions were denied institution in view of earlier petitions against the same patent by another entity, Ingenico. The Board found a significant relationship between PayPal and Ingenico, similar to the relationship between the petitioners in Valve Corp. v. Electronic Scripting Products, Inc., Nos. IPR2019-00062, 00063, 00084, Paper 11 (P.T.A.B. Apr. 2, 2019) (precedential). See PayPal v. Ioengine, No. IPR2019-00885 Paper 21 at 9 (P.T.A.B. Oct. 3, 2019).

The petitions identified in green-shaded cells were granted institution, and those in pink-shaded cells were denied institution. The two gray-shaded cells in *Intel v. Tela* identify two petitions that were withdrawn after the Patent Owner stipulated that it would not contest the prior art status of any prior art.

Patent	Filing	Petitioner	Patent Owner	#1	#2	#3
8,448,215	19-Jul-2019 [01353] 1-Aug-2019 [01354, 55]	Comcast	Rovi	IPR2019-01353 claims 1-20	IPR2019-01354 claims 1-20	IPR2019-01355 claims 1-20
9,055,319	26-Jul-2019 [01375] 1-Aug-2019 [01376, 77]	Comcast	Rovi	IPR2019-01375 claims 1-30	IPR2019-01376 claims 1-30	IPR2019-01377 claims 1-30
9,232,254	31-Jul-2019 [01413] 2-Aug-2019 [01414, 15]	Comcast	Rovi	IPR2019-01413 claims 1-22	IPR2019-01414 claims 1-22	IPR2019-01415 claims 1-22
7,873,978	31-Jul-2019 [01418] 5-Aug-2019 [01419, 20]	Comcast	Rovi	IPR2019-01418 claims 1-8	IPR2019-01420 claims 1-8	IPR2019-01419 claims 1-8
8,272,019	31-Jul-2019 [01431] 5-Aug-2019 [01432, 33]	Comcast	Rovi	IPR2019-01431 claims 1-20	IPR2019-01432 claims 1-20	IPR2019-01433 claims 1-20
8,973,069	31-Jul-2019 [01434] 2-Aug-2019 [01435, 36]	Comcast	Rovi	IPR2019-01434 claims 1-20	IPR2019-01435 claims 1-20	IPR2019-01436 claims 1-20
9,399,531	9-Aug-19	Weber	Provisur	IPR2019-01464 claims 1-15	IPR2019-01465 claims 1-15	

Table 2

Table 2: Ranked parallel petitions challenging same claims of same patent, after the July Update.

Out of the 39 instances in our dataset of a petitioner filing parallel petitions challenging the same patent, 32 came before the July Update, and 7 after it. As expected, all the tabulated Petitioners who filed before the July Update submitted a ranking notice in response to a Board order directing the filing of a ranking notice. The petitions filed after the July Update included the ranking notice in their original petition filing.¹⁶

We present observations with respect to our dataset below.

1. The numbers, technology areas, and types (IPR/CBM/PGR) of the parallel petitions

16. The July Update explains that the ranking notice can be included in the petitions or in a separate paper, such as an exhibit, filed with the petitions.

Of the 39 instances of parallel petition filings, two included six petitions,¹⁷ three included five,¹⁸ three included four,¹⁹ eighteen included three,²⁰ and thirteen included two petitions. All but two instances of four or more parallel petitions were filed by the same Petitioner.

Parallel petitions have been filed in more than one type of USPTO AIA post-grant proceeding. Both IPR and post-grant review (“PGR”) petitions²¹ have been filed as parallel petitions and ranked by the Petitioner.²²

Petitioners filed parallel petitions in many different technologies, including, *e.g.*, semiconductor devices,²³ wireless communications,²⁴ and life sciences. For example, Nalox-1 filed five sets of three parallel petitions challenging five Orange Book-listed patents covering the FDA-approved drug Narcan (Naloxone Hydrochloride),²⁵ a medication that can stop or reverse the effects of an opioid overdose.²⁶ For another example, Pfenex Inc. filed three parallel petitions²⁷ challenging a patent

17. Comcast Cable Commc’ns, LLC v. Rovi Guides, Nos. IPR2019-00224 to 00229; Comcast Cable Commc’ns, LLC v. Rovi Guides, Inc., Nos. IPR2019-00284 to 00289.

18. Comcast Cable Commc’ns, LLC v. Rovi Guides, Inc., Nos. IPR2019-00279 to 00283; Comcast Cable Commc’ns, LLC v. Rovi Guides, Inc., Nos. IPR2019-00299 to 00300; 00303 to 00305; SolarEdge Techs. Ltd. v. SMA Solar Tech., AG, Nos. IPR2019-01223 to 01227.

19. Comcast Cable Commc’ns, LLC v. Veveo, Inc., Nos. IPR00290 to 00293; Comcast Cable Commc’ns, LLC v. Rovi Guides, Inc., Nos. IPR2019-00555 to 00558; PayPal, Inc. v. Ioengine, LLC, Nos. IPR2019-00884 to 00887.

20. In two instances, one petition was later dismissed. Intel Corp. v. Tela Innovations, Inc., Nos. IPR2019-01220, -01221, -01228 and Intel Corp. v. Tela Innovations, Inc., Nos. IPR2019-0254, -01255, and -01256.

21. Flex Logix Techs., Inc. v. Konda Techs. Inc., PGR2019-00037, -00040, and -00042.

22. The covered business method (“CBM”) transitional program, which is set to expire September 16, 2020 (*see* AIA § 18) has no parallel petitions ranked to date in the tabulated cases. Life Technologies Corporation filed two CBM petitions on November 1, 2019 challenging a patent of Unison Strategic IP, Inc., but did not rank the two petitions. The petitions challenged two different, non-overlapping sets of claims: CBM2020-00001 challenges 9-11, 15-17, 29, 30, 39-41, 46-51, 63-65, 78-80, and 88-92 of the patent, and CBM2020-00005 challenges claims 2-8, 12, 13, 18, 20, 21, 31, 33, 37, 38, 42-44, 53-61, 66, 68, 69, 77, 82, 86, 87, and 93-95. *See* Life Techs. Corp. v. Unison Strategic IP, CBM2020-00001 and CBM2020-00005. Because these petitions were not ranked by the petitioner, they are not included in the dataset.

23. Intel Corp. v. Tela Innovations, Inc., Nos. IPR2019-01254 to 01256.

24. Facebook Inc. v. Blackberry Ltd., Nos. IPR2019-00924, -00925.

25. Nalox-1 Pharm., LLC v. Opiant Pharm., Inc., Nos. IPR2019-00685 to 00699. “Orange Book-listed” patents are those patents that an NDA holder lists in the Orange Book as relevant to an FDA-approved drug product. *See* FDA, “Approved Drug Products With Therapeutic Equivalence Evaluations (Orange Book),” <https://www.fda.gov/drugs/drug-approvals-and-databases/approved-drug-products-therapeutic-equivalence-evaluations-orange-book> (last visited March 17, 2020).

26. *See* FDA News Release, *FDA Approves First Generic Naloxone Nasal Spray To Treat Opioid Overdose*, April 19, 2019, <https://www.fda.gov/news-events/press-announcements/fda-approves-first-generic-naloxone-nasal-spray-treat-opioid-overdose>, last visited on February 29, 2020.

27. Pfenex Inc. v. Glaxosmithkline Biologicals SA, Nos. IPR2019-01027, -01028, and -01478.

directed to expression of bacterial toxins associated with multiple vaccines.²⁸

2. Petitioner's Rankings and Institution Decisions

In 25 of the 39 sets of parallel petitions, only one of the parallel petitions was instituted by the Board. With only one exception,²⁹ the instituted petition was always the petition that was ranked first by the Petitioner.

In eight instances,³⁰ all parallel petitions were denied institution. Almost all of these decisions were based on the merits of the petitions, not on the basis of filing multiple petitions. The exception is *PayPal v. Ioengine*, where four parallel petitions were denied institution in light of other, previously pending petitions as to the same patent that had been filed earlier by a related party.³¹

In our dataset there was no decision instituting three parallel petitions, which is consistent with the July Update statement that "it [is] unlikely that circumstances will arise where three or more petitions by a petitioner with respect to a particular patent will be appropriate."³²

However, the Board has instituted two parallel petitions in six instances. This occurred in one instance where the petitioner filed five parallel petitions,³³ one instance where the petitioner filed four parallel petitions,³⁴ two instances where the petitioners filed three parallel petitions,³⁵ and two instances where the petitioners filed two parallel petitions.³⁶ In all these proceedings, the instituted petitions always included the first ranked petition.

28. *Pfenex Inc. v. Glaxosmithkline Biologicals SA*, No. IPR2019-01478 Paper 9 at 2-3 (P.T.A.B. February 10, 2020). *See also* U.S. Patent No. 9,422,345 at Col. 1, ll. 52-58 (discussing bacterial toxins that "are components in many vaccines providing immunity against *Corynebacterium diphtheria*" and other pathogens).

29. In the *Comcast v. Rovi* IPRs, *Comcast Cable Commc'ns, LLC v. Rovi Guides, Inc.*, Nos. IPR2019-01418 through -01420, the Board denied the institution of the first ranked petition (01418) on a basis unrelated to parallel petitions and instituted the second ranked petition (01420).

30. These include one set of four parallel petitions, three sets of three parallel petitions, and four sets of two petitions.

31. *See supra* note 15.

32. *See supra* note 8, at 26.

33. *SolarEdge Techs. Ltd. v. SMA Solar Tech., AG*, Nos. IPR2019-01223 to 01227.

34. *Comcast Cable Commc'ns, LLC v. Veveo, Inc.*, No. IPR2019-00290 to 00293.

35. *Comcast Cable Commc'ns, LLC v. Veveo, Inc.*, Nos. IPR2019-00237 to 00239;

Flex Logix Techs., Inc. v. Konda Techs. Inc., PGR2019-00037, 00040, and 00042.

36. *Chegg, Inc., Match Grp., LLC, and RPX Corp. v. NetSoc, LLC*, Nos. IPR2019-00165, 00171; *Weber, Inc. v. Provisur Techs., Inc.*, Nos. IPR2019-01464, 01465.

3. Board's rationales for instituting two parallel petitions

Both the July Update and the earlier case orders assume that only one of the parallel petitions would be instituted in most cases.³⁷ Nonetheless, the July Update “recognizes that there may be circumstances in which more than one petition may be necessary”³⁸ and provides two concrete examples of such “circumstances,” relating to the number of claims asserted in the litigation and the priority date of the challenged claims.

After the introduction of the ranking requirement, the Board's stated rationale for instituting two parallel petitions has tracked the following areas.

A. When there is the potential to antedate a prior art reference

The July Update listed one of the “circumstances in which more than one petition may be necessary” as “when there is a dispute about priority date requiring arguments under multiple prior art references.”³⁹ Consistent with this guidance, the potential antedating of references is frequently cited by the Board as a reason to grant the institution of two parallel petitions.

In the *Comcast v. Veveo* IPRs (IPR2019-00290 to 00293), the Board instituted both the first and second ranked petitions.⁴⁰ The Petitioner identified that the Patent Owner might antedate a prior art reference that was relied on in the ground of unpatentability presented.⁴¹ The Patent Owner did not indicate whether it would antedate that prior art reference.⁴² The Board was “persuaded that the potential to antedate a reference relied on in a Petition and claim construction arguments resulting in [a] different manner of application of the prior art are material differences between the submitted Petitions, and these differences warrant institution of *inter partes* review of a second petition.”⁴³

37. See *Comcast Cable Commc'ns, LLC v. Rovi Guides, Inc.*, Nos. IPR2019-00224, 00225, 00226, 00227, 00228, 00229, Paper 10 at 4 (P.T.A.B. Apr. 3, 2019) (stating petitioner should explain “why the Board should exercise its discretion to consider the additional Petitions if it identifies a Petition that satisfies Petitioner's burden under 35 U.S.C. § 314(a)”). See also July Update *supra* note 8, at 26 (“one petition should be sufficient to challenge the claims of a patent in most situations.”).

38. See *supra* note 8, at 26.

39. *Id.*

40. See *Comcast Cable Commc'ns, LLC v. Veveo, Inc.*, No. IPR2019-00292, Paper 16 at 19 (P.T.A.B. July 5, 2019).

41. *Id.*

42. *Id.*

43. *Id.*

B. When material differences in the arguments due to claim construction outweigh the burden of multiple proceedings

In the *SolarEdge v. SMA Solar Technologies* IPRs, Petitioner filed five parallel petitions, each challenging the same claims.⁴⁴ The Board instituted both the first and second-ranked petitions.⁴⁵ In considering the second-ranked petition, the Board agreed with the Petitioner that there were material differences in the arguments addressing a key limitation in materially different ways; and that the differences were highlighted by the arguments of the Patent Owner “in a manner that suggests the outcome of each case may turn on these issues.”⁴⁶ The Board found the burden to the panel and the Patent Owner from instituting an additional petition was outweighed by the material difference of the two petitions, because “the underlying disputed issues overlap to a considerable degree” and that “the overlap in prior art minimizes the need to become familiar with new material.”⁴⁷

In another *Comcast v. Veveo* proceeding, Comcast filed three parallel petitions and the first and second ranked petitions were instituted.⁴⁸ The Board was “persuaded that the potential to antedate a reference relied on in a Petition and claim construction arguments resulting in different manner of application of the prior art are material differences between the submitted Petitions, and these differences warrant institution of *inter partes* review of a second ranked petition.”⁴⁹

Notably, the rationale for institution of multiple parallel petitions based on material difference or potential antedating of the prior art may be obviated when the Patent Owner clearly stipulates that it will not dispute the priority date or the claim limitation at issue. The July Update states that “the patent owner may seek to avoid additional petitions by proffering a stipulation that certain claim limitations are not disputed or that certain references qualify as prior art.”⁵⁰ In *Comcast v. Rovi*, IPR2019-00299-00300, 00303-00305, the Patent Owner conceded that

44. *SolarEdge Techs. Ltd. v. SMA Solar Tech., AG*, No. IPR2019-01224, Paper 10 at 2 (P.T.A.B. Jan. 23, 2020).

45. *Id.* at 9-10 (although the petition was filed before the July update, the institution decision issued afterwards).

46. *Id.* at 10.

47. *Id.* at 11-12.

48. *Comcast Cable Commc'ns, LLC v. Veveo, Inc.*, No. IPR2019-00239, Paper 15 at 18 (P.T.A.B. July 5, 2019).

49. *Id.*

50. *Supra* note 8, at 28.

the § 102(b) reference could not be antedated.⁵¹ Moreover, the Patent Owner asserted it would not attempt to swear behind the two primary references relied on in other petitions that were prior art under 35 U.S.C. § 102(e). On the basis of these representations by the Patent Owner, the Board concluded that “the different priority dates of the asserted references across the five petitions do not warrant multiple *inter partes* reviews of the ‘799 Patent.”⁵²

C. For PGR petitions: when different petitions are based on novelty and non-novelty statutory bases for invalidity, respectively

In the *Flex Logix v. Venkat Konda* PGRs, three parallel PGR petitions were directed to different statutory bases for invalidity: the first-ranked petition challenged the claims under 35 U.S.C. § 112, and the other two petitions raised anticipation and/or obviousness challenges under 35 U.S.C. §§ 102 and 103.⁵³ The Board concluded that “Petitioner’s argument regarding the distinct nature of the § 112 challenges and the prior-art challenges, coupled with the length limitations imposed on petitions for post-grant review, is persuasive.”⁵⁴ The Board ultimately instituted two petitions to include challenges under § 112 and §§ 102/103.

D. When there are a large number of real parties-in-interest

In the *Chegg, Inc. v. NetSoc, LLC* IPRs, the Board was persuaded that instituting both petitions filed on behalf of three Petitioners representing seven real parties-in-interest (RPI) would lead to efficient administration of the proceedings.⁵⁵ Notably, however, the Board also agreed with the Petitioner that the Patent Owner might antedate multiple references.⁵⁶ It is therefore unclear whether the *Chegg* IPRs suggest that a large number of RPIs alone would support institution of multiple petitions.

51. Comcast Cable Commc’ns, LLC v. Rovi Guides, Inc., Nos. IPR2019-00300, 00303 to 00305, Paper 13 (P.T.A.B. July 1, 2019).

52. *Id.*

53. PGR2019-00042, Paper 14 at 41 (P.T.A.B. Sept. 19, 2019).

54. *Id.*

55. *Chegg, Inc., Match Grp., LLC, and RPX Corp. v. NetSoc, LLC*, No. IPR2019-01171, Paper 16 at 15, 82 (P.T.A.B. Dec. 5, 2019).

56. *Id.* at 14.

E. For split-claim petitions: a large number of claims asserted in litigation by the Patent Owner

The July Update listed another “circumstance[] in which more than one petition may be necessary” as “when the Patent Owner has asserted a large number of claims in litigation[.]”⁵⁷ This rationale is particularly relevant for parallel petitions that challenge different claims of the same patent, referred to herein as “split-claim petitions.”

It may be too early to assess the full impact of the ranking requirement on the institution of these parallel petitions because there are only two instances where ranked parallel “split-claim petitions” have received institution decisions, as documented in row 2 and 3 of Table 3. In earlier instances of split-claim petitions, petitioners did not rank the petitions. The first row of Table 3 documents a recent example⁵⁸ of three unranked split-claim parallel petitions filed on the same day. All three petitions were denied institution on other grounds,⁵⁹ and the panel did not reach the parallel petition issue.

Patent	Filing	Petitioner	Patent Owner	#1	#2	#3
8,523,921	15-Jul-19	VOI	DePuy Synthes	IPR2019-01331 claims 1-11	IPR2019-01332 claims 12-18	IPR2019-01333 claims 19-20
7,016,676	22-Jul-19	Marvell	Uniloc 2017	IPR2019-01349 claims 1, 2, 5	IPR2019-01350 claims 3, 6-9	
6,836,654	9-Aug-19	Microsoft	Uniloc 2017	IPR2019-01471 claims 10-20	IPR2019-01470 claims 1-9	

Table 3

Table 3: Split-claim petitions.⁶⁰

57. *Supra* note 8, at 26.

58. A recent example is *Veterinary Orthopedic Implants, Inc. v. DePuy Synthes Products, Inc.*, Nos. IPR2019-01331 (challenging claims 1-11), -01332 (challenging claims 12-18), -01333 (challenging claims 19-20) (“*VOI v. DePuy Synthes*”).

59. The 01332 petition was denied on the merits; the other two were denied because the Petitioner previously argued that the claims were indefinite. *See Veterinary Orthopedic Implants, Inc. v. DePuy Synthes Products, Inc.*, No. IPR2019-01332, Paper 17 at 51 (P.T.A.B. Jan. 22, 2020); *Veterinary Orthopedic Implants, Inc. v. DePuy Synthes Products, Inc.*, No. IPR2019-01331, Paper 18 at 30 (P.T.A.B. Jan. 21, 2020); *Veterinary Orthopedic Implants, Inc. v. DePuy Synthes Products, Inc.*, No. IPR2019-01333, Paper 17 at 31 (P.T.A.B. Jan. 22, 2020).

60. There are no vertical lines between the three *VOI v. DePuy Synthes* petitions because these were not ranked by the Petitioner. Their positions in the respective columns do not correspond to their ranking.

In the *Marvell v. Uniloc 2017 IPRs*, the Board did not credit Petitioner Marvell's arguments for having two split-claim petitions (1) based on prior art with different priority dates⁶¹ and (2) based on the need to match one of the petitions to an instituted petition by another petitioner (Microsoft). Marvell argued that the Patent Owner might "attempt to exploit Microsoft's improper identification of Marvell" as an RPI in the other petition.⁶² Despite not accepting these arguments, however, the Board still instituted both of Marvell's petitions.⁶³

The Board reasoned that "[t]he two petitions challenge different claims with no overlap."⁶⁴ The Board further reasoned that the July Update had been published less than one week before the petitions were filed, so it may not have been practical to restructure the petitions.⁶⁵ Interestingly, the Board suggested that had Petitioner challenged all claims in a single petition, "Patent Owner and the Board still would have had to consider the vast majority of what Petitioner filed in the two proceedings collectively."⁶⁶

Less than a month later, Microsoft challenged another Uniloc 2017 patent in two split-claim petitions.⁶⁷ The Board only instituted the first ranked petition challenging a subset of the claims.⁶⁸ Rejecting the Petitioner's argument that "no claim is being challenged in both petitions" and that the Board "should give consideration to all challenged claims," the panel stated that "such reasoning would justify as many petitions as there are claims in a patent, which is untenable."⁶⁹ The Board further reasoned that "[n]otably, Petitioner does not argue that Patent Owner 'has asserted a large number of claims in litigation,' which is a listed example in the [July Update] that may necessitate parallel petitions."⁷⁰ "To the contrary," the Board continued, "none of the claims challenged in

61. *Marvell Semiconductor, Inc. v. Uniloc 2017 LLC*, No. IPR2019-01350, Paper 9 at 14 (P.T.A.B. Feb. 4, 2020).

62. *Id.* at 13.

63. *Id.* at 15 ("Notwithstanding the foregoing, we do not agree with Patent Owner that we should discretionarily deny the Petition.").

64. *Id.*

65. *Id.*

66. *Id.*

67. *Microsoft Corp. v. Uniloc 2017 LLC*, No. IPR2019-01470, Paper 7 at 9 (P.T.A.B. Feb. 11, 2020).

68. *Id.* at 11, 13.

69. *Id.* at 13.

70. *Id.*

this Petition are 'being asserted against Petitioner in the underlying district court litigation.'"⁷¹

These *Microsoft v. Uniloc 2017* cases demonstrate that split-claim parallel petitions are subject to similar ranking request and institution constraints as other parallel petitions.

CONCLUSION

The early data on parallel petitions indicate that the Board is applying its guidance and relying on the examples in the recently updated Trial Practice Guide. In nearly all such cases, only the first-ranked parallel petition was instituted. There are a few cases in our dataset where two parallel petitions were instituted, but as yet, never more than two. The trends permitting institution of a second petition include the potential to antedate a prior art reference, material differences in the arguments due to claim construction, or a large number of claims asserted in litigation. Two parallel PGR petitions have been instituted when one is based on 35 U.S.C. § 112 and the other on 35 U.S.C. §§ 102/103. This survey may be informative for Petitioners when deciding whether to file parallel petitions, how many to file, and how to rank them.

71. *Id.*