

The Role of Post-Grant Reviews in Patent Challenges before the PTAB

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The America Invents Act (AIA)¹ established several types of contested proceedings for challenging patents before the Patent Trial and Appeal Board (PTAB) of the U.S. Patent and Trademark Office (USPTO). These proceedings, called “trial proceedings” by the PTAB, include post-grant review (PGR), inter partes review (IPR), and reviews conducted under the transitional program for covered business method patents (CBM). IPRs and CBMs have become popular avenues for attacking claims of issued patents. According to statistics from the USPTO, 2,299 IPR petitions and 277 CBM petitions had been filed by January 1, 2015, with 931 IPR trials and 123 CBM trials instituted as of that date.²

Because of different eligibility requirements, PGRs have yet to be widely used. Unlike IPRs and CBMs, PGRs are only available for patents subject to the “first-to-file” scheme of the AIA. In general, a PGR is available for a patent that issues on an application that has ever included (or that ever claimed priority to another application that ever included) a claim having an effective filing date on or after March 16, 2013.³ This will largely limit PGRs to patents arising from applications filed on or after that date. As of January 1, 2015, only one active PGR was shown in the Patent Review Processing System (PRPS) online records of the PTAB.⁴ As the number of eligible patents grows, however, PGRs are likely to become a much larger percentage of patent challenge proceedings before the PTAB.

As discussed below, there is a fairly narrow post-issuance time window within which a PGR must be filed. If a patent of concern first comes to light after this window has closed, a PGR simply will not be an option. When a PGR is an option, additional grounds for patent challenge available in a PGR present a significant advantage relative to IPRs. However, PGRs also have a significant disadvantage relative to IPRs: a much broader estoppel scope. In some cases where a PGR is possible, a challenger might thus wish to wait a few months and file an IPR instead of a PGR. This article examines various aspects of PGRs and offers insights into the considerations that may affect such a decision.

Similarity to CBMs

There is overlap between PGRs and IPRs, but as discussed below, there are also substantial differences. However, a CBM is in many ways a specialized type of PGR. For cases where a CBM is available, the standards and procedures of a PGR generally apply.⁵ CBMs differ from PGRs with regard to eligible patents. CBMs are only available with regard to “covered business method” patents, which are defined as patents that claim “a method or corresponding apparatus for performing data processing or other

operations used in the practice, administration, or management of a financial product or service,” but that exclude patents for “technological inventions.”⁶ Moreover, and unlike PGRs, a suit or charge of infringement is a prerequisite to a CBM.⁷

Nine-Month Window of Opportunity

One of the most important features of a PGR is the relatively short time within which a PGR petition may be filed. Under 35 U.S.C. § 321(c), “[a] petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a reissue patent.” This short window of opportunity will preclude a PGR if a patent of concern is not discovered until after that window has closed.

In circumstances where a party already knows about a pending patent application of potential concern and can monitor its status, this may not be an issue. In many circumstances, however, some or all of the nine-month PGR filing window may be gone by the time a patent of concern is recognized by a potential challenger. For example, a patent may issue from an application filed by an individual or other applicant that is not known to be a player in a particular field. In such a case, a party impacted by that patent may have no practical way to learn of it. For many technologies, routinely reviewing all recently issued patents in a particular field may be an expensive and time-consuming effort that many companies are unwilling to perform. Even in cases where all of the players in a particular field may be known, simply reviewing all recently issued patents owned by one of those players may be insufficient if a patent owner is determined to hide that ownership interest.

The nine-month PGR filing window is not a long time period. As discussed below, one advantage of a PGR relative to an IPR is the ability to challenge patentability under 35 U.S.C. § 112.⁸ Such challenges, particularly with regard to enablement or written description under § 112(a) or with regard to definiteness under § 112(b), will be dependent on the knowledge of a person of ordinary skill in the art. Successfully arguing a challenge on one of these bases will almost certainly require declaration testimony from an appropriate expert. Identifying an expert, bringing that expert up to speed on the patent of interest and the relevant issues, and working with that expert to obtain a declaration are time-consuming tasks. Starting those tasks at the last minute could, to say the least, be quite stressful.

If outside the nine-month PGR filing window, an IPR or CBM may be available. The window for filing an IPR petition opens nine months after patent issuance and remains open for the enforceable life of the patent. However, an IPR petitioner can only challenge claims in a patent based on anticipation by and/or obviousness over prior art consisting of patents or printed publications. As discussed below, an IPR may also offer slightly less discovery opportunities than might be available in a PGR. A CBM petition may be filed any time during the enforceable life of a patent, but is restricted in other ways mentioned above.

As with IPRs, a PGR is precluded if a petitioner or real party in interest has previously filed a civil action challenging the validity of a claim in the patent at issue.⁹ Notably, “a civil action challenging the validity of a claim” does not include a counterclaim challenging validity.¹⁰

(Possibly) Higher Standard for Instituting Trial

The first step in challenging a patent in an IPR, PGR, or CBM is to file a petition requesting institution of a trial. That petition must identify all of the claims being challenged and all of the grounds for challenge. Based on the petition, supporting evidence, and the patent owner's preliminary response (if filed), the PTAB determines whether a trial will be instituted to decide the patentability of all, some, or none of the challenged claims. If a trial is instituted, it may proceed on less than all of the grounds initially asserted in the petition. After a trial is instituted, and after additional evidence and arguments have been submitted, the PTAB will issue a final written decision that decides which of the claims at issue in the trial are unpatentable.

Ostensibly, the threshold for instituting a trial in a PGR is higher than the threshold for IPRs. For a PGR, the PTAB may not institute a trial unless it "determines that the information presented in the petition . . . , if such information is not rebutted, would demonstrate that *it is more likely than not* that at least 1 of the claims challenged in the petition is unpatentable."¹¹ For an IPR, the PTAB may not institute a trial unless it "determines that the information presented in the petition . . . and any response . . . shows that *there is a reasonable likelihood* that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."¹² The PTAB takes the position that the PGR threshold is higher: "Comparing the two standards, the 'reasonable likelihood' standard is lower than the 'more likely than not' standard. The reasonable likelihood standard allows for the exercise of discretion but encompasses a 50/50 chance whereas the 'more likely than not' standard requires greater than a 50% chance of prevailing."¹³

At least in theory, the higher institution threshold for PGRs militates in favor of waiting and filing an IPR if there is concern about the strength of the evidence regarding invalidity. As a practical matter, however, this difference in institution thresholds may not be meaningful in many (if any) cases. The delta between "greater than a 50% chance of prevailing" and "50/50 chance" seems very small, and it is hard to imagine many arguments that are strong enough for purposes of instituting an IPR but not strong enough for purposes of instituting a PGR. Perhaps more important, many parties may be unlikely to attempt either procedure based solely on marginal evidence. The IPR filing fee is less than the PGR filing fee,¹⁴ but both are significant, and total fees and costs through preparation and filing of a petition in either procedure could easily exceed \$100,000.

More Bases for Challenge but Bigger Estoppel Scope

In an IPR, a petitioner may only challenge a patent claim under 35 U.S.C. § 102 and/or § 103 (i.e., as anticipated by and/or obvious), and *only* based on prior art consisting of patents or printed publications.¹⁵ In a PGR, a petitioner may challenge a patent claim based on *any* prior art under 35 U.S.C. § 102 and/or § 103.¹⁶ A PGR petitioner may also challenge a patent claim, under 35 U.S.C. § 101, as directed to nonstatutory subject matter. As discussed below, however, there is some controversy in this regard. Finally, a PGR petitioner may challenge a patent claim under 35 U.S.C. § 112 for failing to meet the written description, enablement, definiteness, or other requirement of § 112.¹⁷

These added grounds for patent challenge are the biggest advantage of a PGR. This advantage comes at a price, however. A PGR petitioner may not assert in a civil action or in an International Trade Commission (ITC) proceeding that a claim reviewed in the PGR is invalid on any ground that the petitioner raised or reasonably could have raised during the PGR.¹⁸ Although a similar estoppel provision applies to IPRs,¹⁹ the “or reasonably could have raised” scope of estoppel becomes much more significant in the context of a PGR. In other words, losing a PGR as to a particular claim could prevent any further challenge to the validity of that claim in a district court or ITC proceeding.

There have been several legislative efforts to narrow the scope of PGR estoppel by amending 35 U.S.C. § 325(e) to eliminate the “or reasonably could have raised” component.²⁰ Whether such efforts will succeed, and if so when, remains anyone’s guess. A broad scope of estoppel will thus be the biggest drawback to use of PGR proceedings for at least the foreseeable future.

Challenges under 35 U.S.C. § 101

The Supreme Court decision in *Alice Corp. v. CLS Bank International*²¹ opened the floodgates for challenges to patent claims involving business activities. Under *Alice Corp.*, a claim is not patentable under 35 U.S.C. § 101 if it is directed to an “abstract idea” and if the claim elements “individually and as an ordered combination” fail to provide “an inventive concept.”²² The analysis of *Alice Corp.*, which seems to conflate § 101 with patentability over the prior art, is troubling on several levels and worthy of multiple separate articles. Nevertheless, numerous parties have embraced *Alice Corp.* as a tool to attack patentability of claims implicating business activities.

Even before *Alice Corp.*, however, the PTAB was aggressively applying § 101 to business-related claims in CBMs. Although there had only been three CBM final written decision before *Alice Corp.* that involved patentability under § 101, no claims survived a § 101 challenge in any of those decisions. Out of all decisions on CBM petitions issued by the PTAB before *Alice Corp.* that addressed a claim challenge under § 101, approximately 90 percent instituted a trial based on § 101. Post-*Alice Corp.* and through January 1, 2015, that rate is approximately 88 percent. It seems likely that this high rate of trial institution will continue for § 101 challenges in PGRs, at least with regard to business-related claims.

The patent bar is eager for Federal Circuit decisions to help clarify application of *Alice Corp.* As indicated above, however, the PTAB has issued numerous decisions on CBM petitions that apply § 101 to a variety of claims. Many of those are post-*Alice Corp.* There have also been several post-*Alice Corp.* CBM final written decisions that found claims unpatentable under § 101.²³ Even pre-*Alice Corp.*, however, the PTAB often applied a § 101 analysis that looks remarkably like its post-*Alice Corp.* analysis.²⁴ At least with regard to proceedings before the PTAB, and until there is further guidance from the Federal Circuit, many of these pre – and post-*Alice Corp.* CBM decisions may be a fertile resource for parties wishing to challenge business-implicating patents on § 101 grounds.

The PTAB may also aggressively apply § 101 to claims that might not be considered business-related. For example, any claim that only involves a conventional computer that differs from other computers based on its programming is potentially vulnerable to a § 101 attack. As another example, the earlier

Supreme Court decision in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*²⁵ that found methods associated with medical treatment to be nonstatutory may result in § 101 challenges to other types of methods.

It is worth noting that the authority of the PTAB to determine patentability under § 101 is not universally accepted. Under 35 U.S.C. § 321(b), “[a] petitioner in a post-grant review may request to cancel as unpatentable 1 or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of section 282(b) (relating to invalidity of the patent or any claim).” Paragraph (3) of 35 U.S.C. § 282(b) does not relate to § 101. Paragraph (2) only refers to “[i]nvalidity of the patent or any claim in suit on any ground specified in part II [of title 35] as a condition for patentability.” Although § 101 is contained within part II, the only sections of part II that include “condition for patentability” in the section title are § 102 and § 103.

This argument against PTAB authority to consider § 101 challenges has at least superficial appeal. After all, the statute says what it says. Not surprisingly, the PTAB disagrees and has relied on legislative history of the AIA and on several Supreme Court and Federal Circuit decisions indicating that § 101 is a condition for patentability.²⁶ Ultimately, the Federal Circuit will likely decide the issue. At least until then, however, the PTAB can be expected to continue its aggressive application of § 101.

Challenges under 35 U.S.C. § 102 and § 103

As indicated above, an IPR petitioner may only challenge claim validity under 35 U.S.C. § 102 or § 103, and *only* based on prior art that qualifies as a patent or printed publication. There is no restriction to patents or printed publications in a PGR. This can make a huge difference. For example, a party may have evidence of prior public use or other activity that would qualify as prior art, but may lack evidence that would qualify as a printed publication or may have difficulty proving that a useful document is a printed publication under § 102.²⁷ Several CBMs have been instituted based on prior art other than patents or printed publications.²⁸ Indeed, one of the three filed PGRs (since terminated) asserted “on sale” activity as prior art.²⁹

Challenges under 35 U.S.C. § 112

The ability to present patentability challenges under 35 U.S.C. § 112 is certainly an advantage of PGRs relative to IPRs. For some types of cases, however, this advantage may not be as important as one might think. In the context of IPRs, there is a perception of the PTAB as eager to cancel claims as unpatentable under 35 U.S.C. § 102 or § 103. This article takes no position on the accuracy or fairness of that perception. At least with regard to grounds on which trials are instituted, however, CBM petition decisions suggest that challenges under 35 U.S.C. § 112 in a PGR may tend to be less successful than challenges under § 102 or § 103. Based on an informal review of CBM petition decisions through January 1, 2015, and out of all petitions that substantively addressed an alleged ground for patentability,³⁰ approximately 88 percent resulted in trial institution on at least one ground for at least one claim. If this is broken out by types of challenges, however, a different pattern emerges. Out of all CBM petition decisions that substantively addressed alleged unpatentability under 35 U.S.C. § 102 or § 103, approximately 70 percent resulted in institution of trial on at least one § 102 or § 103 ground. Out of all CBM petition decisions substantively addressing a § 112 challenge, however, approximately 36 percent resulted in

institution of trial on at least one § 112 ground. When it comes to final patentability determinations under § 112, it may be too soon to draw any conclusions. As of January 1, 2015, only four CBM final written decisions addressed patentability under § 112.³¹ In each case, however, the PTAB found all of the claims as to which trial was instituted on § 112 grounds to be unpatentable under § 112.³²

The most common challenges to patentability under § 112 are for lack of written description under § 112(a), lack of enablement under § 112(a), and indefiniteness under § 112(b). What follows are some observations about how the PTAB has treated these types of challenges thus far.

Written Description (35 U.S.C. § 112(a))

The written description requirement, as summarized and applied by the PTAB, is as follows:

The written description requirement of 35 U.S.C. § 112, first paragraph, requires that “the disclosure of the application relied upon reasonably convey[] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). One shows “possession” by descriptive means such as words, structures, figures, diagrams, and formulas that set forth fully the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). . . . “One shows that one is ‘in possession’ of *the invention* by describing *the invention*, with all its claimed limitations, not that which makes it obvious.” *Id.*³³

In several CBM petition decisions, the PTAB has instituted trials based on lack of written description.³⁴ In each those cases, the specification and/or drawings failed to include explicit recitations of the relevant limitations, and the patent owner was unable to convince the PTAB that possession of the relevant feature would have been understood from the specification and/or drawings. In many other cases, however, the PTAB has refused to institute a trial on the ground that claims lacked written description support.

PTAB treatment of claims challenged for insufficient written description has thus far not seemed to be any more or less harsh than might be expected in other forums. The PTAB will not require that limitations appear *in haec verba* in the specification,³⁵ and a successful written description argument will require more than hand waving or broad assertions by an expert. The PTAB will want to know what a person of ordinary skill in the art would have understood from the original disclosure, i.e., the original specification (including the claims) and drawings.³⁶ If that person of ordinary skill in the art would have understood some particular feature to be disclosed or not disclosed, the PTAB will likely expect specific citations to the description and/or drawings providing that understanding. If inferences must be drawn, the PTAB will likely want a reasoned explanation why such inferences are appropriate. If knowledge in art must be relied upon, evidentiary support for that knowledge may be helpful.

Similar patterns can be seen in IPR final written decisions. Although an IPR petitioner may not raise 35 U.S.C. § 112 regarding existing claims, the petitioner can raise § 112 challenges with regard to proposed amendment claims. The PTAB has thus far refused addition of most proposed amended claims based on prior art grounds. Even in such cases, however, the PTAB often does find there to be sufficient written description for the proposed claim.³⁷

Enablement (35 U.S.C. § 112(a))

The enablement requirement, as summarized and applied by the PTAB, is as follows:

[A] patent specification “must describe the manner and process of making and using the invention so as to enable a person of skill in the art to make and use the full scope of the invention without undue experimentation.” *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1344–45 (Fed. Cir. 2005) (citations omitted). “The key word is ‘undue,’ not ‘experimentation.’” *In re Wands*, [858 F.2d 731, 737 (Fed. Cir. 1988)].³⁸

When it comes to enablement, the PTAB will require a thorough explanation of any alleged shortcomings in the disclosure of the specification and drawings, together with an explanation of why any experimentation needed to practice the invention based on that disclosure would be “undue.” Determining whether experimentation is “undue” requires consideration of the so-called *Wands* factors:

(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.³⁹

In numerous cases, the PTAB has cited a failure to provide the required *Wands* analysis when denying institution of trial based on lack of enablement.⁴⁰

Definiteness (35 U.S.C. §112(b))

Under 35 U.S.C. § 112(b), a claim must particularly point out and distinctly claim the subject matter that the inventor or a joint inventor regards as the invention. This is also known as the “definiteness” requirement. In its 2014 *Nautilus, Inc. v. Biosig Instruments, Inc.* decision, the Supreme Court stated that “a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.”⁴¹ Before and after *Nautilus*, the PTAB has instituted CBM trials on the ground that claims are indefinite.⁴²

So far, the PTAB has in general been no more or less stringent than most other evaluators of claim definiteness. For example, the PTAB is unlikely to confuse broad claim scope with indefiniteness.⁴³ The PTAB will not impose extreme requirements for precision,⁴⁴ but it may find a claim indefinite if there is no way to determine a reasonable bound for a particular limitation.⁴⁵

The USPTO does consider *Nautilus* to have established higher standards for claim clarity.⁴⁶ Whether this will actually translate into noticeably tougher application of § 112(b) remains to be seen. In post-*Nautilus* IPR final written decisions, two PTAB panels applied common sense analyses of claims relative to specifications when rejecting indefiniteness challenges to proposed amended claims.⁴⁷ Although this is hardly conclusive, it does not suggest that the PTAB will start requiring hyperprecise claims.

There is one type of indefiniteness that has received significant attention from the PTAB. In a number of cases, potential indefiniteness has stemmed from a failure of the specification and/or drawings to provide an algorithm in connection with a means-plus-function claim limitation. Under 35 U.S.C. § 112(f), a claim element may be expressed as a means for performing a specified function and need not recite explicit structure to perform that function. The claim limitation will then be construed to cover the corresponding structure described in the specification, and equivalents of such structure. If there is no corresponding structure in the specification or drawings, the claim is indefinite under § 112(b).⁴⁸ In the context of an invention implemented using a conventional computer having specialized programming, the corresponding “structure” in the specification must include an algorithm to perform the recited function.⁴⁹ If there is no algorithm disclosed, the claim is thus indefinite. In several cases, the PTAB has instituted CBM trials based on a failure of the specification to disclose an algorithm corresponding to a mean-plus-function element.⁵⁰

Discovery

Some discovery is available in both IPRs and PGRs. Depositions of persons submitting declarations are routine in IPRs and CBMs (and can thus be expected in PGRs), but most other discovery requires agreement of the parties or PTAB approval. Such approval is not easily obtained. Although discovery in both IPRs and PGRs is much more limited than what is available in district court litigation, it may be slightly less limited in PGRs. Under 35 U.S.C. § 316(a)(5), IPR discovery (other than deposition of witnesses submitting affidavits or declarations) is limited to “what is otherwise necessary in the interest of justice.” Under 35 U.S.C. § 326(a)(5), PGR discovery is “limited to evidence directly related to factual assertions advanced by either party in the proceeding.” IPRs, PGRs, and CBMs are subject to 37 C.F.R. § 42.51, section (b)(1) of which states that depositions of persons submitting declarations is part of routine discovery. Under, § 42.51(b)(2), however, a party moving for additional discovery “must show that such additional discovery is in the interests of justice, except in post-grant reviews where additional discovery is limited to evidence directly related to factual assertions advanced by either party in the proceeding.” Under 37 C.F.R. § 42.224(a), which applies to PGRs and CBMs, “[r]equests for additional discovery may be granted upon a showing of good cause as to why the discovery is needed.”

The PTAB has stated that

the interests of justice standard [applicable to IPRs] is a slightly higher standard than the good cause standard [applicable to PGRs and CBMs], to reflect that the scope of issues which could be raised by a petitioner in an *inter partes* review is limited to grounds based on patents or printed publications.⁵¹

In both IPRs and PGRs, the mere possibility of finding something useful is insufficient.⁵² In an IPR, “[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.”⁵³ In a PGR, “[u]seful’ means favorable in substantive value to a contention of the party moving for discovery. A good cause showing requires the moving party to provide a specific factual reason for expecting reasonably that the discovery will be ‘useful.’”⁵⁴

Conclusion

For cases in which CBM review is not available, PGRs will expand the bases on which patent claims may be challenged before the PTAB. As the number of patents eligible for PGR continues to grow, PGRs will likely be used with greater frequency. The time window within which a PGR may be filed is relatively narrow, but in appropriate cases the additional grounds for patentability challenge available in a PGR may make the proceeding a potentially powerful tool. n

Endnotes

1. Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, 125 Stat. 284 (Sept. 16, 2011).
2. See *AIA Trial Statistics*, USPTO.GOV, http://www.uspto.gov/ip/boards/bpai/stats/aia_trial_statistics.jsp (follow “AIA Progress Statistics – Graphical View and Subsets” hyperlink) (last modified Jan. 2, 2015).
3. See 35 U.S.C. § 321 note; AIA §§ 3(n)(1), 6(f)(2).
4. See PAT. REV. PROCESSING SYS., <https://ptabtrials.uspto.gov> (last visited Jan. 8, 2015). The parties in two other PGR proceedings settled and filed joint motions to terminate the proceedings, which the PTAB granted. The first, PGR2014-00008, pertained to U.S. Patent No. 8,684,420, which issued from an application filed on July 26, 2013. The second, PGR2014-00010 pertained to U.S. Patent No. 8,598,219, which issued from an application filed on May 23, 2013.
5. AIA § 18(a)(1).
6. *Id.* § 18(d)(1).
7. *Id.* § 18(a)(1)(B).
8. The AIA amended 35 U.S.C. § 112 to redesignate six paragraphs as subsections (a) through (f). The first paragraph of pre-AIA § 112 corresponds to post-AIA § 112(a), the second paragraph of pre-AIA § 112 corresponds to post-AIA § 112(b), etc. The pre – and post-AIA versions are otherwise generally the same for purposes relevant to this article. For convenience, and because the post-AIA version of § 112 will apply to PGRs, specific parts of § 112 are referenced herein by the post-AIA section letters. For IPRs and CBMs, and depending on the patent in question, either the pre – or post-AIA version of § 112 could apply.
9. 35 U.S.C. § 325(a)(1).
10. *Id.* § 325(a)(3).
11. *Id.* § 324(a) (emphasis added).
12. *Id.* § 314(a) (emphasis added).
13. *Message from Chief Judge James Donald Smith, Board of Patent Appeals and Interferences: USPTO Discusses Key Aspects of New Administrative Patent Trials*, USPTO.GOV, http://www.uspto.gov/aia_implementation/smith-blog-extravaganza.jsp#heading-1 (last modified May 21, 2012).
14. As of January 2015, fees due under 37 C.F.R. § 42.15(a) at the time of filing an IPR request for up to 15 claims total \$23,000. Fees due under 37 C.F.R. § 42.15(b) at the time of filing a PGR request for up to 15 claims total \$30,000.
15. 35 U.S.C. § 311(b). In theory, a patent owner can amend claims in an IPR, a PGR, or a CBM. A petitioner may then challenge a proposed amended claim on bases in addition to §§ 102 and/or 103, even in an IPR. In practice, amending claims in an IPR has proven exceedingly difficult.
16. *Id.* § 321(b).

17. *Id.*
18. *Id.* § 325(e)(2). The estoppel attaches when there is a final written decision in the PGR.
19. *Id.* § 315(e)(2).
20. American Renaissance in Manufacturing Act, H.R. 5360, 113th Cong. § 3308(a) (2014); Patent Transparency and Improvements Act of 2013, S. 1720, 113th Cong. § 7(a) (2013); Innovation Act, H.R. 3309, 113th Cong. § 9(a) (2013).
21. 134 S. Ct. 2347 (2014).
22. *Id.* at 2355.
23. See *SAP Am., Inc. v. Arunachalam*, No. CBM2013-00013 (P.T.A.B. Sept. 18, 2014), Paper No. 61; *Salesforce.com, Inc. v. VirtualAgility, Inc.*, No. CBM2013-00024 (P.T.A.B. Sept. 16, 2014), Paper No. 47; *U.S. Bancorp v. Ret. Capital Access Mgmt. Co.*, No. CBM2013-00014 (P.T.A.B. Aug. 22, 2014), Paper No. 33.
24. See, e.g., Decision [on] Institution of Covered Business Method Patent Review, *U.S. Bancorp.*, No. CBM2013-00014 (P.T.A.B. Sept. 20, 2013), Paper No. 12.
25. 132 S. Ct. 1289 (2012).
26. See, e.g., *U.S. Bancorp*, No. CBM2013-00014, Paper No. 33, at 9–10; Brief for the Intervenor—Director of the United States Patent and Trademark Office at 31–33, *Versata Dev. Grp., Inc. v. SAP Am., Inc.*, No. 14-1194 (Fed. Cir. May 1, 2014).
27. See Decision Denying Institution of *Inter Partes* Review, *A.R.M., Inc. v. Cottingham Agencies Ltd.*, No. IPR2014-00671 (P.T.A.B. Oct. 3, 2014), Paper No. 10.
28. See, e.g., Decision [on] Institution of Covered Business Method Patent Review, *GTNX, Inc. v. INTTRA, Inc.*, No. CBM2014-00072 (P.T.A.B. Aug. 12, 2014), Paper No. 8; Decision [on] Institution of Covered Business Method Patent Review, *Search Am., Inc. v. TransUnion Intelligence, LLC*, No. CBM2013-00038 (P.T.A.B. Feb. 7, 2014), Paper No. 15 [hereinafter *Search Am. CBM2013-00038 Institution Decision*].
29. Petition for Post-Grant Review of U.S. Patent No. 8,684,420 at 50–56, No. PGR2014-00008, (P.T.A.B. Aug. 5, 2014), Paper No. 1.
30. Excluded from the category “petitions that substantively addressed an alleged ground for patentability” are petitions where the petition was denied based on reasons that did not address the substance of the challenge. Examples include cases where the challenged patent was not found to be a covered business method patent and cases where asserted art was not shown to be prior art.
31. *Metavante Corp. v. Cashedge, Inc.*, No. CBM2013-00028 (P.T.A.B. Dec. 22, 2014), Paper No. 49; *Groupon, Inc. v. Blue Calypso, LLC*, No. CBM2013-00035 (P.T.A.B. Dec. 17, 2014), Paper No. 45; *Chicago Mercantile Exchange, Inc. v. 5th Market, Inc.*, No. CBM2013-00027 (P.T.A.B. Dec. 17, 2014), Paper No. 33; *SAP Am., Inc. v. Arunachalam*, No. CBM2013-00013 (P.T.A.B. Sept. 18, 2014), Paper No. 61.
32. *Metavante Corp.*, No. CBM2013-00028, Paper No. 49, at 2, 14-19; *Groupon, Inc.*, No. CBM2013-00035, Paper No. 45, at 2, 34-39, 41; *Chicago Mercantile Exchange, Inc.*, No. CBM2013-00027, Paper No. 33, at 12, 20-22, 55-56; *SAP Am., Inc.*, No. CBM2013-00013, Paper No. 61, at 2, 18–20, 29.
33. Decision [on] Institution of Covered Business Method Patent Review at 22–23, *Apple Inc. v. SightSound Techs., LLC*, No. CBM2013-00019 (P.T.A.B. Oct. 8, 2013), Paper No. 17 [hereinafter *SightSound CBM Institution Decision*] (alteration in original).

34. See Decision [on] Institution of Covered Business Method Patent Review, *Monster Worldwide, Inc. v. Career Destination Dev., LLC*, No. CBM2014-00070 (P.T.A.B. Aug. 20, 2014), Paper No. 12; Decision [on] Institution of Covered Business Method Patent Review, *MotionPoint Corp. v. TransPerfect Global, Inc.*, No. CBM2014-00060 (P.T.A.B. July 23, 2014), Paper No. 8 [hereinafter *MotionPoint CBM Institution Decision*]; Decision [on] Institution of Covered Business Method Patent Review, *Fid. Nat'l Info. Servs., Inc. v. DataTreasury Corp.*, No. CBM2014-00021 (P.T.A.B. Apr. 29, 2014), Paper No. 14; Decision [on] Institution of Covered Business Method Patent Review, *Google Inc. v. Unwired Planet, LLC*, No. CBM2014-00006 (P.T.A.B. Apr. 8, 2014), Paper No. 11; Decision [on] Institution of Covered Business Method Patent Review, *Google Inc. v. Unwired Planet, LLC*, No. CBM2014-00005 (P.T.A.B. Apr. 8, 2014), Paper No. 10; Decision [on] Institution of Covered Business Method Patent Review, *Fid. Nat'l Info. Servs., Inc. v. Cashedge, Inc.*, No. CBM2013-00028 (P.T.A.B. Dec. 23, 2013), Paper No. 15.

35. See, e.g., Decision [on] Institution of Covered Business Method Patent Review at 21, *Stewart Title Guar. Co. v. Segin Software, LLC*, No. CBM2014-00051 (P.T.A.B. July 8, 2014), Paper No. 13 [hereinafter *Stewart Title CBM Institution Decision*].

36. See Decision [on] Institution of Covered Business Method Patent Review at 19–20, *Google Inc. v. Inventor Holdings, LLC*, No. CBM2014-00002 (P.T.A.B. Apr. 1, 2014), Paper No. 16 [hereinafter *Inventor Holdings CBM Institution Decision*]; *SightSound CBM Institution Decision*, *supra* note 33, at 25–28; Decision [on] Institution of Covered Business Method Patent Review at 13–15, *CRS Advanced Techs., Inc. v. Frontline Techs., Inc.*, No. CBM2012-00005 (P.T.A.B. Jan. 23, 2013), Paper No. 17.

37. See, e.g., *LaRose Indus., LLC v. Capriola Corp.*, No. IPR2013-00120, at 20–30 (P.T.A.B. June 26, 2014), Paper No. 37; *Adidas AG v. Nike, Inc.*, No. IPR2013-00067, at 27–31 (P.T.A.B. Apr. 28, 2014), Paper No. 60; *Idle Free Sys., Inc. v. Bergstrom, Inc.*, No. IPR2012-00027, at 28–31 (P.T.A.B. Jan. 7, 2014), Paper No. 66.

38. Decision [on] Institution of Covered Business Method Patent Review at 26–27, *eBay, Inc. v. PAID, Inc.*, No. CBM2014-00126 (P.T.A.B. Sept. 30, 2014), Paper No. 15 [hereinafter *eBay CMB2014-00126 Institution Decision*].

39. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

40. See Decision [on] Institution of Covered Business Method Patent Review at 28–29, *eBay, Inc. v. PAID, Inc.*, No. CBM2014-00128 (P.T.A.B. Sept. 30, 2014), Paper No. 15; *eBay CMB2014-00126 Institution Decision*, *supra* note 38, at 26–27; Decision [on] Institution of Covered Business Method Patent Review at 26–27, *eBay, Inc. v. PAID, Inc.*, No. CBM2014-00125 (P.T.A.B. Sept. 30, 2014), Paper No. 15; *MotionPoint CBM Institution Decision*, *supra* note 34, at 18–19; *Search Am. CBM2013-00038 Institution Decision*, *supra* note 28, at 19–20; Decision [on] Institution of Covered Business Method Patent Review at 21, *Search Am., Inc. v. TransUnion Intelligence, LLC*, No. CBM2013-00037 (P.T.A.B. Feb. 7, 2014), Paper No. 18.

41. 134 S. Ct. 2120, 2124 (2014).

42. The pre-*Nautilus* indefiniteness standard applied by the PTAB was similar to the post-*Nautilus* standard: “The test for whether a claim meets the definiteness requirement is whether a person of ordinary skill in the art would have understood the scope of the claim when read in light of the specification. *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001).” See *Inventor Holdings CBM Institution Decision*, *supra* note 36, at 18. The main difference is the addition of the phrase “reasonable certainty” in the current standard. Although pre-*Nautilus* cases may be slightly less reliable than post-*Nautilus* cases for purposes of citation in a PTAB filing, they are still helpful to understand how the PTAB may deal with indefiniteness in PGRs.

43. *See, e.g.*, Decision Denying Institution of Covered Business Method Patent Review at 16–17, Hulu, LLC v. Intertainer, Inc., No. CBM2014-00053 (P.T.A.B. June 23, 2014), Paper No. 11; Decision [on] Institution of Covered Business Method Patent Review at 23, Bloomberg Inc. v. Markets-Alert Pty Ltd., No. CBM2013-00005 (P.T.A.B. Mar. 29, 2013), Paper No. 18.

44. *See, e.g.*, Stewart Title CBM Institution Decision, *supra* note 35, at 25–28; Decision Denying Institution of Covered Business Method Patent Review at 9–11, MasterCard Int’l Inc. v. D’Agostino, No. CBM2013-00057 (P.T.A.B. Mar. 7, 2014), Paper No. 9.

45. Decision [on] Institution of Covered Business Method Patent Review at 13, Google Inc. v. Unwired Planet, LLC, No. CBM2014-00004 (P.T.A.B. Apr. 8, 2014), Paper No. 8.

46. Michelle K. Lee, Deputy Under Sec’y of Commerce for IP & USPTO Deputy Dir., Address at Stanford Law School: Speaking Truth to Patents: The Case for a Better Patent System (June 26, 2014), http://www.uspto.gov/news/speeches/2014/lee_stanford.jsp.

47. *See* Zodiac Pool Sys., Inc. v. Aqua Prods., Inc., No. IPR2013-00159, at 42–45 (P.T.A.B. Aug. 22, 2014), Paper No. 71; LaRose Indus., LLC v. Capriola Corp, No. IPR2013-00120, at 30–34 (P.T.A.B. June 26, 2014), Paper No. 37.

48. Aristocrat Techs. Austl. Pty Ltd. v. Int’l Game Tech., 521 F.3d 1328, 1331 (Fed. Cir. 2008).

49. *Id.* at 1333.

50. *See* MotionPoint CBM Institution Decision, *supra* note 34, at 26–27; Decision [on] Institution of Covered Business Method Patent Review at 17–22, eBay Enter., Inc. v. Lockwood, No. CBM2014-00025 (P.T.A.B. May 20, 2014), Paper No. 24; Decision [on] Institution of Covered Business Method Patent Review at 19–24, eBay Enter., Inc. v. Lockwood, No. CBM2014-00026 (P.T.A.B. May 15, 2014), Paper No. 25; Decision [on] Institution of Covered Business Method Patent Review at 26–27, Chi. Mercantile Exch., Inc. v. 5th Mkt., Inc., No. CBM2013-00027 (P.T.A.B. Dec. 18, 2013), Paper No. 9.

51. Decision [on] Motion for Additional Discovery at 3, Bloomberg Inc. v. Markets-Alert Pty Ltd., No. CBM2013-00005 (P.T.A.B. May 29, 2013), Paper No. 32 [hereinafter Bloomberg Discovery Decision].

52. *Id.* at 5; Decision on Motion for Additional Discovery at 6, Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC, No. IPR2012-00001 (P.T.A.B. Mar. 5, 2013), Paper No. 26 [hereinafter Garmin Discovery Decision].

53. Garmin Discovery Decision, *supra* note 52, at 6.

54. Bloomberg Discovery Decision, *supra* note 51, at 5.