

Abusive and Successive IPR Petitions Can Bar Future Ex Parte Reexaminations

DECEMBER 9, 2021

In re Vivint, Inc., No. 90/020,115 (Fed. Cir. Sept. 29, 2021)

The Federal Circuit vacated and remanded with instructions to dismiss the United States Patent and Trademark Office's (USPTO) final rejection in an *ex parte* reexamination, following a series of unsuccessful IPR petitions. The court held that while the reexamination was based on substantial new questions of patentability, the USPTO abused its discretion and acted arbitrarily and capriciously in granting the reexamination and refusing to dismiss it.

Petitioner had raised several successive IPRs, each incrementally improving upon the last, and each of which the USPTO refused to institute. The USPTO denied the last IPR on the grounds that this filing behavior was abusive. Petitioner later brought the *ex parte* proceeding partially on the same grounds as this last IPR. Patent owner twice moved to dismiss under § 1.181, but the USPTO claimed it had no authority to consider petitions filed after reexamination was ordered and issued a final rejection of all claims.

On appeal, the Federal Circuit held that the *ex parte* proceeding concerned a new question of patentability, even though it had been presented to the USPTO in a previously rejected IPR petition. However, the Federal Circuit held that the USPTO did have the legal authority to reconsider orders granting reexamination, and that the USPTO under § 325(d) cannot deny institution of an IPR based on abusive filing practices and then grant a nearly identical reexamination request.

Read the full decision [here](#).

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