

Additional Petitions Denied Where Petitioner Could Have Challenged All Claims on at Least One Ground in a Single Petition

JANUARY 11, 2022

Fantasia Trading LLC v. CogniPower, LLC, [IPR2021-00067](#), [-68](#), [-69](#), [-70](#), [-71](#), [-72](#), [-73](#) (PTAB May 12 & 20, 2021).

Before: Turner, Smith, Kenny.

Petitioner filed two sets of IPR petitions challenging two patents: four petitions challenging one patent and three petitions challenging another. Each patent contained more than 60 claims, and the various petitions addressed different claims with no overlap. Pursuant to the Board's [Consolidated Trial Practice Guide](#), the petitioner filed notices in each proceeding ranking and explaining the differences between the petitions. The petitioner requested that the Board institute all petitions, but ranked one petition for each patent first in the event the Board denied any of them. The Board instituted only the first-ranked petition for each patent and exercised its discretion to deny the rest under 35 U.S.C. § 314.

The petitioner argued that the Board should institute all petitions because each one challenged a distinct set of claims and relied on different combinations of references. The patent owner was asserting a large number of claims in parallel litigation, and the petitioner argued that it needed separate petitions to address all of them due to the word-count limitations. The patent owner disputed these assertions and argued that the petitions were largely redundant and recycled combinations of the same or similar references.

The Board acknowledged that the petitions each challenged different claims, but it rejected the notion that multiple petitions were necessary to challenge all claims. Notably, the Consolidated Trial Practice Guide "finds it unlikely that circumstances will arise where three or more petitions by a petitioner with respect to a particular patent will be appropriate." Here, the Board focused on the fact that each petition asserted multiple grounds for almost every challenged claim, with significant repetition across petitions. Importantly, the petitioner failed to show that it could not have asserted at least one ground against each claim in a single petition.

The Board also found that the petitioner failed to explain material differences between the grounds it was asserting. As examples, the Board noted that the petitioner did not explain that different dependent claims required the assertion of different primary references. Nor did the petitioner argue that the Board's discretion under 35 U.S.C. § 325(d) to deny a petition because the same or substantially the same art was previously presented to the Office would require arguments under multiple prior art references. Because the petitioner failed to demonstrate a need

for multiple petitions to challenge the patentability of all the claims, the Board exercised its discretion to deny the additional petitions for each patent.

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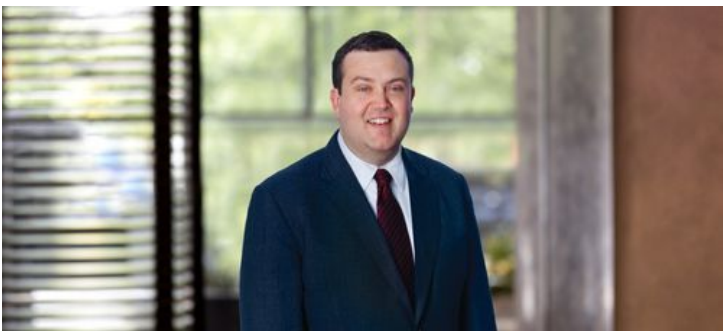
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