



THINK FORWARD

PTAB Grants Rare Requests for Rehearing

The Patent Trial and Appeal Board (PTAB) has rarely granted requests for rehearing on its decisions to deny institution of *inter partes* review (IPR) or covered business method patent review (CBM) since the institution of these proceedings in 2012. However, in two recent PTAB decisions a Petitioner succeeded in convincing a PTAB panel to reverse (in part) its earlier decision denying institution of *inter partes* review. See *AVX Corporation v. Greatbatch, Ltd.*, IPR2015-00710, Paper 13 (Jan. 13 2016); *Milwaukee Electric Tool Corp. v. Irwin Industrial Tool Co.*, IPR2015-01462, Paper 13, (Jan. 15, 2016).

A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d). The party challenging the decision bears the burden of showing that the decision should be modified. *Id.* Furthermore, “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c).

In **AVX**, Petitioner sought *inter partes* review of claims 1-20 of U.S. Patent No. 7,327,553. The Board denied institution as to all challenged claims. In its decision denying institution, the Board did not adopt either the Petitioner or Patent Owner’s construction of the claim term “laminar delamination gap,” but instead provided its own construction. *AVX*, Paper 13, pp. 2-3. The Board then concluded that the prior art cited by Petitioner did not disclose the claimed “laminar delamination gap” as construed, and denied the Petition. *Id.* at 3-4.

In its Request for Rehearing, Petitioner argued that the Board overlooked evidence presented in the Petition, as well as in the supporting declaration of Petitioner’s expert, that the cited art did disclose the claimed “laminar delamination gap” as construed by the Board. *Id.* at 5. Judge Roesel argued in dissent that the Petitioner’s arguments had not been overlooked or misapprehended because they were presented for the first time in the Request for Rehearing. *Id.* at 19. Nonetheless, while the majority of the panel acknowledged that “Petitioner’s arguments were not presented in the Petition or the Declaration with great clarity or precision” (*id.* at 7, n. 3), they ultimately agreed with Petitioner and granted the Request for Rehearing as to some of the challenged claims.

In **Milwaukee Electric Tool**, Petitioner sought review of claims 1-34 of U.S. Patent No. 8,579,555 on several grounds. The Board’s decision instituting the IPR did not include claims 21-30 in the second ground argued by Petitioner. In its Request for Rehearing, Petitioner argued that its Petition included a typographical error omitting claims 21-30 in the heading for Ground 2, which may have caused the Board to overlook claims 21-30 in that ground. *Milwaukee Electric Tool*, Paper 13, p. 2. The Board agreed that the typographical error in the Petition caused them to overlook the fact that claims 21-30 were included in Ground 2 of the Petition. *Id.* The Board granted the Request for Rehearing, and then instituted the IPR on the overlooked claims. *Id.*

While the PTAB still rarely grants requests for rehearing, particularly from decisions denying institution of IPR or CBM, decisions like these provide at least some hope where the requesting party can point to evidence or arguments in the underlying paper that the Board may have missed.

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