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The PTAB's Discretionary Denial of Concurrently Filed Petitions

by [John C. Alemanni](#) , [Justin L. Krieger](#)

On May 20, 2019, the PTAB exercised its discretion under 35 U.S.C. § 314 and denied one of two related petitions filed on the same day by a petitioner challenging the same patent. Comcast Cable Communications LLC v. Rovi Guides Inc., IPR2019-00232, [Paper 14](#). Several weeks before the decision was issued, the PTAB issued an order requiring that the Petitioner rank the two petitions, provide a "succinct explanation of the differences between the petitions," and explain why the PTAB should consider the second petition if it decides to consider the first. The Patent Owner was also given an opportunity to respond. After analyzing the two petitions and considering the arguments of the parties, the PTAB denied institution of the second petition concluding that "the differences between the asserted art and arguments [were not] sufficiently material to outweigh the inefficiencies and costs of instituting an additional proceeding."

Prior to the Supreme Court's *SAS* decision, the PTAB would frequently deny institution of redundant grounds presented in a petition. It was thus incumbent on Petitioners to explain the differences between various grounds to avoid a finding of redundancy and partial denial. Post-*SAS*, Petitioners have often filed multiple petitions challenging the same patent for a variety of reasons. For example, in some cases the limited word count does not provide sufficient room to fully lay out all of Petitioner's argument. The *Comcast* decision makes clear that if Petitioners decide to file multiple petitions, they must provide some explanation of why the PTAB should institute all of the petitions. Petitioners must also consider the potential estoppel effect of a non-instituted petition. At this point, it is unclear how district courts will treat the non-instituted petitions. They may follow the *Shaw* and *HP* cases, limiting estoppel to those grounds that were actually instituted. There is also a risk, however, that district courts may find that the grounds in the second petition "could have been raised" in the first petition, thereby estopping petitioner from raising them in a related district court proceeding.