

Eugene Goryunov and Clint Wilkins in IP Watchdog; Discretionary Denial Under Section 325(d): Nuances of Advanced Bionics Framework

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PRACTICES Intellectual Property, Patents, Patent Litigation, Patent Office Trials, Intellectual Property Litigation

Haynes Boone Partners [Eugene Goryunov](#) and [Clint Wilkins](#) authored an article in *IP Watchdog*. Read an excerpt below:

The Patent Trial and Appeal Board (PTAB) has the discretion to deny institution of an inter partes review (IPR) proceeding under 35 U.S.C. § 325(d) if “the same or substantially the same prior art or arguments previously were presented to the Office.” In *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH (Advanced Bionics)*, the PTAB established a two-part framework for determining whether a PTAB panel should exercise discretion under Section 325(d):

[1] Whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and

[2] If either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

The Board continued: “If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute inter partes review.”

In its decision, the Board also indicated that prior art submitted in an Information Disclosure Statement (IDS) and considered (e.g., initial by an examiner) during prosecution qualifies as art “previously presented to the Office” such that the first condition of *Advanced Bionics* is satisfied. As compared with prior decisions, *Advanced Bionics* can be viewed as potentially creating a new risk for discretionary denial that did not exist previously with respect to IDS references. For example, according to a decision from less than a year prior to *Advanced Bionics*, “[t]he Board has consistently declined exercising its discretion under Section 325(d) when the only fact a Patent Owner can point to is that a reference was disclosed to the Examiner during the prosecution.”

This article surveys recent PTAB decisions having the common fact that the IPR challenges rely upon prior art that is the same or substantially the same as prior art submitted in an IDS during prosecution to glean insights as to how parties and the Board are addressing *Advanced Bionics* in this scenario. The results of the survey suggest that, in the absence of facts in support of denial beyond that prior art was simply cited in an IDS, petitioners have generally avoided discretionary denial, consistent with the state of the law prior to *Advanced Bionics*. However, if a patent owner can identify facts that alter the patent examination narrative, the risk for petitioners increases.

***Advanced Bionics* Framework Part I**

Petitioners have alleged that references simply appearing in an IDS do not satisfy the first part of the *Advanced Bionics* framework. However, the Board has been clear that such references satisfy the first condition of *Advanced Bionics*, regardless of when the IDS was submitted during prosecution or how many other references appear in the IDS.

Excerpted from *IP Watchdog*. To read the full article, [click here](#).