

Wilkins, Ehmke and Horsley in IPWatchdog: Post-Vivint Patent Office Treatment of Ex Parte Reexaminations After Non-Instituted IPRs

May 1, 2023 Clint Wilkins, Andrew Ehmke

PRACTICES Intellectual Property, Patent Office Trials, Patents

Partners [Clint Wilkins](#) and [Andy Ehmke](#) and Associate Eric Horsley authored an article in *IPWatchdog* discussing ex parte reexaminations of IPRs in the wake of *In re Vivint*. Read an excerpt below:

Given the various ways the Patent Trial and Appeal Board (PTAB) can exercise discretion to deny institution of an *inter partes* review (IPR) petition (and the corresponding non-appealability of those decisions), *ex parte* reexamination is becoming an attractive option to challenge patent validity following a decision not to institute.

Because a later filed *ex parte* reexamination is often viewed as a “second bite at the apple,” there were questions as to how the U.S. Patent and Trademark Office (USPTO) should treat these second attempts at invalidating a patent. For IPRs, the PTAB has used several bases for discretionary denial of a later-filed IPR, but those bases were not being applied to follow-on *ex parte* reexamination requests. However, in *In re Vivint*, the Federal Circuit held that the USPTO has the authority to discretionarily deny an *ex parte* reexamination request under 35 U.S.C. § 325(d), i.e., if “the same or substantially the same prior art or arguments previously were presented to the Office.” *In re Vivint, Inc.*, 14 F.4th 1342, 1354 (Fed. Cir. 2021).

In re Vivint, Inc.

Alarm.com filed three petitions seeking IPR of Vivint’s patent. The last of the three IPRs was denied institution due to “undesirable, incremental petitioning” as a “similar, serial challenge[] to the same patent, by the same petitioner.” *In re Vivint, Inc.*, 14 F.4th 1342, 1346 (Fed. Cir. 2021) (quoting from the Board’s decision). Moreover, the Board “relied on § 325(d) considerations” to deny institution based on “abusive filing practices.” *Id.* at 1350.

After the failed IPR petitions, Alarm.com requested *ex parte* reexamination of the same patent, “largely repackag[ing]” the arguments raised in the third IPR petition. *Id.* at 1346. During the reexamination, Vivint’s repeated requests for dismissal under § 325(d) were denied. *Id.* at 1347-48. After final rejection of all claims, Vivint appealed to the PTAB, who affirmed, and then to the Federal Circuit. *Id.* at 1348.

To read the full article on *IPWatchdog*, [click here](#).