

Post-Grant Proceedings

**USPTO PUBLISHED
FINAL RULES
37 C.F.R. § 42**

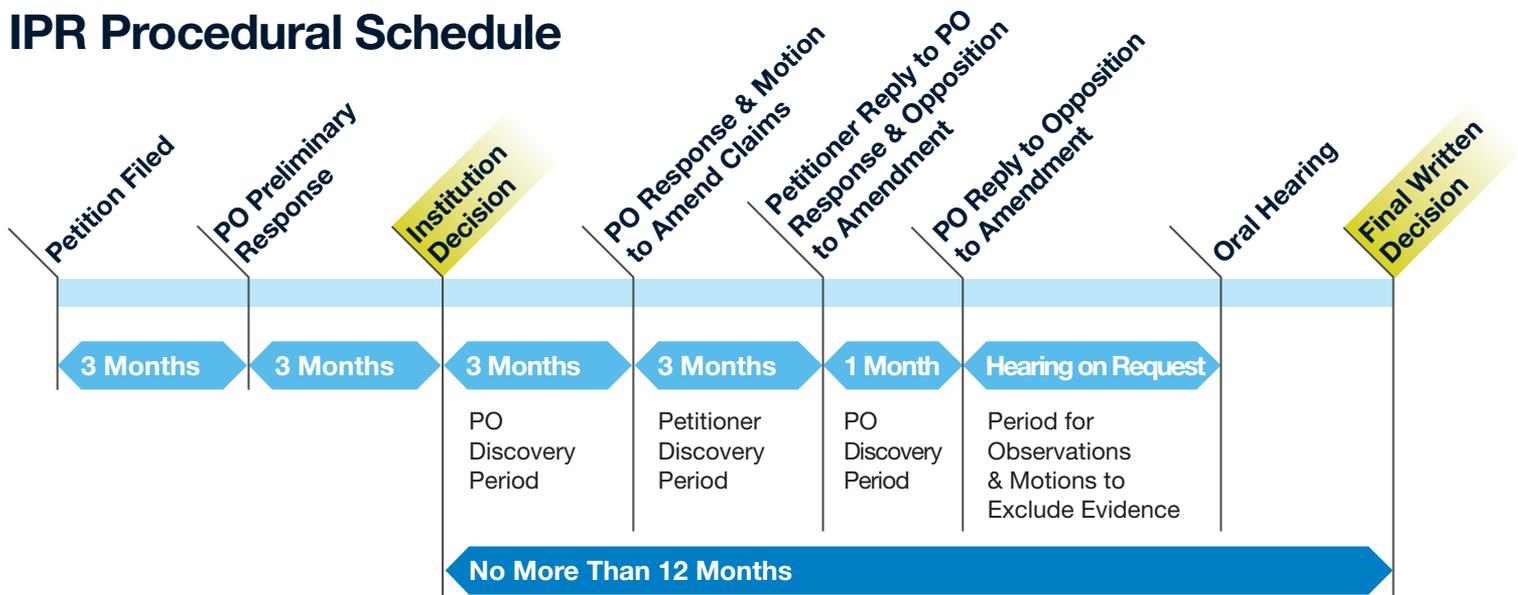
Snapshot: Inter Partes Review

Starting September 16, 2012, Inter Partes Review (IPR) became available to challenge the validity of issued patents, replacing Inter Partes Reexamination (IPRx).

- Inter partes (“between parties”) litigation before an administrative law judge (ALJ) of the new Patent Trial and Appeal Board (PTAB) in 3 phases, over 18 months:
 - Phase I Petition & Initiation
 - Any patent issued for 9 or more months may be challenged, by anyone other than the patent owner, based on prior art patents, published applications, or publications (not sale, use, § 101 subject matter, § 112 written description/enablement, etc.)
 - 60-page-maximum petition (including claim construction, prior art identification, and claim charts) plus exhibits (prior art, declarations, etc.)
 - PTO initiates if “reasonable likelihood petitioner will prevail”; while different, the standard for IPR initiation does not appear to be materially narrower than the standard for IPRx, which yielded >90% adoption
 - Phase II Discovery & Briefing – Petitioner and patent owner alternate, with ALJ resolving disagreements on conference calls
 - Phase III Hearing, Decision, Rehearing, Appeal to the Federal Circuit (not District Court)
- Co-pending patent litigation
 - IPR must be filed within 1 year of service of complaint on petitioner, and/or prior to declaratory judgment action by challenger action
 - District court stay rate expected to exceed old Inter Partes Reexamination rate (56% nationally), due to mandated speed of new proceeding
- Estoppel upon PTAB final decision – Petitioner barred from asserting or maintaining invalidity (at PTO or court) based on all references petitioner “raised or reasonably could have raised”
- USPTO fee starts at \$27,200 for up to 20 claims, increases for additional claims
- PTAB statistics including dispositions, pendency, inventory, and other tracking measures: www.uspto.gov/ip/boards/bpai/stats/index.jsp
- Additional resources covering IPR and other post-grant proceedings: www.fishpostgrant.com

Snapshot: Inter Partes Review

IPR Procedural Schedule



IPR Compared to Other Post-Grant Proceedings

Proceeding	Who May Seek?	When Does It Apply?	Legal Standard?	Grounds?	Estoppel?
Inter Partes Review	Anyone other than patent owner	<ul style="list-style-type: none"> Applies to all patents – beginning 9 months after issue (i.e., after Post-Grant Review window) PTO can initially limit (e.g., 250/year) 	Reasonable likelihood that petitioner would prevail on at least 1 challenged claim	<ul style="list-style-type: none"> Patents Published patent apps Printed publications 	Raised or reasonably could have raised
Supplemental Examination	Patent owner only	Applies to all patents	Substantial new question of patentability would result in Ex Parte Reexamination by PTO	Any information	N/A
Ex Parte Reexamination (Unchanged)	Anyone	Unchanged	Substantial new question of patentability	<ul style="list-style-type: none"> Patents Published patent apps Printed publications 	No legal estoppel
Post-Grant Review	Anyone other than patent owner	<ul style="list-style-type: none"> Applies only to patents having a claim with a priority date on or after March 16, 2013, within 9 months of issue PTO can initially limit (e.g., 250/year) 	More likely than not that at least 1 claim is unpatentable	Any invalidity ground	Raised or reasonably could have raised
Derivation Proceedings	Inventor only	Applies to all claims with priority dates on or after March 16, 2013 (Interference remains available for others)	Claimed invention derived from another	N/A	N/A

For More Information



Karl Renner
Principal, Co-Chair,
Post-Grant Practice
202-626-6447
renner@fr.com



Dorothy Whelan
Principal, Co-Chair,
Post-Grant Practice
612-337-2509
whelan@fr.com



Chad Shear
Principal, Co-Chair,
Post-Grant Practice
858-678-4730
shear@fr.com

fr.com | fishpostgrant.com



Atlanta Austin Boston Dallas Delaware Houston Munich New York Silicon Valley Southern California Twin Cities Washington, DC
Fish & Richardson is a global patent, intellectual property (IP) litigation, and commercial litigation law firm with more than 400 attorneys and technology specialists across the U.S. and Europe. Fish has been named the #1 patent litigation firm in the U.S. for 10 consecutive years. Fish has been winning cases worth billions in controversy – often by making new law – for the most innovative clients and influential industry leaders since 1878. For more information, visit www.fr.com.

These materials may be considered advertising for legal services under the laws and rules of professional conduct of the jurisdictions in which we practice. The material contained in this brochure has been gathered by the lawyers at Fish & Richardson P.C. for informational purposes only and is not intended to be legal advice. Transmission is not intended to create and receipt does not establish an attorney-client relationship. Legal advice of any nature should be sought from legal counsel.