

Post-Grant for Practitioners



FR

Part X: Basics and Strategies for Appeals from PTO Post-Grant Decisions



John Dragseth
Principal

Agenda

- Background of Post-Grant Proceedings
- Steps to Appeal in Patent Office and Federal Circuit
- Timeline of an ITC Appeal to the Federal Circuit
- Unique Issues in PTO appeals
- Strategy in the Patent Office
- Strategy in the Federal Circuit

I. Overview

Where? ... see invitation

How often? ... monthly

When? ... 2nd Wednesday

Topics? ...

Important decisions

Developments

Practice tips

FR FISH & RICHARDSON

Post-Grant Practice



Post-Grant for Practitioners:

A monthly series of webinars focusing on developments in post-grant proceedings and related practice tips

Part I: Inter Partes Review and Covered Business Method Patents - the First Five Months.

Wednesday, February 13, 2013
1:00 p.m. ET

Fish & Richardson's post-grant practice chairs are back with a new monthly series of webinars devoted to topics of interest in the emerging area of post-grant proceedings. Join them as they share their experiences, insights, and practice tips.

This first webinar will discuss the first five months of inter partes review and covered business method patents.

Speakers:

[Dorothy Whelan](#), Principal and Post-Grant Practice Co-Chair, Twin Cities
[Karl Renner](#), Principal and Post-Grant Practice Co-Chair, Washington, DC

Fish & Richardson will apply for 1.0 hour of general CLE credit in most states. If you would like to receive CLE credit, RSVP with your state bar information.

RSVP

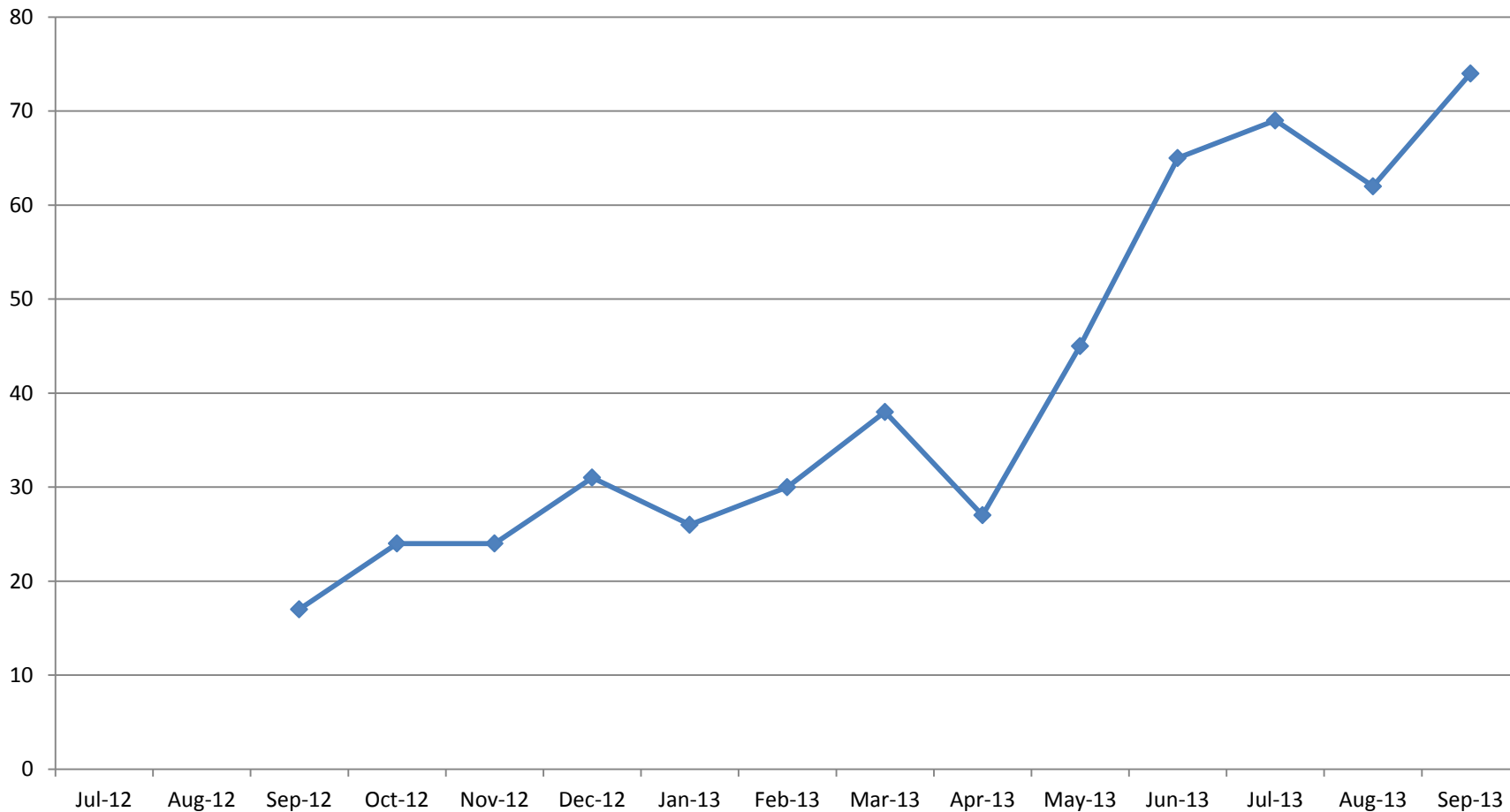
If you have questions, please contact Tracey Spadavecchia at spadavecchia@fr.com.

I. Overview (con't)

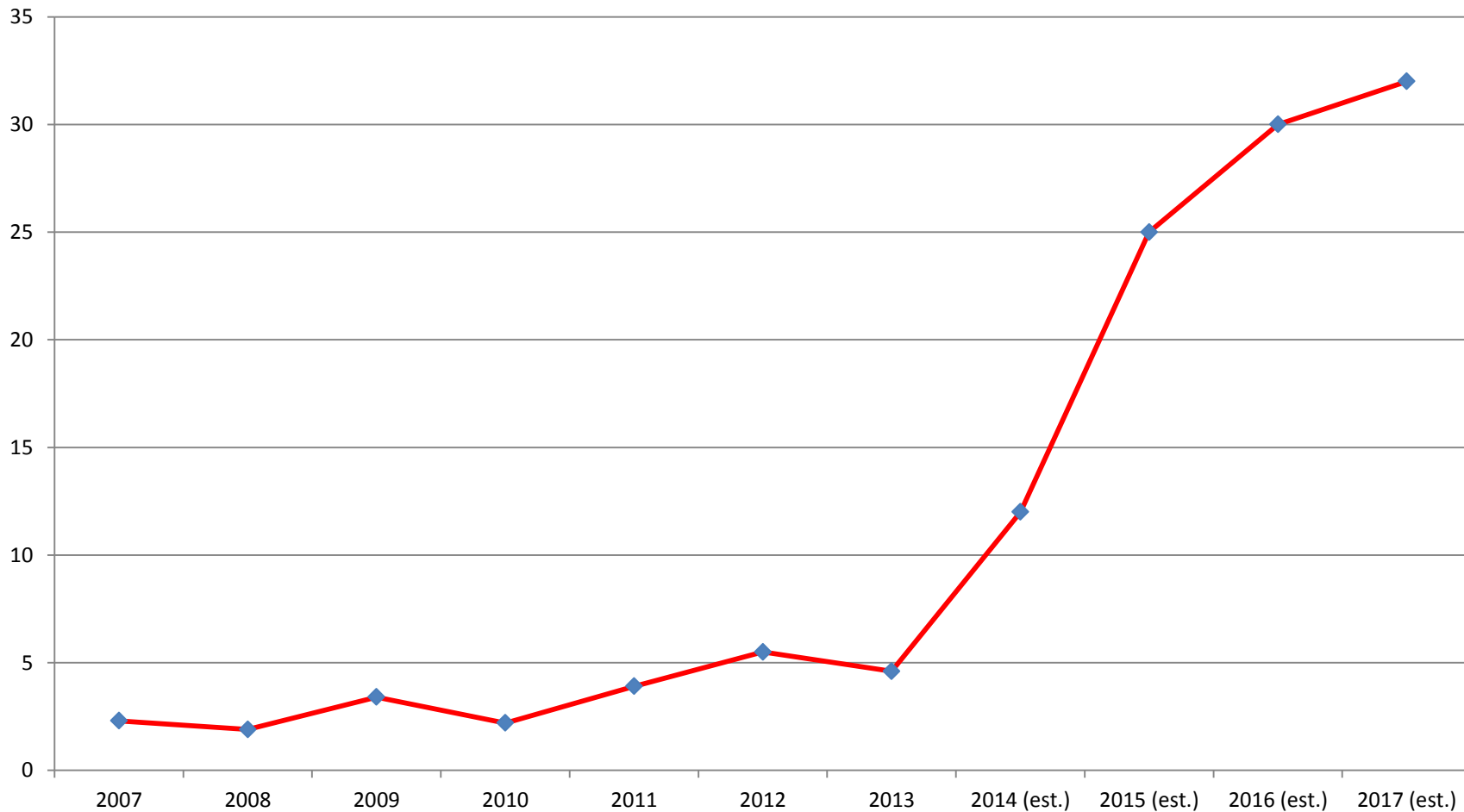
- Housekeeping
 - CLE
 - Questions
 - Materials
 - 2012 & 2013 Webinar series: <http://fishpostgrant.com/webinars/>

#fishwebinar

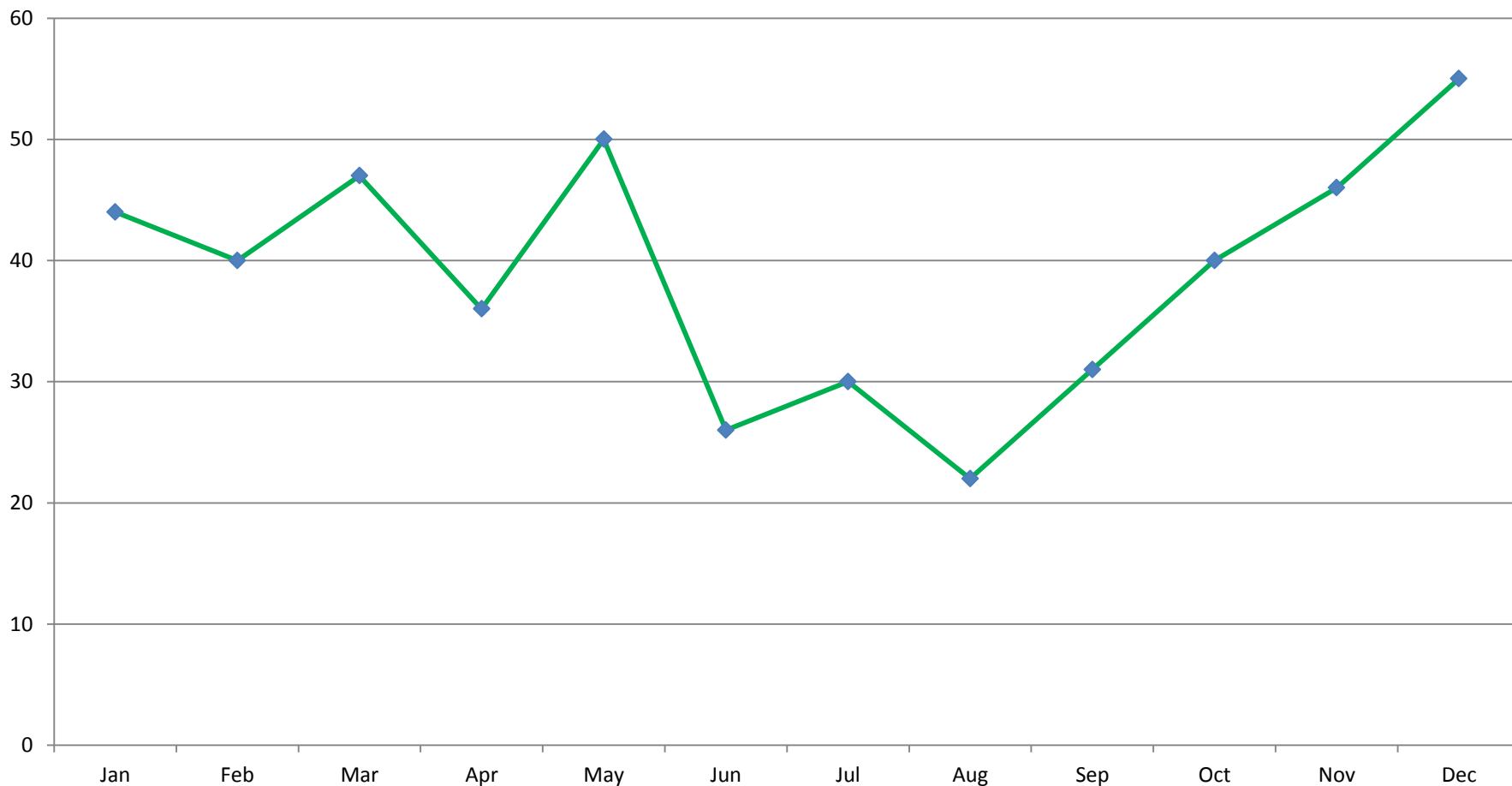
IPRs Filed



of PTO Appeals Argued at Federal Circuit



Total Past Federal Circuit Arguments (of any type)



50%+ Increase in Number of Cases Argued to the Federal Circuit



Background of Post-Grant Proceedings

- Finishing up *inter partes* reexamination and continuing *ex parte* reexamination. Standard examination followed by Board appeal.
- *Inter partes* review (IPR) is the big one right now. Straight to a Board decision in 18 months.
- Post-Grant Review (PGR). The future. Also straight to the Board.
- Covered Business Method (CBM) review. A special form of PGR for a claimed “financial product or service.”
- Derivation proceedings. Small in number.

(Just search on these terms, and the PTO has great FAQs.)

Steps to Appeal in PTO

Controlling U.S. Code -- 35 USC § 141(c) - Appeal to Court of Appeals for the Federal Circuit

- For IPR or PGR, “dissatisfied” party can appeal “only to” the Federal Circuit
- Trickier for derivation proceedings

Controlling Regulations -- 37 CFR Part 90 and Fed Cir R. 15.

Notice of Appeal:

- "must be filed with the Director," 37 CFR 90.2(a), with copy of notice to PTAB, 37 CFR 90.2(a), and 3 copies to Federal Circuit clerk, Fed Cir R. 15(a)(1)
- include your name, address, and telephone number
- Must give Director enough information so that Solicitor can determine whether to intervene. 37 CFR 90.2(a)(3)(ii)
- Time for appeal (37 CFR 90.3(a)) - "no later than sixty-three (63) days after the date of the final Board decision."

Cross-appeals covered by FRAP 4(a)(3) – within 14 days of the Notice of Appeal

Time to file Notice of Election in derivation proceeding "is governed by 35 U.S.C. 141(d)."

Computing time:

- time reset by rehearing request (but not by subsequent requests unless request permitted by Board order).
- Holidays and weekends carry over to next open day.

Extension of Time (made per 37 CFR 104.2):

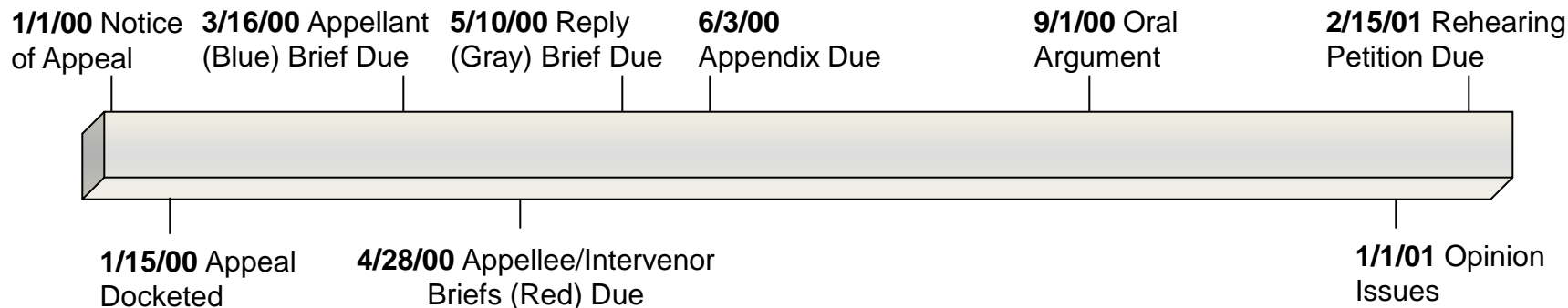
- Director can extend, based on written request if: (i) good cause shown in request made before deadline for appeal; or (ii) showing of excusable neglect in request made after deadline.

Steps to Appeal in Federal Circuit

- Docketing – initial filings (interest statement, entries of appearance)
- Issues and Appendix by appellant
- Appellant Blue Brief – 60 days
- Appellee Red Brief – 40 days
- Appellant Gray (reply) Brief – 14 days
- Appendix – 10 days
- Oral Argument – 5-13 weeks later
- Decision – 1 day, or 3-5 months, later
- Rehearing – 30 days later
- Certiorari – 90 days later
- Motions?

Federal Circuit Appeal Timeline

(no extensions & no cross-appeals = 12-13 months)



Unique Issues in PTO Appeals

- Interaction with PTO Solicitor
- Standard of Review
- *Chenery* Doctrine
- Disposition on Remand
- Building of Record – discovery provisions (including objections)
- Secrecy

Strategy in PTO

- Go all-in early
- Marshall evidence
- Preserve arguments but don't annoy (redundancy)
- Develop interesting legal theories early, with your factual arguments
- Involve someone who is accustomed to developing legal arguments
- Advanced “work-arounds”

Strategy in the Federal Circuit

- Get fresh eyes
- If appellant, find a legal “hook” – somehow – in any manner possible – by hook or by crook
- If appellee, “bury” the case
- Don’t over-rely on claim construction being *de novo*
- Assume your audience is smart, but not technical
- Loosen up – don’t be a prosecutor
- Be clear



- In our initial 7-part webinar series titled “Challenging Patent Validity in the USPTO,” we explored details regarding several of the post grant tools, with 3 sessions dedicated to Inter Partes Review (IPR), and a final session walking through several hypotheticals, to help listeners understand how these apply to common situations.
- Audio and slides for these webinars are posted online at:
<http://fishpostgrant.com/webinars/>
- If you listen to these webinars, you will be well positioned to engage in a conversation over whether and when to use those tools and how to defend against them.

Resources

- F&R web sites:
 - Post-Grant for Practitioners: <http://fishpostgrant.com/webinars/>
 - General: <http://fishpostgrant.com/>
 - IPR: <http://fishpostgrant.com/inter-partes-review/>
 - PGR: <http://fishpostgrant.com/post-grant-review/>
 - Rules governing post-grant: <http://fishpostgrant.com/>
- USPTO sites:
 - AIA Main: http://www.uspto.gov/aia_implementation/index.jsp
 - Inter Partes: http://www.uspto.gov/aia_implementation/bpai.jsp

Questions?



John Dragseth
Principal, Twin Cities
dragseth@fr.com
612-337-2550

Special thanks to Dorothy Whelan, Karl Renner, Tom Rozylowicz, David Holt,
Andrew Patrick, and Josh Pond.

© Copyright 2013 Fish & Richardson P.C. 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 presentation has been gathered by the lawyers at Fish & Richardson P.C. for informational purposes only, is not intended to be legal advice and does not establish an attorney-client relationship. Legal advice of any nature should be sought from legal counsel. Unsolicited e-mails and information sent to Fish & Richardson P.C. will not be considered confidential and do not create an attorney-client relationship with Fish & Richardson P.C. or any of our attorneys. Furthermore, these communications and materials may be disclosed to others and may not receive a response. If you are not already a client of Fish & Richardson P.C., do not include any confidential information in this message. For more information about Fish & Richardson P.C. and our practices, please visit www.fr.com.