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/bpat/stats/index.jsp

- Additional resources covering IPR and other post-grant proceedings: www.fishpostgrant.com
### IPR Procedural Schedule

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<tr>
<td>Inter Partes Review</td>
<td>Anyone other than patent owner</td>
<td>• Applies to all patents – beginning 9 months after issue (i.e., after Post-Grant Review window) &lt;br&gt; • PTO can initially limit (e.g., 250/year)</td>
<td>Reasonable likelihood that petitioner would prevail on at least 1 challenged claim</td>
<td>• Patents &lt;br&gt; • Published patent apps &lt;br&gt; • Printed publications</td>
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<td>Supplemental Examination</td>
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**No More Than 12 Months**

### IPR Compared to Other Post-Grant Proceedings

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### For More Information

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