



America Invents Act: New Board Proceedings

Board of Patent Appeals and Interferences

January 25, 2012



Overview

- I. Board Provisions in America Invents Act (AIA)
- II. Brief Discussion of New Board Proceedings
 - Inter Partes Review (IPR)
 - Post-Grant Review (PGR)
 - Transitional Program for Covered Business Method Patents
 - Derivation
- III. Changes to Interferences



I. Board Provisions in AIA

- America Invents Act contains 37 different sections including:
 - Sec. 3 – Derivation Proceedings
 - Sec. 6 – Inter Partes Review and Post-Grant Review Proceedings
 - Sec. 7 – Patent Trial and Appeal Board
 - Sec. 18 – Transitional Program for Covered Business Method Patents



II. Brief Discussion of New Board Proceedings

- Inter Partes Review
 - Effective as of:
 - 1 year after enactment, Sec. 6(c)(2)
 - Petition requirements
 - Filed 9 months after grant of patent, § 311(c)(1)
 - Seeks to cancel claims based on §§ 102, 103 using patents or printed publications, § 311(b)
 - Demonstrate reasonable likelihood that petitioner will prevail on at least one claim challenged, § 314(a)



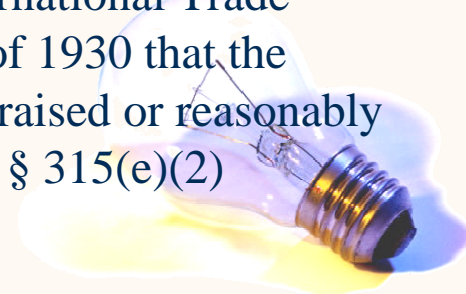
II. Brief Discussion of New Board Proceedings

- Inter Partes Review (cont.)
 - Who may file
 - 3rd Party who has not previously filed a civil action challenging the validity of a claim of the patent, §§ 311(a), 315(a)(1)
 - Petition must be filed within 1 year of service of complaint alleging infringement, § 315(b)
 - Review instituted by Board and completed within one year, which may be extended up to six months for good cause, § 316(a)(11)



II. Brief Discussion of New Board Proceedings

- Inter Partes Review (cont.)
 - Estoppel provisions § 315(e)
 - Petitioner, the real party in interest or privy of the petitioner, after a final written decision by the Board in an Inter Partes Review of a claim of a patent, may not
 - request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during the Inter Partes Review that resulted in the written decision, § 315(e)(1)
 - assert in either a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during the Inter Partes Review, § 315(e)(2)



II. Brief Discussion of New Board Proceedings

- Post-Grant Review
 - Effective as of:
 - Sec. 6(f)(2) provides for post grant 1 year after enactment but generally limited to patents in Sec. 3(n)(1)
 - Sec. 3(n)(1) refers to patents issuing from first-inventor-to-file applications filed 18 months after enactment



II. Brief Discussion of New Board Proceedings

- Post-Grant Review (cont.)
 - Petition requirements
 - Filed within 9 months after grant of patent, § 321(c)(1)
 - Seeks to cancel claims based on any ground that could be raised under paragraph (2) or (3) of § 282(b), relating to invalidity § 321(b)
 - Demonstrate that it is more likely than not that petitioner will prevail on at least one claim challenged or raises novel question that is important to other patents or publications, § 324(a), (b)



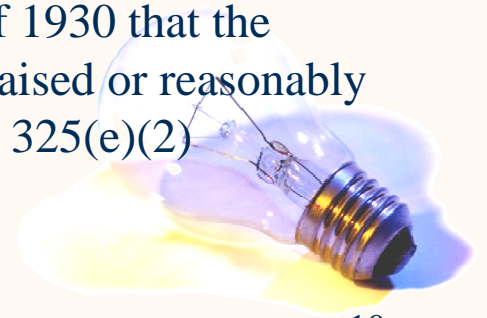
II. Brief Discussion of New Board Proceedings

- Post-Grant Review (cont.)
 - Who may file
 - 3rd Party who has not previously filed a civil action challenging the validity of a claim of the patent, §§ 321(a), 325(a)(1)
 - Review instituted by Board and completed within one year, which may be extended up to six months for good cause, § 326(a)(11)



II. Brief Discussion of New Board Proceedings

- Post-Grant Review (cont.)
 - Estoppel provisions § 325(e)
 - Petitioner, the real party in interest or privy of the petitioner, after a final written decision by the Board in an Post-Grant Review of a claim of a patent, may not
 - request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during the Post Grant Review that resulted in the written decision, § 325(e)(1)
 - assert in either a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during the Post Grant Review, § 325(e)(2)



II. Brief Discussion of New Board Proceedings

- Covered Business Method Patent Program
 - Effective as of:
 - Sec. 18(a)(2) provides for effect upon expiration of 1 year period after enactment
 - Program sunsets 8 years after regulations issued
 - Who may file
 - 3rd Party who has not filed civil action challenging patent but has been sued or charged with infringement, Sec. 18(a)(1)(B)



II. Brief Discussion of New Board Proceedings

- Covered Business Method Patent Program (cont.)
 - Petition requirements
 - Employs most post-grant review standards and procedures
 - Applies only to covered business method patent that is currently in litigation
 - Unlike PGR, applies to patents issuing from applications filed under current first-to-invent system
 - Provides limitations on type of pre-AIA prior art that may be used



II. Brief Discussion of New Board Proceedings

- Covered Business Method Patent Program (cont.)
 - Estoppel provisions – § 325(e)(1); Section 18, ¶ (a)(1)(D)
 - Petitioner, the real party in interest *or privity* of the petitioner, after a final written decision by the Board in a covered business method patent review of a claim of a patent, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised *or reasonably could have raised* during the Post Grant Review that resulted in the written decision, § 325(e)(1)
 - Petitioner or the real party in interest of the petitioner, after a final written decision by the Board in a covered business method patent review of a claim of a patent, may not assert in either a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised during covered business method patent review, Section 18, ¶ (a)(1)(D)



II. Brief Discussion of New Board Proceedings

- Derivation
 - Effective as of:
 - Sec. 3(n)(1) provides for effect 18 months after enactment
 - Petition requirements
 - Petition must be supported by substantial evidence that the claimed invention was derived from petitioner
 - Petition must be filed within one year of first publication of a claim to an invention that is the same or substantially the same invention as earlier application's claim to the invention, § 135(a)
 - Who may file
 - Applicant for patent



III. Changes to Interferences

- Interferences
 - Sec. 3(n)(2) provides that §§ 102(g), 135 & 291 are still in effect for:
 - Applications filed within 18 months of enactment and patents issuing therefrom
 - Application having a claim at any time to claimed invention that has an effective filing date within 18 months of enactment, or contains or contained at any time a specific reference to §§ 120, 121, 365(c)



Thank you!

