

POST GRANT REVIEW PROCEEDINGS IN THE PTO



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PARTNER



PATENT TRIAL AND APPEAL BOARD (PTAB)

COMPOSITION

- DIRECTOR
- DEPUTY DIRECTOR
- COMMISSIONER FOR PATENTS
- COMMISSIONER FOR TRADEMARKS
- APJ

PATENT TRIAL AND APPEAL BOARD (PTAB)

APJ

- LEGAL COMPETENCY
- SCIENTIFIC ABILITY
- APPOINTED BY SECRETARY OF COMMERCE WITH DIRECTOR CONSULTATION (COVERS PRIOR APPOINTMENTS)

PATENT TRIAL AND APPEAL BOARD (PTAB)

DUTIES

- REVIEW ADVERSE PATENTABILITY DECISIONS OF EXAMINERS
- APPEALS OF REEXAMINATIONS
- CONDUCT DERIVATION PROCEEDINGS
- CONDUCT IPR AND PGR

PATENT TRIAL AND APPEAL BOARD (PTAB)

3-MEMBER PANELS

- DESIGNATED BY DIRECTOR

INTER PARTES REEXAMINATION TRANSITION

THRESHOLD SHOWING

- SNQ REPLACED
- NEW STANDARD: REASONABLE LIKELIHOOD REQUESTER WOULD PREVAIL WITH RESPECT TO AT LEAST ONE CHALLENGED CLAIM

INTER PARTES REEXAMINATION TRANSITION

EFFECTIVE DATE

- DATE OF ENACTMENT (9/16/11)
- ALL IP REEXAM REQUESTS FILED BEFORE EFFECTIVE DATE OF IPR (9/16/12)

POST GRANT REVIEW (PGR)

REQUESTER

- ANYONE BUT PATENT OWNER
- SINCE IT IS INTER PARTES DIRECTOR CANNOT MAKE REQUEST

POST GRANT REVIEW (PGR)

FEES

- DIRECTOR SETS BY REGULATION
- PAID BY REQUESTER
- COVERS AGGREGATE COSTS OF PGR TO PTO

POST GRANT REVIEW (PGR)

SCOPE

- SEEK CANCELLATION OF ONE OR MORE CLAIMS
- GROUNDS OF INVALIDITY
 - 101
 - 102

POST GRANT REVIEW (PGR)

- 103
- 112 (EXCEPT FOR BEST MODE)
- 251
- DOUBLE PATENTING

POST GRANT REVIEW (PGR)

FILING DEADLINE

- NOT LATER THAN NINE MONTHS
- AFTER PATENT OR BROADENED REISSUE PATENT ISSUANCE

POST GRANT REVIEW (PGR)

CANCELLATION PETITION

- FEE
- REAL PARTIES IN INTEREST IDENTIFIED
- EACH CLAIM CHALLENGED
- BASIS OF UNPATENTABILITY

POST GRANT REVIEW (PGR)

- EVIDENCE (WITH COPIES TO PATENT OWNER)
 - COPIES OF PATENTS AND PRINTED PUBLICATIONS
 - AFFIDAVITS, DECLARATIONS, OPINIONS OF EXPERTS

POST GRANT REVIEW (PGR)

- OTHER INFORMATION AS DIRECTOR REQUIRES
- DIRECTOR TO MAKE PETITION AVAILABLE TO PUBLIC

POST GRANT REVIEW (PGR)

PRELIMINARY RESPONSE

- PATENT OWNER RESPONSE
- TIME PERIOD SET BY RULE

POST GRANT REVIEW (PGR)

INSTITUTION OF PGR

- AT LEAST ONE OR MORE CLAIMS MORE LIKELY THAN NOT ARE UNPATENTABLE
- AFTER CONSIDERATION OF REBUTTAL EVIDENCE

POST GRANT REVIEW (PGR)

- NOVEL OR UNSETTLED LEGAL QUESTION IMPORTANT TO OTHER PATENTS OR PATENT APPLICATIONS
- DECISION ON PETITION WITHIN THREE MONTHS

POST GRANT REVIEW (PGR)

- PRELIMINARY RESPONSE
- LAST DATE RESPONSE MAY BE FILED IF NO RESPONSE
- NOTICE TO PARTIES AND PUBLIC WITH START DATE OF REVIEW
- DETERMINATION IS NONAPPEALABLE

POST GRANT REVIEW (PGR)

RELATION TO OTHER PROCEEDINGS
PRIOR DJ ACTION BY PETITIONER (NOT
A COUNTERCLAIM)

- BARS PGR

POST GRANT REVIEW (PGR)

DJ ACTION BY PETITIONER ON OR AFTER PETITION

- STAY OF DJ ACTION UNTIL
 - PATENT OWNER MOVES TO LIFT STAY
 - PATENT OWNER SUES OR
COUNTERCLAIMS PGR INFRINGEMENT

POST GRANT REVIEW (PGR)

- PETITIONER MOVES TO DISMISS DJ ACTION

POST GRANT REVIEW (PGR)

PRELIMINARY INJUNCTIONS

- IF PATENT OWNER FILES SUIT FOR INFRINGEMENT WITHIN THREE MONTHS OF PATENT GRANT
 - NO STAY OF PI MOTION
 - IF IPR OR PGR FILED

POST GRANT REVIEW (PGR)

DIRECTOR MAY CONSOLIDATE
MULTIPLE PGR REQUESTS
REGARDING SAME PATENT
MULTIPLE PROCEEDINGS

- STAY, TRANSFER, CONSOLIDATION, OR TERMINATION

POST GRANT REVIEW (PGR)

- MAY CHOOSE NOT TO GRANT PGR IF ART OR ARGUMENTS PREVIOUSLY PRESENTED IN PRIOR PROCEEDINGS

POST GRANT REVIEW (PGR)

ESTOPPEL

- IF PETITIONER LOSES IN FINAL PTAB DETERMINATION IN PGR PETITIONER CANNOT REQUEST OR MAINTAIN PTO PROCEEDING ON GROUND RAISED OR REASONABLY COULD HAVE BEEN RAISED DURING PGR

POST GRANT REVIEW (PGR)

- IF PETITIONER LOSES FINAL PTAB DETERMINATION IN PGR, CANNOT ASSERT IN CIVIL ACTION OR ITC INVALIDITY DEFENSE ON GROUND RAISED OR REASONABLY COULD HAVE BEEN RAISED IN PGR

POST GRANT REVIEW (PGR)

CONDUCT OF PGR BY REGULATIONS

- PUBLIC FILE SUBJECT TO SEALED DOCUMENTS
- SUPPLEMENTAL INFORMATION
- LIMITED DISCOVERY

POST GRANT REVIEW (PGR)

- SANCTIONS
- PROTECTIVE ORDERS
- MOTION TO AMEND OR SUBSTITUTE NEW PATENT CLAIMS
- ORAL HEARING

POST GRANT REVIEW (PGR)

- FINAL DETERMINATION 12-18 MONTHS
- PETITIONER OPPORTUNITY TO FILE WRITTEN COMMENTS

POST GRANT REVIEW (PGR)

AMENDMENT

- CANCEL CLAIM
- PROPOSE SUBSTITUTE CLAIMS FOR EACH CHALLENGED CLAIM
- ONE OR MORE MOTIONS
- NO CLAIM SCOPE ENLARGEMENT
- NO NEW MATTER

POST GRANT REVIEW (PGR)

STANDARDS

- BROADEST REASONABLE CLAIM INTERPRETATION
- PREPONDERANCE OF EVIDENCE

POST GRANT REVIEW (PGR)

SETTLEMENT

- TERMINATION ON JOINT REQUEST PRIOR TO PTO DECISION
- NO ESTOPPEL IF TERMINATED
- MAY TERMINATE IF PETITIONER DROPS OUT

POST GRANT REVIEW (PGR)

- SETTLEMENT FILED WITH PTO, BUT KEPT SEPARATE FROM FILE UPON REQUEST

POST GRANT REVIEW (PGR)

DECISION BY PTAB

- FINAL DECISION ON PATENTABILITY
- CERTIFICATE PUBLISHED
- INTERVENING RIGHTS
 - ABSOLUTE
 - EQUITABLE

POST GRANT REVIEW (PGR)

- APPLIES TO AMENDED OR NEW CLAIMS
- PUBLICATION OF PGR PENDENCY DATA

POST GRANT REVIEW (PGR)

APPEAL

- APPEAL TO FED. CIRCUIT
- EITHER PARTY

POST GRANT REVIEW (PGR)

EFFECTIVE DATE

- ONE YEAR FROM DATE OF ENACTMENT (9/16/12)
- LIMITATION ON NUMBER FOR FIRST FOUR YEARS
- APPLIES TO PATENTS WITH CLAIMED PRIORITY AFTER 3/16/13

POST GRANT REVIEW (PGR)

PENDING INTERFERENCES

- DISMISSED IN FAVOR OF PGR
- PROCEED

POST GRANT REVIEW (PGR)

INTER PARTES REVIEW

- FILED BY ANYONE OTHER THAN PATENT OWNER
- EXCLUDES DIRECTOR SINCE IT IS INTER PARTES
- FEE BASED ON AGGREGATE COSTS TO PTO FOR REVIEW

POST GRANT REVIEW (PGR)

- UNPATENTABILITY OF AT LEAST ONE CLAIM
- LIMITED TO PATENTS AND PRINTED PUBLICATIONS UNDER 102 OR 103

POST GRANT REVIEW (PGR)

- FILED AFTER LATER OF
 - NINE MONTHS AFTER PATENT OR REISSUE GRANT
 - DATE OF TERMINATION OF PGR

POST GRANT REVIEW (PGR)

PETITION (AVAILABLE TO PUBLIC)

- FEE
- REAL PARTIES IN INTEREST
- CLAIMS CHALLENGED
- GROUNDS OF UNPATENTABILITY

POST GRANT REVIEW (PGR)

- EVIDENCE
 - COPIES OF PATENTS AND PRINTED PUBLICATIONS
 - AFFIDAVITS, DECLARATIONS, EXPERT OPINIONS
 - COPIES TO PATENT OWNER
 - OTHER REQUIREMENTS BY RULE

POST GRANT REVIEW (PGR)

PRELIMINARY PATENT OWNER RESPONSE

- TIME PERIOD SET BY DIRECTOR
- REASONS WHY IPR PETITION SHOULD BE DENIED

POST GRANT REVIEW (PGR)

INSTITUTION OF IPR

- REASONABLE LIKELIHOOD THAT PETITIONER WOULD PREVAIL
- WITH THREE MONTHS
 - PRELIMINARY RESPONSE
 - LAST DATE PRELIMINARY RESPONSE CAN BE FILED IF NONE

POST GRANT REVIEW (PGR)

- NOTICE TO PARTIES AND PUBLIC
- DECISION NOT APPEALABLE

POST GRANT REVIEW (PGR)

RELATION TO OTHER PROCEEDINGS

- INFRINGER'S CIVIL ACTION
 - NO IPR IF PRIOR DJ ACTION FILED BY PETITIONER
 - IF DJ ACTION FILED ON OR AFTER PETITION FILED CIVIL ACTION STAYED UNTIL

POST GRANT REVIEW (PGR)

- PATENT OWNER SEEKS TO LIFT STAY
- PATENT OWNER FILES INFRINGEMENT SUIT OR COUNTER CLAIM
- PETITIONER SEEKS TO DISMISS DJ ACTION

POST GRANT REVIEW (PGR)

PATENT OWNER ACTION

- NO IPR IF > ONE YEAR AFTER SERVICE OF INFRINGEMENT COMPLAINT
- TIME LIMIT DOES NOT APPLY TO JOINDER PARTY

POST GRANT REVIEW (PGR)

MULTIPLE PROCEEDINGS

- DIRECTOR MAY STAY, TRANSFER, CONSOLIDATE OR TERMINATE IPR OR OTHER PROCEEDINGS

POST GRANT REVIEW (PGR)

ESTOPPEL

- IF LOSE PTAB FINAL DETERMINATION MAY NOT REQUEST OR MAINTAIN OFFICE PROCEEDING THAT PETITIONER RAISED OR REASONABLY COULD HAVE RAISED AS GROUND OF UNPATENTABILITY AS TO THAT CLAIM

POST GRANT REVIEW (PGR)

- IF LOSE PTAB FINAL DETERMINATION CIVIL ACTION OR ITC ESTOPPEL AGAINST INVALIDITY DEFENSE ON GROUND THAT WAS RAISED OR COULD HAVE BEEN RAISED IN IPR

POST GRANT REVIEW (PGR)

CONDUCT OF IPR (RULES)

- PUBLIC, EXCEPT FOR SEALED DOCUMENTS
- SUPPLEMENTAL INFORMATION
- DISCOVERY INCLUDING DEPOSITIONS OF AFFIANTS OR DECLARANTS

POST GRANT REVIEW (PGR)

- SANCTIONS
- PROTECTIVE ORDERS
- AMENDMENTS OF CLAIMS ON MOTION
- ORAL HEARING
- FINAL DETERMINATION 12-18 MONTHS

POST GRANT REVIEW (PGR)

- JOINDER
- PETITIONER COMMENTS

POST GRANT REVIEW (PGR)

PTAB

- MOTIONS TO CANCEL OR SUBSTITUTE CLAIMS
- NO ENLARGEMENT OF CLAIM SCOPE
- NO NEW MATTER
- PREPONDERANCE OF EVIDENCE

POST GRANT REVIEW (PGR)

SETTLEMENT

- TERMINATION ON JOINT REQUEST PRIOR TO PTAB DECISION
- NO ESTOPPEL
- TERMINATE IF PETITIONER DROPS OUT

POST GRANT REVIEW (PGR)

- FILED WITH PTO AND KEPT SEPARATE FROM FILE ON REQUEST

POST GRANT REVIEW (PGR)

PTAB FINAL DECISION

- CERTIFICATE PUBLISHED
- INTERVENING RIGHTS REGARDING NEW OR AMENDED CLAIM
 - ABSOLUTE
 - EQUITABLE
- PUBLIC PENDENCY DATA

POST GRANT REVIEW (PGR)

EFFECTIVE

- ONE YEAR DATE OF ENACTMENT 9/16/12
- APPLIES TO ALL PATENTS
- DIRECTOR MAY LIMIT NUMBER IN FIRST FOUR YEARS
IF EXCEED FY 2010 IP REEXAM NUMBER FILED

BUSINESS METHOD TRANSITIONAL PROGRAM

- ONE YEAR AFTER ENACTMENT DATE (9/16/12)
- PGR PROCEDURES, EXCEPT
 - NO REQUIREMENT TO FILE WITHIN NINE MONTHS OF PATENT/ REISSUE ISSUANCE
 - JUDGE MAY STAY PI

BUSINESS METHOD TRANSITIONAL PROGRAM

- NO CIVIL ACTION ESTOPPEL
- NO LIMITATION TO BROADENED REISSUES
- PETITIONER MUST BE SUED FOR OR CHARGED WITH INFRINGEMENT

BUSINESS METHOD TRANSITIONAL PROGRAM

- FOR PETITIONS FILED BASED ON OLD 102 AND 103
 - 102(a)
 - 102(b) BASED ON THIRD PARTY DISCLOSURE
- CIVIL ACTION AND ITC ESTOPPEL AS TO GROUND RAISED IN TBMP PROGRAM

BUSINESS METHOD TRANSITIONAL PROGRAM

- RETROACTIVE
- EXCEPTION FOR PATENTS SUBJECT TO PGR
- EIGHT YEAR SUNSET AFTER REGS ISSUED
- WITH THOSE FILED PRIOR TO SUNSET STILL ELIGIBLE

BUSINESS METHOD TRANSITIONAL PROGRAM

STAYS

- SIMPLIFY ISSUES AND STREAMLINE TRIAL
- IF NO DISCOVERY COMPLETE AND TRIAL DATE SET
- NO UNDUE PREJUDICE

BUSINESS METHOD TRANSITIONAL PROGRAM

- REDUCE LITIGATION BURDEN
- RIGHT TO INTERLOCUTORY APPEAL TO FED. CIR. OF STAY DECISION

BUSINESS METHOD TRANSITIONAL PROGRAM

DEFINITION

- METHOD OR MACHINE FOR FINANCIAL PRODUCTS OR SERVICES
- CANNOT BE TECHNOLOGICAL INVENTION

THANK YOU

IF YOU HAVE ANY QUESTIONS, YOU
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