



AMERICA INVENTS ACT

IMPLEMENTATION

The Board of Patent Appeals and Interferences

New Board Proceedings

Overview

- I. The four types of proceedings
 - *Inter Partes* Review (IPR)
 - Post-Grant Review (PGR)
 - Transitional Program for Covered Business Method Patents (CBM)
 - Derivation

- II. Preliminary Proceeding – begins with filing of petition for instituting a trial and ends with a decision from Board as to whether a trial will be instituted.



Deciding to file

- IPR, PGR, CBM or Derivation?
- IPR – effective date 9/16/2012.
 - All patents are eligible – first to invent and first inventor to file.
 - Patents may be challenged under 35 U.S.C. 102 or 103 based on patents or printed publications.
 - A person who is not the patent owner and has not previously filed a civil action challenging the validity of a claim of the patent may file an IPR.
 - Person must file within one year of being served with a complaint alleging infringement.
 - Petition cannot be filed until after the later of: 1) 9 months after the grant of a patent or issuance of a reissue of a patent; or 2) the date of termination of any PGR of the patent.



Deciding to file

- PGR – effective date 3/16/2013.
 - With limited exceptions, only those patents issuing from applications subject to first-inventor-to-file provisions of the AIA.
 - PGR allows challenges based on §§ 101, 102, 103 and 112, except best mode.
 - A person who is not the patent owner and has not previously filed a civil action challenging the validity of a claim of the patent may file a PGR.
 - PGR may only be requested on or prior to the date that is 9 months after the grant of a patent or issuance of a reissue patent.



Deciding to file

- CBM – generally employs PGR procedures and standards.
 - Cannot file CBM during time a PGR could be filed, i.e., 9 months after issuance of a patent.
 - Petitioner must be sued or charged with infringement.
 - Patent must be a covered business method patent.
 - CBM patents that are to technological inventions are exempt.
 - Both first to invent and first inventor to file patents are eligible.
 - Prior Art is limited when challenging a first-to-invent patent.



Deciding to file

- **Derivation** – differs from IPR, PGR and CBM.
 - Only an applicant for patent may file a petition to institute a derivation proceeding.
 - Applicant must file petition within 1 year of the date of the first publication of a claim to an invention that is the same or substantially the same as the earlier application's claim to the invention.
 - The petition must set forth with particularity the basis for finding that an inventor named in an earlier application or patent derived the claimed invention.



Filing a Petition

- Petition requirements for IPR, PGR and CBM are generally the same:
 - Be accompanied by a fee.
 - Identify all real parties in interest.
 - Identify all claims challenged and grounds on which the challenge to each claim is based.
 - Provide a claim construction and show how the construed claim is unpatentable based on the grounds alleged.
 - Identify the exhibit number of the supporting evidence relied upon to support the challenge and state the relevance of the evidence.
 - Provide copies of evidence relied upon.



Filing a Petition

- Petition requirements for derivation:
 - Identify the application or patent for which a derivation is sought.
 - Certify that the petition was filed within the one year time set by statute.
 - Demonstrate that the petitioner has a pending application.
 - Show that the petitioner has at least one claim that is the same or substantially the same as the respondent's claimed invention.
 - Show that the respondent's claimed invention is not patentably distinct from the invention disclosed (directly or indirectly) to the respondent.
 - Certify that the earlier application was filed without authorization.
 - Provide a claim construction for the disputed claims.
 - Provide substantial evidence, including one affidavit, in support of the petition to show how the invention was communicated to the respondent.



The Preliminary Response

- A patent owner may file a preliminary response to the petition to provide reasons why no IPR/PGR/CBM should be instituted.
- Preliminary response is due 2 months from petition docketing date.
- General rule is that preliminary response may present evidence other than testimonial evidence. Testimonial evidence and discovery may be provided where necessary (case-by-case basis). For example, to demonstrate that petitioner's real party in interest is estopped from challenging patent claims.



Institution of Review

- When will the Board institute?
 - For IPR/PGR/CBM – if petition demonstrates (IPR- a reasonable likelihood; PGR/CBM – more likely than not) that petitioner will prevail as to at least one of the claims challenged. For derivation – when standard is met and petitioner’s claims are allowed.
 - Where standards are met, the Board will institute the trial on: 1) claim-by-claim basis; and 2) ground-by-ground basis.



The Trial Phase

- The Board has determined to institute – what next?
 - Scheduling Order concurrent with a decision to institute the trial. Conference call with Judge about one month from institution. (See Practice Guide). The Order would set due dates taking into account the complexity of the proceeding.
 - IPR/PGR/CBM trial will be completed within one year from institution, except the time may be extended up to six months for good cause.



Discovery

- Testimony and document production is permitted
 - AIA authorizes the Office to set standards and procedures for the taking of discovery.
 - The proposed rules allow for two types of discovery: routine discovery and additional discovery.



Discovery

- Routine discovery – reduces costs to parties by making basic information readily available at the outset of the proceeding. Routine discovery may assist the parties to assess the merits of their respective positions, to avoid harassment in the proceeding, or to reach settlement.
- Routine discovery includes:
 - documents cited,
 - cross-examination for submitted testimony, and
 - information inconsistent with positions advanced during the proceeding.



Discovery

- Additional discovery – a party must request any discovery beyond routine discovery.
- A party seeking additional discovery in IPR and derivation must demonstrate that the additional discovery is in the interests of justice.
- A party seeking additional discovery in PGR and CBM will be subject to the lower good cause standard.
- Live testimony – the Board may authorize, where critical, to assess credibility. For example, a Judge may attend a deposition in appropriate instances.



Final Decision

- Final decision where the case is not dismissed due to settlement
 - AIA provides that where an IPR/PGR/CBM trial is instituted, and not dismissed, the Board shall issue a final written decision. The decision shall address the patentability of any claim challenged and any new claim added.
 - For derivation, the Board shall issue a written decision that states whether an inventor named in an earlier application derived the claimed invention from an inventor named in the petitioner's application without authorization.



Estoppel

- Petitioner Estoppels After Final Written Decision
 - A petitioner in an IPR/PGR/CBM may not request or maintain a proceeding before the Office with respect to any claim on any ground raised or reasonably could have been raised.
 - A petitioner in an IPR/PGR/CBM may not assert in district court or the ITC that a claim is invalid on any ground petitioner raised, and in IPR/PGR, any ground that reasonably could have been raised.



Estoppel

- Patent Owner Estoppel
 - A patent owner whose claim is cancelled is precluded from taking action inconsistent with the adverse judgment including obtaining in any patent a claim to substantially the same invention.
- Derivation Specific Estoppel
 - In a derivation, a losing party who could have moved for relief, but did not so move, may not take action inconsistent with that party's failure to move. Where a party receives a split judgment (wins on one claimed invention, loses on another), estoppel does not attach to the subject matter for which a favorable judgment was obtained.
- http://www.uspto.gov/aia_implementation/ for more information.





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THANK YOU!