



Leahy-Smith America Invents Act – Overview: Post Grant Review, Reexamination & Supplemental Examination

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Agenda

- I. America Invents Act – Important Dates
- II. America Invents Act - Impact on Reexamination Practice



Section I

America Invents Act – Important Dates

General Timeline for Implementing of AIA – On or After Sept. 16, 2011

- Section 5 – Prior user rights
- Section 6 – Inter Partes Reexam threshold modified
- Section 6 – Eliminate District Court avenue for Ex Parte Appeals
- Section 7 Appeals to CAFC
- Section 9 – DDC to EDVA
- Section 10 – E-Filing Incentives
- Section 11 – 15% Fee increases (9/26)
- Section 15 – Best Mode
- Section 16 – Marking (Virtual and Actual)
- Section 19 – Joinder and Jurisdiction

General Timeline for Implementing of AIA – On or After Sept. 16, 2012

- Section 4 - Assignee Can Sign Oath
- Section 6 – Inter Partes and Post Grant Review
- Section 7 – PTAB
- Section 8 – 3rd party Submissions
- Section 12 - Supplemental Examination
- Section 17- Advice of Counsel
- Section 18 – Transitional Program for Business Method Patents

General Timeline for Implementing of AIA – On or after March 16, 2013

- Section 3- First to File and Derivation Proceedings
- Amendments to
 - 35 U.S.C. 102 (First to File, Scope of Prior Art, Claimed Invention Date)
 - 35 USC 103 (scope of prior art)
 - 35 USC 135 Derivation Proceedings
 - 35 USC 157 SIR Repealed



Section II

America Invents Act – Impact on Reexamination Practice

AIA - Section 6: SNQ Threshold for Reexamination (Effective 9/16/11)

- Higher threshold than current
 - SNQ is accepted, and Request granted, only if “reasonable likelihood petitioner will prevail on at least one claim”
- Practitioners are still determining what this standard will mean for Requesters

AIA - Section 6 - Post Grant Review (Effective 9/16/12)

- Post Grant Review ($x < 9$ months from grant) –final determination within 12/18 months by Board and not Examiner/CRU – Oral Hearing allowed
 - all 101, 102, 103, 112 and 251 issues except best mode available;
 - unsettled legal issues.
- Higher threshold - reasonable likelihood petitioner will prevail on at least one claim
- Petitioner – Preponderance of Evidence
- Estoppels
 - Petitioner “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 that post-grant review.”
 - Petitioner may not assert invalidity in a civil action “on any ground that the petitioner raised or reasonably could have raised during that post-grant review.”

AIA - Section 6 - Post Grant Review (Effective 9/16/12) (con't)

- DJ action
 - before filing IPR cut off rights to file PGR
 - filed after IPR automatically stays litigation until patent owner moves to lift, patentee files infringement or counterclaim, petition moves to dismiss Settlement Provision allowed to end proceedings at PTO
- Intervening Rights
- Limited Discovery: Either party may conduct discovery “limited to evidence directly related to factual assertions advanced by either party in the proceeding.”
- Appeal to Federal Circuit

AIA- Section 6 - Inter Partes Review (Effective 9/16/12)

- Inter Partes Review (x > 9 months from grant or after post grant ends) – final determination 12/18 months before Board not Examiner/CRU – Oral Hearing allowed
 - Patents and printed publications only – 102 and 103
- Higher threshold than current IPR– reasonable likelihood petitioner will prevail on at least one claim
- DJ action
 - filed before IPR cut off rights to file IPR
 - filed after IPR automatically stays litigation until patent owner moves to lift, patentee files infringement or counterclaim, petition moves to dismiss.
- Not available if not filed within 1 year of infringement complaint
- Settlement Provision allowed to end proceedings at PTO

AIA - Section 6 - Inter Partes Review (Effective 9/16/12) (con't)

- New Estoppel “raised or reasonably could have been raised” – upon final written decision
 - Petitioner “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 that inter-partes review.”
 - Petitioner may not assert invalidity in a civil action “on any ground that the petitioner raised or reasonably could have raised during that inter-partes review.”
- Limited Discovery: Either party may conduct discovery “limited to—(A) the deposition of witnesses submitting affidavits or declarations; and (B) what is otherwise necessary in the interest of justice”
- Appeal: Either party may only appeal to the Federal Circuit.

Discovery Differences

- E.P.O. Oppositions: Limited to:
 - Cross-examination of a witness if the witness is summoned to testify.
- U.S.P.T.O. Post-Grant Review: Limited to:
 - “evidence directly related to factual assertions advanced by either party in the proceeding.”
- U.S.P.T.O. Inter-Partes Review: Limited to:
 - Deposition of witnesses submitting affidavits or declarations
 - What is otherwise necessary in the interest of justice
- U.S. District Court: (Federal Rules of Evidence)
 - Any nonprivileged matter that is relevant to any party’s claim or defense.
 - Includes any documents or other tangible things and the identity and location of persons who know of any discoverable matter.
 - Depositions of Inventors, Prosecuting Attorneys, Experts, Employees.

AIA- Section 8- Preissuance Submission by Third Parties (Effective 9/16/12)

- A 3rd party may submit to the PTO any patent, published patent application or other printed publication of potential relevance
- Submission must be made before the earlier of: (a) a notice of allowance or (b) the later of: (i) six months after publication or (ii) the first rejection
- Must include a concise description of the asserted relevance

AIA- Section 12 - Supplemental Examination (Effective 9/16/12)

- Patent owner may request that the PTO consider, reconsider or correct information believed to be relevant to the patent.
- Not limited to prior art patents or publications.
- If SNQ → *ex parte* reexamination.
- Conduct relating to information provided in supplemental examination may not form the basis for later finding the patent unenforceable.
- Exceptions:
- If the allegation was set forth with particularity in a civil action or ANDA notice letter prior to the request for SE
- No immunity if there was fraud on PTO
- To use this defense, SE and any reexam must be concluded before the patent enforcement action is brought

Pitfalls

- If material fraud involved in original or supplemental examination, PTO will send to Attorney General for review

AIA - Section 18- Business Method Patents (Effective 9/16/12)

- Provides challenges to “covered business method patents” for 8 years – uses Post Grant Review Procedures – no requirement to show “reasonable likelihood...prevail” new standard
- Petition can be filed if real party in interest is sued or charged with infringement
- Defined: method or corresponding apparatus for performing data processing or other operations used in practice, administration or management of a financial product or service –does not apply to “technical inventions”
- Stays – simplify issues, status of proceedings, prejudice non movant, tactical advantage movant
- Basis – any ground of invalidity or any novel or unsettled question that is important to other patents or applications
- Estoppels – limited to issues actually raised

Sedona Conference 12 - SKGF Publications & Articles on America Invents Act, Reexamination, and Reissue

- **America Invents Act: The 5 New Post-Issuance Procedures**
 - October 2011 | Presented at *The Sedona Conference on Patent Litigation XII*
 - <http://reexamcenter.com/resources/from-skgf/>
- **SKGF Dedicated Web Resources for America Invents Act**
 - <http://skgf.com/services.php?ServiceID=126>
- **U.S. Reexamination & Reissue Practice 2011**
 - October 2011 | Presented at *The Sedona Conference on Patent Litigation XII*
 - <http://reexamcenter.com/resources/from-skgf/>

SKGF Presentations and Papers on Reexamination and America Invents Act

- **Concurrent Reexamination and District Court Litigation: Challenges and Opportunities for Improvements**
 - June 2011 | Presented at Berkeley Center for Law and Technology
 - http://www.law.berkeley.edu/files/bclt_USPTO_District_Court_Interface_Sterne.pdf
- **Parallel Patent Reexaminations**
 - September 2011 | Presented at *PLI Patent Litigation 2011 San Francisco, CA*
 - <http://64.237.99.107/media/pnc/3/media.1423.pdf>
- **SKGF Dedicated Web Resources for AIA**
 - <http://skgf.com/services.php?ServiceID=126>

The Reexamination Center: Comprehensive Resource for Legal News and Information

Visit *The Reexamination Center*, the leading site devoted solely to the law and practice of patent reexamination www.reexamcenter.com

The screenshot displays the website's layout. At the top, a dark navigation bar contains the site title "The Reexamination Center" and the tagline "ESSENTIAL KNOWLEDGE AND NEWS FOR PATENT PRACTICE". Below this is a search bar and a main navigation menu with categories: HOME, ESSENTIALS, ANALYSIS, NEWS & EVENTS, and RESOURCES. The "NEWS & EVENTS" category is currently selected. A large banner features a bar chart and the text "Most recent USPTO reexamination statistics regarding volume and timing from 2007". Below the banner are several quick links: REEXAMINATION ESSENTIALS, Mistakes to Avoid, Common Questions, Statistics, and Terms and Concepts. The main content area is divided into two columns. The left column lists news items with dates, such as "AIPLA Webinar on Ex Parte and Inter Partes Reexamination: Strategies and Tactics" and "New Requests for Inter Partes Reexamination in Official Gazette of March 9, 2010". The right column includes an "UPCOMING EVENTS" section with details for the "IPO 20th Annual Conference on U.S. Patent and Trademark Office Law and Practice" and "The Sedona Conference® Webinar on Patent Reform Legislation". A "TOPICS" section at the bottom right lists various legal topics like "Around the Web", "Biotech-Pharma", and "BPAI".

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