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### AIA Trials By Fire: How to Protect Your Patent Portfolio against PTAB "Death Squads"

Under the America Invents Act (AIA), patent challengers now have three new kinds of post-grant review with which to attack a patent's validity: *inter partes* review (IPR), post-grant review (PGR), and covered business method review (CBM review). These **AIA trials are attractive** for numerous reasons, including the speed at which the proceedings are conducted, the technical expertise of the Patent Trial and Appeal Board (PTAB), and the broader claim construction standard used. The PTAB's record of cancelling a majority of challenged claims in AIA trials has garnered it the reputation of being anti-patent and pro-petitioner, creating a flurry of petition filings as patent challengers scramble to take advantage of these proceedings. Many patent owners are wondering what they can do to protect their patents and inventions from these "death squads killing property rights."<sup>1</sup> Here are four steps that patent owners can take to strengthen their patents and bolster their portfolios against the threat of post-grant challenges.

#### 1. Narrow Your Patent Claims

In an AIA trial, the PTAB uses the "broadest reasonable construction in light of the specification"<sup>2</sup> to define claim terms when determining patentability. Under this standard, patent specifications should be drafted to ensure clarity of claim terms and avoid ambiguities. Claim terms construed in light of a focused specification will be more difficult to challenge. In addition, claims should be drafted or amended to have a focused scope in order to be less susceptible to challenge. And as always, focused patent prosecution may avoid creating a prosecution history that could be used to a patent owner's detriment.

#### 2. Check for New Prior Art

The rising popularity of post-grant challenges makes assessment of the relevance of new prior art even more important. Particularly in AIA trials, the majority of decisions have relied on obviousness as grounds for unpatentability.<sup>3</sup> Thus, applicants and patentees need to pay more attention to new references, especially those that may be useful for an obviousness attack.

While a patent application is pending, the applicant must disclose to the PTO all information known to be material to the patentability of any claim. As part of the post-allowance review, applicants should pay special attention to confirming that all material art has been cited, including checking with the inventors to ensure nothing is missed. Patent owners should then assess the prior art's relevance and consider if one of the remedial procedures at the Patent and Trademark Office (PTO) – such as supplemental examination, *ex parte* reexamination, or reissue – should be used to strengthen the patent in light of the prior art.

Of these procedures, supplemental examination may be the most valuable tool for a patent owner. Whereas filing a request for *ex parte* reexamination and filing a reissue application both require negative assertions to be made about a patent, supplemental examination has no such requirement.<sup>4</sup> A patentee may simply request supplemental examination of a patent so that the PTO can consider, reconsider, or correct information material to the patent. If the information does not raise a substantial new question of patentability, the PTO will issue a supplemental examination certificate. If the PTO determines the information gives rise to a substantial new question of patentability, then the PTO may initiate *ex parte* reexamination. A patent that survives supplemental examination or *ex parte* reexamination comes out stronger and more difficult to invalidate.

#### 3. Keep an Eye on Developing Case Law

In an AIA trial, the "broadest reasonable interpretation" standard makes a claim more susceptible to a validity challenge. In particular, in PGR and CBM trials, a claim may be found invalid on non-prior art grounds such as unpatentable subject matter, lack of written description, or indefiniteness. The developing case law in this area, such as the changing definition of "patentable subject matter" under 35

U.S.C. § 101, often disfavors patent owners.

Claims that may be subject to PGR or CBM review proceedings are directly impacted by this developing case law. As such, a patent applicant or patent owner should consider how recent case law affects a claim's validity under the "broadest reasonable interpretation" standard, and should consider whether developments in case law will necessitate using one of the post-grant proceedings available to a patent owner.

#### **4. Maintain a Strong Portfolio**

As has always been the case, large patent portfolios – in both the number of patents and the number of claims – are generally considered stronger because they are more difficult and expensive to challenge. This is particularly true in an AIA trial where there are strict page limits and a limit of one challenged patent per proceeding.<sup>5</sup> Moreover, the cost of requesting and instituting AIA trials is also directly related to the number of claims challenged; for instance, there are additional fees if more than twenty claims are challenged. Accordingly, a large number of claims may act as a deterrent to the filing of an AIA petition on all of the claims. As such, appropriate growth of your patent portfolio may be even more important now.

Venable's patent prosecution attorneys can assist with developing a strategy to strengthen and protect your patent portfolio against the threat of post-grant challenges.

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<sup>1</sup> A term coined by Federal Circuit Chief Judge Randall Rader at the AIPLA annual meeting in October 2013.

<sup>2</sup> See 37 C.F.R. § 42.100(b) (IPR); 37 C.F.R. § 42.200(b) (PGR); 37 C.F.R. § 42.300(b) (CBM reviews).

<sup>3</sup> In CBM reviews, 64% of the decisions have relied on 35 U.S.C. § 103(a). In IPR, 86% of the decisions have relied on 35 U.S.C. § 103(a). See earlier article (<http://www.venable.com/patent-trial-and-appeal-board-statistics-04-23-2014/>). Unlike CBM reviews, IPRs are only limited to prior art as grounds for invalidity.

<sup>4</sup> In a request *ex parte* reexamination, a patentee has to identify "each substantial new question of patentability based on prior patents and printed publications." 37 C.F.R. §1.510(b)(1). Similarly, a reissue application may only be filed if a "patent is, through error, deemed wholly or partly inoperative or invalid." 35 U.S.C. § 251.

<sup>5</sup> The page limits are as follows: IPR – 60 pages; PGR and CBM – 80 pages. 37 C.F.R. § 42.24 (a) (i)-(iii).