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IPR Spotlight Series: Filing a Petition for IPR

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Inter partes review (IPR) before the Patent Trial and Appeal Board (PTAB) became available on September 16, 2012 as a post-grant review procedure to challenge the patentability of issued claims based on prior art patents and publications. To help navigate the uncharted waters of this procedure, each edition of *IP Buzz- Post Grant Practice* will include an installment of our new *IPR Spotlight Series*, where we will feature a specific event on the **IPR timeline**, from filing the petition for IPR through oral hearing and final written decision. We will present an overview of the featured filing or procedure, along with practice tips and strategy informed by recent PTAB decisions, statistics, and practical experience. In this first IPR Spotlight installment, we focus on preparing and filing a petition for IPR.

Part 1: Filing a Petition for IPR

To institute an IPR trial, there must be a reasonable likelihood of finding at least one of the challenged claims unpatentable over prior art patents or publications.¹ Beyond putting together a case for unpatentability, a potential petitioner must also think strategically about several issues:

Where to Challenge the Patent: The vast majority of petitioners are already defending a parallel infringement action in district court when they choose to file a petition for IPR. However, if the patent owner has not yet filed a district court action for patent infringement, an alleged infringer must decide whether to attack the validity of the patent in a declaratory judgment action before a district court, or in an IPR trial before the PTAB. Notably, once a declaratory judgment action is filed, IPR is precluded. In general, statistics show the **PTAB to be the more pro-challenger forum**, with almost every IPR trial resulting in the cancellation of at least some of the challenged claims. But there are many instances where **attacking the validity of the patent in district court may be preferable**, such as where there are multiple patents to challenge, or where the strongest invalidity arguments are not based on patent or printed publication prior art.

When to Challenge the Patent: At the earliest, for patents filed on or after March 16, 2013 (patents examined under the new AIA first-to-file rules), a petition for IPR can be filed nine months after the patent issues or reissues, or after post-grant review, if one has been instituted.² For patents filed before March 16, 2013 (under the old first-to-invent rules), no such limitation exists. For all patents, at the latest, if the petitioner is a defendant in district court litigation, a petition for IPR cannot be filed more than one year after service of the complaint.³ Within these outer boundaries, a petitioner can decide strategically when to file a petition for IPR.

How to Challenge the Patent: The petitioner must identify "with particularity" each challenged patent claim, the grounds for the challenge, and all evidence supporting the grounds for challenge.⁴ At a recent roundtable, the Patent and Trademark Office (PTO) recommended that petitioners focus on just a few grounds for challenges, rather than attempting a kitchen-sink approach. As part of a specific explanation of the grounds for unpatentability, the petitioner should explain why each cited reference qualifies as prior art. While claim charts may be a useful tool for comparing the challenged claims to the prior art, claim charts are ineffective on their own. Charts require explanation and should contain pinpoint references to the supporting evidence. For obviousness grounds, the petitioner must explain the motivation to combine references and support the explanations with evidence.

How to Avoid Redundancy Rejections: If the petitioner includes multiple challenges to the same claim, the PTAB may reject the challenges as duplicative or cumulative. In order to "secure the just, speedy, and inexpensive resolution of every proceeding,"⁵ the PTAB generally will not consider multiple grounds for rejection of the same claim. If the petitioner does choose to include multiple challenges to the same claim, the petitioner should "provide a meaningful distinction between the different, redundant

rejections."⁶ Similarly, a possibility that the patent owner might amend the claim to get around a reference, or swear behind one reference, is also insufficient to meaningfully distinguish the challenges.⁷ In addition, a petitioner cannot avoid redundancy issues merely by filing multiple petitions in order to present multiple challenges to the same claims. Under 35 U.S.C. § 325(d), the PTAB may "reject the petition or request because the same or substantially the same prior art or arguments previously were presented" in another post-grant proceeding.⁸ Therefore, a petitioner should present only the best grounds for rejection, not all possible grounds, and provide an explanation for any possible redundancies.

How to Construe the Claims of the Patent: To determine whether to institute an IPR review, the PTAB will construe the claim terms that the petitioner relies upon to assert the unpatentability of the challenged claims. The PTAB will give a claim "its broadest reasonable construction."⁹ In order to propose a particular construction for a claim term, the petitioner should provide support for the argument that the claim limitation should deviate from the ordinary and customary meaning of the claim terms.¹⁰ The petitioner should also address any inconsistent claim construction or findings from prior proceedings. When proposing a particular construction, a petitioner should always consider the impact on any co-pending litigation.

Very Important Minutiae – Formatting and Fees: The petition must comply with a host of technical requirements, such as the use of specific fonts and page limits, along with payment of the required fee. Although it may be easy to gloss over these technicalities, a petitioner should review the petition carefully for compliance. A petition will not be accorded a filing date until it satisfies all of the requirements.¹¹ If a petitioner is running up against the one-year deadline to file after service of the complaint, failure to include the required fee, or comply with formatting requirements, could be fatal to the petition.

¹ 35 U.S.C. § 314(a).

² 35 U.S.C. § 311(c).

³ 35 U.S.C. § 317(b).

⁴ 35 U.S.C. § 312(a).

⁵ 37 C.F.R. § 42.1.

⁶ *Illumina, Inc. v. The Trustees of Columbia University in the City of New York*, IPR2012-00006, Paper 43 (May 10, 2013).

⁷ *Liberty Mutual Ins. v. Progressive Casualty Ins.*, CBM2012-00003, Paper 7 (Oct. 25, 2012).

⁸ See also *Oracle v. Clouding IP*, IPR2013-00088, Paper 13 (June 13, 2013) (denying petitioner's request for rehearing after PTAB denied institution of review on the ground of obviousness because petitioner failed to articulate a meaningful distinction between two prior art references cited to challenge the same patent claim).

⁹ 37 C.F.R. § 42.100(b); see also Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48766 (Aug. 14, 2012) (*Claim Construction*).

¹⁰ See *Gracenote, Inc. v. Iceberg Industries LLC*, IPR2013-00552, Paper 6 (March 7, 2014).

¹¹ 37 C.F.R. § 42.106.