AIA Trial Roundtables

Welcome

Agenda

Time	Topic
1:00 PM	Welcome
1:10 PM	Presentation • Overview of trials, statistics, and lessons learned (30 minutes) • Audience Questions/Comments (20 minutes)
2:00 PM	Mock Conference Call • Topics include motion to amend and motion for additional discovery (30 minutes) • Audience Questions/Comments (20 minutes)
2:50 PM	BREAK (10 minutes)
3:00 PM	Panel Discussion
5:00 PM	Closing Remarks

Roundtable Materials

- Available at:

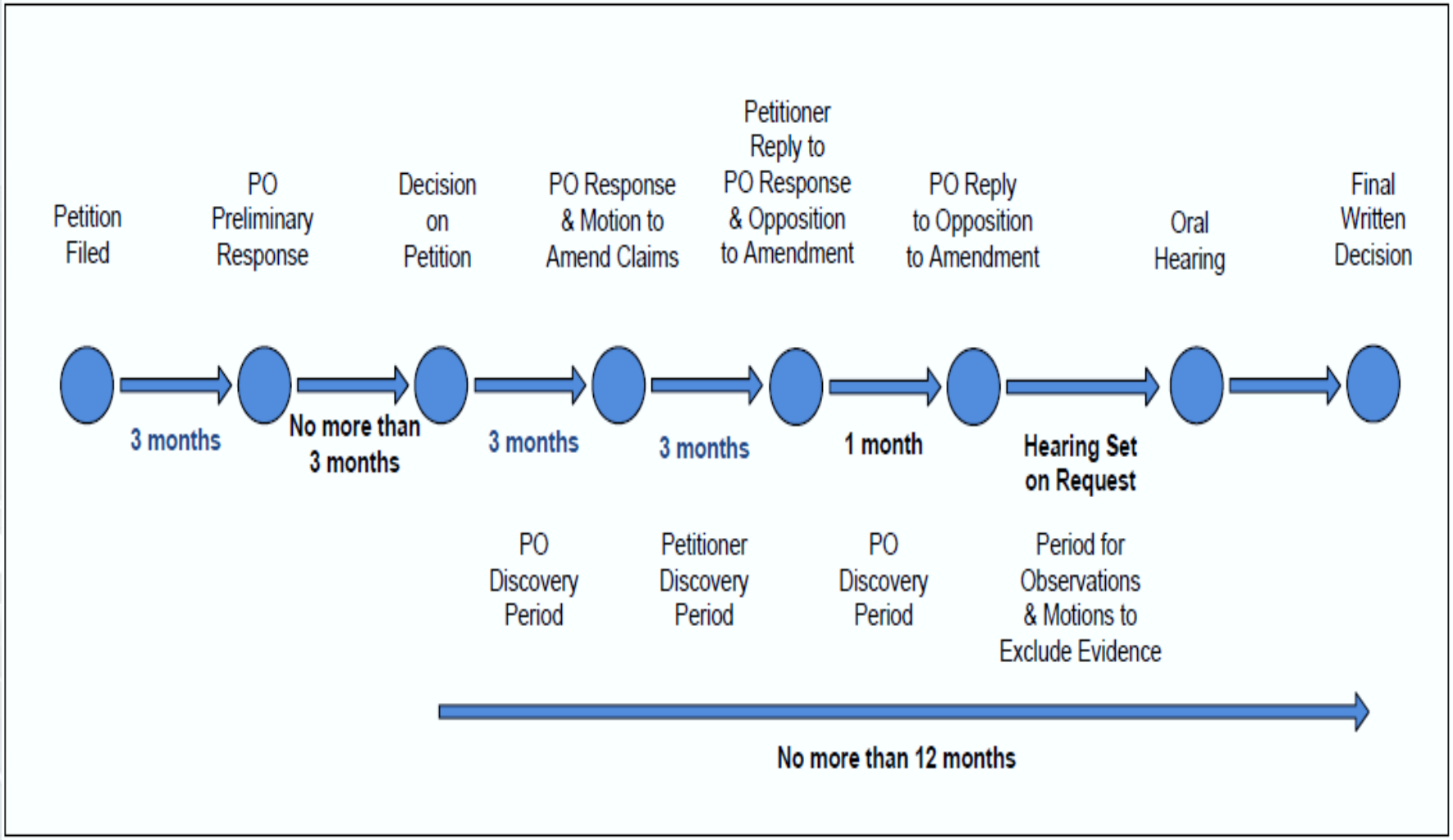
http://www.uspto.gov/ip/boards/bpai/ptab_aia_trial_roundtables_2014.jsp

PTAB Presentation

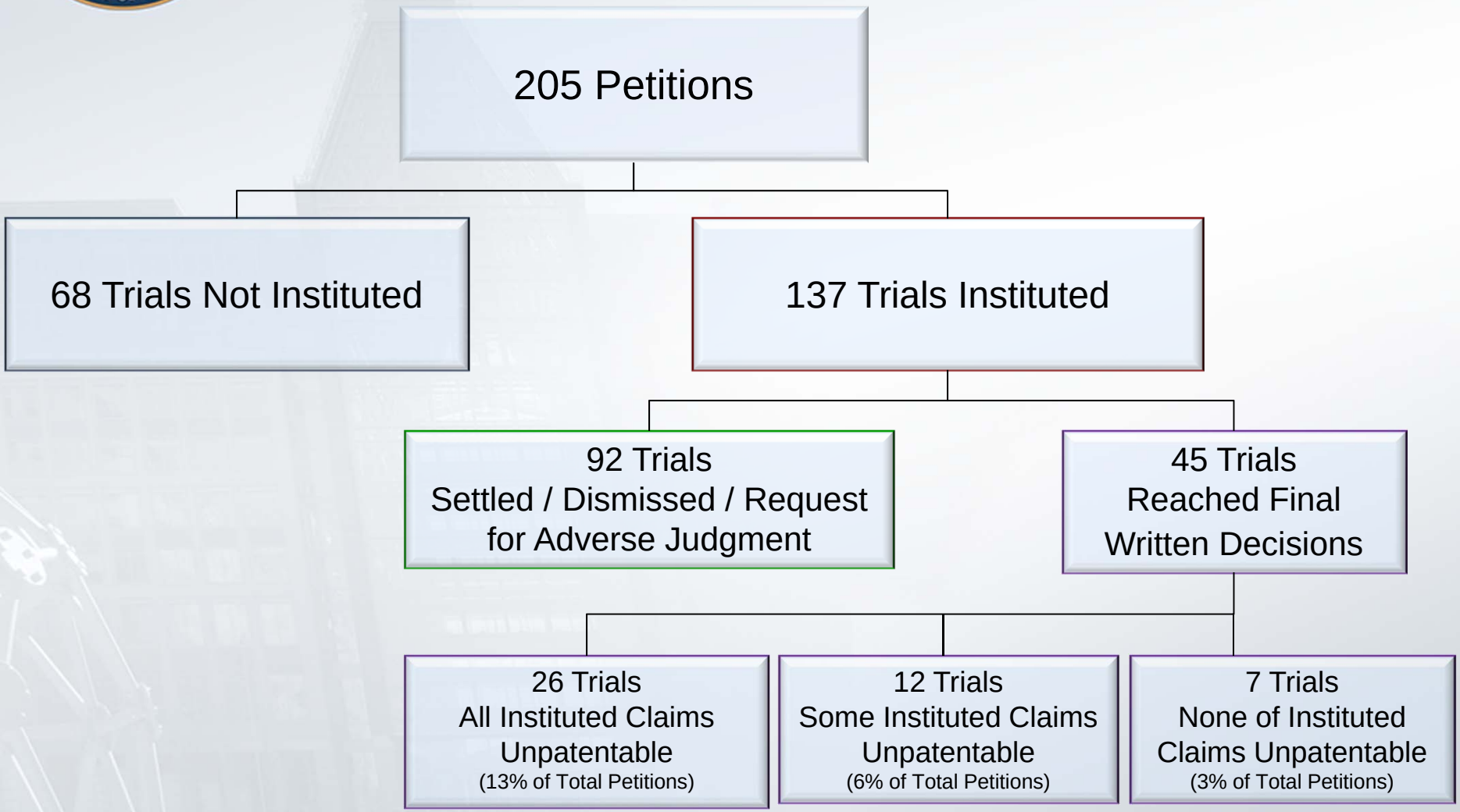
Overview

- AIA Trials
  - Statistics
  - Lessons Learned
- Administrative Patent Judges
- PTAB Website Tour

Trial Proceeding Timeline



Inter Partes Review Petitions Terminated to Date (As of 5/1/2014)



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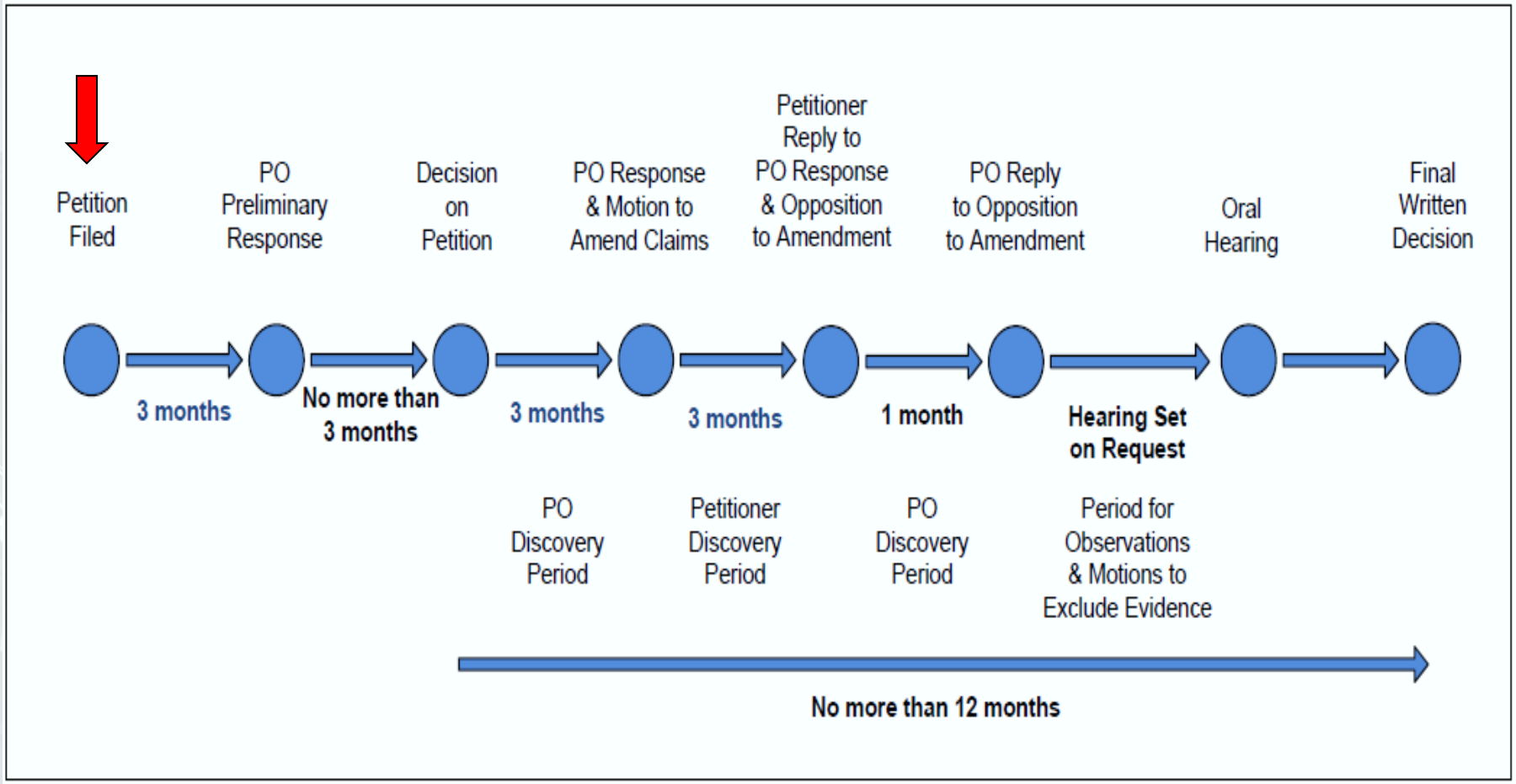
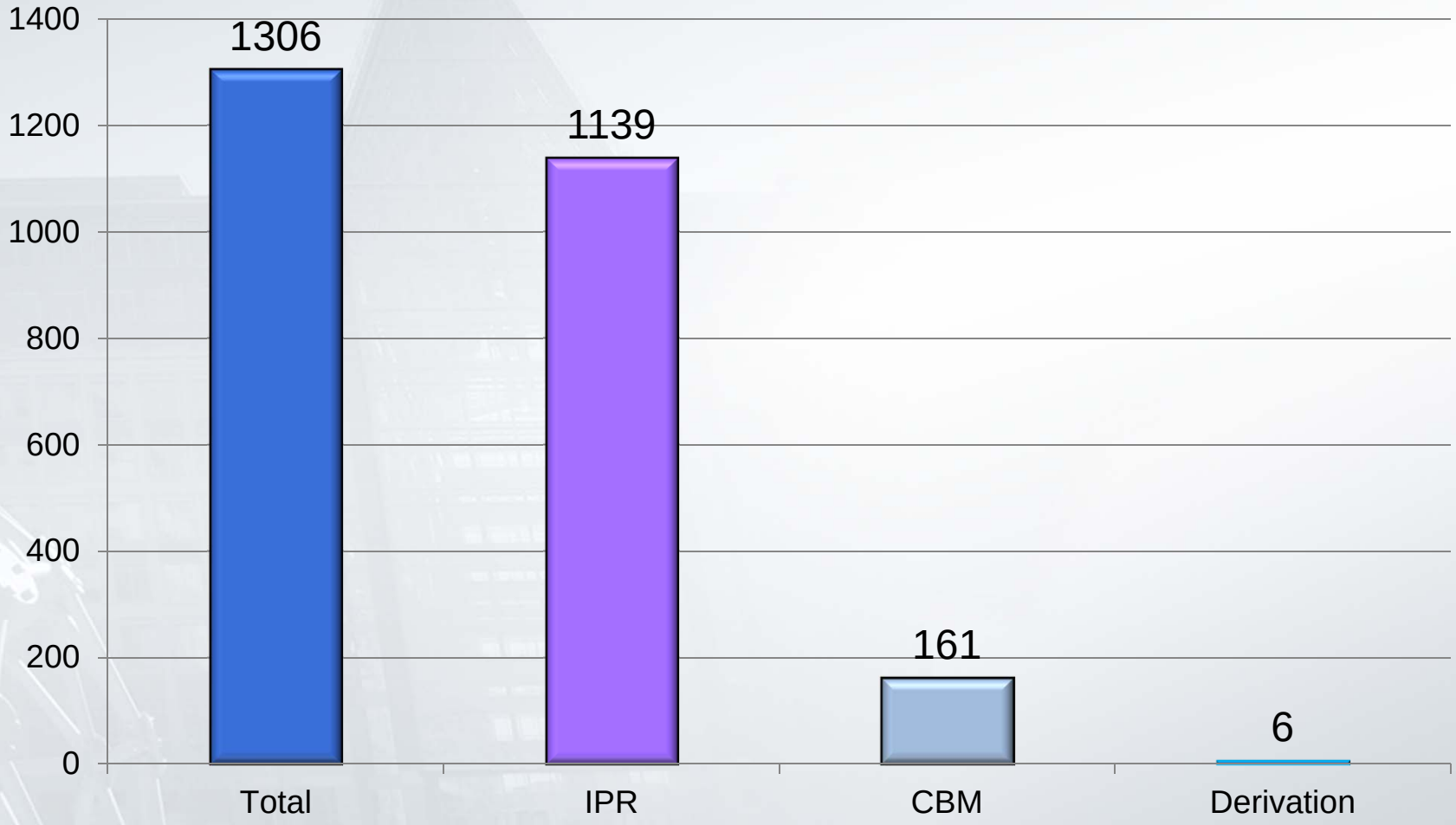
Petition Filing

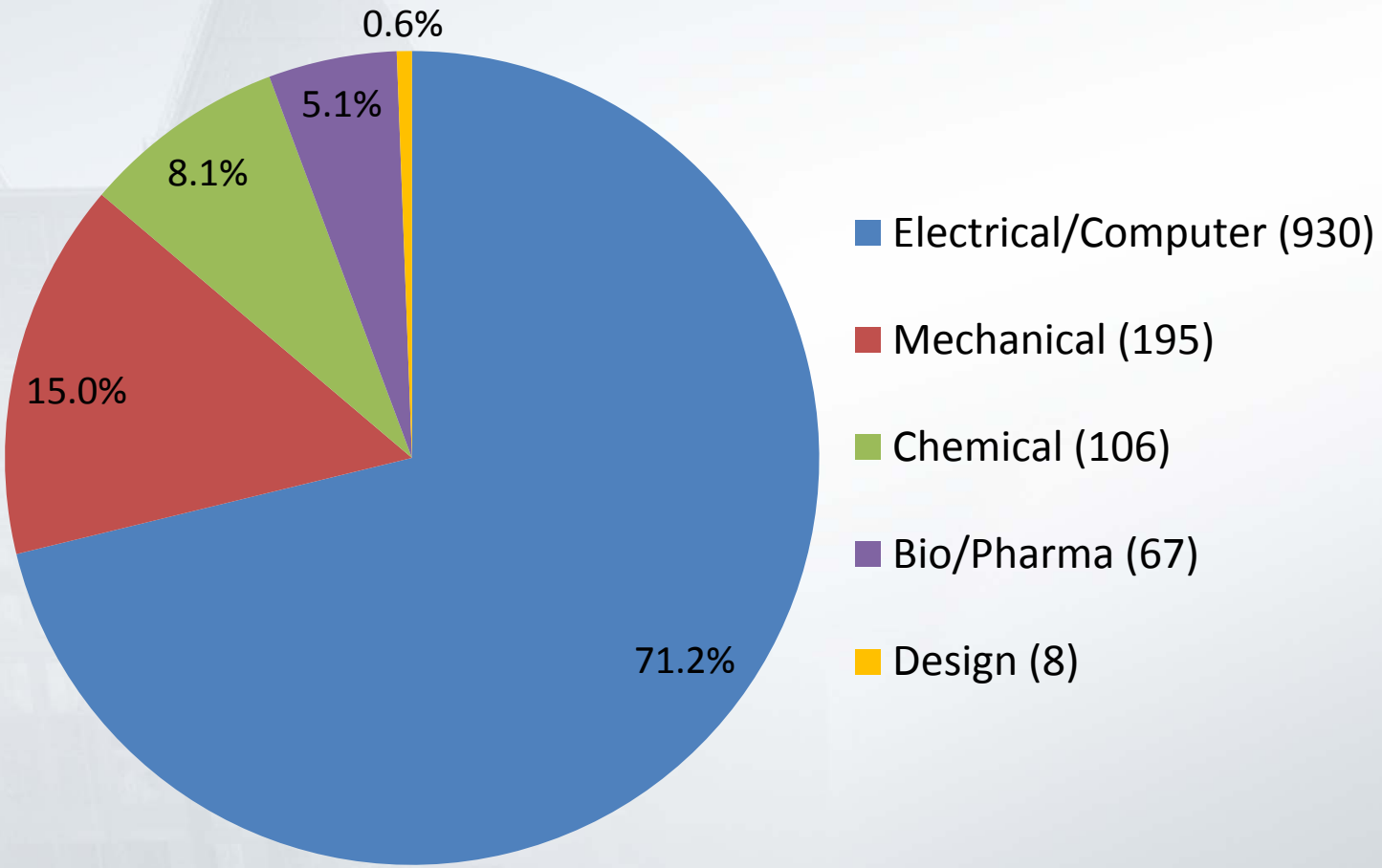


AIA Petitions

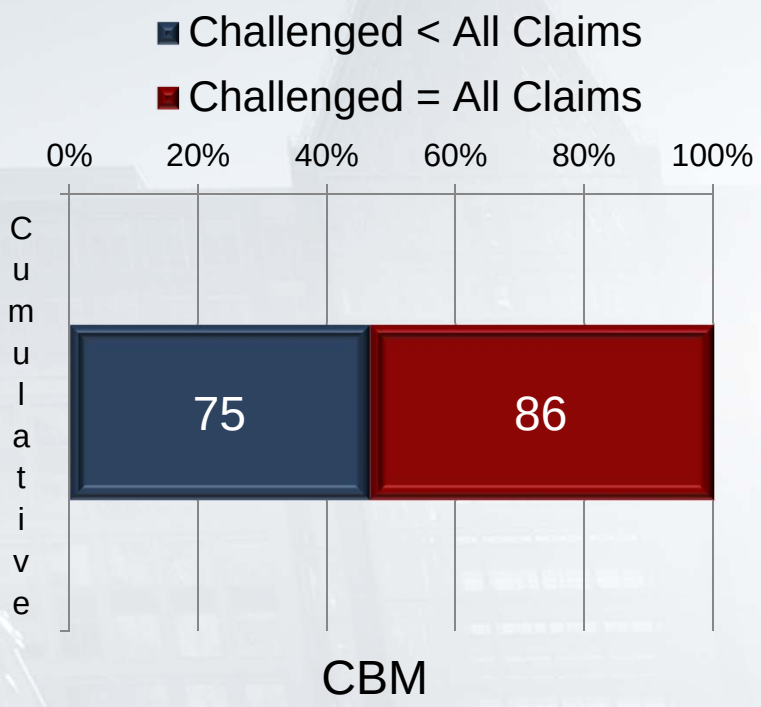
(Cumulative Number as of 5/1/2014)

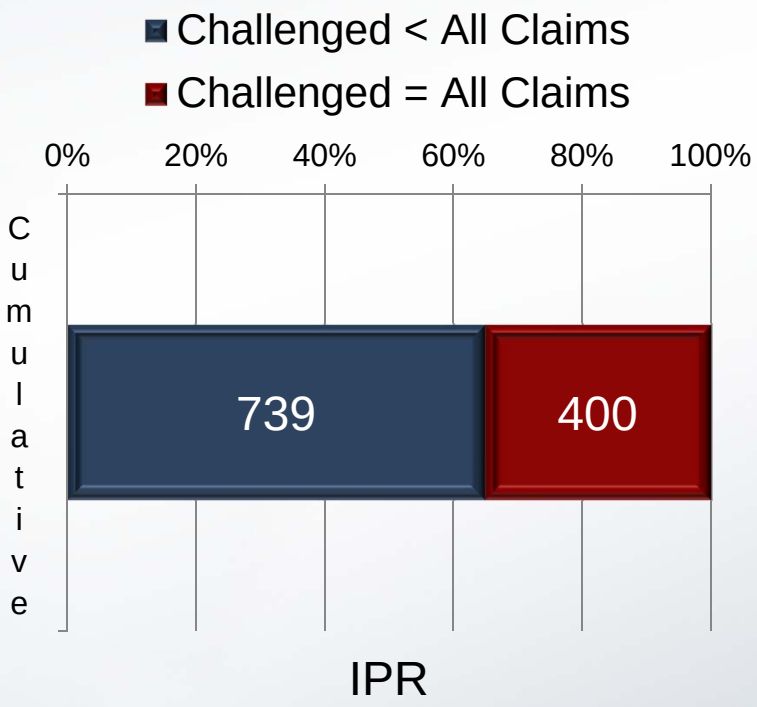


AIA Petitions
(Technology Breakdown as of 5/1/14)

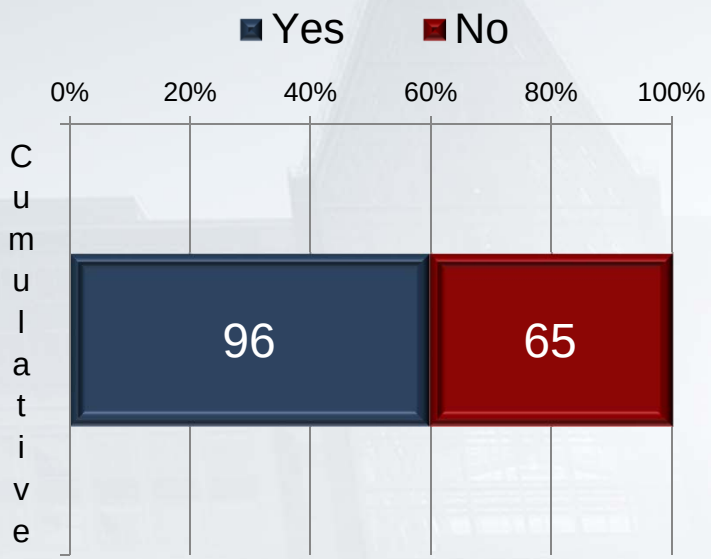


Petition Challenges
(As of 5/1/2014)

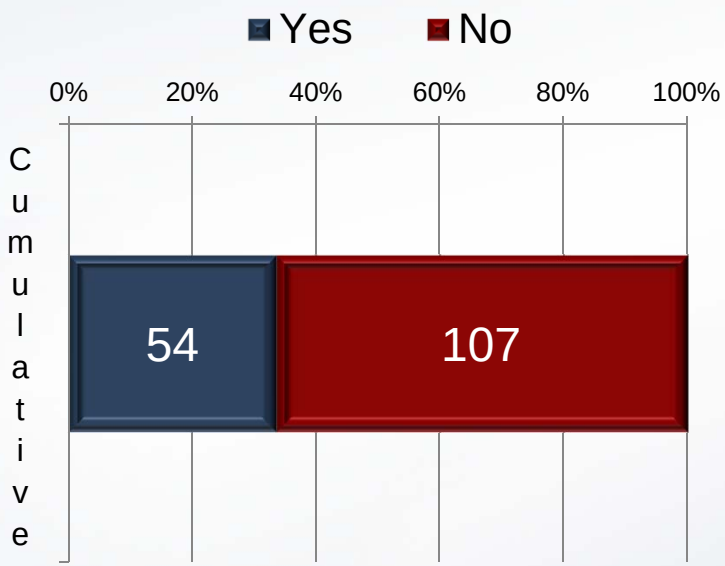




§101 and § 112 Grounds Raised in CBM Petitions Only (As of 5/1/2014)



101 Grounds



112 Grounds

Lessons Learned: Petitions

- Conclusions need to be supported by:
  - Sound legal analysis; and
  - Citations to evidentiary record

- Analysis needs to appear in petition itself (no incorporation by reference from declaration)

- Better to provide detailed analysis for limited number of challenges than identify large number of challenges for which little analysis is provided

- *See Wowza Media v. Adobe*, IPR2013-00054 (Paper 12)(denying petition)

Lessons Learned: Claim Charts

- Use standard two-column format. *See* FAQ D13
- Claim charts are not sufficient by themselves; they must be explained.
- Claim charts should contain pinpoint references to the supporting evidence. *See* FAQ D12

Lessons Learned: Claim Construction

- Claim constructions should be supported by citations to the record that justify the proffered construction and analysis provided as to why the claim construction is the broadest reasonable construction. 37 C.F.R. § 42.104(b)(3).

- An example of a failure to provide a sufficient claim construction occurs where claim terms are open to interpretation, but party merely restates claim construction standard to be used, e.g.,

  – A claim subject to inter partes review receives the "broadest reasonable construction in light of the specification of the patent in which it appears." 37 C.F.R. § 42.100(b)

Lessons Learned: Experts

- Tutorials are helpful especially for complex technologies

- Expert testimony without underlying facts or data is entitled to little or no weight. 37 C.F.R. § 42.65(a). *See Monsanto Co. v. Pioneer Hi-Breed Int'l,* IPR2013-00022, Paper 43 (denying petition)

- Avoid merely "expertizing" your claim charts

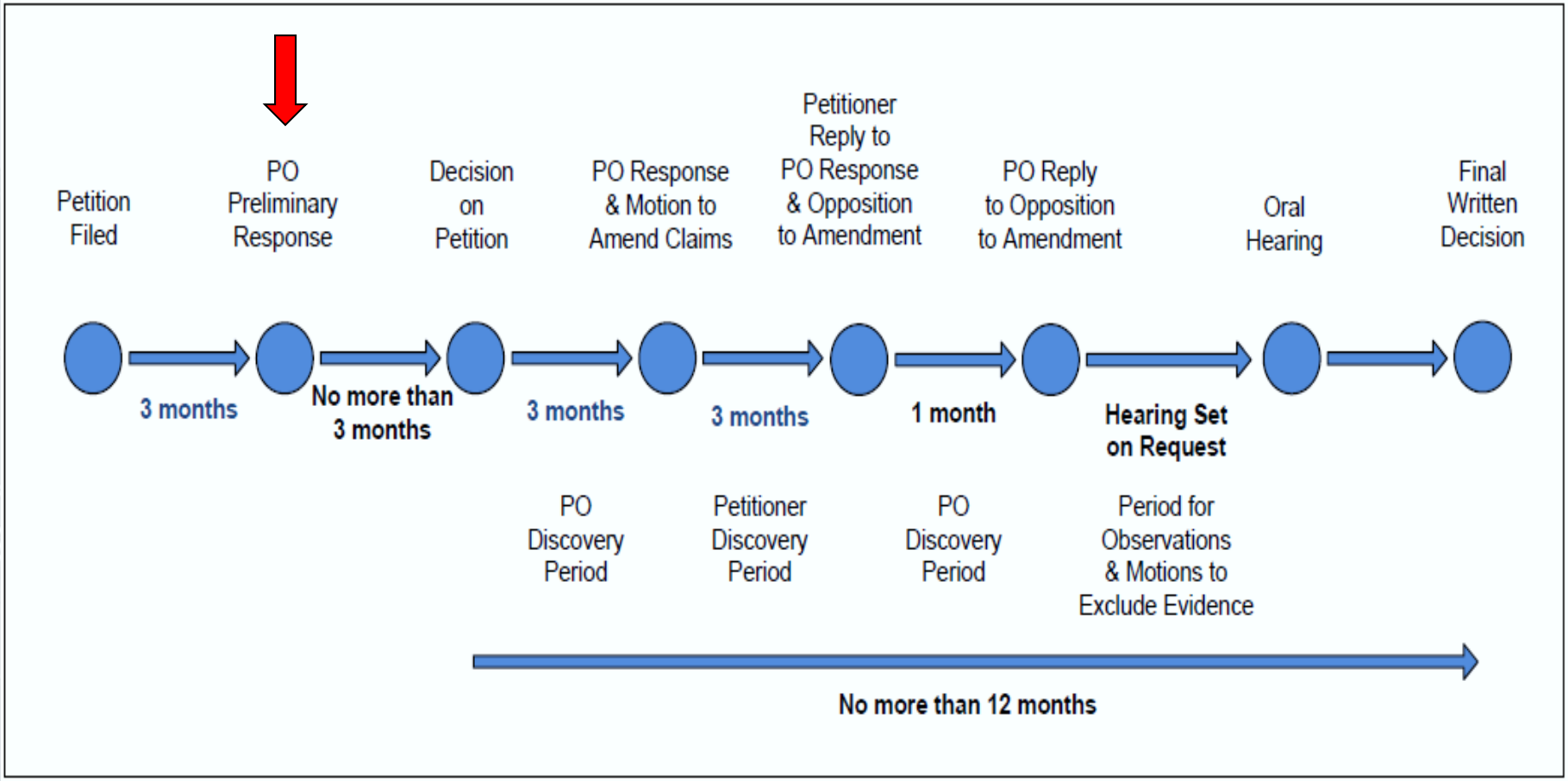
Lessons Learned: Obviousness

- Question of obviousness is resolved based on underlying factual determinations identified in *Graham*
  - Includes addressing differences between claimed subject matter and the prior art

- Address the specific teachings of the art relied upon rather than rely upon what others have said (e.g., examiners)
  - Parties are to address whether there is a reason to combine art (*KSR*) and avoid conclusory statements

- *See Veeam Software v. Symantec*, IPR2013-00145 (Paper 12); *Heart Failure Tech. v. CardioKinetix*, IPR2013-00183 (Paper 12) (denying petition)

Patent Owner Preliminary Response



Patent Owner Preliminary Responses (As of 5/1/14)

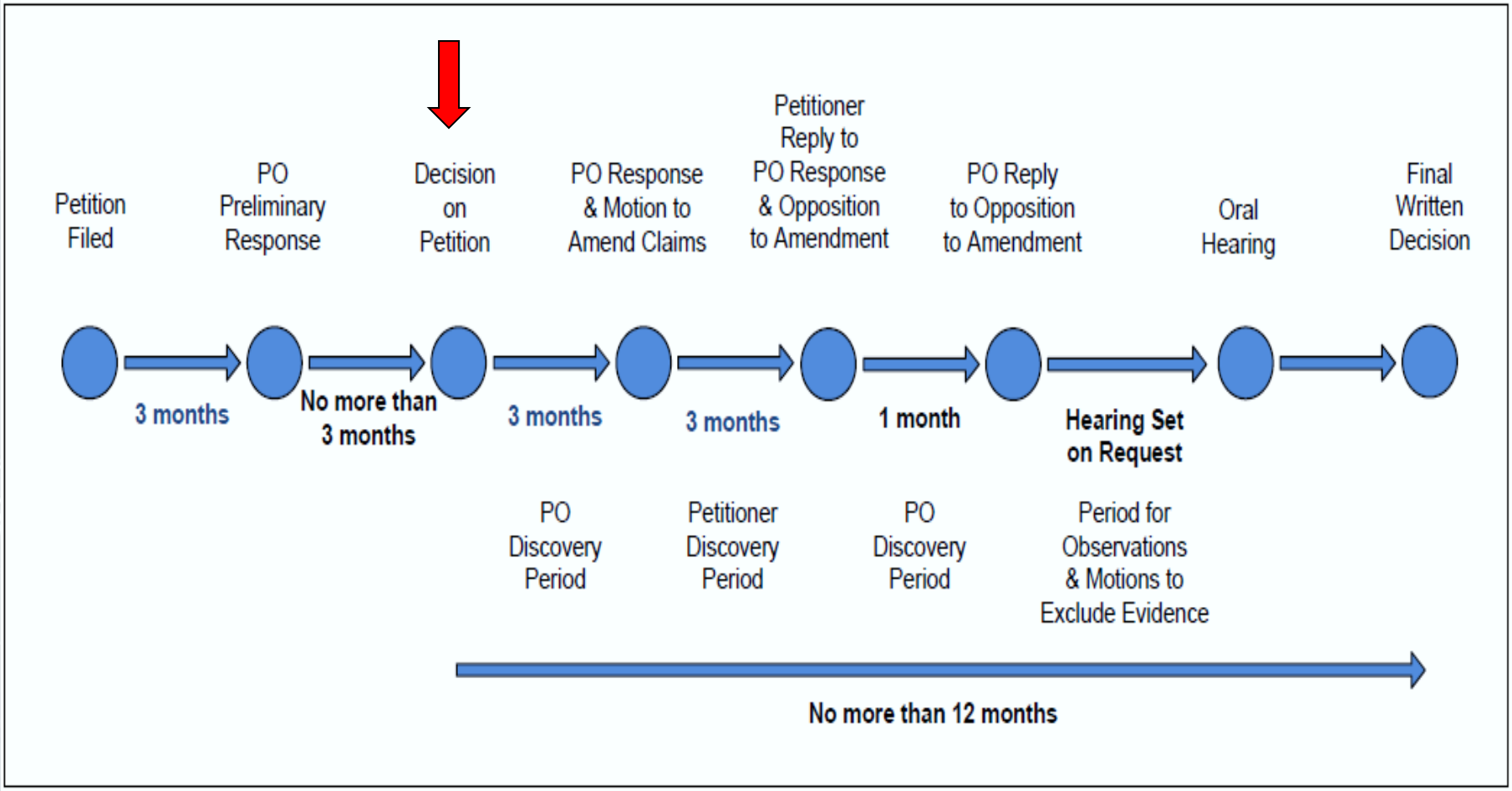
	Filed	Not Filed or Waived
IPR	76%	24%
CBM	91%	9%

Lessons Learned: Patent Owner Preliminary Response

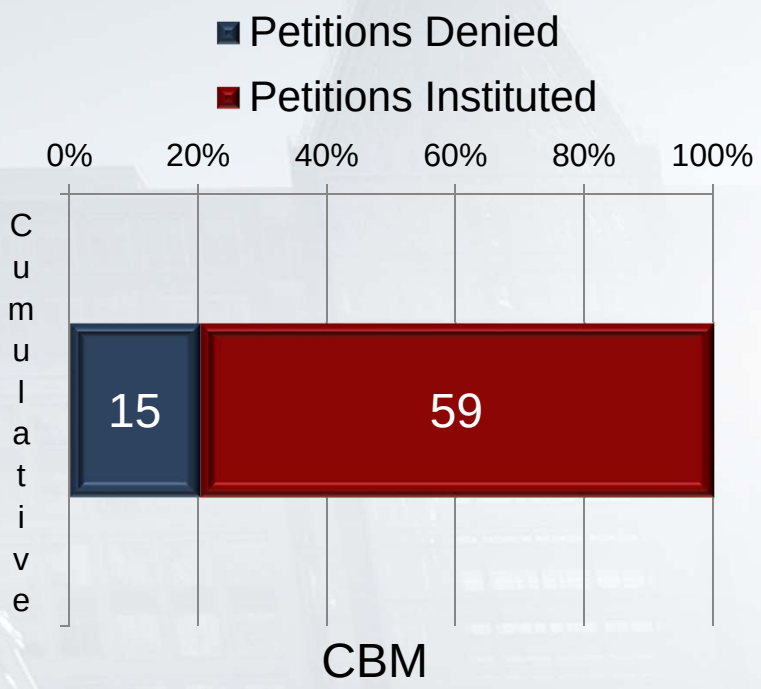
- Clearly identify procedural and substantive reasons to deny petition, e.g.,
  - Statutory bar under 35 U.S.C. § 315 or § 325?
  - Failure to identify real parties-in-interest/privies?
  - Weaknesses in Petitioner's case?
    - Petitioner's claim construction is improper
    - Cited references are not, in fact, prior art
    - Cited references lack material element(s)

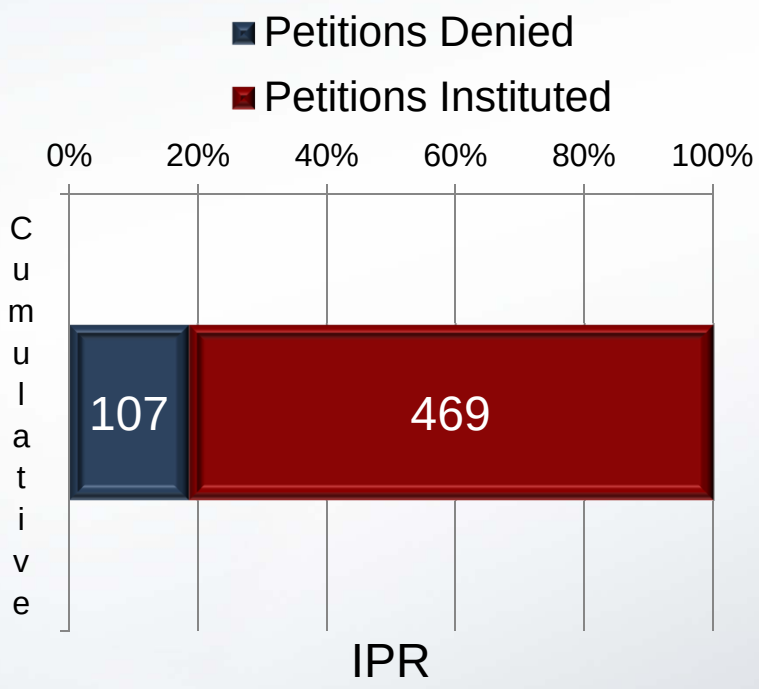
- Cannot present new testimonial evidence
  - BUT can cite existing testimony and reports

Decision on Petition



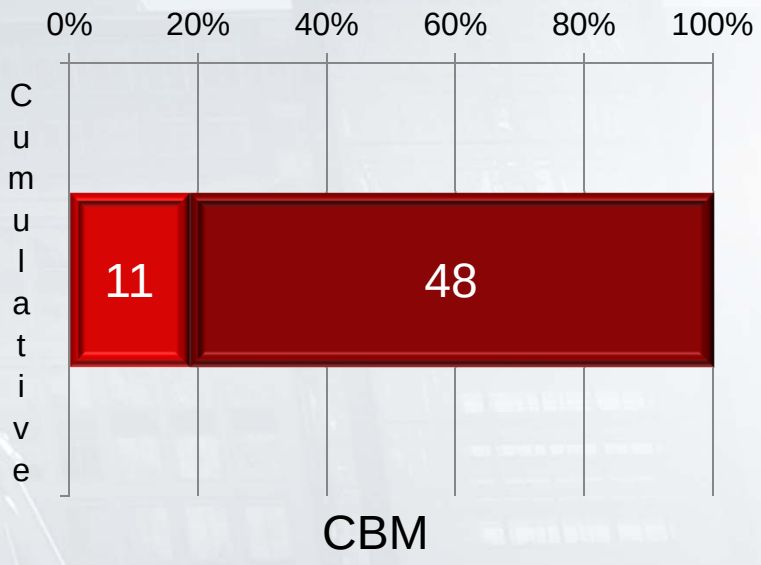
Institutions (As of 5/1/2014)





Institutions (As of 5/1/2014)

- Instituted Claims < Challenged Claims
- Instituted Claims = Challenged Claims



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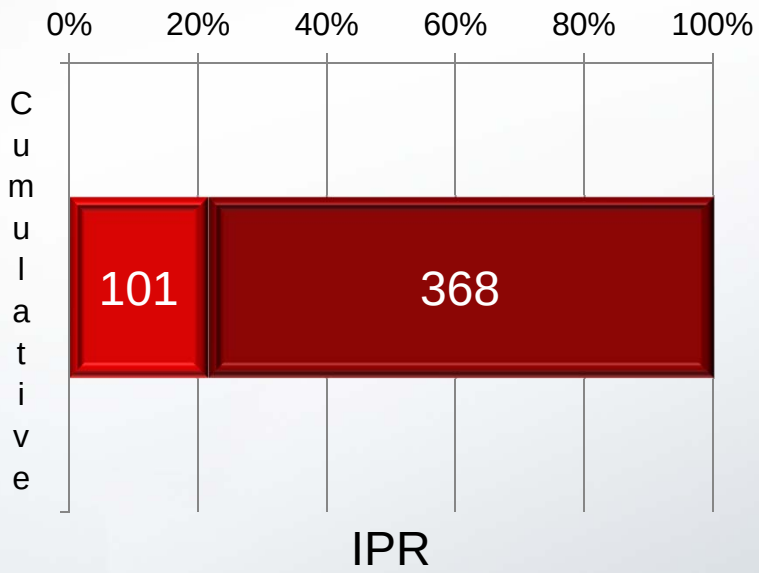
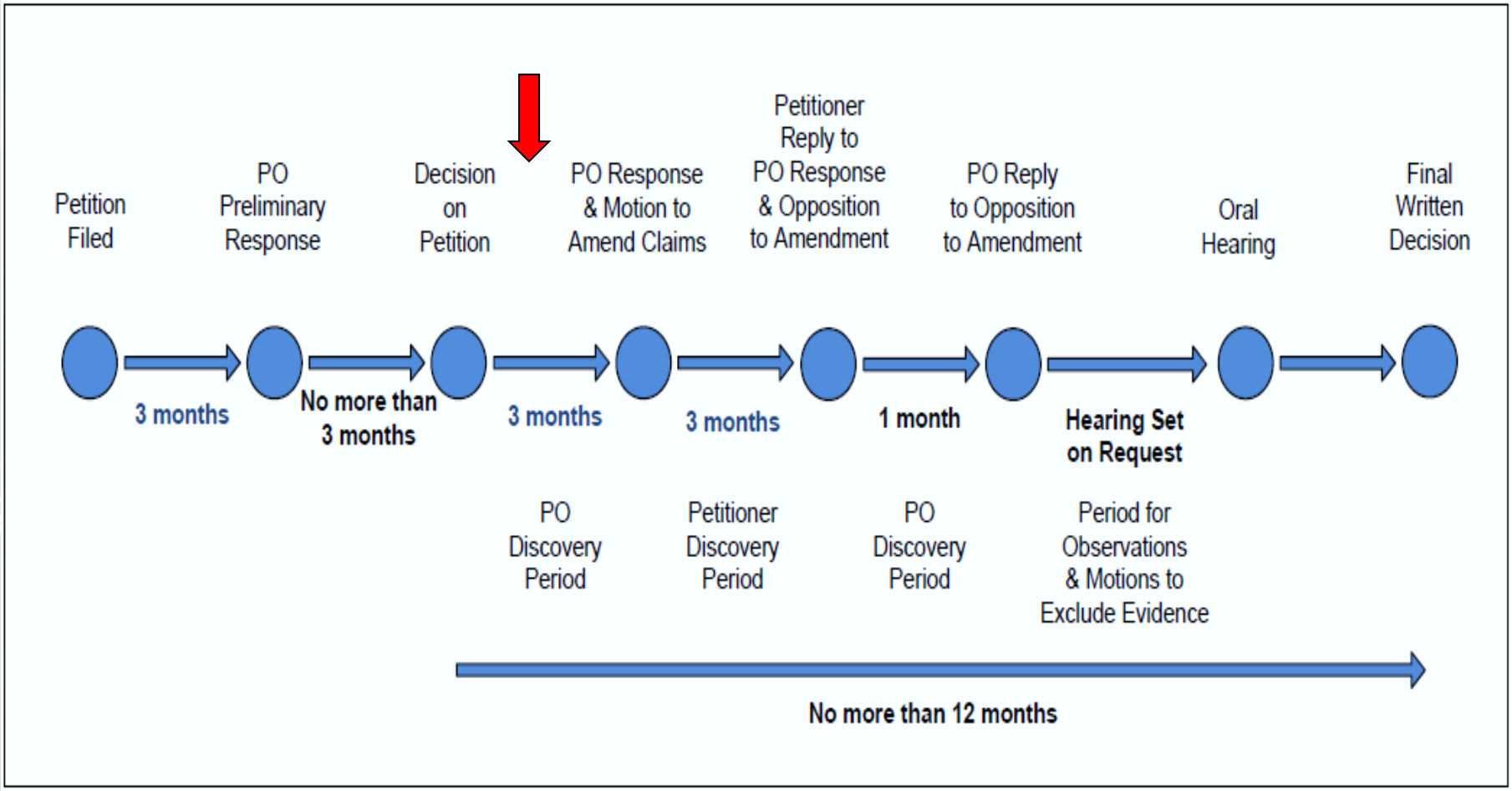


Petition Dispositions (As of 5/1/14)

	Total No. of Decisions on Institution	Trials Instituted	Joinders	Denials	Percent Instituted
IPR	576	457	12+	107	79%
CBM	74	58	1+	15	78%

+13 cases joined to 12 base trials for a total of 25 cases involved in joinder.

Joinder


Petition Filed
PO Preliminary Response
Decision on Petition
PO Response & Motion to Amend Claims
Petitioner Reply to PO Response & Opposition to Amendment
PO Reply to Opposition to Amendment
Oral Hearing
Final Written Decision
3 months
No more than 3 months
3 months
3 months
1 month
Hearing Set on Request
PO Discovery Period
Petitioner Discovery Period
PO Discovery Period
Period for Observations & Motions to Exclude Evidence
No more than 12 months

Joinders (As of 5/1/14)

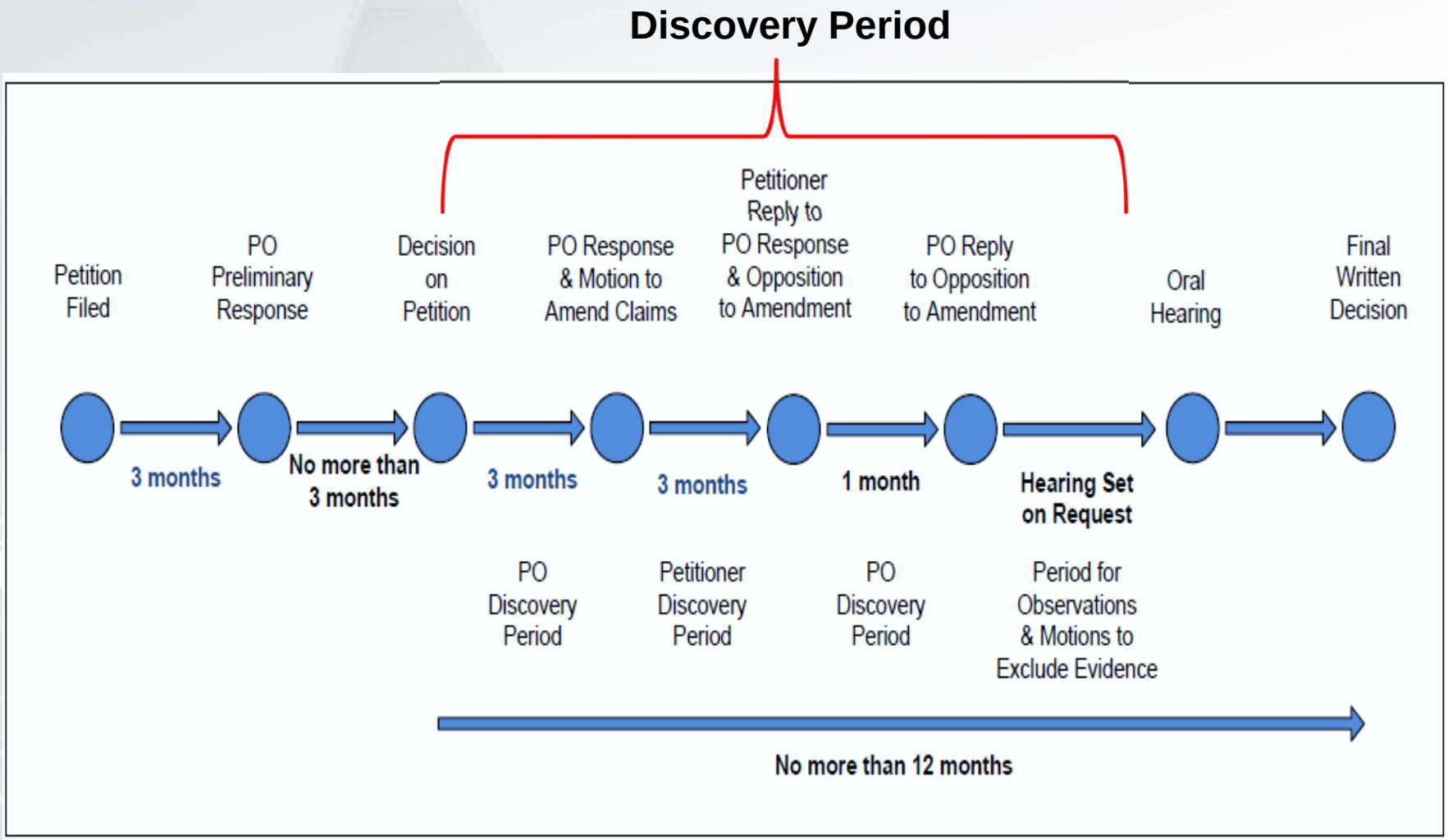
	Trials Instituted	Joinders
IPR	457	12+
CBM	58	1+

+13 cases joined to 12 base trials for a total of 25 cases involved in joinder.

Lessons Learned: Joinder

- Must be a like review proceeding
- Requires filing a motion and petition
- File within one month of institution
- Impact on schedule important
- *Dell v. Network-1*, IPR2013-00385 (Paper 17)(joinder granted)
- *Sony v. Network-1*, IPR2013-00386 (Paper 16)(joinder denied)

Discovery


Discovery Period
Petition Filed
PO Preliminary Response
Decision on Petition
PO Response & Motion to Amend Claims
Petitioner Reply to PO Response & Opposition to Amendment
PO Reply to Opposition to Amendment
Oral Hearing
Final Written Decision
3 months
No more than 3 months
3 months
3 months
1 month
Hearing Set on Request
PO Discovery Period
Petitioner Discovery Period
PO Discovery Period
Period for Observations & Motions to Exclude Evidence
No more than 12 months

Types of Discovery

- Initial disclosures (Trial Practice Guide, 77 Fed. Reg. 48756, 48761-62 (Aug. 14, 2012)

- Routine Discovery
  - Cited exhibits
  - Cross-examination of witnesses
  - Inconsistent information

- Additional Discovery

Lessons Learned: Additional Discovery

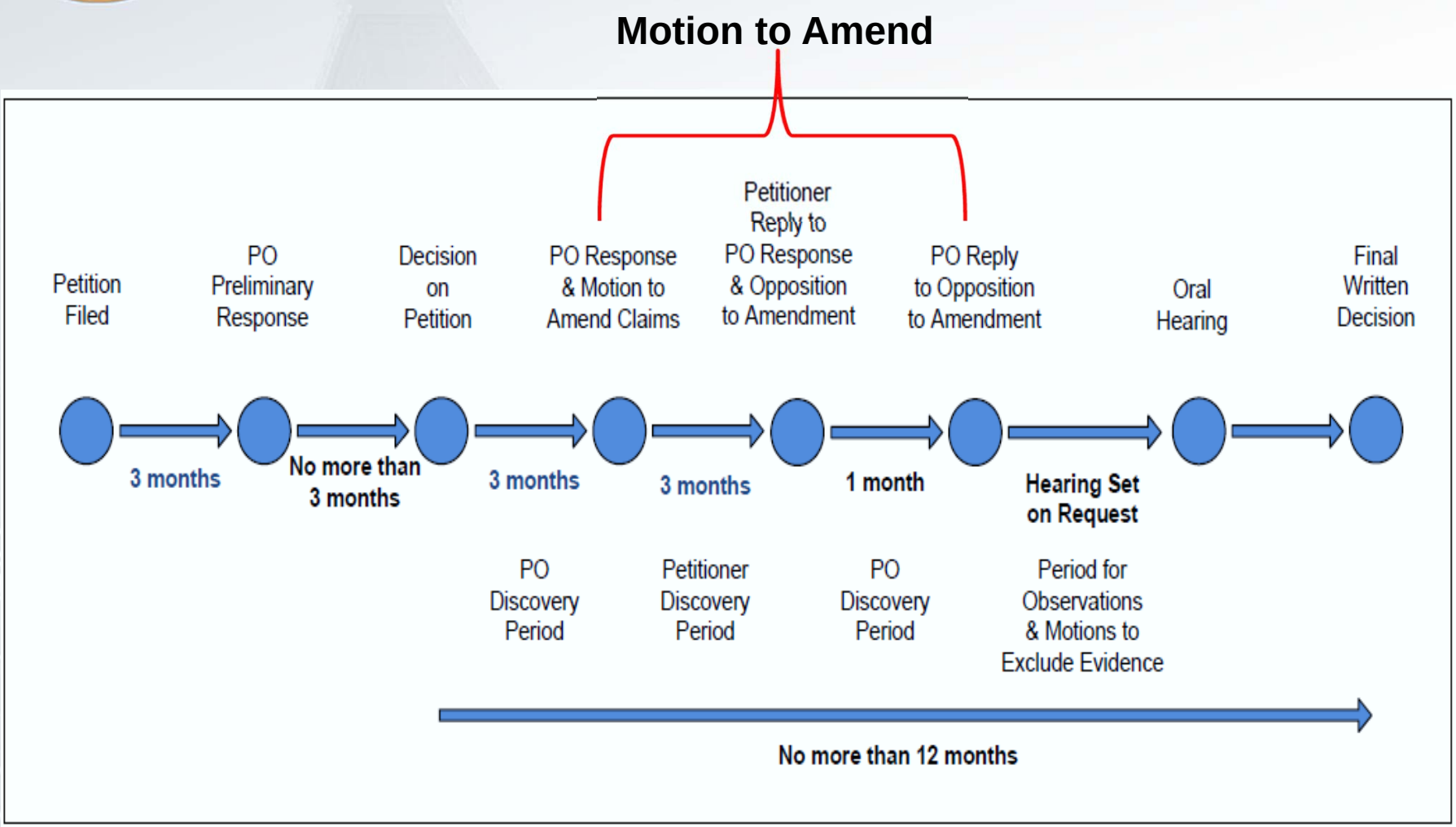
- Five factor test used in evaluating additional discovery requests (IPR2012-00001, *Garmin v. Cuozzo (*Paper 26)):
  1. More than a possibility and mere allegation must exist that something useful might be found.
  2. Is the request merely seeking early identification of opponent's litigation position?
  3. Can party requesting discovery generate the information?
  4. Interrogatory questions must be clear.
  5. Are requests overly burdensome to answer?

- Requests for specific documents with a sufficient showing of relevance are more likely to be granted whereas requests for general classes of documents are typically denied

Lessons Learned: Depositions

- Federal Rules of Evidence apply
- Objections to admissibility waived
- Follow the Testimony Guidelines (Practice Guide Appendix D)
  - No “speaking” objections or coaching
  - Instructions not to answer are limited
- Foreign language/country. *See Ariosa v. Isis*, IPR2013-00022 (Papers 55, 67)

Motion to Amend



Motions to Amend

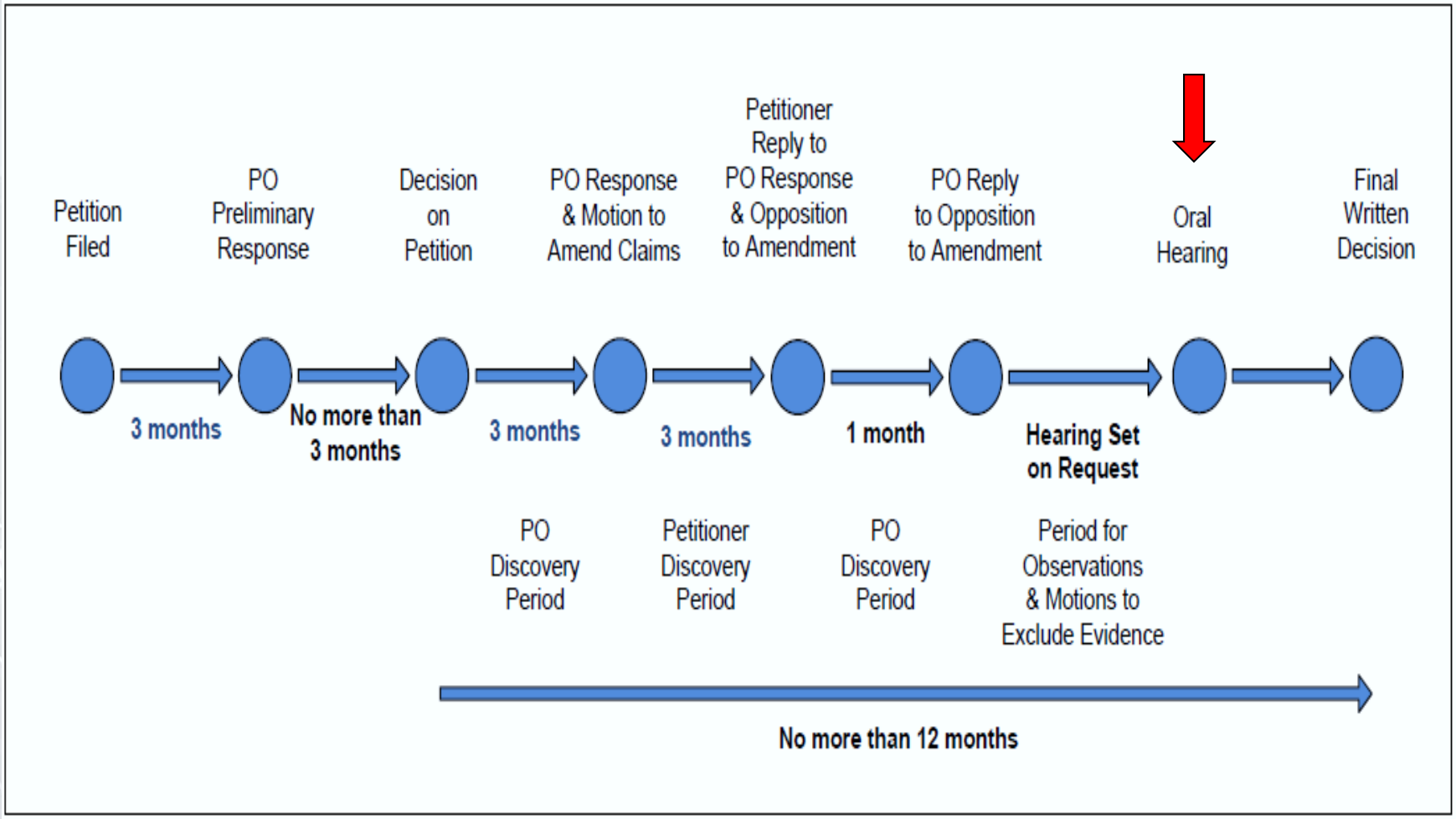
- Board conference required
- Normally one-for-one claim substitution
- Must narrow scope
- Need to show patentable distinction
- Clearly state the contingency of substitution
- *See Idle Free v. Bergstrom*, IPR2012-00027 (Paper 26)

Motions to Amend

- Unlike during examination, PTAB does not "examine" amended claims during an AIA proceeding
  - No search is conducted
  - No claim rejections made

- Burden is on the movant (i.e., the patent owner) to show the patentable distinction of the proposed amended claim

Oral Hearing



Lessons Learned: Oral Hearing

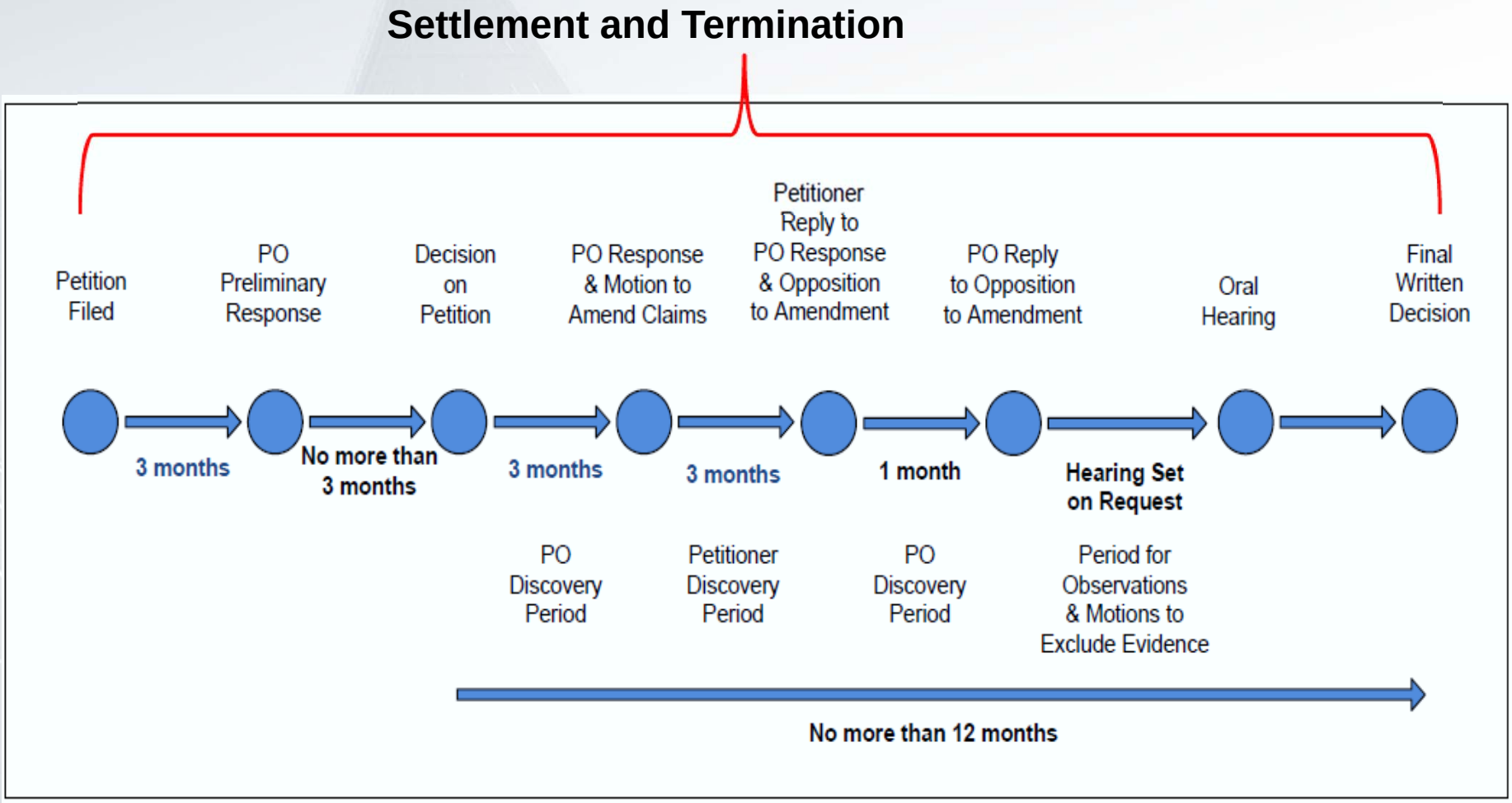
- Attorneys should bear in mind that:
  - Panel may have more than three judges;
  - Some panel members may participate by video; and
  - All questions from the judges are based on the written record, including arguments made in the parties' briefs and expert testimony filed in support of the parties' briefs

- Attorneys should be prepared to answer questions about the entire record, including claim construction, motion to amend, priority, secondary consideration and swearing-behind issues
  - Have sufficient familiarity with the record to answer questions effectively; and
  - Be ready to deviate from a prepared presentation to answer questions

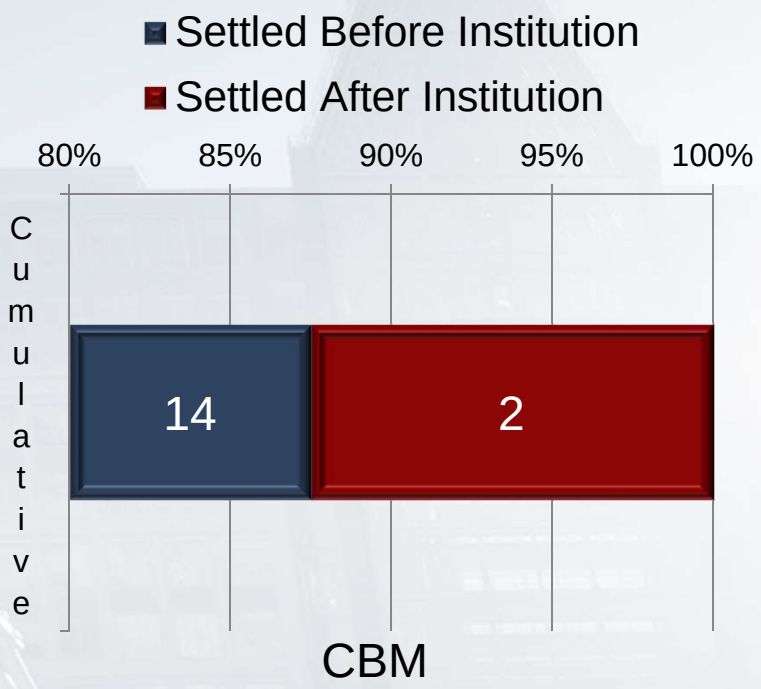
Lessons Learned: Oral Hearing

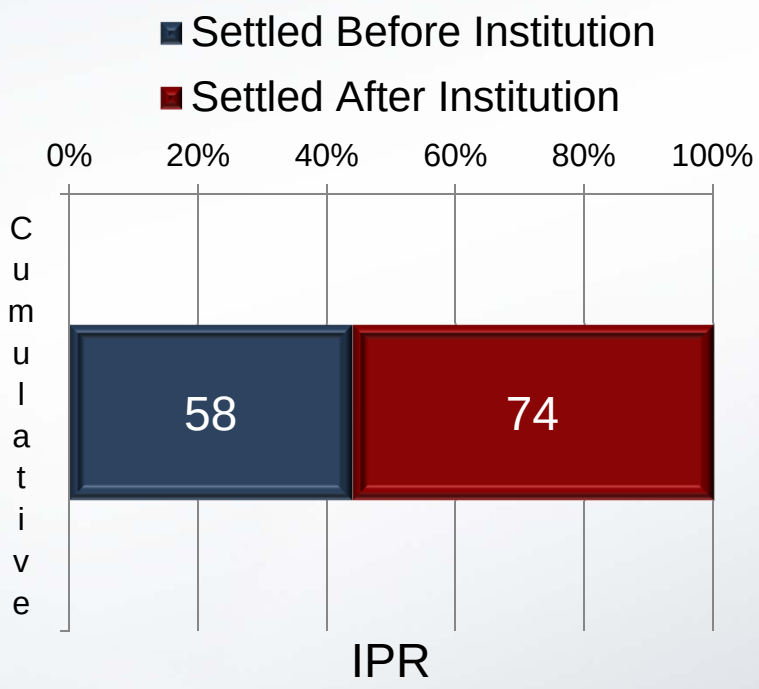
- Attorneys should focus on the best argument and not try to cover every argument made during the course of the trial
- No new evidence or argument is permitted
- Demonstrative exhibits should serve merely as visual aids
  - Pages of the record, with appropriate highlighting (e.g., highlighted figures), are effective and could be very helpful
  - When referring to slides, identify the number of the slide rather than say “this slide” or “next slide”

Settlement and Termination



Settlements* (As of 5/1/2014)





* Pool is taken from 148 cases that have settled since inception.

Settlements and Adverse Judgments (As of 5/1/14)

	Settlements	Adverse Judgments
IPR	132	25
CBM	16	0

Lessons Learned: Settlement

- Parties may file a joint motion to terminate a proceeding on the basis of settlement
  - Preauthorization is required; and
  - May be filed at any stage of the proceeding, even before institution
    - If the proceeding is terminated before institution, petitioner may file a request for refund of post-institution fee
- Board has discretion to proceed to final written decision, especially at an advanced stage when all briefing is complete
- Board is more likely to grant early motions to terminate

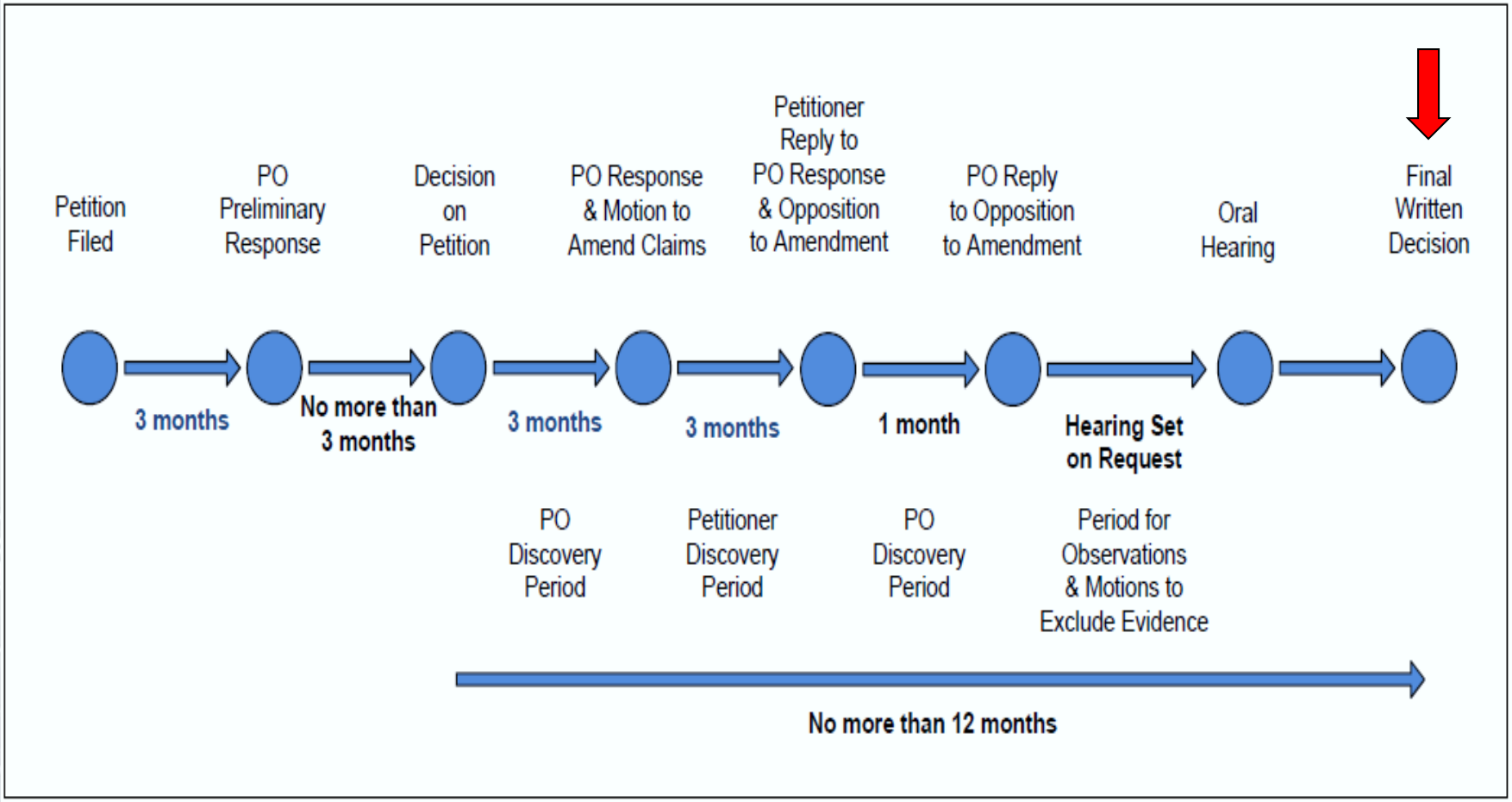
Lessons Learned: Settlement

- When there are multiple petitioners, proceeding may be terminated with respect to one petitioner when that petitioner settles with patent owner

- Joint motion to terminate must be accompanied by a true copy of the settlement agreement; a redacted version is not permitted

- Parties may request that the settlement agreement be treated as business confidential information
  - See § 42.74(c) and FAQ G2

Final Written Decision



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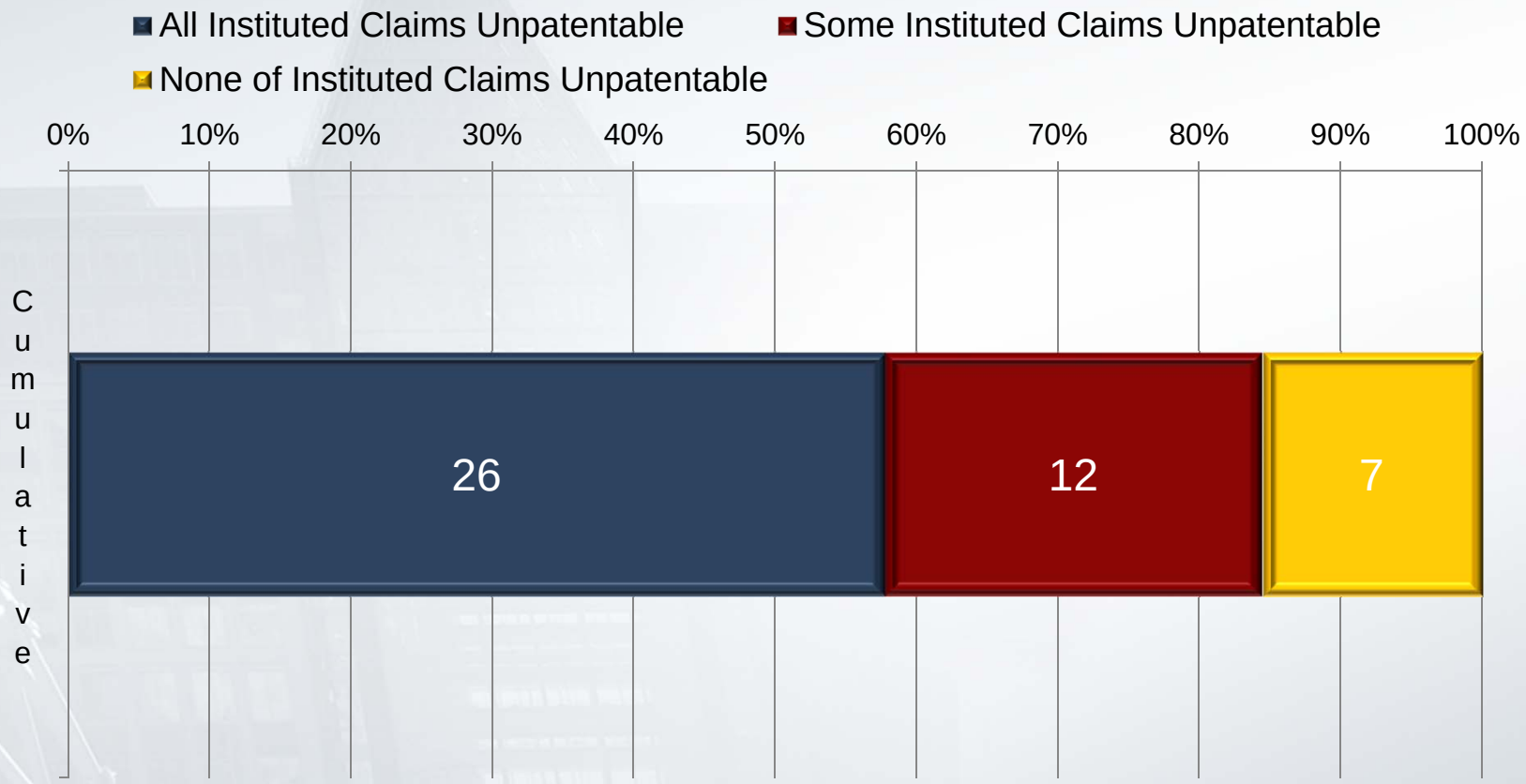
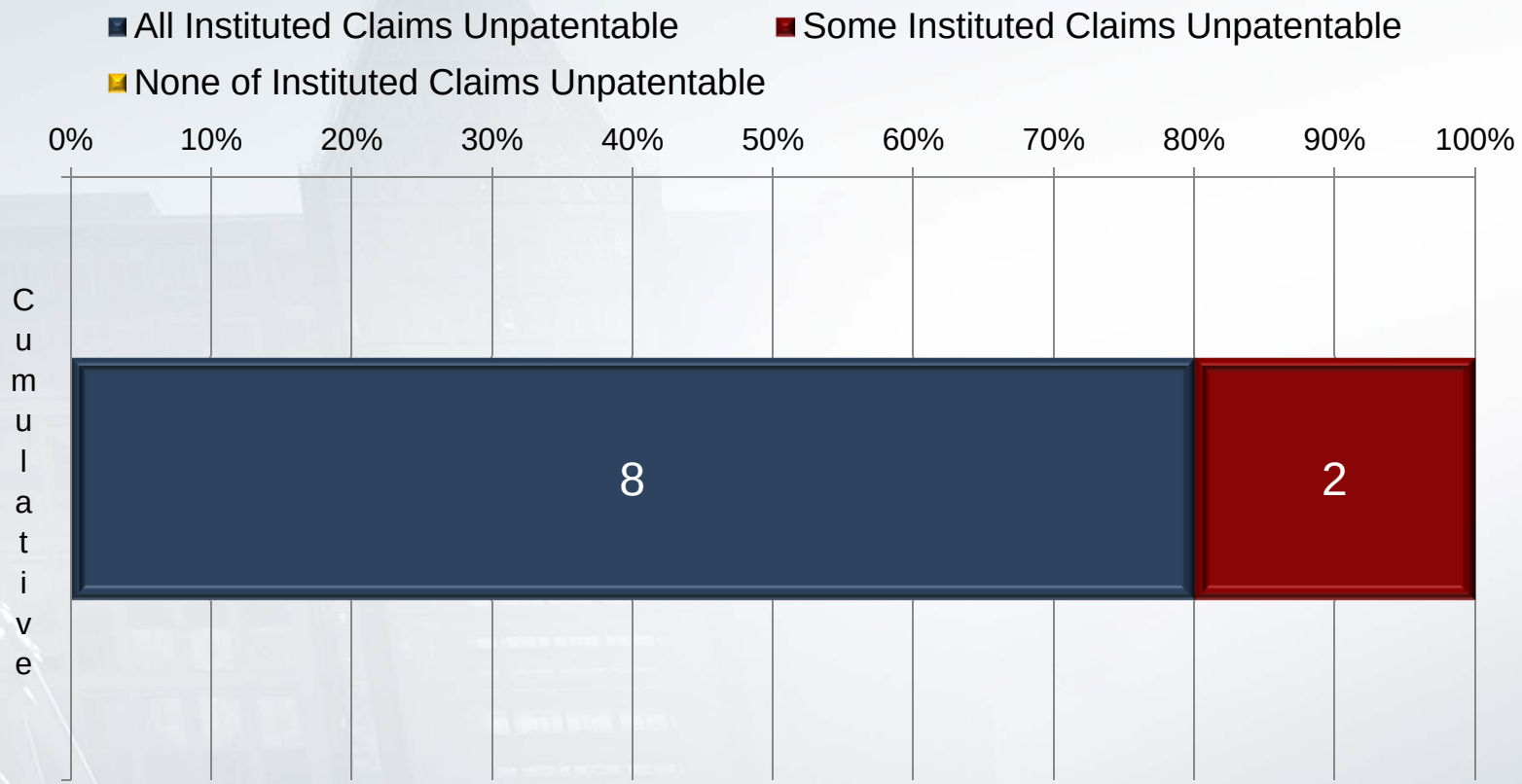
Final Written Decisions in IPRs (As of 5/1/2014)



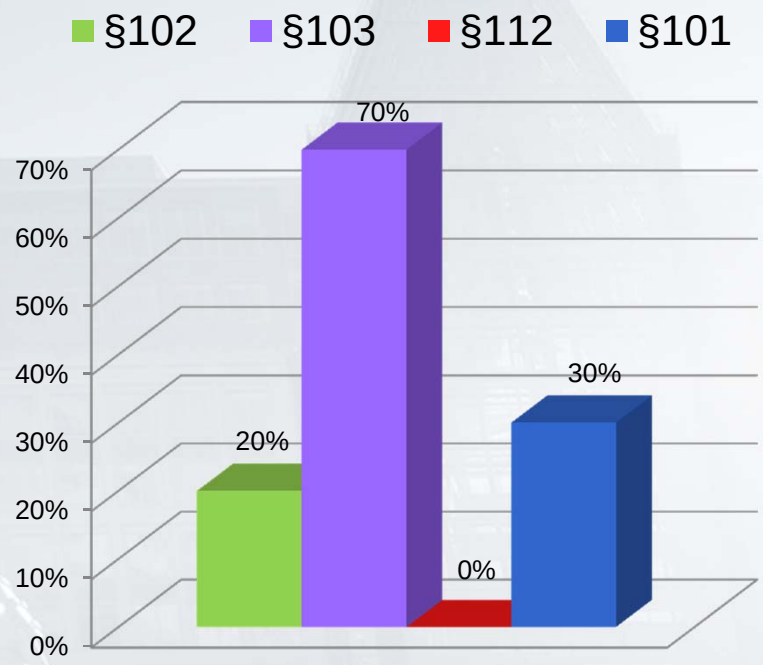
*IPR (45 Final Written Decisions)

Final Written Decisions in CBMs (As of 5/1/2014)

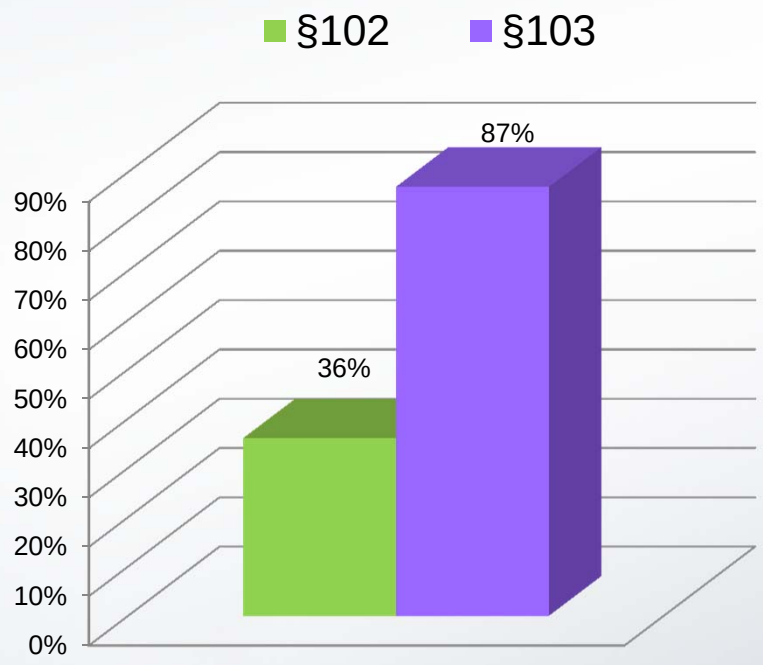


*CBM (10 Final Written Decisions)

Final Written Decisions: Basis for Unpatentability (As of 5/1/2014)



CBM (10 decisions)



IPR (45 decisions)

* Multiple bases can be reported for a single Final Written Decision

Interesting Recent Final Decisions

- *ABB Inc. v. Roy-G-Biv Corp.*, IPR 2013-00062 & IPR 2013-00282, Paper 84 (issued 4/11/2014) (petitioner did not meet burden to prove any of the challenged claims unpatentable)

- *ABB Inc. v. Roy-G-Biv Corp.*, IPR 2013-00074 & IPR 2013-00286, Paper 80 (issued 4/11/2014) (petitioner did not meet burden to prove any of the challenged claims unpatentable)

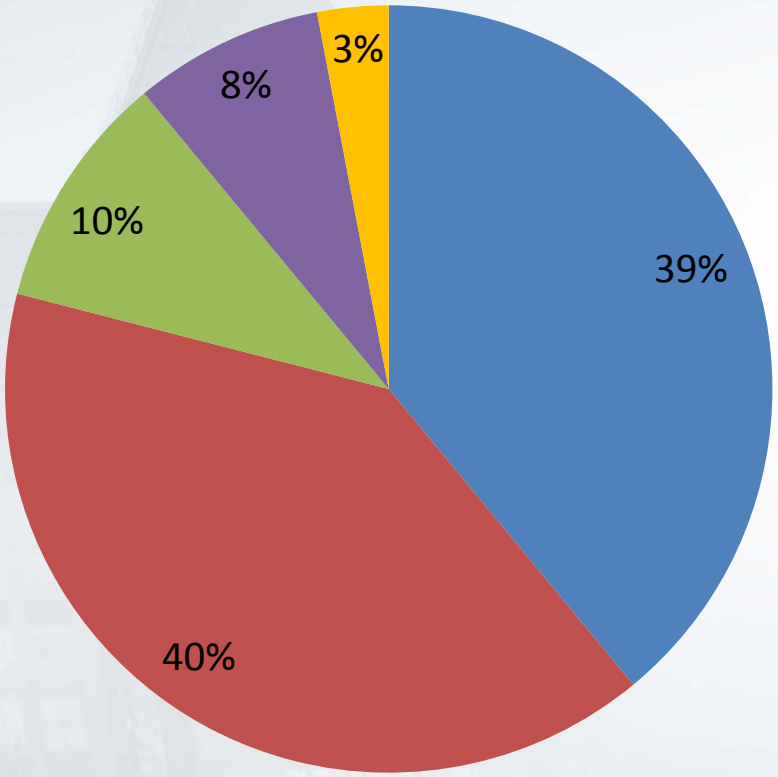
- *Corning, Inc. v. DSM IP Assets B.V.*, IPR2013-00047, Paper 84 (issued 5/1/2014) (petitioner did not meet burden to prove any of the challenged claims unpatentable)

- *Corning, Inc. v. DSM IP Assets B.V.*, IPR2013-00043, Paper 95 (issued 5/1/2014) (petitioner did not meet burden to prove any of the challenged claims unpatentable)

- *Corning, Inc. v. DSM IP Assets B.V.*, IPR2013-00044, Paper 92 (issued 5/1/2014) (petitioner did not meet burden to prove any of the challenged claims unpatentable)

Administrative Patent Judges

Allocation of Judges



- AIA
- Ex parte Appeals
- Inter Partes Reexamination Appeals
- Management
- Interferences

* As of April 15, 2014 (183 judges)

Board Hiring

- Goal is to add 52 judges by October
- Opportunities exist at Alexandria and at the Detroit/Denver/Dallas/Silicon Valley Satellite Offices
- Current job posting on USAJOBS
  - https://www.usajobs.gov/GetJob/ViewDetails/367273800

PTAB Website Tour

PTAB Website: From USPTO Home Page

PTAB Website: Landing Page (top half)

PTAB Website: Landing Page (bottom half)

Initiatives & Events

Popular Links

- **Interference Website**
- **Contacts & Mailing Addresses**
- **Directions to USPTO**
- **Precedential Opinions**
- **Informative Opinions**
- **PTAB Final Decisions**
- **Public Board Hearing Information**
- **Patent Prosecution Highway (between USPTO and JPO fast-track examination)**
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- **Patent Prosecution Highway (between USPTO and KIPO fast-track examination)**
- **Patent Prosecution Highway (between USPTO and IPAU fast-track examination)**

What's New

- **PTAB Blogs**

  Message From Administrative Patent Judges Sheridan Snedden And Jacqueline Bonilla: Deep Dive Into A Patent Owner Preliminary Response In An Inter Partes Review Proceeding Before The Patent Trial And Appeal Board (25FEB2014)

  >> View older PTAB blog messages

- A Day-in-the-Life of an APJ *[PDF]*
- Notice Concerning Payment of Appeal Forwarding Fee under 37 CFR 41.45 and Improper Use of Deposit Account General Authorization under 37 CFR 1.25(b) (13 Mar 2014)
- Official Gazette Notices

System Maintenance

>> Download browser plugins to view formatted files

- » Accessibility
- » Privacy Policy
- » Terms of Use
- » Security
- » Emergencies/Security Alerts
- » Information Quality Guidelines
- » Federal Activities Inventory Reform (FAIR) Act
- » Notification and Federal Employee Antidiscrimination and Retaliation (NoFEAR) Act
- » Budget & Performance
- » Freedom of Information Act (FOIA)
- » Department of Commerce NoFEAR Act Report
- » Regulations.gov
- » STOP!Fakes.gov
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Last Modified: 3/26/2014 1:44:13 PM

PTAB Website: Blogs

Initiatives & Events

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- A Day-in-the-Life of an APJ *[PDF]*
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Representative Orders, Decisions, and Notices

Representative Trial Hearing Orders:

- CBM2012-00001, Order – Trial Hearing, Paper 61, Apr. 8, 2013

Representative Decisions to Institute:

- IPR2012-00026 Decision to Institute, Paper 17, Dec. 21, 2012
- CBM2012-00001 Decision to Institute, Paper 36, Jan. 9, 2013
- IPR2012-00001 Decision to Institute, Paper 15, Jan. 9, 2013
- IPR2013-00034 Decision to Institute, Paper 22, Apr. 22, 2013

Representative Scheduling Orders:

- IPR2012-00026 Scheduling Order, Paper 18, Dec. 21, 2012
- CBM2012-00001 Scheduling Order, Paper 37, Jan. 9, 2013
- IPR2012-00001 Scheduling Order, Paper 16, Jan. 9, 2013

Other Representative Orders and Decisions:

- IPR2013-00639 Order Authorizing Motion for *Pro Hac Vice* Admission, Paper 7, Oct. 15, 2013
- IPR2012-00005, Order regarding Written Description Support for Substituted Claims, Paper 27, June 3, 2013
- IPR2012-00027, Decision on Motion to Amend Claims, Paper 26, June 11, 2013
- IPR2013-00004 Order Authorizing Motion for Joinder, Paper 15, Apr. 24, 2013
- IPR2013-00010, Decision regarding Service Under 35 U.S.C. § 315(b), Paper 20, Jan. 30, 2013
- IPR2013-00109, Decision granting motion for joinder, Paper 15, Feb. 25, 2013
- IPR2012-00018, Decision – Real Party in Interest, Paper 12, Jan. 24, 2013
- CBM2012-00003, Order (Redundant Grounds), Paper 7, Oct. 25, 2012
- CBM2012-00003, Order (Denial of Grounds), Paper 8, Oct. 25, 2012
- CBM2012-00001, Decision Denying Motion for Pro Hac Vice Admission, Paper 21, Nov. 6, 2012
- CBM2013-00005, Decision Granting Motion for Pro Hac Vice Admission, Paper 13, Nov. 26, 2012
- IPR2013-00033, Order to Stay Reexam, Paper 15, Nov. 6, 2012
- IPR2013-00028, Decision on Motion to Take Jurisdiction, Paper 8, Nov. 27, 2012
- CBM2012-00005 Order regarding Content of Motions List, Paper 31, Feb. 13, 2013
- IPR2012-00022 Decision regarding Standing to file Petition, Paper 20, Feb. 12, 2013

Representative Notices:

- CBM2012-00002, Notice of Filing Date Accorded, Paper 4, Sept. 21, 2012
- IPR2013-00033, Notice of Filing Date Accorded, Paper 14, Oct. 26, 2012
- IPR2012-00004, Notice of Defective Petition, Paper 6, Sept. 21, 2012
- IPR2012-00022, Notice of Incomplete Petition, Paper 5, Sept. 27, 2012

Representative Settlement Related Orders

- IPR2012-00004 Order regarding Settlement after Initiation, Paper 21, Feb. 4, 2013
- IPR2013-00078 Order regarding Pre-Institution Settlement, Paper 7, Feb. 8, 2013
- IPR2013-00078 Judgment Termination of Proceeding, Paper 11, Feb. 12, 2013

Evidentiary Decisions and Orders including Discovery

- IPR2013-00043 Decision on Motion for Additional Discovery, Paper 27, June 21, 2013
- CBM2013-00005 Decision on Motion for Additional Discovery, Paper 32, May 29, 2013
- CBM2012-00001, Decision on Discovery Request, Paper 24, Nov. 15, 2012
- IPR2012-00001, Decision including Discussion of Discovery Standards, Paper 26, Mar. 5, 2013
- IPR2012-00026, Decision Denying Additional Discovery on Commercial Success, Paper 32, Mar. 8, 2013
- IPR2012-00001, Decision Motion to Seal, Paper 34, Mar. 14, 2013

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RESOURCES

- Board-related Official Gazette Notices
- Board Rules for Ex Parte Appeals [effective Jan. 23, 2012]
- Board Trial Rules
- Board Practice Guide *[PDF]*
- Standard Operating Procedures
- Satellite Offices
- Patent Review Processing System (PRPS)
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Other Resources

- U.S. Court of Appeals for the Federal Circuit
- USPTO Rules of Professional Conduct
- Title 35 of the United States Code

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Mock Conference Call

Motion to Amend: Fact Pattern

- IPR instituted against claims 1-5
  - Claims 1, 4, and 5 are independent
  - Claims 2 and 3 depend from claim 1

- **<u>Before</u>** telephone conference, Patent Owner contemplates filing a motion to amend that will:
  - Replace claim 1 with substitute claim 1;
  - Replace claim 4 with substitute claims 6-10; and
  - Cancel claim 5

Motion to Amend: Fact Pattern

- **<u>After</u>** teleconference, Patent Owner intends to file a motion to amend that will:
  - Replace claim 1 with substitute claim 6;
  - Replace claim 4 with substitute claim 7; and
  - Cancel claim 5

Lessons Learned: Motion to Amend

- Motion to amend may request cancellation or substitution of an original claim
  - Wholesale addition of new claims generally is not allowed
- A substitute claim generally should contain all of the limitations of the original claim that it replaces
- A substitute claim should add one or more features that respond to the grounds of unpatentability at issue in the trial
- Each original claim that changes in scope as a result of the amendment should be presented as a substitute claim with a unique claim number
  - Applies to claims that change in scope only by virtue of their dependence on a substitute claim too

Motion to Amend: Lessons Learned

- AIA trial is not a patent examination
  - Board does not conduct a prior art search or enter rejections
- If a motion to amend is granted, the substitute claim is added to an issued patent without any Office search or examination
- Patent Owner “moves” to amend; no amendment of right
- As the party requesting relief, Patent Owner bears the burden of establishing the patentability of proposed substitute claims
- In general, the Board takes up a motion to amend only if the original claim is cancelled or found unpatentable, so no gloss of patentability transfers from original claim to substitute claim

Lessons Learned: Motion to Amend

- An inventory that catalogues the individual disclosures of each prior art reference may not be helpful or the best use of the 15 pages allowed for motions

- Provide a narrative that explains what the Patent Owner knows about the state of the prior art as it relates to the feature added by amendment
  - Focus on why adding that feature to the combined elements of the original claim would not have been obvious

- Patent Owner may support that narrative with an expert declaration, citations to textbooks, or evidence of conventional practices relevant to the added feature

Motion to Amend: Some Interesting Cases

- *Idle Free Systems, Inc. v. Bergstrom, Inc.,* IPR2012-00027, Papers 26, 66 (setting forth requirements for meeting burden of proof on a motion to amend).

- *Corning Gilbert, Inc. v. PPC Broadband, Inc.*, IPR2013-00347, Paper 20 (discussing the burden regarding the state of the prior art and level of ordinary skill in the art with respect to features added by amendment).

- *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00419, Paper 32 (providing guidance on mechanics and substance of a motion to amend).

- *Nichia Corp. v. Emcore Corp.*, IPR2012-00005, Paper 27 (motion to amend should adequately establish written description support for substitute claims based on the original disclosure of the application).

Motion for Additional Discovery: Fact Pattern

- **<u>Before</u>** the telephone conference call, Patent Owner seeks pre-authorization to file a motion for additional discovery requesting 2 categories of documents:

  1. All sales and pricing documents relating to Petitioner's products that are at issue in a district court infringement action; and

  2. All documents regarding the relationship between Petitioner and two non-parties:
     - Acme = Petitioner's customer; and
     - Universal = a company recently acquired by Petitioner

Motion for Additional Discovery: Fact Pattern

- **<u>After</u>** the telephone conference, the Board authorizes Patent Owner to file a motion for additional discovery directed to the following documents:

  1. A summary document that reflects sales and pricing data for the products manufactured by Petitioner that are accused of infringement in district court. Counsel for Petitioner admitted that a summary document already exists, so compiling a summary is not required; and

  2. A customer sales agreement between Acme and Petitioner, as well as an acquisition agreement between Universal and Petitioner. Counsel for Petitioner admitted that these documents exist and are easily accessible

Lessons Learned: Motion for Additional Discovery

- The discovery permitted in an AIA trial is more limited than the discovery available in a district court
- Party seeking discovery that exceeds the scope of routine discovery must ask the Board for authorization to file a motion for additional discovery
- Motion must show that a grant of the additional discovery will serve the interests of justice (for an IPR) or is supported by good cause (for a CBM or PGR)

Lessons Learned: Motion for Additional Discovery

- Motion must do more than target information that is likely to be useful. Motion must show that the requested documents likely exist and will be useful in making out an element of the requesting party's case
- Requests seeking "any" or "all" documents in a broad category may be viewed as speculative
- Board will consider whether the discovery request would unduly burden the producing party or can be obtained from other sources, such as the Internet
- Expect the Board to encourage reasonable compromise

Motion for Additional Discovery: Some Interesting Cases

- *Garmin Int'l v. Cuozzo Speed Techs.,* IPR2012-00001, Paper 26 (enumerating the "Garmin factors")

- *Corning, Inc. v. DSM IP Assets B.V.*, IPR2013-00043, Paper 27 (granting additional discovery request for laboratory notebooks)

- *RPX Corp. v. Virnetx Inc.*, IPR2014-00171, Paper 25 (granting additional discovery regarding real-party-in-interest and privity issues after identifying a limited set of relevant documents)

- *Apple Inc. v. Achates Ref. Publ., Inc.*, IPR2013-00080, Paper 66 (granting additional discovery of email communications exchanged directly between patent owner's two experts)

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Break

Fact Pattern: Patents

- Patent Owner is assigned two patents:
  - ‘001 Patent
    - has 100 claims; and
    - was issued in 2000
  - ‘002 Patent
    - has 5 claims;
    - was issued in 2014; and
    - and is subject to the first-inventor-to-file provisions of the America Invents Act

Fact Pattern: District Court Litigation

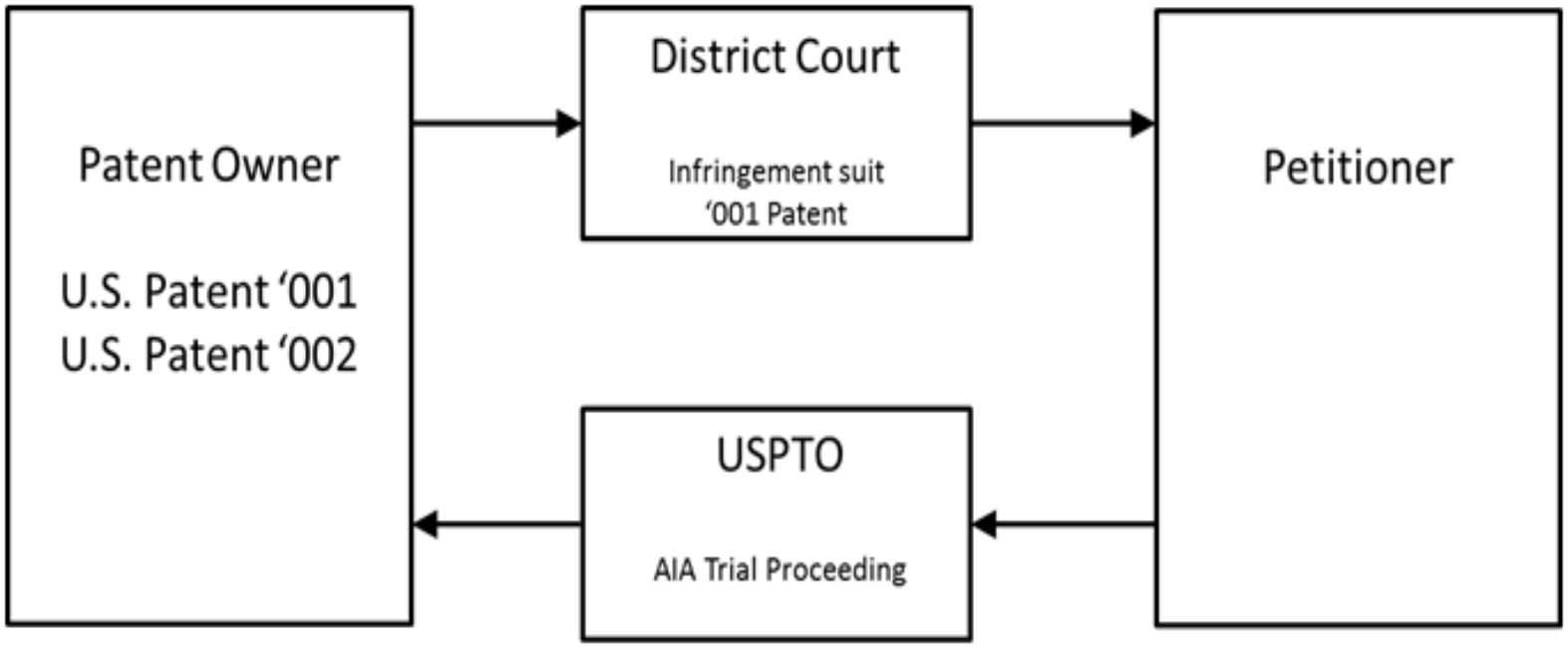
- Patent Owner has sued Petitioner for infringement of certain claims in the ‘001 Patent in District Court

- Patent Owner is considering suing the Petitioner for infringement of certain claims in the ‘002 Patent in District Court too

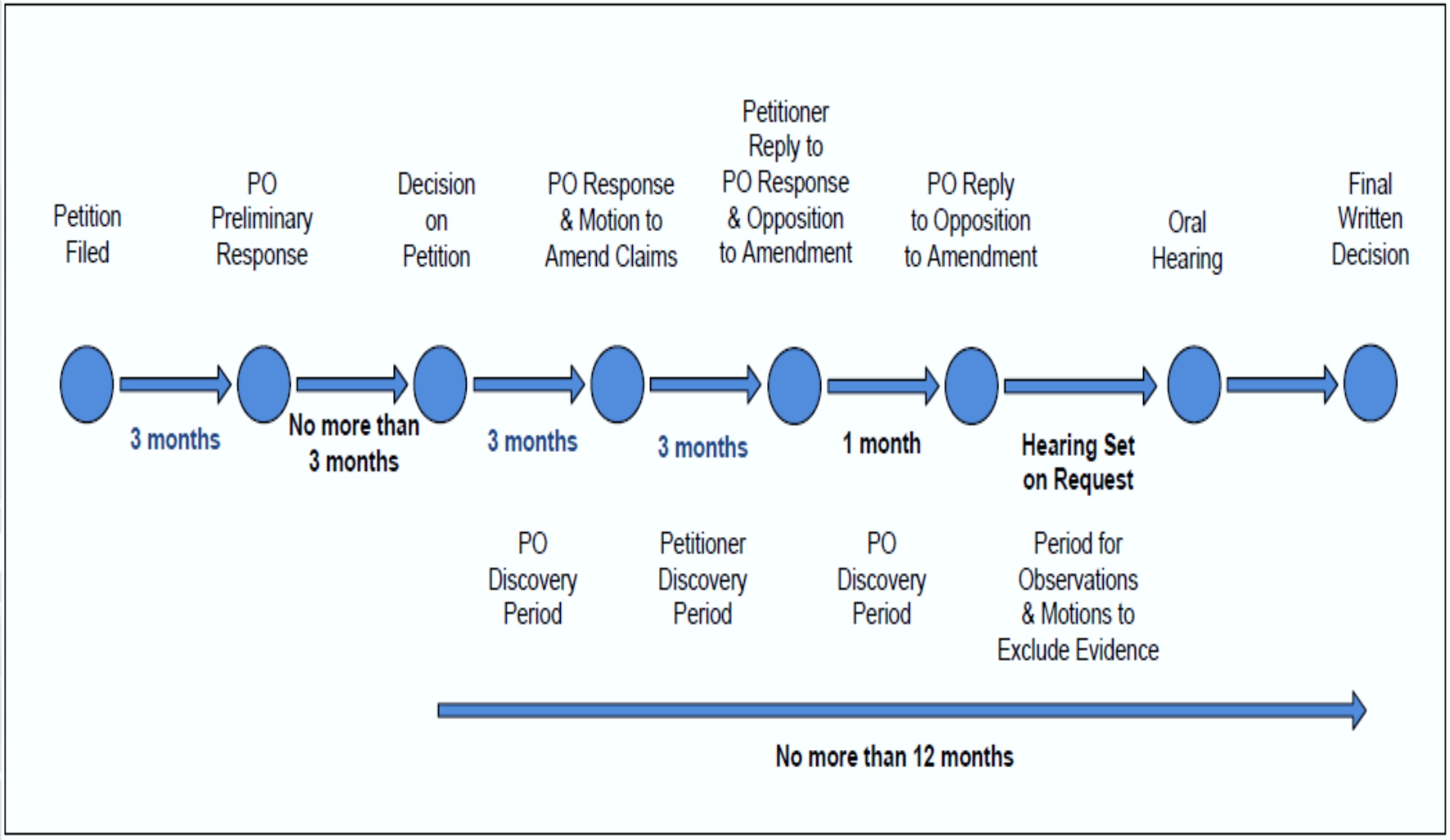
Fact Pattern: AIA Trial

- Petitioner wants to file one or more AIA trial proceedings against the ‘001 Patent and the ‘002 Patent because it believes:
  - certain claims in the ‘001 Patent are anticipated and obvious as well as unpatentable under § 101 and § 112; and
  - certain claims of the '002 Patent are obvious

Fact Pattern: Graphic



Trial Proceeding Timeline



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