



# 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.
  - 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 an IPR.
  - 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.





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**THANK YOU!**