



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!