

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Relationship Between AIA Proceedings, Reexamination Proceedings, and Reissue Proceedings

Administrative Patent Judges Sally Medley, and Joni Chang

Patent Trial and Appeal Board

Webinar Series (2 of 5)

April 5, 2016

UNITED STATES
PATENT AND TRADEMARK OFFICE



Boardside Chats

| Date | Time | Topic | Speakers |
|--------------------|---------------------------------|---|---------------------------------------|
| Tuesday, April 19 | Noon to 1 pm Eastern Time | New AIA Final Trial Rules | Judge Susan Mitchell |
| Tuesday, June 7 | | Best practices to present argument related to patentability and unpatentability before the PTAB | Judges Jay Moore and Kit Crumbley |
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Agenda

| Topics | Presenter |
|---|--|
| AIA Trial, Reexamination, and Reissue Proceedings | Judge Sally Medley Judge Joni Chang |
| Q&A with audience | Janet Gongola (moderator) |

Differentiation of Proceeding Types

- AIA Trial
- Reexamination
- Reissue

Comparison of AIA, Reexam, and Reissue Proceedings

| | AIA review | Ex parte Reexam | Reissue |
|--|---|---|--|
| Who may file? | A person who is not the patent owner | Patent owner or third party | Patent owner |
| Who conducts the proceeding? | A panel of 3 APJs | Examiner | Examiner |
| Threshold standard | IPR – a reasonable likelihood that petitioner would prevail as to at least one claim; PGR & CBM – it is more likely than not that at least one claim is unpatentable | Substantial new question of patentability | At least one error in the patent where, as a result of the error, the patent is deemed wholly or partly inoperative or invalid |
| Grounds of unpatentability | IPR – only on §§ 102 and 103 grounds based on patent and printed publications; PGR & CBM – §§ 101, 102, 103, and 112, except best mode, grounds are permitted | Only on §§ 102 and 103 grounds based on patent and printed publications | Examined in the same manner as an original nonprovisional application—essentially on any grounds |
| Burden | Petitioner has the burden of proving a proposition of unpatentability by a preponderance of the evidence, §§ 316(e), 326(e) | The burden is on the Office to establish any prima facie case of unpatentability, MPEP 2103 | The burden is on the Office to establish any prima facie case of unpatentability, MPEP 2103 |
| Speed | Final determination within 1 year after institution, which may be extended by up to 6 months for good cause | Conducted with special dispatch | Taken up as “special” |
| Discovery (e.g., cross-examination of declarants) | Yes | No | No |
| Claim construction standard | BRI for unexpired patents | BRI for unexpired patents | BRI for unexpired patents |
| Amending claims | Patent owner may file a motion to amend | Patent owner may file a proposed amendment under § 1.530 | Patent owner may file an amendment under § 1.173 |
| Enlarging claim scope | No | No | No, unless applied for within 2 years from the grant of the original patent |
| Presumption of validity | No | No | No |
| Settlement | Parties may file a joint motion to terminate a proceeding on the bases of settlement | | |

Stay

- 35 U.S.C. §§ 315 (d) and 325(d) provides authority to stay
- Examples of when the Board has not stayed
 - *Toshiba Corp v. Intellectual Ventures II LLC*, IPR2014-00317 (PTAB May 6, 2014)
 - *American Simmental Assoc. v. Leachman Cattle of Colorado, LLC*, PGR2015-00003 (PTAB Dec. 12, 2014)
 - *Kaiser Aluminum v. Constellium Rolled Products Ravenswood, LLC*, IPR2014-01002 (PTAB Feb. 19, 2015)
- Examples of when the Board has stayed
 - *American Simmental Assoc. v. Leachman Cattle of Colorado, LLC*, PGR2015-00003 (PTAB June 25, 2015)
 - *Google Inc. v. Summit 6 LLC*, IPR2015-00806 (PTAB Oct. 7, 2015)
 - *Gnosis S.p.A. v. Merck & CIE*, IPR2013-00117 (PTAB Feb. 5, 2015)

Consolidation

- 35 U.S.C. §§ 315 (d) and 325(d) provides authority to consolidate
- Examples of when the Board has consolidated
 - *Microsoft Corp. v. SurfCast, Inc.*, IPR2013-00292 (PTAB Nov. 19, 2013)
 - *Canon Inc. v. Intellectual Ventures II LLC*, IPR2014-00631 (PTAB Sept. 10, 2014)
 - *McAfee, Inc. v. CAP Co. LTD.*, IPR2015-01855 (PTAB Mar. 8, 2016)
- Examples of when the Board did not consolidate
 - *Ford Motor Co. v. Signal IP, Inc.*, IPR2015-00860 (PTAB Nov. 17, 2015)

Terminate/Not Institute

- 35 U.S.C. §§ 315(d) and 325(d) provides authority to terminate/not institute
- Examples of when the Board terminated
 - *RPX Corp. v. Macrosolve, Inc.*, IPR2014-00140 (PTAB June 20, 2014)
 - *Ford Motor Co. v. Signal IP, Inc.*, IPR2015-00861 (PTAB Feb. 18, 2016)
- Examples of when the Board did not institute or terminate
 - *Mercedes-Benz USA, LLC v. Velocity Patent, LLC*, IPR2015-00290 (PTAB Feb. 4, 2015)
 - *American Express Co. v. Signature Systems, LLC*, CBM2015-00153 (PTAB Dec. 28, 2015)
 - *Intromedic Co., Ltd. v. Given Imaging LTD.*, IPR2015-00579 (PTAB Aug. 5, 2015)
 - *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00419 (PTAB Dec. 12, 2014)

Exclusive Jurisdiction

- Per 37 C.F.R. §42.3, the Board “may exercise exclusive jurisdiction within the Office over every involved application and patent during the proceeding, as the Board may order”
- Patent Owner seeking certificate of correction during AIA proceeding
 - *Alarm.Com Inc. v. Vivint, Inc.*, IPR2015-01995 (PTAB Jan. 28, 2016)
 - *Energetiq Tech., Inc.*, IPR2015-01375 (PTAB Oct. 14, 2015)

Same or Substantially the Same Art or Arguments

- Whether to deny AIA Petition because same or substantially the same prior art or arguments previously were presented to the Office – last sentence of 35 U.S.C. § 325(d)
- Examples of when the Board denied follow-on petition:
 - *Samsung v. Rembrandt Wireless*, IPR2015-00114 (PTAB Dec. 28, 2015)
 - *Butamax v. Gevo*, IPR2014-00581 (PTAB Oct. 14, 2014)
 - *ZTE v ContentGuard*, IPR2013-00454 (PTAB Sept. 25, 2013)
- Examples of when the Board denied due to previous/concurrent reexamination/reissue proceeding:
 - *Front Row Technologies, LLC v. MLB Advanced Media, L.P.*, IPR2015-01932 (PTAB March 25, 2016)
 - *Palo Alto Networks, Inc. v. Finjan, Inc.*, IPR2015-01999 (PTAB March 29, 2016)

Same or Substantially the Same Art or Arguments

- Whether to deny AIA Petition because same or substantially the same prior art or arguments previously were presented to the Office – last sentence of 35 U.S.C. § 325(d)
- Examples of when the Board exercised discretion to institute:
 - *Kaiser Aluminum v. Constellium Rolled Products Ravenswood, LLC*, IPR2014-01002 (PTAB Dec. 29, 2014)
 - *Nexans, Inc. v. Belden Technologies Inc.*, IPR2013-00057 (PTAB Apr. 16, 2013)

Amendment v. Reexam/Reissue

- Motion to amend versus pursuing claims in a reexamination and/or reissue proceeding
- Examples of pursuing Reexamination and/or Reissue “just in case”
 - *Game Show Network, LLC and Worldwinner.com Inc. v. John H. Stephenson*, IPR2013-00289 (Papers 21 and 31)
- Examples of pursuing Reexamination and/or Reissue that results in termination of AIA proceeding:
 - *RPX Corp. v. Macrosolve, Inc.*, IPR2014-00140 (PTAB June 20, 2014)
 - *Ford Motor Co. v. Signal IP, Inc.*, IPR2015-00861 (PTAB Feb. 18, 2016)

Amendment v. Reexam/Reissue

- Motion to amend versus pursuing claims in a reexamination and/or reissue proceeding
- Rule 42.73(d)(3) specifies that a patent applicant or owner is precluded from taking action inconsistent with an adverse judgment, including obtaining in any patent a claim that is not patentably distinct from a finally refused or canceled claim

Questions?

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Thank You



