GLOSSARY[1]

35 U.S.C. § 325(d) – this section of the U.S. Patent Act (i.e., Title 35 of the U.S. Code) provides that the Director of the USPTO may consider whether the same or substantially the same prior art and/or arguments were previously presented to the Office when determining, for example, whether an AIA proceeding will be instituted. TPG Part II.D.2 (*See, e.g.*, *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential) (setting forth a two-part framework under 35 U.S.C. § 325(d), entailing determining (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of [the] first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims).

America Invents Act (AIA) – this legislation, signed into law in 2011, changed how patents are granted and enforced in the United States. Among the many changes this Act made to U.S. patent laws was the creation of new procedures for challenging issued patents at the Patent Trial and Appeal Board ("PTAB" or "the Board," which was also created by the AIA), including *inter partes* review (IPR) and post grant review (PGR) proceedings. *See* 35 U.S.C. § 6; *see also id.* §§ 135, 311–319, 321–329.

Anticipation – a patentable invention must be novel. 35 U.S.C. § 102. A claimed invention lacks novelty, and is said to be anticipated, if it was already publicly known prior to the effective filing date of the patent's application. *Id*. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." TPG at Part II.B.2 (quoting *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). (*see* Prior Art).

Back-Up Counsel – a party in an AIA proceeding, when represented by counsel (which is typical), must designate (*see* Mandatory Notices) both a lead counsel and a back-up counsel that is able to step in to act on behalf of the primary, lead counsel. 37 C.F.R. § 42.10(a).

[1] This glossary is for informational purposes and does not replace or supplement the definitions provided in 37 C.F.R. Part 42.

Challenged Claims – in IPR and PGR proceedings, a petitioner challenges patentability and seeks cancellation of one or more claims of an issued U.S. patent; such claims are referred to as the challenged claims. 35 U.S.C. §§ 311(b), 321(b)).

Challenged Patent – an issued U.S. patent with one or more claims challenged in an AIA petition.

Claim Construction – in district court patent litigation and in AIA proceedings at PTAB, the language of the involved claims is sometimes in dispute as to its meaning and/or scope. In such cases the parties may argue for a certain meaning or scope of the claim language and the presiding court or PTAB may provide an interpretation of the claim language, which is called claim construction. *See Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

Claim – each U.S. patent includes at the end of its specification one or more numbered sentences called claims, which define the subject matter and scope of the patented invention. 35 U.S.C. § 100(j); 37 C.F.R. § 1.75(a).

Confidential Information – information a party desires to be kept non-public, for example, because it encompasses a trade secret, financial information, or commercial information. 37 C.F.R. § 42.2; *see also id*. § 42.44 (confidential information in a petition).

Discretionary Denial – when a petitioner challenges a patent in an AIA proceeding, the Director of the USPTO has the discretion to deny the petition. 35 U.S.C. §§ 314(a), 324(a), 325(d); *see id.* §§ 316(b) and 326(b); *see also* TPG at Part II.D.2; www.uspto.gov/patents/ptab/interim-director-discretionary-process.

Enablement – for a patent/application claim to be patentable, the specification of that patent/application must describe the claimed invention in a way that allows a person skilled in the relevant field to make, use, or perform the invention without undue experimentation. 35 U.S.C. § 112(a).

Estoppel – a legal bar to alleging or denying a fact because of one's own previous actions or words to the contrary; parties who challenge a patent in an AIA proceeding reaching a final written decision cannot re-challenge the patent again (before PTAB or in U.S. district court) on any ground they raised or could have raised in the original AIA proceeding. 35 U.S.C. §§ 315(e), 325(e).

Final Written Decision (FWD) – a final decision by PTAB addressing the patentability of the challenged claims at the conclusion of an AIA proceeding. TPG Parts II.D.2, II.O.

Ground(s) of Unpatentability – the separate, specific basis or bases on which a petitioner asserts challenged claims of a patent are unpatentable. *See, e.g.*, 35 U.S.C. §§ 311(b), 316(a)(2), 321(b); TPG at Introduction, Parts II.A.1, B.2.

Indefiniteness – a claim is indefinite under 35 U.S.C. § 112(b) if, when read in light of the specification of the patent and the prosecution history, it fails to inform those skilled in the art about the scope of the invention with reasonable certainty. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014).

Institution – a formal decision by the USPTO Director or PTAB that a petitioner has met the threshold requirements (based on the petition, any preliminary response, and the record to that point) to start an AIA trial. 35 U.S.C. §§ 314, 324; *see also* TPG Part II.D (discussing petitioner's burden for institution and the Board's considerations and decision regarding institution); *see also* Discretionary Denial. If PTAB or the Director institutes a trial, the trial proceeds; if not, the trial is denied, and the proceeding ends.

***Inter Partes* Review ("IPR")** – an AIA proceeding in which a third-party petitioner challenges the patentability of one or more claims in an issued U.S. patent at PTAB, based on anticipation by and/or obviousness over prior art (i.e., patents, published patent applications, printed publications) to determine whether the challenged claims are unpatentable and should be cancelled. 35 U.S.C. § 311. (*see* Anticipation, Obviousness, and Prior Art).

Lead Counsel – designated primary counsel to represent and conduct business on behalf of a party in an AIA proceeding. 37 C.F.R. § 42.10(a); TPG at I.B. (*see* Back-up Counsel and Mandatory Notices).

Mandatory Notices – required notifications that must be entered of record (and updated as circumstances change) by each party in an AIA proceeding to inform the public, the parties in the case, and the Board of certain information: the real party or parties in interest, related matters, identification of lead and back-up counsel, and service information. 37 C.F.R. § 42.8.

Means-Plus-Function – a type of patent claim limitation that, rather than setting out a specific structure of the claimed element (or steps if a method claim), focuses on a function accomplished. 35 U.S.C. § 112(f); *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1351 (Fed. Cir. 2015) (*en banc*). Often, but not always, such claim limitations use the words "means for" or "steps for," followed by a recited function or purpose, which indicates a means-plus-function limitation. Such limitations are interpreted (*see* Claim Construction) as limited to whatever corresponding structure (or steps) are described in the patent's specification for the claim's recited function (and equivalent structures/steps).

Objective Indicia of Obviousness or Non-Obviousness – evidence to demonstrate that an invention would or would not have been obvious (*see* Obviousness) to one of ordinary skill in the art, most often presented as a rebuttal to evidence and arguments of obviousness. Factors or types of such objective indicia include unexpected results, copying by others, expressed skepticism, commercial success, long felt but unsolved need, and failure of others. 35 U.S.C. § 103; *Graham v. John Deere Co*., 383 U.S. 1, 17–18 (1966). Objective indicia of non-obviousness are sometimes referred to by the term "secondary considerations."

Obviousness – to be patentable, a patent/application claim must be non-obvious over the prior art. 35 U.S.C. § 103; 35 U.S.C. § 102 (defining prior art); *see also KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) (discussing obviousness in depth). Non-obviousness or obviousness is considered from the perspective of a person of ordinary skill in the art (*see* Person of Ordinary Skill in the Art) as of the time of the invention, considering the prior art (prior art references may be considered individually or in combination) as of that time.

Office – the United States Patent and Trademark Office ("USPTO"). 37 C.F.R. § 42.2.

Parallel Petitions – two or more AIA petitions filed by the same petitioner against the same patent at or about the same time (i.e., less than 90 days apart and, e.g., before the first preliminary response by the patent owner). TPG at II.D.1.

Patent Trial and Appeal Board ("PTAB" or the "Board") – the USPTO tribunal created by the AIA, consisting of Administrative Patent Judges, that reviews patentability disputes in AIA Proceedings (and also decides *ex parte* appeals by patent applicants). 35 U.S.C. § 6.

Person of Ordinary Skill in the Art (also "POSITA" or "POSA") – refers to a hypothetical person who has ordinary knowledge, skills, and experience in a particular field or industry relating to the invention claimed in a patent/application, from whose perspective matters such as obviousness, the sufficiency of the written description, and the meaning of claim language are analyzed. 35 U.S.C. § 103; 35 U.S.C. § 112; *see also KSR*, 550 U.S. 398 (2007) (discussing obviousness); *Phillips*, 415 F.3d at 1312–13 (discussing claim construction); *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111 (Fed. Cir. 2004) (discussing claim construction and § 112).

Petition – refers to a formal request, in the form of a brief, to PTAB in an IPR or PGR proceeding, asserting with particularity and supporting evidence that at least one claim of an issued U.S. patent is unpatentable and requesting such

claim's cancellation by the USPTO. 37 C.F.R. §§ 42.2 ("petition" defined), 42.20–42.25 (requirements and content of petitions).

Post-Grant Review ("PGR") – an AIA proceeding where a third-party petitioner challenges the patentability of one or more claims in an issued U.S. patent at PTAB, based on any condition of patentability (*see* 35 U.S.C. §§ 101, 102, 103, 112), except best mode, to determine whether the challenged claims are unpatentable and should be cancelled. 35 U.S.C. § 321(b); *see also* 35 U.S.C. § 282(b) (identifying invalidity defenses available to a party accused of infringement).

Preliminary Response – after a petitioner files a petition and prior to PTAB deciding whether to institute trial, the patent owner may (but is not required to) file a response (a brief) setting forth the reasons why no IPR or PGR should be instituted; a patent owner can include supporting evidence. 37 C.F.R. §§ 42.107(a), 42.207(a).

Prior Art – refers to publicly known information prior to the effective filing date of a patent application or patent. *See* 35 U.S.C. § 102. Prior art can be patents, published patent applications, scientific papers, publications, or any public knowledge, including offers for sale of the invention, that could demonstrate a claimed invention is already in the public domain. Note, in IPRs, asserted prior art is limited to patents and printed publications (including published patent applications).

Priority – a patent's/application's claims may be accorded their actual filing date in the USPTO or an effective filing date earlier than their actual filing date based on a right of priority to an earlier filed U.S. provisional application, related U.S. patent application, PCT (Patent Cooperation Treaty) application, or foreign application. 35 U.S.C. §§ 100(i), 119, 120, 121, 365, 386. Whether the actual filing date or an earlier priority date is applied to a patent's/application's claims, that is the date at which the claims are compared to prior art (for anticipation or obviousness analysis), when the sufficiency of the written description is assessed (for written description or enablement purposes), and the date at which the hypothetical person of ordinary skill in the art is defined.

Protective Order – an order from the Board for the purpose of protecting the parties' or a third party's sensitive information, e.g., confidential information, during a proceeding by ensuring that only authorized people can access the information to avoid public disclosure. *See* 37 C.F.R. § 42.54(a); TPG at Part I.E. (*see* Confidential Information and Seal).

P-TACTS – acronym for Patent Trial and Appeal Case Tracking System, which is the USPTO's and PTAB's online system to file, manage, and track documents in AIA proceedings. 37 C.F.R. § 42.6(b); *see* www.uspto.gov/patents/ptab/about-p-tacts.

Real Parties in Interest – concerning AIA proceedings at a general level, the "real party in interest" is the party that desires review of the patent and may be the petitioner itself, and/or those at whose behest the petition has been filed or those in control over or funding a party's participation in a proceeding. 35 U.S.C. § 312(a)(2); 37 C.F.R. § 42.8; TPG at Part I.D. Real-party-in-interest issues are determined on a case-by-case basis. (*see* Mandatory Notices).

References – documents or publications that are evidence in a proceeding, often those asserted as prior art in challenging a patent's claims.

Related Matters – any other judicial or administrative matter that would affect, or be affected by, a decision in an AIA proceeding. Judicial matters include actions involving the patent in federal court, and administrative matters include every patent application and patent claiming, or which may claim, the benefit of the priority of the filing date of the party's involved patent or patent application as well as any *ex parte* and *inter partes* reexaminations for an involved patent. 37 C.F.R. § 42.8; TPG at Part I.D.2. (*see* Mandatory Notices).

Reply – a formal response (a brief) filed by a party to address issues or arguments raised by the opposing party in an immediately prior brief, to provide evidence or further explanation in support of one's position. TPG at Part II.I. Typically, a reply is filed by the party who filed the initial respective petition or motion, for example, a petitioner may file a reply to a patent owner response.

Response – in IPR and PGR proceedings, the patent owner may respond to the petition (and PTAB's institution decision) with a brief and supporting evidence once a trial has been instituted; this brief is called the patent owner response. 35 U.S.C. §§ 316(a)(8), 326(a)(8); 37 C.F.R. §§ 42.120, 42.220. (*see* Institution and Petition).

Seal – when necessary, PTAB maintains filings or information to be accessible to only certain parties or the Board, for example, if such information is confidential; such protected information is identified as being "under seal." 37 C.F.R. § 42.14; TPG at Part I.E.3.

Serial Petitions – multiple petitions filed by the same petitioner, challenging claims of the same patent, which are filed more than 90 days apart, i.e., after the time for the patent owner's preliminary response and/or PTAB's institution decision on the prior petition.

Service – the act of providing materials, e.g., papers or evidence, to the opposing party in an AIA proceeding. The rules require that parties to a proceeding provide service information as part of their mandatory notices (*see* Mandatory Notices). 37 C.F.R. § 42.8.

Specification – refers to the entire disclosure of a patent or patent application, including a written description of the invention, any drawings or figures, and the claims. 35 U.S.C. § 112. The written description portion is sometimes colloquially referred to as the specification.

Standing – whether a party is one legally permitted to bring a challenge in an AIA proceeding. For example, in an IPR, a person who is not the owner of a patent may file a petition to institute a review of the patent unless: (a) before the petition was filed, that petitioner or a real party in interest filed a civil action challenging the validity of a claim of the patent; (b) the petition was filed more than one year after the petitioner, the petitioner's real party in interest, or a privy of the petitioner was served with a complaint alleging infringement of the patent; or (c) the petitioner, the petitioner's real party in interest, or a privy of the petitioner is estopped from challenging the claims on the grounds identified in the petition. 35 U.S.C. §§ 311, 315; 37 C.F.R. § 42.101. In a PGR, a person who is not the owner of a patent may file a petition to institute a review of the patent unless: (a) before the petition was filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent; or (b) the petitioner, the petitioner's real party in interest, or a privy of the petitioner is estopped from challenging the claims on the grounds identified in the petition. 35 U.S.C. §§ 321, 325; 37 C.F.R. § 201.

Subject Matter Eligibility – the invention claimed in a patent application or patent must fall within the types of subject matter that can be patented: process, machine, manufacture, or composition of matter. 35 U.S.C. § 101. Abstract ideas (e.g., mathematical formulas), laws of nature, or natural phenomena are not considered patent-eligible. *Id.*; *see also Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208 (2014); *Ass'n for Molecular Pathology v. Myriad Genetics, Inc*., 569 U.S. 576 (2013); *Mayo Collaborative Servs. v. Prometheus Lab'ys, Inc.*, 566 U.S. 66 (2012).

Sur-reply – refers to a reply (brief) filed in response to a reply (*see* Reply). TPG at Part II.I. Typically, a sur-reply is filed by the party who originally filed the respective response or opposition to a motion, but subsequently needs to address new points or new arguments raised by the opposing side in their reply. For example, a patent owner may file a sur-reply to a petitioner's reply to a patent owner response to a petition.

Time Barred – a legal action or proceeding, such as a filing of a patent challenge with, or appealing a decision of, the PTAB, may be precluded because a certain deadline has passed. 35 U.S.C. § 315(b); 35 U.S.C. § 321(c). For example, in an IPR, a petitioner may not file a petition more than one year after they, or their real party in interest or privy, was served with a complaint alleging infringement of the challenged patent (35 U.S.C. § 315(b)), and in a PGR, a petition may only be filed within 9 months from the date of the grant of the challenged patent (or of the issuance of a reissue patent) (35 U.S.C. § 321(c)).

Trial Practice Guide (TPG) – PTAB's publicly accessible practice guide that explains the standard practices before the Board during AIA proceedings (available at www.uspto.gov/patents/ptab/trial-practice-guide).

Written Description – the portion of a patent's/patent application's specification describing the claimed invention in writing. For a patent/application claim to be patentable, the specification of that patent/application must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention at the time of filing. 35 U.S.C. § 112(a); *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

USPTO – the United States Patent and Trademark Office (the Office), which is the federal agency responsible for granting patents and registering trademarks. PTAB is a part of the USPTO.

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