

Office of Patent Quality Assurance *Inter Partes* Review (IPR) Study - Practice Tips

Patent applicants

- Patent applicants, who are most familiar with the field of the invention, are in the best position to identify and highlight relevant prior art
- Before filing/drafting the application and during prosecution, applicants should consider:
 - Conducting prior art searches and analyzing relevant art carefully
 - Expressly discussing the most relevant art with the examiner and taking steps to ensure clarity and completeness of the prosecution record
- Applicants may wish to help insulate their patent from a possible challenge at the USPTO later:
 - Under 35 U.S.C. 325(d), institution of an IPR may be denied if “the same or substantially the same prior art or arguments previously were presented to the [USPTO]”

Patent owners

- IPR challenges are rare but are more likely when a patent is asserted in a patent infringement lawsuit
- If an IPR challenge happens, it is usually many years after prosecution has concluded
- Before asserting a patent, patent owners may wish to consider:
 - Conducting prior art searches and related analysis
 - As needed, conducting further prosecution to ensure they have the desired claim scope
 - Patent owners may file a reissue application or a request for reexamination before, during, or after an America Invents Act proceeding, as long as it is timely filed
 - See the Federal Register Notice regarding options for amendments through reissue and reexamination, [84 FR 16654](#) (April 22, 2019)