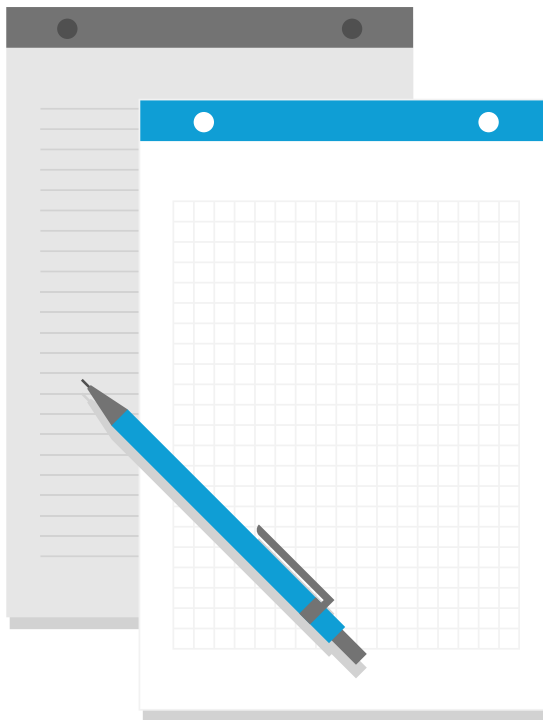


Post-Grant Patent Opposition



Part One

Constitution & Law

The Basis for Patents and
Patent Administration in the
Constitution and Statute

CONSTITUTIONAL FOUNDATIONS: Patent Rights

[The Congress shall have Power . . .] To promote the Progress of Science and useful Arts, by securing for limited Times to **Authors** and **Inventors** the exclusive Right to their respective **Writings** and **Discoveries**.

U.S. Constitution

Article One, Section Eight, Clause Eight

STATUTORY BASIS:

U.S. Patent & Trademark Office

PART I—UNITED STATES PATENT AND TRADEMARK OFFICE (§§ 1 – 42)

PART II—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS (§§ 100 – 212)

PART III—PATENTS AND PROTECTION OF PATENT RIGHTS (§§ 251 – 329)

PART IV—PATENT COOPERATION TREATY (§§ 351 – 376)

PART V—THE HAGUE AGREEMENT CONCERNING INTERNATIONAL
REGISTRATION OF INDUSTRIAL DESIGNS (§§ 381 – 390)

United States Code

Title 35

STATUTORY BASIS:

U.S. Patent & Trademark Office

CHAPTER 1—ESTABLISHMENT, OFFICERS AND EMPLOYEES, FUNCTIONS (§§ 1 – 14)

CHAPTER 2—PROCEEDINGS IN THE PATENT AND TRADEMARK OFFICE (§§ 21 – 28)

CHAPTER 3—PRACTICE BEFORE PATENT AND TRADEMARK OFFICE (§§ 31 – 33)

CHAPTER 4—PATENT FEES; FUNDING; SEARCH SYSTEMS (§§ 41 – 42)

United States Code

Title 35

Patent Application

When a patent application is filed with the **U.S. Patent & Trademark Office**, “there are a number of legal requirements that must be met, including *novelty* (35 U.S.C. 102), *utility* and *eligibility* (35 U.S.C. 101), *non-obviousness* (35 U.S.C. 103), and *written description* (35 U.S.C. 112)...”

U.S. Patent & Trademark Office

“Patent Process Overview”

Patent Examination

A patent examiner, “review[s] the contents of the application to determine if it meets all legal requirements for a patent to be granted. The examination consists of a study for compliance with legal requirements... and a search through U.S. patents, publications of patent applications, foreign patent documents, and available literature.”

“This is to see if the claimed invention is new, useful, and non-obvious, and if the application meets patent statute requirements and rules of practice.”

U.S. Patent & Trademark Office

“Patent Process Overview”

Patent Grant

Criteria for Patent Grant

Eligibility: Does the claimed invention or discovery fit the statutory definition of a new and useful *process, machine, manufacture or composition of matter*, and avoid judicial carve-outs?

Patentability: Has the claimed invention or discovery been shown to be *new, useful*, and *non-obvious* to a “Person of Ordinary Skill in the Art” (POSA)?

Enablement: Was the invention adequately described in the application such that the POSA could follow the steps to re-create the invention?

Part Two

Post-Grant Opposition To Patents

Why • When • Where

Post-Grant: Patent Opposition

The Examiner Got It Wrong

- Misconstrued the facts

The Patent Owner Misrepresented the Facts

- Failed to appropriately present all relevant facts to the examiner

Additional Prior Art Found/Established

- New evidence shows the invention was not novel

CONSEQUENCE: The Patent Should Not Have Been Granted

STATUTORY BASIS:

Patent Opposition

CHAPTER 10—PATENTABILITY OF INVENTIONS (§§ 100 – 105)

CHAPTER 11—APPLICATION FOR PATENT (§§ 111 – 123)

CHAPTER 12—EXAMINATION OF APPLICATION (§§ – 135)

**CHAPTER 13—REVIEW OF PATENT AND TRADEMARK OFFICE
DECISIONS (§§ 141 – 146)**

United States Code

Title 35

STATUTORY BASIS: Burden of Proof

(a) In General.—

A patent shall be **presumed valid**. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. The **burden of establishing invalidity** of a patent or any claim thereof shall rest on the **party asserting such invalidity**.

United States Code

Title 35 § 282 - **Presumption of validity**; defenses

The presumption of validity does not apply in PTAB Inter Partes Review proceedings.

STATUTORY BASIS: Grounds for Challenge

(b) **Defenses**.—The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

- (1) Noninfringement, absence of liability for infringement or unenforceability.
- (2) **Invalidity of the patent** or any claim in suit on any ground specified in part II as a **condition for patentability**.
- (3) Invalidity of the patent or any claim in suit for failure to comply with—
 - (A) any **requirement of section 112**, except that the failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable; or
 - (B) any requirement of section 251.
- (4) Any other fact or act made a defense by this title.

United States Code

Title 35 § 282 - Presumption of validity; **defenses**

Post-Grant Patent Opposition: Why?

Defense

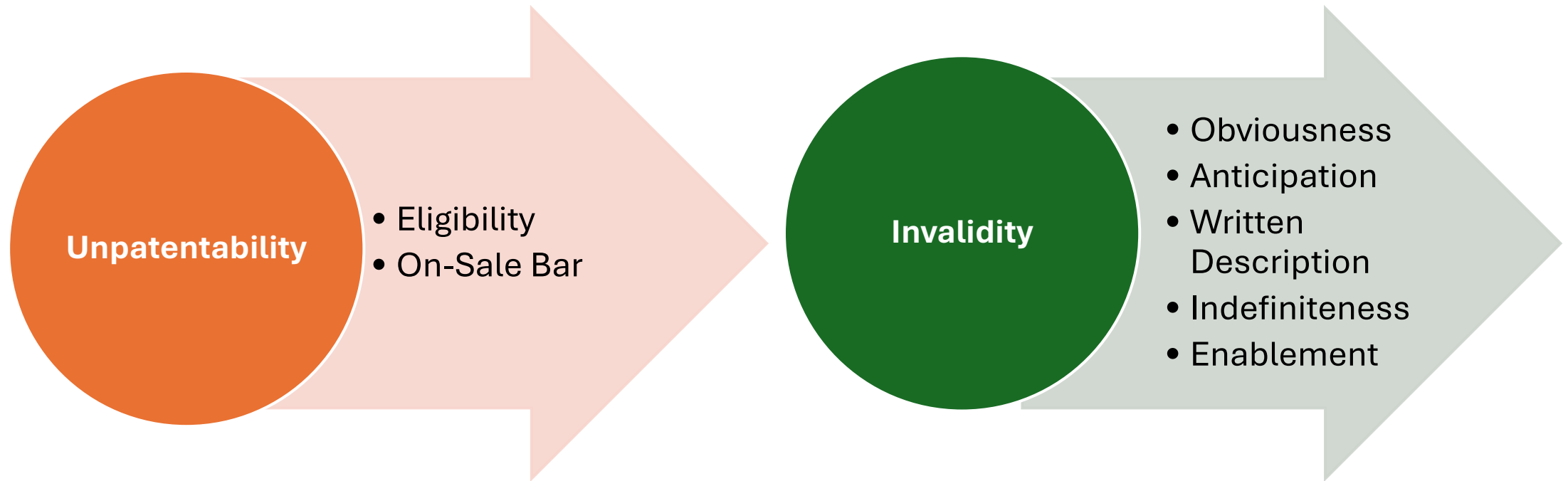
A party may challenge a patent as a defense against accusations of patent infringement.

Offense

A party may proactively challenge a patent to secure freedom to operate in the space claimed by the patent.

Post-Grant Patent Opposition:

When? Grounds for Revoking a Granted Patent



Post-Grant Patent Opposition: **Where?** Options for Challenging a Patent



Judicial:
District Court
Litigation

OR



Administrative:
USPTO Patent Trial
and Appeal Board



Appeals:
Court of Appeals for the
Federal Circuit

Part Three

Post-Grant Opposition to Patents in the AIA Era

Post-Grant Opposition to Patents in the AIA Era

Track One:

Litigation at the
Federal District
Courts

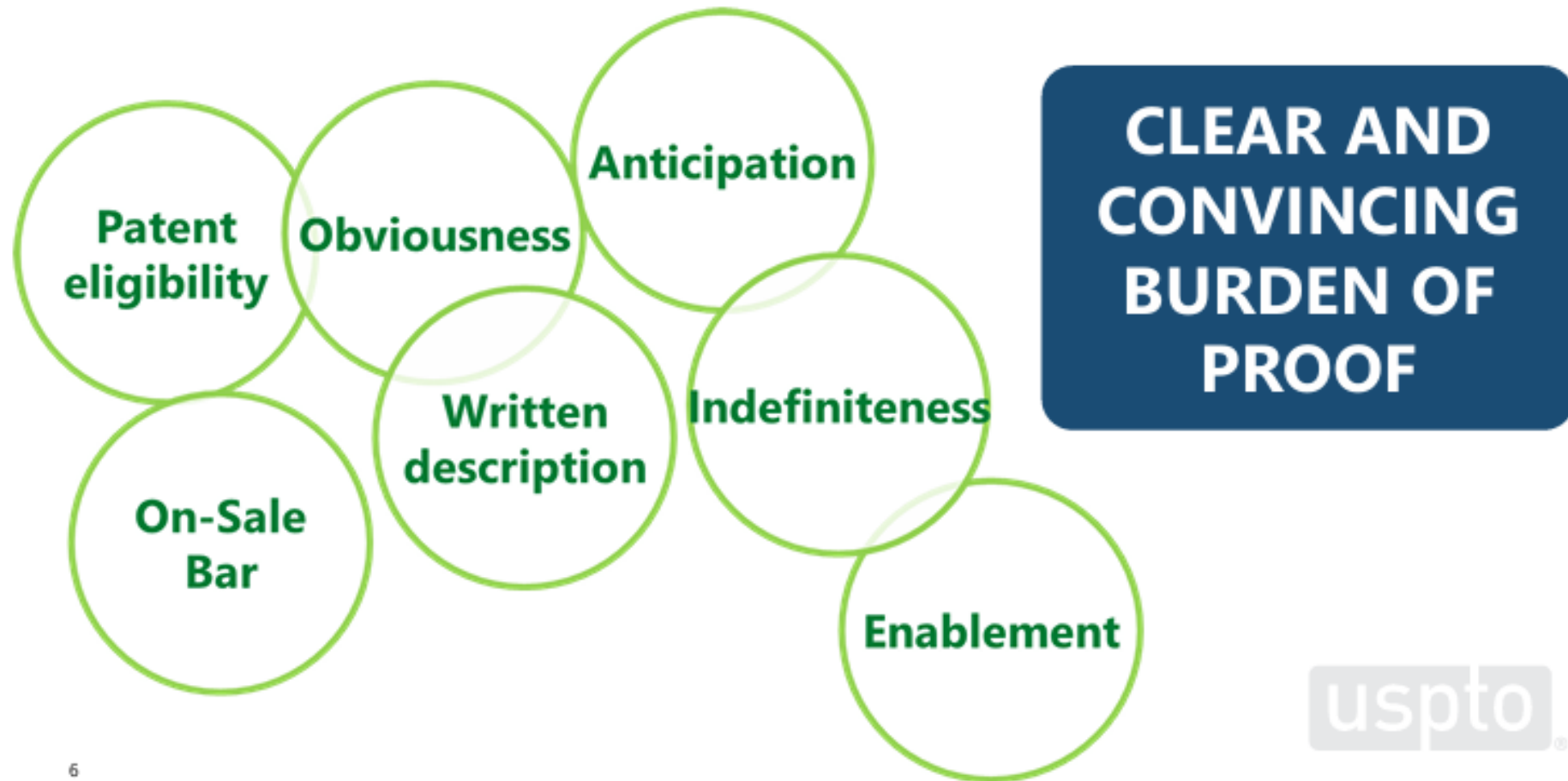
Origins of District Court Patent Jurisdiction

(a)The district courts shall have **original jurisdiction** of any civil action arising under any Act of Congress **relating to patents**, plant variety protection, copyrights and trademarks. No State court shall have jurisdiction over any claim for relief arising under any Act of Congress relating to patents, plant variety protection, or copyrights.

28 U.S. Code § 1400

(codified June 25, 1948, ch. 646, 62 Stat. 931)

U.S. District Courts: Invalidity



Post-Grant Opposition to Patents in the AIA Era

Track Two:

Patent Trial and
Appeal Board
(PTAB) Petitions
and Trials

Effects of 2011 America Invents Act

Established the PTAB and its 3 principal review procedures:

- inter partes review (IPR)
- covered business method review
- post-grant review (PGR)

Ex Parte reexamination remained in place

Established supplemental examination as expedited procedure for USPTO to consider, reconsider or correct information believed to be relevant to the patent

Added derivation proceeding for determining whether a patent application “derived” a claimed invention from another person or persons and whether it was therefore patentable by that applicant

Established covered business method review
(expired in September 2020)

Central Re-examination Unit (CRU) remained in place; now handles patent reissuance, ex parte reexamination, and supplemental examination

Patent Trial and Appeal Board: PTAB

The America Invents Act (AIA, 2011) created the PTAB as a tribunal within the United States Patent and Trademark Office (USPTO) to decide patentability questions for issued patents raised by third parties. The PTAB conducts trials, including *inter partes* and *post-grant* reviews.



STATUTORY BASIS:

Patent Trial and Appeal Board (PTAB)

§ 1. Establishment

§ 2. Powers and duties

§ 3. Officers and employees

§ 4. Restrictions on officers and employees as to interest in patents

§ 5. Patent and Trademark Office Public Advisory Committees

§ 6. Patent Trial and Appeal Board

United States Code

Title 35

STATUTORY BASIS:

Composition of PTAB

(a) In General.—

There shall be in the Office a **Patent Trial and Appeal Board**. The Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Patent Trial and Appeal Board. The administrative patent judges shall be persons of competent legal knowledge and scientific ability...

United States Code

Title 35

STATUTORY BASIS:

Duties of PTAB

(b) Duties.—The Patent Trial and Appeal Board shall—

- (1) ...review adverse decisions of examiners upon applications for patents...;
- (2) review appeals of reexaminations...;
- (3) conduct derivation proceedings...; and
- (4) conduct inter partes reviews and post-grant reviews pursuant to chapters 31 and 32.

United States Code

Title 35

STATUTORY BASIS:

Administrative Patent Opposition

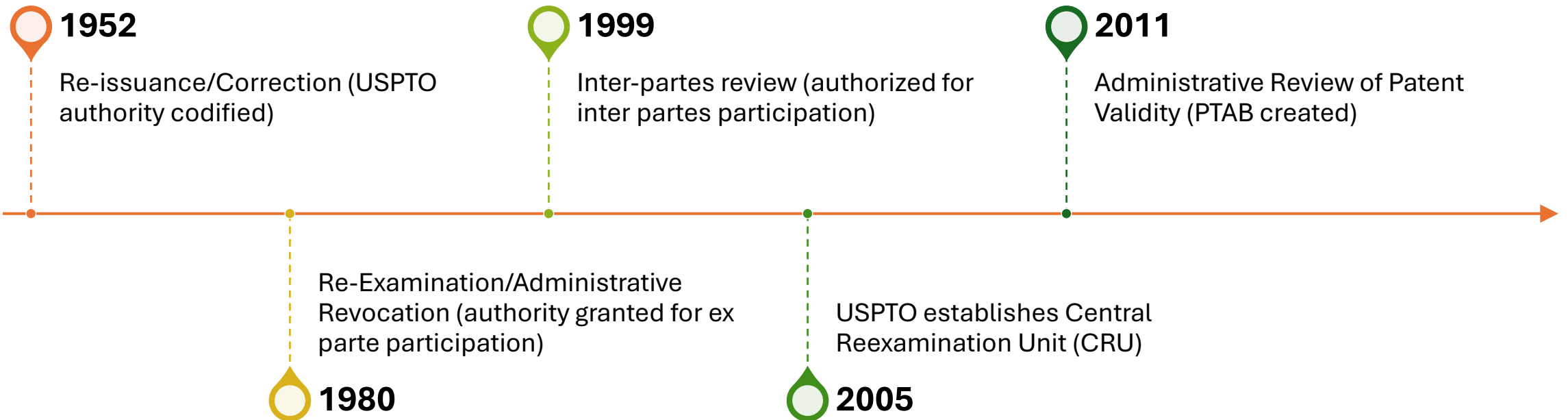
CHAPTER 31—INTER PARTES REVIEW (§§ 311 – 319)

CHAPTER 32—POST-GRANT REVIEW (§§ 321 – 329)

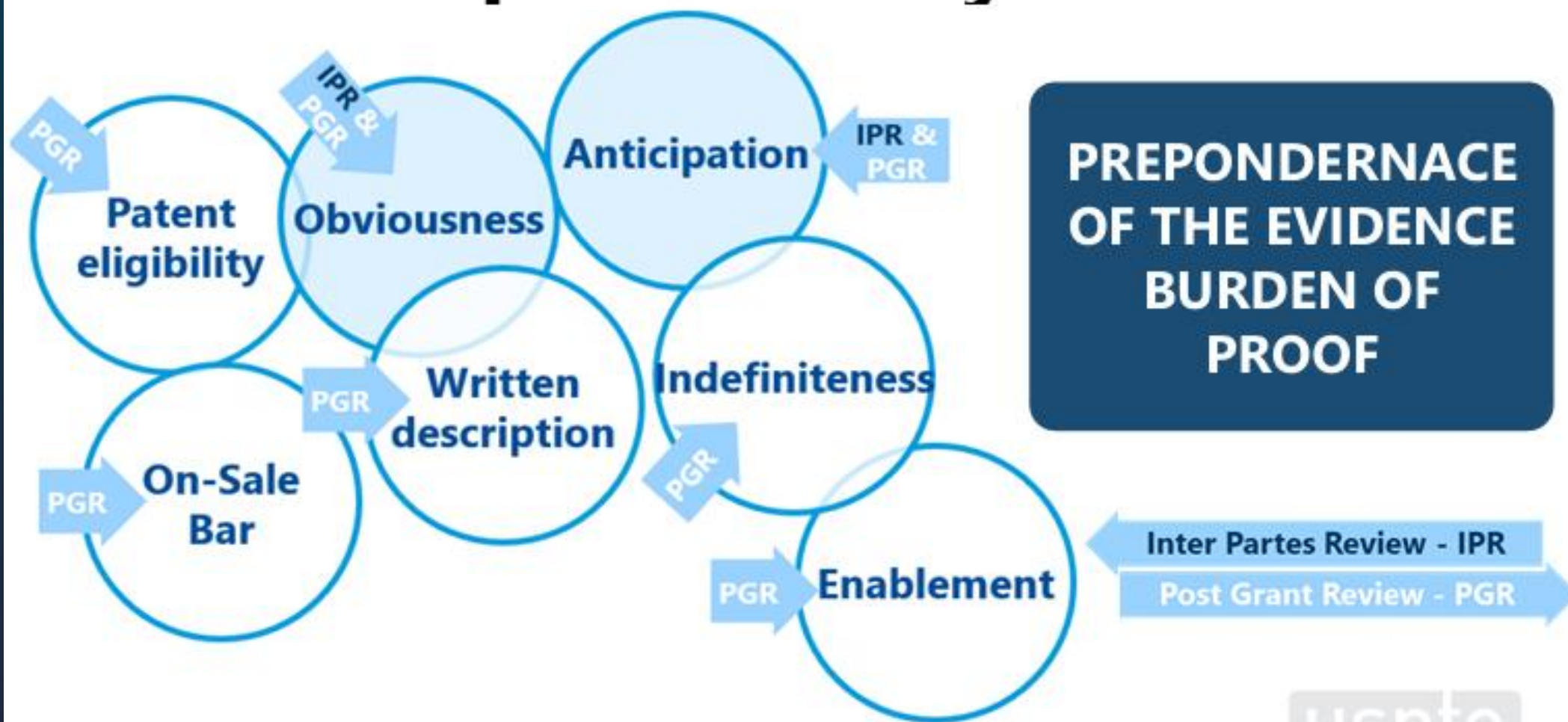
United States Code

Title 35

History of Administrative Patent Review



PTAB: Unpatentability



Inter Partes Review (IPR)

(a)In General.—

Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent. The Director shall establish, by regulation, fees to be paid by the person requesting the review, in such amounts as the Director determines to be reasonable, considering the aggregate costs of the review.

(b)Scope.—

A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.

United States Code

Title 35 § 311 - Inter partes review

Inter Partes Review (IPR)

Inter partes review is a trial proceeding conducted at the Board to review the **patentability** of one or more claims in a patent only on a ground that could be raised **under §§ 102 or 103**, and **only on the basis of prior art** consisting of patents or printed publications. For first-inventor-to-file patents, inter partes review process begins with a third party (a person who is not the owner of the patent) filing a petition after the later of either: (1) 9 months after the grant of the patent or issuance of a reissue patent; or (2) if a post grant review is instituted, the termination of the post grant review. These deadlines do not apply to first-to-invent patents (pre-2011).

Source: USPTO

Post-Grant Review (PGR)

(a)In General.—

Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute a post-grant review of the patent. The Director shall establish, by regulation, fees to be paid by the person requesting the review, in such amounts as the Director determines to be reasonable, considering the aggregate costs of the post-grant review.

(b)Scope.—

A petitioner in a post-grant review may request to cancel as unpatentable 1 or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of section 282(b) (relating to invalidity of the patent or any claim).

United States Code

Title 35 § 321 - Post-grant review

Post-Grant Review (PGR)

Post grant review is a trial proceeding conducted at the Board to review the **patentability** of one or more claims in a patent on any ground that could be raised under **§ 282(b)(2) or (3)**. (i.e., eligibility, novelty, utility, non-obviousness, or completeness of written description)

A post grant review may be instituted upon a showing that, it is more likely than not that at least one claim challenged is unpatentable.

Source: USPTO

Sequencing of PTAB Proceedings

- PGRs must be filed within **nine months** of patent issuance
- May challenge validity on any grounds



- IPRs can be filed at anytime beginning **nine months** after patent issuance
- Only challenge on grounds of novelty or non-obviousness
- Only challenge on the basis of prior art in patents or printed publications



Institution Thresholds

- For IPRs, the threshold is “**a reasonable likelihood** that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”
- For PGRs, the threshold is “**more likely than not** that at least 1 of the claims challenged in the petition is unpatentable.”

Post-Grant
Opposition
to Patents
in the
AIA Era

PTAB and the
District Courts:

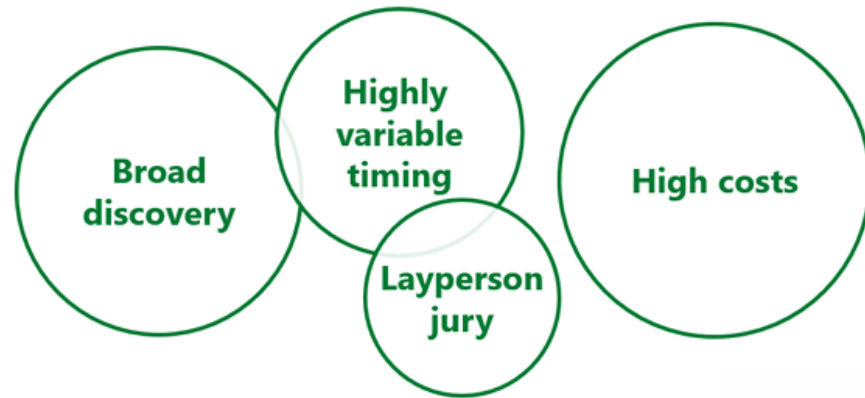
Parallel Tracks

Bifurcated: Two-Track System

AIA-created overlap between District Courts and PTAB:

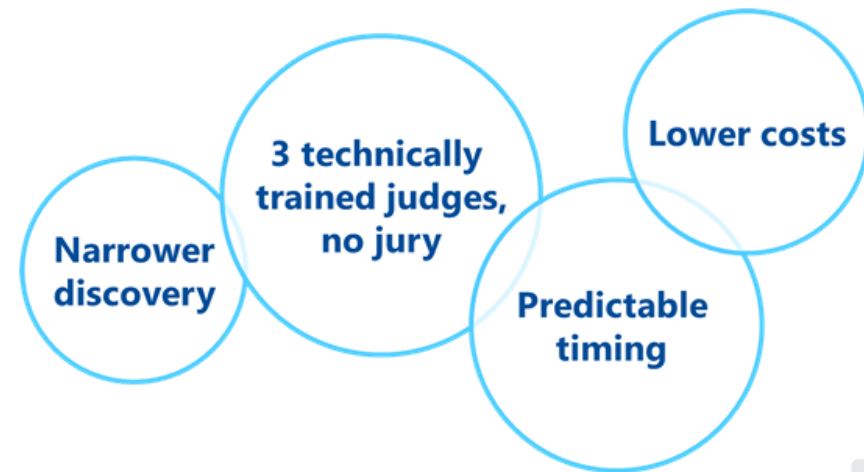
- (1) U.S. **district courts** adjudicate patent infringement actions and resolve invalidity disputes;
- (2) **USPTO** Patent Trial and Appeal Board (**PTAB**) reviews patent validity.

U.S. District Courts: Issues of Note



uspto

PTAB: Issues of note



uspto



Duplication?

“U.S. patent litigation often entails parallel proceedings with parties seeking to take advantage of the distinctive characteristics of different dispute resolution fora. The copendency of litigation involving the same patent can result in the **duplicative** expenditure of judicial resources and impose unnecessary burdens on parties.”

- **World Intellectual Property Organization**



Key Differences: Standing

A “case or controversy” is required at Federal District Courts. This principle in the legal system stipulates that courts should only hear and decide cases in which there is an actual dispute between parties.

No “case or controversy” or parties in dispute is required at the PTAB. Instead, there is a petition phase and a trial phase.

Key Differences: Evidentiary Standard

- District Court - **Clear and convincing evidence** standard for invalidating patent claims
- PTAB - **Preponderance of the evidence** standard for invalidating patent claims.

Key Differences: Remedies

District Courts:

- Invalidation of patent claims
- Monetary relief available
- Attorney fees and costs potentially available
- Injunctive relief subject to equitable balancing

PTAB:

- Invalidation of patent claims
- No monetary relief

Part Four

Court of Appeals for the Federal Circuit

STATUTORY BASIS:

Final Appeal

§ 141. Appeal to Court of Appeals for the Federal Circuit

§ 142. Notice of appeal

§ 143. Proceedings on appeal

§ 144. Decision on appeal

§ 145. Civil action to obtain patent

§ 146. Civil action in case of derivation proceeding

United States Code

Title 35

Federal Circuit Court of Appeals

Patent Jurisdiction

“The U.S. Court of Appeals for the Federal Circuit (CAFC) has nation-wide jurisdiction over certain disputes that involve the Federal government including intellectual property, international trade, government contracts, and federal employee benefits. The court can hear appeals related to its subject matter from all the district courts, the Court of International Trade, administrative agencies like the Patent and Trademark Office, and many other government decision making bodies.”

Source: Cornell Law School, Legal Information Institute

Court of Appeals for the Federal Circuit

Where the PTAB and
District Court Tracks
Collide

Appeal of PTAB Decisions

(c) Post-Grant and Inter Partes Reviews.—

A party to an inter partes review or a post-grant review who is dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) or 328(a) (as the case may be) may appeal the Board's decision only to the United States Court of Appeals for the Federal Circuit.

United States Code

Title 35 § 141

Review of Decisions

District Court:

- No administrative agency review
- Federal Circuit appeal

PTAB:

- USPTO Director may review all PTAB decisions
- Decisions of the PTAB can be appealed to the Federal Circuit
- USPTO may intervene in Federal Circuit appeal to defend its decision

- World Intellectual Property Organization

Review of Decisions

Standard of Review

District Court:

- Hybrid standard of review of claim construction determinations (factual determinations underlying claim construction rulings are subject to the “clearly erroneous” (or “abuse of discretion”) standard of review, while the Federal Circuit exercises de novo review over the ultimate claim construction determination)

PTAB:

- Reviewed under standards of the APA

BOTH:

- Substantial evidence or “clearly erroneous” standard for factual determinations/Substantial evidence standard for factual determinations
- De novo review for legal determinations/De novo review for the PTAB’s legal conclusions.

- **World Intellectual Property Organization**

Part Five

Issues Raised by Pending Legislation



Key Issues Raised in Legislation

- **Standing** to bring patent challenges;
- **Divergences** in burden of proof and evidentiary standards between federal district court and PTAB;
- **Double jeopardy** considerations raised by redundant petitions challenging the same patent at the PTAB;
- **Duplication** of patent challenges at the PTAB and in district court;
- **Transparency** of USPTO director decisions and influence on PTAB rulings.

Primary Resources:

U.S. Patent & Trademark Office, Public Engagement Partnership Meeting Series, Introduction to patent challenge processes before PTAB, September 24, 2024

(<https://www.uspto.gov/sites/default/files/documents/PTAB-pub-engage-slides-9-6-24.pdf>)

World Intellectual Property Organization, An International Guide to Patent Case Management for Judges - <https://www.wipo.int/patent-judicial-guide/en/full-guide/united-states>

Cornell Law School, Legal Information Institute

- Title 35, United States Code (<https://www.law.cornell.edu/uscode/text/35>);
- Wex legal encyclopedia
(https://www.law.cornell.edu/wex/u.s._court_of_appeals_for_the_federal_circuit)