

Post Grant Proceedings: Focused Update with Practical Advice

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Overview (emphasis on IPRs)

- Availability
- Petition
- Response
- Discovery
 - Protective Order
 - Depositions

Dead-zone Eliminated for First-to-Invent Patents

- Before had to wait 9 months before could file petition for IPR (inter partes review).
 - But PGRs (post-grant reviews) are unavailable for first-to-invent patents. *Umbrella Trial Rules* at 48687.
 - Thus, might have had to wait 9 months to do a post-grant proceeding.
- Now IPR is available upon grant of patent.
 - Without wait for 9 months. 37 CFR § 42.102(a)(2).

IPR's Advantage over PGR

- For PGR, a federal court cannot stay its consideration of a motion for preliminary injunction, if the patent owner:
 - Sues for infringement within 3 months of the patent's issue, and
 - Moves for a preliminary injunction. 35 USC § 325(b).
- For IPR, no such statutory provision.

Dec Action Precludes IPR?

- Not if a party sued patent owner only for declaratory judgment of non-infringement.
 - Not for invalidity.
- In the litigation, that party can then raise the affirmative defense of invalidity.
- Party would not be precluded from also filing an IPR. *Ariosa Diagnostics v. Isis Innovation*, IPR2012-00022, Paper 20 at 6-9 (Feb. 2, 2013).

Join Own Petition after Deadline

- File 1st IPR within 1-year deadline.
- File 2nd IPR.
 - Even if post 1-year deadline,
 - As long as file IPR within 1 month of the Board's (PTAB) instituting the 1st IPR.
 - *Microsoft v. Proxyconn*, No. IPR2013-00109, Paper 15 at 4 (Feb. 25, 2013).

Join Another's Review Effortlessly

- File identical petition to join another's already instituted trial. *NetApp v. PersonalWeb*, IPR2013-00319, Paper 18 at 9.
 - Evaluate if should join.
 - Identical petition should not impact schedule.
 - Original petitioner files consolidated responses.
 - *Motorola Mobility v. Softview*, IPR2013-00256, Paper 10 at 9 (June 20, 2013).
 - Maintain settlement pressure even if original petitioner settles out.
 - Lose pressure if fail to join.
 - *Apple v. Grobler*, IPR2014-00060, Paper 12 (Oct. 29, 2013).

The Petition

- Construe claim terms likely to be at issue.
 - Chance to sway the Board.
 - For means-plus-function terms, identify corresponding structure.
 - In IPR, cannot argue that corresponding structure is missing because indefiniteness arguments are unavailable. 35 U.S.C. § 311(b).

Claim Charts

- Board discourages use of claim charts.
 - “Claim charts are not sufficient by themselves, they must be explained.” *PTO AIA 2nd Anniversary Forum*, Slide 180, (Sept. 16, 2013).
 - “Extensive usage of claim charts in a petition is discouraged.” *PTO FAQs*, Filing a Petition, D12 at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>.
- Omit charts.
 - If really think chart would be helpful to the Board, perhaps expert can include a chart with declaration.

Selectivity & Thoroughness

- Identify best prior art and take care to explain the invalidity arguments.
 - Space is limited.
 - Sixty pages, double spaced, 14-point font, 1-inch margins.
 - If petitioner fails to chose best prior art, the Board may chose and decide which prior art is strongest.
 - Board may reject the rest as redundant.

Redundancy

- Horizontal redundancy
 - distinct and separate alternatives without explanation of relative strength.
- Vertical redundancy
 - combinations of prior art without explanation of relative strength.
 - http://www.uspto.gov/blog/aia/entry/message_from_michael_tierney_lead, Representative Order discussing redundancy grounds (see *CBM2012-00003, Order (Redundant Grounds), Paper 7*, Oct. 25, 2012).

Avoiding Potential Estoppel?

- Not including all grounds may create estoppel against later use of omitted grounds. 35 U.S.C. § 315(e).
 - Petitioners still figuring out approach.
 - Consider separating grounds into multiple petitions and requesting that Board combine.

Basic Service

- Rule: serve petition on patent owner at correspondence address of record for the patent. 37 C.F.R. § 42.105(a).
 - Service is proper even if not on patent owner but only on party listed at correspondence address of record. *Blackberry v. NXP*, IPR2013-00232, Paper 9 at 7 (Sept. 30, 2013).

Preliminary Response

- Do submit preliminary response to petition. 37
CFR § 42.107.
 - This is an opportunity:
 - To sway Board on claim construction, and
 - To reduce the number of grounds that Board may adopt.

Claim Amendments

- By due date of response, patent owner can propose claim amendments. 37 CFR § 42.121(a)(1).
- But this is NOT patent prosecution.
 - Can only cancel or substitute claims. 37 C.F.R. § 42.121(a)(3).
 - Must distinguish over prior art of record and known to patent owner.
 - Conclusory statements on prior art and written description are unacceptable.
 - Consider supporting amendments with expert declaration.
 - *Idle Free Systems v. Bergstrom*, IPR 2012-000027, Paper 26 at 7 (June 11, 2013); *Nichia v. Emcore*, IPR2012-00005, Paper 27 at 4 (June 3, 2013).

One Substitute Claim

- The burden is on patent owner to show that more than one substitute claim is needed. 37 CFR § 42.121(a)(3).
 - Amending independent claim does not justify, without more, amending dependent claims.
 - Need meaningful reasons. *Idle Free Systems* at 9.

Limited Discovery

- Do not expect to get or defend against broad & expensive & time consuming discovery.
- Discovery in post grant proceedings is limited.
 - Not litigation-style fishing expedition.
 - Mere possibility of discovering something useful does not meet interest of justice standard in IPRs.
 - *Garmin v. Cuozzo*, Case IPR2012-00001, Paper No. 26 at 4-6 (PTAB March 5, 2013).

Protective Order

- Tailor protective order to Board proceeding.
 - Cannot assume that litigation’s protective order fits post grant proceeding.
 - *CRS Advanced Tech. v. Frontline Tech.*, CBM2012-00005, Paper 43 at 4 (May 28, 2013).
- Conversely, do not assume that litigation’s protective order addresses post grant proceedings.
 - consider if need a post-grant bar akin to a prosecution bar.

Deposition

- Scope of deposition (cross-examination) is limited to scope of affidavit. 37 CFR §42.53(a),(d)(5)(ii).
 - Questions about denied grounds are within scope, if they go to the credibility or state of the art.
 - *Micron v. Board of Trustees of U. of Illinois*, IPR2013-00005, Paper 22 at sheet no. 4 (April 15, 2013).
 - But see *ZTE v. Contentguard*, IPR2013-00133, Paper 30 at 2-3 (Oct. 9, 2013)(Board limited cross-exam to instituted grounds).

Deposition

- Don't instruct witness not to answer, even if the question is beyond scope.
 - Call the Board during deposition or move to exclude testimony after deposition.
 - *Corning v. DSM IP Assets*, IPR2013-00043, Paper 31 at 2-3 (July 8, 2013).

Conclusion

- Board's formal and informal guidance is evolving.
- Availability of IPR is greater than might think.
- Figure out way to focus petition.
 - Watch for ways to reduce potential estoppel.
- Do preliminary response.
- Focus on important discovery; not quantity.
 - Resist broad discovery.