

New U.S. Patent Office Trials To Challenge U.S. Patents

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On September 16, 2012, *inter partes* review proceedings became available against U.S. patents and post-grant review proceedings became available against certain U.S. business method patents. In two weeks, seventeen petitions for *inter partes* review [have been filed](#) and eight petitions for [post-grant review](#) have been filed. This article takes a brief look at these new proceedings.

Inter Partes Review

While similar in principle to *inter partes* reexamination (which is no longer available), *inter partes* review is different in many significant respects. Like *inter partes* reexamination, *inter partes* review offers a way to challenge a granted U.S. patent based on print publications in a Patent Office proceeding. However, *inter partes* review is conducted by the USPTO Board of Patent Trials and Appeals, not by an examiner. The patent owner has a limited opportunity to amend (narrow) the claims, and the parties can obtain limited discovery. By statute, *inter partes* review proceedings are to be completed within one year, and the Board's decision may be appealed directly to the U.S. Court of Appeals for the Federal Circuit. Parties can terminate an *inter partes* review by settlement agreement, but any final decision rendered by the Board gives rise to estoppel against the petitioner that applies to subsequent Patent Office and court proceedings.

Who Has Filed IPR Petitions?

Robert Sterne of Sterne, Kessler, Goldstein & Fox filed four of the seventeen petitions for *inter partes* review, all on behalf of Intellectual Ventures Management, LLC. My colleague [Matthew Smith](#) has filed three petitions, each on behalf of different parties.

Six petitions have been filed against patents examined in Technology Center 2800 (Semiconductors, Electrical and Optical Systems and Components), three against patents examined in Technology Center 2100 (Computer Architecture, Software, and Information Security), and three against patents examined in Technology Center 1600 (Biotechnology and Organic Chemistry).

Post-Grant Review

Post-grant review is completely new to the U.S. patent system, and permits patent challenges on any grounds for patentability (including patent-eligibility, enablement and written description). All patents examined under the first-to-file laws which take effect on March 16, 2013 will be subject to post-grant review within 9 months of grant. Until then, only "certain business method patents" can be challenged in a post-grant review proceeding, and only by a petitioner who has been charged with infringement. Like *inter partes* review, post-grant review is conducted by the Board, in accordance with similar procedures.

Who Has Filed PGR Petitions?

J. Steven Baughman of Ropes & Gray LLP has filed five post-grant review petitions, all on behalf of Liberty Mutual Insurance Company. Probably due to page limits, two patents were challenged in two petitions each.

Looking Ahead

Now that the initial rush of filings has been made, it will be interesting to see how popular these new proceedings are. With *inter partes* review and post-grant review documents readily accessible through the [Patent Trial and Appeal Board portal](#), practitioners and stakeholders can watch the proceedings progress, and see how the USPTO implements the new laws and applies the new rules on a case-by-case basis. Moreover, the twelve-month statutory time period for completing these proceedings promises to yield final decisions in a relatively short time period, further building a body of examples to draw from. No doubt these first cases will be followed closely as we assess the potential risks and advantages of these new patent trial proceedings.