

# BOND

## PATENT POST-ISSUANCE PRACTICE

Patent practice before the U.S. Patent and Trademark Office (PTO) does not end at issuance of a patent. Post-issuance procedures are available for parties to challenge the validity of issued patents before the Patent Trial and Appeal Board (PTAB), as well as for patent owners to strengthen or correct the scope of an issued patent. These complex proceedings require an in-depth knowledge of patent office rules and procedures.

### Alternative to Patent Litigation

Parties involved in high-value patent disputes are increasingly utilizing post-grant proceedings before the PTO, including *inter partes* review, post-grant review, and *ex parte* reexamination, to challenge the validity of issued patents. Such proceedings can avoid or defer district court litigation, and provide a strategic, cost-effective alternative. Various post-grant options provide a faster path for a validity challenge, utilize the technical patent knowledge of the judges at the PTAB and provide a lower burden of proof for invalidation than in federal court. While these procedures provide advantages to challenging validity of issued patents, patent owners must also be prepared to face such challenges when attempting to enforce their patent rights.

### Identifying the Correct Path

Post-grant proceedings come in different flavors, including *inter partes* review, post grant review, and *ex parte* reexamination. Bond's IP attorneys have an in-depth understanding of the various procedures that can inform the client's decision with respect to whether to use post-grant proceedings, and which proceeding is appropriate.

### Inter Partes Review (IPR)

IPRs are truncated trials challenging the validity of issued patents (except those available for post grant review) based on prior art patents and printed publications. An IPR petitioner need not have been sued on the patent or threatened with suit to file an IPR petition, however, there is a one year deadline after service of a patent infringement complaint to file a petition with the PTAB. An IPR trial is instituted when the PTAB determines that a petition demonstrates a "reasonable likelihood" of invalidating at least one claim. The patent owner has an opportunity to respond to the allegations, including optionally amending the patent's claims. The IPR trial, once instituted, must be concluded within one year.

### Post-Grant Review (PGR)

PGRs apply only to patents issuing from applications filed on or after March 16, 2013, and can only be filed during the first nine months after issuance. While PGRs are procedurally similar to IPRs, the petitioner can advance a challenge on any basis of unpatentability and is not limited to prior art challenges. A PGR may be instituted upon a showing that it

### About Bond, Schoeneck & King

Bond, Schoeneck & King PLLC serves individuals, companies and public-sector entities in a broad range of areas.

With 250 lawyers and 13 offices, we represent clients in manufacturing; agribusiness; commercial lending and real estate and construction; energy; health care and long term care as well as municipalities, school districts, higher education and other exempt and nonprofit organizations. We maintain nine offices across New York; and one each in Boston; Kansas City; Naples, Florida and Red Bank, New Jersey.

Bond is committed to understanding our clients' needs and providing comprehensive, practical, high-quality and responsive solutions. We strive to maintain the highest professional and ethical standards, and to provide leadership in community activities, pro-bono work and service to the Bar.

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is “more likely than not” that at least one challenged claim is unpatentable. Similar to IPR, the patent owner has an opportunity to respond and may file a motion to amend the patent by substituting new claims, and the PTAB will issue a final determination within one year after it institutes trial.

### **Ex Parte Reexamination**

*Ex parte* reexamination allows a third party to file a request for the PTO to reexamine an issued patent, based on printed prior art. The petition must raise a substantial new question of patentability for reexamination to be instituted. While the patent owner is allowed to participate in the reexamination, the third-party challenger has no further involvement after filing the initial request.

### **Benefits vs. Risks**

While post-grant proceedings provide alternative options to litigation for parties involved in patent disputes, it is important to understand the risks involved as well. In particular, the use of certain post-grant proceedings to challenge validity can limit the petitioner’s ability to challenge validity in any subsequent litigation on certain grounds.

### **A Hybrid Approach**

Post-grant proceedings incorporate aspects of traditional patent practice before the PTO, as well as features that are more akin to patent litigation. Success in the post-grant arena requires a mixture of sophisticated patent practice experience before the PTO, as well as litigation acumen.

### **Strengthening or Correcting Issued Patents**

Reissue applications are valuable tools for correcting defects in issued patents and can be utilized prior to enforcement efforts to strengthen the patent asset and Bond attorneys have

experience drafting and prosecuting these applications. The reissue application request must identify an error that causes the patent to be invalid. Reissue applications, for example, may be filed based on the claims being too narrow or too broad, although a broadening reissue must be filed within two years from the grant of the patent.

### **Why Choose Bond**

The attorneys in Bond’s Patent and IP litigation practice have the experience and skills to develop post-grant strategies that strengthen their intellectual property position in each of these areas.

Bond’s IP attorneys possess a mixture of patent prosecution and litigation experience that provides clients with strategic advantages and guidance in developing post-issuance strategies. Our deep bench includes litigators and registered patent attorneys with sophisticated technical backgrounds. Bond IP attorneys hold degrees in aerospace, electrical and optical engineering, computer science, as well as physics, biology and chemistry making them well-equipped to provide post-grant results.

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