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A Look Back on a Decade of Practice at the PTAB
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September 2022 marked the 10-year anniversary of the implementation of the America Invents Act (AIA). Since then, inter partes review (IPR) and other proceedings established by the AIA have exploded in popularity, and the Patent Trial and Appeal Board has become the busiest forum for patent disputes in the country.

Responding to the AIA

While the AIA became effective in September 2012, we knew it was coming well before then and began to bring together a post-grant practice group comprised of patent prosecutors and litigators, with a particular focus on those who had experience handling inter partes and ex parte reexaminations. At first, significant uncertainty existed about the implications of these proceedings and whether and how clients would use them in actual practice. The threat of estoppel was a significant concern for many, as were the inherent unknowns of practicing before new judges and under a new set of standards.

Getting In on the Ground Floor

Our early entry into post-grant practice was informed by two guiding principles: our desire to meaningfully contribute to shaping post-grant jurisprudence, while of course also preserving the paramount interests of our clients. While some clients expressed excitement over efficiencies promised by the proceedings, others were reluctant to enter the fray before knowing what the long-term consequences could be. Ultimately, it wasn't until about a year after the AIA came into effect that we had sufficient data to feel comfortable recommending the use of post-grant proceedings on a wide scale.

A Changing Practice

While post-grant proceedings initially may have been envisioned as a means for addressing nonpracticing entity litigation outside of district court, they have been leveraged by many companies in competitor-competitor disputes.

In reflecting on the relatively short history of the PTAB, it seems that the post-grant practice can be divided into roughly three eras. The first era was characterized largely by hesitation—some practitioners jumped in enthusiastically, but most stayed on the sidelines because the stakes and the uncertainty were both high. The second era (sometimes referred to as the "Death Squad" era) saw an influx of practitioners into the practice, many of whom were inexperienced with practice at the United States Patent and Trademark Office, and as a result had different degrees of success. The third and current era has been marked by increasing formality, with post-grant as a distinct practice taking shape and the market solidifying.

Amid these eras, at times, the PTAB has been characterized as favoring petitioners and patent owners. In its early days, the PTAB was generally seen as pro-petitioner, but once discretionary denials became commonplace, the PTAB was oft characterized as a pro-patent owner forum. We tend to find it more fruitful to focus on the facts and circumstances of a particular case, assessing the likelihood of prevailing as petitioner or patent owner under its circumstances and tuning strategies to maximize the odds of prevailing.

Post-grant practice has also matured as USPTO-issued guidance and post-grant jurisprudence have developed over the past decade. Major turning points—such as the replacement of broadest reasonable interpretation (BRI) with the district court Phillips claim construction standard, the end of partial institution post-SAS, and the survival of the PTAB through its constitutional challenges—have stabilized the practice. Director Vidal's

early efforts to press forward on PTAB-related guidance also serve to promote continued efficiency and increased certainty.

Planning for Long-Term Success

Long-term success in post-grant practice requires building a sustainable practice that leverages a group of highly trained and experienced professionals. As opportunities for post-grant work have grown, we have remained mindful of the need to involve and train our "next gen" attorneys. When involving new attorneys in this practice, we have purposefully avoided a "watch and learn" approach; we want our attorneys to jump in and get their hands dirty. We believe that people excel when placed in the right environment, but that the responsibility to create that environment is on us.

However, post-grant practice is not for everyone. Aspiring post-grant practitioners should enjoy adversarial proceedings and be ready for a fight. Most importantly, they need to understand the forum; the PTAB is not district court, and PTAB judges are not lay jurors. Attorneys who are ill-acquainted with the nuances of PTAB practice risk losing not only their case before the PTAB, but their credibility with its judges.

Looking Toward the Future

Ten years in, we see post-grant proceedings continuing to be staples of well-developed IP strategies, particularly as they become increasingly central elements in many companies' litigation defense toolkits. While the practice will continue to change, in recent years the number of petitions filed at the PTAB has leveled off, indicating a maturing and stabilizing practice. Smart companies will continue to educate themselves on the intricacies of post-grant practice and understand how post-grant proceedings work in conjunction with other forums where they face litigation. For practitioners, there is a need for skilled and talented attorneys to enter the practice as it matures. While there have been many changes in post-grant practice over the decade (and even more opportunities to overreact), an important lesson we've learned is that a typical, thoughtful approach most often wins the day.

Dorothy Whelan *and* ***Karl Renner****, co-chairs of the post-grant practice at Fish & Richardson, helmed that firm's efforts to become one of the dominant forces in post-grant practice. Under their leadership, Fish became the first firm to reach 1,000 appearances at the PTAB and continues to be active firms in the forum.*

Post-grant colleague ***Casey Kraning, Ph.D.****, is a next-gen attorney at Fish who focuses her practice on patent litigation and AIA proceedings in the life sciences, pharmaceutical and biotechnology industries.*