

April 13, 2016

# Post-Grant for Practitioners

## Multiple Parties, Multiple Petitions Part II



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*Associate*

- I. Overview of Webinar Series
- II. Statistics
- III. Multiple Parties and Multiple Petitions in Post-Grant Proceedings
- IV. Post Grant Resources



# Overview of Webinar Series

- Where? ... see invitation
- How often? ... monthly
- When? ... 2<sup>nd</sup> Wednesday
- Topics? ...
  - Important decisions
  - Developments
  - Practice tips
- Housekeeping
  - CLE
  - Questions
  - Materials
    - <http://fishpostgrant.com/webinars/>

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**Post-Grant  
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Fishpostgrant.com Bios Alerts Webinars Case Studies App





### Multiple Parties, Multiple Petitions Part II

Join us as we continue our discussion from March on multiple parties and multiple petitioners. Our speakers will take a closer look at redundancy and 325(d) and how they influence strategy in post-grant proceedings. They will also address a number of hypothetical situations involving filings at the PTAB and address the issues that petitioners and patent owners face.

[Register](#) now for this Post-Grant for Practitioners Webinar.

Wednesday, April 13, 2016  
1:00 PM - 2:00 PM EST  
Via the web





Speakers:

 <p><a href="#">Dorothy Whelan</a> <a href="mailto:whelan@fr.com">whelan@fr.com</a> Principal, Co-Chair Twin Cities</p>	 <p><a href="#">Karl Renner</a> <a href="mailto:renner@fr.com">renner@fr.com</a> Principal, Co-Chair Washington, DC</p>
 <p><a href="#">Thomas Rozylowicz</a> <a href="mailto:rozylowicz@fr.com">rozylowicz@fr.com</a> Principal Washington, DC</p>	 <p><a href="#">David Holt</a> <a href="mailto:david.holt@fr.com">david.holt@fr.com</a> Associate Washington, DC</p>

[REGISTER](#)

Fish & Richardson will apply for 1.0 hour of general CLE credit in most states. If you would like to receive CLE credit, register with your state bar information.

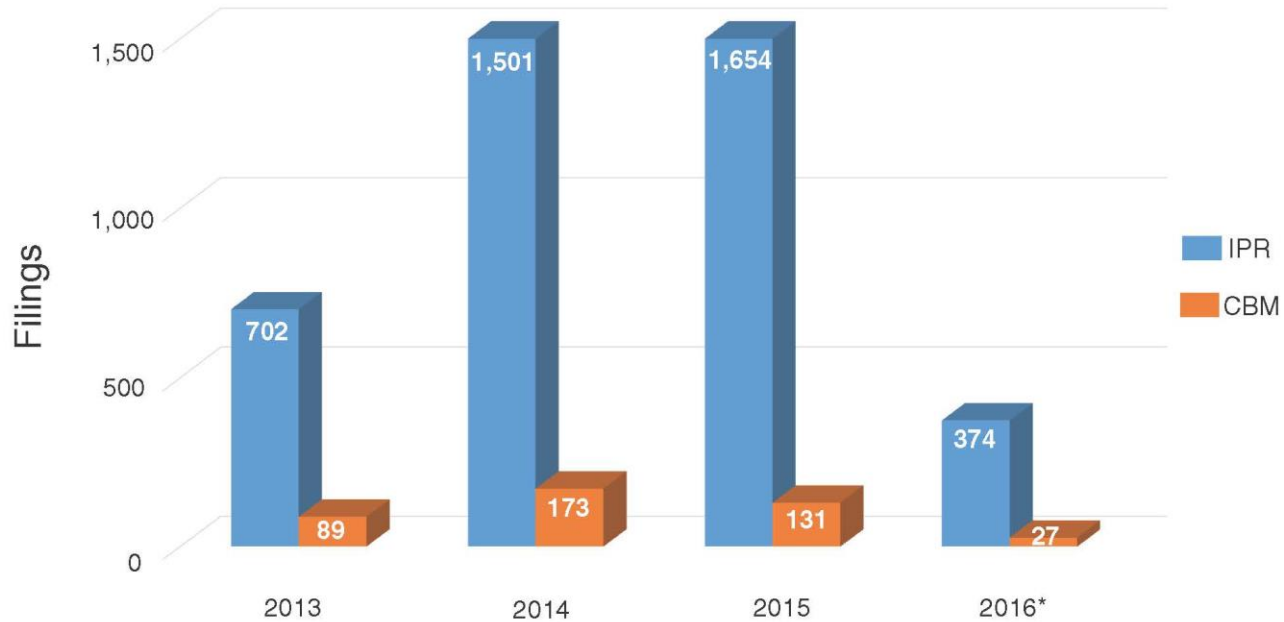
If you have questions, please contact Crystal Chisholm at [chisholm@fr.com](mailto:chisholm@fr.com)

 <p>Never miss an update! Sign up for the eNewsletters of your choice.</p>	 <p>View webinar replays from our Post-Grant for Practitioners series.</p>	 <p>Connect with Fish &amp; Richardson on LinkedIn</p>	 <p>Follow Fish &amp; Richardson on Twitter</p>
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## Trial Filings



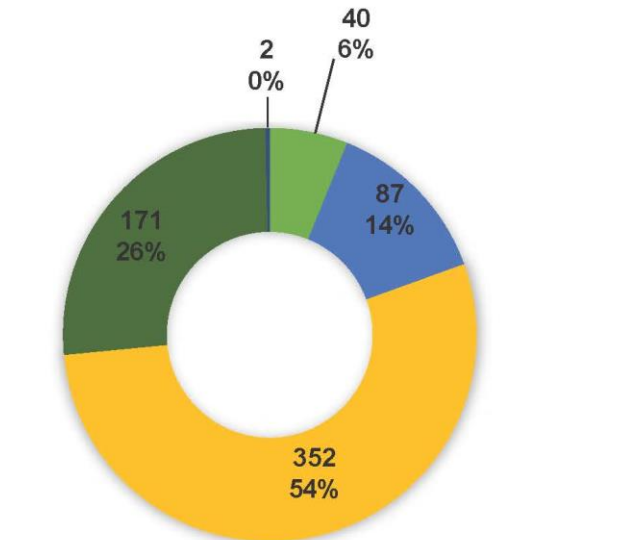
\*2016 numbers are year-to-date. Numbers are through April 11, 2016.

## Trial Status

Open: 1,495      Terminated: 3,267

Source: LexMachina PTAB Trial Data, filed between 2013 and April 11, 2016.

**652 Total AIA Petitions in FY 16\*  
(Technology Breakdown)**

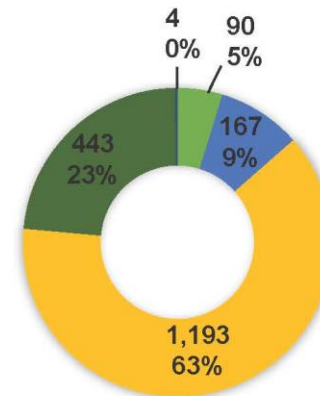


- Electrical/Computer - TCs 2100, 2400, 2600, 2800
- Mechanical/Business Method - TCs 3600, 3700
- Chemical - TC 1700
- Bio/Pharma - TC 1600
- Design - TC 2900

\*Data current as of 2/29/2016

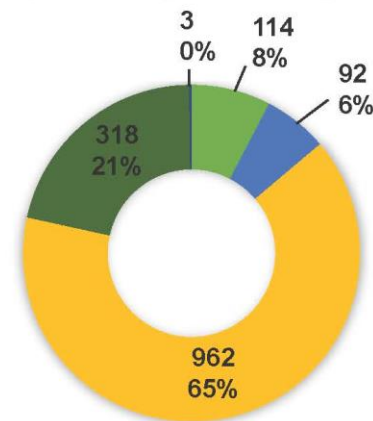
Source: USPTO Patent Trial and Appeal Board Statistics, 2/29/2016

**1897 Total AIA Petitions in FY 15\*  
(Technology Breakdown)**



**Narrative:** The pie chart shows the total number of AIA petitions filed in the current fiscal year to date as well as the number and percentage of these petitions broken down by technology.

**1489 Total AIA Petitions in FY 14\*  
(Technology Breakdown)**





# Multiple Parties and Multiple Petitions in Post-Grant Proceedings



## Case Studies and Issues

- Joinder
- Real Party in Interest
- Timing Issues when there are multiple potential filers



Joinder



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## Joinder

- Fact Pattern:
  - IPRs filed by co-defendants appear to have solid grounds for rejection.
  - Approaching one year anniversary of filing date.
  - Institution Decision expected after the one year anniversary of service of the complaint.
- Questions:
  - What are the options?
    - What are the risks and rewards for each option?





Real party in interest and  
privity issues

## Real party in interest and privity issues

- Fact pattern:
  - Joint Defense Group is sharing prior art and costs involved with uncovering art.
  - The subject of a post-grant filing has generally arisen but not specifically discussed.
- Questions:
  - What factors inform the inquiry on privity and RPI?
  - How can JDG members protect themselves from charges of privity?
  - Should a JDG agreement include explicit carve-outs for post-grant work?

## Real party in interest and privity issues

- **Fact Pattern:**
  - What if you learn that another member of the team is preparing a challenge?
- **Questions:**
  - Do you approach and seek to learn more?
    - What if you learn through the JDG?
    - What if you learn through competitive intelligence?
  - What if you are aware of the grounds and like them, but lack confidence in the evidence or expert used by another petitioner?



Timing issues where there are  
multiple potential filers

## Timing issues where there are multiple potential filers

- Fact:
  - PTAB being asked to consider common question of law across multiple petitions with different factual bases (e.g., 101, evidentiary matters)
- Question:
  - Is consolidation likely?
- Fact:
  - Large number of art-based grounds for rejection are presented across multiple petitions by one or more parties.
- Question:
  - Will redundancy and 315(d)/325(d) impact consideration of the issues?



## Timing issues where there are multiple potential filers

- Differences between redundancy and 35 U.S.C. §315(d)/325(d)

Redundancy conventionally defined as the PTAB's refusal to consider multiple grounds that do not feature a meaningful distinction between them, as it is believed to be contrary to the AIA and related regulations (see, for example, *Amkor Tech., Inc. v. Tessera, Inc.*, IPR2013-00242, Paper 37, 2013 WL 5653117, at \*16-17 (PTAB Oct. 11, 2013), request for reconsideration denied, IPR2013-00242, Paper 82, 2014 WL 2864145, at \*2 (PTAB Jan. 10, 2014)).

325(d) Multiple Proceedings.— Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of any post-grant review under this chapter, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the post-grant review or other proceeding or matter may proceed, including providing for the stay, transfer, consolidation, or termination of any such matter or proceeding. In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

# Post-Grant for Practitioners

Timing issues where there are multiple potential filers



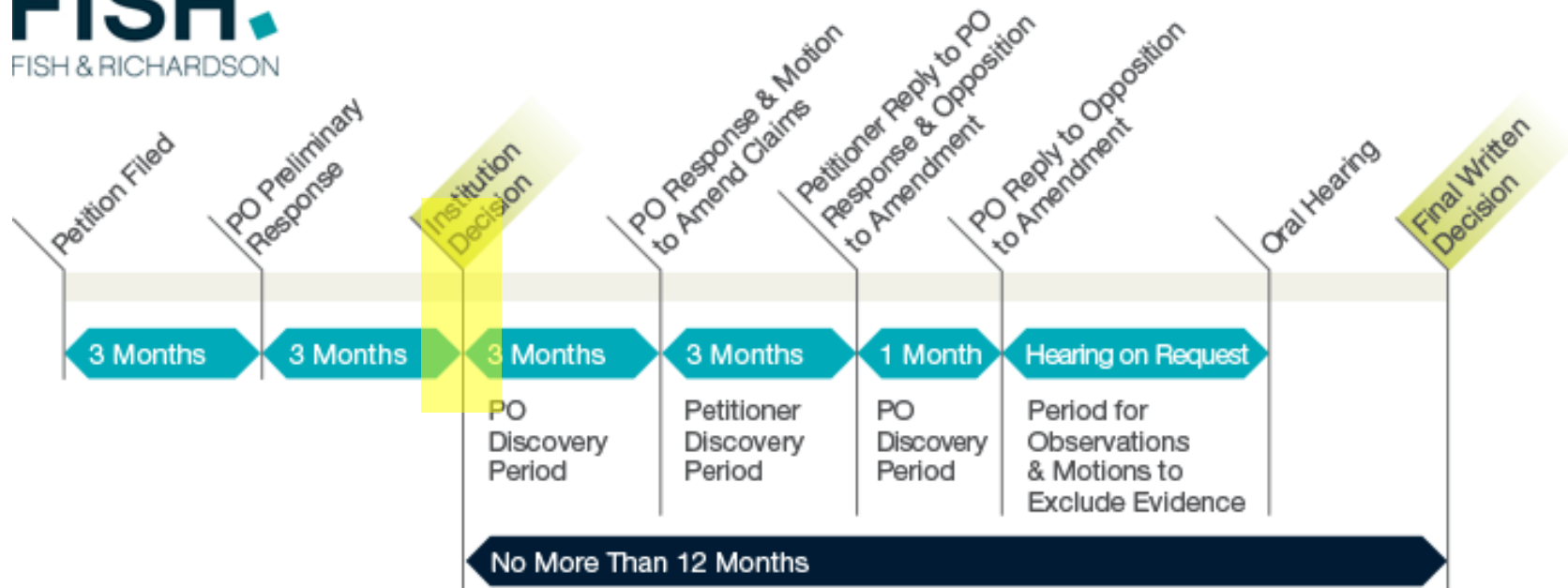
## Timing issues where there are multiple potential filers

- Fact:
  - Later IPR is filed after PPOR but before Institution.
- Issues:
  - This amounts to waiting ~4 months relative to when 2<sup>nd</sup> filer learns of first filing.
  - Is the first filing suboptimal?
  - What if better art/evidence exists than art relied upon in first filing?
    - Do we even know the best references as of the time of first filing?
    - What if best art is applied but used poorly?

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Timing issues where there are multiple potential filers



## Timing issues where there are multiple potential filers

- Fact:
  - Later IPR is filed after Institution but before POR.
- Issues:
  - This amounts to waiting ~6 months relative to first filing.
  - How much risk does a favorable Institution Decision remove?
  - Did PTAB offer claim construction that addresses risk?
  - Did PTAB address Patent Owner's best argument in depth?
  - Consider impact on district court timing.

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Timing issues where there are multiple potential filers



## Timing issues where there are multiple potential filers

- Fact:
  - Later IPR is filed after Patent Owner's Response.
- Issues:
  - This amounts to waiting ~9 months relative to first filing.
  - Is consolidation likely?

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# Post-Grant Resources

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- In Fish & Richardson’s initial 7-part webinar series titled “Challenging Patent Validity in the USPTO,” we explored details regarding several of the post grant tools, with 3 sessions dedicated to Inter Partes Review (IPR), and a final session walking through several hypotheticals, to help listeners understand how these apply to common situations.
- Audio and slides for these webinars are posted online at:  
<http://fishpostgrant.com/webinars/>
- If you listen to these webinars, you will be well positioned to engage in a conversation over whether and when to use those tools and how to defend against them.

- Fish web sites:
  - Post-Grant for Practitioners: <http://fishpostgrant.com/webinars/>
  - General: <http://fishpostgrant.com/>
  - IPR: <http://fishpostgrant.com/inter-partes-review/>
  - PGR: <http://fishpostgrant.com/post-grant-review/>
  - Rules governing post-grant: <http://fishpostgrant.com/>
  - Post-Grant App: <http://fishpostgrant.com/app/>
- USPTO sites:
  - AIA Main: [http://www.uspto.gov/aia\\_implementation/index.jsp](http://www.uspto.gov/aia_implementation/index.jsp)
  - Inter Partes: [http://www.uspto.gov/aia\\_implementation/bpai.jsp](http://www.uspto.gov/aia_implementation/bpai.jsp)

# Thank You!

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