



# Post-Grant for Practitioners: Post-Grant 101

September 29, 2020



# Agenda

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- Types of post-grant proceedings
- What is the PTAB and who are the judges?
- Interplay between Litigation and IPRs
- Discovery during IPR and PGR proceedings
- Oral hearings in IPR and PGR proceedings
- Recent developments in exercise of discretionary denial of IPR petitions

# Types of Post-Grant Proceedings

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- **Inter Partes Review (IPR)**
- **Post Grant Review (PGR)**
- ***Ex Parte* Reexamination**

# Types of Post-Grant Proceedings

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- **Inter Partes Review (IPR)**

- *Inter partes* proceeding between Petitioner and Patent Owner
- Can only be initiated by a Petitioner **9 months after patent's grant** (for patents with post AIA priority)
- **Petition** must be **filed within 1 year of service** of complaint for patent infringement
- Prior art can include **patents and printed publications**
- Patent can generally be challenged **only on anticipation and obviousness grounds**

# Types of Post-Grant Proceedings

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- **Post Grant Review (PGR)**

- Can only be initiated ***within 9 months*** of patent's grant and only available for patents with post-AIA priority
- Prior art can include patents, printed publications, ***and evidence of public use, on-sale activity, or other public disclosures***
- Patent can be challenged on the following grounds: anticipation, obviousness, ***lack of written description, enablement, indefiniteness, and subject matter eligibility***

# Main Types of Post-Grant Proceedings

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- **Ex Parte Reexamination**

- **Anyone** (3<sup>rd</sup> party, patent owner) can request to re-examine the patent
- Challenge **using printed publications and patents**
- Reexamination request must raise “**substantial new question of patentability**”
- 3<sup>rd</sup> party **requestor cannot participate in the reexamination** once granted
- Proceeding handled by the **Central Reexamination Unit**

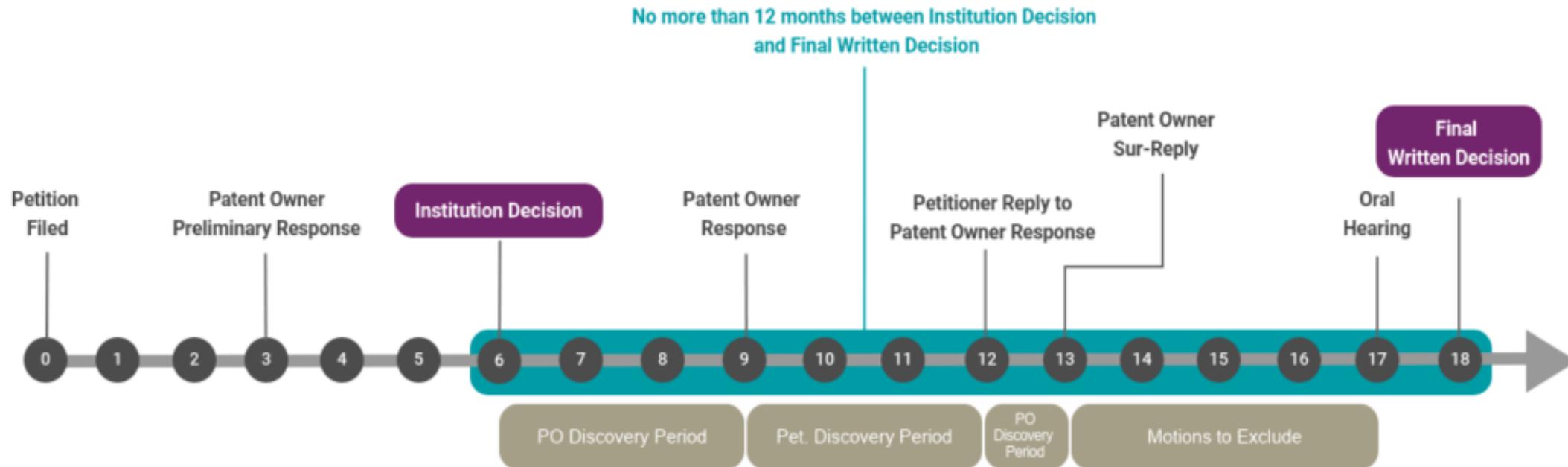
# What is the PTAB and Who are the Judges

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- PTAB is administrative ***adjudicatory body of the PTO*** (replaced BPAI)
- PTAB is split into:
  - ***Appeals division*** – adjudicates cases in active prosecution
  - ***Trials division*** – adjudicates post-grant proceedings
- PTAB Judges
  - 10-15 years of patent litigation and/or prosecution experience
  - BS in engineering or other scientific discipline
- PTAB's factual findings reviewed under ***deferential “substantial evidence” standard***

# IPR Timeline

## Inter Partes Review Timeline



# Interplay Between Litigation and IPRs

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## *Seeking a Stay*

- A stay pending resolution of an IPR can save resources and avoid duplication of effort across different fora
- **BUT:**
  - District courts generally reluctant to grant stays pending IPR, unless ***early enough in litigation***
  - PTAB has ***discretionary authority to deny petition*** if related ***litigation is at an advanced stage***

# Interplay Between Litigation and IPRs

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## *Claim Construction*

- Same ***Phillips*** claim construction standard as in Federal court (recently changed from “broadest reasonable interpretation” standard)
- ***Prosecution disclaimer*** can arise based on claim construction positions at the PTAB
- ***Prosecution history estoppel could prevent*** a patent owner from asserting infringement under the ***doctrine of equivalents*** based on IPR arguments that a claim is valid over a prior art equivalent

# Interplay Between Litigation and IPRs

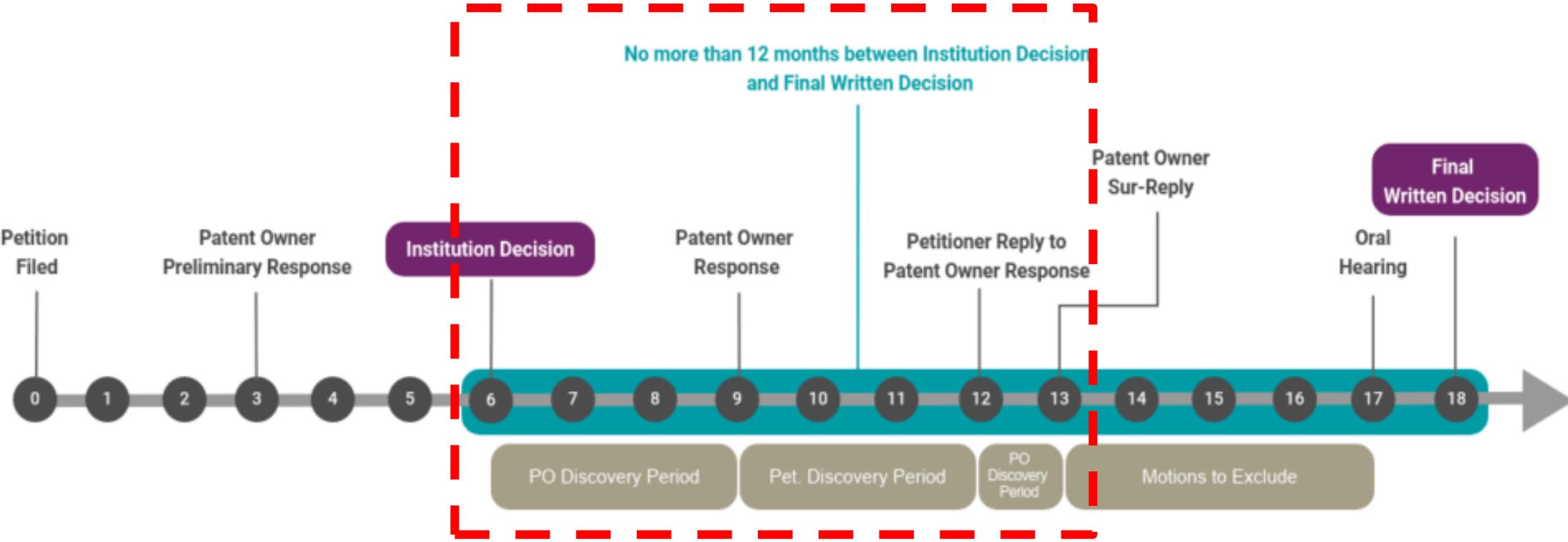
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## *Prior Art Estoppel*

- If PTAB issues a final written decision (FWD) in an IPR:
  - Petitioner is ***estopped from asserting any patent/publication art in related litigation***
  - Includes patent/publication art that was ***raised or reasonably could have been raised*** at the IPR
- **BUT:** ***system prior art could still be asserted*** in litigation

# Discovery during IPR and PGR Proceedings

## Discovery Timeline



# Discovery during IPR and PGR Proceedings

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- Routine discovery permitted at the PTAB
  - Any exhibit cited in a paper or testimony
  - Cross-examination of the other party's declarant or affiant
  - Relevant information that is inconsistent with a position advanced during the proceeding
- Additional discovery
  - Generally ***requires motion for additional discovery*** (unless agreement between parties)
  - Only granted if ***in the interests of justice***
    - E.g., discovery related to identification of privity/real party-in-interest and objective indicia of non-obviousness.

# Depositions during IPR Proceedings

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- Generally only *expert witnesses* are deposed
  - **BUT**: fact witnesses may be deposed where date of invention is an issue
- *No speaking objections* are allowed
- *Generally no video depositions*—unless prior PTAB authorization
- *Timing*: 7 hours for cross-exam + 4 hours for re-direct + 2 hours for re-cross
- *Cost* of deposition *borne by taking party*
- *Entire transcript should be filed as exhibit* to paper it supports

# Oral Hearings in IPR and PGR Proceedings

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- **Who:** 3 judge-panel, counsel for parties, and any member of public (by request)
- **What:** *Logistics in Oral Hearing Order* (e.g., when to exchange demonstratives, objections to demonstratives, requests for special presentation equipment)
- **When:** Specified in Scheduling Order issued at time of institution
- **Where:** USPTO's headquarters in Alexandria, VA or remotely via videoconference (entirely remote since COVID)
- **How:**
  - Each party has *1 hour to present case*
  - *Demonstratives can be used* at hearing
  - *Live testimony rarely allowed*—unless witness credibility is relevant

# Recent Developments in PTAB Discretionary Denials

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*Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 (P.T.A.B. May 13, 2020)  
(precedential): **PTAB has discretion to deny petitions under 35 U.S.C. § 314(a)**

- (1) ***Whether the District Court had granted a stay*** or evidence exists that the Court ***would grant a stay*** if the IPR were instituted;
- (2) ***Proximity of the court's trial date to the PTAB's expected deadline for a FWD;***
- (3) Investment by the parties and the court in the district court proceedings;
- (4) ***Degree of overlap between the issues*** raised in the IPR and the district court case;
- (5) Whether the parties in the two proceedings are the same; and
- (6) Any other factors that might affect the Board's discretion, including merits of the IPR petition

# Additional Resources

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1. <https://www.fr.com/fish-litigation/challenging-patents-through-post-grant-proceedings-what-are-your-options/>
2. <https://www.fr.com/fish-litigation/what-is-the-ptab-and-who-are-the-judges/>
3. <https://www.fr.com/fish-litigation/when-should-i-file-an-ipr-during-litigation/>
4. <https://www.fr.com/fish-litigation/what-discovery-available-inter-partes-review/>
5. <https://www.fr.com/depositions-for-inter-partes-review-how-do-they-work/>
6. <https://www.fr.com/fish-litigation/oral-hearings-at-the-ptab/>

# Thank You!



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