

Inter Partes Review

Inter partes review provides an opportunity to challenge an issued patent under 35 U.S.C. §§ 102 and 103 based on prior art patents or printed publications. A petition for *inter partes* review is made by any party other than the patent owner, and is available for any issued patent (*i.e.*, both first to invent and first inventor to file patents), subject to certain restrictions. Most notably, *inter partes* review is only available during the first **one year** after a client (or a privy) is served with a patent infringement complaint. A party is also barred from filing for *inter partes* review of a patent for which the party has filed a civil action challenging validity.

Inter partes review proceedings are administrated by the Patent Trial and Appeal Board (PTAB); there is no examination involved. The proceedings are heard by a panel of administrative law judges who make rulings regarding institution of a review and discovery matters as well as ultimately issuing a final decision on patentability at the conclusion of the *inter partes* review. Any party dissatisfied with the final decision may appeal directly to the Federal Circuit.

As noted above, *inter partes* review is requested via petition. The petition must include an identification of the real parties in interest, the claims being challenged along with explanations of grounds of unpatentability for those claims, copies of evidence relied upon and an explanation of the relevance of that evidence, along with payment of a fee. The requesting party may submit technical declarations with supporting evidence and opinions with their request for *inter partes* review. The patent owner is prohibited from filing any testimonial evidence with their preliminary response. Such evidence may be filed at later points in the proceedings, such as with the patent owner response in cases where *inter partes* review is granted.

Upon review of the petition and any preliminary response by the patent owner, the PTAB will determine whether there is a reasonable likelihood that the petitioner would prevail on at least one of the challenged claims. The PTAB may narrow issues at this time, and will provide a decision detailing the grounds of unpatentability that will be at issue in the proceeding. After initiation of an *inter partes* review, the PTAB will issue a scheduling order that will conclude the proceeding within 12 months, where the proceeding may be extended for 6 additional months for cause. A typical scheduling order will provide the patent owner with three months to perform discovery and to respond to the grounds of unpatentability. Discovery can include depositions of any witnesses that submitted declarations with the request petition. A response may include a contingent motion to amend the claims. This is the only opportunity that the patent owner has to amend the claims by right. The petitioner is then given a three month period to perform discovery (*e.g.*, deposition of patent owner declarants) and to respond to the patent owner's reply. A short period for motions may be provided before the oral hearing. After the oral hearing, the PTAB then prepares a final written decision regarding the patentability of the challenged claims. Parties are permitted to settle during the proceedings, unless the PTAB has already decided the dispute on the merits.

Estoppel for the requesting party applies upon issuance of the final decision. Estoppel extends to any ground that the petitioner raised or reasonably could have raised during the *inter partes* review. This estoppel applies to proceedings before the USPTO, civil actions, and proceedings before the International Trade Commission (ITC).



- 208 IPR Requests were filed in the first seven months that the proceedings were available.
- The base filing fee for an *inter partes* review petition is \$9,000.
- A base institution fee of \$14,000 is due if the PTAB institutes a full review.

