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# AIPLA • How can a patent owner strengthen its patent before litigation? • Supplemental Examination • Reissue • Ex Parte Reexamination ("EPR") • Continuation or continuation-in-part

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# Supplemental Examination

 35 U.S. Code § 257(a): "A patent owner may request supplemental examination of a patent in the Office to consider, reconsider, or correct information believed to be relevant to the patent"

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## Reissue

 35 U.S.C. § 251: "Whenever any patent is, through error, deemed wholly or partly inoperative or invalid, ... the Director shall, on the surrender of such patent ..., reissue the patent ... for the unexpired part of the term of the original patent."

# Ex Parte Reexamination

- 35 U.S.C. § 302: "Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art"
- 35 U.S.C. § 303(a):"the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised"

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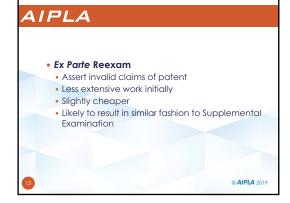
AIPLA Supplementa Examination Cure possible Cancel, amend, add defects relating to inequitable only within 2 years of Cancel claims as unpatentable, or compel amendments Obtain stronger, more targeted, and/or broader patent Purpose inequitable conduct issuance) Standing Patent owner only Patent owner only 3rd party, patent Patent owner only owner, PTO Director What Patent Any patent Any patent before Any patent Based on a pending or allowed parent patent application expiration © AIPLA 2019

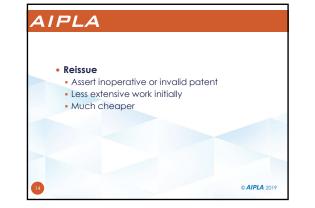
	Supplemental Examination	Reissue	EPR	Continuatio
When	Any time during enforceability of patent	Any time before patent expires	Any time during enforceability of patent (up to 6 years after lapse or expiration)	Any time during pendency of pare patent application
Grounds	Any "information believed to be relevant to the patent"	The patent, through error, is considered to be wholly or partly inoperative or invalid	102 and 103 only, and only patents or printed publications	N/A
Standard for Institution	Raises Substantial New Question (SNQ) of patentability	N/A	Raises Substantial New Question (SNQ) of patentability	N/A

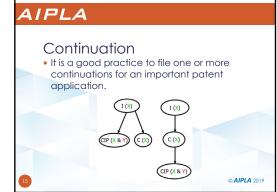
	Supplemental Examination	Reissue		
Burden of Proof	Preponderance of evidence	Preponderance of evidence	Preponderance of evidence	N/A
Before Whom	Examiner	Original examiner, if available	CRU	Original examiner, if available
Estoppel	None	None	No legal estoppel	None
Appeal	Only patent owner may appeal to PTAB then Federal Circuit			

# AIPLA Supplemental Examination - Pros - Oure patent of inequitable conduct - Strengthen claim of validity against assertion of allowance based on incorrect/incomplete information - Can consider issues other than 102/103 - Determination for institution within 3 months - Need not assert inoperative or invalid patent

# AIPLA Supplemental Examination - Cons - Repensive - Likely to find substantial new question of - Requires extensive work to file





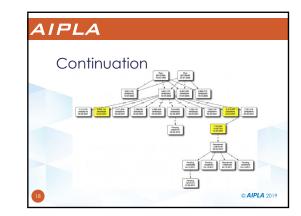


# Reissued Patent US RE41,685

	Name and Annual Property (a) a space factors interation (see	10, 21, 270	
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US 6,381,211 C1			
EX PARTE	Case	Case Filing Date •	Case Terrinal
REEXAMINATION CERTIFICATE ISSUED UNDER 35 U.S.C. 307	TCT Mobile (J.S) Inc. + WIRELESS PROTOCOL INVOVATIONS. INC. 19205-0000 (PDate)	Aq. 31.205	Jun 02 200
	TCT Mobile (J/D) Inc. + WIRELESS PROTOCOL INVOVATIONS, INC. IP2215 (CCC) (PEAR)	Ag. 71.206	Jun. 02. 2017
THE PATENT IS HEREBY AMENDED AS INDICATED BELOW.	TCT Mobile, Inc. v Winkess Protocol Innovations, Inc. (PS205-0490 (PCR))	M 26, 206	Jun 02.207
Matter enclosed in heavy brackets [] appeared in the patent, but has been deleted and is no longer a part of the	Wireless Protocol Innovations. Inc. v. TCL Corporation et al. 5-15-cv:00198/174201	01.23.205	03.31,200
patent; matter printed in italies indicates additions made to the patent.	Wireless Protocol Innovations. Inc. v. 278: Corporation et.al 6/15/cv00999/DXED	01.23.205	Jan. 10, 2007
AS A RESULT OF REEXAMINATION, IT HAS BEEN	WiLAN Inc. v Apple Inc. 6-12-cv-00920 (DED)	Dec. 06, 2012	0.1.20,2014
DETERMINED THAT:	W-LAN Inc. v Sena Wreles America. Inc. 6-0-cv-00101:D3D1	Dec. 06, 2012	0.1.16,2013
Claims 1-10 are cancelled. New claims 11-203 are added and determined to be patentable.	WLAN Inc. v Alotei Luoen USA Inc. et al. 6 10 ov 00520 (7982)	0:1.05,200	Feb. 67, 2014



• How can an accused infringer challenge the validity of an asserted patent?

#### Post-grant Review ("PGR") Inter Partes Review ("IPR")

Covered Business Method Review ("CBM")

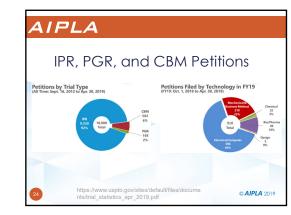


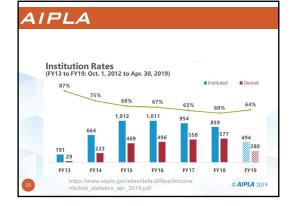
	IPR	PGR	СВМ	EPR
Standing	3rd party: Not filed civil action challenging patent; not served w∕ complaint ≥1 yr	(Same as IPR)	3rd party: Sued or charged with patent infringement; not served w/ complaint >1 yr	3rd party, patent owner, or Director of PTO
What Patent	Any patent	Any patent having an effective filing date on or after 3/16/2013	at least one claim of patent is directed to a "financial product or service"	Any patent
When	For pre-AIA patent, any time during enforceability; for AIA patent, 9 months after issuance or reissue of patent, or termination of PGR	Within 9 months of issuance or reissuance of patent having an effective filing date on or after 3/16/2013	Now until 9/16/2020, unless extended, except during period a PGR is available or ongoing	Any time during enforceability of patent (up to 6 years after lapse or expiration)

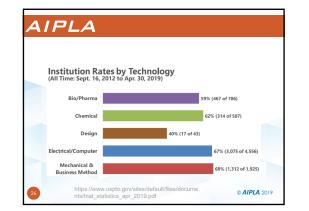
	IPR	PGR	СВМ	EPR
Grounds	102 and 103 only, and only patents or printed publications	Any invalidity ground: 101, 102, 103, 112	Any invalidity ground, except § 102(e) prior art	102 and 103 only, a only patents or prin publications
Standard for Institution	"Reasonable likelihood"	"More likely than not"	(Same as PGR)	Raises Substantial New Question (SN of patentability
Burden of Proof	Preponderance of evidence	Preponderance of evidence	Preponderance of evidence	Preponderance of evidence
Before Whom	PTAB	PTAB	PTAB	CRU

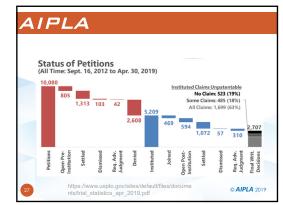
	IPR	PGR	СВМ	EPR
Anonymous	No	No	No	Yes
Estoppel	Issues raised or reasonably could have been raised	(Same as IPR)	<u>PTAB</u> : raised or reasonably could have raised <u>District Court</u> : raised	None
Appeal	Both parties may appeal to Federal Circuit	(Same as IPR)	(Same as IPR)	Only patent owner may appeal to PTAB then Federal Circuit
Settlement	Yes	Yes	Yes	No

# Advantages of IPR, PGR, CBM Advantages of IPR, PGR, CBM . Cost: 1/10 of litigation cost in the district court . Speed: 12 months to conclude after institution . Effect: Cancel or narrow claims . Much higher success rate: . No presumption of validity . Preponderance of evidence vs. clear & convincing evidence . Administrative judges vs. jury









21%

12%

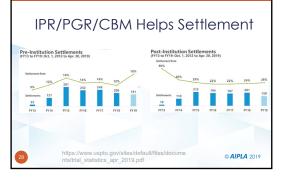
67%

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21% 1404 12% 67% 7608

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Ex Parte	Reexamination			
4. Number known to be in liti	sation	4731	34%	
5. Decisions on requests			13178	
a. No. granted		12042	91%	
(1) By examin	ner	11891		
(2) By Direct	or (on petition)	151		
b. No. denied		1136	9%	
(1) By examin	her	1089		
(2) Reexam v	acated	47		
6. Total examiner denials (inc	udes denials reversed by Director)		2272	
a. Patent owner rec	uester	586	26%	
b. Third party reque	ster	1686	74%	
7. Overall reexamination pen	lency (Filing date to certificate issue date)			
a. Average pendenc	y	27.7 (mos.)		
b. Median pendenc	(	19.8 (	mos.)	
	/www.uspto.gov/sites/default/files/documents/ex_ historical_stats_roll_up.pdf	© Al	<b>PLA</b> 20	19

#### AIPLA Ex Parte Reexamination 8. Reexam certificate claim analysis: Owner 3rd Party Comm'r Requester Requester Initiate Overall a. All claims confirmed 6% 15% 0% 0% b. All claims canceled 3% 10% c. Claims changed 20% 47% 0% 9. Total ex parte reexamination certificates issued (1981 - present) ..... a. Certificates with all claims confirmed b. Certificates with all claims canceled c. Certificates with all claims changes 2391

https://www.uspto.gov/sites/default/files/documents/exparte\_historical\_stats\_roll\_up.pdf

# Use IPR to Force a Settlement

• Step 1: Search prior art and prepare invalidity positions: may present to the plaintiff

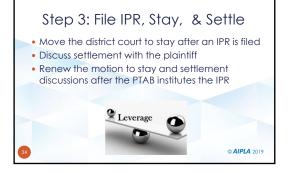
- Step 2: Prepare IPR petition and present to the plaintiff
- Step 3: File IPR and negotiate with the plaintiff
   for settlement



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## AIPLA Step 2: Prepare IPR Petition Provide expert support, well-articulated motivation Don't incorporate by reference into Petition Provide important claim constructions Clearly identify where claim elements are found in prior art Identify all real parties-in-interest in Petition Use annotated figures to show the similarities Annotation words added to figures are counted PETION



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# Responding to Threat of Injunction An injunction? PTAB proceeding may impact: Whether to grant an injunction Whether to stay the entry of an injunction pending appeal

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## Asymmetrical Discovery Burdens

- Petitioner: much more time locating experts and preparing arguments, evidence, and declarations in support of the petition
- Patent owner: much less time to conduct all discovery, prepare claim amendments, draft declarations, and submit patent owner response



# Technical Complexity of Invalidity Arguments The more technically complex, the less suited for a judge or jury, who most typically lack any technical training or background PTAB judges are more likely to appreciate obviousness for technically complex



