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PATENT LAW DEVELOPMENTS

Patentable Subject Matter, Prior Art, and Post Grant Review

Christine Ethridge

DISCLAIMER

The statements and views expressed in this presentation

- are my own and do not reflect those of my law firm or colleagues in my law firm,
- are intended for general informational purposes only, and
- do not constitute legal advice or a legal opinion.

America Invents Act (AIA)

- Signed into law on September 16, 2011
  - Passed House 304-117
  - Passed Senate 89-9
- First comprehensive patent bill since 1952
- Most substantial changes to patent law since Patent Act of 1836
- First Inventor to File Provisions effective March 16, 2013

President Barack Obama signs the America Invents Act into law September 16, 2011, at Thomas Jefferson High School for Science and Technology in Alexandria, Va.

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TIME LINE: PROSECUTION AND POST GRANT PROCEEDINGS

Supplemental examination →

Ex parte reexamination →

Inter partes review →

File application

Prosecution before examiners in the Patent Office
Will reject or allow claims based on compliance with patentability requirements

Post-grant review →

Patent Issue Date

9 months from issue

Pre-allowance final rejections, PGR, *Ex Parte* Re-exam & IPR are all appealable

Prompt prior art submissions by applicants in Information Disclosure Statements throughout prosecution are required.

Third party submissions are also permitted.

→ Patent may be enforced after issuance

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PATENTABILITY REQUIREMENTS

In the United States, a patent will be granted on an application if:

(1) the invention falls within the scope of the **subject matter** Congress and the courts have determined is eligible for patent protection;

(2) - filed by the **first inventor** of the claimed invention for applications filed before March 16, 2013 (Pre-AIA), or

- filed by the **inventor who is first to file,** or to disclose and file within one year, for applications filed on or after March 16, 2013 (AIA);

(3) the invention is **useful, novel and nonobvious**; and,

(4) the invention is **described** in the manner required by statute.

PATENTABLE SUBJECT MATTER

CLAIM UTILITY AND SUBJECT MATTER:
35 U.S.C. §101

- **Whoever invents or discovers** any new and useful **process, machine, manufacture, or composition of matter**, or any new and useful improvement thereof, may obtain a patent therefor… .

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NOT PATENTABLE SUBJECT MATTER

- Laws of Nature and Physical Phenomena
  - However, specific methods or devices employing a law of nature **are** patentable.
- Abstract Ideas
- Literary, dramatic, musical, and artistic works
- Inventions which are offensive to public morality
- Under the America Invents Act (AIA), certain tax strategies and human organisms are not patentable

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LAWS OF NATURE AND ABSTRACT IDEAS THE SUPREME COURT WEIGHS IN

METHODS OF TREATMENT

***Mayo Collaborative Services v. Prometheus Laboratories, Inc*.**

A unanimous U.S. Supreme Court ruled that steps directed generally to (1) administering a specific drug to a patient and (2) determining the level of metabolites of that drug in the patient in the claims of two patents that otherwise recited only a natural phenomenon were not significant enough to transform the unpatentable laws of nature into patent-eligible applications of those laws.

The Court stated that if there is to be invention from [a discovery of a law of nature], it must come from the application of the law of nature to a new and useful end,'" and that "'post-solution activity' that is purely 'conventional or obvious,' … 'cannot transform an unpatentable principle into a patentable process.'"

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LAWS OF NATURE AND ABSTRACT IDEAS THE SUPREME COURT WEIGHS IN

PATENTS TO GENES

Association of Molecular Pathology et al. v. Myriad Genetics, Inc.

15 claims of 7 patents claiming isolated DNA related to the human BRCA1 and BRCA2 cancer susceptibility genes and a method for their use, which were exclusively licensed to Myriad, were challenged on behalf of the Ass'n. of Molecular Pathology, and several patients, counselors, and medical researchers, under several theories, including lack of patentable subject matter under §101.

After inconsistent rulings from the District Court and the Federal Circuit, the U.S. Supreme Court ruled in June 2013 that the claims to isolated and purified DNA were not patent eligible because the claimed DNA read on isolated naturally-occurring DNA that is a "product of nature." The Court held that isolating a gene from its surrounding genetic material is not an act of invention. Several method claims were also invalidated as abstract ideas. However, claims to man-made DNA compositions, such as cDNA are patent eligible.

LAWS OF NATURE AND ABSTRACT IDEAS THE SUPREME COURT WEIGHS IN

PATENTS TO COMPUTER SYSTEMS FOR MITIGATING RISK

Alice Corp. v. CLS Bank

In June 2014, the Supreme Court determined that even though the claims fell within one of the patentable subject matter categories (methods and machines), they included abstract ideas and thus fell within one of the exceptions to patent eligible subject matter. The Court found the concepts to be fundamental economic principals and the claims failed to recite significantly more than applying the abstract idea. The fact that the method was carried out on a computer system did not save the claims because the functions performed by the generic computer were "well-understood, routine and conventional."

The Supreme Court has never defined what constitutes an "abstract idea."

LAWS OF NATURE AND ABSTRACT IDEAS
THE FEDERAL CIRCUIT STRIKES THE FINAL BLOW
PATENTS TO METHODS FOR USING GENES

Utah Research v. Ambry Genetics Corporation

The Supreme Court's 2013 decision in *Myriad Genetics* left unanswered whether several claims to a method of screening for alterations in the BRCA1 genes by comparing wild-type BRCA sequences to a patient's BRCA sequences, and claims to synthetic, single-stranded primers were patentable subject matter. Myriad sued several competitors who began selling test kits soon after the Supreme Court decision.

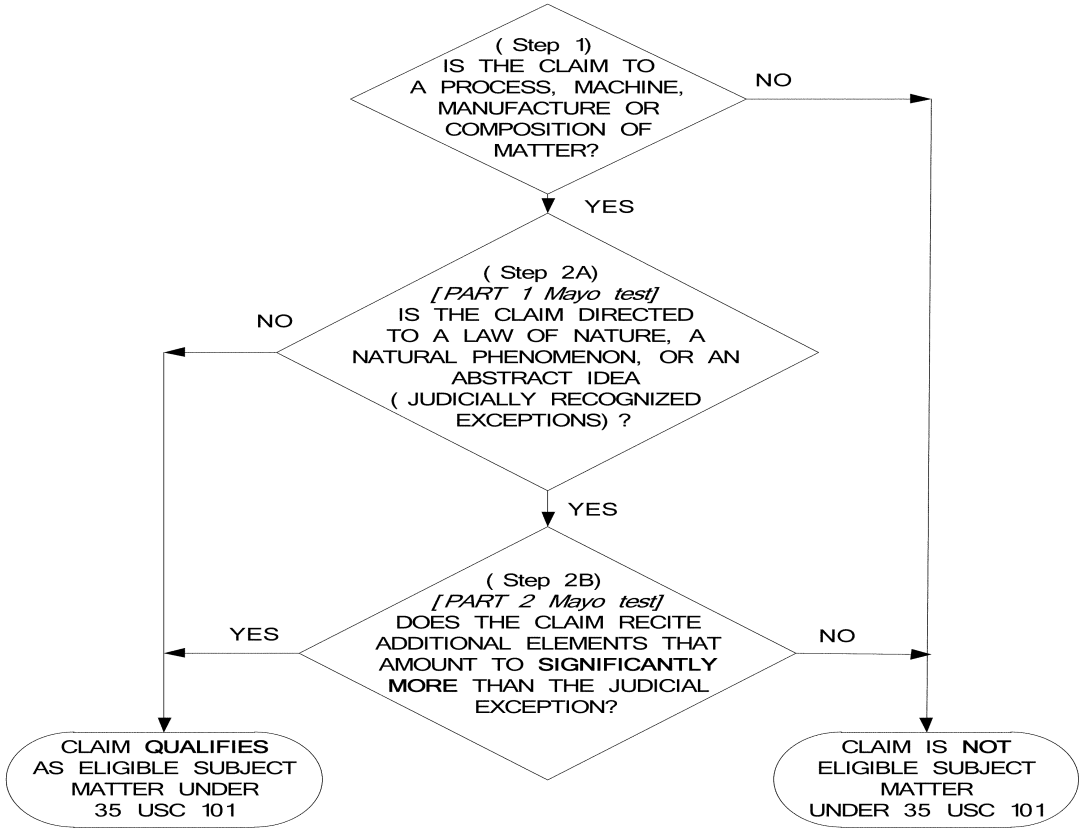
On December 17, 2014, the Federal Circuit found the claims to the DNA primers were not patentable subject matter because the synthetic sequences did not differ from the naturally occurring sequences and performed the same function. The Court found the method claims to be subject matter ineligible because the step of analyzing gene sequences is an abstract mental process and the comparison techniques were conventional, so did not transform the abstract nature of the claim.

PTO GUIDANCE FOR DETERMINING SUBJECT MATTER ELIGIBILITY

- On December 16th, the USPTO issued revised interim guidelines to Examiners for determining subject matter eligibility in view of the *Alice*, *Myriad* and *Prometheus* decisions.
- Giving claims to an invention their broadest reasonable interpretation, if the claims involve one of the judicial exceptions to subject matter eligibility (e.g., abstract ideas, laws of nature, or natural products), examiners are to ask if the claims recite additional elements that amount to ***significantly more*** than the judicial exception. If the answer is no, the claims are to be rejected under §101. If, yes, the claims are patent eligible

SUBJECT MATTER ELIGIBILITY TEST FOR PRODUCTS AND PROCESSES

PRIOR TO EVALUATING A CLAIM FOR PATENTABILITY, ESTABLISH THE BROADEST REASONABLE INTERPRETATION OF THE CLAIM. ANALYZE THE CLAIM AS A WHOLE WHEN EVALUATING FOR PATENTABILITY.



IN ACCORDANCE WITH COMPACT PROSECUTION, ALONG WITH DETERMINING ELIGIBILITY, ALL CLAIMS ARE TO BE FULLY EXAMINED UNDER EACH OF THE OTHER PATENTABILITY REQUIREMENTS: 35 USC §§ 102, 103, 112, and 101 (UTILITY, INVENTORSHIP, DOUBLE PATENTING) AND NON- STATUTORY DOUBLE PATENTING.

Notable changes from prior guidance:
- All claims (product and process) with a judicial exception (any type) are subject to the same steps.
- Claims including a nature- based product are analyzed in Step 2A to identify whether the claim is directed to (recites) a "product of nature" exception. This analysis compares the nature- based product in the claim to its naturally occurring counterpart to identify markedly different characteristics based on structure, function, and/ or properties. The analysis proceeds to Step 2B only when the claim is directed to an exception (when no markedly different characteristics are shown) .

EXAMPLES OF ELIGIBLE SUBJECT MATTER

- Changes in the physical or chemical structure of a composition that differ from the naturally occurring composition can demonstrate markedly different characteristics.
- A process of practical application of a naturally occurring composition that includes more than conventional steps.
- A genetically modified bacterium that has different functional characteristics from the naturally occurring bacteria.
- An isolated nucleic acid comprising a sequence that has 90% identity to a specified naturally occurring sequence and contains at least one substitution modification relative to the specified naturally occurring sequence.

EXAMPLES OF INELIGIBLE SUBJECT MATTER

- A purified composition that does not differ in structure or function from the naturally occurring composition.
- A mixture of bacteria where there is no indication that the mixture has any characteristics that are different from the individual naturally occurring bacteria.
- An antibody to protein S where there are antibodies to the protein in some but not all species because the claim doesn't distinguish between the classes of antibody. If limited to a species that does not normally produce the antibody, the claim can be eligible.
- An isolated man-made human cell if the cell has any naturally occurring counterparts.

WHO IS AN INVENTOR?

- **Inventorship Guidelines**
  - An inventor is a person who alone or jointly with another inventor conceives an invention claimed in a patent application or patent, not someone who only reduces an invention to practice based on someone else's conception.
  - Conception occurs when an inventor or inventors have a definite and permanent idea of an operative invention, including every feature of the subject matter sought to be patented.
  - Conception does not exist when the viability of the invention is uncertain. Often experimentation is needed to confirm the invention's viability. In that case, conception occurs at the same time the invention is "reduced to practice."

NOVELTY: When is it Prior Art?

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Novelty of Claimed Invention: 35 U.S.C. §102

Pre-AIA Law

A person shall be entitled to a patent unless the invention

- was known or used by others in this country **before the invention** thereof by the applicant ,
- patented or described in a printed publication in this or a foreign country either **before the invention** thereof by the applicant or *more than one year prior to the date of the application*
- in public use or on sale in this country more than one year prior to the date of the application for patent in the United States

Under the AIA

A person shall be entitled to a patent unless –

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public **before the effective filing date** of the claimed invention; or

(2) the claimed invention was described in a patent or a published application naming a different inventor and was effectively filed **before the effective filing date** of the claimed invention.

Novelty *(continued)*

Pre-AIA Law

A person shall be entitled to a patent unless the invention

- was first patented by the applicant in a foreign country on an application filed *more than twelve months* before the filing of the U.S. application.

- was described in a published application or patent by another filed in the United States before the invention by the applicant

- was not invented by the applicant

Under the AIA

Exceptions –

- Direct or indirect disclosures by an inventor *not more than one year* before the effective filing date.

- Disclosures by anyone occurring *less than one year* before the effective filing date and after a direct or indirect inventor disclosure.

- Disclosures in patents or applications where the subject matter was obtained directly or indirectly from an inventor.

NOVELTY UNDER AIA: EXCEPTIONS *(CONTINUED)*

- Disclosures in patents or applications having effective filing dates after a direct or indirect inventor disclosure.

- Patents or applications that, not later than the effective filing date, were "owned by the same person or subject to an obligation of assignment to the same person."

  - Joint research agreements entered into before the effective filing date can create common ownership if the invention arose from the joint research and the parties to the agreement are disclosed in the application.

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AIA Statutory Framework

Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
102(a)(1) Disclosure with Prior Public Availability Date	**102(b)(1)**	**(A)** Grace Period Disclosure by Inventor or Obtained from Inventor
		(B) Grace Period Intervening Disclosure by Third Party
102(a)(2) U.S. Patent, Published U.S. Patent Application, and Published PCT Application with Prior Filing Date	**102(b)(2)**	**(A)** Disclosure Obtained from Inventor
		(B) Intervening Disclosure by Third Party
		(C) Commonly Owned Disclosures

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One Year Grace Period
Exception to Potential Prior Art

- For the exception to apply, the public disclosure must be:
- within one year prior to the application filing date, and
- an "inventor-originated disclosure" (i.e., the subject matter in the public disclosure must be attributable to the inventor, one or more co-inventors, or another who obtained the subject matter directly or indirectly from the inventor or a co-inventor).

Exception to Potential Prior Art

- For the exception to apply when there is a third party disclosure prior to the application date, the third party's disclosure must have been made during the one year grace period before the filing date of the claimed invention;

- For the exception to apply to a third party's U.S. patent document as potential prior art, the third party's U.S. patent document must have been effectively filed before the effective filing date of the claimed invention; and

- In each case, an inventor-originated disclosure/patent document (i.e., shielding disclosure) must have been made prior to the third party's disclosure/patent document, and

- both the third party's disclosure/patent document and the inventor-originated disclosure/patent document must have disclosed the same subject matter.

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Common Owner Exception to Potential Prior Art

For this exception to apply, the subject matter of the U.S. patent document and the claimed invention in the application under examination must have been:

- owned by the same person,
- subject to an obligation of assignment to the same person, or
- deemed to have been owned by or subject to an obligation of assignment to the same person, in view of a joint research agreement,

in each case, not later than the effective filing date of the claimed invention.

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Recognizing an Exception to a Potential Reference

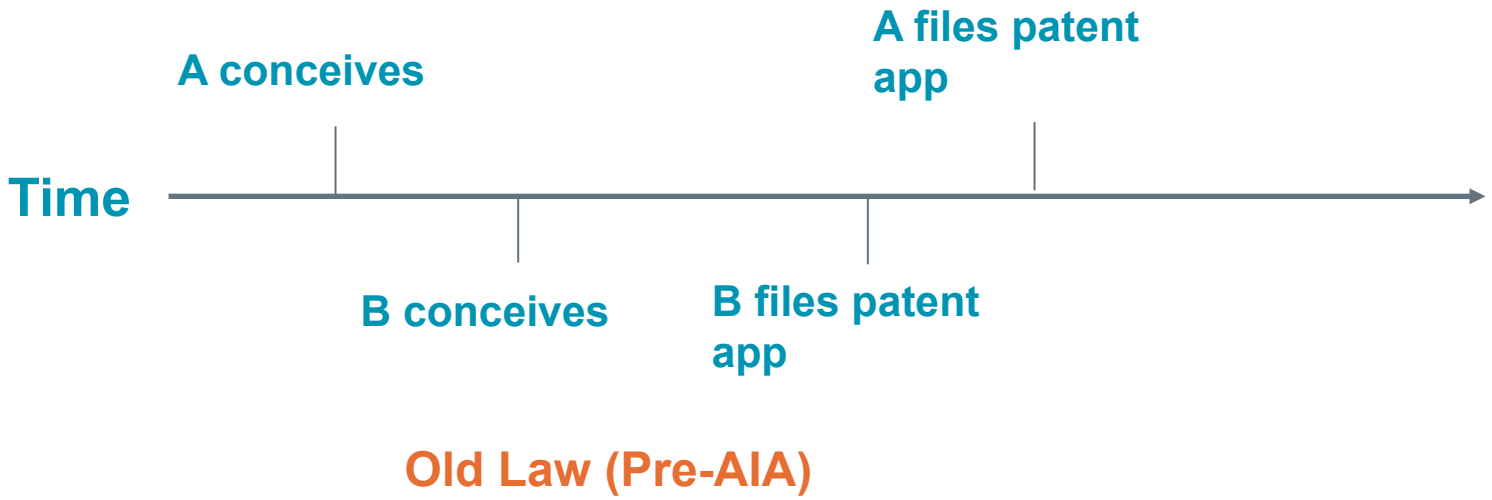
For the joint research agreement exception to apply,

- A statement on the record that either common ownership or a joint research agreement were in place may be made.
- In the case of a joint research agreement , the application must name or be amended to name the parties to the joint research agreement .

PRE-AIA: FIRST TO INVENT

- Prior to AIA, US was "First-to-Invent" patent system
  - If two people file applications for the same invention, the patent went to the person who ***conceived*** of the invention first (assuming diligence)

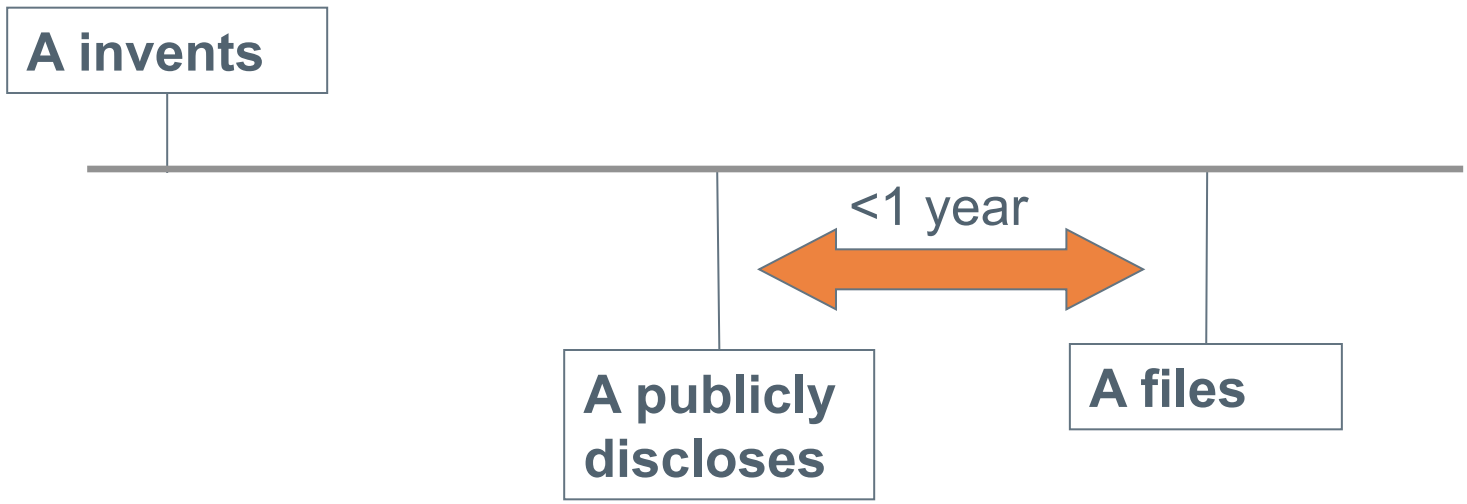
FTI: patent to A



Timeline: Example 1

FTI: patent to A

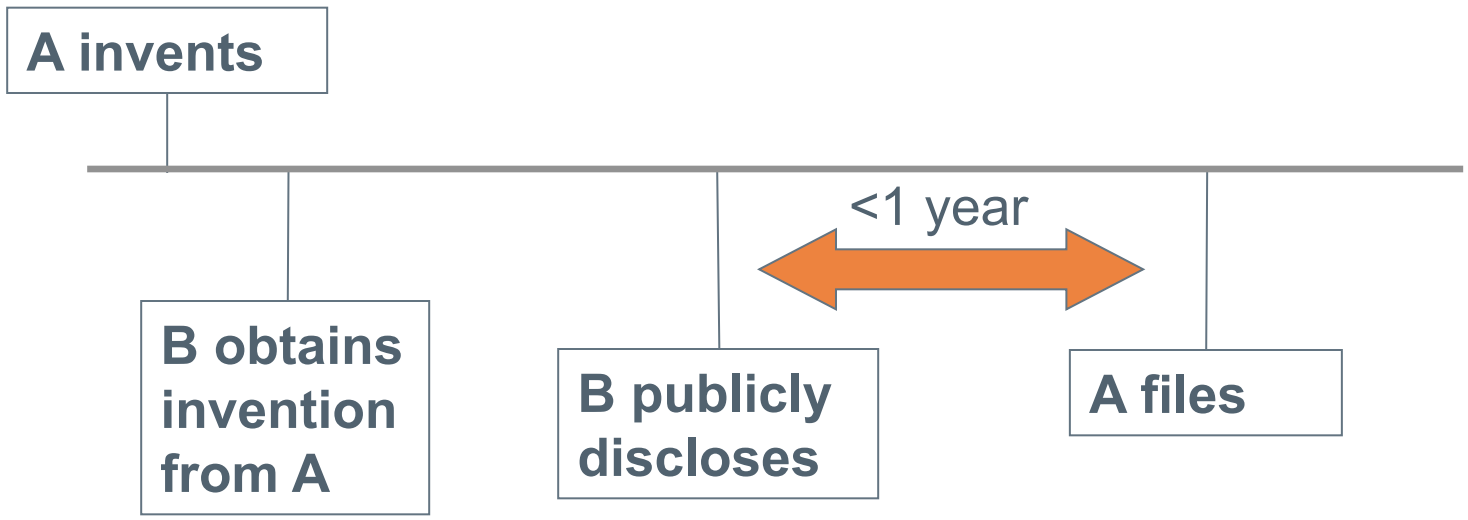
FITF: patent to A



Timeline: Example 2

FTI: patent to A

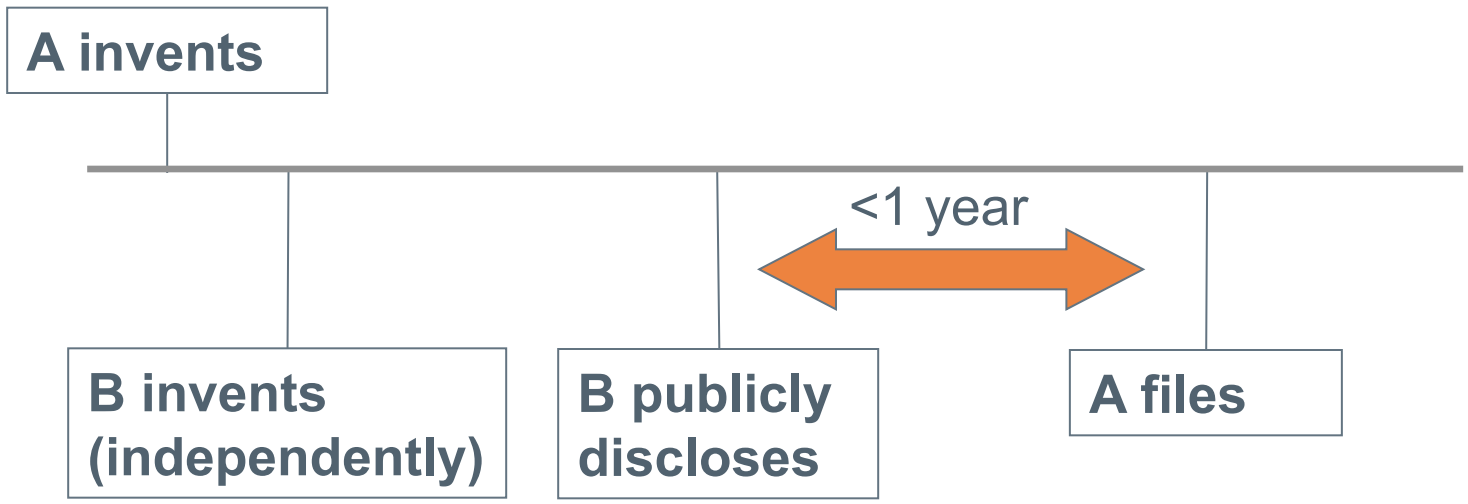
FITF: patent to A



Timeline: Example 3

FTI: patent to A

FITF: no patent to A

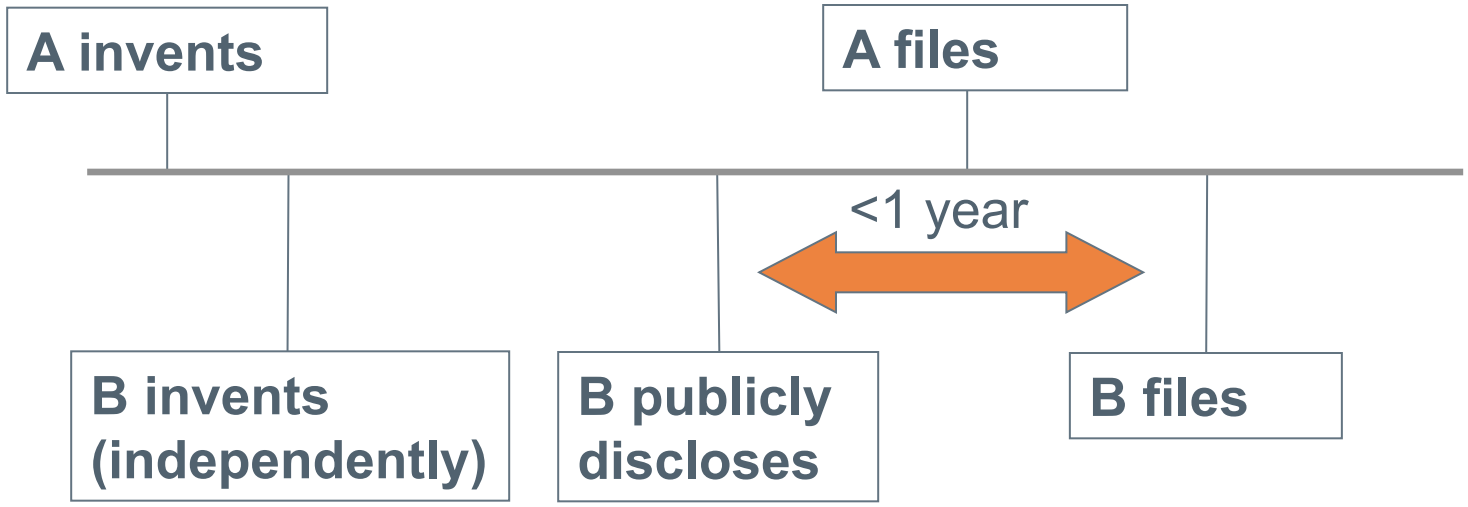


Timeline: Example 4

FTI: patent to A

FTF: patent to nobody

FITF: patent to B



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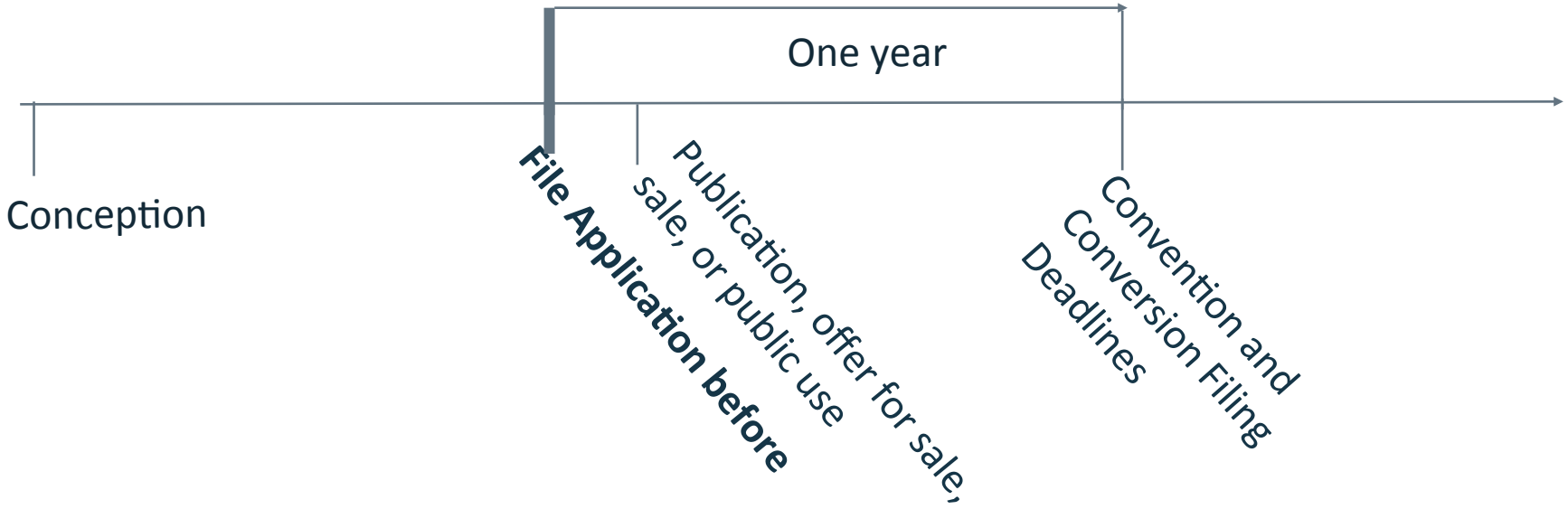
Foreign Filing: When is it time to file?



Absolute Novelty Outside the United States

If patent protection outside the United States is desired, then the US patent application has to be filed ***before*** any of the foregoing events.

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What happens when more than one patent or application claims the same subject matter?

Pre-AIA law

Interference practice

- used to determine who invented first.
- Contested rights were most often granted to the first to conceive (*i.e.*, the first to invent).
- The time between conception of the claimed subject matter and reduction to practice is relevant to show diligence and non-abandonment.

Under the AIA

Derivation practice

(effective as of 3/16/13)

- used to determine whether the applicant of the earlier-filed application derived the claimed subject matter from the applicant of the later-filed application.
- Contested rights are to be granted to the applicant of the earlier-filed application unless that applicant derived the claimed subject matter from the applicant of the later-filed application.

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THINGS NOT TO DO BEFORE FILING IF PROTECTION OUTSIDE THE US IS TO BE SOUGHT

- Publish manuscript, paper or thesis – beware of early electronic publishing
- Disclose invention in a presentation, including poster presentations
- Discuss with anyone without a confidentiality agreement
- Offer for Sale or other *public* commercial activity
- Submit a non-confidential grant application
- All parties privy to invention (employees, research partners and sales force) must be advised adequately of, and be subject to, confidentiality requirements and practice them
- *Publicly* Use Invention for its intended purpose
- Engage in Experimentation without meticulous record keeping of activities and results

OBVIOUSNESS

Nonobviousness of Claimed Invention
35 U.S.C. §103

Pre-AIA Law

A patent may not be obtained if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art to which the subject matter pertains.

Under the AIA
(effective as of 3/16/13)

A patent for a claimed invention may not be obtained if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.

NONOBVIOUSNESS: THE SUPREME COURT WEIGHS IN

There are two U.S. Supreme Court decisions that are central to a determination of obviousness notwithstanding the AIA :

1. *Graham v. John Deere & Co.*, 383 U.S. 1 (1966)

2. *KSR International Co. v. Teleflex Inc. (2007)*

NONOBVIOUSNESS *(CONTINUED)*

In *Graham v. John Deere*, the Supreme Court held that, under 35 U.S.C. §103,

obviousness or nonobviousness of the claimed subject matter is determined by looking to:

1. the scope and content of the prior art;

2. the differences between the prior art and the claims at issue; and

3. the level of ordinary skill in the pertinent art; and

4. secondary considerations such as commercial success, long felt but unresolved needs, and the failure of others.

NONOBVIOUSNESS *(CONTINUED)*

In *KSR* , the U.S. Supreme Court rejected rigid tests for obviousness and reaffirmed the approach taken in *Graham v. John Deere* with considerable elaboration.

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WHAT IS OBVIOUS UNDER *KSR*?

- Combining prior art elements according to known methods to achieve predictable results
- Simple substitution of one known element for another to obtain predictable results
- Use of known techniques to improve similar devices (methods, or products) in the same way
- Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results
- "Obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success
- Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or market forces if the variations would have been predictable to one of ordinary skill in the art.

NONOBVIOUSNESS AFTER *KSR*

- How To Rebut A Showing Of Obviousness
  - Rebutting the Functional Test:
    - The invention is not merely a combination of known elements
    - The invention has an unexpected result
  - Show that there would be no motivation to Combine Prior Art
    - The references "teach away" from the proposed combination
  - Rebutting "Obvious to Try"
    - At the time of the invention, there was not a small number of possible solutions, but a large number or broad range of them.
    - At the time, the solution chosen did not appear to have a reasonable likelihood of success.

DESCRIPTION REQUIREMENTS

U.S. Utility Patent Applications

Provisional

No Claims necessary (but recommended)

Lower Filing fees ($260* + $400/each 50 pages over 100)

Will not be examined

Expires one year from filing.

Must be converted into a Non-provisional claiming priority to the provisional within 1 year of filing.

Must satisfy invention disclosure requirements of §112 with respect to claims of the eventual non-provisional

Non Provisional

Claims required that satisfy requirements of §112, 2d paragraph of Patent Statute

Higher Filing fees, plus examination and search fees ($1600* + $400/ each 50 pages over 100 + $80/claim in excess of 20 & $420 /independent claim in excess of 3)

Will be examined and
Can mature into patent

Must satisfy invention disclosure requirements of §112 of Patent Statute

** All fees subject to change; 50% reduction for small entity; 75% reduction in some fees for micro-entity; does not include lawyers' fees.*

DESCRIPTION REQUIREMENTS
35 U.S.C. §112, 1ST AND 2d PARAGRAPHS

Disclosure and Claiming Requirements

- Description of the Invention.
- Manner and Process of Making and Using the Invention Sufficient to Enable One Skilled in the Art to Make and Use the Claimed Invention
- Best Mode
- Claiming with Particularity and Distinctness

WRITTEN DESCRIPTION REQUIREMENT

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail such that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention at the time the application was filed.

HOW DO YOU SHOW POSSESSION OF THE INVENTION?

- By describing the claimed invention with all of its limitations and for all embodiments sought, using: words, structures, figures, diagrams, and formulas.

- The disclosure obligation varies with the maturity of the art to which the invention pertains.

- It is better to err on the side of over-inclusiveness and over-description. The unacceptable alternative is non allowance or an unenforceable patent.

SEQUENCE LISTINGS

For purposes of uniformity in patent documents and to enable accurate classification and searching, information provided about nucleic acid and amino acid sequences must conform to internationally recognized standards and symbols

ENABLEMENT REQUIREMENT

"The specification shall contain a written description … of the manner and process of making [*the invention*], in such full, clear, concise, and exact terms as ***to enable any person skilled in the art*** to which it pertains, or with which it is most nearly connected, ***to make and use*** the same,.."

ENABLEMENT *(CONTINUED)*

The test for enablement is whether one reasonably skilled in the art could make and use the full scope of the claimed invention from the disclosures in the patent, at the time the application was filed, coupled with information known in the art without undue experimentation.

ENABLEMENT: WHAT IS UNDUE EXPERIMENTATION?

The test is not whether any experimentation is necessary or even complex, time consuming or expensive – it is whether the experimentation is undue.

Is it routine or does it require independent development?

ENABLEMENT: CORRELATION OF ANIMAL MODELS

- There must be correlation between *in vivo* or *in vitro* animal model assays or treatments with the claimed use.
- If there is a known correlation of the disclosed animal model to a particular human condition, then an example using that animal model will constitute a working example.
- Without a known correlation, the example alone does not correlate and therefore, is not enabling.

ENABLEMENT: DEPOSIT OF BIOLOGICAL MATERIALS

- A deposit made in a recognized depository (for example, the ATCC) of a viable biological material together with as much information as is possible to permit verification that the deposited material is in fact what is disclosed in the application and to aid in the resolution of infringement questions.
- Includes bacteria, fungi, eukaryotic cells, plant tissue cells and cell lines, hybridomas, plasmids, viruses and seeds.
- Replacements must be made if needed while application is pending and after patent issues. Deposit must be maintained for 30 years from the date of deposit and at least 5 years after the last request for a sample.

PATENTS: GOOD PRACTICE

- File early and often – utilize provisional applications, with attention to scope of disclosure.
- Maintain the invention in confidence until after the patent application is filed.
- Maintain substantiated records of all disclosures to anyone else, any publications, uses, and offers for sale.
- Search for relevant prior art well before filing, even at the R&D phase, so you can design around the closest prior art.
- Determine the scope of desired protection available in view of the prior art and commercial expectations – think of commercial uses for your invention.
- Conduct experiments or gather information to support the desired scope.
- Be over-descriptive in the application - your target audience includes patent examiners, judges, and juries. Laws vary among countries and may change, requiring more stringent examination and interpretation of patent claims.

NEW PRE & POST GRANT PROCEEDINGS

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TIME LINE: PROSECUTION AND POST GRANT PROCEEDINGS

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Inter partes review →

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Will reject or allow claims based on compliance with patentability requirements

Post-grant review →

Patent Issue Date

9 months from issue

Pre-allowance final rejections, PGR, *Ex Parte* Re-exam & IPR are all appealable

Prompt prior art submissions by applicants in Information Disclosure Statements throughout prosecution are required.

Third party submissions are also permitted.

→ Patent may be enforced after issuance

THIRD PARTY SUBMISSIONS

- Pre-Issuance
  - Under the AIA, third parties may submit any prior art patent, published patent application, or other printed publication during early prosecution.
  - Time Limit – Must be filed before the earlier of (i) the date of a notice of allowance; or (ii) the later of (a) six months from the first publication, or (b) the date of the first rejection.
  - Effective since 9/16/12 against any applications filed before, on or after that date.

POST-GRANT OPPOSITION PROCEEDINGS

- Proceeding at Patent Office to invalidate an issued patent
- Alternative to litigation
  - Less expensive than litigation
  - Fewer grounds to invalidate patent than in litigation
- Often requested early in litigation, with litigation then suspended until reexamination is concluded

PRE-AIA POST GRANT OPPOSITION PROCEEDINGS

- Ex parte reexamination
  - Requestor does not participate other than filing request
  - Implemented in 1981
  - All claims confirmed – 21%; All claims canceled – 11%
  - About 750-800 filed per year
  - Average pendency 28 months
- Inter partes reexamination
  - Requestor is permitted to participate throughout
  - Implemented in 1999
  - All claims confirmed – 21%; All claims canceled – 42%
  - Growing popular; 530 filed in 2012
  - Average pendency 40 months

~~Post~~ PRE-AIA POST GRANT OPPOSITION PROCEEDINGS

- Ex parte reexamination
  - Requestor does not participate
- ~~Inter partes reexamination~~
  - ~~Requestor is permitted to participate~~
- Inter partes review (IPR)
- Post-grant review (PGR)
  - Only for patents subject to FITF
  - Can only be initiated in first 9 months after patent issues
  - More grounds to invalidate than other procedures

POST GRANT PROCEEDINGS

- **Types of Proceedings**
  - **Proceedings for challenging a patent**
    - Post grant review - effective for applications filed on or after 3/16/13
    - *Inter partes* review - applies to all patents
    - *Ex parte* Reexamination
  - **Procedures for defending a patent**
    - Supplemental Examination
  - **Post-Issuance Third Party Submissions** - New category of submission created by AIA for statements made by the patent owner in a proceeding before a Federal court or the USPTO in which the patent owner took a position on claim scope
    - The USPTO may only consider submissions for determining, "the proper meaning of a patent claim" in a reexamination, *inter partes* review or post grant review.

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COMPARISON OF PROCEDURES

	Post Grant Review	Ex parte reexam	Inter partes review
Standard	more likely than not that at least 1 of the claims challenged is unpatentable, or there is a novel or unsettled legal question	Substantial new question	Reasonable likelihood of success
Based on	Any Patentability Requirement (§§ 101, 102, 103, 112) for AIA applications	Prior art patents and publications	Prior art patents and publications
Identity of real party in interest	Yes	No	Yes
Current Filing Fee	$30,000 + excess claims fees	$12,000 + excess claims fees	$23,000 + excess claims fees
PTO decision by	Patent Trial and Appeal Board (PTAB)	Panel of 3 patent examiners	Patent Trial and Appeal Board (PTAB)
Requestor's participation	Limited	Limited	Continued
Timing	Can be filed up to 9 months after grant and is to be concluded within 1 yr. of decision to review patent	"special dispatch" Avg. 2-3 yrs	Can be filed only after 9 month PGR period and is to be concluded 1 yr. from grant of petition
Appeal	Patentee and/or requestor	Patentee but not requestor	Patentee and/or requestor
Discovery	No	No	Yes
Estoppel	Yes	No	Yes

SUPPLEMENTAL EXAMINATION

- Supplemental examination may be used by a patent owner to request USPTO consideration of issues and information that may not have been considered during prosecution.
- Supplemental examination can remove issues that would otherwise render the patent unenforceable, including possibly inequitable conduct, if the issues are raised during supplemental examination.
- But, if the PTO believes there was fraud during the initial examination, it will refer the matter to the Department of Justice
- The fee for each request is $4,400 plus extra fees for excessive pages of submissions or pages of application, and an additional $12,100 if the PTO re-examines the patent, all due upon filing the request
- Re-exam will be initiated if the PTO determines that a substantial new question of patentability exists

K&L GATES

Thank You

Christine Ethridge