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Inter Partes Review for U.S. Patent Invalidation (IPR) – The IPR Petition

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An IPR may be filed after termination of a post-grant review or after a patent has been issued for more than nine months, whichever is later. A person who is not the owner of the patent at issue (the petitioner) may initiate an IPR by filing a petition with the U.S. Patent Office (Petition). However, an IPR is not available to:

1. The owner of the patent.
2. A petitioner or real party-in-interest which filed a civil action in federal district court challenging the validity of a claim of the patent. This prohibition does not apply to a petitioner who included a validity defense or challenge as part of a counterclaim filed in response to a civil action brought against the petitioner.
3. A petitioner, the petitioner's real-party in interest or a party in privy with the petitioner who has not filed the IPR within one year of being served with a complaint for infringement the patent in a civil action.
4. A petitioner, the petitioner's real-party in interest or a party in privy with the petitioner who is estopped from challenging the claim(s) of the patent.

See, 35 U.S.C. §§312, 315, and 37 C.F.R. §42.101.

As to format, the Petition must be less than 60 pages long and have page sizes of 8½ by 11 inches. The Petition text must be double space and be set out in a at least a 14-point proportional font with no more than 4 characters per centimeter and be within margins of no less than 1 inch. The page limit does not include a table of contents, a table of authorities, a certificate of service or appendix of exhibits. See, 37 C.F.R. §§42.6 and 42.24.

From a procedural standpoint, to obtain a filing date, a Petition must include the following:

1. The petition fee ($9,000 request fee, $14,000 institution fee and $200/claim over 20). See, 35 U.S.C. §312 and 37 C.F.R.§§ 42.103, 42.15.
2. A certification that the patent at issue is available for an IPR and that the

petitioner is not barred or estopped from requesting an IPR for the patent at issue.

3. A statement of precise relief requested for each claim challenged, which includes the following for each claim challenged:
    - construction of the claim including, for some claim formats, references to the patent specification;
    - the statutory grounds for the challenge, i.e. 35 U.S.C. §102 and/or §103;
    - a discussion of the invalidity of the claim, which includes a precise statement specifying where each element of the claim is found in the prior art;
    - references to evidence by exhibit number;
    - >the relevance of the evidence to the respective validity challenge; and
    - >references to the specific portions of the evidence that support the challenge.

See, 35 U.S.C. ¶312 and 37 C.F.R. §42.104.

The Patent and Trial Appeal Board (Board) has the right to exclude or give no weight to evidence where a petitioner fails to state its relevance or to identify specific portions of the evidence that support the challenge. 35 U.S.C. ¶312(a)(3) and 37 C.F.R. §42.104(b)(5). As a practical matter, a two-column claim chart with the claim elements in the left column and corresponding quotation or specific reference in the right column provides a useful guide for the Board in evaluating the claims against specific portions of the prior art evidence.

In addition to prior art and other documentary evidence (e.g. prior litigation testimony if available), it is useful, and in most cases important, for a petitioner to rely upon expert declarations for purposes of explaining the prior art or other evidence. Attorney argument will not take the place of expert testimony, which, for the petitioner, is initially introduced with a declaration submitted as an exhibit to the petition.

Under 35 U.S.C. §314, the initial goal in drafting a Petition and selecting evidence for the exhibits is to provoke an IPR by convincing the U.S. Patent Office Director that there "is a reasonable likelihood that the petitioner will prevail with respect

to at least 1" of the patent claims challenged. However, a review of the IPR proceedings and decisions to date demonstrate that, to the extent possible, Petitions be drafted and exhibits included to go beyond just obtaining a decision by the director to institute a IPR. The IPR process is set up so that the petitioner has the right to speak first (*i.e.* file the Petition.) Accordingly, the Petition is a petitioner's opportunity to initiate an IPR trial with a well-supported, strong impression of invalidity, that will put the patentee at a disadvantage. This can be a disadvantage and very difficult to overcome given the relatively severe timing and discovery constraints in an IPR. The burden is on the petitioner to prove invalidity by the preponderance of the evidence. However, in a challenge based upon a single piece of prior art and 35 U.S.C. §102, a patentee is confronted with a difficult task of rebutting the challenge. In particular, a patentee rebuttal which includes evidence cannot be filed until after the U.S. Patent office has instituted an IPR (i.e. found that there "is a reasonable likelihood that the petitioner will prevail with respect to at least 1 of the claims challenged").

As a general note, an IPR is a trial and if an IPR is ordered, the Petition and all of the evidence submitted with the Petition are the start of the substantive “trial record.” Given the limitations placed upon IPR discovery, the IPR Petition may be the petitioner's best and least restricted opportunity to introduce arguments and evidence into the IPR trial. Examples of Petitions that meet the requirements discussed above were prepared and filed by the author in IPR Nos. 2012-0006, 2012-0007 and 2013-0011. On March 6, 2014, the Board ruled in favor of the petitioner on all 3 IPRs. A comparison of the three Petitions and written decisions of the Board is instructive.

After prepared and filed, a Petition must be served on the appropriate party pursuant to §§37 C.F.R. 42.6 and 42.105.