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How "Inter Partes Review" Will Reshape Patent Litigation Advice

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AUTHORED ARTICLE | 12.2014

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Michael Garvin, a partner in the Vorys Cleveland office and a member of the litigation group, authored an article for the Canadian Federated Press publication *Intellectual Property*. The article was titled "How "Inter Partes Review" Will Reshape Patent Litigation Advice." The article examined the process for the U.S. Patent and Trademark Office *inter partes review* (IPR) proceedings and the post-grant patent challenges associated with this review process.

The article states:

"To date, IPR has been the most used of the three methods of challenging patent validity in the USPTO since the adoption of the AIA. This has been in part due to the timing of the implementation of those three schemes. In broad terms, in an IPR, the validity of a patent can be challenged on prior art grounds only -either anticipation or obviousness. Rather than taking place before an examiner, IPRs take place before a three-member panel of administrative judges on the USPTO's Patent Trial and Appeal Board ("PTAB"), whose powers over the proceedings are akin to the power that a judge has in cases litigated in court. Both the patent challenger and the patent owner have significant opportunity to argue their cases, first in successive rounds of written memoranda and then ultimately, in an argument made in person before the three judges at the USPTO's headquarters in Arlington, Virginia.

Parties to IPR proceedings are allowed limited discovery for purposes of challenging the arguments and evidence relied on by the other. This form of discovery is nothing like the "wide open" discovery permitted in U.S. courts, but rather is tightly directed to the evidence and arguments presented in the proceeding. Depositions of witnesses are permitted, but those are generally limited to fact and expert witnesses who have provided written affidavits in favour of an adversary's position.

The deadlines for resolving an IPR are comparatively very short. The relevant statute requires an IPR to be concluded within a year of institution (which takes place within six months after the initial petition was filed), but may be extended up to an additional six months in extraordinary circumstances. However, so far, no IPR proceedings have been extended beyond the one-year time limit. An IPR may be instituted at any time after the challenged patent has been issued. However, if the challenger has been sued for patent infringement, the IPR may only be filed within a year after the challenger has been served with the complaint in the district court litigation. When an IPR has been filed during litigation, either party may file a motion with the court to stay the litigation pending the resolution of the IPR proceedings. Thus far, motions to stay litigation pending an IPR have been granted in a slight majority of cases."

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