

# OUR PRACTICE

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## Patent Post Grant Proceedings

### Third Party Patent Office Proceedings

The America Invents Act (AIA) recently created a number of new third-party mechanisms for challenging patents at the United States Patent and Trademark Office (USPTO). Our extensive patent prosecution, litigation and reexamination experience allows us to help you develop a cohesive strategy for challenging third party patents or defending your own patents in these new USPTO proceedings.

### Post-grant Review and *Inter Partes* Review

Post-grant review and *inter partes* review are USPTO proceedings that permit a third party to petition for the cancellation of patents. Key aspects of both:

- They contain significant litigation aspects, including the opportunity for limited discovery.
- They are appealable directly to the Federal Circuit without an administrative appeal.
- They must be completed within 12 months (extendable by six months for good cause).

Post-grant review is available for nine months after issuance or reissue of the patent and may raise any basis for invalidity that could be raised in litigation, including validity challenges under 35 USC §§ 101, 102, 103, and 112 (except for best mode). The third party challenger must establish that at least one claim of the patent is more likely than not to be declared unpatentable, or there exists a novel or unsettled legal question that is important to other patents or patent applications. Post-grant review is only available for patents effectively filed on or after March 16, 2013, and for certain business method patents.

*Inter partes* review permits third parties to challenge validity of a patent on the basis of prior art consisting of patents or printed publications. Successful petitions must establish a reasonable likelihood that at least one claim of the patent is invalid. It is available upon issuance or reissue for all patents effectively filed on or before March 16, 2013, and no earlier than nine months after issuance or reissue for patents effectively filed on or after March 16, 2013.

### Interference Proceedings and Derivation Proceedings

Under the AIA, the United States' patent system will move from first-to-invent to a modified first-to-file model for all applications effectively filed on or after March 16, 2013. For applications under the first-to-invent regime, interference proceedings will remain available to determine the question of who was first to invent. For applications filed under the first-to-file regime, a mechanism exists to determine whether a party derived a claimed invention from someone else, termed a derivation proceeding.

Baker Donelson has a sophisticated team of experienced patent litigators and patent prosecutors to guide you through both new post-grant proceedings and the remaining interference proceedings to help maximize the potential for successful outcomes.