

# Challenging Patents at the USPTO

## 米国特許商標庁における特許無効手続

Knobbe Japan Practice Series

March 4, 2022

Kerry Taylor  
[kerry.taylor@knobbe.com](mailto:kerry.taylor@knobbe.com)

Mauricio Uribe  
[mauricio.uribe@knobbe.com](mailto:mauricio.uribe@knobbe.com)

Kenny Masaki  
[kenny.masaki@knobbe.com](mailto:kenny.masaki@knobbe.com)

# Strategic Importance – Challenging Patents at USPTO

## 米国特許商標庁における特許無効化の戦略的重要性

---

- Outcome/Result: Presumption of validity of issued patent overcome – patent retroactively considered not patentable
- Determination: Considered by USPTO – independent of US district court litigation
- Fees/Costs:
  - Significant investment to challenge patents at USPTO
    - \$300,000 - \$1M in legal fees and government fees is still significant investment
    - Less expensive than traditional validity challenges in US district court litigation

# Strategic Importance – Challenging Patents at USPTO

---

## USPTOにおける特許無効化の戦略的活用

- Strategic Use of Challenges

- Pre-Litigation

- Resolution of licensing disputes in which prior art has been identified – USPTO as independent authority
    - Cancellation or renegotiation of existing license agreements based on challenges to licensed patents
    - Pre-emptive challenge to patents that may be asserted in license letter (e.g., NPE) or may be asserted (e.g., blocking patent from competitor)

# Strategic Importance – Challenging Patents at USPTO

---

## USPTOにおける特許無効化の戦略的活用

- Strategic Use of Challenges

- Litigation

- Parallel challenge to validity before USPTO – may be considered earlier than litigation challenges
    - Support for stay in filed litigation (if filed early)
    - Support against requested preliminary injunctive relief (if filed early)

# AIA Post-Grant Proceedings AIA 特許付与後の手続

---

- *Inter Partes* Review
- Post-Grant Review
- Covered Business Method Patent Review\*
  
- Pre-AIA proceeding still available: *Ex Parte* Reexam

\*Expired as of September 16, 2020

# AIA Post-Grant Proceedings – Overview 手続の概要

---

- Challenge Patentability of One or More Claims in Patent
  - “Preponderance” Standard for Unpatentability
- Conducted at the U.S. Patent Office
  - Patent Trial and Appeal Board (PTAB) Presides
  - Administrative Patent Judges Have Law Degrees and Technical Degrees
- Any Third Party Can File Petition – But Must Identify Real Party In Interest
- Petitioner is Full Participant in Proceedings
- Duration ~18 Months
  - Preliminary Phase ~6 Months
  - Trial Phase ~12 Months
- Appealable Only to Federal Circuit

- Challenges Are Limited To
  - Novelty (102) and Obviousness (103)
  - Patents and Prior Publications
- If Patent Is Asserted in Lawsuit, Must File Within One Year of Being Served With Complaint for Infringement
- Estoppel Applies for Grounds That Reasonably Could Have Been Raised
  - Novelty and Obviousness
  - Patents and Publications

## Post-Grant Review 付与後レビュー

---

- Available Only For First-to-File Patents (Filed After March 15, 2013)
- Challenges Are Broad in Scope: Statutory Subject Matter (101), Novelty (102), Obviousness (103), Indefiniteness (112), Enablement (112), Written Description (112)
- Not Limited To Patents And Prior Publications
- Must Be Filed Within Nine Months Of Patent Issuance
- Estoppel Applies
  - 101/102/103/112
  - Any evidence that reasonably could have been used

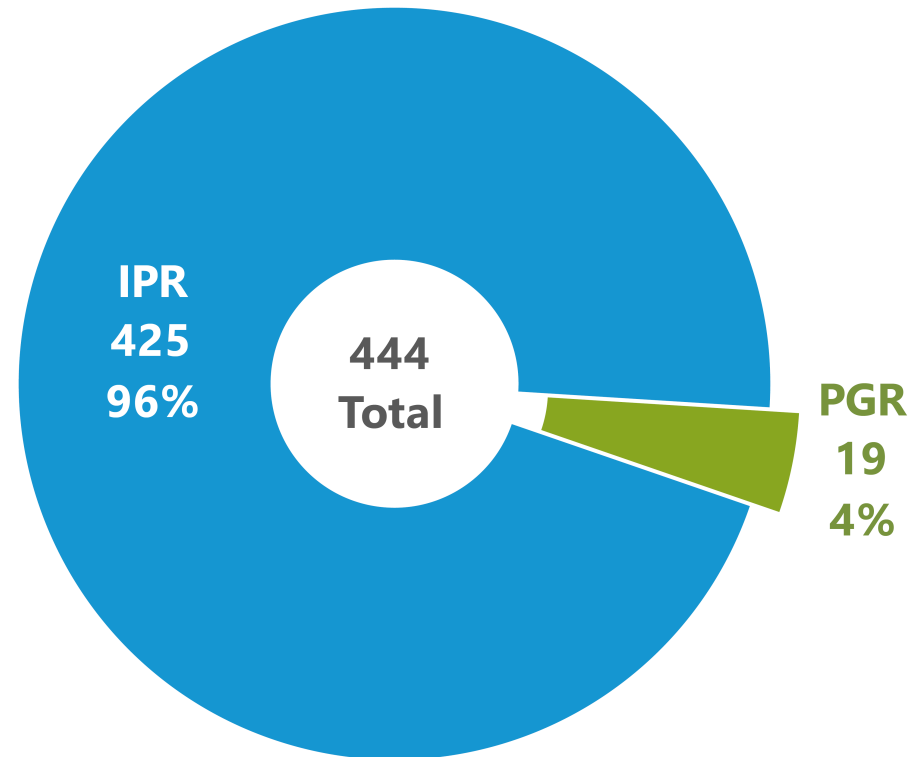


# AIA Petition IPR and PGR Filings Fiscal Year 2022

## 会計年度2022年のIPRとPRGの請求件数

### Petitions filed by trial type

(FY22 through January: Oct. 1, 2021 to Jan. 31, 2022)

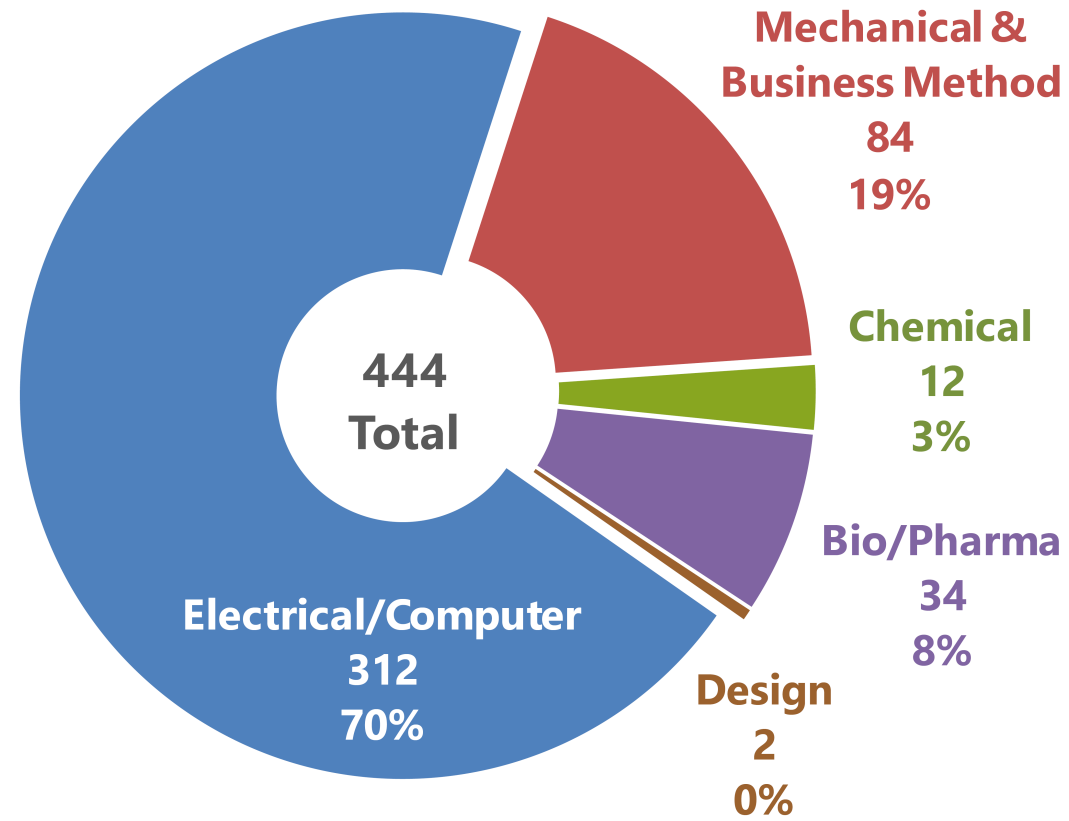


<https://www.uspto.gov/patents/ptab/statistics>

# AIA Petition Filings by Technology in Fiscal Year 2022

## 会計年度2022における技術分野別請求件数

### Petitions filed by technology (FY22 through January: Oct. 1, 2021 to Jan. 31, 2022)



<https://www.uspto.gov/patents/ptab/statistics>

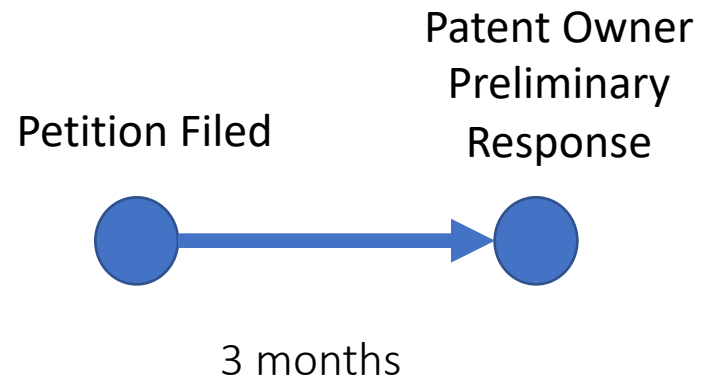
# IPR and PGR – The Petition IPR及びPGR - 請願

---

- Petitions Must Thoroughly Present All Arguments Challenging Patentability of Claims
  - Arguments Must Be In Clear Detail – Grounds of Unpatentability Clearly Explained
  - Include Claim Construction, If Appropriate
  - Cannot Incorporate By Reference Arguments That Are Located in Another Document, e.g., Expert Declaration
- Heavy Front Loading – Detailed Arguments, All Relied-Upon Evidence, and Supporting Declaration(s) Must Be Filed With Petition
  - New Grounds Cannot Be Introduced Later in Proceeding

# IPR and PGR Timeline – First Steps

# タイムライン第一段階



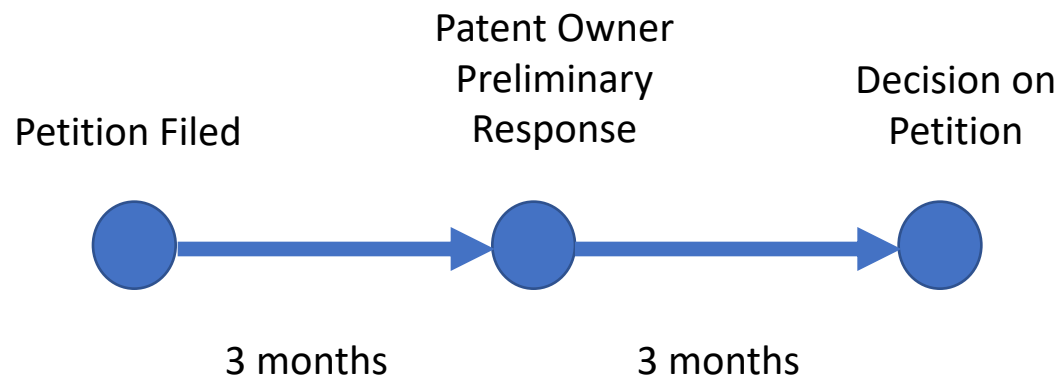
# IPR and PGR – Preliminary Response 予備的答弁

---

- Patent Owner May File Preliminary Response To Petition
  - Directed To Reasons Why Review Should Not Be Instituted
  - Declaration(s) Permitted
- Strategies:
  - Focus on Procedural Shortcomings and Sufficiency of Arguments
  - Present Discretionary Denial Arguments
  - Consider Whether Substantive Argument Can Be More Successfully Raised At Later Stage

# IPR and PGR – Preliminary Phase Timeline

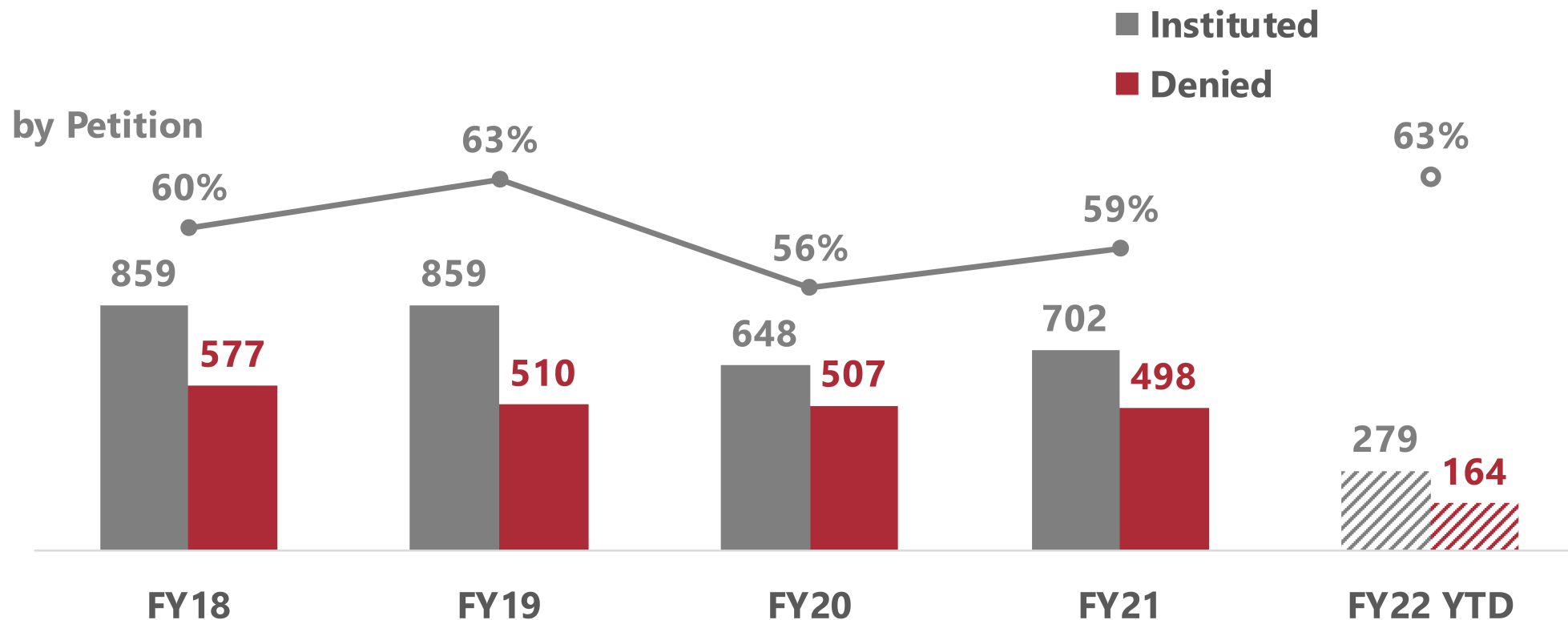
予備段階の流れ



# Trial Institution Rate 審理開始の割合

## Institution rates by petition

(FY18 to FY22 through January: Oct. 1, 2017 to Jan. 31, 2022)



<https://www.uspto.gov/patents/ptab/statistics>

© 2022 Knobbe Martens

# IPR and PGR Review – Trial Phase 審理段階

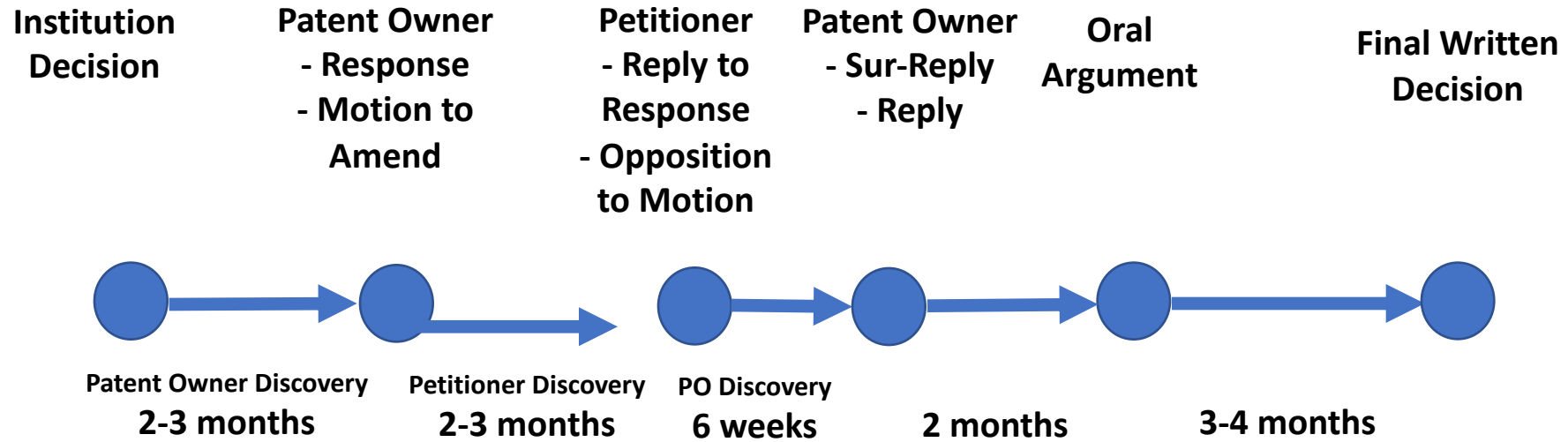
---

- After Institution Decision, the Term “Trial” Refers to the Entire Remainder of IPR or PGR Review Proceeding
- During the Trial Phase:
  - Both Parties Conduct Depositions of Witnesses
  - Patent Owner Files:
    - Response
    - Motion to Amend (Optional)
  - Petitioner Responds to Patent Owner’s Filings
  - Last Step For Parties is Oral Hearing
- Trial Phase Ends When the Board Issues Written Decision



# IPR and PGR – Trial Phase Timeline

# 審理段階の流れ



- Patent Owner Addresses the Petition
  - Must Include All Arguments Patent Owner Wants to Make – No New Arguments Permitted Later
    - But Patent Owner Can Elect to Not Defend All Claims
  - Can Include Claim Construction
  - Declaration(s) Permitted
- Strategies:
  - Focus on Substantive Issues
  - Provide Evidence to Rebut Petition

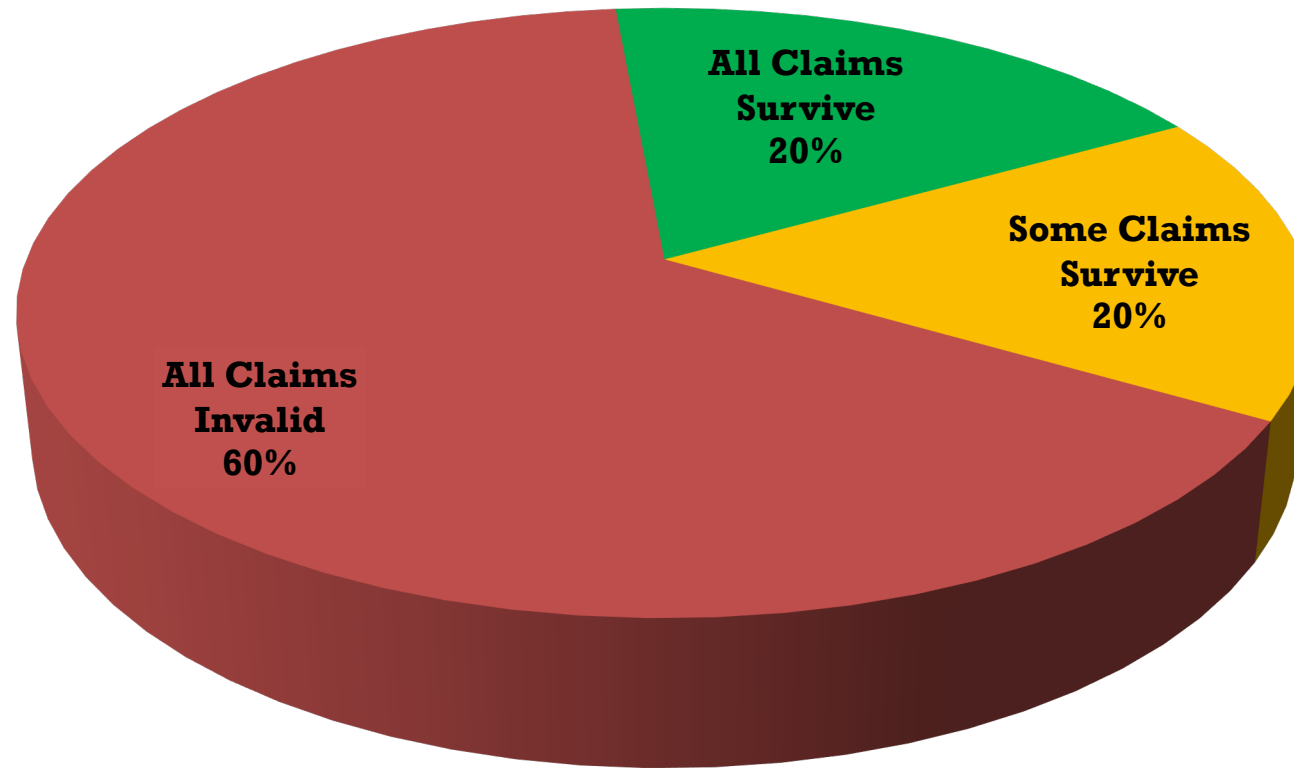
# IPR and PGR – Motion to Amend 補正請求

---

- Patent Owner May File a Motion To Amend The Claims
  - Cannot Broaden Claims
  - Must Respond to Grounds in Petition
- Petitioner Bears The Burden Of Demonstrating Unpatentability
- Low Success Rate - ~20% of Motions to Amend Are Granted
- Optional Pilot Program Provides Preliminary Guidance from PTAB

# IPR and PGR Final Written Decisions – Fiscal Year 2021

## IPRとPGRの最終決定書の結果



~20% of Motions to Amend are Granted

# Knobbe Martens

Thank you!

Kerry Taylor  
[kerry.taylor@knobbe.com](mailto:kerry.taylor@knobbe.com)

Mauricio Uribe  
[mauricio.uribe@knobbe.com](mailto:mauricio.uribe@knobbe.com)

Kenny Masaki  
[kenny.masaki@knobbe.com](mailto:kenny.masaki@knobbe.com)