

# Buchanan IP® - Patent Office Litigation

Your Patent Rights – New Rules and More Challenges

With the advent of the America Invents Act, the Patent Trial and Appeal Board (PTAB) of the U.S. Patent and Trademark Office (USPTO) has become a destination for many validity challenges to parties in district court litigation. Parties are challenging and defending patent rights before the PTAB in response to infringement allegations in district court, to pursue licensing agreements, and to protect or remove patent rights in contested technological areas.

## Why the PTAB for Post-Grant Proceedings?

*Inter Partes* Reviews (IPRs), Covered Business Method Reviews (CBMs) and Post-Grant Reviews (PGRs) before the PTAB offer an efficient way to challenge and defend patent rights. PTAB judges are trained to hear validity challenges involving highly technical, scientific, and patent law concepts—and at a lower cost than traditional district court litigation.

## How We Can Help You

Our successes before the PTAB are built upon our decades of handling complex, adversarial interference proceedings before the PTAB. Because we have one of the most active post-grant practices in the country, with nationally recognized attorneys and staff dedicated to post-grant challenges before the PTAB, we are able to devise creative and effective strategies that offer you efficient alternatives or adjuncts to district court litigation.

### *Inter Partes* Review, Post-Grant Review and Covered Business Method Review

On behalf of petitioners in IPR, PGR and CBM proceedings before the PTAB, we have obtained cancellation of challenged claims and defended the cancellation of those claims on appeal before the U.S. Court of Appeals for the Federal Circuit. On behalf of patent owners, we have defended the validity of claims challenged in IPR and CBM proceedings by persuading the PTAB to deny institution of review or uphold the validity of the claims in final written decisions. We assist clients in settling disputes before the PTAB. We also successfully defend clients in appellate proceedings before the Federal Circuit.

## Patent Interference, *Ex Parte* Reexamination and Patent Reissue

In patent interferences, one party challenges a competitor's right to a patent, and the PTAB must determine who was the first to invent. Interferences are complex, adversarial proceedings that we have been successfully handling for decades. *Ex parte* reexamination often occurs in parallel to other challenges to patents, and requires skillful advocacy before the Central Reexamination Unit of the USPTO. Reissue proceedings can be an effective procedure for patent owners to engage in further prosecution of an issued patent, although there are risks. Our team has earned a national reputation for providing highly effective representation in interferences, *ex parte* reexamination, and reissues. We are ready to advise you on the risks and guide you through these complex, high-stakes proceedings.

## Derivation Proceedings and Supplemental Examination

Our attorneys represent clients in derivation proceedings and supplemental examinations. A derivation petition is a patent challenge by an inventor who is not the first to file a patent application but believes that the first to file a patent application derived the invention from the inventor. To protect a patent from any possible defects that a challenger might raise against the patent in litigation, a patent owner may request a supplemental examination, asking the USPTO to consider, reconsider, or correct information that the patent owner believes is relevant.

## IPRs, PGRs, and CBMs

### How We Help Petitioners

- Identify Effective Prior Art
- Work with Experts to Present Effective Challenges
- Formulate Effective Challenges to Targeted Claims
- Draft Persuasive Petitions, Replies and Motions

### How We Help Patent Owners

- Develop a Coherent Patent Protection Strategy
- Work with Experts to Formulate Protection Strategy
- Effectively Contest Challenges to Patent Rights
- Draft Persuasive Responses and Motions

## Patent Interferences

- Defend Clients' Patent Rights When Competitors Provoke Interferences
- Handle Multi-Party and Multi-Application Interferences
- Handle Appeals of PTAB Decisions on Interferences
- Handle Specialized Appeals in the Court of Appeals for the Federal Circuit
- Handle Specialized Appeals in District Court Litigation Under 35 U.S.C. § 146
- Negotiate Settlements and Licensing Agreements to Resolve Interferences

**80+ years practicing IP law**

**45+ registered patent attorneys**

**3 post-grant practitioners nationally recognized by IAM 1000**

**65+ AIA post-issuance proceedings litigated before the PTAB**

**30+ years of experience in post-issuance practice**

**80+ interference proceedings litigated before the PTAB**

**165+ reexamination proceedings**

## ADVANCING OUR CLIENTS' GOALS

### Making It All Right Again

Our IP team forced a multi-million dollar settlement by one of the world's largest technology companies in support of our client's post-grant defense of its patent for an advanced data organization system.

### A Clean Sweep

Our post-grant team protected the valuable patents of a client going six for six in thwarting the institution of IPR petitions in the biotechnology space.

Learn more at **BIPC.com** and Subscribe to **Buchanan PTAB Report**  
at **Buchanan-IP.com/PTAB** for the latest USPTO PTAB insights and resource information.