

USPTO PATENT TRIALS AND REEXAMS

OVERVIEW

Bryan Cave Leighton Paisner is a leading firm for handling high-value patent challenges for Fortune 500 technology companies before the U.S. Patent and Trademark Office (USPTO). Our Patent Trials and Reexaminations Team regularly assists clients in various post-grant review proceedings, which present a potentially faster and more cost-efficient way to resolve patent disputes outside of federal court. Our team has substantial experience using these proceedings concurrent with litigation, to help dispose of bet-the-company claims. Clients turn to us to defend the validity of their patents when such proceedings are initiated against them.

With our combined depth of experience in patent prosecution and litigation, we have a strong record practicing before the USPTO and the Patent Trial and Appeal Board (PTAB), as well as the trial experience key to handling inter partes reviews and other PTAB proceedings.

We help our clients determine which of the following USPTO proceeding presents the best opportunity to challenge a patent's validity and, when needed, work with clients to defend patents challenged in these proceedings.

***Ex Parte* Reexamination:** In this proceeding, the patent owner or a third party requests USPTO examination of an already-granted patent based on patents and/or printed publications. The requestor must establish that the submitted prior art establishes a substantial and new question of patentability. Once a request is granted the patent owner is responsible for defending the patent before the USPTO (the third party is no longer involved).

Post-Grant Review (PGR): This proceeding allows third parties to challenge the validity of patents for the nine-month period following grant of a patent or issuance of a reissue patent. Any party other than the patent owner and that has not filed a civil action challenging the validity of the patent may file a petition for post-grant review. A petition for post-grant review may be based on any patentability ground available under 35 U.S.C. § 282 (b)(2)-(3).

***Inter Partes* Review (IPR):** This proceeding allows for invalidity challenges based on patents and/or printed publications. Unlike inter partes reexaminations (which this proceeding replaces), it allows the patent owner to respond to and challenge a petition for review, the possibility of an oral hearing before a decision on the merits, limited discovery; and the potential for settlement between the petitioner and the patent owner. This review may not be requested until after the nine-month period allowed for post-grant review, or until any post-grant review proceeding is completed.

Transitional Program for Covered Business Method Patents (CBMR): This is another form of post-grant review. However, there is no nine-month time limit. This option is only available if the petitioner has already been sued for infringement of the patent or has been charged with infringement under that patent.

Our Patent Trials and Reexaminations practice relies on interdisciplinary teams that merge technical, USPTO and district court trial experience to handle post-grant patent review proceedings on behalf of our clients. Our attorneys are registered before the USPTO, have advanced degrees in many technical areas, and regularly appear before the USPTO's Central Examination Unit and PTAB.

MEET THE TEAM



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EXPERIENCE

- **Apple** – Our team’s efforts challenging some of Apple’s most important patents, including the Pinch-to-Zoom patent no. 7,844,915, resulted in the USPTO reexamining and invalidating claims at the center of high-profile litigations in federal courts and before the International Trade Commission. The USPTO’s rejection was affirmed by the Federal Circuit, with a handful of claims being remanded to the office for reconsideration.
- **Symantec**– We represented Symantec in over twenty IPR proceedings and Reexaminations before the PTAB. In some of these IPRs, we defended Symantec’s patents which were challenged by Veeam. One of these matters was appealed to the Federal Circuit where we succeeded in maintaining key claims for U.S. Patent 5,024,527, which is now assigned to Veritas Technologies. We also challenged several patents asserted against Symantec by Finjan, who sued multiple players in the cybersecurity industry for patent infringement. While the IPR proceedings against Finjan have been terminated at the request of both parties, our Reexamination requests challenging certain Finjan patents were granted by the USPTO and remain ongoing.
- **Proofpoint** – We were engaged by this leading cybersecurity company to launch a wave of Reexamination requests challenging the validity of patents related to virus detection software. This builds on our team’s work on behalf of Symantec against the common Finjan plaintiff.
- **Hyundai / Kia** - We initiated nine IPR proceedings challenging the validity of patents related to hybrid vehicles on behalf of prominent vehicle manufacturers. These patents were asserted by Paice and the Abell Foundation against various automakers including Ford and Toyota.
- **STMicroelectronics**– We represented one of the world’s largest semiconductor companies in connection with several Reexamination and IPR proceedings before the USPTO. We have prepared Reexamination requests to challenge patents owned by one of our client’s competitors, as well as opposed reexamination proceedings that were instituted against a number of our client’s patents. We have also defended our client in IPR proceedings that were instituted against some of its patents.