POST-GRANT REVIEW TRIALS - PGRT Basics

Intellectual Property 401

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Meet the Faculty

Panelists

Jeremy Albright - Norton Rose Fulbright US LLP

Brooke Parker - Haynes and Boone

Andrea Shoffstall - Unified Patents

Moderator

David Tobin - McDermott Will & Schulte LLP

About This Webinar

PGRT Basics

- This segment will discuss the statutory and procedural background of post-grant review proceedings.
- It will discuss the types of proceedings available and provide a high-level discussion of how the proceedings are conducted.

About This Series

IP- 401: Post-Grant Review Trials 2025

- The series is intended to give attendees a crash-course in post-grant review proceedings at the U.S. Patent and Trademark Office. Many topics will be addressed, sufficient to explain the big picture considerations involved in this new and very popular area of law.

- Each Financial Poise Webinar is delivered in Plain English, understandable to investors, business owners, and executives without much background in these areas, yet is of primary value to attorneys, accountants, and other seasoned professionals. Each episode brings you into engaging, sometimes humorous, conversations designed to entertain as it teaches. Each episode in the series is designed to be viewed independently of the other episodes so that participants will enhance their knowledge of this area whether they attend one, some, or all episodes.

Episodes In This Series

#1: PGRT Basics

Premiere date: 8/7/25

#2: Things to Consider Before You File

Premiere date: 9/11/25

#3: Interplay With District Court Litigation

Premiere date: 10/30/25

Episode #1
PGRT Basics

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Overview

Overview of Proceedings

- Post-grant proceedings for challenging patent validity
  - Inter Partes Review (IPR)
  - Post-Grant Review (PGR)
  - Derivation

- "Trials" before the Patent Trial and Appeal Board ("PTAB")

- Allow for limited discovery, not previously available
  - Not "trials" in U.S. district court sense: no live witnesses (with rare exception), no jury, no opening statements, no closing arguments

Overview of the PTAB

- Handles AIA post-grant proceedings, appeals, and derivations

- Staffed by Administrative Patent Judges (“APJ”)
  - Employs roughly 220 APJs
  - Judges typically come from USPTO Examining Corps and private bar

- Each AIA proceeding is decided by a 3-member APJ panel

Overview of PTAB Trials

- Proceedings are initiated with a petition
- Parties may file reply papers
- Parties engage in very limited discovery
- Hearing is conducted on the merits
- Concluded with final written decision unless parties settle

Strategic Considerations

Overview of Advantages

- “Preponderance” v. “clear and convincing”
- Favorable Petitioner success rate
- Potential to stay co-pending district court litigation
- Lower cost than district court litigation and trial
- Quicker to initial resolution than district court litigation

Overview of Disadvantages

- Significant risk of discretionary denial in view of amended procedures
- Estoppel
- Limited opportunity to develop record
- Very limited opportunity to present true testimony
- Patent Owner has the opportunity to amend claims

DJ Actions

- If Petitioner files DJ of invalidity first, no IPR
  - 35 U.S.C. § 315(a)(1); 37 C.F.R. 42.101(a);
  - http://www.uspto.gov/blog/director/entry/ptab_s_quick_fixes_for

- Consider filing DJ of noninfringement; assert invalidity as defense to responsive claim for infringement
  - Affirmative defense of invalidity to a counterclaim of infringement plead by Patent Owner does not deprive Petitioner of standing
    - ✔ E.g., IPR2012-00022, Paper 20 (Feb. 12, 2013); CBM2014-00035, Paper 12 (Apr. 25, 2014)

Estoppel

- IPR/PGR:
  - At the PTO/Court/ITC: Cannot maintain another proceeding on a ground Petitioner "raised or reasonably could have raised"
    - ✔ PGR: 35 U.S.C. § 325(e); IPR: 35 U.S.C. § 315(e)

Impact

- Should inform district court of IPR proceedings
    - *Va. Innovation Scis., Inc. v. Samsung Elecs. Co., Ltd.*, 2:12-cv-548 (EDVA May 2, 2014) (must inform court of IPR proceeding or face "sharp[] consequences")

Impact

- Motions *in Limine*
  - *Universal Elec. Inc. v. Universal Remote Control Inc.*, 8:12-cv-329 (C.D. Cal. Apr. 21, 2014) (denying MIL to preclude mention of rejected petition); *StoneEagle Serv., Inc. v. Pay-Plus Solutions, Inc.*, No. 8:13-cv-2240 (M.D. Fl. June 19, 2015) (same)
  - *InterDigital Commc'ns. Inc. v. Nokia Corp.*, 1:13-cv-10 (D. Del. Sept. 19, 2014) (granting MIL to preclude mention of rejected petition)
  - *UltraTec, Inc. v. Sorenson Commc'ns, Inc.*, 3:13-cv-346 (W.D. Wis. Oct. 8, 2014) (granting-in-part MIL to preclude mention of instituted IPR to Jury; allow mention to Judge)

Impact

- Issues of claim construction, validity, and non infringement
  - *The Procter & Gamble Co. v. Team Techs., Inc.*, No. 12-cv-552 (S. D. Ohio Jul. 3, 2014) (considering USPTO's decision in a post-grant proceeding to grant MSJ of no invalidity)
  - *VAE Nortrak N. Am. v. Progress Rail Serv. Corp.*, 459 F. Supp. 2d 1142 (N.D. Alabama Oct. 25, 2006) (granting defendant's MSJ on DEO based on statements made during foreign prosecution)

Other Considerations (Petitioner)

- Timing considerations
  - File right away? File after contentions in court?

- Audience considerations
  - Invalidity arguments more judge/jury friendly?

- Multi-patent considerations
  - Challenge all or subset of asserted patents/claims?

Other Considerations (Patent Owner)

- Multi-party considerations
  - Joint defense group? Privity? Real Party-in-Interest?
- Multi-patent considerations
  - Assert one or many patents at once?
- Non-party considerations
  - Role of manufacturer/supplier?

Timeline

Effective March 2025, there is a discretionary denial process from months 2-4

Required Parts of an IPR Petition

- The grounds for standing
- An identification of all challenged claims and grounds
- Claim construction
- A specific explanation of the grounds for unpatentability
- A specific explanation of the relevance of evidence
- An identification of all real parties in interest
- Copies of relevant evidence
- The required fee

Discovery

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- Discovery timeline for petitioner and patent owner
  a. Patent owner
     i. Between institution decision and patent owner response
     ii. Between petitioner reply and patent owner sur-reply
  b. Petitioner
     i. Between patent owner response and petitioner reply
- Mandatory initial disclosures
- Routine discovery
- Additional discovery

Motion Practice

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- Rules: 37 C.F.R. § § 42.20-25 and Consolidated Trial Practice Guide (Nov. 2019)
- Motion to appear *pro hac vice*
- Motion for mandatory initial disclosures
- Motion for additional discovery
- Motion to file supplemental information
- Motion to seal
- Motion to exclude
- Request for rehearing
- Motion to amend
- Request for joinder

Questions or Comments?

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Meet The Faculty

Jeremy Albright - jeremy.albright@nortonrosefulbright.com

Jeremy Albright is a partner at Norton Rose Fulbright US LLP. He is a patent attorney in the mechanical arts, and his practice is focused on patent preparation and prosecution as well as post-issuance challenges, with emphasis on inter partes reviews and ex parte reexaminations.

David Tobin - dtobin@mwe.com

David Tobin focuses his practice on intellectual property (IP) matters, with a particular emphasis on patent post-grant trials and patent litigation. He has extensive experience litigating complex patent infringement and other IP cases across the country, including in district courts, the Patent Trial and Appeal Board (PTAB) and the International Trade Commission (ITC).

David represents clients in a wide variety of fields spanning telecommunications hardware and standards, computer hardware and software, e-commerce, data compression, semiconductor manufacturing and design, fossil energy production, renewable energy generation, medical devices, chemical processes and pharmaceutical formulations. He also litigates and provides counseling on trade secret, copyright, trademark and trade dress issues. Read More

Brooke Parker - Brooke.Parker@haynesboone.com

Andrea Shoffstall - andrea@unifiedpatents.com

Andrea Shoffstall is a registered patent attorney with extensive experience in post-grant proceedings, including inter partes reviews and ex parte reexaminations before the USPTO. Currently Senior Patent Counsel at Unified Patents, she handles ex parte reexaminations across many technologies such as Wifi, telecommunications, and software. In her prior roles at Husch Blackwell and Brinks Gilson & Lione, Andrea represented clients in PTAB proceedings, district court litigation, and ITC actions, developing deep experience across all stages of patent litigation.

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