Things to Consider Before You File

Intellectual Property 401

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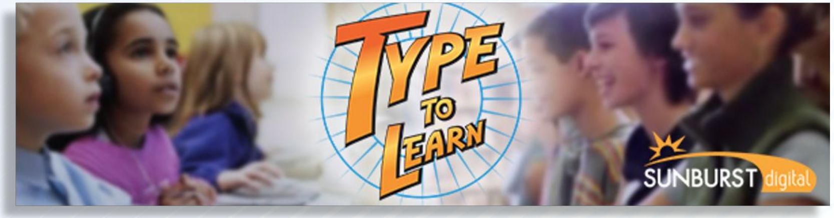

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Meet the Faculty

Panelists

Jeremy Albright - Norton Rose Fulbright US LLP

Andrea Shoffstall - Unified Patents

Patrick Richards - Much Shelist, P.C.

Moderator

David Tobin - McDermott Will & Schulte LLP

About This Webinar

Things to Consider Before You File

- This episode delves into considerations that come into play when filing or responding to post-grant review proceedings.
- These considerations include issues of real party in interest, timing, and substantive arguments.

About This Series

Post-Grant Review Trials

- The series is intended to give attendees a crash-course in post-grant review proceedings at the U.S. Patent and Trademark Office. Designed to teach newcomers to the field about this critical process, where recently issued patents are reviewed by the USPTO to ensure their compliance with patentability requirements.
- It provides a comprehensive overview, exploring key aspects and procedural steps involved. Gain valuable insights into how these proceedings influence patent validity and the strategic considerations for patent holders and challengers alike. Perfect for those looking to understand the complexities of patent challenges at the PTO.

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 #2: Things to Consider Before You File

Each Financial Poise Webinar is delivered in Plain English, understandable to investors, business owners, & executives without much background in these areas, yet is of primary value to attorneys, accountants, & 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.

Filing a Petition

When Can a Petition be Filed?

- PGR
  - Post-AIA Patent: Must be filed within 9 months after issue
    - ✔ 35 U.S.C. § 321; 37 C.F.R. 42.202

- IPR: Can be filed after the later of:
  - Pre-AIA Patent: Issue of the patent;
  - Post-AIA Patent: (1) 9 months after issue or (2) end of PGR
    - ✔ 35 U.S.C. § 311(c); 37 C.F.R. 42.102

Who Can File a Petition?

- PGR: Petitioner must not file DJ of invalidity first
  - 35 U.S.C. § 321(a); 35 U.S.C. § 325(a)(1); 37 C.F.R. 42.201

- IPR: Petitioner must not file DJ of invalidity first and must file within one year after being served with a district court complaint
  - 35 U.S.C. § 315; 37 C.F.R. 42.101

What is the Standard to Institute PTAB Trial

- PGR:
  - “More likely than not that at least one of the claims challenged in the petition is unpatentable;” or
  - “Raises a novel or unsettled legal question that is important to other patents or patent applications”
  - ✔ PGR: 35 U.S.C. § 324(a) and (b); 37 C.F.R. 42.208(c) and (d);

- IPR: “[R]easonable likelihood that the Petitioner would prevail” with respect to at least one challenged claim in the patent
  - 35 U.S.C. § 314(a); 37 C.F.R. 42.108(c)

What Can a Petition be Based on?

- PGR: Patents, printed publications, evidence of public use, sale, and offer for sale, and §§ 101, 102, 103, 112, 251.
  - 35 U.S.C. § 321

- IPR: Patents and printed publications, and §§ 102, and 103.
  - 35 U.S.C. § 311(b); 37 C.F.R. 42.104(b)(2)

What Must the Petition Include?

- Identify real parties in interest and privies;
- Identify challenged claim and grounds for the challenge;
- Provide claim construction;
- Identify exhibit numbers of supporting evidence;
- Provide copies of the supporting evidence; and
- Be accompanied by filing fee
  - PGR: 35 U.S.C. § 322(a) and 37 C.F.R. 42.204(b);
  - IPR: 35 U.S.C. §312(a) and 37 C.F.R. 42.104(b);
  - Generally: 35 U.S.C. § 312(a)

Petition Formalities

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- Grounds
  - Must include full analysis in petition, not just expert declaration

- Claim Construction
  - Include explanation why proposed construction is correct
  - ✔ 37 C.F.R. 42.104(b)(3)

- Common defect in petitions is failure to provide proposed construction for term open to interpretations

Word Limits

- IPR
  - 14,000 words
  - 14-pt font, including any footnotes

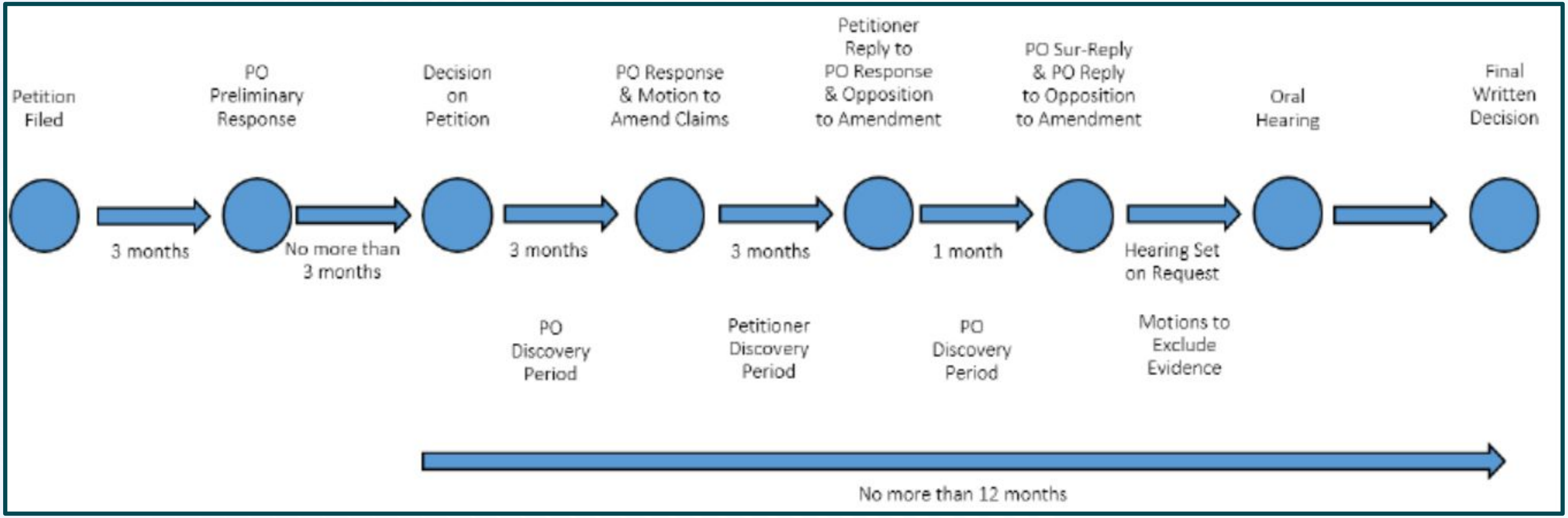
- PGR
  - 18,700 words
  - 14-pt font, including any footnotes
  - ✔ 37 C.F.R. 42.6 and 42.24

Fees

- IPR Request Fee: $23,750
  - Additional $470 fee for each claim in request over 20
- IPR Post-Institution Fee: $28,125
  - Additional $940 for each claim granted review over 20
- PGR Request Fee: $25,000
  - Additional $595 fee for each claim in request over 20
- PGR Post-Institution Fee: $34,375
  - Additional $1,315 for each claim granted review over 20
    - ✔ 37 C.F.R. 42.15

Litigating a PTAB Trial

Timeline/Filings



PO Preliminary Response

- Limited to reasons why trial should not be instituted
  - Cannot include any amendments to the challenged claims

- Filed within 3 months after notice of filing date of petition
  - PGR: 35 U.S.C. § 323; 37 C.F.R. 42.207; IPR: 35 U.S.C. § 313; 37 C.F.R. 42.107

- PTAB will discount any conclusory, unsupported Patent Owner statements, especially when contrary to written description

- Petitioner can seek a reply for good cause

PO Response and/or Motion to Amend

- PO Response: May respond to any ground included in trial
  - Filed after discovery is taken of Petitioner
    - ✔ PGR: 35 U.S.C. § 326(a)(8); IPR: 35 U.S.C. § 316(a)(8)
- PO Motion to Amend: New Motion to Amend Pilot began March 15, 2019 and final rules were issued in October 2024:
  - Cancel or propose substitute claims of same or narrower scope
  - Can receive preliminary guidance from Board and then provide "revised motion to amend"
  - Can be supported with expert declaration
    - ✔ PGR: 35 U.S.C. § 326(d) and 37 C.F.R. § 42.221
    - ✔ IPR: 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121

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.

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.

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

Patrick Richards - PRichards@muchlaw.com

Patrick focuses his practice on intellectual property, spanning patents, trademarks, copyrights, and trade secrets. While primarily focused on prosecution and post-grant matters, he also monetizes clients' IP through licensing, litigation, and the purchase and sale of IP assets. He is also deeply involved in the litigation funding space. In addition to representing clients backed by third-party capital, he works with funders to help find the best opportunities for their investments.

Patrick approaches legal work with the mind of an entrepreneur. In addition to founding a law firm that he managed for over a decade, Patrick co-founded and managed two software businesses, including an AI-based medical device company in the neuromodulation, cochlear implant, and hearing aid space, and a crowdfunding platform that was named one of the 100 Brilliant Businesses of 2014 by Entrepreneur Magazine. He was also an adjunct professor at the Northwestern Pritzker School of Law for five years co-teaching the NUvention Medical course. Read More

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