

Navigating the PTAB

Patent Trial and Appeal Board Proceedings

The PTAB handles three types of matters:

- 1) **ex parte appeals**,
- 2) **post grant reviews (PGRs)** and
- 3) **inter partes reviews (IPRs)**



Patent Trial and Appeal Board Trials

Post Grant Reviews. PGRs allow for broad patent validity challenges which must be brought within nine months after a patent is issued.



PTAB Trials Overview

The PTAB process has two phases: institution and trial. Once a petition is filed, the patent owner has three months to file a preliminary response. At this point the PTAB decides whether or not to institute a nine-step trial. The PTAB must issue its decision within 12 months, although six-month extensions are possible.



Institution Phase

In the institution phase, the PTAB decides whether there is a reasonable likelihood that the petitioner would prevail on at least one claim.



Trial Phase: Federal Court and PTAB Differences

1-year time to decision

3-judge panel

Validity Presumption: a party only needs to prove that more likely than not the patent is invalid

Standing: No need to show that there is an actual dispute between the parties (unlike in Federal court)

Claim amendments

Discovery: Discovery scope, types, and processes are more limited

Litigation expense: PTAB trials are cheaper

Potential Inventor Actions

Here are some actions an inventor may consider if the patent is core to the inventor's business and is likely to be attacked at the PTAB:

1) Actions Before Petition

There are several actions (many free or low cost) an inventor may consider to improve their PTAB odds.



2) Conduct an extensive prior art search

3) Engage experienced patent prosecutors and litigation counsel

4) Create a good patent prosecution record

5) Create a Litigation Readiness Plan

6) Identify and engage patent litigation counsel

7) Identify funding sources



Trial Phase: Federal Court and PTAB Differences

If you are served, consider whether you can argue that the PTAB should not initiate an IPR because the allegations are immaterial, or that there are pending Federal proceedings or IPR(s).

Read the full article at michelsonip.com