

# Post-Grant Procedures

## ADVANCED PATENT LAW INSTITUTE

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## Technology Breakdowns of AIA Petitions

As of January 20, 2013, the Office received a Total of 123 AIA Petitions: 15 CBMs and 108 IPRs

Technology	Number of Petitions	Percentage
Electrical/ Computer	89	72.4%
Mechanical	5	4.1%
Chemical	19	15.4%
Bio/Pharma	9	7.3%
Design	1	.8%



## Post Grant Resources

- General information concerning implementation of the Leahy-Smith America Invents Act, including post grant reviews, may be found at:

[http://www.uspto.gov/aia\\_implementation/index.jsp](http://www.uspto.gov/aia_implementation/index.jsp)

- Information concerning the Board and specific trial procedures may be found at:

<http://www.uspto.gov/ip/boards/bpai/index.jsp>

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## Lessons Learned

- Conclusions need to be supported by:
  - Sound legal analysis
  - Citations to evidentiary record
- Better to provide detailed analysis for limited number of challenges than identify large number of challenges for which little analysis is provided



## Lessons Learned – Claim Construction

- Claim constructions should be supported by citations to the record that justify the proffered construction and analysis provided as to why the claim construction is the broadest reasonable construction. 37 C.F.R. 42.104(b)(3)
- An example of a failure to provide a sufficient claim construction occurs where claim terms are open to interpretation but party merely restates claim construction standard to be used, e.g.,
  - A claim subject to inter partes review receives the “broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b).



## Lessons Learned – Obviousness

- The question of obviousness is resolved based on underlying factual determinations identified in *Graham*. This includes addressing differences between claimed subject matter and the prior art.
  - Address the specific teachings of the art relied upon rather than rely upon what others have said, e.g.,

The Examiner found that all limitations of the challenged claims except X were present in AAA, BBB and CCC. Additional reference DDD teaches X. Thus, the challenged claims are unpatentable as obvious over prior art references AAA, BBB, CCC and DDD.



## Lessons Learned – Obviousness

- Parties are to address whether there is a reason to combine art (*KSR*) and avoid conclusory statements such as:
  - It would have been obvious at the time of the priority date of the challenged patent to incorporate a widget as disclosed by references AAA, BBB, CCC, DDD or EEE into FFF's widget. See MPEP § 2143(A), (C)