KILPATRICK TOWNSEND

4 KEY TAKEAWAYS

"Patents: Developing Iss Post Grant Patent Challe

Kilpatrick Townsend partner Justin Krieger recently spoke at the North Carolina Intellectual Property Law Section Annual Meeting and Litigation Section Joint C Mr. Krieger presented on "Patents: Developing Issues in Post Grant Patent Ch

4 key takeaways from the presentation, include:

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Supreme Court Update: The Supreme Court's recent *Oil State Group* means IPRs are here to stay. The Court held that pater "public rights doctrine," which provides Congress with great di the granting of patents as well as reconsidering the issuance The Court also held in *SAS Institute v. Iancu* that a plain readi requires that any final written decision (FWD) issued by the P and every claim challenged in the corresponding Petition. The issued Guidelines on April 26, 2018 indicating that for pending it would institute, if at all, based on all challenged claims *and* *SAS* decision to have a broad impact on IPR practice, includir focused petitions being preferred), preliminary responses (few of co-pending litigation (more will be granted).

Improving Predictability: Look for the USPTO to continue to modify IPR pra

Improving Predictability: Look for the USPTO to continue to modify IPR pra improve consistency and predictability. In *Tinnus Enterprises v. Telebrands* currently before the Federal Circuit, the USPTO filed a brief as an Interven arguing that the USPTO should continue to employ a lower indefiniteness s than used in district court proceedings. Shortly after Dir. Iancu was sworn i Director, however, USPTO withdrew its brief, indicating "the PTAB's approa claim construction and indefiniteness during post-issuance proceedings un America Invents Act is something the agency is actively considering." Subs on May 9, 2018, the USPTO proposed new rules dropping the broadest rea interpretation (BRI) standard for claim construction and adopting the narrov *Phillips* standard. Look for the Office to similarly shift to the Supreme Court standard for indefiniteness for motions to amend and in PGR proceedings.

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Motions to Amend are on the rise. As of September 2017, onl included a motion to amend, and of those, only 8% have beer In a fractured decision, however, the Federal Circuit recently h *v. Matal* (en banc) that the burden of proving patentability of a be placed on the Patent Owner. It remains to be seen whethe Petitioner, on the Patent Office, or both; but look for future rule issue. Although more data is needed, the PTAB appears to be Amend with greater frequency post-*Aqua Products*.

IPR Statistics: IPR/PGR filings are holding constant at a little more than 1,5 Of terminated proceedings: roughly 25% are settled or procedurally dismis institution, 20% are denied institution, 25% are settled or dismissed post in about 30% reach final written decision (FWD). Of those reaching FWD, abo in all claims being held unpatentable. FY2017 statistics reflect a slight drop FWD's finding all claims unpatentable and a surprising uptick in decisions f claims patentable (27%).

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Related People



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