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**Honors and Awards**

## Special Edition: AIA Post-Grant Proceedings

Post-grant proceedings before the Patent Trial and Appeal Board (PTAB) became available as means to challenge a patent under the America Invents Act on September 16, 2012. They include *inter partes* review (IPR), covered business method patent review (CBM) and post grant review (PGR). They have been even more popular than predicted and the decisions have been very pro-petitioner, with Justice Rader of the Federal Circuit calling the PTAB judges “death squads” of patent rights. These proceedings are available for both utility and design patents, and in fact, just this week, the PTAB invalidated the first design patent to be reviewed (*Munchkin, Inc. v. Luv n’ Care*, Case IPR2013-00072). In this special edition of *IP Buzz*, we have focused on these post-grant proceedings, giving you an overview of options, enumerating pros and cons to consider, laying out statistics, predicting potential movement looking forward, and digging into detail on some recent and upcoming decisions.

### [10 Reasons Every Defendant in Patent Litigation Should Consider \*Inter Partes\* Review](#)

Numerous articles and practitioners are touting *inter partes* review proceedings, and for good reason. We provide a breakdown of why these proceedings are considered pro-petitioner and why every patent infringement defendant should give IPR serious consideration.

[Click here](#) to read our top ten reasons every patent infringement defendant should consider IPR.

### [Reasons to Think Twice Before Initiating \*Inter Partes\* Review](#)

Though there has been a lot of hype about *inter partes* review, and the post-grant review proceedings have the goal of saving time and money, they will not always do that. Depending on the prior art, the location and the timing of the litigation, post-grant review proceedings may not be a good strategy.

[Click here](#) to read our list of reasons to think twice before initiating *inter partes* review.

### [First AIA Roundtable Hints at More Conservative Approach to PTAB Review](#)

On April 15, 2014, the Patent and Trademark Office hosted the first in a series of eight scheduled roundtable discussions intended to share information about the new America Invents Act trials, and to solicit feedback from the public. The tone seemed to hint at a more conservative approach to PTAB review looking forward.

[Click here](#) for a summary of the roundtable and the information shared.

### [Federal Circuit To Review PTAB Post-Grant Review Proceedings in \*SAP v. Versata\*](#)

Over the last 18 months, the rules and standards for post-grant proceedings have begun to be hashed out, but this area of law is still evolving. A prime example of this is the currently pending appeal to the Federal Circuit from the PTAB’s decision in the first CBM review in *SAP America, Inc. v. Versata Data Development Group*. This case involves several key issues, including the: (1) PTAB’s jurisdiction; (2) scope of available grounds of invalidity; and (3) appropriate claim construction.

[Click here](#) to learn more about this important case.

### [Patent Trial and Appeal Board Statistics](#)



Post-grant proceedings are turning out to be even more popular than predicted, and the decisions thus far appear to be demonstrating a pro-petitioner tendency.

[Click here](#) to see a roundup of statistics.

#### **Hurry Up and Settle! Settling Early to Avoid PTAB Refusal to Terminate IPR**

In an *inter partes* review proceeding, the parties often reach settlement before a final decision has been reached. Once the parties file the request to terminate, if the merits have yet to be decided, the PTAB retains discretion as to whether to dismiss the proceeding with respect to the patent owner. In fact, the PTAB has decided in cases where the parties already settled, that, because the issues for trial had already been fully briefed, it would proceed to a final written decision.

[Click here](#) to learn how to deal with this contingency.

#### **The Tide May Be Changing: The PTAB Allows Two Patents to Emerge from IPR Unscathed**

The PTAB has been painted as highly pro-petitioner because most post-grant petitions are instituted, and once instituted, most claims are canceled. However, in its recent statements and decisions, the PTAB seems to be hinting that the tide may be changing.

[Click here](#) to read about the PTAB's recent statements and decisions.

#### **Snapshot Overview of Options for Post-Issuance Challenges Before the PTAB**

There are three available types of post-issuance challenges to the validity of a patent: (1) *Inter Partes* review; (2) Transitional Program for Covered Business Method Patents; and (3) Post-Grant Review.

[Click here](#) for an overview of these post-issuance challenges.

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