

IPR Proactive Defense Measures - Strategies And Considerations For Patent Owners

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Many patent owners have not yet had to defend against an inter partes review (IPR), but the popularity of this proceeding increases the chances that they will encounter it down the road if they have not already faced one. This article explores IPR proactive defense measures that may be useful for patent owners to deploy in advance of facing an IPR.

Defense Starts With a Sound Patent

Few patent owners would be pleased to learn that a petition for inter partes review (IPR) has been filed against one of their prized patents. Crafting a robust portfolio of IP protection around a given product can help patent owners be prepared to respond to the news that their patents are being challenged.

According to the latest statistics available from the USPTO, more than 1,500 petitions for inter partes review (IPRs) were filed in fiscal year 2015 and roughly 80% of the patents involved in these petitions were also involved in co-pending district court litigation.

The Patent Trial and Appeal Board (PTAB) has a different standard of review from district court, and it is important for a patent owner to remember the standard of review under which their claims will be analyzed in the event that a petition is instituted.

The PTAB reviews claims under the “broadest reasonable interpretation” standard, which means the PTAB will stretch the metes and bounds of a claim with disputed terms to its practical limits, and broadly interpreted claims can be problematic for a patent owner when validity is being tested. One option to address this problem is to try to define any potentially disputable claim terms in the specification of the patent, and taking extra care during prosecution to avoid ambiguity in claim language.

While encouraging careful application drafting and prosecution may sound self-evident, a surprising number of practitioners do not approach the drafting process with defense in mind. This can lead to unintended interpretations of claim terms that are either too limiting for enforcement or too broad for validity defense. Either mistake can lead to a situation in which the intended scope of the patent is inconsistent with the literal language of the claim. Ensuring that the patent owner is afforded the interpretation that it envisioned, rather than allowing the PTAB to construe the claims in an unintended light, is of paramount importance to surviving an IPR attack.

Moreover, the evidence of record in the prosecution can also be used to the patent owner’s benefit. Although recent rule changes allow a patent owner to submit new expert evidence with its patent owner preliminary response (POPR) (see [“USPTO Releases New Rules for AIA Proceedings”](#)), practically it is very difficult to produce new expert evidence prior to the three-month statutory deadline for filing a POPR. But if the patent owner has previously produced expert testimony or objective evidence during prosecution of the challenged patent or in a related patent, it may be useful for bolstering the patent owner’s claim construction in the POPR, if it does not prevent IPR from being instituted in the first instance.

Given the PTAB’s high cancellation rate of instituted claims, the old adage “an ounce of prevention is worth a pound of cure” is apt in preparing for an anticipated IPR attack, as a “cure” can be difficult to find if the claims



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are construed unfavorably.

Use Continuation Applications to Keep Competitors Guessing

A strong defensive portfolio should not depend on a single patent, regardless of how clearly and painstakingly the specification and claims are drafted.

It is always good practice to maintain a pending application in any commercially valuable patent family. Although the option to amend the instituted claims in an IPR is theoretically available, to date the PTAB has only granted motions to substitute claims in four cases. Thus, having an alternative mechanism for pursuing a different claim scope is key.

Continuation practice is one such mechanism, and it allows the patent owner to pursue claims that are patentably distinct from those at issue in a post grant proceeding while the PTAB decides the fate of the instituted claims. Furthermore, having a pending related application at the USPTO during review of a related patent by the PTAB allows the patent owner to consider the cited art and craft claims to explicitly avoid the assertions in the post grant proceeding. This allows the patent owner to pivot to a fallback position and potentially maintain protection of a commercialized product even if the instituted claims are canceled.

Keep Reissue In Mind

As discussed above, the PTAB has rarely granted motions to substitute claims. In case certain claim amendments are needed to hedge against the risk of invalidity, while the patent family under IPR attack has no pending application, the patent owner should consider filing a reissue application to achieve the necessary claim amendments. In this regard, the Federal Circuit has recognized that “adding dependent claims as a hedge against possible invalidity of original claims is a proper reason for asking that a reissue be granted.” In re Tanaka, 640 F.3d 1246, 1249 (Fed. Cir. 2011). The patent owner can even broaden the issued claims in one or more aspects if the reissue application is filed within two years of the issuance date of the original patent.

Unlike in an IPR where a patent owner can file only one motion to amend and carries the immediate burden of showing patentability of the amended claims over all known prior art, a reissue applicant has a right to amend claims prior to a final office action. A reissue applicant also has the flexibility of filing a request for continued examination (RCE) or even a continuing or divisional reissue application, if additional claim amendments are desired. For these reason, a patent owner should keep reissue in mind when preparing for anticipated IPR filings.

Carefully Weigh the Benefits of a POPR

Prior to institution, the patent owner only has one chance to present arguments to the PTAB regarding why the petition should be denied. Submission of a POPR is optional, but if a patent owner wants the petition to be denied, it should likely file a POPR. In approximately 90% of the petitions that are denied by the PTAB, the patent owner submitted a POPR, thus underscoring the importance of this single chance to argue against institution.

However, in certain situations, a patent owner may have an incentive to refrain from preparing a POPR and waive the right to file. For example, the estoppel effects of post grant proceedings are only tied to final written decisions. Even if a petition is instituted, a settlement between the parties will allow another third party to attack the same patent using the same art. Thus, if a patent owner believes that it has a good chance of succeeding on the merits of a case, then it may want to allow institution of the proceeding and pursue a final written decision that would prevent the petitioner and any other would-be petitioners from repeatedly attacking the patent.

Alternatively, the patent owner may decline to file a POPR in order to maintain the element of surprise. One drawback of filing a POPR is that if the proceeding is instituted, the patent owner has given the petitioner a six month head start on developing arguments to counter the patent owner’s substantive assertions. If, on the other hand, the patent owner waits to file its substantive response until after the proceeding has been instituted, then the petitioner has a fraction of the time to react to the arguments and develop counterarguments. Of course, the patent owner could always avoid substantive arguments in the POPR and instead rely solely of procedural arguments for why institution should be denied and save the substantive arguments for post-institution.

Of course, sometimes the decision may boil down to concrete considerations like budget. If a patent owner is trying to minimize expense, then foregoing an optional preliminary response if an easy, albeit undesirable, place to start. But the patent owner should consider that while refraining from filing a POPR prevents some short-term spending, it is cheaper for the patent owner in the long run to prevent institution altogether.

Monitoring and Competitive Intelligence

Many services are available to keep track of IP litigation as well as patent application publications and grants. These monitoring services can help patent owners to keep an eye on major competitors. For example, a patent owner can receive automated updates for patent portfolios of interest. Monitoring services further allow patent owners to keep track of their competitors' activities in court and before the PTAB. Such information can help a patent owner avoid being caught off guard by an aggressive competitor.

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