How to successfully challenge or defend a patent before the USPTO Patent Trial and Appeal Board

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Litigation before the Patent Trial and Appeal Board (PTAB) is unique and complex. There are four important strategies that should not be overlooked if you want to successfully challenge or defend a patent.

1. **Pick your counsel wisely**
   An *inter partes review* (IPR) is a new form of administrative litigation before the USPTO PTAB. Successful lawyers before the PTAB have both significant patent prosecution experience and litigation experience. Too often, we have seen companies hire what appears to be good counsel, but are the wrong ones for this distinct practice.

   If you hire counsel with significant prosecution but not litigation experience, you potentially have someone that will see the trees but not the forest: They will draft documents that, while lengthy, miss key legal and technical points written in a persuasive and succinct manner. And remember: The PTAB now allows limited discovery including depositions. Therefore, it is important to have an experienced lawyer who knows how to effectively depose technical experts to obtain the necessary evidence to help your case.

   If you hire counsel with significant litigation but not prosecution experience, you potentially have someone that sees the forest but not the trees: There are specific USPTO nuances in their rules that only come with experience prosecuting patent applications before the PTAB. And those nuances can make the difference between winning and losing.

   This is why the USPTO requires that your counsel be registered to practice before the USPTO - a qualification that many pure patent litigators lack.

2. **Choose your expert wisely**
   An effective technical expert can be as important as your counsel. The technical expert can help identify the art before the time the patent was filed, find prior art patents and printed publications, and bridge that key evidence together in a way that makes a very effective basis for the PTAB to ultimately rule that the patent is unpatentable because it is either anticipated or obvious based on the prior art.

   If you don't have an effective expert (or one at all), the PTAB can deny your petition outright, and you may end up with litigation as your only option.

3. **Work on your invalidity defenses as quickly and comprehensively as possible**
   You have only one year from the date a competitor sues you to file your IPR petition. You need to have a thorough understanding of the technology, the patent(s) at issue, and the art before the time the patent was filed. You also need to find prior patents and printed publications that hit the heart of the technology covered under the patent.

   In litigation , discovery may move slowly and extensions are freely granted, so a party often has time to develop and finesse its invalidity theories. IPR, in contrast, moves very quickly and few extensions, if any, are available.

4. **Anticipate your opponent's counterarguments**
   This step is too often overlooked in the process, and you can see it in the initial petitions filed before the USPTO. You generally have to put your evidence - and best foot forward - in your petition. And because the patent owner has the right to respond and later present rebuttal evidence, you do not want to be in a situation of wanting to present new evidence but you cannot do so under the PTAB rules.

If you follow the four tactics discussed, your ability to succeed should be greatly enhanced. If you have questions, please contact one of the attorneys listed below.

DAVID CUPAR

I love innovation. Innovators hire me to develop creative IP strategies that align with their business objectives while minimizing risks and maximizing value

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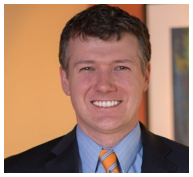

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