

## US Patent Prosecution and Litigation Advice in View of Post Grant Reviews

By Rick Neifeld, Neifeld IP Law, PC

The US patent laws changed in 2012 pursuant to the America Invents Act (AIA). One AIA change provided for patent cancellation proceedings (called post grant reviews) conducted by the Patent Trial and Appeal Board of the USPTO. Now, in early 2014, the Board has issued final decisions in the first few of those proceedings. Those decisions present a grim picture for patents subject to post grant review. The vast majority of patent claims in post grant reviews are being canceled. Post grant reviews are now the preferred method to attack validity of a patent asserted in litigation. If you file a patent infringement law suit, you should expect the defendant to file for one, or more, post grant reviews.

Post grant reviews replaced "inter partes reexaminations." Unlike inter partes reexaminations, the early decisions for post grant reviews show that patent claims in post grant reviews generally cannot be amended. Therefore, you should take more care in presenting dependent claims in the US patent application process, so that you have suitable backup protection in case your patent is attacked in post grant reviews. You should present dependent claims that claim a variety of features. In addition, you should also present dependent claims for the same feature using a variety of different words that provide slightly different claim scope for that same feature.

If you are preparing to sue for patent infringement, anticipate the likelihood of defending your patent in a post grant review before the Board. There are a few things you can do to anticipate a post grant review of your patent. These include maintaining a continuing application on file so you can present narrower claims, and retaining counsel suitable for handling the anticipated post grant reviews.

If sued for patent infringement, you should consider filing for post grant reviews, as a first line of defense. And you should do so as soon as practical, to increase the likelihood of the Court in the patent infringement law suit staying that law suit. For more information on these topics, see Neifeld IP Law's IP articles page: <http://www.neifeld.com/advidx.html>. To follow developments in post grant review proceedings, join the PatentInterPartes list serve: <https://groups.yahoo.com/neo/groups/PatentInterPartes/info>. Contact Neifeld IP Law if you need advice specific to a particular situation.