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Editors:

Martin L. Saad
mlsaad@Venable.com
202.344.4345

Meaghan Hemmings Kent
mhkent@Venable.com
202.344.4481

Authors:

Andrew F. Pratt
afpratt@Venable.com
202.344.4389

Steven J. Schwarz
sjschwarz@Venable.com
202.344.4295

Meaghan Hemmings Kent
mhkent@Venable.com
202.344.4481

Fabian M. Koenigbauer
fmkoenigbauer@Venable.com
202.344.4477

Annette K. Kwok
akkwok@Venable.com
202.344.4835

Carly S. Levin
cslevin@Venable.com
202.344.4638

Trent B. Ostler
tbostler@Venable.com
202.344.4833

Honors and Awards:

IPR Spotlight Series: Preparing and Filing a Petition

Inter partes review (IPR) before the Patent Trial and Appeal Board (PTAB) became available on September 16, 2012 as a post-grant review procedure to challenge the patentability of issued claims based on prior art patents and publications. To help navigate the uncharted waters of this procedure, each edition of *IP Buzz - Post Grant Practice* will include an installment of our new IPR Spotlight Series, where we will feature a specific event on the **IPR timeline**, from filing the petition for IPR through oral hearing and final written decision. We will present an overview of the featured filing or procedure, along with practice tips and strategy informed by recent PTAB decisions, statistics, and practical experience. In this first IPR Spotlight installment, we focus on preparing and filing a petition for IPR.

[Click here](#) to read about preparing and filing a petition for IPR.

AIA Trials By Fire: How to Protect Your Patent Portfolio Against PTAB "Death Squads"

AIA trials are attractive for numerous reasons, including the speed at which the proceedings are conducted, the technical expertise of the Patent Trial and Appeal Board (PTAB), and the broader claim construction standard used. The PTAB's record of cancelling a majority of challenged claims in AIA trials has garnered it the reputation of being anti-patent and pro-petitioner, creating a flurry of petition filings as patent challengers scramble to take advantage of these proceedings.

[Click here](#) to read the four steps that can strengthen your patents and bolster your portfolios against the threat of post-grant challenges.

Should I Stay or Should I Go [to the PTAB] Now? Stays of Litigation Pending *Inter Partes* Review Likely to Increase

For a variety of reasons, not least of which is resources, parties do not typically want to fight the same battle in two venues. So when a defendant in patent litigation initiates an *inter partes* review (IPR) challenging the validity of the patent, a motion to stay district court litigation often follows. The Patent and Trademark Office reported during a recent **roundtable** that 80-90% of petitions to the PTAB involve patents in pending federal court litigation. Statistics show, however, that only 60-70% of motions to stay pending IPR are granted. However, two recent decisions – one that orders that the parties notify the district court judge as soon as a petition for IPR is filed, and the other that entered a stay before a petition was initiated – indicate that the percentage of motions to stay pending IPR is likely to increase.

[Click here](#) to read the rest of this article.

Open for Business: The PTO Offers a Fast and Low-Cost Shot at Invalidating Business Method Patents

Business method patents exploded in the mid-1990s, leaving companies vulnerable to patents that many felt never should have been issued. The expense of litigation and the high hurdle to invalidating issued patents caused many companies to pay license fees rather than wage pyrrhic legal battles. But the good times for business method patentees may be ending.

[Click here](#) to learn about the Covered Business Method Review (CBM) qualifications.

First Design Patent Falls Victim to *Inter Partes* Review



Since the *inter partes* review (IPR) process became available on September 16, 2012, over 1,100 IPR petitions have been filed. But only eight petitions have challenged design patents, representing less than 0.8% of all petitions filed. This trend might change, however, given the recent final written decision in *Munchkin Inc. et al. v. Luv N' Care Ltd.* (IPR2013-00072), which invalidated Luv N' Care Ltd.'s design patent for a baby drinking cup. The Luv N' Care design patent is the first to fall victim to an IPR challenge.

[Click here](#) to learn why the Luv N' Care design patent fell victim to an IPR challenge.

AIA Statistics: A Closer Look at the Outcome of AIA Trials Based on the Year of Patent Issue

Since September 16, 2012, *inter partes* review (IPR) and covered business method (CBM) review have been available as proceedings to challenge the validity of patents before the PTO. Using a patent analytics database called [PatentBoardFerret.com](#), we look at how the Patent Trial and Appeal Board (PTAB) is treating patents that have been challenged through IPR and CBM review, specifically based on the patent's issue date.

[Click here](#) to see how patent issue date has affected the outcome of AIA trials.

Announcements and Events

Venable Attorneys to Present at 2014 BIO International Convention: "Navigating Patent Challenges Under the America Invents Act"

Wednesday, June 25, 2014 | 10:15 - 11:30 a.m. PT
San Diego Convention Center, Room 23ABC

Venable attorneys will present the panel "Navigating Patent Challenges Under the America Invents Act" at the 2014 BIO International Convention. The panel will discuss the potential impact of these changes from various perspectives – the bench, the administration, and the patent owner – and will investigate the mechanisms available for challenging patents; analyze strategies and issues to consider when challenging or defending patent validity; and assess the risks and benefits associated with the various types of actions that can be used to challenge patent validity. Michael Tierney, Lead Administrative Patent Judge, Trial Section at the Patent Trial and Appeal Board, has been confirmed as a speaker.

[Click here](#) for more information and to register for the 2014 BIO International Convention.

Save-The-Date: Lunch Panel on "Successfully Navigating AIA Trials"

Monday, July 14, 2014 | 12:00 - 2:00 p.m. ET
Venable LLP's Washington Office, Multipurpose Room

Venable, in partnership with the Bar Association of the District of Columbia, will present a lunch panel on practice tips for successfully using AIA trials. Panelists will include Administrative Patent Judge at the Patent Trial and Appeal Board Brian Murphy, Proctor & Gamble Senior Counsel of Intellectual Property Mark Charles, and PTAB expert and consultant Oliver Ashe. Stay tuned for more information in the coming weeks.

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