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Honors and Awards

Terminal Disclaimer Cannot be Used to Circumvent IPR Review Standard

One of the main reasons to challenge a patent in *inter partes* review (IPR) is that the PTAB will construe claims more broadly than a district court, using the broadest reasonable interpretation (BRI) in light of the specification, instead of "ordinary and customary meaning" to a person of ordinary skill in the art. However, when a patent has expired, BRI is no longer the appropriate standard for construction, and "ordinary and customary meaning" under *Phillips v. AWH Corp.* should be used instead. This begs the question: can a patentee file a terminal disclaimer after the PTAB has instituted IPR to change the standard of review and thereby request termination of the IPR?

[Click here to learn the answer.](#)

IPR Spotlight Series: Evaluating Whether to File a Preliminary Patent Owner Response

To help navigate the uncharted waters of *inter partes* review (IPR) before the Patent Trial and Appeal Board (PTAB), each edition of *IP Buzz - Post Grant Practice* includes an installment of our *IPR Spotlight* series, where we feature a specific event on the [IPR timeline](#), from filing the petition for IPR through oral hearing and final written decision. In our second *IPR Spotlight* installment, we focus on whether to file a patent owner preliminary response.

[Click here to learn how to evaluate whether to file a preliminary patent owner response.](#)

Unscathed by Review: Recent IPR Results Temper PTAB's Overall Record

The PTAB has been labeled an anti-patent "death squad" because of the high percentage of unpatentability findings in early AIA trials. Through March 2014, all 28 Final Written Decisions decided on the merits held at least one claim of the challenged patent unpatentable. Since then, the PTAB has issued eight decisions finding the patent wholly valid, helping to temper the PTAB's overall record and assuage early fears of patent owners.

[Click here to read more about the PTAB's treatment of challenged patents.](#)

The Potential Impact of *Nautilus v. Biosig Instruments* on AIA Trials

In *Nautilus, Inc. v. Biosig Instruments, Inc.*, the Supreme Court recently clarified the standard for determining invalidity of a patent claim for indefiniteness under 35 U.S.C. § 112, second paragraph. Specifically, the Court unanimously held that "a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, fail to inform, with reasonable certainty, those of skill in the art about the scope of the invention." *Nautilus*, slip op. at 1. This new "reasonable certainty" standard is much stricter than the overruled Federal Circuit standard, which only permitted a claim to be invalidated under 35 U.S.C. § 112, second paragraph if the claim was not "amenable to construction" and was "insolubly ambiguous." *Id.*

[Click here to read how this decision may impact AIA trials.](#)



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 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.

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

Join us at Happy Hour during BIO at Fox Sports Grill (within walking distance from the San Diego Convention Center, located Inside the Hilton San Diego Bayfront Hotel) on Tuesday, June 24, 2014 from 6:30-8:30 p.m. PT. [Click here to RSVP.](#)

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, PTAB expert and consultant Oliver Ashe, and Venable partner [Adam Hess](#).

[Click here to register.](#)

Save-The-Date: Venable IP Symposium

Wednesday, September 10, 2014 | 12:30 - 6:00 p.m. ET
Venable LLP's Washington Office, Multipurpose Room

On September 10, Venable's Intellectual Property Division will hold its inaugural IP Symposium. Venable IP attorneys will be joined by distinguished guest speakers for a half-day event in our Washington, DC offices. We'll kick off with a keynote luncheon, followed by panel discussions on current trends in IP law and strategies for settling a case favorably, and we'll end the day with drinks on the rooftop. The IP Symposium is complimentary and CLE credit will be available. We hope you will join us!

[Click here for early registration.](#)

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