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Honors and Awards

IPR Spotlight Series: Strategically Using Requests for Joinder in IPR

To help navigate the uncharted waters of *inter partes* review (IPR) before the 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 fourth *IPR Spotlight* installment, [we focus on strategically using requests for joinder in IPR](#).

Lessons Learned From the First Successful Motion to Amend in an *Inter Partes* Review

While the Leahy-Smith America Invents Act (AIA) provides a mechanism that allows amendments to patents challenged in an *inter partes* review, until recently, all motions to amend have failed. The final decision in [International Flavors & Fragrances, Inc. v. United States](#) marks the first time the PTAB at least partially granted a patentee's motion to amend. The decision highlights the potential value of a motion to amend in an *inter partes* review and also provides [some guidelines on how to succeed](#).

Reaching a Milestone: Filing of the First Ever Petition for a Post Grant Review

On August 5, 2014, a milestone was reached for AIA trials. For the first time, a petition for a Post Grant Review (PGR) was filed. As was the case with the first covered business method review, the first PGR will likely be quite instructive to practitioners as to how the PTAB will conduct these proceedings.

[Click here to learn the details of this first time filing.](#)

Consider this Potential Downside of *Inter Partes* Review: Denial of the Petition May Be Used Against You in a Concurrent District Court Litigation

In many instances, it may be advantageous to challenge patent validity via an AIA trial in front of the PTAB. Despite all of the [advantages to an AIA trial](#), a potential AIA trial petitioner should also consider the [potential downsides](#) particularly when involved in concurrent district court litigation. One such potential downside – that the denial of a petition for an *inter partes* review (IPR) may be used against the petitioner – is illustrated by a recent summary judgment decision in the District Court of the Southern District of Ohio.

[Click here to learn another reason to think twice before initiating *inter partes* review.](#)

ANNOUNCEMENTS AND REMINDERS

Keynote Speaker Added! Venable IP Symposium

Wednesday, September 10, 2014 | 12:30 - 6:30 p.m. ET



Venable's Washington Office, Capitol Room

Keynote speaker, **The Honorable Mike Lee**, Senator for Utah and co-sponsor of the Patent Transparency & Improvements Act of 2013, will join Venable IP attorneys and distinguished guest panelists for this half-day event in our Washington, DC office. Following Senator Lee's keynote address, there will be 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.

Panel 1: Current Trends in IP Law

- Recent developments in patent, trademark and copyright law and legislation
- The effect of the latest Supreme Court decisions on IP law and practice

Panel 2: How to Settle Your Case Favorably

- Different approaches to settling patent troll and Hatch-Waxman cases
- Drafting settlement documents that best benefit your client

Speakers

- **Tamany Bentz**, Venable LLP
- **Nora Garrote**, Venable LLP
- **Frank Gasparo**, Venable LLP
- **Jeffri Kaminski**, Venable LLP
- **Meaghan Kent**, Venable LLP
- **Janet Satterthwaite**, Venable LLP
- **Kenneth Cappel**, Vice President, Global IP, Amneal Pharmaceuticals
- **Christopher Copeland**, Senior Counsel, Contracts & IP, M&T Bank
- **Vicki Margolis**, Chief IP Counsel, Kimberly-Clark
- **Elizabeth Winston**, Associate Professor, Columbus School of Law, Catholic University

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