



THINK FORWARD

Managing Patent Portfolios and Drafting Applications To Withstand IPR Challenges

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February 10, 2017

Since implementation of the Leahy-Smith America Invents Act, inter partes review (“IPR”) and other post-grant proceedings have been used successfully to challenge and invalidate thousands of patent claims. Over 2,000 IPR petitions were filed in 2016 alone,[1] and according to statistics released by the USPTO, about 50% of claims on which trial was instituted were found unpatentable in a PTAB Final Written Decision. While there may not be a single way to make patent claims bulletproof, there are several strategies patent owners can take to strengthen their portfolios and reduce susceptibility to IPR challenges.

Including Many Meaningful Claims with Different Scopes

IPR petitions are subject to a 14,000-word limit, and that limit is strictly enforced and applies irrespective of the number of claims. From the patent owner’s perspective, it is therefore advantageous to present a large number of claims (more than the typical 3/20 approach used to avoid extra claims fees) to make it difficult for the petitioner to adequately present arguments against all of the claims in a single petition. This forces the petitioner to either incur the expense of filing multiple petitions or use “broad brush” arguments against groups of claims, which may not adequately address some of the claims in the group (leaving an opening for the patent owner to exploit).

Even if companies choose to stick with 20 claims, it may be beneficial to include independent claims that are significantly different in scope. The PTAB requires a petitioner to clearly discuss each element of a claim in its petition, and claims with differences will require the petitioner to use space addressing these differences or incur the cost of filing additional petition(s). Similarly, it may be beneficial to use different terminology in different claims for similar features. This may require the petitioner to separately construe similar (but different) terms in both its claim construction portion of the petition and its invalidity arguments. While different terminology may turn out to be construed differently, different constructions may be beneficial from the perspective of enforcement, and certain terms may survive invalidity challenges even when others do not.

Include Narrow Claims

While patent owners and inventors understandably want the broadest possible coverage, including narrow claims that clearly distinguish an invention from the closest known art can significantly increase a patent’s chances of withstanding an IPR attack. Dependent claims can and should specifically focus on narrow features that have a high chance of having commercial value and/or clearly differentiate over known prior art. These claims can provide fallback positions that may not be easily obtained by narrowing amendments during the IPR process. While post-grant proceedings technically allow owners to add new limitations to overcome the prior art, this strategy has been largely unsuccessful in practice.

See the Brinks blog post, “New PTAB Study Confirms Motions to Amend Largely Unsuccessful.”

Include a Means-Plus-Function Claim

Patent practitioners have often refrained from using mean-plus-function claims in the belief that they are overly narrow, and it remains true that the “means” element of a means-plus-function limitation is limited to corresponding structure disclosed in the specification and equivalents thereof.[2] However, for IPR-defense purposes, it may be advantageous to include at least one independent claim structured as a means-plus-function claim. An IPR petitioner must provide a statement on how a claim should be interpreted in its petition, and the rules specifically require the petitioner to “identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function” when a means-plus-function or step-plus-function limitation is at issue.[3] Thus, a claim having a means-plus-function limitation will typically command more attention from the petitioner’s attorneys (and more words of the petition) to properly address the claim.

Search and Analyze Prior Art Before Preparing Patent Applications

It may not be necessary (or realistic) to conduct a formal prior art search for each new application, but companies should consider searching for and analyzing relevant prior art before preparing applications covering high-priority inventions. Some companies elect to skip the pre-filing prior art investigation as a cost-cutting or time-saving measure and instead primarily rely on the search conducted by the patent examiner. While the USPTO requires its examiners to search for prior art, individual examiners may not have the time or resources to conduct a search as comprehensive as one that might be done by a rival company, and it is not uncommon for previously-unknown art to surface in an IPR or litigation context.

There is no guarantee that a pre-filing search will uncover everything, but the search provides a relatively low-cost opportunity to uncover references that may form the basis of an IPR petitioner’s argument down the road. If close prior art turns up, the patent applicant will have the first opportunity to characterize that art and to distinguish it from the invention in the application’s specification. The specification will have a greater influence than describing differences during a subsequent IPR or litigation.

It is important to remember that all people involved with a patent application have a duty to disclose to the Patent Office anything material to patentability,[4] so any material references uncovered in a prior art search should be cited in an Information Disclosure Statement. In the context of IPR defense, placing all relevant art in front of a patent examiner at the prosecution stage should be seen as a benefit, as it may be difficult for a petitioner to repeat analysis first presented by a patent examiner in a subsequent IPR. The PTAB has shown that it may use its discretion to deny IPR institution when a petitioner uses art and positions previously considered by an examiner.[5]

Since arguing validity of an application at the prosecution stage is typically much cheaper than presenting a proper IPR defense, collecting the most relevant art early and handing it over for the examiner’s consideration is also beneficial for its cost-effectiveness. Even if the Examiner takes a different position than one ultimately taken by the petitioner, finding and considering the art at the drafting stage can help practitioners to consider many different positions and then tailor the application to disclose various embodiments circumventing the prior art while the opportunity exists, thereby undermining potential invalidity arguments before filing and providing a basis for additional claiming strategies.

File Continuations Liberally and Keep Families Alive

Companies should consider using a liberal continuation strategy to obtain several applications covering related concepts. While potentially costly, it may be advantageous to keep a continuation application alive well into the term of a related patent, particularly when the original filing covers successful products. If an issued patent with a related pending application is challenged, the pending application may provide the ability to consider the positions taken by the petitioner (and any uncovered art) and then tailor pending claims to withstand a future attack.

Further Thoughts

It should be noted that strategies that make IPR challenges more difficult for a petitioner can come at a financial or other cost for the patent applicant. For example, filing a large number of claims and/or claims with different terms or scope may trigger a restriction requirement and increase the cost of prosecution, and the use of means-plus-function claims may present pitfalls. Accordingly, a patent applicant should weigh the risks and benefits of these strategies before employing them.

[1] <https://www.uspto.gov/sites/default/files/documents/2016-5-31%20PTAB.pdf>

[2] 35 U.S.C. 112(f)

[3] 37 CFR 42.104(b)(3)

[4] 37 C.F.R. § 1.56.

[5] Hulu LLC v. Intertainer Inc., IPR2014-01456 (PTAB March 6, 2015); Microboards Technology LLC v. Stratasy Inc., IPR2015-00287 (PTAB May 28, 2015).

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Additional information about post-grant proceedings can be found on our [Post-Grant Patent practice group page](#). If you have any questions about the defense strategies above or post-grant practice in general, please contact your Brinks attorney.