

The Timing Interplay Between *Inter Partes* Review and District Court Proceedings

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A “New” Trial Forum

*A view of the U.S. Patent and Trademark
Office in Alexandria, VA*

I. Introduction to a New Forum to Challenge Patent Validity

The America Invents Act (AIA), signed into law on September 16, 2011, introduced new mechanisms to challenge the validity of patents through newly created administrative processes. Specifically, the AIA sets forth four new review processes for patents that are undertaken by a newly created administrative tribunal at the U.S. Patent and Trademark Office (PTO), namely, the Patent Trial and Appeals Board (PTAB). The PTAB replaces the prior Patent Board of Appeals and Interferences (BPAI).

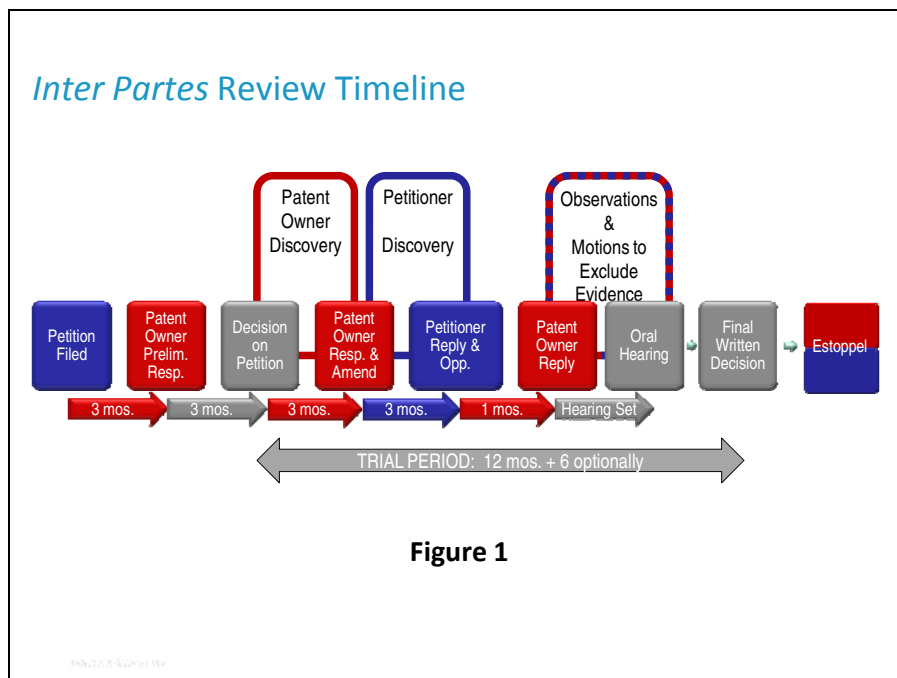
The processes for challenging patent validity are defined as “proceedings” under the AIA. The four proceedings are *inter partes* review, covered business method patent review, post grant review and derivation proceedings. This article focuses on *inter partes* review proceedings. *Inter partes* review is a challenge of a patent by a third party on the basis of prior art patents and printed publications. *Inter partes* review proceedings are “patent trials” that take place before the PTAB.

As with the other new proceedings, an *inter partes* review proceeding is initiated at the PTAB by a “petition.” If the PTAB determines that the petition meets the requirements for instituting the review, the proceeding moves to a “trial.”

The name “trial” is derived from the statutory title of the PTAB and is less analogous to traditional courtroom style trials often portrayed in television and movies. Rather, a “trial” before the PTAB is more akin to the contested portion of *inter partes* reexamination, which existed from 1999 to 2012, or a de novo appellate review of patentability based on the record developed during the proceeding. However, the new *inter partes* review does have some aspects that are similar to conventional civil litigation. These aspects correspond to discovery and motion practice.

II. The *Inter Partes* Review Proceeding

The AIA structured *inter parte* review proceedings with the expectation that the PTAB would complete the review within a fixed (and comparatively brief) period of time. Specifically, the AIA set a time limit of 12 months for the PTAB to issue its Final Decision from the date of deciding to grant a petition for *inter partes* review. For good cause, the statute permits extending the proceeding by up to an additional six-months. The timeline in Figure 1 (below) illustrates how quickly *inter partes* review proceedings are expected to move.



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