

PATENT OFFICE LITIGATION

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Chapter 1

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Robert Greene Sterne

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§ 1:1 Purpose of book

Signed into law on September 16, 2011, the Leahy-Smith America Invents Act (AIA) is the most significant U.S. patent legislation since the 1952 Patent Act, and perhaps since the 1836 Patent Act, which created the concept of the patent claim. The only other event that comes close was the creation of the United States Court of Appeals for the Federal Circuit (“Federal Circuit”) in 1982.¹ The AIA creates new patent provisions and proceedings that fundamentally alter patent practice and the patent landscape in the U.S. These new provisions and proceedings are added to the existing process at the United States Patent & Trademark Office (“Office”). The Office has called some of these “contested proceedings” because there is a party adverse to the patentee, patent owner or applicant. These contested proceedings are layered on to the existing post patent issuance proceedings, although inter partes reexamination proceedings will be phased out. Together they create a matrix of new laws and proceedings that now must be mastered by all stakeholders of the U.S. patent community.

§ 1:2 Audience

This book is written for the many and diverse stakeholders in the U.S. patent community. They include: people involved with the new Patent Office litigations; people engaged in patent procurement; people involved with patent enforcement; people licensing, monetizing and valuing patents; people starting and building companies; people providing products and services that may be implicated by the patent rights of others; and judges, government officials, commentators, academics, students, and

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¹The Federal Courts Improvement Act of 1982. For jurisdiction see 28 U.S.C.A. § 1295. See Chapter 18.

legislators involved with the U.S. patent system. Also included is the public at large, which benefits from a robust patent system that promotes innovation and a robust marketplace. This book takes an inclusive stakeholder perspective and focuses on how the new patent landscape will operate and its impact on all aspects of patent rights and the patent community.

§ 1:3 Patent enforcement

With regard to patent enforcement, patent litigators must decide now how to incorporate or defend against these new AIA provisions and proceedings in their enforcement program. Essentially, the contested proceedings shift the focus from a parallel enforcement regime between the Office and the district courts and the United States International Trade Commission (USITC) that had arisen in the last decade, to more of a serial model where various issues of patentability of the patent claims are tested first in the Office and then the validity aspects of the proceeding moves back to the courts. Whether this serial patentability/validity sequence will in fact occur between the Office and the USITC remains to be seen, since the USITC views its legislative mandate as the very prompt resolution of section 337 proceedings. Judges must determine how to deal with these parallel Office proceedings involving some or all possible validity defenses and other issues involving one or more of the claims of a patent in suit. All must cope with the uncertainty that has been created and how the new world will operate. The issues of timing of the parallel proceedings, possible stay of one proceeding pending the completion of the other, estoppels between the various proceedings, and the appeals of the decisions of each proceeding must be addressed.

The AIA was crafted by Congress with an eye towards the district court and USITC tribunals. But, as is often the case with heavily lobbied and controversial legislation, many last-minute changes were made. These include the new joinder provision, which forces multiple lawsuits to be filed when a single patent is being enforced against multiple defendants, possibly resulting in a multi-district litigation proceeding. The AIA also contains different stay and estoppel provisions that create considerable differences in how patent enforcement in the United States will occur in the future. This book therefore focuses on the important interfaces between these tribunals and the new AIA provisions and proceedings.

Also available as part of the eCourse

[Patent Litigation Updates: Litigation Strategies after AIA; Post-Grant Proceedings, Strategies, and Practice after AIA; Patent Exhaustion; plus Divided Infringement](#)

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