



Drafting Patent Applications to Withstand Post-Grant Proceedings

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Agenda

- Post-Grant Proceedings
- Prior Art Search
- Claims
- Specification
- Prosecution History
- Patent Portfolio
- Budget





Post-Grant Proceedings



Types of Post-Grant Proceedings

| Proceeding | Who Initiates | Filing Timing | Filing Grounds | Responsible USPTO Branch |
|-------------------------------------|-----------------------------|------------------------------------|--|--------------------------|
| Reissue | Patent Owner | Before patent expires | Due to error, some or all of patent is invalid | Original Examiner |
| Supplemental Examination | Patent Owner | Before patent expires | Any "information" relevant to patentability | Examiner |
| <i>Ex Parte</i> Reexamination (EPR) | Patent Owner Third Party | Up to 6 years after patent expires | §§ 102 and 103 based on patents and publications | Different Examiner |
| Post-Grant Review (PGR) | Third Party | Within 9 months of patent issuance | Any ground except best mode noncompliance | PTAB |
| <i>Inter Partes</i> Review (IPR) | Third Party | 9+ months after patent issuance | §§ 102 and 103 based on patents and publications | PTAB |

Prior Art Search



Drafting with the Prior Art in Mind

- Conduct Patentability Search before filing patent application
- Tailor specification and claims to survive Post-Grant Proceedings, including IPR challenges, down the road
- Devote resources on front end to draft clear and concise patent applications



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Title search: Drafting Patent Applications to Withstand Post-Grant Proceedings

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