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Advancing the effective filing date in an inter partes review proceeding

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Why advance effective filing date?

- Challenged patent
 - · Patent Owner: antedate invalidating reference
 - Either: apply Phillips claim construction standard
 - <u>Petitioner</u>: ensure timely filing of IPR petition
- · Invalidating reference
 - · Petitioner: make invalidating reference available as prior art

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"Effective Filing Date" under AIA

- · Earlier of:
 - Actual filing date, OR
 - Earliest application to which priority/benefit can be claimed
- Applications include:
- foreign national applications (§ 119(a), (b), (c), and (d));
- domestic provisional applications (§ 119(e));
- continuing applications based on prior United States nonprovisional applications (§ 120);
- divisional applications based on prior United States nonprovisional applications (§ 121); and
- PCT applications that designate the United States or other countries (§ 365).

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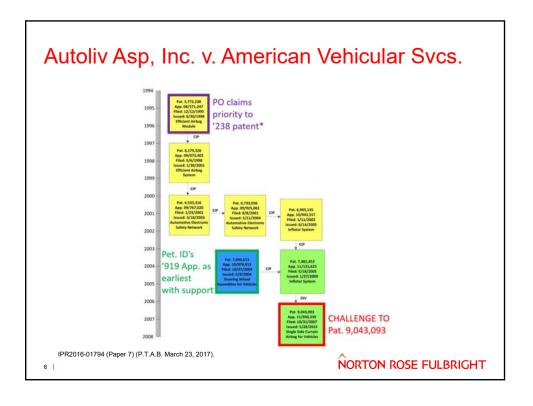
Examples and Practice Tips

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Literal written description support must be shown in each application in the priority chain

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Also available as part of the eCourse 2017 Advanced Patent Law (Austin) eConference

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