

**Use, In Parallel or Sequence, of Different Post-Grant Proceedings:  
USPTO Proceedings, New Japanese PGOs, and/or European Opposition Proceedings**

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Various countries have implemented procedures for contested administrative challenges to patent validity, including:

- in the U.S., a person may file requests for *inter partes* review (“IPR”), covered business review (“CBMR”), and/or post-grant review (“PGR”) with the U.S. Patent & Trademark Office’s Patent Trial and Appeal Board (“PTAB”), depending on the circumstances at hand (collectively, “USPTO Proceeding”);
- in Japan, a person may request a Post-Grant Opposition (“PGO”) from the Japanese Patent Office (“JPO”); and
- in Europe, a person may attempt to institute an Opposition Proceeding with the European Patent Office (“EPO”).

Multiple validity challenges to the same patent may also be instituted and proceed in parallel. In the U.S., for example, a patent may be challenged in a litigation filed in a U.S. district court as well as in a USPTO Proceeding, again, depending on the circumstances at hand. This paper compares and contrasts these various proceedings, and addresses potential interplay.

**I. Background on USPTO Proceedings**

The patent law of the United States underwent a substantial revision in 2011 as part of the “America Invents Act” (“AIA”). One function of the AIA was to introduce three new USPTO Proceedings: IPR, CBMR, and PGR. Generally, any person, who is not the patent owner, may request a USPTO Proceeding. An IPR and PGR may only be filed by a person who did not, prior to filing a request, file a civil action for invalidity of the patent (IPR: 35 U.S.C. § 315; PGR: 35 U.S.C. § 325(a)(1)), an IPR cannot be filed by a person that waited more than one year after being served with a complaint asserting infringement of the patent (35 U.S.C. § 315), and a

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<sup>1</sup> This paper reflects only the present considerations and views of the authors, which should not be attributed to Kirkland & Ellis LLP, or to any of its or their former or present clients.

CBMR may only be filed by a person who has been sued for or charged with infringement of the patent. (37 C.F.R. 42.302(a).) The AIA also includes a number of timing restrictions. A timely PGR, available only for post-AIA patents, must be filed within nine months of the issuance of a patent. (35 U.S.C. § 321.) An IPR and CBMR may be filed any time after issuance of a pre-AIA patent, but an IPR and CBMR may only be filed after nine months after issuance of a post-AIA patent. (35 U.S.C. § 311(c), 37 C.F.R. 42.303.)

The grounds for a USPTO Proceeding depend on the type of proceeding being requested (PGR: 35 U.S.C. § 321; IPR: 35 U.S.C. § 311; CBMR: PL 112-29, Sec. 18(a)(1)(C) (Sept. 16, 2011)):

- Patent lacks novelty (PGR, IPR, CBMR);
- Patent lacks inventive step (PGR, IPR, CBMR);
- Patent lacks enablement or sufficient written description (PGR and CBMR);
- Patent lacks definite claims (PGR and CBMR);
- Patent lacks patentable subject matter (PGR and CBMR); and
- Patent is a defective reissue (PGR and CBMR)

A USPTO Proceeding must be filed in writing with the PTAB. A proper submission must state the filer's name, identify any real parties-in-interest and privies of the filer, number of the challenged patent, provide a claim construction statement, and identify the grounds and evidence supporting the challenge. (PGR/CBMR: 35 U.S.C. § 322 and 37 C.F.R. 42.204, 42.304; IPR: 35 U.S.C. § 312.) The challenge must be accompanied by two fees, a filing fee and an examination fee. The filing fee for an IPR is \$9,000 plus \$200 per claim for each claim challenged over 20, and the examination fee is \$14,000 plus \$400 per claim for each challenged claim over 15. The filing fee for a PGR/CBMR is \$12,000 plus \$250 per claim for each

challenged claim over 20, and the examination fee is \$18,000 plus \$550 per claim for each challenged claim over 15. (37 C.F.R. 42.15.)

A USPTO Proceeding is begun when the submission is filed, but much of the USPTO Proceeding takes place in a trial phase. A panel of three administrative patent judges (“APJ”) evaluates the submission (37 C.F.R. 42.2). The panel of APJs must first determine whether to institute a USPTO Proceeding. (PGR/CBMR: 37 C.F.R. 42.208; IPR: 37 C.F.R. 42.108.) The trial phase will be instituted on an IPR submission if the filer has demonstrated there is a reasonable likelihood it will succeed in invalidating at least one of the challenged claims. (35 U.S.C. § 314(a).) A trial phase will be instituted on a filer’s PGR and CBMR submissions, on the other hand, if it is more likely than not the filer will succeed in demonstrating the challenged claims are invalid or that the submission presents a novel or unsettled legal question. (PGR: 35 U.S.C. § 324(a)-(b); CBMR: 37 C.F.R. 42.304(a).)

If the panel of APJs decides to institute the trial phase of a USPTO Proceeding, the filer must demonstrate unpatentability of the challenged claims by a preponderance of the evidence. (37 C.F.R. 42.1(d).) The USPTO Proceeding is conducted on the papers but includes an oral hearing if requested by the parties, which normally does not involve live testimony of any fact or expert witness(es). (PGR/CBMR: 35 U.S.C. § 326(a)(10); IPR: 35 U.S.C. § 316(a)(10).) The parties may move to terminate a USPTO Proceeding any time before the panel of APJs issues a final decision on the merits but the panel retains discretion to continue with USPTO Proceeding to a final decision on the merits even if terminated. (PGR/CBMR: 35 U.S.C. § 327; IPR: 35 U.S.C. § 317(a).)

Once instituted, parties make various submissions to the panel supporting their respective positions. (PGR/CBMR: 35 U.S.C. § 326(a)(8); IPR: 35 U.S.C. § 316(a)(8).) The patent owner

also has an opportunity to amend the challenged claims. (PGR/CBMR: 35 U.S.C. §§ 326(a)(9), (d)(1); IPR: 35 U.S.C. §§ 316(a)(9), (d)(1). Proposed amendments to the claims are not entered automatically, however, and the patent owner must establish it is entitled to the proposed claims as amended. (37 C.F.R. 42.20(c).)

At the conclusion of the USPTO Proceeding, the panel of APJs may decide to cancel or uphold the challenged claims or accept the proposed claims as amended. (PGR/CBMR: 35 U.S.C. § 328(a)-(b); IPR: 35 U.S.C. § 318(a)-(b).) The party dissatisfied with the outcome of the USPTO Proceeding may appeal the decision to the Court of Appeals for the Federal Circuit. (PGR/CBMR: 35 U.S.C. § 329; 35 U.S.C. § 141(c); IPR: 35 U.S.C. § 319; 35 U.S.C. § 141(c).)

## **II. Background on Japanese PGO**

The Japanese Patent Act was revised in 2014 by the “Bill for the Act for the Partial Revision of the Patent Law, etc.” to re-introduce Post-Grant Oppositions (“PGO”). A PGO may be requested by any person except the patent owner. (Art. 113.) A timely PGO must be filed within six months after the patent is published in the Gazette. (Art 113.)

The grounds for challenging a patent in a PGO must relate to a public interest (Art. 113), which include:

- Patent constitutes double patenting (Art. 39);
- Patent lacks industrial applicability (Art. 29);
- Patent lacks novelty (Art. 29, ¶ 1, *29bis*);
- Patent lacks inventive step (Art. 29, ¶ 2);
- Patent lacks enablement or sufficient written description (Art. 36, ¶ 4(i), ¶ 6);
- Patent lacks definite claims (Art. 36, ¶ 6(i));
- Patent lacks patentable subject matter or may injure the public order, morality, or public health (Art. 32);

- Patent includes matter added by an amendment that exceeds the description, claims, and drawings of the originally filed Japanese patent application of foreign patent application (Art. 17*bis*, ¶ 3);
- Patent was granted in violation of a treaty (Art. 113); and
- Patent was granted to a foreign national not entitled to Japanese patents (Art. 25.)

A PGO may not raise private interest grounds, such as a misappropriated application or that the patent was granted on an application not filed jointly by all joint owners.

A PGO must be filed in writing with the Commissioner of the JPO. The submission must state the filer's name, domicile/residence, number of the challenged patent, and the grounds and evidence supporting the challenge. (Art. 115, ¶ 1.) The grounds for the challenge may be amended until the earlier of (1) expiration of the six-month filing window or (2) a first notice of revocation in the PGO. (Art. 115, ¶ 2.) The PGO must be accompanied by an examination fee of ¥16,500 plus ¥2,400 per challenged claim. (Art. 195.)

A board consisting of three or five trial examiners evaluates a submission (Art. 114, ¶ 1) to satisfy itself whether maintaining the patent would be contrary to the public interest. (Art. 113, ¶ 1.) The entirety of the PGO is conducted on the papers without an oral hearing. (Art. 118, ¶ 1.) The trial examiners conduct the PGO *ex officio*, meaning the examiners may revoke the patent on grounds not included in the PGO but cannot examine unchallenged claims. (Art. 120*bis*, ¶¶ 1-2.)

If the board of trial examiners decides to revoke the patent, the patent owner is notified and given an opportunity to submit rebuttal arguments and/or request correction of the patent. (Art. 120*quinquies*, ¶¶ 1-3.) Once the decision to revoke the patent is made, the PGO may no longer be withdrawn. (Art. 120*quater*, ¶ 1.) The patent owner may request correction of the description, drawings, or the claims, but the correction may not introduce new matter or enlarge the claim scope. (*Id.*) Any proposed corrections must be patentable as of the filing date of the

original application that issued as the challenged patent. (*Id.*) The filer of the PGO is also given an opportunity to submit arguments as to why any proposed corrections are improper under the patent law. (Art.120*quinquies*, ¶ 5)

The board of trial examiners reviews the entire record and arrives at a determination. The board may decide to maintain the patent. (Art. 114, ¶ 4.) Decisions to maintain the patent are not appealable and the only recourse for the filer of the PGO is to file a patent invalidation trial. (Art. 114, ¶ 5.) The trial examiners may decide to revoke the patent. (Art. 114, ¶ 3.) If revoked, the patent is deemed void *ab initio*. (*Id.*) The patent owner may appeal a decision revoking its patent to the Intellectual Property High Court within 30 days. (Art. 178, ¶¶ 1, 3).

### **III. Background on European Opposition Proceeding**

Opposition Proceedings in Europe are governed by the European Patent Convention and associated rules and regulations. A request for an Opposition Proceeding may be filed by any person other than the patent owner. (Art 99(1).) A timely request for an Opposition Proceeding must be filed within nine months after the notice of issuance of the patent was published. (*Id.*)

An Opposition Proceeding may be requested based on certain stated grounds of patentability (Art. 100):

- Patent lacks industrial application (Art. 52(1) and Art. 57);
- Patent lacks novelty (Art. 52(1) and Art. 54 and Art. 55);
- Patent lacks inventive step (Art. 52(1) and Art. 56);
- Patent lacks enablement and sufficient written description (Art. 100);
- Patent lacks patentable subject matter (Art. 52(2));
- Patent may be contrary to the *ordre public* or morality (Art. 53); and
- Patent includes matter added by an amendment that exceeds the description, claims, and drawings of the originally filed European patent application (Art. 100);

A request for an Opposition Proceeding must be filed in writing with the EPO in Munich, The Hague, or Berlin. (Rule 76(1).) The submission must state the filer's name, address/nationality, the patent being challenged, and the grounds and evidence supporting the challenge. (Rule 76(2).) An examination fee of €775 is required. (Code 010.)

A panel of three examining members of the Opposition Division reviews submissions to confirm that a ground prejudices the maintenance of the patent. (Art. 101(1).) If the submission is accepted, and an Opposition Proceeding begins, the panel will determine whether the filer has shown that the balance of probabilities weights against maintaining the patent. The standard of proof, however, varies as defined by case law, depending on the grounds and can range from a preponderance of the evidence to an "up to the hilt" standard. (T 0729/91 (21 Nov. 1994); T 0472/92 (20 Nov. 1996).) The Opposition Proceeding is conducted on the papers, but allows the parties or panel to request an oral hearing. (Rule 111.) The panel conducts the Opposition Proceeding *ex officio*. (Rule 81.) An Opposition Proceeding may be withdrawn at any time but, consistent with the principle of *ex officio*, the panel has discretion to continue the Opposition Proceeding even if it is withdrawn. (Rule 84.)

If the request for an Opposition Proceeding is accepted, the panel will determine whether at least one ground prejudices maintaining the patent. (Art. 101(1).) The panel then invites the parties to make various submissions and file observations on submissions from another party or those of the panel. (*Id.*) The patent owner may also attempt to amend the description, claims, and drawings of the patent. (Art. 101(3).) If the panel concludes the patent is invalid, it will revoke the patent; otherwise, the panel will reject and cancel the Opposition Proceeding. (Art. 101(2).) If revoked, the patent ceases to exist when the decision is published in the European

Patent Bulletin and is retroactive. (Art. 105b(3), 68.) Any party dissatisfied by the panel's decision may appeal to the Boards of Appeal within two months. (Art. 106, 108.)

Opposition Proceedings may be conducted in parallel or serially with enforcement actions of the same patent in a European national court, interplay similar to that between USPTO Proceedings and U.S. district court litigation, discussed below in Section IV. The national court of England, for example, has recognized that parallel validity challenges in national courts and in the EPO are inherent in the legal arrangements in the European Patent Convention. *Glaxo Grp. Ltd. v. Genentech Inc.*, [2008] EWCA Civ 23 (31 Jan. 2008). Where an Opposition Proceeding is ongoing, however, English courts have discretion to stay a concurrent English patent litigation if guided to do so by the following considerations:

1. The discretion, which is very wide indeed, should be exercised to achieve the balance of justice between the parties having regard to all the relevant circumstances of the particular case.
2. The discretion is of the Patents Court, not of the Court of Appeal. The Court of Appeal would not be justified in interfering with a first instance decision that accords with legal principle and has been reached by taking into account all the relevant, and only the relevant, circumstances.
3. Although neither the EPC nor the 1977 Act contains express provisions relating to automatic or discretionary stay of proceedings in national courts, they provide the context and condition the exercise of the discretion.
4. It should thus be remembered that the possibility of concurrent proceedings contesting the validity of a patent granted by the EPO is inherent in the system established by the EPC. It should also be remembered that national courts exercise exclusive jurisdiction on infringement issues.
5. If there are no other factors, a stay of the national proceedings is the default option. There is no purpose in pursuing two sets of proceedings simply because the Convention allows for it.
6. It is for the party resisting the grant of the stay to show why it should not be granted. Ultimately it is a question of where the balance of justice lies.
7. One important factor affecting the exercise of the discretion is the extent to which refusal of a stay will irrevocably deprive a party of any part of the benefit



which the concurrent jurisdiction of the EPO and the national court is intended to confer. Thus, if allowing the national court to proceed might allow the patentee to obtain monetary compensation which is not repayable if the patent is subsequently revoked, this would be a weighty factor in favour of the grant of a stay. It may, however, be possible to mitigate the effect of this factor by the offer of suitable undertakings to repay.

8. The Patents Court judge is entitled to refuse a stay of the national proceedings where the evidence is that some commercial certainty would be achieved at a considerably earlier date in the case of the UK proceedings than in the EPO. It is true that it will not be possible to attain certainty everywhere until the EPO proceedings are finally resolved, but some certainty, sooner rather than later, and somewhere, such as in the UK, rather than nowhere, is, in general, preferable to continuing uncertainty everywhere.

9. It is permissible to take account of the fact that resolution of the national proceedings, whilst not finally resolving everything, may, by deciding some important issues, promote settlement.

10. An important factor affecting the discretion will be the length of time that it will take for the respective proceedings in the national court and in the EPO to reach a conclusion. This is not an independent factor, but needs to be considered in conjunction with the prejudice which any party will suffer from the delay, and lack of certainty, and what the national proceedings can achieve in terms of certainty.

11. The public interest in dispelling the uncertainty surrounding the validity of monopoly rights conferred by the grant of a patent is also a factor to be considered.

12. In weighing the balance it is material to take into account the risk of wasted costs, but this factor will normally be outweighed by commercial factors concerned with early resolution.

13. The hearing of an application for a stay is not to become a mini-trial of the various factors affecting its grant or refusal. The parties' assertions need to be examined critically, but at a relatively high level of generality. *Id.*

*IPCom GmbH & Co Kg v. HTC Europe Co. Ltd.*, [2013] EWCA Civ 1496. England does not have a specialized court dedicated to nullity actions.

Germany is another example of a European country that permits and, in fact, anticipates parallel proceedings challenging a patent's validity. Unlike other European countries, a German Landgerichte regional court does not have jurisdiction over the validity of a patent. As such,

defendants commonly turn to parallel Opposition Proceedings at the EPO. The German regional courts also have discretion to stay parallel infringement proceedings pending resolution of an Opposition Proceedings. (Sec. 148, Zivilprozessordnung.) German Patent Law further provides for specific nullity actions that may be filed in Federal Patent Court, but only if the time to file a request for an Opposition Proceeding has closed. (Art. 81(2), German Patent Act.)

France, like England, does not have a specialized court for revocation actions and also expects parallel validity proceedings. Validity of patent may be challenged in an enforcement proceeding pending before a Tribunaux de Grande Instance district court. (Art. L613-25, French Intellectual Property Code.) French district courts, however, have wide discretion to stay enforcement actions pending resolution of an Opposition Proceeding, but only if the court finds the Opposition Proceeding has a high likelihood of success.

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The table below summarizes and compares various elements of USPTO Proceedings, Japanese PGOs, and European Opposition Proceedings.

Factor	USPTO Proceedings	JPO Post-Grant Oppositions	EPO Oppositions
Who can file	<p><b>IPR/PGR:</b> Any person other than patent owner, unless person filed civil action of invalidity first.</p> <p><b>IPR:</b> Must be filed less than 1 year after service of complaint asserting infringement</p> <p><b>CBMR:</b> Only person sued or charged with infringement</p> <p>IPR: 35 U.S.C. § 315</p> <p>PGR: 35 U.S.C. § 325(a)(1)</p> <p>CBMR: 37 C.F.R. 42.302(a)</p>	<p>Anyone other than patent owner.</p> <p>Art. 113, ¶ 1</p>	<p>Anyone other than patent owner.</p> <p>Art 99(1)</p>

Factor	USPTO Proceedings	JPO Post-Grant Oppositions	EPO Oppositions
When to file	<p><b>PGR:</b> Within 9 months of issue.</p> <p><b>IPR/CBMR:</b> pre-AIA patents, date of issue; post-AIA patents, 9 months or later</p> <p>IPR: 35 U.S.C. § 311(c)</p> <p>PGR: 35 U.S.C. § 321</p> <p>CBMR: 37 C.F.R. 42.303</p>	<p>Within 6 months from publication of patent.</p> <p>Art. 113, ¶ 1</p>	<p>Within 9 months from publication of notice of issuance.</p> <p>Art 99(1)</p>
Bases	<p>Patentability.</p> <p>IPR: 35 U.S.C. § 311(b)</p> <p>PGR: 35 U.S.C. § 321</p> <p>CBMR: PL 112-29, Sec. 18(a)(1)(C) (Sept. 16, 2011)</p>	<p>Public interest reasons.</p> <p>Art. 113, ¶ 1</p>	<p>Patentability.</p> <p>Art. 100</p>
Standard to institute	<p><b>IPR:</b> reasonable likelihood of success.</p> <p><b>PGR/CBMR:</b> “more likely than not” or “novel or unsettled legal question.”</p> <p>IPR: 35 U.S.C. § 314(a)</p> <p>PGR: 35 U.S.C. § 324(a)-(b)</p> <p>CBMR: 37 C.F.R. 42.304(a)</p>	<p>Whether maintaining the patent would be against the public interest.</p> <p>Art. 113, ¶ 1</p>	<p>Whether a ground “prejudices the maintenance” of the patent.</p> <p>Art. 101(1)</p>
Examination	<p>Three APJs.</p> <p>37 C.F.R. 42.2</p>	<p>Three or five trial examiners.</p> <p>Art. 114, ¶ 1</p>	<p>Three examining members.</p> <p>Art. 101(1)</p>
Standard of proof	<p>Preponderance.</p> <p>37 C.F.R. 42.1(d)</p>	<p>Unclear.</p>	<p>The “balance of probabilities,” which ranges from a preponderance to “up to the hilt,” all depending on the basis for the opposition.</p> <p>T 0729/91 (21 Nov. 1994); T 0472/92 (20 Nov. 1996)</p>
Consequence of revocation	<p>Patent rights end.</p> <p>35 U.S.C. § 318(b)</p>	<p>Patent rights cease to exist retroactively.</p> <p>Art. 114, ¶ 3</p>	<p>Patent rights cease to exist retroactively.</p> <p>Art. 105b(3)</p>
How conducted	<p>On the papers but oral argument can be requested.</p> <p>IPR: 35 U.S.C. § 316(a)(10)</p> <p>PGR/CBMR: 35 U.S.C. § 326(a)(10)</p>	<p>On the papers.</p> <p>Art. 118, ¶ 1</p>	<p>On the papers but oral argument can be requested.</p> <p>Rule 111</p>
<i>ex officio</i> Examination	<p>No.</p>	<p>Yes.</p> <p>Art. 120<i>bis</i>, ¶ 1</p>	<p>Yes.</p> <p>Rule 81</p>

Factor	USPTO Proceedings	JPO Post-Grant Oppositions	EPO Oppositions
Withdrawal	Can be withdrawn but panel has discretion to continue. IPR: 35 U.S.C. § 317(a) PGR/CBMR: 35 U.S.C. § 327	Cannot be withdrawn after notice of revocation. Art. 120 <sup>quater</sup> , ¶ 1	Can be withdrawn but board has discretion to continue. Rule 84
Amendment	Yes. IPR: 35 U.S.C. §§ 316(a)(9), (d)(1) PGR/CBMR: 35 U.S.C. §§ 326(a)(9), (d)(1)	Yes. Art. 120 <sup>quinquies</sup> , ¶ 2	Yes. Art. 101(3)
Filing Fee	<b>IPR:</b> \$23,000 + \$200 for each claim over 20 in filing and \$400 for each claim over 15 included in proceeding. <b>PGR/CBMR:</b> \$30,000 + 250 for each claim over 20 in filing and \$550 for each claim over 15 included in proceeding. 37 C.F.R. 42.15	¥16,500 + ¥2,400 per claim. Art. 195	€775. Code 010
Estoppel	Yes. IPR: 35 U.S.C. § 315(e) PGR/CBMR: 35 U.S.C. § 325(e)	None	None. <i>Glaxo Grp. Ltd. v. Genentech Inc.</i> , [2008] EWCA Civ 23 (31 Jan. 2008)

#### IV. Potential Interplay Between U.S. District Court and Post-Grant Proceedings

Litigation in a U.S. district court may proceed in parallel or sequence with a USPTO Proceeding, depending on the circumstances, and arguments or decisions issued in one may certainly impact the other. Similarly, a U.S. district court litigation may be effected by arguments or decisions issued in a foreign post-grant proceeding.

Many requests for a USPTO Proceeding, roughly 80 percent, are filed when there is already a related litigation pending in a U.S. district court. Conducting such proceedings concurrently may provide certain strategic advantages but may also substantially increase the total cost for the parties. A party or the parties collectively may thus seek to stay the U.S. district court litigation pending resolution of the USPTO Proceeding to streamline the litigation and

control costs. A judge faced with a stay motion generally evaluates three factors: (1) the stage of the litigation, including considerations of whether the litigation is in its early stage, whether discovery is complete or is still ongoing, and whether claim construction has been completed; (2) whether a stay will simplify the issues, including considerations of whether any claims or defenses will remain at issue in the case after a USPTO Proceeding is completed, whether a USPTO Proceeding has been requested of all asserted patents and/or claims, and whether the party requesting a stay will be subject to AIA estoppel; and (3) whether a stay would unduly prejudice or present a clear tactical disadvantage to the nonmoving party, including whether the parties in the litigation are competitors, whether a USPTO Proceeding has been instituted, and whether the plaintiff in the litigation is seeking an injunction. *See, e.g., Universal Elec., Inc. v. Universal Remote Control, Inc.*, 943 F. Supp. 2d 1028, 1030 (C.D. Cal. 2013). At present, roughly 60 percent of stay motions are granted, which is 10 percent lower than the same time last year. *See, e.g., Intellectual Ventures II LLC v. U.S. Bancorp, et al.*, 13-CV-2071, 2014 WL 5369386 (D. Minn. Aug. 7, 2014).

If a U.S. district court litigation is not stayed, and the litigation proceeds in parallel with a USPTO Proceeding, the sequence in which various final decisions are made might well effect which resolution is controlling. In *Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 721 F.3d 1330 (Fed. Cir. 2013), *cert. denied*, 134 S. Ct. 2295 (2014), a U.S. district court granted a motion for summary judgment and found claims of a patent to be not invalid. In the meantime, the USPTO completed a post-grant review and invalidated the same patent. The U.S. district court then entered a final judgment on its decision confirming the patent. On appeal, the United States Court of Appeals for the Federal Circuit affirmed the USPTO's decision finding the patent to be invalid.

If, on the other hand, a U.S. district court litigation is stayed, and a USPTO Proceeding comes to an end, the litigation may resume, if necessary. The filer of the request for a USPTO Proceeding and patent owner will need to resolve what issues are eventually presented in any jury or bench trial. *First*, if the filer did not invalidate the challenged claims, estoppel provisions of the AIA will limit the filer's ability to put on a full invalidity defense. Specifically, the filer, and any real-parties-in-interest or privies of the filer, will be estopped from arguing in the U.S. district court litigation or to the U.S. International Trade Commission that a challenged claim is invalid on any ground the filer "raised or reasonably could have raised" during an IPR or PGR (PGR: 35 U.S.C. § 325(e); IPR: 35 U.S.C. § 315(e)), or those grounds actually raised in a CBMR. (PL 112-29, Sec. 18(a)(1)(D) (Sept. 16, 2011).) Estoppel is a major factor each filer must consider when determining a strategy for parallel/serial validity challenges.

*Second*, the parties will also need to address how the USPTO Proceeding affects the U.S. district court's analysis of any subsequent summary judgment motions. For example, patent owner may move for summary judgment that claims that survive a USPTO Proceeding are not invalid and point to a defendant's unsuccessful attempt to institute a USPTO Proceeding for support. Under similar circumstances, the U.S. district court in *The Procter & Gamble Co. v. Team Techs., Inc.*, No. 12-cv-552 (S. D. Ohio Jul. 3, 2014), granted patent owner's motion for summary judgment of no invalidity, stating that decisions of administrative agencies, such as the USPTO, are properly considered, especially where they address the same prior art or other issues equally involved in the litigation. *Id.* at 21-24.

If the litigation proceeds beyond summary judgment and is presented to a jury, whether the jury hears about a USPTO decision in a post-grant proceeding is of high importance as well. Patent Owner may gain some favor with the jury that if it were to inform the jury the USPTO

denied a request for a USPTO Proceeding of the asserted patent. On the other hand, a defendant may be able to sway the jury by informing it that the USPTO accepted a request and instituted a USPTO Proceeding. Parties are thus likely to address whether evidence of these decisions is presented to the jury in motions *in limine*. U.S. trial judges have broad discretion when ruling on *in limine* motions, including motions requesting to prevent or permit the presentation of such evidence to the jury. See, e.g., *Universal Elec. Inc. v. Universal Remote Control Inc.*, 8:12-cv-329 (C.D. Cali Apr. 21, 2014) (denying motions *in limine* to preclude mention of a rejected IPR); *InterDigital Commc'ns. Inc. v. Nokia Corp.*, 1:13-cv-10 (D. Del. Sept. 19, 2014) (granting motions *in limine* to preclude mention of a rejected IPR); *UltraTec, Inc. v. Sorenson Commc'ns, Inc.*, 3:13-cv-346 (W.D. Wisc Oct 8, 2014) (granting-in-part motions *in limine* to preclude mention of an instituted IPR to the jury but allowing mention of the same to judge).

Similarly, U.S. district courts are sensitive to litigants presenting evidence of decisions or arguments made in a foreign post-grant proceeding to the jury. In *PharmaStep Therapeutics, Inc. v. Viacell Inc.*, 1:02-cv-148 (D. Del. Sept. 30, 2003), for example, patent owner moved *in limine* to prevent the defendant from presenting to the jury that the EPO revoked one of patent owner's related European patents as a result of an Opposition Proceeding. The court, in granting the motion and precluding presentation of the evidence, observed that European patent law is different from U.S. patent law and the claims revoked by the EPO were different from those at issue in the U.S. litigation. *Id.* at \*1-\*2.

A decision or arguments presented in a foreign post-grant proceeding may also substantially effect U.S. district court litigation. For example, arguments made by patent owner to the EPO may be used in U.S. district court litigation to limit the scope of the U.S. counterpart patent of a European patent. In *VAE Nortrak N. Am. v. Progress Rail Serv. Corp.*, 459 F. Supp.

2d 1142 (N.D. Alabama Oct. 25, 2006), patent owner made various arguments to overcome prior art in a European Opposition Proceeding. The defendant moved for summary judgment on patent owner's infringement arguments under the doctrine of equivalents. The U.S. district court first observed that representations made to a foreign patent office "should be considered" when, as here, they are relevant. *Id.* at 1154 (citing *Tanabe Seiyaku Co., Ltd. v. U.S. Int'l Trade Comm'n*, 109 F.3d 726 (1997).) The court then granted defendant's motion, observing that patent owner's statements precluded infringement arguments under the doctrine of equivalents. *Id.* at 1156.

As patent litigation continues to grow in size, complexity, and sophistication, worldwide, it is important for practitioners to consider how to best take advantage of various local and foreign post-grant review proceedings as well as parallel/serial challenged to the same patent in multiple forums. As this paper demonstrates, all parties have a number of opportunities to make their case, but such parties must be cautious about how arguments they make might be used in a later subsequent proceeding.