



*Fordham Intellectual Property Law Institute & Emily C. & John E. Hansen Intellectual Property Institute  
23<sup>rd</sup> Annual Fordham Intellectual Property Law & Policy Conference*

*Cambridge, UK April 9, 2015*

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

**Ken Adamo\***

**Kirkland & Ellis LLP**

**300 North LaSalle  
Chicago, Illinois 60654  
Tel (312) 862-2671  
Cell (216) 632-9537  
Fax (312) 862-2200**

**601 Lexington Avenue  
New York, New York 10022-4611  
Tel (212) 446-4839  
Fax (212) 446-4900**

**[kradamo@kirkland.com](mailto:kradamo@kirkland.com)**

## Global Post-Grant Proceedings

- USPTO Proceedings:
  - *inter partes* review (“IPR”)
  - covered business method review (“CBMR”)
  - post-grant review (“PGR”)
  
- JPO Post-Grant Oppositions (“PGO”)
  
- EPO Opposition Proceedings

## Comparing Global Post-Grant Proceedings

Factor	USPTO Proceedings	JPO Post-Grant Oppositions	EPO Oppositions
Who can file	<p><b><u>IPR/PGR</u></b>: Any person other than patent owner, unless person filed civil action of invalidity first.</p> <p><b><u>IPR</u></b>: Must be filed less than 1 year after service of complaint asserting infringement.</p> <p><b><u>CBMR</u></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>
When to file	<p><b><u>PGR</u></b>: Within 9 months of issue.</p> <p><b><u>IPR/CBMR</u></b>: pre-AIA patents, date of issue; post-AIA patents, 9 months or later.</p> <p>PGR: 35 U.S.C. § 321</p> <p>IPR: 35 U.S.C. § 311(c)</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>

## Comparing Global Post-Grant Proceedings

Factor	USPTO Proceedings	JPO Post-Grant Oppositions	EPO Oppositions
Bases	Patentability. IPR: 35 U.S.C. § 311(b) PGR: 35 U.S.C. § 321 CBMR: PL 112-29, Sec. 18(a)(1)(C)	Public interest reasons. Art. 113, ¶ 1	Patentability. Art. 100
Standard to institute	<b>IPR:</b> reasonable likelihood of success. <b>PGR/CBMR:</b> “more likely than not” or “novel or unsettled legal question.” IPR: 35 U.S.C. § 314(a) PGR: 35 U.S.C. § 324(a)-(b) CBMR: 37 C.F.R. 42.304(a)	Whether maintaining the patent would be against the public interest. Art. 113, ¶ 1	Whether a ground “prejudices the maintenance” of the patent. Art. 101, ¶ 1
Examination	Three APJs. 37 C.F.R. 42.2	Three or five trial examiners. Art. 114, ¶ 1	Three examining members. Art. 101(1)
Standard of proof	Preponderance. 37 C.F.R. 42.1(d)	Unclear.	The “balance of probabilities,” which ranges from a preponderance to “up to the hilt.” T 0729/91 (21 Nov. 1994); T 0472/92 (20 Nov. 1996)

## Comparing Global Post-Grant Proceedings

Factor	USPTO Proceedings	JPO Post-Grant Oppositions	EPO Oppositions
Consequence of revocation	Patent rights end. 35 U.S.C. § 318(b)	Patent rights cease to exist retroactively. Art. 114, ¶ 3	Patent rights cease to exist retroactively. Art. 105b(3)
How conducted	On the papers but oral argument can be requested. IPR: 35 U.S.C. § 316(a)(10) PGR/CBMR: 35 U.S.C. § 326(a)(10)	On the papers. Art. 118, ¶ 1	On the papers but oral argument can be requested. Rule 111
<i>ex officio</i> Examination	No.	Yes. Art. 120 <i>bis</i> , ¶ 1	Yes. Rule 81
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 <i>quater</i> , ¶ 1	Can be withdrawn but board has discretion to continue. Rule 84
Amendment	Yes. IPR: 35 U.S.C. § 316 (d)(1) PGR/CBMR: 35 U.S.C. § 326 (d)(1)	Yes. Art. 120 <i>quinquies</i> , ¶ 2	Yes. Art. 101(3)

## Comparing Global Post-Grant Proceedings

Factor	USPTO Proceedings	JPO Post-Grant Oppositions	EPO Oppositions
Filing Fee	<p><b>IPR:</b> \$23,000 + \$200 for each claim over 20 in filing and \$400 for each claim over 15 included in proceeding.</p> <p><b>PGR/CBMR:</b> \$30,000 + 250 for each claim over 20 in filing and \$550 for each claim over 15 included in proceeding.</p> <p>37 C.F.R. 42.15</p>	<p>¥16,500 + ¥2,400 per claim.</p> <p>Art. 195</p>	<p>€75.</p> <p>Code 010</p>
Estoppel	<p>Yes.</p> <p>IPR: 35 U.S.C. § 315(e)</p> <p>PGR/CBMR: 35 U.S.C. § 325(e)</p>	<p>None</p>	<p>None.</p> <p><i>Glaxo Grp. Ltd. v. Genentech Inc.</i>, [2008] EWCA Civ 23 (31 Jan. 2008)</p>

## Potential Interplay: U.S. District Court and USPTO

- Motion to Stay
  - *Universal Elec., Inc. v. Universal Remote Control, Inc.*, 943 F. Supp. 2d 1028, 1030 (C.D. Cal. 2013).
- Timing Conflict
  - *Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 721 F.3d 1330 (Fed. Cir. 2013), *cert. denied*, 134 S. Ct. 2295 (2014).
- Estoppel
  - PGR: 35 U.S.C. § 325(e); IPR: 35 U.S.C. § 315(e);
  - CBMR: PL 112-29, Sec. 18(a)(1)(D) (Sept. 16, 2011).
- Summary Judgment
  - *The Procter & Gamble Co. v. Team Techs., Inc.*, No. 12-cv-552 (S. D. Ohio Jul. 3, 2014).
- Motions *in Limine*
  - *Universal Elec. Inc. v. Universal Remote Control Inc.*, 8:12-cv-329 (C.D. Cali Apr. 21, 2014) (denying MIL to preclude mention of a rejected IPR);
  - *InterDigital Commc'ns. Inc. v. Nokia Corp.*, 1:13-cv-10 (D. Del. Sept. 19, 2014) (granting MIL 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 MIL to preclude mention of an instituted IPR to the jury but allowing mention of the same to judge).

## Potential Interplay: U.S. District Court and EPO

- Summary Judgment

- *VAE Nortrak N. Am. v. Progress Rail Serv. Corp.*, 459 F. Supp. 2d 1142 (N.D. Alabama Oct. 25, 2006);
- *Tanabe Seiyaku Co., Ltd. v. U.S. Int'l Trade Comm'n*, 109 F.3d 726 (Fed. Cir. 1997).

- Motions *in Limine*

- *PharmaStep Therapeutics, Inc. v. Viacell Inc.*, 1:02-cv-148 (D. Del. Sept. 30, 2003)



## Potential Interplay: European Court and EPO

- Parallel proceedings in national courts and at EPO are inherent in legal authority of European Patent Convention
  - *Glaxo Grp. Ltd. v. Genentech Inc.*, [2008] EWCA Civ 23 (31 Jan. 2008).
  
- National courts have wide discretion to stay cases pending resolution of EPO Opposition Proceeding
  - *IPCom GmbH & Co Kg v. HTC Europe Co. Ltd.*, [2013] EWCA Civ 1496 (discretion in English court).
    - Sec. 148, Zivilprozessordnung (discretion in German court).