

Inter Partes Review for U.S. Patent Invalidation (IPR) – Introduction

An IPR is a process for challenging the validity of a U.S. Patent. The challenge is limited to the use of prior art patents and printed publications. 35 U.S.C. §311(b). In general, the invalidity challenge would be that the patent is anticipated by the prior art (35 U.S.C. §102) and/or rendered obvious by the prior art (35 U.S.C. §103). IPRs were first available for use on September 16, 2012.

The statutory basis for the IPR process is found in 35 U.S.C. §§311-319. The regulations applying to the IPR process are found in 37 C.F.R. §§42.1-42.80 (Trial Practice & Procedure) and 37 C.F.R. §§42.100-42.123 (Inter Partes Review). General guidance for the IPR trial procedure is found in the Office Patent Practice Guide, and the orders issued by the U.S. Patent and Trademark Office Patent Trial and Appeal Board (Board) as part of the ongoing IPRs. Appeals from a Board decision in an IPR are made to the Court of Appeals for the Federal Circuit (CAFC). 35 U.S.C. §319. As of February 1, 2014, the CAFC has not rendered any decisions on the appeal of an IPR decision from the Board.

An IPR can be used to challenge the validity of any patent after it has been issued for more than nine months. 35 U.S.C. §311(c)(1). However, many of the IPRs filed to date have been filed in relation to an infringement action filed in a U.S. federal district court. After a party accused of infringement is served with an infringement complaint, that party has only a one-year window from the date of service within which to file an IPR. 35 U.S.C. §315(b). Accordingly, if a party is served with a complaint for infringement on the date a patent is issued, the party will have only a three-month window within which to file an IPR.

The U.S. Patent Office has exclusive jurisdiction over an IPR. 35 U.S.C. §311(a). In other words, an IPR is an invalidity trial process that is conducted in the U.S. Patent Office and not in a U.S. federal district court. U.S. district courts have jurisdiction to determine the validity of a patent, but not based upon the statutory and regulatory framework created for IPRs. U.S. district courts are currently the only entity with statutory jurisdiction over the determination of patent infringement. See, 28 U.S.C. §1338. When an IPR is brought during a patent litigation in a federal district court, the patent litigation is likely to be stayed or partially stayed until the IPR is decided. If a patent challenger files an IPR for a patent and then challenges the patent in a district court action, the action will be

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stayed. 35 U.S.C. 315(2).

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