

Protecting Your Patents from Post-Grant Challenges

February 27, 2018

A GC3 Startup Network Webinar



What is the GC3?

- A cross-sector, full value chain business membership organization
- A convener of collaborations to advance green chemistry innovation & practice
- An advocate for government policy & funding that advances green chemistry R&D and innovation

Mission: To make green chemistry standard practice – **Mainstream** – in industry, for innovation, public health, and environmental protection



More than 120 Members Across Sectors and the Value Chain





GC3 Green & Bio-Based Chemistry Startup Network

*Creating an innovation ecosystem for green and
bio-based chemistry technologies*

Goals

- Support green and bio-based chemistry start-ups
- Introduce large strategics to new chemical technologies, partnership and investment opportunities

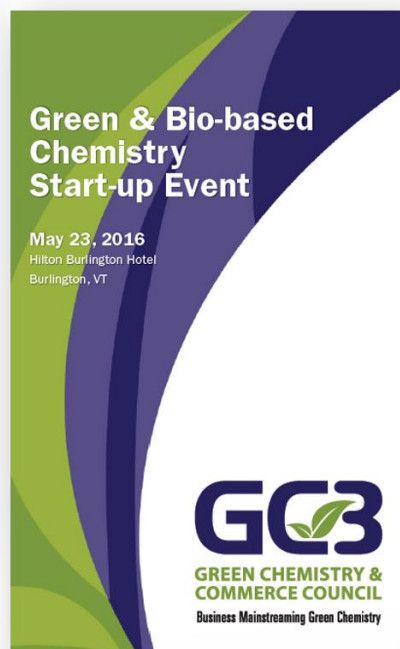


Members of the GC3 Startup Network Include:



GC3 Startup Network Technology Showcases

Workshop on Leveraging Partnerships
to Accelerate Green & Bio-Based
Chemistry Innovation



February 1, 2017

Hosted by

LEVI STRAUSS & CO.

<http://greenchemistryandcommerce.org/startup-network/>





GC3 INNOVATORS ROUNDTABLE

May 8-10, 2018 • Kingsport, TN
Hosted by
EASTMAN



**13th Annual
GC3 Innovators Roundtable**
May 8-10, 2018

**3rd Annual Green & Bio-Based
Chemistry Technology
Showcase & Networking Event**
May 8, 2018

Registration is now open!



Ground Rules

- Due to the number of participants in the webinar, all lines will be muted
- If you have a question or comment, please type it in the “Questions” box located in the control panel
- Questions will be answered at the end of the presentation

Today's Lineup

Moderator



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Presenters



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FINNEGAN

Protecting Your Patents from Post-Grant Challenges

By Mark Feldstein and Mike Flibbert

February 27, 2018



Post-Grant Proceedings

Proceeding	Patents	Grounds	Timing
<u>Inter Partes Review (IPR)</u>	<u>All US patents</u>	102 and 103 based on prior art patents and printed publications	For pre-AIA patents, anytime after grant or reissue For AIA patents, from later of: (i) 9 months after grant or reissue; or (ii) termination of any PGR
Post Grant Review (PGR)	Only AIA patents (first-inventor-to-file system)	101, 102, 103, 112, double patenting	From grant to 9 months after grant or reissue
Covered Business Method (CBM)	All US patents concerning financial products or services (excludes technological inventions) Must be sued or charged with infringement	Same as PGR (some 102 differences)	Only available until 9/16/20

Why Have IPRs Become So Popular?

Lower burden of proof
No presumption of validity

**High institution and claim
cancellation rates**

Fast resolution

- Decided in 12-18 months
- Direct appeal to CAFC

Highly skilled judges

Avoid or stay litigation

**Difficult for Patent Owner
to amend claims**

Lower cost

- Limited discovery
- No live testimony

Leverage for settlement

**Limited estoppel (prior art
issues)**

How to Make Your Company IPR Ready

- Obtain strong patents (specification must have sufficient technical detail; identify/distinguish closest prior art; seek claims of varying type and scope)
- Conduct a portfolio review of your patents
- Keep continuation applications pending
- Identify/maintain contacts with inventors and technical experts
- Engage a legal team with both litigation and Patent Office experience
- Explain what an IPR is to management/business

Patent Owner Strategies to Avoid Institution

- § 315(b) statutory bar (even if 1 day late!)
- Legally flawed claim construction
- Missing claim elements in cited prior art
- Reliance on non-prior art or conclusory expert declaration
- Failure to address reasonable expectation of success or unexpected results
- § 325(d) discretion to deny “follow-on” petitions
- Failure to prove printed publication

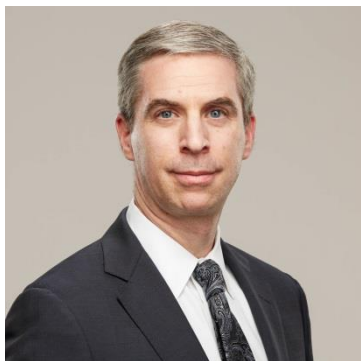
Using IPRs to Challenge Competitors' Patents

- Identify closest prior art (ideally more relevant than considered by PTO during prosecution)
- Retain strong expert witnesses
- Limit proposed grounds of unpatentability to avoid redundancy
- Explain the technology and prior art in a way that facilitates the judges' understanding
- Use claim charts to map prior art onto claims
- Address file history evidence of unexpected results or commercial success
- Avoid evidentiary pitfalls (e.g., printed pub. issues)

USPTO's IPR Fees for 2018

- **IPR Request Fee:** \$15,500 (up to 20 claims)
 - \$300 per claim for each claim >20
- **IPR Post-Institution Fee:** \$15,000 (up to 15 claims)
 - \$600 per claim for each claim >15
 - refundable if no IPR is instituted

Thank you



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Question & Answer

Please enter questions or comments in the “Questions” box located in the control panel.

Upcoming Patent Webinar Series

A GC3 Startup Network Webinar

Part 3: Enforcing Your Patents

Wednesday, March 28, 2018 at 12:00 PM EDT

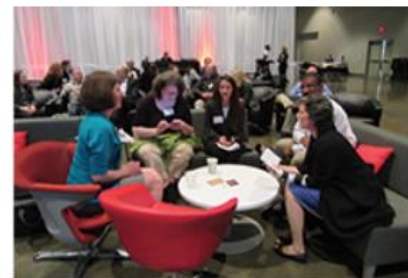
Visit www.greenchemistryandcommerce.org to register.





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Thank you for joining us!

For more information about the GC3:
www.greenchemistryandcommerce.org

