FICPI VIRTUAL 19TH OPEN FORUM 2020

Plenary 2 - Arguing subject matter eligibility at the PTAB and in oral proceedings at the EPO

November 5, 2020

Parties to AIA trials

- Petitioner—third party
  - Files challenge against a patent
  - Carries legal burdens throughout proceeding for both original grounds in petition as well as with amended claims
- Patent owner
  - No burden to demonstrate patentability of claims
  - Has several opportunities to represent their interests

Types of AIA trials

- *Inter partes* review (IPR)
- Post grant review (PGR)
- Covered business method review (CBM) (sunset on September 16, 2020)

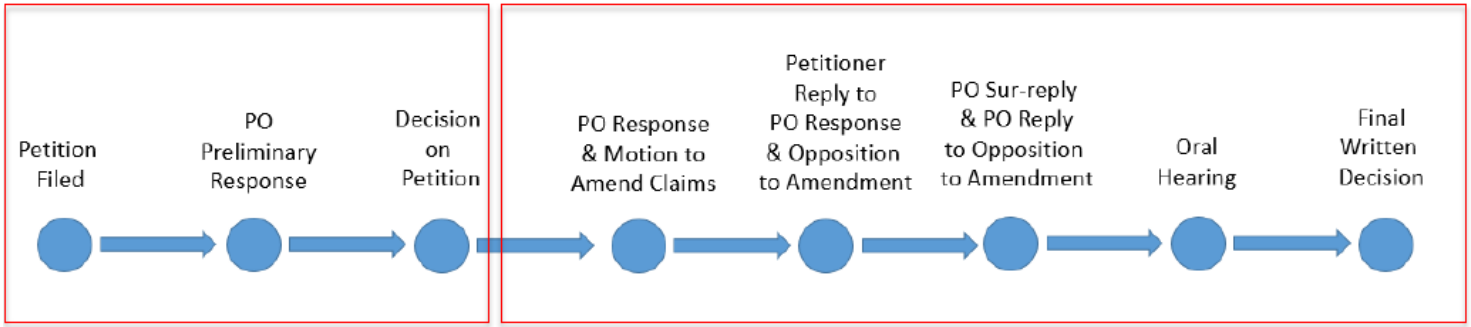
Scope of grounds-IPR

- **Petition:** only on §102 (novelty) and §103 (obviousness) grounds, and only on basis of prior art consisting of patents and printed publications
- **Amended Claims:** on any grounds for invalidity, including §101 (statutory subject matter) and §112 (written description and enablement)

Scope of grounds-PGR

- On any ground of unpatentability, including §101, §112, §102 (novelty) and §103 (obviousness)

Phases of a PTAB Trial



- First Phase: Institution
  - 6 months
- Second Phase: Trial
  - 12 months
  - 6 month good cause extension possible

Motion to amend-occurs in the Trial (second) Phase

- Patent owner may amend its claims during the trial phase to narrow the scope of the claims
  - For example, in some cases, the Board may cancel the original claims but conclude that amended claims can be obtained

Oral Argument

- Default-each party has one hour
  - Petitioner argues first
  - Patent Owner presents argument
  - Petitioner reply argument
  - Patent Owner sur-reply argument