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

Levi Strauss & Co.
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:

- Resinate Materials Group
- IMD Natural Solutions
- Checkerspot
- Amyris
- Mango Materials
- Kalion
- XF Technologies
- Green Biologics
- Acticell Technology Solutions
- Grow Bioplastics
- Remooble
- Renmatix
- Mimikai Insect Repellent
- Novomer Catalyzing Green Chemistry
- GF Biochemicals
- GC3
GC3 Startup Network Technology Showcases

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

Hosted by LEVI STRAUSS & CO.

http://greenchemistryandcommerce.org/startup-network/
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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Protecting Your Patents from Post-Grant Challenges

By Mark Feldstein and Mike Flibbert

February 27, 2018
### Post-Grant Proceedings

<table>
<thead>
<tr>
<th>Proceeding</th>
<th>Patents</th>
<th>Grounds</th>
<th>Timing</th>
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</thead>
<tbody>
<tr>
<td><strong>Inter Partes Review (IPR)</strong></td>
<td><strong>All US patents</strong></td>
<td>102 and 103 based on prior art patents and printed publications</td>
<td>For pre-AIA patents, anytime after grant or reissue</td>
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<td>For AIA patents, from later of: (i) 9 months after grant or reissue; or (ii) termination of any PGR</td>
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<tr>
<td><strong>Post Grant Review (PGR)</strong></td>
<td><strong>Only AIA patents</strong></td>
<td>101, 102, 103, 112, double patenting</td>
<td>From grant to 9 months after grant or reissue</td>
</tr>
<tr>
<td><strong>Covered Business Method (CBM)</strong></td>
<td><strong>All US patents concerning financial products or services (excludes technological inventions)</strong></td>
<td><strong>Must be sued or charged with infringement</strong></td>
<td><strong>Same as PGR (some 102 differences)</strong></td>
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<td><strong>Only available until 9/16/20</strong></td>
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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.
Registration is now open.
Thank you for joining us!

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