
IPRs and Post-Grant Proceedings

There are important distinctions between patent infringement actions in federal court and proceedings before the Patent Trial and Appeal Board (PTAB), including *inter partes* reviews (IPRs) and post-grant reviews (PGRs). Unlike most district court judges and jurors, administrative patent judges (APJs) on the PTAB have scientific or engineering backgrounds, which they draw on in considering the technical arguments advanced by counsel. The APJs' understanding of the underlying technology is a significant factor in determining the outcome of the proceeding.

Arguments that are persuasive to the PTAB are often different from what works in district court. While the parties' motives and intent often come into play in patent infringement actions in federal court, APJs at the PTAB typically find such facts irrelevant to the issue of patentability in IPRs and PGRs. Instead, APJs focus on a technical understanding of the patented invention, the scientific literature at the time of invention (*i.e.*, "prior art"), and how the patented invention is different from approaches taken by others in the prior art.

As a technology-first firm, Volpe Koenig's technical acumen sets it apart from others. Volpe Koenig's attorneys have backgrounds in an array of scientific and technology driven disciplines that give them significant technical depth in most fields. Volpe Koenig's attorneys are adept at understanding and explaining the details of complex technologies so as to lay the foundation for effective advocacy at the PTAB, which has led to a record of success.

Partnerships

IPRs often proceed in parallel with district court litigation, and while the two may have different areas of focus, the strategy advanced in the IPR must align with that of the overall district court case. Volpe Koenig's IPR attorneys are team-oriented and collaborate with litigation counsel at other firms as well as the client to ensure that issues like claim construction and validity/invalidity contentions are presented consistently across all venues. Volpe Koenig's IPR attorneys have substantial experience in district court litigation, which enables them to communicate effectively and efficiently with litigation counsel.

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Using a separate law firm to focus on IPRs also has distinct advantages. IPRs are typically commenced after a litigation has begun, at a time when the litigation team has formed impressions about a strategy going forward. Engaging separate counsel for the IPRs can provide new perspectives for approaching aspects of the case.

Blog Posts

A New *Cache* to the "Known Technique" Test For Obviousness Under 35 U.S.C. § 103
Imagine That IP Law Blog, 03.16.2023

Director Vidal Further Clarifies When a Discretionary Denial of an IPR is Appropriate Under Fintiv
Imagine That IP Law Blog, 03.09.2023

Discretionary Denials under Fintiv Rebooted by Vidal's Decision
Imagine That IP Law Blog, 03.03.2023

A Different State of Mind: Getting Technical With Post-Grant Proceedings Before the PTAB
Imagine That IP Law Blog, 01.24.2023