

PIPLA NEWS

The official newsletter of the Pittsburgh Intellectual Property Law Association

JANUARY LUNCH MEETING

Wednesday, January 16, 2013

Rivers Club
One Oxford Centre
301 Grant Street – Suite 411
Pittsburgh, PA 15219

Noon – Lunch Buffet
\$43 per person (Lunch)
\$63 per person (Lunch & CLE)

Speaker: The Honorable U.S. District Judge Arthur J. Schwab

The Honorable U.S. District Judge Arthur J. Schwab serves in the United States District Court for the Western District of Pennsylvania. The title of Judge Schwab's talk will be "*Since Patent Attorneys Are Smarter Than Juries and Judges, How Can They Ever Be Effective Advocates?*"

Judge Schwab is a designated patent judge under the Patent Pilot Program, which is a ten-year program designed by Congress to enhance expertise in patent cases among federal judges at the district court level. He has taught an Intellectual Property course for more than a decade, and regularly participates in programs organized by Intellectual Property Law Associations. Representative patent cases include R.M.F. Globel, Inc., et al. v. Cattan, et al., 04cv593; CNX Gas Corporation v. CDX Gas Company LLC, 05cv1574; The Sollami Company v. Kennametal, Inc., 06cv62; Noah Systems, Inc. v. Intuit Inc., 06cv933 and 10cv1420; and University of Pittsburgh v. Varian Medical Systems, Inc., 07cv0491 and 08cv1307.

Prior to becoming a district court judge in 2003, Judge Schwab worked at Reed Smith LLP from 1973 to 1990 and joined Buchanan Ingersoll Professional Corporation in the Fall of 1990 as Chair of Litigation (1990-1999) and then as Chief Counsel, Complex Litigation (2000-2002).

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PIPLA INVENTOR OF THE YEAR AWARD NOMINATION FORM DUE FEBRUARY 20, 2013

The Pittsburgh Intellectual Property Law Association announces that it is accepting nominations for its 2013 INVENTOR OF THE YEAR AWARD.

The INVENTOR OF THE YEAR AWARD is awarded annually to honor living inventors whose patented inventions have a significant impact on the economy, the social well being, and the advancement of technology. To be eligible, an inventor or team of inventors must reside or work within, or have some special connection to the Pittsburgh tri-state area.

Nominations may be made on the basis of one or more issued United States Patents, regardless of date of issue. It is not necessary that all of the inventors named on the patents on which a nomination is based be included in the nomination. Inventors who were nominated in prior years may again be nominated.

A plaque recognizing the Inventor of the Year will be presented to the winning nominee at the March 20, 2013 dinner meeting of the Association.

NOMINATIONS MUST BE RECEIVED NO LATER THAN February 20, 2013.

A copy of the nomination form is attached. Please send completed nomination forms to:

PIPLA Inventor Award Committee
c/o Christine R. Ethridge
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210 Sixth Avenue
Pittsburgh, PA 15222-2613
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ADMINISTRATIVE PATENT TRIALS BEFORE THE PTAB: INTER PARTES REVIEW (IPR)

*As of September 2012, a number of new post-grant review procedures are available for challenging patents before the Patent Trial and Appeal Board (PTAB). While by no means exhaustive, the summary below is intended to provide a primer on the new **inter partes review (IPR)** procedure, which has replaced *inter partes* reexamination.*

Inter Partes Review

Eligibility: All patents. By contrast, *inter partes* reexamination was available only for patents issued from original applications filed on or after November 29, 1999.

Restrictions: Petitioner must not have filed a civil action challenging the validity of the patent. Petition must be filed more than 9 months from issue date of patent. By contrast, Post Grant Review petitions must be filed less than 9 months from issue date.

Grounds: Only §§ 102 (anticipation) and 103 (obviousness) grounds based on patents or printed publications. By contrast, Covered Business Method (CBM) and Post Grant Review (PGR) allow for §§ 101, 102, 103, and 112 grounds (except best mode).

Standard for Institution of Trial: Petition must demonstrate a reasonable likelihood that Petitioner would prevail as to at least one of the claims challenged. By contrast, PGR and CBM use a heightened “more likely than not” standard. If the standard is met, the PTAB will institute the trial on a claim-by-claim, ground-by-ground basis.

Petition Fee: \$27,200 for 1-20 challenged claims; \$600 for each additional claim over 20. The petition fee for PGR/CBM proceedings is \$35,800.

Petition Requirements:

- Be accompanied by fee
- Identify all real parties in interest
- Identify all claims challenged and grounds on which the challenge to each claim is based
- Provide a claim construction and show how construed claim is unpatentable based on the grounds alleged
- Provide copies of evidence relied upon (exhibits)
- Certify that Petitioner is not stopped from proceeding

Patent Owner Responses: Patent Owner may file a preliminary response setting forth reasons why no IPR trial should be instituted within 3 months from petition docketing. If a trial is instituted, Patent Owner may file a response to the petition addressing any ground for unpatentability not already denied by the PTAB. With the response, Patent Owner must file, through affidavits or declarations, any additional factual evidence and expert opinions on which the Patent Owner relies in support of the response. The response must be filed within 3 months from institution of the trial.

Page Limits / Formatting: 60 pages for petition, preliminary response, and patent owner response. 14 point font (for proportional fonts, e.g., Times New Roman) required. Double spacing must be used except in claim charts, headings, tables of contents, tables of authorities, indices, signature blocks, and certificates of service. Block quotations may be 1.5 spaced.

Discovery: Testimony and document production is permitted. The discovery rules allow parties to agree to discovery between themselves. However, rules also provide for mandatory initial disclosures, and routine discovery. Routine discovery includes documents cited, cross examination for submitted testimony, and information inconsistent with positions advanced during the proceeding.

Length of Trial: An IPR trial will be completed within one year from institution, except that the time may be extended up to six months for good cause.

Petitioner Estoppel After Final Written Decision of PTAB: A petitioner in an IPR may not request or maintain a proceeding before the Office with respect to any claim on any ground raised or that reasonably could have been raised. A petitioner in an IPR may not assert in district court or the ITC that a claim is invalid on any ground petitioner raised or that reasonably could have been raised. Note that estoppel takes effect after a final written decision of the PTAB, and **not** after all appeal rights are exhausted, as was the case for *inter partes* reexaminations.

Miscellaneous: Lead counsel must be a registered practitioner before the USPTO, except that the PTAB may recognize counsel pro hac vice upon a showing of good cause, subject to the PTO's Code of Professional Responsibility and any other conditions as the PTAB may require.

RECENTLY FILED IP CASES IN THE WESTERN DISTRICT OF PENNSYLVANIA

Case	Gary W. Lundgren v. Ameristar Credit Solutions Inc.
Case Number:	3:12-cv-00263-KRG
Filed:	Monday, December 31, 2012
Presiding Judge:	Judge Kim R. Gibson
Cause	Trademark Infringement

Case	W. Korol Selley v. Authorhouse Inc.
Case Number:	2:12-cv-01894-TFM
Filed:	Friday, December 28, 2012
Presiding Judge:	Judge Terrence F. McVerry
Cause	Copyright Infringement

Case	Cranberry Motors LLC v. Diehl Automotive Group Inc. et al
Case Number:	2:12-cv-01682-NBF
Filed:	Friday, November 16, 2012
Presiding Judge:	Judge Nora Barry Fischer
Cause	Trademark Infringement

Case	Maxim Integrated Products Inc. v. JPMorgan Chase & Co. et al
Case Number:	2:12-cv-01641-NBF
Filed:	Thursday, November 08, 2012
Presiding Judge:	Judge Nora Barry Fischer
Cause	Patent Infringement

Case	Maxim Integrated Products Inc. v. Citigroup Inc. et al
Case Number:	2:12-cv-01628-NBF
Filed:	Wednesday, November 07, 2012
Presiding Judge:	Judge Nora Barry Fischer
Cause	Patent Infringement

REPORT ON DEVELOPMENTS AT THE EPO AND WITHIN THE EUROPEAN PATENT SYSTEM

A Report from the President of the European Patent Office (EPO) will be available at the January lunch meeting and via the PIPLA website. The report aims to provide readers with a survey of recent developments at the EPO and in Europe.

The report is provided by William H. Logsdon, US Bar/EPO Liaison Council Representative of PIPLA.

FROM THE NEWSLETTER COMMITTEE

We hope you've enjoyed this issue of the 2011/2012 PIPLA News, an informative and hopefully entertaining look at the goings on in IP law. We invite our entire readership to contribute to this endeavor with articles, announcements, and job postings of your own. If you have something you would like included in PIPLA News or have questions about how you can contribute, please contact Matt Johnson at 412-394-9524 or at mwjohnson@jonesday.com.

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