

# IPX vs. IPR

## A Cheat Sheet

Consider requesting Inter Partes Reexamination (IPX) before it is displaced by Inter Partes Review (IPR) on September 16, 2012.

|                  | <i>Inter Partes Reexamination</i>   | <i>Inter Partes Review</i>   |
|------------------|---|--|
| Eligible Patents | <ul style="list-style-type: none"><li>Patents having an original filing date on or after 29 Nov 1999</li><li>This includes first-filed applications, CONs, DIVs, CIPs, national stage filings &amp; CPAs (not RCEs)</li></ul> | Any patent, including those not eligible for IPX   |
| When To File     | Until 15 Sept 2012  | <ul style="list-style-type: none"><li>Starting on 16 Sept 2012, but:</li><li>After 9 months following issuance or 9 months following reissue</li><li>After conclusion of any PGR</li><li>Prior to the PTO reaching any annual limit in each of the 1st four years</li></ul>  |
| Who May File     | Anyone who is not estopped based on prior reexam or litigation  | Anyone except parties (or privies) who: <ul style="list-style-type: none"><li>Are estopped based on prior reexam or litigation,</li><li>Had filed a DJ for invalidity, or</li><li>Had been served with a complaint for patent infringement &gt; 1 yr before.</li><li>E.g., all parties served before 9/16/11 are time-barred</li></ul> |
| Bases For Filing | Reasonable likelihood of prevailing in showing unpatentability based on patents or printed publications with respect to at least one claim  | Reasonable likelihood of prevailing in showing anticipation or obviousness based on patents or printed publications with respect to at least one claim   |
| Cost             | <ul style="list-style-type: none"><li>\$8800 + atty's fees &amp; expenses</li><li>No page limits on the request</li></ul>   | <ul style="list-style-type: none"><li>PTO fees + atty's fees &amp; expenses (e.g., deposition costs)</li><li>PTO fees:<ul style="list-style-type: none"><li>1 to 20 claims—\$27,200</li><li>\$600 per additional claim</li></ul></li><li>60 page limit for petition</li></ul>  |
| Tribunal         | An examinational proceeding conducted by a panel of three CRU examiners; then appeal to the Board   | <ul style="list-style-type: none"><li>An adjudicative proceeding conducted by a panel of three APJs of the Board</li><li>Highest authority in the PTO</li><li>May better appreciate legal arguments</li></ul>  |
| Overall Timing   | ~ 36 months (through Board appeal)  | ~18 months (max. 12 months from institution --> final written decision, absent good cause or joinder)  |

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### Inter Partes Reexamination

### Inter Partes Review

|                   |   |  |
|-------------------|---|--|
| Procedure         | <ol style="list-style-type: none"> <li>1. Request</li> <li>2. Decision &amp; Office action</li> <li>3. PO reply</li> <li>4. 3PR comments</li> <li>5. Action Closing Prosecution</li> <li>6. PO reply</li> <li>7. 3PR comments</li> <li>8. Right of Appeal Notice (then on to Board appeal)</li> </ol> | <ol style="list-style-type: none"> <li>1. Petition</li> <li>2. PO prelim response (no decs or amendments)</li> <li>3. Decision</li> <li>4. Scheduling order</li> <li>5. List of intended motions</li> <li>6. Initial conference call</li> <li>7. PO discovery</li> <li>8. PO response and motion to amend</li> <li>9. Petitioner discovery</li> <li>10. Petitioner reply and opposition to motion to amend</li> <li>11. PO discovery</li> <li>12. PO reply to opposition to motion to amend</li> <li>13. Petitioner's observations on cross</li> <li>14. Oral hearing</li> <li>15. Final written decision</li> </ol> |
| Standards         | <ul style="list-style-type: none"> <li>• Preponderance of the evidence</li> <li>• Broadest reasonable claim construction</li> </ul>   | <ul style="list-style-type: none"> <li>• Preponderance of the evidence</li> <li>• Broadest reasonable claim construction</li> </ul>  |
| Evidence          | FRE do not apply; FRCP do not apply   | <ul style="list-style-type: none"> <li>• FRE do apply; FRCP do not apply</li> <li>• Can move to exclude evidence</li> </ul>  |
| Discovery         | NONE  | <ul style="list-style-type: none"> <li>• Depositions of declarants</li> <li>• Initial disclosures</li> <li>• Production of cited exhibits</li> <li>• Production of inconsistent info</li> <li>• May move for additional discovery 'in the interests of justice'</li> </ul>   |
| Protective Order  | Not available   | <ul style="list-style-type: none"> <li>• Yes, file a motion to seal and include protective order</li> <li>• Default protective order applies unless parties agree otherwise</li> </ul>   |
| Hearing           | None at CRU (interviews not permitted); Board hearing on appeal   | <ul style="list-style-type: none"> <li>• Oral hearing with 3 APJs</li> <li>• Very short</li> <li>• No live witnesses</li> </ul>  |
| Appeal & Estoppel | <ul style="list-style-type: none"> <li>• Appeal to the Board then Federal Circuit</li> <li>• Estoppel arises after all appeals are final</li> </ul>   | <ul style="list-style-type: none"> <li>• Appeal to the Federal Circuit</li> <li>• Estoppel arises upon a final written decision of the Board</li> </ul>  |
| Settlement        | <ul style="list-style-type: none"> <li>• 3PR may drop out --&gt; Can petition for interview</li> <li>• Proceeding usually does not end if 3PR drops out (unless certain stringent requirements are met)</li> </ul>  | <ul style="list-style-type: none"> <li>• May settle without creating estoppel</li> <li>• Settlement will terminate the proceeding unless it has already been decided on the merits</li> </ul>  |

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