



POST-GRANT AND INTER PARTES REVIEW

Brand Protection

Post-grant proceedings are mechanisms that serve to challenge or strengthen the validity of an issued U.S. patent. The passage of the Leahy-Smith America Invents Act (AIA) of 2011 brought sweeping changes to the landscape of post-grant proceedings before the U.S. Patent & Trademark Office (USPTO). Among other modifications, the AIA provides for new methods in the form of inter partes review (IPR), post-grant review, and covered business method patent review, which are held before the Patent Trial and Appeal Board (PTAB). These proceedings involve aspects of USPTO prosecution practice coupled with those more typically found in litigation, such as discovery, motions practice and oral argument.

In the hands of the experienced counsel at Barnes & Thornburg, these new mechanisms can provide more cost-effective means to invalidate patents, limit issues for patent litigation and promote licensing or other negotiated settlements. We are well-versed in developing cost-effective and uniquely tailored legal teams comprised of seasoned patent litigators, patent prosecutors and post-grant practitioners for representations in administrative proceedings before the USPTO.

You can expect to work with a team of experienced patent practitioners with relevant technical knowledge and those with experience in pre- and post-AIA post-grant proceedings and oral argument at the USPTO, as well as patent litigators with experience before the USPTO and the federal courts. Our teams are well-positioned to provide effective counsel at each stage of an AIA post-grant proceeding, from preliminary diligence in consideration of bringing or defending an AIA proceeding through a USPTO hearing, and, if necessary, through an appeal to the U.S. Court of Appeals for the Federal Circuit.

Our petitioner and patent-owner clients turn to us for our knowledge of the

Why Barnes & Thornburg?

Finding new ways to help clients identify solutions and new business opportunities, across industries, is at our core. We are, at times, more than lawyers, we are advisers bringing new ideas to light. We understand what keeps you up at night and work collaboratively to find practical and creative solutions, at the heart of business.

RELATED PRACTICES

Intellectual Property

distinctions between courtroom proceedings, USPTO practice, and the USPTO trial and appeals process, which we apply in ways that best serve the needs of each particular client.

Our breadth of experience allows us to develop pre- and post-grant strategies to achieve our clients' objectives, including protecting their intellectual property to maintain market advantages and licensing revenue; staying co-pending litigation; improving claim construction or non-infringement positions; reducing or enhancing damages; and leveraging settlement and dispute resolution positions.