

**STRATEGIC PATENT PORTFOLIO  
DEVELOPMENT –  
CLIENT PERSPECTIVES AND THE  
EFFECT OF AIA**

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# Patent Portfolio – Client issues

- In-house Client Concerns
  - Budgeting
    - Make v. Buy
    - Outside counsel selection and management
      - Contract?
      - Internal review
      - Delegation/work assignment process
  - Technology Differentiation
    - Affects filing strategy – timing and budget
    - Competitive analysis – defensive filing

# Patent Portfolio – Client issues, cont'

- Defensive litigation portfolio growth acquisition – over time; controversial
- Large portfolio acquisition (Nortel, Motorola Mobility, etc.) – highly strategic
- Merger and Acquisition – due diligence critical; separately devoted staff?

# Portfolio Mgmt – AIA Issues

- America Invents Act
  - Biggest patent reform legislation 100 years.
  - Rules packages out from USPTO
  - Rationale
    - Best practices/harmonization
      - FITF; Best mode reduction; *Hilmer Doctrine* eliminated
      - FITF leads to Derivation procedure at PTAB
    - Greater USTPO Administrative authority
      - Fee setting authority

# AIA con't

## – Quality improvement

- Post-grant processes
  - PGR
  - IPR
  - Covered BMP
  - Supplemental Examination
- 3<sup>rd</sup> party submission of prior art

# AIA Effect on Portfolio Mgmt

- **Post Grant Review**
  - Similar to European opposition
  - All grounds: 101, all102, 103, 112
  - Before PTAB 3 judge panel – “mini-trial”
  - Limited discovery
  - One year time line
  - Significant fees
  - Takes effect 9/16/12: Not retroactive
  - “Estoppel” issue
- **Who will use and when?**

# AIA Effects, con't

- **Inter partes review (IPR)**
  - Replaces inter partes reexamination
    - Standard: “reasonable likelihood petitioner will prevail on one claim” – higher than ip reexam
  - But:
    - Grounds still 102/103 patents and printed pubs.
    - PTAB
  - Begins 9/16/12, but retroactive application
- **Who will use and when?**

# AIA Effects, con't

- **Covered Business Methods**
  - Filed by 3<sup>rd</sup> Party
  - Also PTAB
  - Must be in litigation
  - Definition of “Financial service BM” and “technological” critical
  - Begins 9/16/12 for all patents having claims meeting definition
  - 8 year sunset



# AIA Effects, cont'

- **Supplemental Examination**
  - Inequitable conduct “cure”, usually prior to litigation
  - Filed by patent owner
  - All issues may be reviewed
  - SNQ standard – PTO has 3 mos. to decide
  - If standard met, then put into ex parte reexam
  - Fraud issue

**Thank you.**

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