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Post-Grant Review

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Post-Grant Must Be Independent of the PTO

- Post-Grant Review *must* be independent from PTO political control
- Ten year pendency for Federal Circuit reexamination
- PTO is unable to provide "special dispatch" for billion dollar cases
  - *MedImmune*
  - *BlackBerryGate*
  - *Arriad*

A New "CCPA" for Post-Grant Review

- Court of Federal Claims → Court of Claims and Patent Appeals (CCPA)
- Fed. Cl. "Special Masters" system includes "Special Patent Masters"
- A truly national court – Specialized Masters in San Jose, Boston… everywhere there is technology
- Independence from PTO political interference

Other Models

- The need for creativity –
- Hon. Darrell Issa's legislation to improve trial level courts
- German *Bundespatentgericht*, a patent "validity" court cleaved from the German Patent Office
- Tokyo District Court – generalist judges focusing on patent cases for a certain period in their career, supported by senior technical research staff comprised largely of former patent examiners
- British High Court Judges

One Window, Two Window Stalemate

- Complete deadlock today over the deadline for post-grant review –
- Everyone *but* Pharma/Bio: "Second Window" is essential
- Pharma/Bio: "Second Window" absolute death to the legislation
- ***Solution***
  - **A Green, Yellow and Red Zone Solution** including pharma/bio carveout

Green/Yellow/Red Three Window System for Post Grant Review

(1) "Green Window" Post-Grant Review

(2) "Yellow Window" Controversy Triggered Zone

(2*bis*) "Early Yellow" Pharma/Bio Safety Zone

(3) "Red Zone" Quiet Title Proscription

(1) "Green Window" Post-Grant Review:

- Single, consolidated post-grant review open to all parties
- No second or serial proceeding
- Six month deadline for applications published one year before grant

(1) "Green Window" Post-Grant Review:

- **(1) "Green Window" Post-Grant Review**:
  - (a) Any person may petition after patent grant within the later of (i) six months from grant or (ii) one year from publication of the application, and within six months from filing present detailed reasons for the post-grant review.

(1) "Green Window" Post-Grant Review:

- (b) The Office shall publish notification of any post-grant filing in the *Official Gazette;* such publication start open a six month window for any person to join the post-grant proceeding.
- (c) Only one post-grant proceeding under this section shall be permitted in accordance with the foregoing subsections.

(2) "Yellow Window" Controversy-Triggered Zone

- Single, consolidated post-grant review triggered by justiciable controversy
- No second or serial proceeding
- No late-stage litigation filing

(2) "Yellow Window" Controversy-Triggered Zone

- **(2) "Yellow Window" Controversy-Triggered Zone**:
  - (a) Notwithstanding the "green window" limitations on post-grant review, any party having a justiciable controversy and otherwise entitled to declaratory judgment relief against a patentee shall have a right to seek post-grant review.
  - (b) Any party seeking "yellow window" post-grant review shall certify with particulars the nature of the justiciable controversy and shall allege that the justiciable controversy became known only within the past six months.

(2) "Yellow Window" Controversy-Triggered Zone

- (c) The Office shall publish notification of such "yellow window" post-grant filing in the *Official Gazette* that shall open a three month window for any person similarly asserting a justiciable controversy to join the proceedings.
- (d) No further "yellow window" post-grant review may be sought by any party after a first "yellow window" filing other than under the foregoing subsection (d).

(2) "Yellow Window" Controversy-Triggered Zone

- (e) In the event of patent litigation for or against a particular patent, the existence of such litigation shall be promptly notified by the patentee to the Office which shall then publish a notification in the *Official Gazette* that shall then set a six month deadline for filing a "yellow window" post-grant review proceeding.

(2*bis*) "Early Yellow" Pharma/Bio Safety Zone

- Pharma/bio patentees could publish notification very early
- Optional procedure up to the patentee's judgment
- Six month period to commence post-grant review after publication
- "Quiet title" guaranteed after end of six month period

(2*bis*) "Early Yellow" Pharma/Bio Safety Zone

- **(2bis) "Early Yellow" Pharma/Bio Safety Zone**:
  - (a) Any party that is preparing for regulatory approval via NDA or biologics may at any time up through the filing of a request for regulatory approval submit to the Office a statement identifying the specific product and any patent covering that product which shall promptly be published by the Office in the *Official Gazette.*

(2*bis*) "Early Yellow" Pharma/Bio Safety Zone

- (b) Publication of an "early yellow" patent notification under this section in the *Official Gazette* shall open a six month window for any person to seek post-grant review otherwise following the regulation for a "green window" post-grant review, except that only parties seeking post-grant review within this six month window shall be joined in this single proceeding.
- (c) A patentee may elect not to follow the procedure of this section, in which case the patent shall be governed by the regular "yellow window" procedure.

(3) "Red Zone" Quiet Title Proscription

- Absolute bar to private litigants seeking post-"yellow" review
- Bar to right to review during patent litigation
- Very limited judicial discretion to transfer validity to post-grant review

(3) "Red Zone" Quiet Title Proscription

- **(3) "Red Zone" Quiet Title Proscription**:
  - (a) No person may file a post-grant review petition other than as provided for a "green window" or "yellow window" (including "early yellow") proceeding.
  - (b) Notwithstanding the proscription under the foregoing paragraph, a party may petition a Court having jurisdiction over a patent controversy to ask the Court to refer validity issues for a post-grant review.

(3) "Red Zone" Quiet Title Proscription

- (c) The Court shall grant a request under the foregoing paragraph only under extraordinary circumstances including certification by the Court that circumstances at the Court preclude an efficient treatment of validity issues at that Court. The Administrative Office shall establish guidelines for the implementation of this subsection.