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## PATENT OFFICE LITIGATION, SECOND EDITION

**By Sterne, Kessler, Goldstein & Fox, P.L.L.C.**

**Editors Robert Greene Sterne and Jason D. Eisenberg**

Five years after the implementation of the America Invents Act (AIA), this completely rewritten second edition of *Patent Office Litigation* provides a fresh and comprehensive exploration of all aspects of the contested patent proceedings before the United States Patent & Trademark Office, its interplay with the Federal court system and other governmental agencies, and its impact on the global patent landscape.

The first edition of *Patent Office Litigation* was created in response to the biggest changes in patent law in 60 years stemming from the 2012 America Invents Act. Five years later, this extensively updated edition of *Patent Office Litigation* covers all aspects of the contested patent proceedings before the United States Patent & Trademark Office, including Inter Partes Reviews (IPRs), Covered Business Method Reviews (CBMs), Post Grant Reviews (PGRs), Derivations, and Supplemental Examination.

Authored by a team of 70 prominent IP attorneys at Sterne, Kessler, Goldstein & Fox, who have handled nearly 600 of the nearly 6,000 proceedings before the Patent Trial and Appeal Board (PTAB), this treatise analyzes the proceedings, how the PTO has handled them, and the implications for patent owners and petitioners to the PTAB. It details options for building more robust patent portfolios in light of the proceedings. It explores the interface between PTAB proceedings and the US district courts, the US International Trade Commission, and the Court of Appeal for the Federal Circuit. Further, the treatise covers all Federal Circuit precedential cases involving PTAB decisions. Finally, it provides an overview of comparable proceedings in selected countries to provide an international perspective, as well as enforcement and licensing—taking into account Brexit and the new European patent court system.

*Patent Office Litigation* provides readers with a leading-edge treatment of all of the laws, regulations, and USPTO rules of practice and procedure; critical information and analysis for anyone operating in the ever-changing patent world.

### Features & Benefits:

- Extensive treatment of AIA contested proceedings and related case law
- Explanation of how the contested proceedings interact with all other aspects of patent procurement and enforcement in the United States
- Practical analysis and advice based upon the authors' extensive experience at the PTAB
- Tables of Laws and Rules, Table of Cases, and an Index; all of which assist readers in locating information quickly

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# TESTIMONIALS

*This practical treatise maps [the] suddenly shifting landscape as no other and is a “must” for legal practitioners.*

Circuit Judge Paul R. Michel (Ret.), Solo Litigation Consultant

*During my 15 years as a United States District Judge, there was no field that experienced more rapid changes in law and procedure than patent law. What was settled law in any given year could be the basis for reversible error in the next. ... Patent Office Litigation is a “must-read” to stay abreast of this area of practice as it changes and develops, both in the US and abroad.*

Honorable Faith S. Hochberg, United States District Judge (Ret.)

*In this Second Edition of Patent Office Litigation, Messrs. Sterne and Eisenberg provide an invaluable guide to the Patent Trial and Appeal Board (“PTAB”) proceedings as well as invention protection and enforcement options. Definitely a critical reference for portfolio managers and those who advise them.*

Phyllis T. Turner-Brim, VP Assistant General Counsel, Intellectual Property and Technology, Starbucks Coffee Company

*[F]or anyone entrusted with protecting valuable US IP portfolios, the Patent Office Litigation, 2nd Edition, is a welcomed and useful reference. The post-AIA world is not easily navigated, and it’s even harder to explain to stakeholders (inventors, investors, innovators, and decision-makers at the Board and C-level of organizations alike); but successful navigation and communication of these challenges are a must. This reference can set you on the right path.*

Julie Mar-Spinola, Chief Intellectual Property Officer, and VP, Legal Operations, Finjan Holdings, Inc.

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