

America Invents Act

Post Grant Review

What is a post grant review?

Post grant review ("PGR") enables a third party to challenge one or more claims in an issued patent at the United States Patent & Trademark Office ("Office") during the first nine months following issuance of a patent or following reissuance of broadened patent claims. The challenge can be based on prior art patents or printed publications, and, for example, non-statutory subject matter, statutory double patenting, lack of enablement, lack of written description, lack of utility, claim indefiniteness, lack of structure for means plus function claim limitations, prior public use, or prior sale or offer for sale. Alternatively, PGR may be granted on the basis of a novel or unsettled legal question that is important to other patents or patent applications.

Which patents are eligible?

PGR is available for a patent having an effective filing date under the new first-inventor-to-file ("FITF") regime, effective from March 16, 2013. A petition to institute a PGR can be filed by a third party who is not precluded from filing a petition. A petitioner is precluded from petitioning for PGR if the petitioner, its real party in interest ("RPI") or its privy (i) previously filed an IPR, post grant review, or covered business method review of a claim that resulted in a final written decision by the Board; (ii) or previously filed a civil action challenging the validity of a claim of the patent - a counterclaim challenging validity does not bar PGR.

How does one institute a PGR?

A petitioner must file a petition that, in addition to containing certain mandatory disclosures, contains information that, "if not rebutted," demonstrates that it is more likely than not that at least one of the claims challenged in the petition is unpatentable. A petition for PGR of a patent may be filed no later than nine months after (i) the date of the grant of a patent or (ii) the issuance date of a reissue patent. One may not request PGR for a claim in a reissue patent that is identical to or narrower than a claim in the original patent, unless the petition is filed not later than nine months after the date of the grant of the original patent. After the petition is filed, the patent owner may file a preliminary response, limited to setting forth the reasons why no PGR should be instituted by the Office. Both the petition and any optional preliminary response will be considered prior to a decision whether to institute a proceeding.

Burdens and standards

The default evidentiary standard is a preponderance of the evidence, which is more favorable to the petitioner than the "clear and convincing evidence" standard used in district court. In addition, the Office will apply the broadest reasonable construction standard to PGRs, and there will be no presumption of validity. A patent owner has the opportunity to move to amend claims in a limited manner in a PGR. Doing so, however, may create intervening rights for third parties.

Who decides the outcome and how?

The determination of whether to institute a PGR trial is made by the Patent Trial and Appeals Board ("PTAB") on a claim-by-claim basis and a ground-by-ground basis. Each case will be heard by a panel of three technically-trained, patent-savvy judges. Once the PTAB institutes a PGR, it will be adjudicated by a three-judge panel in a single-phase trial. Unlike inter partes reexaminations ("IPX"), in PGR there will be opportunities for limited discovery, a hearing, joinder, and settlement without creating an estoppel.

Also, instead of lasting an average of three years, like IPXs, PGRs must be completed within one year from institution of the trial (up to approximately 18 months from filing the petition), or 18 months on a showing of “good cause.”

Estoppel

When a petitioner, its RPI or its privy loses a PGR, it cannot subsequently assert or maintain unpatentability of any challenged claim in any subsequent proceeding at the Office, or challenge validity in a civil action in district court or before the International Trade Commission on any grounds it raised or reasonably could have raised in the PGR. The Office's final written decision will trigger the estoppels for an unsuccessful party. A patent owner is also estopped from taking action inconsistent with an adverse judgment in a PGR, including obtaining in any patent a claim to substantially the same invention as a finally refused or canceled claim or a claim that could have been filed in response to any properly-raised ground of unpatentability for a finally refused or canceled claim.

Can I appeal the Board's decision?

A party dissatisfied with a decision of the Board in a PGR may seek remedy at the Court of Appeals for the Federal Circuit.

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