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10 Things To Know About Post-Grant Review Under The America Invents Act of 2011

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The America Invents Act (H.R. 1249) promises to bring substantial changes to the U.S. patent system, including new mechanisms for challenging patents at the U.S. Patent and Trademark Office. One of the new mechanisms is a post-grant review proceeding (PGR), which will provide patent challengers expanded bases on which to attack patents. However, with this new opportunity to challenge patents comes trade-offs. Here are 10 things to know to help the challenger and patentee navigate post-grant review proceedings.

1. Petitions for PGR may first be filed one year after enactment of the America Invents Act. In PGR, patents may be challenged on any invalidity ground, e.g., prior art, lack of written description, or lack of enablement, but not failure to comply with the best mode requirement.
2. Once the petition is filed, a patentee may file a preliminary response before the USPTO considers the petition. PGR will be adjudicated by the Patent Trial and Appeal Board, and it will involve filing motions, e.g., as with current interference practice before the Board.
3. A challenger can file a petition for PGR within nine months following the issuance of a patent or issuance of a broadening reissue patent, but only if the challenger has not already initiated a civil action in district court challenging validity of the patent claims. A petitioner that has filed a counterclaim challenging patent validity in a civil action is not precluded from seeking PGR. If the petitioner files a civil action to challenge validity after petitioning for PGR, the civil action will be automatically stayed.
4. The standard for initiating PGR differs from the current standard for initiating reexamination. The PGR standard requires that it is more likely than not that at least one challenged claim is unpatentable, if the petition is not rebutted. Alternatively, PGR may be initiated if the petition raises a novel or unsettled legal question important to other patents or applications. Currently, reexamination requires a finding of a substantial new question of patentability.
5. A patentee may file a motion to cancel a challenged claim or propose substitute claims. And, the challenger will be given an opportunity to submit comments in the proceeding.
6. Parties to PGR may have the opportunity for limited discovery of evidence directly related to factual assertions advanced by the parties.
7. A challenger whose petition for PGR results in a final decision will be estopped at the USPTO, in district court, and at the ITC from later asserting that the claim is unpatentable or invalid on any ground the challenger raised or reasonably could have raised during PGR.



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8. PGR can be settled before the USPTO makes a final decision, in which case the estoppel provisions will not apply to the settling challenger(s).

9. PGR should provide the interested parties with a relatively quick decision from the Board – in one to one and a half years after the petition is granted.

10. A final decision by the Patent Trial and Appeal Board regarding PGR can be appealed to the Federal Circuit, but a decision by the Director not to institute PGR is final and not appealable.

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