

A Brief Summary and Comparison of Inter Partes Review and Post
Grant Review
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There are three major mechanisms now available for a petitioner to challenge others' granted patents: 1) inter partes review (IPR), 2) Post Grant Review (PGR), and 3) Covered Business Method (CBM) review. CBM review is only available if the petitioner is sued or charged with infringement of a non-technical financial product or services invention. PGRs and IPRs, however, are available regardless of the subject matter of the invention. This blog entry summarizes and compares IPRs and PGRs. The reader is cautioned that the filing of a civil complaint challenging the validity of a claim of the patent could affect the availability of an IPR or PGR for that patent. The remainder of this blog entry assumes no such civil action has been filed.

Availability

PGRs are only available if 1) the effective filing date of the patent to be challenged has an effective filing date of March 16, 2013 or later, and 2) the PGR petition is filed within 9 months after the patent issued. PGRs may request cancellation of any claim based on substantially any ground that could have been originally considered for patentability during examination (except for the best mode requirement).

IPRs are available for any patent regardless of the issuance date of the patent or effective filing date of the corresponding application. However, the petition must be later than 9 months after the patent issued. However, the grounds for canceling a claim in an IPR are only based on prior art and lack of novelty (102 rejections) or obviousness (103 rejections).

Legal Standard for Cancellation

The legal standard for cancelling a claim under a PGR is "more likely than not" OR "novel or unsettled legal question important to other patents/applications". The legal standard for cancelling a claim under an IPR is "reasonable likelihood that the petitioner will prevail." At present, the standard for cancellation of an IPR is generally considered to be more favorable towards cancellation.

Claim Scope

When evaluating the scope of a claim for purposes of cancellation in an IPR or PGR, the “broadest reasonably interpretation” of the claim is considered. This is much broader than the “plain and ordinary meaning” standard that is taken in civil courts. This, in addition to the reduced cost and rapid decision, makes IPRs and PGRs an attractive alternative to civil litigation when challenging a patent.

Estoppel

Under either an IPR or PGR, the petitioner is estopped in subsequent proceedings (including USPTO, district court, or ITC proceedings) from asserting any argument that they raised or reasonably could have raised in the IPR or PGR proceeding. Because the pleadings in a PGR and IPR are subject to length restrictions, great care must thus be placed on asserting the strongest arguments.