Post-Grant Review

Post-grant review (PGR) was introduced by the America Invents Act (AIA) on September 16, 2012 as a counterpart to the *inter partes* review procedure.

**Timing**

First, timing is crucial. In order to file a PGR, the challenged claims of the patent must have an effective filing date of March 16, 2013 (pursuant to the “first inventor to file” rules) or later.

Additionally, a PGR can only be used to challenge a recently issued patent during a small window of time. A PGR petition must be filed within nine months after a patent’s issuance (or reissuance), otherwise IPR becomes the proper challenge vehicle. In addition, like IPR, a PGR petition must be filed before the petitioner seeks a declaratory judgment challenging the validity of the claims in federal court. In the below diagram of the timing interplay between available post-grant options, PGRs can only be filed within a short and discrete time frame.

**AIA Post Issuance Timeline**

<table>
<thead>
<tr>
<th>Application Filed</th>
<th>Patent Issues</th>
<th>9/30/2014</th>
</tr>
</thead>
<tbody>
<tr>
<td>3/16/2013</td>
<td>1/30/2014</td>
<td></td>
</tr>
</tbody>
</table>

11 months 9 months 12-18 months

Post Grant Review Inter Partes Review & CBM Ex Parte Reexamination, Reissue, Supplemental Examination

Second, post-grant review enjoys more available statutory grounds for challenges, in addition to a broader scope of applicable prior art. As opposed to IPR where the grounds for a challenge are limited to anticipation and obviousness, post-grant review can be sought based on any grounds that can be used to challenge the validity of a patent claim. Such grounds include anticipation (§ 102), obviousness (§ 103), patent eligibility (§ 101) and lack of compliance with written description, enablement or indefiniteness (with the exception of best mode) (§ 112). In addition, PGR prior art is not limited to patents and printed publications. Indeed, post-grant review can be sought by alleging unpatentability based on evidence of public use, on-sale activity or other public disclosures.

**Limited Discovery and Estoppel**

Third, discovery is broader than allowed under *inter partes* review, and it is limited to evidence directly related to facts asserted by either party.

Finally, estoppel can be a significant barrier to success using post-grant review because of its broad and potentially severe limitations. Estoppel can be applied to any issue previously raised or that reasonably could have been raised in proceedings before the USPTO, federal district courts or the International Trade Commission (ITC).
Post-Grant Review Timeline

Like IPRs, PGRs also follow the same trial-like proceedings conducted in front of a panel of administrative judges at the USPTO. As shown below, the PGR process is broken down into the following three phases, including petition, discovery and hearing.

Petition

Post-grant review is requested by filing a petition at the USPTO. A petition must meet certain requirements. These include all of the following:

1. Identifying the real parties in interest.
2. Identifying the claims being challenged along with explanations of grounds of unpatentability for those claims.
3. Providing a detailed explanation of the relevance of the evidence.
4. Paying a filing fee.

The petition may also include technical declarations with evidence and opinions supporting the petitioner’s arguments. Importantly, this petition must be filed within nine months of the patent’s issuance.

Once a petition is filed, the patent owner has three months to submit a preliminary response. This response is optional, and the patent owner must weigh the positive and negative implications of this early filing option. At the very least, the preliminary response provides the patent owner with a chance to persuade the PTAB not to institute the PGR. Importantly, the patent owner is not allowed to submit evidence or rebuttal declarations directed to the validity challenges at this stage.

Within six months from filing, the PTAB reviews the petition and patent owner’s preliminary response (if any) and institutes a trial if it determines that there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition. In its institution decision, the PTAB may narrow issues, provide initial claim constructions and provide details regarding the grounds of unpatentability that will be at issue in the proceeding.

Discovery and Hearing Phases

Upon institution, the PTAB issues a scheduling order that concludes the proceeding within 12 months. Pursuant to the scheduling order, a patent owner is granted approximately three months to take discovery of the petitioner’s supporting evidence and to file a formal response or motion to amend. The scope of document discovery is still evolving. However, depositions of declarants and, at times, other witnesses is allowed.

The petitioner is then granted a three-month period to perform discovery on the patent owner’s supporting evidence and to file a reply brief or present arguments needed to counter a proposed amendment. A short period for motions may be provided before the oral hearing. After the oral hearing, the PTAB issues a final written decision regarding the patentability of the challenged claims. Parties involved in corresponding litigation may settle during the proceedings unless the PTAB has already decided the dispute on the merits. Both the patent owner and petitioner may appeal the PTAB’s final decision to the U.S. Court of Appeals for the Federal Circuit.

Below is a typical timeline for PGR proceedings:
Perkins Coie Recognized as National Patent and Life Sciences Leader by Managing IP

Press Releases

IAM Patent 1000 Recognizes 37 Perkins Coie Attorneys as Top Practitioners and Names Perkins Coie a Patent Leader in US and China

Press Releases

Perkins Coie is pleased to announce that the firm and 37 of its intellectual property attorneys were recognized by Intellectual Asset Management (IAM) in the 2020 IAM Patent 1000 list, which recognizes the world’s leading patent professionals who are the best-in-class in patent prosecution, licensing, and litigation.

Partner Nate Kelley Quoted in Bloomberg Law - Patent Office to Hold Remote Meetings ‘Until Further Notice’

General News

Bloomberg Law

Nate Kelley was quoted in the Bloomberg Law article, “Patent Office to Hold Remote Meetings ‘Until Further Notice,’” regarding the U.S. Patent and Trademark Office's decision to conduct all in-person meetings remotely.

Perkins Coie Recognized in Law360 Article - These Firms Racked Up The Most Patent Work Last Decade

General News

Law360

Perkins Coie was recognized by Law360 as one of the most-hired law firms in the country for patent litigation defense in the past decade and for PTAB litigation since the inception of the Patent Trial and Appeal Board.

Gene Lee Quoted in Managing Intellectual Property - PTAB Petition Fall Tied to Broad Litigation Trends

General News

Managing Intellectual Property

Gene Lee was quoted in “PTAB Petition Fall Tied to Broad Litigation Trends,” an article in Managing Intellectual Property, regarding the decrease in petitions to the U.S. Patent Trial and Appeal Board.

Law360 Names Perkins Coie an IP Group of the Year

Press Releases

Perkins Coie is pleased to announce that its Intellectual Property practice has been recognized as a 2019 Practice Group of the Year by Law360. In its annual assessment of leading law firm practice groups, Law360 recognizes the firms that won significant litigation victories and managed large deals.
**Perkins Coie Named an Intellectual Property Group of the Year by Law360**

General News

Law360

Perkins Coie has earned a spot among Law360’s 2019 Intellectual Property Group of the Year.

01.01.2020

**Nate Kelley Quoted in Law360 - Patent Cases To Watch In 2020**

General News

Law360

Partner Nate Kelley was quoted in the Law360 article, “Patent Cases To Watch In 2020,” regarding the U.S. Supreme Court possible decision to address the contentious issue of patent eligibility, and the justices guidelines on appeals of inter partes review decisions.

**PUBLICATIONS**

2020

**The Supreme Court’s SAS Decision: Has All-or-Nothing Institution Created a Wave of Change?**

Attorney Publications

Did the SAS Institute Inc. v. Iancu ruling change the PTAB’s approach to institution of IPRs? Our original research examines the aftereffect of the Court's decision.

2020

**Proving Up Publications as Prior Art in IPR Proceedings After Hulu**

Attorney Publications

Our follow-up prior art article considers the PTAB’s precedential opinion in Hulu and its implications for practitioners.

2020

**Challenges in Proving Up Publications as Prior Art**

Attorney Publications

Proving up prior art when working with publications has been complicated and unpredictable. In this two-part series, we look at varying opinions from Patent Trial and Appeal Board panels and issues triggered by Hulu, LLC v. Sound View Innovations, LLC.

2020

**Fewer Bites at the IPR Apple? Impact of Recent Decisions and Guidance on Multiple Petitions**

Attorney Publications

When multiple inter partes review petitions are filed against the same patent, what result can you expect? We analyze recent developments on serial and parallel IPR petitions and offer practical tips.

01.09.2020


Articles

Law360

This article provides an empirical review of the U.S. Court of Appeals for the Federal Circuit’s decisions in patent cases during calendar year 2019.

**PRESENTATIONS**

09.24.2020 - 09.25.2020

**2020 PTAB Bar Association Annual Conference**

Sponsorships

Washington, D.C.

07.2020 - 08.2020

**18th Annual Rocky Mountain Intellectual Property & Technology Institute Virtual Conference**

Speaking Engagements

Sponsorships

**CONTACTS**
RELATED SERVICES

PRACTICES
- Inter Partes Review (IPR)
- Covered Business Method Review (CBM)
- Post-Grant Proceedings
- Reexaminations & Reissues

NEWS & INSIGHTS

IPR Evolution
A one-stop collection of insights and research on noteworthy decisions and practical effects for parties and attorneys involved with inter partes reviews.

IPR >> IRL
How do inter partes reviews work in real life? Our brief guide breaks down the IPR process and suggests basic strategies for challengers and patent owners.
### Post-Grant Resources

Explore in-depth analysis, original research, and guides on the developing procedures for challenging the validity of a patent granted by the U.S. Patent and Trademark Office.

| Procedure | Post Grant Damages | Issue Points Present | Claim Damages | IPR Validity | Patent Assurances | License
<table>
<thead>
<tr>
<th></th>
<th></th>
<th></th>
<th></th>
<th></th>
<th></th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td>Inter Partes</td>
<td>0</td>
<td>0</td>
<td>0</td>
<td>0</td>
<td>0</td>
<td>0</td>
</tr>
<tr>
<td>Patent Infringement</td>
<td>0</td>
<td>0</td>
<td>0</td>
<td>0</td>
<td>0</td>
<td>0</td>
</tr>
<tr>
<td>Trial</td>
<td>0</td>
<td>0</td>
<td>0</td>
<td>0</td>
<td>0</td>
<td>0</td>
</tr>
<tr>
<td>District Court</td>
<td>0</td>
<td>0</td>
<td>0</td>
<td>0</td>
<td>0</td>
<td>0</td>
</tr>
</tbody>
</table>

**POST ISSUANCE PROCEDURE MATRIX**

Perkins Coie’s post-issuance procedure matrix is a comprehensive overview of key factors to consider when evaluating which post-grant procedure is the best fit for your matter.

READ MORE

© 2020 Perkins Coie LLP