

## Intellectual Property News

### Post-Grant Review and Inter Partes Review – New Tools from the America Invents Act

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By Elizebeth M. Maag

The new patent law creates two new post grant review provisions to provide administrative alternatives for parties to challenge the validity of issued patents more quickly and more cost effectively than in traditional litigation. These provisions are identified as post-grant review and inter partes review. Both are effective September 16, 2012, and will apply to any patents issued before, on, or after September 16, 2012.

There are many similarities between the two post grant review provisions. Post-grant review and inter partes review proceedings are conducted by the US Patent Office and can be initiated by petition by any non-owner of the patent. Both proceedings should be concluded within one year from filing the petition ("final determination"); however, the USPTO can extend that time up to 6 months for good cause. Unlike litigation, post-grant review and inter partes review do not start with a presumption of validity. Both post-grant review and inter partes review may be terminated by the parties through settlement prior to the final determination. If an issue related to patentability is not raised during the post-grant review or inter partes review, the parties may not subsequently assert that issue on appeal or in subsequent litigation.

The requirements to file a petition for either post-grant review or inter partes review are very similar and include paying a fee and submitting a petition, identifying the real parties in interest, identifying challenged claims, providing grounds on which the challenged claims are based, providing evidence that supports the grounds for the challenge, and providing a copy of the petition request to the patent owner.

The differences between the two procedures include the deadline for filing the petition and submissions with regard to patentability. Post-grant review must be initiated within nine (9) months of the date of issue of the patent and permits any patentability issue (e.g. non-patentable subject matter (§101), novelty (§102), non-obviousness (§103), written description and enablement (§112)) to be raised, except best mode. As such, evidence submitted in a post-grant review proceeding may include any evidence. In contrast, inter partes review cannot be initiated until the later of nine (9) months after patent issuance or after post-grant review is complete. Inter partes review is limited to review on the grounds of novelty or non-obviousness and based on submissions of patents or printed publications.

The procedures for both post grant review provisions do not permit a challenge to the patent if the petitioner has already filed a civil law suit challenging the patent's validity and mandates a stay if the petitioner subsequently files a civil lawsuit. Also, the petitioner only has one opportunity to challenge the patent before the US Patent Office.

Both of these new post grant provisions will provide additional non-litigation tools to parties accused of infringement or who question the validity of issued patents.

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