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Post-Grant Review

Summary

In the United States, for patents issued from applications having an effective filing date on or after March 16, 2013, a post-grant review (PGR) process will be available wherein a third party may petition, within 9 months of the date the patent is granted, for the USPTO to review the patentability of one or more claims of a patent. PGR provides a third party a lower-cost and accelerated-schedule alternative, relative to traditional patent litigation, for challenging a patent on the basis of, for example, lack of utility, lack of novelty, obviousness, lack of written description, and lack of enablement.

Additional Information

A PGR will proceed generally as follows: A Petitioner submits a Petition requesting PGR of a patent. In PGR, the Petitioner will have the burden of proving a proposition of unpatentability by a preponderance of the evidence. A Patent Owner may submit a Preliminary Response to argue that the Petition does not satisfy one or more requirements. The PTO will then decide whether to institute a PGR. If the PGR is instituted, the Patent Owner may submit a Patent Owner Response to provide substantive arguments in favor of patentability and/or a motion to amend one or more challenged claims. A scheduling order will be entered to provide deadlines for subsequent Petitioner replies, Patent Owner replies, timing of motions, and an optional oral hearing. A final written decision from the Board will generally be entered no more than 12 months from the date the PGR is instituted. At any time until the final written decision is entered, the parties may opt to settle and jointly request an end to the PGR.

Although the costs of PGR may be low, relative to patent litigation, the costs are not insignificant. For example, the fee filing a PGR Petition is \$35,800 for up to 20 claims, plus \$800 for each claim in excess of 20. Obviously, the costs preparing the documents for PGR can be significant and can vary widely for both Petitioner and Patent Owner, depending on the facts and circumstances.

Notably, the PGR includes several estoppel effects. For example, estoppel attaches to a Petitioner of a PGR that results in a final decision with respect to a claim on any ground that the

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Petitioner raised or reasonably could have been raised during that PGR. In addition, if a PGR results in a final decision, the Petitioner is estopped in certain civil actions and certain other proceedings before the United States International Trade Commission.

Because PGRs are available only as to patents issued from applications having an effective filing date on or after March 16, 2013, there is plenty of time to plan your strategic use of PGR. Please contact our office to discuss your circumstances and how the new rules regarding PGR affect you.

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