

Post Grant Proceedings

	Post-Grant Review (PGR)	Inter Partes Review (IPR)	Reissue Application	Supplemental Examination	Citation of Prior Art	Ex Parte Reexamination
Who Can Initiate?	Third Party only (except plaintiff in court action challenging validity of patent)	Third Party only (except plaintiff in court action challenging validity of patent)	Patent Owner only	Patent Owner only	Anybody	Anybody
Does the Patent Qualify?	Any AIA patent.	Any patent	Any patent	Yes, but covers “any information” and thus not limited to patents (e.g., incorrect arguments of a declaration; public sale before critical date; litigation papers; small entity status wrongly claimed; etc.)	Any patent	Any patent
Window for Filing	No later than 9 months after patent issuance or issuance of reissue application.	The later of: on or after 9 months after patent/reissue issuance; or termination of PGR. Also can’t be filed more than one year after real party in interest is sued for infringement.	Anytime before the patent expires, unless you want to broaden claims (then 2 years after issue)	Anytime before the patent expires	Anytime during enforceability of patent	Anytime during enforceability of patent (which can be 6 years past expiration)
Grounds for Filing	Any ground (except for failure to comply with the best mode requirement)	§§ 102 and 103 based on patents and publications	The patent, through error and [without any deceptive intent], is considered to be wholly or partly inoperative or invalid	Any “information” relevant to patentability exists.	Patents, publications, written statements of a patent owner if the statements were filed in a proceeding before a federal court or the USPTO	§§ 102 and 103 based on patents and publications
Threshold Standard	“more likely than not” that at least one of the claims challenged in the petition is unpatentable. Aka	“reasonable likelihood that the petitioner would prevail” with respect to at least one challenged claim	N/A	SNQ of Patentability		There’s a substantial new question (SNQ) of Patentability (what a reasonable examiner would find <u>important</u> in determining the

	preponderance of evidence.					patentability of the claims)
USPTO Branch Handling Proceeding	PTAB	PTAB	Original Examiner from handling application	Examiner		Different Examiner
Identification of Real Party in Interest Required?	Yes	Yes	N/A	N/A	No (can be anonymous)	No (can be anonymous)
Extent of Estoppel	After a final decision, the real party and interest and any privy thereto is estopped from challenging the patent in the USPTO, ITC or district court on any ground the RPI raised or could have been reasonably raised in the PGR.	After a final decision (by PTAB), the real party and interest and any privy thereto is estopped from challenging the patent in the USPTO, ITC or district court on any ground the RPI raised or could have been reasonably raised in the IPR.	N/A	Would prevent the patent from being held unenforceable (in a court proceeding) on the basis of conduct relating to information that had not been considered, was inadequately considered, or was incorrect, if submitted or corrected during Supplemental Examination		None
Effect of Concurrent proceeding	If court case for invalidity filed, PGR cannot be filed; if PGR filed, then later filed court proceeding automatically stayed	If court case for invalidity filed, IPR cannot be filed; if IPR filed, then later filed court proceeding automatically stayed	Stay of litigation depends on court/judge	Patent cannot be held unenforceable on basis of conduct relating to the “information” if the “information” was considered, reconsidered or corrected during supplemental examination		Likely no effect (as can be filed anonymously)
Appeal Forum	CAFC	CAFC	PTAB	PTAB		District Court or Court of Appeals for Federal Circuit (CAFC)

Possibility of settlement?	Yes	Yes	N/A	N/A		No
Extra info				Is a useful mechanism of affirming a patent, contrary to reissue (fixing). It is also more expensive and a faster process.	No fee is required, amazingly Service on patent owner is required	Automatic time extensions aren't available. Reexamination can't be cancelled or withdrawn after filing. New claims can be added, but not broader.

Summary

Post-grant review: no later than 9 months from issuance, any grounds except for best mode, preponderance of evidence (more likely than not).

Inter partes review: after PGR is over or 9 months after issuance, patents and publications for 102/103, reasonable likelihood. Third parties are barred if more than one year has passed since they were served with infringement.

- Third party only, settlement ok, PTAB, estoppel

Reissue app: owner wants to fix their app, their original examiner. To broaden claims must be filed for within two years of issuance.

Supplemental examination: SNQ. different examiner, any information relevant to patentability exists. More expensive and faster procedure.

- Owner, settlement N/A, until the patent expires.

Citation of prior art: anybody can send patents, publications, and patent owner statements filed in proceedings for no fee. Must serve patent owner.

Ex part reexamination: SNQ. no automatic time extensions, different examiner, 102/103 patents and publications.

- Anybody, no settlement, until the patent is no longer enforceable (6 years after expiration), anonymity allowed

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Combatting pending apps

Protest for pending app: pending applications, but only for those that haven't been published or allowed yet. Otherwise you can ask the app owner for the ability to do so after the fact, but who would reasonably consent to that? Lol

Third-Party Submission for pending app: can use patents or publications to combat a pending app. Can be submitted after 6 months from the date of publication, or the date of the first office action on the merits., or before the notice of allowance.

Derivation proceeding: show proof with particularity that a filed invention was copied from applicant, and establish the proof within one year of it being published