

Comparison of Post-Grant Proceedings

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The chart below highlights the differences between the various proceedings available for post-issuance review of patents.

| | Post Grant Review (PGR) | <i>Inter Partes</i> Review (IPR) | Covered Business Method (CBM) | Ex Parte Reexam | Suppl. Exam. | Reissue |
|--|--|--|--|--|--------------|---------|
| What type of patent qualifies for this proceeding? | <p>For patents having an effective filing date or claim to priority that is on or after March 16, 2013 (i.e., for patents filed under the first-inventor-to-file system).</p> <p>Petition must be filed no later than 9 months after the patent has been issued or reissued.</p> | <p>For patents filed under the first-inventor-to-file system: (i) 9 months after patent grant or reissue; or (ii) the date of termination of any post grant review of the patent.</p> <p>For patents filed under the first-to-invent system: available after grant or reissue.</p> | <p>For patents filed under the first-inventor-to-file system, but only after PGR is completed or no longer available. In addition, the patent must be related to a “financial product or service,” but excludes “technological innovations.”</p> <p>However, after September 16, 2020, the transitional program for CBMs will sunset and no longer be available for petitioners.</p> | For any patent, whether first-inventor-to file or first-to-invent. | | |

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|-----------------------------|---|--|--|---|---|---|
| Who can file? | Anyone other than the patent owner who has not previously filed a civil action challenging the validity of the patent. | Anyone other than the patent owner who has not previously filed a civil action challenging the validity of the patent or has not been served with a complaint more than 1 year prior to filing the Petition. | Anyone other than the patent owner who is sued or charged with infringement of the patent. | Anyone | Patent owner | |
| Who is the review unit? | PTAB | | | CRU | | |
| What is the legal standard? | More likely than not that at least one claim is <u>unpatentable</u> or novel or unsettled legal question important to patents and applications. | Reasonable likelihood of prevailing as to at least one challenged claim. | More likely than not that at least one claim is <u>unpatentable</u> . | Substantial new question of patentability; whether a reasonable examiner would consider the prior art important in determining patentability. | Substantial new question of patentability; whether a reasonable examiner would consider the information important in determining patentability. | An error which causes the patent to be "wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent." |

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|--------------------------------------|--|---|---|---|--|---|
| What are the grounds for invalidity? | § 101 § 102 § 103 § 112 (except best mode) | § 102 § 103 Prior art limited to patents or printed publications. | § 101 § 102 § 103 § 112 Prior art cannot fall under pre-AIA §102(e). | § 102 § 103 Prior art limited to patents or printed publications. | Any information relevant to patentability, in writing, and limited to 12 items of information. | Most common: claims too narrow or broad; disclosure contains inaccuracies; failed to or incorrectly claimed foreign priority; or failed to make or incorrectly made reference to prior <u>copending</u> applications. |
| Is discovery available? | Yes | | | No | | |
| Is there statutory estoppel? | Estoppel applies to any ground raised or reasonably could have <u>raised</u> in proceedings before the USPTO, district court, or the ITC. 35 U.S.C. § 315(e) (IPR); 35 U.S.C. §325(e) (PGR) | | In proceedings before the USPTO, estoppel applies to any ground raised or reasonably could have <u>raised</u> . In proceedings before the district court or the ITC, estoppel applies only to any ground actually raised. AIA § 18(a)(1)(D) | No statutory estoppel. | | |

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|---|---|---|--|---|--|---|
| How long does the proceeding take? | Statutorily required to complete proceeding within 1 year of institution. | | | Months or up to several years. | 3 months to receive decision on whether there is an <u>SNQ</u> . If determined that there is an <u>SNQ</u> , then proceeds as an Ex Parte Reexam. | Months or up to several years. |
| Where to appeal? | Federal Circuit | | | <u>PTAB</u> first, then Federal Circuit. | | |
| What are the statutory and regulatory authorities? | <u>35 U.S.C. §§ 321-329</u> <u>37 C.F.R. §§ 42.1-42.80 and 42.200-42.224</u> | <u>35 U.S.C. §§ 311-319</u> <u>37 C.F.R. §§ 42.1-42.80 and 42.100-42.123</u> | <u>AIA § 18</u> <u>37 C.F.R. §§ 42.300-42.304</u> | <u>35 U.S.C. §§ 301-307</u> <u>37 C.F.R. § 1.501-1.570</u> | <u>35 U.S.C. §§ 257</u> <u>37 C.F.R. § 1.601-1.625</u> If determined that there is an <u>SNQ</u> , then proceeds as an Ex Parte Reexam. | <u>35 U.S.C. § 251-252</u> <u>37 C.F.R. §§ 1.171-1.178</u> |
| Are there additional Office resources for guidance? | Office Trial Practice Guide, 77 Fed. Reg. at 48,759 Trial Practice Update , August 2018 Precedential and Informative Decisions (issues specific to AIA trial proceedings) | | | <u>MPEP §§ 2200, et seq.</u> | | <u>MPEP §§ 1400, et seq.</u> |