

Post-Grant Challenges

A Cheat Sheet

Inter Partes Reexamination

Ex Parte Reexamination

Inter Partes Review

Covered Business Method Review

Post Grant Review

WHO

Person who is not the owner	Anyone	Person who is not the owner	Person who is not the owner	Person who is not the owner
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WHAT

<ul style="list-style-type: none"> Patents and printed publications Obviousness double patenting available Standard: Reasonable likelihood of prevailing 	<ul style="list-style-type: none"> Patents and printed publications Obviousness double patenting available Standard: Substantial new question of patentability 	<ul style="list-style-type: none"> Patents and printed publications - ground that could be raised under 102 or 103 Standard: Reasonable likelihood of prevailing 	<ul style="list-style-type: none"> Any ground for invalidity that could be raised under §§2, 3 of §282(b) <ul style="list-style-type: none"> prior patents and publications; public use/sale; offers for sale; written description and enablement Standard: More likely than not challenged claim unpatentable OR raises novel or unsettled legal Q 	<ul style="list-style-type: none"> Any ground for invalidity that could be raised under §§2, 3 of §282(b) <ul style="list-style-type: none"> prior patents and publications; public use/sale; offers for sale; written description and enablement Standard: More likely than not challenged claim unpatentable OR raises novel or unsettled legal Q
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WHEN

Any time after patent issues	Any time after patent issues	Patent effective filing date before 3/16/13 - after the patent issues Patent effective filing date on/after 3/16/13 - after the later of: (1) nine months after grant or issuance of a reissue of a patent, or (2) if a post grant review ("PGR") is instituted, the date of termination of that PGR.	<ul style="list-style-type: none"> Non first to file patents: any time after the patent issues First to file patents: 9M after date of grant of patent or issuance of reissue 	< 9M after issuance or reissuance of patent
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LIMITATIONS

<ul style="list-style-type: none"> Only for patents filed after 11/29/1999 Sunset on 9/15/2012 	None	<ul style="list-style-type: none"> May not be instituted after petitioner or RPI has filed civil action challenging validity Must be filed within 1 year after service of complaint 	<ul style="list-style-type: none"> Claims must be directed to practice, administration, or management of financial service or product Does not include technological inventions Person or RPI/privy must have been sued for infringement or charged with infringement 	<ul style="list-style-type: none"> Only available for first to file patents (claims filed after 3/16/13) May not be instituted after petitioner or RPI has filed civil action challenging validity
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STRATEGIC CONSIDERATIONS

<ul style="list-style-type: none"> Handled by Central Reexamination Unit (CRU) Estoppels attach after final Decision (all appeals exhausted) 	<ul style="list-style-type: none"> Handled by CRU No estoppels No third party participation Patent owner can interview 	<ul style="list-style-type: none"> Handled by Patent Trial and Appeal Board (PTAB) Estoppels attach upon <u>final written decision of the Board</u> Estoppels apply to both District Court and ITC proceedings 	<ul style="list-style-type: none"> Handled by PTAB Estoppels attach upon <u>final written decision of the Board</u> Estoppels apply to both District Court and ITC proceedings Estoppels limited to what petitioner raised during proceeding 	<ul style="list-style-type: none"> Handled by PTAB Estoppels attach upon <u>final written decision of the Board</u> Estoppels apply to both District Court and ITC proceedings
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