

Patent – Post-Grant Proceedings

The U.S. Patent & Trademark Office (“USPTO”) has emerged as both an offensive and defensive tool in mitigating expensive and protracted district court litigation. A number of procedures exist at the USPTO and its adjudicative body, the Patent Trial and Appeal Board (“PTAB”), to challenge or refine issued patents, including *inter partes* review (“IPR”), covered business method review (“CBM”), post-grant review (“PGR”), *ex parte* reexamination, supplemental examination, and patent reissue.

Taking full advantage of these options can bolster any offensive or defensive patent strategy. Our IP practice group’s seasoned patent litigators and practitioners work with clients to develop innovative patent strategies that are business-focused and cost effective. Post-grant proceedings can be a tool for patent holders to improve the quality and strength of patent portfolios in advance of business transactions or litigation campaigns. For defendants, these proceedings have emerged as an effective alternative to costly and uncertain patent litigation.

Our team is well versed in patent examination and litigation before the USPTO, federal courts, and the International Trade Commission, providing the foundation and tools to foresee problems and formulate solutions. Team members hold undergraduate and graduate degrees in engineering, computer science, medicine, physical sciences, and life sciences. Moreover, our lawyers have patent experience in a broad range of technologies, from aerospace, telecom, and gaming to pharmaceuticals. This comprehensive technical expertise and strategic foresight enable our attorneys to be effective client advocates in all of the USPTO post-grant proceedings described below.

Patent owners and prospective challengers have a number of post-grant options, including the following:

***Inter Partes* Review (“IPR”)**

IPR is a proceeding conducted before the PTAB to review the patentability of patent claims based only on anticipation and obviousness grounds, and then only on the basis of prior art consisting of patents or printed publications.

Post-Grant Review (“PGR”)

PGR is a proceeding conducted at the PTAB to review the patentability of claims in a patent on broader grounds than an *inter partes* review, including failure to comply with written description, enablement, or patent eligibility requirements, and can also rely on evidence of public use, on-sale activity, or other public disclosures; however, PGR rules impose a limited filing window (must be filed within nine months of the issuance or reissuance of the patent).

Covered Business Method (“CBM”) Review

CBM review is a proceeding conducted at the PTAB to review the patentability of claims in a covered business method patent, which employs the standards and procedures of a post-grant review, but has notable differences (e.g., there has to be a formal allegation of infringement, and PGR cannot be available).

***Ex Parte* Reexamination**

Ex parte reexamination is a proceeding in which the requester (most often a third party) may re-examine an issued patent based on prior patents and printed publications, at any time during the enforceability of a patent. The requester initially bears the burden of showing that the submitted prior art establishes a substantial new question of patentability, after which the USPTO will commence the reexamination process. From that point on, the *ex parte* reexamination proceeding will, for the most part, involve only the patent owner and the USPTO.

Supplemental Examination

Supplemental examination is filed by a patent holder and asks the USPTO to “consider, reconsider, or correct information believed to be relevant to the patent,” which is not limited to patents or printed publications. The standard and procedure otherwise substantially mimics that of *ex parte* reexamination.

Patent Reissue

Reissue is available as a procedure to correct errors in an issued patent where the error renders the patent wholly or partially inoperable or invalid. Patent reissue can address errors and issues relating to utility, written description, or enablement, whereas patent reexamination only reaches issues of novelty and obviousness. Further, patent reissue may allow for broadening of claim scope for a limited time after issuance.