

Post-Grant Challenges

A Cheat Sheet

Inter Partes Reexamination

Ex Parte Reexamination

Inter Partes Review

Covered Business Method Review

Post Grant Review

WHO

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| 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

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| <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 <ul style="list-style-type: none"> 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 §112, 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 §112, 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

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| Any time after patent issues | Any time after patent issues | <ul style="list-style-type: none"> Later of: <ul style="list-style-type: none"> (i) > 9M after issuance or reissuance of the patent OR (ii) if PGR is initiated, date of termination of PGR For newly issued patents prior to FTF, will have a "9M dead zone" where no PTO <i>inter partes</i> challenges available | <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

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| <ul style="list-style-type: none"> Only for patents filed after 11/29/1999 Sunsets 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 if served on or before 9/15/11 file IPReex by 9/16/12 or lose access to PTO <i>inter partes</i> challenges | <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

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| <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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