

Articles & White Papers

AIA Post-Grant Review and Monitoring of Third-Party U.S. Patent Grants

September 25, 2014

- [Share Link](#)

With the America Invents Act of 2011 (AIA) came the new Post-Grant Review (PGR) procedure for challenging granted U.S. patents. PGR can be used to challenge the validity of a U.S. patent issued under the first-inventor-to-file provisions of the AIA. Since only those applications with an effective filing date on or after March 16, 2013 are subject to those provisions, recently granted U.S. patents are the first patents for which a PGR challenge is an available option. It is important to remember that PGR is a time-constrained option: a PGR petition must be filed no later than nine (9) months from the grant of the U.S. patent.

Due to the time constraints on PGR petitions, as a courtesy, Panitch Schwarze Belisario & Nadel offers a complimentary service for monitoring patent grants. In an effort to maximize the time available for considering whether to file a Request for Post-Grant Review, we can implement an alert system for U.S. patents granted to assignees of interest (e.g., competitors, partners, etc.). In addition to the complimentary monitoring, our firm can provide analysis and counsel regarding the viability of requesting PGR, and we can assist with the filing of a request.

PGR offers a challenging party an opportunity to seek cancellation of one or more claims in an issued U.S. patent. PGR provides certain advantages to the patent challenger because, unlike Inter Partes Review (IPR), the challenger can present subject matter (§101) and/or written description, indefiniteness, and enablement (§112) challenges in addition to novelty/anticipation (§102) and lack of inventive step/obviousness (§103) challenges. Accordingly, PGR can be a very valuable tool to address potentially problematic patents outside of normal litigation.

A request for PGR incurs a large USPTO filing fee and can be a time-intensive, adversarial procedure, but it is also likely to be less expensive than district court litigation. A petition requesting PGR requires: (1) the appropriate fee; (2) identification of real parties in interest; and (3) identification of each claim challenged, the grounds of challenge, and evidence supporting the challenge. PGR will only be instituted if it is more likely than not that at least one of the claims challenged in the petition is unpatentable. Ultimately, the USPTO will decide whether to institute the review within six months of receiving the Petition requesting PGR, and must normally complete the review within one year of institution.

Please [contact us](#) with any questions regarding our patent monitoring service, Post-Grant Review, or any other intellectual property issue for which we can be of assistance to you.