

# PANITCH Intellectual Property Law SCHWARZE

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## Post Grant Review

In today's intellectual property landscape, the granting of a patent is not the final say on patentability. Patents can be, and often are, challenged after they are awarded, typically as a parallel proceeding to a patent infringement litigation. Two post-grant review proceedings introduced by the America Invents Act of 2011 – post-grant review (PGR) and *inter partes* review (IPR) – offer mechanisms for challenging awarded patents at the US Patent and Trademark Office (USPTO).

Post-grant proceedings are high-stakes legal challenges that can make or break a company's IP portfolio or completely alter litigation outcomes, making it vital to have experienced post-grant attorneys on your side.

Panitch Schwarze's skilled, knowledgeable post-grant attorneys represent both petitioners and patent owners in proceedings before the Patent Trial and Appeal Board (PTAB). These proceedings are typically related to a co-pending district court litigation. So, it is important to have consistent post-grant and litigation strategies. Whether Panitch Schwarze is also handling your related litigation or is partnering with your litigation counsel, Panitch Schwarze's attorneys ensure that your post-grant proceeding strategies are optimized, cost-efficient, and aligned with your overall intellectual property goals.

Our Philadelphia and Wilmington, Delaware, IP law firm excels at identifying methods for achieving successful resolutions and creating innovative ideas to manage long-term patent strategies. Our post-grant attorneys have successfully represented clients in *inter partes* reviews through trial and written decision, and often [present on post-grant review](#) proceedings.

### Post-Grant Proceedings Change U.S. IP Landscape

The America Invents Act made the most sweeping changes to the U.S. patent system in more than 50 years. Post-grant review and *inter partes* review replaced *inter partes* reexamination as the primary tool for effective third-party validity contests at the US Patent Office, and offer third parties relatively quick and inexpensive alternatives to challenging a patent through litigation.

PGR is used to [challenge the validity of a patent](#) (having an earliest effective filing date on or after March 16, 2013) based on any ground, except failure to disclose the best mode. PGR challenges must be filed at the Patent Office within the nine months following a patent's issuance. [Inter partes reviews \(IPR\) are trial proceedings](#) to review the patentability of one or more claims in any issued patent in light of prior art in the form of patents or printed publications. IPR challenges to patents, having an

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## Industries Served

Agriculture / Horticulture  
Automotive  
Business Services  
Construction  
Consumer Goods / Retail  
Electronics / Manufacturing / Machinery  
Energy  
Entertainment  
Financial / Banking  
Medical / Medical Equipment / Medical Devices  
Pharmaceuticals / Biotechnology / Chemicals  
Technology / Software

earliest effective filing date before March 16, 2013, can be filed at any time, but an IPR petition for a patent having an earliest effective filing date on or after March 16, 2013, can be filed only after the nine-month post-grant review period elapses.

There are also rules governing the interplay of these proceedings with district court litigation. For example, a petition cannot be filed by a party that has already filed a civil action challenging the patent's validity. For IPRs, a petition cannot be filed more than one year after the party was served with a complaint for patent infringement in district court.

Post-grant proceedings are often viewed as a strategic alternative or supplement to federal litigation and are characterized by the following:

- Conducted before: PTAB.
- Time for Decision: 12-18 months from decision whether to institute a PGR or IPR trial (which is approximately 6 months from the petition filing).
- Institution Standard of Proof (PGR): More likely than not that at least one challenged claim is unpatentable.
- Institution Standard of Proof (IPR): Reasonable likelihood that petitioner would prevail with respect to at least one challenged claim.
- Standard of Proof at Trial: Preponderance of the evidence.
- Appeal: Both parties can typically appeal to the U.S. Court of Appeals for the Federal Circuit.

Post-grant proceedings require Panitch Schwarze's comprehensive patent knowledge, renowned trial skills, and extensive experience before the USPTO and PTAB.

#### Representative Matters

<b>Trial No.</b>	<b>Case Name</b>	<b>Represented Party</b>
IPR2018-01006	MacSports, Inc. v. Idea Nuova, Inc.	Patent Owner Idea Nuova
IPR2016-01910	Hamamatsu Corp. v. SiOnyx, LLC	Petitioner Hamamatsu
IPR2016-01143	Hamamatsu Corp. v. President and Fellows of Harvard College	Petitioner Hamamatsu
IPR2015-01499	Samsung Display Co., Ltd. v. Gold Charm Limited	Patent Owner Gold Charm
IPR2015-01491	Funai Electric Co., Ltd. v. Gold Charm Limited	Patent Owner Gold Charm
IPR2015-01479	Toshiba Corporation v. Gold Charm Limited	Patent Owner Gold Charm
IPR2015-01452	Samsung Display Co. Ltd. v. Gold Charm Limited	Patent Owner Gold Charm

IPR2015-01448	Funai Electric Co., Ltd. v. Gold Charm Limited	Patent Owner Gold Charm
IPR2015-01421	Atlas Copco Airpower N.V. v. Kaeser Kompressoren GmbH	Patent Owner Kaeser Kompressoren
IPR2015-01417	Samsung Display Co. Ltd. v. Gold Charm Limited	Patent Owner Gold Charm
IPR2014-01438	Panasonic System Networks Co., Ltd. v. 6115187 Canada Inc.	Patent Owner 6115187 Canada Inc.
IPR2014-01422	Galderma S.A. v. Allergan Inc.	Petitioner Galderma
IPR2014-01417	Galderma S.A. v. Allergan Industrie, SAS	Petitioner Galderma
IPR2014-01222	Unified Patents, Inc. v. Broadband iTV, Inc.	Patent Owner Broadband iTV
IPR2014-00776	Atlas Copco Airpower N.V. v. Kaeser Kompressoren GmbH	Patent Owner Kaeser Kompressoren
IPR2014-00742	Billy Goat Industries, Inc. v. Schiller Grounds Care, Inc.	Patent Owner Schiller Grounds Care
IPR2013-00637	Sumitomo Chemical Company, Ltd. v. Polypore International, Inc.	Petitioner Sumitomo
CBM2014-00189	Hawaiian Telcom, Inc. v. Broadband iTV, Inc.	Patent Owner Broadband iTV