



**Go Ahead and Challenge That Patent....Anyone!**

By **Niq Howard**, BrownWinick Attorney  
[howard@brownwinick.com](mailto:howard@brownwinick.com)

Post grant proceedings survive the gavel of the Supreme Court. On April 24, 2018, the Supreme Court issued two decisions upholding the validity of post grant proceedings (“PGPs”). A PGP is a trial proceeding conducted at the Patent Trial and Appeal Board (“PTAB”) to review the patentability of one or more claims in a patent. PGPs allow a third party to challenge the validity of one or more claims of a patent. The first holding of the two decisions, *Oil States*, confirmed that such reviews are constitutional. The second, *SAS Institute*, struck down the United States Patent & Trademark Office’s discretionary practice of “partial institution” where the PTAB reviews less than all of the challenged claims.

It frequently surprises a patent owner when they learn their patent has been challenged. Although, PGPs don’t occur in a high percentage of issued patents, they directly challenge the rights of the patent holder. A PGP allows virtually anyone to challenge the claims of a patent. The ruling in *Oil States* confirmed this reality. The ruling in *SAS Institute* made a slight change to the existing conduct of the PTAB.

Before April 24, 2018, the PTAB could choose which claims of the challenged patent they would consider. The PGP process allows a petitioner to challenge a claim or claims of a patent. This includes challenging the validity of the entire patent. The previous PGP process allowed the PTAB to select which claims they would consider from the petition. As of April 24, 2018, the PGP must choose to consider none or all of the patent challenger’s claims in the petition. The result on April 24, 2018 was somewhat expected. There will be no more “partial institutions” and PGPs are here to stay.

The procedure for conducting a PGP became available in September of 2012. The goal of the United States Patent & Trademark Office in creating these PTAB proceedings was to provide a streamlined alternative to the ever growing patent litigation. However, since 2012, thousands are using the PGP procedures as a powerful supplement to litigation rather than a replacement. Most petitioners are supplementing litigation by way of the inter party review (“IPR”). An IPR is a type of PGP. While PGPs are very powerful, they are also very complex and expensive. According to the American Intellectual Property Law Association, an entire PGP proceeding can cost upwards of \$300,000 or more. Thus, it is highly recommend you consult your favorite intellectual property attorney when being challenged by a PGP or when considering implementing a PGP.

666 Grand Avenue, Suite 2000  
Des Moines, IA 50309

515-242-2400  
[www.brownwinick.com](http://www.brownwinick.com)

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