

Articles

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Snapshot Overview of Options for Post-Issuance Challenges Before the PTAB

There are three available types of post-issuance challenges to the validity of a patent: (1) *Inter Partes* review; (2) Transitional Program for Covered Business Method Patents; and (3) Post-Grant Review. Another option not included in this table is a derivation proceeding, which challenges the ownership of a patent.

Proceeding	Applicability	Legal Standard for Review	Invalidity Grounds	Timing	Additional Info	Fees
<i>Inter partes</i> review (IPR)	Available since September 16, 2012, for any patent	<u>Reasonable likelihood</u> that the petitioner would prevail with respect to at least one of the claims	Limited to patents, published applications and printed publications	<u>First-to-invent patents</u> : any time after issuance of the patent <u>First-to-file patents</u> : at least nine months after issue date of the patent but no earlier than termination of any PGR of the patent	Estoppel on any grounds of invalidity that was raised or could have been raised; may not be filed if petitioner has challenged validity of patent in court or litigation pending for more than one year; patentee may seek to amend claims	<u>Request fee</u> of \$9,000 plus \$200 for each claim in excess of 20 <u>Post-institution fee</u> of \$14,000 plus \$400 for each claim in excess of 20
Transitional Covered Business Method Patent Review (CBM)	Available since September 16, 2012, for any patent	<u>More likely than not</u> that at least one claim is unpatentable	Any invalidity grounds (including broadened AIA §18(a)(1)(c) definition of	Any time after issuance for patents filed before March 16, 2012, if sued for	Expressly limited to covered business method; sunsets Sept. 16, 2020;	<u>Request fee</u> of \$12,000 plus \$250 for each claim in excess of 20

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			prior art) except for best mode	infringement or charged with infringement or nine months after issuance for first-to-file patents	estoppel on any grounds of invalidity that was raised; patentee may seek to amend claims	<u>Post-institution fee</u> of \$18,000 plus \$550 for each claim in excess of 20
Post-grant Review (PGR)	Patents that contain, or contained at any time, any claimed invention having an effective filing date on or after March 16, 2013	<u>More likely than not</u> that at least one claim is unpatentable	Any invalidity grounds except for best mode	Within nine months of the issue date; also available for reissue patents except for claims that are identical to or narrower in scope than the claims in the original patent which issued more than nine months prior	Estoppel on any grounds of invalidity that was raised or could have been raised; may not be filed if petitioner has challenged validity of patent in court or litigation pending for more than one year; patentee may seek to amend claims	See CBM fees above