

Brian Kwok in Law360: Post-Grant Reviews To Grow In Number, But As A Niche Tool

May 19, 2017 Brian Kwok

PRACTICES Patent Office Trials, Patents, Intellectual Property

Attorneys expect the number of petitions challenging patents under the America Invents Act's post-grant review program to shoot up from the few dozen filed to date, but even with the anticipated increase, the program won't rival popular and less restrictive *inter partes* reviews.

Over 6,100 petitions challenging patents in *inter partes* reviews had been filed through the beginning of April, compared to only 51 post-grant review petitions, according to the U.S. Patent and Trademark Office.

That may seem like a major discrepancy given the wider array of challenges available in post-grant reviews. While *inter partes* reviews only allow petitioners to argue that a patent is invalid on the grounds of obviousness or anticipation, post-grant reviews permit challengers to argue, for example, that a patent claims ineligible subject matter or lacks a required written description. However, post-grant reviews are available only for patents that have issued relatively recently, and few patents so far qualify for review. But as more such patents issue in the years to come, post-grant reviews will become a significant part of many patent disputes, attorneys say...

"I don't think PGRs are as popular as a lot of people anticipated," said [Brian Kwok](#) of Haynes Boone LLP.

Two key aspects of post-grant reviews are likely making potential challengers wary: the seemingly very broad estoppel provision limiting future invalidity arguments petitioners can make, and the limited window for challenging patents. The AIA states that following a post-grant review, petitioners are barred from later raising in litigation "any ground that the petitioner raised or reasonably could have raised during that post-grant review."

Since practically every invalidity ground can be raised in a post-grant review, litigants worry that unless they put every possible argument in the petition, they might forfeit any opportunity to later argue that the patent is invalid if it survives review.

"People always cite the estoppel as a reason for not filing a PGR," Kwok said....

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