

Brian Kwok and Nicholas Martini for Law360: Post-Grant Review Is Becoming Increasingly Popular

June 1, 2016 Brian Kwok

PRACTICES Intellectual Property, Patents, Patent Litigation, Patent Office Trials

When patents issue with questionable validity, it reflects negatively on the patent system and undermines the confidence businesses have in their investments. Post-grant review allows invalid patents that were mistakenly issued by the U.S. Patent and Trademark Office to be disposed of early in their life, before they disrupt an entire industry or result in expensive litigation. Because PGR has a relatively short, nine-month period for filing a petition, the new proceedings strike a balance between weeding out patents that should have never issued in the first place and protecting the rights of patent owners against endless challenges over the life of a patent.

As more patents issue under the America Invents Act's first-inventor-to-file system, PGR proceedings at the Patent Trial and Appeal Board are being filed with increasing frequency. A counterpart to the widely used inter partes review, PGRs allow a petitioner to challenge nearly all grounds of patentability. Post-grant review proceedings are designed to be quick, lasting no more than 12-18 months, and the PTAB's decision regarding patentability is immediately appealable to the Federal Circuit. A PGR challenge invoked wisely can be a powerful tool to resolve patent disputes favorably.

This article compares PGR and IPR proceedings, exploring the reasons underlying their differences. It then considers all PGR petitions filed as of the date of this writing to provide a contextual overview of the types of patents, parties and patentability challenges that are being argued before the PTAB. Finally, we conclude with strategic considerations for using PGR as part of a comprehensive patent legal strategy.

Excerpted from *Law360*. To read the full article, please [click here](#).