PANITCH
Intellectual Property Law
SCHWARZE

Detailed Summary of Post-Grant Proceedings

	U.S. PATENT AND TRADEMARK OFFICE					DISTRICT COURTS	INTERNATIONAL TRADE COMMISSION
	INTER PARTES REVIEW (IPR)	POST GRANT REVIEW (PGR)	*EX PARTE* REEXAMINATION (XPR)	REISSUE	SUPPLEMENTAL EXAMINATION		
Purpose and Benefits of the Proceeding	Canceling one or more claims in less time, and at a lower cost, than district court, with minimal discovery		Canceling or compelling narrowing amendment of one or more claims in relatively slow, low cost *ex parte* forum with no advocacy by requester after initial request, no discovery, low standard of review, and broad claim interpretation	Canceling or adding one or more claims by right (narrower at any time before patent expires, or broader if filed within two years of issuance) in relatively slow, low cost *ex parte* forum with no discovery, low standard of review, and broad claim interpretation	Curing possible defects relating to inequitable conduct in relatively slow, low cost *ex parte* forum with no discovery, lower standard of review and broader claim interpretation	Invalidating one or more claims; finding of unenforceability; finding of infringement or non-infringement; obtaining injunction and damages for infringement	Invalidating one or more claims; finding of unenforceability; obtaining exclusion order
Presumption of Validity	No presumption of validity					Yes	Yes
Standing (Who May Seek Review?)	Third party (who is not the U.S.) who is not a plaintiff challenging validity of patent or had been served with a complaint alleging infringement more than one year before IPR filing	Third party (who is not the U.S.) who is not a plaintiff challenging validity of patent	Patent Owner, third party (can be anonymous) and USPTO director	Patent Owner only	Patent Owner only	Patent Owner or exclusive licensee alleging an actual case for infringement; third party seeking a declaratory judgment of invalidity, unenforceability, or non-infringement	Patent Owner or exclusive licensee are required to be a complainant alleging infringement (other parties may join complaint); must have domestic industry relating to the protected product
Qualification of Patent	Any patent	Any patent having at least one claim with an effective filing date on or after March 16, 2013	Any patent	Any patent	Any patent	Any patent	Any patent

PANITCH'S POST-GRANT GROUP CO-CHAIRS:
Erin M. Dunston | 215-965-1291 | edunston@panitchlaw.com ■ **Stephen E. Murray** | 215.965.1307 | smurray@panitchlaw.com
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When the Challenge can be Filed	For pre-AIA patents, any time; for AIA patents (having at least one claim with an effective filing date on or after March 16, 2013), on or after 9 months after issuance or reissuance, or termination of PGR	Within 9 months of issuance or reissuance for patents having at least one claim with an effective filing date on or after March 16, 2013	Any time during enforceability of the patent (up to 6 years after lapse or expiration)	Any time before patent expires	Anytime during enforceability of the patent (up to 6 years after lapse or expiration)	Any time before six years after expiration of the patent or six years after last infringing conduct	Any time before patent expires
Permitted Grounds of Challenge	35 U.S.C. §§ 102 and 103 based on patents and printed publications	Any grounds (35 U.S.C. §§ 101, 102, 103, 112) except § 112 failure to comply with "best mode" requirement	35 U.S.C. §§ 102 and 103 based on patents and printed publications	The patent, through error, is considered to be wholly or partly inoperative or invalid	Any "information relevant to patentability"	Any grounds (35 U.S.C. §§ 101, 102, 103, 112) except § 112 failure to comply with "best mode" requirement	Any grounds (35 U.S.C. §§ 101, 102, 103, 112) except § 112 failure to comply with "best mode" requirement
Prior Art Considered	Limited to patents and printed publications	All statutory prior art (*i.e.*, patents, printed publications, prior art products and prior art acts)	Limited to patents and printed publications	All statutory prior art	All statutory prior art	All statutory prior art	All statutory prior art
Standard For Initiating Review	"Reasonable likelihood" that the petitioner would prevail with respect to at least one challenged claim (intended to be higher than in PGR)	"More likely than not" at least one of the challenged claims is unpatentable	Raises "substantial new question" of patentability (what a reasonable examiner would find important in determining patentability of the claims)	N/A	Raises "substantial new question" of patentability	Rules 8, 9, and 11 of the Federal Rules of Civil Procedure	Complainant must plead detailed facts showing (a) unfair competition or unfair act (*e.g.*, patent infringement), (b) importation, sale for importation, or sale after importation into the U.S. of the accused products, and (c) the existence of a domestic industry relating to the protected product

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Discovery	Yes, automatic deposition of witnesses submitting declarations or affidavits, automatic discovery of contradictory evidence; additional discovery by motion as necessary in the "interests of justice"	Yes, automatic deposition of witnesses submitting declarations or affidavits, automatic discovery of contradictory evidence; additional discovery by motion upon showing of "good cause" and limited to evidence directly related to factual assertion of other party (broader than IPR)	No	No	No	Yes, broad and can involve any non-privileged material that is "relevant to any party's claim or defense and proportional to the needs of the case"	Yes, broad, but governed by ITC Rules of Practice and Procedure (19 C.F.R. §§ 210.1 *et seq.*) and Ground Rules specified by presiding Administrative Law Judge.
Burden Of Proof	Preponderance of evidence					"Clear and Convincing" evidence	
Claim Interpretation Standard	*Phillips* standard. *See Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005)	*Phillips* standard	Broadest reasonable interpretation	Broadest reasonable interpretation	Broadest reasonable interpretation	*Phillips* standard	*Phillips* standard
Requirement for Identification	Must identify all real parties in interest	Must identify all real parties in interest	Can be anonymous	Patent Owner	Patent Owner	Limited to Rule 7.1 disclosure	Patent Owner or exclusive licensee; no separate real parties in interest requirement
Decision Maker	Patent Trial and Appeal Board (PTAB) — a panel of 3 Article I Administrative Patent Judges (APJs) who have both law and technical backgrounds		Examiner of Central Reexamination Unit		Examiner	Article III judge and jury	Article I Administrative Law Judge's determination reviewed by the Commission

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Extent of Estoppel	The real party in interest and any privy thereto is estopped from challenging the patent in the USPTO, ITC, or district court on any ground the petitioner raised or reasonably could have raised in the IPR.	The real party in interest and any privy thereto is estopped from challenging the patent in the USPTO, ITC, or district court on any ground the petitioner raised or reasonably could have been raised in the PGR.	No estoppel applies	N/A	N/A	*Res judicata* and collateral estoppel	N/A
Potential for Stay of Coordinate Proceedings	Potential stay of litigation depending on many factors	If PGR is filed, then later filed court proceeding automatically stayed	Stay of litigation possible but unlikely	Stay of litigation possible but unlikely	N/A	Discretionary stay possible	Stay of proceeding possible but unlikely
Appeal Forum And Standard of Review	CAFC (both parties); substantial evidence for factfinding and *de novo* for legal issues	CAFC (both parties); substantial evidence for factfinding and *de novo* for legal issues	PTAB, then CAFC (only patentee); substantial evidence for factfinding and *de novo* for legal issues	PTAB, then CAFC (only patentee); substantial evidence for factfinding and *de novo* for legal issues	PTAB, then CAFC (only patentee); substantial evidence for factfinding and *de novo* for legal issues	CAFC; substantial evidence for factfinding and *de novo* for legal issues	CAFC; substantial evidence for factfinding and *de novo* for legal issues
Possibility of Settlement	Yes, but PTAB has discretion to continue	Yes, but PTAB has discretion to continue	No	N/A	N/A	Yes	Yes
Typical Duration (to Completion)	12-18 months; 6 months if trial phase not instituted	12-18 months; 6 months if trial phase not instituted	Approximately 2 years, unless initial request not granted	Approximately 2-3 years	If no SNQ, 3 months; if SNQ, approximately 2-3 years	Depends on court; approximately 2-5 years	Up to 18 months
Government Fees	$19,000 for up to 20 claims; $375 for each claim thereafter; Post-institution fee of $22,500 for up to 20 claims; $750 for each claim thereafter	$20,000 for up to 20 claims; $475 for each claim thereafter; Post-institution fee of $27,500 for up to 20 claims; $1,050 for each claim thereafter	$12,600 (large entity, non-streamlined), $6,300 (large entity, streamlined) for up to 3 independent claims and up to 20 claims total; $480 for each independent claim thereafter, and $100 for each claim in excess of 20 thereafter	$3,340 (large entity) for up to 3 independent claims and up to 20 claims total; $480 for each independent claim thereafter, and $100 for each claim in excess of 20 thereafter	$4,620 (large entity) to file request; $12,700 (large entity) if XPR ordered; $180 for Supplemental Examination Document of 21-50 sheets and $300 for each 50 sheets thereafter	Minimal	None
Estimated Total Average Cost Range	$200k-$1.5MM	$200k-$1.5MM	$20k-$75k	$10k-$30k	$10k-$30k	$1.5MM-$6MM	$1.5MM-$6MM

WE PROVIDE EXPERIENCED REPRESENTATION IN COMPLEX INTELLECTUAL PROPERTY MATTERS

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