

Inter Partes Review



An inter partes review (IPR) is the most common post-grant proceeding used to challenge the validity of patents at the United States Patent and Trademark Office (USPTO). Any patent can be challenged by a third party (non-patent owner) using an IPR starting nine months after the patent's grant date. However, an IPR must be filed within 12 months of the service of any complaint alleging infringement.

An IPR is a type of post-grant review procedure that allows a party to challenge the validity of an issued patent before the Patent Trial and Appeal Board (PTAB), which is a panel of three administrative law judges within the USPTO.

The patent challenger, known as the petitioner, files a petition for a review of one or more claims of a patent. The petition identifies why the claims are invalid in view of prior art, which can consist of patents and printed publications.

A petition can identify grounds of invalidity based on anticipation and obviousness under 35 U.S.C. §§ 102 and 103. However, a petition cannot challenge claims under §§ 101 (abstract idea) or 112 (written description, enablement or best mode). In order for the PTAB to institute review, the petitioner must show that there is a reasonable likelihood that they would prevail in showing that at least one claim in the patent is unpatentable.

The patent owner has the right to file a Preliminary Patent Owner Response, which may raise one or more procedural defects with the petition, respond to the substance of the arguments made or otherwise request the PTAB deny institution on other grounds.

If the PTAB decides to institute an IPR, the patent owner can file a Patent Owner Response, which may more substantively respond to the grounds raised in the petition and argue in favor of the validity of their patent. If there is still term left on the challenged patent, the patent owner may also file a motion to amend the claims, asking the PTAB to issue new claims that address the invalidity grounds in the event any claims are found to be invalid.

While an IPR is technically an administrative proceeding, it is often thought of as quasi-litigation. An IPR can include discovery, additional motion practice, depositions and oral argument. The proceeding involves a review of the patent and any relevant prior art, the

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written submissions by both parties, deposition testimony (which may include fact and expert testimony), as well as oral arguments. The PTAB may also conduct a hearing to gather additional evidence and testimony. At the conclusion of the IPR, the PTAB issues a final written decision, either confirming the validity of the challenged and proposed amended patent claims or finding them unpatentable. The decision may be appealed to the Federal Circuit, which is the appellate court for patent cases.

If the IPR results in a final written decision, the petitioner will be estopped from challenging the validity of the patent in subsequent proceedings, including in district court, that it “raised or reasonably could have raised” in the IPR. In other words, the petitioner may be barred from future challenges to the patent that are based on prior art patents and publications that were known or could have been known at the time the petition was filed. This is intended to prevent parties from using IPRs as a “second bite at the apple” by challenging a patent’s validity in multiple proceedings with different arguments and evidence. There are limits to the estoppel, allowing the petitioner to raise arguments it could not reasonable have raised in the IPR. For example, because products cannot be used as prior art references in an IPR, a challenge that includes products may not be estopped in a subsequent proceeding. Overall, estoppel in the context of IPRs serves as a mechanism to promote finality and efficiency in patent validity challenges, while also ensuring that parties have a fair opportunity to present their case in each proceeding.