



Home > Patents > Laws > America Invents Act (AIA)
> America Invents Act (AIA) Frequently Asked Questions

America Invents Act (AIA) Frequently Asked Questions

Go

America Invents Act (AIA) Frequently Asked Questions

America Invents Act (AIA) - Post Grant Review - Other

▼ Can a party to post grant review appeal the Board's final decision?

Yes, a party dissatisfied with the final written decision in a post grant review may appeal to the Federal Circuit.

▼ How will the Board handle multiple proceedings for the same patent, such as two or more post grant reviews on the same patent?

Where another matter involving the same patent is before the Office during the pendency of the post grant review, the Board may enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter. Joinder may be requested by a patent owner or petitioner.

▼ Can the parties to a post grant review settle?

The AIA permits the parties to a post grant review to settle. A settlement terminates the proceeding with respect to the petitioner, and the Board may terminate the proceeding or issue a final written decision.

▼ Can a party to a post grant review be sanctioned?

Yes, then AIA requires the Office to prescribe sanctions for abuse of discovery, abuse of process, or any other improper use of a post grant review, such as to harass or cause unnecessary delay or an unnecessary increase in the cost of the proceeding.

▼ How long will a post grant review take?

A post grant review is statutorily required to be complete within one year of institution, except that the time may be extended up to six months for good cause.

▼ How will the Board conclude a post grant review?

The AIA provides that where a post grant review is instituted and not dismissed, the Board shall issue a final written decision. The decision shall address the patentability of any challenged patent claim and any new claim added via amendment during the post grant review.

▼ After the Board renders a final decision in a post grant review, do any estoppels apply against the petitioner?

Yes, a petitioner in a post grant review may not request or maintain a subsequent proceeding before the Office with respect to any challenged patent claim on any ground that was raised or reasonably could have been raised in the post grant review. Similarly, a petitioner in a post grant review may not assert in a subsequent district court or ITC action that a claim is invalid on any ground that the petitioner raised or reasonably could have been raised in the post grant review.

▼ After the Board renders a final decision in a post grant review, do any estoppels apply against the patent owner?

Yes, a patent owner is estopped from taking action inconsistent with any adverse judgment including obtaining in a patent a claim that is patentably indistinct from a finally refused or cancelled claim or amending its specification or drawing in a way that it was denied during the proceeding.

▼ What type of discovery is permitted during a post grant review?

Routine discovery includes cited documents, cross-examination of declaration testimony, and information inconsistent with positions advanced during the proceeding. The parties may agree mutually to provide additional discovery or either party may file an authorized motion seeking additional discovery.

▼ During a post grant review, how can a party seek relief?

The AIA provides that a party may request relief during a post grant review by filing a motion. In addition, the use of conference calls to raise and resolve issues in an expedited manner is encouraged. A party seeking relief may contact the Board and request a conference call, explaining why the call is needed. The Office envisions that most of the procedural issues arising during a proceeding will be handled during a conference call or shortly thereafter, i.e., in a matter of days.

▼ Can a party file a motion seeking relief at any time during the post grant review proceeding?

A motion will not be entered without Board authorization. Authorization may be provided in an order of general applicability, e.g., a scheduling order entered at the start of the trial, or during the proceeding after conferring with the Board.

▼ Is an oral hearing permitted during a post grant review?

Yes, the AIA permits either party to a post grant review to request an oral hearing.

▼ If a post grant review is instituted, can the patent owner amend the claims during the review?

A patent owner may file one motion to amend the challenged patent claims, subject to the standards and procedures set by the Office, during a post grant review. Amendments may cancel any challenged patent claim and/or propose a reasonable number of substitute claims.

▼ If a post grant review is instituted, can the petitioner file additional information?

A petitioner may supplement information provided in the petition for post grant review by a motion within one month of the date trial is instituted.

▼ How can a party to a post grant review protect confidential information?

The AIA provides that the file of a post grant review is open to the public, except that a party may seek to have a document sealed by filing a motion to seal. The AIA also provides for protective orders to govern the exchange and submission of confidential information.

▼ Is discovery permitted during a post grant review?

The AIA authorizes the Office to set standards and procedures for the taking of discovery during a post grant review, including that discovery be limited to evidence directly related to factual assertions advanced by either party in the proceeding.

▼ What is the standard for instituting a post grant review and who will decide whether the standard is met?

The petitioner must demonstrate that it is more likely than not that at least one of the claims challenged in the petition is unpatentable to trigger a post grant review. Alternatively, the petitioner may show that the petition raises a novel or unsettled legal question that is important to other patents or patent applications. The Patent Trial and Appeal Board will decide petitions for post grant review and conduct any ensuing reviews. In instituting a review, the Board may take into account whether, and reject the petition or request because, the same or substantially same prior art or arguments previously were presented to the Office.

▼ Can a party request rehearing of the Board's decision on the petition?

Yes, a party may request rehearing of the Board's decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed.

▼ Can a party appeal the Board's decision whether to institute a post grant review?

No, a party is statutorily precluded from appealing the Board's decision whether to institute a post grant review.

▼ If a post grant review is instituted, can the patent owner respond during the review?

Yes, a patent owner may file a response after the institution of a post grant review.

▼ How does a party request a post grant review?

To initiate a post grant review, a party must file a petition establishing certain statutory requirements.

▼ What statutory and regulatory requirements must a petitioner meet in a petition for a post grant review?

In a petition for a post grant review, the petitioner must by statute (i) identify all real parties in interest; (ii) identify all claims challenged and all grounds on which the challenge to each claim is based; and (iii) provide copies of evidence relied upon. The petition must be accompanied by a fee. In addition, the petitioner must by rule (i) identify the grounds for standing; (ii) provide a claim construction for each challenged claim; (iii) specifically explain the grounds for unpatentability; and (iv) specifically explain the relevance of evidence relied upon.

▼ What is the fee for filing a post grant review petition?

The AIA requires the Director to set the fee for a post grant review in such amounts as the Director determines to be reasonable, considering the aggregate costs of the review. For petitions filed prior to March 19, 2013, the fee for filing a petition challenging the patentability of up to 20 claims is \$35,800. For each additional claim challenged, there is a fee of \$800.00. For petitions filed on or

after March 19, 2013, the request fee is \$12,000 plus a fee of \$250.00 for each claim over 20, and the post-institution fee is \$18,000 plus a fee of \$550.00 for each claim over 15.

▼ Can a patent owner respond to a petition for a post grant review?

Yes, a patent owner may file a preliminary response to a post grant review petition to provide reasons why no post grant review should be instituted.

▼ What patents are eligible for a post grant review?

With limited exceptions, only those patents issuing from applications subject to first-inventor-to-file provisions of the AIA. The first-inventor-to-file provision of the AIA is not effective until March 16, 2013.

▼ When can a petitioner bring a post grant review for a patent?

A post grant review may be requested on or prior to the date that is 9 months after the grant of a patent or issuance of a reissue patent.

▼ Who may file for a post grant review?

A person who is not the patent owner and has not previously filed a civil action challenging the validity of a claim of the patent may petition for a post grant review of the patent.

▼ On what grounds may a petitioner challenge a patent in a post grant review?

A petitioner for post grant review may request to cancel as unpatentable one or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of 35 U.S.C. 282(b) relating to invalidity (i.e., novelty, obviousness, written description, enablement, indefiniteness, but not best mode).

▼ What is the effective date for the post grant review provision in the AIA?

The effective date for the post grant review provision in the AIA is September 16, 2012.

Was this page helpful?  

 Share this page  Print this page

[Additional information](#) about this page

Receive updates from the USPTO

Enter your email to subscribe or update your preferences

[Subscribe](#)

[About the USPTO](#) • [Search for patents](#) • [Search for trademarks](#)

[US Department of Commerce](#)

[Accessibility](#)

[Privacy Policy](#)

[Terms of Use](#)

[Financial and Performance Data](#)

[Vulnerability Disclosure Policy](#)

[Freedom of Information Act](#)

[Inspector General](#)

[NoFEAR Act](#)

[USA.gov](#)

Follow us