

Opposition systems

United States of America

Until 2011, there was no opposition system *stricto sensu* in the patent system of the United States of America. However, the Leahy-Smith America Invents Act (AIA) of September 16, 2011, provided for additional options for challenging patent validity which entered into force on September 16, 2012. A post-grant review, which is a time-bound *inter partes* review mechanism, has been introduced, and the former *inter partes* re-examination procedure has been replaced by the *inter partes* review. The post-grant review provides a time limit of nine months after the grant of a patent to file a petition and, therefore, is similar to post-grant opposition mechanisms.

Post-grant review

The post-grant review is a trial proceeding conducted at the Patent Trial and Appeal Board (PTAB) to review the patentability of one or more claims in a patent on any ground that could be raised under 35 U.S.C. § 282(b)(2) or (3). The PTAB is composed, in case of a post-grant review, of at least three administrative patent judges, having legal knowledge and scientific ability, as designated by the Director.¹

According to 35 U.S.C. § 321, the post-grant review process begins with a third party filing a petition on or prior to the date that is nine months after the grant of the patent or issuance of a reissue patent.² The petition has to contain the payment of a fee, provide for the grounds including evidence to those grounds. The petition is made available to the public.³ The patent owner may provide a preliminary response to the petition within a time period set by the Director. The institution of the post-grant review is conditioned by a threshold according to 35 U.S.C. § 324. A post-grant review may be instituted upon a showing that it is more likely than not that at least one claim challenged is unpatentable. An additional ground may also be that the petition raises a novel or unsettled legal question that is important to other patents or patent applications. It is not possible to appeal to the determination whether to institute a post-grant review.

If the proceeding is instituted and not dismissed, a final determination by the Board will be issued within one year, extendable up to six months.⁴ The procedure for conducting post-grant review took effect on September 16, 2012, and generally applies to patents issuing from applications subject to first-inventor-to-file provisions of the AIA. The post-grant review will have an estoppel effect for civil action on any ground the requester raised or reasonably could have raised during the post-grant review.⁵ It will not be possible to request a post-grant review after a civil action has been started, and in case of a later civil action, it will have to stay under the conditions set by 35 U.S.C. § 325.

The conduct of the post-grant review by the PTAB provides *inter partes* proceedings, including either parties rights to an oral hearing as part of the proceedings. In the post-grant review, the petitioner shall have the burden of providing a proposition of unpatentability by a preponderance of the evidence according to 35 U.S.C. § 326. Either party may appeal the final decision of the Patent Trial and Appeal Board to the Court of Appeals for the Federal Circuit.

¹ 35 U.S.C. § 6 (a)(c).

² 35 U.S.C. § 321 (c).

³ 35 U.S.C. § 322.

⁴ 35 U.S.C. § 326 (11).

⁵ 35 U.S.C. § 325 (e).

With respect to the review of the validity of business method patents,⁶ Section 18 of the AIA provides a special transitional program. For example, the nine-month time period for requesting a review does not apply to such a transitional post-grant review proceeding.

AIA review procedures⁷

Over the last year, the United States Patent and Trademark Office (USPTO) has made a number of revisions to AIA review procedures to enhance consistency, transparency, and certainty. For example, the USPTO changed PTAB rules directed to the claim construction standard applied during AIA proceedings. The USPTO replaced the “broadest reasonable interpretation” standard, the standard still used during examination of patent applications, with the claim construction standard used by federal courts to construe a claim in a civil action.⁸

As it relates to claim amendments, the PTAB began a new pilot program for motion to amend procedures in AIA cases.⁹ Regarding practice before the Board generally, the PTAB published updates to its AIA Trial Practice Guide containing additional detailed guidance.¹⁰ The PTAB also updated its standard operating procedures for paneling cases and issuing precedential (binding) and informative decisions.

Following the new procedures, the USPTO recently designated a number of decisions as precedential or informative, providing further guidance to stakeholders. In 2019, the Supreme Court found that the U.S. government is not a “person” capable of petitioning for institution of an AIA review proceeding.¹¹ Information and documents relating to recent PTAB changes are readily available on the PTAB’s website.¹²

⁶ The definition is found in AIA Sec. 18(d).

⁷ These changes are applicable to all AIA review proceedings (inter partes review, post-grant review and business method reviews).

⁸ 83 FR 51340.

⁹ 84 FR 9497.

¹⁰ <https://www.uspto.gov/sites/default/files/documents/trial-practice-guide-update3.pdf> (Trial Practice Guide Update (July 2019));
https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf (Trial Practice Guide Update (August 2018)).

¹¹ *Return Mail, Inc. v. U.S. Postal Serv.*, 139 S. Ct. 1853, 1871 (2019).

¹² <https://www.uspto.gov/patentsapplication-process/patenttrialandappealboard>