

Naples Roundtable: Issue 1, Topic 4

PGR	IPR
Patent claims with effective filing date, on / after March 16, 2013	
Available only up to nine (9) months after patent issue or reissue	If effective filing date before March 16, 2013, available at any time
	If effective filing date on or after March 16, 2013, available only after nine (9) months after issuance or reissue, or following termination of PGR
Grounds of alleged invalidity broader than IPR: §§ 101, 102, 103, 112, double patenting, proved using any legally available evidence (e.g., prior sale / use / knowledge, AIA § 102)	Grounds of alleged invalidity: Only patents / printed publications, §§102, 103

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PGR	IPR
Institution: Petition must demonstrate that “more likely than not”, at least one challenged claim invalid	Institution: Petition must demonstrate “reasonable likelihood” that would invalidate at least one challenged claim
USPTO: “Reasonable likelihood” burden of proof lower than “more likely than not”	
Estoppel: If PGR / IPR results in final written decision re patent claim, petitioner is estopped from later challenging validity of claim in district court litigation (and from certain actions in USPTO) “on any ground that the petitioner raised or reasonably could have raised”.	
PGR estoppel broader than IPR estoppel (grounds for invalidity broader)	IPR estoppel narrower than PGR estoppel (grounds for invalidity narrower)