

## **Opposition and Post Grant Review (Predictability, Reliability and Timeliness)**

### **Best reason to endorse an opposition or post grant review system:**

Low cost administrative proceeding at BPA  
conducted with “special dispatch” by skilled APJs  
(persons of legal and scientific competence (35  
U.S.C. § 6(a)) increases predictability and timeliness

### **Best reason to avoid an opposition or post grant review system:**

The issue preclusion features of 35 U.S.C. §§ 315  
and 317 as to issues that could have been raised  
during the proceeding (9-12M)

# **Opposition and Post Grant Review**

**Single most important pitfall to avoid in designing a new opposition or post grant review system:**

- Do **not** include issue preclusion and estoppel features (35 U.S.C. §§ 315 and 317) that limit the desirability of the system to a potential challenger to a patent for first 9-12 months.
- Avoid merger with other proceedings such as reissue or reexamination
- Give requestor adequate deadlines for comments on patent owner's response >30 days

# **Opposition and Post Grant Review**

## **Single most important feature to include in a opposition or post grant review system:**

- The ability to challenge claims in a patent on all patentability grounds to get complete resolution of validity issues
- To include reliability conduct proceedings using E-processing
- Streamline proceeding to permit conclusion within 12 months of initiation
- Allow one narrowing amendment plus additional with showing of good cause
- Settlement

# Opposition and Post Grant Review

## Single best feature of the U.S. reexamination system:

For a patent owner, *ex parte* reexamination permits correction or strengthening of the patent before the USPTO  
inter partes reexamination:

- Examiner hears both sides of issue => Better informed decision
- Appeal to Federal Circuit is quicker compared to litigation
- Best suited where third party has killer pieces of prior art

# Opposition and Post Grant Review

## Single worst feature of the U.S. reexamination system:

There is no opportunity for a third party requester to obtain any discovery or to cross-examine the affiant/declarant when evidence is submitted in support of patentability

- Challenge to Patent is permitted at any time during Patent's period of enforcement
  - small entities affected after commitment of significant funds to develop invention
- Third party requester has no duty of disclosure: can omit potentially damaging information to its case