

Second-Window Post-Grant Patent Review

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The U.S. patent community now widely supports the concept of incorporating a post-grant patent review system into the patent statute. However, the community remains significantly divided over the implementation details. In particular, whether to place a strict time limit on the filing of post-grant review petitions, or whether to allow petitions to be filed during a “second window,” has emerged as point of serious contention. In this presentation, I propose a second window provision that is based predominantly on the premise that some types of prior art (non-documentary prior art) should be regarded as proper bases for post-grant review petitions at any time during the period of enforceability of the patent, while other types (documentary prior art) should be usable for post-grant review only during a time-limited “first window.” The proposal is an experiment in a very attenuated sort of incontestability for patents.

The proposal is motivated by obvious practical considerations, but I see the debate over second window provisions as linking to more fundamental policy issues. In this presentation, I take up two such issues. First, what is the central aspiration of post-grant review – to serve as a safety net to catch and correct the most egregious PTO errors, or to serve as a robust alternative mechanism for validity adjudication? Second, what should we expect to get from *ex parte* examination in a system that includes post-grant review, and do these expectations conform with current statutory imperatives?