

PATENT REEXAMINATION

FREQUENTLY ASKED QUESTIONS



A T T O R N E Y S A T L A W

Patent Reexamination

Frequently Asked Questions¹

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APPENDIX: USPTO FLOW CHART FOR REEXAMINATION

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Patent Reexamination

Frequently Asked Questions²

1. What is Patent Reexamination?

Patent reexamination is a procedure by which a granted patent is reexamined by a primary examiner in the United States Patent & Trademark Office's Central Reexamination Unit (CRU).³ The procedure was added to provide an alternative forum to the courts to challenge a patent's validity. The Patent Act provides that a request for reexamination may be submitted by "any person," which includes the patentee, any third party, or by the initiative of the USPTO Director.⁴

A threshold question for reexamination is whether the prior art raises a substantial new question of patentability of at least one claim.⁵ During reexamination, only prior patents and printed publications will be considered.

When a request for reexamination is filed, the USPTO Director will evaluate the request to determine if the submitted prior art raises a substantial new question of patentability. If the Director denies the request, his decision is final and not appealable. If granted, the PTO will begin the reexamination procedure.

2. What is the difference between ex parte and inter partes reexamination?

Ex parte reexaminations, once initiated, involve only the patentee and the USPTO. If a third party files the request for reexamination, the patent owner may submit a brief or proposed amendment, or refrain from taking any action at all. If no response is submitted from the patentee, the third party is precluded from any further participation in the reexamination. If a response is submitted by the patentee, the third party initiator may file a response to the patentee's statement, at which point the third parties' substantive participation ends. There are no additional opportunities for

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³ See generally 35 U.S.C. §§ 301-318; MPEP Chapters 2200, 2600; In almost all circumstances an examiner other than the one who originally examined the application will be assigned the case.

⁴ See 35 U.S.C. § 302; MPEP § 2212

⁵ See MPEP § 2216

the third party to submit information to the USPTO, and the third party has no right to appeal the decision in an *ex parte* reexamination.

Inter partes reexaminations allow the third party requesting the reexamination to actively participate in the proceeding.⁶ Unlike an *ex parte* reexamination, the third party can file a submission to the USPTO each time the patent owner responds to an office action.⁷ Further, the third party may appeal an adverse decision.⁸

3. *Why would a third party request an ex parte reexamination as opposed to an inter partes reexamination?*

At first glance, it may appear that the *inter partes* procedures are more favorable to a third party requester. However, there are a number of reasons to opt for an *ex parte* reexamination instead.

First, a third party requester can remain anonymous in an *ex parte* reexamination. Anonymity can be important to maintaining ongoing relationships while still allowing a validity challenge. Second, *ex parte* reexaminations are generally cheaper for a third party requester, because participation is limited to the initiation phase.

Finally, one critical downside to filing an *inter partes* request involves estoppel issues. If an *inter partes* request is granted and reexamination performed, the third party may not assert an invalidity defense in litigation based on prior art that was raised, or could have been raised in the reexamination proceeding.⁹ Similarly, a final decision by a district court that the third party has not sustained its burden of proving the invalidity of any patent claim in suit will bar the third party from bringing a *inter partes* reexamination.

4. *Why would a patentee request a reexamination of their own patent?*

The reexamination will be performed at the USPTO where the CRU has specific expertise in these matters. Thus, a patentee can test the validity of his patent in front of patent experts in a shorter time, at a reduced cost, and with some procedural advantages as compared to an infringement litigation. Furthermore a patentee may amend claims to preserve some of

⁶ See 35 U.S.C. § 311, 314

⁷ See 35 U.S.C. § 314 (b)(2); the third party may file written comments within 30 days from the date of service of the patentee's response.

⁸ See 35 U.S.C. § 315 (b)

⁹ See 35 U.S.C. § 315(c)

the original coverage, as opposed to risking an entire claim to an invalidity judgment in court.¹⁰

5. *As a patentee, why opt for reexamination over reissue?*

A patent owner may seek a reissue of the patent to narrow the scope of his claims as well. However, filing a reissue subjects *all* the claims to the *full scope* of the patent laws. By contrast, a patentee can limit a reexamination to certain claims, and the USPTO will only consider patents and printed publications under 35 U.S.C. §§ 102, 103.

6. *When may a request for reexamination be filed?*

A request for *ex parte* reexamination must be filed during the period of enforceability of a patent, which lasts 6 years after the date on which the patent expires.¹¹ The same is true for *inter partes* reexaminations, however inter partes examinations are only proper for patents with a filing date on or after November 29, 1999.

7. *What happens during reexamination?*

Reexamination is conducted according to the procedures established for initial examination under the provisions of 35 U.S.C. §§ 132, 133. In any reexamination proceeding, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims, in order to distinguish the invention as claimed from the prior art cited, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter.¹²

The USPTO may issue one or more office actions to which the patent owner may respond.¹³ If the reexamination is *inter partes*, the third party requester may file a submission each time the patent owner responds to an office action.¹⁴

¹⁰ Note amendments in reexamination are limited to narrowing amendments. See 35 U.S.C. § 305

¹¹ See MPEP § 2216

¹² See 35 U.S.C § 305

¹³ See MPEP §§ 2260-2266

¹⁴ See MPEP § 2666.05

8. *May I interview the examiner during reexamination?*

Examiner interviews are allowed, but only for *ex parte* reexaminations.¹⁵ Interviews on the merits are prohibited in *inter partes* proceedings.¹⁶ The patent owner must file a complete written statement of the reasons presented at the interview as warranting favorable action. If the patent owner fails to file an interview summary, the reexamination may be terminated in accordance with the last Office Action.

An interview does not remove the necessity for response to Office actions. Response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

9. *What effect do claim amendments have during reexamination?*

Any amendments or new claims deemed patentable in a reexamination are valid and enforceable against infringers, but will create “intervening rights,” specified in 35 U.S.C. § 252 concerning reissue patents. Intervening rights protect any person who made, purchased, or used within the United States, or imported into the United States, anything patented by the amended or new claim, or who made substantial preparation for the same prior to issuance on an *ex parte* reexamination certificate.¹⁷

10. *What is the end result of either reexamination procedure?*

The USPTO will issue a certificate that cancels invalid claims, confirms the originally allowed claims, or incorporates any amendments or new claims deemed patentable during the proceeding.¹⁸

11. *May I file a second request for reexamination on the same patent?*

A party may file a second *ex parte* reexamination as long as a new substantial question of patentability is at issue.¹⁹

Inter partes reexaminations present a different scenario. Once an *inter partes* reexamination is ordered, neither the third party requester, nor its

¹⁵ See MPEP § 2281

¹⁶ See 35 C.F.R. § 1.955

¹⁷ See MPEP § 2293

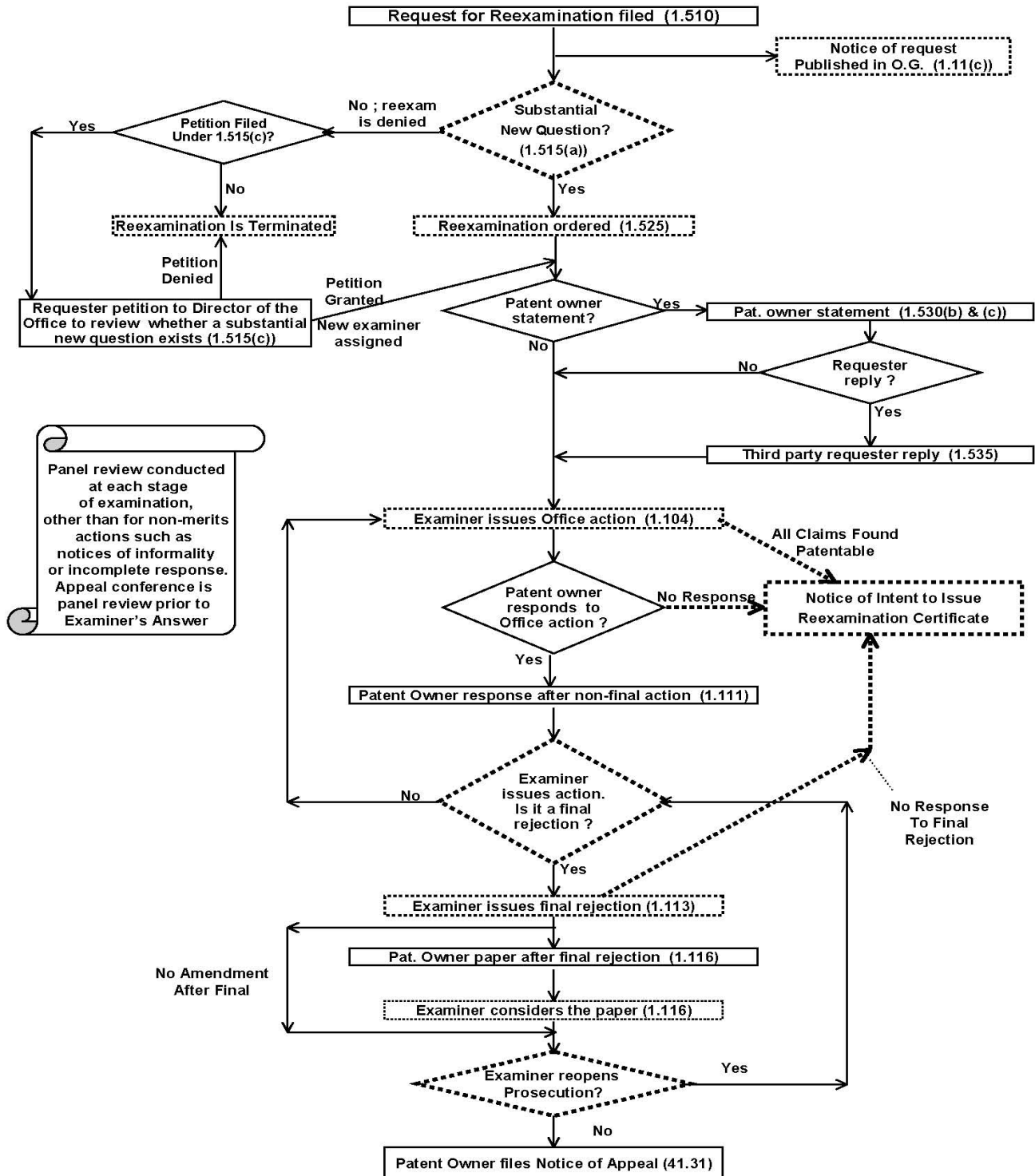
¹⁸ See 35 U.S.C. §§ 307, 316

¹⁹ See MPEP § 2240

privies may file another *inter partes* request until a reexamination certificate is issued. If the reexamination determines that any of the claims are patentable, then neither the third party requestor nor its privies may request *inter partes* reexamination on any claims based on issues that were raised or could have been raised in the previous proceeding.²⁰

²⁰ See 37 C.F.R. § 1.907(c)

Ex Parte Reexamination - PROCEDURE PRIOR TO APPEAL
(applicable rule section)



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MAIER & MAIER PLLC specializes in the practice of Intellectual Property and is conveniently located in Alexandria, Virginia next to the United States Patent and Trademark Office.

Our practice areas include, but are not limited to: patent searches, patent application drafting, patent opinions, patent prosecution, patent litigation, trademarks, copyrights, trade secrets and licensing. Our experienced, dedicated lawyers are focused on, and take great pride in, advising and obtaining patent protection for a wide scale of technologies.

Our attorneys and agents have garnered vast amounts of intellectual property expertise and experience while serving middle market companies from a variety of venues. Our distinctive approach to client service is rooted in a common guiding principle of exceeding client expectations by delivering the highest quality advice and excellence in execution, built upon a foundation of uncompromising integrity.

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