

Reexamination at the USPTO:

Berkeley Conference for Improving the Interface Between the USPTO and the Federal District Courts



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Topics

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Ex Parte Reexamination

- Statutory Basis effective July 1, 1981.
 - Provided ability for patent owners or third parties to request that the USPTO reconsider granted patents based on pre-existing technology that previously escaped review. Reexamination may only be granted to answer a substantial new question of patentability (SNQ) based on patents and printed publications.
- Amended in 1999 (to permit appeal only after a final rejection) and 2002 (to expand the prior art that can support reexamination).

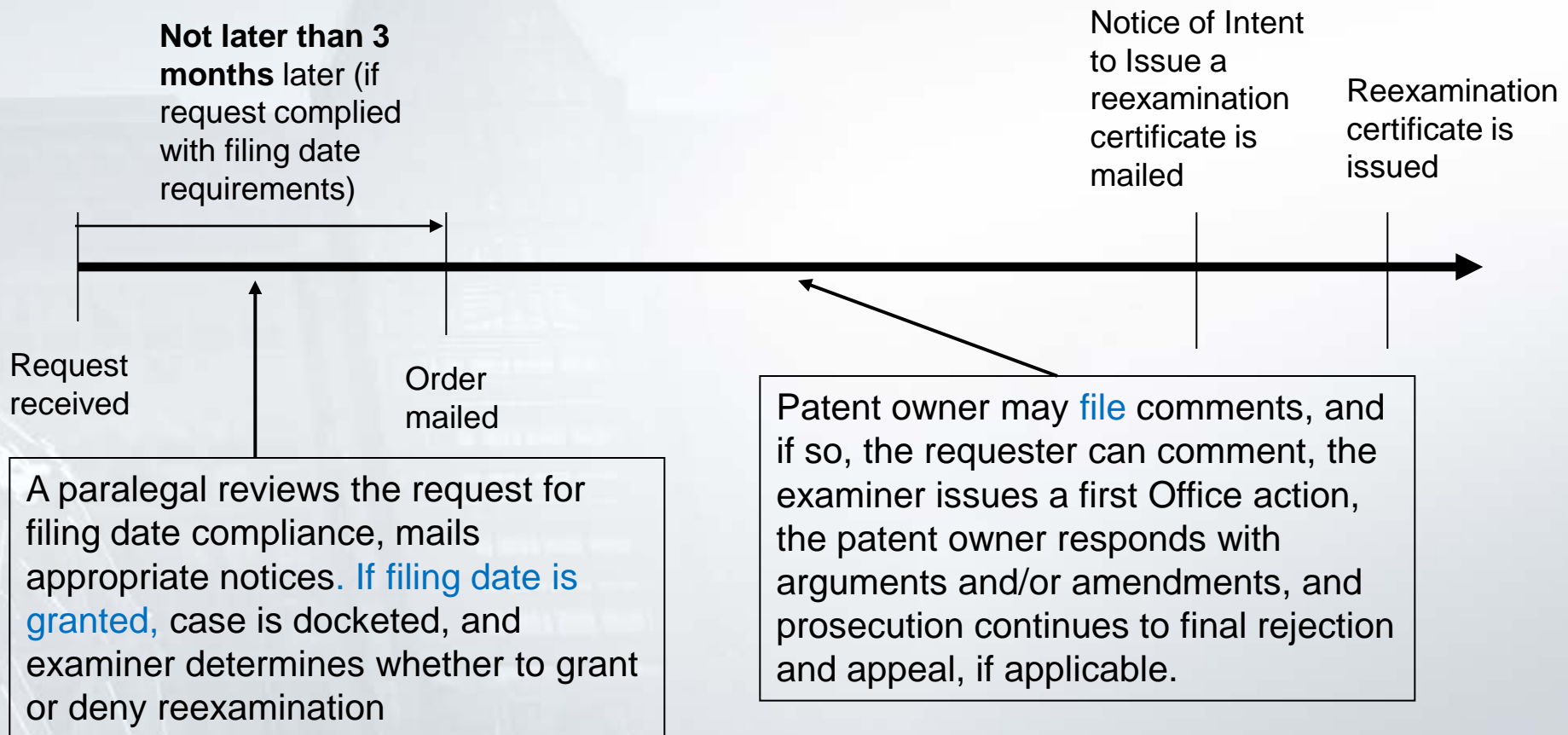


Characteristics of *Ex Parte* Reexamination MPEP § 2210

- (1) Anyone can request reexam during enforceability period (can be anonymous)
- (2) Prior art is limited to patents or printed publications
- (3) A substantial new question of patentability (SNQ) must be present
- (4) Decision on request must be made within 3 months from filing date (statutory deadline)
- (5) If ordered, reexamination will normally conclude with reexam certificate
- (6) No broadening in reexam



General *Ex Parte* Reexamination Timeline





Inter Partes Reexamination

- Statutory Basis effective November 29, 1999.
 - Provided ability for third parties to request that the USPTO reconsider granted patents based on pre-existing technology that previously escaped review. Reexamination may only be granted to answer a SNQ based on patents and printed publications. Real party in interest must be revealed.
 - Limited to patents issued from “original” applications filed on or after November 29, 1999.
 - Provided for right of third party to comment on any patent owner response to an action on the merits by the USPTO.
 - Provided for right of third party to appeal to the Board of Patent Appeals and Interferences (BPAI) and participate in patent owner's appeal to the BPAI.
- Amended in 2002 (to expand the prior art that can support reexamination and to permit the third party to appeal decision of the BPAI to the Court of Appeals for the Federal Circuit (CAFC) and to participate in Patent Owner appeals to the CAFC).

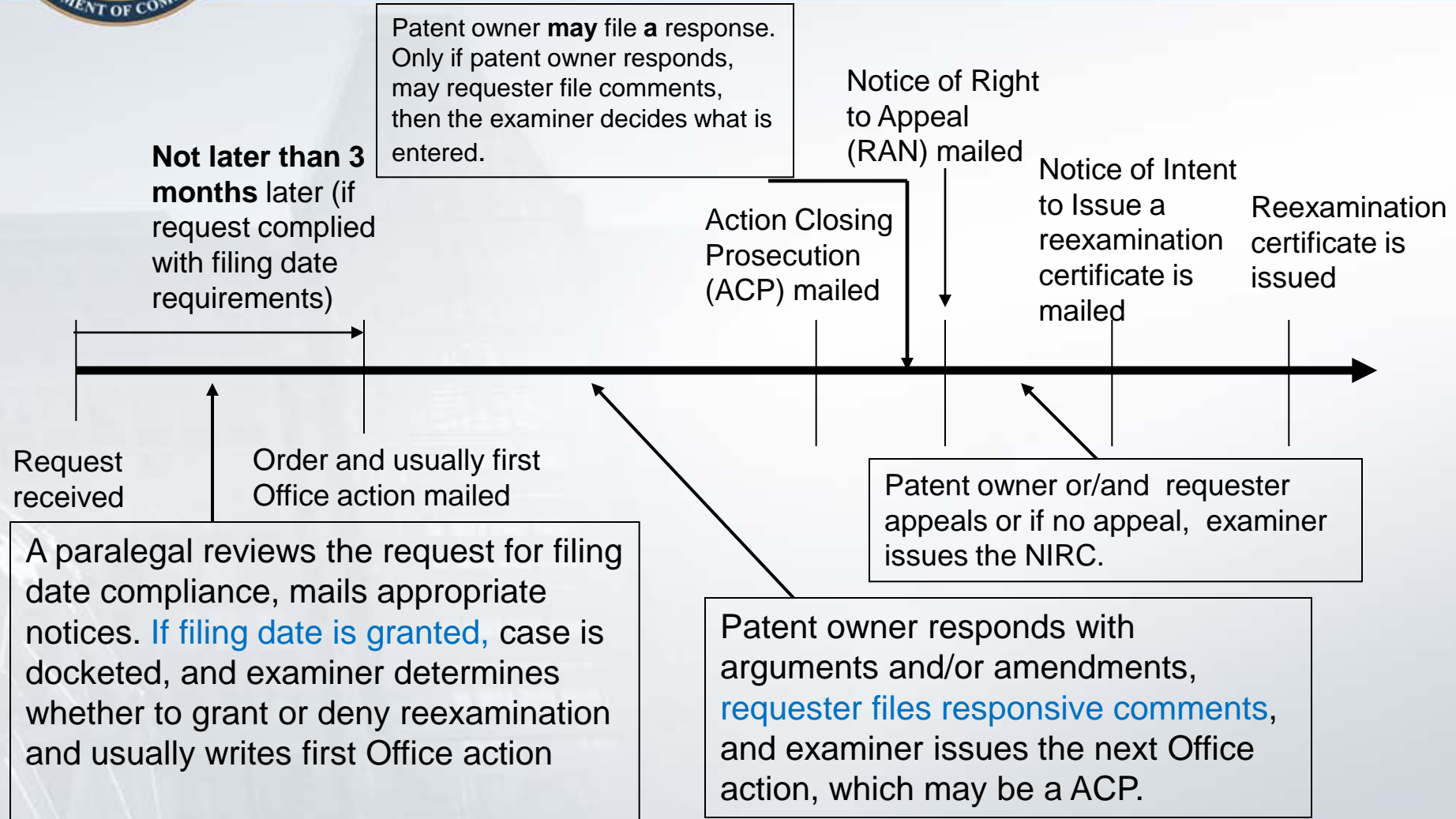


Characteristics of *Inter Partes* Reexamination MPEP § 2610

- (1) Any third party requester can request reexam during enforceability period. Real party in interest must be revealed. Must certify that estoppel provisions do not apply.
- (2) Prior art is limited to patents or printed publications
- (3) A substantial new question of patentability (SNQ) must be present
- (4) Decision on request must be made within 3 months from filing date (statutory deadline). An action on the merits may accompany order
- (5) Third party has 30-day right of comment on any response by Patent owner to an action on the merits
- (6) Third party has right of appeal on rejections not made if a claim considered patentable
- (7) If ordered, reexamination will normally conclude with reexam certificate
- (8) No broadening in reexam



General *Inter Partes* Reexamination Timeline





Compare - Contrast *Inter Partes/Ex parte* Reexamination

- Third party requester can file comments for every substantive patent owner response after an action on the merits, whereas *ex parte* reexamination provides limited requester participation.
 - Unique types of Office actions, e.g., ACP and RAN.*
 - Timing of issuance of Office actions.
 - Identification of the real party in interest/rather than anonymous requester in *ex parte*.
 - Estoppel effect as to the third party requester in *inter partes* reexamination.
 - When the initiation of *inter partes* reexamination is prohibited. 35 U.S.C. § 317
- Does not differ from *ex parte* reexam as to substance.

*Office is considering the consolidation of these two actions



Substantial New Question of Patentability MPEP § 2216

- For an SNQ to be present it is only necessary that:
 - Prior art reference(s) raise an SNQ for at least one patent claim - prior art is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim was patentable.
 - For reexamination proceedings filed after November 2, 2002, prior art previously considered by the Office may satisfy the SNQ requirement if considered in a new light.
 - Same question of patentability as to the claim has not been decided by Office or in final holding of invalidity by the federal courts.
 - Prior art rejection by Office based on same or substantially identical prior art reference of the same patent claims, which was never overcome, usually means an SNQ is present. For example, a rejection could arise from a reissue application which was abandoned after rejection of a claim and without disclaiming the patent claim.
 - It is not necessary that a “*prima facie*” case of unpatentability exists as to the claim in order for “a substantial new question of patentability” to be present as to the claim. See - *In re Etter*, 756 F.2d 852, 857 n.5, 225 USPQ 1, 4 n.5 (Fed. Cir. 1985).



Substantial New Question of Patentability MPEP § 2242

Federal court decision on issued patent

- Final holding of validity by the courts - does **not** mean no new question of patentability is present - different standards of proof (“preponderance of evidence” vs “clear and convincing”) and different standard of claim construction during patent term. *In re Trans Texas Holdings Corp.*, 498 F.3d 1290, 83 USPQ2d 1835 (Fed. Cir. 2007).
- Non-final holding of invalidity or unenforceability by the Courts will **not** be controlling on question of whether SNQ is present
- Only **final** holding of invalidity or unenforceability of claim(s) specified by the courts (after all appeals) will be controlling on the Office as to those claims (no SNQ).



Substantial New Question of Patentability *In re Swanson*

- *In re Swanson*, 540 F.3d 1368, 1376 (Fed. Cir. 2008)
- Consideration of a question of patentability in district court or at the CAFC does not prevent the same question of patentability from being a substantial new question of patentability before the USPTO in reexamination, since different rules and standards apply.
- Following the amendment to 35 U.S.C. § 303(a), previously considered references may be applied in a new light to form a substantial new question of patentability. This might include (as in the facts of *Swanson*) where the reexamination considers the previously-considered reference for a different teaching or purpose than in the initial USPTO examination.



Decision Ordering *Ex Parte* Reexamination MPEP § 2246

- 37 CFR 1.525 - Order
 - If SNQ exists, the determination will include an order for *ex parte* reexamination of the patent.
 - The prior notice in the *Official Gazette* will be considered to be constructive notice and reexamination will proceed.
 - The examiner must identify at least one SNQ and explain how the prior art raises such a question with respect to at least one claim.
 - No rejection of a claim should be included in the order, but all issues identified in the request should be addressed.



Identification of Issues in the Order MPEP § 2246

- For each SNQ identified, the decision should state:
 - The prior art which adds some new teaching to at least one claim.
 - What the new teaching is.
 - The claims that the new teaching is directed to.
 - That the new teaching was not previously considered nor addressed in a prior examination of the patent or a final holding of invalidity by the Federal Courts.
 - That the new teaching is such that a reasonable examiner would consider it important in deciding to allow the claim being considered.
 - When a question of priority is raised (*i.e.* date of prior art vs. patented claim), explain why the prior art is deemed to be available against patent claims.



Denying a Request for Reexamination MPEP § 2247

- If no new question of patentability is raised by the request, reexamination is denied.
- Indicate for each prior art reference why the citation is:
 - Cumulative to the teachings of the art cited in earlier concluded examination of the patent;
 - Not available against the claims; or
 - Not important to a reasonable examiner in determining patentability.
- Requester has one month after the determination denying the request for reexamination to file a petition under 37 CFR §§ 1.515(c) and 1.181 for review of the determination.
- A petition decision affirming the denial of the request is final and non-appealable.
- If no petition is filed, the reexamination is “terminated.”



Patent Owner's Statement

35 U.S.C. § 304

- Except as provided for in 37 CFR § 1.510(e), no premature statement or response will be acknowledged or considered in the determination of the request
- If *ex parte* reexamination is ordered, the decision will set a period of two months in which patent owner may file a statement or amendment of claims (optional).
- Pilot program for waiver of Patent Owner's Statement in *Ex Parte* Reexamination currently ongoing, and the Office considering making the pilot permanent.



Third Party Requester's Reply MPEP § 2251

- A requester may reply to patent owner's statement (if one is filed) within two months of owner's service date.
- The reply is not limited to issues raised in patent owner's statement.
- If no owner's statement is filed, no requester's reply is permitted.
- After reply period, no further requester-filed papers are permitted; any further papers will not be considered or entered in the reexam file.



Decision Ordering *Inter Partes* Reexamination MPEP § 2646

- For each SNQ identified, the decision should state:
 - The prior art which adds some new teaching to at least one claim.
 - What that new teaching is.
 - The claims that the new teaching is directed to.
 - That the new teaching was not previously considered nor addressed in a prior examination of the patent or a final holding of invalidity by the Federal Courts.
 - That the new teaching is such that a reasonable examiner would consider it important in deciding to allow the claim being considered.
 - When a question of priority is raised (i.e. date of prior art vs. patented claim) explain, why the prior art is deemed to be available against patent claims.



Decision Denying *Inter Partes* Reexamination MPEP § 2647

- The decision denying the request will indicate, for each patent or publication cited in the request, why the citation:
 - Cumulative to the teachings of the art cited in earlier concluded examination of the patent;
 - Not available against the claims; or
 - Not important to a reasonable examiner in determining patentability,
 - Is one which was cited in the record of the patent and is barred by the guidelines set forth in MPEP § 2642, subsection II.A.
- Requester has one month after the determination denying the request for reexamination to file a petition under 37 CFR §§ 1.927 and 1.181 for review of the determination.
- A petition decision affirming the denial of the request is final and non-appealable.
- If no petition is filed, the reexamination is “terminated.”



Form & Content of Office Action *Ex Parte* Reexamination MPEP § 2262

- The examiner's FAOM should be so complete that the second Office action can properly be a final action. See MPEP § 2271 Final Action.
- If one or more claims are considered to be allowable, the examiner should indicate why the claims(s) are clearly patentable in a manner similar to that used to indicate reasons for allowance. See MPEP § 1302.14.
- The FAOM should respond to the substance of each argument raised by the patent owner and requester.



Scope of *Ex Parte* Reexamination 37 CFR § 1.552 & MPEP § 2258

- The reexamination proceeding provides a complete reexamination of the patent claims on the basis of prior art patents and printed publications.
- 35 U.S.C. § 112 issues are not raised with regard to original (unamended) patent claims.
 - **New claims** as well as **amended patent claims** may be considered for § 112 first and second paragraph issues.
- Claims may not be broader than those of the original patent. See 35 U.S.C. § 305.



Response Time in *Ex Parte* Reexamination MPEP § 2263

- A shortened statutory period of two (2) months will be set for response to Office actions.
 - Exception: where the reexamination (1) results from a court order or (2) litigation is stayed (suspended) for the purpose of reexamination, the shortened statutory period will be set at one (1) month.
 - See MPEP § 2263 for additional exceptions.



Extensions of time in *Ex Parte* Reexamination MPEP § 2265

- A request for an extension of time must be filed on or before the day on which action by the patent owner is due.
- A request for an extension of time must be for a reasonable amount of time and show sufficient cause for the extension. See 37 CFR § 1.550(c).
 - The provisions of 37 CFR § 1.136(a) are NOT applicable to reexamination proceedings.
- There is a \$200 fee for review of a request for an extension of time. 37 CFR § 1.17(g).



Improper Papers Denied Entry in *Ex Parte* Reexamination MPEP § 2267

- The active participation of a third party requester ends with the third party requester reply, pursuant to 37 CFR § 1.535. Any further submission on behalf of or by the third party requester will not be placed in the reexam file. 37 CFR § 1.550(g).



Final Action *Ex Parte* Reexamination MPEP § 2271

- It is intended that the second Office action in the reexam proceeding, which follows the decision ordering the reexam, will be a final Office action in accordance with the guidelines set forth in MPEP § 706.07(a).
- The examiner and the patent owner should identify and develop all issues prior to the final Office action.
- Normally a shortened statutory period of two* months is given for response to a final Office action. See MPEP § 2272. *See MPEP § 2263 for exceptions.
- A “patentability review conference” consisting of three people will be convened to review a final action before it is issued.
 - A patentability review conference is also convened just prior to issuing a Notice of Intent to Issue Reexamination Certificate (NIRC)



After Final Practice *Ex Parte* Reexamination MPEP § 2272

- Consideration of amendments after final follow the standards of 37 CFR § 1.116.
- An amendment after final should be given consideration if:
 - The total effect of the amendment is to cancel claims or comply with any requirement of form expressly set forth in a previous Office action, or present rejected claims in better form for consideration on appeal;
 - For an amendment touching the merits of the patent under reexamination, the patent owner provides a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.



Advisory Action Practice in *Ex Parte* Reexamination MPEP § 2272

- A timely first response to a final rejection will automatically result in a one month extension of the shortened statutory period (if a notice of appeal has not yet been filed).
- If the advisory action is delayed, the time period should be extended, *e.g.*, by an additional month, to provide the patent owner with sufficient time to respond. The response period may not be extended to run beyond the six-month statutory period.



First Office Action *Inter Partes* Reexamination MPEP § 2660

- 37 CFR § 1.935. Initial Office action usually accompanies order for *inter partes* reexamination.
- If all claims are found patentable in first action, examiner will issue an Action Closing Prosecution (ACP).
- Where one or more claims are rejected in the first Office action on the merits, a non-final action is mailed. This is same as in *ex parte* reexamination, except that *inter partes* reexamination forms and form paragraphs are used.
- Patent owner and requester will each be sent a copy.



First Office Action *Inter Partes* Reexamination MPEP § 2660 (cont.)

Compact Prosecution:

- The first Office action is intended to be the primary action to establish all issues that exist. Therefore, patent owner and any third party submissions should place the proceeding in condition for issuing an ACP in the second Office action.
- Comprehensive reasons for patentability must be given for each determination favorable to patentability of claims. See MPEP § 1302.14.
- Must address each issue raised by requester as “adopted” or “not adopted,” and must respond to substance of each argument of requester.
- Must state why rejection proposed by requester is not appropriate if not adopting it.
- Clearly set forth each ground of rejection and/or ground of objection, and the reasons supporting the ground(s).



First Office Action *Inter Partes* Reexamination MPEP § 2660 (cont.)

- Clearly indicate reasons why the rejection proposed by the third party requester is not appropriate for each rejection proposed by the third party requester that the examiner refuses to adopt.
- Clearly set forth each determination favorable to the patentability of claims.
- Address any issues independent of the request, *e.g.*, examiner's rejections based on prior art (titled "Additional Rejections").
- Ordinarily no amendment to address in first Office action – thus no 35 U.S.C. § 112.
- "Special dispatch" – issue ACP at the earliest possible time.
- Caution patent owner for complete response.
- Caution patent owner on requirements of 37 CFR § 1.116(b) (use form paragraphs 26.05 and 26.73 at end of action).



Patent Owner Response *Inter Partes* Reexamination MPEP § 2666

- Response to a non-final Office action - 37 CFR §1.111(a)(1):
 - If Office action is adverse in any respect, patent owner must reply and request reconsideration or further examination with or without an amendment.
- Substance of the Response
 - Request for reconsideration of position must be in writing and distinctly and specifically point out each supposed error in examiner's action (general allegations inadequate).
 - Patent owner will normally be given **two months** to respond
 - Amendments must be in compliance with 37 CFR §§ 1.530(d)-(k) and 1.943. See 37 CFR § 1.941.



Patent Owner Response *Inter Partes* Reexamination MPEP § 2666 (cont.)

- Response to a non-final Office action - 37 CFR § 1.111(a)(2):
 - A supplemental response will not be entered as a matter of right, except as provided in 37 CFR § 1.111(a)(2)(ii) (during a suspension period).
- The Office may enter a supplemental response if the supplemental response is clearly limited to:
 - Cancellation of a claim(s); Adoption of the examiner suggestion(s); Placement of the application in condition for allowance; Reply to an Office requirement made after the first reply was filed; Correction of informalities (e.g., typographical errors); or Simplification of issues for appeal.
- If patent owner wishes to have an unentered supplemental response considered by the examiner, the patent owner must include its contents in a proper response to a subsequent Office action.



Patent Owner Amendments

37 C.F.R. 1.530 & MPEP 2666.01

Making amendments:

(1) Specification (not claims)

- Changes must be made by submission of entire text of added or rewritten paragraph including markings pursuant to 37 CFR 1.530(f).

(2) Claims

- Entire text of each patent claim must be included.
- Parenthetical expression (“amended,” “new”) should follow claim numbers.
- Claims must include markings pursuant to 37 CFR 1.530(f).

(3) Drawings

- Changes must be submitted as a sketch on separate paper showing proposed changes. Figures must be identified as amended, new, etc.

(4) Formal requirements other than those set out in 37 CFR 1.530 are set forth in 37 CFR 1.52.



Patent Owner Amendments

37 C.F.R. § 1.530 & MPEP § 2666.01 (cont.)

- Claims cannot be broadened – 35 U.S.C. §§ 305 and 314.
- No enlargement of scope broader than broadest patent claim.

See *In re Freeman* 30 F. 3d 1459, 1464, 31 USPQ2d 1444, 1447 (Fed Cir 1994).

- No new matter can be introduced - 35 U.S.C. §§ 112 and 132.
- No amendment other than cancellation will be incorporated into the patent by a certificate Issued after expiration of the patent.
- Amendments are not effective until reexamination certificate issues.



Inter Partes Third Party Comments After Owner Response MPEP § 2666.05

- 37 CFR § 1.947 Timeliness
 - By statute each time patent owner files a response to an Office action on the merits, a third party requester may **once** file written comments **within 30 days from the date of service** of the patent owner response. 35 U.S.C. § 314(b)(2).
 - Written comments by third party will be considered received by the Office as of date of deposit specified in certificate (mailing or transmission) under 37 CFR § 1.8.
- 37 CFR § 1.948 Limitations on Prior Art by Third Party.
 - May only cite new prior art under 37 CFR § 1.501, if filed as part of a comments submission under 37 CFR §§ 1.947 or 1.951(b) and limited to prior art:
 - which is necessary to rebut a finding of fact by the examiner
 - which is necessary to rebut a response of the patent owner
 - which for the first time became known or available to the third party requester after request filing date



Inter Partes Third Party Comments After Owner Response MPEP § 2666.05 (cont.)

- Comments by third party requester must be directed to points and issues covered by Office action and/or owner's response:
 - (A) Set forth point or issue.
 - (B) State the page of the Office action and/or the patent owner response where the point or issue is recited.
 - (C) Present third party requester's discussion and argument as to the point or issue.
 - If the above is **not** done, the comments should **not** be held defective **if** the examiner can ascertain all comments are directed to issues and points in Office action and/or owner's response.



Action Closing Prosecution MPEP § 2672

Right of Appeal Notice MPEP § 2673.01

- A response to an ACP is **not** required.
 - If no response to ACP is filed by patent owner:
 - No third party requester comments are permitted, and
 - A Right of Appeal Notice (RAN) is prepared.
 - Patent Owner Response to ACP:
 - Triggers Third Party Comment right, and
 - Amendments and evidence not entered as a matter of right.
 - Right of Appeal Notice may issue, and in rare situations, prosecution maybe reopen MPEP § 2673.
- Right of Appeal Notice and Appeal MPEP § 2764
 - Issuance of RAN triggers appeal rights for parties.
 - Each party has thirty days to file a Notice of Appeal.
 - An opposing party who has not appealed may file a Notice of Cross Appeal within fourteen days from an appealing party's Notice of Appeal.



Reexamination Appeals and Issuance of a Reexamination Certificate

- Reexamination at the Board of Appeals and Interferences
 - Dedicated group at BPAI decides all *Inter partes* reexamination appeals
 - BPAI reviews all appeals briefs for regulatory compliance.
- Notice of Intent to Issue Reexamination Certificate (NIRC)
 - Upon conclusion of proceedings an NIRC is issued.
 - Issued when no response is submitted, appeal is not taken, failure to file appeal briefs, final decision from BPAI that is not appealed, and after the Federal Court appeal process is complete.
MPEP 2287, 2687
- Certificate Publication
 - Sets forth the result of the proceeding listing claims canceled, confirmed, newly added, amended, or not reexamined; changes to the description, statutory or terminal disclaimers and identify unamended claims held invalid on a final holding by another forum on any grounds. MPEP 2288, 2688



Duty of Disclosure During Reexamination 37 C.F.R. § 1.555(b)

- Information is material to patentability in a reexamination proceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and
 - (1) **It is a patent or printed publication** that establishes, by itself or in combination with other patents or printed publications, a *prima facie* case of unpatentability of a claim; or
 - (2) It refutes, or is inconsistent with, a position the patent owner takes in:
 - (i) Opposing an argument of unpatentability relied on by the Office, or
 - (ii) Asserting an argument of patentability.
- Confidential Material maybe submitted per MPEP § 724.02.
- For information covered by protect orders see: Memorandum Order, March 31, 2009, *TeleCommunication Systems, Inc. v. Mobile 365, Inc.*, C.A. No. 3:06CV485; Control No. 95/000353.



Statistical Information *Ex Parte* and *Inter Partes* Reexamination

- *Ex parte* and *inter partes* historical statistics and reexamination operational statistics are available on the USPTO web site, www.uspto.gov.
- Specific web page address:
http://www.uspto.gov/patents/stats/Reexamination_Information.jsp



Thank You