

INTER PARTES REEXAMINATION

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I. Introduction

A. Scope Of This Text

This project was born of the need for a comprehensive guide to practice before the Patent Office in *inter partes* reexamination. The law governing *inter partes* reexamination is found not only in the statutes and rules, but also in hundreds of published but unreported day-to-day decisions of the Patent Office. Even to those who have directly experienced an *inter partes* reexamination, these decisions can appear as a vast, unfamiliar ocean of customary law.

This text is intended as a navigational guide to that ocean. It is based on the author's hopefully painstaking, and certainly painful, review of the *inter partes* reexamination files, as reflected in the online PAIR database.¹ This review revealed not only Patent Office practice, but also where practitioners typically go wrong. There are numerous simple mistakes that are committed with heartbreaking predictability in *inter partes* reexamination proceedings. These mistakes are often avoidable with proper knowledge of Patent Office practice.

The purpose of the guide is not to parrot the rules and Patent Office guidance, but a certain amount of this is unavoidable. Take the careful explanation of claim amendment markings presented in section VII.E.7. These procedures are relatively simple, and adequately set forth in the rules and the MPEP. Yet read the first few *inter partes* reexamination files and the absolute necessity of further explanation will be apparent (over twenty amendments returned for a failure of form in the forty cases).²

This is a work in progress. The author would be glad to hear from practitioners who wish to share their experiences in *inter partes* reexaminations or provide comments on the text.

B. Overview Of *Inter Partes* Reexamination

1. What Is *Inter Partes* Reexamination?

Inter partes reexamination is a United States Patent and Trademark Office ("Patent Office") administrative proceeding to challenge the validity of patents that have already issued. In *inter partes* reexamination, a person challenges the patent by submitting a "request" to the Patent Office. The request must supply prior art references and make proposed rejections of

¹ PAIR is an acronym for the U.S. Patent & Trademark Office's Web-based "Patent Application Information Retrieval" system. PAIR, although rarely 100% accurate, is a remarkable improvement in patent file access for which the Patent Office should be commended, and without which this book would not have been possible. *Inter partes* reexamination files may be accessed by their control numbers, which currently take the form 95/xxxxxx, where "x" represents a number. The first *inter partes* reexamination had control number 95/000001, the second 95/000002, and so forth.

² Based on the author's own review of *inter partes* reexamination proceedings.

the claims. The request is assigned to a patent Examiner in the Central Reexamination Unit (“CRU”) of the Patent Office. The Examiner decides whether the request raises a “substantial new question of patentability”, and if so, begins an *inter partes* reexamination proceeding.

After the reexamination is granted, the Examiner will typically issue a non-final office action rejecting one or more of the claims. The Patent Owner may file a response, which can amend the claims to avoid prior art, and add new claims. Within one month of the service date of the Patent Owner’s response, the Third Party Requester may file comments. The Examiner will then consider the filings and issue an “Action Closing Prosecution”. The Action Closing Prosecution is not “final” in the sense that it may be appealed, but does place restrictions on the ability of the Patent Owner to amend the claims. The Patent Owner may respond to the Action Closing Prosecution and if it does so, the Third Party Requester may again file comments. A “Right Of Appeal Notice” typically follows. The “Right of Appeal Notice” is a final, appealable office action. From there, either party may appeal the decision to the Patent Office Board of Appeals and Interferences (“Board”) and then to the Court of Appeals for the Federal Circuit (“Federal Circuit”).

While the Patent Owner may amend claims in *inter partes* reexamination, the Patent Owner may not broaden the scope of the patent. If narrower new or amended claims are allowed, strong intervening rights are likely to attach. Where such rights attach, all past damages are eliminated, even if an accused product or method would infringe both the original and amended claims.

2. History

November 29, 2008, marked the ninth anniversary of the availability of the *inter partes* reexamination proceeding. In the past nine years, the *inter partes* reexamination has found acceptance among a small but growing class of Third Party Requesters.³ The atmosphere of uncertainty which once surrounded this proceeding, with its foreboding and untested estoppel provisions,⁴ has now been somewhat dispelled.

In the late 1990s, elements of Congress introduced reforms to the patent system. Some of the reforms were intended to deal with the underutilization of *ex parte* reexamination as

³ See section II, *infra*.

⁴ See United States Patent and Trademark Office, Transcript of Round Table Meeting: The Equities Of Inter Partes Reexamination Proceedings, at 30 (Feb. 17, 2004) <http://www.uspto.gov/web/offices/pac/dapp/opla/comments/reexamproceed/round_tbl_transcript.pdf>(identifying the estoppel provisions of 35 U.S.C. § 315(c) as the single greatest inhibitor of *inter partes* reexamination); PAN, S.P., *Considerations for Modifying Inter-Partes Reexam And Implementing Other Post-Grant Review*, 45 IDEA 1, 10-13 (2004); CHIANG, J.T., *The Advantages of Inter Partes Reexamination*, 90 J. Pat. & Trademark Off. Soc’y 579, FN 1 (2008)(citing two second-hand sources indicating that it would be legal malpractice to recommend *inter partes* reexamination to a client).

a vehicle to test the validity of issued patents.⁵ The *ex parte* reexamination process had been conceived to provide: (i) a more expeditious and less expensive resolution of validity disputes than litigation; (ii) involvement of the Patent Office and its expertise in validity disputes; and (iii) the reinforcement of “investor confidence in the certainty of patent rights” by allowing the Patent Office to review doubtful patents.⁶

Despite a relatively successful two-decade showing of the *ex parte* reexamination proceeding, a number of experts identified concerns that made the proceeding a potentially unattractive alternative to district court litigation.⁷ Chief among these was the sense that a capably represented Patent Owner, in possession of a litigation-type budget, could tilt the odds too heavily in its favor, potentially strengthening a questionable patent without making it any less questionable.⁸ A Third Party Requester had no option but to dump its prior art in front of

⁵ See Conference Report on HR 1554, Intellectual Property And Communications Omnibus Reform Act of 1999, 145 Cong. Rec. H11769, H11804 (Nov. 9, 1999), *hereinafter* “Conference Report on HR 1554”.

⁶ See *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 602 (Fed. Cir. 1985).

⁷ See, e.g., Conference Report on HR 1554, 145 Cong. Rec. H11769, H11804 (Nov. 9, 1999) (“[The Optional Inter Partes Reexamination Act] is intended to reduce expensive patent litigation in U.S. district courts by giving third-party requesters, in addition to the existing *ex parte* reexamination in Chapter 30 of title 35, the option of inter partes reexamination proceedings in the USPTO. Congress enacted legislation to authorize *ex parte* reexamination of patents in the USPTO in 1980, but such reexamination has been used infrequently since a third party who requests reexamination cannot participate at all after initiating the proceedings. Numerous witnesses have suggested that the volume of lawsuits in district courts will be reduced if third parties can be encouraged to use reexamination by giving them an opportunity to argue their case for patent invalidity in the USPTO.”)

⁸ See, e.g., United States Patent And Trademark Office, *Report To Congress On Inter Partes Reexamination*, p. 2, (2004) <http://www.uspto.gov/web/offices/dcom/olia/reports/reexam_report.htm> (“Subsequent Congressional review indicated infrequent use of *ex parte* reexamination, primarily because a third party who requested reexamination was unable to participate in the examination stage of the reexamination after initiating the reexamination proceeding. Interested parties suggested that the volume of lawsuits in the Federal District Courts would be reduced if third parties were encouraged to, and able to, use reexamination procedures that provided an opportunity for them to present their case for patent invalidity at the USPTO during the examination stage of the proceeding. To address those concerns and provide such an opportunity, Congress enacted the ‘Optional Inter Partes Reexamination Procedure Act of 1999’ as Subtitle F of the ‘American Inventors Protection Act of 1999’ (AIPA.)”); GOLDMAN, M.L., *The New Option Inter Partes Reexamination Procedure And Its Strategic Use*, 28 AIPLA Q.J. 307, 314 (2000) (“prosecution was thereafter *ex parte*, with the attendant risk to the patent challenger that the ‘antlike persistence’ [footnote omitted] of the patentee and his solicitor would result in a favorable patentability ruling over art the patent challenger might rely on in U.S. district court.”).

the Examiner, and hope that he or she would have the legal and technical insight to persevere against experienced advocates with a better awareness of the overall context.⁹

Congress attempted to answer these concerns by enacting the Optional Inter Partes Reexamination Act.¹⁰ A number of features were notable at the inception. Aside from the obvious third-party participation, the most prominent landmark from a practitioner's perspective was 35 U.S.C. § 315(c), which placed limitations on an unsuccessful Third Party Requester's ability to present a prior art defense in later litigation. This provision was so intimidating at the outset that some practitioners asserted it would be malpractice to recommend filing a request for *inter partes* reexamination.¹¹

The *inter partes* reexamination statutes envisioned a cross-estoppel that would prevent parallel resolution of validity issues by courts and the Patent Office. If the Third Party Requester lost in court, it would not be able to pursue an *inter partes* reexamination.¹² If the Third Party Requester lost in the *inter partes* reexamination, it would not be able to pursue a defense of invalidity in court.¹³ These provisions were put into place "to guard against harassment of a patent holder."¹⁴

The *inter partes* reexamination did, however, put in place procedures to limit the Patent Owner's power to influence the proceedings. The Third Party Requester had a right of comment for every substantive Patent Owner response, effectively getting a last shot at the Examiner. Implementing regulations also eliminated Examiner interviews, one of the preferred

⁹ See, e.g., CANNUSCIO, R.E., *Optional Inter Partes Reexamination: A Practitioner's Perspective*, ALI-ABA COURSE OF STUDY, November, at 78-79 (2000).

¹⁰ See Public Law 106-113 . The Act was part of the American Inventors Protection Act, passed on November 29, 1999 as S.R. 1948 (106th Cong. First Sess., 1999) by a line item in the Intellectual Property and Communications Omnibus Reform Act of 1999; see also 95/000093 (2005-08-23 Petition Decision, pp. 3-5); *Cooper Technologies Co. v. Dudas*, 87 U.S.P.Q.2d 1705, 1706 (Fed. Cir. 2008) ("The AIPA created the *inter partes* reexamination procedure to allow third parties to have an expanded role in the reexamination of issued patents. See Optional Inter Partes Reexamination Procedure Act of 1999, Pub. L. No. 106-113, §§ 4601-08, 113 Stat. at 1501A-567 to -572 (codified as amended at 35 U.S.C. §§ 311-18); see also 145 Cong. Rec. S13259 (Oct. 27, 1999) (statement of Sen. Hatch) (remarking that AIPA was designed to "make reexamination a viable, less-costly alternative to patent litigation by giving third-party requesters the option of *inter-partes* reexamination procedures" in which they are "afforded an expanded, although still limited, role in the reexamination process").

¹¹ See, e.g., CHIANG, J.T., note 4, *supra*.

¹² See 35 U.S.C. § 317(b).

¹³ See 35 U.S.C. § 315(c).

¹⁴ Conference Report on HR 1554, 145 Cong. Rec. H11769, H11805 (Nov. 9, 1999).

weapons of choice in the Patent Owner *ex parte* reexamination arsenal.¹⁵ The Third Party Requester had a right of appeal to the Patent Office Board of Appeals and Interferences.

Amendments to the statute in 2002 added the right of the Third Party Requester to appeal from a decision of the Patent Office Board, or to participate in the Patent Owner's appeal.¹⁶ Previously, the Third Party Requester had only the right to appeal to the Patent Office Board, but not beyond.¹⁷ The amendments also made several technical clarifications.¹⁸ Section 311 was amended, for example, to specify that an *inter partes* reexamination could not be requested by the Patent Owner.¹⁹

In the past nine years, over four hundred *inter partes* reexaminations have been requested. The manner in which these proceedings have been administered, as well as their results, are described in this book.

C. Notable Features As Compared to *Ex Parte* Reexamination

The *inter partes* reexamination proceeding differs markedly from the *ex parte* reexamination. These differences are summarized here.

1. Visibility

An *inter partes* reexamination may not be requested anonymously.²⁰ This is at times a disadvantage as compared to *ex parte* reexamination. Any request for reexamination is a billboard to advertise the underlying concerns of the Third Party Requester, but with *inter partes* reexamination, the billboard also has the name and address of the Third Party Requester.

While there are many reasons for filing a request for reexamination that do not implicate a Third Party Requester's concern as to its own infringement, the request will at least prompt many Patent Owners to investigate the question. Because of this, the author suspects that practitioners will deemphasize *inter partes* reexamination filings where there is a chance that the

¹⁵ See 37 C.F.R. § 1.955.

¹⁶ See the Patent and Trademark Office Authorization Act of 2002, enacted as part of Public Law 107-273 on November 2, 2002.

¹⁷ See *Changes to Implement the 2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute*, 68 Fed. Reg. 70996, 70997 (Dec. 22, 2003).

¹⁸ See *Changes to Implement the 2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute*, 68 Fed. Reg. 70996, 70997 (Dec. 22, 2003).

¹⁹ See *Changes to Implement the 2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute*, 68 Fed. Reg. 70996, 70997 (Dec. 22, 2003).

²⁰ See 37 C.F.R. § 1.915(b)(8).

Third Party Requester is not the focus of the Patent Owner's attention. Instead, *inter partes* reexamination is likely to be more frequently used where the Third Party Requester is already a target of the Patent Owner and where the avoidance of further provocation is not an issue.

2. Third Party Participation

In contrast to *ex parte* reexamination, the Third Party Requester in an *inter partes* reexamination has a right to participate in the proceedings after filing the request. This participation may be exercised in several ways, including (1) by filing comments on substantive submissions of the Patent Owner;²¹ (2) by filing, together with comment documents, evidence to rebut evidence of the Patent Owner or findings of the Examiner;²² (3) by submitting further prior art under limited circumstances;²³ (4) by filing petitions;²⁴ and (5) by filing an appeal and/or participating in the Patent Owner's appeal to the Patent Office Board and the Court of Appeals for the Federal Circuit.²⁵

Previously, it was also possible in *ex parte* reexamination for the same requester to file multiple requests based on the same questions of validity.²⁶ This allowed a quasi-*inter partes* form of proceeding.²⁷ The Patent Office has since revised its guidance to prevent the

²¹ See section VIII, *infra*.

²² See section VIII.B.2, *infra*.

²³ See section VIII.B.2, *infra*.

²⁴ See section X, *infra*.

²⁵ See 35 U.S.C. §§ 141 and 315.

²⁶ See MPEP § 2240 (2004) (“If a second or subsequent request for reexamination is filed (by any party) while a reexamination is pending, the presence of a substantial new question of patentability depends on the prior art cited by the second or subsequent requester. If the requester includes in the second or subsequent request prior art which raised a substantial new question in the pending reexamination, reexamination should generally be ordered. This is because the prior art which raised a substantial new question of patentability resulting in an order for reexamination continues to raise a substantial new question of patentability until the pending reexamination is concluded.”).

²⁷ See United States Patent And Trademark Office, *Report To Congress On Inter Partes Reexamination*, p. 6 (2004) <http://www.uspto.gov/web/offices/dcom/olia/reports/reexam_report.htm> (“Prior to May of 2004, there was a potential of abusing *ex parte* reexamination practice to effectively obtain an *inter partes* procedure. The availability of this avenue may have deterred parties from filing *inter partes* reexamination requests as follows: A third party could achieve an alternative to *inter partes* reexamination not having any attachment of estoppel (which exists for *inter partes* reexamination, but not for *ex parte* reexamination) by filing multiple, sequential reexamination requests based on the same substantial new question of patentability as the original request.

submission of multiple requests based on the same prior art.²⁸ Now, requesters in *ex parte* proceedings must present a substantial question of patentability that is also new over the prior request.²⁹ Even if this is done, the second request may be the subject of petition review for harassment.³⁰

Although Third Party Requesters may file petitions in *inter partes* reexamination proceedings, there have been indications from the Patent Office that it views the scope of Third Party Requester participation in *inter partes* reexamination as limited to the merits of the proceedings.³¹ This has often taken the form of refusing Third Party Requester papers, and in particular petitions, commenting on formal matters.³²

The author maintains that third part participation has a substantial effect on the reexamination process, and that this effect is manifested in the office-level success rate of Third Party Requesters in *inter partes* reexamination as opposed to *ex parte* reexamination.³³ The participation of the Third Party Requester changes the balance of the proceedings in several ways. First, the Third Party Requester is able to gather evidence and devote time to the examination of the Patent Owner's position using resources not available to the Examiner. Second, the Third Party Requester is able to reinforce the initial rejection in areas where the Examiner may be less than fully confident and where otherwise a well-equipped Patent Owner might make some progress against the position of the Office. Where parties have fought over the competing jurisdiction of *ex parte* reexamination and *inter partes* reexamination, Patent Owners

Thus, the filing of an *inter partes* reexamination request to achieve the increased requester participation result might be avoided. To address this inequity, the Office amended § 2240 of the Manual of Patent Examining Procedure in May 2004.").

²⁸ See MPEP § 2240.II. (2008) ("If the requester includes in the second or subsequent request prior art which raised a substantial new question in the pending reexamination, reexamination should be ordered only if the prior art cited raises a substantial new question of patentability which is different than that raised in the pending reexamination proceeding.").

²⁹ See section V.D.3, *infra*.

³⁰ See MPEP § 2240 (2008).

³¹ See, e.g., *inter partes* reexamination 95/000067 (2008-09-04 Notice, p. 6) ("While enactment of the *inter partes* reexamination statute was for the purpose of expanding a third party requester's participation in the merits of the proceeding, there is no indication whatsoever in the legislative history of the *inter partes* reexamination statute that the requester was granted any right to challenge the granting of a petition for revival in an *inter partes* reexamination proceeding.").

³² See, e.g., *inter partes* reexamination 95/000093 (2005-07-14 Notice, p. 2).

³³ See section II.B., *infra*.

have consistently pushed for an *ex parte* reexamination, whereas the Third Party Requesters have consistently urged an *inter partes* reexamination.³⁴

While an *inter partes* reexamination proceeding offers the Third Party Requester an opportunity to participate, the opportunity can also be a burden. The Examining Corps expects a Third Party Requester to present a decent position, to offer evidence, and to remain on-topic. Where the Third Party Requester fails to be active on these fronts, it runs the risk of strengthening the Patent Owner's position or annoying the Examiner. A poorly represented real party in interest may be better off in *ex parte* reexamination.

3. Interviews

Interviews with the Examiner are used effectively during *ex parte* proceedings. It is far easier for most people, Examiners included, to take questionable positions in writing, seal them in an envelope and forget about them. The possibility of being directly confronted with a request for a deeper explanation tends to motivate Examiners to examine more deeply prior to the confrontation. Furthermore, interviews can be used to establish rapport and credibility with the Examiner—to show that what might otherwise seem like a “paper patent” is supported by qualified people and a real-world technology.

The interviews that are used with effect in *ex parte* proceedings are highly restricted in an *inter partes* reexamination. Rule 1.955 states that “[t]here will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.”³⁵ This rule applies to both *ex parte* and *inter partes* interviews, and limits the effect of interviews in all but the rarest of proceedings. In practice, the Patent Office is very conscious of this restriction, and will even sometimes avoid discussion of specific cases altogether unless there is some prior assurance that the merits will not be mentioned. It is the occasional practice of the Patent Office to consider any contact with the office (whether with the assigned Examiner or someone else) regarding a specific case as a type of interview for which the requirements of rule 1.955 need to be observed.

Interviews do occasionally take place in *inter partes* reexamination proceedings, however. These are generally limited to interviews concerning formalities, or a few relatively rare procedural occurrences that allow interviews on the merits.

(a) Interviews On Formalities

Rule 1.955 only prohibits interviews that discuss the merits of the case. The phrase “on the merits” is officially interpreted by the Patent Office more broadly than most practitioners would expect. Officially, “on the merits” means “not available from reading the

³⁴ See, e.g., *Cooper Technologies Co. v. Dudas*, 87 U.S.P.Q.2d 1705, 1706 (Fed. Cir. 2008); *Alcatel USA Resources, Inc. v. Dudas*, Case No. 1:06-cv-01089-LMB-TRJ (E.D.Va.); *inter partes* reexamination 95/000093 (2006-03-22 Petition Decision, p. 3).

³⁵ 37 C.F.R. § 1.955.

file.”³⁶ As an example, the MPEP states that asking the Examiner when the next office action will be mailed is improper, because it is not available from reading the file, and thus is a question directed to the merits.³⁷

In reality, interviews relating to formalities are often carried out *ex parte*, even when the information sought is not ascertainable from the file.³⁸ The CRU and the Office of Patent Legal Administration (“OPLA”) will generally allow inquiries into procedural matters if it is clear that the inquiries are not substantive in the traditional sense. The CRU will also initiate *ex parte* interviews on subjects that, while they relate to matters most people would consider procedural, are not limited to things ascertainable in the file. The best example of this is probably the CRU’s tendency to call either party if the party did not file a document as expected based on a deadline.³⁹ Such exceptions can not be relied upon as a general repudiation of the relevant MPEP section defining “on the merits”, however, because the Patent Office will also limit interviews on seemingly procedural matters in some cases.⁴⁰

³⁶ See MPEP § 2685. The file likely means the internal file kept by the PTO, not the information available on PAIR, which is known to be inaccurate.

³⁷ See MPEP § 2685.

³⁸ See, e.g., *inter partes* reexamination 95/000027 (2007-09-28 Interview Summary)(the Patent Office called the Patent Owner to ask whether a response to an Action Closing Prosecution was being filed); *inter partes* reexamination 95/000146 (2006-06-19 Letter, p. 1)(indicating that a conversation with a Patent Office employee was held about formalities); *inter partes* reexamination 95/000147 (2006-09-08 Request, p. 2)(same); *inter partes* reexamination 95/000035 (2007-10-03 Letter, p. 1)(conversation between Examiner and Third Party Requester held on whether Patent Owner had filed appeal brief); *inter partes* reexamination 95/000135 (2007-03-28 Letter)(indicating that a conversation with a Patent Office employee was held about formalities).

³⁹ See, e.g., MPEP § 2666.06 (“Where no proof of service is included, the Central Reexamination Unit (CRU) may contact the party making the submission by telephone to see whether the indication of proof of service was inadvertently omitted from the party’s submission (however, there was actual service).”).

⁴⁰ See, e.g., *inter partes* reexamination 95/000145 (2006-10-26 Petition Decision, p. 2) (“As noted above, patent owner has not submitted the requisite petition fee. Due to the nature of an *inter partes* reexamination proceeding, it would not be appropriate to telephone the patent owner to authorize charging of the petition, since that would be an *ex parte* communication with the patent owner in the present *inter partes* proceeding. Therefore, the present patent owner petition is dismissed for failure to pay the required \$400.00 petition fee.”); see also MPEP § 2666.30.I. (“It should be noted that the patent owner cannot simply be notified by telephone that the omission must be supplied within the remaining time period for response. This notification would be an interview, and interviews are prohibited in *inter partes* reexamination. 37 CFR 1.955.”).

(b) Interviews On The Merits

In the vast majority of *inter partes* reexaminations, interviews going to the substance of case do not occur. The prohibition against interviews on the merits has its limits, however, and in the past such interviews have occurred in two types of cases. First, because the restriction on interviews is not a statutory requirement, the Patent Office is entitled to waive rule 1.955 and allow interviews. Second, rule 1.955 only prevents interviews “in an *inter partes* reexamination proceeding”. Interviews in other, related, proceedings are not prohibited by rule 1.955.

An interview may be obtained by filing a petition under 37 C.F.R. § 1.183 to waive rule 1.955. The Patent Office has waived rule 1.955 in at least three instances. In *inter partes* reexaminations 95/000142, 95/000274 and 95/000283, the Patent Office waived the requirements of 37 C.F.R. § 1.955 because the Third Party Requester indicated in a letter that it did not intend to further participate in the *inter partes* reexamination. In *inter partes* reexamination 95/000142, for example, the Patent Office granted an interview, reasoning:

In this instance, the RPI for the third party requester...has stated on the record that it will not further participate in the ‘142 *inter partes* reexamination proceeding in way, including in any interview with the examiner. [Requester] has also stated that it supports a waiver of 37 C.F.R. 1.955 that is presently requested by patent owner. Thus, only a single party (patent owner) will now participate in the ‘142 *inter partes* reexamination proceeding, and any interview that might be permitted in the proceeding. Therefore, permitting an interview to be conducted at this point in the ‘142 *inter partes* reexamination proceeding is not anticipated to potentially hinder the ability of the Office to conduct the ‘142 *inter partes* reexamination proceeding with special dispatch, but rather may well assist the Office in expeditiously resolving the proceeding.⁴¹

The Patent Office came up with a long list of requirements for the interview.⁴² First, the Patent Owner was directed to contact the Examiner (ironically to have an interview) to identify the issues to be discussed. The Examiner was directed to consider whether an interview should be conducted according to the standard set for *ex parte* reexamination. One week prior to the interview, the Patent Owner was required to FAX the Examiner a list of the agreed interview topics and any claim amendments to be discussed, and to serve the same on the Third Party Requester. The interview was restricted to one hour, extendable at the discretion of the Examiner, and was to be attended by multiple conferees. At the end of the interview, the

⁴¹ *Inter partes* reexamination 95/000142 (2007-04-17 Petition Decision, p. 2).

⁴² *Inter partes* reexamination 95/000142 (2007-04-17 Petition Decision, p. 4).

Examiner was required to fill out a summary, give a copy to the Patent Owner before the close of the interview, and file and serve a copy to the Third Party Requester.

The Patent Office grant of interviews in 95/000274 and 95/000283 stated simply that the Patent Owner must follow the rules for interviews in *ex parte* reexaminations.⁴³

The Patent Office also allows interviews to occur in *ex parte* cases that are closely related to the subject matter of the *inter partes* reexamination. In *inter partes* reexamination 95/000080, the Examiner conducted an *ex parte* interview in connection with the prosecution of a patent application related to the patent undergoing *inter partes* reexamination. When the Third Party Requester petitioned to have the Examiner replaced for a violation of rule 1.955, the Patent Office dismissed the petition as moot (because the case had already been transferred to a different Examiner), but found along the way that the Examiner had not violated any requirement of the rules:

No evidence has been presented to indicate that [the Examiner] conducted himself in any manner other than a proper manner. The Office notes that the two applications in which the interviews were conducted were not reexamination applications. MPEP § 713.03 makes clear that interviews can be conducted in non *inter partes* reexamination applications.⁴⁴

D. “Estoppel” In *Inter Partes* Reexamination

It is common to refer to the “estoppel” provisions of the *inter partes* reexamination statutes, usually meaning 35 U.S.C. § 315(c). Although section 315 uses the word “estopp”, it is in some cases more accurate to speak of procedural limitations placed on the Third Party Requester, the Patent Owner and the Patent Office at different stages in the *inter partes* reexamination process. The different procedural limitations that can attach are described *infra*.

1. Section 317(a): Limitation Preventing Third Party Requester From Requesting Another *Inter Partes* Reexamination

Once the Third Party Requester has filed a request for *inter partes* reexamination and the request has been granted by the Patent Office, neither the Third Party Requester nor its privies may file a subsequent request for *inter partes* reexamination on the same patent until a reexamination certificate has issued.⁴⁵ This procedural limitation is one reason why Third Party

⁴³ See *inter partes* reexamination 95/000274 (2008-10-06 Petition Decision, p. 8); *inter partes* reexamination 95/000283 (2008-09-17 Petition Decision, p. 8).

⁴⁴ *Inter partes* reexamination 95/000080 (2007-03-30 Petition Decision, p. 8).

⁴⁵ See 35 U.S.C. § 317(a).

Requesters are required to name the “real party in interest” in their applications—so that other potential requesters can evaluate whether they are barred from filing a request.⁴⁶

The limitation, provided in section 317(a), takes effect as soon as reexamination is ordered by the Patent Office.⁴⁷ Thus, if a reexamination request is denied, another request may be filed by the Third Party Requester. The limitation on new requests also does not apply to requests for *ex parte* reexamination, which may be filed while the *inter partes* reexamination is ongoing. The limitation applies for the entire patent,⁴⁸ regardless of the claims for which the *inter partes* reexamination was requested, and regardless of whether all claims are actually examined. Absent special circumstances, it is thus usually wise to request *inter partes* reexamination of all claims in a patent.

A new *inter partes* reexamination request may be filed, however, if authorized by the Director.⁴⁹ In order to seek authorization, the Third Party Requester must file a petition together with the new request for *inter partes* reexamination and the filing fee.⁵⁰ For any such petition to be necessary, the provisions of 35 U.S.C. § 317(a) must be in effect, which means that an *inter partes* reexamination is already pending for that patent. Generally, then, this will mean that the Third Party Requester did not originally request reexamination for certain claims or certain prior art, or that the already instituted proceeding has been suspended or compromised in some other way.

In *inter partes* reexamination 95/000093, the Patent Office entertained a petition under section 317(a).⁵¹ Prior to the original request for *inter partes* reexamination, a district court had held that the Third Party Requester had failed to prove the invalidity of some of the claims of the same patent.⁵² The Third Party Requester then filed its original request for *inter partes* reexamination, requesting reexamination of only the litigated claims plus one additional

⁴⁶ See MPEP § 2612; *inter partes* reexamination 95/000166 (2007-11-09 Petition Decision, p. 9).

⁴⁷ See 35 U.S.C. § 317(a)(requiring that an order for *inter partes* reexamination be issued).

⁴⁸ See 35 U.S.C. § 317(a)(“...neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent...”)(emphasis added).

⁴⁹ See 35 U.S.C. § 317(a).

⁵⁰ See *inter partes* reexamination 95/000093 (2006-03-22 Petition Decision, p. 5).

⁵¹ See *inter partes* reexamination 95/000093 (2006-03-22 Petition Decision, p. 4).

⁵² See *inter partes* reexamination 95/000093 (2006-03-22 Petition Decision, p. 2).

claim.⁵³ The Patent Office suspended the *inter partes* reexamination proceedings pending appeal to the Court of Appeals for the Federal Circuit.⁵⁴ The Third Party Requester then filed requests for *ex parte* reexamination of certain non-litigated claims, and petitioned the Director for authorization to file subsequent requests for *inter partes* reexamination on non-litigated claims, in an apparent attempt to revive the suspended *inter partes* reexamination in another, non-suspended, proceeding.⁵⁵

The Patent Office denied the Third Party Requester's request, finding that the relief requested was "extraordinary", and that the Third Party Requester had another avenue of relief.⁵⁶ Specifically, the Patent Office reasoned that the Third Party Requester could petition the Patent Office to merge the newly ordered *ex parte* reexaminations with the currently pending, but suspended, *inter partes* reexaminations.⁵⁷ The Patent Office also reasoned that, if the Third Party Requester were to lose at the Federal Circuit level, it would have a "final decision", at which point the suspended reexamination proceedings would be terminated, and the Third Party Requester would be free to file a new request as to the non-litigated claims.⁵⁸

When the Third Party Requester petitioned to merge the *ex parte* reexaminations with the suspended *inter partes* reexaminations, however, the Patent Office denied the request. The Patent Office ruled that a party could not circumvent the provisions of 35 U.S.C. § 317 by filing an application for *ex parte* reexamination and then petitioning for merger.⁵⁹

2. Section 317(b): Limitation Preventing Third Party Requester From Filing *Inter Partes* Reexamination After Final Decision

A Third Party Requester or its privy is also prevented from filing a request for *inter partes* reexamination as to a particular claim, if the Third Party Requester or its privy tries

⁵³ See *inter partes* reexamination 95/000093 (2006-03-22 Petition Decision, p. 2). The additional claim was probably added to better position the Third Party Requester to resist the immediate suspension of the *inter partes* reexamination.

⁵⁴ See *inter partes* reexamination 95/000093 (2006-03-22 Petition Decision, p. 3).

⁵⁵ See *inter partes* reexamination 95/000093 (2006-03-22 Petition Decision, p. 3).

⁵⁶ See *inter partes* reexamination 95/000093 (2006-03-22 Petition Decision, p. 5).

⁵⁷ See *inter partes* reexamination 95/000093 (2006-03-22 Petition Decision, p. 5).

⁵⁸ See *inter partes* reexamination 95/000093 (2006-03-22 Petition Decision, p. 6).

⁵⁹ See *inter partes* reexamination 95/000093 (2006-07-03 Petition Decision, p. 9).

and fails to invalidate that claim⁶⁰ before a district court or the Patent Office in an *inter partes* reexamination proceeding.⁶¹

(a) “Final” Decision

The decision that the claim is “not invalid” must be final.⁶² Here, “final” means a judgment or reexamination certificate after all appeals have been exhausted.⁶³ A final district court judgment or Patent Office Board decision will not suffice unless the Third Party Requester or its privy, whichever is the party in the prior proceeding, fails to file an appeal. Usually, a final decision from the Court of Appeals for the Federal Circuit (and, if applicable, a denial of a petition for certiorari⁶⁴) will be required for the limitation to take effect.

A number of petitioners have challenged the Patent Office’s interpretation of “final” at the Patent Office level and lost. The Patent Office relies heavily on a portion of the legislative history that seems to interpret “final decision” to mean “after any appeals”:

if a third-party requester asserts patent invalidity in a civil action and a final decision is entered that the party failed to prove the assertion of invalidity, or if a final decision in an *inter partes* reexamination instituted by the requester is favorable to patentability, after any appeals, that third-party requester cannot

⁶⁰ See 35 U.S.C. § 317(b); *inter partes* reexamination 95/000019 (2003-08-20 Decision p. 3).

⁶¹ See 35 U.S.C. § 317(b); *inter partes* reexamination 95/000019 (2003-08-20 Decision p. 3).

⁶² See 35 U.S.C. § 317(b); *inter partes* reexamination 95/000019 (2003-08-20 Decision p. 3).

⁶³ See MPEP § 2686.04.V.(C).; *inter partes* reexamination 95/000020 (2004-06-02 Petition Decision, p. 8); *inter partes* reexamination 95/000093 (2005-08-23 Petition Decision, p. 6) (“However, as explained below, since the section 317(b) estoppel provision applies only after a ‘final decision’ by the Federal Circuit, the Office cannot dismiss the litigated claims from the two *inter partes* reexamination proceedings at this time.”); *inter partes* reexamination 95/000093 (2005-08-23 Petition Decision, p. 9) (“As earlier explained, the statutory scheme creates a reciprocal estoppel effect, and the term ‘final decision,’ is used equally in reciprocal fashion in the same statutory clause applied to both *inter partes* reexamination proceedings and civil actions. Accordingly, the legislative history confirms, rather than detracts from, the Office’s interpretation of ‘final decision’ as ‘after all appeals.’”).

⁶⁴ See *inter partes* reexamination 95/000020 (2005-11-30 Petition Decision, p. 12).

thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised. (emphasis added)⁶⁵

The Patent Office has consistently dismissed petitions to terminate an *inter partes* reexamination based on the application of 35 U.S.C. § 317(b) to an appealable district court judgment, and terminated *inter partes* reexaminations where the judgment is not appealable.⁶⁶ The author is not aware of any district court that has examined the issue.

The term “final” has also been applied to exclude situations where the Federal Circuit has rendered an appeal decision, but remanded to the district court for further proceedings, even if those proceedings are only tangentially related to validity.⁶⁷ In *NTP v. RIM*, for example, the Court of Appeals For The Federal Circuit disposed of all issues affecting validity, but remanded on the question of infringement. Patent Owner NTP petitioned to terminate the co-pending *inter partes* reexamination proceedings. The Patent Office, while acknowledging that the decision had disposed of the validity issues,⁶⁸ still denied the petition, reasoning:

[I]t appears from the Federal Circuit's replacement August 2, 2005 decision that the issue remanded to the District Court directly bears on the interpretation of a claim limitation appearing in claim 40 of the '592 patent. Presumably, the District Court's construction of the limitation, on remand, will affect issues directly bearing on the '020 *inter partes* reexamination proceeding, and the merged proceeding as a whole. Thus, Petitioner has not shown that there is a "final decision" with respect to the claim validity issue raised in the *inter partes* reexamination, Petitioner has not demonstrated that RIM will be unable to obtain a different outcome (from the initial District Court finding) regarding the interpretation of one or more of the claims of the '592 patent, and that a different interpretation would not necessarily require that the Court revisit the issue of the validity of the involved claim or claims.⁶⁹

⁶⁵ See 145 Cong Rec S 14696, S14720 (Nov. 17, 1999).

⁶⁶ See *inter partes* reexamination 95/000020 (2004-06-02 Petition Decision, p. 8)(judgment appealed); *inter partes* reexamination 95/000093 (2005-08-23 Petition Decision, p. 6)(judgment appealed); *inter partes* reexamination 95/000019 (2003-07-28 Notification, p. 1)(judgment not appealed); *inter partes* reexamination 95/000199 (2008-11-18 Petition Decision, p. 12)(judgment appealed).

⁶⁷ See *inter partes* reexamination 95/000020 (2005-09-16 Petition Decision, p. 7).

⁶⁸ See *inter partes* reexamination 95/000020 (2005-09-16 Petition Decision, n. 20).

⁶⁹ *Inter partes* reexamination 95/000020 (2005-09-16 Petition Decision, p. 8).

The Patent Office also noted that the petition had made no showing that the art “could have been raised” in the litigation.⁷⁰

It is not clear whether a dismissal without prejudice would be considered a “final decision”, even if it resolved validity issues. The Patent Office has in the past hinted that a dismissal without prejudice might not be final under 35 U.S.C. § 317(b).⁷¹

Under the literal language of the statute⁷² and the corresponding rule,⁷³ there does not need to be a finding that the Third Party Requester lost on a validity challenge based on patents or printed publications. A failed challenge to the validity of the patent as issued under 35 U.S.C. § 112, for example, may prevent the Third Party Requester from filing a request for *inter partes* reexamination.

(b) “In Suit”

The 317(b) exclusion is not a blanket prohibition of reexamination for the entire patent, as is the limitation under section 317(a).⁷⁴ Rather, it applies on a claim-by-claim basis.⁷⁵ Where the Third Party Requester loses in court (or in a previous *inter partes* reexamination), but where the validity of certain claims was not in issue, the Third Party Requester is not prevented from filing a request for *inter partes* reexamination on the claims not in issue.⁷⁶ Likewise, where

⁷⁰ *Inter partes* reexamination 95/000020 (2005-09-16 Petition Decision, p. 9).

⁷¹ See *inter partes* reexamination 95/000020 (2006-03-20 Petition Decision, p. 10)(“...even aside from the fact that the patent owner has not shown the District Court dismissal ‘without prejudice’ of the underlying action (based on a settlement agreement reached between patent owner NTP and RIM) to in any way be a final decision where RIM ‘has not sustained its burden of proving the invalidity of any patent claim in suit’ pursuant to 35 U.S.C. § 317(b).”).

⁷² See 35 U.S.C. § 317(b) (“...the party has not sustained its burden of proving the invalidity of any patent claim in suit....”).

⁷³ See 37 C.F.R. § 1.907(b).

⁷⁴ See section I.D.1, *supra*.

⁷⁵ See MPEP § 2686.04.V.(A); *inter partes* reexamination 95/000093 (2005-08-23 Petition Decision, p. 11); *inter partes* reexamination 95/000020 (2005-09-16 Petition Decision, p. 10)(“The estoppel effect provided by 35 USC § 317(b) is on a ‘claim by claim’ basis and therefore, each claim must be independently analyzed.”); *inter partes* reexamination 95/000186 (2008-06-24 Petition Decision, p. 4).

⁷⁶ See *inter partes* reexamination 95/000093 (2005-08-23 Petition Decision, p. 11) (“Thus, the section 317(b) estoppel provision was not written to estoppel any and all validity challenges to a patent after a final validity decision has been reached in litigation regarding some or all of the patent’s claims. Instead, the estoppel triggers on a claim by claim basis. Petitioner fails to acknowledge this distinction in its petition. Here, since claim 1 of both the '213 and '333

the infringement of the claim was litigated, but not the validity, the Third Party Requester or its privy will likely be able to file a request for *inter partes* reexamination.

Section 317(b) applies to any claim actually confirmed or found to be patentable in a previous *inter partes* reexamination,⁷⁷ and only to claims “in suit” in a litigation.⁷⁸ This would appear to exclude application of 317(b) where the Third Party Requester had the opportunity to raise the validity of certain claims, but chose not to do so.⁷⁹ Even where a court’s order by its terms applies to the entire patent, the Patent Office has sometimes required proof that each claim was litigated.⁸⁰ The Patent Office will apparently not investigate the course of a litigation to determine whether section 317(b) applies. Rather it will rely on the submission of court documents by the parties.⁸¹

The application of 317(b) to only those claims actually litigated means that claims which have been added during the *inter partes* reexamination will not be subject to the

patents were not litigated, no final decision, let alone any decision, has been reached regarding the validity of those claims. Therefore, even assuming that Petitioner's proposed interpretation of ‘final decision’ in section 317(b) is a district court decision would be correct, there has been no district court decision on the validity of claim 1 of either patent. Thus, no estoppel applies to claim 1 of each reexamination proceeding under any theory. For that reason alone, Petitioner's requested relief to terminate the entire proceedings cannot be granted.”).

⁷⁷ See 35 U.S.C. § 317(b)(“...the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent...”)(emphasis added).

⁷⁸ See, e.g., *inter partes* reexamination 95/000020 (2006-03-20 Petition Decision, p. 7)(“It is once again pointed out that the '020 *inter partes* reexamination proceeding is directed to a patent for reexamination having six hundred and sixty five claims, only six of which were even involved in the litigation. It is also pointed out once again that there had been no decision on the patentability of any claims other than these six claims, and that the estoppel effect provided by 35 U.S.C. § 317(b) is on a ‘claim by claim’ basis. Therefore, it is reiterated that even if the litigation were presumed to be final with respect to RIM having failed to establish claim invalidity, the '020 *inter partes* reexamination proceeding cannot simply be ‘dismissed’ (*i.e.*, terminated) based upon 35 U.S.C. § 317(b) estoppel.”).

⁷⁹ See, e.g., *inter partes* reexamination 95/000020 (2005-09-16 Petition Decision, p. 10); *inter partes* reexamination 95/000186 (2008-09-30 Petition Decision, p. 6).

⁸⁰ See *inter partes* reexamination 95/000186 (2008-09-30 Petition Decision, p. 6); *but see inter partes* reexamination 95/000234 (2007-10-12 Petition Decision, p. 4)(not requiring such proof where the Patent Owner and Third Party Requester jointly reported that the district court’s decision applied to “all claims”).

⁸¹ See *inter partes* reexamination 95/000274 (2008-10-06 Petition Decision, pp. 6-7).

estoppel.⁸² This gives the Patent Owner an extra degree of flexibility – if all other claims are subject to estoppel, the Patent Owner may terminate the *inter partes* reexamination by canceling the excess claims.

It is not entirely clear how the Patent Office will apply section 317(b) to litigated claims that were amended in the *inter partes* reexamination. On the one hand, the text of 317(b) would appear to apply literally to “any claim in suit”. It is not clear, however, whether an amended claim fails within the purview of section 317(b) by virtue of having the same number as a litigated claim. Where the Patent Office has applied section 317(b) to terminate or partially terminate a case, the claims were not amended.

The Patent Office has in the past refused to apply section 317(b) to claims narrower than those in suit.⁸³ Even if a Third Party Requester fails to prove the invalidity of an independent claim, the Patent Office will likely not terminate the *inter partes* reexamination of a dependent claim that was not litigated.

(c) “Could Have Raised”

Once it is determined that a Third Party Requester “finally” lost on any claim in a *inter partes* reexamination or any claim “in suit” in a prior litigation, then the Third Party Requester is prevented from requesting an *inter partes* reexamination for that claim “on the basis of issues which that party or its privies raised or could have raised” in the prior proceeding. That is, the Patent Office will first determine whether a claim was involved in a prior proceeding. Only if a claim was involved in the prior proceeding will the “raised or could have raised” issue be reached. This is important because a Patent Owner might argue that, in principle, any issue with respect to any claim “could [be] raised” in any litigation. The Patent Office’s treatment of claims “at issue” would appear to foreclose such arguments.⁸⁴ Therefore, Patent Owners may not be able to argue that an issue “could have [been] raised” for a claim, if no other issue relating to the claim was decided.

Whatever else “could have raised” means, it entails the procedural ability to raise prior art. In *inter partes* reexamination 95/000020, the Patent Office denied a petition to terminate the reexamination under 35 U.S.C. § 317(b), in part because the petitioner had not

⁸² See *inter partes* reexamination 95/000186 (2008-06-24 Petition Decision, p. 5) (“It is also observed with respect to at least the newly added claims 58-74 that there are issues raised in the '186 proceeding, not raised in the litigation. Because no showing has been made by patent owner that the outstanding issues in the reexamination are based on ‘issues which that party or its privies raised or could have raised in such civil action,’ it has not been established that the estoppel provisions of 35 U.S.C. 317(b) preclude the maintenance of the '186 proceeding with respect to those issues. Patent owner is advised that cancellation of these newly proposed claims would remove this particular hindrance to termination of the reexamination proceeding.”).

⁸³ See *inter partes* reexamination 95/000186 (2008-09-30 Petition Decision, p. 8).

⁸⁴ See note 79 and text thereto, *supra*.

demonstrated that the Requester had raised or could have raised the same prior art in the litigation. The Patent Office reasoned that the petition would be required to show “that [the Third Party Requester] had a legal right, as to the patent or printed publication, to introduce it into the litigation after it became ‘available’ to [the Third Party Requester].”⁸⁵

Beyond procedural ability to raise prior art, there is the question of the Requester’s knowledge of the prior art. There are two principal interpretations in the context of section 317(b).⁸⁶ First, one might assert that a party “could have raised” an issue if it was actually aware of the issue. Second, one might assert that a party “could have raised” an issue if there was a (legal) means of identifying the issue at the time of the prior proceeding.⁸⁷ The last

⁸⁵ *Inter partes* reexamination 95/000020 (2005-09-16 Petition Decision, p. 9); *inter partes* reexamination 95/000020 (2005-11-30 Petition Decision, p. 14)(“...the patent owner has not shown that [the Third Party Requester] had a legal right, as to a given patent or printed publication relied on in the merged reexamination proceeding, to introduce that patent or publication into the litigation after it became ‘available’ to [the Third Party Requester]”).

⁸⁶ In the context of section 315, which limits what a Third Party Requester may do in a district court, there are other possible interpretations. For example, because of the limited jurisdiction of the Patent Office in an *inter partes* reexamination, certain issues that can be raised before a district court legally could not have been raised in a prior *inter partes* reexamination proceeding. See, e.g., section V.A.3, *infra*. For section 317, which limits what a Third Party Requester may do in an *inter partes* reexamination proceeding, the language is less susceptible to this interpretation, because the prior proceeding either had exactly the same jurisdiction (if it was an *inter partes* reexamination) or broader jurisdiction (if a court action).

⁸⁷ See, e.g., *U.S.P.T.O. Report To Congress On Inter Partes Reexamination*, http://www.uspto.gov/web/offices/dcom/olia/reports/reexam_report.htm, Analysis of Comments, ¶1 (2004)(“In the view of round table participants, it is not clear how extensive a prior art search must be in order to avoid the ‘could have been raised’ estoppel or to satisfy the exception that a prior art issue could not have been raised if the prior art was ‘unavailable’ to the third party. In the section-by-section analysis of S. 1948 (Cong. Rec., 17 Nov. 1999: S14720), ‘unavailable’ prior art was defined as prior art that was ‘...not known to the individuals who were involved in the ...inter partes reexamination proceeding on behalf of the third-party requester and the USPTO.’ The current USPTO position was posted in the Official Gazette 1234:97 (May 23, 2000) and states: ‘The question of whether an issue could have been raised must be decided on a case-by-case basis, evaluating all the facts and circumstances of each individual situation.’ It is further suggested that an ‘all encompassing’ definition might not account for unanticipated facts that could arise in the future. The statute thus leaves open whether prior art that was not discovered in a search performed by the third party will be deemed prior art that was ‘unavailable’ or ‘not known,’ or if the ‘unavailable’ standard only applies to prior art that was not published at the time the inter partes reexamination request was filed.”). Thanks to Andrew Baluch for pointing the author to this comment.

sentence of section 317(b) and associated legislative history seem to indicate that the first interpretation is preferred.⁸⁸

The Patent Office has not yet offered much guidance concerning the language “could have raised.” In those proceedings where an issue under 317(b) has arisen, the Third Party Requester did not assert that the issues being limited fell outside of those that it “could have raised”.⁸⁹ The Patent Office’s guidance in the MPEP states only that “[t]he patent owner has the burden of showing that the art and issues applied in the request was available to the third-party requester and could have been placed in the litigation.”⁹⁰

(d) Prior Art Unavailable To The Requester

Section 317(b) seems itself seems to define subject matter falling outside of what “could have [been] raised” in its final clause:

[t]his subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.⁹¹

This final sentence of section 317(b) appears to define a “safe harbor” for raising new prior art in a subsequent or parallel *inter partes* reexamination. The Patent Office has in the past required a Patent Owner petitioning for termination to demonstrate that this safe harbor provision does not apply.⁹²

The safe harbor provision is somewhat oddly worded to be applicable only to prior art unavailable “at the time of the inter partes reexamination proceedings”. The interpretation of the phrase would seem to depend on the two situations outlined in 317(b): (1) where a first *inter partes* reexamination finally upheld the patentability of one or more claims and where a second *inter partes* reexamination is thus precluded or (2), where a litigation

⁸⁸ See Conference Report on HR 1554, 145 Cong. Rec. H11769, H11805 (Nov. 9, 1999).

⁸⁹ See *inter partes* reexamination 95/000093 (2005-08-23 Petition Decision)(whether issues “could not have been raised” not addressed).

⁹⁰ See MPEP § 2686.04 IV(A).

⁹¹ 35 U.S.C. § 317(b).

⁹² See, e.g., *inter partes* reexamination 95/000020 (2005-09-16 Petition Decision, p. 9); *inter partes* reexamination 95/000020 (2006-03-20 Petition Decision, pp. 8-9)(“The patent owner has been repeatedly challenged in the prior decisions on petitions to provide any evidence that the applied references were known and available to the requester in time to enter them into the District Court proceeding, and the patent owner has failed to address that challenge.”).

resulted in a final judgment that the Third Party Requester had failed to prove invalidity, and a parallel or subsequent *inter partes* reexamination is precluded.

If applied to the first situation, the phrase “at the time of the *inter partes* reexamination proceedings” should mean at the time of the first *inter partes* reexamination, because the evaluation of 317(b) in this situation takes place at the beginning of the second *inter partes* reexamination, where the art is presumably available. If the art were required to be unavailable at the start of the second *inter partes* reexamination, the exception inherent in the clause could never be applied.

In the second situation (a final judgment from a litigation) it is beneficial to distinguish between two cases. In the first case, the final judgment occurs before the request for reexamination is filed. In this case, the exception is difficult to apply literally, because if the art is unavailable at the time of the (later) request, what is the basis for filing the request? As noted *infra*, however, the application of the statute in this literal manner (i.e. failing to apply the exception because the art was available at the time of the later request) does not appear to be supported by the legislative history, which refers instead to prior art unavailable at the time of the “civil action or *inter partes* reexamination.”⁹³

In the second case, the judgment is rendered after the request for reexamination is filed. The exception could then mean that the Third Party Requester is allowed to assert prior art despite a final judgment of invalidity, provided that the prior art was unavailable at the time of the request in the *inter partes* reexamination proceeding.⁹⁴ The issue of whether the Third Party Requester would be allowed to introduce the new art would then have to be addressed.⁹⁵ Here it is worth noting that 37 C.F.R. § 1.948(a)(3) allows new prior art to be submitted “which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding”.⁹⁶

The application of the sentence in this manner would seem to be a bit arbitrary in some cases, especially where the prior art is newly discovered, but the Third Party Requester “could have raised” it, or in fact did raise it, in the litigation. For example, suppose a litigation and *inter partes* reexamination are co-pending. New prior art is revealed to the Third Party Requester in discovery, and “could [be] raised” in the litigation. A final judgment is then rendered that the Third Party Requester failed to prove the invalidity of a claim. If the Third

⁹³ See Conference Report on HR 1554, 145 Cong. Rec. H11769, H11805 (Nov. 9, 1999)(emphasis added).

⁹⁴ See, e.g., *inter partes* reexamination 95/000020 (2006-03-20 Petition Decision, p. 8)(“Certainly, an issue of claim validity based on prior art that was unknown or unavailable during the litigation cannot be a an issue ‘that was raised or could have been raised.’”).

⁹⁵ That is, the Patent Office would have to determine whether section 317(b) contains an implicit exception that would override 37 C.F.R. § 1.948(a).

⁹⁶ 37 C.F.R. § 1.948(a)(3).

Party Requester is successful in introducing the new prior art into the *inter partes* reexamination, then the exception in the last sentence of section 317(b), by its literal application, would not require the Patent Office to terminate the reexamination at least as to invalidity based on the new prior art.

If the Third Party Requester were not allowed to introduce the new prior art into the reexamination under 37 C.F.R. § 1.948, the Patent Office would be required to terminate the proceedings as to the litigated claim under section 317(b), assuming all other conditions of section 317(b) were met. The Third Party Requester might then file a new request for *inter partes* reexamination based on the new art, but would run into the ambiguity in section 317(b) described *supra*, because the “time of the inter partes reexamination proceeding” could now refer to the time of the second-filed reexamination. So where there is new prior art discovered and co-pending litigation that concludes with a final judgment of non-invalidity, much depends on the Patent Office’s application of 37 C.F.R. § 1.948.

One might also interpret the reference to “the time of the inter partes reexamination proceedings” in the last sentence of section 317(b) as excluding the case where estoppel is based on a prior judgment. That is, the last sentence might only provide a “safe harbor” for the Third Party Requester where the Patent Owner seeks to apply 317(b) based on a prior *inter partes* reexamination, not on a final judgment from litigation. There appears to be evidence conflicting with such an interpretation in the Congressional Record, for example:

However, the third-party requester may assert invalidity based on newly discovered prior art unavailable at the time of the civil action or inter partes reexamination. Prior art was unavailable at the time if it was not known to the individuals who were involved in the civil action or inter partes reexamination proceeding on behalf of the third-party requester and the US Patent Office.⁹⁷

Although this is may require turning a blind eye to the literal wording of the statute, it does seem to be a more logical way to apply the exception. Indeed the Patent Office has applied the last sentence of section 317(b) against a Patent Owner requesting termination based on a decision from a concluded court proceeding.⁹⁸ In the same decision, however, the Patent Office also stated that 317(b) further meant that

If the patent or printed publication became "available" at or subsequent to [the Third Party Requester]'s filing of the request for

⁹⁷ See Conference Report on HR 1554, 145 Cong. Rec. H11769, H11805 (Nov. 9, 1999)(emphasis added).

⁹⁸ *Inter partes* reexamination 95/000020 (2005-09-16 Petition Decision, p. 9).

inter partes reexamination, then [the Third Party Requester] had a legal right to present it.⁹⁹

Thus, it would seem that the Patent Office interprets the last sentence of section 317(b) to mean both that, for the limitation of section 317(b) to apply, the Third Party Requester had to have the knowledge of prior art and procedural ability to inject the prior art into the first proceeding, and that the prior art was known before the Requester filed the request subsequent request for *inter partes* reexamination.

(e) Prior Art Unavailable To the Patent Office

The last sentence of 317(b) also expressly applies to art that was “not available to the third-party requester and the Patent and Trademark Office”. At the outset, the conjunctive nature of this clause adds a layer of complexity to the analysis. One could interpret the language to mean that, in order for the exception to apply, both the Third Party Requester and Patent Office must be unaware of the prior art.

As discussed above, however, the Patent Office has previously placed the burden on the Patent Owner to show that the exception does not apply. If the last sentence of 317(b) really requires that both the Third Party Requester and Patent Office have been aware of the prior art, then it should be sufficient for the Patent Owner to demonstrate in its petition that either the Third Party Requester or the Patent Office was aware of the prior art. It is currently unknown whether the Patent Office will apply the statute in this manner.

The Patent Office has previously relied on the inclusion of the “Patent and Trademark Office” in last sentence of 317(b) as one reason, among many, for denying a petition to terminate based on a parallel litigation judgment:

This finding by the Office [that 317(b) did not apply based on parallel litigation] was made prior to the September 28, 2005 Office action in which the so-called "TeleNor" prior art was applied against the claims. The TeleNor prior art provides new art which clearly was not of record until well after the *ex parte* and *inter partes* reexamination proceedings had been ordered and merged, and was not considered during any of the court proceedings, and further distances the instant proceeding from the estoppel of 35 U.S.C. § 317(b).¹⁰⁰

(f) Section 317(b) Where Request Denied

If the Patent Office finds that the Third Party Requester failed to show a substantial new question of patentability and denies the *inter partes* reexamination request, the

⁹⁹ *Inter partes* reexamination 95/000020 (2005-09-16 Petition Decision, p. 9).

¹⁰⁰ *Inter partes* reexamination 95/000020 (2005-11-30 Petition Decision, n. 20).

limitations of section 317(b) will not apply.¹⁰¹ The language of section 317(b) requires that an *inter partes* reexamination be “instituted by a Third Party Requester” before the relevant limitation attaches attached. According to the Patent Office, an *inter partes* reexamination is not “instituted by a Third Party Requester” until the Patent Office actually orders reexamination.¹⁰² In such a case, the Third Party Requester is free to file another request (unless other limitations apply), despite the fact that the denial of a request is considered by the Patent Office to be a “final holding of patentability”.¹⁰³

3. Section 317(b): Limitation Preventing Patent Office From Maintaining *Inter Partes* Reexamination After Final Decision.

Not only is the Third Party Requester prevented from filing a request for *inter partes* reexamination after it has “finally” lost on the same issue in court, the Patent Office is also prevented from maintaining such an *inter partes* reexamination.¹⁰⁴ This limitation is applied on a claim-by-claim basis, similar to the limitation against filing of a request for *inter partes* reexamination after a final judgment of non-invalidity.¹⁰⁵ The same construction of “final” (after all appeals)¹⁰⁶ applies when deciding whether to terminate the proceedings.¹⁰⁷ A Patent Owner may petition to terminate an ongoing *inter partes* reexamination under section 317 when it has obtained such a final judgment.¹⁰⁸

If an *inter partes* reexamination has been merged with an *ex parte* reexamination, the Patent Office will not terminate both proceedings under section 317. Rather, the Patent Office has indicated that it will sever the proceedings and terminate the portion of the *inter*

¹⁰¹ See *inter partes* reexamination 95/000106 (2007-06-27 Petition Decision, p. 7).

¹⁰² See *inter partes* reexamination 95/000106 (2007-06-27 Petition Decision, p. 7).

¹⁰³ See MPEP § 2640 (“It should be noted that a decision to deny the request for reexamination is equivalent to a final holding (subject to a petition pursuant to 37 CFR 1.927 for review of the denial), that the patent claims are patentable over the cited art (patents and printed publications).”).

¹⁰⁴ See 35 U.S.C. § 317(b)(“Once a final decision has been entered against a party...an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office....”).

¹⁰⁵ See section I.D.2, *supra*; *inter partes* reexamination 95/000186 (2008-06-24 Petition Decision, p. 4)(“The statute attaches the estoppel on a claim-by-claim basis.”).

¹⁰⁶ See section I.D.2, *supra*.

¹⁰⁷ See *inter partes* reexamination 95/000093 (2007-06-05 Petition Decision, FN 1); *inter partes* reexamination 95/000147 (2007-11-19 Show Cause Order, pp. 5-6).

¹⁰⁸ See section X.D.5, *infra*.

partes reexamination subject to section 317(b) limitation, even if some of the claims are found unpatentable.¹⁰⁹

4. Section 315(c): Limitation On Use Of Prior Art By Third Party Requester In Subsequent Litigation.

If the Third Party Requester loses finally on an issue of patentability in an *inter partes* reexamination, it may not thereafter raise the same issue of invalidity in a district court.¹¹⁰ This section literally applies on a claim-by-claim basis, similar to section 317.¹¹¹ If the Third Party Requester asserts the invalidity of a claim, the court must first determine whether the claim was “finally determined to be valid and patentable.”¹¹²

Is not quite clear when a section 315(c) estoppel is triggered. A court wishing to be consistent with the Patent Office’s interpretation of “final” in section 317 would require that a reexamination certificate be issued.¹¹³ The legislative history of the two sections is different, however. While conference committee reports for section 317(b) indicate that the section may apply “after any appeals”, the comments to section 315(c) state only that:

a third-party requester who is granted an inter partes reexamination by the USPTO may not assert at a later time in any civil action in U.S. district court the invalidity of any claim finally determined to be patentable on any ground that the third-party requester raised or could have raised during the inter partes reexamination.¹¹⁴

¹⁰⁹ See *inter partes* reexamination 95/000093 (2007-06-05 Petition Decision, FN 1); *inter partes* reexamination 95/000147 (2007-11-19 Show Cause Order, pp. 5-6); *inter partes* reexamination 95/000199 (2008-08-18 Petition Decision, p. 7)(“Even if all of the claims of the '138 patent are found valid upon resolution of the '0199 concurrent litigation, only the participation rights of the *inter partes* third party requester would be terminated immediately; the merged reexamination proceeding would be severed, and prosecution and examination would continue as the '8330 *ex parte* reexamination proceeding with respect to *all of the issues* present in the previously merged proceeding.”).

¹¹⁰ See 35 U.S.C. § 315(c).

¹¹¹ See 35 U.S.C. § 315(c)(“...is estopped from asserting...the invalidity of any claim finally determined to be valid and patentable...”)(emphasis added).

¹¹² See 35 U.S.C. § 315(c).

¹¹³ See section I.D.2.

¹¹⁴ Conference Report on HR 1554, 145 Cong. Rec. H11769, H11805 (Nov. 9, 1999)(emphasis added).

The legislative history refers to the claims “finally determined” to be patentable. The understanding of section 315(c) is enhanced little by this phrase, both because “finally determined” mirrors the language of the statute, and because the word “final” is used inconsistently throughout the legislative history. In reference to section 317, “final” appears to mean “after any appeals”, but perhaps because the qualification “after any appeals” is express in the legislative history.¹¹⁵ In the context of section 4607, it appears to mean both after a final office action and a final appellate decision.¹¹⁶ In the context of appeals, it appears to mean an after final office action.¹¹⁷

To the author’s knowledge, no court has ever examined this issue.

It is interesting to note that the estoppel of section 315(c) does not literally apply to “privies”, whereas section 317 does. Literally, section 315(c) applies only to the Third Party Requester,¹¹⁸ which is usually an individual attorney in a law firm. Based on the intent expressed in the legislative history to “deter unnecessary litigation”,¹¹⁹ however, it is unlikely that a court would find that a real party in interest who was not also the Third Party Requester is free from the effect of section 315(c).

Section 315(c) prevents a Third Party Requester from raising prior art in a later district court proceeding that it “could have raised” in a prior *inter partes* reexamination.¹²⁰ If a claim has been finally determined to be valid and patentable in a prior *inter partes* reexamination, the court must decide whether the party asserting invalidity is asserting it on grounds that the party raised or could have raised in the *inter partes* reexamination. Further insight into the meaning of the phrase “could have raised” might be had from section 317, which

¹¹⁵ See Conference Report on HR 1554, 145 Cong. Rec. H11769, H11805 (Nov. 9, 1999).

¹¹⁶ See Conference Report on HR 1554, 145 Cong. Rec. H11769, H11805 (Nov. 9, 1999)(“The estoppel arises after a final decision in the *inter partes* reexamination or a final decision in any appeal of such reexamination.”).

¹¹⁷ See Conference Report on HR 1554, 145 Cong. Rec. H11769, H11805 (Nov. 9, 1999)(“a third-party requester in an *inter partes* reexamination proceeding may all appeal final adverse decisions from a primary examiner to the Board of Patent Appeals and Interferences.”).

¹¹⁸ Note that the term “third party requester” is defined in 35 U.S.C. § 100(e) to mean a person, other than the Patent Owner, who requests reexamination.

¹¹⁹ See Conference Report on HR 1554, 145 Cong. Rec. H11769 at H11805, (Nov. 9, 1999).

¹²⁰ See 35 U.S.C. § 315(c).

also uses the “could have raised” language.¹²¹ Exactly as with section 317(b), section 315(c) expressly provides that

[t]his subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.¹²²

Like section 317, however, section 315 has legislative history that can guide interpretation. Congressional committee reports from the time of the legislation’s passage indicate that the “could have raised” language in section 315 should include only those cases where the Third Party Requester was actually aware of the issue. For example, the House Conference Committee report states that:

[t]o deter unnecessary litigation, proposed section 315 imposes constraints on the third-party requester. In general, a third-party requester who is granted an inter partes reexamination by the US Patent Office may not assert at a later time in any civil action in U.S. district court the invalidity of any claim finally determined to be patentable on any ground that the third-party requester raised or could have raised during the inter partes reexamination. However, the third-party requester may assert invalidity based on newly discovered prior art unavailable at the time of the reexamination. Prior art was unavailable at the time of the inter partes reexamination if it was not known to the individuals who were involved in the reexamination proceeding on behalf of the third-party requester and the US Patent Office.¹²³

By its plain meaning, the term “could have raised” is likely limited to those things which were not procedurally excluded.¹²⁴ The statute also excludes an assertion of invalidity that the Patent Office “could have raised”.¹²⁵

¹²¹ *C.f. inter partes* reexamination 95/000020 (2005-09-16 Petition Decision, p. 6)(Finding, in the context of deciding the meaning of “final” in 35 U.S.C. § 317(b), that “the plain language of the statute reflects Congress’ intent to provide estoppel effect in a reciprocal fashion between court and *inter partes* reexamination proceedings.”).

¹²² *See* 35 U.S.C. § 315(c).

¹²³ *See* Conference Report on HR 1554, 145 Cong. Rec. H11769, H11805 (Nov. 9, 1999).

¹²⁴ *See, by analogy,* 95/000020 (2005-09-16 Petition Decision, p. 9)(Limiting the application of section 317(b) to those cases where the Third Party Requester was legally entitled to raise the prior art).

¹²⁵ *See* 35 U.S.C. § 315(c).

The real party in interest is usually an entity conducting the *inter partes* reexamination through its employees and agents. With this in mind, it is interesting to note that the “could have raised” standard should be tested, according to the legislative history, only against “individuals who were involved in the reexamination proceeding on behalf of the third-party requester and the US Patent Office.”¹²⁶ If the legislative history is treated as authoritative, proof of the possession by a real party in interest of a copy of a reference at the time of the *inter partes* reexamination should not, in and of itself, be sufficient to show that the reference “could have been raised”. Rather, it should be necessary to show that an individual involved in the *inter partes* reexamination proceeding had some exposure to the reference at a relevant point in time. That is, according to the legislative history, the “possession” by the entity should not be construed as “awareness” of the individuals involved in the *inter partes* reexamination (although it may be circumstantial evidence thereof).

This is perhaps a necessary restriction when applied to the Patent Office. The safe harbor language of subsection 315(c) carves out an exception to the estoppel for prior art “unavailable to...the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings”. The exception means relatively little if awareness of all prior art in the possession of the Patent Office can be imputed to the Examiner.

The Patent Office in previous guidance has indicated that section 315(c) estoppel would apply, even if the *inter partes* reexamination is terminated for technical reasons when one or more of the claims stand allowed.¹²⁷

5. AIPA Section 4607: Estoppel Based On Facts Determined In Reexamination

The AIPA contains an uncodified factual estoppel that applies to Third Party Requester of *inter partes* reexaminations. Section 4607 of the AIPA states:

¹²⁶ Conference Report on HR 1554, 145 Cong. Rec. H11769, H11805 (Nov. 9, 1999) (emphasis added).

¹²⁷ See *Changes to Implement the 2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute*, 68 Fed. Reg. 70996, 70999 (Dec. 22, 2003) (“Thus, the third party requester would be barred from appealing the case when a sufficient payment of the fee is inadvertently not made, in the absence of the present revision to Sec. 1.959. Yet, estoppel attaches to the third party requester which precludes further resolution of the issues that the requester wishes to appeal. Under the statute, requester is estopped from later asserting in any civil action, or in a subsequent *inter partes* reexamination, the invalidity/unpatentability of any claim finally determined to be valid and patentable on any ground the third party requester raised or could have raised in the *inter partes* reexamination. Requester is further estopped from later challenging in a civil action any fact determined in the *inter partes* reexamination. Accordingly, a requester's loss of appeal rights because of an inadvertent payment would be an unduly harsh and extreme measure.”).

Any party who requests an inter partes reexamination under section 311 of title 35, United States Code, is estopped from challenging at a later time, in any civil action, any fact determined during the process of such re examination, except with respect to a fact determination later proved to be erroneous based on information unavailable at the time of the inter partes reexamination decision. If this section is held to be unenforceable, the enforceability of the remainder of this subtitle or of this title shall not be denied as a result.¹²⁸

The factual estoppel applies only to the Third Party Requester,¹²⁹ although the reason for freeing the Patent Owner from this estoppel is not evident. The section literally does not apply to the real party in interest or its privies, although such a literal interpretation would seem to defeat the purpose of the estoppel. The estoppel also does not apply to later reexaminations, only “civil action[s]”.

It is not entirely clear when the estoppel attaches. The section refers to “challenging at a later time”. From the text, “at a later time” could refer to the time of the “request”, the time of the determination of the fact, or the time of the “process of such reexamination”. An interpretation consistent with section 317 would be “after a final determination”.¹³⁰ Legislative history is not entirely conclusive. One conference committee report indicates:

Section 4607 estopps any party who requests inter partes reexamination from challenging at a later time, in any civil action, any fact determined during the process of the inter partes reexamination, except with respect to a fact determination later proved to be erroneous based on information unavailable at the time of the inter partes reexamination. The estoppel arises after a final decision in the inter partes reexamination or a final decision in any appeal of such reexamination. If section 4607 is held to be unenforceable, the enforceability of the rest of subtitle F or the Act is not affected.¹³¹

¹²⁸ Sec. AIPA § 4607.

¹²⁹ *See Callaway Golf Co. v. Acushnet Co.*, 523 F.Supp.2d 388, 398 n.9 (D.Del. 2007)(Declining to follow the Patent Office finding in *inter partes* reexamination that a reference inherently disclosed a particular limitation).

¹³⁰ *See* section I.D.2, *supra*, for more detail.

¹³¹ Conference Report On HR 1554, 145 Cong. Rec. H11769, H11806 (Nov. 9, 1999)(emphasis added).

This could indicate that the estoppel should be applied after an Action Closing Prosecution, a Right of Appeal Notice, or after an appeal in an *inter partes* reexamination. The intent of the language “or [after] a final decision in any appeal of such reexamination.” is not known. It could mean that if an appeal is filed, the estoppel does not attach until after the appeal. It could also mean, however, that the estoppel attaches after a final Examiner-level action, but may change if factual determinations are changed or newly made on appeal.

The estoppel also has no effect if the Third Party Requester can prove that the determination was incorrect, using evidence that was not available at the time of the determination.¹³²

Section 4607 contains a severability clause that allows it to be struck down without affecting the remainder of the AIPA. The section most likely anticipates a due process challenge to the estoppel provision.¹³³

At least one court has recognized the potential factual estoppel and used it, *inter alia*, to justify a stay of litigation pending reexamination.¹³⁴

6. Estoppel Based On Facts Determined In Litigation

There are also certain forms of issue preclusion that may apply in an *inter partes* reexamination when issues are decided in litigation. If an issue is litigated to finality, the finding may collaterally estopp the Third Party Requester or the Patent Owner before the Patent Office.¹³⁵ Patent Office policy is to apply collateral estoppel only to issues that have been fully litigated, after all appeals.¹³⁶ Unlike the estoppel of section 4607, issues decided in litigation can estopp the Patent Owner as well as the Third Party Requester and real party in interest.¹³⁷

7. Policy Concern: Avoidance Of Harassment

¹³² See AIPA § 4607.

¹³³ *C.f.* PAN, S.P., *Considerations for Modifying Inter-Partes Reexam And Implementing Other Post-Grant Review*, 45 IDEA 1, 11 (2004)(“The language appears to at least tacitly recognize that the legislated estoppel provisions are harsh, perhaps to the extent that their enforceability may be called into question”).

¹³⁴ See *Echostar Technologies Corp. v. Tivo, Inc.*, Case No. 5:05-CV-81 (DF), Order of July 14, 2006 (E.D. Tex.); *Middleton, Inc. v. Minnesota Mining and Mfg. Co.*, 2004 WL 1968669, *10 (S.D. Iowa, 2004).

¹³⁵ See MPEP § 2659.

¹³⁶ See MPEP § 2659.

¹³⁷ See MPEP § 2659.

At least sections 317 and 315(c) were put in place to prevent “harassment” of the Patent Owner.¹³⁸ The Patent Office views the relevant form of harassment as the filing of multiple requests and not, for example, misconduct in a related litigation.¹³⁹ The Patent Office has previously refused to play judge and jury over allegations of harassment based on a the sum of conduct in different fora, stating that such a determination would be beyond the scope of reexamination as provided in 37 C.F.R. § 1.906(c).¹⁴⁰

In one interesting decision involving the scope of “harassment”, the petitioner argued that the word “final” in 35 U.S.C. § 317(b) meant after the first final judgment. If “final” were to mean after all appeals, the petitioner contended, the policy of avoiding harassment would be undermined, because after all appeals the Patent Owner has an enforceable judgment and the Third Party Requester has no incentive to file further request.¹⁴¹ This argument has a number of flaws, including that the Patent Owner may not have a judgment of infringement, and even if it did, it may not be for all relevant claims or products. The Patent Office determined, however, that harassment could not occur until after a final judgment (including all appeals) had been entered:

Petitioner's argument is unpersuasive because it is precisely when there is no longer any economic or legal incentive available to a third party that further legal activity by a third party against a patent holder becomes harassing. Prior to that, conduct by a third party to invalidate a patent is in defense of the third party's property and Business interests. Thus, filing for *inter partes* reexamination during appeal of a litigation decision is not the evisceration of 35 US. C. 317 as argued by Petitioner. Any

¹³⁸ See Conference Report On HR 1554, 145 Cong. Rec. H11769, 11805 (Nov. 9, 1999)(“Subtitle F creates a new section 317 which sets forth certain conditions by which inter partes reexamination is prohibited to guard against harassment of a patent holder. In general, once an order for inter partes reexamination has been issued, neither a third-party requester nor the patent owner may file a subsequent request for inter partes reexamination until an inter partes reexamination certificate is issued and published, unless authorized by the Director. Further, if a third-party requester asserts patent invalidity in a civil action and a final decision is entered that the party failed to prove the assertion of invalidity, or if a final decision in an inter partes reexamination instituted by the requester is favorable to patentability, after any appeals, that third-party requester cannot thereafter request inter partes reexamination on the basis of issues which were or which could have been raised.”).

¹³⁹ See, e.g., *inter partes* reexamination 95/000020 (2004-06-02 Petition Decision, p. 5).

¹⁴⁰ See *id.*

¹⁴¹ See *inter partes* reexamination 95/000020 (2004-06-02 Petition Decision, p. 8).

harassing conduct could not be found until after the exhaustion of any and all appeals.¹⁴²

This reasoning, if maintained by the Patent Office, would seem to remove the avoidance of potential harassment as a policy underpinning for the limitation against filing a second *inter partes* reexamination found in 35 U.S.C. § 317(a).

II. Use Of *Inter Partes* Reexamination

A. Number of Requests for *Inter Partes* Reexamination

The total number of requests for *inter partes* reexamination is still low compared to requests for *ex parte* reexamination, but the number of requests per year is expanding.¹⁴³ The first *inter partes* reexamination request was filed on July 27, 2001, followed by the second request five months later. Today, however, several requests are filed each week in the Patent Office, and the trend appears to be upward. The following table shows the number of requests filed per year through the end of 2007.¹⁴⁴

2001	2
2002	6
2003	24
2004	37
2005	48
2006	91
2007	123

While it is clear that the number of requests is increasing, it is not clear from this data is that the increase has been caused by the popularity of *inter partes* reexamination. Because *inter partes* reexamination is limited to patents issued on applications filed after the enactment date, Nov. 29, 1999,¹⁴⁵ one would expect that the number of *inter partes*

¹⁴² *Id.*

¹⁴³ The following discussion is based on the author's study of *inter partes* reexamination proceedings.

¹⁴⁴ These data are based on the dates on which requests were submitted to the Patent Office, not the official Patent Office filing date. In some cases, no filing date was granted. In many cases where filing dates were granted, the filing date was delayed by the failure of the Third Party Requester to comply with amended 37 C.F.R. § 1.915.

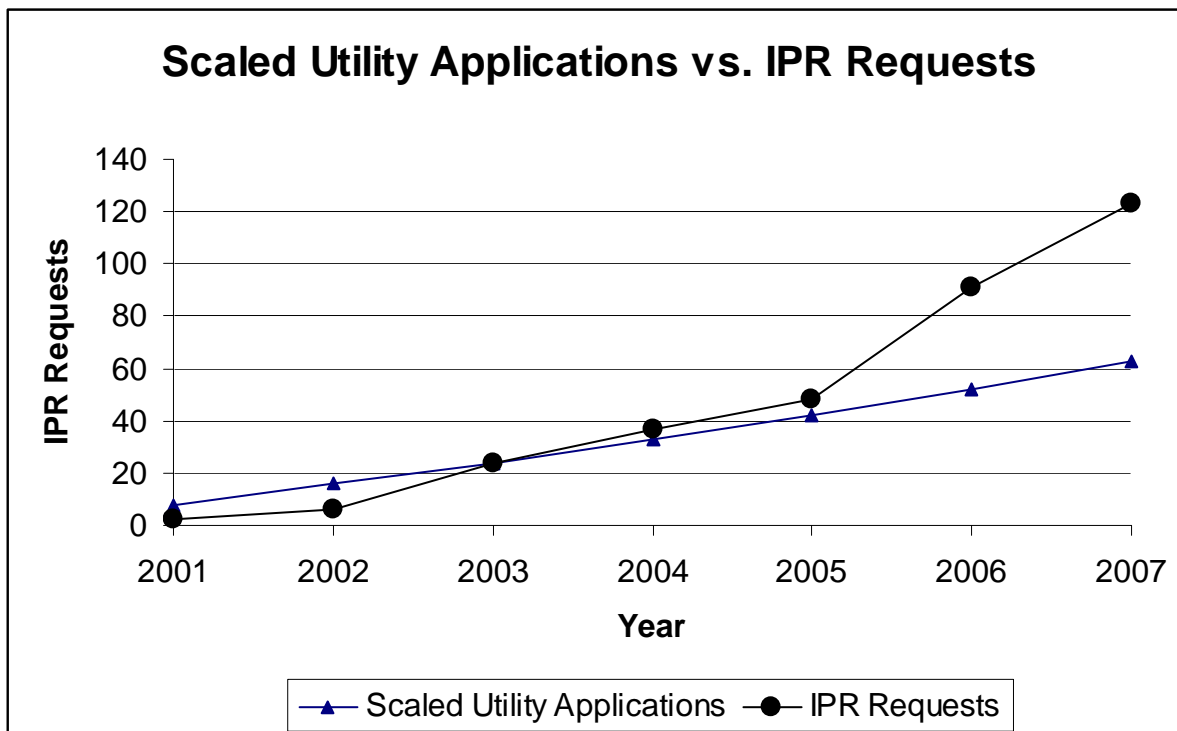
¹⁴⁵ See section V.A.1, *infra*.

reexaminations to increase *at least* proportionally to the number of patents issued on applications filed after that date.¹⁴⁶ The question is whether the growth shown in the table above can be attributed to something other than the expansion of the *inter partes* reexamination jurisdiction base.

While we know the approximate number of applications filed after November 29, 1999,¹⁴⁷ the number of patents that have issued from these applications is not readily available. If we assume, however, that pendency and allowance rates are not changing (perhaps a poor assumption in recent years), we can use the number of applications as representative of the number of patents that qualify for *inter partes* reexamination. This could be justifiable because we are interested in seeing the changes from year to year, not absolute numbers. Plotting a scaled representation of the cumulative number of applications filed against the number of *inter partes* reexamination requests results in the graph below:

¹⁴⁶ *C.f.*, United States Patent And Trademark Office, *Report To Congress On Inter Partes Reexamination*, p. 6 (2004)< http://www.usPatentOffice.gov/web/offices/dcom/olia/reports/reexam_report.htm> (“Making all enforceable patents eligible for inter partes reexamination would greatly increase the patent pool from which to generate inter partes reexamination requests. This will not, however, by itself, solve the problem of the public making wide use of inter partes reexamination. As noted above, almost 900,000 patents have issued since the inter partes reexamination procedure was enacted, yet only a minute fraction of these patents were subject to third-party challenge via inter partes reexamination proceedings. This indicates that there are issues other than the pool of patents eligible for inter partes reexamination that may be deterring a third party from requesting inter partes reexamination of a patent alleged to be unpatentable.”).

¹⁴⁷ See *U.S. Patent Statistics Chart Calendar Years 1963 – 2007*, available at http://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.htm.



The graph plots the number of *inter partes* reexamination requests per year (data points marked with circles) with the scaled cumulative number of applications filed after November 29, 1999 (data points marked with triangles). The application data has been divided by a scale factor so that the scaled cumulative number of applications is equal to the number of *inter partes* reexamination requests in 2003. It is at first apparent that the number of *inter partes* reexamination requests is increasing at a rate that is probably can not be fully accounted for by the increase in the jurisdiction base of the *inter partes* reexamination.¹⁴⁸

In the graph, the increases between later years (*e.g.*, between 2004 and 2005, and between 2005 and 2006) will better indicate the behavior of practitioners in choosing *inter partes* reexamination. This is because, in the early years, a sufficient number of patents had probably not issued from applications filed after Nov. 29, 1999. In other words, the assumption that a certain constant percentage of all applications had issued could not be true until a certain amount of time had passed. This makes the increase in the popularity of *inter partes* reexamination appear higher than it actually was in the early years.

B. Results of *Inter Partes* Reexaminations

¹⁴⁸ See also COHEN, J.D., *What's Really Happening In Inter Partes Reexamination*, 87 J. PAT. & TRADEMARK OFF. SOC'Y 207, 219 (2005) (Finding, based on a study of *ex parte* and *inter partes* reexamination requests on patents that were eligible for *inter partes* reexamination, that *ex parte* reexamination was preferred to *inter partes* reexamination by a ratio of 2.3 to 1 in 2005, but that *ex parte* reexamination requests were filed fifteen times more often than *inter partes* reexamination requests overall).

Given the various motivations behind the establishment of the *inter partes* reexamination proceeding,¹⁴⁹ one of the major questions that needs to be answered is whether it is a *more effective* proceeding than the *ex parte* reexamination. The effectiveness of the proceeding is ultimately measured against its motivation: the ability to root out invalid patents at a lower cost than litigation (while at the same time upholding valid patents). While costs of a typical *inter partes* reexamination are generally much lower than the full costs of litigation,¹⁵⁰ a measurement of its success at rooting out invalid patents is as elusive and subjective as the concept of validity itself.

If we limit ourselves to subjective commentary, then, a review of *inter partes* reexamination files does allow the observation that the Third Party Requester comment procedure is an effective tool for combating the bias toward the Patent Owner that has been observed by some in *ex parte* proceedings.¹⁵¹ The Third Party Requester can act a watchdog over the proceedings, filling to some extent a Patent Office gap in contextual knowledge, resources and litigation training that has been asserted as problematic in *ex parte* reexamination.¹⁵² While some number of Third Party Requester papers do crumble into

¹⁴⁹ See, e.g., United States Patent And Trademark Office, *Report To Congress On Inter Partes Reexamination*, p. 2, (2004) <http://www.uspatentoffice.gov/web/offices/dcom/olia/reports/reexam_report.htm> (“Subsequent Congressional review indicated infrequent use of *ex parte* reexamination, primarily because a third party who requested reexamination was unable to participate in the examination stage of the reexamination after initiating the reexamination proceeding. Interested parties suggested that the volume of lawsuits in the Federal District Courts would be reduced if third parties were encouraged to, and able to, use reexamination procedures that provided an opportunity for them to present their case for patent invalidity at the US Patent Office during the examination stage of the proceeding. To address those concerns and provide such an opportunity, Congress enacted the ‘Optional Inter Partes Reexamination Procedure Act of 1999’ as Subtitle F of the ‘American Inventors Protection Act of 1999’ (AIPA).”); GOLDMAN, M.L., *The New Option Inter Partes Reexamination Procedure And Its Strategic Use*, 28 AIPLA Q.J. 307, 314 (2000)(“prosecution was thereafter *ex parte*, with the attendant risk to the patent challenger that the ‘antlike persistence’” [footnote omitted] of the patentee and his solicitor would result in a favorable patentability ruling over art the patent challenger might rely on in U.S. district court.”).

¹⁵⁰ See note 159, *infra*.

¹⁵¹ See, e.g., D. CARLSON AND J. CRAIN, *Reexamination: A Viable Alternative to Patent Litigation?* 3 YALE. J. LAW & TECH. 2001-02 (“It is no wonder, then, that it is popularly believed that the *ex parte* protocol was a method for the patent owner to take subject matter that was invalid, in view of the uncited prior art, and infringed by the third party, and end up with a patent that was valid and still infringed by the third party. Thus, a significant downside risk exists for the third party associated with the *ex parte* protocol.”).

¹⁵² See also FARRELL, J. AND MERGES, R.P., *Incentives to Challenge and Defend Patents: Why Litigation Won't Reliably Fix Patent Office Errors and Why Administrative Patent Review Might Help*, 19 BERKELEY TECH. L.J. 943, 965-66 (2004).

curmudgeonly accusations of inequitable conduct and other matters only relevant to the Examiner as an emotional being, it is the author's impression the participation of a Third Party Requester usually creates a more level playing field, and one that could not be achieved in an *ex parte* proceeding without a significant overhaul of Patent Office practice. This is reflected in the first results, which show fairly high success rates for the Third Party Requester at the office level.¹⁵³

It is perhaps worth noting that some Examiners disagree with the characterization above. While Third Party Requester participation can sometimes be helpful, in their view the excess posturing caused by the *inter partes* nature of the proceeding usually detracts more than it adds.

One way to measure the effect of the proceedings is to evaluate the "success" of Third Party Requesters, which is admittedly different than "success" from a policy perspective.¹⁵⁴ If we limit ourselves to measuring the "success" of Third Party Requesters, more objective metrics for success become accessible. Where Third Party Requesters are concerned, success can be measured at a variety of different times, any of which may be important depending on the context of the proceedings. The following examines the probability of an accepted request, as well as possible measures for the overall success of Third Party Requesters.

1. Likelihood of Accepted Request

The likelihood of an accepted request can be particularly important where there is co-pending litigation. The Patent Office's decision will obviously be relevant to any motion to stay pending reexam, and may also be relevant to a motion for preliminary injunction.

A request is unlikely to be turned down. To some extent this may be because practitioners are only choosing to file requests against patents that have some sort of weakness. In the first three hundred *inter partes* reexaminations, the Patent Office denied only eight based

¹⁵³ As based on the author's study of *inter partes* reexamination proceedings. See also BALUCH, A, MAEBIUS, S, *The Surprising Efficacy of Inter Partes Patent Re-examination*, 9 L. J. News. 6, (Nov. 2008)(finding, based on issued reexamination certificates, that "the proceedings displayed a high 73% 'kill' rate (complete elimination of all claims targeted by the requesters) — a rate which is far above that in litigation (33%) and *ex parte* re-examination (12%)"); COHEN, J.D., *What's Really Happening In Inter Partes Reexamination*, 87 J. PAT. & TRADEMARK OFF. SOC'Y 207, 220 (2005) ("Even given the difficulty of comparing interim *inter partes* results to old, final *ex parte* data, third-party requesters are doing significantly better in *inter partes* cases than in *ex parte* cases.").

¹⁵⁴ Policy success and Third Party Requester success would seem to be correlated only to the extent that *ex parte* reexamination resulted in the confirmation / allowance of too many invalid patents, while correctly upholding the validity / allowing valid patents, and only to the extent that *inter partes* reexamination corrects the one without upsetting the other.

on failure to show a substantial new question of patentability.¹⁵⁵ This corresponds to a denial rate of less than 3%. About the same number of requests were also granted, only to be followed by a first office action closing prosecution and confirming the claims.¹⁵⁶ A relatively small number of reexaminations were vacated for formal reasons, or terminated based on estoppel provisions.

2. Measuring Requester Win Rates

Measure the overall success of Third Party Requesters is subject to a few difficulties. While a number of proceedings have concluded with reexamination certificates, these proceedings were not fully contested. The proceedings were either procedurally terminated, or terminated because one or the other party gave up at a critical juncture. At the time of this writing, no reexamination certificate had issued in a proceeding that had been appealed. Using the results as reflected in reexamination certificates thus has the potential to skew data in the direction of proceedings that were in some way abnormal. A full picture of the proceeding would include such data, of course. When assessing one's chances prior to the proceeding, however, it is generally more useful to have data that reflect the chances of success if the proceeding is fully contested.

To this end, the author chose two principal approaches to measure success. The first involved the examination of proceedings in which a "Right of Appeal Notice" had been mailed. Issuance of a "Right of Appeal Notice" indicates at least that the proceeding was not terminated at the Examiner level for failure to respond to an office action or for other reasons.¹⁵⁷ At the time of this writing, ninety-nine *inter partes* reexaminations had concluded Examiner-level prosecution with a "Right of Appeal Notice". In these ninety-nine proceedings, the Third Party Requester "won" about twice as often as the Patent Owner.

The second measure looked at the appeal filings. Presumably the primary appellant is the party that is subjectively most dissatisfied with the results. Using this measure, the Patent Owner was the primary appellant about five times as often as the Third Party

¹⁵⁵ See *inter partes* reexaminations 95/000082; 95/000083; 95/000101; 95/000106; 95/000107; 95/000108; 95/000159; and 95/000286. No data was available for *inter partes* reexaminations 95/000141 and 95/000249.

¹⁵⁶ See, e.g., *inter partes* reexaminations 95/000009, 95/000097, 95/000103, 95/000191; 95/000195; 95/000219; 95/000279 and 95/000299.

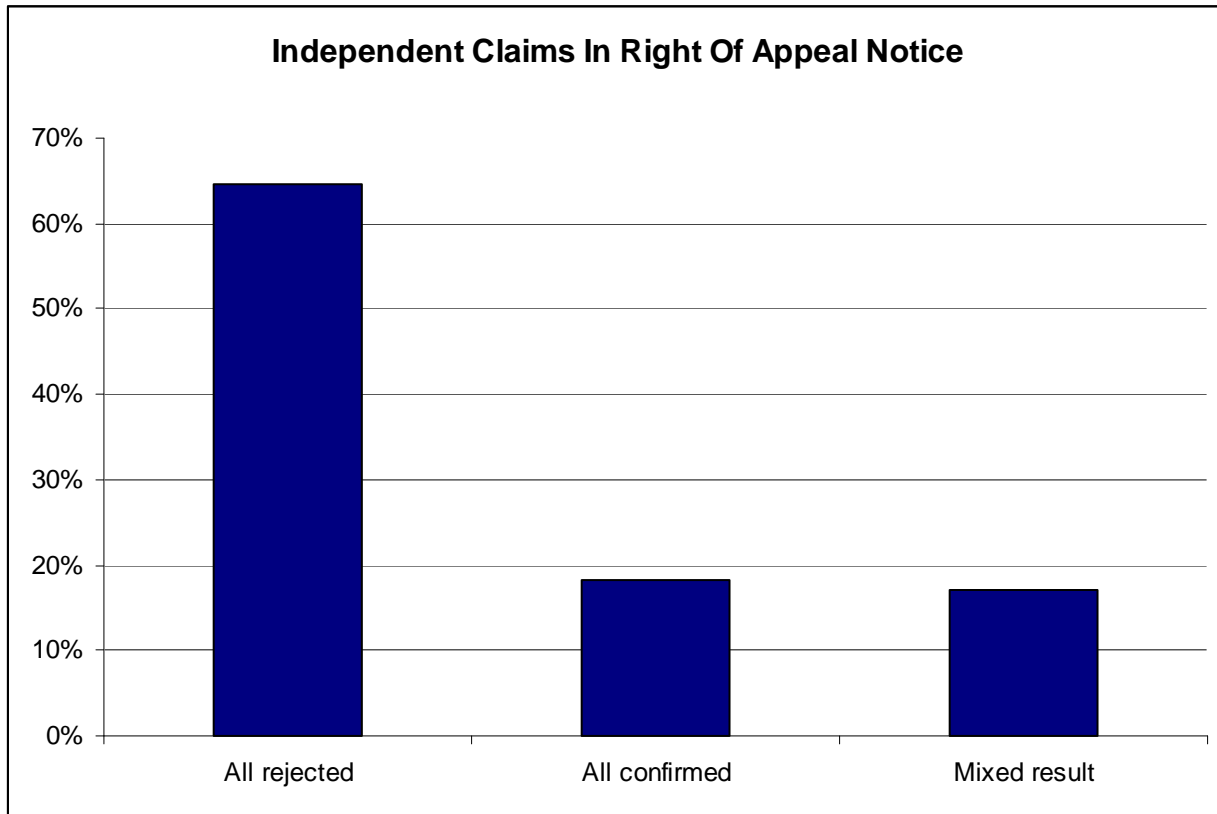
¹⁵⁷ In cases where the Patent Owner fails to respond to an office action rejecting the claims, a "Notice of Intent To Issue A Reexam Certificate" is mailed instead. A "Right of Appeal Notice" will only issue after a failure to respond where there was already an Action Closing Prosecution that was favorable to the Patent Owner in some respect. If there is a more formal problem with the proceeding, the proceeding is usually simply vacated. It is possible, of course, for either party to surrender after the receipt of a "Right of Appeal Notice" by failing to file an appeal or respond to an appeal brief.

Requester. About a third of all cases in which a “Right of Appeal Notice” had been mailed were not appealed by either party, however.

(a) Likelihood of Rejected Claims In Right Of Appeal Notice

The results of the first approach, the examination of rejected claims in a Right of Appeal Notice, are discussed in the following. The conventions used by the Patent Office to describe claim status are followed, and bear mention. A claim is “confirmed” if it is found to be allowable in its original form. A claim is “allowed” if it is a new, patentable claim, or an amended, patentable claim. A claim is “rejected” if it is not patentable, whether in original, amended or new form.

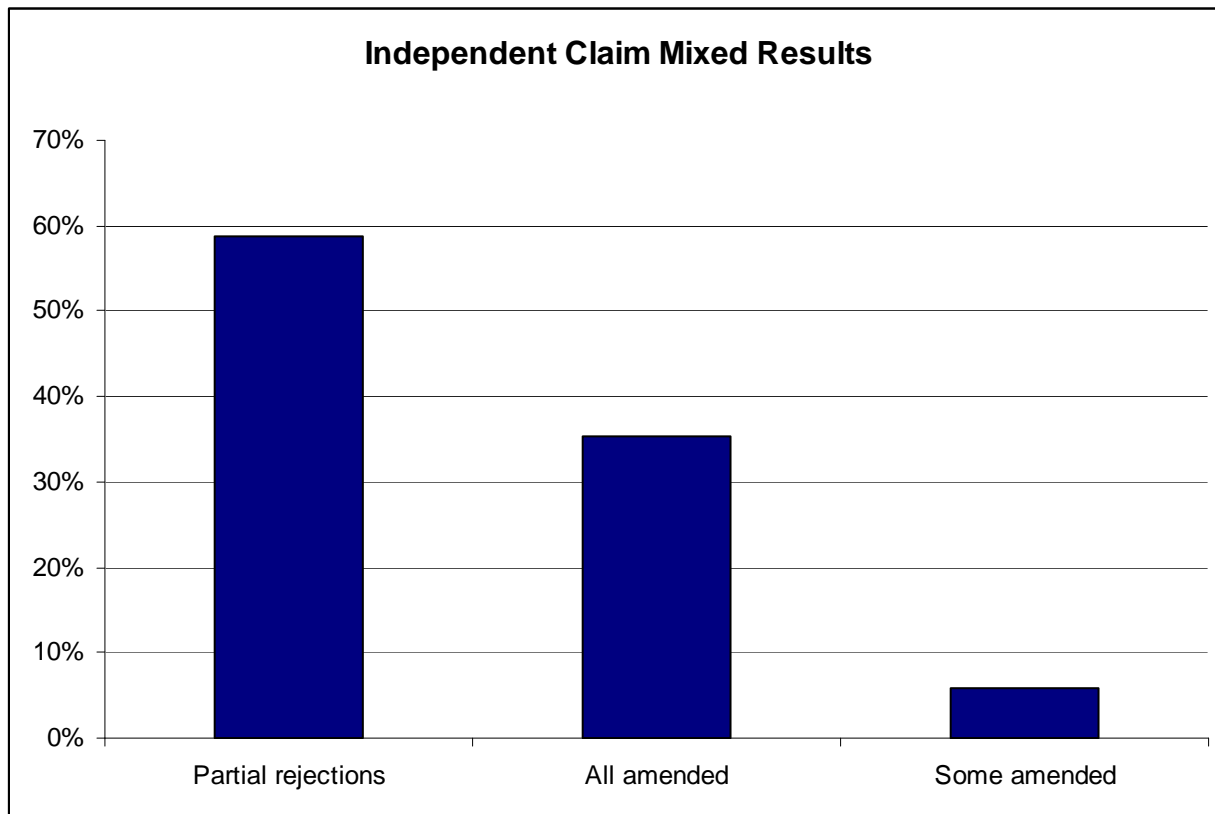
At the time of this writing, the Patent Office had mailed ninety-nine “Right of Appeal” Notices. The Right of Appeal Notice is intended to indicate the final Examiner position taken during prosecution. The results for independent claims for which reexamination was requested are shown as follows:



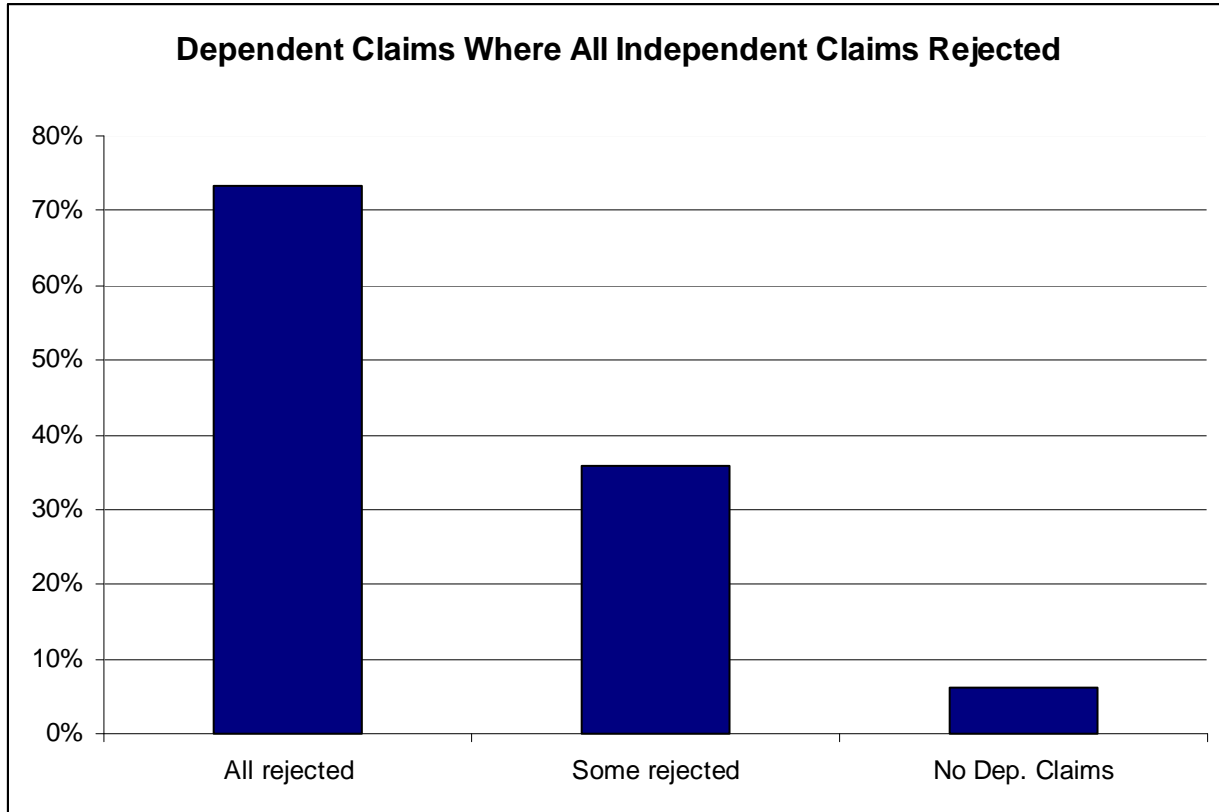
The independent claims for which reexamination were requested, whether amended or not, were entirely rejected in approximately two-thirds of all cases. The independent claims were confirmed in unamended form in fewer than 20% of all cases. More complex results occurred in about the same number of cases.

In those relatively few cases with a “mixed result”, the independent claims were partially rejected and partially confirmed in just under 60% of cases. The independent claims

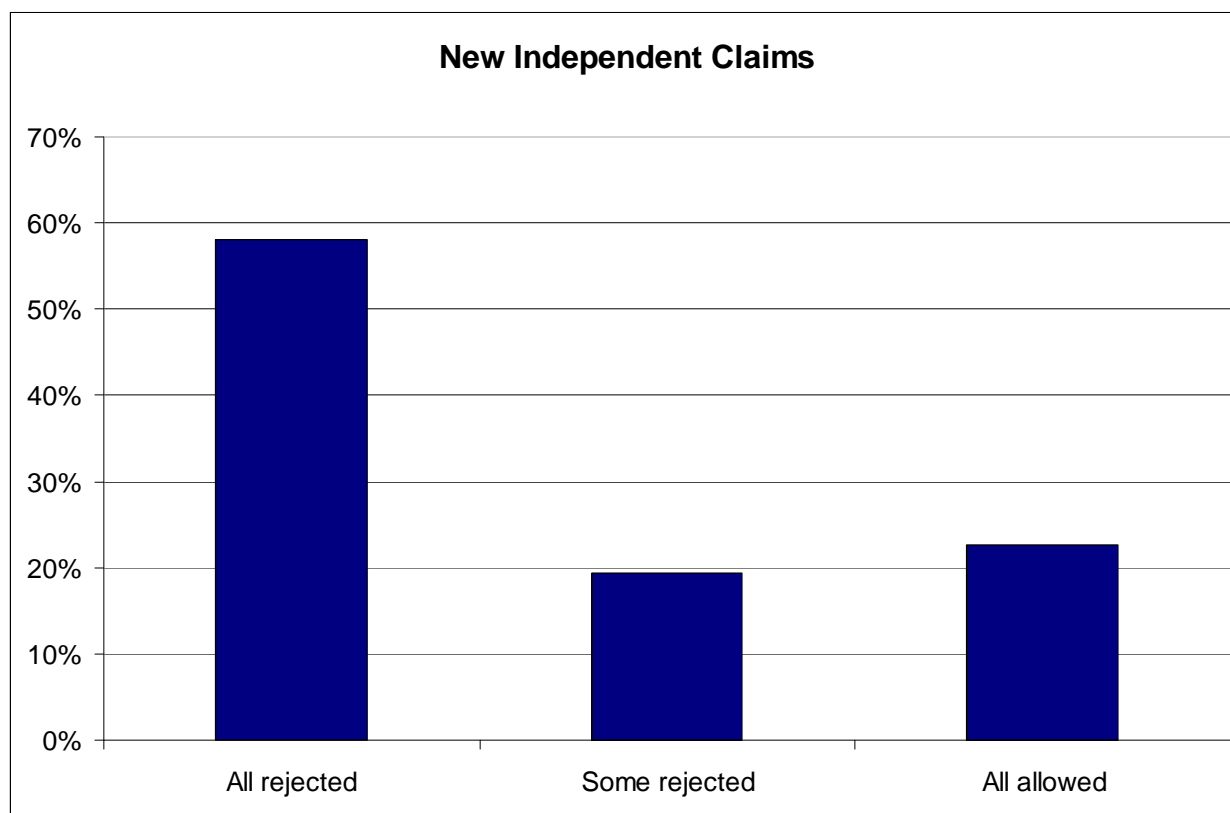
were all allowed, but only after amendment, in roughly one-third of cases. The claims were all confirmed or allowed after amendment in one case.



Among the cases where all independent claims were rejected, dependent claims did not fare particularly well. In about 70% of cases, all dependent claims were rejected as well. In about 35% of cases, some dependent claims were allowed, while a few cases had no dependent claims.

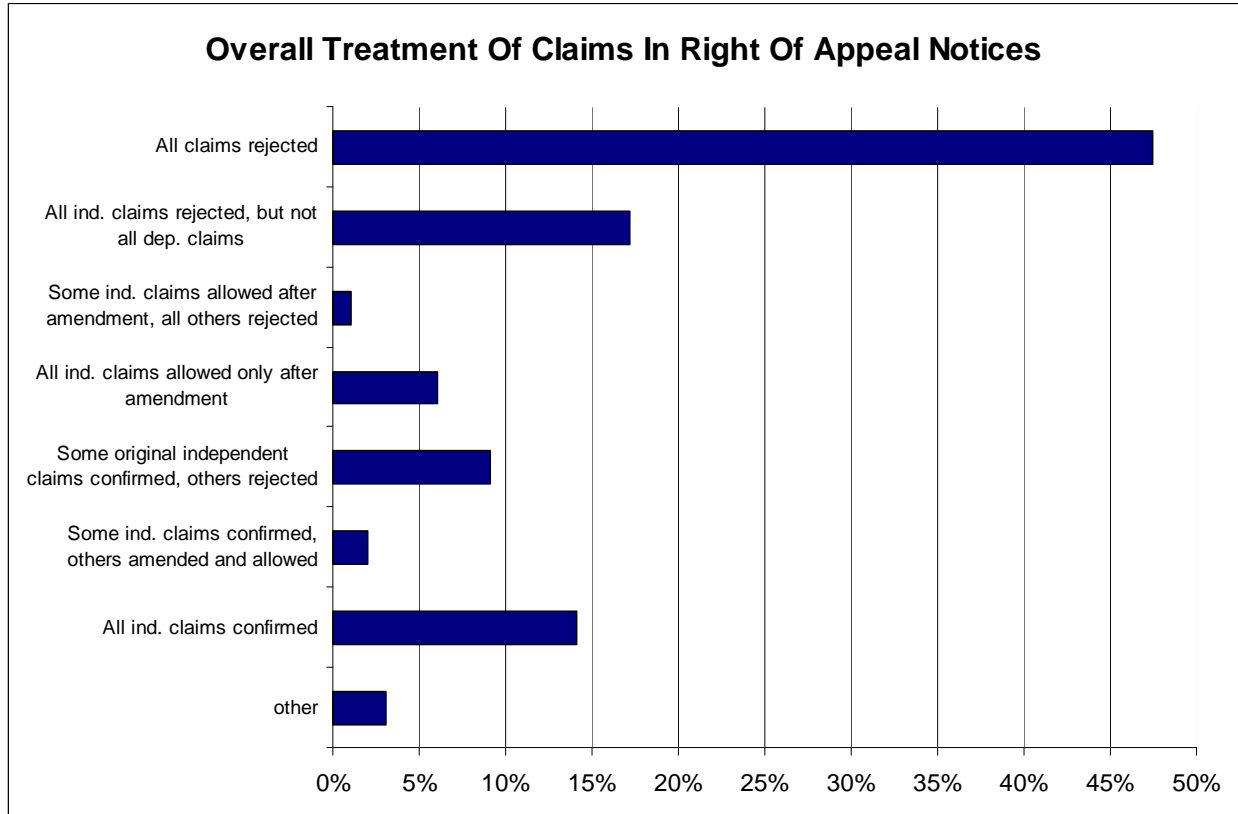


Perhaps surprisingly, new independent claims were introduced in only about one-third of cases. Among these cases, the new independent claims fared about as well as or perhaps slightly worse than original independent claims.



The chart does not take amendments into account, because the new claims themselves raise the possibility of intervening rights.

Overall, all claims of a patent were rejected in just under 50% of cases. All independent claims were rejected in about 65% of cases. All independent claims were either rejected or amended in about 72% of cases. Some independent claims survived unscathed in about 30% of cases. All original independent claims were confirmed in 14% of cases.

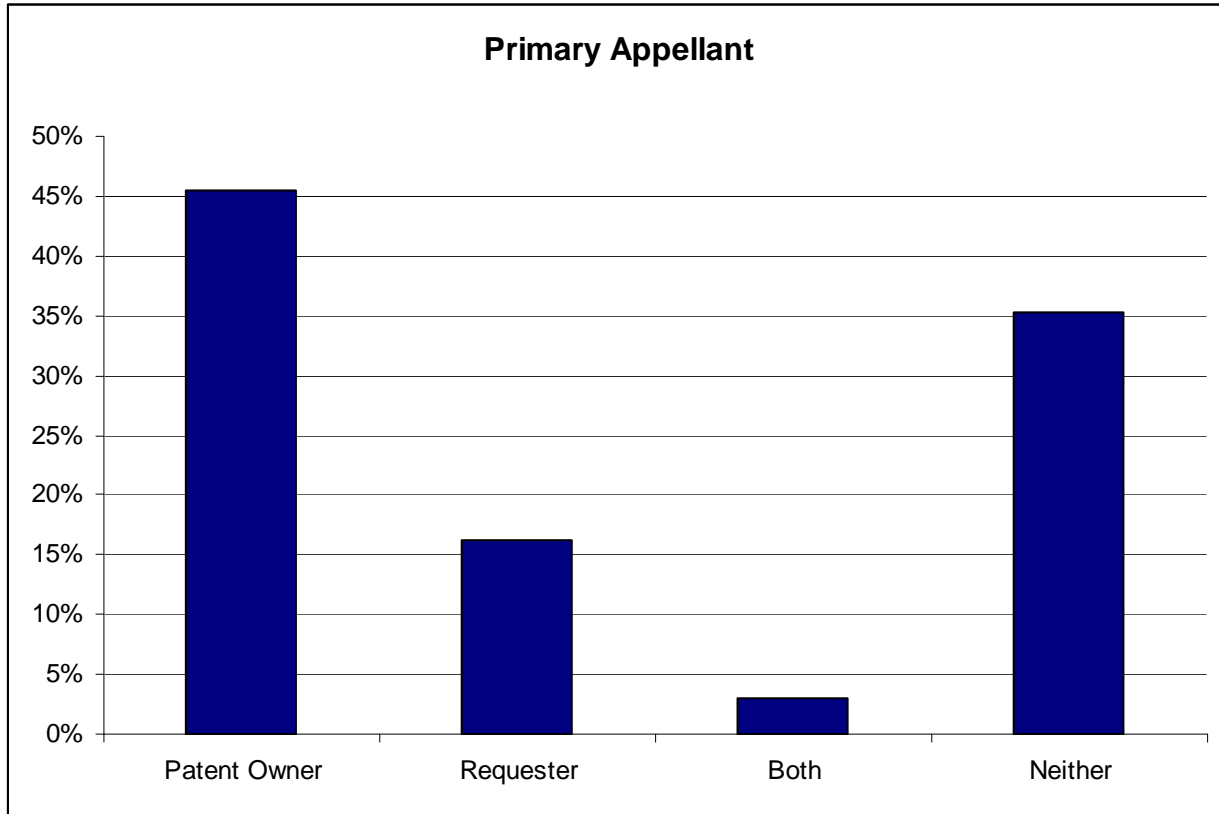


(b) Success As Measured By Appeal Filings

The probability of success can also be gauged through appeal filings. The primary appellant is presumably the party that is most subjectively dissatisfied with the result. This measure takes into account the overall context of the *inter partes* reexamination as reflected in the practitioner’s judgment to file an appeal, and may thus be more revealing. For example, claim amendments can be a victory for the Third Party Requester if the amended claims no longer cover a product of interest, or if intervening rights are important. Claim amendments can also be disastrous, if intervening rights are less important, and the amendment covers an essential product while excluding prior art. Measures based on appeal filings may more accurately capture “success” in such cases.

Because any party may file an appeal where there is an appropriate basis to do so, the matter is made somewhat complex. A party may be sufficiently satisfied with the result to forego an appeal, only to be forced into an appeal by its opponent. This situation can easily result in a Notice of Cross Appeal, so that the party has the status of an appellant rather than a respondent. The present study assumed that the party who filed a “Notice of Appeal” (as

opposed to a “Notice of Cross Appeal”) was the “primary appellant”.¹⁵⁸ The results were as follows:



The Patent Owner was the primary appellant about three times more often than the Third Party Requester. In a surprisingly high number of cases, neither party filed an appeal. In a few cases, both the Patent Owner and Third Party Requester filed Notices of Appeal.

3. Cost

The *inter partes* reexamination was conceived as a less expensive alternative to U.S. district court litigation, and may be viewed cost-wise as a smaller subset of such a litigation. The total client costs for an *inter partes* reexamination will depend on the importance of the patent and the willingness of the opponent to attack on all available fronts. An important, fully contested, competently handled *inter partes* reexamination is likely to cost roughly the same as the briefing of a motion for summary judgment on validity issues in a district court. These costs (for both sides) are likely to be about somewhere between 1% and 10% of the total costs of a

¹⁵⁸ Technically speaking, a “primary appellant” here means an appellant under 37 C.F.R. § 41.61(a).

district court litigation through the final verdict.¹⁵⁹ These costs do not take into account the possibility of an appeal to the Federal Circuit Court of Appeals.

There are several components that contribute to the cost on an *inter partes* reexamination. For the Third Party Requester, there is the cost of investigating and obtaining the prior art before filing. There is the filing fee, which is not insignificant. There are legal fees for the preparation of the request, comments and any appeal. There will also likely be expert witness costs.

For the Patent Owner, the costs are principally legal fees related to the filing of responses and the gathering of evidence, as well as expert witness fees. There will also be some internal administrative costs to the Patent Owner, which will generally need to support its *inter partes* reexamination counsel intensively during the short periods allowed for responses.

4. Timing

It is as yet difficult to estimate how long a fully contested *inter partes* reexamination will take, because no fully contested proceeding has concluded. It appears, however, that Office-level practice to a Right of Appeal Notice is taking on average at least two years, and more likely three years. If fully contested, appeals to the Board of Patent Appeals and Interferences and Court of Appeals for the Federal Circuit could take another three to four years.¹⁶⁰ A fully contested proceeding, therefore, could consume six to seven years.

(a) Timing Of Determination And Order

¹⁵⁹ This is based on the author's experience and anecdotal evidence from other practitioners. See also LANCE G. JOHNSON, *Inter Partes Reexamination: The USPTO Alternative to Patent Litigation*, SCITECH LAWYER, Fall 2004, at 12 (estimating 3-10% of litigation costs, but with a low litigation cost estimate); COHEN, J.D., *What's Really Happening In Inter Partes Reexamination*, 87 J. PAT. & TRADEMARK OFF. SOC'Y 207, 220 (2005)(citing another attorney (Frederick C. Williams of Burns & Levinson) as estimating a \$150,000 to \$200,000 for an important *inter partes* reexamination); Pan, S.P., *Considerations for Modifying Inter-Partes Reexam And Implementing Other Post-Grant Review*, 45 IDEA 1, n.45 2004 ("The Patent Office Comments place costs estimate to a third party requester at \$50,000-\$150,000. 65 Fed. Reg. at 76760. This may be too conservative, as attorneys fees (in now defunct *inter partes* reissue proceedings) approached \$280,000 in 1988 [citation omitted]. This is still, however, only a fraction of the millions that would be expended to litigate invalidity before a U.S. District Court.").

¹⁶⁰ Based on the author's own study. But see SHANG, R. AND TCHAIKOVSKY, Y., *Inter Partes Reexamination Of Patents: An Empirical Evaluation*, A, 15 Tex. Intell. Prop. L.J. 1, 12-13, 2006 (The pendency of *inter partes* reexamination is "comparable to the pendency from filing complaint to trial in many district courts and is longer than the pendency in the faster district courts.").

The first milestone of interest in an *inter partes* reexamination is the decision on whether to grant the request for reexamination. The author surveyed the first three hundred *inter partes* reexamination proceedings, in an attempt to assess the Patent Office's ability to quickly issue such orders. The survey ignored those cases where no determination was made or where reexamination was terminated for a technical reason.

Based on the author's own study, it is reasonable to expect that a decision on a request for *inter partes* reexamination after about seventy days, with an office action after about four months. The statute provides the Patent Office with three months to issue a decision,¹⁶¹ although it is not clear what remedy a Third Party Requester would have should the determination be delayed. A relatively complex and tightly organized procedure has been established in the Patent Office guidelines to deal with this restriction,¹⁶² and to a large extent, the guidelines appear to be functioning well.

In the survey group, the Patent Office consistently issued an order within the first 90 days from the accorded filing date, failing only once (by a two days).¹⁶³ The accorded filing date is, however, later than the date the request was actually given to the Patent Office. The delay is usually caused by a mistake in the request by the Third Party Requester. Over the first 300 requests, the average delay between actual filing date and accorded filing date was 18 days. Almost all cases where such a delay occurred happened after changes to the rules and the issuance of new Patent Office guidelines in 2006.¹⁶⁴ The rule changes mandated complete compliance with 37 C.F.R. § 1.915 before a filing date could be accorded.¹⁶⁵ The guidance interpreted 37 C.F.R. § 1.915 in ways not immediately apparent from the text of the rule, causing a large number of requests to be delayed.¹⁶⁶

(b) Timing of First Office Action

There is no statutory or rules-based requirement for the timing of the first office action, except for the statutory requirement of "special dispatch". As a guideline, however, MPEP § 2660.I. specifies that an office action on the merits should be issued with the determination of a substantial new question of patentability and order granting reexamination ("determination"). If that is not possible, the guidelines specify that an office action should be

¹⁶¹ See 35 U.S.C. § 312(a).

¹⁶² See MPEP §§ 2633 and 2641.

¹⁶³ See *inter partes* reexamination 95/000067 (92 days).

¹⁶⁴ See *Clarification of Filing Date Requirements for Ex Parte and Inter Partes Reexamination Proceedings*, 71 Fed. Reg. 44219 (August 4, 2006).

¹⁶⁵ See 37 C.F.R. § 1.919.

¹⁶⁶ See section V.C.2, *infra*.

mailed within two months after the determination. An office action will likely be delayed if there are co-pending Patent Office proceedings for which a merger must be considered.¹⁶⁷

According to the author's survey, the first office action was issued with the order about 63% of the time, ignoring those cases where the reexamination request was denied or where no order was issued. The rate of issuance with the first office action appears to be getting slightly worse with time.

Among those cases where office actions were required and had already issued, the average time to office action was about 80 days after the determination. The median was zero days, reflecting the fact that more than half of all office actions are issued with the determination. The standard deviation was about 150 days, which tends to indicate that some office actions are issued long after the determination. The latter numbers ignore cases where the reexamination was denied or where no order was issued and those cases where the reexamination was suspended before the office action was issued. The numbers also ignore those cases where an office action should have, but had not, issued at the time of the survey. Thus the numbers for the first three hundred cases will eventually rise as these outstanding office actions issue.

(c) Timing Of Action Closing Prosecution

If we look at the first three hundred *inter partes* reexaminations, 159 Actions Closing Prosecution ("ACPs") had been mailed as of the end of 2008. If we look at only these cases, and exclude cases where the ACP was issued as the first action, the average length of time until the ACP was about 450 days after the determination. The median was about 390 days, and the standard deviation was about 250 days.

This must be viewed as a significant underestimate, however, because proceedings were discounted where an ACP had not issued, even if it had been more than 450 days since the determination. A better method might be to reduce the sample group to the first few proceedings, where all of the proceedings have ACPs mailed. Discounting those proceedings that were terminated before an ACP could be mailed or where the ACP issued on the first action, this reduces the sample set to 43 cases. The average time to ACP in this group was about 710 days after the determination, with a median of about 635 days and a standard deviation of about 380 days.

(d) Timing Of Right of Appeal Notice

It is, of course, more difficult to estimate the time to the Right of Appeal Notice. It can sometimes it can take a long time to issue a Right of Appeal Notice, even when there are no amendments or new evidence introduced after the ACP.¹⁶⁸

¹⁶⁷ See MPEP § 2660.I.

¹⁶⁸ See *inter partes* reexamination 95/000034 (2007-11-02 Right of Appeal Notice)(Right of Appeal Notice issued almost 3 years after Action Closing Prosecution, even though neither Patent Owner nor Third Party Requester filed comments).

In the first three hundred proceedings, ninety-nine had issued Right of Appeal Notices. The average length of time to issuance in this group was about 765 days after the determination, the median was 730 days and the standard deviation was about 400 days.¹⁶⁹ This can only be seen as a significant underestimate. As of October 2008, for every case pending at least 765 days after the accorded filing date, excluding those with procedural irregularities, only about half included issued Right of Appeal Notices.

If we limit the analysis to the first set of proceedings, where every proceeding in the set has an issued Right of Appeal Notice, the average number of days from the determination was around 1130. Overall, the “average” proceeding has the following intervals:

Request Filed	+0 days
Accorded Filing Date	+18 days
Reexam Ordered	+88 days
Non-final Office Action	+120 days
	•
	•
	•
Action Closing Prosecution	+800 days
Right of Appeal Notice	+1250 days

(e) Timing Of Reexamination Certificate

There is as yet no reliable data available to estimate the total time of the proceeding. As of the end of 2008, the only cases with issued reexamination certificates were those in which technical mistakes were made, or in which at least one party chose not to contest the proceedings.

III. Preparation for Filing a Request for *Inter Partes* Reexamination

¹⁶⁹ Compare SHANG, R. AND TCHAIKOVSKY, Y., *Inter Partes Reexamination Of Patents: An Empirical Evaluation*, A, 15 Tex. Intell. Prop. L.J. 1, 12-13, 2006 (Reporting an average of 21.6 and a median of 23.5 months from the request date to the mailing date of the Right of Appeal Notice or the Notice of Intent to Issue A Reexamination Certificate for thirty proceedings where such notices had been mailed.).

A. Is It Advisable To File For Reexamination?

Inter partes reexamination is always filed within a broader strategic context. In the most likely strategic context, the Patent Owner is aware of the Third Party Requester as a potential target and litigation is at least threatened.¹⁷⁰ The Third Party Requester is usually faced with the question of whether to file a request for reexamination at all, and if so, whether that request should be of the *inter partes* or *ex parte* variety. There are instances where any of the three are appropriate, and the options must be evaluated on a case-by-case basis. The following discussion emphasizes the principal considerations.

1. Consider The Likely Timing Of The Reexamination

Reexaminations, both *inter partes* and *ex parte* can be slow.¹⁷¹ Some district court litigations will have completed in about the same time as it takes to conclude office-level practice in a reexamination.¹⁷² Unless a litigation is suspended it is unlikely that a concurrent reexamination will cancel the claims of an invalid patent in question before trial. There is a decent chance that a reexamination could invalidate claims by the time of an appeal from a district court judgment.¹⁷³

It is prudent to evaluate when events in a concurrent reexamination are likely to happen, and how these events are likely to affect the litigation.¹⁷⁴ The principal events in a reexamination that could affect concurrent litigation are the issuance of an order for reexamination, the mailing of an office action on the merits, the Patent Owner's response, the Final Action (*ex parte*) or Action Closing Prosecution and Right of Appeal Notice (*inter partes*), the appeals process and the issuance of a reexamination certificate.

In general, the determination of a substantial new question of patentability and the order instituting the reexamination will happen within three months, and is likely to favor the Third Party Requester.¹⁷⁵ That is, the Third Party Requester will probably have a decision by the

¹⁷⁰ This is due to the visibility provided by the requirement to name the real party in interest in *inter partes* reexamination proceedings. See 37 C.F.R. § 1.915(b). Where it is believed that the Patent Owner is not aware of the Third Party Requester, the Third Party Requester is often more tempted by the anonymity that can be preserved with an *ex parte* reexamination. See section I.C.1, *supra*.

¹⁷¹ See section II.B.4, *supra*.

¹⁷² See section II.B.4(d), *supra*.

¹⁷³ See, e.g., *Translogic v. Hitachi*, 2007 WL 2973955, *1 (Fed. Cir. 2008)(unpublished).

¹⁷⁴ Historical data for *inter partes* reexamination is provided in section II.B.4, *supra*.

¹⁷⁵ See section II.B, *supra*.

Patent Office stating that the validity of the patent is at least questionable and needs to be further examined.

If the Third Party Requester is a bit lucky, a first office action rejecting the claims will be issued with the order. This is a stronger statement than the initial order, because the Patent Office is stating not only that the patentability is questionable, but also that a *prima facie* case of invalidity has been made out. This has obvious value if it can be presented to a jury. If the office action rejecting the claims is not mailed with the order, however, it can take a significant and somewhat unpredictable amount of time to issue.

Often, however, the Patent Owner's response to an office action rejecting the claims is as interesting as the rejection. This usually at the latest within six months of the office action, but usually two to four months.¹⁷⁶ The Patent Owner is often presented with several very unpleasant dilemmas in deciding how to respond to a rejection in a reexamination. If the Patent Owner amends the claim language to avoid the rejection, it gives rise to intervening rights.¹⁷⁷ If instead of making an amendment, the Patent Owner argues that the claims should be interpreted more narrowly than applied by the Patent Office, the Patent Owner must accept the risk that such limitations will be applied against the claims in a later Markman proceeding. If the Patent Owner argues that the prior art cited does not teach the claim elements, usually the safest course where the rejection is under section 102, it risks defining technological safe harbors for its targets.

The Third Party Requester is also interested in receiving a favorable Final Action, either an Action Closing Prosecution or Right of Appeal Notice. These actions, which indicate different, but relatively final stages the Examiner's decision making process, are typically issued after several years of reexamination.¹⁷⁸

The probability of receiving a favorable first office action may be higher than the probability of receiving a favorable second office action, however. In some cases, it may be that the risk of an unfavorable second office action is high enough that the Third Party Requester will not want one prior to trial. Then the likely timing relationship between the first and final office actions becomes a significant factor.

The probability of receiving a reexamination certificate (through all appeals) prior to the trial is almost zero, except for cases where the litigation is stayed, where a procedural mistake is made in the *inter partes* reexamination, or where neither party appeals an Examiner's decision.

2. Consider Whether Events From The Reexamination Can Be Used In Litigation

¹⁷⁶ See 35 U.S.C. §§ 314(a), 305 and 133; 37 C.F.R. §§ 1.956 and 1.550(c).

¹⁷⁷ See 35 U.S.C. §§ 316(b) and 252.

¹⁷⁸ See section II.B.4(c), *supra*.

The timing and likelihood of success of the events in the reexamination must be considered together with the question of which events will be usable in litigation. There are several related questions here. First, can an event be admitted as evidence at trial, and if so, to what issues? Can an event be used as evidence in pretrial? Does a reexamination event have legal significance without needing to be introduced as evidence?

(a) Use At Preliminary Injunction Stage

At the preliminary injunction stage, the standards for the admission of evidence are typically lower. Here, the existence of a reexamination proceeding can be helpful to a defendant in an infringement proceeding.

In *Erico Int'l Corp. v. Doc's Mktg., Inc.*,¹⁷⁹ the Federal Circuit vacated a preliminary injunction, because the defendant had raised “a substantial question as to the validity of the patent”.¹⁸⁰ The similarity of this language to the standard used by the Patent Office for ordering reexamination should not be missed. The existence, therefore, of an administrative decision finding a “substantial new question of patentability” may be helpful in swaying a court to deny a preliminary injunction.

This statement in *Erico* was quickly qualified, however, in *Procter & Gamble Co. v. Kraft Global, Inc.*¹⁸¹ In vacating a district court’s order staying the case pending reexamination, the Federal Circuit acknowledged that intermediate reexamination results could be useful in considering a preliminary injunction.¹⁸² The court noted, however that:

the PTO does not appear to equate the “substantial new question of patentability” standard for whether reexamination should take place, see 35 U.S.C. § 312(a)(1), with the “substantial question of validity” standard by which a defendant may prevent a patentee from demonstrating a likelihood of success on the merits [citation omitted]. In particular, the PTO considers the standard for reexamination met when “there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is

¹⁷⁹ 86 U.S.P.Q.2d 1030 (Fed. Cir. 2008).

¹⁸⁰ See *Erico Int'l Corp. v. Doc's Mktg., Inc.*, 86 U.S.P.Q.2d 1030, 1031 (Fed. Cir. 2008)(“Because this court finds that Doc’s has raised a substantial question as to the validity of the patent at issue, this court vacates the preliminary injunction.”).

¹⁸¹ 2008 WL 5101824 (Fed. Cir. 2008).

¹⁸² See *Procter & Gamble Co. v. Kraft Global, Inc.*, 2008 WL 5101824, *4 (Fed. Cir. 2008)(“We further note that, on remand, the district court should consider the current posture of the inter partes reexamination proceedings at the PTO when evaluating P & G’s likelihood of success on the merits.”).

patentable.” Manual of Patent Examination and Procedure § 2642 (8th ed. Rev. 7 2008) (emphasis in original). “Thus, ‘a substantial new question of patentability’ as to a patent claim could be present even if the examiner would not necessarily reject the claim as either anticipated by, or obvious in view of, the prior art patents or printed publications.” Id. As this court has observed, a requestor's burden to show that a reexamination order should issue from the PTO is unrelated to a defendant's burden to prove invalidity by clear and convincing evidence at trial.¹⁸³

(b) Use During Claim Construction Proceedings

Actions taken in reexamination form part of the intrinsic record, and as such are usable during claim construction.¹⁸⁴ This appears to be true even for unfinished reexamination proceedings.

3. Consider The Term Of The Patent And Whether Significant Past Damages Possible

If past damages heavily outweigh likely future damages, this weighs in favor of filing for reexamination, of either the *ex parte* or *inter partes* variety. This is because amendments to the claims during reexamination can severely restrict the right to recover past damages. If the patent is likely to expire during the course of the reexamination, the Patent Owner will have very little flexibility to amend the claims.

The *inter partes* reexamination statutes apply 35 U.S.C. § 252 by reference to determine the effect of a reexamination certificate.¹⁸⁵ If the Patent Owner is forced by the Patent Office to amend the claims to gain their confirmation, there can be no liability for damages prior to the issuance of the reexamination certificate.¹⁸⁶

(a) Application Of 35 U.S.C. § 252

The *inter partes* reexamination statutes specify that any amended or new claim:

¹⁸³ *Procter & Gamble Co. v. Kraft Global, Inc.*, 2008 WL 5101824, *4 (Fed. Cir. 2008)

¹⁸⁴ See, e.g., *CIAS Inc. v. Alliance Gaming Corp.* 84 U.S.P.Q.2d 1737, 1742 (Fed. Cir. 2007)(limiting claims based on arguments made during reexamination); *Cordis Corp. v. Medtronic AVE Inc.*, 85 U.S.P.Q.2d 1427, 1445 (Fed. Cir. 2008)(discussing whether statements made during reexamination constitute disclaimer).

¹⁸⁵ See 35 U.S.C. § 316(b).

¹⁸⁶ See 35 U.S.C. §§ 316(b) and 252; *Laitram Corp. v. NEC Corp.* 163 F.3d. 1342, 1346 (Fed. Cir. 1998); See *Bloom Eng’g, Inc. v. N Anz. Mfg Co., Inc.*, 129 F.3d 1247, 149-50 (Fed. Cir. 1997).

shall have the same effect as that specified in section 252 of this title for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation therefor, prior to issuance of a certificate under the provisions of subsection (a) of this section.¹⁸⁷

Section 252 specifies two time periods relevant to the effect of reexamined claims. The first time period runs from the date of the issued patent to the day before the date of the reexamination certificate. The second time period runs from the date of the reexamination certificate.¹⁸⁸ If there are multiple reissues / reexamination certificates, presumably several intervening time periods must be taken into account.

Enforcement of the patent for acts of infringement that occurred prior to the issuance of the reexam certificate depends on how the claims were changed. New claims may not be enforced for acts of infringement occurring prior to the date of the reexam certificate. Amended claims may only be enforced if the court finds the claims to be “substantially identical” to an original patent claim.¹⁸⁹ This is not an intervening right, as much as an extinguishing of past rights.

It is interesting to note that the extinguishing of rights is unqualified for amended claims. There is no provision, for example, to allow an action for infringement where an accused device or process meets a claim both in original form and as amended.¹⁹⁰

For the period occurring as of or after the reexam certificate, certain intervening rights may be present. These can be divided into absolute and equitable intervening rights.¹⁹¹ The absolute intervening right is stated as follows in section 252:

¹⁸⁷ 35 U.S.C. § 316(b).

¹⁸⁸ See *Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826 (Fed. Cir. 1984).

¹⁸⁹ See 35 U.S.C. § 252; *Bloom Eng'g Co., Inc. v. N. Am. Mfg. Co., Inc.*, 129 F.3d 1247, 1250 (Fed. Cir. 1997).

¹⁹⁰ See *Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 827 (Fed. Cir. 1984). (“Congress, in this statute, has explicitly limited claim continuity to claims in the reissued patent identical to claims in the original patent. The statute does not allow the claims of the original patent some other form of survival. The original claims are dead. The statute permits, however, the claims of the reissue patent to reach back to the date the original patent issued, but only if those claims are identical with claims in the original patent. With respect to new or amended claims, an infringer's liability commences only from the date the reissue patent is issued.”).

A reissued patent shall not abridge or affect the right of any person or that person's successors in business who, prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the use of, to offer to sell, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported unless the making, using, offering for sale, or selling of such thing infringes a valid claim of the reissued patent which was in the original patent.¹⁹²

This paragraph applies to people who commit, prior to the issuance of the reexam certificate, acts that would constitute infringement of the reexamined patent. The acts must be performed on a "specific thing". In such a case, infringement after the date of issuance of the reexam certificate by the same person with the same "specific thing" is allowed. The provision does not allow, however, infringement by different people with same thing, or by the same people with different things of the same type that were not in existence prior to the issuance of the reexam certificate.¹⁹³

The use of a process prior to the issuance of a reexam certificate does not automatically provide a right to use the process after issuance of the certificate. Instead, processes are subject only to the equitable intervening rights described below.

The equitable intervening right applies to people who made substantial preparations prior to the issuance of the reexam certificate to do something that would infringe the reexamined patent. Section 252 provides:

The court before which such matter is in question may provide for the continued manufacture, use, offer for sale, or sale of the thing made, purchased, offered for sale, used, or imported as specified, or for the manufacture, use, offer for sale, or sale in the United States of which substantial preparation was made before the grant of the reissue, and the court may also provide for the continued practice of any process patented by the reissue that is practiced, or for the practice of which substantial preparation was made, before

¹⁹¹ See *Shockley v. Excalibur Tool & Equip. Co., Inc.*, 248 F.3d 1349, 1359 (Fed. Cir. 2001).

¹⁹² 35 U.S.C. § 252.

¹⁹³ See 35 U.S.C. § 252; *Shockley v. Excalibur Tool & Equip. Co., Inc.*, 248 F.3d 1349, 1360 (Fed. Cir. 2001) ("The use of 'specific thing' in the absolute intervening rights section thus underscores a distinction in the status of the article at the time of reissue. Specifically, a 'specific thing' qualifies for absolute intervening rights only if in existence at the time of reissue.").

the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.¹⁹⁴

This intervening right is within the discretion of the trial court.¹⁹⁵ The court can fashion remedies for people who have practiced a process or engaged in substantial preparations relating to infringing processes or articles. This right is not necessarily limited to “specific things”, but rather can be extended to things not in existence.¹⁹⁶ Because the right is equitable, a court may refuse to apply the remedy for the benefit of parties with unclean hands.¹⁹⁷

There is some question as to the effect of intervening rights on prior judgments. In *Amado v. Microsoft Corp.*,¹⁹⁸ the defendant requested *ex parte* reexamination after a district court had entered a judgment of infringement. The defendant later moved under F.R.C.P. 60(b)(6) for relief from judgment, because the Patent Owner had amended its claims to gain issuance. The district court denied the claims, citing the defendant’s lack of diligence in filing the request. The Federal Circuit held that the district court had not abused its discretion in denying the request.¹⁹⁹

(b) Substantial Identity

In order for past infringement to be extinguished, the Patent Owner must amend the claims such that they are not “substantially identical” to claims in effect prior to the reexam. Determining whether an amendment is “substantial” can be a difficult task. Amendments that correct typographical errors probably do not qualify as substantial amendments. Beyond that,

¹⁹⁴ 35 U.S.C. § 252.

¹⁹⁵ See *Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 830 (Fed. Cir. 1984).

¹⁹⁶ See *Shockley v. Excalibur Tool & Equip. Co., Inc.*, 248 F.3d 1349, 1360 (Fed. Cir. 2001)(“This equitable intervening rights language uses the broader term ‘the thing’ to refer to the subject merchandise. Equitable intervening rights also explicitly extend protections for continued manufacture, thus extending protection to articles not yet in existence at the time of the reissue.”).

¹⁹⁷ See *Shockley v. Excalibur Tool & Equip. Co., Inc.*, 248 F.3d 1349, 1361 (Fed. Cir. 2001).

¹⁹⁸ 86 U.S.P.Q.2d 1090 (Fed. Cir. 2008).

¹⁹⁹ See *Amado v. Microsoft Corp.*, 86 U.S.P.Q.2d 1090, 1098 (Fed. Cir. 2008).

the determination will depend on whether and to what extent a court perceives the scope of claim has changed.²⁰⁰

In *Predicate Logic Inc. v. Distributive Software Inc.*,²⁰¹ the court considered a claim amended during reexamination. The original claim recited “instantiating said at least one index by means of the programmed computer”, but was amended to replace this limitation with two similar limitations that read “first instantiating at least one said index by means of the programmed computer” and “second instantiating at least one said index by means of the programmed computer”. The district court found that the recitation of a second “instantiating step” rendered the claim not substantially identical. The Federal Circuit reversed, finding that the requirement of a second instantiation was implied in another claim element, which required “comparing at least one of the data sets linked to at least one of said instantiated indexes to at least another of the data sets linked to at least another of said instantiated indexes.”²⁰²

4. Consider Whether A Stay Is Possible

One reason to enter reexamination is the possibility of staying a litigation pending the results of the reexamination. The decision to stay a case is within the discretion of the presiding judge, and results are highly variable from judge to judge.²⁰³ If litigation is ongoing, the defendant will need to research the stay history for the presiding judge to ascertain its chances. If litigation is not ongoing, the defendant will have little idea where the case is going to be filed, and will have to estimate its chances using national figures or its best guess at the likely districts.²⁰⁴

5. Choosing Between *Ex Parte* And *Inter Partes* Reexamination

If the choice has been made to file a request for reexamination, then the Third Party Requester must decide between *ex parte* and *inter partes* reexamination. This is typically a balancing of the advantages of *inter partes* reexamination (higher likelihood of success at each stage) against its primary disadvantage (section 315(c) estoppel) as compared with *ex parte* reexamination. The visibility of the Third Party Requester in an *inter partes* reexamination can also be a concern, but is not likely to be relevant where litigation is in the air.

²⁰⁰ See, e.g., *Bloom Eng'g Co., Inc. v. N. Am. Mfg. Co., Inc.*, 129 F.3d 1247, 1250 (Fed. Cir. 1997)(“‘Identical’ does not mean verbatim, but means at most without substantive change. . . . An amendment that clarifies the text of the claim or makes it more definite without affecting its scope is generally viewed as identical . . .”).

²⁰¹ 88 U.S.P.Q.2d 1526 (Fed. Cir. 2008).

²⁰² *Predicate Logic Inc. v. Distributive Software Inc.*, 88 U.S.P.Q.2d 1526, 1531 (Fed. Cir. 2008).

²⁰³ See section XI.E, *infra*, for more detail.

²⁰⁴ See, e.g., section XI.E, *infra*.

Most Third Party Requesters would probably choose the procedural aspects of the *inter partes* reexamination but for the section 315(c) estoppel. The question of the importance of the section 315(c) estoppel is one that can be much discussed, and will depend on the circumstances of each case.

(a) How Important Is Section 315(c)?

It can be argued that the effect of the section 315(c) estoppel is exaggerated. The statute by its terms does not apply until the patentability of a claim is “finally decided” in the *inter partes* reexamination.²⁰⁵ “Finally decided” may mean after a reexamination certificate has issued.²⁰⁶ This takes long enough that a section 315(c) estoppel may only be relevant where the case has been stayed.

Moreover, the practical result of losing an *ex parte* reexamination is not all that pleasant either. If the Third Party Requester submits its best prior art and loses, the Patent Owner may be able to point this out in related litigation.²⁰⁷ While the Third Party Requester will not be estopped from presenting a defense on that prior art, the defense could be severely weakened by the Patent Office’s apparent agreement with the Patent Owner on that particular question. If, too avoid this result, the Third Party Requester withholds prior art from the reexamination that it “could have” submitted, it could face an argument that it was afraid to let the Patent Office do its job. If the section 315(c) estoppel from an *inter partes* reexamination does not take effect because the issue has not been “finally decided”, the cost of losing at an advanced stage in the *inter partes* reexamination is arguably the same as losing in an *ex parte* reexamination. That is, the prior art submitted will potentially be just as damaged if the patent survives the proceeding.

Under the assumption of an ultimate loss, the choice between *ex parte* reexamination and *inter partes* reexamination is not one of having a prior art defense or not. It is more likely the choice between being able to present only a crippled prior art defense (*ex parte* reexamination) or being able to present only a crippled prior art defense with a chance (depending on timing and whether the litigation is stayed) of being legally precluded from presenting any prior art defense at all (*inter partes* reexamination).²⁰⁸

²⁰⁵ See 35 U.S.C. § 315(c).

²⁰⁶ See section I.D.2, *supra*.

²⁰⁷ C.f. CANNUSCIO, R.E., *Optional Inter Partes Reexamination: A Practitioner’s Perspective*, ALI-ABA COURSE OF STUDY, November, at 78-79, 2000 (“The patentee would be able to wave the reexamination certificate before the jury, cloaking the patent with an aura of untouchability. Juries love it when someone else has already decided a complex issue for them. End result: patent valid.”).

²⁰⁸ This is assuming that the likelihood of success is the same in both *inter partes* reexamination and *ex parte* reexamination. This is probably not true.

(b) Is There A Strong Non-Infringement Case?

Where there is a strong non-infringement case, it will be more tempting to begin a reexamination process. If the prior art case is damaged, or even precluded by the reexamination, the real party in interest will still have a case at the district court.

(c) Is There Good Prior Art That Can Not Be Submitted To The Patent Office?

If there is good prior art that can not be submitted to the Patent Office, this may weigh in favor of requesting reexamination. Prior art that is not a patent or printed publication will not be considered by the Patent Office.²⁰⁹ This means that prior art based on prior invention, use, or offers for sale can not be considered. Such prior art will not be subject to estoppel, because it could not have been raised during reexamination.²¹⁰ If the Patent Owner makes a successful reexamination part of its rebuttal prior art case, the defendant can respond that the Patent Office never saw the prior art in question.

Patent Owners can to some extent undermine this tactic, however. Suppose the prior art is based on the previous use, sale or invention of a physical product. If there are publications, manuals, data sheets, etc. that describe the product, these can be (and in some cases must be) submitted by the Patent Owner to the Patent Office. If the Examiner evaluates the publications, a defendant's argument that the product art was not examined by the Patent Office may have less impact with a jury.

(d) Is There Reexaminable Prior Art Better Considered By The Patent Office

Some prior art may simply be better suited for Patent Office consideration. Arguments can be made that the Patent Office is more likely to reject claims under 35 U.S.C. § 103(a) than a court is to invalidate claims. Complicated prior art may be better presented to a technically trained Examiner. Disclaimers in the file history that could distinguish over prior art may be ignored by the Examiner through dedication to the Patent Office's "broadest reasonable construction" standard.²¹¹

IV. General Procedural Matters

A. Filing Of Papers And General Form Considerations

1. Filing Electronically

²⁰⁹ See section V.A.3, *infra*.

²¹⁰ See sections I.D.2(c) and I.D.4, *supra*.

²¹¹ See, e.g., MPEP § 2258.I.G.

Documents in *inter partes* reexamination may be electronically filed as of 2007.²¹² Each document should be filed designating the “mail stop *inter partes* reexamination”²¹³ Filing may use a mailing certificate.²¹⁴

2. Significance Of Filing Electronically

Electronic filing can have implications that are not readily observable from the outside. For example, almost all document review by Examiners is now performed electronically, as it is apparently a monumental task to print out large volumes of paper within the Patent Office. If documents are submitted on paper, the pages must be scanned by staff within the Office, who may not present the papers in the same way presented by the parties. If filed electronically, the scanning step is avoided.

3. Useful Form Tips For Electronic Documents

Because review of papers usually happens electronically, Examiners do not have the ability to annotate documents in arbitrary ways, or jump between documents as easily as they could using paper. Furthermore, it may be difficult for Examiners to see document boundaries that would otherwise easily be known through staples or binder clips. It is therefore important for practitioners to carefully maintain document breaks and to place identifying information in the documents themselves. For example, a top-level table of contents can be provided with page numbers to Exhibits, with the start of each document being bookmarked and indicated in the document with a cover sheet. In addition, it is useful to attach a footer that reads, for example, “Exhibit ___, page ___ of ___”. This can help Examiners navigate documents more quickly.

B. Service

Any document filed by a representative of the Patent Owner or Third Party Requester in an *inter partes* reexamination must be served on the opposing party.²¹⁵ Although the language of 35 U.S.C. § 314(b)(1) and 37 C.F.R. § 1.903 would appear to exempt the Third Party Requester request itself from the requirement of service, in fact service is required even for the request.²¹⁶

1. When Service Must Be Effected

²¹² See Framework for EFS-Web, (November 29, 2007) p. 10, § XXII, at <http://www.uspto.gov/ebc/portal/efs/legalframework.pdf>.

²¹³ See 37 C.F.R. § 1.1(c)(2).

²¹⁴ See 37 C.F.R. § 1.8(a).

²¹⁵ See 37 C.F.R. §§ 1.903 and 1.915(b)(6).

²¹⁶ See 37 C.F.R. § 1.915(b)(6); MPEP § 2620.

The practical effect of the rules governing service is that service of a document must be effected the same day the document is filed with the Patent Office. Rule 1.903 does not expressly state when a document must be served, but does state that “[a]ny document must reflect service or the document may be refused consideration by the Office.”²¹⁷ Rule 1.903 requires that documents be served according to rule 1.248, which in turn requires that “[p]apers filed in the Patent and Trademark Office which are required to be served shall contain proof of service”. It is difficult to see how a “proof of future service” could be accepted by the Patent Office.

That being said, rule 1.903 does not require that the Patent Office refuse entry of any paper not properly served. Instead, the Patent Office “may” refuse to consider such documents, and in fact the Patent Office sometimes exercises its discretion to avoid technically harsh results.²¹⁸

The most typical error forgiven by the Patent Office is the failure to include a certificate of service with the document filed. In most cases, a responsible official from the Patent Office will call the representative of the filing party and request that a certificate of service be filed.²¹⁹ This practice is reflected in the current version of the MPEP.²²⁰

2. How Service is Effected

Service must be effected according to the requirements of 37 C.F.R. § 1.248. This section can be difficult to understand and is worthy of some discussion.

3. The Person On Whom Service Must Be Made

Rule 1.248(a) provides that the service of papers must be on the attorney or agent of a party, not the party itself. The only exception is where a party is not represented. The

²¹⁷ 37 C.F.R. § 1.903.

²¹⁸ See, e.g., *inter partes* reexamination 95/000074 (2007-10-18 Petition Decision, p. 12) (“Because the October 12, 2006 patent owner response was not served on the third party requester by the October 12, 2006 due date, however, the Office had the option of refusing consideration of this response pursuant to 37 C.F.R. 1.903, 37 C.F.R. 1.939(a), and MPEP 2667 II A 3. In view of the Office’s prolonged delay in reviewing the documents filed on October 12, 2006, and in view of the statutory requirement to conduct *inter partes* reexamination proceedings with special dispatch, however, the Office is exercising its option to address the October 12, 2006 patent owner response.”).

²¹⁹ See, e.g., *inter partes* reexamination 95/000074 (2007-10-08 Petition Decision, FN 3).

²²⁰ See MPEP § 2666.06 (“Where no proof of service is included, the Central Reexamination Unit (CRU) may contact the party making the submission by telephone to see whether the indication of proof of service was inadvertently omitted from the party’s submission (however, there was actual service).”).

attorney or agent of the Patent Owner is always the person who is listed as the correspondent under 37 C.F.R. § 1.33, however illogical or impractical this may seem in any particular case. Even where the Third Party Requester knows that the correspondence counsel of record (typically the *ex parte* prosecution counsel) has not been retained to represent the Patent Owner with respect to the *inter partes* reexamination, it must still serve on the correspondence counsel.²²¹ Of course, there is nothing preventing the Third Party Requester from generously serving papers on both the correspondence counsel and the Patent Owner or its known *inter partes* reexamination counsel.

4. The Way In Which Papers Must Be Delivered

There are several different ways to effect service according to rule 1.248. The most common way to serve another party is by placing a copy in first class U.S. mail with proper postage and addressing, under rule 1.248(a)(4). This entails several advantages. First, when served by U.S. mail, the date of service is the date the paper was placed in the mail. This provides tactical advantages especially when service is effected by a Patent Owner on a Third Party Requester, because the Third Party Requester's statutorily non-extendible 30-day period begins to run from the date of service,²²² not the date of receipt or the date the Patent Owner's response is due or filed. Thus, the postal delay cuts into the Third Party Requester's time to prepare comments.²²³ Furthermore, a Third Party Requester can become confused as to the expiration of its comment period (*e.g.*, by calculating it from the date the Patent Owner's response was due, the date of filing of the Patent Owner response, or the date of receipt by the Third Party Requester) and miss its hard deadline.

Service may also be effected by "delivering a copy of the paper to the person served".²²⁴ Such service does not require hand-delivery of the paper, only that the paper actually be received. So, for example, delivery by email, FAX, FedEx or any other means would qualify as service under rule 1.248(a)(1).²²⁵ Technically, a party serving under 37 C.F.R. § 1.248(a)(1) should have some way of knowing that the paper was actually received by the served party before it can attest to service in a certificate of service. However, the Patent Office has accepted

²²¹ See, *e.g.*, *inter partes* reexamination 95/000131 (2006-07-25 Decision, p. 2)(Service was held defective because the Third Party Requester chose to serve the unrecorded assignee and its attorneys, rather than the correspondent of record, the first-named inventor).

²²² See 35 U.S.C. § 314(b)(2).

²²³ Because of the current scanning delay in the PAIR system, it is unlikely that the Third Party Requester will be able to access the Patent Owner's filings online until after the posted papers arrive.

²²⁴ 37 C.F.R. § 1.248(a)(1).

²²⁵ See, *e.g.*, *inter partes* reexamination 95/000002 (2004-06-17 Decision pp. 2-3)(Service by email was proper service under 37 C.F.R. § 1.248(a)(1)).

a number certificates of service for papers “served” by certified mail, express mail or courier services.²²⁶

Under 37 C.F.R. § 1.248(a)(2) and (3), service may be effected by “leaving” a copy at the person’s usual place of business with someone in that person’s employment, or, if there is no such place of business, by leaving a copy at the person’s residence with a responsible member of the household. These provisions are rarely used because they require hand service and are more costly.

5. Certificate of Service

Every document must be filed with a proof of service.²²⁷ There are two alternative types of proof of service: (1) an acknowledgement of service²²⁸ or (2) a certificate of service.²²⁹

An acknowledgement of service is an acknowledgement by the person served (or that person’s authorized representative). The literal text of the rule requires that an acknowledgement of service include the served person’s name, the date of service and the manner of service, and that it be certified by the person making service.²³⁰ In those rare cases where the served party has actually admitted to being served, however, any formal requirements beyond the admission have not been enforced by the Patent Office.²³¹ The very fact that a Third Party Requester responds to a Patent Owner paper might serve as an acknowledgement of service, where the document was not otherwise available through PAIR, since the Third Party Requester would not have known of the filing but for service.

A certificate of service is a statement signed by the attorney or agent representing the party effecting service. The certificate of service can be attached as a separate document with its own header, or included in the text of the paper being served.²³² Since the Patent Office

²²⁶ See, e.g., *inter partes* reexamination 95/000013 (Request served by FedEx); *inter partes* reexamination 95/000002 (Patent Owner response served by certified mail, return receipt requested); *inter partes* reexamination 95/000009 (Request served by express mail);

²²⁷ See 37 C.F.R. § 1.248(b).

²²⁸ See 37 C.F.R. § 1.248(b)(1).

²²⁹ See 37 C.F.R. § 1.248(b)(2).

²³⁰ See 37 C.F.R. § 1.248(b).

²³¹ See, e.g., *inter partes* reexamination 95/000002 (2004-06-17 Decision pp. 2-3)(Third Party Requester acknowledged in its petition papers that it received a Patent Owner paper by email. The Patent Office held that this alone was proper proof of service).

²³² See 37 C.F.R. § 1.248(b).

will quickly review incoming papers for proof of service, however, it is recommended that any certificate of service be filed with the primary paper but under a separate caption and with its own heading indicating that it is a “Certificate of Service”.

There are several requirements for a Certificate of Service. First, the Certificate of service must actually make a certification.²³³ For example, a certificate of service usually begins with “I hereby certify that”, followed at the end by the certifier’s printed name and signature.²³⁴ Second, the certificate of service must indicate the date of actual service.²³⁵ Third, the certificate of service must indicate the manner of service (e.g. “by first class mail”).²³⁶ Fourth, the certificate of service must indicate the person on whom service is being effected.²³⁷ This person must be the correspondent listed according to 37 C.F.R. § 1.33.²³⁸ Fifth, the certificate of service must indicate which documents are being served, including any attachments²³⁹ and the certificate of service itself.²⁴⁰ Sixth, the certificate of service must be signed by the person making the certification.²⁴¹

²³³ See 37 C.F.R. § 1.248(b).

²³⁴ See 37 C.F.R. § 1.248(b).

²³⁵ See 37 C.F.R. § 1.248(b).

²³⁶ See 37 C.F.R. § 1.248(b); *inter partes* reexamination 95/000224 (2008-06-18 Petition Decision, p. 4).

²³⁷ See 37 C.F.R. § 1.248(b).

²³⁸ See, e.g., *inter partes* reexamination 95/000131 (2006-07-25 Decision, p. 2).

²³⁹ See *inter partes* reexamination 95/000020 (2007-03-15 Petition Decision, p. 6)(“It appears that the present Petition for Reconsideration was accompanied by the filing of a collection of FOIA material, and some material related to the Telenor documents. However, the Certificate of Service that accompanied patent owner's filing of all of the papers filed by patent owner on February 5, 2007 states only that counsel for patent owner ‘caused a copy of the foregoing 'PETITION PURSUANT TO 37 CFR § 1.181 OR, ALTERNATIVELY, 37 CFR § 1.182, OR, ALTERNATIVELY, 37 CFR § 1.181 TO RECONSIDER DECISION DISMISSING PETITION AND SUA SPONTE, 'RETURNING' PAPERS AND ENTER THE PAPERS INTO THE OFFICIAL RECORD’ to be served on the third party requester. It cannot be established from the language of the Certificate of Service that the papers accompanying the present Petition for Reconsideration (i.e., the copies of the FOIA material and the material related to the Telenor documents) were considered to be part of the petition and were, therefore, also served on the third party requester.”).

²⁴⁰ See, e.g., *inter partes* reexamination 95/000023 (2004-06-17 Decision pp. 2-3).

²⁴¹ See 37 C.F.R. § 1.248(b)(2); *inter partes* reexamination 95/000087 (2008-05-27 Office Action, p. 5).

It is worth noting that the Patent Office provides a short certificate of service in its *inter partes* reexamination request form.²⁴² This form has never been rejected. If additional documents are served beyond the request (such as declarations), however, it is worth amending the language to indicate that or providing an additional certificate of service.

C. Confidential Papers

Papers submitted to the Patent Office in a reexamination proceeding are by default public.²⁴³ If sensitive information or information subject to a protective order is to be submitted, there are essentially two ways of doing it. First, the sensitive information can be redacted, as long as the evidentiary value of the material is not impaired.²⁴⁴ Second, confidential materials may be submitted sealed in envelopes with the markings described in MPEP § 724.02. Such envelopes should be marked “proprietary”, “trade secret” or “subject to protective order”, and should be hand-carried to the Patent Office.²⁴⁵

Materials submitted under MPEP § 724.02 will become public if the Examiner finds them to be material to patentability, or if they are found to be non-material, but no petition to expunge under 37 C.F.R. § 1.59 has been granted by the time the reexamination certificate issues.²⁴⁶ The Patent Office has previously stated that the public has an interest in evaluating materials that bear on allowability in reexamination.²⁴⁷

V. The Request For *Inter Partes* Reexamination

As of the time of this writing, well over three hundred decisions on requests for *inter partes* reexamination had been issued by the Patent Office. The author’s study of a subset of these decisions has revealed a body of practice relevant to the formulation and filing of requests for *inter partes* reexamination.

A. Restrictions On Filing Requests For *Inter Partes* Reexamination

1. Patent Office’s Treatment Of “Original Application” And Filing Date Restrictions

²⁴² See MPEP § 2614.II.

²⁴³ See MPEP § 724.

²⁴⁴ See MPEP § 724; *inter partes* reexamination 95/000228 (2007-07-05 Petition Decision, p. 9).

²⁴⁵ See MPEP § 724.02.

²⁴⁶ See MPEP § 724.02.

²⁴⁷ See *inter partes* reexamination 95/000228 (2007-07-05 Petition Decision, p. 9).

An *inter partes* reexamination proceeding may only be requested for patents that issued from “original applications” filed on or after November 29, 1999.²⁴⁸ The phrase “original application” has been interpreted by the Patent Office to include any continuation, divisional, continuation-in-part or continued prosecution applications.²⁴⁹ This is regardless of whether the application can claim a priority date earlier than November 29, 1999.²⁵⁰ In addition, patents issuing from applications filed as PCT applications before November 29, 1999, but having a national stage entry date after November 29, 1999, qualify for *inter partes* reexamination.²⁵¹ The *inter partes* reexamination is not available, however, solely because a reissue application or a request for continued examination was filed after November 29, 1999.²⁵²

²⁴⁸ See 37 C.F.R. § 1.913(a). AIPA § 4608 states that the *inter partes* reexamination statutes “shall apply to any patent that issues from an original application filed in the United States on or after the date of enactment of [the] Act.” The AIPA was signed into law on November 29, 1999. The term “original application” is not defined by the AIPA.

²⁴⁹ See MPEP § 2611. The MPEP states that the Patent Office’s interpretation of “original application” is consistent with the use of that phrase in 35 U.S.C. § 251. Section 251, however, refers to an “original patent”, not an “original application”.

²⁵⁰ See MPEP § 2611. In the *Guidelines Concerning the Implementation of Changes to 35 USC §§ 102(g) and 103(c) and the Interpretation of the Term “Original Application” in the American Inventors Protection Act of 1999*, 1233 Off. Gaz. Pat. Office 54 (April 11, 2000), the Patent Office stated “[t]he phrase ‘original application’ is interpreted to encompass utility, plant and design applications, including first filed applications, continuations, divisionals, continuations-in-part, continued prosecution applications (CPAs) and the national stage phase of international applications. This interpretation is consistent with the use of the phrase in 35 U.S.C. 251 and the federal rules pertaining to reexamination. In addition, section 201.04(a) of the Manual of Patent Examination and Procedure (M.P.E.P.) defines an original application as ‘. . . an application which is not a reissue application.’ Section 201.04(a) of the M.P.E.P. further states that ‘[an original application may be a first filing or a continuing application.’ Therefore, the Optional Inter Partes Reexamination Procedure is applicable to patents which issue from all applications (except for reissues) filed on or after November 29, 1999. A patent which issued from an application filed prior to November 29, 1999 with a request for continued examination (defined in section 4403 of the Act) on or after May 29, 2000, however, is not eligible for the Optional Inter Partes Reexamination Procedure. A request for continued examination is not considered a filing of an application.”

²⁵¹ See *Guidelines Concerning the Implementation of Changes to 35 USC 102(g) and 103(c) and the Interpretation of the Term “Original Application” in the American Inventors Protection Act of 1999*, 1233 Off. Gaz. Pat. Office 54 (April 11, 2000).

²⁵² See *Guidelines Concerning the Implementation of Changes to 35 USC 102(g) and 103(c) and the Interpretation of the Term “Original Application” in the American Inventors Protection Act of 1999*, 1233 Off. Gaz. Pat. Office 54 (April 11, 2000).

The Patent Office’s interpretation of “original application” has been challenged twice, in *Cooper Technologies Co. v. Dudas*²⁵³ and *Alcatel USA Resources, Inc. v. Dudas*.²⁵⁴ In *Cooper*, the patent in question issued from an application filed April 14, 2003. The patent ultimately claimed the benefit of an application filed prior to November 29, 1999, however. The Patent Owner sued the Patent Office and requested an injunction against further *inter partes* reexamination proceedings. The court granted summary judgment for the Patent Office, finding that the Patent Office’s interpretation of “original application” was “fully consistent with the term’s established meaning in patent law”, and citing MPEP § 201.04(a).²⁵⁵ The Patent Office’s interpretation was also challenged in *Alcatel*, but the case apparently settled prior to a resolution of the issue.

In both cases, the plaintiff’s argument was based on the text of the enacting law as interpreted by comparison to 35 U.S.C. § 121. Section 4608 of the American Inventors Protection Act states that:

...this subtitle and the amendments made by this subtitle shall take effect on the date of the enactment of this Act [Nov. 29, 1999] and shall apply to any patent that issues from an original application filed in the United States on or after that date.²⁵⁶

The plaintiffs interpreted “original application” to mean the first (U.S.) application in the priority chain. To support their arguments, both plaintiffs pointed to the literal meaning of the word “original”, as well as the only other place in the patent statute where the phrase “original application” was used: 35 U.S.C. § 121. Section 121 provides that a divisional application shall be entitled to the benefit of the filing date of “the original application”.

The district court in *Cooper* appeared to agree with the plaintiff’s interpretation of section 121, but found that this use of “original application” was limited to the context of that section.²⁵⁷ The court granted summary judgment for the Patent Office. On appeal, the Federal Circuit reasoned that the term “original application” had no settled meaning in patent law.²⁵⁸

²⁵³ Case. No. 1:07-cv-00853-LMB-BRP (E.D. Va.).

²⁵⁴ Case No. 1:06-cv-01089-LMB-TRJ (E.D.Va.).

²⁵⁵ See *Cooper Technologies Co. v. Dudas*, Case. No. 1:07-cv-00853-LMB-BRP (E.D. Va.), Memorandum Opinion of Nov. 30, 2007.

²⁵⁶ AIPA § 4608 (emphasis added).

²⁵⁷ See *Cooper Technologies Co. v. Dudas*, Case. No. 1:07-cv-00853-LMB-BRP (E.D. Va.), Memorandum Opinion of Nov. 30, 2007, p. 11.

²⁵⁸ See *Cooper Technologies Co. v. Dudas*, 87 U.S.P.Q.2d 1705, 1712 (Fed. Cir. 2008).

The Patent Office's interpretation was therefore entitled to *Chevron* deference,²⁵⁹ and was upheld.²⁶⁰

Although the facts of *Cooper* were based on a continuation filing, the *Cooper* decision would appear to apply to all aspects of the Patent Office's guidance. Therefore, the more questionable aspects of the Patent Office's guidance, such as including a national stage entry in the concept of an "original application", are likely also entitled to *Chevron* deference.

2. Types Of Patents That Have Been Reexamined *Inter Partes*.

Inter partes reexamination is available for all patent types, including utility, design and plant patents.²⁶¹ A number of requests have been filed for design patents.²⁶² Perhaps due to the nature of the subject matter, requests related to design patents have so far experienced a relatively high denial rate.²⁶³

3. Restrictions On The Scope of Reexamination In Practice

When we speak of the scope of reexamination, we are speaking of the extent of the Examiner's ability to rule on certain issues. In general, there are two different contexts in which an Examiner may rule on an issue: in the determination to grant or deny reexamination, and in office actions. In the determination, the Examiner is required to determine whether the Third Party Requester has presented a substantial new question of patentability. In office actions, the Examiner is required to reject or confirm claims. The ability of the Examiner to act in each of these contexts is slightly different. For example, the Examiner is not allowed to base a finding of a substantial new question of patentability based on an issue under 35 U.S.C. § 112 (if not related to a priority claim), but can later reject an amended or new claim under 35 U.S.C. § 112.²⁶⁴

(a) Patents And Printed Publications

²⁵⁹ See *Cooper Technologies Co. v. Dudas*, 87 U.S.P.Q.2d 1705, 1710 (Fed. Cir. 2008).

²⁶⁰ See *Cooper Technologies Co. v. Dudas*, 87 U.S.P.Q.2d 1705, 1715 (Fed. Cir. 2008).

²⁶¹ See MPEP § 2611.

²⁶² See, e.g., *inter partes* reexaminations *inter partes* reexaminations 95/000034; 95/000082; 95/000083; 95/000086; 95/000159.

²⁶³ See, e.g., *inter partes* reexamination 95/000082; 95/000083; and 95/000159.

²⁶⁴ Compare MPEP § 2617 with 37 C.F.R. § 1.906(a).

Examination on prior art is restricted to “patents or printed publications”.²⁶⁵ The author is not aware of a case where non-patent or printed publication prior art was used as the basis for a rejection.

(b) Issues Under 35 U.S.C. § 112

The Patent Office is restricted in its ability to examine a patent for compliance with 35 U.S.C. § 112. The Examiner may not find a substantial new question of patentability based on a section 112 issue standing alone.²⁶⁶ While the statutes do not provide an express limitation on the Patent Office’s ability to reject claims on section 112 issues, the rules *affirmatively* state that reexamination shall proceed on the basis of the requirements of 35 U.S.C. § 112 “with respect to subject matter added or deleted in the reexamination proceeding”.²⁶⁷ The rules then state that issues other than those expressly provided for “will not be resolved in an *inter partes* reexamination proceeding”.²⁶⁸ If such issues are raised, the issues are to be noted by the Examiner in an office action, but otherwise not addressed.²⁶⁹

The Patent Office may, however, examine new or amended claims for support under 35 U.S.C. § 112.²⁷⁰ For amended claims, this examination is likely to be limited to those portions of the claims affected by the amendments.²⁷¹ The Patent Office may also examine claims under section 112 where the disclosure is amended.²⁷²

Where the section 112 issue arises through a question of priority, however, the Patent Office has sometimes examined the issue.²⁷³ The MPEP states in this regard that the

²⁶⁵ See 37 C.F.R. §§ 1.906(a), 1.915 and 1.923; MPEP §§ 2616 and 2617.

²⁶⁶ See MPEP § 2617.

²⁶⁷ See 37 C.F.R. § 1.906(a).

²⁶⁸ 37 C.F.R. § 1.906(c).

²⁶⁹ See 37 C.F.R. § 1.906(c).

²⁷⁰ See 37 C.F.R. § 1.906(a).

²⁷¹ See MPEP § 2658.II. (referring to MPEP § 2258); MPEP § 2258.II. (“Consideration of 35 U.S.C. 112 issues should, however, be limited to the amendatory (e.g., new language) matter.”).

²⁷² See 37 C.F.R. § 1.906(a).

²⁷³ See *inter partes* reexamination 95/000029 (2004-01-21 Office Action pp. 2-3)(holding that claim for alleged failure of base reference to support the claims under 35 U.S.C. §120 was examinable according to MPEP 2258 I.C.); *inter partes* reexamination 95/000196 (2007-04-19 Office Action, p. 4).

Third Party Requester, in its request, may point out that a certain claim is not entitled to priority under section 120 because the claim is not supported by the prior application.²⁷⁴

In *inter partes* reexamination 95/000166, the Patent Office held a substantial new question of patentability based on the qualification of an intervening reference a prior art was not *ultra-vires*, even though the basis for attacking priority was a lack of support. The Patent Office stated:

Patent owner attempts to characterize the grounds for reexamination proposed by requester and accepted by the examiner as whether the specification of the patent has adequate written description (under 35 U.S.C. 112 first paragraph) to support the claims. This mischaracterizes the request for reexamination and the order granting reexamination. Rather, the issue is whether the patent claims to be reexamined are entitled to benefit under 35 U.S.C. 120 of the filing date(s) of one or more prior filed applications, to thereby avoid the asserted art, or whether they are not so entitled. The issue of whether the instant specification satisfies the written description requirement of 35 U.S.C. 112 first paragraph is not raised nor implicated in the order granting reexamination. The first argument put forth by the requester with respect to the granting of priority for the '916 patent is based on the filing of a copy of a declaration in the '863 patent from the original '898 application, which perforce did not make reference to a concurrently filed preliminary amendment. Thus, it is argued, that under the rules then in effect, the preliminary amendment in the '863 patent is not part of the original filing and cannot be relied

²⁷⁴ See MPEP § 2617 (“The statement applying the prior art may, where appropriate, point out that claims in the patent for which reexamination is requested are entitled only to the filing date of that patent and are not supported by an earlier foreign or United States patent application whose filing date is claimed. For example, even where a patent is a continuing application under 35 U.S.C. 120, the effective date of some of the claims could be the filing date of the child application which resulted in the patent, because those claims were not supported in the parent application. Therefore, any intervening patents or printed publications would be available as prior art. See *In re Ruscetta*, 255 F.2d 687, 118 USPQ 101 (CCPA 1958), *In re van Langenhoven*, 458 F.2d 132, 173 USPQ 426 (CCPA 1972). See also MPEP § 201.11.”); see also MPEP § 2258 I.C. (“Rejections may be made in reexamination proceedings based on intervening patents or printed publications where the patent claims under reexamination are entitled only to the filing date of the patent and are not supported by an earlier foreign or United States patent application whose filing date is claimed. For example, under 35 U.S.C. 120, the effective date of these claims would be the filing date of the application which resulted in the patent. Intervening patents or printed publications are available as prior art under *In re Ruscetta*, 255 F.2d 687, 118 USPQ 101 (CCPA 1958), and *In re van Langenhoven*, 458 F.2d 132, 173 USPQ 426 (CCPA 1972). See also MPEP § 201.11.”).

upon for establishing priority. The second and related argument as to priority is simply that there is no support for certain specific claims of the '916 patent in the prior application. Pages 9-16 of the request are devoted to a detailed elaboration 18 of elements of claims 1-5, 9-10, 12-20, 23, 25-32, 34-35, 37, and 39-41 of the '916 patent, presenting specific arguments as to why the specification of the '918 patent does not provide written description support of these elements.²⁷⁵

In some cases, however, the Patent Office has not fully embraced the examination of section 112 issues under the guise of an examination of the priority date. In *inter partes* reexamination 95/000179, for example, the Third Party Requester suggested a rejection over a Canadian patent application in the same patent family as the patent under reexamination. The Canadian application had a disclosure identical to both the patent under reexamination and its priority application. The Examiner refused to find a substantial new question of patentability with respect to the Canadian application. The Third Party Requester petitioned for review. The Patent Office denied the petition, stating that if the patent under reexamination maintained its priority date, the Canadian patent would not be prior art. If the patent under reexamination did not maintain its priority date because the disclosure of the priority application did not support the claims under reexamination, however, then the Canadian application could not anticipate the claims, because the Canadian application would not be enabling to the same extent.

In denying the petition the Patent Office buttressed its reasoning by stating that the Third Party Requester's requested rejection would require the Patent Office to reexamine section 112 issues:

Moreover, reassessing the benefit claims in the '669 patent as to whether the invention of claim 12 is enabled by, or has the required written description, in the '490 application within the meaning of 35 USC § 112, first paragraph, is not proper in this instance because to reassess that issue with respect to the parent patent(s) would necessarily amount to a reassessment of that enablement issue with respect to the specification of the '669 patent. This is because the '669 patent was filed with the identical disclosure in the '490 application. However, the United States Patent and Trademark Office cannot conduct an initial reassessment off the original specification and claims of the 669 patent for compliance with 35 USC § 112, first paragraph in an *inter partes* reexamination proceeding before the Office, whether that initial reassessment is explicitly requested or merely implicit in the reexamination request.²⁷⁶

²⁷⁵ *Inter partes* reexamination 95/000166 (2007-12-12 Petition Decision, pp. 7-8).

²⁷⁶ *See inter partes* reexamination 95/000179 (2007-03-08 Petition Decision, p. 6).

Presumably, the Patent Office would not examine a section 112 issue relating to priority where that issue was previously *examined* in *ex parte* prosecution or a prior reexamination.

(c) Issues Under 35 U.S.C. § 101

The statutes, rules and MPEP say very little about examination under 35 U.S.C. § 101. Rule 1.906(c) appears in its catch-all clause to exclude examination on this section entirely.²⁷⁷ The MPEP states only that the Examiner may not find a substantial new question of patentability under section 101,²⁷⁸ and that the Third Party Requester should not include comments related to section 101 in its request.²⁷⁹

Although no specific exception is made for the examination of new or amended claims under section 101, as is the case for section 112, the Patent Office might reject under section 101 a new or amended claim not directed to statutory subject matter.²⁸⁰

(d) Inventorship

Inventorship determinations have generally not been available to the Patent Office as a basis for finding a substantial new question of patentability or for rejecting the claims.²⁸¹ The Patent Owner, however, may submit a petition to correct inventorship during an *inter partes* reexamination,²⁸² which may open up the issue for examination.

(e) Inequitable Conduct

Inequitable conduct and fraud are generally not within the scope of an *inter partes* reexamination.²⁸³ The Patent Office states in its guidance that it will not find a substantial new question of patentability based on a charge of inequitable conduct, nor will the Patent Office

²⁷⁷ See 37 C.F.R. § 1.906(c) (“Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in an *inter partes* reexamination proceeding.”).

²⁷⁸ See MPEP § 2617.

²⁷⁹ See MPEP §§ 2616 and 2617.

²⁸⁰ See, by analogy, 37 C.F.R. § 1.906(a).

²⁸¹ See, e.g., *inter partes* reexamination 95/000055 (2006-10-13 Letter p. 6) (A Third Party Requester petition challenging inventorship determination was returned and not considered).

²⁸² See 37 C.F.R. § 1.941(l); *inter partes* reexamination 95/000055 (2006-10-13 Letter pp. 5-6).

²⁸³ See 37 C.F.R. §§ 1.906(a)-(c); MPEP §§ 2616 and 2617.

examine such claims.²⁸⁴ As one might expect, this has not prevented Third Party Requesters from slinging the occasional fistful of mud in the direction of the Patent Owner.

The Patent Office has recently taken a tough stance with regard to allegations of inequitable conduct. The Rule 1.906 states that where an issue not within the scope of reexamination is raised by a party, it is to be noted in the next office action and not further examined.²⁸⁵ In 2007, however, the Patent Office went beyond this requirement and returned papers that contained allegations of wrongdoing.²⁸⁶ For example, in *inter partes* reexamination 95/000096, the Patent Office refused to enter comments of a Third Party Requester, finding that:

[t]his discussion alleging fraud, misconduct, gamesmanship, lack of good faith, and inequitable conduct has no bearing on how any patents or printed publications might establish or raise a substantial new question of patentability (SNQ) or provide basis for a rejection or proposed rejection of record based on patents or printed publications; it simply does not go to the merits of the proceeding. Further, this discussion is not limited to issues raised by the Office action and the patent owner's response, as is required by statute and rule. There is simply no statutory authority for entry of such discussion (information) into the patent....It is also observed that the presence of such information in the public record is detrimental to the record aside from the examination considerations. Its presence could potentially have a negative or prejudicial effect on the public perception of the patent, while there is no statutory authority for entry of such information into the patent.²⁸⁷

4. Protective Orders

²⁸⁴ See MPEP §§ 2616 and 2617.

²⁸⁵ See 37 C.F.R. § 1.906(c).

²⁸⁶ See, e.g., *inter partes* reexamination 95/000096 (2007-07-24 Letter, p. 3, FN 1); *inter partes* reexamination 95/000166 (2007-08-14 Notice, p. 5); *inter partes* reexamination 95/000227 (2007-12-19 Petition Decision, p. 4) (“[an] *inter partes* reexamination proceeding is a proceeding before an administrative agency. It is not litigation. Thus, tactics and comments that may be appropriate in the context of litigation must be carefully considered with respect to the requirements of 37 CFR 1.3 and 37 CFR 10.18(b) before such are incorporated in a paper filed before the Office. The parties are advised that a paper that contains inappropriate comments or otherwise does not comply with 37 CFR 10.18(b) will, at a minimum, result in return of the paper.”).

²⁸⁷ See *inter partes* reexamination 95/000096 (2007-07-24 Letter, p. 3, FN 1).

Where there is co-pending litigation, there is often a protective order with a “prosecution bar”, which prevents attorneys who have received confidential information from participating in patent prosecution.

Litigation attorneys for the Patent Owner in particular must be careful when it comes to participation in reexamination. The purpose of a prosecution bar is to prevent the confidential information obtained in discovery from being used to obtain more valuable patent rights. As a consequence, a prosecution bar could be applied to reexamination, even if limited by its terms to “applications”. Courts may not place as much emphasis on the distinction between “applications” and “reexaminations” as the Patent Office.²⁸⁸

B. Limitations On Filing A Request For *Inter Partes* Reexamination

Any person may file a request for reexamination, with two principal exceptions. First, the requester may not be the Patent Owner or a privy of the Patent Owner.²⁸⁹ This prevents the Patent Owner from submitting ostensibly Third Party Requester comments favorable to the Patent Owner’s position. The Patent Office appears to check assignment records to ensure that the request was filed by someone other than the Patent Owner or its privies.²⁹⁰ Second, the Requester may not be someone who is prevented from filing by the action of 35 U.S.C. § 317.²⁹¹

1. Patent Owner And Privity With The Patent Owner

The exclusion of the statute against the filing of requests by those in privity with the Patent Owner has not been interpreted expansively by the Patent Office.²⁹² According to the Patent Office, privies include those “not at arms [sic] length” with the Patent Owner.²⁹³ The words of the statute concerning who may file a request, however, are “broadly drawn”, and do

²⁸⁸ See, e.g., *Microunity Systems, Eng’g, Inc. v. Dell, Inc.*, Case No. 2-04-CV-120 (TJW), Order of August 17, 2005 (Denying a motion to clarify that a prosecution bar applying to “applications” did not include reexamination).

²⁸⁹ See 37 C.F.R. § 1.913 (“...any person other than the patent owner or its privies may...file a request...”).

²⁹⁰ See, e.g., *inter partes* reexamination 95/000062 (2004-12-21 Action, p. 1).

²⁹¹ See *inter partes* reexamination 95/000142 (2006-08-16 Petition Decision, p. 3).

²⁹² See *inter partes* reexamination 95/000120 (2006-07-19 Petition Decision, p. 13).

²⁹³ *inter partes* reexamination 95/000142 (2006-08-16 Petition Decision, p. 5).

not exclude “former privies”.²⁹⁴ A wholly owned subsidiary is a privy, as is counsel for the Patent Owner.²⁹⁵

2. Section 317 Limitations On Filing

The Requester may not be someone who is prevented from filing by the action of 35 U.S.C. § 317.²⁹⁶ See sections I.D.1 and I.D.2 for more information.

3. Where A Contract With A Forum Selection Clause Exists

The Patent Office has previously refused to terminate an *inter partes* reexamination based on a forum selection clause in a contract between the Third Party Requester and Patent Owner. In *inter partes* reexamination 95/000120, the Patent Owner filed a petition under 35 U.S.C. § 1.181 to vacate the reexamination order. The Patent Owner argued that the Third Party Requester had signed a settlement agreement that mandated all disputes be submitted to the U.S. District Court for the District of Delaware. According to the Patent Owner, the Patent Office act was *ultra vires* because the Third Party Requester had no “standing” to file a request. The Patent Office dismissed the petition, reasoning:

Neither has patent owner cited authority for the proposition that private parties, by agreement, may abrogate the statutory jurisdiction conferred upon the Office to decide the merits of a request for inter partes reexamination and to thereafter conduct an inter partes reexamination within the framework provided by the statutes and regulations. Second, a contractual provision preventing a party from seeking reexamination would be void as being contrary to public policy. In *Lear v. Adkins*, 395 U.S. 653, (1969), the United States Supreme Court determined that prohibiting licensees from challenging the validity of a patent that they had licensed runs afoul of public policy "in permitting full and free competition in the use of ideas which are in reality part of the public domain." *id.* at 670. By analogy, preventing a third party requester (and a potential licensee of the subject patent) from requesting reexamination of a patent would be contrary to the public policy embodied in the *Lear v. Adkins* decision.²⁹⁷

²⁹⁴ See *inter partes* reexamination 95/000120 (2006-07-19 Petition Decision, p. 13); *inter partes* reexamination 95/000142 (2006-08-16 Petition Decision, p. 3).

²⁹⁵ See *inter partes* reexamination 95/000142 (2006-08-16 Petition Decision, p. 5).

²⁹⁶ See *inter partes* reexamination 95/000142 (2006-08-16 Petition Decision, p. 3).

²⁹⁷ *Inter partes* reexamination 95/000120 (2006-06-07 Petition Decision, pp. 3-4).

It is important, however, to note the comments of the court overseeing a co-pending infringement litigation where the same agreement was implicated:

Respectfully, the court owes no deference to the Patent Office's interpretation of the legal effect of the Agreement or, more generally, the legality of a provision that purports to prevent parties from filing *inter partes* reexaminations. The reexamination at issue having been filed, and a substantial new question of patentability recognized, the Patent Office was clearly within its jurisdiction to dismiss plaintiff's request to halt the proceedings. It does not follow, however, that defendant was not in breach when it filed its *inter partes* reexamination request in the first instance.²⁹⁸

4. Where There Is An Agreement Not To Challenge Validity

The Patent Office has also previously refused to enforce an agreement by the Third Party Requester not to challenge validity. In *inter partes* reexamination 95/000155, the Patent Owner petitioned for *vacatur* and redesignation as an *ex parte* reexamination because the Third Party Requester had signed an agreement to support the validity of the patent. The Patent Office found that "to the extent that petitioner's argument for both *vacatur* and redesignation as an *ex parte* proceeding is based on the position that the requester has contractual obligations to patent owner with respect to supporting the validity of the patent, the forum for enforcement of such obligations is the courts, not the Office."²⁹⁹

5. Where There Is Assignor Estoppel

Likewise, the Patent Office has refused to use the doctrine of assignor estoppel to prevent a Third Party Requester from requesting an *inter partes* reexamination. In *inter partes* reexamination 95/000142, the Patent Office considered a petition to vacate the proceedings on the grounds that there was no "third party Requester". The Patent Owner contended that because the Requester was a former CEO of the Patent Owner and inventor on the patent, he was a privy to the Patent Owner, and thus barred under 37 C.F.R. § 1.913. The Patent Owner also noted that the Requester had been barred before the ITC from challenging the validity of the patent under the doctrine of assignor estoppel.

The Patent Office reasoned that 35 U.S.C. § 311 created a statutory right for anyone but the Patent Owner, and that 37 C.F.R. § 1.913 merely clarified that this right applied to anyone the Patent Owner could not control. Said the Patent Office: "[t]herefore, absent citation of authority holding that assignor estoppel applies to reexamination so as to bar a statutorily approved request for *inter partes* reexamination filed by '[A]ny third-party requester

²⁹⁸ *Callaway Golf Co. v. Acushnet Co.*, 523 F.Supp.2d 388, 405 (D.Del. 2007).

²⁹⁹ *Inter partes* reexamination 95/000155 (2007-03-08 Petition Decision, pp. 7-8).

at any time,' assignor estoppel has not been shown to apply generally to reexamination, and specifically to the present *inter partes* reexamination proceeding.”³⁰⁰

6. Where There Is Collateral Estoppel

The Patent Office has promulgated guidance on its intended application of collateral estoppel. If a district court adjudges a patent not invalid, the Patent Office maintains that the judgment will not collaterally estop the Third Party Requester from proceeding in an *inter partes* reexamination.³⁰¹ Instead, where a judgment of non-invalidity has been issued, the Patent Owner must rely on the provisions of 35 U.S.C. § 317.³⁰² The effect of the doctrine of collateral estoppel and the statutory estoppel of section 317 are not necessarily coextensive.

The Patent Office has indicated, however, that a form of collateral estoppel will be enforced against the Patent Owner should a patent be found invalid in a final court decision.³⁰³ A “final decision” is one which stands after all possible appeals have been exhausted.³⁰⁴ If all claims are held invalid, the *inter partes* reexamination will be terminated.³⁰⁵ If fewer than all claims are invalid, the *inter partes* reexamination may continue as to valid claims.³⁰⁶

7. Substituting The Third Party Requester

It is difficult to substitute one Third Party Requester for another after a proceeding has begun. In *inter partes* reexamination 95/000201, a non-party petitioned to be substituted as the Third Party Requester after the original Third Party Requester settled a co-pending litigation. The Patent Office denied the petition, stating that the non-party could file a

³⁰⁰ *Inter partes* reexamination 95/000142 (2006-08-16 Petition Decision, p. 7); *See also inter partes* reexamination 95/000155 (2007-03-08 Petition Decision, pp. 4-6)(The first-named inventor, who had been barred by a district court from challenging the validity of the patent under the doctrine of assignor estoppel, was not in privity with the Patent Owner under 37 C.F.R. § 1.913, because he had divested himself of all interest in the patent and was no longer associated with the Patent Owner).

³⁰¹ *See* MPEP § 2686.04.II. Of course, if a final judgment of non-invalidity issues in a case where the Third Party Requester is also a party, the estoppel of 35 U.S.C. § 317(b) will bind the Patent Office.

³⁰² *See supra*, section V.B.2.

³⁰³ *See* MPEP § 2686.04.IV.

³⁰⁴ *See* MPEP § 2686.04.IV.

³⁰⁵ *See* MPEP § 2686.04.IV.

³⁰⁶ *See* MPEP § 2686.04.IV.

request for *inter partes* reexamination, but also noting that a different substantial new question of patentability would be required.³⁰⁷

In many cases, the Third Party Requester is an attorney, and the client is the real party in interest. It is questionable how the Patent Office would react to a petition to add a real party in interest, or even to add another attorney and real party in interest.

C. Where Third Parties Have Failed To Meet Form Requirements

There are a number of form requirements to a request for *inter partes* reexamination that are relatively strictly enforced. Most of the formal requirements are specified in 37 C.F.R. § 1.915, although some are not apparent from the text of the rules. No filing date will be granted unless all formal requirements are met.³⁰⁸

1. Notice of Incomplete Request

Failure to file in the proper form has usually resulted in the Patent Office issuing a “Notice of Incomplete Request For *Inter Partes* Reexamination”, sometimes also called “Notice of Failure to Comply with Inter Partes Reexamination Request Filing Requirements” Such a notice generally sets a short time frame to reply. Fifteen days is a typical response period, although seven days is not unheard of.³⁰⁹ The Third Party Requester must therefore be especially conscious of incoming Patent Office mail during the time period immediately after filing and monitor the PAIR database on a daily basis for transaction history indicating that such a notice has been mailed. It is probably worthwhile to docket a call to the CRU two weeks after filing to make sure that no notice was mailed.

A Third Party Requester may respond to a Notice of Incomplete Request by supplying the incomplete portions. If, however, the notice relates to a failure by the Third Party Requester to submit a detailed explanation for all claims / prior art documents, the Third Party Requester may simply withdraw portions of the prior art or claims for which reexamination was requested.³¹⁰ In most cases, the Third Party Requester will be given only one opportunity to correct the request.³¹¹

³⁰⁷ See *inter partes* reexamination 95/000201 (2008-02-08 Petition Decision, p. 6).

³⁰⁸ See MPEP § 2615; 37 C.F.R. § 1.919.

³⁰⁹ See, e.g., *inter partes* reexamination 95/000134 (2006-03-20 Notice, p. 1)(Setting a seven day period for response to a Notification of Incomplete Request for *Inter Partes* Reexamination).

³¹⁰ See MPEP § 2617.I.

³¹¹ See MPEP § 2627.A.2.(“Thus, absent extraordinary circumstances, requester will be given only one opportunity to correct the non-compliance.”).

2. Frequency And Effect of Notice of Incomplete Request

Notices of Incomplete *Inter Partes* Reexamination Requests were relatively rare before the issuance of new Patent Office Reexamination request guidelines on August 4, 2006 (retroactive to March 26, 2006).³¹² Between *inter partes* reexaminations 150 and 200, 56% of the Third Party Requesters received at least one of these notices. By far the largest culprit was the citation of prior art references in an IDS which were not used as the basis of a proposed rejection.³¹³ Coming in a distant second was the failure to list the real party in interest.

The rules were also amended during the 2006 time frame to mandate that Third Party Requesters meet all filing requirements in order to receive a filing date.³¹⁴ Thus, one of the principal effects of filing an incomplete request is a delay of one or more months, sufficient for the Patent Office to send out a notice and for the Third Party Requester to respond.

Requests are initially reviewed by the CRU Legal Instruments Examiners and paralegals.³¹⁵ If the request is incomplete and the Third Party Requester gets lucky, the CRU will simply call the Third Party Requester and request the submission of supplemental information,³¹⁶ although this has happened less frequently of late.³¹⁷ The Patent Office will most often call if the Third Party Requester fails to name the real party in interest, although there is no

³¹² See *Clarification of Filing Date Requirements for Ex Parte and Inter Partes Reexamination Proceedings*, 71 Fed. Reg. 44219 (August 4, 2006).

³¹³ Based on the author's study in this time frame, twenty-three such requests were held incomplete because of this requirement.

³¹⁴ See 37 C.F.R. § 1.919(a); *Clarification of Filing Date Requirements for Ex Parte and Inter Partes Reexamination Proceedings*, 71 Fed. Reg. 44219, 44219 (August 4, 2006) (“The United States Patent and Trademark Office (Office) is...revising the rules of practice in title 37 of the Code of Federal Regulations (CFR) to require that a request for *ex parte* reexamination or for *inter partes* reexamination must meet all the applicable statutory requirements in 35 U.S.C. 302 or 311 (respectively) and the regulatory requirements in § 1.510 or § 1.915 (respectively) before a filing date is accorded to the request for *ex parte* reexamination or for *inter partes* reexamination.”)

³¹⁵ See *Clarification of Filing Date Requirements for Ex Parte and Inter Partes Reexamination Proceedings*, 71 Fed. Reg. 44219, 44221 (August 4, 2006).

³¹⁶ See, e.g., *inter partes* reexamination 95/000081 (2005-03-15 Letter)(the Third Party Requester neglected to include an identification of the real party in interest. The CRU called the Third Party Requester and the Requester was allowed to supplement its response); *inter partes* reexamination 95/000169 (2006-09-06 Letter)(same).

³¹⁷ See, e.g., *inter partes* reexaminations 95/0000157; 95/000169; 95/000182; 95/000187; 95/000188; 95/000189.

guarantee that Third Party Requesters will be granted such grace in every case.³¹⁸ Even if the Patent Office assigns a filing date after an initial review, the Examiner may decide that the filing requirements were not met.³¹⁹

It is not clear whether the Patent Office must refund the filing fee to a Third Party Requester that does not respond to such a Notice, although it has been the Patent Office's practice to do so in those very few cases where the question has arisen.³²⁰

3. What To Do If A Notice Of Incomplete Request Is Missed

If the Third Party Requester can confirm that a notice has been mailed but not received, a call to the CRU should usually resolve the issue if there is time left to respond. If the short deadline is missed by the Third Party Requester (in which case the CRU will generally call the Third Party Requester's representative),³²¹ the Patent Office will not always vacate the *inter partes* reexamination. The Third Party Requester may refile the request and petition³²² for late acceptance of the request. The Third Party Requester should make the showing specified by MPEP § 711.03(c)II.³²³

4. Substantive Completeness – Opportunity To Amend

Unfortunately for Third Party Requesters, it is very difficult to substantively amend a request for *inter partes* reexamination once the request has been filed. Bald attempts at

³¹⁸ See, e.g., *inter partes* reexamination 95/000068 (2005-01-17 Notification)(the Third Party Requester neglected to include an identification of the real party in interest, and received a Notification of Incomplete Inter Partes Reexamination Request).

³¹⁹ See *Clarification of Filing Date Requirements for Ex Parte and Inter Partes Reexamination Proceedings*, 71 Fed. Reg. 44219, 44222 (August 4, 2006).

³²⁰ See *supra*, section VI.C.2; MPEP § 2615.

³²¹ See, e.g., *inter partes* reexamination 95/000031 (2004-01-13 Petition, p. 2).

³²² This has been accepted previously as a petition under 37 C.F.R. § 1.181(a)(3) where reconsideration of the Notice was also requested, *see id.*, although 37 C.F.R. § 1.182 is probably the appropriate rule if the petition is only for late entry.

³²³ See, e.g., *inter partes* reexamination 95/000031 (2004-02-13 Petition Decision, p. 2)(a Third Party Requester responded late to a Notice of Incomplete Request for Inter Partes Reexamination, stating that it did not receive the notice until it was past the 15-day deadline to respond. The Patent Office reasoned that under 1.915(d) a reexam *may* be vacated for failure to comply with the notice, but need not be. To prove that the paper was not received, the Patent Owner stated that the file was searched, and attached the docket entry where the notice would have shown up if, under normal circumstances, it had been received. The Patent Office granted the petition).

supplementation have usually failed.³²⁴ This has the practical effect that the Third Party Requester should request reexamination for all claims, using all prior art, in the first attempt. If the Third Party Requester needs to later add references, the Third Party Requester must meet the conditions of 37 C.F.R. § 1.948, which basically require the art to be newly discovered, or to be responsive to a finding of fact by the Examiner or a response by the Patent Owner.³²⁵

D. Patent Office Practice Concerning Substantial New Questions of Patentability

1. Patent Office's Application Of Legal Standard Governing Substantial New Questions Of Patentability

To have jurisdiction to order an *inter partes* reexamination, the Patent Office must find that the request raises a substantial new question of patentability.³²⁶ The Patent Office determines whether a substantial new question of patentability exists by determining whether there is a "substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable."³²⁷ The Third Party Requester is not obligated to propose a rejection that renders the claim invalid, but rather one that would require examination before it can be dismissed.³²⁸ Indeed, the Patent Office has previously found that a request raised substantial new questions of patentability but allowed the claims on the first office action.³²⁹

The *inter partes* reexamination standard of "substantial new question of patentability" is identical to the standard used in *ex parte* reexamination.³³⁰ Court decisions and

³²⁴ See *inter partes* reexamination 95/000075 (2005-03-17 Letter, p. 2). Note that 37 C.F.R. § 1.939(b) prevents substantive communications with the Patent Office after the request has been filed but before the first office action; *but see inter partes* reexamination 95/000067 (2007-11-27 Decision, p. 4)(*sua sponte* giving the Third Party Requester 30 days to clarify a proposed rejection over 25 references applied in any combination).

³²⁵ See section VIII.B.2, *infra*.

³²⁶ See 35 U.S.C. § 312.

³²⁷ MPEP § 2642.I.

³²⁸ See MPEP § 2642.I.

³²⁹ See, e.g., *inter partes* reexaminations 95/000009, 95/000097, 95/000103, 95/000191; 95/000195; 95/000219; 95/000279 and 95/000299.

³³⁰ See 145 Cong. Rec. E 1788, (1999); see also 145 Con Rec. S 14696 (1999); see also MPEP § 2642.I.; *inter partes* reexamination 95/000179 (2007-05-16 Petition Decision, p. 3).

the provisions of the MPEP dealing with this question are treated by the Patent Office as equally applicable to *inter partes* reexamination.³³¹

2. Patent Office Analysis Of “New” Questions Of Patentability

While the substantiality of questions raised by Third Party Requesters is rarely questioned, the newness is questioned with some regularity. The most typical challenge to “newness” involves an argument or finding that a reference used to support a proposed substantial new question of patentability was known to a prior Examiner. While this in and of itself does not prevent a finding that a substantial new question of patentability exists,³³² it forms the beginning of most reasoning moving to that conclusion.

The question of “newness” is constrained by the statute. Section 312(a) was amended in 2002 to state that “[t]he existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.”³³³ This effectively overruled prior law as expressed in *In re Portola Packaging*.³³⁴

In accordance with section 312(a), the Patent Office has interpreted the question of newness in a way that favors the Third Party Requester. A question of patentability is generally not new only if more or less exactly the same question has been decided in a previous examination.³³⁵

As formulated by the Patent Office in one case:

The standard for establishing whether a given prior patent or printed publication previously of record is barred from serving as the basis for a substantial new question of patentability is whether the document was applied on the record in the same manner it is now being applied.³³⁶

³³¹ See *inter partes* reexamination 95/000059 (2006-09-27 Petition Decision, FN 4).

³³² See 35 U.S.C. § 312(a).

³³³ 35 U.S.C. § 312(a); Public Law 107-273, 116 Stat. 1758, 1899-1906 (2002).

³³⁴ 110 F.3d 786 (Fed.Cir.1997).

³³⁵ See *inter partes* reexamination 95/000106 (2007-06-27 Petition Decision, p. 4)(citing *In re Recreative Technologies*, 83 F.3d 1394,38 USPQ2d 1776 (Fed. Cir. 1996)).

³³⁶ *inter partes* reexamination 95/000059 (2006-09-27 Petition Decision, p. 10).

According to the Patent Office, being applied on the record goes beyond merely citing the document or initialing a disclosure form.³³⁷ The Examiner must explicitly analyze the references on the record.³³⁸ If the Examiner did so, the Third Party Requester must in turn provide an analysis concerning the newness of any substantial question of patentability involving the reference, or risk denial of the request.³³⁹

³³⁷ See, e.g., *inter partes* reexamination 95/000059 (2006-09-27 Petition Decision, p. 7)(“Initially, it is to be noted that the placement of the examiner's initials adjacent one or more citations on a listing of prior art references submitted as part of a properly filed Information Disclosure Statement is not tantamount to a **detailed** consideration of those references, whether individually or in various combinations, with respect to the claims. As pointed out in MPEP § 609.05(b), the initials of the examiner placed adjacent to the citations on the listing of documents simply means that the information has been considered by the examiner in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. Consideration of documents that are being ‘flipped through,’ whether in a paper bundle of documents or as presented on a computer screen during a computerized search, is not an in depth consideration of the documents equivalent to an application of such documents to the claims of an application under examination, or a discussion of such documents on the record during the examination process. Even with respect to the more stringent standards for determining the existence of a substantial new question of patentability that apply to reexamination proceedings filed prior to November 2, 2002, MPEP § 2258.01 states ‘... the Office cannot presume that a prior art reference was previously relied upon or discussed in a prior Office proceeding if there is no basis in the written record to so conclude other than the examiner's initials or a check mark on a form Patent Office 1449, ITO/SB/OBA or 08B, or Patent Office/SB/42 (or on a form having a format equivalent to one of these forms) submitted with an information disclosure statement.’ Therefore, patent owner's arguments with respect to the mere initialing of citations on a listing of prior art as being indicative of consideration of a particular citation by the examiner are not persuasive.”)(emphasis in original).

³³⁸ See, e.g., *inter partes* reexamination 95/000059 (2006-09-27 Petition Decision, p. 10-11); *inter partes* reexamination 95/000039 (2004-07-13 Determination, p. 4)(“The record indicates that the Gudmundsen was cited by the patent owner during prosecution of the application which became the Kawasaki et al patent, but the relevance to the patentability of claims 1-4 was not discussed by either the examiner or the patent owner. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office. 35 U.S.C. 303(a). Accordingly, Gudmundsen raises a substantial new question of patentability as to claims 1-4, which question has not been decided in a previous examination of the Kawasaki et al patent.”).

³³⁹ See, e.g., *inter partes* reexamination 95/000106 (2007-06-27 Petition Decision, p. 5)(“This is a request for *inter partes* reexamination, and requester would be expected to provide the specifics of a proposed ground of rejection in compliance with the 35 U.S.C. 311(b)(2) requirement that that the request ‘set forth the pertinency and manner of applying cited prior art

Thus, it is entirely possible to use the same reference or combination of references used in a prior examination as the basis for a proposed substantial new question of patentability.³⁴⁰ If this is to be done, the reference or combination must be presented “in a new light”.³⁴¹ There are a number of ways that have been used to present a reference “in a new light”. First, if the reference was disqualified as prior art, presenting evidence that the reference is prior art can cast the matter in a new light. This might be done, for example, by proving the publication date of a reference,³⁴² or attacking the priority date of the patent if the reference is intervening. Where there is some doubt as to whether a reference was properly considered – *e.g.* because date information was not present, the Patent Office may find the question to be new.³⁴³

Second, if the Examiner misinterpreted the reference or the inventors mischaracterized the reference, evidence to that effect can be used cast the matter in a new light.³⁴⁴ Evidence of the Examiner’s misinterpretation can come, for example, from the

to every claim for which reexamination is requested’ [emphasis added]. The examiner would then either adopt, or not adopt, the proposed ground of rejection, and requester would have an appeal right as to the examiner’s decision. Had requester set forth the specifics of one or more proposed grounds of rejection, by setting forth the pertinency and manner of applying cited prior art to the claims, it would appear that the requester could have relied upon the providing of a ‘new light’ with respect to previously cited references, because the patent owner did not set forth the specifics of a rejection in its prior request for reexamination. Requester chose not to do so, and therefore failed to raise a different substantial new question of patentability.”).

³⁴⁰ See, *e.g.*, MPEP § 2614, Sample Request For *inter partes* reexamination, stating “[t]he Cooper reference was cited in the prosecution of U.S. Patent 9,999,999, but was never relied upon in any rejection of the claims.”

³⁴¹ See MPEP § 2642.II.A.

³⁴² See *inter partes* reexamination 95/000059 (2006-09-27 Petition Decision, p. 11)(“As to whether the issue of the date of publication may present a substantial new question of patentability, this is readily answered by the opinion in *Heinl v. Godici*, 143 F. Supp. 2d 593 (E.D.Va. 2001), where the court found that art cited in the original patent proceedings, but for which no findings as to their status as prior art were made in the original proceedings, could raise a substantial new question of patentability in light of evidence as to their status as prior art.”).

³⁴³ See, *e.g.*, *inter partes* reexamination 95/000086 (2008-08-08 Office Action, p. 3)(“The Patent Owner has stated that there is no Substantial New Question of Patentability. One of the reasons is because the prior art Gift Envelop samples #1 and #2 that Third Party Requestor relies upon as one of the new questions of patentability were already of record. However, no dates were provided by applicant in the Information Disclosure Statement of April, 2000, and the examiner could not have properly considered these references.”).

³⁴⁴ See *inter partes* reexamination 95/000106 (2007-06-27 Petition Decision, p. 4)(“In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be ‘presented/viewed in a new light, or in a different

Examiner's statements in office actions or in the reasons for allowance.³⁴⁵ Third, if the reference was missing a critical teaching, supplying another reference with the teaching to be used in combination can cast the matter in a new light.³⁴⁶

The Federal Circuit has considered the Patent Office's approach to evaluating "newness" in *In re Swanson*.³⁴⁷ There, the original patent had been rejected under 103, using the Deutsch patent as a secondary reference. The Patent Owner sued the Third Party Requester, and the Third Party Requester argued that claims 22 and 23 were anticipated by Deutsch. The jury found otherwise, and the Federal Circuit did not reverse the district court's failure to grant Judgment as a Matter of Law. The Third Party Requester then filed for *ex parte* reexamination. The Examiner and eventually the Patent Office Board found that Deutsch, now presented as an anticipatory reference, provided a substantial new question of patentability, and in fact anticipated claims 22 and 23.

The Patent Owner appealed to the Federal Circuit, arguing that the Patent Office's prior explicit examination of the Deutsch reference precluded the finding of a substantial new question of patentability. The Federal Circuit upheld the Patent Office's approach, stating:

[U]nder § 303(a) as amended, a reference may present a substantial new question even if the examiner considered or cited a reference for one purpose in earlier proceedings. Nothing in the statute creates an exception to this rule for references considered in the context of a rejection of prior claims. Indeed, such an exception would overwhelm the rule and thwart a central purpose of the amendment, to overrule *In re Portola Packaging*. In that case, as here, the issue was whether a piece of prior art relied on for a prior rejection could nevertheless create a new question of patentability

way, as compared with its use 'in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request.' This new light must be in terms of how to interpret the state of the 'pre-existing technology,' as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a 'new light' if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.").

³⁴⁵ See, e.g., *inter partes* reexamination 95/000007 (2003-03-12 Determination, p. 4).

³⁴⁶ See, e.g., *inter partes* reexamination 95/000059 (2005-08-08 Petition Decision, pp. 5-6)(citing references in addition to those cited to the *ex parte* examiner).

³⁴⁷ 88 U.S.P.Q.2d 1196 (Fed. Cir. 2008).

sufficient to warrant a reexamination. *See In re Portola Packaging*, 110 F.3d at 787-89. After the amendment to § 303, the answer to that question must be yes.³⁴⁸

In evaluating a substantial new question of patentability, the Examiner should “evaluate the context in which the reference was previously considered and the scope of the prior consideration and determine whether the reference is now being considered for a substantially different purpose.”³⁴⁹ Applying this standard and finding a new question of patentability, the Federal Circuit observed that “Deutsch was not evaluated as a primary reference that taught or made obvious the specific analytical method claimed.”³⁵⁰

The Federal Circuit also found that the jury’s verdict did not preclude a finding of substantial new question of patentability, reasoning:

[P]rior to *Ethicon* the Patent Office had held that a substantial new question of patentability would not be found if the same issue had been addressed by a federal court, *see In re Wichterle*, 213 U.S.P.Q. 868, 869 (Comm’r Pat. & Trademarks 1982), but it revised its position in the wake of *Ethicon*, instructing examiners that a final court decision of a claim’s validity will not preclude a finding of a substantial new question of validity based on the same art ‘because of the different standards of proof employed by the Federal District Court and the Office,’ MPEP § 2242. We agree with the Patent Office’s current position.³⁵¹

If the Patent Owner has advocated a claim scope in licensing talks or co-pending litigation that conflicts with the original Examiner’s understanding, it might be possible to use this to cast the matter in a new light. The author is not, however, aware of any case in which the Patent Office has found a substantial new question of patentability based on the litigation-induced claim construction positions of the Patent Owner.

In *inter partes* reexamination 95/000303, the Patent Office denied the request because it failed to show a previously examined reference “in a new light”. The patent had been reexamined twice on a reference. In the third request, the Third Party Requester provided dictionary definitions for several terms that had previously been found to be important to the patentability of the claims. The Patent Office denied the request, stating:

³⁴⁸ *In re Swanson*, 88 U.S.P.Q.2d 1196, 1204 (Fed. Cir. 2008).

³⁴⁹ *In re Swanson*, 88 U.S.P.Q.2d 1196, 1205 (Fed. Cir. 2008).

³⁵⁰ *In re Swanson*, 88 U.S.P.Q.2d 1196, 1205 (Fed. Cir. 2008).

³⁵¹ *In re Swanson*, 88 U.S.P.Q.2d 1196, 1203 (Fed. Cir. 2008).

There is no evidence that the meanings of the words provided by the Requester in this request for reexamination were not considered in the previous reexamination and request. As evidenced by the sources of the definitions, they are the common meanings for the terms. Further, claim language is interpreted in view of the disclosure. No evidence has been provided that shows that the terms in question have been interpreted in a way that would be inconsistent with the disclosure of Haberman or that the definitions provided would introduce something new into the consideration of the features. Therefore, it is clear that terms do not show the Catta reference in a "new light". In addition, the definitions provided by the Requester regarding the terms "slot" and "mount" do not change the fact that Catta does not show an upper surface having a slot or the first and second stringer members mounted to the same mounting surface of the vertical frame. Neither Vogt nor Kemp remedy the problems of the Catta reference as only Catta was discussed regarding the questioned features. As these issues were covered in the previous reexamination and request, no SNQP regarding claims 1 and 9 exists.³⁵²

3. Questions Of Patentability In Co-Pending Reexaminations And Reissues

The Patent Office has previously stated in guidance that a question of patentability is not new if the same question was raised in a prior request for reexamination, even if the proceeding resulting from the request has not concluded.³⁵³ The same prior art may be used, but it must be presented "in a new light".³⁵⁴

³⁵² 95/000303 (2007-12-13 Determination, p. 3)(emphasis in original).

³⁵³ See *Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending*, 1292 Official Gazette 20, March 1, 2005; *inter partes* reexamination 95/000106 (2007-06-27 Determination, p. 5)("As explained in the order denying reexamination, in accordance with MPEP 2640, if the subsequent request includes the art which raised a substantial new question in the earlier pending reexamination, then reexamination should be ordered only if the art cited raises a substantial new question of patentability which is different from that raised in the earlier pending reexamination. If the art cited in the subsequent request raises the same substantial new question of patentability as that raised in the earlier pending reexamination, the subsequent request should be denied."); *inter partes* reexamination 95/000286 (2007-11-19 Decision, p. 11)("Thus, since the requester has not explained how the SNQ in this instant *inter partes* reexamination is different from the SNQ raised in the pending *ex parte* reexamination (control number 90/007,706) and since the references are deemed to be cumulative to the previous prior art references as used in *ex parte* reexamination 90/007,706, then the cited prior art references fail to raise a substantial new question of patentability as to anyone of the

This raises the possibility that the Patent Owner can pre-emptively request an *ex parte* reexamination, thus preventing the Third Party Requester from requesting an *inter partes* reexamination on the same substantial new question of patentability. The Third Party Requester might argue that such pre-emption is improper, but the Patent Office has previously noted (in the context of a reissue application) that it is difficult to accuse the Patent Owner of manipulation when it is uncertain that the Third Party Requester will file a request:

Third party requester also argues that patent owner's reissue application is an "attempt to 'moot'" statutory rights and is contrary to the reexamination statute. It is, however, difficult to see how the filing of a reissue application more than six months prior to the filing of an *inter partes* reexamination request filed for the same patent is an "attempt" to do anything with respect to the subsequently filed (i.e., then non-existent) request for *inter partes* reexamination.³⁵⁵

If a claim is rejected in a reissue application, and the reissue application is subsequently abandoned, there is likely to be a substantial new question of patentability based on the rejection in the reissue proceeding.³⁵⁶

4. Specific Instances of Art Before *Ex Parte* prosecution Examiner

A number of specific cases have been decided which give insight into the Patent Office's interpretation of "newness". In *inter partes* reexamination 95/000007, the Third Party Requester requested reexamination based in part on a reference that had been explicitly examined during *ex parte* prosecution. The Third Party Requester noted that the primary reference had been cited to the Examiner and the Examiner had initialed the reference, but argued that the Examiner had never rejected the claims over the reference. The Patent Office, in

Hitchcock patent claims. In view of the above statements, the request for reexamination is DENIED.").

³⁵⁴ See *Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending*, 1292 Official Gazette 20, March 1, 2005; *inter partes* reexamination 95/000106 (2007-06-27 Determination, p. 1) ("It is to be noted that reliance on prior art cited in the pending reexamination (old art) does not preclude the existence of a SNQ that is based exclusively on that old art. Determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request.").

³⁵⁵ 95/000269 (2007-11-28 Petition Decision, p. 10).

³⁵⁶ See MPEP § 2642.II.B.

finding that a substantial new question of patentability existed, found that the reasons for allowance indicated that the Examiner had not understood the reference as presented by the Third Party Requester.³⁵⁷

The Third Party Requester submitted a request based in part on a German reference that was included in the list of cited prior art on the face of the patent in *inter partes* reexamination 95/000033. The Patent Office found that the substantial question of patentability raised by the reference was new, because the full translation of the reference was not before the *ex parte* Examiner.³⁵⁸

In *inter partes* reexamination 95/000038, a Japanese Abstract was considered to raise a substantial new question because the *ex parte* Examiner misinterpreted a teaching based on an English / metric (mis)conversion. The mistake was apparently evident from the Examiner's reasons for allowance, and admitted by the Applicant in comments on the reasons for allowance.³⁵⁹

In *inter partes* reexamination 95/000101, the Patent Office did not order reexamination. The two primary references cited were before the *ex parte* Examiner, and the Patent Office did not believe there was any new teaching. The Third Party Requester cited another primary reference to supply an additional teaching, which, in the opinion of the Patent Office, did not teach that feature.³⁶⁰

Inter partes reexamination 95/000165 presented several situations. With regard to one reference, the Examiner in previous office actions had a different view of the features taught by the art than the Third Party Requester. Other references had not been applied on the record at all. The Patent Office found that these situations gave rise to substantial new questions of patentability, citing *In re Swanson*.³⁶¹

In *inter partes* reexamination 95/000185, the Third Party Requester filed a petition to vacate the proceedings as *ultra-vires*. The Patent Office examined previous prosecution with respect to two references, finding that very little detail was provided regarding the actual questions at issue. The Patent Office found that:

Since the specifics of the manner in which the technical teachings of the Japanese patent publication and the 5-400 Strip Vent publication might apply to the patentability of the '193 patent

³⁵⁷ See *inter partes* reexamination 95/000007 (2003-03-12 Determination, p. 4).

³⁵⁸ See *inter partes* reexamination 95/000033 (2004-07-08 Office Action p. 16)

³⁵⁹ See *inter partes* reexamination 95/000038 (2004-05-04 Determination, p. 3)

³⁶⁰ See *inter partes* reexamination 95/000101 (2005-09-22 Determination, pp. 4-5).

³⁶¹ See *inter partes* reexamination 95/000165 (2008-11-04 Petition Decision, pp. 8-9).

claims do not exist in the record of any prior proceeding related to the '193 patent or the '825 reissue patent, the discussion of these documents in the examiner's Order in the '185 *inter partes* reexamination proceeding in which the examiner found substantial new questions of patentability based on these documents must necessarily be based upon viewing these documents in a new light.³⁶²

E. Form Of Requests Typically Submitted

A broad range of requests have been submitted to the Patent Office, and almost all have been successful in eliciting a determination that a substantial new question of patentability exists. While it is probably correct to say that a thorough request with numerous proposed bases for rejection will have a higher chance of ultimate success, too few *inter partes* reexamination requests have been denied to be able to correlate the length of the request to success at the initial determination level.

1. Fee

The fee must for an *inter partes* reexamination be paid with the request for *inter partes* reexamination in order to receive a filing date.³⁶³ No notice of missing parts will be mailed establishing a filing date. Instead, the Third Party Requester will receive a Notice of Incomplete Request for Inter Partes Reexamination, setting a short deadline for compliance.³⁶⁴

To be safe, a blanket authorization to charge fees to a deposit account should be included. Be careful to read the authorization—if it is copied from an *ex parte* prosecution paper it may be limited in ways that make it difficult for the Patent Office to help the Third Party Requester.³⁶⁵ Also, because the fee for *inter partes* reexamination is substantial, firms with smaller deposit accounts will wish to notify the account manager of the potential fee.

There is no small entity status fee for requesting an *inter partes* reexamination.³⁶⁶

2. Identification Of Patent And Claims For Which Reexamination Is Requested

³⁶² *Inter partes* reexamination 95/000185 (2008-01-14 Petition Decision, p. 8).

³⁶³ See 37 C.F.R. § 1.915(a).

³⁶⁴ See section V.C.1, *supra*.

³⁶⁵ See, e.g., *inter partes* reexamination 95/000145 (2006-10-26 Petition Decision, FN 3)(restrictively interpreting an authorization to charge a deposit account relating to extensions of time apparently lifted from an *ex parte* prosecution form).

³⁶⁶ See MPEP § 2634.

The request must identify the patent for which reexamination is requested.³⁶⁷ This should be done by number, inventors and title.³⁶⁸ The request must also specify the claims for which reexamination is requested,³⁶⁹ which is usually done in a single sentence. As of October, 2006, the Patent Office is no longer examining claims not specified in the request.³⁷⁰

3. Post-Issuance Amendments Or Additions

Reexamination may only be requested for the claims that can be enforced at the time of the determination.³⁷¹ Thus, amendments or new claims in pending proceedings should be ignored.³⁷² The Third Party Requester should check to see whether a certificate of correction has been issued, or whether the patent is subject to a previously concluded reissue or reexamination proceeding. If a patent has been changed, then only the changed version may be reexamined. Any request based on the original patent will be denied.³⁷³

It is unclear whether the Patent Office will consider additional proposed substantial new questions of patentability that are directed to claims as amended in an unconcluded copending proceeding. The MPEP states that the decision on whether to grant a request will be made only on the patent claims in effect at the time of the determination:

The patent claims in effect at the time of the determination will be the basis for deciding whether a substantial new question of patentability has been raised (37 CFR 1.923). See MPEP § 2643. Amendments which (A) have been filed in a copending reexamination proceeding in which the reexamination certificate has not been issued, or (B) have been submitted in a reissue application on which no reissue patent has been issued, will not be

³⁶⁷ See 37 C.F.R. § 1.915(b)(1).

³⁶⁸ See MPEP § 2614.II.

³⁶⁹ See 37 C.F.R. § 1.915(b)(1).

³⁷⁰ See MPEP § 2640 (“The Office’s determination in both the order for reexamination and the examination stage of the reexamination will generally be limited solely to a review of the claim(s) for which reexamination was requested. If the requester was interested in having all of the claims reexamined, requester had the opportunity to include them in its request for reexamination. However, if the requester chose not to do so, those claim(s) for which reexamination was not requested will generally not be reexamined by the Office.”).

³⁷¹ See 37 C.F.R. § 1.923.

³⁷² See *inter partes* reexamination 95/000286 (2007-08-23 Notice, p. 2).

³⁷³ See MPEP § 2640.I.

considered or commented upon when deciding a request for reexamination.³⁷⁴

In the same section, however, the MPEP goes on to state that if there is reexamination request filed after another is already pending:

The second or subsequent request for reexamination may raise a substantial new question of patentability with respect to any new or amended claim which has been proposed in the first (or prior) pending reexamination proceeding. The substantial new question may be directed to any proposed new or amended claim in the pending reexamination, to permit examination of the entire patent package. It would be a waste of resources to prevent addressing the proposed new or amended claims, by requiring parties to wait until the certificate issues for the proposed new or amended claims, and only then to file a new reexamination request challenging the claims as revised via the certificate.³⁷⁵

4. Citation of Prior Art

(a) Citation Should Be Made In An IDS Form

The request must contain a “citation of the patents and printed publications which are presented to provide a substantial new question of patentability”.³⁷⁶ The citation usually takes the form of an information disclosure statement, on a form provided by the Patent Office for that purpose.³⁷⁷

(b) Certain References May Not Be Cited In IDS

The citation of prior art must include only those references used as the basis of a proposed rejection (a substantial new question of patentability), but not include background references, or references not directly relied upon as a basis for a proposed rejection.³⁷⁸ Note that

³⁷⁴ See MPEP § 2640.

³⁷⁵ See MPEP §§ 2640.II.A. and 2642.I.

³⁷⁶ See 37 C.F.R. § 1.915(b)(2).

³⁷⁷ See MPEP § 2614.

³⁷⁸ See 37 C.F.R. § 1.915(b)(3); 71 Fed.Reg. 44219 (August 4, 2006); *see, e.g., inter partes* reexamination 95/000147 (2006-08-09 Notice, p. 2)(“The present request has cited documents (patents and printed publications) on an Information Disclosure Statement, Form PT0 1449. The request does not, however, provide a ‘statement pointing out each substantial new question of patentability based on the cited patents and printed publications’ for each cited document, as is required by the first clause of 37 CFR 1.915(b)(3). Nor does the request provide

this is a reversal of the prior Patent Office requirement that all references listed in the request be cited on an IDS form.³⁷⁹

For example, suppose the request states in a background section that references A and B generally taught subject matter close to that of the patent claims. The request then states that the combination of references C and D raises a substantial new question of patentability for claim 1. The request provides a detailed explanation of how to apply references C and D to claim 1. In doing so, the request relies on reference E to show how a person of ordinary skill in the art would have interpreted a teaching in reference D. In this case, the Third Party Requester should cite in its information disclosure form only references C and D. In the Patent Office's view, these are the only references used as a basis to reject the claims. Any other citation of prior art will most likely lead to a Notice of Incomplete Request.

5. Number Of References Cited

According to the author's study of requests, there is wide variance in the number of references cited among requests. It is clear that certain requesters are focusing on making a limited and inexpensive request, while others are dumping litigation style prior art search results on the Patent Office. To the extent an average number is meaningful, the average number of references submitted as part of the proposed prior art rejection appears to be around ten.³⁸⁰

Anecdotal evidence indicates that the Patent Office is frustrated by large volumes poorly organized prior art submitted by Third Party Requesters. Focusing requests on a handful of the most relevant references may result in a faster proceeding and a less hostile Examiner.

6. Are Rejections Under 35 U.S.C. § 102 Necessary?

Third party requesters may, in preparing the request, feel pressure to characterize proposed questions of patentability as questions of anticipation rather than obviousness. This can occur for a number of reasons, including the wish to avoid admissions in a co-pending proceeding, the wish to force the Patent Owner to amend the claims (as opposed to arguing motivation or secondary considerations), or the belief that the Examiner will be more likely to find a substantial new question of patentability if the proposed rejection is put forward under 35 U.S.C. § 102.

a 'detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested,' as is required by the second clause of 37 CFR 1.915(b)(3).").

³⁷⁹ See, e.g., *inter partes* reexamination 95/000011 (2003-05-19 Decision, p. 4)(stating that old 37 C.F.R. § 1.915 had not been satisfied because not all of the references listed in the table of contents were cited in the IDS form).

³⁸⁰ Based on the author's study of the first 40 *inter partes* reexamination requests.

In general, the latter concern is unfounded. There appears to be no significant correlation between the type of proposed rejection and its chance of success. Rejections under section 103 as readily accepted as those under section 102.³⁸¹

If anything, it is more dangerous before the Patent Office to stretch a reference in order propose a 102 rejection where such is not well-founded. This can result in refusal to reject based the art under any section.³⁸² The Examiners will generally not sift through the Third Party Requester's proposed rejections under section 102 to find possible combinations of references under section 103. Proposing 102 and 103 rejections in the alternative has in the past led to a rejection under section 103.³⁸³

In *inter partes* reexamination 95/000009, the Board of Appeal criticized a practitioner for maintaining an improper rejection under section 102. The claim under review required "60 micron-sized nylon 12 particles", and the alleged 102 reference taught the same type of particles in a size range of 30-200 microns.³⁸⁴ The Board held:

At the oral argument, [the Third Party Requester's] representative...was asked to explain how this limitation was met. He could not do so yet he also declined the panel's invitation to withdraw the proposed anticipation rejection for claim 1. [Third Party Requester's] argument for the anticipation of claim 1 is frivolous. An argument is frivolous when, among other possibilities, a reasonable patent practitioner would not believe the reference taught the contested limitation....By maintaining a baseless assertion of anticipation without any plausible argument, [the practitioner] exceeded the limits of acceptable advocacy....*Inter partes* reexamination requesters and their proxies

³⁸¹ Based on the author's study of rejections in the first forty *inter partes* reexamination proceedings. See also SHANG, R. AND TCHAIKOVSKY, Y., *Inter Partes Reexamination Of Patents: An Empirical Evaluation*, A, 15 TEX. INTELL. PROP. L.J. 1, 12-13, 2006 (finding, based on the progress as of 2005 in the first 117 *inter partes* reexamination proceedings that more claims are rejected under section 103 than section 102).

³⁸² See, e.g., *inter partes* reexamination 95/000007 (2003-03-12 Office Action, pp. 4-16); *c.f.* *inter partes* reexamination 95/000009 (2003-04-07 Action Closing Prosecution, pp. 5-6)(finding the claims patentable in the first action in part because the proposed rejection under 102 did not adequately show anticipation, reasoning that "the requester states that 'there is overlap' because the two different sizes are 'prima facie equivalent', which is not within the realm of anticipation as required by 35 U.S.C. 102, but rather 35 U.S.C. 103.").

³⁸³ See, e.g., *inter partes* reexamination 95/000010 (2003-06-11 Office Action, p. 2).

³⁸⁴ See *inter partes* reexamination 95/000009 (2007-03-30 Board Decision, p. 3).

should not assume that they are impervious to procedural and substantive sanctions.³⁸⁵

The Board in this instance ultimately reversed the Examiner's finding that the claims were allowable, finding that the Examiner should have found them obvious over the same reference in combination with other references.³⁸⁶

7. Detailed Explanation Of Manner Of Applying Prior Art

The rules require that a detailed explanation of the manner of applying the prior art references cited. These should probably take the form of a list of proposed rejections for the Examiner,³⁸⁷ although this is rarely done by Third Party Requesters. A proposed rejection should be provided that corresponds to each substantial new question of patentability.³⁸⁸ A practical form for this part of the request involves two parts for each such proposed rejection. First, there is an introductory section that explains the legal basis as a proposed rejection. Second, a claim chart (or similar mappings of the features of the prior art to specific claim elements) is provided.³⁸⁹

8. Introductory Section

The purpose of the introductory section is to provide a legal context for what comes next: a specific mapping of prior art features to claim elements. In some cases where Third Party Requesters have simply submitted naked claim charts without providing an overall context, the request has been rejected as insufficient.³⁹⁰

³⁸⁵ *Inter partes* reexamination 95/000009 (2007-03-30 Board Decision, p. 4).

³⁸⁶ *Inter partes* reexamination 95/000009 (2007-03-30 Board Decision, p. 6).

³⁸⁷ Third Party Requesters are required to appeal proposed rejections that were not adopted. *See* 37 C.F.R. § 41.61(b)(2). For more information on proposed rejections, *see* section VIII.A.1, *infra*.

³⁸⁸ *See* MPEP § 2614. It appears that further proposed rejections (unrelated to proposed substantial new questions of patentability) could be provided, as nothing in the rules or statute prevents an Examiner from raising a rejection that does not raise a substantial new question of patentability.

³⁸⁹ *See* MPEP § 2617.I.

³⁹⁰ *See inter partes* reexamination 95/000011 (2003-05-22 Decision, p. 5). (the Third Party Requester stated in response to a deficiency notice that “[a] series of claim charts were given as appendices...to the request....[t]hus, this requirement has been complied with.” The Patent Office rejected this contention, stating “[t]he series of claim charts included in the request merely align certain limitations of the patent claims with certain portions of the references. The request does not go so far as to set forth each substantial new question of patentability, as

The introductory section should accomplish three things. First, it should specify the references used and their statutory basis for qualification as prior art.³⁹¹ If any proof is required to establish a reference as prior art, it should be explained here. Second, the introductory section should thoroughly explain why the proposed rejection raises a substantial new question of patentability.³⁹² Third, if a rejection under 35 U.S.C. § 103 is proposed, the Third Party Requester should make explicit in this section the motivation for combining the references, and/or the reasons that the claim would have been obvious over the reference or combination.³⁹³

9. The Request Should Include Proof Of Publication Date

required, nor does it provide any proposed manner of applying the references, as required. The information, as compiled, merely invites the examiner to consider the claim charts and determine *ab initio* whether any of the references (alone or in combination) raise a substantial new question of patentability. Such an invitation is not in compliance with 37 CFR 1.915(b)(3), which specifically requires the third party requester to identify all of the grounds on which the third party requester is relying as raising a substantial new question of patentability for consideration by the examiner. The request has been clearly indicated to be insufficient to comply with 37 CFR 1.915(b)(3). Since the response to the ‘Notice’ merely refers to the series of claim charts provided with the original request (in spite of the detailed instructions with examples as to how to complete the request), such response lends nothing to rectify these deficiencies of the original request.”).

³⁹¹ See, e.g., *inter partes* reexamination 95/000009 (2007-03-30 Board Decision, pp. 2-3)(“[Requester] is vague about which provision of § 102 applies....In failing to state a precise basis for the rejection, [Requester] arguably failed to make out a facially complete case in the first instance. The Examiner should not be placed in the position of having to guess what the requester really meant before proceeding with the examination....On different facts, the requester’s imprecision in proposing the rejection might have resulted in a simple affirmance [of the refusal to adopt the rejection] instead.”); See also section V.E.9, *infra*, discussing the requirements of publications in more detail.

³⁹² See section V.D.2, *supra*, discussing the requirements of newness.

³⁹³ See, e.g., *inter partes* reexamination 95/000103 (2005-09-29 Action Closing Prosecution, p. 5)(confirming claims on the first action, in part because of the Third Party Requester’s failure to cite a specific motivation to combine references in a proposed rejection under 35 U.S.C. § 103(a)); *inter partes* reexamination 95/000106 (2007-06-27 Petition Decision, p. 7); MPEP § 2617 (“For proposed obviousness rejections, requester must provide basis for combining the cited reference, and a statement of why the claim(s) under reexamination would have been obvious over the proposed reference combination. Preferably, the requester should quote the pertinent teachings in the reference, referencing each quote by page, column and line number, and any relevant figure number. The explanation must not lump together the proposed rejections or proposed combinations of references.”).

If a publication is a core reference in the Third Party Requester's request, it will pay to examine the reference to determine whether proof of actual publication and the publication date is necessary. The Patent Office has denied a small number of requests or proposed rejections based on the failure of the Third Party Requester to qualify key references as prior art.³⁹⁴

In the past, it has usually not necessary to support a reference that, on its face, describes its own publication and publication date.³⁹⁵ For example, a technical paper that, in the footer, states the name of the publication and the publication date would probably be accepted by the Patent Office as *prima facie* evidence of the qualification as prior art for the purpose of deciding whether to grant the request. If the publication is challenged by the Patent Owner, the Third Party Requester will likely be allowed to rebut the Patent Owner's challenge.³⁹⁶

If the reference is not self-qualifying in this manner, the Third Party Requester should submit evidence that the reference qualifies as prior art. This should include the declaration of a witness with first hand knowledge of the publication and date of publication. In *inter partes* reexamination 95/000082, for example, the Patent Office denied the request in part based on the failure of a declaration to provide "factual evidence to positively" identify images as associated with a publication or to establish a publication date. The declaration in question stated that the declarant had downloaded image files from a particular Web site, and these files

³⁹⁴ See, e.g., *inter partes* reexamination 95/000082 and *inter partes* reexamination 95/000083 (Denying reexamination in part because of the failure of the Third Party Requester to prove that images were posted on the World Wide Web by a date that would establish them as prior art); *inter partes* reexamination 95/000106 (2007-06-27 Petition Decision, p. 6)(denying reexamination based in part on the failure of the Third Party Requester to provide evidence that certain drawings were publications); *inter partes* reexamination 95/000107 (2005-11-09 Determination, p. 8) (denying reexamination based in part on the failure of the Third Party Requester to provide evidence of publication dates); *inter partes* reexamination 95/000195 (2007-04-18 Determination, p. 7)(refusing to find substantial new questions of patentability where drawings were not qualified as prior art).

³⁹⁵ See *inter partes* reexamination 95/000107 (2005-11-09 Determination, p. 8); *inter partes* reexamination 95/000020 (2007-03-30 Petition Decision, p. 10)(in rejecting a declaration from a forensic document expert challenging the date listed on certain references, the Patent Office reasoned "Mr. Browne's statement that there may be 'doubt' does not present any concrete basis to establish the likely truth of patent owner's allegations regarding the authenticity of the Telenor documents; nor does it carry patent owner's burden of rebutting the status of the Telenor documents as printed publications that are prior art to the '592 patent that is *prima facie* established by the dates on the document.")(emphasis in original).

³⁹⁶ See, e.g., *inter partes* reexamination 95/000231 (2007-06-20 Petition Decision, p. 5).

were recorded in his system with dates that would have established them as prior art, had they been published on those dates.³⁹⁷

In a related case, the Third Party Requester requested review of the refusal to order a reexamination based on the same declaration. The Patent Office reasoned:

[a]s noted above, the examiner did consider and address the Madgwick Declaration in making the determination to deny the request for *inter partes* reexamination. Upon consideration of the declaration, the assertions in the declaration were not found to be persuasive nor to be supported by factual evidence. With regard to the MPEP section referred to by petitioner, this section indicates that the affidavits and declarations should explain the contents or pertinent dates in more detail. For example, a declaration from a librarian attesting to the date a monthly magazine was received would be persuasive to establish the date of reference with the month indicated on the magazine. However, in the instant situation, the assertions in the declaration are an attempt to establish the reference date and not to explain a pertinent date in more detail. Although such assertions to establish the reference date have been considered, such assertions are not supported by factual evidence as indicated by the examiner, because no factual evidence is presented to identify and correlate the referenced images to a particular website nor is factual evidence presented which establishes a date that the images were posted.³⁹⁸

It is of interest to note in these cases that the Patent Office independently tried to verify the publication date of the images using a Web archiving service, and presumably would have relied on the output of the service:

[t]he U.S.P.T.O. has independently attempted to confirm the reference dates asserted by searching the Internet Archive at www.archive.org for the web pages noted in the Madgwick Declaration. However, although the Internet Archive shows, for example; that the blazekglass.com website had pages posted dating back to 1999, neither the pages nor the images that may have been included on the pages could be viewed. Therefore, the search results did not conclusively show that the images presented in the request for *inter partes* reexamination were available on the dates indicated in the Madgwick Declaration (Note that the July 21,

³⁹⁷ See *inter partes* reexamination 95/000082 (2005-05-11 Determination, pp. 3-4).

³⁹⁸ *Inter partes* reexamination 95/000083, (2005-10-25 Petition Decision).

2004 blazek-glass.com website page in the Internet Archive was viewable).³⁹⁹

It is important to note, however, that the Patent Office has the discretion to order reexaminations based on publications of somewhat questionable chronology. The standard applied where the Patent Office grants reexamination is thus more lenient with respect to publication dates:

The Order granting *inter partes* reexamination addresses the issue of the dates for the various publications. In doing so, it sets forth the examiner's concerns regarding variations between some of the documents as attached to the February 7, 2007 request for *inter partes* reexamination and the March 30, 2007 request for *inter partes* reexamination. The examiner has requested clarification from the third party requester on that issue. It is also clear that the examiner has expressed concerns regarding the dates of these documents. However, as pointed out above, it is only necessary to establish that a legitimate question be raised as to the date of the references, and here the examiner has gone further and determined that the documents are *properly datable as prior art to the '439 patent*.⁴⁰⁰

10. Mapping Of Prior Art To Claim Elements

After the introductory section, the Third Party Requester should provide a mapping of particular claim elements to the prior art. The mapping usually takes the form of a claim chart, and should cite the prior art with line-number specificity if possible.⁴⁰¹

There is an argument to be made, however, that claim charts should not be submitted. To make the adoption of the request easier, a Third Party Requester could mimic the style of an office action. Because Examiners only rarely use claim charts, it may make sense to present proposed rejections in paragraph format.

The most basic formal rule to remember in providing a proposed rejection is to be thorough. The Patent Office has refused requests that leave it up to the Examiner to provide the

³⁹⁹ *Inter partes* reexamination 95/000083 (2005-10-25 Petition Decision, p. 2); *inter partes* reexamination 95/000231 (2007-06-05 Petition Decision, p. 6) (“It is also to be noted that the Internet website at <http://www.archive.org> (known as the WayBackMachine) is a recognized source for archiving earlier versions of Internet Web Pages, and that web pages in fact qualify as printed publications.”).

⁴⁰⁰ *Inter partes* reexamination 95/000231 (2007-06-05 Petition Decision, p. 6)(italics in original, underlining added).

⁴⁰¹ See MPEP § 2617.I. See also the Patent Office sample request at MPEP § 2614.

relevant mapping for any proposed substantial new question of patentability.⁴⁰² Third Party Requesters sometimes make the mistake of listing a number of references, describing the teachings of each reference, and then making a statement that they can be combined in numerous alternative ways to render the claims invalid.⁴⁰³ This is likely to raise the hackles of the CRU.⁴⁰⁴ It also does not present a clean record for appeal, where the Third Party Requester will have to point out specific proposed rejections.⁴⁰⁵ The Third Party Requester should even avoid statements that indicate that multiple rejections could be made, but that the Third Party Requester is limiting itself in the spirit of conciseness.⁴⁰⁶

In *inter partes* reexamination 95/000107, for example, a fairly detailed discussion of the prior art in light of the invention was provided, but the discussion did not map specific portions of the cited art to each claim that was requested to be rejected. The Patent Office denied the request for *inter partes* reexamination, stating:

⁴⁰² See MPEP § 2617.I.; *see also, e.g., inter partes* reexamination 95/000103 (2005-09-29 Action Closing Prosecution, p. 3-4)(noting, in a first Action Closing Prosecution confirming the claims, that the Third Party Requester provided a claim chart, but that “when one reviews this claim chart, one finds that the requester never explains how each and every limitation of claim 1 might be met by the combined teachings/showings of the prior art.”).

⁴⁰³ *See, e.g., inter partes* reexamination 95/000107 (2005-11-09 Determination, pp. 9-11); *inter partes* reexamination 95/000067 (2007-11-27 Decision, p. 2)(“(the ‘Requester’) originally filed a Request for reexamination containing, among other arguments, an identification at page 18, of proposed rejections under 35 U.S.C. § 103 (advanced to provide a substantial new question of patentability) consisting of multiple permutations, i.e., potentially $(2^{25} - 1) = 33,554,431$ separate proposed rejections....the reexamination requester must provide ‘a ‘detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.’ Such has clearly not been provided for the multiple permutations presented.”); *inter partes* reexamination 95/000221 (2007-04-04 Decision, pp. 4-5); *inter partes* reexamination 95/000251 (2007-07-02 Decision, p. 4)(“Specifically, a request for reexamination is made for claims 1, 3, 4, 8-15, 18, 19, 23, 24, 26-30, 34, 36, 38, and 40-44 based upon Gross, Halpern et al., Rodriguez, and Heinzmann et al in view of Pendleton, Noonan, Covey, Kirpluk, Goetz, Henneberg, Hunt, Bailey, Granzow, Pirkle, Noble, Hillary, Killian, Delapp, Sweere, Sampson, Seiler, Rossmann, Brown, Trom, Randolph, Bradbury, or Richard (see page 2 of the request). This provides multiple permutations of combinations. The request then only presents a single combined explanation for these distinct proposed rejections applied to multiple claims.”); *inter partes* reexamination 95/000288 (2007-10-02 Decision, FN 2)(“‘Shot-gun’ statements, or lumping of multiple permutations of substantial new questions of patentability, is not permitted.”).

⁴⁰⁴ See MPEP § 2617.I.

⁴⁰⁵ See MPEP § 2674.

⁴⁰⁶ *See, e.g., inter partes* reexamination 95/000288 (2007-10-12 Decision, p. 2).

[t]he Third Party Requester is advised when writing a Request for Reexamination the teachings of the prior art should be referenced by line and column number. The Third Party Requester is reminded that in order to comply with 37 C.F.R. 1.915(b)(3) the Third Party Requester must specifically point out how each teaching of the prior art, for example by line and column number, relates to each recited feature of the patent claims....This raises a potential for numerous combinations of prior art in the rejection of the claims. The prior art in Appendices C-F and I-K, as proposed by the reexamination requester fail to comply with 35 U.S.C. § 311(b) and 37 C.F.R. 1.915(b)(3), because the request does not adequately set forth the pertinency and manner of applying, to the claims, the cited prior art individually, or the full (wide) scope of combination rejections for the cited prior art. The request lacks a sufficiently detailed explanation of how each of the cited prior art, individually, are applied to the claims, or of how each of the different combinations of prior art is being individually (per proposed combination) applied to the claims.⁴⁰⁷

11. Copies Of References Cited

All prior art references “referred to” in the request must be submitted.⁴⁰⁸ This goes beyond the references listed in the IDS, which should only comprise references used in a proposed rejection to teach elements of the claims.⁴⁰⁹ For example, if the request uses a first reference to explain the teaching of a second reference which is used in a proposed § 102(b) rejection, copies of both references must be submitted, whereas only the second reference may be listed in the IDS. The Patent Office is currently not enforcing this requirement, however, to require copies of U.S. patents or U.S. patent publications.⁴¹⁰

If any reference is not in English, a translation of the pertinent passages must be submitted.⁴¹¹ A translated abstract or summary is not sufficient, if there is relevant material not available in the abstract.⁴¹² The translations do not need to be verified. Because the Third Party Requester is not protecting its patent rights, the concerns of that a Patent Owner would have

⁴⁰⁷ *Inter partes* reexamination 95/000107 (2005-11-09 Determination, pp. 9-11).

⁴⁰⁸ *See* MPEP § 2618.

⁴⁰⁹ *See* section V.E.4(b), *supra*.

⁴¹⁰ *See* MPEP § 2656.

⁴¹¹ *See* 37 C.F.R. § 1.915(b)(4); *inter partes* reexamination 95/000251 (2007-07-02 Decision, p. 5).

⁴¹² *See* MPEP § 2618.

submitting only a portion of a reference rather than the full reference, and the subsequent possibility that this could be construed as inequitable conduct, are not as pronounced.

If the Third Party Requester wishes to have a fast *inter partes* reexamination proceeding, it may be advisable to submit the file history of any relevant *ex parte* prosecution or prior *inter partes* reexamination, including the cited references. This is because the necessary files may not be immediately available to the Examiner when the case is docketed for review (in particular, the Patent Office may not initially realize that certain file histories are relevant).⁴¹³

In *inter partes* reexamination, the exception of 37 C.F.R. § 1.98(d)(1) does not apply to information disclosure forms. This exception provides that copies of references cited in prior cases for which benefit is claimed under 35 U.S.C. § 120 need not be provided in the application in which the IDS is being submitted. Because the reexamination does not claim the benefit of a prior application, however, rule 1.915(b)(4) applies instead.⁴¹⁴

12. Copy Of Patent For Which Reexamination Requested

The request must provide a copy of the patent. The copy of the patent must be one-sided, should be in two column format, and must include all parts.⁴¹⁵ The standard image format available from numerous online sources, printed one-sided, will suffice. Note, however, that the rules require that all certificates of correction and reexamination, as well as any relevant administrative or court decisions should also be provided.⁴¹⁶ It is therefore recommended that a post-issuance search be conducted to ensure that all parts of the patent are included.

13. Submission Of Other Documents

The Third Party Requester may wish to submit a variety of other, non-prior art documents to the Patent Office. These might include, for example, documents from litigation, declarations, or non-confidential correspondence with the Patent Owner. Under no circumstances should these documents be listed on an IDS form. Instead, they may be included by attaching them to the request directly. If there are a large number of such documents, it is advisable to order them as exhibits with an exhibit list, and to label each page with the Exhibit number and page number.⁴¹⁷

The submission of U.S. file history documents for applications in the same family as the patent is covered in section V.E.11.

⁴¹³ See MPEP § 2618.

⁴¹⁴ See MPEP § 2656

⁴¹⁵ See 37 C.F.R. § 1.915(b)(5); MPEP § 2619.

⁴¹⁶ See MPEP §§ 2614.II.; 2619.

⁴¹⁷ See section IV.A.3, *supra*.

F. Requirements Concerning Real Party In Interest

Every request must name a “real party in interest”. The Patent Office considers a real party in interest to be a party that controls or “directly contributes” to the Third Party Requester’s involvement in the *inter partes* reexamination.⁴¹⁸

Failure to name the real party in interest is the second most frequent ground for finding a request defective. The real party in interest must be specifically identified as such, even if the real party in interest is also the Third Party Requester. If, for example, the Requester is Company X, and the real party in interest is Company X, the identification of the real party in interest should read “Company X”.

1. Real Party In Interest Versus Privies

The purpose of the statement of the real party in interest is to allow future potential Requesters to evaluate whether they are prevented from filing a new request by 35 U.S.C. § 317.⁴¹⁹ This means that it is not necessary for the Third Party Requester to name all privies of the real party in interest, because potential privies will presumably evaluate their status before they file an additional request.⁴²⁰ The question of who is a real party in interest must be kept separate from the question of who the real party in interest’s privies are.

In *inter partes* reexamination 95/000166, the Patent Owner petitioned to vacate the *inter partes* reexamination for failure of the Third Party Requester to name all privies under the real party in interest declaration. The Patent Office denied the petition, reasoning “[to the] extent that petitioner construes 37 CFR 1.915(b)(8) to require inclusion of the identity of all parties who would be related or co-defendants of [the Third Party Requester], such a construction would be unreasonable.”⁴²¹

2. Challenging The Real Party In Interest.

The Patent Office also has previously held that it has no duty to examine the Third Party Requester’s statement for its substantive accuracy. Rather, it is the burden of the Patent Owner to establish that another party was actually in control or “directly contributing” to the *inter partes* reexamination proceeding.⁴²² Specifically, in *inter partes* reexamination 95/000166, it was held that co-defendants in a co-pending litigation, whether or not they have

⁴¹⁸ See *inter partes* reexamination 95/000166 (2007-11-09 Petition Decision, p. 9).

⁴¹⁹ See 37 C.F.R. § 1.915(b)(8).

⁴²⁰ See *inter partes* reexamination 95/000166 (2007-11-09 Petition Decision, p. 9).

⁴²¹ *Inter partes* reexamination 95/000166 (2007-11-09 Petition Decision, p. 9).

⁴²² See *inter partes* reexamination 95/000166 (2007-11-09 Petition Decision, p. 9); *inter partes* reexamination 95/000166 (2008-06-17 Petition Decision, pp. 14-15).

formed a joint defense group, are not for that reason alone co-real parties in interest.⁴²³ The Patent Office reaffirmed this line of reasoning in 95/000227, where the defendants had even resisted discovery on their communications based on a joint defense privilege.⁴²⁴

Petitioner's position appears to be that because the *Tessera* co-defendants may benefit from this reexamination proceeding along with collaborating with Silicon Precision in concurrent litigation they should automatically qualify as a "real party interest" in this reexamination. As pointed out above, it is the Office's position that such is not the case.⁴²⁵

In *inter partes* reexamination 95/000166, the Patent Owner discovered that the Third Party Requester had listed three different entities as the real party in interest in different parts of its request. This prompted the Patent Office to issue an order for the Third Party Requester to show cause why the reexam should not be vacated. The Third Party Requester responded by pointing to one of the entities as the real party in interest, and stating that the naming of the other entities had been a "stenographical error". The Patent Office accepted the revised designation.⁴²⁶

Indeed, the Patent Office has shown little interest to get involved in disputes surrounding the real party in interest, unless the error is obvious from the face of the request:

Even if the "real party in interest" is shown to be misstated, the statute and rules do not provide a remedy for such misstatement to be addressed in the Office. Rather, relief from such a misstatement can only be addressed via the courts.⁴²⁷

3. Amending The Real Party In Interest.

Changing the real party in interest appears to be difficult. The Patent Office has in the past simply ignored such requests.⁴²⁸

4. Signature And Authorization to Act

⁴²³ See *inter partes* reexamination 95/000166 (2007-11-09 Petition Decision, p. 9).

⁴²⁴ See *inter partes* reexamination 95/000227 (2007-09-07 Petition Decision, p. 4).

⁴²⁵ *Inter partes* reexamination 95/000227 (2007-09-07 Petition Decision, p. 7).

⁴²⁶ See *inter partes* reexamination 95/000166 (2008-04-07 Decision, p. 4).

⁴²⁷ *Inter partes* reexamination 95/000227 (2007-06-08 Petition Decision, p. 3).

⁴²⁸ See, e.g., *inter partes* reexamination 95/000042 (2004-05-26 Letter, p. 1).

The request must be signed by the real party in interest or a registered attorney or agent acting in a representative capacity.⁴²⁹ If the person signing the request is not the real party in interest, then the Third Party Requester must either file a power of attorney, or a registered attorney or agent must sign in accordance with 37 C.F.R. § 1.34(a).⁴³⁰ The MPEP states that while a power of attorney is desirable, it is not necessary.⁴³¹

G. Claim Interpretation Issues

1. Standard For Patent Office Interpretation

There is plenty of authority to indicate that the Patent Office must, in reexamination, apply the “broadest reasonable” construction of the claims.⁴³² The conventional wisdom states that because a district court is required to construe claims to preserve their validity, the claim constructions of a district court may be substantially narrower than those of the office.⁴³³ Requesters with plausible non-infringement arguments are fond of citing this authority in requests, in an attempt to prevent broad constructions asserted in a request from serving as admissions in a later Markman proceeding.

Whether the constructions applied in practice by the typical Examiner are broader than what one might expect before a district court may be doubted. The reasoning typically given for the difference is very likely not correct, as district courts rarely construe claims to preserve their validity anymore. More accurately, the difference depends in a complex way on the patent and its file history, as well as the proclivities of the particular judge and Examiner. Examiners rarely use the previous *ex parte* file history to interpret the claims.⁴³⁴ In cases where there is a clear disclaimer of subject matter in the *ex parte* file history, for example, an Examiner may well apply a broader claim construction than a court, if the court is one that typically follows the doctrine of disclaimer.

2. Express Consideration Of Claim Interpretation

Claim interpretations are sometimes discussed by the Examiner on the record in *inter partes* reexamination. This generally occurs where the issue is somehow highlighted in the request, for example, by expressly raising the issue, or by proposing an alternative 102/103

⁴²⁹ See MPEP §§ 2613 and 2667.II.B.1.

⁴³⁰ See *inter partes* reexamination 95/000011 (2003-05-22 Decision, p. 4).

⁴³¹ See MPEP § 2613.

⁴³² See, e.g., *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984); MPEP § 2258.I.G.

⁴³³ See, e.g., *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984).

⁴³⁴ *C.f.* *inter partes* reexamination 95/000017 (2008-12-17 Board Decision, p. 33)(“it is appropriate to consider the prosecution history of a patent undergoing reexamination.”).

rejection based on a claim interpretation. Claim interpretation issues are only rarely raised at the Examiner's own initiative.⁴³⁵

The Third Party Requester thus has a vehicle to influence the Examiner's discussion of particular claim terms on the record. By highlighting a narrow subset of issues, and especially by proposing rejections in the alternative (e.g. 102/103 rejections) that turn on a particular claim interpretation issue, the Third Party Requester can make it more likely that the Examiner will discuss particular claim terms on the record.

H. Formulating The Request In Light Of Co-Pending Or Threatened Litigation

The prospect of co-pending litigation will drive much of what is submitted in an *inter partes* reexamination. There are a few tactics to be considered in almost every case where co-pending litigation is a possibility. If the products of the real party in interest are threatened, the Third Party Requester should have a good understanding of the likely infringement defenses.

1. Requester Strategies For Obtaining A Fast And Favorable Reexamination

There are a number of things Third Party Requesters can do to help speed the reexamination along and avoid irritating the Examiner. First, requests should focus on a limited selection of the most relevant prior art. Second, the request should comply with the 37 C.F.R. § 1.915 initially, avoiding the formal pitfalls (such as the citation of improper materials in an IDS) mentioned elsewhere in this section. The request should clearly state the nature of the substantial new questions of patentability, and then propose rejections in a style that can be used by an Examiner. Documents should be filed electronically and annotated as described in section IV.A.3.

Anecdotal evidence indicates that Examiners are particularly frustrated when Requesters go off-topic. Requests should focus on the issues relevant to the Patent Office. Examiners will review all materials submitted, but become irritated by large volumes of litigation materials intended to cast the Patent Owner in a bad light. Many CRU Examiners have seen multiple requests that use this form of persuasion, and tend to view it as "noise" that serves only to impede their examination of the request.

While there is usually no avoiding the submission of materials intended to demonstrate the Patent Owner's asserted claim constructions, the Third Party Requester should be careful to confine its characterizations of that material to within realistic bounds to avoid losing credibility and insulting the intelligence of Patent Office staff at the same time.⁴³⁶

⁴³⁵ Based on a substantive survey of the first forty *inter partes* reexaminations.

⁴³⁶ One specific example pointed out to the author was the frequent characterization of Patent Owner *Markman* positions as "admissions". As explained to the author, practitioners should understand that the Patent Office applies a different standard for claim interpretation, and legal positions taken in a brief are not factual "admissions".

Discussions of misconduct should be avoided entirely.⁴³⁷ The more factual and relevant the discussion, the more likely the Examiner will pay close attention, and the less likely the request will be delayed for a failure of form.

2. Safe Harbor Art

Every Third Party Requester should consider the inclusion of at least one proposed safe harbor rejection. This is a rejection based on art which looks like the products or processes that are or are likely to be accused of infringement. Although such a product/process may not exist in a single reference, it can sometimes be found in a combination of multiple references, and may be worth submitting even if the motivation to combine references is not as clean as could be wished.

3. Push The Patent Owner To Narrow Claims In Helpful Ways

The goal of reexamination is sometimes not to have the claims rejected over prior art, but rather to have the claims narrowed in a way that excludes products that may be accused of infringement. This can be an effective tactic before litigation or early in the discovery process, if it is not likely that the Patent Owner fully understands the accused product.

To effect a narrowing of the claims for a particular element, it is useful to find a reference or combination that discloses all elements of the claims clearly except for the one to be narrowed. This disclosure will ideally be such that is arguably (but only arguably) outside the scope the language of the relevant claim element, to provide a tempting means for the Patent Owner to overcome the rejection should the Examiner persist in it.

4. Avoid Advocating Broad Constructions

Although the Third Party Requester is generally protected by statute from amendments that broaden the scope of the claims,⁴³⁸ there is no statute that prevents changes in the file history. Because the file history is used to interpret the claims, the Third Party Requester must realize that a poorly conducted reexamination may effectively broaden the scope of coverage in unfortunate ways.

One particularly pervasive pitfall of Third Party Requesters is the tendency to assert broad claim constructions in order to more convincingly propose a rejection over a particular reference, or to be able to propose a rejection under section 102 as opposed to section 103. This is a dangerous practice, if the broad constructions also make infringement of the Third Party Requester's products more likely. Specifically, the Examiner might accept the broad construction without comment, as might the Patent Owner. Then the Third Party Requester is in a position where all three parties involved have accepted a particular claim interpretation that may be detrimental to the real party in interest.

⁴³⁷ See section V.A.3(e), *supra*.

⁴³⁸ See 35 U.S.C. § 314.

These situations are of course difficult to avoid sometimes. If a broad construction must be advocated, typically practitioners will attempt to alleviate the impact by doing a number of things. First, the broad construction will be disclaimed, perhaps with a specific invitation for the Examiner to consider adopting a narrower construction if he or she fails to reject the claim in question. Most Third Party Requesters would also like to point to a document of the Patent Owner that adopts the claim construction to further distance themselves from the proposed construction, such as licensing analyses, preliminary infringement contentions or interrogatory responses.

5. Include A Variety Of Art That Covers Various Possible Interpretations Of Vague Claim Terms

It is important for the Third Party Requester to submit a variety of proposed rejections that are covered by different flavors of vague claim terms. For example, if a claim term says “X associated with Y”, then it behooves the Third Party Requester to propose a variety of rejections that cover different relationships of X to Y.

In most reexaminations, the Patent Owner desires to have its claims confirmed without amendment and potentially improved through additional prosecution. If the claims need to be narrowed, then the Patent Owner will want to find a way that excludes the prior art but includes the products targeted for infringement. By providing a variety of different reference combinations that cover different aspects of vague claim language, the Patent Owner has less room to find an appropriate narrowing amendment.

I. Use Of Declarations

1. Patent Office Guidelines For Considering

Declarations under 37 C.F.R. § 1.132 may be submitted with the request.⁴³⁹ The declarations can be considered to the extent they are used to explain the content of the prior art, or to qualify a reference as prior art.⁴⁴⁰ For example, it is appropriate to submit a declaration to show that a particular compound disclosed in a reference inherently had particular properties.⁴⁴¹

Rejections may not be based on declaratory evidence itself, however.⁴⁴² This means, for example, that the Patent Office will not reject the claims over a declaration that states

⁴³⁹ See MPEP §§ 2616 and 2258.

⁴⁴⁰ See MPEP § 2258; *In re Chambers*, 20 USPQ2d 1470, 1474 (Comm’r Pats. 1991).

⁴⁴¹ See *inter partes* reexamination 95/000009 (2005-05-06 Petition Decision, p.7)(a declaration stating that examples used in a patent were sold as products and that these products had a feature asserted by requester to be inherent was an acceptable declaration, used to explain the content of the prior art).

⁴⁴² See MPEP § 2258.I.E.

that a particular publication existed and that it had a particular content.⁴⁴³ Rather, the publication itself must be the basis of the rejection.⁴⁴⁴

Declarations may also be submitted that interpret prior art (*e.g.* to determine what is inherent in a reference), describe the context in which obviousness is to be decided, or provide information relevant to secondary considerations of non-obviousness. The Patent Office will likely not strike or refuse consideration to declarations that contain legal argument, as long as the argument is limited to issues that may be considered in reexamination.⁴⁴⁵

A declarant should be qualified as an expert in the subject matter about which he or she is testifying.⁴⁴⁶

2. Declaration Use In Practice

⁴⁴³ See MPEP § 2258.I.E.

⁴⁴⁴ The declaration may qualify as prior art if was created prior to the relevant benefit date and it meets the requirements of a “printed publication”.

⁴⁴⁵ See *inter partes* reexamination 95/000276 (2008-06-04 Petition Decision, p. 5) (“In regard to the patent owner's argument on the issue that the examiner may not rely on an affidavit or declaration for the purpose of determining validity of patent claims, the examiner is permitted to make a rejection based upon the prior art patents or printed publications as explained by the affidavits or declarations or other written evidence. See MPEP §§ 2258 and 2617. 35 U.S.C. 314 provides that reexamination will be ‘conducted according to the procedures established for initial examination under the provisions of sections 132 and 133’ and 35 U.S.C. 132 provides that ‘[w]henver, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful’ (emphasis added). A rejection of a claim in a reexamination proceeding must be based upon patents and/or printed publications. However, the examiner is not precluded from considering other ‘information’ (*e.g.*, affidavits, declarations and transcripts) to help define the scope and content of the prior art, or to establish that a claimed invention is unpatentable under 35 U.S.C. 102 or 103. See *In re Baxter Travenol Labs.*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991); *In re Chambers.*, 20 U.S.P.Q.2d 1470, 1474 (Com'r Pat. & Trademarks, 1991); *Heinl v. Godici*, 143 F.Supp.2d 593 (E.D. Va. 2001). Furthermore, if the examiner were to improperly made a rejection in an Office action that is not based upon patents and/or printed publications, such as a rejection under 35 U.S.C. 101, the patent owner should raise this issue in the response to any such Office action, rather than seeking to strike the Declaration....”).

⁴⁴⁶ See, *e.g.*, *inter partes* reexamination 95/000030 (2008-02-06 Board Decision, p. 25) (“[Declarant] does not claim to be, nor is he characterized by Requester as, an expert in materials science, as is necessary for him to offer any helpful insights into some of the inherency issues before us, such as whether the axle connector is repositionable on the axle before being welded thereto.”).

In high-value cases, it is typical for multiple declarations to be submitted with the request. Among the declarations submitted with a request for *inter partes* reexamination, there are typically two types: (1) those that present past facts and (2) those that interpret. Declarations as to past facts are usually used to qualify a reference as prior art. In the case of a printed publication, these declarations should not be omitted unless it is clear from the face of the publication where and when it was published. *See* section V.E.9 for more detail.

Declarations that interpret are usually submitted to clarify what a reference actually teaches. These declarations may involve the assertion of past facts (for example, that a particular thing mentioned in a patent specification inherently had certain characteristics), but the purpose of the declaration is to convince the Examiner that something which is not clearly stated in the reference is, in fact, present. This can be a particular claim feature, or a motivation to combine the reference with other references.

Examiners' treatment of declarations is about as one might expect. Declarations that qualify prior art are generally regarded. That is, Examiners will actively consider them (or their absence), and take the content at face value, even if that content fails to qualify the reference as prior art.⁴⁴⁷

Declarations that interpret are usually regarded suspiciously by Examiners. This means that they are treated much as attorney argument would be, *i.e.* the Examiner will be persuaded by the merits of the declaration, not by the fact that a credentialed person is willing to sign under threat of penalty of perjury. It is rare that an Examiner will reverse a substantive evaluation of a reference based on the testimony of a declarant.⁴⁴⁸ Examiners will usually, however, consider declarations and put their evaluation on the record.⁴⁴⁹ Declarations have sometimes been given more weight if they are submitted by the authors of the reference being interpreted.⁴⁵⁰

In *inter partes* reexamination 95/000009, the Board of Appeals considered a declaration of an employee of the Third Party Requester, stating:

⁴⁴⁷ *See, e.g., inter partes* reexamination 95/000083 (2005-10-05 Petition Decision, p. 1).

⁴⁴⁸ *But see inter partes* reexamination 95/000078 (2007-10-02 Action Closing Prosecution, p. 11)(second Examiner assigned to case reverses rejection citing interpretive declaration).

⁴⁴⁹ *See, e.g., inter partes* reexamination 95/000031 (2006-04-19 Action Closing Prosecution, p. 12).

⁴⁵⁰ *See, e.g., inter partes* reexamination 95/000030 (2005-03-17 Action Closing Prosecution p. 29)(a Third Party Requester declaration submitted by the author of a reference was given weight by the Examiner in deciding what the reference taught a person of ordinary skill in the art).

The examiner accords little weight to [the declarant's] testimony because he is an employee of the requester. The relationship between a declarant and the proponent of the testimony is certainly a factor to be considered when assigning weight to the testimony....There is no per se rule, however, that a relationship between the witness and proponent necessarily deprives the testimony of weight and credibility. While [the declarant's] relationship with [the Third Party Requester] gives rise to an inference that [the declarant] framed his testimony in a manner most favorable to [the Requester], it does not follow that his loyalty extends to dishonesty. Indeed, his declaration concludes with an acknowledgement of his obligation to tell the truth and of his criminal liability if he does not do so. Moreover, [the declarant's] declaration is largely directed to statements of testable fact rather than opinion and includes data that tends to support the testimony.⁴⁵¹

If a party attacks the credibility of a declarant, it should provide both evidence of bias and evidence (or at least argument) tending to contradict the content of the testimony.⁴⁵²

3. Timing Of Interpretive Declarations.

If interpretive declarations are to be submitted, the Third Party Requester must decide whether it is better to submit them with the request or with the first set of comments after the Patent Owner response, or both. Submitting declarations with the request has four advantages. First, the declarations will be securely on the record for the purposes of appeal. Otherwise, the Third Party Requester risks that the Patent Office will find the claims patentable, and the Patent Owner will not file a response.⁴⁵³ Or, the proceeding might be merged with a proceeding at a later stage, thus potentially placing the Third Party Requester under stricter

⁴⁵¹ *Inter partes* reexamination 95/000009 (2007-03-30 Board Decision, p. 5).

⁴⁵² *See, e.g., inter partes* reexamination 95/000030 (2008-02-06 Board Decision, p. 29)(“Although Patent Owner considers the statement to be biased...[it] provides no explanation of why the statement is erroneous.”).

⁴⁵³ *See, e.g., inter partes* reexamination 95/000148 (2008-08-27 Decision, pp. 5-6)(an *ex parte* reexamination of which Third Party Requester was unaware was merged with the *inter partes* reexamination. The Patent Owner had submitted evidence in the *ex parte* reexamination, and the Patent Office found claims allowable in a first office action in the merged proceeding. The Patent Owner did not respond to the office action, and the Patent Office rejected a Third Party Requester attempt to enter comments and evidence).

requirements for the entry of evidence. It is also unclear to what extent an interpretive declaration submitted with Requester comments must meet 37 C.F.R. § 1.948.⁴⁵⁴

Second, the declarations will be seen by the Examiner before the initial office action and can be taken into account. If the declarations are necessary for a particular point, *i.e.* there is not sufficient proof to make out the request otherwise, then obviously they must be submitted with the request or risk denial.

Third, the request is not subject to a fifty-page limit, as are the Patent Owner response and the Third Party comments.⁴⁵⁵ Because interpretive declarations can contribute to this fifty-page limit, submitting declarations with the request can create difficulties for the Patent Owner who has to respond to these issues under a fifty-page constraint.⁴⁵⁶

Fourth, declarations with the Third Party Requester comments will be limited in scope to issues raised in the office action or by the Patent Owner.⁴⁵⁷ Thus, declarations submitted with the request will be more flexible in their usage.

Submitting declarations for the first time with the comments also has its advantages, however. Principally, the Patent Owner will not be aware of the content of the declaration or the identity of the declarant until after it has a chance to respond. This means that, if the Patent Owner wishes to respond, it will have to meet the requirements for submitting a supplemental amendment.⁴⁵⁸ The Patent Owner may not even recognize that declarations are desirable and fail to locate an appropriate expert in a suitable amount of time.

Third Party Requesters must be very careful in foregoing declarations until after the first set of comments. Even if the Patent Office has rejected the claims and a Patent Owner does not submit evidence, the Third Party Requester should still submit whatever evidence might be needed in its first set of comments.

J. Patent Owner Preparation

⁴⁵⁴ See, e.g., *inter partes* reexamination 95/000030 (2008-02-06 Board Decision, pp. 23-24)(the Board stated that a Requester's declaration evidence supporting inherency "must be submitted in accordance with the rules governing inter partes reexamination", citing 37 C.F.R. § 1.948. After this introduction, however, the Board did not expressly apply the rule, but rather proceeded to consider the declaration.).

⁴⁵⁵ See 37 C.F.R. § 1.943(b).

⁴⁵⁶ See, e.g., *inter partes* reexamination 95/000276 (2008-03-12 Decision, p. 3)(denying the Patent Owner's request for a 150-page response including declarations, where the Third Party Requester had submitted nearly 200 pages of declarations with the request).

⁴⁵⁷ See 37 C.F.R. § 1.947.

⁴⁵⁸ See 37 C.F.R. § 1.945(b).

1. Establishment of Ownership And Power of Attorney

If the Patent Owner retains new counsel to defend the *inter partes* reexamination, as is often the case, the Patent Owner should intervene⁴⁵⁹ under rule 3.73 and file a new power of attorney.

2. Notice of Change of Correspondence Address

All papers in reexamination will be sent to by the Patent Office, and must be served by the Third Party Requester on the correspondent registered according to 37 C.F.R. § 1.33(c). The Patent Owner should file a Notice of Change of Correspondence Address in case a different address is required. Papers should not be served on the attorney or agent of record at its Office of Enrollment and Discipline address.⁴⁶⁰

3. Disclosure Of Prior Art By The Patent Owner

The Patent Owner may disclose prior art or other information material to the examination by filing an information disclosure statement (IDS) according to 37 C.F.R. § 1.98 at any time during the proceedings. *See* 37 C.F.R. § 1.902. However, the rules for disclosure of references in a reexamination suggest that any IDS should be filed within two months after the order for reexamination. *See* 37 C.F.R. § 1.555(a). Filing an IDS within this window would seem to be effective in precluding later litigation arguments that the filing of relevant material was intentionally with to hinder or delay the reexamination.

The citation of prior art before the first office action is not limited by 37 C.F.R. § 1.939, because it is not considered to be a filing “on the merits”.⁴⁶¹ However, an IDS prior to the first office action on the merits should be limited in its commentary. A Patent Owner that provides an analysis as to why the cited references do not render the claims unpatentable risks a return of the paper as improper und § 1.939.

4. Patent Owner Preparation For The Substantive Response

After the first office action is mailed, the Patent Owner will have two months to file its response. Because this is a relatively short time frame to evaluate the office action, references, confer with the real party in interest, potentially confer with litigation counsel and to retain and work with experts, the Patent Owner should begin preparation as soon as the Third Party Requester request is received.

⁴⁵⁹ *See* 37 C.F.R. § 3.73.

⁴⁶⁰ *See Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination*, 72 Fed. Reg. 18892, 18893 (May 7, 2007).

⁴⁶¹ *See* MPEP § 2625, 37 C.F.R. § 1.939; *inter partes* reexamination 95/000053 (2005-04-19 Petition Decision pp. 2-3).

The Patent Owner should first try to find a good expert or two and retain them in the event that expert testimony is needed. This task tends to be time-consuming and subject to external scheduling demands. The Patent Owner should next assume that all rejections will be adopted as proposed in the request, evaluate any evidence (such as evidence of commercial success, etc.) that might be needed, and begin its collection. Finally, Patent Owner should begin formulating a draft response.

VI. Decision And First Office Action

A. Likely Timing Of The Decision And First Office Action

The likely timing of the decision on the request for reexamination and the first office action are presented in sections II.B.4(a) and II.B.4(b), respectively.

B. Who Is The Examiner Likely To Be?

1. Examiner In Charge Of The Case

Since 2005, all *inter partes* reexaminations have been handled by a “supergroup” of Examiners within the CRU.⁴⁶² These are all Examiners at the primary level.⁴⁶³ The Examiners handle both *ex parte* and *inter partes* reexaminations, but not *ex parte* prosecution.⁴⁶⁴ As of the end of 2008, there were approximately 60 Examiners in the supergroup. Because there are relatively few Examiners handling *inter partes* reexaminations, it is possible to review the actions of these Examiners by reviewing previous cases handled by each. That is, most CRU Examiners have had the opportunity to handle a number of reexaminations, making the interpretation of the results more meaningful.

Supergroup Examiners are compensated at a GS-15 level, one step higher than a primary Examiner. Because of the higher pay grade, job announcements for the CRU usually generate keen interest within the Patent Office, allowing the CRU staff to choose from a large pool of applicants. Generally, applicants are chosen who have a reputation for high-quality examination. Lately, the CRU has shifted emphasis in its selection criteria from pure quality to a mixture of quality and efficiency.

If an Examiner in the supergroup was somehow involved in a previous examination, the Patent Office will not assign the request to that Examiner absent special

⁴⁶² See United States Patent & Trademark Office, *Performance and Accountability Report for Fiscal Year 2005*, 131 (2005), available at http://www.usPatentOffice.gov/web/offices/com/annual/2005/040201_patentperform.html

⁴⁶³ See *id.*

⁴⁶⁴ See *id.*

circumstances.⁴⁶⁵ However, where a previous reexamination is still ongoing, the Examiner assigned to the previous reexamination will also be assigned the new request.⁴⁶⁶

Before any office action is mailed, it will be reviewed by a panel of Examiners.⁴⁶⁷ The “panel review” is conducted by the Examiner to whom the *inter partes* reexamination is assigned, his or her manager,⁴⁶⁸ and another Examiner of the manager’s choosing.⁴⁶⁹ The third Examiner will be of the primary level, or have some particular expertise that justifies the presence of a non-primary Examiner.⁴⁷⁰ The stated purpose of the panel review is to “diminish any perception that the patent owner can disproportionately influence the Examiner in charge of the proceeding.”⁴⁷¹

C. Denial Of *Inter Partes* Reexamination Requests

1. Remedies If Request Denied

The decision on whether to order an *inter partes* reexamination is one that is committed to the discretion of the Patent Office. If the order is denied, it can not be appealed to the Board under section 312(c) and, if the legislative history is credited, by a mandamus action.⁴⁷² The Patent Office will, however, allow parties to petition the Director to review the decision of the Examiner.⁴⁷³

If the Patent Office denies the request for *inter partes* reexamination, the Third Party Requester may file a petition under 37 C.F.R. § 1.927 for review of the denial.⁴⁷⁴ The

⁴⁶⁵ See MPEP § 2636.I.(A).

⁴⁶⁶ See MPEP § 2636.I.(A).

⁴⁶⁷ See MPEP § 2671.03.

⁴⁶⁸ See MPEP § 2671.03.II.

⁴⁶⁹ See MPEP § 2671.03.I.

⁴⁷⁰ See MPEP § 2671.03.I.

⁴⁷¹ See MPEP § 2671.03.III.

⁴⁷² See 35 U.S.C. § 312(c). According to legislative history, the determination is not “subject to judicial review”. See *Conference Report on HR 1554*, 145 Cong Rec H 11769, H11805 (Nov. 9, 1999). This restriction likely will not apply if the Patent Office’s action was *ultra-vires*.

⁴⁷³ See 37 C.F.R. § 1.927. It is unclear whether section 312 will be interpreted to preclude mandamus review of Patent Office decisions to

⁴⁷⁴ See 37 C.F.R. § 1.927.

petition for review must be filed within one month⁴⁷⁵ (rather than the normal two-month limit for petitions under rule 1.181) of the mailing date of the order denying reexamination, which is not extendable.⁴⁷⁶ The petition must include a statement of facts, a statement of support (such as a memorandum or brief), and evidentiary support for any facts not already established in the proceedings.⁴⁷⁷ If the petition is granted, the reexamination will be conducted by a different Examiner.⁴⁷⁸

If the request was defective in a way that can be remedied, however, it may be beneficial to file a new request for *inter partes* reexamination. The limitations of 35 U.S.C. §§ 317(a) and (b) on the filing of new requests will probably not be applied, because the Patent Office never ordered reexamination.⁴⁷⁹

2. Patent Office Treatment Of Requests For A Refund Of The Filing Fee

Rule 1.925 provides that the filing fee may be partially refunded if the Patent Office does not order reexamination.⁴⁸⁰ The rule refers to the terms of 37 C.F.R. § 1.26(c), which provides that “if the Director decides not to institute a reexamination proceeding”, a refund of an amount specified by the rule (currently \$7,970) will be granted.⁴⁸¹ In the first two hundred *inter partes* reexaminations, the request was denied eight times, and in all eight of these cases, a partial refund was promised by the Patent Office.⁴⁸²

Rules 1.925 and 1.26(c) differ in that rule 1.925 requires a refund where the Director does not order reexamination, whereas 1.26(c) requires a refund only where the Director makes a decision in not ordering reexamination. The language of the relevant statute provides that the Director may provide a refund “upon a determination by the Director that no substantial

⁴⁷⁵ See 37 C.F.R. § 1.927.

⁴⁷⁶ See 37 C.F.R. §§ 1.181(f).

⁴⁷⁷ See 37 C.F.R. § 1.181(b).

⁴⁷⁸ See MPEP § 2655.

⁴⁷⁹ See *supra*, section V.B.2, *supra*.

⁴⁸⁰ See 37 C.F.R. § 1.925.

⁴⁸¹ See 37 C.F.R. § 1.26(c).

⁴⁸² See *inter partes* reexamination 95/000082 (2005-05-11 Order, p. 3); *inter partes* reexamination 95/000083 (2005-05-11 Order, p. 3); *inter partes* reexamination 95/000101 (2005-09-22 Order, p. 3); *inter partes* reexamination 95/000106 (2005-11-16 Order, p. 3); *inter partes* reexamination 95/000107 (2005-11-09 Order, p. 4); *inter partes* reexamination 95/000108 (2005-10-20 Order, p. 3); *inter partes* reexamination 95/000159 (2006-10-24 Order, p. 3); *inter partes* reexamination 95/000286 (2007-11-19 Order, p. 13).

new question of patentability has been raised”,⁴⁸³ tending to support the idea that the Director has no discretion to order a refund if the Director has not made such a determination.

This point is important if no order actually issues. One might imagine that the Patent Office would not refund fees where, for example, the jurisdictional basis for reexamination dissolves before the Patent Office makes a decision or where the Third Party Requester simply fails to complete the request. In fact, the Patent Office appears to deny a refund only where the *inter partes* reexamination can not be further maintained. In *inter partes* reexamination 95/000019, for example, a final court decision preventing further *inter partes* reexamination proceedings issued before the Patent Office’s order, and the Patent Office did not refund the fee.⁴⁸⁴

If an *inter partes* reexamination is vacated after an order has issued, it is the Patent Office’s policy to issue a partial refund.⁴⁸⁵ The word “vacated” is not necessarily used consistently by the Patent Office, but in this instance is probably intended to apply where the Patent Office finds, in retrospect, that it should not have ordered the reexamination. However, the MPEP also uses the verb “to vacate” to describe the situation where an *inter partes* reexamination proceeding is ended because of the effect of section 317(b) after a final court decision, or where a court finally declares a patent invalid.⁴⁸⁶ This would appear to be inconsistent with the Patent Office’s decision in *inter partes* reexamination 95/000019, as there is no principled difference between the effect of a final court decision before and after the Patent Office’s order.⁴⁸⁷

Note that the Patent Office also applies rule 1.26(a), which provides for a refund for amounts that were paid by mistake or in excess of that required.⁴⁸⁸ The Patent Office has applied this rule to the case where a Third Party Requester submits a deficient request and fails

⁴⁸³ 35 U.S.C. § 312(c).

⁴⁸⁴ See *inter partes* reexamination 95/000019 2003-08-20 Decision, p. 3).

⁴⁸⁵ See MPEP § 2615 (“If...an ordered reexamination is vacated...a refund in accordance with 37 CFR 1.26(c) will be made....”).

⁴⁸⁶ See MPEP 2686.04.II.; MPEP § 2610 (“In some limited circumstances, such as after a final court decision where all of the claims are held invalid, a reexamination order may be vacated.”).

⁴⁸⁷ One might say that the Patent Office has done more work after the decision on reexamination has been reached, but this would support return of the fee if the 317(b) estoppel applies before reexamination is instituted, not after. The Patent Office’s practice to date has been the opposite: to partially refund filing fees where the 317(b) estoppel takes effect after the order, but not before.

⁴⁸⁸ See 37 C.F.R. § 1.26(a).

to correct the deficiencies.⁴⁸⁹ In *inter partes* reexaminations 95/000011 and 95/000167, for example, the Third Party Requester failed to respond to a Notice of Incomplete Inter Partes Reexamination Request and the reexaminations were vacated. In those two proceedings, the Patent Office promised full refunds to the respective Third Party Requesters.⁴⁹⁰

D. Likely Form Of Rejection

In almost all cases where the Patent Office finds a substantial new question of validity, it will also reject the claims.⁴⁹¹ Rejections are done in style traditional for *ex parte* prosecution, by providing a paragraph or two generally describing the references in terms of the claim language to be rejected. The author's subjective impression is that rejections in *inter partes* reexamination are usually of higher quality than those that can be expected in *ex parte* prosecution.⁴⁹²

Although Examiners will sometimes adopt the rejections of the Third Party Requester⁴⁹³ completely, it is more often the case that the Examiner will refuse to adopt certain suggestions.⁴⁹⁴ This happened in about three quarters of the cases looked at by the author.⁴⁹⁵ In fewer than half the cases did the Examiner find additional references to examine.⁴⁹⁶

⁴⁸⁹ See MPEP § 2615 (“If the request for *inter partes* reexamination is found to be incomplete and the defect is not cured...a refund in accordance with 37 CFR 1.26(a) will be made to the identified requester.”).

⁴⁹⁰ See *inter partes* reexamination 95/000011 (2003-05-22 Modified Decision, p. 1); *inter partes* reexamination 95/000167 (2006-11-01 Notice, p. 1).

⁴⁹¹ But see note 156, *supra*, noting cases where reexamination was granted and all claims allowed.

⁴⁹² See also SHANG, R. AND TCHAIKOVSKY, Y., *Inter Partes Reexamination Of Patents: An Empirical Evaluation*, A, 15 TEX. INTELL. PROP. L.J. 1, 18, 2006 (“It appears that, for the \$8,800 filing fee, the *inter partes* reexamination requester obtains an examination that receives greater attention than the normal prosecution of original patent applications.”).

⁴⁹³ See, e.g., *inter partes* reexamination 95/000016, *inter partes* reexamination 95/000027; *inter partes* reexamination 95/000035; *inter partes* reexamination 95/000039.

⁴⁹⁴ See, e.g., *inter partes* reexaminations 95/000001; 95/000002; 95/000003; 95/000005; 95/000006; 95/000007; 95/000008; and 95/000009.

⁴⁹⁵ Based on the author's survey of the first forty *inter partes* reexaminations.

⁴⁹⁶ Based the author's survey of the first forty *inter partes* reexaminations. See also MPEP § 2644 (“If the examiner believes that additional prior art patents and publications can be readily obtained by searching to supply any deficiencies in the prior art cited in the request, the examiner can perform such an additional search. Such a search should be limited to that area

E. Actions Between The First Office Action and Patent Owner’s Response

1. General

The parties are restricted from making filings on the merits prior to the mailing first office action.⁴⁹⁷ The language of the relevant rule (1.939(b)) states “[u]nless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.” The rule is somewhat ambiguous as to whether the phrase “on the merits” describes the type of Office action that must issue, or the type of paper that may not be filed. The MPEP appears to interpret the rule to mean that only “papers...on the merits” may not be filed.⁴⁹⁸

The papers specifically allowed by MPEP § 2625, however, are more limited than those most would consider to be not “on the merits”. The MPEP states that the Patent Office will only allow citations of prior art, additional complete requests for *inter partes* reexamination, or notices of concurrent proceedings before the first office action.⁴⁹⁹

The citation of prior art by the Patent Owner before the first office action is not limited by 37 C.F.R. § 1.939, because it is not considered to be a filing “on the merits”.⁵⁰⁰ However, an IDS prior to the first office action on the merits should be limited in its commentary. A Patent Owner that provides an analysis as to why the cited references to not render the claims unpatentable risks a return of the paper as improper und § 1.939.

A petition to merge proceedings may also be filed prior to the issuance of the first office action, despite the requirements of 37 C.F.R. § 1.939(b).⁵⁰¹

2. Petition To Vacate The Proceedings Because Of An Improper Request

The Patent Owner may petition to vacate the proceedings if the request is somehow improper.⁵⁰² This is a petition under 37 C.F.R. § 1.181(a)(1) from the Patent Office’s

most likely to contain the deficiency of the prior art previously considered and should be made only where there is a reasonable likelihood that prior art can be found to supply any deficiency necessary to ‘a substantial new question of patentability.’”).

⁴⁹⁷ See 37 C.F.R. § 1.939. *But see* the exception noted in MPEP § 2686.01.VI.

⁴⁹⁸ See MPEP § 2625.

⁴⁹⁹ See MPEP § 2625; *inter partes* reexamination 95/000053 (2005-04-19 Petition Decision, pp. 2-3).

⁵⁰⁰ See MPEP § 2625, 37 C.F.R. § 1.939; *inter partes* reexamination 95/000053 (2005-04-19 Petition Decision pp. 2-3).

⁵⁰¹ See MPEP § 2686.01.VI. (waiving the requirements of 37 C.F.R. § 1.939).

decision to accord a filing date, and must be accompanied by a petition under 37 C.F.R. § 1.183 to waive 37 C.F.R. § 1.939.⁵⁰³ A request may be improper for violating any of the requirements of rule 1.915.⁵⁰⁴ If granted, such a petition is likely to result in an opportunity for the Third Party Requester to correct the request and the delay necessary to do so.

In *inter partes* reexamination 95/000166, the Patent Owner petitioned the Patent Office to vacate the proceedings because the Third Party Requester had included allegations of fraud and misconduct in its request. The Patent Office granted the request, noting that the decision to vacate in this instance was discretionary and that the allegations of fraud were “inappropriate”. The Patent Office noted that correction required only that the Third Party Requester resubmit the request without the material.⁵⁰⁵ A similar decision, not based on a petition, was rendered in *inter partes* reexamination 95/000250.⁵⁰⁶

3. Petition to Vacate The Proceedings As *Ultra Vires*

If the request is granted, the Patent Owner may also file a petition to vacate the proceedings as *ultra vires*. This is a petition to review a non-appealable⁵⁰⁷ decision of the Examiner to order *inter partes* reexamination, and is thus a petition under 37 C.F.R. § 1.181(a)(1). The author is aware of no case where such a petition has been granted.

The petition to vacate proceedings as *ultra vires* may not be based on any decision of the Examiner that is appealable.⁵⁰⁸ Thus, any substantive consideration of prior art references

⁵⁰² See *inter partes* reexamination 95/000166 (2007-08-14 Petition Decision, p. 2).

⁵⁰³ See *id.*

⁵⁰⁴ See *id.*

⁵⁰⁵ See *id.*

⁵⁰⁶ See *inter partes* reexamination 95/000250 (2007-06-20 Decision, p. 3).

⁵⁰⁷ See 35 U.S.C. § 312(c).

⁵⁰⁸ See *inter partes* reexamination 95/000059 (2007-09-27 Petition Decision, p. 11)(“In *Heinl*, 143 F.Supp.2d at 601, the court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability: ‘Under the well established *ultra vires* doctrine, the exhaustion and final agency requirements are excused ‘only if plaintiff is able to show that the Patent Office clearly exceeded its statutory authority’, quoting from *Philip Morris, Inc. v. Block*, 755 F.2d 368,370 (4th Cir. 1985) (quoting *Mayor and City Council of Baltimore v. Mathews*, 562 F.2d 914,920 (4th Cir. 1977), vacated on other grounds, 571 F.2d 1273 (4th Cir. 1978). The court went on to state: ‘Put differently, when an agency acts in ‘brazen defiance’ of its statutory authorization, courts need not await the conclusions of the underlying proceedings.’”).

cited, or legal determinations as to whether references are prior art, are not a sufficient basis for granting such a petition.

Patent Office guidance states that such a petition is only appropriate where the Patent Office had no discretion to order *inter partes* reexamination. The MPEP lists cases for which the Patent Office believes such a petition might be appropriate:

- (1) “the reexamination order is not based on prior art patents or printed publications;”
- (2) the reexamination was prohibited by 35 U.S.C. § 317;
- (3) “the reexamination was ordered for the wrong patent;”
- (4) “the reexamination was ordered based on a duplicate copy of the request; or”⁵⁰⁹
- (5) “the reexamination order was based wholly on the same question of patentability raised by the prior art previously considered in an earlier concluded examination of the patent by the Office (e.g., the application which matured into the patent, a prior reexamination, an interference proceeding).”⁵¹⁰

Petitions based on an argument that the substantial question of validity was not “new” have been required to show that only questions that were before a previous Examiner in exactly the same form are presented. It has not been sufficient, for example, to argue that the same references upon which the *inter partes* reexamination is based were before a previous Examiner. In *inter partes* reexamination *inter partes* reexamination 95/000059, for example, the Patent Owner filed a petition to vacate the order granting an *inter partes* reexamination, alleging that there was no substantial new question of patentability. The Patent Office dismissed the petition, stating

[t]he petition urges that the fact that the examiner initialed the citations in the '382 prosecution evidences the examiner's consideration, such that those references cannot be the basis for a new question of patentability. The petition also urges that because the combination of Schmitt and the Diamond reference was previously applied in a rejection by the Office during the prosecution of the '382 patent, those references cannot be the basis for a new question of patentability, even when newly combined with additional references. This is an incorrect reading of the law. 35 U.S.C. 303(a) states, in pertinent part, ‘The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.’ Furthermore, a substantial new question of patentability may be based solely on

⁵⁰⁹ This prophylactic portion of the MPEP serves to notify the parties that they may petition to vacate a proceeding where, through some administrative error, two proceedings were ordered on the same request.

⁵¹⁰ MPEP § 2646.

‘old art’ where the ‘old art’ is being presented / viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request. See MPEP 2642. See also *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).⁵¹¹

When the Patent Office issues a decision on such a petition, the petition decision is also not appealable.⁵¹² However, a party may file a petition under 37 C.F.R. § 1.182 to review the standard applied by the Director, *i.e.*, whether the decision by the director was an *ultra vires* action.⁵¹³ A subsequent petition not limited to this question risks return.⁵¹⁴

In *inter partes* reexamination 95/000231, the Patent Owner petitioned to vacate because some of the publications had questionable dates. The Patent Office noted that the publication dates were not evident, but reasoned that the Patent Office had discretion to order reexamination where it made a reasonable decision based on the facts before it:

After a review of the record, and based upon the above discussion, it is found that patent owner has not established that the Office ‘clearly exceeded its statutory authority,’ nor acted ‘in brazen defiance of its statutory authorization,’ in the Office’s determination that the reexamination request properly raised a substantial new question of patentability.⁵¹⁵

The MPEP allows a Third Party Requester to file a paper in opposition without itself filing a petition, but the paper must be submitted within two weeks of the date of service of the Patent Owner’s petition.⁵¹⁶

4. Court Action If Patent Office’s Determination Is *Ultra Vires*

⁵¹¹ *Inter partes* reexamination 95/000059 (2005-08-18 Petition Decision, pp. 5-6).

⁵¹² *See, by analogy*, 37 C.F.R. § 1.927; *inter partes* reexamination 95/000083 (2005-10-05 Petition Decision, p. 2).

⁵¹³ *See inter partes* reexamination 95/000179 (2007-05-16 Petition Decision, pp. 6-7).

⁵¹⁴ *See inter partes* reexamination 95/000179 (2007-05-16 Petition Decision, p. 7)(a Third Party Requester petition for reconsideration of a previous petition decision by the same authority within the Patent Office was limited to consideration of whether the correct standard had been applied).

⁵¹⁵ *Inter partes* reexamination 95/000231 (2007-06-05 Petition Decision, p. 7).

⁵¹⁶ *See* MPEP § 2646; *inter partes* reexamination 95/000185 (2008-08-22 Petition Decision, p. 1).

Although section 312(c) commits the decision to order reexamination to the Patent Office's discretion, the decision may be subject to judicial review through a mandamus action to determine whether it is truly *ultra-vires*. In *Alcatel USA, Resources, Inc. v. Dudas*, 1:06cv1089 (E.D.Va), for example the Patent Owner challenged the Patent Office's interpretation of "original application" in section 4608 of the AIPA as allowing an *inter partes* reexamination proceeding the first application in a chain of applications was filed prior to November 29, 1999.⁵¹⁷ The Patent Owner moved for a preliminary injunction, but later withdrew the motion and the case was apparently settled prior to any substantive decision by the Court.⁵¹⁸ A similar action was filed *Cooper Technologies Co. v. Dudas*, where the Federal Circuit ultimately upheld the Patent Office's action.⁵¹⁹

Because the issuance of a preliminary injunction involves a balancing of the harms, requesting one puts the Patent Owner in the awkward position of arguing that the *inter partes* reexamination will harm it. The subliminal message, whether true or not, is that the patent is at least in part invalid or that the *inter partes* reexamination is less subject to manipulation than an *ex parte* reexamination. In *Alcatel*, for example, the Patent Owner argued to the district court that

[i]f the law is applied properly, then the '090 patent can only be reexamined under the *ex parte* procedure, which would preclude Foundry from participating in the proceeding after the Patent Office's first office action issues. In the absence of an injunction, however, the Patent Office will proceed under the improper *inter partes* route. This will allow Foundry to participate significantly impairing Alcatel's procedural rights, and increasing Alcatel's burdens and expenses in defending its patent. Moreover, under the improper *inter partes* procedure, Alcatel will be denied a vital procedural right: the right to meet with the patent examiner in person for an interview. Compare 37 C.F.R. § 1.955 (no right to interview in *inter partes* proceeding), with *id.* § 1.560 (patent owner's right to interview in *ex parte* proceeding).⁵²⁰

5. Petition Challenging the Office Action

It is theoretically possible to challenge an office action for procedural defects via a petition under rule 1.181(a)(1). In *inter partes* reexamination 95/000100, for example, the Patent Owner filed a petition requesting that the office action be withdrawn in favor of a new

⁵¹⁷ See *supra*, section V.A.1, *supra*, for more details.

⁵¹⁸ See Plaintiff's Motion For Preliminary Injunction of Sept. 26, 2006 and Withdrawal of Motion of Oct. 6, 2006.

⁵¹⁹ See note 258, *supra*.

⁵²⁰ See *Alcatel*, Plaintiff's Motion For Preliminary Injunction of Sept. 26, 2006, p. 7.

office action. The Patent Owner stated that the office action was too lengthy and unduly multiplied the number of rejections, arguing that 37 C.F.R. § 1.104(c)(2) required the Examiner to apply the ‘best available’ prior art. The Patent Office dismissed the petition, reasoning that the *inter partes* reexamination statutes allowed the Third Party Requester to appeal any failure of the Examiner to include a proper rejection in an office action.⁵²¹

6. Subsequent Request On Denial Of Order

The Third Party Requester is not estopped from filing a subsequent request to correct form mistakes if the request for *inter partes* reexamination is denied. See section V.B.2 for more details.

VII. Responding To Office Actions

A. Ability And Requirement To Respond

After the first office action on the merits, the Patent Owner is afforded a chance to respond.⁵²² The response can encompass an amendment to the claims, the addition of new claims, the presentation of evidence, and the presentation of arguments.⁵²³ Unless governed by a more specific rule the rules of responses in *ex parte* prosecution apply.⁵²⁴

If all claims are rejected, the Patent Owner must respond or the reexamination will be terminated and a reexam certificate will issue.⁵²⁵ Note that the Patent Owner is not, however, required to respond in order to preserve its appeal rights where all of the claims are rejected in an Action Closing Prosecution.⁵²⁶

Where only some of the claims stand rejected, there is no requirement for the Patent Owner to respond in order to keep the reexamination going.⁵²⁷ This is in tension with the

⁵²¹ See *inter partes* reexamination 95/000100 (2006-01-10 Petition Decision, p. 5).

⁵²² See 37 C.F.R. §§ 1.937(b) and 1.111(a)(1).

⁵²³ See MPEP § 2666.I.

⁵²⁴ See MPEP § 2666.I.

⁵²⁵ See 37 C.F.R. § 1.957(b) and (c); MPEP § 2687; *inter partes* reexamination 95/000041 (2006-01-10 Notice, p. 1); *inter partes* reexamination 95/000095 (2005-10-25 Notice, p. 2); *inter partes* reexamination 95/000131 (2007-03-06 Notice, p. 2); *inter partes* reexamination 95/000164 (2007-11-16 Notice, p. 2).

⁵²⁶ See MPEP § 2666.10.II.; see, e.g., *inter partes* reexamination 95/000132 (2007-04-29 Right of Appeal Notice, p. 2)(failure of the Patent Owner to respond to the Action Closing Prosecution leads only to a Right of Appeal Notice, not a reexamination certificate).

⁵²⁷ See MPEP § 2666.10.I.(B).

ex parte prosecution rules (that apply to *inter partes* reexamination). These require that the Patent Owner respond if the office action is “adverse in any respect”,⁵²⁸ in order to avoid abandonment of the application.

If key claims are found patentable, the Patent Owner may wish to consider foregoing a response. If no response is filed, the Third Party Requester has no right to comment.⁵²⁹ Where the Patent Owner does not respond and some claims stand allowed, prosecution will continue only as to the allowed claims—the others will be withdrawn.⁵³⁰ The Patent Owner may add claims of equal or narrower scope, provided that the Patent Owner can justify any such amendment after an Action Closing Prosecution has been mailed.⁵³¹

B. Calculating The Due Date

The Patent Owner will usually be given two months to respond to a non-final office action on the merits,⁵³² and must be given at least thirty days.⁵³³ This is in contrast to the usual response time for an Action Closing Prosecution, which is usually the greater of thirty days or one month.⁵³⁴ The time period begins on the day the office action is mailed.⁵³⁵ If due date for the response falls on a Saturday, Sunday or federal holiday, it is moved to the next business day.⁵³⁶

If there is co-pending litigation, there is a chance that the Patent Office will only grant thirty days or one month, whichever is longer.⁵³⁷ This should be the usual practice where the litigation was stayed, and is allowable practice where the litigation has not been stayed.⁵³⁸

C. Requests for Extensions

⁵²⁸ 37 C.F.R. § 1.111(a)(1).

⁵²⁹ See 37 C.F.R. §§ 1.947 and 1.951(b).

⁵³⁰ See MPEP § 2666.10.I.(B).

⁵³¹ See MPEP § 2666.10.I.(B) and 37 C.F.R. § 1.951(a).

⁵³² See MPEP § 2662.

⁵³³ See 37 C.F.R. § 1.945(a).

⁵³⁴ See MPEP § 2662.

⁵³⁵ See MPEP § 2662.

⁵³⁶ See 37 C.F.R. § 1.7(a).

⁵³⁷ See MPEP § 2662(L).

⁵³⁸ See MPEP § 2662(L).

1. Rules

Automatic extensions of time are not allowed in *inter partes* reexaminations.⁵³⁹ The Patent Office is required by statute to conduct the *inter partes* reexamination with “special dispatch”, “unless otherwise provided by the Director for good cause.”⁵⁴⁰ The Director has provided in rule 1.956 that the Patent Owner may receive a reasonable extension of time, if sufficient cause is demonstrated in a petition filed prior to the expiration of the Patent Owner’s response time.⁵⁴¹ The petition fee under 37 C.F.R. § 1.17(g) must be paid.⁵⁴²

The Patent Office in its guidance divides petitions into those that request one month and those that request more.⁵⁴³ According to the MPEP, a first month requires the Patent Owner to show “sufficient cause”.⁵⁴⁴ A second month requires the Patent Owner to show “extraordinary circumstances”. These guidelines are not always strictly applied, however.⁵⁴⁵ In no case may the total response time exceed six months.⁵⁴⁶

In practice, the Patent Office has proven quite flexible in allowing Patent Owners to receive an extension of up to one month, with petitions being granted about 85% of the time. Requests for more than one-month have been granted, but these are less certain. Usually, if the Patent Owner requests more than one month, presents “sufficient cause” for a one-month extension of time, but not “extraordinary circumstances” required by the MPEP for more than one month, the Patent Office will grant only a one month extension of time.⁵⁴⁷

2. Likelihood Of Receiving A Decision Prior To Deadline

⁵³⁹ See MPEP § 2665.

⁵⁴⁰ 35 U.S.C. § 314(c).

⁵⁴¹ See 37 C.F.R. § 1.956.

⁵⁴² See 37 C.F.R. §§ 1.956 and 1.17(g).

⁵⁴³ See MPEP § 2665.

⁵⁴⁴ See MPEP § 2665.

⁵⁴⁵ See *inter partes* reexamination 95/000089 (2006-03-30 Decision, pp. 2-3); *inter partes* reexamination 95/000100 (2005-10-12 Decision, p. 2); *but see inter partes* reexamination 95/000151 (2006-12-12 Decision, p. 2)(quoting MPEP § 2665 but finding only ‘sufficient cause’ in granting a two-month extension of time); *inter partes* reexamination 95/000153 (2007-09-28 Decision, p. 3)(same); *inter partes* reexamination 95/000161 (2007-06-29 Decision, pp. 1-2)(same); *inter partes* reexamination 95/000203 (2007-06-04 Decision, p. 2)(same).

⁵⁴⁶ See 35 U.S.C. § 133, applicable to *inter partes* reexamination via 35 U.S.C. § 314(a).

⁵⁴⁷ See, e.g., *inter partes* reexamination 95/000089 (2006-03-30 Decision, pp. 2-3).

The question remains whether an extension will be usable. That is, if the Patent Owner files the petition prior to the expiration of its response period, as it must, will the Patent Office be able to answer prior to the end of the response period? In many past cases, the Patent Office has not been able to do this. This leaves the Patent Owner in the uncomfortable position of deciding whether to file a Response without confirmation from the Patent Office that an extension has been granted.⁵⁴⁸

According to the author's study encompassing some forty requests for extension of time in the first 200 reexaminations, the Patent Office was able to respond to Patent Owner petitions within an average of twenty-five days. If the two longest response times are eliminated (as well as the one case where the Patent Office did not respond at all), however, the average drops to about 14 days, and the median is only 11 days.

On average, the Patent Office responded around 11 days after the deadline for the Patent Owner response. The median response time, however, was two days before the deadline. If the two longest response times are eliminated, the average Patent Office response arrived one day before the deadline. The response time did not appear to be correlated in any appreciable way to the date on which the decision was granted—meaning that the Patent Office does not appear to be getting better or worse with time. The standard deviations of the data set were quite high, reflecting both the small sample size and wide variances in Patent Office speed.

The ability of the Patent Office to respond before the deadline varied, of course, with lead time given to the Patent Office by the Patent Owner. The more time the Patent Owner gave the Patent Office, the more likely the Patent Office was to respond before the deadline. Due to the wide variance in Patent Office response times no amount of lead time can really be considered “safe”. However, there was an apparent break in the data for requests filed two weeks or more prior to the expiration of the deadline. In these cases, the Patent Office was able to respond prior to the deadline about 75% of the time.

3. Formulating The Request For Extension Of Time

A request for extension of time should be filed as a petition under 37 C.F.R. § 1.956. Any request should include a description of the actions the Patent Owner has taken to comply with the deadline and reasons why these will not be successful.⁵⁴⁹ This description is sometimes not required by the Patent Office,⁵⁵⁰ but when requests are denied, it is often on this

⁵⁴⁸ See, e.g., *inter partes* reexamination 95/000129 (2008-10-09 Decision, p. 3)(Patent Owner filed a request for extension of time shortly before the deadline. The Patent Office responded by denying the petition two years later, forcing the Patent Owner to file a petition for reconsideration, which had not been decided as of November, 2008); *inter partes* reexamination 95/000224 (2008-06-18 Decision, p. 3).

⁵⁴⁹ See MPEP § 2665.

⁵⁵⁰ See, e.g., *inter partes* reexamination 95/000138 (2007-02-23 Decision, p. 1); *inter partes* reexamination 95/000142 (2006-08-09 Decision, p. 2).

basis.⁵⁵¹ It is risky to file a petition without a showing that the Patent Owner has been diligent. For example, in denying one request for a one-month extension of time, the Patent Office stated:

The present request is incomplete in that it fails to include (a) a statement of what action the patent owner has taken thus far such as a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period, and (b) why, in spite of the action taken thus far, the additional one month time is needed.⁵⁵²

Once the Patent Owner has demonstrated how it has attempted to comply with the deadline, it should put forward one or more reasons why it can not reasonably meet the deadline. The Patent Office usually finds a combination of the following causes to be sufficient for a one-month extension of time: (1) the need to respond to a particularly lengthy office action;⁵⁵³ (2) the need to prepare declarations;⁵⁵⁴ (3) the need to prepare a lengthy IDS; (4) the need to

⁵⁵¹ See, e.g., *inter partes* reexamination 95/000109 (2006-01-18 Decision, p. 3); *inter partes* reexamination 95/000130 (2006-06-02 Decision, p. 2); *inter partes* reexamination 95/000109 (2006-01-18 Decision, p. 3) (“The decision to file a declaration under 37 C.F.R. 1.132 by the Patent Owner is not persuasive for a showing of ‘sufficient cause.’ A showing of ‘sufficient cause’ could include what action the Patent Owner has undertaken thus far in the preparation of a response. The Patent Owner has also not shown why more time is needed and what needs to be done in the preparation of the declaration under 37 C.F.R. 1.132. Absent a showing of ‘sufficient cause’ this reasoning is insufficient and is dismissed. Lastly, the holiday season is not considered a reason showing ‘sufficient cause’ since the holidays are well known in advance and there was no showing of what the Patent Owner has undertaken thus far to overcome any shortage of personnel in this time.”)

⁵⁵² *Inter partes* reexamination 95/000020 (2005-11-02 Decision, p. 2); *but see inter partes* reexamination 95/000081 (2008-07-15 Decision, p. 3) (“Although not explicitly stated, the petition is construed to also mean that reasonably diligent behavior has been exercised to date in the preparation of the response and that, in spite of those efforts, additional time is needed.”).

⁵⁵³ See, e.g., *inter partes* reexamination 95/000090 (2007-07-26 Decision, p. 2); *inter partes* reexamination 95/000027 (2007-04-20 Petition Decision p. 2); *inter partes* reexamination 95/000043 (2004-09-15 Decision, p. 2); *inter partes* reexamination 95/000138 (2007-02-23 Decision, p. 1); *inter partes* reexamination 95/000161 (2007-06-29 Decision, pp. 1-2); *inter partes* reexamination 95/000173 (2006-10-20 Decision, p. 2); *inter partes* reexamination 95/000196 (2007-06-07 Decision, p. 2); *inter partes* reexamination 95/000043 (2005-05-09 Decision, p. 2); *inter partes* reexamination 95/000091 (2008-03-28 Decision, p. 2) (denying a request for extension based solely on the fact that the office action was “lengthy”, in that it had 24 pages and 12 grounds of rejection).

⁵⁵⁴ See, e.g., *inter partes* reexamination 95/000043 (2004-09-15 Decision, p. 2); *inter partes* reexamination 95/000070 (2005-06-17 Decision); *inter partes* reexamination 95/000070 (2005-06-17 Decision, p. 3); *inter partes* reexamination 95/000096 (2005-11-02 Decision, p. 1);

communicate with a foreign client;⁵⁵⁵ (5) the unavailability of key personnel, such as the inventor, reexam attorney, expert or management of the real party in interest;⁵⁵⁶ (6) delay in receiving the office action;⁵⁵⁷; (7) a change in counsel;⁵⁵⁸; or (8) the need to investigate the publication date of a reference.⁵⁵⁹ The Patent Office has on occasion required the Patent Owner

inter partes reexamination 95/000136 (2007-03-09 Decision, p. 3); *inter partes* reexamination 95/000173 (2006-10-20 Decision, p. 2); *inter partes* reexamination 95/000161 (2007-06-29 Decision, pp. 1-2); *inter partes* reexamination 95/000196 (2007-06-07 Decision, p. 2); *inter partes* reexamination 95/000142 (2006-08-09 Decision, p. 2)(“In view of the indication that Patent Owner is in the process of obtaining declarations for submission with a response to the Office of action, sufficient cause for an extension of time has been established and it is for this reason only that it is granted for one-month.”); *but see inter partes* reexamination 95/000020 (2005-11-02 Decision, p. 2)(“It is noted that the patent owner does not set forth that steps have been taken to secure the services of Dr. Rhyne, or the specifics of how Dr. Rhyne will be involved. The request for extension merely speculates that [the Third Party Requester] will ‘likely’ have to file its response without his assistance if the extension is not granted. The request fails to state unequivocally that Dr. Rhyne does not have enough time to provide assistance before November 28, 2005. Finally, the request goes so far as to suggest that he may not be available even if the extension is granted. Such speculative needs cannot amount to ‘sufficient cause.’”); *inter partes* reexamination 95/000109 (2006-01-18 Decision, p. 3)(“The decision to file a declaration under 37 C.F.R. 1.132 by the Patent Owner is not persuasive for a showing of ‘sufficient cause.’”). The MPEP cautions that the grant of an extension based on the Patent Owner’s need to prepare a declaration does not guarantee that the Patent Office will consider the declaration, especially when submitted after the Action Closing Prosecution. *See* MPEP § 2665.

⁵⁵⁵ *See, e.g., inter partes* reexamination 95/000138 (2007-02-23 Decision, p. 1); *inter partes* reexamination 95/000043 (2004-09-15 Decision, p. 2); *inter partes* reexamination 95/000043 (2005-05-09 Decision, p. 2).

⁵⁵⁶ *See, e.g., inter partes* reexamination 95/000089 (2006-03-30 Decision, pp. 2-3)(declarant unavailable); *inter partes* reexamination 95/000096 (2005-11-02 Decision, p. 1)(attorney unavailable due to travel); *inter partes* reexamination 95/000096 (2006-03-03 Decision, p. 3)(inventor unavailable due to health); *inter partes* reexamination 95/000179 (2007-07-26 Petition, p. 2)(plant shutdown); *inter partes* reexamination 95/000179 (2007-08-10 Decision, p. 2)(same); *inter partes* reexamination 95/000181 (2007-03-05 Decision, p. 2)(death in the family of an attorney); *inter partes* reexamination 95/000196 (2007-06-07 Decision, p. 2)(attorney unavailable due to travel).

⁵⁵⁷ *See inter partes* reexamination 95/000039 (2004-09-29 Decision, p. 1)(due to a law firm clerical error, attorneys for the Patent Owner did not receive the office action until the due date for the response); *inter partes* reexamination 95/000136 (2007-03-09 Decision, p. 3).

⁵⁵⁸ *See inter partes* reexamination 95/000038 (2005-12-14 Action Closing Prosecution p. 2); *inter partes* reexamination 95/000268 (2007-11-19 Decision, pp. 2-3).

⁵⁵⁹ *See, e.g., inter partes* reexamination 95/000311 (2008-09-25 Decision, pp. 2-3).

to provide documentary proof of the grounds it put forward in its petition.⁵⁶⁰ Usually, a successful petitioner will present a number of these grounds in a petition for extension of time.

Patent Owners have sometimes requested extensions of time to wait for some decision to be made by the Patent Office or a district court. For example, the Patent Owner might wish to wait for the Patent Office to decide a petition to vacate, because that would spare the Patent Owner the burden of filing a response (and potentially making admissions relevant to a co-pending litigation). This is one area where the Patent Office has not been generous in granting extensions. In general, a request for extension of time will not be granted if it is filed solely to allow the Patent Office to make decisions on other outstanding petitions.⁵⁶¹ If the Patent Owner's justification is that the Patent Owner must wait for the outcome of any particular decision in court, it should make certain that the Patent Owner has taken all necessary steps to allow the court to decide.⁵⁶² For example, rather than explaining that the "Patent Owner plans to file a motion for X", the Patent Owner should already have filed the motion.

The Patent Office has also not looked favorably on petitions based solely on the heavy workload of the reexam attorneys.⁵⁶³ In *inter partes* reexamination 95/000059, for example, the Patent Office denied such a request, stating:

Clearly, the intent of 37 C.F.R. 1.956 was to offer relief from the special dispatch requirement only in rare instances of unusual circumstance, and was not intended to be invoked upon anything as common as 'a large workload'.⁵⁶⁴

⁵⁶⁰ See *inter partes* reexamination 95/000096 (2006-03-03 Decision, p. 3)(Patent Owner offered to provide documentary support, and Patent Office accepted this offer).

⁵⁶¹ See, e.g., *inter partes* reexamination 95/000155 (2007-02-16 Decision, p. 3); *inter partes* reexamination 95/000142 (2006-08-09 Decision, p. 2)(granting the petition, but only because the Patent Owner needed time to gather evidence, not because Patent Owner wished to have Patent Office decide an outstanding petition).

⁵⁶² See *inter partes* reexamination 95/000089 (2005-07-19 Decision, p. 2).

⁵⁶³ See *inter partes* reexamination 95/000059 (2005-06-15 Petition Decision, p. 2)(denying request based on heavy workload of attorney); *inter partes* reexamination 95/000130 (2006-06-02 Decision, p. 2)(denying request based on heavy workload related to co-pending litigation, because the Patent Owner had not demonstrated that it was diligent in trying to respond on time); *inter partes* reexamination 95/000225 (2008-03-24 Decision, p. 2)("The requirement for conducting the present proceedings with special dispatch overrides any desire to provide Patent Owner additional time to make up for the time not spent working on the present merged proceeding.").

⁵⁶⁴ *Inter partes* reexamination 95/000059 (2005-06-15 Petition Decision, p. 2).

In *inter partes* reexamination 95/000129, the Patent Owner requested an extension of time. It first disclaimed the claims that had been requested for reexamination. The Patent Owner then argued that, once the requested claims were gone, the proceeding was more akin to *ex parte* prosecution and no longer required special dispatch. The Patent Office dismissed the request stating “[i]t is unclear how or why Patent Owner equates the filing of a disclaimer to a transformation of the present *inter partes* proceeding into application where an applicant would be entitled to a 6 month period for response.”⁵⁶⁵

4. Second Requests for Extensions Or Requests For More Than One Month

A second or subsequent request for time requires a showing of extraordinary circumstances.⁵⁶⁶ This goes well beyond the “sufficient cause” required for a first extension. The most relevant application of this principle is that an unforeseen (or even foreseen) continuation of the circumstances that necessitated the first request for an extension may not justify a second request for extension.⁵⁶⁷ In many cases where a Patent Owner requests two-month extensions (or longer), the Patent Office will grant extensions for one month.⁵⁶⁸

In some cases, however, the Patent Office has granted two-month extensions of time where a combination of circumstances has resulted in a particularly heavy burden for the Patent Owner.⁵⁶⁹ In *inter partes* reexamination 95/000062, for example, The Patent Office mailed an office action on March 17, 2005. On April 8, 2005, the Patent Owner requested a three-month extension of time. The Patent Owner stated that it needed extra time because the office action was extensive, because it need to consider the priority where continuations-in-part had been filed, because it needed to obtain the file history of a reference, because it had filed a petition to disqualify the Third Party Requester counsel, and because its attorney had only recently taken over the case, which in turn was the result of a refusal by the Third Party Requester to grant a waiver to the usual counsel. The Patent Office granted a two month

⁵⁶⁵ *Inter partes* reexamination 95/000129 (2008-10-09 Petition Decision, p. 3).

⁵⁶⁶ See MPEP § 2665.

⁵⁶⁷ See, e.g., *inter partes* reexamination 95/000089 (2005-09-21 Decision, p. 2).

⁵⁶⁸ See, e.g., *inter partes* reexamination 95/000089 (2006-03-30 Decision, pp. 2-3).

⁵⁶⁹ See, e.g., *inter partes* reexamination 95/000062 (2005-04-27 Decision); *inter partes* reexamination 95/000089 (2005-07-19 Decision, p. 2); *inter partes* reexamination 95/000092 (2005-08-30 Decision, p. 1); *inter partes* reexamination 95/000096 (2006-03-03 Decision, p. 3); *inter partes* reexamination 95/000151 (2006-12-12 Decision, p. 2); *inter partes* reexamination 95/000153 (2007-09-28 Decision, p. 3); *inter partes* reexamination 95/000161 (2007-06-29 Decision, pp. 1-2).

extension on April 27, 2005, listing all reasons and finding that they together provided “sufficient cause”.⁵⁷⁰

5. Petitions To Revive

If the Patent Owner misses the due date for a response, it may file a petition to revive the proceeding under 37 C.F.R. §§ 1.137 and 1.958.⁵⁷¹ A petition to revive is not available for the Third Party Requester if, for example, it misses a comment deadline.⁵⁷²

The petition to revive has been used at least eight times with success by Patent Owners. In *inter partes* reexamination 95/000017, the attorney handling *inter partes* reexamination for Patent Owner became ill and decided to transfer the case to another firm. This apparently resulted in docket confusion and the case was never in effect transferred. A petition under rule 1.137(b) was granted by the Patent Office to revive the proceeding.⁵⁷³ In *inter partes* reexaminations 95/000003, 95/000065, 95/000067, 95/000160, 95/000188, 95/000265 and probably 95/000035 cookie-cutter petitions for revival were submitted under rule 1.137(b), stating simply that the delay was unintentional. The Patent Office granted the petitions in 95/000003⁵⁷⁴ and 95/000035⁵⁷⁵, 95/000067⁵⁷⁶, 95/000160⁵⁷⁷, 95/000188⁵⁷⁸, 95/000265⁵⁷⁹ and

⁵⁷⁰ See *inter partes* reexamination 95/000062 (2005-04-27 Decision); see also *inter partes* reexamination 95/000278 (2008-02-09 Decision, p. 3)(after granting a one month extension, the Patent Office granted a further 15-day extension).

⁵⁷¹ See 37 C.F.R. §§ 1.137. and 1.958.

⁵⁷² See, e.g., *inter partes* reexamination 95/000209 (2008-11-18 Petition Decision, p. 8)(“miscalculation of a due date during the prosecution of proceedings in the Office is, unfortunately, something that is not a rare occurrence, and is hardly an unusual or extraordinary circumstance. Such a miscalculation is addressed by a petition to revive where a date is missed by a patent owner. Unfortunately, there is no statutory basis for a requester's filing of a petition to revive.”).

⁵⁷³ See *inter partes* reexamination 95/000017 (2004-11-19 Decision Granting Petition Under 1.137).

⁵⁷⁴ See *inter partes* reexamination 95/000003 (2008-09-03 Petition Decision, p. 2).

⁵⁷⁵ See *inter partes* reexamination 95/000035 (2007-12-12 Petition Decision, p. 2). A copy of the petition was not available on PAIR as of late 2008.

⁵⁷⁶ See *inter partes* reexamination 95/000067 (2008-08-29 Petition Decision, p. 2).

⁵⁷⁷ See *inter partes* reexamination 95/000160 (2008-06-05 Petition Decision, p. 1).

⁵⁷⁸ See *inter partes* reexamination 95/000188 (2008-01-29 Petition Decision, p. 2).

⁵⁷⁹ See *inter partes* reexamination 95/000265 (2007-11-27 Petition Decision, p. 2).

granted the petition in 95/0000065 after dismissing it once for failure to include an office action response.⁵⁸⁰

The Patent Owner should take care to file a petition to revive promptly upon learning of abandonment. In 95/000224, the Patent Owner delayed approximately four months after a decision denying a necessary extension of time was mailed. The Patent Office stated that the Patent Owner had not demonstrated that the time between the mailing of the decision and the filing of the petition to revive had been unintentional:

As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay, as opposed to Office acceptance of a general allegation of unintentional delay. See *Lawman Armor v. Simon*, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMi.ch 2005); *Field Hybrids, LLC v. Toyota Motor Corp.*, 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23. In view of the above, statements are required from the responsible person(s) having firsthand knowledge of the circumstances surrounding the delay, after the termination date, in seeking revival. Furthermore, as the record shows that petitioner was aware that the decision dismissing the petition for the extension of time under 37 CFR 1.956 was mailed on June 18, 2008, an explanation from petitioner as to why the 4-month delay in seeking revival should be excused must be provided, independently of delay in responding which caused termination in the first instance.⁵⁸¹

Recently, the Patent Office has issued a “show cause” when the Patent Owner fails to respond in time.⁵⁸² The “show cause” order gives the Patent Owner a period of time (e.g. 15 days) to file a rule 1.137 petition. It is believed that the Patent Office would use the deadline set in the “show cause” order to refuse any petition under 1.137 filed thereafter.

D. Requirements Of Form

1. The Patent Office Often Rejects Filings For Failure To Meet Form Requirements

Special rules apply to Patent Owner responses in reexamination.⁵⁸³ The Patent Office rightly protects its public record by enforcing these rules rather strictly.⁵⁸⁴ The failure to

⁵⁸⁰ See *inter partes* reexamination 95/000065 (2005-11-08 Petition Decision).

⁵⁸¹ *Inter partes* reexamination 95/000224 (2008-11-10 Petition Decision, p. 4).

⁵⁸² See, e.g., *inter partes* reexamination 95/000130 (2008-06-30 Decision, p. 1).

⁵⁸³ See 37 C.F.R. §§ 1.941 and 1.530(d) – (k).

observe these rules leads to a “Notice Re: Defective Paper” in a large number of *inter partes* reexaminations, probably more than half,⁵⁸⁵ and often more than once in the same case.⁵⁸⁶

A failure by the Patent Owner to meet the form requirements of a response has several detrimental effects. First, if the Patent Office issues a Notice within the Third Party Requester’s comment period, the effect is an automatic extension of time for the Third Party Requester, with foreknowledge of the Patent Owner’s likely response. Second, the Patent Office may use the fact of form failures against the Patent Owner, should the Patent Owner later have any extraordinary requests that might tend to impede the Patent Office’s requirement of “special dispatch”.⁵⁸⁷

Although the Patent Office attempts to mail such notices promptly (before the Third Party Requester replies), they can sometimes take much longer to issue.⁵⁸⁸ If the Patent

⁵⁸⁴ If the Patent Owner is lucky, the Patent Office may waive requirements that, if enforced, would have rendered the amendment defective. *See, e.g. inter partes* reexamination 95/000109 (2006-03-16 Decision, p. 4); *inter partes* reexamination 95/000111 (2006-03-28 Decision, p. 3).

⁵⁸⁵ For example, according to the author’s study of the first forty *inter partes* reexamination proceedings, the Patent Office issued around twenty such notices.

⁵⁸⁶ *See, e.g., inter partes* reexamination 95/000026 (200-03-04 and 2004-05-27 Notices); *inter partes* reexamination 95/000029 (four notices in one case); *inter partes* reexamination 95/000080 (2005-07-29 and 2005-10-12 Notices).

⁵⁸⁷ *See, e.g., inter partes* reexamination 95/000003 (2007-09-27 Petition Decision, p. 6)(“In summary, on June 3, 2002, a first improper amendment was filed; on April 27, 2005, a second improper amendment was filed; on July 18, 2005, a third improper amendment was filed; and on September 19, 2006, a fourth improper amendment was filed. It is noted that out of five (5) amendments presented by patent owner in this reexamination proceeding, only one (1) amendment has been found to be in compliance with the rules for reexamination amendment practice. It is further noted that although the previous petition was dismissed in October 2006, during the time subsequent to the dismissal, patent owner has not provided a proper amendment for consideration. Such prosecution evidences a **recurring pattern** of patent owner providing reexamination amendments which are **not** in compliance with the rules. This recurring pattern has resulted in unnecessary delays which are contrary to the statutory requirement for the reexamination proceedings to be conducted with ‘special dispatch’ pursuant to 35 U.S.C. 305.”)(emphasis in original).

⁵⁸⁸ *See, e.g., inter partes* reexamination 95/000018 (2004-04-09 Notice)(five and one-half months); *inter partes* reexamination 95/000032 (2006-05-10 Notice)(nearly two years); *inter partes* reexamination 95/000033 (2005-04-12 Notice) (six months); *inter partes* reexamination 95/000039 (2006-01-26 Notice)(one and one-half years); *inter partes* reexamination 95/000044 (2007-10-29 Notice)(seventeen months).

Owner receives such a Notice, he or she will usually be given the greater of one month or 30 days to respond to the notice.⁵⁸⁹ Failure to respond to the notice means that effectively no response has been filed and, depending on the circumstances,⁵⁹⁰ a reexamination certificate can issue.

If the Patent Owner successively submits a number of informal amendments, the Patent Office may terminate or limit the reexamination. For example, in *inter partes* reexamination 95/000090, the Patent Office stated that if the Patent Owner submitted three informal amendments, the amendments would not be entered.⁵⁹¹ Sometimes, however, the Patent Office will only afford two chances to make a non-defective amendment.⁵⁹² The Patent Office has previously indicated its intent to pursue attorneys under the disciplinary rules if it perceives an intentional delay of proceedings.⁵⁹³

If the CRU notifies the Patent Owner of a defective amendment by telephone, or if the Patent Owner realizes that the amendment was defective prior to receiving an informality notice, the Patent Owner may correct the filing immediately with a supplemental amendment.

2. Expanding The Response After A Notice Re: Defective Paper

If the Patent Owner receives a Notice Re Defective Paper, it must respond to the defects cited in the paper. It may not as a matter of right substantively alter the response. While

⁵⁸⁹ See MPEP § 2662(B).

⁵⁹⁰ See section VII.A, *supra*.

⁵⁹¹ See, e.g., *inter partes* reexamination 95/000090 (2006-06-30 Notice)(stating that if a further defective amendment is submitted, it will not be entered).

⁵⁹² See *inter partes* reexamination 95/000113 (2006-02-02 Notice, p. 2)(threatening to terminate or limit the reexamination if the second response failed to correct the defects); *inter partes* reexamination 95/000114 (2006-04-06 Notice, pp. 2-3)(same).

⁵⁹³ See *inter partes* reexamination 95/000078 (2007-04-12 Letter, p. 3)(in response to a Third Party Requester petition that did not request any specific relief, the Patent Office warned that ‘the '078 *inter partes* reexamination proceeding will be conducted with special dispatch in accordance with 35 U.S.C. 314(c). The filing of papers directed to issues previously addressed and resolved by the Office in papers that are of record in the IFW, or papers that request guidance on matters clearly addressed by the regulations and discussed in the MPEP, impedes the handling of this proceeding with special dispatch. Similarly, papers that are incomplete when filed will impede the handling of this proceeding with special dispatch. Depending on the facts of an individual situation, papers of these types might be construed as being papers that have been filed to improperly delay the proceeding. Such papers might run counter to 37 C.F.R. 10.18(b)(2)(i.i).”).

substantive alteration has been allowed in the past,⁵⁹⁴ the Patent Office's more recent decisions indicate that substantive material, submitted by the Patent Owner in response to an informality notice but not in the original response, will be cause the paper to be treated as a supplemental amendment under 37 C.F.R. § 1.111(a)(2)(i).⁵⁹⁵

A particularly onerous situation that may have resulted in the loss of a patent was encountered by the Patent Owner in 95/000105. There, an Action Closing Prosecution noted that a previous amendment had been improper, but was provisionally accepted in an effort to maintain special dispatch. The Patent Owner was instructed to resubmit the amendment within one month, and duly warned that failure would result in the issue of a reexamination certificate.⁵⁹⁶ Rather than submitting a corrected version of its previous amendment, the Patent Owner submitted a response to the ACP. Its response corrected the deficiencies, but made new arguments and added a new claim.⁵⁹⁷ Three months later, the Patent Office returned the response, stating that the amendment had added claim 10, and "was thus not a resubmission of the October 6, 2006 amendment in proper form."⁵⁹⁸ The Patent Owner filed a supplemental response one month later, which was returned as an improper supplemental response.⁵⁹⁹

3. Responding To All Issues

⁵⁹⁴ See *inter partes* reexamination 95/000014 (2004-01-20 Decision, pp. 1-2)(dismissing as moot a petition for an extension of time because the Patent Owner had submitted an informal amendment and been granted 30 days or one month to respond, thus equating the changes a Patent Owner can make with an extension of time to those that can be made in responding to a Notice Re: Defective Paper. In fact, the Patent Owner submitted a new IDS and declaration in response to the Notice); *inter partes* reexamination 95/000135 (2007-03-28 Letter).

⁵⁹⁵ See *inter partes* reexamination 95/000074 (2007-10-18 Petition Decision, p. 19)("When the Office determines that a submission filed in response to a notice of defective paper contains additional arguments (and appendices) directed to the merits that are deemed to be improper under 37 C.F.R. 1.111(a)(2)(i), the Office generally mails a decision 'returning' the paper and setting a 30-day or one month period for reply, whichever is longer, to correct the defect without a discussion on the merits. In view of the prolonged delay on the part of the Office in reviewing the October 12, 2006 patent owner response, however, and further in view of the statutory requirement for special dispatch, the Office will redact the October 12, 2006 patent owner response by removing the arguments improperly included in the October 12, 2006 patent owner response, rather than sending a notice of defective paper.")(emphasis omitted).

⁵⁹⁶ See *inter partes* reexamination 95/000105 (2007-11-15 ACP, p. 13).

⁵⁹⁷ See *inter partes* reexamination 95/000105 (2007-12-17 Amendment, p. 3).

⁵⁹⁸ *Inter partes* reexamination 95/000105 (2008-03-28 Notice, p. 2).

⁵⁹⁹ See *inter partes* reexamination 95/000105 (2008-09-19 Decision, p. 1).

If the Patent Owner files a response, it must respond to all rejections and objections in an office action.⁶⁰⁰ If the Patent Owner does not respond to all rejections and objections, the Examiner will consider whether the response was *bona fide*.⁶⁰¹ If so, the Patent Owner will receive an additional period in which to respond.⁶⁰²

4. Length Of Response

Patent Owner responses are limited to fifty pages in length “excluding amendments, appendices of claims, and reference materials such as prior art references”.⁶⁰³ If the Patent Owner files a *bona fide* response to an office action that exceeds fifty pages, the Patent Owner will return the response with a Notice Re: Defective Paper, setting a deadline to either submit a shorter response, or to redact portions of the response.⁶⁰⁴ The deadline is usually fifteen days from the date of mailing.⁶⁰⁵

The Patent Office will count the remarks section of a response as contributing to the total. Declarations will contribute to the total to the extent they make arguments. If the declaration, for example, analyzes the combinability of references, or makes arguments as to whether a reference does or does not anticipate, it will be counted against total page limit.⁶⁰⁶

If a declaration interprets the content of the prior art, it is not considered to be argument.⁶⁰⁷ Declarations that are intended to qualify evidence are not counted against the limit,⁶⁰⁸ nor are declarations which swear behind the filing date of a reference, establish the date

⁶⁰⁰ See 37 C.F.R. § 1.937(b), referring to, *inter alia*, 37 C.F.R. § 1.111(b).

⁶⁰¹ See 37 C.F.R. § 1.957(d).

⁶⁰² See 37 C.F.R. § 1.957(d); *inter partes* reexamination 95/000063 (2008-05-02 Notice, p. 3).

⁶⁰³ See 37 C.F.R. § 1.943(b).

⁶⁰⁴ See MPEP § 2667.I.A.2.

⁶⁰⁵ See MPEP § 2667.I.A.2.; see, e.g., *inter partes* reexamination 95/000138 (2006-08-11 Notice, p. 2); *inter partes* reexamination 95/000143 (2006-09-12 Notice, p. 4).

⁶⁰⁶ See *inter partes* reexamination 95/000033 (2005-04-12 Notice, p. 2); *inter partes* reexamination 95/000016 (2004-07-14 Decision, p. 4)(declaration is “reference material such as prior art references” to the extent it explains the factual content of the prior art. To the extent it makes argument, however, such as argument relating to combinability of references, it ‘crosses the line’ and becomes part of the remarks); *inter partes* reexamination 95/000070 (2008-06-12 Notice, p. 2).

⁶⁰⁷ See *inter partes* reexamination 95/000016 (2004-07-14 Decision, p. 4).

⁶⁰⁸ See *inter partes* reexamination 95/000068 (2005-09-14 Letter, p. 3).

of a printed publication; or explain or further define terms of art used by a reference.⁶⁰⁹ Attachments to declarations, such as expert CVs, also do not count toward the page limit.⁶¹⁰

The Patent Office will divide declarations on a paragraph by paragraph basis in determining whether the fifty-page limit has been violated.⁶¹¹

(a) If Extra Pages Are Needed

If more pages are needed, the Patent Owner should petition under 37 C.F.R. § 1.183 to suspend the 50-page limit. The Patent Owner should state the number of pages that are required to equitably file a response to the Office Action. Usually, the Patent Owner will get at least as many pages as the Patent Office used in the office action.⁶¹²

E. Amendments

1. When May A Patentee Amend Or Add Claims

A Patent Owner in an *inter partes* reexamination may “propose any amendment to the patent and a new claim or claims”,⁶¹³ with the exception that the claims may not be broadened.⁶¹⁴ Note that this is somewhat different from the *ex parte* reexamination statute, which states that claims may be amended or added “in order to distinguish the invention as

⁶⁰⁹ See *inter partes* reexamination 95/000140 (2006-11-13 Letter, p. 2).

⁶¹⁰ See *inter partes* reexamination 95/000143 (2006-09-12 Decision, p. 3).

⁶¹¹ See *inter partes* reexamination 95/000016 (2004-07-14 Decision, p. 4); *inter partes* reexamination 95/000143 (2006-09-12 Decision, p. 3); *inter partes* reexamination 95/000070 (2008-06-12 Notice, p. 3).

⁶¹² See *inter partes* reexamination 95/000100 (2005-12-02 Petition Decision, p. 2)(the Patent Office granted, in the absence of a Patent Owner statement requesting a specific number of pages, a sixty-page response. This was in part due to the length fifty-eight-page office action); *inter partes* reexamination 95/000186 (2007-05-23 Petition Decision, p. 4)(the Patent Office granted the Patent Owner’s request to file a 65-page response. The length of the office action was 67 pages, and it incorporated by reference the request, which was 310 pages. The Patent Office found that allowing a response of 65 pages would be “appropriate in the interest of justice.” The Patent Office also noted “that the present petition includes a statement by patent owner that a good faith effort to limit the patent owner's response in accordance with the 50-page limitation of 37 CFR 1.943(b) was unavailing, and that the presentation of a 65 page response to the March 9, 2007 is necessary. This statement is considered to be a verified statement pursuant to the provisions of 37 CFR 10.18(b)(1).”).

⁶¹³ 35 U.S.C. § 314(a).

⁶¹⁴ See 35 U.S.C. § 314(a).

claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent.”⁶¹⁵

2. Amendments And Intervening Rights

Making amendments risks extinguishing past damages and creating intervening rights.⁶¹⁶ The author questions, therefore, why practitioners make substantive amendments to claims at all.⁶¹⁷ To the extent narrower claims are required, new claims can be added. If the older claims are not allowed in unamended form, they can be canceled. This allows the Patent Owner to preserve arguments on the unamended claims, without sacrificing the possibility of narrower claims to avoid prior art.

3. Amendments May Not “Broaden The Scope Of The Patent”

(a) Claim Amendments And New Claims

The Patent Owner is permitted to amend claims and add new claims in the *inter partes* reexamination.⁶¹⁸ Any amendment or new claim, however, may not broaden “the scope of the patent”.⁶¹⁹ If claims are broadened during reexamination, a defendant may use the broadening as a defense to infringement.⁶²⁰

The test for whether an amendment or new claim broadens the scope of a patent is the same test applied in reissue proceedings.⁶²¹ An amendment or new claim broadens the scope of the patent if it encompasses any conceivable subject matter that was not covered by the claims as originally issued.⁶²² This is true even where a claim has been narrowed in other respects.⁶²³

⁶¹⁵ 35 U.S.C. § 305. The practical effect of this difference may be minimal. *See, e.g., Cordis Corp. v. Medtronic AVE Inc.*, 85 U.S.P.Q.2d 1427, 1447 (Fed. Cir. 2008)(“For purposes of assessing validity under section 305, the MPEP directs the examiner to determine only whether any added claims impermissibly ‘enlarge the scope of the original claims.’”).

⁶¹⁶ *See* section III.A.3(a), *supra*.

⁶¹⁷ The avoidance of claim fees is not likely to be an issue where the Patent Owner considers the patent sufficient valuable to defend in *inter partes* reexamination.

⁶¹⁸ *See* 35 U.S.C. § 314(a).

⁶¹⁹ *See* 35 U.S.C. § 314(a).

⁶²⁰ *See Quantum Corp. v. Rodime, PLC*, 65 F.3d 1577, 1584 (Fed. Cir. 1995).

⁶²¹ *See* MPEP § 2658.

⁶²² *See* MPEP §§ 2658 and 1412.03 (“A claim which reads on something which the original claims do not is a broadened claim. A claim would be considered a broadening claim if

It is unclear whether the Patent Office would apply the “broadest reasonable” construction of the claims in assessing broadening under 35 U.S.C. § 314. Given that the standard for assessing broadening is based on the change in the scope of the claims in the context of infringement, a court’s approach to claim construction may apply.

4. Formal Requirements For Amendments

There are numerous formal requirements for claim amendments in reexamination. If a Patent Owner fails to comply with the formal rules, it is usually because its representative has not understood the claim amendment rules, which are not the same as used in *ex parte* prosecution. A fairly comprehensive explanation is found in the MPEP section on *ex parte* reexamination.⁶²⁴ Nevertheless, the text of the rules themselves is not as clearly presented as it could be.

In the author’s own study of the first forty *inter partes* reexaminations, at least one Notice re: Defective Paper related to amendment practice was received in twenty cases, with a number of cases having multiple notices.

5. Claim Listing (Presentation Of The Text Of Claims)

If changes are made to the claims, a listing of the claims that are being changed (or added) must be presented.⁶²⁵ The relevant rule (1.530(d)(1)) requires that each response must include “the entire text of each patent claim which is being proposed to be changed by such amendment paper and of each new claim being proposed to be added by such amendment paper”. The text of claims to be canceled should not be presented.⁶²⁶ The text of amended or new claims needs to be marked as described in section VII.E.6.

As in *ex parte* prosecution, most Patent Owner representatives will present a listing of all claims currently pending, with only amended or new claims having markings. The rule in reexamination, however, states only that the text of new or amended claims is required to be presented. The rule does not require that the text of non-amended, patented claims be presented.⁶²⁷

the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement.”).

⁶²³ See, e.g., *inter partes* reexamination 95/000008 (2003-12-17 Action Closing Prosecution, p. 13).

⁶²⁴ See MPEP § 2250 III.E.

⁶²⁵ See 37 C.F.R. § 1.530(d)(1).

⁶²⁶ See 37 C.F.R. § 1.530(d)(1).

⁶²⁷ See 37 C.F.R. § 1.530(d)(1).

Unfortunately, the Patent Office has sometimes interpreted this provision to require that that unamended claims not be presented.⁶²⁸ In other, more recent cases, the Patent Office has either stated that all claims should be presented,⁶²⁹ or avoided taking a position on whether non-amended claims must be presented.⁶³⁰ The MPEP is silent on the issue.

In the author's view, the best course is to reproduce all claims in an amendment document. The relevant rule does not require that non-amended claims be left out, nor would such a limitation make sense. If the non-amended claim is subject to a rejection, the Patent Owner's attorney should be able to present the text of the claim (or parts of it) for the Examiner's reference in the remarks. Where the Patent Office has expressed itself on the subject, the more recent decisions indicate that the presentation of the text of non-amended claims is acceptable.⁶³¹ Moreover, the Patent Office routinely accepts amendment documents that reproduce the text of unamended claims.⁶³²

6. Parentheticals (New, Amended, Canceled, etc.).

⁶²⁸ See, e.g., *inter partes* reexamination 95/000024 (2004-02-06 Notice p. 2); *inter partes* reexamination 95/000014 (2003-09-25 Notice, p. 2) (“Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim. In the present instance, the patent owner improperly presented the claims in a format under the provisions of 37 CFR 1.121, rather than 1.530. The amendment for reexamination purposes should have included only the new claims completely underlined. Further, the use of status identifiers should not have been used in this amendment, nor should the original claims, as unamended, have been provided in the amendment.”).

⁶²⁹ See, e.g., *inter partes* reexamination 95/000027 (2006-05-10 Action Closing Prosecution, p. 2) (“A complete copy of the claims should be submitted with **all** amendments since all incoming documents are scanned, and examining is done using the scanned documents.”)(emphasis in original).

⁶³⁰ See, e.g., *inter partes* reexamination 95/000038 (2006-04-06 Right of Appeal Notice p. 2)(a Third Party Requester complained that a Patent Owner amendment had presented all claims, not just the amended and new claims, and that therefore the amendment was informal. The Patent Office responded by explaining “Firstly, to the extent that 37 C.F.R. 1.530 technically prevents the patent owner from presenting all the claims in addition to those that have actually been amended, the rule is hereby waived by Senior Legal Advisor Kenneth M. Schor, who has signed this action solely for that purpose.”).

⁶³¹ See, e.g., *inter partes* reexamination 95/000038 (2006-04-06 Right of Appeal Notice, p. 2).

⁶³² For recent examples, see *inter partes* reexamination 95/000201 (2007-10-03 Amendment, p. 2); *inter partes* reexamination 95/000038 (2006-01-17 Amendment, p. 2).

The rules require that “[f]or any claim changed by the amendment paper, a parenthetical expression ‘amended,’ ‘twice amended,’ *etc.*, should follow the claim number.”⁶³³ This requirement is referred to as the requirement of “parentheticals”, to distinguish it from the requirement of a “status identifier”.⁶³⁴

The rules are not very specific as to which parentheticals should be used. There is no specific parenthetical required for new or original claims. Perhaps because of this vagueness in the governing rule, the Patent Office rarely issues a Notice Re: Defective Paper based solely on the use of the wrong parentheticals.

The rule does require that amended claims (not new, non-amended or canceled claims) have parentheticals indicating the number of amendments made. Taking this requirement into account, the usual practice is to label claims as follows:

- (1) For unamended claims in the patent as originally issued, with the parenthetical: (Original)⁶³⁵
- (2) For issued claims amended for the first time: (Amended)
- (3) For issued claims amended for the second time: (Twice Amended), *etc.*
- (4) For new claims (relative to the patent as issued): (New).⁶³⁶
- (5) For canceled claims: (Canceled).⁶³⁷

⁶³³ 37 C.F.R. § 1.530(d)(1).

⁶³⁴ *See* section VII.E.8, *infra*, for more detail on “status identifiers”.

⁶³⁵ Note that 37 C.F.R. § 1.530(d)(1) does not require presentation of the text of original claims, so there is correspondingly no parenthetical required by the rule. The Patent Office will sometimes add “original” for its own benefit if original claims are presented. *See, e.g., inter partes* reexamination 95/000038 (2006-01-17 Amendment, p. 2). The Patent Office has also, at times, admonished Patent Owners to use the parenthetical “(original)” in Notices Re Defective Papers that were largely directed at other mistakes. *See, e.g., inter partes* reexamination 95/000084 (2007-09-26 Notice, p. 2).

⁶³⁶ 37 C.F.R. § 1.530(d)(1) does not require the use of parentheticals with new claims, MPEP 2250.IV. presents an example of a new claim with no parenthetical, and numerous Patent Owners have presented new claims with no parentheticals without receiving a Notice Re Defective Paper. That said, it is the practice of many practitioners to use the parenthetical (new) with new claims, and the Patent Office has, on a number of occasions, admonished Patent Owners to use the parenthetical (new) when the text of new claims is presented. *See, e.g., inter partes* reexamination 95/000031 (2007-09-18 Notice p. 3); *inter partes* reexamination 95/000084 (2007-09-26 Notice, p. 2).

Note that new claims are labeled “New”, whether or not they are changed over the previous presentation of the new claim.⁶³⁸ The practice is somewhat inconsistent: new claims are labeled new regardless of amendment, presumably because they are new relative to the patent. Amended claims, however, change their status with each new amendment, even though relative to the patent as issued, they can always be viewed as simply “amended”.

Note that claims in *inter partes* reexamination can also be “withdrawn”. Withdrawal may occur if the proceeding is merged with a reissue application.⁶³⁹ It may also occur where the Patent Owner does not respond to an office action that rejects only some of the claims.⁶⁴⁰ In these cases, the claims should probably be provided the parenthetical “(withdrawn)”.

7. Amendment Markings (Underlining and Bracketing)

Material inserted into a claim relative to the issued patent is underlined.⁶⁴¹ Material that is removed, relative to the patent as issued, is bracketed.⁶⁴² Strikethrough and double brackets should not be used in *inter partes* reexamination.

The fundamental law of claim marking in *inter partes* reexamination is that all changes are marked relative to the patent as issued.⁶⁴³ This makes a certain amount of sense, because the Examiner and third parties observing the proceedings are generally most interested in how the claims currently in force (the issued claims) are different from the claims in

⁶³⁷ 37 C.F.R. § 1.530(d)(1) does not require canceled claims to be listed in a section together with the presentation of the text of amended claims, but rather requires only that the amendment have a statement directing the Patent Office to cancel the claims. In accordance with *ex parte* prosecution habits, however, most practitioners will provide claim numbers with the parenthetical (canceled) in their presentation of the claim texts.

⁶³⁸ See *inter partes* reexamination 95/000031 (2007-09-18 Notice, p. 3)(“[C]laims that have been added to the proceedings should be identified as ‘new’, even when they are amended.”); *inter partes* reexamination 95/000084 (2007-09-26 Notice, p. 2)(“New claims are always new and the only status identifier for a newly presented claim is (new).”)(emphasis in original).

⁶³⁹ See 37 C.F.R. § 1.176(2).

⁶⁴⁰ See MPEP § 2666.10.I.(B).

⁶⁴¹ See 37 C.F.R. § 1.530(f)(2).

⁶⁴² See 37 C.F.R. § 1.530(f)(1).

⁶⁴³ See 37 C.F.R. § 1.530(f).

reexamination. In addition, the Patent Office will issue a reexamination certificate that indicates the changes made to the claims over the issued patent.⁶⁴⁴

This rule has several unexpected consequences for those used to *ex parte* prosecution. First, new claims must be completely underlined, including the claim number.⁶⁴⁵ This is because they are new relative to the patent. If a new claim is presented in a first amendment, and then amended in a second amendment, the entire claim is still underlined in the second amendment. This is because the changes are relative to the patent, not to the previous amendment.⁶⁴⁶ This makes the process of finding changes more difficult for the Examiner, which is why the MPEP requires practitioners to explain changes to new claims in the remarks.⁶⁴⁷

Second, if an insertion is made in an issued claim by a first amendment and maintained in a second amendment, the inserted material must still be underlined in the second amendment.⁶⁴⁸ Again, this is because the material is new relative to the patent as issued, regardless of whether it was previously offered in the *inter partes* reexamination. Likewise, if material is inserted and then deleted, no markings are required.⁶⁴⁹ This is because, relative to the patent as issued, no changes have been made.

It may be useful for practitioners to have an automatic document comparison performed between the claims as amended and the claims in the issued patent, to ensure that all proper matter is underlined/bracketed. Note that matter added to a patent by a certificate of correction or completed reexamination or reissue is considered to be part of the original patent.⁶⁵⁰

⁶⁴⁴ See MPEP § 2250.II.

⁶⁴⁵ See *inter partes* reexamination 95/000031 (2007-09-18 Notice p. 3); 37 C.F.R. § 1.530(d)(2) and (f); *inter partes* reexamination 95/000007 (2004-10-28 Notice, p. 2).

⁶⁴⁶ See, e.g., *inter partes* reexamination 95/000031 (2007-09-18 Notice p. 3); *inter partes* reexamination 95/000084 (2007-09-26 Notification, p. 2).

⁶⁴⁷ See MPEP § 2250.IV.(D) (“Although the presentation of the amended claim does not contain any indication of what is changed from a previous version of the claim, patent owner must point out what is changed, in the ‘Remarks’ portion of the amendment.”).

⁶⁴⁸ See, e.g., *inter partes* reexamination 95/000007 (2006-03-27 Notice p. 2); *inter partes* reexamination 95/000054 (2008-09-29 Notice, p. 3) (“all amendments are to be made vis-a-vis the original patent, including the claims--not vis-a-vis previously proposed amendments in the reexamination proceeding....Accordingly, Patentee's proposed amendment to claim 1 should simply have left out the strike-through text.”).

⁶⁴⁹ See, e.g., *inter partes* reexamination 95/000018 (2004-04-29 Notice p. 3).

⁶⁵⁰ See *inter partes* reexamination 95/000088 (2008-05-20 Action, p. 1).

8. Status Of Claims

Rule 1.530(e) requires that the Patent Owner provide “on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment...”⁶⁵¹ The “status of claims” is sometimes confused with the required parenthetical.⁶⁵² At least part of the confusion arises because the Patent Office will, on occasion, refer to the parenthetical as a “status identifier”.⁶⁵³ In contrast to the parenthetical, however, the status of claims is simply a statement, separate from the marked up claims, about which claims are pending and which are canceled. It is usually a sentence or two at the beginning of the remarks, but to be certain of avoiding a Notice Re Defective Paper, it is prudent to have a separate “Status of Claims” heading, with a table showing each claim and its status.⁶⁵⁴ The Patent Office has at least once required the status of claims to appear on a sheet separate from the amendment document.⁶⁵⁵ The latter interpretation, however, does not appear to be common.

9. Support For Claim Changes

Rule 1.530(e) also requires that the Patent Owner provide “on pages separate from the pages containing the changes...an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper.”⁶⁵⁶ The support must be given by even the most mundane changes, for example, the amendment of dependent claims into independent claims.⁶⁵⁷

⁶⁵¹ 37 C.F.R. § 1.530(e).

⁶⁵² See section VII.E.6, *supra*.

⁶⁵³ See, e.g., *inter partes* reexamination 95/000084 (2007-09-26 Notice, p. 2).

⁶⁵⁴ See *inter partes* reexamination 95/000030 (2004-05-20 Notice, p. 3)(“No statement of support on pages separate from the amendment was included for the added claims.”); *inter partes* reexamination 95/000007 (2005-03-08 Resubmission, p. 11).

⁶⁵⁵ See *inter partes* reexamination 95/000018 (2004-04-29 Decision, pp. 2-3)(issuing a “Decision As To, And Notice Of Inappropriate/Defective Papers”, where the first paragraph of the remarks stated “[c]laims 1-28 remain in the application”. The Patent Office eventually accepted a revised amendment with a “Status of Claims” section on a separate sheet of paper, which stated only “[c]laims 1-28 are pending as of this date of this amendment”).

⁶⁵⁶ 37 C.F.R. § 1.530(e).

⁶⁵⁷ See, e.g., *inter partes* reexamination 95/000103 (2008-07-25 Notice, p. 2)(“There is no statement of support to the changes made to claims 3, 8 and 52. While it is recognized that these claims were rewritten in independent form, these changes must nevertheless also be supported by a statement in compliance with 37 CFR 1.530(e)....”).

As with the “status of claims” section, this is best done on a separate page with a heading entitled “Explanation of Support”.⁶⁵⁸ The Patent Office has, on occasion, complained to Patent Owners where the “Explanation of Support” appears in multiple places in the remarks.⁶⁵⁹

The section need only cite to the portions of the specification that support the amended/new claim language, as opposed to explanations of those citations.⁶⁶⁰ In less clear cases, for example where claim text is to be supported by a drawing, it is probably best to explain in a few words how the cited subject matter supports the changes.

10. Allowed Dependent Claims

If dependent claims are allowed, but the unamended base claims are rejected, the dependent claim need not be written in independent form.⁶⁶¹ Instead, the reexamination certificate can issue with a dependent claim depending on canceled base claims. If the base claims were amended, however, the dependent claim may be objected to by the Patent Office.⁶⁶²

11. Line Spacing

Amendments to the claims are required to be 1.5 or double-spaced. The line spacing is not, however, required for responses that are pure remarks.⁶⁶³

F. Information Disclosure

1. Types of Information to Disclose

The disclosure of prior art or other relevant subject matter by a Patent Owner is governed by *ex parte* reexamination rule 1.555,⁶⁶⁴ which mirrors *ex parte* prosecution rule 1.56, modified to apply to reexamination proceedings.⁶⁶⁵

⁶⁵⁸ See section VII.E.8, *supra*.

⁶⁵⁹ See, e.g., *inter partes* reexamination 95/000102 (2008-09-15 Notice, p. 2) (“There is no statement of support to the changes made to claims 2, 4, 5, 11-16, 33, 46 and 55. Rather than addressing the question of support for claim amendments in one section, Patent Owner has comments directed at certain claim amendments scattered throughout his remarks, thus making review for this issue difficult.”).

⁶⁶⁰ For an example of this, see *inter partes* reexamination 95/000007 (2005-03-08 Resubmission, p. 11).

⁶⁶¹ See MPEP § 2660.03.

⁶⁶² See *inter partes* reexamination 95/000044 (2007-10-29 Notice, p. 1).

⁶⁶³ See *inter partes* reexamination 95/000227 (2008-04-09 Decision, p. 2).

Rule 1.555 requires that information material to patentability⁶⁶⁶ be submitted to the Patent Office, and recommends that the information be submitted within two months of the order for reexamination.⁶⁶⁷ Information “material to patentability” of course includes prior art patents or printed publications which, alone or in combination with other references, establish a *prima facie* case of patentability.⁶⁶⁸ Such patents or publications need not be submitted if they are cumulative to references already of record, or if they are not prior art.⁶⁶⁹

- Beyond patents or printed publications, there are numerous types of information that a Patent Owner may wish to submit to the Patent Office. Submission of the documents, although they may not strictly be required by rule 1.555 or federal case law on inequitable conduct, may at least practically foreclose the allegation of inequitable conduct in later proceedings, and may even, for all practical purposes, render the underlying substantive defenses ineffective.

2. Special Form Requirements in an *inter partes* reexamination

Information disclosure statements (IDS) are submitted pursuant to *ex parte* prosecution practice under rule 1.98 via the action of rules 1.933 and 1.555(a).⁶⁷⁰ Rule 1.98 applies to the “application”, but Rule 1.555 somewhat ambiguously requires that 1.98 be applied “as applied to individuals associated with the patent owner in a reexamination proceeding....”. Presumably, this means that the references in the rule to the “application” for which the IDS is being submitted⁶⁷¹ should be treated as references to the “patent” under reexamination.

There are two particular points which should be made with regard to IDS forms. First, a Patent Owner should generally refrain from providing substantive commentary in an IDS

⁶⁶⁴ See 37 C.F.R. § 1.933.

⁶⁶⁵ See 37 C.F.R. § 1.555(a) and (b).

⁶⁶⁶ See 37 C.F.R. § 1.555(a).

⁶⁶⁷ See 37 C.F.R. § 1.555(a).

⁶⁶⁸ See 37 C.F.R. § 1.555(b).

⁶⁶⁹ See 37 C.F.R. §§ 1.555(b) and 1.555(b)(1).

⁶⁷⁰ See 37 C.F.R. § 1.933 (referencing 1.555 referencing 1.98).

⁶⁷¹ See, e.g., 37 C.F.R. § 1.98(a)(1)(i).

unless expressly required by a rule.⁶⁷² A refusal to enter a Patent Owner IDS would most likely arise if the Patent Owner decided to include substantive comments in the IDS document.⁶⁷³

Second, for any Patent Owner IDS that is submitted after a Patent Owner response on the merits, it may be necessary to state that the IDS is being submitted under 37 C.F.R. § 1.933, and not as a supplemental response under 37 C.F.R. § 1.945(b). If the IDS can be construed “as part of the response”, it may afford the Third Party Requester the opportunity to further submit comments.⁶⁷⁴

G. Supplemental Response Practice Is Limited

Early Patent Office practice in allowing supplemental amendments was unclear, leading to the haphazard submission and acceptance of such responses.⁶⁷⁵ In some cases, the

⁶⁷² For example, 37 C.F.R. § 1.98(a)(3)(i).

⁶⁷³ See, e.g., *inter partes* reexamination 95/000080 (2007-03-30 Petition Decision, p. 7) (refusing to enter commentary in a Third Party Requester IDS).

⁶⁷⁴ See *inter partes* reexamination 95/000078 (2006-12-01 Communication)(Patent Owner submitted a supplemental IDS. The Third Party Requester was able to submit comments in response to the supplemental IDS). *But see inter partes* reexamination 95/000080 (2007-03-30 Petition Decision, p. 7)(the Third Party Requester submitted new prior art and commentary in response to a non-final office action. The Patent Office did not enter the commentary, but ruled that the new prior art had to be considered because it had been submitted by the Patent Owner in an IDS under its duty of disclosure); *inter partes* reexamination 95/000065 (2008-05-02 Notice, p. 3)(in returning Third Party Requester comments on an Information Disclosure Statement by the Patent Owner, the Patent Office stated “[a]n IDS without comment by the Patent Owner in Patent Owner's response is not a response to an Office action within the meaning of Rule 1.947.”).

⁶⁷⁵ In *inter partes* reexamination 95/000039, the Patent Owner filed a supplemental response. The Third Party Requester complained that it was a mini-rebuttal not allowed by the rules, but also filed comments on the supplemental request. The Examiner explicitly considered both papers. See *inter partes* reexamination 95/000039 (2005-05-19 Action Closing Prosecution). In the same case, after the Action Closing Prosecution, the Patent Owner tried again to submit a supplemental response entitled “Response to Requester’s Comments in Inter Partes Reexamination”, which was returned by the Patent Office under 1.951(a). The Patent Office reasoned that the Patent Owner could petition under 1.181 if any decision after Action Closing Prosecution is adverse to the Patent Owner. See *inter partes* reexamination 95/000039 (2006-04-06 Decision). In *inter partes* reexamination 95/000043, the Patent Owner submitted what was in effect a response to the Third Party Requester’s comments. The Third Party Requester submitted a response to the response. The Examiner expressly considered all papers. See *inter partes* reexamination 95/000043 (2005-04-11 Action Closing Prosecution, p. 2).

submission of supplemental responses by the Patent Owner and follow-on comments by the Third Party Requester did not stop until the Patent Office issued its next action.⁶⁷⁶

The Patent Office reformed this practice by amendment to rule 1.945 in April, 2007. Now, supplemental responses are allowed only under limited circumstances.⁶⁷⁷ With any such response, the Patent Owner must include a statement showing how the conditions of 37 C.F.R. § 1.111(a)(2)(i) are satisfied, a statement as to why the response could not have been submitted earlier, and a “compelling” reason to enter the response.⁶⁷⁸ Rule 1.111(a)(2)(i) can only be satisfied by showing that the supplemental response cancels claims, adopts an Examiner suggestion, places the case in condition for allowance,⁶⁷⁹ responds to a requirement made after filing of the first response, corrects informalities, or simplifies the issues for appeal.⁶⁸⁰

The Patent Owner thus does not have a right to comment on Third Party Requester comments as such, and the Patent Office has more recently returned attempts to do so. In *inter partes* reexamination 95/000058, for example, the Patent Office returned a Patent Owner paper that commented on Third Party Requester comments. In the decision, the Patent Office stated:

[t]he patent owner's response to the requester's June 11, 2007 comments is an unauthorized paper in the present reexamination proceeding because it is not provided for in the reexamination statute, regulations, or practice. After an action closing prosecution, the patent owner has only **one** opportunity to file

⁶⁷⁶ See, e.g., *inter partes* reexamination 95/000014 (twelve responses/comments filed prior to the mailing of the Action Closing Prosecution).

⁶⁷⁷ See 37 C.F.R. § 1.945(b).

⁶⁷⁸ See 37 C.F.R. § 1.945(b).

⁶⁷⁹ See *inter partes* reexamination 95/000227 (2008-02-04 Petition Decision, p. 6)(“However, in the rulemaking that promulgated 37 CFR 1.111(a)(2)(i), it is noted that ‘the standard for entry under § 1.116 [of a response after final action] is similar to the standard for entry under § 1.111(a)(2)(i).’ That is, with respect to entry of a supplemental response pursuant to 37 CFR 1.111(a)(2)(C), the standard of whether the response has placed ‘the application in condition for allowance’ (or, in a reexamination proceeding, whether the claims are placed in a condition to be held patentable or confirmed) is not a subjective standard based upon an applicant's or patent owner's belief that the supplemental response places the *inter partes* reexamination proceeding in condition for termination favorable to the applicant or patent owner. Rather, the standard under 37 CFR 1.111(a)(2)(C) is an objective standard, i.e., whether the supplemental response adopts examiner's suggestions made on the record of the proceeding, such that the proceeding would be ready for issuance of a Notice of Intent to Issue a Reexamination Certificate.”).

⁶⁸⁰ See 37 C.F.R. § 1.111(a)(2).

comments pursuant to 37 C.F.R. 1.951(a) in response to the issues raised in the Office action closing prosecution, and nothing further is provided for. Any further paper in opposition/rebuttal/response to the requester paper is improper and will not be considered. There is a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination.⁶⁸¹

As noted by the Patent Office in one case, a supplemental response must contain some justification for its entry. If it does, the Examiner can make a decision to enter or not to enter it. If it does not, it is subject to an immediate petition to strike.⁶⁸²

VIII. Third Party Comments

A. General

After a Patent Owner response to an office action, a Third Party Requester is given one opportunity to comment on the Patent Owner's response. The comments are due within thirty days after the date of service, and are limited to issues raised in the office action or the Patent Owner's response thereto, absent special circumstances discussed below.

1. Importance Of "Proposed Rejections".

It is important to understand that a Third Party Requester can not appeal a finding of patentability as such. Rather, the Third Party Requester must appeal proposed rejections that were not adopted.⁶⁸³ At the time a Third Party Requester drafts its Appellant's brief, it will be required to identify specific proposed rejections. The proposed rejections presumably must meet the standards of particularity governing the initial request.⁶⁸⁴

A Third Party Requester's comments, therefore, should always be couched in the language of, or at the least include, proposed rejections. This is especially true where an Examiner refuses to adopt or withdraws a rejection. In the next available comment, the Third Party Requester should maintain or propose that rejection if it wishes to appeal the issue.⁶⁸⁵

⁶⁸¹ *Inter partes* reexamination 95/000058 (2007-09-10 Letter, p. 10)(emphasis in original); *see also inter partes* reexamination 95/000071 (2007-09-25 Right of Appeal Notice, pp. 2-3).

⁶⁸² *See inter partes* reexamination 95/000227 (2007-12-19 Petition Decision, pp. 4-5).

⁶⁸³ *See* section XII.B.3, *infra*.

⁶⁸⁴ *See* section V.E.7, *supra*; *see also, e.g.*, 95/000009 (2007-03-30 Board Decision, pp. 3-4).

⁶⁸⁵ *See* 37 C.F.R. § 41.67(c)(1)(vi).

The Third Party Requester's proposed rejections should follow the same guidelines applicable to the request.⁶⁸⁶ Principally, the Third Party Requester should not propose "shotgun" rejections that require the Patent Office to work through multiple unexplained interpretations, and should not cite references on an IDS form that are not used in proposed rejections.⁶⁸⁷

B. Scope Of Allowable Comment

1. Limitations On The Right To Comment

The right of the Third Party Requester to participate in the proceedings does not include a general right to comment on all matters. Instead, section 35 U.S.C. § 314(b) states:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

There are several pertinent limitations in this paragraph. First, a Third Party Requester may only file comments on a Patent Owner response to an office action. If a Patent Owner does not respond to an office action, Third Party Requester comments are not allowed.⁶⁸⁸ Second, the comments must be on a response to an action on the merits.⁶⁸⁹ The Third Party Requester does not have the right to comment on intermediate filings of the Patent Owner (such

⁶⁸⁶ For further details on these requirements, *see* section V.E, *supra*.

⁶⁸⁷ *See, e.g., inter partes* reexamination 95/000272 (2008-09-04 Decision, p.)("In the response filed July 18, 2008 by the Third Party Requestor the proposed rejection statements of the Third Party Requestor on pages 4 and 5 of the response is improper. The explanation must not lump together the proposed rejections or proposed combinations of references. The proposal must also address those claims as amended and give an explanation of how the cited patents or printed publications are applied to all claims which the requester considers to merit reexamination based on patents or printed publications.").

⁶⁸⁸ *See* MPEP 2667 I.B.1; *inter partes* reexamination 95/00053 (2005-12-21 Letter p. 4)(a "Request to Close Prosecution" was returned to the Third Party Requester after the Patent Owner failed to respond to the initial office action).

⁶⁸⁹ Note that, in the context of interviews, the Patent Office has a broad definition of "on the merits" that is likely not applicable in this situation. In that context, "on the merits" includes anything not ascertainable from the written record. *See* MPEP § 2685. Because the Third Party Requester is commenting on a presumably written action, however, the definition is not helpful in deciding the actions on which the Third Party Requester may comment.

as an information disclosure statement) or purely procedural actions by the Patent Office (such as petition decisions).⁶⁹⁰

The Patent Office has previously allowed a Third Party Requester to comment on subject matter raised in a Patent Owner petition that accompanied an amendment. In *inter partes* reexamination 95/000134, the Third Party Requester commented on the Patent Owner's Response and an accompanying petition to reopen prosecution.⁶⁹¹

If the Patent Owner submits a declaration, comments on the credibility of the declarant are considered to be a proper response. The Third Party Requester should be careful, however, to avoid allegations of misconduct.⁶⁹²

The Third Party Requester may, through an express waiver, forego its right to comment.⁶⁹³

2. Submission of Additional Prior Art

After the filing of the request for reexamination, prior art may be only submitted by a Third Party Requester under certain circumstances.⁶⁹⁴ A citation by the Third Party Requester may only be made in connection with a comments submission after a non-final office action or an action closing prosecution.⁶⁹⁵ If the Patent Owner does not respond to any office actions, the Third Party Requester has no right to submit new prior art absent a petition decision waiving 37 C.F.R. § 1.948(a).⁶⁹⁶

Rule 1.948(a) limits the submission of new prior art to three cases: (1) where the prior art is necessary to rebut a finding of fact by the Examiner; (2) where the prior art is necessary to rebut a response of the Patent Owner; and (3) where the prior art was previously unknown to the Third Party Requester.⁶⁹⁷ The Third Party Requester, in submitting its prior art,

⁶⁹⁰ See MPEP § 2667.B.3.

⁶⁹¹ See *inter partes* reexamination 95/000134 (2007-11-27 Petition Decision, p. 5)

⁶⁹² See *inter partes* reexamination 95/000227 (2008-12-19 Petition Decision, p. 4).

⁶⁹³ See *inter partes* reexamination 95/000274 (2008-10-06 Petition Decision, pp. 7-8).

⁶⁹⁴ See 37 C.F.R. § 1.948; *inter partes* reexamination 95/000124 (2007-11-28 Decision, p. 3).

⁶⁹⁵ See 37 C.F.R. § 1.948(a).

⁶⁹⁶ See, e.g., *inter partes* reexamination 95/000102 (2008-06-26 Notice, p. 3)(returning Third Party Requester comments for adding references and proposed rejections).

⁶⁹⁷ See 37 C.F.R. § 1.948(a).

must point out which of these exceptions applies, as the Patent Office has previously rejected papers that simply state “this submission satisfies 37 C.F.R. § 1.948”.⁶⁹⁸

The Patent Office has previously ruled that a finding by the Examiner or an argument that by the Patent Owner that a particular teaching is not found in the prior art does not justify the submission of new prior art under rule 1.948(a). In *inter partes* reexamination 95/000080, the Examiner stated that a prior art combination failed to teach a particular feature of one of the claims. The Third Party Requester submitted a new reference that allegedly taught the feature. The Patent Office returned the Third Party Requester’s comments, ruling that the Third Party Requester had not satisfied 37 C.F.R. § 1.948(a). The Third Party Requester petitioned for entry of the comments and the prior art, arguing that the prior art was necessary to rebut, per 37 C.F.R. § 1.948(a)(1), the Examiner’s finding that the feature was not taught in the prior art. The Patent Office ruled that the Third Party Requester’s commentary did not satisfy 37 C.F.R. 1.948(a)(1), because the Examiner’s finding was inherently to the prior art of record, not all prior art in existence. The Patent Office, however, granted the Third Party Requester’s petition to the extent that it requested the Examiner to consider the new prior art without the Third Party Requester’s commentary.⁶⁹⁹

If the Third Party Requester does submit new prior art under 37 C.F.R. § 1.948(a)(1), it should clearly explain which finding of the Examiner or argument of the Patent Owner it rebuts, or the Third Party Requester should submit new proposed rejections (*i.e.* claim charts) as well. If the Third Party Requester does neither of these things, there is a chance that the Examiner will refuse to consider the reference and the commentary associated with it.⁷⁰⁰

⁶⁹⁸ See, e.g., *inter partes* reexamination 95/000110 (2007-05-25 Notice, p. 3).

⁶⁹⁹ See *inter partes* reexamination 95/000080 (2006-03-30 Petition Decision, p. 6).

⁷⁰⁰ See, e.g., *inter partes* reexamination 95/000007 (2005-09-30 Action Closing Prosecution, p. 3)(considering Third Party Requester comments, but stating “[n]oticeably absent from the Requester’s response, however, are ‘proposed rejections’ that actually apply prior art against amended claim 1, the claims dependent therefrom, and new claims 23-28.”); *inter partes* reexamination 95/000080 (2006-04-07 Decision, p. 2)(“The requester’s comments fail to establish that any of (a)(1)-(3) are satisfied. The requester has stated that the prior art reference is cited ... ‘to rebut the findings of fact made by the Examiner....’ However, the prior art reference was cited for the purpose of contesting the examiner’s confirmation of the patentability of claim 15. The examiner did not find that it was not ‘well-known to one of skill in the art at the time of the invention in 1996 that the output of a computer sound card could be connected with another device by a wire to enable the sound signals to be passed to the device.’ Nor has the requester indicated any other finding of fact by the examiner for which the citation of the prior art reference is necessary to rebut. Rather, the citation of the prior art reference appears to be for the purpose of establishing a substantial new question of patentability regarding claim 15, based on a reference that the requester failed to supply in the initial request for *inter partes* reexamination.”).

The exception found in 37 C.F.R. § 1.948(a)(3) allows the Third Party Requester to submit prior art of which it was not previously aware, provided the Third Party Requester tells the Patent Office when it became aware of the prior art, and shows how to apply the prior art to at least one claim of the patent under reexamination.⁷⁰¹ This may affect the scope of the estoppel provision of 35 U.S.C. §§ 315(c) and 317(b), which limit the Third Party Requester based on issues that it “could have raised” in the *inter partes* reexamination proceeding.⁷⁰²

If the Third Party Requester is not allowed to submit prior art under rule 1.948, then it can petition for waiver of rule 1.948. The Third Party Requester may also wait for a final decision in the current *inter partes* reexamination, to avoid the limitation of 35 U.S.C. § 317(a), and then file a new request. Filing a request for *ex parte* reexamination based and petitioning for merger may not work—the Patent Office has previously refused merge an *ex parte* reexamination requested by the Third Party Requester with the ongoing *inter partes* reexamination.⁷⁰³

3. Submission Of Additional Proposed Rejections

Where the Third Party Requester proposes rejections based on previously cited prior art, 37 C.F.R. § 1.948 does not apply. In that case, the Third Party Requester may be restricted by 37 C.F.R. § 1.947, which limits comments to the scope of issues addressed in the Office Action or Patent Owner Response.⁷⁰⁴

If a prior art rejection not adopted, and the claims have been amended, the Third Party Requester is allowed to propose prior art rejections as to the amended claims.⁷⁰⁵ Whether those prior art rejections must be the same as those previously withdrawn or not adopted is not entirely clear.⁷⁰⁶ However, in *inter partes* reexamination 95/000114, the Patent Office deemed

⁷⁰¹ See 37 C.F.R. § 1.948(a)(3). Whether this section would allow the submission of prior art against claims not under reexamination is unclear.

⁷⁰² See 37 C.F.R. § 1.948(a). Note that even beyond this point, the Third Party Requester could petition to reopen prosecution and waive rule 1.948.

⁷⁰³ See *inter partes* reexamination 95/000096 (2006-07-17 Petition Decision, p. 5).

⁷⁰⁴ See 37 C.F.R. § 1.947.

⁷⁰⁵ See MPEP § 2666.05.III.

⁷⁰⁶ *But see inter partes* reexamination 95/000112 (2007-11-29 Notice, p. 2)(“Additionally, the Third Party's inclusion of the provisional rejections of claims under the doctrine of judicially created double patenting was not earlier a part of either the Office action mailed December 13, 2005, nor a part of the patent owner's response, February 2, 2006. As such, the newly proposed rejections do not fall within the accepted ‘content’ described in MPEP 2666.05 nor 37 CFR 1.948.”).

defective a Third Party Requester's comments that sought to introduce new proposed rejections based on previously cited art. The Patent Office reasoned:

The third-party requester's comments filed 09/26/2007 do not comply with 37 CFR 1.947 because the comments are not limited to issues raised by the office action or the patent owner's response. In the office action mailed 07/27/2007, the examiner refused to adopt the third-party requester's proposed rejection of claims 1-6 and 9 as anticipated by DD 314. See items 78-81, 95, & 96 of the office action. The patent owner did not respond with respect to this particular issue. At p. 14 of the third-party requester's comments filed 09/26/2007, the third-party requester proposed an alternative ground of rejection: the same claims are obvious in view of the same reference. The issue raised in the office action was the refusal to adopt the anticipation rejection. The proposal of the obviousness rejection does not address this issue, but instead raises an entirely new issue: whether or not the claims are anticipated by [sic:obvious over] this reference. The third-party requester is given a time period of 30-days or one month from the date of this letter, whichever is longer, to rectify and refile the comments. See MPEP 2666.05.⁷⁰⁷

C. The Most Practice-Relevant Form Requirements

1. Maximum Fifty Pages Length

As with Patent Owner responses, comments by the Third Party Requester are limited to fifty pages.⁷⁰⁸ The page counting rules are the same as those applied to Patent Owner responses, with due regard to the fact that the Third Party Requester will not be submitting amendments.⁷⁰⁹

Like the Patent Owner, the Third Party Requester may petition for waiver of rule 1.943(b). The Third Party Requester's petition should set forth reasons for the waiver beyond the fact that the Patent Owner received extra pages for its response.⁷¹⁰

⁷⁰⁷ *Inter partes* reexamination 95/000115 (2008-09-29 Notice, p. 3).

⁷⁰⁸ *See* 37 C.F.R. § 1.943(b).

⁷⁰⁹ *See* section VII.D.3, *supra*.

⁷¹⁰ *See inter partes* reexamination 95/000276 (2008-03-28 Petition Decision, pp. 3-4) (“...the third party requester has not provided any specific facts as to why the third party requester would need to file written comments that exceed the 50-page limit. The patent owner's response to the Office action is required under 37 CFR 1.111(b) to distinctly and specifically point out the supposed errors in the Office action and must reply to every ground of objection

Given the limited time allotted for Third Party Requester submissions, the petition should probably be submitted with the comments. If the petition is not grantable, the Patent Office will return the comments and give the Third Party Requester fifteen days to bring the comments into proper form.⁷¹¹ The Third Party Requester may wish to divide comments into sections, the less important of which can be easily removed if a petition is not granted.

2. Allowable Content Of A Comment

The statute limits Third Party Requester comments to “issues raised by the action of the Office or the patent owner’s response thereto”. Patent Office practice reflects this wording if the comments are following a non-final office action.⁷¹² If the comments are following a patent owner response to an action closing prosecution, however, 37 C.F.R. §1.951(b) further limits the scope of Third Party comments to the scope of the Patent Owner’s response.⁷¹³ That is, the Third Party may not comment on issues in the Action Closing Prosecution not addressed in the Patent Owner’s Response.⁷¹⁴ Material falling outside these limits risks return.⁷¹⁵ The Third Party Requester will generally be given a period of thirty days to remedy the situation.⁷¹⁶

The Patent Office has returned a number of Third Party Requester comments for containing subject matter outside the scope of the office action and response. In *inter partes* reexamination 95/000091, for example, the Third Party Requester discussed an office action issued by the European Patent Office in a related case. The Patent Office returned the entire paper, giving the Third Party Requester 30 days to correct it.⁷¹⁷ The Patent Office also seems particularly ill-disposed toward allegations of misconduct, and has returned several papers making such allegations.⁷¹⁸

and rejection in the Office action. This requirement does not apply to the third party requester's written comments. The mere fact that the USPTO grants the patent owner an additional fifty pages for responding to the Office action is not *per se* sufficient to justify an additional fifty pages for the third party requester's written comments.”).

⁷¹¹ See MPEP § 2667.B.2.

⁷¹² See MPEP § 2666.05.II.

⁷¹³ See 37 C.F.R. § 1.951(b); MPEP § 2672.IV.

⁷¹⁴ See *id.*

⁷¹⁵ See MPEP § 2666.05.II.

⁷¹⁶ See MPEP § 2666.05.II.

⁷¹⁷ See *inter partes* reexamination 95/000091 (2007-05-21 Decision, p. 1).

⁷¹⁸ See *supra* section V.A.3(e), *supra*.

The Patent Office has sometimes gone so far as to state that Third Party Requesters should point out in their requests exactly to which portion of the office action or response particular comments are directed.⁷¹⁹ However, “[i]f this is not done by the third party requester, the comments should not be held defective if the Examiner can ascertain that all of the comments filed by the third party requester are directed to the issues and points in the Office action and/or the patent owner’s response.”⁷²⁰

3. Informality Notice

The Patent Office will on occasion notify the Third Party Requester that its comments are defective. In such a situation, the Patent Office will sometimes give the Third Party Requester an additional time period to correct the defect,⁷²¹ although the authority to do this is unclear. If the comments were not a *bona fide* attempt to following the rules, the MPEP states that the Patent Office may refuse the comments consideration altogether.⁷²²

4. Letters Correcting Comments

Where minor errors were made in a response or Third Party Requester comments, the party may submit a letter briefly specifying the error. The Patent Office has typically not returned such letters as improper.⁷²³

D. Due Date

1. Counting Thirty Days

One of the harshest procedural aspects of the *inter partes* reexamination is the thirty-day, non-extendable comment period for the Third Party Requester.⁷²⁴ Representatives of

⁷¹⁹ See MPEP § 2666.05.II.

⁷²⁰ See MPEP § 2666.05.II.

⁷²¹ See MPEP § 2666.05.II.; see, e.g., *inter partes* reexamination 95/000091 (2007-05-21 Decision, p. 1).

⁷²² See MPEP § 2667.

⁷²³ See, e.g., *inter partes* reexamination 95/000120 (2008-06-08 Letter); *inter partes* reexamination 95/000119 (2008-03-28 Letter).

⁷²⁴ See 35 U.S.C. § 314(b)(2); United States Patent & Trademark Office, REPORT TO CONGRESS ON INTER PARTES REEXAMINATION, <http://www.usPatentOffice.gov/web/offices/dcom/olia/reports/reexam_report.htm>, p. 5 (“The current 30-day comment period has been identified as unduly burdensome on the third-party requester of *inter partes* reexamination.”)

the Patent Office have sometimes characterized the thirty-day period as “unduly burdensome” on the Third Party Requester.⁷²⁵

The due date for Third Party Requester comments can be easily miscalculated, even by the Patent Office. The statute indicates that comments must be “received by the Office within 30 days after the date of service of the patent owner’s response.”⁷²⁶ The first thing to notice is that the event which triggers the 30-day period is service of the Patent Owner response. Because the Patent Owner papers can be served by U.S. mail, and because the date of service is the date of mailing, not the date of receipt,⁷²⁷ the Third Party Requester is likely to have less than the full 30 days to prepare its response. Notably, the due date is not calculated from the date the Patent Owner response was due in the Patent Office, the day the Patent Office receives the Patent Owner response, or the day the Third Party Requester receives the response (unless service was not by U.S. mail).

The statute further indicates that the comments must be received by the Patent Office within a 30 day window that begins [the day] after the date of service. This should work as in the following example: The Patent Owner serves its response on January 1 by U.S. mail. The Third Party Requester receives the response on January 7. The thirty-day period after January 1 encompasses January 2 to January 31. The Third Party Requester must therefore ensure that the Patent Office receives its comments on or before January 31.⁷²⁸

In *inter partes* reexamination 95/000023, for example, the Patent Owner papers indicated that a response had been served on December 8, 2003. The thirty day period after December 8, 2003, included the twenty-three days from December 9 to December 31, and the first seven days of January. The Patent Office returned Third Party Requester comments filed on January 8, 2004, stating:

The record shows that the date of service of the patent owner's response (paper No. 8) is December 8, 2003. Any requester comments, in reply to patent owner's response must be filed within 30 days or January 7, 2004. The comments filed on January 8, 2004, were filed one day late....Accordingly, pursuant to 37 CFR §§ 1.947 & 1.957(a), the comments filed on January 8, 2004, by

⁷²⁵ *See id.*

⁷²⁶ 35 U.S.C. § 314(b)(2).

⁷²⁷ *See* 37 C.F.R. § 1.248(a)(4) (“Transmission by first class mail. When service is by mail the date of mailing will be regarded as the date of service....”).

⁷²⁸ *See, e.g., inter partes* reexamination 95/000018 (2004-04-29 Notice p. 4)(comments served two days late were refused); *inter partes* reexamination 95/000078 (2007-11-30 Third Party Requester Comments acceptable when Patent Owner response served on October 31, 2007).

the third party requester in reply to the patent owner's response of December 8, 2003, will not be considered by the examiner.⁷²⁹

It is perhaps worth noting that the Third Party Requester comments were eventually accepted in this particular case, because the Patent Owner had not served a signed copy of the certificate of service on the Third Party Requester.⁷³⁰ The author has at times felt that the Patent Office will attempt to avoid a technically harsh result for late-filed papers if some procedural vehicle is present that arguably would allow late service.⁷³¹ Furthermore, the Patent

⁷²⁹ *Inter partes* reexamination 95/000023 (2004-03-08 Notice, p. 2).

⁷³⁰ The certificate of service accompanying the Patent Owner response of December 8, 2003, stated that the response had been deposited in USPS 1st class mail. The certificate of service, however, was not signed. The Requester received an email copy on December 12, which also did not contain the signed Certificate of Service. The Requester filed comments on January 8, 2004. The Patent Office notified the Third Party Requester that the comments were one day late, and would not be considered. *See inter partes* reexamination 95/000023 (2004-3-8 Notice p. 2). The Third Party Requester petitioned to have comments entered, since the papers actually served by the Patent Owner did not have a signed certificate of service. The Patent Owner responded to the petition, saying that a signed certificate of service was not necessary, because the Third Party Requester knows it is being served. The Patent Office found that (1) the comments were filed 31 days after the filing date of the Patent Owner response, but (2) the Patent Owner response was not properly served on December 8, because the papers actually served were not a "document" within the meaning of 37 C.F.R. 1.903. Rule 903 says any document filed must be served according to 1.248, the inference drawn by the Patent Office being that if service is not according to rule 1.248, the paper submitted is not a "document". Rule 1.248 says that papers filed which require service shall contain proof of service which "may" be attached to the papers as filed. The Patent Office then reasoned that the Third Party Requester had acknowledged that service was made on December 12 in its petition (although the Third Party Requester's petition stated that no complete certificate of service was present). This allowed the Patent Office to find that service had been accomplished by email satisfying rule 1.248(a)(1), which requires "delivering a copy of the paper to the person served". Since the service date was effectively December 12, 2003, a reply date of January 8, 2004 was deemed acceptable. *See inter partes* reexamination 95/000023 (2004-06-17 Decision pp. 2-3). This was in spite of the fact that (1) no complete certificate of service was ever served and (2) the Patent Owner response did not "contain" proof of service; it came later, after filing, thus making it, by the Patent Office's reasoning, a "document" only after the Patent Owner's deadline for filing had expired.

⁷³¹ *See, e.g., inter partes* reexamination 95/000078 (2006-12-01 Communication, pp. 4-5)(determining that an IDS filed by the Patent Owner after its response had been served was actually a "supplemental response", and allowing the Third Party Requester comment period to begin on the date of service of the IDS); *inter partes* reexamination 95/000018 (2004-04-29 Notice, p. 6)(finding that Third Party Requester comments were submitted three days too late, but also finding that the original Patent Owner response was defective and allowing both parties to refile their submissions).

Office has, on occasion, not refused Third Party Requester comments that were filed on the thirtieth day after the date of service.

The Patent Office rule implementing 35 U.S.C. § 314(b) is less clear on when the thirty day period begins, however, stating that the comments must be filed “within a period of 30 days from the date of service of the patent owner’s response”⁷³², changing the word “after” in the statute to “from” in the rule. This could lead to the interpretation that the date of service is included in the thirty day period. The MPEP unfortunately provides no guidance on this issue. The author therefore recommends filing Third Party Requester comments within twenty-nine days after the service of the Patent Owner response.

The Third Party Requester may use the mailing provisions of 37 C.F.R. §§ 1.8 and 1.10, and the comments will be received on the date deposited or transmitted in accordance with these rules.⁷³³ Furthermore, if the thirty day period would end on a Saturday, Sunday or federal holiday in the District of Columbia, it may be extended to the next regular business day.⁷³⁴

2. Due Date Where Patent Owner Response Is Deficient

If the Patent Office rules that a Patent Owner response is deficient and must be corrected, the question arises as to when the Third Party Requester may respond. Must comments be filed on the original Patent Owner response, or the Patent Owner submission in response to the Notice Re Defective Paper?

The Patent Office guidance on this matter is perhaps unnecessarily intricate. The general rule, as expressed in MPEP § 2666.40, appears to be that the Third Party Requester may respond to either the first or the second Patent Owner response.⁷³⁵ If the first Patent Owner response is too long, however, the Third Party Requester may only file comments on the second Patent Owner response.⁷³⁶ In contrast, if the deficiency in the Patent Owner response was the failure to pay a fee, the Third Party Requester may only file comments on the first Patent Owner

⁷³² 37 C.F.R. § 1.947(emphasis added).

⁷³³ See MPEP § 2666.05.I; 37 C.F.R. § 1.947.

⁷³⁴ See 35 U.S.C. § 21(b).

⁷³⁵ See MPEP § 2666.40 (“The third party requester may file comments on the response as completed. This is true whether or not the third party requester filed comments on the response that was incomplete.”).

⁷³⁶ See MPEP § 2667.I.A.2.(“Any previously submitted third party comments in response to this improper patent owner submission [of more than 50 pages] would also not be considered, as being moot, since the patent owner did not in fact respond to the Office action in accordance with the rules.”).

response.⁷³⁷ There is a further exception to this exception: if the Patent Owner deficiency was the failure to pay an excess claim fee, then the Third Party Requester may file comments on the second Patent Owner response.⁷³⁸

The complexity of this guidance suggests that the Third Party Requester should submit comments on both the original Patent Owner response and the response to the Notice Re Defective Papers. It is the author's subjective impression, however, that the Patent Office will not enforce its guidance harshly against Third Party Requesters making *bona fide* comments.

3. Due Date Where The Patent Owner Files A Petition To Make Its Response Compliant

A different due date occurs where the Patent Owner submits a response that is not compliant, together with a petition to make the response compliant. Such a situation might occur if the Patent Owner submits a response of more than fifty pages, and there is an undecided petition to exceed the limitations on length outstanding. In such a case, the Third Party Requester can not know with certainty what the content of the Patent Owner response will be.

In at least one such case, the Patent Office has held that the Third Party Requester's comments are due 30 days from the mailing date of a decision granting the Patent Owner's petition.⁷³⁹ If the petition is not granted, the response will presumably be found defective, and the Third Party Requester's comments will be due 30 days from the date of service of the amended response.

IX. The Second Round

A. Action Closing Prosecution

Normally, the second office action on the merits will be an Action Closing Prosecution.⁷⁴⁰ The Action Closing Prosecution is not a final agency decision (*i.e.* not a basis for appeal). Rather, it triggers certain restrictions on the ability of the Patent Owner to further prosecute the claims and the Third Party Requester to comment.

After an Action Closing Prosecution, the Patent Owner may not submit further amendments or evidence as a matter of right. Rather, the Patent Owner must convince the Examiner that the requirements of 37 C.F.R. § 1.116 are met.⁷⁴¹ This burden probably can not

⁷³⁷ See MPEP § 2666.40.

⁷³⁸ See MPEP § 2666.40.

⁷³⁹ See *inter partes* reexamination 95/000232 (2007-07-17 Petition Decision, p. 6).

⁷⁴⁰ See MPEP § 2671.01.VIII.

⁷⁴¹ See 37 C.F.R. § 1.951.

be met by an assertion that the Patent Owner believed that the previously unamended claim language was patentable.⁷⁴² Furthermore, the Patent Owner remarks must be limited to issues addressed in the Action Closing Prosecution.⁷⁴³ The Patent Owner response period is also shortened to one month or thirty days, whichever is greater.⁷⁴⁴

Despite these limitations, there is usually a significant amount of substantive prosecution after the Action Closing Prosecution has been mailed, and it may take some time for this to coalesce into a Right of Appeal Notice. The Examiner may also be convinced to re-open prosecution and to issue a second Action Closing Prosecution, or to issue a non-final action after the issuance of an Action Closing Prosecution.⁷⁴⁵

1. Timing Of The Action Closing Prosecution

The likely timing of the Action Closing Prosecution is discussed in section II.B.4(c).

The Patent Office generally sets a one-month response deadline for the Patent Owner after the Action Closing Prosecution, not two months.⁷⁴⁶ If Patent Office sets a two month deadline on the Patent Office L-2065 page accompanying the office action, practitioners should check the end of the office action to make sure that this is intended.⁷⁴⁷ The Patent Owner can also check the timing with a telephone call to the CRU.

2. Options After An Action Closing Prosecution

The Patent Owner has a number of options after an Action Closing Prosecution. First, the Patent Owner can do nothing. If the Patent Owner is satisfied with the current state of the claims, doing nothing will prevent further comment by the Third Party Requester. Second,

⁷⁴² See *inter partes* reexamination 95/000043 (2008-07-21 Petition Decision, p. 5).

⁷⁴³ See 37 C.F.R. § 1.951(a); MPEP § 2672.III.

⁷⁴⁴ See MPEP § 2672.II.

⁷⁴⁵ See, e.g., *inter partes* reexamination 95/000036 (2007-01-30 Office Action, p. 2) (“Pursuant to MPEP 2673.01, Part I, prosecution is reopened based upon the examiner's decision to modify his position. The prosecution is reopened by issuance of the following action, which does NOT close prosecution.” - issuing a non-final action, an Action Closing Prosecution, then a non-final action, then a second Action Closing Prosecution).

⁷⁴⁶ See 37 C.F.R. § 1.953(b); MPEP § 2671.III.(D).

⁷⁴⁷ See, e.g., *inter partes* reexamination 95/000191 (2007-07-23 Action Closing Prosecution, pp. 1 and 6)(setting a two-month reply deadline on the first page and a one-month reply deadline at the end of the office action); *inter partes* reexamination 95/000275 (2008-06-24 ACP, pp. 1 and 14)(same).

the Patent Owner can file a response with argument. Third, the Patent Owner can file a response with amendments and / or new evidence.

If the Patent Owner files a response with amendments and / or new evidence, it has a tactical choice to make, because the presentation of new amendments and evidence is limited by 37 C.F.R. §§ 1.951 and 1.116. One option is to file what is called here a “petition for a non-final action”. This can be a petition under 37 C.F.R. § 1.182 for continued reexamination. A related, although less advisable option, is to file a petition requesting that prosecution be reopened or that the finality of the Action Closing Prosecution be removed. A third option is to file a Response with the amendments, arguing that the amendments meet the requirements of Rule 1.116, and wait for a Patent Office response (most likely in a Right of Appeal Notice). If the response is unfavorable, the Patent Owner may file a petition for entry of the amendments, where it will need to argue that the requirements of 37 C.F.R. §§ 1.951 and 1.116 were met.

Of course, there is no reason why the Patent Owner can not file multiple petitions at the same time, allowing the Patent Office to pick a winner.⁷⁴⁸ The Patent Owner must simply take care to file the petitions in separate papers and pay separate fees.⁷⁴⁹

These options are discussed in more detail below.

B. Patent Owner Response To The Action Closing Prosecution

1. Does A Response Need To Be Filed?

The Patent Owner is not required to file a response to an Action Closing Prosecution. According to the MPEP, the omission of a response to the Action Closing Prosecution will not affect the Patent Owner’s rights on appeal,⁷⁵⁰ and this appears to be a proper reading of 37 C.F.R. § 1.953(a).⁷⁵¹ While at least one Examiner has previously ignored

⁷⁴⁸ See, e.g., *inter partes* reexamination 95/000149 (2008-10-08 Petition Decision, p. 2)(denying petition under 37 C.F.R. § 1.181 for entry of amendments) and *inter partes* reexamination 95/000149 (2008-10-14 Petition Decision, p. 2)(granting a request for continued reexamination on the same facts).

⁷⁴⁹ See section X.B.4, *infra*; *inter partes* reexamination 95/000184 (2008-09-18 Petition Decision, p. 1)(Patent Owner requested reopening prosecution or continued reexamination in the same petition. The Patent Office denied the petition to reopen prosecution, and did not address the petition for continued reexamination).

⁷⁵⁰ See MPEP § 2672.V. (“It should be noted that where the patent owner chooses not to file a submission pursuant to 37 CFR 1.951(a), no rights of appeal are lost.”); see also MPEP § 2673.02.I. (“Because there is no requirement for the patent owner to respond, there is no situation in which a Notice of Intent to Issue Inter Partes Reexamination Certificate (NIRC) can be issued after an Action Closing Prosecution and prior to the RAN.”).

⁷⁵¹ See 37 C.F.R. § 1.953(a)(“...upon expiration of the time for submitting such comments, the examiner shall issue a Right of Appeal Notice....”).

this guidance and issued a Notice of Intent To Issue A Reexamination Certificate after the Patent Owner failed to respond to the Action Closing Prosecution,⁷⁵² the MPEP and the rules are clear on the issue. Patent Owners should thus feel comfortable that a response to the Action Closing Prosecution need not be filed, and that an errant Notice of Intent To Issue A Reexamination Certificate can be vacated with a petition under 37 C.F.R. § 1.181.

Whether it is advisable to file a response is another matter. Most Patent Owners will choose to file a response to the Action Closing Prosecution if there are important issues decided in favor of the Third Party Requester. Where the key claims stand allowed, however, the Patent Owner can consider foregoing a response to prevent the Third Party Requester from further commenting on the proceedings.⁷⁵³

Where the Third Party Requester, contrary to the rules, raised a new issue in the comments preceding the Action Closing Prosecution, the Patent Owner should consider a response, even if all claims stand allowed. The Patent Office faulted a Patent Owner in such a situation during *inter partes* reexamination 95/000025, stating:

The patent owner, however, fails to provide any reason why the unredacted versions of the August 19, 2004 exhibits A and B, and the supplemental Trigiani declaration and accompanying exhibits, are necessary and were not earlier presented. As the third party requester correctly points out, the issue regarding the redacted dates of the August 19, 2004 exhibits A and B was originally raised by the third party requester in his comments filed on September 13, 2004, in response to patent owner's August 19, 2004 response. While the September 15, 2005 action closing prosecution stated that all claims were patentable, the patent owner was aware that the third party requester had a right to appeal in an *inter partes* reexamination proceeding, as is the case here, and should have filed a submission after the action closing prosecution to address the newly raised issue in the requester's comments. The patent owner fails to provide any reason why the unredacted versions of the August 19, 2004 exhibits A and B, and the supplemental Trigiani declaration and accompanying exhibits, were not

⁷⁵² See *inter partes* reexamination 95/000027 (2007-09-28 Notice p. 2). The more usual practice is to issue a Right of Appeal Notice, see, e.g., *inter partes* reexamination 95/000030 (2005-09-30 Right of Appeal Notice)(the Patent Owner failed to file comments after the Action Closing Prosecution, and a RAN was mailed).

⁷⁵³ See 37 C.F.R. § 1.951(b)(allowing Third Party Requester comment after an Action Closing Prosecution only where the Patent Owner has filed a response).

presented in response to the September 15, 2005 action closing prosecution.⁷⁵⁴

One possible Patent Owner strategy⁷⁵⁵ in such a situation might be to file a petition to strike the subject matter presented in the Third Party Requester's comments. If the decision on the petition is unfavorable, the Patent Owner could submit a supplemental amendment, assuming that Action Closing Prosecution has not issued. This might allow the Patent Owner to present the rebuttal material while still preserving the ability to not respond to the Action Closing Prosecution.

2. Amendments After The Action Closing Prosecution.

Under rule 1.116(b), the Patent Owner may present an amendment that cancels claims, if the cancellation does not affect the scope of any other claim.⁷⁵⁶ The Patent Owner may also amend the claims to comply with a formal requirement set forth in an office action,⁷⁵⁷ or change the wording of claims to place them in a better state for appeal.⁷⁵⁸ Other amendments may be accepted where they require only a "cursory review" by the Examiner.⁷⁵⁹

A Patent Owner may also make more substantive amendments to the claims, provided that it presents "good and sufficient reasons why the amendment is necessary and was not earlier presented."⁷⁶⁰ The requirement appears to go beyond showing that the amendment would result in patentable claims.⁷⁶¹ The Patent Office objects to such a practice on the basis

⁷⁵⁴ *Inter partes* reexamination 95/000025 (2007-10-31 Petition Decision, p. 8).

⁷⁵⁵ The author does not have an opinion as to whether the practitioner in this particular instance pursued the best course of action. It is difficult to judge without understanding the full context, which will include broader strategic considerations and a relationship with a client.

⁷⁵⁶ See 37 C.F.R. §§ 1.116(b)(1) and (d)(2).

⁷⁵⁷ See 37 C.F.R. § 1.116(b)(1); see, e.g., *inter partes* reexamination 95/000038 (2006-04-06 Right of Appeal Notice p. 2)(amendment after Action Closing Prosecution that canceled claims and amended new claim to adopt Examiner suggestion allowed.)

⁷⁵⁸ See 37 C.F.R. § 1.116(b)(2).

⁷⁵⁹ See MPEP § 2673.III.

⁷⁶⁰ 37 C.F.R. § 1.116(b)(3).

⁷⁶¹ See, e.g., *inter partes* reexamination 95/000024 (2005-10-18 Right of Appeal Notice, p. 2)(relatively simple amendments offered to overcome an indefiniteness rejection and a prior art rejection were not entered, because the Patent Owner had not presented good and sufficient reasons. The Patent Owner had only explained why the amendment rendered the claims patentable); see also *inter partes* reexamination 95/000026 (2005-09-15 Right of Appeal Notice, p. 2).

that it would, if the Patent Owner may be taken at its word, require the Examiner to withdraw a rejection and state reasons for patentability, which is more than a “cursory review”.⁷⁶² Instead, the Patent Owner should focus on providing reasons why the Patent Owner did not recognize the advisability of the amendment prior to the Action Closing Prosecution.

C. Petitions For A Non-Final Action

The Patent Owner may freely (subject to 35 U.S.C. § 314) amend claims as long as the previous office action was not final. There are essentially two ways to seek a non-final office action. The first is a petition for continued reexamination. The second way can be given several different names, including a petition to reopen prosecution, a petition to withdraw the action closing prosecution, or a petition to withdraw the finality of the action closing prosecution. For simplicity’s sake, the discussion below refers to all such petitions as petitions “to reopen prosecution”.

There is an important difference between a petition for continued reexamination and a petition to reopen prosecution.⁷⁶³ A petition for continued reexamination essentially states that, although the ACP may have been proper, the Patent Owner should be allowed to enter a new amendment or evidence. It requires the presentation of a *bona fide* attempt to advance prosecution.⁷⁶⁴ A petition to reopen prosecution, on the other hand, is often treated as a request to review the propriety of the Patent Office’s decision to issue a final office action. It essentially states that, in the situation presented, the Patent Office should not have made the second action final. To demonstrate this, the Patent Office will sometimes require a showing that the Patent Office’s standards for deciding whether an action should be final were not met. This is a more difficult standard to meet in practice, and the results are predictably worse.⁷⁶⁵

1. Petitions For Continued Reexamination

⁷⁶² See MPEP 2673.III. (“Where the entry of the proposed amendment (after the Action Closing Prosecution) would result in any ground of rejection being withdrawn or any additional claim indicated as patentable, the proposed amendment generally raises new issues requiring more than cursory review by the examiner.”).

⁷⁶³ See, e.g., *inter partes* reexamination 95/000184 (2008-09-18 Petition Decision, p. 5)(“Furthermore, it is noted that many of the patent owner's arguments pertain to the alleged unfairness resulted in the closing of prosecution. These arguments are more appropriate in a petition under 37 CFR 1.182 requesting continuing reexamination as mentioned below. For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to issue an ACP. Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the patent owner's petition, as it relates to reopening prosecution of the instant reexamination proceeding, is denied.”).

⁷⁶⁴ See section IX.C.1, *infra*.

⁷⁶⁵ See section IX.C.2, *infra*.

The *inter partes* reexamination rules make no explicit provision for a “request for continued reexamination”. That is, the Patent Owner can not as a matter of right purchase a non-final office action.⁷⁶⁶ In 2005, however, the Patent Office indicated issued guidelines establishing a “transitional procedure” acknowledging the ability of Patent Owners to petition for continued reexamination (“2005 Transition Procedure”). This is a petition under 37 C.F.R. § 1.182.⁷⁶⁷ The Patent Office has expressly made “continued reexamination” available under “appropriate circumstances”.⁷⁶⁸

In *inter partes* reexamination 95/000071, the Patent Office responded to a petition to enter a post-Action Closing Prosecution amendment by suggesting that the Patent Owner file a petition requesting continued reexamination. The Patent Office advised the Patent Owner as follows:

The patent owner may wish to consider filing a petition under 37 C.F.R. 1.182 (with an appropriate submission) to request for continued reexamination. This will be referred to herein as "a § 1.182 petition." As is the case with a Request for Continued Examination (RCE) in an application, such a § 1.182 petition and accompanying submission must be filed to further the prosecution of the reexamination proceeding, rather than to delay it. The patent owner must make a bona fide effort to define the issues for appeal, or for the issuance of a reexamination certificate, when filing a request for continued reexamination, since this is a key factor in reducing pendency of a reexamination proceeding. Entry of an amendment solely limited to presenting claims defining over the art applied in the Action Closing Prosecution could be obtained via such a § 1.182 petition, as such an amendment can define the issues for appeal, or for the issuance of a reexamination certificate. Entry of an amendment re-prosecuting the proceeding, or "rounding out" patent owner's scope of claim protection will not be granted. In further explanation, note as follows: The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. Where an amendment and/or evidence to define patentability of the existing claims is denied entry after an action closing prosecution in an *inter partes* reexamination proceeding, a patent owner can obtain entry of that

⁷⁶⁶ See, e.g., MPEP § 2673.02.II. See section IX.C.2, *infra*, for more detail.

⁷⁶⁷ See *Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending*, 1292 Official Gazette 20, March 1, 2005.

⁷⁶⁸ See *inter partes* reexamination 95/000007 (2008-08-15 Petition Decision, p. 3).

amendment and/or evidence under 37 C.F.R. 1.182 in appropriate circumstances. The reason for such is that the patent owners treatment of the existing claims would further "special dispatch" by resolving issues. Where, however, the patent owner provides a new set of claims, that requires an entirely new evaluation of the new set of claims, and it would be contrary to the public interest in providing a speedy resolution of the question of patentability raised by a request for reexamination to newly address the new set of claims. Thus, patent owner may wish to consider filing an appropriate 37 C.F.R. 1.182 petition, with an appropriate submission. For example, an amendment presenting claims defining over the art applied in the Action Closing Prosecution dated June 7, 2006 while deleting the broader claims rejected in the Action Closing Prosecution would be an appropriate submission. If such a petition is filed and granted, the prosecution would then be reopened for entry into the record of the response, the proceeding would be forwarded to the examiner for consideration of the response, and the examiner would issue an Office action treating the request. If patent owner chooses to employ this option, all amendments needed to deal with the prior art should be carefully considered, since, after the granting of the first such 1.182 petition, no further continuation of the reexamination proceeding would be granted under 37 C.F.R. 1.182, absent a showing of extraordinary circumstances."⁷⁶⁹

In order to justify a request for continued reexamination, the Patent Owner must present a paper with the petition that makes a *bona fide* effort to advance the proceedings to conclusion.⁷⁷⁰ It is not entirely clear why this standard should be meaningful, because the fastest way to a conclusion of the proceedings is usually a maintenance of rejections. Nevertheless, where a Patent Owner has provided amendments that remove a number of issues or are a clear attempt to distinguish over prior art, the Patent Office has granted requests for continued reexamination.

For example, such a petition was granted in *inter partes* reexamination 95/000007, where the Patent Owner amended one independent claim to include a limitation of another. The amendment would have reduced the number of obviousness rejections for appeal based on the findings of the Examiner. The Patent Office granted the petition, directing the Examiner to enter the amendment and treat it as a response to a non-final action.⁷⁷¹

⁷⁶⁹ *Inter partes* reexamination 95/000071 (2007-06-05 Petition Decision, p. 5-6).

⁷⁷⁰ *See inter partes* reexamination 95/000007 (2008-08-15 Petition Decision, p. 3).

⁷⁷¹ *See inter partes* reexamination 95/000007 (2008-08-15 Petition Decision, p. 4).

In *inter partes* reexamination 95/000043, the Patent Owner petitioned under 37 C.F.R. § 1.182 for continued reexamination after a Right of Appeal Notice had already been mailed. The Patent Owner petitioned for entry of an amendment which canceled one claim and amended two others. The amendment had been offered after the Action Closing Prosecution, but was not entered by the Examiner, because it would have required more than a cursory review. The Patent Office granted the petition, finding that the Patent Owner had demonstrated that it was making a *bona fide* attempt to define the issues for appeal or for the issuance of a reexamination certificate.⁷⁷²

In *inter partes* reexamination 95/000134, the Third Party Requester had submitted four new references with its comments after the first office action. The Patent Office rejected the claims over the new references, and the Patent Owner submitted extensive amendments and a petition to “reopen prosecution”. The Patent Office denied the petition, stating that the Examiner had properly closed prosecution on the second action, despite the new references. The Patent Office suggested, however, that the Patent Owner’s request might be proper in the context of a request for continued reexamination.⁷⁷³ The Patent Owner then filed such a petition, and the Patent Office granted it, stating:

In this instance, the patent owner submitted a response to the first office action that overcame all known grounds for rejection. As new references were cited after patent owner's response and new grounds of rejection were entered, patent owner's May 21, 2007 response could not have been presented earlier, and it represents a good faith effort to advance prosecution. Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's presentation of an amendment paper addressing the new references and grounds of rejection is deemed provide the requisite *bona fide* effort to advance the prosecution. As such, the granting of the present petition is consistent with the requirement of 35 U.S.C. 305 to conduct reexamination proceedings ‘with special dispatch within the Office.’⁷⁷⁴

In *inter partes* reexamination 95/000149, the Patent Office had rejected several amended claims under 35 U.S.C. § 112 for omitting an essential feature from the specification. The Patent Owner responded by cancelling some claims and amending the claims to include the feature. The Patent Office granted the Patent Owner’s request for continued reexamination, stating:

⁷⁷² See *inter partes* reexamination 95/000043 (2006-09-13 Petition Decision, p. 4).

⁷⁷³ See *inter partes* reexamination 95/000134 (2007-11-27 Petition Decision, pp. 4-6).

⁷⁷⁴ *Inter partes* reexamination 95/000134 (2008-02-11 Petition Decision, p. 3).

The post ACP amendment submitted by patent owner for entry cancels claims 3, 4, 15, and 16, adds claim 27, and attempts to reduce issues for appeal by further amending claims 1 and 13 to recite the ‘deposition temperature sufficiently low to avoid gas-phase nucleation of Ge’ in the deposition of the first layer.’ This further amending of claims 1 and 13 was submitted presumably for the purpose of obviating the rejection based upon the omission of a critical feature. The August 29, 2008 RAN denied entry of the after ACP amendment stating *inter alia* that entry of patent owner's proposed amendment would require rejections for new matter. Patent owner's submission in support of the petition under 37 CFR 1.181 argues that the proposed amendment contains no new matter. Accordingly, based upon the facts and circumstances of the present case, the post ACP amendment presented by Petitioner/patent owner is deemed a *bona fide* attempt to advance the prosecution by reducing issues to be addressed. As such, the granting of the present petition is consistent with the requirements of 35 USC 305 to conduct reexamination proceedings ‘with special dispatch within the Office.’

The Patent Office has in some cases, however, indicated that requests might be limited based on content. In *inter partes* reexamination 95/000020, the Patent Owner sought a request for continued reexamination to file a supplemental response to an Action Closing Prosecution. The offered response also apparently contained material alleging misconduct by the Patent Office. The Patent Owner relied in part on the 2005 Transition Procedures in requesting entry of the submission. The Patent Office dismissed the petition, because it did not comply with 37 C.F.R. § 1.951, stating:

the patent owner petition requests relief which, if granted, would permit patent owner to obtain entry of material that is not confined to evidence and/or an amendment directed to issues of patentability raised in the ACP. Rather, as presented by patent owner, the supplemental comments to the ACP that were filed on May 12, 2006 are directed to complaints of misconduct and bias, as well as issues of patentability raised in the ACP. To grant the requested relief under 37 CFR 1.182 would necessarily require a waiver of 37 CFR 1.3, 37·CFR 1.951(a).⁷⁷⁵

The Patent Office has also indicated that a second petition for continued reexamination will be granted only under “extraordinary circumstances”.⁷⁷⁶ For example, a second petition for continued reexamination in *inter partes* reexamination 95/000043 was

⁷⁷⁵ *Inter partes* reexamination 95/000020 (2006-09-13 Petition Decision, p. 6).

⁷⁷⁶ *See inter partes* reexamination 95/000007 (2008-08-15 Petition Decision, p. 4).

dismissed.⁷⁷⁷ The Patent Office noted that despite the 2005 Transition Procedures, “the statutory mandate for special dispatch in reexamination proceedings is still paramount.”⁷⁷⁸ The Patent Owner had not shown the “extraordinary circumstances” required for a second continued reexamination.⁷⁷⁹

2. Petition to Reopen Prosecution

A Patent Owner may file a petition under 37 C.F.R. § 1.181(a) or 1.182 to reopen prosecution if it believes that an Action Closing Prosecution was issued prematurely.⁷⁸⁰ Such a petition will likely be based on the Patent Office’s admonition that

[t]he examiner should not prematurely cut off the prosecution with a patent owner who is seeking to define the invention in the claims that will offer the patent protection to which the patent owner is entitled. However, the examiner and all other parties to the reexamination should recognize that a reexamination proceeding may result in the final cancellation of claims from the patent and that the patent owner does not have the right to continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d) nor by filing a Request for Continued Examination under 37 CFR 1.114, and the patent owner cannot file an inter partes reexamination request (see MPEP § 2612).⁷⁸¹

⁷⁷⁷ See *inter partes* reexamination 95/000043 (2008-07-21 Petition Decision, p. 1).

⁷⁷⁸ *Inter partes* reexamination 95/000043 (2008-07-21 Petition Decision, p. 3).

⁷⁷⁹ See *inter partes* reexamination 95/000043 (2008-07-21 Petition Decision, p. 3).

⁷⁸⁰ See MPEP § 2672.VI; *but see inter partes* reexamination 95/000133 (2008-10-08 Petition Decision, p. 3)(Patent Owner filed a petition to reopen prosecution after the Right of Appeal Notice. The Patent Office stated “[a]s noted in section 2673.02 of the *Manual of Patent Examining Procedure* (MPEP), ‘[a]n amendment filed after the RAN will not be entered at all, in the absence of a grantable petition under 37 CFR 1.183, because 37 CFR 1.953(c) prohibits an amendment after the RAN in an inter partes reexamination.’ The provisions of 37 CFR 1.953(c) may be waived under 37 CFR 1.183 where a petitioner demonstrates an extraordinary situation in which justice requires suspension of the rule....Patent owner's arguments, as set forth in the affidavit, do not demonstrate an extraordinary situation in which justice requires suspension of the rule prohibiting the filing of an amendment after RAN in an inter partes reexamination. The entry of an amendment after . RAN for the purpose of presenting amended claims so as to exclude late-discovered allegedly infringing products is not for a purpose related to reexamination and is not for purposes of advancing the prosecution toward appeal....”).

⁷⁸¹ MPEP § 2671.02 (emphasis in original).

A petition to reopen prosecution or remove the finality of the Action Closing Prosecution is fundamentally different from a petition for continued reexamination. In a petition to reopen prosecution, the Patent Owner is essentially saying that the Patent Office was wrong in making the second office action final.

Along these lines, the Patent Office prescribes that prosecution be reopened wherever there is a change in position detrimental to the Patent Owner, to which the Patent Owner has not had opportunity to respond before appeal.⁷⁸² The Patent Office also recommends that the Examiner reopen prosecution where minor amendments after the Action Closing Prosecution could place the claims in position for confirmation.⁷⁸³ When prosecution is reopened, it should be reopened with a non-final action, so that the Patent Owner has full rights to amend its claims.⁷⁸⁴

In contrast to the ability of the Patent Owner to request that prosecution be reopened, there is relatively little basis for the Third Party Requester to do so. This stems from the Patent Office's view that "[t]he third party requester has no right to comment on and address a finding of patentability made during the reexamination proceeding *until the appeal stage....*"⁷⁸⁵ Conceivably, the Third Party Requester might be successful in petitioning to reopen prosecution if it can point to a very obvious mistake that will require reopening of prosecution later.

The Patent Office has had the opportunity to consider several petitions to reopen prosecution in the first three hundred *inter partes* reexaminations. In *inter partes* reexamination 95/000020, the Patent Office denied a petition to withdraw an Action Closing Prosecution. The Patent Owner claimed that the ACP improperly incorporated new grounds of rejection, because it introduced new evidence received by email from a Librarian in Norway, made an assertion regarding search techniques at a relevant point in time, and changed two rejections from express to inherent anticipation. The Patent Office dismissed the petition stating that the introduction of evidence and the factual assertion did not bear on the substance of the rejections, and that a change from express anticipation to anticipation by inherency was not a new ground of rejection.⁷⁸⁶

In *inter partes* reexamination 95/000071, the Patent Owner petitioned to reopen prosecution because the Examiner did not consider supplemental amendments. The Patent Office denied the request, stating that the Patent Owner had not met the requirements of

⁷⁸² See MPEP § 2673.01.I; 37 C.F.R. § 1.949 ("An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment.").

⁷⁸³ See MPEP § 2673.01.II.

⁷⁸⁴ See MPEP § 2673.01.II.

⁷⁸⁵ MPEP § 2673.01.I. (emphasis in original).

⁷⁸⁶ See *inter partes* reexamination 95/000020 (2006-02-23 Petition Decision, pp. 4-5).

37 C.F.R. § 1.111(a)(2)(i) for supplemental amendments, and had therefore not presented “good and sufficient” reasons for reopening prosecution.⁷⁸⁷

In *inter partes* reexamination 95/000096, the Patent Owner petitioned to reopen prosecution to allow merger with a copending reissue application, and because the Examiner had not established a *prima facie* case with respect to a particular double-patenting rejection. The Patent Office denied the petition, stating with that the reissue application had been suspended. With regard to the faulty rejection, the Patent Office stated:

The second argument has been carefully considered and the examiner has carefully reviewed the previously made non-statutory obviousness double patenting rejection. In view of this reevaluation, the examiner will withdraw the rejection of Ground 14 in issuing a Right to Appeal Notice. Therefore, this argument that prosecution should be reopened is effectively moot. In accordance with Office policy and procedures, prosecution need not be reopened if a new finding of patentability is made (i.e., a ground of rejection is withdrawn or an additional claim is indicated as patentable). The third party requester has no right to comment on and address a finding of patentability made during the reexamination proceeding *until the appeal stage*, unless the patent owner responds (after which the third party requester may file comments). Thus, the third party requester may address any new finding of patentability at the appeal stage in the same manner that it would address a finding of patentability made during the reexamination proceeding where the patent owner does not respond (e.g., all claims are allowed on the first Office action and the patent owner sees no reason to respond). See MPEP 2673.01.⁷⁸⁸

In *inter partes* reexamination 95/000111, the Patent Owner added two claims after the first office action. In an Action Closing Prosecution, the Examiner rejected the new claims over newly cited prior art. The Patent Owner petitioned to reopen prosecution, stating that the Patent Office had not given the Patent Owner the chance to amend claims 8 and 9, which were added as soon as allowable by the Patent Owner. The Patent Office dismissed the petition, reasoning (1) that the amendment after Action Closing Prosecution was defective for failure to comply with 37 C.F.R. § 1.941, and that the Patent Owner had also included specification and drawing amendments that would require the Examiner to unduly search through the specification to ascertain whether new matter had been entered. The Patent Office further reasoned that most

⁷⁸⁷ See *inter partes* reexamination 95/000071 (2007-04-27 Petition Decision, p. 5).

⁷⁸⁸ *Inter partes* reexamination 95/000096 (2007-09-21 Petition Decision, p. 4).

of the art had already been cited, and that the new reference was used only to show one element of one claim.⁷⁸⁹

In *inter partes* reexamination 95/000153, the Patent Owner filed a petition under 37 C.F.R. § 1.181 to withdraw an allegedly premature Action Closing Prosecution, arguing that three new positions were presented. The Patent Office dismissed the petition but allowed further amendments and evidence, stating:

The Action Closing Prosecution mailed September 5, 2007 is fully compliant with Office requirements. A discussion of stability was made in the first Office action (see page at least page 10, last paragraph). The issue regarding component 'C' is fully developed and the statements made in the ACP are directly in response to Patent Owner's amendments and arguments. There are no new positions offered and all comments and remarks are directed to the amendments, declarations, and remarks made by Patent Owner and remarks made by Third Party Requester. The amendments and declarations presented with this petition on December 5, 2007 are entered and will be considered as will Third Party comments filed January 9, 2008. Patent Owner should expect a Right of Appeal Notice (RAN) in due course.⁷⁹⁰

Based on these decisions, prospects for any such a petition can not be considered particularly good, especially given the requirement of special dispatch.⁷⁹¹ The Patent Owner might as a fallback file a substantive response to the Action Closing Prosecution assuming the petition will not be granted. The Patent Owner may also divide its response into remarks that can be entered as a matter of right, and other matter that requires permission of the Patent Office to enter.

3. Reopening Prosecution After A Right Of Appeal Notice

A petition to reopen prosecution after a Right of Appeal Notice requires a petition under 37 C.F.R. § 1.182, and a petition under 37 C.F.R. § 1.183 to waive 37 C.F.R. § 1.953(c).⁷⁹²

⁷⁸⁹ See *inter partes* reexamination 95/000111 (2007-06-12 Petition Decision, pp. 3-4).

⁷⁹⁰ *Inter partes* reexamination 95/000153 (2008-06-20 Petition Decision, p. 3).

⁷⁹¹ See 35 U.S.C. § 314(c). An exception might be where the Examiner makes one of the simple mistakes more often committed by *ex parte* prosecution Examiners in making office actions final. The author believes this is unlikely, however, given the quality of examination and panel review at the reexamination level.

⁷⁹² See MPEP § 2673.02; *inter partes* reexamination 95/000133 (2008-10-08 Petition Decision, p. 3)(noting that the Patent Office will only charge one fee, because the fees are the same).

The Patent Office has previously granted petitions for continued reexamination after a Right of Appeal Notice.⁷⁹³

D. Petition From Refusal To Enter Amendments

If a Patent Owner amendment is not entered, the Patent Owner may petition under 37 C.F.R. § 1.181 for entry of the amendment.⁷⁹⁴ The Patent Owner will not, of course, know that its amendment was not entered until it receives the Right of Appeal Notice. From that point, the Patent Owner will have one month from the mailing date of the Notice to file the petition,⁷⁹⁵ although it can be filed earlier.⁷⁹⁶ The filing of a petition does not alter the deadline for filing a Notice of Appeal⁷⁹⁷—the two will usually be filed at about the same time. The MPEP provides the Third Party Requester with the ability to file an opposition to any such petition.⁷⁹⁸

The Patent Office had noted several times that it is proper to close prosecution in the second action where new grounds of rejection were necessitated by a previous amendment. That the Patent Owner may not be able to predict which new grounds of rejection will be made is of little moment.

A petition from non-entry of an amendment under 37 C.F.R. § 1.181 is different from a petition for continued reexamination under 37 C.F.R. § 1.182.⁷⁹⁹ In a petition from non-entry, the Patent Owner is saying that amendments were properly proposed under 37 C.F.R. § 1.116 and should have been entered. In any petition from non-entry, the Patent Owner must show that it made arguments in the Response to the ACP as to why the amendments meet the standards of rule 1.116.⁸⁰⁰

E. Third Party Requester Comments.

If the Patent Owner provides comments on the Action Closing Prosecution, the Third Party Requester may once file comments to respond to the Patent Owner comments.⁸⁰¹

⁷⁹³ See *inter partes* reexamination 95/000043, (2006-09-13 Petition Decision, p. 4).

⁷⁹⁴ See MPEP § 2673.02.

⁷⁹⁵ See MPEP § 2673.02.

⁷⁹⁶ See, e.g., *inter partes* reexamination 95/000149 (2008-10-08 Petition Decision, p. 1).

⁷⁹⁷ See MPEP § 2673.02.

⁷⁹⁸ See MPEP § 2673.02.

⁷⁹⁹ See section IX.A.2, *supra*.

⁸⁰⁰ See, e.g., *inter partes* reexamination 95/000149 (2008-10-08 Petition Decision, p. 3).

⁸⁰¹ See 37 C.F.R. § 1.951(b).

Strictly speaking, the Third Party Requester may not address issues that were not addressed in the Patent Owner response, even if these were addressed in the Action Closing Prosecution.⁸⁰² Patent Office enforcement of this rule has been somewhat unpredictable, however.⁸⁰³

F. Right of Appeal Notice

After the time to comment on an Action Closing Prosecution has expired, the Examiner must consider whether to issue a Right of Appeal Notice or to reopen prosecution.⁸⁰⁴ The Right of Appeal Notice sets forth the final Examiner position on the claims. After the Notice has been mailed, the parties are prohibited from submitting any further amendments or evidence, except as allowed by the Board of Appeals.⁸⁰⁵ The Patent Owner may, however, present an amendment cancelling claims, where the cancellation does not affect the scope of other claims.⁸⁰⁶

X. Petitioning

A. General

Petitions are a central part of any hotly contested *inter partes* reexamination proceeding. The filing of petitions is akin to motion practice before a district court, in that petitions are used to communicate with the Patent Office and to request specific sorts of actions.

1. Rules 1.181, 1.182 and 1.183

Petitions are usually filed under one of 37 C.F.R. §§1.181, 1.182 or 1.183. These rules have different requirements,⁸⁰⁷ which are often overlooked by the parties.

Rule 1.181 applies where the petitioner believes that the Examiner has done something improper in an office action that is not otherwise subject to appeal. Rule 1.181 is also invoked where another rule states that a matter is to be determined by the Director, or where the supervisory authority of the Director is to be invoked.

⁸⁰² See MPEP § 2672.IV.

⁸⁰³ See, e.g., *inter partes* reexamination 95/000078 (2007-11-30 Third Party Requester Comments)(responding to issues raised in the first non-final action but not in the Action Closing Prosecution and not in the Patent Owner comments).

⁸⁰⁴ See 37 C.F.R. § 1.953(a); MPEP § 2673.02.

⁸⁰⁵ See 37 C.F.R. § 1.953(c).

⁸⁰⁶ See 37 C.F.R. § 1.116(d)(1).

⁸⁰⁷ Note that, for all petitions filed under rules 182 or 183 in *inter partes* reexamination, there is no reduction in fee based on small-entity status. See MPEP § 2634.

Rule 1.182 is used where the rules do not specifically provide for the situation.⁸⁰⁸ The Patent Office sometimes interprets this to mean situations where there is no rule that would dictate the outcome,⁸⁰⁹ and sometimes to mean situations where no right of petition is explicitly provided.⁸¹⁰ Rule 1.183 provides for a petition to request a waiver of a rule. Petitions may also be filed under any rule that specifically provides for a petition in reexamination.

In identifying the proper rule, it should first be considered whether any specific rule authorizes the petition being filed. There are three petitions specifically authorized by the *inter partes* reexamination rules: (1) a petition under rule 1.927, to review a refusal to order *inter partes* reexamination; (2) a petition under rule 1.956 for a Patent Owner extension of time; and (3) a petition under rule 1.958 to revive a proceeding where the Patent Owner unintentionally or unavoidably failed to respond. There are, however, a number of other petitions provided for in the remaining (non *inter partes* reexamination) rules that explicitly apply or could apply in an *inter partes* reexamination.

If there is no rule specifically providing for a right to petition, then a petition under 37 C.F.R. § 1.181 may be appropriate. If a rule says that a matter may be reviewed by the Director, but does not provide for a petition, then a petition under paragraph (a)(2) is the correct vehicle. If no such language is present, then it must be considered whether the petition is to request review of an Examiner action that is not the subject of appeal (for example, the decision to issue a first Action Closing Prosecution). If this is the case, the petition should be filed under 37 C.F.R. § 1.181(a)(1). Any petition under rule § 1.181 and must be filed within two months of the mailing date of the action which occasioned the petition,⁸¹¹ unless a shorter time is specified by another rule.⁸¹²

⁸⁰⁸ See 37 C.F.R. § 1.182.

⁸⁰⁹ See, e.g., *inter partes* reexamination 95/000020 (2007-11-07 Petition Decision, p. 4) (“37 CFR 1.182 is inapplicable because the regulations specifically address (*i.e.*, provide for) the present situation by precluding entry of the requested material as a matter of procedure.”)

⁸¹⁰ See, e.g., *inter partes* reexamination 95/000186 (2008-06-24 Petition Decision, p. 1) (“Since the rules do not provide for a petition for termination of a reexamination proceeding, the paper is being treated as a petition under 37 CFR 1.182....”); *inter partes* reexamination 95/000228 (2007-07-05 Petition Decision p. 4) (“Thus, 37 CFR 1.987 provides authority for suspension of an *inter partes* reexamination proceeding where the patent being reexamined ‘is or becomes involved in litigation.’ However, 37 CFR 1.987, does not authorize the filing of a petition to suspend an *inter partes* reexamination proceeding. No regulation authorizes the filing of a petition to suspend an *inter partes* reexamination proceeding. Therefore, the patent owner's renewed petition will be considered pursuant to 37 CFR 1.182”).

⁸¹¹ See 37 C.F.R. § 1.181(f).

⁸¹² See, e.g., 37 C.F.R. § 1.927.

For any petition under rule 1.181, there must be some action by the Examiner against which to petition. Preemptively filing a petition against what one thinks the Examiner will do, or to present extra reasoning as to why the Examiner should not do something, has in the past resulted in a dismissal.⁸¹³ Furthermore, the petition may be treated as a supplemental response which fails to satisfy 37 C.F.R.1.947(b).⁸¹⁴

If the petition is not the direct result of an Examiner action, chances are it should be filed under 37 C.F.R. § 1.182. Although rule 1.182 does not provide a specific time limit for filing, it is subject to the restriction of 37 C.F.R. § 1.181(f).⁸¹⁵ Because there is sometimes no explicit action of the Examiner from which the party petitions, calculation of the due date for a petition under 37 C.F.R. § 1.182 can be difficult.

Any petition filed may require a separate petition under 37 C.F.R. § 1.183 to waive the rules, if the petition, or the action sought by the petition, would otherwise be forbidden by rule. Petitions filed before the first office action are an example.⁸¹⁶ Petitions under 37 C.F.R. §1.183 must set forth the applicable regulation to be waived, or they are not petitions under 37 C.F.R. § 1.183.⁸¹⁷

The Patent Office considers relief under 37 C.F.R. § 1.183 under an “extraordinary situation” standard:

Waiver is not intended to be routine, and the situation presented must rise to the level of an “extraordinary situation” that would justify waiver under 37 CFR 1.183. See e.g., *Issidorides v. Ley*, 4 USPQ 2d 1861 (Comm. of Patents 1987) (“It is not the policy of the Patent and Trademark Office, however, to routinely waive rules”), citing, *Myers v. Feigelman*, 455 F.2d 596, 172 USPQ 580, 584 (CCPA 1972) (“the rules are designed to provide an orderly procedure and the parties are entitled to rely on their being followed in the absence of such circumstances as might justify waiving them under Rule 183”). In order to grant of any petition under 37 CFR 1.183, petitioner must show (1) that an extraordinary situation is presented where (2) justice requires

⁸¹³ See, e.g., *inter partes* reexamination 95/000127 (2007-07-27 Petition Decision, pp. 2-3).

⁸¹⁴ See *id.*

⁸¹⁵ See MPEP § 1002 (“The 2-month time period in 37 CFR 1.181(f) applies to a petition under any section (e.g., 37 CFR 1.182 and 37 CFR 1.183) that does not specify the time period within which a petition must be filed.”)

⁸¹⁶ See 37 C.F.R. § 1.939(b); MPEP § 2625.

⁸¹⁷ See *inter partes* reexamination 95/000089 (2005-11-28 Petition Decision, p. 1).

waiver of the rule for which waiver is requested. *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985).⁸¹⁸

In this case “extraordinary” probably means “not ordinary”, rather than “astonishing”:

it is sufficient that petitioner patent owner desires certain relief, has correctly alleged that the requested relief is procedurally barred by the regulations, and that there are circumstances that would, in the opinion of a reasonable patent owner, injure patent owner unless the regulations are waived to permit consideration of the request for relief such that the relief may be granted.⁸¹⁹

The Patent Office has not granted relief requested under 37 C.F.R. § 1.183 if it appeared possible for the petitioner to request relief without suspending the rules,⁸²⁰ if the petitioner had the power to avoid application of the rule,⁸²¹ or if the waiver of the rule would result in the violation of another rule, or another requirement of the same rule.⁸²² The latter

⁸¹⁸ *Inter partes* reexamination 95/000087 (2008-03-13 Petition Decision, p. 11).

⁸¹⁹ *Inter partes* reexamination 95/000246 (2007-06-28 Petition Decision, p. 9).

⁸²⁰ *See inter partes* reexamination 95/000074 (2007-10-18 Petition Decision, p. 14)(the Patent Owner petitioned to waive the rules and allow a declaration under 37 C.F.R. § 1.131 signed by only one inventor. The Patent Owner stated that the second inventor now claimed not to have invented the subject matter of the claims, and that the Patent Owner was in bankruptcy, and hence that no officer was available to sign a substitute declaration. The Patent Office dismissed the petition, stating that the trustee in bankruptcy was the proper signatory by later assignment, and “[t]he extraordinary relief of waiving a rule will not normally be considered if the rules provide an alternative avenue for obtaining the relief sought. *See Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). Because the patent owner has not provided evidence of any inability to submit a declaration under 37 C.F.R. 1.131 signed by an assignee of the entire interest in the patent under reexamination, the present situation is not deemed to be extraordinary. For this reason, the October 12, 2006 patent owner petition under 37 C.F.R. 1.183 to waive the requirements of 37 C.F.R. 1.131 is dismissed.”).

⁸²¹ *See inter partes* reexamination 95/000020 (2006-09-13 Petition Decision, p. 5) (“Thus, compliance with the 37 CFR 1.3 does not present an extraordinary situation that requires waiver of the regulation, but rather, this is a mechanism wholly within control of patent owner which can be employed by the patent owner in compliance with the rules. Therefore, 37 CFR 1.3 will not be waived.”)

⁸²² *See inter partes* reexamination 95/000020 (2006-09-13 Petition Decision, p. 5)(“As a further consideration, 37 CFR 1.951(a) provides, inter alia, that ‘[A]fter an Office action closing prosecution in an inter partes reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution.’ The relief requested by patent owner

policy would appear to require that the petitioner specifically name and request waiver of all individual requirements that would otherwise be violated by the action it seeks to take.

2. Who May File A Petition

It is not clear from the text of the rules who is entitled to file a petition in an *inter partes* reexamination proceeding. The general petition rules, 37 C.F.R. §§ 1.181, 1.182 and 1.183, are written without specifying that the petitioner must be a party to the proceedings. Other petitioning rules (*e.g.*, 37 C.F.R. § 1.927) specify who may file a petition.

In *inter partes* reexamination 95/000165, the Patent Office considered a petition to suspend a co-pending reissue proceeding that was filed in both the *inter partes* reexamination and the reissue proceeding. The Patent Office concluded:

The following is to be noted, with respect to the filing of a paper directed to the '843 reissue application by the third party requester of the '165 inter partes reexamination proceeding. In an application for which a party is not acting under 37 CFR 1.34 in a representative capacity for the applicant or assignee, the only submissions that are permitted for that party are protests under 37 CFR 1.291, petitions for public use proceedings under 37 CFR 1.292, and third-party submissions of prior art under 37 CFR 1.99. A request for suspension of the '843 reissue application is not a protest, a petition for public use proceedings, or a third-party submission of prior art. Thus, third party requester lacks authority to request suspension in of the '843 reissue application, either by filing a paper directly in the '843 reissue application, or by filing a paper in the '165 inter partes reexamination proceeding. There is nothing in the patent statute that gives rise to a right for a non-applicant to object in a patent application of another to the manner in which a patent application of another is prosecuted, nor to the manner in which a patent application of another is treated by the Office. *See Animal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 USPQ2d 1677, 1685 (Fed. Cir. 1991); *Hallmark Cards, Inc. v. Lehman*, 959 F. Supp. 539, 42 USPQ2d 1134 (D.D.C. 1997). Third party requester's representative is placed on notice that the Office considers the filing of a petition or other papers on behalf of a party having no standing in an application, and not otherwise authorized by the rules of practice, to be a paper presented for an improper purpose (37 CFR . 10.18). Therefore, the Office may refer any further such unauthorized papers in this application, or

would require waiver of 37 CFR 1.951(a) in order to permit more than a single submission of comments following an ACP. However, the requested relief is precluded because the comments for which entry is sought are not limited to issues raised in the action closing prosecution.”).

any other application, to the Office of Enrollment and Discipline for appropriate action.⁸²³

Nevertheless, the Patent Office has previously considered a petition by a non-party under 37 C.F.R. § 1.183, and “granted [it] to the extent that it has been considered.”⁸²⁴

It is also important to consider whether the relief requested is relief that can be granted within the *inter partes* reexamination. If it is not, the client should be counseled that the petition stands a good chance of dismissal.⁸²⁵ These sorts of petitions occur with relative frequency where there are *ex parte* proceedings co-pending with the *inter partes* reexamination. Because the Third Party Requester has no right to participate in the *ex parte* proceedings, its only input into the overall context is through the *inter partes* reexamination. This might easily lead, for example, to a petition to suspend a co-pending proceeding in favor of the *inter partes* reexamination.⁸²⁶

B. Procedural Pitfalls

There are a number of procedural aspects to petitioning that are often overlooked by the parties in an *inter partes* reexamination.

1. Identifying The Correct Rule

First, it is important to properly identify the rule under which one is petitioning. This is very often improperly done, and can lead to dismissal of the petition if (a) the proper timing of the petition is not observed⁸²⁷ or (b) the proper fee is not paid.⁸²⁸ If there is a rule forbidding a particular petition, the Patent Office can interpret the petition as one to waive the rules under rule 1.183 if a proper deposit account authorization is present.

⁸²³ *Inter partes* reexamination 95/000165 (2007-01-09 Decision, pp. 3-4).

⁸²⁴ *Inter partes* reexamination 96/000201 (2008-02-08 Petition Decision, p. 1). The “chicken and egg” problem that a non-party may need to file a petition to obtain waiver of a rule that will allow it to file petition is observable here. In other situations, however, the Patent Office has allowed petitions by parties to the proceedings under Rule 1.183 where otherwise no papers are allowed (*e.g.* under 37 C.F.R. § 1.939).

⁸²⁵ *See, e.g., inter partes* reexamination 95/000057 (2005-04-19 Letter); *inter partes* reexamination 95/000165 (2007-01-09 Letter, p. 3).

⁸²⁶ *See* section XI.C, *infra*.

⁸²⁷ *See, e.g.,* 37 C.F.R. § 1.181(f)(providing that a petition must be filed within two months of the mailing date of the action which occasioned the petition.).

⁸²⁸ *See, e.g.,* 37 C.F.R. § 1.181(d).

2. Petition Deadlines

The timing of petitions in particular must be carefully observed. Rule 1.181(f) sets a two-month, non-extendable deadline for petitions that request relief from a particular action. This deadline applies at least to petitions filed under 37 C.F.R. §§1.181, 1.182 and 1.183, if they are necessitated by a Patent Office action.⁸²⁹ If a petition can at all be construed as necessitated by a Patent Office action, it is best to file it within two months of that action.

Note that other deadlines may impose practical limits on the filing of petitions, and the Patent Office may have specified a shorter time limit in its guidance. A petition from non-entry of amendments after a Right of Appeal Notice must, for example, be filed within one month period for filing a Notice of Appeal, even though the petition is filed under 37 C.F.R. § 1.181.⁸³⁰

The petitioner should always ensure that a proper authorization to charge a deposit account is present in the petition. While it sounds obvious to have a proper deposit account authorization, these paragraphs are all too often copied from *ex parte* prosecution and do not allow the Patent Office the flexibility to handle misidentified petitions.⁸³¹ If the petitioner mistakes the rule under which is petitioned, the Patent Office can charge the proper fee without dismissing the petition.

⁸²⁹ See *inter partes* reexamination 95/000020 (2007-03-15 Petition Decision, p. 8) (“37 CFR 1.181(f) provides, *inter alia*, that any petition under Part I of 37 CFR (‘...any petition under this part...’) which is not filed within two months of ‘the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided.’ 37 CFR 1.181(f) also provides that this two-month period ‘is not extendable.’ Thus, any petition filed pursuant to 37 CFR 1.181, 1.182 or 1.183 may be dismissed as untimely filed, if it is not filed within two months of the mailing date of the notice from which relief is requested. When the Office’s September 13, 2006 Decision on Petition was mailed on May 12, 2006, a two month non-extendable period under 37 CFR 1.181(f) was established for requesting reconsideration of the Decision on Petition.”).

⁸³⁰ See MPEP § 2673.02 (“In the event that an amendment submitted by the patent owner after the ACP has not been entered because the amendment does not comply with the requirements of 37 CFR 1.116 (see 37 CFR 1.951(a)), the patent owner may file a petition under 37 CFR 1.181 requesting entry of the amendment. The petition under 37 CFR 1.181 must be filed within the time period for filing a notice of appeal or cross appeal, if appropriate (see 37 CFR 1.953(c)).”).

⁸³¹ See, *e.g.*, *inter partes* reexamination 95/000145 (2006-10-26 Petition Decision, FN 3)(restrictively interpreting an authorization to charge a deposit account relating to extensions of time apparently lifted from an *ex parte* prosecution form).

It is the author's impression, after reviewing scores of petition decisions, that the Patent Office is not fond of dismissing petitions based on failure to pay the proper fee, and will go to considerable lengths to spare petitioners from a strict interpretation of the rules.⁸³²

Note that the deadline under 37 C.F.R. § 1.181(f) may not apply where the petition relies on information that was not available within the original deadline.⁸³³

3. Petitions Do Not Automatically Toll Other Deadlines

The filing of a petition to undo a particular action does not automatically toll deadlines triggered by the action.⁸³⁴ The petitioner is well-advised to assume the petition will be denied, and follow through with any submissions that would otherwise be due. This is true for all parties in the proceeding.⁸³⁵

4. Filing More Than One Petition In A Single Paper

Petitioners should also not combine petition matters into a single petition.⁸³⁶ Each request for relief should be filed in a separate petition (with a separate fee). The Patent Office has, however, not dismissed some petitions that have requested certain types of relief in the alternative, especially where one branch of alternative relief is requested under 37 C.F.R.

⁸³² See, e.g., *inter partes* reexamination 95/000074 (2007-10-28 Petition Decision, p. 17).

⁸³³ See *inter partes* reexamination 95/000227 (2008-09-10 Petition Decision, p. 7).

⁸³⁴ See 37 C.F.R. § 1.181(f).

⁸³⁵ See e.g., *inter partes* reexamination 95/000133 (2008-10-08 Decision, p. 4) (“It should be noted that the patent owner's June 27, 2008 petition under 37 CFR 1.183 did not stay any periods for reply running in the '133 proceeding, as ‘[t]he mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.’The patent owner's petition under 37 CFR 1.183, filed concurrently with its notice of appeal on June 27, 2008, did not relieve the third party requester of the requirement for timely filing any notice of cross appeal. Third party requester's time for filing a notice of cross appeal expired on July 11, 2008 (i.e., fourteen days from service of the patent owner's timely filed notice of appeal).”).

⁸³⁶ See 37 C.F.R. § 1.4(c); *inter partes* reexamination 95/000185 (2007-06-08 Petition Decision, p. 6) (“37 CFR 1.4(c) provides that each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects. The patent owner's request to vacate the Order granting reexamination in the '185 *inter partes* reexamination proceeding is a request for a second, distinct form of relief contained within a single petition paper. As such, it is a request for of relief that is inappropriate under 37 CFR 1.4(c), and the request must be dismissed.”).

§ 1.183.⁸³⁷ If such relief is requested, a proper deposit account authorization is a sensible precautionary move.

C. Oppositions to Petitions

One point of confusion is whether the non-petitioning party is allowed to file a paper in opposition to a petition. Some practitioners have divined from the *inter partes* nature of the proceeding that an opposition to a petition is allowed, or have simply filed oppositions and hoped for the best. Some have waited for the Patent Office to give an opportunity to respond of its own initiative.⁸³⁸

There is no rule expressly allowing oppositions. The Patent Office interprets the lack of express authority to submit oppositions as a prohibition against such submission, and requires a petition for waiver of the rules under 37 C.F.R. § 1.183 for an opposition to be filed.⁸³⁹ Such petitions have been granted regularly in the past. It is unclear, however, which rule the Patent Office is waiving.⁸⁴⁰

⁸³⁷ See, e.g., *inter partes* reexamination 95/000269 (2007-11-28 Petition Decision, p. 7); but see *inter partes* reexamination 95/000007 (2008-08-15 Petition Decision, p. 2) (“The May 19, 2008 submission of a petition under 37 CFR 1.182 Requesting Continued Reexamination or Entry of Amendment after Action Closing Prosecution is an improper submission as it runs contrary to the strictures of 37 CFR §1.4(c), which requires separate submissions for separately distinct and different matters. A petition requesting entry of an amendment after ACP is properly presented under 37 CFR 1.181, and not 37 CFR 1.182. These petitions would be addressed by different areas of the Office, and require different showings. Therefore, the May 19, 2008, submission from petitioner is an improper paper under 37 CFR §1.4(c). Patent owner may file separate petitions (1) requesting entry of an amendment after ACP under 37 CFR 1.181 and/or (2) requesting continued reexamination under 37 CFR 1.182”); *inter partes* reexamination 95/000256 (2008-03-11 Petition Decision, p. 1) (“Because petitions filed under 37 CFR 1.182 are decided by the Office of Patent Legal Administration while petitions filed under 37 CFR 1.181 are decided by the Central Reexamination Unit, the third party must submit the petition under 37 CFR 1.182 in a separate paper to avoid confusion and delay.”); *inter partes* reexamination 95/000297 (2007-12-13 Petition Decision, p. 4) (“Since the petition was offered in the alternative if the request was granted and reexamination was ordered, the Office considers patent owner's petition under the alternative, which requests suspension of the reexamination proceeding.”).

⁸³⁸ See, e.g., *inter partes* reexamination 95/000062 (2005-10-06 Petition, p. 2) (“[the Third Party Requester’s] petition was granted by the USPTO without giving [the Patent Owner’s counsel] an opportunity to respond.”).

⁸³⁹ See *inter partes* reexamination 95/000093 (2005-07-14 Notice, p. 2).

⁸⁴⁰ *C.f.* *inter partes* reexamination 95/000089 (2005-11-28 Petition Decision, p. 1)(treating a petition filed under 37 C.F.R. § 1.183 as filed under 37 C.F.R. 1.181 because the petitioner did not request the suspension of a specific rule).

Recently, the Patent Office has taken a stricter view of oppositions relating to more formal matters, including petitions to revive and petitions to continue reexamination. In 95/000003, for example, the Patent Office denied entry to a Third Party Requester petition opposing a petition to revive the reexamination. The Patent Office reasoned:

35 U.S.C. § 314 (b)(2) does not provide any right for the third party requester to file an opposition to, or otherwise comment on, the patent owner's petition for "revival" (i.e., for acceptance of unintentionally delayed brief). Revival is an issue that goes to formal requirements, rather than to the merits. While enactment of the *inter partes* reexamination statute was for the purpose of expanding a third party requester's participation in the merits of the proceeding, there is no indication whatsoever in the legislative history of the *inter partes* reexamination statute that the requester was granted any right to challenge the granting of a petition for revival in an *inter partes* reexamination proceeding. Such a right was not provided in the enactment of the *inter partes* reexamination statute (or in any of its precursor bills), and there is no evidence to indicate that enacting such a right was ever contemplated by Congress. A third party requester's opposition to a patent owner's petition for "revival" is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly it was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. Third party requester's opposition to patent owner's petition for 'revival' therefore is not enterable into the record.⁸⁴¹

The basis for this refusal is not entirely clear. It may be that the Patent Office was simply stating the obvious: that a response to a petition is not enterable without a petition to enter the response. The Patent Office's characterization of the petition as "not enterable", as well as a later discussion distinguishing those cases where oppositions have been allowed (with grantable petitions under 37 C.F.R. § 1.183), however, casts a shadow of doubt on the issue.

The Patent Office has expressly allowed petitions to oppose a Patent Owner petition to vacate a reexamination, noting that such petitions relate to a "jurisdictional issue [that] is deemed to go to the merits, since it can result in the vacating or terminating a reexamination proceeding."⁸⁴² Thus, when an *inter partes* reexamination is ordered, and the Patent Owner

⁸⁴¹ *Inter partes* reexamination 95/000003 (2008-09-03 Letter, p. 4); *see also inter partes* reexamination 95/000007 (2008-06-30 Decision, p. 3); *inter partes* reexamination 95/000134 (2008-02-26 Decision, p. 6).

⁸⁴² *Inter partes* reexamination 95/000134 (2008-02-26 Notice, FN 1); *see also* MPEP § 2646.

protests by petition, the Third Party Requester may file a response. In the opposite situation, however, the Patent Office has stated that the Patent Owner would not have a right to a response. In a decision relating to a petition under 1.927 from a denial of reexamination, the Patent Office reasoned:

Even if an opposition petition fee were included, and the 37 CFR 1.927 petition had not been withdrawn, the opposition petition would not have been appropriate for consideration, and would be expunged from the record. The only purpose of the decision on the reexamination request made in an examiner's Order, and in a decision under 37 CFR 1.927, is to decide whether reexamination should go forward at all, and the patent owner does not have a right to submit input at that stage of the proceeding. If a substantial new question of patentability is found and reexamination is ordered, then the patent owner is permitted to provide input in response to the Office's actions. It is during the examination/prosecution stage of the proceeding where any new question of patentability ultimately will be resolved that patent owner provides input.

Where the Third Party Requester still has an opportunity to provide its normal comments to a Patent Owner Response, however, it may also be able to comment on a petition on formalities. The Patent Office has at least twice allowed such comments, although they were potentially not “to the merits” and were potentially outside of the scope of the issues raised in the Patent Owner’s response.⁸⁴³

The petition under rule 1.183 is likely not required where an opposition paper is specifically provided for in the MPEP. For example, the MPEP provides for oppositions to petitions challenging the grant of an inter partes reexamination as *ultra vires*⁸⁴⁴ and to petitions to reverse the premature closure of prosecution.⁸⁴⁵

The Patent Office has shown a unwillingness to grant a petition by the Patent Owner to allow a reply to an opposition.⁸⁴⁶ In *inter partes* reexamination 95/000199, the Patent Office explained:

⁸⁴³ See, e.g., *inter partes* reexamination 95/000134 (2007-11-27 Petition Decision, p. 4)(“The third party requester, in comments submitted on June 13, 2007....states that the patent owner now seeks to avoid the consequences of its actions by filing the instant petition.”); *inter partes* reexamination 95/000184 (2008-09-18 Petition Decision, p. 3).

⁸⁴⁴ See MPEP § 2646.II.

⁸⁴⁵ See MPEP § 2672.VI.

⁸⁴⁶ See MPEP § 2646; *inter partes* reexamination 95/000093 (2005-08-23 Petition Decision, FN 5).

After an opposition to a patent owner petition is filed by a third party requester (regardless of whether such opposition has an entry right or not) any further paper in opposition, rebuttal or response to the third party opposition paper is improper and will not be considered. There is a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination. There is no indication anywhere in the reexamination statute, or its legislative history, nor in the case law, that multiple iterations of input in petitionable matters prior to decision on the base petition was ever contemplated as an exception to the statutory mandate for special dispatch in reexamination. As provided in MPEP § 2646(II) (last sentence), it is to be noted that even where there is a jurisdictional challenge to a reexamination proceeding's existence, "[t]he filing of a 37 CFR 1.181 petition to vacate an *ultra vires* reexamination order is limited to a single submission, even if an opposition thereto is filed by a third party requester."⁸⁴⁷

D. Examples Of Specific Petitions

1. Petitions To Correct Inventorship

If it is determined that inventorship is incorrect during reexamination, a petition to correct the inventorship may be filed under 37 C.F.R. § 1.324. The petition may also be filed in outside of reexamination in the form of a request for a certificate of correction. If filed outside of reexamination, the Third Party Requester has no chance to respond, but the correction will appear in a certificate of correction, not the reexam certificate.⁸⁴⁸

2. Petitions To Disqualify Counsel

At times the *inter partes* nature of the proceeding leads to ethical disputes among counsel, which can in turn result in petitions to disqualify opposing counsel under 37 C.F.R. §10.130(b). The Patent Office, having its own ethical body in the Office of Enrollment and Discipline, has typically decided these matters.⁸⁴⁹ In *inter partes* reexamination 95/000062, for example, the Patent Office disqualified a Third Party Requester's attorney because he had prosecuted applications similar to the patent under reexamination pursuant to a grant from the Patent Owner.⁸⁵⁰

⁸⁴⁷ *Inter partes* reexamination 95/000199 (2008-08-18 Decision, p. 2).

⁸⁴⁸ *See inter partes* reexamination 95/000055 (2006-10-13 Letter pp. 5-6).

⁸⁴⁹ *See inter partes* reexamination 95/000062 (2005-08-10 Petition Decision); *see also* 2005-10-31 Petition, as of November 23, 2007 unacted upon.

⁸⁵⁰ *See inter partes* reexamination 95/000062 (2005-08-10 Petition Decision).

3. Petition to Strike Matter

If inappropriate subject matter is placed before the Patent Office in a Patent Owner response or Third Party Requester comments, the aggrieved party may petition to strike the subject matter. The proper vehicle is a petition under 37 C.F.R. §§ 1.181 or 1.182.⁸⁵¹ A petition filed under 37 C.F.R. § 1.181 technically focuses on the Patent Office's (*i.e.* Examiner's) decision to enter the paper, and thus may not be preferred.

Under current Patent Office practice, a petition to strike particular rejections as *ultra-vires* is not likely to succeed. Once the Patent Office has determined that a reexamination should go forward on any ground legitimately within its jurisdiction, the Examiner may issue a rejection without supervision from the Director. This is because the Patent Office currently views the jurisdiction of the Examiner in rejecting claims as a matter for appeal, thus removing the Patent Owner's right to petition under 37 C.F.R. § 1.181.⁸⁵²

4. Petition For Relief From Improper Procedure

If an Examiner is biased or has the appearance of bias, the aggrieved party may file a petition under 37 C.F.R. § 1.181(a)(3) to have the case transferred. The petitioner must provide evidence of bias.⁸⁵³ In *inter partes* reexamination 95/000080, the petition to have the

⁸⁵¹ See, e.g., *inter partes* reexamination 95/000074 (2007-10-18 Petition Decision, p. 17)(petition to strike under 37 C.F.R. § 1.183 treated as petition under 37 C.F.R. § 1.182); *inter partes* reexamination 95/000089 (2005-11-28 Petition Decision, pp. 1 and 6)(petition to strike under 37 C.F.R. § 1.183 treated as petition under 37 C.F.R. § 1.181).

⁸⁵² See, e.g., *inter partes* reexamination 95/000089 (2005-11-28 Petition Decision, p. 6)(the Examiner rejected claims on an intervening reference after denying priority based on the failure of the earliest filing to support the claims under 35 U.S.C. § 112 ¶1. The Third Party Requester petitioned to strike the relevant rejections. The Patent Office dismissed the petition, reasoning “[w]here, as in *Patlex* and as here, the order granting reexamination has not been shown to have been an *ultra vires* action on the part of the Office, thereby depriving the Office of jurisdiction to reexamine, the propriety of a rejection alleged to be based upon subject matter not proper for consideration in reexamination is properly determined by appeal, and not by way of petition.”).

⁸⁵³ See *inter partes* reexamination 95/000080 (2007-03-30 Petition Decision, p. 8)(“It is to be noted that the burden is upon requesting party to show that the examiner of record should be removed from a reexamination proceeding on grounds of improper conduct, including a showing of bias or the appearance of bias. See *In re Ovshinsky* 24 USPQ2d 1241 (Jan. 29, 1992). Requester freely admits that Examiner Chapman did not have any improper intent in conducting the subjective interview. In addition, requester has shown no inappropriate influence on the present proceeding resulting from the interviews conducted.”).

case transferred was dismissed as moot, because the case had already been transferred as part of an overall reorganization of the reexamination process.⁸⁵⁴

Requests suggesting misconduct by the Patent Office should not be made in papers going to the merits, or containing other matters.⁸⁵⁵ The Patent Office appears to be particularly sensitive about this, and will return such petitions or mark them non-public.⁸⁵⁶

5. Petition to Terminate

A petition to terminate the proceedings seeks to end the proceedings, but does not maintain that the Patent Office never had jurisdiction to grant the request for reexamination. The Patent Office has previously indicated that a “termination” can result in the issuance of a reexam certificate,⁸⁵⁷ although it is not at all clear what the certificate would say.

A petition to terminate reexamination proceedings may be filed under 37 C.F.R. § 1.182, where there is a final, non-appealable judgment that estopps the Third Party Requester from proceeding.⁸⁵⁸ There should be no issues before the Examiner in the *inter partes* reexamination beyond those which were raised or could have been raised in the district court action.⁸⁵⁹ Examples of such issues might be new or amended claims in the *inter partes*

⁸⁵⁴ See *inter partes* reexamination 95/000080 (2007-03-30 Petition Decision, p. 8).

⁸⁵⁵ See 37 C.F.R. § 1.3 and 1.4(c); *inter partes* reexamination 95/000020 (2006-09-13 Petition Decision, p. 5).

⁸⁵⁶ See, e.g., *inter partes* reexamination 95/000020 (2006-09-13 Petition Decision, p. 7).

⁸⁵⁷ See *inter partes* reexamination 95/000020 (2006-03-20 Petition Decision, n. 2) (“It is not clear whether patent owner's use of the word ‘dismissed’ (or variations thereof) throughout this petition is intended to mean that the '020 *inter partes* reexamination prosecution should be ‘terminated.’ Termination of an *inter partes* reexamination prosecution may, in turn, result in conclusion of the proceeding by publication of a reexamination certificate. See 35 U.S.C. § 316, and the discussion in MPEP § 2694, which points out that conclusion of an *inter partes* reexamination may occur as a result of the vacating the proceeding, which would not result in publication of a reexamination certificate. In prior petitions directed to this issue, patent owner's requested relief was that the 95/000,020 proceeding be ‘severed and dismissed,’ but patent owner also used the phrase ‘severed and terminated’ interchangeably. In discussing patent owner's requested relief and rationale therefor, this decision will continue to use patent owner's terminology, *i.e.* “dismiss,” or a variation thereof. While it is unclear whether patent owner actually is requesting that the 95/000,020 be concluded by publication of a reexamination certificate, or simply vacated, the result reached in this decision would apply for either interpretation.”).

⁸⁵⁸ See *inter partes* reexamination 95/000093 (2007-06-05 Petition Decision, FN 1); *inter partes* reexamination 95/000147 (2007-11-19 Show Cause Order, pp. 5-6).

⁸⁵⁹ See 35 U.S.C. § 317(b).

reexamination, or prior art that was discovered late and could not have been added to the district court litigation.⁸⁶⁰

To increase the possibility of a termination, a petition based on 35 U.S.C. § 317(b) should make a number of showings. First, the petition should demonstrate that there is no possibility of further proceedings on the issue of validity.⁸⁶¹ Second, the petition should demonstrate that the claims at issue in the *inter partes* reexamination have been adjudicated.⁸⁶² Third, the petition should demonstrate that the prior art used in the *inter partes* reexamination was available to be used in the district court proceeding.⁸⁶³

Termination pursuant to section 317(b) is covered in section I.D.2.

6. Petition To Suspend

A petition to suspend the *inter partes* reexamination may be made under 37 C.F.R. § 1.182.⁸⁶⁴ Section 1.103 does not apply in *inter partes* reexamination.⁸⁶⁵ Suspension is covered in section XI.C.

E. Review Of Petitions

Petition decisions under 37 C.F.R. § 1.181 are decided by the Director of the Central Reexamination Unit (or designee). Review of petition decisions by the CRU may be had

⁸⁶⁰ See, e.g., *inter partes* reexamination 95/000147 (2007-11-19 Show Cause Order, pp. 5-6).

⁸⁶¹ See, e.g., *inter partes* reexamination 95/000020 (2005-09-16 Petition Decision, pp. 8-9).

⁸⁶² See, e.g., *inter partes* reexamination 95/000020 (2005-09-16 Petition Decision, pp. 8-9).

⁸⁶³ See, e.g., *inter partes* reexamination 95/000020 (2005-09-16 Petition Decision, pp. 9)(“Accordingly, petitioner has not demonstrated that all of the patents and printed publications deemed to demonstrate a substantial new question of patentability in the August 26, 2003 order granting reexamination were raised (or could have been raised) in the District Court litigation. Therefore, petitioner has not demonstrated a critical fact to warrant sever and termination of the '020 *inter partes* reexamination proceeding pursuant to 35 U.S.C. § 317(b)”).

⁸⁶⁴ See, e.g., *inter partes* reexamination 95/000199 (2008-08-18 Petition Decision, p. 1); *inter partes* reexamination 95/000228 (2007-07-05 Petition Decision, p. 4).

⁸⁶⁵ See *inter partes* reexamination 95/000120 (2006-03-29 Decision, p. 1).

within the Patent Office under 37 C.F.R. § 1.181(a)(3),⁸⁶⁶ within the time limit specified by 37 C.F.R. § 1.181(f), unless a different time is set in the petition decision.⁸⁶⁷

Petitions under 37 C.F.R. § 1.182 and 1.183 are decided by particular staff of the Office of Patent Legal Administration,⁸⁶⁸ through a chain of internal delegation. The OPLA's policy has been to allow a petition for rehearing on its decision, unless it appears that facts may not be further developed, or unless the petitioner specifically requests that the petition decision be final. In either of these cases, the OPLA will generally expressly designate a petition decision as a "final agency action".

Petition decisions relating to *inter partes* reexamination under 37 C.F.R. §§ 1.181-183 may ultimately be reviewed through a mandamus action in the U.S. District Court for the Eastern District of Virginia.⁸⁶⁹ The petition decision must be a final agency decision to be reviewable under the Administrative Procedure Act.⁸⁷⁰ Any district court mandamus action must be undertaken prior to the submission of the case to the Board of Appeals.⁸⁷¹

F. Status Inquiries

Because there can sometimes be long delays between Patent Office actions in *inter partes* reexamination, many parties have been tempted to use status inquiry letters in an attempt to speed things along. True status inquiries have never been treated as improper papers. The apparent success of status inquiries is highly variable. The author has not noticed any consistent effect of status letters, although some actions are mailed suspiciously quickly after the receipt of such a letter.⁸⁷² Using status letters can also have its disadvantages. If there is

⁸⁶⁶ See *Changes to Implement the 2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute* 68 Fed. Reg. 70996, 71002 (Dec. 22, 2003).

⁸⁶⁷ See *inter partes* reexamination 95/000087 (2008-07-15 Petition Decision, p. 4).

⁸⁶⁸ See *inter partes* reexamination 95/000256 (2008-03-11 Petition Decision, p. 1).

⁸⁶⁹ See 28 U.S.C. § 1361; *Helgott & Karas, P.C. v. Dickenson*, 209 F.3d 1328 (Fed. Cir. 2000).

⁸⁷⁰ See 5 U.S.C. § 704.

⁸⁷¹ See *inter partes* reexamination 95/000009 (2007-03-30 Board Decision, pp. 4-5) ("Review of a petition decision is beyond the purview of the Board on appeal. Cf *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2005). Congoleum's remedy was a mandamus action seeking review of the Director's discretionary decision. *Hornback v. United States*, 405 F.3d 999, 1000-01, 74 USPQ2d 1538, 1539 (Fed. Cir. 2005). The time for Congoleum to pursue its equitable remedy passed once the case was submitted to the Board.").

⁸⁷² See, e.g., *inter partes* reexamination 95/000038 (2008-02-21 Status Inquiry)(after two years of inaction, status inquiry is followed by litigation search within four days and ACP within one month); *inter partes* reexamination 95/000016 (2005-02-28 Status inquiry); *inter partes*

anything wrong with the last paper most recently filed, the inquiry might prompt a notice of defective paper long after the fact.⁸⁷³

G. Complaints About Form Violations

Numerous parties have submitted documents that point out form deficiencies in their opponents' submissions. There is no evidence to indicate that this is effective. In some cases, the Patent Office simply ignores such papers.⁸⁷⁴ In some cases, the Patent Office will return the filings as improper papers.⁸⁷⁵ The Patent Office has also in some cases gone out of its way to avoid the necessity of agreeing with parties that complained of their opponents' form failures.⁸⁷⁶

reexamination 95/000018 (2007-08-09 Status Inquiry)(after the inquiry an office action was received within a month); *inter partes* reexamination 95/000045 (2008-02-26 Status Inquiry)(after almost five months of inaction Examiner's Brief mailed two weeks after receiving second status inquiry); *inter partes* reexamination 95/000060 (2008-05-20 Status Inquiry)(after nine months without a Patent Office action, an office action issued two weeks after status inquiry, but five months after receiving first status inquiry); *inter partes* reexamination 95/000152 (2008-01-10 Status Inquiry)(after one year without action, an ACP issued six weeks after status inquiry); *but see, e.g., inter partes* reexamination 95/000024 (2007-08-06 Status Inquiry); *inter partes* reexamination 95/000033 (2006-10-20 Status Inquiry)(after status inquiry, more than a year passes without action); *inter partes* reexamination 95/000051 (2008-01-29 Status Inquiry)(after status inquiry, four months pass without action); *inter partes* reexamination 95/000061 (2006-10-12 Status Inquiry)(after status inquiry, eleven months pass without action); *inter partes* reexamination 95/000096 (2008-04-02 Status Inquiry)(after status inquiry, no action six months later).

⁸⁷³ *See, e.g., inter partes* reexamination 95/000044 (2007-10-29 Notice, p. 1)(Notice Re Defective Paper mailed regarding paper filed seventeen months earlier, after two status inquiry letters had been sent).

⁸⁷⁴ *See, e.g., inter partes* reexamination 95/000032 (2007-11-26 Letter); *but see inter partes* reexamination 95/000209 (2008-11-18 Petition Decision, p. 11)(sealing a late-filed Third Party Requester appeal brief upon a Patent Owner petition).

⁸⁷⁵ *See, e.g., inter partes* reexamination 95/000134 (2006-07-28 Letter, p. 2)(the Patent Owner filed a notice complaining of various formal rule violations evident in the Third Party Requester's comments. The Patent Office returned the Patent Owner paper as improper, but also returned the Third Party Requester comments as defective, based on some of the same considerations listed in the Patent Owner's notice).

⁸⁷⁶ *See, e.g., inter partes* reexamination 95/000038 (2006-04-06 Right of Appeal Notice p. 2)(a Third Party Requester complained that a Patent Owner amendment had presented all claims, not just the amended and new claims, and that therefore the amendment was informal. The Patent Office responded by explaining "[f]irstly, to the extent that 37 C.F.R. 1.530

One good example is provided by *inter partes* reexamination 95/000073. There the Patent Owner filed an Appellant's Brief, and the Third Party Requester followed with Respondent's Brief. The Patent Owner filed a request asserting that the Respondent's Brief was too late, and asking the Patent Office to refuse it consideration.⁸⁷⁷ The Third Party Requester responded by stating that, even if its Brief was late, the Patent Owner's Notice of Appeal was also late.⁸⁷⁸ The Patent Office, instead of terminating the Appeal or returning the Brief, issued a notice indicating that the Briefs were defective and allowing both parties to resubmit their Briefs within one month.⁸⁷⁹

The Patent Office has also refused petitions to expunge, strike, return or seal opponent's papers where the Examiner has not yet had a chance to rule on them.⁸⁸⁰

The MPEP allows Examiners to ignore minor Patent Owner informalities where a *bona fide* response has been made, in order to facilitate the statutory requirement of "special dispatch".⁸⁸¹

XI. Concurrent Litigation And Other Proceedings⁸⁸²

A relatively large proportion of *inter partes* reexaminations are instituted when a proceeding involving the same patent is already taking place.⁸⁸³ Such concurrent proceedings alter the strategic context of an *inter partes* reexamination.

technically prevents the patent owner from presenting all the claims in addition to those that have actually been amended, the rule is hereby waived by Senior Legal Advisor Kenneth M. Schor, who has signed this action solely for that purpose."); *see also inter partes* reexamination 95/000016 (2004-07-14 Decision, p. 4).

⁸⁷⁷ *See inter partes* reexamination 95/000073 (2007-12-14 Request, pp. 1-2).

⁸⁷⁸ *See inter partes* reexamination 95/000073 (2007-12-23 Submission, pp. 1-2).

⁸⁷⁹ *See inter partes* reexamination 95/000073 (2008-02-08 Notice, pp. 1-3).

⁸⁸⁰ *See, e.g., inter partes* reexamination 95/000244 (2008-11-04 Decision, p. 3).

⁸⁸¹ *See* MPEP § 2666.30.

⁸⁸² Some of the material in this section has been updated and adapted from its original publication by the author in M.A. SMITH, *Stay, Suspension and Merger: Considerations for Concurrent Proceedings Involving Inter Partes Reexamination*, 90 J. PAT. & TRADEMARK OFF. SOC'Y 657 (2008).

⁸⁸³ An examination of the first two-hundred *inter partes* reexaminations conducted by the author shows that over one hundred were directed to patents involved in co-pending litigation. The relatively high ratio of concurrent litigation probably results from the fact that *inter partes*

A. Notice Requirement

1. Concurrent Proceedings

The Patent Owner must file a Notice of Concurrent Proceedings with the Patent Office, if the patent under reexamination “is involved” in any co-pending legal proceeding.⁸⁸⁴ Such proceedings probably include district court or appellate litigations affecting claim scope or validity, arbitrations involving the patent, ITC actions, other reexaminations, reissue proceedings, or interference proceedings.

The Patent Owner further has the duty to supply the “results” of such proceedings to the Patent Office. The word “results” has been interpreted by many Patent Owners as encompassing intermediate “results”, or even documents where the Patent Owner or Third Party Requester take a position on the interpretation of the claims or the prior art. The Patent Office itself requests “updated status” information from co-pending proceedings.⁸⁸⁵

Notices must be limited to the bare information to be submitted and not contain further argument or analysis. Otherwise the papers risk return.⁸⁸⁶ The MPEP specifically mentions that “highlighting” or otherwise identifying specific text goes beyond “bare notice”.⁸⁸⁷ About the most one can get away with is a very limited quotation of particularly helpful portions of the decision, and even this may be limited to notices that portend a termination of the *inter partes* reexamination.⁸⁸⁸

Proceedings on related patents or applications, such as parent or child applications / patents or proceedings on foreign patents, do not require a Notice of Concurrent

reexaminations can not be requested anonymously, and are relatively costly and aggressive when compared to licensing negotiations.

⁸⁸⁴ See 37 C.F.R. § 1.985(a).

⁸⁸⁵ See MPEP § 2686.01.

⁸⁸⁶ See, e.g., *inter partes* reexamination 95/000157 (2007-11-01 Decision, pp. 5-6)(“37 CFR 1.985(b) authorizes the filing in an *inter partes* reexamination proceeding, at any time, of a paper notifying the Office of concurrent proceedings in which the same patent is or was involved, provided that the paper is limited to ‘merely providing notice of the other proceeding without discussion of issues of the current *inter partes* reexamination proceeding.’ Any paper that is not so limited will be returned.”); *inter partes* reexamination 95/000227 (2007-05-24 Decision, pp. 2-3).

⁸⁸⁷ See MPEP § 2686.01.

⁸⁸⁸ See, e.g., *inter partes* reexamination 95/000197 (2006-12-18 Notice, p. 1)(quoting an ITC decision stating that the patent had been found not invalid by the ALJ).

Proceedings. Events from these proceedings, however, may trigger the Patent Owner's duty of disclosure to the Patent Office under rules 1.933 and 1.555.⁸⁸⁹

The Third Party Requester has no duty to submit information on co-pending proceedings,⁸⁹⁰ but the Patent Office will accept notices from the Third Party Requester, and possibly anyone else.⁸⁹¹

B. Inconsistent Results

Whenever there are concurrent proceedings, there is the possibility of inconsistent results. Indeed, it is the possibility of inconsistent results that often motivates a reexamination request where there is co-pending litigation.

The probability of inconsistent results depends on which proceedings are co-pending. Where two Patent Office proceedings are co-pending, the Patent Office can usually avoid inconsistent results by merging the proceedings or by suspending all but one of them. Where reexamination is co-pending with litigation, however, the potential for inconsistent results is greater. Because the Patent Office employs a different standard of proof and allows Patent Owners to amend claims, arguments that the Patent Office should defer to a court, or *vice versa*, are weaker than arguments that the Patent Office should merge proceedings.⁸⁹² Furthermore, the Patent Office and some courts are slow to suspend or stay their own proceedings in favor of others.⁸⁹³

Inconsistent results can happen at many levels. Examiners and courts can make different findings of fact and law⁸⁹⁴ (although the ultimate result may be the same or moot). Inconsistent results on the ultimate issue (whether a particular claim is invalid) can also occur.

⁸⁸⁹ See 37 C.F.R. § 1.933(a) referencing 37 C.F.R. 1.555.

⁸⁹⁰ As various branches within the Patent Office have warned, however, “requesters and their proxies should not assume that they are impervious to procedural and substantive sanctions”. *Inter partes* reexamination 95/000009 (2007-03-30 Board Decision, p. 4).

⁸⁹¹ See 37 C.F.R. § 1.985(b). The MPEP states that the Patent Office will accept submissions from “any parties”—this likely means “any person” in accordance with the rules.

⁸⁹² See, e.g., *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988).

⁸⁹³ See sections XI.C and XI.E, *infra*.

⁸⁹⁴ See, e.g., *Callaway Golf Co. v. Acushnet Co.*, 523 F.Supp.2d 388, 398 n.9 (D. Del. 2007)(“The court respectfully disagrees with the conclusion of the Patent Office, which has found that Nesbitt incorporates by reference Molitor '637”). The Third Party Requester, however, may be estopped from advocating an inconsistent factual position by virtue of AIPA § 4067. See section I.D.5, *supra*.

Where such inconsistencies occur, the combined effect of the proceedings depends on whether a court or the Patent Office found the claim invalid, and when.

1. Court Finds A Claim Invalid

The Patent Office has indicated that a final, non-appealable judgment of invalidity obliges the Office to “terminate” a reexamination.⁸⁹⁵ This is because, according to the Patent Office, a final holding of invalidity removes the “substantial new question of patentability”, thus depriving the Patent Office of jurisdiction.⁸⁹⁶ Presumably, the Patent Office would actually “vacate” a proceeding for which it has no jurisdiction.

If a judgment of invalidity is still appealable, the Patent Office has indicated that it will not defer to a court.⁸⁹⁷ The Patent Office may, however, suspend the reexamination if other conditions are met.⁸⁹⁸

2. Court Finds A Claim Not Invalid

If a court finds a claim not invalid, the effect of the judgment is governed by 35 U.S.C. § 317(b). If the judgment is not appealable and the Third Party Requester advocated invalidity in the court case, the Patent Office may be obliged to terminate the proceedings with respect to the claim in question.⁸⁹⁹ If the Third Party Requester is not a party to the case, the Patent Office has indicated that it will not defer to the court’s finding, but “may accord deference to factual findings made by the court”⁹⁰⁰ The legality of the Patent Office’s decision to not defer has been confirmed by the Federal Circuit.⁹⁰¹

⁸⁹⁵ See MPEP § 2686.04.II.(A).

⁸⁹⁶ See MPEP § 2686.04.II.(A).

⁸⁹⁷ See MPEP § 2686.II.(A).

⁸⁹⁸ See section XI.C, *infra*.

⁸⁹⁹ See section I.D.3, *supra*.

⁹⁰⁰ See MPEP § 2686.II.(A).

⁹⁰¹ See, e.g., *in re Swanson*, 88 U.S.P.Q.2d 1196, 1203 (Fed. Cir. 2008)(“Thus, prior to *Ethicon* the Patent Office had held that a substantial new question of patentability would not be found if the same issue had been addressed by a federal court, see *In re Wichterle*, 213 U.S.P.Q. 868, 869 (Comm'r Pat. & Trademarks 1982), but it revised its position in the wake of *Ethicon*, instructing examiners that a final court decision of a claim's validity will not preclude a finding of a substantial new question of validity based on the same art ‘because of the different standards of proof employed by the Federal District Court and the Office,’ MPEP § 2242. We agree with the Patent Office 's current position.”).

3. Patent Office Finds Claim Unpatentable

If the Patent Office issues a reexamination certificate canceling a claim, the original patent claim can no longer be enforced under 35 U.S.C. § 252.⁹⁰²

A fully contested reexamination may not reach a reexamination certificate before a co-pending litigation goes to trial. If an office action with final character is mailed rejecting the claim, however, the Third Party Requester may be able to convince an otherwise unwilling court to stay the litigation pending appeal.

The Third Party Requester may be relieved of an adverse district court judgment, however, if appeals from the Patent Office and district court reach the Federal Circuit at roughly the same time. In *Translogic v. Hitachi*,⁹⁰³ the defendant suffered an adverse judgment at trial and appealed to the Federal Circuit. The Patent Owner, however, had suffered a rejection of all at the Patent Office Board of Appeals. The Federal Circuit released decisions in both appeals on the same day. The decision in the appeal from the reexamination upheld the rejection of all claims.⁹⁰⁴ In a separate opinion, the Federal Circuit vacated the district court judgment, and remanded for dismissal.⁹⁰⁵

4. Patent Office Finds Claim Patentable

If the Patent Office confirms or finds patentable a claim in a reexamination certificate, the effect is governed by 35 U.S.C. § 252.⁹⁰⁶ If the Third Party Requester is a defendant in an infringement suit, its defenses against the confirmed claim will be limited by 35 U.S.C. § 315(c).⁹⁰⁷

Where the Patent Office has confirmed or found a claim patentable at some stage prior to a reexamination certificate, 35 U.S.C. § 315(c) does not oblige a district court to preclude evidence of invalidity, even if the Third Party Requester is a defendant.

C. Suspension Of The *Inter Partes* Reexamination

⁹⁰² See 35 U.S.C. § 252 via 35 U.S.C. § 316(b).

⁹⁰³ See *Translogic v. Hitachi*, 2007 WL 2973955, *1 (Fed. Cir. 2008)(unpublished).

⁹⁰⁴ See *in re Translogic Technologies, Inc.*, 504 F.3d 1249, 1262 (Fed. Cir. 2008).

⁹⁰⁵ 2007 WL 2973955, *1 (Fed. Cir. 2008)(unpublished).

⁹⁰⁶ See section III.A.3(a), *supra*.

⁹⁰⁷ See section I.D.4, *supra*.

Patent Owners are often interested in suspending *inter partes* reexaminations in favor of co-pending litigation proceedings.⁹⁰⁸

1. Application Of Rules Governing Suspension

Rule 1.937 allows the office to suspend an *inter partes* reexamination where the Director finds “good cause” to do so.⁹⁰⁹ The requirement to find “good cause” arises from the statutory requirement of “special dispatch”.⁹¹⁰ If a patent is involved in litigation, the Patent Office must make a decision on whether to suspend the *inter partes* reexamination.⁹¹¹

Either party may petition for a suspension, which is treated as a petition under 37 C.F.R. § 1.182.⁹¹² The Patent Office will not suspend an *inter partes* reexamination when a Patent Owner response to an office action is outstanding.⁹¹³ The Office will usually require a

⁹⁰⁸ This is principally because the Patent Office can not find infringement or award damages. But there are indications that the *inter partes* reexamination may be a comparably advantageous proceeding for parties asserting the invalidity of a patent. See section II.B, *supra*.

⁹⁰⁹ See 37 C.F.R. § 1.937(a).

⁹¹⁰ See 35 U.S.C. § 314(c).

⁹¹¹ See 37 C.F.R. § 1.987; *Sony Computer Entertainment Am., Inc., v. Dudas*, 2006 WL 1472462, *6 (E.D.Va., May 22, 2006).

⁹¹² See *inter partes* reexamination 95/000185 (2007-06-08 Petition Decision, pp. 1-2); *inter partes* reexamination 95/000071 (2005-06-09 Petition Decision, p. 2); see also *inter partes* reexamination 95/000120 (2006-07-19 Petition Decision, p. 6) (“The patent owner’s argues that 37 C.F.R. 1.987 independently authorizes the filing of the present petition to suspend. This too is not persuasive. The plain language of the regulation does not state or imply that it in any way authorizes the filing of a petition to suspend, particularly a petition that would be improper pursuant to one or more of the regulations that implement the *inter partes* reexamination statutes. 37 C.F.R. 1.987 is merely declaratory of the Director’s discretionary authority to sua sponte suspend an *inter partes* reexamination proceeding in certain circumstances, i.e., when there is both: (a) litigation involving the patent which is the subject of the *inter partes* reexamination proceeding and (b) ‘good cause’ to suspend. 37 C.F.R. 1.987 in no way authorizes the filing of a petition to request such a suspension. The right of parties in this arena is the filing of a Notification of Existence of Prior or Concurrent Proceedings and Decisions pursuant to MPEP § 2686 to provide the Office with information which may, or may not, just a suspension of action. Patent owner has not cited a regulation that authorizes the filing of a petition to suspend an *inter partes* reexamination proceeding. In fact, no regulation implementing the *inter partes* reexamination statutes authorizes such a petition.”).

⁹¹³ See MPEP § 2686.01.

petition to suspend the *inter partes* reexamination to be filed in the *inter partes* reexamination proceeding, and not in a co-pending proceeding.⁹¹⁴

The decision to suspend an *inter partes* reexamination is a final agency decision reviewable under the Administrative Procedure Act. This appears to be the Patent Office position,⁹¹⁵ which has been confirmed by at least one district court.⁹¹⁶

2. How Does The Patent Office Decide Whether To Suspend?

The Patent Office interprets the “good cause” required by statute to imply an “exceptional (extraordinary)” circumstance.⁹¹⁷ This concept of “good cause” includes at least the possibility of inconsistent results where co-pending proceedings can not be merged, as suspension is the usual measure in such a situation.⁹¹⁸ The Patent Office will sometimes apply 37 C.F.R. § 1.103 (suspension of an application) by analogy.⁹¹⁹

The Patent Office is not likely to suspend an *inter partes* reexamination based simply on the fact that there is ongoing litigation. This results from the Federal Circuit’s decision in *Ethicon v. Quigg*, where the Patent Office’s suspension of an *ex parte* reexamination was reversed based on the requirement of “special dispatch”.⁹²⁰ The Federal Circuit held that “[w]hatever else special dispatch means, it does not admit of an indefinite suspension of

⁹¹⁴ See, e.g., *inter partes* reexamination 95/000057 (2005-04-19 Letter); *inter partes* reexamination 95/000165 (2007-01-09 Letter, p. 3). However, this is not to say that all such petitions are fruitless. There is nothing preventing the Patent Office from *sua sponte* taking action in another case that was suggested in a petition in the *inter partes* reexamination. For example, in *inter partes* reexamination 95/000070, the third party requester requested that a co-pending reissue application be suspended in favor of the *inter partes* reexamination. The Patent Office reasoned that the reissue application was later filed and was not required to be conducted with special dispatch. The Patent Office therefore suspended the reissue application, thus effectively granting the third party requester’s request. See *inter partes* reexamination 95/000070 (2005-09-14 Petition Decision, p. 6).

⁹¹⁵ See, e.g., *inter partes* reexamination 95/000093 (2005-11-17 Petition Decision, p. 10).

⁹¹⁶ See *Sony Computer Entertainment Am., Inc., v. Dudas*, 2006 WL 1472462, *5 (E.D.Va., May 22, 2006).

⁹¹⁷ See MPEP § 2686.01.II.

⁹¹⁸ See, e.g., *inter partes* reexamination 95/000070 (2005-09-14 Petition Decision, p. 5); *inter partes* reexamination 95/000081 (2005-09-20 Decision, p. 6).

⁹¹⁹ See *inter partes* reexamination 95/000071 (2005-06-09 Petition Decision, p. 2).

⁹²⁰ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1426 (Fed. Cir. 1988).

reexamination proceedings pending conclusion of litigation.”⁹²¹ Because the statutes authorizing *inter partes* reexamination also require “special dispatch”,⁹²² the Patent Office feels confident that it is proper to maintain an *inter partes* reexamination where there is ongoing litigation.⁹²³

It must be noted, however, that the statutory provision requiring “special dispatch” in *inter partes* reexaminations (section 314(c)) differs from the corresponding provision for *ex parte* reexamination. Section 314(c) specifically provides for an exception to “special dispatch” if the Director finds “good cause”. The weight given to this textual difference by the Patent Office is apparent from *inter partes* reexamination 95/000093, where the Patent Office denied a petition for suspension, reasoning:

Petitioner argues that *Ethicon* is inapplicable because Congress ‘amended the very language that the Federal Circuit relied on to decide *Ethicon*, 35 U.S.C. § 305 (“All reexamination proceedings...will be conducted with special dispatch”).’ Pet. at 13. This is incorrect. The special dispatch requirement is still maintained in *inter partes* reexamination. 35 U.S.C. § 314(c). The amendment cited by Petitioner did not eliminate the special dispatch requirement; it simply provided that the Director may, for good cause, suspend (not terminate or discontinue) an *inter partes* reexamination proceeding.⁹²⁴

The Patent Office’s interpretation of “good cause” was concretized during the proceedings related to *inter partes* reexamination 95/000093. There, the Patent Owner obtained a district court judgment finding the various patent claims not invalid. The Patent Owner

⁹²¹ *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1426 (Fed. Cir. 1988).

⁹²² See 35 U.S.C. § 314(c).

⁹²³ See *inter partes* reexamination 95/000093 (2005-08-23 Petition Decision, p. 6)(“There is no doubt that *ex parte* reexamination of a patent and litigation of that same patent can occur simultaneously. In *Ethicon v. Quigg*, 849 F.2d 1422, 1428-1 429, (Fed. Cir. 1988), the patent was both being reexamined and in civil litigation. The Office suspended the reexamination until the litigation was finally resolved. The Federal Circuit reversed the Office's decision, and ordered the Office to continue the reexamination while the litigation was ongoing. The court gave several reasons for its decision, including the statutory mandate that reexaminations must be conducted with special dispatch. *Inter partes* reexamination has the same "special dispatch" requirement. See 35 U.S.C. 317(b). Similarly, like *ex parte*, *inter partes* reexamination does not include provisions that (i) preclude an *inter partes* reexamination when a civil action has been filed, or (ii) preclude a civil action on a patent once an *inter partes* reexamination has been started on that same patent. The statute thus clearly contemplates that there may be concurrent proceedings, at least for some period of time. 35 U.S.C. § 317.”)(emphasis in original).

⁹²⁴ *Inter partes* reexamination 95/000093 (2005-08-23 Petition Decision, p. 12).

petitioned for a suspension, which was denied because the *inter partes* reexamination involved claims that were not part of the district court's decision. After the Patent Owner disclaimed the extra claims, it petitioned again for suspension. The Patent Office granted the petition, and the Third Party Requester sued in the Eastern District of Virginia for review of the suspension under the Administrative Procedure Act in *Sony Computer Entertainment Am., Inc., v. Dudas*.⁹²⁵

The district court found that the Patent Office's decision was supported by "good cause" and therefore proper.⁹²⁶ Supporting the finding of "good cause" were the fact that the litigation had advanced to the appeal stage and the fact that the issues in *inter partes* reexamination were coextensive with issues on appeal.⁹²⁷ The Patent Office and the court both recognized that a variety of outcomes were possible at the Federal Circuit. But both also found that the possibility of a decision forcing the continuation of the *inter partes* reexamination did not outweigh the good cause in favor of suspension.⁹²⁸

The standard set by the district court in *Sony* has been used in later decisions as the *de facto* interpretation of "good cause" for a suspension.⁹²⁹ The factors, as later interpreted by the Patent Office, include (1) whether the *inter partes* reexamination is at an early stage; (2) whether the litigation is at a later stage; and (3) whether the prior art on appeal is identical to the prior art in the *inter partes* reexamination; and (4) whether the claims at issue are identical.⁹³⁰

Petitions to suspend that can not support these factors are unlikely to be granted. In *inter partes* reexamination 95/000120, for example, the Patent Owner petitioned for a suspension in light of concurrent litigation and potential estoppel. The Patent Office denied the petition, reasoning that, unlike the situation in *Sony*, the concurrent litigation had not advanced significantly.⁹³¹

⁹²⁵ 2006 WL 1472462 (E.D.Va., May 22, 2006).

⁹²⁶ *Sony Computer Entertainment Am., Inc., v. Dudas*, 2006 WL 1472462, *7 (E.D.Va., May 22, 2006).

⁹²⁷ *Sony Computer Entertainment Am., Inc., v. Dudas*, 2006 WL 1472462, *7 (E.D.Va., May 22, 2006).

⁹²⁸ *Sony Computer Entertainment Am., Inc., v. Dudas*, 2006 WL 1472462, *7 (E.D.Va., May 22, 2006).

⁹²⁹ See *inter partes* reexamination 95/000166 (2007-10-29 Petition Decision, p. 11).

⁹³⁰ See *inter partes* reexamination 95/000166 (2007-10-29 Petition Decision, p. 11).

⁹³¹ See *inter partes* reexamination 95/000120 (2006-07-19 Petition Decision, p. 11). The Patent Office also concluded that the third party requester (the inventor), was not in privity with the patent owner such that he had no right to file a request under 37 C.F.R. § 1.917.

Nor is the Patent Office likely to suspend an *inter partes* reexamination based on arguments that a district court is a better forum because of its discovery powers, despite the suggestion to that effect found in MPEP § 2686.04.III.⁹³² In *inter partes* reexamination 95/000071, the Patent Owner petitioned for a suspension of the *inter partes* reexamination based on the co-pendency of a district court case that had proceeded to a few months after the issuance of the Markman order. The Patent Owner argued that the Court was the best forum to decide the variety of issues (*i.e.* that the Patent Office was necessarily limited as to what it could consider) and that the Patent Owner was entitled to a trial by jury.

The Patent Office rejected these arguments,⁹³³ reasoning that 35 U.S.C. § 318 specifically contemplates concurrent proceedings. The Office noted that an *inter partes* reexamination can be instituted any time prior to the time the limits in 35 U.S.C. § 317 take effect, and thus arguments that the court proceeding was advanced were not sufficient cause for a suspension. Addressing the issue of whether a district court would be the best forum for the issues, the Office reasoned that it “possesses a combination of legal and technical expertise unique to patents”. The Office stressed that *inter partes* reexamination and federal court litigation are not redundant, noting that:

claims may be amended during an *inter partes* reexamination proceeding under 35 U.S.C. § 314(a), but not before the District Court. Thus, while a trial in District Court is an all-or-nothing inquiry with regard to the patentability of a given claim, a reexamination proceeding before the Office affords the patent owner the possibility of obtaining patent protection of a narrower scope if the patentability of a claim as originally issued cannot be upheld.⁹³⁴

The Patent Office also noted the fact that differing claim interpretations can be applied, and that the standards of evidence applied (preponderance in the Patent Office) are different.⁹³⁵

Even a district court judgment finding the patents not invalid is unlikely to provoke a suspension, unless the claims at issue are identical.⁹³⁶ The Patent Office is likely

⁹³² See, e.g., *inter partes* reexamination 95/000071 (2005-06-09 Petition Decision, p. 4).

⁹³³ The patent owner had also not responded to an outstanding office action. The Patent Owner renewed its petition twice more after responding to the office action. The Patent Office denied both renewed petitions. See *inter partes* reexamination 95/000071 (2005-09-08 Petition Decision); *inter partes* reexamination 95/000071 (2006-03-23 Petition Decision).

⁹³⁴ *Inter partes* reexamination 95/000071 (2005-09-08 Petition Decision, p. 3).

⁹³⁵ See *inter partes* reexamination 95/000071 (2006-03-23 Petition Decision, p. 2).

continue with the reexamination of all claims at issue to avoid piecemeal examination. The Patent Office might consider suspending an *inter partes* reexamination that has a claim in addition to those involved in the district court judgment, however, if the Patent Owner can make the difficult showing that the issues on appeal are identical to those in the *inter partes* reexamination.⁹³⁷

As demonstrated in the *Sony* case, if non-litigated claims are removed from issue by statutory disclaimer, the issues may become identical to the point where good cause will exist to suspend the *inter partes* reexamination.⁹³⁸ Good cause may be found where there are claims in the patent that were not part of the judgment, but also not part of the reexamination request.⁹³⁹

Suspension is, however, the typical measure taken where co-pending Patent Office proceedings are not merged. This can occur where one of the co-pending proceedings has advanced to the appeal stage, where one of the co-pending proceedings is a broadening reissue,⁹⁴⁰ or where it appears that the third party requester is trying to circumvent the provisions of 35 U.S.C. § 317.⁹⁴¹

In *inter partes* reexamination 95/000157, for example, the Patent Office *sua sponte* suspended the reexamination in favor of a co-pending *ex parte* reexamination. The Examiner in the *ex parte* reexamination had rejected all claims, and this rejection had been upheld by the Board. The Patent Owner had appealed to the Federal Circuit.⁹⁴²

A petition for suspension was granted in *inter partes* reexamination 95/000185. The argument for suspension was based on a prior merged reissue /*ex parte* reexamination proceeding. The Patent Office reasoned that it had “good cause” to suspend the *inter partes* reexamination because of the advanced nature of the prior proceeding, in which a notice of allowance had issued. The Patent Office further stated that it may not have jurisdiction to continue the *inter partes* reexamination after conclusion of the merged proceeding, if the Patent

⁹³⁶ See *inter partes* reexamination 95/000093 (2005-08-23 Petition Decision, p. 14); *inter partes* reexamination 95/000020 (2004-06-02 Petition Decision, p. 10)(refusing to suspend the reexamination after the district court found in favor of the patent owner).

⁹³⁷ See *inter partes* reexamination 95/000093 (2005-08-23 Petition Decision, pp. 13-14).

⁹³⁸ See *inter partes* reexamination 95/000093 (2005-11-17 Petition Decision, p. 9).

⁹³⁹ See *inter partes* reexamination 95/000093 (2005-11-17 Petition Decision, p. 8).

⁹⁴⁰ See section XI.D.2, *infra*, and text thereto.

⁹⁴¹ See *inter partes* reexamination 95/000093 (2006-07-03 Petition Decision, pp. 9-10).

⁹⁴² See *inter partes* reexamination 95/000157 (2007-11-01 Decision, p. 5).

Office were to conclude that same claims in the merged proceedings were patentable over the same prior art before the Examiner in the *inter partes* reexamination.⁹⁴³

If the conditions for which a suspension was granted change, either party may file a paper (likely a petition under 37 C.F.R. § 1.182) to lift the suspension.⁹⁴⁴

3. Further Example Decisions on Petitions To Suspend

In *inter partes* reexamination 95/000120, the Patent Owner petitioned for a suspension in light of concurrent litigation and potential estoppel. The Patent Office denied the petition, reasoning that, unlike the situation in *Sony*, the concurrent litigation had not advanced significantly. Second, the Patent Office concluded that the Third Party Requester (the inventor), was not in privity with the Patent Owner such that he had no right to file a request under 37 C.F.R. § 1.917.⁹⁴⁵

In *inter partes* reexamination 95/000145, the Patent Owner also petitioned for a suspension in light of concurrent litigation and potential estoppel. The Patent Owner pointed out that the litigation was two and a half years advanced, and that the Patent Office had just begun reexamination proceedings. The Patent Office denied the petition because the Patent Owner had failed to authorize the charging of a deposit account for or pay the fee for petition under 37 C.F.R. § 1.182.⁹⁴⁶

In *inter partes* reexamination 95/000221, the Patent Owner petitioned for suspension based on a concurrent district court judgment finding some claims of the patent not invalid. The Patent Office dismissed the petition on other grounds, but also stated:

Patent owner should also note that the action of the Office in suspending the *inter partes* reexamination proceedings that resulted in the *Sony* decision was predicated, in part, on the fact that the claims in the *inter partes* reexamination proceedings and the claims of the involved patent that had been subject to the copending litigation were identical. Therefore, a final, non-appealable holding of claim invalidity would have resulted in termination of two *inter partes* reexamination proceedings with respect to **all** of the claims subject to *inter partes* reexamination in those proceedings. Had the claims not been identical in each litigation and the corresponding *inter partes* reexamination proceeding, the 35 U.S.C. § 317(c) [sic] estoppel would not have

⁹⁴³ See *inter partes* reexamination 95/000185 (2007-06-08 Petition Decision, pp. 5-6).

⁹⁴⁴ See *inter partes* reexamination 95/000185 (2007-06-08 Petition Decision, p. 6).

⁹⁴⁵ See *inter partes* reexamination 95/000120 (2006-07-19 Petition Decision, p. 11).

⁹⁴⁶ See *inter partes* reexamination 95/000145 (2006-10-26 Petition Decision, p.).

applied and, in furtherance of the public interest, the Office would have continued to reexamination of the patent claims that were not the subject of the litigation. It presently appears, that the '221 *inter partes* reexamination proceeding involves patent claims 1-33. The *Anascope* litigation appears to have determined only the validity of patent claims 14, 16, 19, 22 and 23. Therefore, based on present information, a petition to suspend the '221 *inter partes* reexamination proceeding would not be grantable.⁹⁴⁷

In *inter partes* reexaminations 95/000228, 95/000246 and 95/000278 the Patent Office refused to suspend an *inter partes* reexamination in favor of co-pending litigation, where the litigations were still significantly before trial.⁹⁴⁸ In *inter partes* reexamination 95/000228, the litigation had additionally been stayed by the district court.⁹⁴⁹

In *inter partes* reexamination 95/000247, the Patent Owner wished to obtain a suspension, but did not want to go the full *Sony* route of disclaiming claims not in the litigation. Instead, it submitted a disclaimer that was conditioned upon the grant by the Patent Office of a petition to suspend. The Patent Office denied the petition, finding:

In this instance, patent owner has filed a 'Conditional Statutory Disclaimer' in an attempt to disclaim claims 4-8 and 11 of the '133 patent such that only those patent claims that are the subject of the pending litigation would be the subject of the '247 *inter partes* reexamination proceeding. However, the 'Conditional Statutory Disclaimer' filed by patent owner is ineffective to disclaim claims 4-8 and 11 of the '133 patent, because it cannot be entered. First, as stated in MPEP § 1490, 35 U.S.C. § 253 does not authorize the Office to accept a 'conditional' disclaimer. A statutory disclaimer must be an unequivocal, unconditional legal instrument.⁹⁵⁰

4. Conduct Of Suspended Reissue Proceedings After Suspension

If a reissue application is suspended in light of an *inter partes* reexamination proceeding, when the *inter partes* reexamination is complete (a reexamination certificate has

⁹⁴⁷ *Inter partes* reexamination 95/000221 (2008-10-08 Petition Decision, p. 5)(emphasis in original).

⁹⁴⁸ See *inter partes* reexamination 95/000228 (2007-07-05 Petition Decision, p. 8); *inter partes* reexamination 95/000246 (2007-06-24 Petition Decision, p. 8); *inter partes* reexamination 95/000278 (2008-04-07 Petition Decision, p. 6).

⁹⁴⁹ See *inter partes* reexamination 95/000228 (2007-07-05 Petition Decision, p. 8).

⁹⁵⁰ *Inter partes* reexamination 95/000247 (2008-02-07 Petition Decision, p. 10).

issued) the reissue application must proceed as if the reexamination certificate is the original patent.⁹⁵¹

D. Merger With Another Patent Office Proceeding

1. Merger In General

Merger is the Patent Office action to combine two co-pending proceedings into one proceeding. The Patent Office has the express power to merge a later-filed reexamination proceeding with an earlier filed *inter partes* reexamination under 37 C.F.R. § 1.989(a).⁹⁵² The Patent Office interprets this rule to mean that the *inter partes* reexamination may be merged with an earlier filed, co-pending reexamination.⁹⁵³ The Patent Office also has the express power to merge an *inter partes* reexamination with a reissue application.⁹⁵⁴

Merger may be a *sua sponte* decision by the Patent Office or may occur as the result of a petition.⁹⁵⁵ The Patent Office advises parties that it is not necessary to file a petition.⁹⁵⁶ A petition to merge, however, may bring the issue before the Office of Patent Legal Administration more quickly than the Patent Office would otherwise pick it up.

There are a number of formalities of note for petitions to merge. A petition to merge proceedings is a petition under 37 C.F.R. § 1.182.⁹⁵⁷ The MPEP indicates that, in contrast to the usual practice, the Patent Office will entertain petitions for merger in the *inter partes* reexamination from any requester from any co-pending reexamination proceeding that is being advocated for merger.⁹⁵⁸ A petition to merge must wait until after reexamination has been

⁹⁵¹ See MPEP § 1453; *inter partes* reexamination 95/000070 (2005-09-14 Petition Decision, p. 7).

⁹⁵² See 37 C.F.R. § 1.989(a).

⁹⁵³ See MPEP § 2686.01; see also, e.g., *inter partes* reexamination 95/000005 (2002-12-13 Merger Decision, p. 2)(merging an *inter partes* reexamination with an earlier filed *ex parte* reexamination); *inter partes* reexamination 95/000053 (2005-04-19 Merger Decision, p. 2); *inter partes* reexamination 95/000057 (2005-04-19 Decision, p. 3)(same); *inter partes* reexamination 95/000182 (2007-02-07 Decision, p. 3)(same).

⁹⁵⁴ See 37 C.F.R. § 1.991

⁹⁵⁵ See MPEP § 2686.01.VI.

⁹⁵⁶ See *id.*

⁹⁵⁷ See *inter partes* reexamination 95/000096 (2006-07-14 Decision, p. 1)

⁹⁵⁸ See MPEP § 2686.01.VI.

ordered in every relevant proceeding.⁹⁵⁹ Such a petition may, however, be filed prior to the issuance of the first office action, despite the requirements of 37 C.F.R. § 1.939(b).⁹⁶⁰

2. How Does The Patent Office Decide Whether To Merge?

The Patent Office exercises a large degree of discretion in decisions on merger.⁹⁶¹ The general policy is to merge co-pending proceedings, absent special circumstances,⁹⁶² in order to avoid wasting resources or risking conflicting results.⁹⁶³

The Office of Patent Legal Administration is charged with deciding whether co-pending proceedings should be merged. The OPLA is reluctant to give specifics on how their merger decisions are made (beyond the guidelines in the MPEP), but the parameters can be inferred from decisions already made. Where two or more reexaminations are co-pending, the

⁹⁵⁹ See MPEP § 2686.01.VI.

⁹⁶⁰ See MPEP § 2686.01.VI. (waiving the requirements of 37 C.F.R. § 1.939).

⁹⁶¹ See *inter partes* reexamination 95/000093 (2006-07-03 Petition Decision, pp. 7-8) (“As an initial matter, there is no legal requirement for the Office to merge two pending reexamination proceedings. Rather, as with the Office's decisions to reexamine claims beyond those requested and to suspend an *inter partes* reexamination for ‘good cause,’ the Office's decision to merge two reexaminations is a purely discretionary act. See *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas*, 2006 WL 1472462 (E.D.Va. May 22,2006).”).

⁹⁶² See MPEP § 2686.03; *inter partes* reexamination 95/000069 (2005-03-14 Merger Decision, p. 3) (“The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings.”).

⁹⁶³ See MPEP § 2686.01.I. (“If a second request for reexamination is filed prior to the issuance of a Notice of Intent to Issue a Reexamination Certificate for the first reexamination proceeding, the proceedings generally will be merged.”); *inter partes* reexamination 95/000050 (2007-09-22 Merger Decision, pp. 2-3).

result will generally be merger.⁹⁶⁴ This is true whether the other proceeding is an *ex parte* or *inter partes* reexamination,⁹⁶⁵ and regardless of which proceeding was first filed.⁹⁶⁶

The likelihood of merger of reexaminations makes it difficult for a Patent Owner to avoid *inter partes* reexamination by preemptively requesting an *ex parte* reexamination. In *inter partes* reexamination 95/000057, the Patent Office merged an *ex parte* reexamination, requested by the Patent Owner in August 2004, with an *inter partes* reexamination, requested by a third party in October 2004. The Patent Owner argued, in an *ex parte* reexamination statement under 37 C.F.R. 1.530, that the proceedings should not be merged because the *inter partes* reexamination duplicated and “unnecessarily complicated” the *ex parte* reexamination. The Patent Office rejected the reasoning and merged the proceedings, ordering that the merged proceeding be conducted under the *inter partes* rules.⁹⁶⁷

The likelihood of merger has, however, opened doors for potential strategic use of *ex parte* reexamination requests during the course of the *inter partes* reexamination. In *inter partes* reexamination 95/000050, for example, the Patent Owner requested *ex parte* reexamination on a single reference fifteen months after the *inter partes* reexamination had been requested. An Action Closing Prosecution had already been mailed in the *inter partes* reexamination. The Patent Office merged the *inter partes* reexamination with the *ex parte* reexamination and reopened prosecution, stating that it was not the Patent Office’s policy to allow reexaminations to proceed concurrently. Thus, for the price of an *ex parte* reexamination request, a possible admission against interest, and one additional reference in the *inter partes* reexamination (which the Patent Owner was required to disclose in any case) the Patent Owner obtained a reopening of prosecution and a delay of at least a year and a half.⁹⁶⁸

The Patent Office hinted that it might disapprove of such practices in *inter partes* reexamination 95/000096. There, the reexamination was co-pending with a broadening reissue

⁹⁶⁴ See, e.g., *inter partes* reexamination 95/000005 (2002-12-13 Merger Decision, p. 2); *inter partes* reexamination 95/000050 (2007-09-22 Merger Decision, pp. 2-3); *inter partes* reexamination 95/000057 (2005-04-19 Decision, p. 2); *inter partes* reexamination 95/000053 (2005-04-19 Merger Decision p. 2); *inter partes* reexamination 95/000069 (2005-03-14 Merger Decision, p. 2); *inter partes* reexamination 95/000182 (2007-02-07 Decision, p. 3).

⁹⁶⁵ See, e.g., *inter partes* reexamination 95/000069 (2005-03-14 Notice p. 2)(merging two *inter partes* reexaminations with different third party requesters).

⁹⁶⁶ See, e.g., *inter partes* reexamination 95/000050 (2007-09-22 Merger Decision, pp. 2-3)(merging the *inter partes* reexamination with an *ex parte* reexamination filed fourteen months after the *inter partes* reexamination request); *inter partes* reexamination 95/000069 (2005-03-14 Notice p. 2)(merging the *inter partes* reexamination with a previously requested *ex parte* reexamination).

⁹⁶⁷ See *inter partes* reexamination 95/000057 (2005-04-19 Decision, pp. 2-3).

⁹⁶⁸ See *inter partes* reexamination 95/000050 (2007-09-22 Merger Decision, pp. 2-3).

application. The reissue application was filed one and a half years after the request for *inter partes* reexamination. The Patent Owner petitioned to have the proceedings merged. At the time of the petition, an Action Closing Prosecution had already been mailed in the *inter partes* reexamination, whereas no office action had yet been mailed in the reissue application.⁹⁶⁹ The Patent Office denied the petition and suspended the reissue application, principally because the reissue application was broadening.⁹⁷⁰ In its decision, however, the Patent Office also stated that:

Further, while in other situations it may be beneficial to consolidate reexamination and reissue proceedings within the Office, in this instance, such consolidation would necessitate the prolonging of prosecution in the *inter partes* reexamination proceeding at a point where the next Office action in the reexamination proceeding will most likely be a final Office action, *i.e.*, a Right of Appeal Notice (RAN). Any such prolonging of prosecution in the *inter partes* reexamination proceeding would be contrary to the special dispatch requirement set by the statute. Therefore, rather than merging the reexamination and reissue proceedings in this instance, it is instead appropriate that the reissue application be suspended pursuant to 37 C.F.R. § 1.103(e) in favor of the *inter partes* reexamination proceeding for the reasons discussed *supra*.⁹⁷¹

There are several other exceptions to the general rule that a co-pending Office proceeding will be merged with an *inter partes* reexamination. These can include: (1) where the co-pending proceeding is an interference,⁹⁷² (2) where the merged proceeding would result in inappropriate rights for the Third Party Requester, such as the ability to comment on broadened claims from a reissue application,⁹⁷³ (3) where one of the co-pending proceedings is far advanced (e.g. a notice of intent to issue a reexamination certificate has been mailed);⁹⁷⁴ or (4) where it appears that a Third Party Requester is attempting to circumvent the restriction of 35 U.S.C. § 317(a).⁹⁷⁵

⁹⁶⁹ See *inter partes* reexamination 95/000096 (2006-07-17 Petition Decision, p. 2).

⁹⁷⁰ See *id.* at 4-5.

⁹⁷¹ *Inter partes* reexamination 95/000096 (2006-07-17 Petition Decision, p. 5).

⁹⁷² See MPEP § 2686.02.

⁹⁷³ See MPEP § 2686.03.II.; *inter partes* reexamination 95/000070 (2005-09-14 Petition Decision, p. 5); *inter partes* reexamination 95/000081 (2005-09-20 Decision, p. 6).

⁹⁷⁴ See MPEP § 2686.01.IV.

⁹⁷⁵ See *inter partes* reexamination 95/000093 (2006-07-03 Petition Decision, pp. 9-10).

First, because of the fundamentally different nature of interference proceedings as compared with reexaminations, the Patent Office will not merge an *inter partes* reexamination with an interference proceeding.⁹⁷⁶ However, the interference may take into account actions taken during the prosecution of the *inter partes* reexamination.⁹⁷⁷

The Patent Office may merge an *inter partes* reexamination with a non-broadening reissue application.⁹⁷⁸ The Patent Office has in the past refused to merge an *inter partes* reexamination with a broadening reissue application.⁹⁷⁹ Under the prior practice, where a broadening reissue was co-pending, the usual result was a suspension of the reissue application.⁹⁸⁰ This was true even where broadened claims have been eliminated from the reissue application by amendment, because the Patent Owner still retains the right to present broadened claims.⁹⁸¹

More recently, however, the Patent Office has merged broadening reissue applications with *inter partes* reexaminations, where the *inter partes* reexamination was later-filed. In *inter partes* reexaminations 95/000206 and 95/000270, the Patent Office merged broadening reissue applications with the respective co-pending *inter partes* reexamination, reasoning:

The facts presented in the present instance, however, are distinguishable from those in [a previous decision refusing to merge]. The '537 reissue application is the first filed proceeding. The '206 *inter partes* reexamination proceeding was filed more than eight months after the filing of the '537 reissue application. Further, there has been no request by patent owner to suspend the reissue proceeding. Thus, if merger is not to be carried out and one of the proceedings is suspended, it is the '206 *inter partes* reexamination proceeding which should be suspended. If an earlier-filed broadening reissue application would be the one

⁹⁷⁶ See MPEP § 2686.02.

⁹⁷⁷ See *id.*

⁹⁷⁸ See 37 C.F.R. § 1.991.

⁹⁷⁹ See *In re Allan*, 17 U.S.P.Q.2d 1751, 1752 (Com'r Pat. & Trademarks, April 26, 2004); *inter partes* reexamination 95/000081 (2005-09-20 Decision, p. 6); *inter partes* reexamination 95/000096 (2006-07-17 Petition Decision, pp. 4-5); *inter partes* reexamination 95/000098 (2005-10-21 Petition Decision, pp. 4-5).

⁹⁸⁰ See, e.g., *inter partes* reexamination 95/000070 (2005-09-14 Petition Decision, p. 5); *inter partes* reexamination 95/000081 (2005-09-20 Decision, p. 6); *inter partes* reexamination 95/000098 (2005-10-21 Petition Decision, pp. 4-5).

⁹⁸¹ See *inter partes* reexamination 95/000098 (2005-10-21 Petition Decision, pp. 4-5).

suspended, a requester observing that a patent owner has filed a broadening reissue application could then simply file an *inter partes* reexamination, to stop the earlier-filed reissue application. 35 U.S.C. 314(c) does call for “special dispatch,” however, it also permits the Director to determine that there is good-cause for suspension. Addressing the problem of a requester bringing a reissue application to a halt will provide such good cause, unless there is some way to merge the two proceedings, so that they both can proceed at the same time. Such merger can be effected, if merger guideline requirements can be fashioned to be more specific than was the December 22, 2003 decision in *Allan*, whereby third party requester will be permitted to comment in the merged proceeding only on matters that could have been commented on in the '206 *inter partes* reexamination proceeding. Such merger guideline requirements will be provided in this decision.⁹⁸²

The merged proceeding in *inter partes* reexamination 95/000206 was “conducted on the basis of the rules relating to the broader, reissue application examination, to *the extent it is permissible and practical to do so.*”⁹⁸³ The Third Party Requester was allowed to comment on the application of prior art to broadened claims, but not to argue specifically that the broadened aspect of the claims made the prior art applicable. The Third Party Requester was also not allowed to argue section 112 issues for original claims or broadened aspects of claims, or other matters specific to reissue applications.⁹⁸⁴

An *inter partes* reexamination was merged with a prior-filed reissue application in *inter partes* reexamination 95/000269. In that case, it was not entirely clear whether the reissue application was broadening. The Patent Office distinguished the *Allan* decision, noting:

A review of the third party requester's petition shows that third party requester takes the position that patent owner cannot pursue a broadening reissue application, because patent owner is barred by the limitation in 35 U.S.C. § 251 that precludes the filing of a broadening reissue application more than two years after the issue date of the original patent (for which reissue is sought). However, as noted in Section III, *supra*, this decision does not reach that issue. Any broadening issue that might be present would be an

⁹⁸² *Inter partes* reexamination 95/000206 (2008-05-01 Merger Decision, p. 8); *see inter partes* reexamination 95/000270 (2007-10-24 Decision, pp. 6-7).

⁹⁸³ *Inter partes* reexamination 95/000206 (2008-05-01 Merger Decision, pp. 10-11)(emphasis in original).

⁹⁸⁴ *See inter partes* reexamination 95/000206 (2008-05-01 Merger Decision, pp. 14-15).

issue that can be addressed by the examiner during the examination of the reissue application (whether or not it is merged), and may be appealed should the examiner's decision be adverse to patent owner. Requester, on the other hand, has no statutory right to comment on any broadening issue with respect to the reissue application. It is to be noted that this matter should not have an effect on the merger.⁹⁸⁵

The Patent Office may also refuse to merge proceedings where one of the proceedings is far advanced. In the MPEP, it is explained that a reexamination proceeding will not be merged with another proceeding if a Notice of Intent To Issue A Reexamination Certificate has been mailed.⁹⁸⁶ The Office has also indicated that the requirement of “special dispatch” may preclude merger at earlier stages, such as when the Examiner’s decision is on appeal.⁹⁸⁷ In such cases, the Patent Office may instead choose to suspend a co-pending proceeding.⁹⁸⁸

The Patent Office will also likely refuse to merge two cases if it perceives that the Third Party Requester is attempting to avoid the limitations of 35 U.S.C. § 317. In *inter partes* reexamination 95/000093, the Patent Office refused to merge a co-pending *ex parte* reexamination (filed by the Third Party Requester of the *inter partes* reexamination) with the already suspended *inter partes* reexamination. The Third Party Requester filed an *ex parte* reexamination request on certain claims not in the suspended *inter partes* reexamination, and at approximately the same time petitioned for permission to request a second *inter partes* reexamination on the same claims. The Patent Office denied the petition, suggesting that the Third Party Requester might petition to have the *ex parte* reexamination merged with the suspended *inter partes* reexamination. The Third Party Requester then petitioned to do exactly that, which petition was denied. The Patent Office ruled that a party could not circumvent the provisions of 35 U.S.C. § 317 by filing a subsequent request for *ex parte* reexamination and petitioning for merger with an *inter partes* reexamination.⁹⁸⁹

The latter decision, if treated as doctrinal by the Patent Office, would effectively limit the scope of 37 C.F.R. § 1.989(a) to reexamination proceedings requested by the Patent Owner or third parties other than the Third Party Requester. While new requests for *ex parte*

⁹⁸⁵ *Inter partes* reexamination 95/000269 (2007-11-28 Decision, p. 10).

⁹⁸⁶ See MPEP § 2686.01.IV.

⁹⁸⁷ See, e.g., *inter partes* reexamination 95/000157 (2007-11-01 Decision, p. 5)(suspending a co-pending reexamination where the other had advanced to the appeal stage).

⁹⁸⁸ See *id.*

⁹⁸⁹ See *inter partes* reexamination 95/000093 (2006-07-03 Petition Decision, pp. 9-10).

reexamination may be filed, the procedural aspects of *inter partes* reexamination could not be achieved through merger where they are not otherwise allowed by statute.⁹⁹⁰

3. Procedure In Merged Proceedings

(a) Rights Of Different Requesters

If another reexamination proceeding is merged with an *inter partes* reexamination, the rules of the *inter partes* reexamination will govern the merged proceeding.⁹⁹¹ However, if the requester of a co-pending *ex parte* reexamination is not the Third Party Requester of the *inter partes* reexamination, that requester will have no rights in the merged proceeding.⁹⁹² If two *inter partes* reexaminations are merged, both Third Party Requesters will have a right to comment on Patent Owner responses.⁹⁹³

The Patent Office has on at least one occasion ruled that, if the Third Party Requester of the *inter partes* reexamination is not the requester of the co-pending proceeding, it will not have rights relating to that proceeding. For example, where the Patent Owner responds

⁹⁹⁰ It should be noted that the Patent Office does not consider the *ex parte* reexamination itself as problematic, but rather its later merger with an *inter partes* reexamination. During rulemaking, a comment was submitted requesting that the language of 37 C.F.R. § 1.989 be amended to require a stay of subsequent requests for *ex parte* reexamination, to avoid a possible “end-run” around 35 U.S.C. § 317(a). The Patent Office responded to the comment by stating “[a]s to the suggestion that the subsequent *ex parte* reexamination be stayed, this would be in direct violation of the special dispatch requirement of the *ex parte* reexamination statute. *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). Moreover, the filing of an *ex parte* reexamination request by an *inter partes* third party requester is not an ‘end-run’ of the prohibition of 35 U.S.C. 317(a), because the two proceedings are of a different nature, and thus, the filing of the *ex parte* reexamination is not the same as the filing of a second *inter partes* reexamination. The comment is not adopted and the section is adopted as proposed.” 65 Fed. Reg. No. 76756, 76770-71 (Dec. 7, 2000).

⁹⁹¹ See 37 C.F.R. §§ 1.989(b); *inter partes* reexamination 95/000053 (2005-04-19 Merger Decision p. 3)(“The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination. Pursuant to 37 C.F.R. 1.989(b), the merged proceeding is governed by 37 C.F.R. 1.902 through 1.997. While the rights of any third party requester of the *ex parte* reexamination are governed by 37 C.F.R. 1.510 through 1.560, in this instance, there is no third party requester of the *ex parte* reexamination, since the patent owner requested the *ex parte* reexamination.”).

⁹⁹² See MPEP § 2686; *inter partes* reexamination 95/000005 (2002-12-13 Merger Decision, p. 2).

⁹⁹³ See *inter partes* reexamination 95/000069 (2005-03-14 Notice p. 2).

under 37 C.F.R. § 1.530(b) to an order beginning reexamination, the Third Party Requester is provided no opportunity to comment on the response.⁹⁹⁴

Where proceedings are merged, the Patent Owner is required to maintain the same patent or application in all proceedings. The Patent Office will therefore first require a “housekeeping amendment” to reconcile any differences in the description, drawings or claims between the merged proceedings. The Third Party Requester has no right to comment on a housekeeping amendment.⁹⁹⁵ Afterwards, the Patent Owner will be required to make the same amendments in both cases, and the amendments will be entered in both files.

The *ex parte* reexamination chapter of the MPEP states that the Examiner should issue a final office action if at all possible, to prevent requesters from “hamstringing” a proceeding by filing multiple requests.⁹⁹⁶ Patent Office guidelines issued in 2004 state:

[T]he examiner is directed to, where possible, prepare an Office action at the most advanced point possible for the ongoing (first) proceeding, which in the commenter's scenario is the final rejection stage. If, however, a new issue (e.g., new art, combining the old art a new way, or new evidence) that precludes a final rejection is raised by the later request, a final rejection would not be issued. In that instance, public policy dictates that the substance of the later request be considered and applied in order that only valid patent claims result from the reexamination proceeding, i.e., to prevent the public from being barred from using claimed subject matter for which protection is not warranted.⁹⁹⁷

If a reissue application is merged with an *inter partes* reexamination, the proceeding is conducted according to reissue rules, with the exception that the Third Party Requester may participate as provided for in the rules governing *inter partes* reexamination.⁹⁹⁸ The Third Party Requester’s right to comment, however, is limited to issues within the *inter*

⁹⁹⁴ See *inter partes* reexamination 95/000148 (2008-08-27 Decision, p. 6)(“Further, requester did not file the request for *ex parte* reexamination (i.e, it was filed by the patent owner) and therefore does not have any rights to reply to a patent owner statement. As stated in the merger decision, the rules governing the merged proceedings will be conducted pursuant to the rules of *inter partes* reexamination (i.e., 37 CFR 1.901-1.997)”).

⁹⁹⁵ See *inter partes* reexamination 95/000269 (2008-03-04 Petition Decision, pp. 6-7).

⁹⁹⁶ See MPEP § 2283.III.

⁹⁹⁷ *Changes to Implement the 2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute*, 68 Fed. Reg. 70996, 71003 (Dec. 22, 2003)(applying this section to *inter partes* reexamination).

⁹⁹⁸ See 37 C.F.R. § 1.991.

partes reexamination.⁹⁹⁹ If the reissue is a broadening reissue, then the Third Party Requester is not permitted to comment on the broadening effect of any amendments, or the support for broadening amendments.¹⁰⁰⁰

(b) Filing Of Papers In Merged Proceedings

Each filing in a merged proceeding must have information identifying all merged proceedings, and filed with the number of copies corresponding to the number of merged proceedings. If a *inter partes* reexamination is merged with two *ex parte* reexaminations, for example, each paper would be captioned with the control number, title, Examiner, etc. for all three proceedings.¹⁰⁰¹ Three identical copies would need to be filed. It would not be proper, for example, to file three papers, each having a caption for one of the particular proceedings.¹⁰⁰² The Patent Office has, on at least one occasion, taken parties to task for not filing duplicate copies of papers that were filed electronically.¹⁰⁰³

There are a few instances, however when it be proper to file a paper in fewer than all of the merged proceedings. When proceedings are merged, the Patent Owner may initially need to file a housekeeping amendment in fewer than all of the merged proceedings. The housekeeping amendment is intended to make the claims and specification identical in all proceedings, and must therefore be filed in fewer than all of the proceedings.¹⁰⁰⁴

Where a reissue is merged with an *inter partes* reexamination, there may be certain issues (such as rejection of unamended originally issued claims under 35 U.S.C. § 112) that are only properly in the reissue. In that case, the best procedural course for the Third Party Requester is probably to file papers indicating both proceedings, but omit comments that relate only to the reissue.

(c) Fees In Merged Proceedings

Although two proceedings have been merged, only a single fee need be paid.¹⁰⁰⁵ For example, the filing of an appeal brief in two proceedings would require only one fee to be

⁹⁹⁹ See 37 C.F.R. § 1.991.

¹⁰⁰⁰ See, e.g., *inter partes* reexamination 95/000269 (2008-03-04 Petition Decision, p. 8).

¹⁰⁰¹ See, e.g., *inter partes* reexamination 95/000291 (2008-01-03 Merger Decision, p. 3).

¹⁰⁰² See, e.g., *inter partes* reexamination 95/000049 (2008-08-01 Decision, p. 3); *inter partes* reexamination 95/000053 (2005-04-19 Merger Decision p. 3).

¹⁰⁰³ See *inter partes* reexamination 95/000199 (2008-11-18 Petition Decision, p. 13).

¹⁰⁰⁴ See, e.g., *inter partes* reexamination 95/000049 (2008-08-01 Decision, p. 3).

¹⁰⁰⁵ See MPEP §§ 2686.01.V. and 2686.03.VI.

paid.¹⁰⁰⁶ If a reissue application is merged with an *inter partes* reexamination, the reissue fee schedule governs for excess claims.¹⁰⁰⁷

4. Petition To Sever Merged Proceedings

Several petitions to sever merged *inter partes* reexamination and *ex parte* reexamination proceedings were filed in 95/000020. The Patent Owner had succeeded in defending the validity of six claims in a patent with more than 600 claims before a district court. The Federal Circuit reversed the overall judgment of the district court, in part based on claim construction issues. The parties then settled. The Patent Owner petitioned for severance of the *inter partes* reexamination from the *ex parte* reexamination and termination of the *inter partes* reexamination.

The Patent Office dismissed the petition, noting that severance would leave the '495 *ex parte* reexamination proceeding intact, because there are no estoppel provisions in the *ex parte* reexamination statutes. Therefore, the '495 *ex parte* reexamination proceeding would have to continue separately on all of the claims, while the '020 *inter partes* proceeding would have to continue separately on fewer than all the claims. It is still deemed to be undesirable for the two severed proceedings to continue independently of one another, because there would be overlapping issues.¹⁰⁰⁸

E. Motions To Stay Before District Courts

1. Law Governing Stays Pending *Inter Partes* Reexamination

The author has examined over one hundred district court proceedings with copending *inter partes* reexaminations for stay activity. The results of this examination show that, at a practical level, motions to stay patent litigation pending *inter partes* reexamination differ somewhat from motions to stay pending *ex parte* reexamination. These differences are founded upon 35 U.S.C. §§ 315(c) and 318, and are reflected in the manner in which parties argue and courts decide motions for stay.

The abstract legal framework is similar to that which governs stays pending *ex parte* reexamination. As the Federal Circuit stated in *Ethicon*, “[c]ourts have inherent power to manage their dockets and stay proceedings, including the authority to order a stay pending conclusion of a Patent Office reexamination.”¹⁰⁰⁹ “In deciding whether to grant a stay, the court

¹⁰⁰⁶ See, e.g., *inter partes* reexamination 95/000049 (2008-08-01 Decision, p. 4).

¹⁰⁰⁷ See MPEP § 2686.03.VI.

¹⁰⁰⁸ IPR *inter partes* reexamination 95/000020 (2006-03-20 Petition Decision, p. 7).

¹⁰⁰⁹ *Ethicon, Inc. v. Quigg*, 849 F.2d. 1422, 1426-27 (Fed. Cir. 1988).

must weigh the benefits of the stay against the costs.”¹⁰¹⁰ The decision to stay is discretionary with the district court.¹⁰¹¹ Courts have used three factors in deciding whether to stay a litigation pending *inter partes* reexamination: (1) whether a stay would unduly prejudice or present a clear tactical disadvantage to the non-moving party; (2) whether a stay will simplify the issues in question and the trial of the case; and (3) whether discovery is complete and whether a trial date has been set.¹⁰¹² These three factors are the same as those typically applied when the stay is requested pending *ex parte* reexamination.¹⁰¹³

There are a few differences when the stay is requested pending *inter partes* reexamination, however. For example, section 318 provides a particular right for the “patent owner” to obtain a stay:

Once an order for *inter partes* reexamination of a patent has been issued under section 313, the patent owner may obtain a stay of any pending litigation which involves an issue of patentability of any claims of the patent which are the subject of the *inter partes* reexamination order, unless the court before which such litigation is pending determines that a stay would not serve the interests of justice.¹⁰¹⁴

That is, a Patent Owner is entitled to a stay under 35 U.S.C. § 318 unless the court finds that a stay would not be in the interests of justice.¹⁰¹⁵ The “interests of justice” might allow a court to decline a stay where, for example, where a preliminary injunction is in place.

One question that typically arises during stay litigation is whether section 318 affects the ability of an accused infringer to obtain a stay pending *inter partes* reexamination. Although a number of Patent Owners have argued that section 318 precludes a stay that is opposed by a Patent Owner, the author is unaware of any court that has so held. The closest to

¹⁰¹⁰ See, e.g., *Motson v. Franklin Covey Co.*, No. Civ. 03-1067(RBK), 2005 WL 3465664, *1 (D. N.J. December 16, 2005).

¹⁰¹¹ See *Viskase Corp. v. Am. Nat'l Can Co.*, 261 F.3d 1316, 1328 (Fed. Cir. 2001).

¹⁰¹² See, e.g., *Target Therapeutics, Inc. v. SciMed Life Sys., Inc.*, 33 U.S.P.Q.2d 2022, 2023 (N.D. Cal. 1995).

¹⁰¹³ See, e.g., *IMAX Corp. v. In-Three, Inc.*, 76 U.S.P.Q.2d 1957, 1958 (C.D. Cal. 2005).

¹⁰¹⁴ 35 U.S.C. § 318.

¹⁰¹⁵ See 35 U.S.C. § 318; *Microunity Systems Engineering, Inc. v. Dell, Inc. et al.*, Case No. 2-04-CV-120 (TJW) (E.D.Tex) Order Denying Stay of August 15, 2005, pp. 2-3.

such a holding occurred in *Mars, Inc. v. JCM American, Corp, et al.*, where the court indicated that stays requested by defendants are disfavored in *inter partes* reexamination.¹⁰¹⁶

A fair number of district courts have granted stays on an opposed motion of the accused infringer, thereby at least implicitly holding that section 318 does not preclude granting such a request. At least one district court has expressly confirmed this.¹⁰¹⁷ In *Microunity Systems Engineering, Inc. v. Dell, Inc. et al.*, Judge Ward held:

35 U.S.C. § 318 does not limit or otherwise change this Court's ability to grant a stay requested by a defendant. Instead, 35 U.S.C. § 318 provides that a patent owner has a lower standard to meet in order to obtain a stay pending *inter partes* reexamination than would a defendant. Rather than requiring that the patent owner establish the factors set out above for granting a stay, Section 318 of the Patent Act provides that a plaintiff is *entitled* to a stay pending *inter partes* reexamination 'unless the court before which such litigation is pending determines that a stay would not serve the interests of justice.' See 35 U.S.C. § 318. Thus, Section 318 of the Patent Act does not absolve or otherwise change this Court's discretionary powers to grant a stay to a defendant, but instead provides a patent owner with a greater ability to obtain a stay if one is requested. Thus, when requested by a defendant, this Court's analysis of whether to grant a stay pending *inter partes* reexamination is treated similarly to a request for a stay based on an *ex parte* reexam.¹⁰¹⁸

The Federal Circuit confirmed this interpretation in *Procter & Gamble Co. v. Kraft Global, Inc.*¹⁰¹⁹ The court stated:

§ 318 must be read as enabling a patentee to obtain a stay of district court proceedings more readily than it could otherwise when its patent is subjected to *inter partes* reexamination by the

¹⁰¹⁶ See *Mars, Inc. v. JCM American, Corp, et al.*, Case No. 05-3156 (RBK) (D. N.J.) Order Denying Stay of April 27, 2006, p. 3.

¹⁰¹⁷ See *Microunity Systems Engineering, Inc. v. Dell, Inc. et al.*, Case No. 2-04-CV-120 (TJW) (E.D.Tex) Order Denying Stay of August 15, 2005, pp. 2-3.

¹⁰¹⁸ *Id.*

¹⁰¹⁹ 2008 WL 5101824 (Fed. Cir. 2008) ("The district court rejected this argument, reasoning that '[a]lthough true that § 318 does not expressly provide for an automatic stay of parallel district court proceedings, the statute in no way impacts the inherent powers of the court to control the litigation before it, and to grant a stay in the interests of justice when so required.' *Stay Order* at 2. We agree with the district court.").

PTO. A holding to the contrary would rest on a conclusion that Congress intended to strip district courts of the full scope of their inherent power with no mention of that effect. Thus, when an order granting *inter partes* reexamination issues, a patentee may move for a stay under § 318, but the defendant may nevertheless seek a stay under the district court's inherent power.¹⁰²⁰

The estoppel provisions affecting *inter partes* reexamination can also affect a court's decision on a motion for stay. Under section 315(c), a Third Party Requester may not raise any defense of invalidity against a claim allowed in the reexamination that it raised or could have raised before the Office.¹⁰²¹ The Third Party Requester is also precluded from taking factual positions inconsistent with any fact determined by the Patent Office, unless proved to be erroneous based on information unavailable during reexamination.¹⁰²² At least one court has found that the estoppel provisions mean that "an *inter partes* reexamination can have no other effect but to streamline ongoing litigation."¹⁰²³ Another district court judge in the same court, however, has noted that this is not the case where there are multiple defendants, at least one of whom is not a Third Party Requester.¹⁰²⁴

In *Anascope Ltd. v. Microsoft Corp.*,¹⁰²⁵ the Eastern District of Texas (Clark, J.) was presented with twelve patents, some of which were the subject of requests for *ex parte* reexamination, and some of which were the subject of requests for *inter partes* reexamination. The Court stayed the case for a subset of the patents subject to *inter partes* reexamination, but did not stay the case for any of the patents subject to *ex parte* reexamination, finding:

the possibility of simplification of issues resulting from reexamination weigh in favor of granting stays as to the '791, '205 and '415 patents. These benefits are outweighed by the burdens of delay and potential unfair prejudice to Plaintiff as to the other patents. Additionally, as to the patents for which *ex parte*

¹⁰²⁰ *Procter & Gamble Co. v. Kraft Global, Inc.*, 2008 WL 5101824, *5 (Fed. Cir. 2008).

¹⁰²¹ See 35 U.S.C. § 315(c); see also section I.D.4, *supra*.

¹⁰²² See AIPA § 4607; see also section I.D.5, *supra*.

¹⁰²³ *Echostar Technologies Corp. v. Tivo, Inc., et al.*, Case No. 5:05-CV-81 (DF), Order of July 14, 2006 Granting Stay (E.D. Tex.).

¹⁰²⁴ See *Texas MP3 Technologies, Ltd. v. Samsung Electronics Co., Ltd.* 2007 WL 3219372, *2 (E.D. Tex., Oct. 30, 2007)(Ward, J.).

¹⁰²⁵ 475 F.Supp.2d 612 (E.D. Tex. 2007).

reexamination has been requested, the likelihood of simplification is much less.¹⁰²⁶

A district court may not grant a stay where there is an outstanding motion for preliminary injunction.¹⁰²⁷ The grant of the stay effectively denies the preliminary injunction motion by rendering it moot. Instead, the court must consider the factors required in considering preliminary injunctions.¹⁰²⁸

2. Arguments Typically Made

As discussed above, courts usually consider three factors in deciding whether to stay a litigation pending reexamination: (1) whether a stay would unduly prejudice or present a clear tactical disadvantage to the non-moving party; (2) whether a stay will simplify the issues in question and the trial of the case; and (3) whether discovery is complete and whether a trial date has been set.¹⁰²⁹ The parties will typically spend a fair amount of energy arguing the first and second factors.

(a) Arguments On Prejudice

The question of prejudice is the least consistently treated of the three. Under one view “prejudice and tactical advantage” are limited to the parties’ ability to present their cases.¹⁰³⁰ An example of prejudice in this sense might be a party’s inability to later present evidence that is likely to become unreliable with time, due to deteriorating physical evidence, fading memories, or the likely incapacity of a witness.

¹⁰²⁶ See *Anascape Ltd. v. Microsoft Corp.*, 475 F.Supp.2d 612, 617 (E.D. Tex. 2007).

¹⁰²⁷ See *Procter & Gamble Co. v. Kraft Global, Inc.* Case No. 2008-1105 (Fed. Cir. Dec. 5, 2008).

¹⁰²⁸ See *Procter & Gamble Co. v. Kraft Global, Inc.* Case No. 2008-1105 (Fed. Cir. Dec. 5, 2008).

¹⁰²⁹ See, e.g., *Target Therapeutics, Inc. v. SciMed Life Sys., Inc.*, 33 U.S.P.Q.2d 2022, 2023 (N.D. Cal. 1995).

¹⁰³⁰ See *Echostar Technologies Corp. v. Tivo, Inc., et al.*, Case No. 5:05-CV-81 (DF) Order of July 14, 2006 Granting Stay (“First, the Court is not persuaded that a stay would unduly prejudice Plaintiff. Although Plaintiff correctly notes that Defendants have not acted with dispatch in seeking reexamination and that Plaintiff has undoubtedly pursued an extremely burdensome discovery program, Plaintiff cannot say that its future costs associated with this litigation will be affected by the grant or denial of a stay.”); *Grober v. Mako Products, Inc., et al.*, Case No. 04-8604 (NM) (C.D. Cal.) Order of August 9, 2005 Granting Stay.

In another view, prejudice and tactical disadvantage are extended to a broader business or litigation context between the parties.¹⁰³¹ For example, a Patent Owner might argue that it does not have the funds to survive an extended period without a resolution in the case, or that a stay of litigation will allow the Third Party Requester an advantage by proceeding against the Patent Owner in a related counter litigation.¹⁰³²

When presenting a motion to stay, Patent Owners routinely make a number of arguments to establish prejudice. The Patent Owner will typically argue that a defendant waited too long in filing its request,¹⁰³³ and that the Patent Owner has invested a significant amount in the litigation. The Patent Owner will usually bring up the multi-year delay that can be caused by reexamination. If possible, the Patent Owner will emphasize specific ways in which its ability to present its case will deteriorate with time or in which its case would be prejudiced by a stay at the current procedural juncture.¹⁰³⁴ If that is not possible, the Patent Owner may argue that it will be generally prejudiced by the passage of time.¹⁰³⁵ The Patent Owner may also argue that the Third Party Requester should not be allowed to continue infringement, because the Patent Owner will lose market share and customer goodwill in ways that will be difficult to compensate. If there are allegations of inequitable conduct, the Patent Owner may argue that it has the right to

¹⁰³¹ See, e.g., *Mars, Inc. v. JCM American, Corp., et al.*, Case No. 05-3156 (RBK) (D. N.J.) Order of April 27, 2006 Denying Stay (court explicitly acknowledges tactical disadvantage based on co-pending litigation); *Hasabit Belting, Inc. v. Rexnord Industries, Inc., et al.* Case No. 03-185-JJF (D.Del) Order of September 22, 2005 Granting Stay p. 1 (finding persuasive that the defendant agreed not to sell the accused product during the stay period).

¹⁰³² But see *Echostar Technologies Corp. v. Tivo, Inc., et al.*, Case No. 5:05-CV-81 (DF) Order of July 14, 2006 Granting Stay (“the Court does not weigh in on the tactical effects on separate litigation. This matter stands on its own.”).

¹⁰³³ See, e.g., *Remington Arms Co., Inc. v. Modern Muzzleloading, Inc.*, 1998 WL 1037920, *3 (M.D.N.C. 1998)(three month delay in filing reexamination was too long).

¹⁰³⁴ See, e.g., *Polycom, Inc., et al. v. Codian, Ltd., et al.*, Case No. 2:05-CV-520 (DF) Order of April 23rd, 2007 Denying Stay, p. 3 (“A stay would function as a tactical disadvantage to Polycom since several of the reexamination requests were only filed after the parties had served their preliminary infringement contentions and Polycom had filed its opening claim construction brief.”).

¹⁰³⁵ See, e.g., *Microunity Systems Engineering, Inc. v. Dell, Inc. et al.*, Case No. 2-04-CV-120 (TJW) (E.D.Tex) Order Denying Stay of August 15, 2005, p. 4 (“Finally, the Court is persuaded that a stay pending reexamination would unduly prejudice MicroUnity. Due to the inherent delay in reexamination proceedings, the opportunities for numerous appeals, and the apparent conflict between the parties, it appears likely that if a stay were granted, it could take more than four to five years before this case would be back before this Court.”); see also *Texas MP3 Technologies, Ltd. v. Samsung Electronics Co., Ltd.* 2007 WL 3219372, *1 (E.D. Tex., Oct. 30, 2007).

clear its name in a timely manner. If the Third Party Requester filed a declaratory judgment action, the Patent Owner will use this to show that the Third Party Requester has been manipulating the courts for its own tactical advantage.¹⁰³⁶

A Third Party Requester may argue that a Patent Owner will not be prejudiced because, if infringement is later found, damages will have continued to accrue during the stay. A Third Party Requester will also argue, where possible, that the Patent Owner has been dilatory in litigation (using any extensions requested by the Patent Owner). If the Patent Owner has failed to move for a preliminary injunction, a Third Party Requester may use this as evidence that a delay in remedy would not damage the Patent Owner. A Third Party Requester may further argue based on the competitive relationship between the parties, if the Patent Owner is not a direct competitor of the Third Party Requester.¹⁰³⁷ A Third Party Requester may emphasize the “special dispatch” requirement of *inter partes* reexamination,¹⁰³⁸ as well as the Patent Office’s promise to further expedite *inter partes* reexaminations (even beyond the requirement of *special dispatch*) with co-pending, stayed litigations.¹⁰³⁹ Finally, the Third Party Requester may argue that the *inter partes* reexamination will save resources for both parties, as was intended by Congress.¹⁰⁴⁰

(b) Arguments On Simplification

The parties will also trade considerable argument over whether a conclusion in the reexamination would simplify issues before the court. A Third Party Requester will typically argue that reexamination will likely reduce the number of claims at issue or narrow the scope of the claims. This argument is often made using statistics. Because statistics for *inter partes* reexaminations have been difficult to find, many such arguments are based on reported results of *ex parte* reexaminations.¹⁰⁴¹

¹⁰³⁶ See, e.g., *Dusa Pharmaceuticals, Inc., et al. v. River’s Edge Pharmaceuticals, LLC*, Case No. 06-1843 (SRC) (D. N.J.) Order of September 8, 2006.

¹⁰³⁷ See, e.g., *Alza Corp. v. Wyeth*, Case No. 9:06 CV 156 (E.D. Tex.) Order of November 21, 2006 Granting Motion to Stay.

¹⁰³⁸ See 35 U.S.C. § 314(c).

¹⁰³⁹ See MPEP §§ 2661 and 2686.04.I.

¹⁰⁴⁰ See 145 Cong. Rec. E1789-E1790 (Aug. 5, 1999) (stating that the *inter partes* reexamination statute "is intended to reduce expensive patent litigation.").

¹⁰⁴¹ See, e.g., *Output Technology Corp. v. Dataproducts Corp.*, 1991 WL 332547, 22 U.S.P.Q.2d 1072, 1074 (W.D. Wash. Nov. 25, 1991)(noting that 77% of reexaminations lead to cancelled or amended claims); *TAP Pharmaceuticals v. Atrix Labs*, 2004 U.S. Dist. LEXIS 2684, *6, 20 USPQ2d 1319 (N.D. Ill. 2004)(same); *Target Therapeutics v. SciMed Life Sys., Inc.*, 33 USPQ2d 2022, 2023 (N.D. Cal. 1995)(same).

The Third Party Requester is also likely to cite the estoppel provisions 35 U.S.C. § 315(c) as necessarily simplifying the litigation by removing issues that “could have been raised” in the *inter partes* reexamination.¹⁰⁴² This may be combined with an emphasis on the complexity of the issues, for which the Patent Office’s expertise would be useful,¹⁰⁴³ and the possibility that amendments to the claims could further complicate parallel litigation.¹⁰⁴⁴ The Third Party Requester may also argue that reducing issues will make settlement more likely.¹⁰⁴⁵

Patent owners will counter such arguments first by pointing out that *inter partes* reexamination statistics have not been well-developed, and that *ex parte* reexamination statistics indicate that at least some claims are likely to survive.¹⁰⁴⁶ Patent owners will point out that certain types of invalidity defenses may not be submitted to the Patent Office in an *inter partes* reexamination proceeding.¹⁰⁴⁷ The estoppel provisions will not reduce the amount of discovery,

¹⁰⁴² See, e.g., *Echostar Technologies Corp. v. Tivo, Inc., et al.*, Case No. 5:05-CV-81 (DF) July 14, 2006 Order Granting Stay (“However, and of particular import here, the statute imposes estoppel restraints on a third party requester. That is, a third-party requester is estopped from relitigating the same issue ‘which the third-party requester raised or could have raised during the *inter partes* reexamination proceedings.’ *Id.* § 315(c); see also *Middleton, Inc. v. Minnesota Mining and Mfg. Co.*, 2004 WL 1968669, *10 (S.D. Iowa, 2004). In addition, the third-party requester will be estopped from seeking review of factual determinations made in the *inter partes* reexamination. *Id.* Thus, an *inter partes* reexamination can have no other effect but to streamline ongoing litigation. For these reasons, courts have an even more compelling reason to grant a stay when an *inter partes* reexamination is proceeding with the same parties, which is precisely the case here.”).

¹⁰⁴³ See, e.g., *Acco Brands, Inc. v. PC Guardian Anti-Theft Products, inc. et al.*, Case No. C 04-03526 SI (N.D. Cal., Order Granting Defs Motion To Stay, Jan. 19, 2006) (Illston, J.); *United Sweetener USA, Inc. v. Nutrasweet Co.*, 766 F. Supp. 212, 217 (D. Del. 1991) (granting stay pending reexamination and finding that “the administrative review scheme set up by Congress will help sharpen and simplify the issues ... before the [] patent once again darkens our door”); *Echostar Technologies Corp. v. Tivo, Inc., et al.*, Case NO. 5:05-CV-81 (DF) July 14, 2006 Order Granting Stay, pp. 6-7.

¹⁰⁴⁴ See, e.g., *Bausch & Lomb Inc. v. Alcon Lab., Inc.*, 914 F. Supp. 951, 953 (W.D.N.Y. 1996) (“If this Court were to deny the stay and proceed to trial, it is possible that the time, resources, and significant efforts of all those involved in such a trial would be wasted.”); *Clintec Nutrition Co. v. Abbott Laboratories*, 1995 WL 228988, at *3 (N.D. Ill. 1995).

¹⁰⁴⁵ See, e.g., *Sulzer Inc. v. Black Clawson Co.*, 1995 WL 363440, at *1 (S.D.N.Y. 1995).

¹⁰⁴⁶ See *Soverain Software LLC v. Amazon.com*, 356 F. Supp. 2d 660, 662 (E.D. Tex. 2005) (Davis, J.) (“[while] reexamination would substantially simplify this case if the PTO finds that all allegedly infringed claims of any of the patents are canceled, this historically happens in only 12% of reexaminations requested by a third party.”).

¹⁰⁴⁷ See 37 C.F.R § 1.906.

it will be argued, because the Third Party Requester will still be allowed to use prior art that it could not have raised in the *inter partes* reexamination.¹⁰⁴⁸ To search for this prior art, the Third Party Requester may request the same type of discovery from the Patent Owner. Furthermore, if there is an allegation of inequitable conduct in the case, the Patent Owner may argue that discovery of the Patent Owner will not be limited. As for the likelihood of settlement, the Patent Owner will argue that a trial setting is more likely to induce settlement than a stay of litigation where the Third Party Requester (so it will be argued) has nothing to lose.¹⁰⁴⁹

3. Success Rate Of Motions To Stay

The author has found some perhaps surprising results for motions to stay pending *inter partes* reexaminations. In more than half of the approximately one hundred cases examined, neither party moved for a stay. In those cases where there was a motion for stay, the motion was either unopposed, joint, or on behalf of the Patent Owner in about half of the cases.

Where the defendant / accused infringer moved for a stay and was actively opposed by the Patent Owner (24 total cases), courts granted stays in about half of the cases. The breakdown by jurisdiction is as follows:

District	Number of Opposed Motions For Stay Pending <i>inter partes</i> reexamination	Number of Motions Granted	Number of Motions Denied	Number of Motions Not Decided
C.D.Cal.	1	1	0	
D.Ariz.	1	1	0	
D.Col.	2	1	0	1
D.Del.	3	2	1	
D.Mass.	1	0	1	
D.N.J.	2	0	2	
D.N.Mex.	1	0	1	
D.Utah	1	0	1	
E.D.Mich.	1	0	0	1
E.D.Tex.	5	2	3	
E.D.Wis.	1	1	0	
N.D.Cal.	2	1	0	1
N.D.Ga.	1	1	0	
S.D.Cal.	1	0	1	

¹⁰⁴⁸ See 35 U.S.C. § 315(c).

¹⁰⁴⁹ As one Eastern District of Texas court observed in denying a motion for stay pending reexamination, “[f]irm trial settings resolve cases and reduce litigation costs.” *Sovereign Software*, 356 F. Supp. 2d at 663.

W.D.Tenn.	1	1	0	
TOTALS	24	11	10	3

The author’s review of the opinions in these cases indicates that they are highly district and judge-dependent. Parties considering stay litigation are therefore well advised to research the particular proclivities of the potential judges to which a case might be assigned before filing.

F. Settlement

If the parties settle co-pending litigation, there may be no further motivation for the Third Party Requester to continue with the *inter partes* reexamination. While there is no direct mechanism in the rules to allow the Third Party Requester to terminate the *inter partes* reexamination,¹⁰⁵⁰ there are a number of ways that a Patent Owner and Third Party Requester through cooperation can effectively end the *inter partes* reexamination or limit the Third Party Requester’s participation.

1. Terminating The Reexamination Under Section 317(b)

One way to terminate the *inter partes* reexamination is to have the Third Party Requester stipulate (via, e.g., an F.R.C.P. 54 motion) that it has failed to prove invalidity. Once a judgment becomes non-appealable, the Patent Owner may petition under 37 C.F.R. § 1.182 to terminate the proceedings.¹⁰⁵¹

This procedure was apparently carried out in connection with *inter partes* reexaminations 95/000019 and 95/000231.¹⁰⁵² In *inter partes* reexamination 95/00019 a co-pending litigation was settled, and the court entered a stipulated judgment that stated “[The patent] is valid and enforceable.”¹⁰⁵³ The Third Party Requester filed a notice in the *inter partes*

¹⁰⁵⁰ See MPEP § 2610; see also, e.g., *inter partes* reexamination 95/000117 (2007-06-21 Letter)(the Third Party Requester attempted to withdraw the request for reexamination, but the Patent Office issued a reexamination certificate anyway).

¹⁰⁵¹ See, e.g., *inter partes* reexamination 95/000093 (2007-06-05 Petition Decision); *inter partes* reexamination 95/000147 (2007-11-19 Show Cause Order, pp. 5-6).

¹⁰⁵² See *inter partes* reexamination 95/000019 (2003-08-20 Decision, pp. 1-4); *inter partes* reexamination 95/000231 (2007-10-12 Petition Decision, p. 5).

¹⁰⁵³ See *Theory3, Inc., v. Liteglow Industries, Inc.*, Case No, 02-80995-CIV, Consent Final Judgment and Permanent Injunction, entered July 24, 2003 (S.D. Fla. 2003).

reexamination entitled “Notification of Prior or Concurrent Proceedings in Inter Partes Reexamination Under 37 C.F.R. § 1.985.”¹⁰⁵⁴ In the notice, the Third Party Requester explained

The final decision states that Requestor, Liteglow Industries, Inc., has not sustained its burden of proving the invalidity of any patent claim of U.S. Patent No. 6,467,939. The Order is from the United States District Court for the Southern District of Florida in Case No, 02-80995-CIV-Middlebrooks/Johnson The Court’s Order is attached hereto. Accordingly, the *Inter Partes* Reexamination Control No. 95/000,019 may not be maintained by the U.S. Patent and Trademark Office, 35 U.S.C. §317(b).¹⁰⁵⁵

The Third Party Requester also requested a refund of the *inter partes* reexamination filing fee, on the basis that the Patent Office had not yet found that a substantial new question of patentability existed.¹⁰⁵⁶ The Patent Office vacated the *inter partes* reexamination without a petition three weeks later, denying the request to refund the filing fee.¹⁰⁵⁷

This approach is not likely to work for *ex parte* cases, because there are no express estoppel provisions.¹⁰⁵⁸

2. Vacating The Reexamination Under 37 C.F.R. § 1.913(a).

Certain agreements between a Third Party Requester and a Patent Owner could result in “privy” status for a Third Party Requester. In such a case, the Patent Owner might have an argument for vacating the reexamination under 37 C.F.R. 1.913(a), which states that “any person other than the Patent Owner or its privies may...file a request for *inter partes* reexamination”.¹⁰⁵⁹

¹⁰⁵⁴ See Consent Final Judgment and Permanent Injunction, entered July 24, 200395/000019 (2003-07-28 Notification, p. 1).

¹⁰⁵⁵ See Consent Final Judgment and Permanent Injunction, entered July 24, 2003; *inter partes* reexamination 95/000019 (2003-07-28 Notification, p. 1).

¹⁰⁵⁶ See *inter partes* reexamination 95/000019 (2003-07-28 Notification, p. 2).

¹⁰⁵⁷ See Consent Final Judgment and Permanent Injunction, entered July 24, 2003; *inter partes* reexamination 95/000019 (2003-08-20 Decision, pp. 1-4)(stating that the Patent Office did not have the discretion to refund the filing fee if no determination had been made).

¹⁰⁵⁸ See, e.g., *inter partes* reexamination 95/000020 (2006-03-20 Petition Decision, p. 7).

¹⁰⁵⁹ 37 C.F.R. § 1.913(a).

The author has not seen anyone attempt this approach yet. Various types of licenses, joint ventures, agency relationships, mergers, acquisitions, etc. could arguably give rise to privity.¹⁰⁶⁰ It is, however, unclear whether 37 C.F.R. 1.913(a) would require vacating the reexamination should a Third Party Requester later become a privy of the Patent Owner. The Patent Office has previously threatened to vacate proceedings where there was no clear identification of the real party in interest, which arguably prevented the Patent Office from determining whether the requirements of 37 C.F.R. 1.913(a) were met.¹⁰⁶¹ In the case being contemplated here, however, the initial request presumably complied with the rules, because the Third Party Requester was not a privy at the time of the request.

3. Effectively Making The Proceedings *Ex Parte*

Of course, a Third Party Requester may also simply refuse to participate in an *inter partes* reexamination, which effectively converts the proceeding into an *ex parte* reexamination. If the real party in interest indicates in a notice to the Patent Office that that it will not participate further in the *inter partes* reexamination, the Patent Office may grant a petition to waive 37 C.F.R. § 1.955 and allow *ex parte* interviews on the merits with the Examiner.¹⁰⁶²

4. Moving Immediately To Appeal

If the parties are satisfied with the current status of the claims before the Examiner, they may also request that the Patent Office issue an expedited Right Of Appeal Notice.¹⁰⁶³ In order to obtain an expedited notice, the Patent Owner and Third Party Requester must submit a stipulated statement that all issues are ripe for a final action, and must describe the

¹⁰⁶⁰ *C.f.* section V.B.3, *supra*, discussing the Patent Office's refusal to honor a forum selection clause, and stating that preventing a licensor from requesting reexamination would be contrary to the policy expressed in *Lear v. Adkins*.

¹⁰⁶¹ *See, e.g., inter partes* reexamination 95/000221 (2008-10-08 Petition Decision, p. 5).

¹⁰⁶² *See* section I.C.3(b), *supra*; *inter partes* reexamination 95/000142 (2007-04-17 Petition Decision, p. 2) (“In this instance, the RPI for the third party requester...has stated on the record that it will not further participate in the '142 *inter partes* reexamination proceeding in way, including in any interview with the examiner. [Requester] has also stated that it supports a waiver of 37 C.F.R. 1.955 that is presently requested by patent owner. Thus, only a single party (patent owner) will now participate in the '142 *inter partes* reexamination proceeding, and any interview that might be permitted in the proceeding. Therefore, permitting an interview to be conducted at this point in the '142 *inter partes* reexamination proceeding is not anticipated to potentially hinder, the ability of the Office to conduct the '142 *inter partes* reexamination proceeding with special dispatch, but rather may well assist the Office in expeditiously resolving the proceeding.”).

¹⁰⁶³ *See* 37 C.F.R. § 1.953(b); MPEP § 2671.III.(D).

issues for appeal.¹⁰⁶⁴ In that case, the Patent Office can issue a Right of Appeal Notice directly. There is no requirement that the Patent Owner or Third Party Requester actually participate in any appeal.

5. Statutory Disclaimer

In extreme cases, the *inter partes* reexamination may also be terminated by the Patent Owner filing a statutory disclaimer of all claims under reexamination.¹⁰⁶⁵

XII. Appeal

A. Governing Rules

Appeals to the Board in *inter partes* reexamination proceedings are governed by 37 C.F.R. §§ 41.61 – 41.77, and described in MPEP §§ 2674 – 2683 (not MPEP 1200). Although 37 C.F.R. § 41.1 states that “Part 41 governs proceedings before the Board of Patent Appeals and Interferences”, it is clear that the rules of Part 41 are actually invoked with the issuance of a Right of Appeal Notice.¹⁰⁶⁶ However, the case remains with the Examiner until all briefs are received.¹⁰⁶⁷ Likewise, the provisions of 37 C.F.R. §§ 1.901 *et. seq.* continue to apply during the course of the *inter partes* reexamination proceeding.¹⁰⁶⁸

B. General

1. Appeal Process

Appeal procedure in *inter partes* reexaminations differs markedly from *ex parte* appeals. In an *ex parte* appeal, the appellant presumably does not agree with the Examiner’s decision for all issues on appeal. This means that the briefing can take on an *inter-partes* character, with the Appellant and Examiner being in opposition and trading responses and replies.

In an *inter partes* reexamination, both the Patent Owner and the Third Party Requester have the right to initiate or participate in appeals. When the Examiner is added, there

¹⁰⁶⁴ See, e.g., *inter partes* reexamination 95/000058 (2008-06-17 Office Action, p. 48).

¹⁰⁶⁵ See, e.g. *inter partes* reexamination 95/000168.

¹⁰⁶⁶ See, e.g., 37 C.F.R. § 41.61(a)(1) (“ Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the owner may appeal to the Board....”).

¹⁰⁶⁷ See section XII.L.1, *infra*.

¹⁰⁶⁸ See, e.g., 37 C.F.R. § 1.959 *et seq.*; *inter partes* reexamination 95/000087 (2007-10-17 Petition Decision, p. 3).

are at least¹⁰⁶⁹ three parties that may be arrayed in a state of triangular opposition. The various notices and briefings must take this complexity into account.

The appeal proceeding begin with the filing of Notices of Appeal and Notices of Cross Appeal. Both parties may be Appellants. Appellants' Briefs are filed, followed by Respondents' Briefs, followed by an Examiner's Answer, followed by Rebuttal Briefs. Parties can be given one extra month for making timely, but deficient filings. After all Rebuttal Briefs have been filed, the case is transferred to the Board for a decision. Parties may petition for rehearing, and then file an Appeal with the Court of Appeals for the Federal Circuit.

2. Timing Of Papers

The deadlines for submitting are tricky, in that the various time periods for taking actions have different triggers. For example, the deadline for filing a Notice of Appeal is tied to the mailing date of the Right of Appeal Notice.¹⁰⁷⁰ The deadline for filing a Notice of Cross Appeal is tied to the service date of the relevant Notice of Appeal.¹⁰⁷¹ The deadline for filing an Appellant's Brief however, is either tied to the filing date of the last Notice or Cross Notice, or the expiration of the period in which one could have been filed.¹⁰⁷² The deadline for filing a Respondent's Brief is again tied to the service date of the Appellant's Brief.¹⁰⁷³

Deadlines for filing on appeal are, with a lone exception, non-extendable. Because the prohibition on extension is not statutory, however, it is possible to petition under 37 C.F.R. §§ 1.182 and 1.183 for the extension of time and a waiver of the particular rule prohibiting extension of time, respectively.¹⁰⁷⁴

In *inter partes* reexamination 95/000020, for example, the Patent Owner requested an additional month to file its rebuttal brief. The Patent Office granted the request, noting that:

The facts of this particular proceeding include: (1) there are seven other reexamination proceedings that are directed to patents that are owned by patent owner, which patents are directed to subject

¹⁰⁶⁹ There may be more than three parties if the patent has co-owners or proceedings having different Third Party Requesters are merged.

¹⁰⁷⁰ See 37 C.F.R. § 41.61(a).

¹⁰⁷¹ See 37 C.F.R. § 41.61(b).

¹⁰⁷² See 37 C.F.R. § 41.66(a).

¹⁰⁷³ See 37 C.F.R. § 41.66(b).

¹⁰⁷⁴ See *inter partes* reexamination 95/000020 (2007-09-21 Petition Decision, p. 4); *inter partes* reexamination 95/000153 (2008-10-23 Petition Decision, p. 1).

matter related to the subject matter of the present '592 patent; (2) patent owner will have two months in which to file a brief that is responsive to an examiner's answer in those seven proceedings, but is limited, by rule, to one-month in which to file a brief responsive to the examiner's answer in the present merged proceeding; and (3) the examiner's answer is lengthy, due in large part to the complexity of the involved technology. Based on these facts, and the present fact-situation taken as a whole, it is deemed that justice requires waiver of 37 CFR 41.66(d) to permit patent owner to request an extension of the one-month period provided by 37 CFR 41.66(d).¹⁰⁷⁵

It is not clear whether the Patent Office would retroactively provide a waiver and extension of time.

3. Subject Matter

Patent Owners and Third Party Requesters have different things which may be appealed. For Patent Owners, 35 U.S.C. § 134(b) states that “[a] patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the primary Examiner to the Board of Patent Appeals and Interferences....”.¹⁰⁷⁶ Section 315(b), however, states it somewhat differently:

The patent owner involved in an inter partes reexamination proceeding under this chapter— (1) may appeal under the provisions of section 134 and may appeal under the provisions of sections 141 through 144, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent....¹⁰⁷⁷

Section 134 states that the Patent Owner may appeal a “final rejection”, whereas section 315(b) states that the Patent Owner may appeal “any decision adverse to the patentability of [a claim]”. Rule 41.61(a)(1) uses the “final rejection” language of section 134.¹⁰⁷⁸ So does Rule 41.61(b)(1), relating to a Patent Owner Notice of Cross Appeal. The MPEP uses the “final

¹⁰⁷⁵ *Inter partes* reexamination 95/000020 (2007-09-21 Petition Decision, p. 4).

¹⁰⁷⁶ 35 U.S.C. § 134(b).

¹⁰⁷⁷ 35 U.S.C. § 315(b).

¹⁰⁷⁸ *See* 37 C.F.R. § 41.61(a)(1).

rejection” language when referring to Notices of Appeal,¹⁰⁷⁹ but the “adverse to patentability” language when discussing the Notice of Cross Appeal.¹⁰⁸⁰

Because “a decision adverse to patentability” would seem to be a bit broader than “final rejection”, there is at least some basis in the governing law to allow a Patent Owner to appeal where a claim is held patentable for the wrong reasons. The Patent Owner might be able to argue that the Examiner’s decision was adverse to the patentability of other claims in the case, or other claims pending elsewhere before the office.

A Third Party Requester may also appeal from certain decisions of the Examiner. As the Board has previously stated, an appeal by the Third Party Requester places it “in the unaccustomed position of having both the burden of showing error in the Examiner’s decision and the ultimate burden of proof on the question of patentability.”¹⁰⁸¹

A Third Party Requester may appeal from “any final decision favorable to the patentability of [a claim]”.¹⁰⁸² The language is used consistently throughout the statutes and rules. Rule 41.61(a)(2), however, makes clear that this phrase includes “any final decision not to make a proposed rejection.”¹⁰⁸³ This probably includes cases where the claim is rejected on grounds other than those desired by the Third Party Requester, because those other grounds could be reversed during the appeal.

Note that Rule 41.61(a)(2) requires that the rejection have been “proposed”. This means that, if the Examiner makes but then withdraws his or her own rejection, the Third Party Requester should propose the rejection in its next set of comments.¹⁰⁸⁴ If an Examiner refuses to adopt or withdraws a Third Party Requester-proposed rejection, the Third Party Requester should for the sake of caution maintain the proposed rejection in its comments.

4. Miscellaneous Formal Matters Applying To All Briefs

¹⁰⁷⁹ See MPEP § 2674.

¹⁰⁸⁰ See MPEP § 2674.01.

¹⁰⁸¹ *Inter partes* reexamination 95/000009 (2007-03-30 Board Decision, p. 2).

¹⁰⁸² 35 U.S.C. § 315(b)(1); *see also* 35 U.S.C. § 134(c); 37 C.F.R. § 41.61(a)(2); MPEP §§ 2674 – 2674.01.

¹⁰⁸³ 37 C.F.R. § 41.61(a)(2).

¹⁰⁸⁴ See MPEP § 2674; 37 C.F.R. § 41.67(c)(1)(vi) (“No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.”).

Three copies of all briefs should be filed. This was a requirement of old rule 1.192(a), for the purpose of providing one copy to each Board member. The requirement was eliminated from the rules in 2004, but was unfortunately carried over in MPEP § 2675.02.¹⁰⁸⁵

All briefs must be served and contain a proper certificate of service.¹⁰⁸⁶

Briefs should be filed with the CRU, using the *inter partes* reexamination mail stop. The Examiner has jurisdiction over the case until all briefs are filed.

5. Results Of Early Appeals

At the time of this writing, at least four Board decisions in *inter partes* reexaminations had issued.¹⁰⁸⁷ Thus far, the results indicate substantial disagreements between the Board and the CRU Examining corps. In particular, the Board has been active in reversing Examiners and proposing new grounds of rejection. Because this allows a limited re-opening of prosecution,¹⁰⁸⁸ it has resulted in some delay of appealed proceedings.

In *inter partes* reexamination 95/000006, the Board reversed the Examiner's anticipation and obviousness rejections, and entered new prior art rejections of its own. The Examiner's rejection of a new claim for improper broadening under 35 U.S.C. § 314 was also reversed, but an indefiniteness rejection of the same claim upheld.¹⁰⁸⁹

In *inter partes* reexamination 95/000009, the Board upheld the Examiner's finding that the claims were not anticipated, but reversed the Examiner's finding that the claims were not obvious. The case was remanded for further proceedings on the new ground of rejection, but the Patent Owner did not further prosecute the reexamination.¹⁰⁹⁰ In *inter partes*

¹⁰⁸⁵ See MPEP § 2675.02 (“Where an appellant or respondent brief does not comply with all the requirements of 37 CFR 41.67(a) and (c) or 37 CFR 41.68(a) and (b), respectively, such as missing fee or missing portion of the fee, a missing signature, inappropriate signature, less than three copies of the brief, no proof of service on a party; the appropriate party should be notified of the reasons for non-compliance and provided with a nonextendable period of one month within which to file an amended brief.”).

¹⁰⁸⁶ For more details on certificates of service, see section IV.B, *supra*.

¹⁰⁸⁷ See *inter partes* reexaminations 95/000006 (2007-03-26 Board Decision); *inter partes* reexamination 95/000009 (2007-03-30 Board Decision); *inter partes* reexamination 95/000017 (2008-12-04 Board Decision) and *inter partes* reexamination 95/000030 (2007-03-30 Board Decision).

¹⁰⁸⁸ See section XII.M.3, *infra*.

¹⁰⁸⁹ See *inter partes* reexamination 95/000006 (2007-03-26 Board Decision, p. 53).

¹⁰⁹⁰ See *inter partes* reexamination 95/000009 (2008-08-20 Notice of Intent To Issue A Reexamination Certificate, p. 2).

reexamination 95/000030, the Board only partially upheld the Examiner’s anticipation and obviousness rejections, but provided new obviousness rejections.¹⁰⁹¹

The combined appeal in *inter partes* reexaminations 95/000015 and 95/000017, however, resulted in an apparent victory for the Patent Owner. In a split decision, the Board reversed the Examiner’s rejections of claims of two patents. The Examiner was affirmed insofar as proposed rejections were not adopted.¹⁰⁹²

C. Right of Appeal Notice and Notice of Appeal

An appeal may be commenced only after the Patent Office issues a “Right of Appeal Notice”, often referred to as a “RAN”. The Right of Appeal Notice is the Examiner’s final pre-appeal statement of the issues. It can be viewed as a form of pre-brief, inasmuch as Examiners are allowed to refer to the Right of Appeal Notice in their appellant briefing.

A Right of Appeal Notice may only be issued after an ACP. This effectively excludes as a basis for appeal the case where the claims have been twice rejected, but not finally rejected.¹⁰⁹³

D. Notices of Appeal and Notices Of Cross Appeal

1. Notices Of Appeal

When the Right of Appeal Notice is mailed, the Patent Owner and Third Party Requester have the time specified in the Right of Appeal Notice to file a Notice of Appeal.¹⁰⁹⁴ Rule 1.953(b) states that this time period is to be one month from the mailing date of the RAN, whereas MPEP § 2674 states that it is to be the greater of one month or 30 days, whichever is longer. This time period is not extendable.¹⁰⁹⁵

¹⁰⁹¹ See *inter partes* reexamination 95/000030 (2008-02-06 Board Decision, pp. 57-58).

¹⁰⁹² See *inter partes* reexamination 95/000017 (2008-12-04 Board Decision, p. 79).

¹⁰⁹³ But see *Changes to Implement the 2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute* 68 Fed. Reg. 70996, 71002 (Dec. 22, 2003) (“If a patent owner believes that a reexamination proceeding is being ‘suppressed’ from appellate review by the examiner’s refraining from making a rejection final, the patent owner may file a petition under Sec. 1.181(a) requesting that the most recent Office action by the examiner be designated as a final rejection so as to permit an appeal. Such a petition should be accompanied by a showing as to why the most recent the most recent Office action should have been designated as a final rejection.”).

¹⁰⁹⁴ See 37 C.F.R. § 41.61(a)(1); 37 C.F.R. § 1.953(b); MPEP § 2674.01.

¹⁰⁹⁵ See 37 C.F.R. § 41.61(e).

The fact that either party, or both parties, may file a Notice of Appeal means that either or both parties may be the “Appellant”. *A fortiori*, either or both parties may be the “Respondent”, or both “Appellant” and “Respondent” at the same time. Thus, it is possible to have the situation where the Patent Owner is an Appellant, the Third Party Requester is an Appellant, the Patent Owner is a Respondent to the Third Party Requester’s appeal, and the Third Party Requester is a Respondent to the Patent Owner’s appeal.

There are several differences between being an “Appellant” and a “Respondent”. An Appellant can choose which issues to appeal, whereas a Respondent is bound by the Appellant’s choice. This is obviously not a problem where the Respondent was completely victorious before the Examiner, but might be disadvantageous where the result was not so clear. Second, Appellants file the opening, “Appellant’s Brief”, as well as a Rebuttal Brief. Respondents file only a “Respondent’s Brief”, and are thereby limited to one-half the length of the Appellant’s Brief.

2. Notices Of Cross Appeal

Some parties may feel that they were generally, but not completely, successful before the Examiner. In such cases, they might see an appeal as undesirable, since it might result in the undoing of their general, if not complete success. If an appeal is inevitable, however, they will want to have the issues on which they lost addressed. Since both parties are required to file a Notice of Appeal within one month or 30 days of the Right of Appeal Notice, they may not know whether to file a Notice of Appeal until it is too late to file.

The rules address this discomfort by affording both the Patent Owner and Third Party Requester the opportunity to file a Notice of Cross Appeal in response to a Notice of Appeal.¹⁰⁹⁶ Any Notice of Cross Appeal must be filed within 14 days of the service (not filing) of the relevant Notice of Appeal.¹⁰⁹⁷ This time period is also not extendable.¹⁰⁹⁸ Where there are more than two parties (for example, there was a merger resulting in two Third Party Requesters), the time limit begins running from the service date of the relevant Notice of Appeal. For Third Party Requesters, the relevant Notice of Appeal is that of the Patent Owner.¹⁰⁹⁹ For the Patent Owner, the relevant Notice of Appeal is that of any of the Third Party Requesters.¹¹⁰⁰

A Notice of Cross Appeal may not be filed in response to a Notice of Cross Appeal. Suppose there are two Third Party Requesters, and if the first Third Party Requester files a Notice of Appeal on the last possible day while the second does not. The second Third

¹⁰⁹⁶ See 37 C.F.R. § 41.61(b).

¹⁰⁹⁷ See 37 C.F.R. § 41.61(b).

¹⁰⁹⁸ See 37 C.F.R. § 41.61(e).

¹⁰⁹⁹ See 37 C.F.R. § 41.61(b)(1); MPEP § 2674.01.

¹¹⁰⁰ See 37 C.F.R. § 41.61(b)(1).

Party Requester will not be allowed to participate in the appeal,¹¹⁰¹ because the second Third Party Requester can not cross-appeal from the Notice of Appeal of another Requester, nor from a Notice of Cross Appeal from the Patent Owner. This is perhaps an anomaly in the rules, which otherwise try to avoid forcing parties to file appeals because there is the possibility that an appeal will be filed by another party.

There is no difference in status between an Appellant who filed a Notice of Appeal and an Appellant who filed a Notice of Cross Appeal. After the various notices are filed, all briefing rights and schedules will be the same for both kinds of Appellants.¹¹⁰²

3. Requirements Of A Notice Of Appeal Or Notice Of Cross Appeal

A Notice of Appeal must always include a listing of the claims appealed, must be signed by the party or its representative, and must include the relevant fee.¹¹⁰³ This differs from *ex parte* appeals practice, where a Notice of Appeal does not necessarily have to be signed or include a listing of claims.¹¹⁰⁴ Practitioners relying on personnel trained in *ex parte* practice should therefore carefully check their Notices of Appeal. Notices of Appeal must also be served on any parties to the *inter partes* reexamination and include a certificate of service.¹¹⁰⁵

The Third Party Requester must go further than a mere identification of the claims, however. It must specify in the Notice of Appeal which proposed rejections are to be appealed.¹¹⁰⁶ It is not sufficient for the Third Party Requester to appeal generally from a finding of patentability.¹¹⁰⁷

If a Notice of Appeal does not meet these requirements, a deficiency notice will be issued. The deficiency notice should give the filing party a one-month time limit to rectify the

¹¹⁰¹ See MPEP § 2674.

¹¹⁰² See 37 C.F.R. §§ 41.60 and 41.67.

¹¹⁰³ See 37 C.F.R. § 41.61(c).

¹¹⁰⁴ See MPEP § 1204.I.

¹¹⁰⁵ See 37 C.F.R. § 1.903; MPEP § 2674.

¹¹⁰⁶ See 37 C.F.R. § 41.61(b)(2); *inter partes* reexamination 95/000084 (2008-08-18 Examiner's Answer, p. 4) ("In accordance with MPEP §2674, a notice of appeal by a third party requester must identify each rejection that was previously proposed by that third party requester which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.").

¹¹⁰⁷ See MPEP § 2674.

deficiencies by filing an amended Notice. This deadline will be non-extendable, and no second chance to rectify the Notice will usually be given.¹¹⁰⁸

A Notice of Cross Appeal has the same requirements as a Notice of Appeal,¹¹⁰⁹ but there are a few minor differences. The Notice of Cross Appeal should be entitled “Notice of Cross Appeal”.¹¹¹⁰ The Patent Office should, however, treat a “Notice of Cross Appeal” that is improperly titled “Notice of Appeal” as a Notice of Cross Appeal, without issuing a deficiency Notice. A Notice of Cross Appeal must identify the Notice of Appeal to which it is in response.¹¹¹¹

E. Amendments And Evidence After Notice Of Appeal

An amendment that is limited to canceling claims may be entered after a Notice of Appeal is filed.¹¹¹² Such an amendment may not, however, affect the scope of any other claim,¹¹¹³ by canceling an intermediate claim, for example. No other amendments are allowed prior to a Board decision.¹¹¹⁴

As with amendments, it is difficult to add new evidence during an appeal.¹¹¹⁵ If a party wishes to obtain entry of evidence or amendment after appeal, it will need to petition under 37 C.F.R. § 1.183 to waive 37 C.F.R. § 41.63(c) and 37 C.F.R. § 1.116(f).¹¹¹⁶

¹¹⁰⁸ See MPEP § 2674; 37 C.F.R. § 41.61(f).

¹¹⁰⁹ See MPEP § 2674.01.

¹¹¹⁰ See MPEP § 2674.01.

¹¹¹¹ See MPEP § 2674.01.

¹¹¹² See 37 C.F.R. § 41.63(a).

¹¹¹³ See 37 C.F.R. § 41.63(a).

¹¹¹⁴ See 37 C.F.R. § 41.63(b).

¹¹¹⁵ See 37 C.F.R. § 41.63(c).

¹¹¹⁶ See, e.g., *inter partes* reexamination 95/000087 (2008-10-17 Petition Decision, p. 3)(“Furthermore, affidavits or other evidence filed after the date of filing an appeal will not be admitted pursuant to 37 CFR 41.63(c), other than as permitted by reopening under 37 CFR 41.77(b)(l), which is not the case here. See also 37 CFR 1.116(f). To request entry of the declaration under 37 CFR 1.132 by [declarant] filed on June 7, 2006, the third party requester must file a petition under 37 CFR 1.183, accompanied by the petition fee set forth in 37 CFR 1.17(f), to waive the provisions of 37 CFR 41.63(c) and 37 CFR 1.116(f).”).

Usually, evidence will have to have been entered into the record to be usable, although in certain cases exceptions could be obtained via petition.¹¹¹⁷ Evidence found in a reference is entered into the record at least where the Examiner initials the reference on an IDS form.¹¹¹⁸

In *inter partes* reexamination 95/000087, the Third Party Requester sought to introduce a declaration with its Appellant's Brief. The declaration sought to provide evidence that a chemical method taught in the principal prior art method did, in fact, lead to the production of a certain intermediate product. The first Office Action had rejected the claims, assuming that the intermediate product was produced "absent evidence on the record to the contrary". The Patent Owner challenged the assumption in its response, whereupon the Third Party Requester submitted comments late and without the declaration. The Patent Office withdrew its rejections in the ACP, and the Patent Owner did not file a response.¹¹¹⁹ The Patent Office rejected the Third Party Requester's petition to remand and consider the declaration because:

[t]he 30-day statutory period within which the requester is permitted to file comments on patent owner's response would have little purpose if the requester were permitted to refrain from filing, within the 30-day window, any evidence needed to support his comments, and if the requester were instead permitted to wait until the filing of an appeal brief to request that prosecution be reopened, which is not only after the examiner withdraws the rejection and confirms the claims, but also is after a notice of appeal has been filed, simply because the requester wished to wait until the examiner's presumption, and the rejection in which the presumption was made, has been withdrawn.¹¹²⁰

F. Appellants' Briefs

¹¹¹⁷ See, e.g., 37 C.F.R. § 41.67(c)(1)(ix); *inter partes* reexamination 95/000025 (2007-10-31 Petition Decision, p. 8) ("Unredacted versions of the August 19, 2004 exhibits A and B were not previously submitted by the patent owner in the '025 proceeding. Since the patent owner failed to file the present petition with patent owner's May 11, 2007 respondent brief, the patent owner's May 11, 2007 respondent brief is defective pursuant to 37 CFR 41.63(c) and 41.68(b)(I)(viii).").

¹¹¹⁸ See *inter partes* reexamination 95/000038 (2007-05-25 Notice, p. 2).

¹¹¹⁹ Thus the Third Party Requester was not allowed to file comments. See section IX.B.1, *supra*.

¹¹²⁰ *Inter partes* reexamination 95/000087 (2008-03-13 Petition Decision, p. 9).

Each party that has filed a Notice of Appeal or Notice of Cross Appeal must file an Appellant's Brief, or its appeal will be dismissed.¹¹²¹ If its appeal is dismissed, it will still retain the status of a Respondent.

1. Timing Of Appellants' Briefs

Each Appellant's Brief is due two months after the filing date (not service date) of the last Notice of Appeal or Cross Appeal to be filed. If, however, a party had the right to file a Notice of Appeal or Notice of Cross Appeal but did not, then the time period is calculated from the last day any such Notice could have been filed.

For example, if the Patent Owner files a Notice of Appeal and the Third Party Requester files a Notice of Cross Appeal, the time begins running from the date of filing of the Notice of Cross Appeal. If the Third Party Requester does not file a Notice of Cross Appeal, the time begins running from 14 days after the date of service of the Patent Owner's Notice of Appeal.

2. Length Requirements

The form of Appellants' Briefs is governed in part by 37 C.F.R. § 1.943(c). The rule provides that a brief must be 30 pages or less, or have fewer than 14,000 words. If an Appellant's Brief exceeds 30 pages, the Appellant must include a certificate specifying that the word count is less than 14,000.¹¹²² The page/word limitation does not include "appendices of claims and reference materials such as prior art references".¹¹²³

A party may petition under 37 C.F.R. § 1.183 for waiver of this rule.¹¹²⁴ The petition may be submitted with the brief.¹¹²⁵ The petition should contain a description of the need for the waiver, as well as a well-founded request to impose a different specific page / word limit.¹¹²⁶ Absent a specific request for a number of pages, the Patent Office can dismiss the

¹¹²¹ See MPEP § 2675.

¹¹²² See 37 C.F.R. § 1.943(c).

¹¹²³ 37 C.F.R. § 1.943(c); see also *inter partes* reexamination 95/000048 (2008-07-01 Petition Decision, p. 3).

¹¹²⁴ See, e.g., *inter partes* reexamination 95/000020 (2007-03-09 Petition Decision, p. 1).

¹¹²⁵ See, e.g., *inter partes* reexamination 95/000160 (2008-08-28 Petition Decision, pp. 1-3).

¹¹²⁶ See *inter partes* reexamination 95/000069 (2007-02-26 Petition Decision, p. 3).

petition, or impose whatever limit it finds reasonable.¹¹²⁷ If one party receives a waiver of the length requirement, the other party usually may as well.¹¹²⁸

3. Required Components Of An Appellant's Brief

(a) Real Party In Interest

An Appellant's Brief must list a Real Party In Interest. The term "Real Party In Interest" has a particular meaning in the context of *inter partes* reexamination, but loses that meaning in the context of the Appellant's Brief. For Third Party Requesters, the correct Real Party In Interest will be the same Real Party In Interest listed in the request, barring an ownership change or something similar. The Patent Owner, however, should not simply restate the Real Party In Interest listed in the Third Party Requester's request, but rather state the Real Party In Interest from its own perspective, as it would in an *ex parte* appeal.¹¹²⁹ This presumably allows Board members to recuse themselves should they have a conflict.¹¹³⁰

(b) Related Appeals And Interferences

This section of the brief must identify any related proceedings that could bear on Board's decision, including judicial proceedings.¹¹³¹ The proceedings are only those of which the Appellant and its representative are aware – there appears to be no affirmative duty to search for proceedings. The Patent Owner and Third Party Requester may well list different proceedings in this portion of the brief.

(c) Status Of Claims

¹¹²⁷ See, e.g., *inter partes* reexamination 95/000020 (2007-03-09 Petition Decision, p. 1)(“ Petitioner has failed to provide any justification for an extension of the permitted page or word limit for an appellant's brief without any limitation as to the specific number of pages or words. To allow petitioner the unfettered ability to provide a response of whatever page or word limit petitioner deems necessary to address each of the grounds of the Office action could foreseeably open the door for an appellant's brief so voluminous as to substantially delay the instant reexamination proceeding. Nevertheless, given the large number of claims involved, the numerous grounds of rejection set forth by the examiner, the number of pages that were required to set forth the examiner's position, as well as petitioner's timely request, the Office will grant the present petition to the extent of waiving the 37 CFR 1.943(c) appellant brief limit of 30 pages or 14,000 words.”).

¹¹²⁸ See, e.g., *inter partes* reexamination 95/000069 (2007-03-06 Petition Decision, p. 4).

¹¹²⁹ Although this is not clear from the rules or MPEP, it appears to be the assumption in the guidelines for the Examiner's Answer. See MPEP § 2677.III.

¹¹³⁰ See MPEP § 1205.02.

¹¹³¹ 37 C.F.R. § 41.67(c)(1)(ii).

This section is required to have a statement as to whether each claim is “rejected, allowed, confirmed, withdrawn, objected to, or canceled”.¹¹³² In addition, a Patent Owner must identify in this section any rejected claims that it is appealing, whereas the Third Party Requester must identify any allowed or confirmed claims for which it appeals the non-adoption of a ground of rejection.¹¹³³

(d) Status Of Amendments

The Status Of Amendments section requires a statement regarding the status of any amendments offered after the close of prosecution (after the mailing of the ACP).¹¹³⁴ It would seem that supplemental amendments filed before the ACP but refused entry under 37 C.F.R. § 1.945(b) should not be discussed here.

(e) Summary Of Claimed Subject Matter

The Summary Of Claimed Subject Matter requires a mapping of the language of the independent claims to the specification, by column and line number and by drawing reference number.¹¹³⁵ Dependent claims need not be so mapped. For both independent claims and dependent claims, however, any means plus function elements must be set forth and the corresponding structure in the specification identified.

The Summary Of Claimed Subject Matter takes on a new dimension in *inter partes* cases. In *ex parte* appeals, it is used as a way to assist the Board in understanding the claims. In *inter-partes* cases, the Third Party Requester may attempt to use the Summary as an admission. It may therefore be advisable for Patent Owners to ensure that all potential supporting disclosure is cited for each claim element in this section.

(f) Issues To Be Reviewed On Appeal

Here, the Patent Owner and Third Party Requester must set forth the issues in the form of questions. Guidelines on *ex parte* appeals prohibit Appellants from making argument in this section.¹¹³⁶ Rather, issues should be formulated concisely citing the governing law and the

¹¹³² 37 C.F.R. § 41.67(c)(1)(iii). New or amended claims can be “allowed”, while *inter partes* reexaminations merged with reissue applications could potentially have “withdrawn” claims. See 37 C.F.R. § 1.176(2). Claims may also be withdrawn if the Patent Owner fails to respond to an office action that rejects only some of the claims. See MPEP § 2666.10.I.(B).

¹¹³³ See 37 C.F.R. § 41.67(c)(1)(iii).

¹¹³⁴ See 37 C.F.R. § 41.67(c)(1)(iv).

¹¹³⁵ See 37 C.F.R. § 41.67(c)(1)(v).

¹¹³⁶ See MPEP § 1205.02.

applied references, for example “whether claim 1 is obvious under 35 U.S.C. § 103(a) over a combination of X and Y references”.¹¹³⁷

(g) Argument

The argument section is treated procedurally much as in *ex parte* appeals. The Argument section should be divided by headings that are nearly identical to the Issues To Be Reviewed.¹¹³⁸

(h) Claims Appendix

The Claims Appendix provides a copy of the claims as they stand. Unlike the situation in *ex parte* prosecution appeals, however, the claims must include markings relative to the patent as issued.¹¹³⁹ Any new subject matter must be underlined and any deleted subject matter enclosed in brackets.¹¹⁴⁰

(i) Evidence Appendix

The Evidence Appendix contains copies of evidence to be relied upon by the Appellant. The Appellant must include a statement describing where the evidence was entered

¹¹³⁷ See *inter partes* reexamination 95/000025 (2008-06-13 Notice, p. 2) (“For example, Issue (a)(2) of the April 15, 2007 appellant brief states: ‘2. Confirmation of Claims 1-4 as not anticipated by the ‘162 patent and that Claim 5 is patentable over the ‘162 patent in view of various references.’ The statement fails to include the paragraph under 35 U.S.C. 102 on which claims 1-4 were proposed to be rejected (e.g., 35 U.S.C. 102(b) or 35 U.S.C. 102(e)), which secondary references, specifically, over which claim 5 was proposed to be rejected, and the basis for the proposed rejection, 35 U.S.C. 103(a). Furthermore, the concise statement must be of EACH ground of rejection presented for review. The above statement impermissibly lumps together two grounds of rejection, an anticipation rejection and an obviousness rejection.”)(emphasis in original).

¹¹³⁸ See *inter partes* reexamination 95/000025 (2008-06-14 Notice, p. 3) (“The April 15, 2007 appellant brief fails to comply with 37 CFR 41.67(c)(vii), which requires: ‘Each issue must be treated under a separate heading.’ The headings appearing in the ‘Arguments’ section of the brief do not match the issues listed in the ‘Issues to be Reviewed on Appeal’ section of the brief. Appellant is required to treat each issue listed in the ‘Issues to be Reviewed on Appeal’ section of the brief under a separate heading identifying each issue.”).

¹¹³⁹ See MPEP § 2675.

¹¹⁴⁰ For a full explanation of the markings to be applied, see section VII.E.7, *supra*.

into the record by the Examiner.¹¹⁴¹ The Evidence Appendix should not contain earlier portions of the reexamination file – these must be quoted in the Arguments section.¹¹⁴²

(j) Related Proceedings Appendix

The Related Proceedings Appendix contains copies of decisions referred to under the “Related Appeals And Interferences” heading.¹¹⁴³ If there are no related proceedings, the Appendix should still be provided, with the entry “none”.¹¹⁴⁴ Failure to provide a Related Proceedings Appendix where no such proceedings exist is one of the principal reasons that Briefs are found to be defective.¹¹⁴⁵

(k) Certificate Of Service

The Appellant’s Brief, like all papers in an *inter partes* reexamination, must be served and include a certificate of service.¹¹⁴⁶

4. Consequences Of Not Meeting Form Requirements

If the form requirements are not met, the Patent Office will sometimes issue a defective paper notice entitled “Notice Re Brief”.¹¹⁴⁷ The Notice should provide a single opportunity to correct all deficiencies within one month.¹¹⁴⁸ In certain situations, the Patent Office has stated that a party may not respond to such notices by substantively changing briefs.¹¹⁴⁹ If the party does not respond to the Notice, or does not correct all deficiencies, it will be given no second opportunity to correct.¹¹⁵⁰

¹¹⁴¹ See 37 C.F.R. § 41.67(c)(1)(ix).

¹¹⁴² See *inter partes* reexamination 95/000068 (2008-01-14 Notice, p. 2).

¹¹⁴³ See 37 C.F.R. § 41.67(c)(1)(x).

¹¹⁴⁴ See *inter partes* reexamination 95/000068 (2008-01-14 Notice, p. 2).

¹¹⁴⁵ See, e.g., *inter partes* reexamination 95/000068 (2008-01-14 Notice, p. 2); *inter partes* reexamination 95/000069 (2007-03-22 Brief, p. 1).

¹¹⁴⁶ See 37 C.F.R. § 41.67(c)(1)(xi). For more details concerning certificates of service, see section IV.B, *supra*.

¹¹⁴⁷ See, e.g., *inter partes* reexamination 95/000028 (2008-07-17 Notice, p. 2).

¹¹⁴⁸ See MPEP § 2675.

¹¹⁴⁹ See, e.g., *inter partes* reexamination 95/000028 (2008-07-17 Notice, p. 2) (“The third party Respondent Brief cannot add to/alter or refine all other arguments previously submitted.”).

¹¹⁵⁰ See, e.g., *inter partes* reexamination 95/000038 (2007-05-25 Notice, p. 3).

G. Respondent's Brief

1. General

A Respondent's Brief mirrors an Appellant's Brief in structure with the same required sections. However, Respondents have the option, under the various sections, of simply agreeing with the Appellant's statements. This is usually possible for Related Appeals And Interferences, Status Of The Claims, Status Of Amendments, Summary Of Claimed Subject Matter, and Issues To Be Reviewed Section. The Respondent's Brief need not contain a Claims Appendix.

A Respondent's Brief must respond to every section and contention contained in an Appellant's Brief. This means that a statement is required as to whether the Respondent agrees with each portion of the Appellant's Brief.¹¹⁵¹ If the Respondent agrees with the Appellant's contentions on a particular issue, it may not simply ignore the issue, but rather must state that it agrees.¹¹⁵²

A Respondent's Brief is limited to issues addressed in the Appellant's Brief.¹¹⁵³

2. Length

A Respondent's Brief is limited to fifteen pages or 7,000 words in length.¹¹⁵⁴ If fifteen pages are exceeded, the brief must contain a certificate stating that the number of words contained in the brief.¹¹⁵⁵ A Respondent may petition to be allowed a lengthier brief.¹¹⁵⁶

¹¹⁵¹ See, e.g., *inter partes* reexamination 95/000087 (2008-05-27 Office Action, p. 7) ("The Respondent Brief is contrary to the provisions of 37 CFR 41.68 (b)(I)(iii)-(v), which specify that the respondent must provide the statements directed to accepting or disputing appellant's statement of the status of the claims, the status of the amendments, and the summary of the subject matter defined in each of the independent claims involved in the appeal, respectively. In sections III-V (page 3) of the Respondent Brief, these statements specified in 37 CFR 41.68 (b)(I)(iii)-(v) are absent.").

¹¹⁵² See *inter partes* reexamination 95/000028 (2008-07-17 Notice, p. 2) ("The Third Party Brief further failed to respond to Patent Owner's rejection and arguments relating to claims 2-7, 8-20, and 23-28. A statement accepting or disputing the contentions of Patent Owner with each of the issues presented by the Patent Owner for review. If a contention of the appellant is disputed, the errors in Patent Owner's argument must be specified, stating the basis therefor, with citations of the statues, regulations, authorities, and parts of the record relied on. Each issue must be treated under a separate heading. An argument may be made with each of the issues stated in the counter statements of the issues stated in the counter statement of the issues, with each counter-stated issue being treated under a separate heading.").

¹¹⁵³ See MPEP § 2675.01.

¹¹⁵⁴ See 37 C.F.R. § 1.943(c).

3. Timing

A Respondent's Brief must be filed within one month from the date of service (not filing) of the Appellant's Brief. Extensions of time are prohibited by rule, but possible via a petition under 37 C.F.R. §§ 1.182 and 1.183.¹¹⁵⁷

H. Examiner's Answer

1. Procedure And Timing

After the Appellants' and Respondents' Briefs have been received, the Examiner is entitled to consider whether an Examiner's Answer should be filed. If an Examiner's Answer is not filed, then the Examiner must reopen prosecution with a non-final action.¹¹⁵⁸

If the Examiner decides that an Examiner's Answer should be filed, the Examiner holds an appeal conference with his with two additional Examiners and the Reexam Legal Advisor, to discuss issues in the case.¹¹⁵⁹ Within two weeks after holding the conference, the Examiner is to prepare the Answer.¹¹⁶⁰ After the Answer is prepared, it is initialed by the conferees and reviewed by the Special Programs Examiner (SPRE), whereafter it is transferred to the CRU for filing.¹¹⁶¹

There is no deadline for holding the appeal conference, or for initialing and SPRE review. In fact, the Examiner's Answer may take a long time to prepare and file.¹¹⁶²

I. Reopening Prosecution

¹¹⁵⁵ See 37 C.F.R. § 1.943(c).

¹¹⁵⁶ See section XII.F.2, *supra*.

¹¹⁵⁷ See section XII.F.1, *supra*.

¹¹⁵⁸ See MPEP § 2676.

¹¹⁵⁹ See MPEP §§ 2676 and 1208.

¹¹⁶⁰ See MPEP § 2676.

¹¹⁶¹ See MPEP § 2676.

¹¹⁶² See, e.g., *inter partes* reexamination 95/000097 (2008-08-20 Examiner's Answer)(filed more than one year after filing of Respondent's Brief, although proceedings had already been delayed by a defective brief for more than a year); *inter partes* reexamination 95/000098 (2007-10-05 Examiner's Answer)(filed five months after Respondent's Brief); *inter partes* reexamination 95/000103 (2007-11-20 Examiner's Answer)(filed fifteen months after Respondent's Brief).

The CRU retains jurisdiction over the case until transfer of the case to the Board. This means that the Examiner may, upon consideration of the arguments in the Briefs, reopen prosecution.¹¹⁶³

In 95/000058, for example, the Examiner reopened prosecution with a non-final action after receiving the Appellant's and Respondent's Briefs, withdrawing a previous finding of patentable subject matter.¹¹⁶⁴ The Examiner urged the parties, however, to submit a request for an Expedited Right of Appeal Notice.¹¹⁶⁵

J. Rebuttal Briefs

1. General

Following the filing of the Examiner's Answer, Appellants (not Respondents), may file Rebuttal Briefs.¹¹⁶⁶

The Rebuttal Brief of the Patent Owner may respond to issues raised in the Examiner's Answer, or in any Respondent's Brief.¹¹⁶⁷ The Rebuttal Brief of the Third Party Requester, however, may only respond to issues raised in the Examiner's Answer or Patent Owner's Respondent's Brief.¹¹⁶⁸ This effectively means that Third Party Requesters may not rebut the arguments made by other Third Party Requesters in a multi-Third Party Requester proceeding.

The Rebuttal Brief must point out, for each argument made, which issue in Examiner's Answer or corresponding Respondent's Brief is being addressed.¹¹⁶⁹ This should include a citation to a page number and a short description of the issue.¹¹⁷⁰ This allows the Patent Office to quickly determine whether the Rebuttal Brief is properly limited in scope.

2. Length

¹¹⁶³ See, e.g., *inter partes* reexamination 95/000058 (2008-06-17 Office Action, p. 2).

¹¹⁶⁴ See *inter partes* reexamination 95/000058 (2008-06-17 Office Action, p. 2).

¹¹⁶⁵ See *inter partes* reexamination 95/000058 (2008-06-17 Office Action, p. 48).

¹¹⁶⁶ See 37 C.F.R. § 41.71.

¹¹⁶⁷ See 37 C.F.R. § 41.71(2).

¹¹⁶⁸ See 37 C.F.R. § 41.71(2).

¹¹⁶⁹ See MPEP § 2678.

¹¹⁷⁰ See, e.g., *inter partes* reexamination 95/000020 (2007-11-09 Notice, p. 2); *inter partes* reexamination 95/000038 (2007-05-25 Notice, p. 2).

A Rebuttal Brief is limited to fifteen pages or 7,000 words in length.¹¹⁷¹ If fifteen pages are exceeded, the brief must contain a certificate stating that the number of words contained in the brief.¹¹⁷² An Appellant may petition to be allowed a lengthier brief.¹¹⁷³

3. Timing

A Rebuttal Brief must be filed within one month from the date of the Examiner's Answer.¹¹⁷⁴ Extensions of time are prohibited by rule, but possible via a petition under 37 C.F.R. §§ 1.182 and 1.183.¹¹⁷⁵

K. Request For Oral Hearing

Within two months after the date of the Examiner's Answer, either party may request an oral hearing upon payment of the appropriate fee.¹¹⁷⁶ If a request is received, the Board will probably (but need not)¹¹⁷⁷ docket an oral hearing date and provide a notice of the date to all parties.¹¹⁷⁸ At that point, any party to the proceedings may also file, within a period of time set by the notice, a request for oral hearing upon payment of the same fee.¹¹⁷⁹ If the party does not file the request and pay the fee, it will not be allowed to participate.¹¹⁸⁰

L. Board Decision

1. Transfer Of Case To Board

When all briefs have been filed, the case is transferred to the Board for decision. Until that time, jurisdiction remains with the Examiner.¹¹⁸¹ When a case is transferred to the

¹¹⁷¹ See 37 C.F.R. § 1.943(c).

¹¹⁷² See 37 C.F.R. § 1.943(c).

¹¹⁷³ See section XII.F.2, *supra*.

¹¹⁷⁴ See 37 C.F.R. § 41.66(d).

¹¹⁷⁵ See section XII.F.1, *supra*.

¹¹⁷⁶ See 37 C.F.R. § 41.73(b).

¹¹⁷⁷ See 37 C.F.R. § 41.73(f).

¹¹⁷⁸ See 37 C.F.R. § 41.73(d).

¹¹⁷⁹ See 37 C.F.R. § 41.73(d).

¹¹⁸⁰ See 37 C.F.R. § 41.73(d).

¹¹⁸¹ See 37 C.F.R. § 41.64(a); *inter partes* reexamination 95/000025 (2007-10-31 Petition Decision, p. 7); *inter partes* reexamination 95/000068 (2008-06-23 Action, p. 2).

Board, a Notice will issue and be placed in the file.¹¹⁸² Until that time, petitions and correspondence should not be directed to the Board.¹¹⁸³ Specifically, 37 C.F.R. § 41.3, governing petitions to the Board, is not invoked until the case is transferred.¹¹⁸⁴

M. After Board Decision

1. Possible Outcomes

There are a number of possible Board decisions that will dictate the course of proceedings from that point forward. First, the Board may remand to the Examiner to address one or more issues. Second, the Board may provide at least one new ground of rejection, which will trigger a proceeding particular to *inter partes* reexamination. Third, the Board may affirm or reverse the Examiner, without providing any new grounds of rejection.

2. Remand To Examiner

The Board may choose to remand to the Examiner for a variety of reasons.¹¹⁸⁵ A remand should happen, for example, if the Examiner has neglected to issue a Notice re: Brief for a defective Brief, or if there are deficiencies in the file, such as missing reference copies.¹¹⁸⁶ The Board might also remand to the Examiner for consideration of one or more specific questions that were left open.¹¹⁸⁷ The Examiner can consider the issue and return the case to the Board,¹¹⁸⁸ or reopen prosecution. If the Examiner decides to reopen prosecution, the consent of the CRU Director is required.¹¹⁸⁹

3. New Ground Of Rejection Proceedings

¹¹⁸² See, e.g., *inter partes* reexamination 95/000098 (2008-07-18 Notice).

¹¹⁸³ See, e.g., *inter partes* reexamination 95/000087 (2007-10-17 Petition Decision, p. 3)(in dismissing a petition to remand to the Examiner, the Patent Office stated “[j]urisdiction over an *inter partes* reexamination proceeding, however, remains with the examiner until all briefs and examiner's answers have been entered, after which the proceeding is transmitted to the Board, pursuant to 37 CFR 41.64. In the '087 proceeding, jurisdiction remains with the examiner since an examiner's answer has not yet been mailed.”).

¹¹⁸⁴ See, e.g., *inter partes* reexamination 95/000087 (2007-10-17 Petition Decision, p. 3).

¹¹⁸⁵ See 37 C.F.R. § 41.77(a).

¹¹⁸⁶ See, e.g., *inter partes* reexamination 95/000064 (2008-09-18 Order, p. 3).

¹¹⁸⁷ See MPEP § 2682.IV.

¹¹⁸⁸ See MPEP § 2682.IV.

¹¹⁸⁹ See MPEP § 2682.IV.A.

In some instances, the Board may reverse the allowance or confirmation of a claim or affirm a rejection on grounds not raised in the appeal. In such a case, the Board has provided a “new ground of rejection”. Even where a rejection is presented to the Board as an issue, a new ground of rejection will exist if the Board reverses the Examiner’s refusal to adopt the rejection.¹¹⁹⁰ Where the Board provides a new ground of rejection, it can trigger a quasi-prosecution proceeding particular to *inter partes* reexamination.¹¹⁹¹

After a decision having a new ground of rejection, the Patent Owner has the option to either (1) petition for rehearing or (2) file within one month a request that prosecution be reopened, which must include an amendment or new evidence.¹¹⁹² The Patent Owner must do one or the other to avoid the termination of the proceedings with respect to the appealed claim.¹¹⁹³

If the Patent Owner files a request to reopen prosecution, the request may address only the portions of the Board decision relating to the new ground of rejection.¹¹⁹⁴ Any Third Party Requester Appellant may once file comments on the Patent Owner response.¹¹⁹⁵ If a Third

¹¹⁹⁰ See MPEP § 2682.III.

¹¹⁹¹ See 37 C.F.R. §§ 41.77(b)(1) and (c) – (g).

¹¹⁹² See 37 C.F.R. § 41.77(b)(1); MPEP § 2682.II.B.

¹¹⁹³ See 37 C.F.R. § 41.77(b).

¹¹⁹⁴ See *inter partes* reexamination 95/000006 (2008-05-19 Notice, p. 2)(“The amendment and response filed by patent owner on April 25, 2007, responsive to the decision of the Board of Patent Appeals and Interferences (Board), which was rendered on March 26, 2007, and which made new grounds of rejection against the claims, is informal as failing to be made in accordance with the requirement under 37 CFR 41.77(b). The rule requires that an amendment filed in response to a new ground of rejection must be one made ‘to the claims so rejected’ (37 CFR 41.77(b)(2). On this, MPEP 2682, II.B states that the amendment will either ‘amend the claims involved’ or ‘substitute new claims,’ and ‘[s]uch amended or new claims must be directed to the same subject matter as the appealed claims.’ Additionally, the section states that ‘any amendment or showing of facts not directed to that subject matter to which the new rejection was applied will be refused entry and will not be considered.’ (See page 2600-143 (rev. 5, Aug. 2006).) The amendment filed by patent owner goes beyond merely amending claims rejected to overcome the new grounds of rejection of the Board. The amendment also adds new dependent claims 17-29 for obtaining a ‘more varied protection for the invention’ (see Remarks, 4/25/06, page 17), and further amends claim 16 in order to overcome an *affirmed* rejection thereof under 35 U.S.C. 112, second paragraph (see Remarks, page 16).”).

¹¹⁹⁵ See 37 C.F.R. § 41.77(c).

Party Requester is not an Appellant, it must pay the fees for a Notice of Appeal and Appellant's Brief before it is allowed to comment.¹¹⁹⁶

Upon receipt of any such submissions, the proceeding will be remanded to the Examiner for the issuance an office action addressing the Patent Owner amendment and/or evidence.¹¹⁹⁷ In preparing the office action, the Examiner is bound by the Board's decision as it relates to the unamended claim and evidence considered by the Board.¹¹⁹⁸

The issuance of an office action triggers a dual comment/reply period. Within a month from the mailing date of the office action, both the Patent Owner and Third Party Requester may submit comments on the action. Within one month from the date of service of a comment, the respective other party may file a reply. Thus, there is the potential for two sets of comments and two replies to be filed.¹¹⁹⁹

After the comments and replies are received, the Examiner does not issue a final office action, but rather the case is returned to the Board for consideration of the submissions.¹²⁰⁰

The time for a Patent Owner's initial response to a Board decision may be extended under 37 C.F.R. § 1.956.¹²⁰¹ All other time periods in this proceeding may not be extended absent a petition to extend and petition to waive under 37 C.F.R. §§ 1.182 and 1.183.¹²⁰²

4. Petition For Rehearing

Whether or not the Board issues new grounds of rejection, a party may petition the Board for rehearing. A petition for rehearing may be filed after the original Board decision,¹²⁰³ or any new Board decision resulting from a previous petition for rehearing, or from a new ground of appeal proceeding.

¹¹⁹⁶ See 37 C.F.R. § 41.77(c).

¹¹⁹⁷ See 37 C.F.R. § 41.77(d).

¹¹⁹⁸ See 37 C.F.R. § 41.77(d).

¹¹⁹⁹ See 37 C.F.R. § 41.77(e).

¹²⁰⁰ See 37 C.F.R. § 41.77(f).

¹²⁰¹ See 37 C.F.R. § 41.77(g).

¹²⁰² See 37 C.F.R. § 41.77(g).

¹²⁰³ See 37 C.F.R. §§ 41.79(a)(1) and (2).

A petition for rehearing must usually be filed within one month of the decision from which rehearing is requested.¹²⁰⁴ If a new ground of appeal is presented, however, the situation is somewhat complex. Rule 41.77(b) states that the Patent Owner has a one month period to take action “with respect to the new ground of rejection”. One possible action, according to 37 C.F.R. § 41.77(b)(2), is to “request that the proceeding be reheard under § 41.79. Rule 41.79(a) states that “parties” may file a request for rehearing “within one month from the date of...” “(2) [t]he original § 41.77(b) decision under the provisions of § 41.77(b)(2),” or “(3) [t]he expiration of the time for the owner to take action under § 41.77(b)(2)”¹²⁰⁵

The combined effect of these provisions seems to be that the Patent Owner may file a request for rehearing within one month of a Board decision having a new ground of rejection under Rule 41.77(b)(2). The Third Party Requester may also do so under Rule 41.79(a). If the Patent Owner does not file a request within one month of the decision, both parties have the opportunity to do so again within one month from the expiration of one month from the decision under Rule 41.79(a)(3).

A request for rehearing must state “with particularity the points believed to have been misapprehended or overlooked in rendering the Board’s opinion reflecting its decision.”¹²⁰⁶ The request may not, without cause, introduce new arguments or evidence.¹²⁰⁷ Exceptions can be made at least for taking into account new decisions by the Board or a Federal Court,¹²⁰⁸ or to respond to a new ground of rejection.¹²⁰⁹

A month after the date of service of a request for rehearing, the respective other parties may file comments on the request.¹²¹⁰ The comments are limited to the issues raised in the request.¹²¹¹

Where a proper request for rehearing is made, the Board will issue a decision on the request. If the Board does not change its prior decision, no further requests for rehearing are

¹²⁰⁴ See 37 C.F.R. § 41.79(a).

¹²⁰⁵ 37 C.F.R. §§ 41.79(a)(1) and (4).

¹²⁰⁶ 37 C.F.R. §§ 41.79(b)(1).

¹²⁰⁷ See 37 C.F.R. §§ 41.79(b)(1).

¹²⁰⁸ See 37 C.F.R. §§ 41.79(b)(2).

¹²⁰⁹ See 37 C.F.R. §§ 41.79(b)(3).

¹²¹⁰ See 37 C.F.R. § 41.79(c).

¹²¹¹ See 37 C.F.R. § 41.79(c).

allowed.¹²¹² However, if the Board issues a “new decision” and describes the decision as such, a new request for rehearing is allowed.¹²¹³

5. Appeal To Federal Circuit

An appeal to the Court of Appeal for the Federal Circuit is possible for both the Patent Owner and the Third Party Requester.¹²¹⁴ To have the right to appeal, a party must be “dissatisfied” with the decision of the Board.¹²¹⁵ Furthermore, all requests for rehearing must be exhausted.¹²¹⁶

Notices of Appeal must be filed both in the Patent Office and before the Federal Circuit.¹²¹⁷ Cross Appeal Notices may thereafter be filed within 14 days of the date of service of the Notice of Appeal.¹²¹⁸

¹²¹² See 37 C.F.R. § 41.79(a); MPEP § 2682.I.B.(“Any party to the appeal not satisfied with the Board decision may file a single request for rehearing of the decision.”).

¹²¹³ See 37 C.F.R. § 41.79(d).

¹²¹⁴ See 35 U.S.C. § 141.

¹²¹⁵ 35 U.S.C. § 141.

¹²¹⁶ See 37 C.F.R. § 41.81

¹²¹⁷ See 37 C.F.R. § 1.983(b).

¹²¹⁸ See 37 C.F.R. § 1.983(d).

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