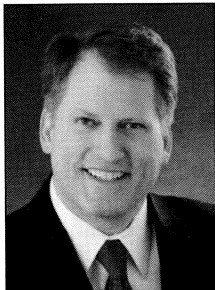
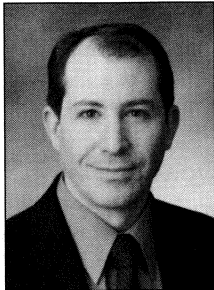


Multiple Reexamination Requests

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It is not uncommon for the same patent to be the subject of multiple reexaminations, or at least multiple reexamination requests. The reexaminations may or may not overlap temporally. If overlapping, the proceedings may continue independently or may be merged together. This article discusses how the PTO handles multiple requests for reexamination of the same patent. In a subsequent article, we will discuss the merger or suspension of copending proceedings at the PTO.

WHO MAY FILE A SUBSEQUENT REQUEST FOR REEXAMINATION

A third party who was not the requester in an earlier reexamination can always file a subsequent request for reexamination, whether *ex parte* or *inter partes*. When the subsequent requester is the same party that requested an earlier pending *ex parte* reexamination, the requester can file a subsequent request for reexamination, whether *ex parte* or *inter partes*. If, however, the earlier reexamination is *inter partes*, then the requester may file a subsequent request for an *ex parte* reexamination, but generally not for *inter partes* reexamination.¹

EACH REQUEST MUST RAISE A SUBSTANTIAL NEW QUESTION OF PATENTABILITY

To be granted, a request for either *ex parte* reexamination or *inter partes* reexami-

nation must be based on prior art printed publications that raise a “substantial new question of patentability” (SNQP).² The same applies to a subsequent request; as a result, it can become increasingly more challenging for each successive request to raise an SNQP. Also, the standard for the SNQP is the same in *ex parte* and *inter partes* reexaminations. The identity of the requester is not relevant to the issue of whether an SNQP is present. That issue depends only on the prosecution history (including prior reexaminations) of the patent and the patentability question identified in the present request.

When a subsequent request for a reexamination is filed during the pendency of an earlier reexamination and the prior art cited in the subsequent request is the same as the prior art cited in the earlier request, the subsequent request will be granted only if the prior art raises a different SNQP, typically by viewing the prior art in a new light.³

If the prior art cited in the subsequent request is different from the prior art cited in the earlier request, the new prior art must still raise an SNQP different from that raised in the earlier pending reexamination. Thus, the new prior art must not be merely cumulative of the art considered in the earlier pending reexamination and must disclose a new, non-cumulative technological teaching vis-à-vis the art considered in the earlier pending reexamination.⁴

TIMING AND PROCEDURE

The PTO’s handling of a subsequent request for reexamination may depend on when the subsequent request is filed. Also, the necessary content of a subsequent request may be determined based on the status of the earlier reexamination.

Subsequent Request After Denial of Earlier Request

A subsequent request for reexamination may be filed after the denial of an earlier request so long as the subsequent request presents an SNQP vis-à-vis all PTO proceedings on the patent prior to the subsequent request, including any earlier filed request, which was denied. A request that merely presents the same question of patentability as a prior request, even if more persuasively, should not be expected to be granted. Thus, a requester whose request

has been denied should consider filing a petition from denial of the earlier request instead of filing a subsequent request, unless new prior art or “new light” evidence to shine on old prior art is submitted along with the subsequent request.⁵

Subsequent Request Filed During Pendency of Earlier Reexamination

When a subsequent request for reexamination is filed during the pendency of an earlier reexamination, the PTO is free to reconsider its actions in the earlier reexamination in view of the subsequent request.⁶ This provides a motivation for the requester to attempt to influence the reexamination through the filing of a subsequent request.

If the patent owner proposes an amendment during a pending reexamination, a subsequent request may be filed that provides information directed to any proposed new or amended claim in the pending reexamination, so long as the subsequent request raises a different SNQP based on the claims in effect at the time of the decision (*i.e.*, not any new or amended claims from the pending reexamination since they are not “in effect” at the time of the subsequent request).⁷ In other words, the threshold for granting another request for reexamination is an SNQP relative to the claims in the patent before the pending reexamination began. Only if that threshold is passed can a request additionally raise patentability questions regarding new or amended claims in the pending reexamination. On the one hand, enforcing the regulatory requirement that a request be based on the original claims prevents abuse arising from serial requests each time the claims change in reexamination. On the other hand, allowing a subsequent request to be filed with information directed to a proposed new or amended claim helps prevent a patent owner from making nominal amendments during a pending reexamination with the intent of blocking the filing of a subsequent request.⁸ In addition, allowing a subsequent request to be filed with information directed to an amendment made during a pending reexamination promotes the efficient use of PTO resources by fully addressing the proposed new or amended claims without waiting for the issuance of the reexamination certificate based on the proposed amendments.⁹

If a subsequent request is granted, the patent owner may ask for reconsideration of whether an SNQP was raised.¹⁰ Additionally, the patent owner may file a

petition along with the patent owner's statement alleging that the subsequent request was filed to harass the patent owner.¹¹ If the petition is granted, prosecution on the subsequent reexamination will be suspended.

Subsequent Request After Allowance of Claims

If a subsequent request for reexamination is filed after the claims have been allowed in an earlier reexamination (as indicated by a notice of intent to issue reexamination certificate (NIRC)) but before the issuance of the reexamination certificate for the earlier reexamination, the procedure for handling the subsequent request is determined based on the expected issue date of the reexamination certificate. For example, if the reexamination certificate will issue before a determination of whether to grant the subsequent reexamination must be made (the determination of whether to grant reexamination must be made within three months following the filing date of a request),¹² the earlier reexamination and subsequent request will normally not be merged and the reexamination certificate will be allowed to issue.¹³ The subsequent request is then considered based on the claims in the reexamination certificate, not the original patent claims.¹⁴

The MPEP instructs that the PTO should not delay issuance of the reexamination certificate based on a later filed request.¹⁵ The MPEP provides, however, that "the Office always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster 'special dispatch.'"¹⁶ If the reexamination certificate will issue after a determination whether to grant the reexamination must be made, the earlier reexamination and subsequent request may be merged and the reexamination certificate may be pulled from issuance.

Thus, if a subsequent request is filed after a NIRC in an earlier reexamination but before the issuance of the reexamination certificate, the subsequent request may need to present an SNQP of either the original claims or the reexamination certificate claims, depending on when the decision whether to grant the subsequent request is made.

Subsequent Request After Reexamination Certificate

If a subsequent request is filed after the issuance of a reexamination certificate for an earlier request, the determination of whether to grant the subsequent request is based on

the claims as modified by the reexamination certificate for the earlier reexamination, not based on the original claims of the patent.¹⁷ Thus, the subsequent request needs to present an SNQP directed at the claims in the reexamination certificate.

Amendments to the claims or specification during the subsequent reexam proceeding must be presented as though the changes made via the reexamination certificate form part of the original patent. In other words, if additional claim limitations were added as part of the reexamination certificate, the same claim limitations should not be shown as added (*e.g.*, underlined) during the subsequent reexamination.

POSSIBLE IMPACT OF SERIAL REQUESTS

Filing a request for *ex parte* reexamination while an *inter partes* reexamination is pending will generally result in the *ex parte* reexamination being merged into the *inter partes* reexamination. Filing a request for *inter partes* reexamination when an *ex parte* reexamination is pending will also generally result in the *ex parte* reexamination being merged into the *inter partes* reexamination. This second scenario is a useful tactic in litigation for an accused infringer seeking a quick stay of the litigation based on reexamination. Once the stay is in place, more time can be taken to carefully craft the request for *inter partes* reexamination.

Serial requests for *ex parte* reexamination are useful vehicles for third parties to impact an *ex parte* reexamination in a quasi-*inter partes* manner. A third party may do this by selectively withholding information from an earlier request and then including the withheld information in a subsequent request. Several examples illustrate that approach.


First, assume that a third party requests reexamination based on one or more prior art references, which are used by the PTO to reject the claims in a first Office action. Assume further that the patent owner traverses the rejection by argument, pointing out a deficiency in the references. If the third party has additional prior art that (1) independently raises an SNQP and (2) cures the deficiency, then the third party can file a new request including the additional prior art and the reasons for its relevance. Typically, the third party will have sufficient time to do so after the PTO issues a NIRC but before the reexamination certificate. Also, nothing prevents the third party from including in the new request a

defense of the original rejection without reliance on the additional prior art.

As a second example, consider a case in which the patent owner makes claim amendments. As noted above, a request directed at the new or amended claims can be filed, provided the request raises an SNQP as to the unamended claims.

A third example is a case in which the third-party requester has evidence establishing the dates of public availability of the printed publication(s) on which it relies in an initial request. The requester need not include that evidence with the initial request. If the patent owner makes an argument attacking the public availability or prior art status of the publications, and the PTO is convinced by that argument, then the third-party requester can file a subsequent request including the evidence that provides the "new light" in which to view the printed publications. If the patent owner also made arguments on the merits, assuming that the publications are prior art, as an appropriately cautious patent owner should do, then the third party may also address those arguments in its subsequent request.

CONCLUSION

The statutory requirement that reexamination be conducted with special dispatch results in a process that is necessarily rigid. However, the ability to file multiple requests for reexamination provides requesters with flexible tactical tools. 

ENDNOTES

1. 35 U.S.C. § 317(a), 37 C.F.R. § 1.907 and MPEP § 2686.01 (unless authorized by Director, third-party requester of earlier reexamination (or its privy) cannot file subsequent request for *inter partes* reexamination of patent until *inter partes* reexamination certificate is issued).
2. 35 U.S.C. §§ 301-303, 312(a); MPEP § 2216 and MPEP § 2616.
3. *Id.*
4. MPEP § 2242(I) and MPEP § 2642(I).
5. MPEP § 2248 and MPEP § 2648.
6. *In re Bass*, 314 F.3d 575 (Fed. Cir. 2002).
7. MPEP § 2240(II) and MPEP § 2640(II)(A).
8. *Id.*
9. *Id.*
10. In an *ex parte* reexamination ordered on or after June 25, 2010, to preserve the issue for appeal, the patent owner must request that the examiner reconsider whether an SNQP was raised by either filing a statement under 37 C.F.R. 1.530 prior to issuance of an Office action or in a response to an Office action. 75 Fed. Reg. 36,357 (June 25, 2010).
11. MPEP § 2240(II) and MPEP § 2640(II)(A).
12. 35 U.S.C. § 303(a) and 35 U.S.C. § 312(a).
13. MPEP § 2295 and MPEP § 2695.
14. *Id.*
15. MPEP § 2283(V) and MPEP § 2686.01(IV).
16. *Id.*
17. MPEP § 2295 and MPEP § 2695.