

Notice of Concurrent Proceedings in Reexamination and Reissue

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A patent that is the subject of a reexamination or a reissue proceeding is often simultaneously involved in litigation or in an additional proceeding at the PTO. This article discusses the obligations and opportunities for parties involved or interested in a reexamination or reissue proceeding to inform the PTO about the existence of, status of, and papers from such additional matters by way of a Notice of Concurrent Proceedings and other means of disclosure.

LITIGATION SEARCH BY THE PTO

After a reexamination is ordered or a reissue application is filed, the PTO conducts a search to determine if there is any concurrent or prior litigation involving the patent. The PTO uses this information in several ways. First, the existence of pending litigation impacts the status of the reexamination or reissue application. For example, the time period to respond to an Office action may be shorter in a reexamination with copending litigation. Second, the PTO may analyze documents from the litigation and use those documents in mak-

ing a decision.¹ If additional details of a litigation appear to be material to examination, the examiner may make such additional inquiries as necessary and appropriate.² Third, awareness of concurrent proceedings provides an opportunity for the PTO to assess the most efficient use of its resources to avoid duplicating efforts and taking conflicting positions. For example, a reissue application or *inter partes* reexamination may be suspended when it is found that there is copending litigation.³ The search conducted by the PTO does not relieve the patent owner from an obligation to provide additional information regarding developments after the search about any concurrent litigation or a concurrent proceeding at the PTO, as discussed below.

PATENT OWNER'S DUTY TO DISCLOSE OTHER PROCEEDINGS

Those involved in prosecuting a patent under reexamination or filing and prosecuting a reissue application have a continuing obligation to timely apprise the PTO of any information that is material to the patentability of the claims under consideration. This duty arises from 37 C.F.R. § 1.56 for reissue, 37 C.F.R. § 1.555 for *ex parte* reexamination, and 37 C.F.R. § 1.933 for *inter partes* reexamination. The duty continues from the commencement of the proceeding until its completion due to issuance of a reexamination certificate or reissue patent or the abandonment of the reissue application.

This continuing duty includes an obligation to notify the PTO regarding proceedings in which the patent is or was involved and the outcome of such proceedings.⁴ So, an owner of a patent in reexamination and a reissue applicant are obligated to notify the PTO of prior or concurrent proceedings, such as interferences, reissues, reexaminations, or litigation. The PTO may *sua sponte* decide to merge two of its proceedings, suspend one of the proceedings, or permit their concurrent prosecution. Of course, such a decision can also be requested by

the patent owner or a third party in a reexamination.

Failure to comply with the duty to notify can compromise the enforceability of the patent. For example, in *Critikon v. Becton Dickinson Vascular Access*, a reissued patent was found unenforceable because, during prosecution of the reissue application, the patentee failed to report to the PTO an ongoing litigation that involved the patent.⁵

Timing for Submissions in Reexamination

Alerting the PTO to the existence of litigation or another proceeding at the PTO should be done at the time of filing of a request for reexamination. The notice may be included in the request. However, it is preferable to submit a separate paper titled “Notice of Concurrent Proceedings.” Proceedings begun after reexamination is ordered should be promptly brought to the attention of the PTO. Also, as discussed below, substantive documents generated from the litigation should also be submitted.

Timing for Submissions by Reissue Applicants

A reissue applicant should alert the PTO of concurrent proceedings when, or shortly after, the applicant files the application, either in the reissue oath or declaration, or preferably in a separate paper titled “Notice of Concurrent Proceedings.” Also, any subsequent proceeding should be promptly brought to the attention of the PTO. In addition to submitting substantive documents from the litigation, a reissue applicant should submit documents from any concurrent proceeding, such as a reexamination, via an Information Disclosure Statement.

THIRD PARTY'S OPPORTUNITY TO DISCLOSE OTHER PROCEEDINGS

During Reissue

A third party interested in a reissue application can file a protest, which may discuss other proceedings involving the patent and may include papers from the other proceedings. There are no restrictions on the content of a relevant protest.

During Reexamination

A third party's opportunity to disclose other proceedings affecting a patent under reexamination, unlike reissue, is quite restricted. As discussed below, a third party may give the PTO “bare notice” of other proceedings, their status

or results, and certain documents from the other proceedings. Third parties other than the requester can also file a Notice of Concurrent Proceedings.

CONTENT OF A NOTICE OF CONCURRENT PROCEEDINGS

Bare Notice

A Notice of Concurrent Proceedings should merely provide an itemization of the documents being submitted and an accurate report of the status of the other proceeding.⁶ For example, the notice may identify the application number or case number of the proceedings and the status thereof. The notice should not include arguments or other information about the submitter's views on the proceedings or litigation. A notice that exceeds this "bare notice" restriction may not be entered in a reexamination proceeding. The bare notice restriction ensures that parties do not get an opportunity to comment on the merits of the reexamination outside of the opportunities strictly proscribed by the reexamination rules. It is recommended that a notice *per se* filed by a patent owner adhere to the bare notice restrictions. If the patent owner wants to provide additional commentary, it is recommended that the owner provide that commentary in another paper where appropriate.

Third-Party Notices in Reexamination

Even though the PTO does not typically accept any further submissions of any kind from a third-party requester after a request for *ex parte* reexamination, a third-party *ex parte* reexamination requester can file a Notice of Concurrent Proceedings, provided it is limited to bare notice, as discussed above. The same also applies to *inter partes* reexamination. A third-party *inter partes* reexamination requester who submits a Notice of Concurrent Proceedings should withhold additional commentary about the other proceedings and instead provide that commentary in third-party comments, if appropriate, or other appropriate, permitted submissions touching on the merits.⁷

Litigation Documents

Documents from a prior or concurrent litigation that are helpful to the PTO's analysis should be submitted with a Notice of Concurrent Proceedings. The PTO will accept litigation documents that are substantive such as copies of notices of suits

and other proceedings involving the patent, and copies of decisions or papers filed in the court from litigations or other proceedings involving the patent. Examples include "final court decisions (even if the decision is still appealable), decisions to vacate, decisions to remand, and decisions as to the merits of the patent claims."⁸ Underlining or highlighting portions of a document is considered to be going "beyond bare notice of the prior or concurrent proceedings."⁹

Of course, not all documents from a prior or concurrent litigation are helpful to the PTO's analysis, so discretion is required in submitting documents. The PTO will not accept litigation documents that do not shed any light on the issues being considered by the PTO. If the PTO has accepted a document that is subsequently considered inappropriate for entry into the record, it will be expunged. Examples of documents that will not be accepted or that will be expunged are non-merit decisions on motions such as motions "for a new venue, a new trial/discovery date, or sanctions."¹⁰ Other unacceptable documents include papers that "provide a party's arguments, such as a memorandum in support of summary judgment."¹¹ Furthermore, the PTO may consider a submission to be too voluminous and refuse to enter it for that reason. The submitting party may be given an opportunity to resubmit just the portion of the submission that is deemed relevant.¹²

Failure by the patent owner to disclose material litigation documents during reexamination can constitute inequitable conduct. In *Marlow Industries v. Igloo Products*, for example, a reexamined patent was held unenforceable due to the patentee's failure to submit to the PTO during the reexamination relevant documents from a litigation pending during the reexamination.¹³ In particular, although the patentee reported the litigation to the PTO, the patentee failed to disclose two court opinions that (1) set forth the court's construction of the claims of the patent and (2) found that an accused infringer's products did not literally infringe the claims.

Other PTO Documents When a Patent Is in Reexamination

Certain submission requirements are different for reexamination proceedings as compared with reissue. For example, the MPEP admonishes parties to a reexamination not to submit copies of copending

reexaminations and applications, as these copies could be mistaken for a new request or filing.¹⁴ Rather, submitters should only identify the application/proceeding number and its status. In contrast, for reissue applications, there is no prohibition against the submission of prosecution documents from another PTO proceeding. In view of the Federal Circuit's current inequitable conduct jurisprudence, this may in fact represent the best practice for such cases.¹⁵

CONCLUSION

Knowing when and how to properly submit a Notice of Concurrent Proceedings in a reexamination or a reissue application is an important aspect of post-grant practice. For a third party, taking full advantage of permitted notice filings can be an opportunity to ensure that the PTO is aware of the most helpful information. For the patent owner, the PTO's notice rules and the duty of disclosure can be a minefield for the unwary. IPT

ENDNOTES

1. MPEP §§ 2286(V), 2686.04(VI).
2. MPEP § 1442.01.
3. MPEP § 1442.02 (to avoid suspension of reissue application, reissue applicant must, *e.g.*, express desire for reissue application to be examined, indicate that concurrent litigation has been stayed, or state that there are no overlapping issues); 37 C.F.R. § 1.987 (suspension of *inter partes* reexam).
4. C.F.R. §§ 1.565(a), 1.985(a); MPEP §§ 1418, 1449.01(I), 2282, 2686.
5. *Critikon, Inc. v. Becton Dickinson Vascular Access, Inc.*, 120 F.3d 1253, 1259 (Fed. Cir. 1997).
6. 37 C.F.R. §§ 1.565(a), 1.985(b); MPEP §§ 2282, 2686.
7. MPEP § 2686.
8. MPEP §§ 2282, 2686.
9. *Id.*
10. *Id.*
11. *Id.*
12. *Id.*
13. *Marlow Indus., Inc. v. Igloo Prods. Corp.*, 65 F. App'x 313, 315-18 (Fed. Cir. 2003) (nonprecedential).
14. MPEP §§ 2282, 2686
15. *See, e.g., Larson Mfg. Co. of S.D. v. Aluminart Prods. Ltd.*, 559 F.3d 1317 (Fed. Cir. 2009) (finding that Office actions from continuation application were material to copending reexamination and remanding to district court to determine whether withholding Office actions was deceptive and thus constituted inequitable conduct); *McKesson Info. Solutions, Inc. v. Bridge Med., Inc.*, 487 F.3d 897 (Fed. Cir. 2007) (affirming unenforceability of patent due to inequitable conduct where prosecution documents from allowed and rejected applications were not submitted in copending application).