

# Requesting *Inter Partes* Reexamination

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Our July 2010 article discussed the filing requirements for an *ex parte* reexamination request, best practices for preparing a request, and guidance recently published by the PTO regarding filing compliant requests.<sup>1</sup> This article discusses the unique additional requirements for requesting *inter partes* reexamination.

## WHEN IS INTER PARTES REEXAM AVAILABLE?

Only patents granted from an “original application” filed on or after November 29, 1999, are eligible for *inter partes* reexamination.<sup>2</sup> While there was an initial transition period when *inter partes* reexamination was an infrequent possibility, it is increasingly available as an option for a patent challenger.

An “original application” includes first-filed, divisional, continuation, and continuation-in-part (CIP) applications, as well as now-defunct continuing prosecution applications (CPAs).<sup>3</sup> Thus, a divisional, continuation, CIP or CPA filed on or after November 29, 1999 is eligible for *inter par-*

*tes* reexamination even if it has an earlier priority date.

A United States national stage filing of an international PCT application is also an “original application,” the relevant date for which is the international filing date – not the date of entry into the U.S. national stage under 35 U.S.C. § 371.<sup>4</sup> The international filing date must be on or before November 29, 1999 for an application filed under § 371 to be eligible for *inter partes* reexamination.

Neither a reissue application nor a request for continued examination (RCE) is an “original application.” Thus, for example, the eligibility of a reissue patent for *inter partes* reexamination depends whether its original filing date, not its reissue filing date, is on or before November 29, 1999.<sup>5</sup>

Provided the patent is recent enough to be eligible for *inter partes* reexamination, a request can be filed anytime during the enforceable life of the patent.

## WHO MAY REQUEST INTER PARTES REEXAMINATION?

Only a third party can file an *inter partes* reexamination request. In fact, only a third party who is not estopped may file an *inter partes* request. A party may be estopped as a result of a prior *inter partes* reexamination or a prior litigation.

### Estoppel Based on Prior Reexamination

A prior *inter partes* reexamination can prevent the same requester from requesting another *inter partes* reexamination in two ways.

First, *inter partes* reexamination is a one-at-a-time proceeding for any given requester. Once a reexamination has been ordered, a subsequent request by the same requester or its privies is not allowed, except by petition.<sup>6</sup> This prohibition against a subsequent reexamination continues until a reexamination certificate issues.

Second, the conclusion of a first *inter partes* reexamination estops the same requester from requesting another *inter partes* reexamination of the same patent claims in most cases.<sup>7</sup> The trigger for this estoppel is a final decision favorable to patentability in an *inter partes* reexamination requested by the requester and ordered by the PTO. “Final” here means after all appeals, remands, etc. have been exhausted, according to the PTO. The

estoppel operates claim by claim and only attaches to those claims found patentable in the concluded reexamination. This estoppel also extends to the requester’s privies.

The scope of this estoppel is all arguments that were actually raised or “could have been raised” in the concluded reexamination.<sup>8</sup> The meaning of “could have been raised” is not clear. What is clear is that it does not include an argument based on “newly discovered prior art unavailable to the third-party requester and the [PTO]” during the earlier reexamination.<sup>9</sup> This carve-out also lacks clarity, as the conjunctive “and” is counter-intuitive, and the notion of what is unavailable to the PTO is rather fuzzy.

### Estoppel Based on Prior Litigation

Former litigants are also estopped from requesting *inter partes* reexamination in most circumstances.<sup>10</sup> The trigger for this estoppel is a final decision that a litigant has not sustained its burden to prove invalidity of a claim in a civil action under 28 U.S.C. § 1338. This estoppel applies to actions that arise in district courts; it does not apply to International Trade Commission proceedings. “Final” here also means after all appeals, remands, etc. have been exhausted. Thus, ongoing concurrent litigation does not trigger this estoppel. This estoppel also operates claim by claim and attaches only to those claims held not invalid in the litigation. This estoppel also extends to the requester’s privies.

## WHAT MUST BE INCLUDED IN AN INTER PARTES REEXAM REQUEST?

Assuming the patent is eligible for *inter partes* reexamination, and the requester is not estopped by either a prior ongoing or concluded *inter partes* reexamination or a concluded court case, what must the requester include in its request for *inter partes* reexamination? All of the requirements for third-party requested *ex parte* reexamination, as listed in our July 2010 article, must be satisfied. To recap, they are (1) a copy of the entire patent for which reexamination is requested, as well as any disclaimer, certificate of correction, and prior reexamination certificate; (2) a copy of every printed publication relied upon in the request; (3) an identification of each claim for which reexamination is requested; (4) a statement that clearly points out each substantial new question of patentability (SNQP) in view of the cited prior art printed publications; (5) an explanation of the pertinence and manner of applying the prior art to each identified claim; (6) the filing