

Requesting *Inter Partes* Reexamination

BY MATTHEW C. PHILLIPS & KEVIN B. LAURENCE
OF STOEL RIVES LLP



Matt Phillips



Kevin Laurence

Matt Phillips and Kevin Laurence are partners at Stoel Rives LLP. Matt is an adjunct professor teaching patent prosecution at Lewis & Clark Law School in Portland, Oregon. Kevin has taught a variety of patent law courses as an adjunct professor at the law schools of Brigham Young University and the University of Utah. Together they teach the multi-day course "Patent Reexamination and Reissue Practice" for Patent Resources Group.

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.¹ 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.² 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).³ 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. § 371.⁴ 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, 1999.⁵

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.⁶ 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.⁷ 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.⁸ 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.⁹ 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.¹⁰ 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

fee (\$8,800 for *inter partes*, compared to only \$2,520 for *ex parte*); and (7) a certificate of service on the patent owner.

Statement of No Estoppel

In addition, an *inter partes* request must also include a certification that the requester is not subject to the estoppel provisions discussed above.¹¹ In most cases that means that the requester has not requested an earlier ongoing or concluded *inter partes* reexamination and that the requester was not a party to a concluded litigation involving the patent.

Identification of Real Party in Interest

Moreover, an *inter partes* request must also identify the real party in interest.¹² In order for the PTO to enforce the estoppel provisions, it must know who the real party in interest is behind each request. This enables the patent owner and the PTO to determine who the requester's privies may be. It also enables a subsequent requester to determine if it is a privy to a prior requester. Thus, it is not possible to request *inter partes* reexamination anonymously, as it is for *ex parte* reexamination.

WHAT ELSE CAN BE INCLUDED?

The same optional parts that a third-party requester may consider including with an *ex parte* reexamination request can also be included with an *inter partes* request. These include (1) a transmittal form; (2) claim charts; (3) declarations; (4) old prior art; (5) parent patent applications; and (6) patent owner admissions; and (7) a notification of other proceedings involving the patent.

However, there are two differences unique to *inter partes* reexamination. They concern the transmittal form and declarations.

Transmittal Form

First, there is an *inter partes* version of transmittal form PTO/SB/57 (also referred to as a Form PTO 1465), which serves as a handy checklist of the parts that the requester must include in the request and, when properly completed, itself fulfills several of the request requirements (*e.g.*, identification of claims for which reexamination is requested, identification of the real party in interest). The PTO recommends that requesters use this form.¹³

Declarations

Second, unlike an *ex parte* requester, an *inter partes* requester can choose whether to include supporting declarations with the request or to wait to possibly include them with the requester's comments after the owner's response to an Office action.¹⁴

Home Lawsuits Tools Register 847-705-7100 | Register | Sign In | Cart (0)

RFC Express™ beta
US Federal District Court Recently Filed Cases

Access to over 18,500 cases
229 Lawsuits added in the last 7 days

The Leading Provider of
INTELLECTUAL PROPERTY LAWSUIT INFORMATION

Recent Lawsuits
The most frequently updated, searchable, intellectual property lawsuit information available on the web.

Lawsuit Report
Receive up to three emails a day of recently filed cases within hours after being docketed.

Lawsuit Alarm
Set alarms by entering information which triggers an e-mail of new lawsuits that match your criteria.

Lawsuit Tracker
Proactively track any patent, trademark or copyright lawsuit currently being litigated.

Complaint Download (PDF)
Immediately download available complaints. Why pay PACER when you can get it free from RFC?

Start your FREE trial today by visiting www.rfcexpress.com

Including declarations with the request ensures that the declarations will be considered by the PTO but also gives the patent owner maximum time to react to the declarations. On the other hand, waiting for a later opportunity to submit a declaration may catch the patent owner less able to respond, but that approach also runs the risk that the requester might not get the chance to file the declaration. For example, a patent owner who is satisfied with an Office action need not file a response. Without a response on file, the requester has no right to file comments.

CONCLUSION

Preparing an *inter partes* request is not significantly different from preparing an *ex parte* request. In fact, there may be less pressure to present perfectly all arguments and evidence in an *inter partes* request because of the requester's ongoing participation rights that are not available in *ex parte* reexamination. On the other hand, the estoppel provisions provide pressure to include the most pertinent prior art in an *inter partes* request. Furthermore, once *inter partes* reexamination is ordered, the resemblance to *ex parte* reexamination quickly disappears. A future article will

cover the unique procedures for *inter partes* reexamination. **IP**

ENDNOTES

1. Matthew C. Phillips & Kevin B. Laurence, *Requesting Reexamination: Requirements & Best Practices*, Intellectual Property Today 26-27 (July 2010).
2. 37 C.F.R. § 1.913.
3. *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1331-32 (Fed. Cir. 2008).
4. Control No. 95/000,242, Decision Vacating Reexam. (July 28, 2009).
5. *Cooper Techs.*, 536 F.3d at 1341.
6. 35 U.S.C. § 317(a).
7. 35 U.S.C. § 317(b).
8. *Id.*
9. *Id.* (emphasis added).
10. *Id.*
11. 37 C.F.R. § 1.915.
12. *Id.*
13. USPTO, *Best Practices and FAQs for Filing for Reexamination Compliant with 37 CFR 1.510 and 1.915*, at 2 (May 2010), available at http://www.uspto.gov/patents/stats/Reexamination_Information.jsp; see also Andy Kashnikow, *Filing Compliant Reexam Requests at 12* (June 2010), available at http://www.cabic.com/bcp/060110/AKashnikow_RBP.ppt.
14. Matthew A. Smith, *Inter Partes Reexamination*, § 5:73, at 192 (West 2d ed. 2010).