



REEXAMINATION & REISSUE PRACTICE GROUP

PATENT REEXAMINATION Frequently Asked Questions¹



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Patent Reexamination

A. *Ex Parte* Reexamination 35 U.S.C. § 302

1. What is a Patent Reexamination?

Answer: Patent reexamination is a procedure by which a post grant review of an issued U.S. Patent is performed by a team of three experienced primary examiners of the United States Patent & Trademark Office’s Central Reexamination Unit (CRU). *Ex parte* patent reexamination may be initiated by the patent owner, the Director of the USPTO or a member of the public (“third party requester”). Patent reexamination is conducted by the USPTO when a submitted reexamination request demonstrates, via a patent or printed publication, that a substantial new question of patentability (SNQ) exists.²

In contrast to patent reissue, patent reexamination is limited in scope to questions of unpatentability of the claimed invention of the patent that are based on prior art patents or printed publications only under §§ 102, 103 and obviousness-type double patenting. Neither patentability questions relating to 35 U.S.C. § 112, nor public use or sale are proper grounds for a reexamination request; nor are questions relating to 35 U.S.C. § 101 in most cases.³ See MPEP § 2217⁴

There are two types of reexamination proceedings conducted by the USPTO, namely *ex parte* reexamination and *inter partes* reexamination. As the nomenclature implies, an *ex parte* proceeding is conducted only between the patent owner and the USPTO.⁵ *Inter partes* on the other hand, allows for third party participation at every stage of the examination proceedings and appeals.

Questions pertaining to aspects of these different proceedings are addressed below.

² An SNQ exists where the patents or printed publications would have been non-cumulative information that would be important to a reasonable examiner in determining whether the claims of the original patent should be reexamined.

³ Questions pertaining to double patenting under 35 U.S.C. § 101 are recognized as proper SNQs relating to “patents.” However, questions of statutory subject matter or utility issues are not recognized as SNQs as they do not relate to “patents or printed publications.” As to 35 U.S.C. § 112, questions of specification support and indefiniteness are not appropriate as SNQs as they do not relate to “patents or printed publications.” However, 112 matters may be considered during the reexamination for amended or newly submitted claims. See 37 C.F.R. § [1.552](#) and MPEP § [2258](#). See 37 C.F.R. § [1.552\(a\)](#) and MPEP § [2258\(II\)](#).

⁴ http://www.uspto.gov/web/offices/pac/mpep/documents/2200_2217.htm#sect2217

⁵ Limited third party participation may occur pursuant to 37 C.F.R § 1.535 should the Patent Owner file a statement to a granted *ex parte* reexamination order.

2. Why would I use *ex parte* reexamination as opposed to filing a reissue application (patent owner)?

Answer: While the patent owner may seek reissuance of the original patent to narrow claims in view of art, filing the reissue application subjects all the claims in the original patent to examination including compliance with the reissue declaration or oath requirements. See MPEP § [1414](#). Filing of an *ex parte* reexamination request does not require that the patent owner identify an error without deceptive intent as is required when filing a reissue application. *Ex parte* reexamination may be conducted only on requested claims and is limited to consideration of patents and printed publications under § 102, 103 and obviousness-type double patenting as to original patent claims. Section [112](#) issues are considered only as to any new or amended claims, thus limiting the patent owner's exposure to the full scope of the conditions of patentability that are considered in reissue. See MPEP § [2243](#). Furthermore, unlike reissue where new claims can be added where there was an error in failing to present such claims in the original patent, in *ex parte* reexamination, the patent owner may add new claims regardless of whether there was an error in failing to present such claims in the original patent.

3. Why file an *ex parte* reexamination instead of *inter partes* to challenge a problem patent?

Answer: As the third party requester, *ex parte* reexam has an advantage in that the requester can remain anonymous and is not restricted by the same estoppel provision effects as an *inter partes* reexam (discussed below). Remaining anonymous can keep competitors in the dark as to the identity of the party attacking the patent. This can be important to maintaining good relations with and avoiding retaliatory actions by the patent owner.

Another benefit for the third party requester in *ex parte* reexamination is the reduced cost as to the reexamination request fee and attorney's fees compared to the costs associated with an *inter partes* reexamination proceeding (significantly more expensive due to the continuous participation involved). See 37 C.F.R. § [1.20](#) and MPEP §§ [2233\(I\)](#) and [2250.03](#) for fees; and See 37 C.F.R. § [1.907](#) regarding estoppel effects of *inter partes* reexamination.

4. Why file an *ex parte* reexamination?

Answer: Consideration will vary for patent owners and third party requesters. Patent owners should consider requesting reexamination when it is necessary to strengthen the patent claims. This may include adding new claims to the patent which are narrower in scope than the original patent claims but are necessary for licensing or enforcement purposes .

⁶ The addition on new claims may provide the patent owner a basis to establish literal infringement rather than having to rely on the doctrine of equivalents to prove infringement.

Third party requesters should consider requesting reexamination when patents and printed publications can be effectively presented to enable the USPTO to reject original patent claims with the expectation that the prosecution of the reexamination proceeding will result in cancellation or amendment of original patent claims.

Reexamination is an attractive strategy for third parties to challenge problematic patents clouding the competitive landscape. This is because the standard of review in reexamination for proving unpatentability of claims purposes is much more favorable to a challenger.

For example, in federal district court the standard to invalidate a U.S. patent is “clear and convincing evidence.” Whereas, in reexamination, the U.S. Patent and Trademark Office can establish unpatentability by a “preponderance of evidence,” and unexpired claims are given their broadest reasonable interpretation. *See* 37 C.F.R. [1.555\(b\)\(2\)\(ii\)](#).

In this manner, the original patent claims may be canceled or amended in reexamination. As such, the third party requester will gain freedom to operate either through non-infringement of the claims which survive reexamination, or through the doctrine of intervening rights. If a concurrent litigation exists, amendment or cancellation of claims may facilitate settlement on terms favorable to the third party. In anticipation of litigation, a common tactic is to request a reexamination as early as possible to enhance the prospects of having the court “stay” (prevent the case from proceeding further) any subsequent litigation.

5. Can I file a second request for *ex parte* reexamination?

Answer: Yes. So long as you present an SNQ you can file a second request for *ex parte* reexamination. *See* MPEP § [2240\(II\)](#). However, whether the new reexamination request will result in an order for reexamination and be merged with the earlier reexamination proceeding will depend to a large degree on the nature of and timing of the second request. *See* 37 C.F.R. §§ [1.565](#) and [1.989](#); and MPEP § [2283\(I\)](#). The second request should consider the status of the claims as pending, including all amendments, in the earlier reexamination proceeding.

6. Is there a limit on when I can request an *ex parte* reexamination application?

Answer: Yes. A request for *ex parte* reexamination can be filed only during the period of enforceability of a patent. The period of enforceability is determined by adding 6 years to the date on which the patent expires. *See* 37 C.F.R. § [1.510\(a\)](#) and MPEP § [2211](#).

7. Should I interview the examiner in *ex parte* reexamination?

Answer: Yes. Interviews are available to patent owners in *ex parte* reexamination proceedings and are a very effective way to advance the prosecution of the reexamination proceeding and to reach a meeting of the minds with the examiner to ascertain what is need to obtain an NIRC (“Notice Of Intent To Issue *Ex Parte* Reexamination Certificate”). While interviews after final rejection are not granted as a matter of right they should be sought because there is no continued reexamination procedure available. The interview after final

rejection may lead to fewer advisory actions denying entry of amendments submitted after final rejection. *See* 37 C.F.R. § [1.560](#) and MPEP § [2281](#).

8. When is an interview summary required?

Answer: In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner to avoid termination of the proceedings. An interview does not remove the necessity for response to Office actions as specified in 37 C.F.R. § [1.111](#). A patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later. *See* 37 C.F.R. § [1.560](#) and MPEP § [2281](#).

9. Will a failure to file an interview summary result in termination of an *ex parte* reexamination?

Answer: Yes. If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under 37 C.F.R. § [1.560\(b\)](#), the prosecution in the *ex parte* reexamination proceeding will be terminated, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under 37 C.F.R. § [1.570](#) in accordance with the last action of the Office. A petition may be filed requesting late acceptance of the written statement of the interview requiring a showing of good cause as to why the written statement of interview was filed belatedly. *See* 37 C.F.R. § [1.560](#) and MPEP § [2281](#).

10. What types of prior art patents and printed publications can I use in reexamination request?

Answer: As noted above, public use and on-sale bar issues are not proper bases for a reexamination request. Appropriate patents and printed publications may constitute newly discovered art, or even previously considered art of the original prosecution.

There is no prohibition in forming an SNQ based on previously considered references. *See* MPEP §§ [2216](#) and [2242](#). When an SNQ is presented relying entirely upon references that were cited during prosecution, they must be discussed in a new light that was not considered during the prosecution of the original patent. *See* MPEP §§ [2216](#) and [2242\(II\)\(A\)](#). Where the Examiner during prosecution never discussed or applied the reference, this reference may form the basis of an SNQ. The new light must be of a technical nature or availability of "prior art" rather than based upon a change in the law (e.g., *KSR*). *See*, for example, the decision on petition in Reexamination Control Number 90/008,949 mailed October 24, 2008.

11. What is my time limit for responding to Office Actions in *ex parte* or *inter partes* reexamination?

Answer: The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. See 35 U.S.C. § [304](#); 37 C.F.R. § [1.550\(b\)](#); and MPEP § [2263](#). In response to any rejection, such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be allowable or confirmable. Typically, a two month response period is given, unless the patent involved in the reexamination is involved in a stayed litigation; in that case a one month or 30 day period for reply, whichever is longer, is given. Response periods may vary in *inter partes* reexamination as detailed below (depending on the stage of prosecution).

12. Can I obtain extensions of time as a matter of right in reexamination?

Answer: Extensions of time are not granted as a matter of right. They are quite difficult to obtain. Exceptional circumstances must be shown in order for an extension of time to be granted. The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. See 37 C.F.R. § [1.550\(c\)](#) and MPEP § [2265](#). Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension of time. Any request for such extension must be accompanied by the petition fee set forth in 37 C.F.R. § [1.17\(g\)](#).

13. If I amend the claims in *ex parte* or *inter partes* reexamination, what rights do I have to assert those claims?

Answer: Any proposed amended or new claim determined to be patentable and incorporated into a patent following a reexamination proceeding will create intervening rights as that specified in of 35 U.S.C. § [252](#) for reissued patents. Thus, you can assert the reexamined patent against infringers subject to the applicability of intervening rights. The doctrine of intervening rights protects 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 for the same, prior to issuance of an *ex parte* Reexamination Certificate. See 35 U.S.C. § [307](#) and MPEP § [2293](#).

14. Are there special filing requirements?

Answer: Responses may be filed on paper or electronically. See MPEP § [2224](#). However, in both instances the patent owner must be served with a certificate of service providing notice of the reexamination request. See MPEP § [2220](#). However, where the patent owner cannot be located, an extra copy of the reexamination request may be sent to the USPTO who in turn will seek to provide the patent owner with a copy of the reexamination request. A copy of the certificate of service must be provided to the USPTO. Likewise, when responding to an Office Action or submitting any other paper to the Office in furtherance of

prosecution, a Patent Owner must serve the third party requester with a certificate of service providing notice of the same.

15. How do I satisfy the duty of disclosure in patent reexamination?

Answer: The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if all information known to be material to patentability of any claim in the patent after issuance of the reexamination certificate was cited by the Office or submitted to the Office in an information disclosure statement. However, the duties of candor, good faith, and disclosure have not been complied with if any fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct by, or on behalf of, the patent owner in the reexamination proceeding. Any information disclosure statement must be filed with the items listed in 37 C.F.R. § [1.98\(a\)](#) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible. See 37 C.F.R. § [1.555](#) and MPEP § [2280](#).

Patent Reexamination

B. *Inter Partes* Reexamination 35 U.S.C. § 311

1. Why would I use *inter partes* reexamination as opposed to an *ex parte* reexamination?

Answer: The third party requester can participate in each stage of the reexamination proceedings and has an independent right of appeal to the BPAI and Federal Circuit. Although limited statistics are available due to the relative short history of the proceeding, statistics have shown that *inter partes* reexamination is especially effective procedure to force cancellation or amendment of claims in issued patents⁷.

2. When is an *inter partes* reexamination proper?

Answer: *Inter partes* reexamination is proper when the third party requester is not estopped from requesting *inter partes* reexamination based on a previous court or USPTO determination and the patent was granted on an application having an actual filing date on or after **November 29, 1999**. See 35 U.S.C. § [311](#); 37 C.F.R. §§ [1.907](#) and [1.913](#); and MPEP §§ [2611](#) and [2612](#).

3. Can an *inter partes* request be filed anonymously?

Answer: No, The real party in interest must be identified in the *inter partes* reexamination request, anonymous filings are not accepted. See 35 U.S.C. § [311\(b\)\(1\)](#); 37 C.F.R. § [1.915\(b\)\(8\)](#); and MPEP § [2610](#).

4. What are some common strategic reasons for filing an *inter partes* reexamination?

Answer: As with *ex parte* reexamination, should *inter partes* reexamination cause the original patent claims to be amended or canceled, intervening rights may apply. Likewise, non-infringement positions may result from the claim amendments.

For patents asserted in a concurrent litigation, the patent owner may seek to settle the litigation on favorable terms to the third party requester. If the third party requester ceases to participate in the *inter partes* reexamination proceedings as a condition of the settlement agreement, the reexamination will still continue between the patent owner and the USPTO. The *inter partes* reexamination proceedings, much like *ex parte* reexamination proceedings, may be the foundation for inequitable conduct defenses against the patent owner to have the

⁷ <http://www.uspto.gov/web/patents/cru.html> contains statistics published by the USPTO for both *ex parte* and *inter partes* reexamination proceedings.

reexamined patent held unenforceable, or the reexamination may serve to delay or stay the concurrent litigation.

5. Is there a limit on when I can request an *inter partes* reexamination application?

Answer: Yes. Much like with *ex parte* reexamination, a request for *inter partes* reexamination can be filed only during the period of enforceability of a patent. The period of enforceability is determined by adding 6 years to the date on which the patent expires. See 37 C.F.R. § [1.913](#) and MPEP § [2611](#). As noted above, only patents granted on applications filed on or after **November 29, 1999**, are eligible for *inter partes* reexamination. See MPEP § [2611](#).

6. What are the dates that I need to keep in mind for my participation in the *inter partes* reexamination proceedings?

Answer: Due dates in *inter partes* reexamination are tricky. The fact that a third party is involved means that dates cannot always be triggered by the mailing date of an Office action. The confusion is compounded by the rules, which do not limit response due date triggers to one type of event (such as a service date), even where this would be possible.

A patent owner's response to an office action is keyed to the mailing date of the action, but depends on whether the action is non-final or an action closing prosecution. A response to a non-final action is due within two months of the mailing date of the action, whereas a response to an action closing prosecution is due within one month or 30 days, whichever is longer. Requester comments, however, are due within 30 days from the *service date* of the response, typically the date in which the response was placed in the mail to the requester. Notably, the requester's 30-day period for response is statutory and not “one month or thirty days, whichever is longer,” and is not triggered by the date of filing of the response, the date the patent owner's deadline expired, or the date the response is received by the requester. See MPEP §§ [2662\(A\)\(1\)](#), [2662\(C\)](#) and [2662\(B\)](#).

Practitioners must pay careful attention to these deadlines, as failure to meet them generally has consequences more severe than those incurred in *ex parte* patent application prosecution.

7. Can I file a second request for *inter partes* reexamination?

Answer: Once an order to reexamine has been issued under 37 C.F.R. § [1.931](#), neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued under 37 C.F.R. § [1.997](#), unless authorized by the Director. See 37 C.F.R. § [1.907\(a\)](#). If a final decision in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding. See 37 C.F.R. § [1.907\(c\)](#).

Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. § [1338](#)⁸ that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and 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. See 37 C.F.R. § [1.907\(b\)](#).

8. Are there limits on my participation during examination?

Answer: Each time the patent owner files a response to an Office action on the merits pursuant to 37 C.F.R. § [1.945](#), a third party requester may once file written comments within a statutory period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under 37 C.F.R. § [1.8](#). See 37 C.F.R. § [1.947](#) and MPEP § [2666.05](#).

9. Are interviews with the Examiner permitted in *inter partes* reexamination?

Answer: No, Interviews on the merits are prohibited in *inter partes* reexamination proceedings pursuant to 37 C.F.R. § [1.955](#). However, questions on strictly procedural matters may be discussed with the parties. Any information which a person could obtain *by reading the file* (which is open to the public) is procedural, and it *may be discussed*. Matters *not available from a reading of the file* are considered as relating to the merits of the proceeding, and *may not be discussed*. Thus, for example, a question relating to when the next Office action will be rendered is improper as it relates to the merits of the proceeding (because this information cannot be obtained from a reading of the file). See MPEP § [2685](#).

The Office may, **in its sole discretion**, telephone a party as to matters of completing or correcting the record of a file, where the subject matter discussed does not go to the merits of the reexamination proceeding. This informal telephone call may take the form of inquiring as to whether a timely response, timely appeal, etc., was filed with the Office, so as to make certain that a timely response, timely appeal, etc. has not been misdirected within the Office. This may also take the form of telephoning to obtain a paper stated to have been attached to, or included in, a filing, but not found to be present in the record. Likewise, calls to obtain a certificate of service, or to have a party re-submit a paper (e.g., where it was submitted via an improper means), may be made by the Office. Any such telephone call IS NOT TO BE MADE by the examiner, or any other Office employee who addresses the proceeding on its merits. Thus, a paralegal or Legal Instruments Examiner (or support staff in general), may make such a telephone call. If the party is reached by telephone and the matter is resolved,

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Such civil actions are limited to federal district court suits and do not include ITC proceedings.

then the next Office communication as may be appropriate (e.g., Office action, NIRC) should will make the telephone call of record. Any statement of the telephone call in the next communication must provide that “the content of the telephone call was limited solely to” the non-merits matter discussed, and “nothing else was discussed.” Such a telephone call is not to be recorded on an interview summary record form. See MPEP § [2685](#).

It is also permitted for a paralegal or Legal Instruments Examiner (or support staff in general) to call a requester to discuss a request that fails to comply with the filing date requirements for filing a reexamination request, because there is no reexamination proceeding yet, and 37 C.F.R. § [1.955](#) proscribes interviews in “*inter partes* reexamination proceedings.” See MPEP § [2685](#).

10. Do I have a right to appeal as a third party?

Answer: Yes. A Right of Appeal Notice (RAN) is a final Office action which presents a final decision to reject the claims (i.e., a final decision that the claims are rejected) and/or a final decision favorable to patentability as to the claims (i.e., a final decision not to make a proposed rejection). See MPEP § [2673.02](#). As set forth in 37 C.F.R. § [1.953](#).

11. What is the down-side to “losing” (i.e. preclusive effects)?

Answer: See Answer to question (7).

12. What happens to the *inter partes* reexamination proceedings when a final district court judgment is entered?

Answer: The third party is estopped from maintaining the *inter partes* reexamination under 35 U.S.C. § [317\(b\)](#). The PTO will vacate the *inter partes* proceedings without any decision on the merits of any then pending rejected claims. The PTO will not convert the proceedings to an *ex parte* reexamination. No reexamination certificate will issue.

The third party would not be precluded from requesting *ex parte* reexamination of the patent, but would be estopped from requesting an *inter partes* reexamination of the patent. Third parties, not in privity with the estopped party would be able to request an *inter partes* reexamination of the patent. See MPEP § [2686.04](#).

Patent Reexamination

C. MPEP TABLE OF CASES

Case Name	Citation	Subject Matter	Description of Significance
KSR International Co. v. Teleflex, Inc.	550 USPQ2d 1385 (2007)	(substantial new question)	Requesting reexamination based solely on KSR's obviousness standard, "without presenting [art] in a new light, or different way, will not raise a substantial new question."
Trans Texas Holdings Corp., In re	498 F.3d 1290 (Fed. Cir. 2007)	(parallel proceedings)	(Federal Circuit upheld PTO reexamination decision which conflicted with parallel district court decision, finding issue preclusion inapplicable to PTO who was a non-party to the earlier infringement proceeding.)
Translogic Technology, Inc., In re	504 F.3d 1249 (Fed. Cir. 2007)	(parallel proceedings)	(Federal Circuit upheld PTO reexamination decision which conflicted with parallel district court proceeding decision, after consolidating the appeals and addressing only the Board's decision.)
Sony Computer Entertainment America, Inc. v. Dudas	85 USPQ2d 1594 (E.D. Va. 2006)	stays pending litigation	(PTO is able to initiate a reexamination on its own initiative of non-requested claims and also suspend an inter

Case Name	Citation	Subject Matter	Description of Significance
			partes reexamination proceeding pending outcome of district court litigation.)
Phillips v. AWH Corp.	415 F.3d 1303 (Fed. Cir. 2005)	(claim construction)	(Phillips claim construction standard should be applied in reexamination of claims in an expired patent.)
Heinl v. Godici	143 F. Supp. 2d 593 (E.D. Va. 2001)	(substantial new question)	(Director finding a substantial new question and ordering reexamination is not reviewable.)
Hiniker Co., In re	150 F.3d 1362 (Fed. Cir. 1998)	(prior art)	(Prior art submitted in prior prosecution for same patent is termed "old art.")
Lonardo, In re	119 F.3d 960 (Fed. Cir. 1997)	(double patenting)	("Double patenting is normally proper for consideration in reexamination.")
Portola Packaging, Inc., In re	110 F.3d 786 (Fed. Cir. 1997)	(substantial new question - old art)	("Old art" in a reexamination ordered prior to November 2, 2002, is controlled by In re Portola.)
Emerson Elec. Co. v. Davoil Inc.	88 F.3d 1051 (Fed. Cir. 1996)	(conduct of proceedings - submissions)	(Federal District Courts may not order patent owner to file papers prepared by a third party.)
Recreative Technologies, In re	83 F.3d 1394 (Fed. Cir. 1996)	(substantial new question)	(Previously considered question of patentability, in earlier examination, cannot be substantially new question.)

Case Name	Citation	Subject Matter	Description of Significance
Freeman, In re	30 F.3d 1459 (Fed. Cir. 1994)	(claim scope enlargement)	(Test for enlargement of claim scope is the same in reexamination as in reissue.)
Zletz, In re	893 F.2d 319 (Fed. Cir. 1989)	(substantial new question)	(Final Federal Court decision does not preclude reexamination before PTO.)
Boeing Co. v. Comm'r Pat.	853 F.2d 878 (Fed. Cir. 1988)	(third-party requester - appeal)	(Third party requester may be permitted to participate in civil action, but lacks standing to appeal decision.)
Greenwood v. Seiko Instruments	8 USPQ2d 1455 (D.D.C. 1988)	(appeal)	("Reexamination statute does not provide for review of a patentability decision favoring the patentee.")
Katrapat, In re	6 USPQ2d 1863 (Comm'r Pat. 1988)	(unavoidable delay)	("The unavoidable delay provisions of 35 U.S.C. 133 are imported into, and are applicable to, reexamination proceedings by 35 U.S.C. 305 and 314.")
McGaughey, Ex parte	6 USPQ2d 1334 (Bd. Pat. App. & Inter. 1988)	(reexamination request)	(Consideration of a reexamination request is limited to patents, printed publications, or both.)
Patlex Corp. v. Quigg	680 F. Supp. 33 (D. D.C. 1988)	(substantial new question)	(Substantial new question determination is at Director's entire discretion and not subject to judicial review.)*

Case Name	Citation	Subject Matter	Description of Significance
Theodor Groz & Sohne & Ernst Beckert Nadelfabrik KG v. Quigg	10 USPQ2d 1787 (D.D.C. 1988)	(conduct of proceedings)	(Additional time may be appropriate to complete response to examiner's position on amendments made after final rejection.)
Fortel Corp. v. Phone-Mate Inc.	825 F.2d 1577 (Fed. Cir. 1987)	(intervening rights)	(Intervening rights, detailed in 35 U.S.C. 252, apply equally in reissue and reexamination proceedings.)
Joy Mfg. Co. v. National Mine Service Co.	810 F.2d 1127 (Fed. Cir. 1987)	(order granting reexamination)	(Substantial new question decision is not reviewable until a final agency decision has issued in the reexamination.)*
Key Mfg. Group Inc. v. Microdot Inc.	679 F. Supp. 648 (E.D. Mich. 1987)	(intervening rights)	(Intervening rights, detailed in 35 U.S.C. 252, apply equally in reissue and reexamination proceedings.)
Tennant v. Hako Minuteman	4 USPQ2d 1167 (N.D. Ill. 1987)	(intervening rights)	(Intervening rights, detailed in 35 U.S.C. 252, apply equally in reissue and reexamination proceedings.)
Yuasa Battery v. Comm'r	3 USPQ2d 1143 (D.D.C. 1987)	(appeal)	(Third party requester of an ex parte reexamination may not seek judicial review of decision.)
Kaufman Co. v. Lantech Inc.	807 F.2d 970 (Fed. Cir. 1986)	(intervening rights)	(Intervening rights, detailed in 35 U.S.C. 252, apply equally in reissue and reexamination)

Case Name	Citation	Subject Matter	Description of Significance
Lanham, In re	1 USPQ2d 1877 (Comm'r Pat. 1986)	(grounds for rejection)	(Rejections in reexamination may be based only on other patents, printed publications, or both.)
Papst-Motoren, In re	1 USPQ2d 1655 (Bd. Pat. App. & Inter. 1986)	(claim interpretation)	(Policy of narrow construction should be applied to claims of an expired patent under reexamination.)
Reed v. Quigg	110 F.R.D. 363 (D.D.C. 1986)	(third party requester - appeal)	(Though statutes are silent, practice has allowed third party requesters to participate in court review of reexamination decisions.)
Stewart Sys. v. Commissioner	1 USPQ2d 1879 (E.D. Va. 1986)	(basis for rejection)	(Rejections in reexamination may be based only on other patents, printed publications, or both.)
Etter, In re	756 F.2d 852 (Fed. Cir. 1985)	(presumption of validity)	(No 35 U.S.C. 282 presumption of validity in reexamination.)
Horton, Ex parte	226 USPQ 697 (Bd. Pat. App. & Inter. 1985)	(basis for rejection - admissions)	(Admissions used as a basis for rejection, must relate to patents, printed publications, or both.)
Kimbell, Ex parte	226 USPQ 688 (Bd. App. 1985)	(basis for rejection - admissions)	(Admissions may be considered in reexamination proceedings.)
Loffland Bros. Co. v. Mid-Western Energy Corp.	225 USPQ 886 (W.D. Okla. 1985)	(conduct of reexamination proceedings)	(For court ordered reexaminations, office actions will normally set a 1-month, extendable for cause, shortened

Case Name	Citation	Subject Matter	Description of Significance
			statutory period for response.)
Obiaya, Ex parte	227 USPQ 58 (Bd. Pat. App. & Inter. 1985)	(double patenting)	("Double patenting rejections are analogous to... 35 U.S.C. 103 rejections, and depend on the presence of a prior patent as the basis for the rejection.")
Onda, In re	229 USPQ 235 (Comm'r Pat. 1985)	(concurrent post-grant proceedings)	(Concurrent reissue and reexamination proceedings are usually merged or one stayed.)
Patlex Corp. v. Mossinghoff	758 F.2d 594 (Fed. Cir. 1985)	(request for reexamination)	(Reexamination is available only during the period of enforceability of the patent.)
Patlex Corp. v. Mossinghoff	771 F.2d 480 (Fed. Cir. 1985)	(diligence in filing)	(Papers on the merits filed prior to order granting reexamination will be returned, but may be submitted later in the proceeding if appropriate.)
Vamco Machine and Tool, Inc., In re	752 F.2d 1564 (Fed. Cir. 1985)	(expedition)	(Reexaminations on court order or during stay of concurrent litigation are expedited in the PTO.)
Chicago Rawhide Mfg. Co., Ex parte	223 USPQ 351 (Bd. Pat. App. & Inter. 1984)	(substantial new question - old art)	("Old art" must include an explanation of why it is being viewed in a new light or different way as compared to earlier concluded examination.)

Case Name	Citation	Subject Matter	Description of Significance
Seiko Koko Kabushiki Kaisha, Ex parte	225 USPQ 1260 (Bd. App. 1984)	(basis for rejection - admissions)	(Admission of prior art in specification of parent application is prior art which may be considered in determining obviousness for reexamination application.)
Toro Co. v. L.R. Nelson Corp.	223 USPQ 636 (C.D. Ill. 1984)	(conduct of reexamination proceedings)	(In court ordered reexaminations, office actions will normally set a 1-month shortened statutory period for response.)
Yamamoto, In re	740 F.2d 1569 (Fed. Cir. 1984)	(claim interpretation)	("During reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims".)
Gould v. Control Laser Corp.	705 F.2d 1340 (Fed. Cir. 1983)	(conduct of reexamination proceedings)	(In court ordered reexaminations, office actions will normally set a 1-month, extendable for cause, shortened statutory period for response.)
Digital Magnetic Sys., Inc. v. Ansley	213 USPQ 290 (W.D. Okla. 1982)	(conduct of reexamination proceedings)	(In court ordered reexaminations, office actions will normally set a 1-month, extendable for cause, shortened statutory period for response.)

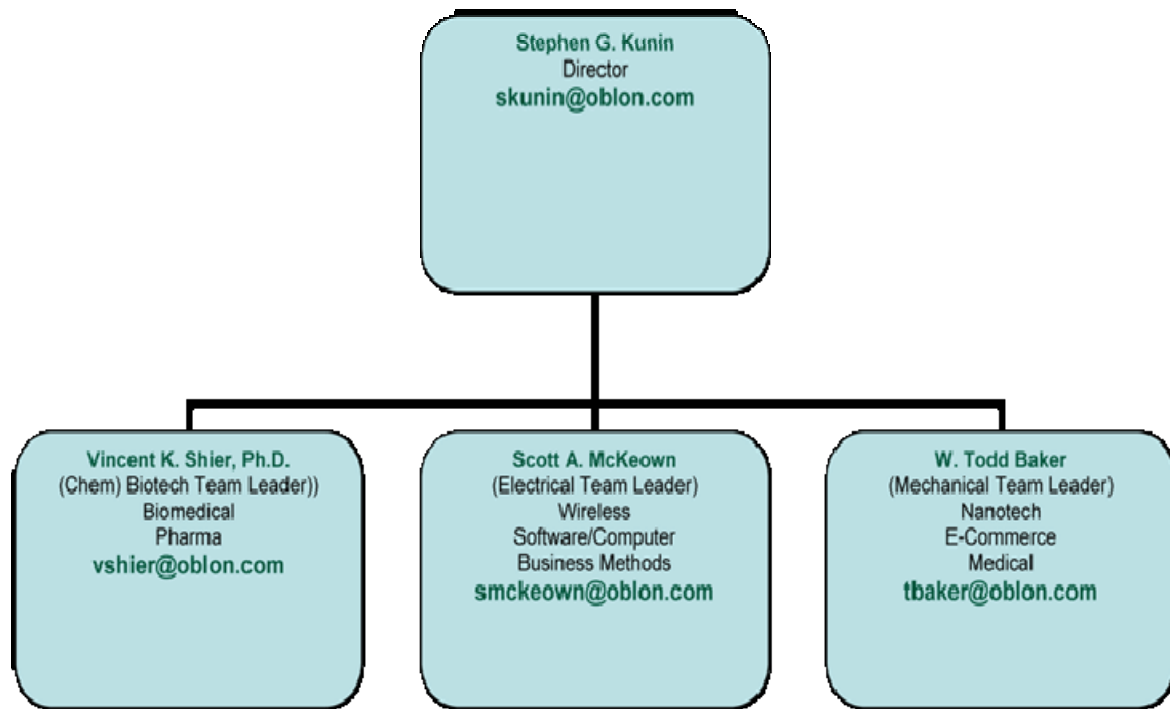
Case Name	Citation	Subject Matter	Description of Significance
Knight, In re	217 USPQ 294 (Comm'r Pat. 1982)	(diligence in filing)	(Papers on the merits filed prior to order granting reexamination will be returned, but may be submitted later in the proceedings if appropriate.)
Scragg, In re	215 USPQ 715 (Comm'r Pat. 1982)	(merger of proceedings)	(The stage of reissue proceeding will influence decision to merge reissue with reexamination proceeding , or stay one of them.)
Stoddard, In re	213 USPQ 386 (Comm'r Pat. 1982)	(merger of proceedings)	(The stage of reissue proceeding will influence decision to merge reissue with reexamination proceeding , or stay one of them.)
Amp, In re	212 USPQ 826 (Comm'r Pat. 1981)	(diligence in filing)	(Papers on the merits filed prior to order granting reexamination will be returned, but may be submitted later in the proceedings if appropriate.)
Dresser Indus. Inc. v. Ford Motor Co.	530 F. Supp. 303 (N.D. Texas 1981)	(conduct of reexamination proceedings)	(In court ordered reexaminations, office actions will normally set a 1-month, extendable for cause, shortened statutory period for response.)
Raytek, Inc. v. Solfan Systems, Inc.	211 USPQ 405 (N.D. Cal. 1981)	(expedition)	(Reexaminations on court order or during stay of concurrent litigation are expedited in the PTO.)

Case Name	Citation	Subject Matter	Description of Significance
Nomiya, In re	509 F.2d 566 (CCPA 1975)	(basis for rejection - admissions)	(Admissions of prior art in specification of parent is prior art which may be considered in determining obviousness for reexamination application.)
Van Langenhoven, In re	458 F.2d 132 (CCPA 1972)	(prior art)	(Patents or printed publications that emerge between effective filing dates of parent and child are available as prior art.)
Graham v. John Deere	383 U.S. 1 (1966)	(basis for rejection - admissions)	(Admissions may be used in evaluating the scope and content of prior art when determining obviousness during reexamination.)
Ruscetta, In re	255 F.2d 687 (CCPA 1958)	(prior art)	(Patents or printed publications that emerge between effective filing dates of parent and child are available as prior art.)
Quayle, Ex parte	25 USPQ 74, 1935 C.D. 11	(conduct of reexamination proceedings)	(When appropriate, Examiner has the authority to withdraw and issue a new Office Action, or close prosecution based on allowance.)
Greenfield, In re	40 F.2d 775 (CCPA 1930)	(new ground of rejection)	(Non-extendable 1-month period to request rehearing of a new ground of rejection.)
Norlund, Ex parte	1913 C.D. 161, 192 O.G. 989 (Comm'r Pat. 1913)	(amendment on board recommendation)	(Absent an express recommendation, a Board remark that a certain feature does not appear in a claim is not a

Case Name	Citation	Subject Matter	Description of Significance
			recommendation that the claim be allowed if the the feature is added by amendment.)
Burrowes, Ex parte	1904 C.D. 155, 110 O.G. 599 (Comm'r Pat. 1904)	(response to new ground of rejection)	(In submitting a response, patent owner may amend the claims, or substitute new claims to avoid rejection.)

Patent Reexamination

D. Oblon Spivak Reexamination/Reissue Practice Group



Patent Reexamination

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STEPHEN G. KUNIN's practice principally includes serving as the Director of the Reissue/Reexamination Practice Group; testifying expert witness on patent examination policy, practice and procedure and providing consultation services to clients on patent law reform, rulemaking, and strategic approaches to dealing with complex patent prosecution matters. He is the former Deputy Commissioner for Patent Examination Policy with the U.S. Patent and Trademark Office. He has more than 38 years of expertise in intellectual property rights protection and 24 years of organizational management and leadership experience. He was appointed to his former position in March 2000 and has served in a similar capacity since November 1994, under the position's prior title, "Deputy Assistant Commissioner for Patent Policy and Projects." Previously, beginning in July 1989, Mr. Kunin served as Deputy Assistant Commissioner for Patents. He participated in the establishment of patent policy for the various Patent Organizations under the Commissioner for Patents, including changes in patent practice, revision of rules of practice and procedures, establishment of examining priorities and classification of technological arts, and oversaw the operations of the Office of Patent Legal Administration, Patent Cooperation Treaty Legal Administration, and the Office of Petitions. Additionally, in January 1993, Mr. Kunin was designated by the Secretary of Commerce to perform the functions of the Assistant Commissioner for Patents on an acting basis until a new Assistant Commissioner for Patents was appointed in 1994.

Mr. Kunin, as a Partner, serves as a patent consultant who advises clients on patent prosecution and policy matters and prepares infringement and non-infringement opinions. He also serves as an expert witness on patent law, policy, practice and procedure.

Mr. Kunin also now serves as the Intellectual Property Program Director at the George Mason School of Law where he is an adjunct professor who teaches patent law and intellectual property law classes.

Mr. Kunin graduated with honors from Washington University in May of 1970 with a B.S. degree in Electrical Engineering. He attended the National Law Center of the George

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A significant portion of Mr. McKeown's work involves post grant proceedings, including patent Reissue practice, Ex Parte, and Inter Partes patent reexamination. Mr. McKeown has worked extensively in the patent reexamination area as the USPTO's Central Reexamination Unit has become a more common alternative to traditional litigation based validity challenges. In this capacity, he has worked and counseled Patent Holder's on the strategic benefits of patent reexamination, as well as third party requestors.

In the telecommunication arts, Mr. McKeown has worked extensively with IP routing and signaling protocols, ATM and wireless communication protocols. He has a broad breadth of experience with OFDM systems, CDMA, TDMA, FSK, QAM and the 802.11 family of protocols.

In the consumer electronic arts, Mr. McKeown's practice has a strong focus in audio and video processing and display technologies, discs, signal compression and encoding schemes, recording medium formatting and construction, and many other related technologies. In this regard, Mr. McKeown works directly with standard setting organizations and patent pools and has successfully advocated the inclusion of his client's IP into patent pools. Additionally, he has counseled open source communities on third party IPR issues and standard setting.

Mr. McKeown received his Law degree from Temple University School of Law. He received his Bachelor of Science degree in Electrical Engineering from Temple University with honors.

Mr. McKeown is admitted to the Pennsylvania and Virginia State Bars and is registered to practice before the U. S. Patent and Trademark Office. He is a member of the Institute of Electrical and Electronics Engineers (IEEE) and the American Intellectual Property Law Association (AIPLA).



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W. TODD BAKER is a patent attorney in the firm's Reissue/Reexamination, Interference, and Electrical/Mechanical Practice Groups.

As a team leader of the Reissue and Reexamination Practice Group, a significant portion of Mr. Baker's practice involves post grant proceedings handled by the USPTO's Central Reexamination Unit including ex parte and inter partes reexaminations.

Mr. Baker is co-chair of the firm's Interference Practice Group. His practice includes advising clients on patent interference prosecution matters before the USPTO's Board of Patent Appeals and Interferences. Interference practice involves issues of priority, patentability, derivation, and inventorship. Mr. Baker's extensive experience with both reexaminations and interferences makes him particularly well suited to advise clients on alternatives to traditional litigation based validity challenges.

In addition to his post grant practice, Mr. Baker prepares and prosecutes patent applications in diversified electrical and mechanical technologies. He is a former patent examiner with the USPTO, where he specialized in multiplex communications.

Mr. Baker is currently the chair of the USPTO Inter Partes Patent Proceedings Committee (formerly known as the Interference Committee) of the American Intellectual Property Law Association. The Interference Committee was renamed and its mission revised to reflect a broadened scope encompassing interferences as well as inter partes reexamination.

Mr. Baker received his Law degree from the University of Maryland School of Law in 1996 and received his Bachelor of Science degree in Electrical Engineering from the University of Virginia in 1993. Mr. Baker is admitted to the Maryland State Bar and is registered to practice before the USPTO.



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VINCENT K. SHIER is a partner in the firm's Chemical & Biotechnology Practice Group. Dr. Shier is also a team leader of the Reissue and Reexamination Practice Group. His areas of technical expertise and practice include: biochemistry, genetics, molecular biology, and pharmaceuticals.

A significant portion of Dr. Shier's work involves post grant proceedings, including Reissue practice, and Ex Parte reexamination. Dr. Shier has worked extensively in the reexamination area on behalf of Patent Holders and Third Party Challengers as the USPTO's Central Reexamination Unit has become a viable alternative to traditional litigation based validity challenges. Additionally, he has worked and counseled Patent Holder's on the strategic benefits of self-initiated reexamination and third-party requests.

As a prosecuting attorney, Dr. Shier's work involves preparing and prosecuting patent applications in diversified technologies within the chemical and biotechnology disciplines. He has also worked extensively in the patent prosecution highway and accelerated examination programs before the USPTO. Another aspect of Dr. Shier's practice entails client counseling and the development of patent portfolio management strategies.

Dr. Shier received his J.D. from the George Washington University Law School. He received his Ph.D. in Biological Chemistry from the Pennsylvania State University. His thesis research, under the direction of Professor Stephen J. Benkovic (member of the National Academy of Sciences), focused on the characterization and inhibition of an essential, non-restriction/modification adenine DNA methyltransferase from *Caulobacter crescentus*. He received his Bachelor of Arts degree from the University of Rochester, with a double major in biology and chemistry.

Dr. Shier is actively involved with the American Bar Association's Section of Intellectual Property Law (ABA IPL), where he is currently serving on Patent Inter Partes Proceedings Committee (Committee 104). He is also actively involved with the Intellectual Property Owners Association (IPO), where he is currently serving on the Patent Office Practice (U.S.) Committee. Dr. Shier is also a member of the American Intellectual Property Law Association (AIPLA). Dr. Shier is admitted to the Virginia State Bar and is registered to practice before the U.S. Patent and Trademark Office.

Patent Reexamination

F. APPENDIX

OVERVIEW OF USPTO PROCEEDINGS FOR THE REEXAMINATION OF A U.S. PATENT

(Reproduced from uspto.gov)

Effect of a Pending Reexamination -- Each claim of a patent is presumed valid under 35 U.S.C. 282 and may be enforced notwithstanding the presence of a pending reexamination proceeding. See *Ethicon v. Quigg*, 849 F.2d 1422, 1428, 7 USPQ2d 1152, 1157 (Fed. Cir. 1988); See also *Viskase Corp. v. Am. Nat'l Can Co.*, 261 F.3d 1316, 1328, 59 USPQ2d 1823, 1831 (Fed. Cir. 2001); *In re Etter*, 756 F.2d 852, 857, 225 USPQ 1, 4 (Fed. Cir. 1985)(en banc). Although litigation may move forward in parallel with a reexamination proceeding, at the district court's discretion, the results of the reexamination proceeding may have an effect on the litigation. See e.g., *In re Translogic*, 504 F.3d 1249 (Fed. Cir. 2007). Under 35 U.S.C. 307, a patent is not revised by any amendment or cancellation of a claim made during a reexamination proceeding until a reexamination certificate is issued.

Ex Parte Reexamination – A proceeding in which any person may request reexamination of a U.S. Patent based on one or more prior patents or printed publications. A requester who is not the patent owner (i.e., a “third party requester”) has only limited participation rights in the proceeding. [MPEP 2209]

Inter Partes Reexamination – A proceeding in which any person who is not the patent owner and is not otherwise estopped may request reexamination of a U.S. Patent issued from an original application filed on or after November 29, 1999 based on one or more prior patents or printed publications. Both patent owner and third party requester have participation rights throughout the proceeding, including appeal rights. [MPEP 2609]

Reexamination Granted – An Order Granting Reexamination is not a determination of claim patentability. An Order that one or more claims of a U.S. Patent will be reexamined because the request has established the existence of at least one SNQ based upon prior patents and/or printed publications. [MPEP 2247.01]

In *ex parte* reexamination, the Order, whether granting or denying reexamination, must be mailed within three months of the filing date of the request for reexamination. [MPEP 2241]

In *inter partes* reexamination, the Order must be mailed not later than three months after the request is filed. [MPEP 2641]

Reexamination Denied – An Order Denying Reexamination is also not a determination of claim patentability. An order denying reexamination of any of the claims of a U.S. Patent because the Office has determined that no SNQ has been established in the request for reexamination. [MPEP 2247.01]

Substantial New Question of Patentability (SNQ) – A request for reexamination must establish the existence of at least one new technological teaching affecting any claim of the patent for which reexamination has been requested that was not considered by the Office in a prior Office proceeding involving the patent. The SNQ is established based on prior patents and/or printed publications. [MPEP 2242]

Notice of Filing of Request for Reexamination – Notice that a request for reexamination has been filed and accorded a filing date is published in the *Official Gazette*. [MPEP 2215]

Rejection (Non-Final) – The initial Office action on patentability.

In *ex parte* reexamination, the initial action is not mailed with the Order Granting Reexamination; the patent owner may file optional comments, to which the third party requester may respond, prior to the initial Office action. Therefore the Office must await the expiration of the periods for such comments and responses thereto before mailing the initial action. [MPEP 2262]

In *inter partes* reexamination, the initial action may optionally be mailed together with the Order Granting Reexamination, but even if not, no party comments are permitted prior the mailing of the initial action. Patent owner files a response to a non-final action that includes argument and/or an evidentiary showing and/or amendments, and the response will be entered as a matter of right. Third party requester may thereafter respond with written comments directed to the Office action and to the patent owner's response. [MPEP 2260]

Rejection (Final) – A second or subsequent action on patentability in an *ex parte* reexamination may be made “final.” While responsive arguments may be considered, entry of an amendment or consideration of additional evidence is not a matter of right in a final rejection. Patent owner may appeal to the USPTO Board of Patent Appeals and Interferences (BPAI). [MPEP 2271]

Action Closing Prosecution (ACP) – The second or subsequent action on patentability in an *inter partes* reexamination proceeding. Patent owner may respond with argument and/or an evidentiary showing and/or amendments. Alternatively, patent owner may choose not to respond. If patent owner does file a response, then third party requester may thereafter file written comments directed only to the patent owner's submission. Entry of the patent owner response is not a matter of right. Neither party may appeal at this point in the proceeding. [MPEP 2671.02]

Right of Appeal Notice (RAN) – After (1) considering any patent owner response to an ACP, and any third party requester written comments thereto, or (2) the expiration of the time for patent owner to file a response and no response has been filed, the examiner will either re-open prosecution if necessary, or issue a RAN. The RAN sets time periods in which the parties may appeal to the BPAI. The RAN also closes prosecution. Any amendment filed after a RAN will not be entered. [2673.02]

It is possible for the Office to issue a RAN after a patent owner response to the initial Office action on patentability if both parties stipulate that the issues are appropriate for a final rejection and or a final patentability determination.

Appeal to the BPAI – Ex Parte Reexamination – A notice of appeal is a proper response to a final rejection in an *ex parte* reexamination. Only patent owner may appeal. The appeal process is similar to that in a non-provisional patent application. [MPEP 2273]

Appeal to the BPAI – Inter Partes Reexamination – Either party may file a notice of appeal as a proper response to a RAN in an *inter partes* reexamination. If some claims are rejected and some claims are allowed or confirmed as patentable, both parties may appeal those determinations, file appeal briefs, respondent’s briefs directed to the other party’s appeal brief, and, after the examiner files the examiner’s answer to those briefs, file a rebuttal brief directed to the examiner’s answer. [MPEP 2674]

Subsequent (Court) Appeals – Ex Parte Reexamination – If the request for reexamination was filed prior to November 29, 1999, patent owner may appeal the decision of the BPAI to either the U.S. District Court for the District of Columbia, or to the Court of Appeals for the Federal Circuit. If the request for reexamination was filed on or after November 29, 1999, patent owner may appeal only to the Federal Circuit. [MPEP 2279]

Subsequent (Court) Appeals – Inter Partes Reexamination – Either party who was a party to an appeal to the BPAI and is dissatisfied with the result may appeal only to the Court of Appeals for the Federal Circuit. [MPEP 2683]

Concurrent Reexamination and Litigation – If there is concurrent litigation and reexamination on a patent, and the request for reexamination was filed as a result of court order, or the litigation has been stayed for the purpose of reexamination, the Office will expedite the proceedings by taking the case up for action at the earliest possible time, setting shorter response times, and permitting extensions of time only upon a strong showing of sufficient cause. [MPEP 2286]

Effect of Concluded Litigation on Reexamination – A court decision holding that a patent claim is valid will not preclude the Office from continuing to reexamine such claim in an *ex parte* reexamination proceeding, even if the court decision is final and non-appealable. The Office applies the “broadest reasonable interpretation” for claim language in a reexamination proceeding, because claims may be amended during the proceeding. Courts apply a less liberal standard of claim interpretation, and therefore, the Office may conclude that a claim held valid in a court proceeding is unpatentable or invalid in an *ex parte* reexamination proceeding. [MPEP 2286]

A final, non-appealable court decision holding that a patent claim is invalid will preclude the Office from ordering any reexamination proceeding for such claim, or, will result in termination of any reexamination proceeding previously ordered as to such claim. [MPEP 2286]

It should be noted that with respect to *inter partes* reexamination, a final, nonappealable holding in litigation that a patent claim is valid may operate to estop a party from even requesting *inter partes* reexamination of that claim, or from maintaining a previously ordered *inter partes* reexamination of that claim. Estoppel may also operate to preclude a party who has obtained an Order Granting *Inter Partes* Reexamination of a patent claim from asserting invalidity of that claim in litigation under Section 1338 of Title 28 on grounds that such party raised, or could have raised, during that *inter partes* reexamination, if that claim has been finally determined to be patentable in the *inter partes* reexamination proceeding. [MPEP 2686.04(V)]

Notice of Intent to Issue Reexamination Certificate (NIRC) – Reexamination proceedings do not become “abandoned.” Rather, an NIRC is mailed to inform the parties that a reexamination proceeding has been terminated, whether by the failure of a party to timely file a required response, or by the natural resolution of all outstanding issues of claim patentability. The NIRC lists the status of all claims that were subject to reexamination, including any patent claims that have been canceled and any claims added during the proceeding that were not part of the patent that were reexamined and determined to be patentable. The NIRC also indicates which patent claims, if any, were not reexamined. An NIRC may include an examiner’s amendment, and must include reasons for confirmation of any patent claims that were determined to be patentable without amendment, and reasons for allowance of any amended patent claims or any newly added claims. [MPEP 2287]

Reexamination Certificate – A reexamination proceeding is concluded by publication of a reexamination certificate. The certificate amends the text of the patent that was reexamined, in a manner analogous to a certificate of correction. The Reexamination Certificate will contain the text of all changes to the text of the patent that was the subject of the reexamination proceeding. [MPEP 2288 and 2290]

Notice to the Public of Reexamination Certificate – Publication of a reexamination certificate is announced in the *Official Gazette*. [MPEP 2691]