

# Patent Reexamination

## Frequently Asked Questions<sup>1</sup>

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### APPENDIX: USPTO FLOW CHART FOR REEXAMINATION

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# Patent Reexamination

## Frequently Asked Questions<sup>2</sup>

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### 1. What is Patent Reexamination?

Patent reexamination is a procedure by which a granted patent is reexamined by a primary examiner in the United States Patent & Trademark Office's Central Reexamination Unit (CRU).<sup>3</sup> The procedure was added to provide an alternative forum to the courts to challenge a patent's validity. The Patent Act provides that a request for reexamination may be submitted by "any person," which includes the patentee, any third party, or by the initiative of the USPTO Director.<sup>4</sup>

A threshold question for reexamination is whether the prior art raises a substantial new question of patentability of at least one claim.<sup>5</sup> During reexamination, only prior patents and printed publications will be considered.

When a request for reexamination is filed, the USPTO Director will evaluate the request to determine if the submitted prior art raises a substantial new question of patentability. If the Director denies the request, his decision is final and not appealable. If granted, the PTO will begin the reexamination procedure.

### 2. What is the difference between *ex parte* and *inter partes* reexamination?

*Ex parte* reexaminations, once initiated, involve only the patentee and the USPTO. If a third party files the request for reexamination, the patent owner may submit a brief or proposed amendment, or refrain from taking any action at all. If no response is submitted from the patentee, the third party is precluded from any further participation in the reexamination. If a response is submitted by the patentee, the third party initiator may file a response to the patentee's statement, at which point the third parties' substantive participation ends. There are no additional opportunities for

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<sup>3</sup> See generally 35 U.S.C. §§ 301-318; MPEP Chapters 2200, 2600; In almost all circumstances an examiner other than the one who originally examined the application will be assigned the case.

<sup>4</sup> See 35 U.S.C. § 302; MPEP § 2212

<sup>5</sup> See MPEP § 2216

the third party to submit information to the USPTO, and the third party has no right to appeal the decision in an *ex parte* reexamination.

*Inter partes* reexaminations allow the third party requesting the reexamination to actively participate in the proceeding.<sup>6</sup> Unlike an *ex parte* reexamination, the third party can file a submission to the USPTO each time the patent owner responds to an office action.<sup>7</sup> Further, the third party may appeal an adverse decision.<sup>8</sup>

### 3. Why would a third party request an *ex parte* reexamination as opposed to an *inter partes* reexamination?

At first glance, it may appear that the *inter partes* procedures are more favorable to a third party requester. However, there are a number of reasons to opt for an *ex parte* reexamination instead.

First, a third party requester can remain anonymous in an *ex parte* reexamination. Anonymity can be important to maintaining ongoing relationships while still allowing a validity challenge. Second, *ex parte* reexaminations are generally cheaper for a third party requester, because participation is limited to the initiation phase.

Finally, one critical downside to filing an *inter partes* request involves estoppel issues. If an *inter partes* request is granted and reexamination performed, the third party may not assert an invalidity defense in litigation based on prior art that was raised, or could have been raised in the reexamination proceeding.<sup>9</sup> Similarly, a final decision by a district court that the third party has not sustained its burden of proving the invalidity of any patent claim in suit will bar the third party from bringing a *inter partes* reexamination.

### 4. Why would a patentee request a reexamination of their own patent?

The reexamination will be performed at the USPTO where the CRU has specific expertise in these matters. Thus, a patentee can test the validity of his patent in front of patent experts in a shorter time, at a reduced cost, and with some procedural advantages as compared to an infringement litigation. Furthermore a patentee may amend claims to preserve some of

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<sup>6</sup> See 35 U.S.C. § 311, 314

<sup>7</sup> See 35 U.S.C. § 314 (b)(2); the third party may file written comments within 30 days from the date of service of the patentee's response.

<sup>8</sup> See 35 U.S.C. § 315 (b)

<sup>9</sup> See 35 U.S.C. § 315(c)

the original coverage, as opposed to risking an entire claim to an invalidity judgment in court.<sup>10</sup>

5. *As a patentee, why opt for reexamination over reissue?*

A patent owner may seek a reissue of the patent to narrow the scope of his claims as well. However, filling a reissue subjects *all* the claims to the *full scope* of the patent laws. By contrast, a patentee can limit a reexamination to certain claims, and the USPTO will only consider patents and printed publications under 35 U.S.C. §§ 102, 103.

6. *When may a request for reexamination be filed?*

A request for *ex parte* reexamination must be filed during the period of enforceability of a patent, which lasts 6 years after the date on which the patent expires.<sup>11</sup> The same is true for *inter partes* reexaminations, however *inter partes* examinations are only proper for patents with a filing date on or after November 29, 1999.

7. *What happens during reexamination?*

Reexamination is conducted according to the procedures established for initial examination under the provisions of 35 U.S.C. §§ 132, 133. In any reexamination proceeding, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims, in order to distinguish the invention as claimed from the prior art cited, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter.<sup>12</sup>

The USPTO may issue one or more office actions to which the patent owner may respond.<sup>13</sup> If the reexamination is *inter partes*, the third party requester may file a submission each time the patent owner responds to an office action.<sup>14</sup>

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<sup>10</sup> Note amendments in reexamination are limited to narrowing amendments. See 35 U.S.C. § 305

<sup>11</sup> See MPEP § 2216

<sup>12</sup> See 35 U.S.C § 305

<sup>13</sup> See MPEP §§ 2260-2266

<sup>14</sup> See MPEP § 2666.05

8. *May I interview the examiner during reexamination?*

Examiner interviews are allowed, but only for *ex parte* reexaminations.<sup>15</sup> Interviews on the merits are prohibited in *inter partes* proceedings.<sup>16</sup> The patent owner must file a complete written statement of the reasons presented at the interview as warranting favorable action. If the patent owner fails to file an interview summary, the reexamination may be terminated in accordance with the last Office Action.

An interview does not remove the necessity for response to Office actions. 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.

9. *What effect do claim amendments have during reexamination?*

Any amendments or new claims deemed patentable in a reexamination are valid and enforceable against infringers, but will create “intervening rights,” specified in 35 U.S.C. § 252 concerning reissue patents. Intervening rights protect any person who made, purchased, or used within the United States, or imported into the United States, anything patented by the amended or new claim, or who made substantial preparation for the same prior to issuance on an *ex parte* reexamination certificate.<sup>17</sup>

10. *What is the end result of either reexamination procedure?*

The USPTO will issue a certificate that cancels invalid claims, confirms the originally allowed claims, or incorporates any amendments or new claims deemed patentable during the proceeding.<sup>18</sup>

11. *May I file a second request for reexamination on the same patent?*

A party may file a second *ex parte* reexamination as long as a new substantial question of patentability is at issue.<sup>19</sup>

*Inter partes* reexaminations present a different scenario. Once an *inter partes* reexamination is ordered, neither the third party requester, nor its

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<sup>15</sup> See MPEP § 2281

<sup>16</sup> See 35 C.F.R. § 1.955

<sup>17</sup> See MPEP § 2293

<sup>18</sup> See 35 U.S.C. §§ 307, 316

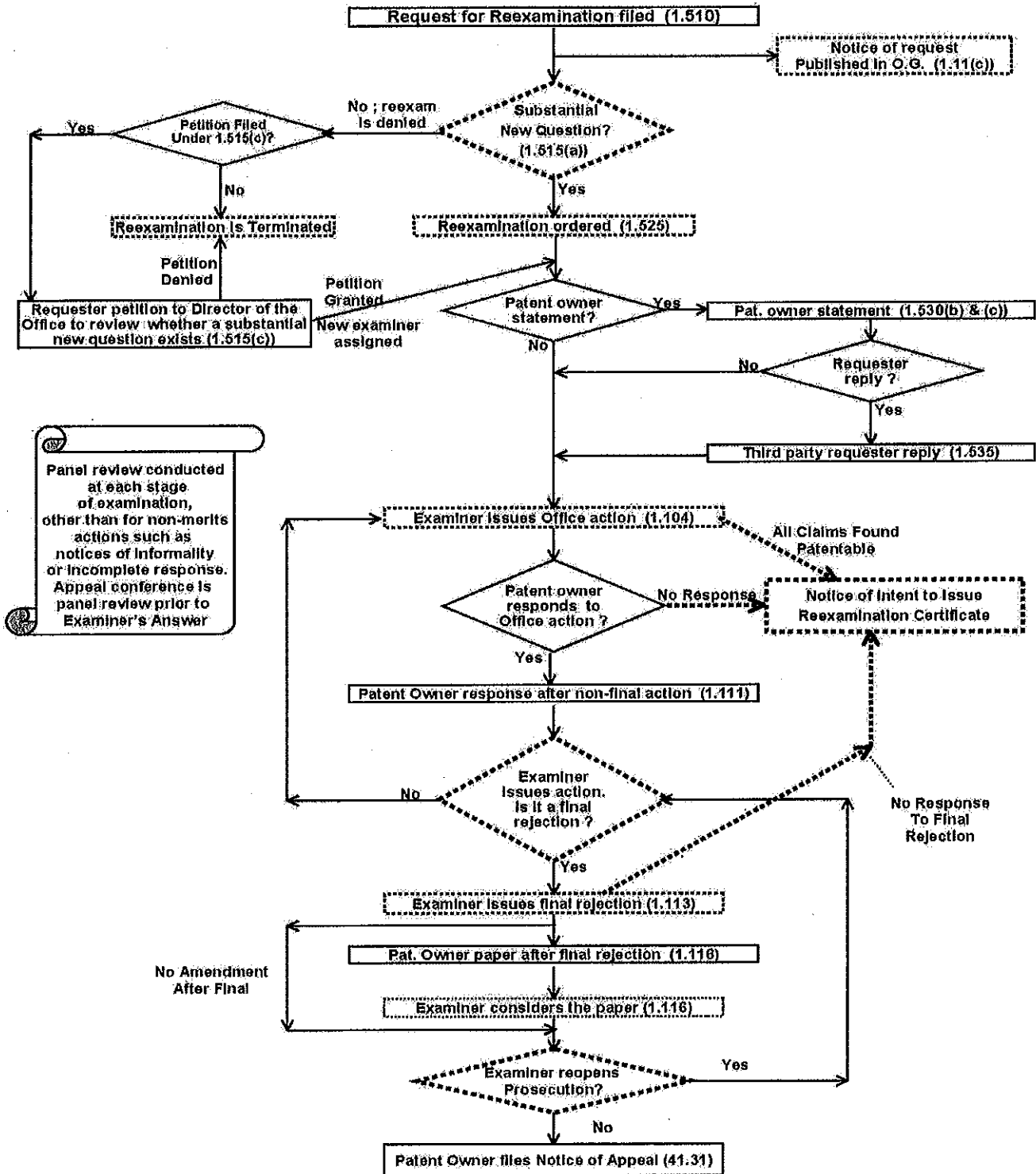
<sup>19</sup> See MPEP § 2240

privies may file another *inter partes* request until a reexamination certificate is issued. If the reexamination determines that any of the claims are patentable, then neither the third party requestor nor its privies may request *inter partes* reexamination on any claims based on issues that were raised or could have been raised in the previous proceeding.<sup>20</sup>

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<sup>20</sup> See 37 C.F.R. § 1.907(c)

**Ex Parte Reexamination - PROCEDURE PRIOR TO APPEAL**  
(applicable rule section)



# Patent Reexamination

## Frequently Asked Questions<sup>1</sup>

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# Patent Reexamination

## *Frequently Asked Questions<sup>2</sup>*

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### *1. What is a reissue patent application?*

A reissue patent application is filed post-grant to correct an error in an issued patent where the error renders the patent wholly or partially inoperable or invalid. The procedure has long been recognized by courts and was later codified in 35 U.S.C. § 251:

The USPTO director, upon request by the patentee, will correct errors in the patent and reissue the new amended patent. The term of the reissue patent will be the remaining unexpired term of the original patent,<sup>3</sup> and the reissued patent cannot contain new matter. The reissue must be for the same invention.

### *2. What types of situations call for a reissued patent?*

A broad range of errors may qualify under the reissue statute. Typical errors correctable by a reissue include a defective specification or drawing, claims that are too narrow or too broad, or failure to correctly reference priority documents.<sup>4</sup> The error may be the result of an accident or mistake, but cannot be purposeful<sup>5</sup> or deceptive. A patent may even reissue based on the prosecuting attorney's misunderstanding of the scope of the invention.

### *3. Why choose patent reissue rather than patent reexamination?*

Patent reexamination can only be performed for issues concerning novelty and obviousness.<sup>6</sup> Thus, if the patent is inoperable or invalid due to an error in the specification or issues relating to utility, written description or enablement, patent reexamination is inappropriate. For a limited time after issuance, a patent reissue may also allow the patentee to broaden the scope of his claims — a procedure that is totally precluded in a reexamination.

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<sup>3</sup> See MPEP § 1405

<sup>4</sup> 35 U.S.C. § 251

<sup>5</sup> See Question Concerning the Rule Against Recapture

<sup>6</sup> See Generally 35 U.S.C. §§ 301-318

4. *May I broaden the scope of a claim in a reissue?*

Yes, but only within two years from the grant of the original patent.<sup>7</sup> Any broadening reissue that occurs outside the two-year window will be deemed invalid. When seeking a broadening reissue, the patentee must unequivocally indicate this intent in the reissue application.

The term *broadening reissue* is a claim that enlarges the scope of the claims of the patent; *i.e.*, a claim that is greater in scope than each and every claim of the original patent.<sup>8</sup>

5. *When can I file a reissue application?*

If the patent has not expired, a patentee may file for a narrowing reissue at any time. However, once a patent expires, no reissue of any kind will be granted.<sup>9</sup> As noted in Question 4 above, a broadening reissue may only be filed within two years of the original patent grant.

6. *What is required in the oath and declaration of the reissue application?*

The reissue oath and declaration must comply with the requirements of the original oath and declaration, and further state that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.<sup>10</sup>

In addition, supplemental oaths and/or declarations may be required for supplemental errors or corrections, or if a continuing reissue application is filed.

7. *How is a reissue application examined?*

A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other

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<sup>7</sup> See U.S.C. § 251

<sup>8</sup> See MPEP § 1412.03

<sup>9</sup> See MPEP § 1415.01

<sup>10</sup> See MPEP § 1414

applications.<sup>11</sup> Reissue applications are normally examined by the same examiner who issued the patent for which reissue is requested.<sup>12</sup>

#### 8. *What is the rule against recapture?*

The rule against recapture of subject matter is an important limitation to reissue. A reissue will not be granted to “recapture” claimed subject matter that was surrendered during the prosecution of an application for the original patent.<sup>13</sup>

The rule “prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims.”<sup>14</sup> The Federal Circuit applies the following three-step test for recapture analysis:<sup>15</sup>

We apply the recapture rule as a three-step process:

- (1) First, we determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims;
- (2) Next, we determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and
- (3) Finally, we determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.

If it is determined that reissue claims recapture subject matter previously surrendered, the reissue claims will be rejected during reissue examination.

#### 9. *What effect do reissued claims have on the enforceability of an original patent?*

If a reissued patent is granted, the original patent must be surrendered. However, 35 U.S.C. § 252 provides for continuity between “substantially identical” claims between the original and reissued patents. A patentee may recover for all infringement that occurred since the date of the original patent if the respective claims are substantially identical. If the reissued claims are not substantially identical to the original claims, the original claims are unenforceable, and the patentee cannot recover for any infringing activity prior to the date of reissue.

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<sup>11</sup> See MPEP § 1440

<sup>12</sup> *Id.*

<sup>13</sup> See MPEP § 1412.02

<sup>14</sup> See *In re Clement*, 131 F.3d 1464, 1468 (Fed. Cir. 1997)

<sup>15</sup> See *North American Container, Inc. v. Plastipak, Inc.*, 415 F.3d 1335, 1349, 75 USPQ2d 1545, 1556 (Fed. Cir. 2005)

## 10. *What is the doctrine of intervening rights?*

Under the doctrine of intervening rights, a patentee's ability to recover for infringing activity based on reissued claims may be limited:

A reissued patent shall not abridge or affect the right of any person or that person's successors in business who, prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the use of, to offer to sell, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported unless the making, using, offering for sale, or selling of such thing infringes a valid claim of the reissued patent which was in the original patent.<sup>16</sup>

The doctrine protects third parties who have made decisions based on the scope of the original patent, only to find themselves infringing the reissued patent.

## 11. *What is a certificate of correction?*

A certificate of correction may be used in lieu of a reissue application.

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. Such patent, together with the certificate, shall have the same effect and operation in law as if the same had been originally issued in such corrected form.<sup>17</sup>

Furthermore, the USPTO may issue a certificate of correction for their own mistakes, with no charge to the patentee, if those mistakes are clear on the record.<sup>18</sup>

## 12. *What happens to the original patent if my reissue application is rejected or abandoned?*

The original patent remains in effect until a reissue is granted. Thus, even if the reissue is denied or abandoned, the original patent will still be enforceable. However, any file history related to a reissue will remain public.<sup>19</sup>

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<sup>16</sup> 35 U.S.C. § 252

<sup>17</sup> See 35 U.S.C. § 255

<sup>18</sup> See 35 U.S.C. § 254

<sup>19</sup> See MPEP § 1416