



## **Post Grant Review: Strategies for Effective Use of *Ex Parte* Reexamination Under the America Invents Act (AIA)**

**Thomas J. Bean, Esq.**

Gibbons P.C.  
One Gateway Center  
Newark, NJ 07102  
(973) 596-4727

[tbean@gibbonslaw.com](mailto:tbean@gibbonslaw.com)

**Second Annual NJIPLA Electronics, Telecom and Software  
Patent Practice Update Seminar  
January 24, 2013**

# Post Grant Proceedings Provided/Maintained By the AIA

- Supplemental Examination
- Third party pre-issuance submissions
- Citation of Prior Art and Written Statements
- Post-grant review
- *Inter partes* review
- ***Ex parte* reexamination**
- Derivation proceedings
- Certificate of correction

# After the AIA, *Ex Parte* Reexamination Is Still A Viable Option

THERE IS A TIME TO LAUGH AND  
THERE IS A TIME TO WEEP

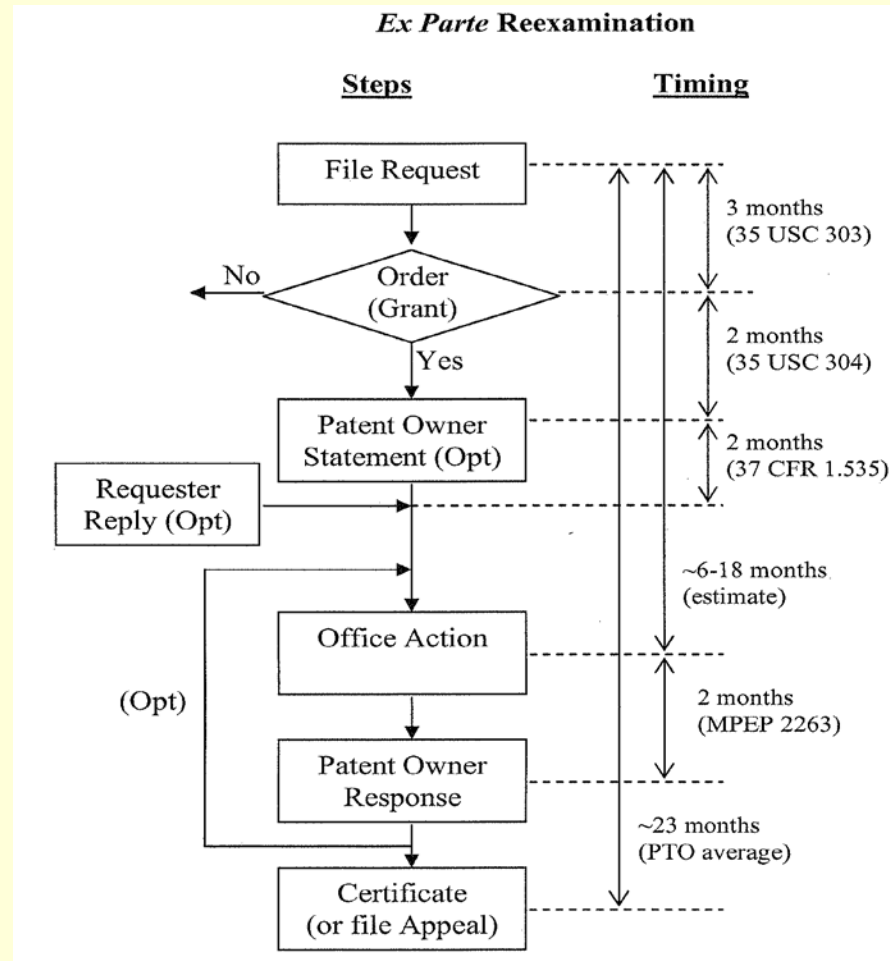


James Ross Clemens, a  
cousin of mine was seriously  
ill two or three weeks ago, <sup>in London,</sup> but  
~~was~~  
~~is~~ is well now. ~~was~~  
~~is~~  
The report of my illness  
grew out of his illness, the  
report of my death was  
an exaggeration.  
Mark Twain

# What is *Ex Parte* Reexamination?

- Introduced in 1980
- Codified in 35 U.S.C. §§ 301 – 307
- Permits a requestor to submit prior art challenging the validity of any patent
  - Prior art is limited to “patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent”
- Request is considered by Examiner in USPTO’s Central Reexamination Unit (CRU)
  - Request is granted when the Examiner determines that the submitted prior art presets a substantial new question of patentability (SNQ)
- Practice is essentially unchanged by AIA

# Ex Parte Reexamination Process



# Pros/Cons of *Ex Parte* Reexamination

- For Patentees
- For Challengers

# *Ex Parte* Reexamination for Patentees

## ■ PROS

- Less cost relative to other post-grant procedures (PGPs)
- Can address problematic prior art before litigation (“gold plating”)
- Can participate in procedure (formal statement, examiner interviews)
- Can appeal
- Under AIA, can be used in conjunction with Supplemental Examination

## ■ CONS

- Slow turnaround relative to other PGPs
- Possible narrowing or rejection of claims
- Procedure cannot be terminated at will

# Supplemental Examination

- Useful adjunct to *ex parte* reexamination for patentees
- Available at any time during the enforceability of a patent
- Advantage: information considered, reconsidered or corrected during supplemental examination cannot be basis for rendering a patent unenforceable, except no immunity:
  - As to allegations pled in civil action or noticed to patentee before supplemental examination request date, and
  - Unless supplemental examination and any resulting *ex parte* reexamination are completed before the civil action is brought
- Request is limited to no more than 12 items of information
- Decided within 3 months of filing
  - Upon finding an SNQ, *ex parte* reexamination is ordered
  - If no SNQ is found, *ex parte* reexamination is not ordered, fees are refunded and supplemental examination certificate is issued



# Comparison to Reissue Procedure

- Reissue Codified in 35 U.S.C. §§ 251, 252
  - “Whenever any patent is, through error deemed 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 he had a right to claim in the patent”
  - Former requirement for no “deceptive intention” deleted by AIA
  - Reissued patent may generate intervening rights
- All claims at issue
  - No presumption of validity of originally-issued claims
- No error, no reissue
  - A “deliberate act” will generally not provide a basis for reissue
  - Omission of narrower, dependent claims does not provide a basis for reissue (In re Tanaka, Fed. Cir. 2011)
- Can obtain broader claims within 2 years of issue
  - Unless covered by claims canceled from original application (recapture

# *Ex Parte* Reexamination for Challengers

## ■ PROS

- Less cost relative to other PGPs
- Requester anonymity
- File history estoppel, claim construction positions
- No restriction on multiple requests, or subsequent IPR
- Possible litigation stay

## ■ CONS

- No participation by challenger after filing Request
- Slow turnaround relative to other PGPs
- Perhaps less effective for litigation stay than other PGPs
- Possible confirmation for patentee of at least some claims (“gold plating”)

# Comparison of *Ex Parte* Reexamination to IPR, PGR

- SNQ presents a lower threshold for proceeding
  - “more likely than not” that at least one claim is unpatentable (PGR)
  - “reasonable likelihood that the petitioner would prevail (IPR)
- Can be anonymous
- Limited estoppel
  - Under AIA, Petitioner who files IPR/PGR may be estopped from subsequent *ex parte* reexamination as to issues that could have been raised in the IPR/PGR (35 U.S.C. §§ 315(e)(1), 325(e)(1))
- Patentee has more rights than Challenger
  - Examiner interviews
  - Appeals
- Less “Adjudicative”
  - Administered by examiners (CRU), not administrative judges (PTAB)
  - No provisions for discovery
  - No provisions for settlement/dismissal

# In a Nutshell ...

- *Ex parte* reexamination remains a relatively **cost-effective** PGR alternative after AIA
- With supplemental examination, it can provide **patentees** with a good tool for **strengthening patents** in advance of assertion, litigation activities
- It can provide some **unique tactical benefits** for **challengers**, e.g.
  - anonymity as shield against retaliation by patentee
  - Limited estoppel enables threat of successive requests with increasingly strong art for settlement leverage with patentee

# References

- *Ex Parte* Reexamination
  - 35 U.S.C. §§ 301 - 307
  - 37 C.F.R. §§ 1.501 - 1.570
  - MPEP Chapter 2200
- Reissue
  - 35 U.S.C. §§ 251, 252
  - 37 C.F.R. §§ 1.171 - 1.179
  - MPEP Chapter 1400
- Supplemental Examination
  - Final Rules (77 Fed. Reg. 48828, August 14, 2012)
- Douglas C. Duskocil et al., *America (re)Invents Alternatives to Patent Litigation*, Goodwin Proctor IP Alert, November 28, 2012

# Post Grant Review: Strategies for Effective Use of *Ex Parte* Reexamination Under the America Invents Act (AIA)

# Thank You