

# ***INTER PARTES REEXAMINATION MECHANICS AND RESULTS***

**Eugene T. Perez**

Birch, Stewart, Kolasch & Birch, LLP

**Gerald M. Murphy, Jr.**

Birch, Stewart, Kolasch & Birch, LLP

**Leonard R. Svensson**

Birch, Stewart, Kolasch & Birch, LLP

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**EUGENE PEREZ** is a partner in the Biotechnological and Chemical group at Birch, Stewart, Kolasch & Birch, LLP located in the Washington, D.C. area. Eugene Perez has practiced in the intellectual property field for over 10 years, specializing in chemical, pharmaceutical and biotechnology patents. His experience includes prosecuting patent applications, including corresponding with clients and preparing replies to all USPTO correspondence such as Office Actions and Restriction Requirements, conducting legal research and preparing freedom-

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to-operate, patentability, infringement, and validity opinion letters. Mr. Perez has also prepared, filed and prosecuted a variety of reexamination and reissue applications and handled numerous appeals, including Oral Hearings, before the U.S. Board of Patent Appeals and Interferences.



**GERALD M. MURPHY, JR.** is a partner in the Biotechnological and Chemical group at Birch, Stewart, Kolasch & Birch, LLP located in the Washington, D.C. area. Mr. Murphy has practiced intellectual property for over 30 years, and has prepared, filed and prosecuted numerous patent applications in the areas of biotechnology, organic chemistry, biochemistry, and pharmaceuticals. Mr. Murphy has also prepared, filed and prosecuted a variety of reexamination and reissue applications, and prepared and filed numerous Appeal Briefs within the U.S. Patent and Trademark Office. Mr. Murphy has also conducted numerous Oral Hearings before the U.S. Board of Patent Appeals and Interferences, represented clients in a variety of *inter partes* matters, including patent interferences and reexaminations. He has personally participated in about 30 patent interferences. Mr. Murphy has further counseled clients and prepared numerous opinions analyzing patent validity and infringement issues, managed worldwide patent portfolios, and prepared and presented numerous seminars before international audiences regarding U.S. patent statutory law and case law developments. Mr. Murphy

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served as the sole arbitrator in two arbitrations involving patent and licensing issues in the fields of DNA diagnostics and therapeutic monoclonal antibodies and has served as an expert witness in a patent infringement litigation.



**LEONARD SVENSSON** is a partner in the Biotechnological and Chemical group at Birch, Stewart, Kolasch & Birch, LLP located in the San Diego, CA area. Leonard Svensson has over 30 years of experience in the intellectual property field, specializing in chemical and biotechnology patents, patent interferences, and litigation. He has prepared, filed and prosecuted numerous patent applications in the areas of biotechnology, biochemistry, pharmaceuticals and organic chemistry. Mr. Svensson has represented clients in numerous patent interferences and at all stages of the proceedings, prepared, filed and prosecuted a variety of reexamination and reissue applications and handled numerous appeals, including Oral Hearings, before the U.S. Board of Patent Appeals and Interferences. Mr. Svensson is experienced in District Court patent infringement litigations and has counseled clients and prepared numerous opinions analyzing patent validity and infringement issues. He has also managed worldwide patent portfolios, including prosecution of applications in numerous countries and management of Oppositions before the Japanese Patent Office,

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European Patent Office and Australian Patent Office, and conducted due diligence studies regarding corporate intellectual patent portfolios. Mr. Svensson is also a member of the Fédération Internationale des Conseils en Propriété Industrielle (“FICPI”).

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**The Creation of the *Inter Partes*  
Reexamination Procedure and Goals  
Thereof**

Reexamination is a procedure established by statute which permits the USPTO to reconsider the patentability of the claims in the issued patent in view of prior art which was not considered in the original prosecution of the application.<sup>1</sup> The reexamination statute was amended on November 29, 1999 by Public Law 106-113. Public Law 106-113 authorized the extension of reexamination proceedings via an optional *inter partes* reexamination procedure in addition to the existing *ex parte* reexamination procedure. The final rules to implement the statutory *inter partes* reexamination option was published in the Federal Register on December 7, 2000<sup>2</sup> and in the *Official Gazette* on January 2, 2001.<sup>3</sup>

Legislative history of the statute establishing *ex parte reexamination* shows that Congress intended that “reexamination will permit efficient resolution of questions about the validity of issued patents without recourse to expensive and lengthy

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<sup>1</sup> 35 United States Code (“U.S.C.”) §§ 301-307, 311-318 and 37 Code of Federal Regulations Patents, Trademarks, and Copyrights (“C.F.R.”) §§ 1.510-1.570.

<sup>2</sup> 65 Fed. Reg. 76756.

<sup>3</sup> 1243 O.G. 12.

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litigation.”<sup>4</sup> Congress intended, therefore, that *ex parte* reexamination be an alternative to protracted or expensive patent litigation by providing an alternative means for testing the validity of patent claims through the USPTO.

Similarly, a major goal of an *inter partes* reexamination procedure is to provide a third party requester (hereinafter referred to as “TPR”) with a greater opportunity to participate in reexamination proceedings, while maintaining most of the features which make reexamination a desirable alternative to litigation in the Federal Courts. Further, the optional *inter partes* alternative also provides TPRs with appeal rights to appeal to the Board of Patent Appeals and Interferences (“BPAI”) and to participate in the patent owner’s appeal to the BPAI. Also, for any *inter partes* reexamination proceeding commenced on or after November 2, 2002, the TPR also has the appeal rights to appeal to the Court of Appeals for the Federal Circuit and to participate in the patent owner's appeal to the Federal Circuit. However, a review of the actual length of *inter partes* reexamination procedures show that such reexaminations are not always faster than Court proceedings.

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<sup>4</sup> H.R. Rep. 96-1307 Part I, 96 Cong. 2d Sess. for (1980), U.S. Code Cong. & Admin. News 1980, pages 6460, 6462-3.

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**Patents That Qualify for *Inter Partes*  
Reexamination**

For a patent issued from an original application filed prior to November 29, 1999, the statutory *inter partes* reexamination option is not available, wherein only the *ex parte* reexamination is available. However, as held by the Federal Circuit, an “original application” can include a later filed related application (e.g., continuations, divisionals, continuations-in-part, continued prosecution applications and national stage phase of international applications), even though the parent patent was filed before the critical date of November 29, 1999.<sup>5</sup>

In *Cooper Technologies*, the Court of Appeals for the Federal Circuit determined that a U.S. patent which issued from a U.S. patent application which was filed on April 14, 2003, was a patent which issued from an original application filed on or after November 29, 1999 and, therefore, was a proper subject of an *inter partes* reexamination proceeding. The appellant argued that the application filed on April 14, 2003, which issued as the U.S. Patent in the *inter partes* reexamination proceeding involved in this decision, was not the original application from which the patent issued. Instead, the appellant argued that the initial application from which the patent in the *inter partes* reexamination patent issued was a parent application, which was filed in 1993, benefit of which was claimed under 35 U.S.C. § 120 through a number of

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<sup>5</sup> *Cooper Technologies Co. v. Dudas*, 536 F.3d 1330, 87 USPQ2d 1705 (Fed. Cir. 2008).



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intervening U.S. patent applications. The Court disagreed with the appellant and based its decision in large part on what was determined to be the USPTO's reasonable published interpretation of an "original application" in the *inter partes* reexamination statute.

### **Compared to *Ex Parte* Reexamination**

Compared to an *ex parte* reexamination procedure, an *inter partes* reexamination proceeding provides a third party requester (hereinafter referred to as "TPR") with a greater opportunity to participate, while maintaining most of the features which make reexamination a desirable alternative to litigation in the Federal Courts.

The *inter partes* reexamination starts with the filing of a request for reexamination, wherein the request must set forth the facts relevant to the reexamination, primarily facts pertaining to the application of the new prior art to the claims for which reexamination is requested. Typically, should the United States Patent & Trademark Office ("USPTO") grant the *inter partes* reexamination, a first Office Action issues. With certain timelines, the patent owner files a response to the Office Action and the TPR can respond to any response filed by the patent owner.

However, mistakes are made by both the patent owner and TPR

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during the course of the *inter partes* reexamination proceeding. In fact, mistakes can be made at any stage of the *inter partes* reexamination proceeding (i.e., initial requirements for filing the request for *inter partes* reexamination all the way to appeal). Certain *inter partes* reexamination proceedings are discussed below that highlight such mistakes, with suggestions on how to avoid such problems in the future.

### **Filing the Initial Request for *Inter Partes* Reexamination - Generally**

In general, the request for reexamination under an *inter partes* procedure must set forth the facts relevant to the reexamination, primarily facts pertaining to the application of the new prior art to the claims for which reexamination is requested.

Reexamination may be requested for fewer than all patent claims and, if reexamination is granted, the proceeding will generally be limited to those claims for which reexamination was requested and for which a substantial new question of patentability is found, in order to conserve USPTO resources. However, reexamination can be ordered for claims other than those for which reexamination was requested, as long as the USPTO determines that a substantial new question of patentability exists for the other claims.<sup>6</sup>

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<sup>6</sup> See *Sony Computer Entertainment America, Inc., et al. v. Jon W. Dudas*, No. 1:05cv1447, 85 U.S.P.Q.2d 1594, 1601-1602 (E.D. Va. 2006).

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Reexamination requests may be based only on “patents or printed publications” and may include those previous cited or considered during prosecution before the PTO.<sup>7</sup> Thus, other potential questions relating to validity, such as prior use or prior sale<sup>8</sup> or issues of lack of written description issues or enablement,<sup>9</sup> cannot form the basis for a request for reexamination.<sup>10</sup> Only printed publications or patents may provide a basis for requesting reexamination. One standard and useful way for showing the pertinency of the new prior art to the claims in issue is to provide a chart giving a side-by-side comparison of the claim language with the pertinent disclosures in the new prior art.

### **Who Can Request an *Inter Partes* Reexamination**

Any person other than the patent owner or its privies may, at any time, file a request for *inter partes* reexamination.<sup>11</sup> The TPR can

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<sup>7</sup> 35 U.S.C. §§ 303(a) and 312(a) overruling: *In re Recreative Technology Corp.*, 32 U.S.P.Q.2d 1776 (Fed. Cir. 1996); *In re Portola Packaging Inc.*, 42 U.S.P.Q.2d 1295 (Fed. Cir. 1997); and *In re Hiniker Co.*, 47 U.S.P.Q.2d 1523 (Fed. Cir. 1998).

<sup>8</sup> 35 U.S.C. § 102(b).

<sup>9</sup> 35 U.S.C. § 112, first paragraph.

<sup>10</sup> 35 U.S.C. § 301.

<sup>11</sup> 35 U.S.C. § 301.

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request *inter partes* reexamination at any time during the period of enforceability of the patent.<sup>12</sup>

Though anyone can file, a statement with the request identifying the “real party in interest” has to be submitted (to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy).<sup>13</sup>

Typically (but not always), real parties in interest include assignees, licensees and potential licensees, infringers, potential exporters, patent litigants, interference applicants, and International Trade Commission respondents.<sup>14</sup>

### **Specific Requirements in the Initial Request for *Inter Partes* Reexamination**

The fees for filing an *inter partes* reexamination are substantially greater than those required for filing an *ex parte* reexamination. This is because the PTO will have to respond to both the patent owner and third-party requester, may have to respond to an appeal and counter appeal in every reexamination proceeding. If the

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<sup>12</sup> M.P.E.P. § 2609.

<sup>13</sup> 37 C.F.R. § 1.915(b)(8).

<sup>14</sup> M.P.E.P. § 2612.

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claims are allowed by the Examiner, then the third-party requester will likely appeal; if the claims are rejected by the Examiner, then the patent owner will likely appeal; and if there is an indication of some allowable subject matter, this will likely lead to an appeal by both the third-party requester and the patent owner.

#### (A) The Eight Requirements

The request for *inter partes* reexamination must include the appropriate fee,<sup>15</sup> and the following eight items<sup>16</sup>:

- (1) An identification of the patent by patent number and every claim for which reexamination is requested.
- (2) A citation of the patents and printed publications which are presented to provide a substantial new question of patentability.
- (3) A statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.
- (4) A copy of every patent or printed publication relied upon or referred to in paragraphs (b)(1) through (3) of this

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<sup>15</sup> 37 C.F.R. § 1.20(c)(2) (currently \$8,800); see also 37 C.F.R. 1.915(a) and M.P.E.P. § 2610.

<sup>16</sup> 37 C.F.R. 1.915(b).

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section, accompanied by an English language translation of all the necessary and pertinent parts of any non-English language document.

(5) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.

(6) A certification by the third party requester that a copy of the request has been served in its entirety on the patent owner at the address provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy of the request must be supplied to the Office.

(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the *inter partes* reexamination.

(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

**(B) Other Requirements**

In addition, if an *inter partes* request is filed by an attorney or

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agent identifying another party on whose behalf the request is being filed, the attorney or agent must have a power of attorney from that party or be acting in a representative capacity pursuant to 37 C.F.R. § 1.34.<sup>17</sup>

Finally, if the *inter partes* request does not include the fee for requesting *inter partes* reexamination required by 37 C.F.R. § 1.915(a) and meet all the requirements of 37 C.F.R. § 1.915(b), then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.<sup>18</sup>

### **Identifying the “Real Party In Interest”**

As stated in 37 C.F.R. § 915(b)(8), the TPR must provide a statement identifying the **real party in interest** to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy. Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent

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<sup>17</sup> 37 C.F.R. § 1.915(c).

<sup>18</sup> 37 C.F.R. § 1.915(d).

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request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director. The requirement avoids harassment of patent owner by multiple filings of reexaminations (whether *ex parte* or *inter partes* in nature).

However, the USPTO does not intend to look beyond this required certification. Further, the USPTO is not required to determine if a second party was a “real party in interest” in a previous *inter partes* reexamination proceeding.

### **Service**

The TPR must serve the owner of the patent with a copy of the request in its entirety.<sup>19</sup> It is required that the TPR set forth the name and address of the party served and the mode method of service on the certificate of service attached to the request. Further, the TPR must include a copy of the certificate of service with the copy of the request served on the patent owner.

After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served<sup>20</sup> on every other party in the reexamination proceeding in the manner provided in 37 C.F.R.

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<sup>19</sup> 37 C.F.R. § 1.915(b)(6).

<sup>20</sup> 37 C.F.R. § 1.903.



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§ 1.248. As proof of service, the party submitting the paper to the Office must attach a certificate of service to the paper. Also, a copy of the certificate of service must be attached with the copy of the paper that is served on the other party. The failure of the patent owner or the third party requester to serve documents may result in the USPTO refusing consideration of the filed documents.

**Demonstrating a Substantial New  
Question of Patentability**

Reexamination of the claims in *inter partes* proceedings proceed essentially the same as standard prosecution of an original patent application.<sup>21</sup> That is, questions of patentability and claim interpretation are considered on the same basis as if the application were an originally filed application. The Examiner assigned to the reexamination application is different than the original Examiner.

**(A) SNQ of Patentability**

In order for the USPTO to grant *inter partes* reexamination proceeding, and as required in 37 C.F.R. § 915(b), subsections (2)-(3), a substantial new question (“SNQ”) of patentability must be present for reexamination to be ordered. However, a “substantial new question of patentability” is not defined in the statute and is

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<sup>21</sup> 35 U.S.C. § 305.

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instead developed to some extent on a case-by-case basis.<sup>22</sup> There is no “new” SNQ of patentability if the same question was present in a previous examination of the patent. A “previous examination” is: (A) the original examination of the application which matured into the patent; (B) the examination of the patent in a reissue application that has resulted in a reissue of the patent; or (C) the examination of the patent in an earlier pending or concluded reexamination.

#### (B) How is a SNQ Determined?

The TPR must provide a statement pointing out each SNQ of patentability based on the cited patents and printed publications to every claim for which reexamination is requested.<sup>23</sup> A SNQ of patentability is defined as a reasonable examiner would consider the prior art important in deciding whether or not the claim is patentable.<sup>24</sup> This is a lower standard than a *prima facie* of unpatentability. In other words, it is not necessary that a “*prima facie*” case of unpatentability exist as to the claim in order for a SNQ of patentability to be present as to the claim. A SNQ of

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<sup>22</sup> M.P.E.P. § 2642.

<sup>23</sup> 37 C.F.R. 1.915(b)(3).

<sup>24</sup> M.P.E.P. § 2642.

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patentability is determined by the Director of the USPTO, and is not subject to an appeal.<sup>25</sup>

As stated in 37 C.F.R. § 915(b)(3), the TPR must provide a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested

For a proposed rejection for obviousness,<sup>26</sup> TPR must provide at least one basis for combining the cited references, and a statement of why the claim(s) under reexamination would have been obvious over the proposed reference combination. For instance, the TPR can provide some teaching, suggestion or motivation<sup>27</sup> as a basis for combining two cited references.<sup>28</sup>

A reexamination request relying on previously applied prior art that asks the Office to look at the art again based solely on the Supreme Court's clarification of the legal standard for determining obviousness under 35 U.S.C. § 103(a) in *KSR Int'l*, without presenting the art in new light or different way, will not raise a

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<sup>25</sup> M.P.E.P. § 2642.

<sup>26</sup> 35 U.S.C. § 103(a).

<sup>27</sup> Several rationales are set forth in *KSR Int'l Co. v. Teleflex, Inc.*, 550 US 398, 82 USPQ2d 1385 (2007); *see also* M.P.E.P. § 2173.

<sup>28</sup> *See* M.P.E.P. § 2616.

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substantial new question of patentability as to the patent claims.<sup>29</sup> Still, a request may properly raise a substantial new question of patentability by raising a material, new analysis of a previously considered reference(s) under the rationales set forth in *KSR*.

The requirement for a substantial new question of patentability remains in place even if it is clear from the record of a patent for which reexamination is requested that the patent was granted because the previous USPTO Examiner did not show “motivation” to combine, or otherwise satisfy the teaching, suggestion, or motivation (TSM) test.<sup>30</sup> Thus, reexamination will not be ordered. Still, a request may properly raise a substantial new question of patentability by raising a material, new analysis of a previously considered reference(s) under the rationales set forth in *KSR*.

### (C) Errors in Proposing SNQ of Patentability

In providing a “detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested,” the TPR can provide some teaching, suggestion or motivation<sup>31</sup> as a basis for combining two cited references.<sup>32</sup>

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<sup>29</sup> See M.P.E.P. § 2616.

<sup>30</sup> See M.P.E.P. § 2616.

<sup>31</sup> Several rationales are set forth in *KSR Int'l*; see also M.P.E.P. § 2173.

<sup>32</sup> See M.P.E.P. § 2616.

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In Reexamination Control No. 95/000,103, the TPR proposed the following rejection for obviousness:

(i) Reexamination is requested of claims 1-3 and 5-8 of Chang in view of U.S. Patent Nos. 6,678,892 ("Lavelle"); 4,983,951 ("Igarashi"); and Japanese Pub. No. 2001047921 ("Yamaoka").

A claims chart was also provided that compared the features of the disputed patent claims with the Lavelle, Igarashi and Yamaoka references. Then, the TPR states:

**III. Statement Pointing Out Each Substantial New Question Of Patentability**

There are 9 claims in Chang. Claims 1 and 5 are independent, claims 2-4 and 6-9 depending from claims 1 and 5, respectively. All the elements of claims 1 and 5 of Chang are shown or are inherently shown by Lavelle in view of Igarashi and further in view of Yamaoka. Therefore, claims 1 and 5 are rendered obvious by Lavelle in view of Igarashi and Yamaoka. Each of the dependent claims 2-3 and 6-8 are also shown to have been disclosed by Lavelle in view of Igarashi and Yamaoka.

Accordingly, a substantial new question of patentability based on Lavelle in view of Igarashi and further in view of Yamaoka exists for each of claims 1-3 and 5-8.

The following is the subsequent Action Closing Prosecution, wherein the rejection was not adopted:

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<b>ACTION CLOSING PROSECUTION (37 CFR 1.949)</b>	Control No.	Patent Under Reexamination	
	95/000,103 Examiner DAVID E. HARVEY	6871356 Art Unit 3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

**Responsive to the communication(s) filed by:**  
 Patent Owner on \_\_\_\_\_  
 Third Party(ies) on 1 August 2005

Patent owner may once file a submission under 37 CFR 1.951(a) within one month(s) from the mailing date of this Office action. Where a submission is filed, third party requester may file responsive comments under 37 CFR 1.951(b) within 30-days (not extendable- 35 U.S.C. § 314(b)(2)) from the date of service of the initial submission on the requester. **Appeal cannot be taken from this action.** Appeal can only be taken from a Right of Appeal Notice under 37 CFR 1.953.

**All correspondence** relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

**PART I. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

1.  Notice of References Cited by Examiner, PTO-892
2.  Information Disclosure Citation, PTO-1449 or PTO/SB/08
3.  \_\_\_\_\_

**PART II. SUMMARY OF ACTION:**

- 1a.  Claims 1-9 are subject to reexamination.
- 1b.  Claims \_\_\_\_\_ are not subject to reexamination.
2.  Claims \_\_\_\_\_ have been canceled.
3.  Claims 1-9 are confirmed. [Unamended patent claims]
4.  Claims \_\_\_\_\_ are patentable. [Amended or new claims]
5.  Claims \_\_\_\_\_ are rejected.
6.  Claims \_\_\_\_\_ are objected to.
7.  The drawings filed on \_\_\_\_\_  are acceptable  are not acceptable.
8.  The drawing correction request filed on \_\_\_\_\_ is:  approved.  disapproved.
9.  Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d). The certified copy has:  
 been received.  not been received.  been filed in Application/Control No \_\_\_\_\_
10.  Other \_\_\_\_\_

U.S. Patent and Trademark Office  
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The Examiner did not adopt the TPR's proposed rejection as since the TPR inadequately explained how the prior art met the claimed limitations:

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A) REASON #1

The third party requester alleges that claim 1 of the Chang patent is rendered obvious by the combined showing of Lavelle et al. [U.S. Patent #6,678,892], Igarashi [U.S. Patent #4,983,951], and Yamoaka [JP #2001-047921] for the reasons set forth in the claim chart that appears on pages 2-6 of the request. However, when one reviews this claim chart, one finds that the requester never explains how each and every limitation of claim 1 might be met by the combined teachings/showings of this prior art. For example, the Requester clearly indicates that element 122 of Figures 1A and 1B in Lavelle et al. is relied on for the showing of the recited "radio," and that element 128 (or 130) of Figures 1A and 1B in Lavelle et al. is relied on for the showing of the recited "first wireless transmitter". However, the claim chart fails to address where the applied prior art shows or suggests using the "radio" of Lavelle et al. (@ 122) to receive the audio signals that are transmitted from the "first wireless transmitter" (@ 128/130). Specifically, as described in Lavelle et al., it appears that the "radio" (@ 122) is a selectable source of the audio signaling that is transmitted to a plurality of headphones (@ 152 and 154) via the "first wireless transmitter" (@ 128/130) and, more specifically, that Lavelle et al. never shows or suggests using the "radio" to receive the audio signaling that is transmitted from "first wireless transmitter."

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Another reason the USPTO did not adopt the TPR's rejection was due to the lack of a statement of motivation to combine the references:

2-6 of the request. However, when one reviews this claim chart, one finds that the requester never explains the motivation for combining the prior art in the manner suggested by the claim chart. For example, while it is true that Igarashi et al. illustrates display device that is hinged at its upper edge, it is unclear why one would have been motivated to combine the showing with the headrest mounted display shown in Yamaoka.

Thus, the TPR did not provide a detailed explanation accounting for all claimed features, and fails to provide sufficient motivation, or some other *KSR* rationale, for combining Lavelle, Igarashi and Yamaoka. The TPR should not simply rely on a claims chart in the request for *inter partes* reexamination.

The TPR has to provide the proper rejection as well. The following are examples of inappropriate language in proposing a rejection in a request for *inter partes* reexamination<sup>33</sup>:

- Claim 1 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by, **or in the alternative**, under 35 U.S.C. § 103 as being obvious over the Smith reference.
- Claim 1 is unpatentable under 35 U.S.C. § 103 as being

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<sup>33</sup> See also M.P.E.P. § 2617(I).



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obvious over Smith **and/or** Charles.

(Emphasis added.)

The TPR inadequately setting forth a SNQ of patentability for each claim in Reexamination Control No. 95/001,001:

-- Claim 36 of the '902 patent is obvious under 35 U.S.C. 103(a) over Focsaneanu '910 in view of Farese '685 **and** Jonas '792 **or** Arango '078;"

The request asserts that there are 39 substantial new questions of patentability (see pages 19 –24). Requester has provided (see pages 20 – 24) 33 distinct proposed obviousness (103) rejections without a corresponding detailed explanation. For example, for Claim 68 alone, Requester is proposing to combine seven references:

**"Claim 68 of the '902 patent is obvious under 35 U.S.C. 103(a) over Focsaneanu '910 in view of Jonas '792 or Arango '078 or Farese '685 or Matsukawa '411 or Yoshida '516 and Lucent"**

While the corresponding claim chart provides (see pages 369 – 414) an exemplary job of explaining each reference separately the request fails to explain how each reference is combined with each of the above references presented for claim 68 which requester desires the Office to look at.

## **An *Inter Partes* Reexamination Proceeds with "Special Dispatch"**

If ordered, the actual reexamination proceeding is essentially *inter partes* in nature, and the reexamination proceeding will normally be conducted to its conclusion and the issuance of an *inter partes* reexamination certificate. Once ordered, an *inter partes* reexamination proceeding is conducted with "special dispatch",<sup>34</sup> wherein the reexamination proceeding will be considered "special"

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<sup>34</sup> 35 U.S.C. § 314(c).

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throughout their pendency in the Office. In order to further the requirement for special dispatch, the Examiner's first Office action on the merits in an *inter partes* reexamination should ordinarily be mailed together with the order for reexamination. Further, any cases involved in litigation, whether they are reexamination proceedings or reissue applications, will have priority over all other cases.<sup>35</sup>

These proceedings include additional procedures which accommodate the participation by the TPR. Copies of all Office Actions, as well as all communications filed by both the patent owner and the third party requester, are sent to both parties.<sup>36</sup>

## **Timelines**

In contrast to *ex parte* reexamination, *inter partes* reexamination opens up the PTO reexamination process to more involvement by the TPR. The TPR has the right to file one written response at each stage of the reexamination procedure, on any response by the patent owner to an Office Action<sup>37</sup>, but the TPR usually faces shorter time periods for filing a response versus the patent owner.

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<sup>35</sup> M.P.E.P. § 2661.

<sup>36</sup> 37 C.F.R. § 1.903.

<sup>37</sup> 35 U.S.C. § 314(b)(3).

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The time periods for response and comments for the various stages of an *inter partes* reexamination proceeding are as follows:

**(A) After an Office Action that is not an Action Closing Prosecution (non-ACP Office action)**

Patent owner may file a patent owner's response within the time for response set in the non-ACP Office action. The time period set for response will normally be two (2) months from the mailing date of the action.

Where the patent owner files a timely response to the non-ACP Office action, the TPR may once file written comments addressing issues raised by the Office action or by the patent owner response to the action. The third party requester's written comments must be submitted within 30 days (not one month<sup>38</sup>) from the date of service of the patent owner's response on the third party requester. The date of service can be found on the Certificate of Service that accompanies the patent owner's response.

**(B) Extensions of Time Are Not Automatic**

The third party requester must file any comments addressing any patent owner response within thirty days with no extensions of

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<sup>38</sup> 37 C.F.R. § 1.7.

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time being available.<sup>39</sup>

The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. 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. The provisions of 37 CFR §§ 1.136(a) and 1.136(b) are not applicable to *inter partes* reexamination proceedings under any circumstances. Thus, extensions of time are not automatic, and instead must be requested ahead of the due date in the form of a petition (along with the appropriate fee – currently \$200). A request for an extension of time in an *inter partes* reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time is decided by the Central Reexamination Unit Director.<sup>40</sup>

A request for a first month extension of time requires “**sufficient cause**”.<sup>41</sup> In no case, will the mere filing of a request for extension of time automatically affect any extension, because the showing of cause may be insufficient or incomplete.

Second or subsequent requests for extensions of time, or requests

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<sup>39</sup> 37 C.F.R. §§ 1.956, 1.947.

<sup>40</sup> M.P.E.P. § 2665.

<sup>41</sup> M.P.E.P. § 2665.

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for more than one month, will be granted only in “**extraordinary situations**”.

Possible reasons for requesting extension of time:

- Length of Office Action (e.g., multiple grounds of rejections), including number of references cited;
- Location of Patent Owner (e.g., abroad);
- Availability of attorney(s), inventors, declarants, in-house counsel;
- Consultation among inventors or experts needed to prepare possible Rule 131/132 Declarations;
- More experimental testing needed; and
- A comparison of the receipt date versus mailing date of Office Action shows a longer than expected delay.

A two month extension of time was granted in Reexamination Control No. 95/000,153, wherein a part of the September 28, 2007 Decision is reproduced below:

**Patent Owner’s Showing of Sufficient Cause to Grant an Extension of Time**

The petition for extension of time states that the various legal and technical personnel associated with Patent Owner and Licensee and conducted the first of several teleconferences discussing the issues raised in the ACP. In view of the complexity of these issues, an in-person meeting has been scheduled to maximize access to technical expertise and information. Patent Owner and Licensee are considering the necessity of conducting additional testing in response to the position taken by the examiner that would likely take at least two months. An extension of time of two months is requested to fully analyze the complex issues and develop responsive positions on behalf of the Patent Owner.

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On balance, it is considered that the petition explains the “sufficient cause” for an extension of time. It is clear that the Office action is substantial and that Patent Owner requires consultation with technical personnel and Patent Owner to prepare a complete response. Patent Owner has set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period. When balanced against the requirement of 35 USC 314(c) that this proceeding be handled with special dispatch, Owner's showing is adequate to justify the grant of a two-month extension of time in which to file a response to the outstanding Office action. Accordingly, the period of time for filing a reply to the Office action dated September 5, 2007 is extended to run three months from the date of the Office action and is due on December 5, 2007. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time

But generally, when responding to an Office Action, there are no extensions of time for the patent owner. Also, the provisions of 37 C.F.R. §§ 1.136(a) and 1.136(b) are applicable to applications, and thus do not apply to *inter partes* reexamination proceedings.

The times for filing a notice of appeal or cross-appeal, an appellant brief, a respondent brief, submissions curing a defective appeal or brief, a rebuttal brief, and a request for oral hearing cannot be extended.

#### **(C) After an Office letter indicating that a response by the patent owner is not proper**

After an Office letter indicates that a response filed by the patent owner is not completely responsive to a prior Office action (*i.e.*, an incomplete response) but is a *bona fide* attempt to respond, the patent owner is required to complete the response within the time

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period set in the Office letter.<sup>42</sup> A time period of 30 days or one month (whichever is longer) is normally set. Any third party requester comments on a supplemental patent owner response that completes the initial response must be filed within 30 days from the date of service of the patent owner's supplemental response on the third party requester.

**(D) After an Action Closing Prosecution (ACP) and the Right of Appeal Notice (RAN)**

Subsequent to the first Office Action and upon a determination by the patent examiner that the issues have been “clearly developed”, the Examiner may issue an “Action Closing Prosecution” (“ACP”) which severely limits further attempts by the patent owner to introduce any additional changes to the patent claims or evidence supporting patentability.<sup>43</sup>

After the ACP issues, the patent owner may once file written comments and/or present a proposed amendment to the claims within the time period set in the ACP.<sup>44</sup> Normally, the ACP will set a period of 30 days or one month (whichever is longer) from the mailing date of the ACP. Where the patent owner files comments and/or a proposed amendment, the third party requester

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<sup>42</sup> 37 C.F.R. § 1.957(d).

<sup>43</sup> 37 C.F.R. § 1.949.

<sup>44</sup> 37 C.F.R. § 1.951(a).

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may once file comments responsive to the patent owner's submission within 30 days from the date of service of the patent owner's submission on the third party requester.<sup>45</sup>

However, a Notice of Appeal (“NOA”) cannot be filed by either party at this point. After receiving any additional comments from the patent owner, and any additional optional comments from the third party requester, the patent examiner may then issue a “Right of Appeal Notice” (or “RAN”) which then allows either party to appeal the reexamination.<sup>46</sup>

### **(E) Appeal to the Board of Patent Appeals and Interferences (Board) after the examiner issues Right of Appeal Notice**

Both a TPR and a patentee may appeal any proposed ground of rejection, not adopted by the Examiner as a final decision unfavorable to patentability,<sup>47</sup> to the Board of Patent Appeals and Interferences.

After the examiner issues a Right of Appeal Notice (RAN), the patent owner and the third party requester may each file a notice of appeal within 30 days or one month (whichever is longer) from the

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<sup>45</sup> 37 C.F.R. § 1.951(b).

<sup>46</sup> 37 C.F.R. § 1.953.

<sup>47</sup> 35 U.S.C. § 315(b)(1).



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mailing date of the RAN.<sup>48</sup> The time for filing a notice of appeal cannot be extended.<sup>49</sup>

A patent owner who has not filed a timely notice of appeal may file a notice of cross appeal (with respect to any decision adverse to the patentability of any claim) within fourteen days of service of a third party requester's notice of appeal.<sup>50</sup>

A third party requester who has not filed a timely notice of appeal may file a notice of cross appeal (with respect to any final decision favorable to the patentability of any claim) within fourteen days of service of a patent owner's notice of appeal.<sup>51</sup>

The time for filing a notice of cross-appeal cannot be extended.<sup>52</sup>

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<sup>48</sup> 37 C.F.R. § 1.953(c).

<sup>49</sup> 37 C.F.R. § 41.61(e).

<sup>50</sup> 37 C.F.R. § 41.61(b)(1).

<sup>51</sup> 37 C.F.R. §41.61(b)(2).

<sup>52</sup> 37 C.F.R. § 41.61(e).

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**(F) After an Office notification of defective notice of appeal or notice of cross appeal (to the Board)**

A party who is notified of a defective notice of appeal, or defective notice of cross appeal, must cure the defect within one month from the mail date of the Office letter notifying the party.

The time for curing a defective notice of appeal or cross-appeal cannot be extended, since the paper curing the defect is in-effect a substitute notice of appeal or cross-appeal.

**(G) Filing of briefs after notice of appeal or notice of cross appeal (to the Board)**

Each party that filed a notice of appeal or notice of cross appeal may file an appellant brief and fee within two months after the last-filed notice of appeal or cross appeal. Additionally, if any party to the reexamination is entitled to file an appeal or cross appeal but fails to timely do so, the appellant brief and fee may be filed within two months after the expiration of time for filing (by the last party entitled to do so) of the notice of appeal or cross appeal.<sup>53</sup>

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<sup>53</sup> 37 C.F.R. § 41.66(a).

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Once an appellant brief has been properly filed, an opposing party may file a respondent brief and fee within one month from the date of service of the appellant brief.<sup>54</sup>

The times for filing appellant and respondent briefs may not be extended.<sup>55</sup>

#### **(H) After an Office notification of non-compliance of appellant brief or respondent brief**

A party who is notified of non-compliance of an appellant brief or respondent brief must file an amended brief within a non-extendable time period of one month from the date of the Office letter notifying the party of the non-compliance of the brief.

#### **(I) Rebuttal brief after the examiner issues an Examiner's Answer**

A third-party requester appellant and/or a patent owner appellant may each file a rebuttal brief within one month of the date of the Examiner's Answer. The time for filing a rebuttal brief may not be extended.<sup>56</sup>

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<sup>54</sup> 37 C.F.R. § 41.66(b).

<sup>55</sup> 37 C.F.R. §§ 41.66(a) and (b).

<sup>56</sup> 37 C.F.R. § 41.66(d).

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(J) Oral Hearing

If an appellant or a respondent (who has filed a respondent brief) desires an oral hearing by the Board, he or she must file a written request for an oral hearing accompanied by the fee<sup>57</sup> set forth in 37 C.F.R. § 41.20(b)(3) within two months after the date of the Examiner's Answer. The time for filing a request for oral hearing may not be extended.<sup>58</sup>

(K) Appeal to Court

The patent owner and TPR also both have the right to appeal an adverse decision of the Board of Patent Appeals and Interferences to the CAFC.<sup>59</sup> The appeal of the Board's decision may only be made to the CAFC and cannot be made to a District Court, unlike *ex parte* reexamination proceedings.<sup>60</sup>

The time for the patent owner and/or the third party requester to file a notice of appeal to the U.S. Court of Appeals for the Federal Circuit is two months from the date of the Board decision. If a timely request for rehearing pursuant to 37 C.F.R. § 41.79 is filed,

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<sup>57</sup> Currently \$1,030.00 for a large entity.

<sup>58</sup> 37 C.F.R. § 41.73(d).

<sup>59</sup> 35 U.S.C. § 141(c).

<sup>60</sup> 35 U.S.C. § 141.

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the time for the patent owner and/or the third party requester to file a notice of appeal to the Federal Circuit is two months from final Board action on the request for rehearing.<sup>61</sup>

**(L) Litigation**

Where the reexamination results from a court order or litigation is stayed for purposes of reexamination, the shortened statutory period will generally be set at one month or thirty days, whichever is longer.

In addition, if (1) there is litigation concurrent with an *inter partes* reexamination proceeding and (2) the reexamination proceeding has been pending for more than one year, the Director of the Office of Patent Legal Administration (OPLA), Director of the Central Reexamination Unit (CRU), Director of the Technology Center (TC) in which the reexamination is being conducted, or a Senior Legal Advisor of the OPLA, may approve Office actions in such reexamination proceeding setting a one-month or thirty days, whichever is longer, shortened statutory period for response rather than the two months usually set in reexamination proceedings. A statement at the end of the Office action – “One month or thirty days, whichever is longer, shortened statutory period approved,” followed by the signature of one of these officials, will designate such approval.

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<sup>61</sup> 37 C.F.R. § 1.304(a)(1).

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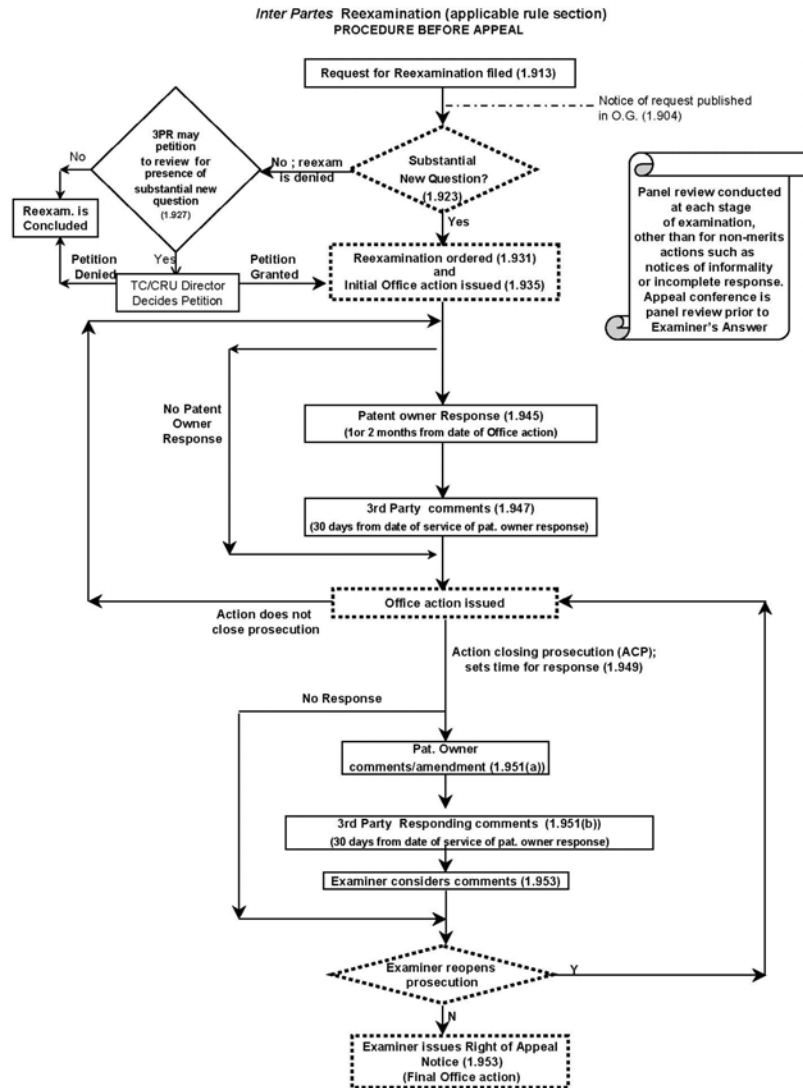
**Possible Flowcharts of an *Inter Partes*  
Reexamination Procedure**

The flowcharts below are reproduced from Chapter § 2601.01 of the Manual of Patent Examining Procedure (“M.P.E.P.”), wherein these flowcharts show the various stages of *inter partes* reexamination proceedings.

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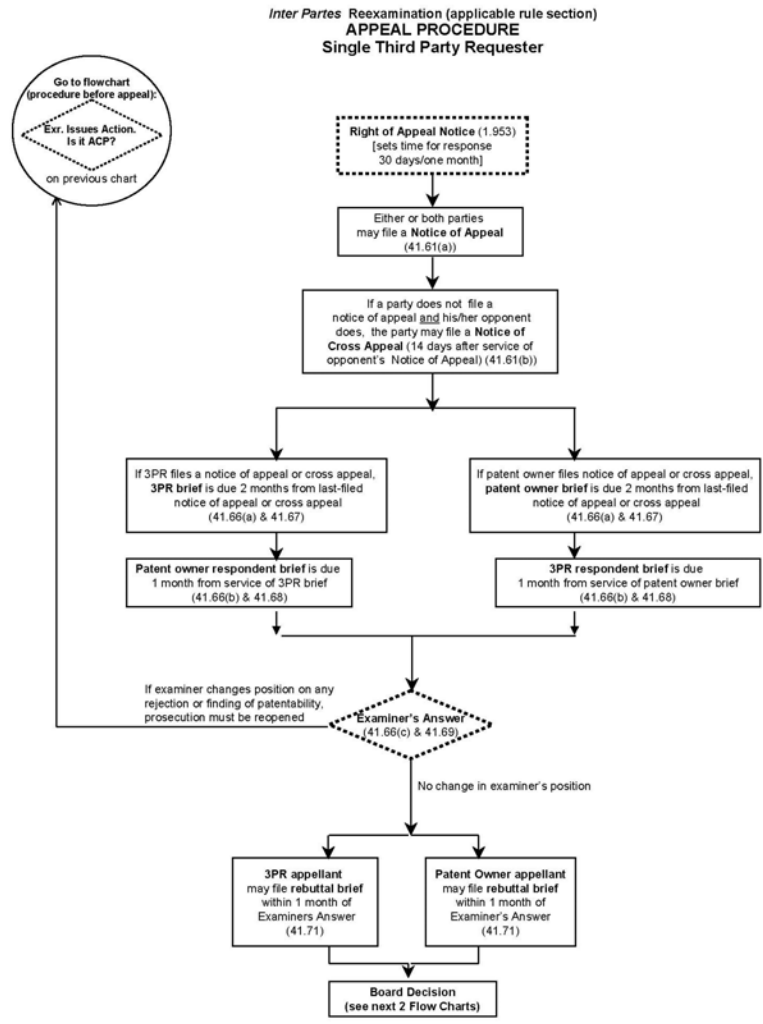
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(A) Flowchart #1: The procedures before appeal



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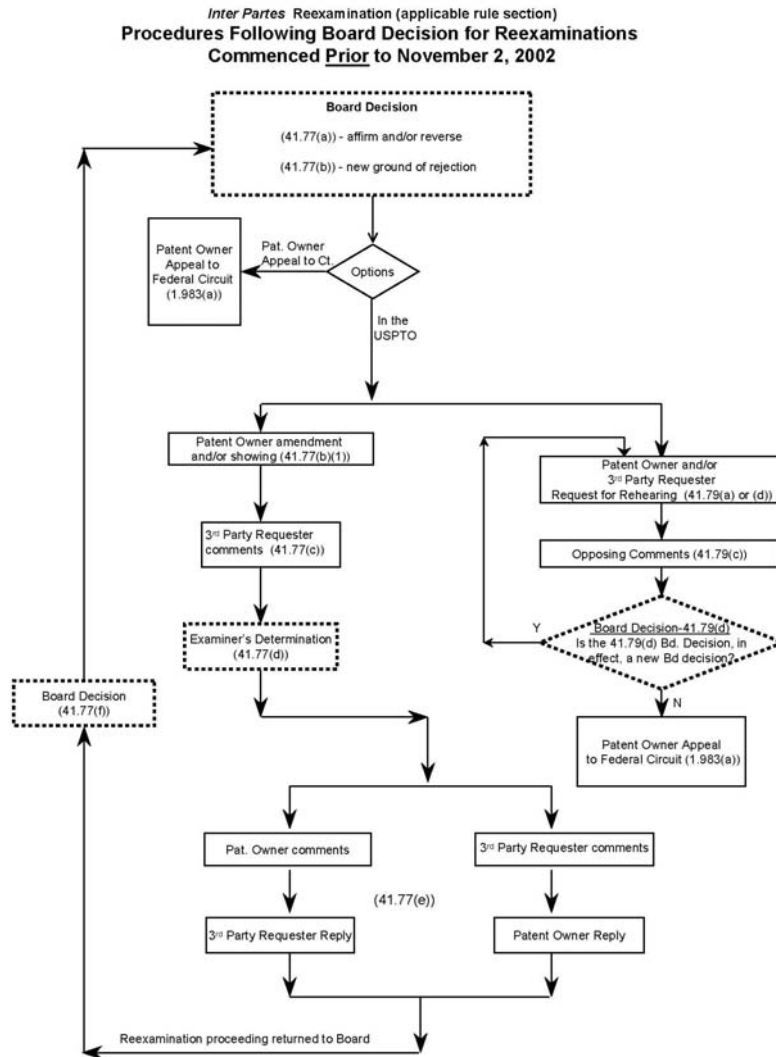
(B) Flowchart #2: The appeal procedure with a single TPR





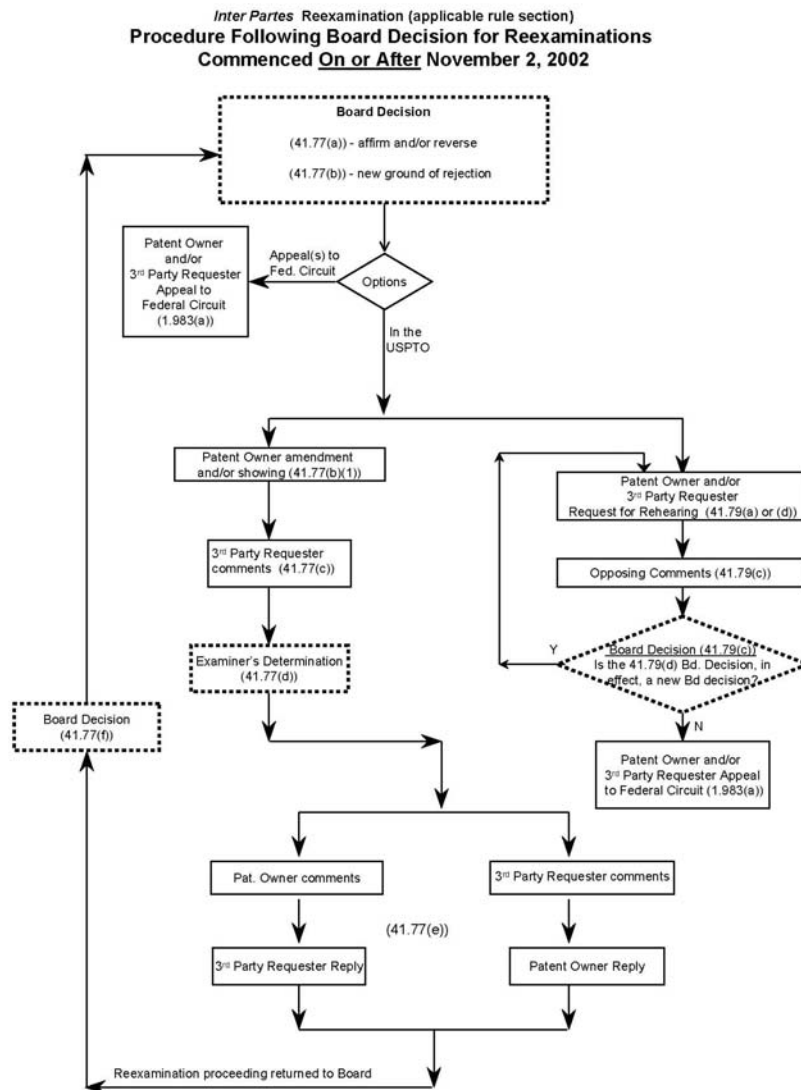
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(C) Flowchart #3: The procedures following a Board decision for reexamination proceedings commenced prior to November 2, 2002:



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(D) Flowchart #4: The procedures following a Board decision for reexamination proceedings commenced on or after November 2, 2002



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## **Prior Art That Can Be Used**

As one requirement of 37 C.F.R. § 915(b), the TPR must furnish a copy of every patent or printed publication relied upon, accompanied by an English language translation of all the necessary and pertinent parts of any non-English language document, for the proposed rejection(s). Typically, the prior art patent or publication is new.

However, prior art that is not new can be seen in a “new light”. As held in the *In re Swanson* decision,<sup>62</sup> a Federal court’s consideration of prior art reference in determining validity of patent does not preclude that reference from raising “substantial new question of patentability” for purposes of *ex parte* reexamination proceeding. This was true even though the Federal Circuit itself previously decided an issue of validity concerning the same reference in a prior, separate court proceeding.

## **The Page/Word Limits on Responses & Briefs**

Whether responding to the first Office Action or the Action Closing Prosecution, 37 C.F.R. §1.943(b) sets a 50-page limit on responses by either the patent owner or TPR. It is worth noting that an Office Action can have no page limit (and thus contain

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<sup>62</sup> 540 F.3d 1368, 88 USPQ2d 1196 (Fed. Cir. 2008).

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multiple grounds of rejections), thereby compliance with this rule can be difficult.

There is also a limit of thirty pages or 14,000 words when filing an appellant brief, and a limit of fifteen pages or 7,000 words when filing all other types of briefs.<sup>63</sup>

Furthermore, any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 C.F.R. §1.943.<sup>64</sup>

Affidavits or declarations that are excluded from the page limit requirements include:

- declarations attempting to swear behind (antedate) the filing date of a reference;
- declaration establishing the date of a printed publication; and
- declarations that provide comparative test data and an analysis of same.<sup>65</sup>

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<sup>63</sup> 37 C.F.R. §1.943(c).

<sup>64</sup> M.P.E.P. § 2667.

<sup>65</sup> M.P.E.P. § 2667.

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Also, if the patent owner's or TPR's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome/supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included as a part of the page limit.

Finally, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome.

**Provisions of 37 C.F.R. § 1.116**

Subsequent to the first Office Action and upon a determination by the patent examiner that the issues have been “clearly developed”, the Examiner may issue an Action Closing Prosecution (“ACP”) which severely limits further attempts by the patent owner to introduce any additional changes to the patent claims or evidence supporting patentability.<sup>66</sup>

After the ACP issues, the patent owner may once file written comments and/or present a proposed amendment to the claims within the time period set in the ACP.<sup>67</sup> Normally, the ACP will

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<sup>66</sup> 37 C.F.R. § 1.949.

<sup>67</sup> 37 C.F.R. § 1.951(a).

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set a period of 30 days or one month (whichever is longer) from the mailing date of the ACP. Where the patent owner files comments and/or a proposed amendment, the third party requester may once file comments responsive to the patent owner's submission within 30 days from the date of service of the patent owner's submission on the third party requester.<sup>68</sup>

Upon issuance of the ACP, a Notice of Appeal (“NOA”) cannot be filed by either party at this point. After receiving any additional comments from the patent owner, and any additional optional comments from the third party requester, the patent examiner may then issue a “Right of Appeal Notice” (or “RAN”) which then allows either party to appeal the reexamination.<sup>69</sup>

37 C.F.R. §§ 1.949 and 1.951 and M.P.E.P. § 2672 set the standard for the patent owner's option after an ACP issues. As stated in 37 C.F.R. § 1.951(a) and M.P.E.P. § 2672, any amendment as proposed by the patent owner is governed by the strict criteria of 37 C.F.R. § 1.116 (“Rule 116”) as to whether or not such amendment should be admitted. Rule 116, subsection (b)(1)-(3), allows entry of a proposed amendment only when:

- (1) an amendment is made to cancel claims or to comply with any requirement of form expressly set forth in previous Office Action;

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<sup>68</sup> 37 C.F.R. § 1.951(b).

<sup>69</sup> 37 C.F.R. § 1.953.

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- (2) an amendment presenting rejected claims in better form for consideration on appeal that *may* be admitted; or
- (3) an amendment touching the merits of the application or patent under reexamination may be admitted based on a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

Thus, the patent owner has limited options once the ACP issues. Any substantive changes to the claims will likely result in the in the filed Amendment not being entered.

In Reexamination Control No. 95/000,138, the patent owner filed an amendment (on March 29, 2007) after the ACP (dated January 26, 2007) that was not entered. In the Amendment after the ACP, the independent claims were amended, and some claims were and some were added. However, the patent owner overall presented additional claims without canceling a corresponding number of finally rejected claims. Further, the newly incorporated subject matter in the independent claims originated from the specification and not from an existing dependent claims. Thus, as indicated in the RAN of November 29, 2007, the Amendment after ACP was not entered since it raised “new issues” and increased the number of claims. The claims on appeal are those as pending before issuance of the ACP.

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## **Petitions**

There are three types of petitions as provided for in 37 C.F.R. §§ 1.181-183. Each type of petition serves a different purpose.

### **(A) Rule 181 Petition**

Regarding a Rule 181 petition, there are two types: (1) a premature ACP invoking supervisory authority of the USPTO Director; and (2) denial of entry of amendments filed in response to an ACP.<sup>70</sup>

Regarding the first type of Rule 181 petition (a premature ACP invoking supervisory authority of the USPTO Director), a typical situation is where an ACP has issued, and then the patent owner files an amendment wherein the claims are amended to address the ground(s) of prior art rejection(s). Thereafter, the RAN indicates whether or not the claim amendments are entered for purposes of appeal. If the claim amendments are not entered, the patent owner may file a Rule 181 petition to request entry. However, many of these petitions are dismissed.<sup>71</sup>

Still, a Rule 181 petition to reopen prosecution was granted in Reexamination Control No. 95/000,153 (see USPTO decision dated December 10, 2008). This was because the Examiner in the

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<sup>70</sup> M.P.E.P. § 2672(VI) and § 2673.02.

<sup>71</sup> See, e.g., Reexamination Control Nos. 95/000,010, 95/000,020, 95/000,025, 95/000,070 and 95/000,071.



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RAN included a rejection of a claim that was not included in the ACP. Thus, the Examiner essentially made a new rejection in the RAN, which the USPTO found the ACP as being premature since the patent owner has had no opportunity to respond to the new rejection.

Note that 37 C.F.R. § 182(f) indicates a two month window to file the Rule 181 petition (from the mailing date of the RAN, wherein this time period is not extendable. The TPR can respond to any filed petition within 30 days of date of service. Also, filing a petition does not toll the time period for filing a notice of appeal of cross appeal.

Regarding the second type of Rule 181 petition (denial of entry of amendments filed in response to an ACP), this type of petition is relatively rare. This type of petition was filed and dismissed in Reexamination Control No. 95/000,043.

**(B) Rule 183 Petition**

A Rule 183 petition can be used to waive a rule specific in 37 C.F.R. It is worth noting that as stated in M.P.E.P. § 2673.02, when a Rule 181 petition is filed, the USPTO encourages that a Rule 183 petition be also filed to request waiver of the prohibition of an extension of time for filing an appeal brief. In effect, the petitioner is requesting that the due date for filing the appeal brief be tolled.

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As an example of a rule to be waived, and as mentioned, a response to a first Office Action or to the ACP cannot exceed 50 pages in length (but excludes claims and references).<sup>72</sup> Patent Owner appellant briefs are not to exceed 30 pages or 14,000 words.<sup>73</sup> A Rule 183 petition can be filed to waive these such page/word limits.

For instance, in Reexamination Control No. 95/000,020, the patent owner petitioned (on February 23, 2007) to waive the provisions of 37 C.F.R. § 1.943(c) to exceed the page/word limit for filing an appellant brief:

Patent Owner, NTP, Inc., ("Patent Owner") by and through the undersigned counsel, hereby petitions the Commissioner of Patents and Trademarks to suspend the page and word count limitations imposed by 37 C.F.R. §1.943 and grant Patent Owner leave to submit an Appeal Brief that fully and completely addresses each of the allegations and rejections presented by the Patent Office in its Action Closing Prosecution and Right of Appeal. Alternatively, if

The USPTO granted the Rule 183 petition in a decision dated March 9, 2007. The decision gave a page limit for the appellant's brief to not exceed 60 pages or 28,00 words in length:

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<sup>72</sup> 37 C.F.R. § 1.943(b).

<sup>73</sup> 37 C.F.R. § 1.943(c).

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1. The petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) is granted to the extent that the page limit for the appellant's brief is extended to not exceed 60 pages or 28,000 words in length.

In Reexam. Control No. 95/000,071, the Patent Owner filed a Rule 183 petition to waive the rules of 37 CFR § 111(a)(2). In effect, the Patent Owner wanted entry of the response after the ACP issued, wherein 50 new claims were added, and reopening of prosecution. However, the USPTO dismissed the Petition.

### (C) Rule 182 Petition

As the third type of petition, a Rule 182 petition is used for “questions not specifically provided for. For instance, a Rule 182 petition can be used by the patent owner to reopen prosecution.

When the RAN issues, the patent owner can appeal, but has no right to reopen prosecution by filing a Request for Continued Examination (“RCE”), since the provisions of 37 C.F.R. § 1.114 apply to an “application” and not a “patent. However, the provisions of 1292 *Off. Gaz. Pat. Office* 20 (Official Gazette dated March 1, 2005) allows for Request for Continued Reexamination practice (like RCE for normal prosecution):

“It is noted that, as a consequence of the changes made to MPEP 2240, a patent owner will now be prevented from obtaining entry of an amendment and/or evidence not entered after final rejection in an *ex parte* reexamination proceeding by filing another request for

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reexamination based on the same substantial question of patentability raised/existing in the pending reexamination proceeding. In order to provide relief to the patent owner, the Office plans to propose a revision to the patent rules to provide for the filing of a request for continued reexamination (**RCR**) which would be similar to the request for continued examination (RCE) practice for applications. If the RCR practice is implemented, the patent owner, by filing an RCR, could obtain continued prosecution on the merits in the reexamination proceeding, including entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding or after an action closing prosecution in an *inter partes* reexamination proceeding. Until these new rules become effective, however, patent owners are advised to use either: (1) the petition procedure under 37 CFR 1.181 to seek review of a denial of entry of an amendment submitted after final rejection in an *ex parte* reexamination proceeding or after an action closing prosecution in an *inter partes* reexamination proceeding; or (2) the petition procedure under 37 CFR 1.182 to seek relief that is not currently provided by an existing rule, but that would be provided when a new request for continued reexamination (RCR) practice is in effect.” (Emphasis added.)

Thus, a Rule 182 petition for RCR can be filed to reopen prosecution of the reexamined patent. However, remember that this is a petition that needs a decision from the USPTO. Further, simply filing the Petition does not toll the time period for filing a response to an outstanding Office Action.

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## **Duty of Disclosure**

Each individual associated with the patent owner in an *inter partes* reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding as set forth in § 1.555(a) and (b).<sup>74</sup> The USPTO makes no evaluation as to whether or not such individuals comply with the duty of disclosure.<sup>75</sup> If the patent owner or TPR raises a question of compliance, the question goes unresolved in accordance with 37 C.F.R. § 1.906(c).

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<sup>74</sup> 37 C.F.R. § 1.933(a).

<sup>75</sup> 37 C.F.R. § 1.933(b).