

USPTO PATENT REEXAMINATION – AN EFFECTIVE “TOOL” TO ACQUIRE A FRESH VIEW OF PATENTABILITY AT A LOW COST COMPARED TO LITIGATION.

By: Temnit Afework

There are two types of reexamination of issued U.S. patents before the U.S. Patent and Trademark Office (USPTO): (1) ex parte reexamination, and (2) inter partes reexamination.

Ex Parte Reexamination:

Ex parte reexaminations can be requested by the patentee, a third party or the USPTO. However, once a request is submitted, other than replying to a preliminary statement or a preliminary amendment if filed by the patentee, a third party requestor does not participate in the ex parte reexamination proceedings. Additionally, third party requestors can make submissions anonymously. The request for reexamination must show “a substantial new question of patentability.” An Examiner decides whether to grant the request for reexamination within three months of filing the request. If a request is not granted, a petition can be made to the Director of the USPTO. A decision by the Director is final and non-appealable. If a reexamination is ordered, the findings of the examiner can be appealed to the Board of Patent Appeals and Interferences (BPAI) only by the patentee. Decisions reviewed by the BPAI can be appealed to the Court of Appeals for the Federal Circuit (CAFC).

Inter Partes Reexamination:

Inter partes reexaminations can be requested by third parties in relation to a patent which issued from an original application that was filed on or after November 29, 1999. Unlike ex parte proceedings, third party requestors can participate in the inter partes reexamination process after a request is submitted by filing a reply to each response filed by the patentee. The identity of a third party requestor cannot be kept secret. The Office initially determines if “a substantial new question of patentability” is presented. A third party requestor or the patentee can appeal the result of an inter partes reexamination to the BPAI and subsequently to the CAFC.

According to USPTO reexamination data through the USPTO third quarter ending June 30, 2009, a total of 676 requests for reexaminations were filed year to date through the third quarter for the USPTO fiscal year 2009. Of the total reexaminations filed through the third quarter, 481 were ex parte reexaminations and 195 were inter partes examinations. Through the same third quarter for the fiscal year 2008, there were a total of 615 reexaminations filed.

The average pendency of both types of reexaminations measured from filing to certificate through the third quarter for the fiscal year 2009 is 33.8 months. The average pendency of ex parte proceedings from filing to certificate is 33.0 months and the average pendency of inter partes certificate proceedings from filing to certificate is 41.7. This is compared to 37.6 months of pendency from filing to certificate for both types of reexaminations, 38 months from filing to ex parte certificate and 32.7 months from filing to inter partes certificate for the fiscal year 2008 through the same quarter.

Practice Tip: Reexamination by the patent owner can strengthen enforceability of a U.S. patent. While reexamination by third parties is quick and is generally inexpensive compared to litigation, it may not be an appropriate strategy for all situations. For example, if subsequent litigation involving a reexamined patent occurs, a third party requestor of an inter partes examination is estopped from attacking validity of the patent in view of a reference that was reviewed in the reexamination. For further information, please contact us.