



**REEXAMINATION
PRACTICE BEFORE THE
US PTO**

U.S. PATENT AND TRADEMARK OFFICE

HERSHKOVITZ & ASSOCIATES, LLC
Presented at IP Conferences
January, 2012

Reexamination Requests

- **Accused Infringer:**
 - **Not Infringing**
 - **Patent Invalid, Requests Reexamination**
 - **Patent Owner Wishes to Strengthen Patent at PTO**

Reexamination Types

- **Ex Parte**
- **Inter Partes (pre 9/16/11)**
- **Inter Partes (post 9/16/11, but pre 9/16/12)**
- **Inter Partes (post 9/16/12)**

Reexamination (cont'd)

- **Who Can File?**
 - **Patent Owner**
 - **Any Third Party**
 - **Requester Must be Identified in *Inter Partes* only**

Reexamination (*ex Parte*)

- **Requirements**
 - **Substantial New Question of Patentability (new reference)**
 - **Previously Considered Reference being viewed in a new Light**
 - **Non-Cumulative**

Reexamination (*inter Partes*)

- **Requirements 9/16/11-9/16/12**
 - **Reasonable likelihood that the requester will prevail with respect to at least one of the claims**
 - **Examined by Patent Trial and Appeals Board Judges**

Reexamination (*inter Partes*)

- **After 9/16/12**
 - **Not Permitted**
 - **Replaced by Petition to Conduct *Inter Partes* Review**

Other Challenges by Opposers

- **After 9/16/12**
 - **Post-Grant Review Permitted (New)**
 - **Supplemental Examination (New)**
 - **Transitional post-grant review proceeding for review of the validity of covered business-method patents**

Reexamination

- **Within 3 Months, Reexam Must Be**
 - **Ordered**
 - **Refused**
 - **Opportunity to Correct Provided (New Filing date)**

Reexamination (cont'd)

- **If Reexam Ordered**
 - **2 Months for Patent Owner Statement if by 3rd Party (Not Recommended Generally)**
 - **PTO Action within about 9-12 Months from Filing**

Reexamination Strategies

- **Interviews (ex-parte; not available for inter-partes)**
- **Cannot broaden**
- **Prior Art: Patent, Printed Publication**

Reexam Strategies (cont'd)

- **NO RCE**
- **New claims must be underlined**
- **Response: Not extendable unless petition is granted**
- **Inter partes: 50 page limit**

Reexam Strategies (cont'd)

- **Patent Prosecution Goals vs. Litigation Goals**
- **Today's Goals - Insight into the litigation perspective**
- **Past Damages for Infringement**

Reexam Strategies (cont'd)

- Amend Claims?
- Practical advice - claim Drafting
– Arguments *Laitram Corp. v. NEC Corp.*, 163 F.3d 1342. (Fed. Cir. Dec. 18, 1998).

Reexamination (cont'd)

- **After Amendment/Response PTO usually Issues Final Rejection or NIRC**
- **If Final Rejection, Interview Again, New Claims, Arguments**
- **If NIRC, file Comments**

Reexamination (cont'd)

- **After Final Amendment or Response, PTO Issues Advisory Action or NIRC**
- **Advisory Gives About 1 month for Filing Appeal**

Reexamination (cont'd)

- Patent Owner may appeal in *Ex Parte*
- Both Sides May Appeal in *Inter Partes*
- In *Inter Partes*, Requester Participates Throughout

Reexamination Filing Data - September 30, 2011

Ex Parte

- 1. Total requests filed since start of ex parte reexam on 07/01/81
11,782

Inter Partes

- 1. Total requests filed since start of inter partes reexam on 11/29/99
1,389

Filings

Ex Parte

- a. By patent owner
3,801.....33%
- b. By other member of
public 7,815.....66%
- c. By order of
Commissioner
166..... 1%

Inter Partes

- a. By patent owner
N/A
- b. By other member of
public 1,389.....100%
- c. By order of
Commissioner
N/A

2. Number of filings by discipline

Ex Parte

a. Chemical Operation	3,211	27%
b. Electrical Operation	4,405	37%
c. Mechanical Operation	3,987	34%
d. Designs	179	2%

Inter Partes

a. Chemical Operation	260	18%
b. Electrical Operation	722	52%
c. Mechanical Operation	401	29%
d. Designs	16	1%

3. Determinations on Requests

Ex Parte

Total 11,262

a. No. granted
10,333 92%

(1) By examiner
.....10,213

(2) By Director (on
petition)120

Inter Partes

Total 1,246

a. No. granted
1,187 95%

(1) By examiner
.....1,178

(2) By Director (on
petition) 9

3. Determinations on Requests

Ex Parte

b. Number denied
929 8%
(1) By examiner ...894
(47% PO; 53%TP)
(2) Order vacated...35

Inter Partes

b. Number denied
59 5%
(1) By examiner.... 54
(2) Order vacated ... 5

4. Overall reexamination pendency (Filing date to certificate issue date)

Ex Parte

Inter Partes

- | | |
|------------------------------------|------------------------------------|
| a. Average pendency
25.6 months | a. Average pendency
36.2 months |
| b. Median pendency
19.9 months | b. Median pendency
32.9 months |

5. Total Reexamination Certificates Issued

Ex Parte

(1981 - present)
..... 8,578

a. Certificates with all
claims confirmed
1,943 23%

Inter Partes

(1999 - present)
..... 305

a. Certificates with all
claims confirmed
35 11%

5. Total Reexamination Certificates Issued

Ex Parte

b. Certificates with all claims canceled	
974	11%
c. Certificates with claims changes	
5,661	66%
In Litigation	3,894.....33%

Inter Partes

b. Certificates with all claims canceled	
133	44%
c. Certificates with claims changes	
137	45%
In Litigation	974.....70%

Thank You

- Abe HersHKovitz

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The End

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