



Patent Resources Group

Reexamination and Reissue Practice

Course Syllabus

I. INTRODUCTION

- A. PATENT ERRORS
 - 1. Correctable patent errors
 - 2. Uncorrectable patent errors
- B. OVERVIEW OF REISSUE
- C. OVERVIEW OF *EX PARTE* REEXAMINATION
- D. OVERVIEW OF *INTER PARTES* REEXAMINATION
- E. POST-GRANT OPTIONS FOR THE PATENT OWNER
 - 1. Minor errors
 - 2. Reissue vs. reexamination
 - 3. Reexamination vs. litigation
- F. POST-GRANT OPTIONS FOR THE PATENT CHALLENGER
 - 1. Reexamination vs. litigation
 - 2. *Ex parte* vs. *inter partes* reexamination

II. DISCLAIMER

- A. INTRODUCTION
- B. SOURCES OF LAW
- C. OVERVIEW
- D. STATUTORY REQUIREMENTS FOR DISCLAIMER
 - 1. Lack of deceptive intention
 - 2. Patentee must make the disclaimer
 - 3. Statement of owner's interest in a patent
 - 4. Writing recorded with the Patent Office
 - 5. Fee payment
- E. STATUTORY DISCLAIMERS
- F. TERMINAL DISCLAIMERS
 - 1. Consequences of terminal disclaimers
 - 2. Withdrawal of terminal disclaimers

III. CERTIFICATE OF CORRECTION

- A. INTRODUCTION
- B. SOURCES OF LAW
- C. OVERVIEW OF CERTIFICATE OF CORRECTION
 - 1. Types of errors that are correctable via a certificate of correction
 - 2. Overview of the effect of a certificate of correction
- D. ERRORS ATTRIBUTED TO THE PTO
 - 1. Overview of requirements to correct PTO error
 - 2. Procedure for requesting a certificate of correction under 35 U.S.C. § 254
- E. ERRORS ATTRIBUTED TO THE APPLICANT
 - 1. Overview of requirements for correcting applicant error
 - 2. Procedure for requesting a certificate of correction under 35 U.S.C. § 255
- F. CORRECTION OF INVENTORSHIP ERRORS
 - 1. Nonjoinder – adding an omitted inventor
 - 2. Misjoinder – removing an individual as an inventor
 - 3. Reissue and uncooperative inventor
 - 4. Differences with respect to inventorship changes during pendency of the application and post-grant changes
- G. CORRECTION OF PRIORITY



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- H. FAILURE TO OBTAIN A CERTIFICATE OF CORRECTION FROM THE PTO AND THE LIMITED AUTHORITY OF DISTRICT COURTS TO CORRECT CLAIMS BASED ON INTERPRETATION

IV. REISSUE

- A. INTRODUCTION
- B. SOURCES OF LAW
- C. OVERVIEW
 - 1. Overview of requirements and procedure for reissue
 - 2. Overview of the effect of reissue
- D. HISTORICAL DEVELOPMENT OF REISSUE
- E. STATUTORY REQUIREMENTS FOR REISSUE
 - 1. Reissue is initiated by patentee or the patentee's assignee
 - 2. Amended application, fee, and offer to surrender original
 - 3. Lack of deceptive intent
 - 4. Patent is deemed wholly or partly invalid or inoperable due to at least one error
 - 5. Unexpired term of the patent
 - 6. New matter and the "invention disclosed in the original patent"
- F. UNCORRECTABLE ERRORS
 - 1. Applicant failed to meet the requirements of 35 U.S.C. § 112
 - 2. Deliberate acts are excluded
 - 3. Inequitable conduct
 - 4. Failure to file a divisional or continuation application
 - 5. Reissue cannot withdraw or nullify a recorded terminal disclaimer
 - 6. Failure to pay a maintenance fee
 - 7. Failure of the PTO to declare an interference
- G. DEFECTS CORRECTABLE BY REISSUE
 - 1. Inventorship
 - 2. Priority
 - 3. Disclaimer
 - 4. Defective specification or drawing
 - 5. Overclaiming – narrowing reissue
 - 6. Amended claims having the same or similar scope as original claims
 - 7. Underclaiming – broadening reissue
- H. RULE AGAINST RECAPTURE
 - 1. Federal Circuit recapture test
 - 2. Interplay of the recapture rule and the *Orita* doctrine
- I. THE EFFECT OF REISSUE
 - 1. Effective date of claims
 - 2. Intervening rights
 - 3. Opening up design-around possibilities
 - 4. Effects of reissue prosecution history
- J. PROCEDURES UNIQUE TO REISSUE APPLICATIONS
 - 1. Filing deadlines
 - 2. Availability to the public
 - 3. Announcement regarding reissue application
 - 4. Reissues are generally not examined until two months following the publication of the notice in the *Official Gazette*
 - 5. Special status and expedited prosecution
 - 6. Protest in reissue applications



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- 7. Review by SPREs and OPLA
- K. REQUIREMENTS FOR COMPLETING THE FILING OF A REISSUE APPLICATION
 - 1. Reissue applicant files the same parts as the original application or an earlier reissue application
 - 2. Priority
 - 3. An offer to surrender the original patent
 - 4. Reissue oath or declaration
 - 5. Written consent of assignee if original oath was signed by inventors; if assignee signed original oath, then no consent is required but documentary evidence of title of patent is needed
 - 6. Fee – same as filing fee for utility application
- L. FORMAT OF A REISSUE APPLICATION
- M. AMENDMENTS TO THE REISSUE APPLICATION
 - 1. Amendments to the specification
 - 2. Amendments to the claims
 - 3. Amendments to the drawings
- N. EXAMINATION OF REISSUE APPLICATIONS
 - 1. Original scope of protection is subject to attack
 - 2. Duty of disclosure
 - 3. Consideration of references
 - 4. Restriction
 - 5. Election of species
 - 6. Request for continued examination
 - 7. Appeal
 - 8. Supplemental oath or declaration
 - 9. Grant of the reissue patent
 - 10. Reissue granted for the unexpired term of the original patent
- O. DIVISIONAL AND CONTINUATION APPLICATIONS
 - 1. Divisional applications
 - 2. Continuation reissue application
- P. CONCURRENT PROCEEDINGS, MERGERS, AND STAYS
 - 1. Concurrent reissue proceedings
 - 2. Concurrent reexamination proceeding
 - 3. Interference
 - 4. Concurrent litigation and stays
- Q. PRESUMPTION OF VALIDITY AND JUDICIAL REVIEW OF REISSUE PATENTS
 - 1. No presumption of validity during prosecution
 - 2. Judicial review
- R. COMPARISON WITH OTHER TOOLS FOR CORRECTING PATENTS BY PATENT OWNERS
 - 1. Certificate of correction versus reissue
 - 2. *Ex parte* reexamination versus reissue
- V. **EX PARTE REEXAMINATION**
 - A. INTRODUCTION
 - B. SOURCES OF LAW
 - C. OVERVIEW OF PROCESS
 - D. CONGRESSIONAL INTENT
 - E. CONSTITUTIONALITY
 - F. WHO CAN FILE A REQUEST FOR REEXAMINATION?



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1. Anyone
2. Statistics (% patent owner vs. % third party)
- G. WHEN CAN A REQUEST FOR REEXAMINATION BE FILED?
- H. THE PTO DECISION MAKERS: THE CENTRAL REEXAMINATION UNIT
- I. CRITERIA FOR GRANTING A REQUEST FOR REEXAMINATION
 1. Must be based on printed publication prior art
 2. Must raise a patentability question under 35 U.S.C. § 102 or 103
 3. Substantial New Question of Patentability
 4. Statistics (% granted vs. % denied)
- J. HOW TO FILE A REQUEST FOR *EX PARTE* REEXAMINATION
 1. RFR requirements
 2. Optional items to consider including
- K. PTO HANDLING OF A REQUEST FOR *EX PARTE* REEXAMINATION
 1. Flowchart
 2. Control number assigned
 3. Assigned to CRU for clerical processing
 4. SNQP determination
 5. Statutorily required to issue order granting or denying reexamination in three months
 6. If the request is denied
 7. If request is granted
 8. Statement by patent owner (only if requester is third party)
 9. Wait for PTO to issue Office action
- L. *EX PARTE* REEXAMINATION PROSECUTION
 1. Flowchart
 2. Preliminary amendments
 3. First Office action
 4. Interviews
 5. Patent owner's response
 6. Supplemental responses
 7. Second Office actions
 8. After-final practice in reexamination
 9. NIRC
 10. Reexamination certificate
 11. Reexamination proceedings are publicly open on PAIR
 12. Prohibition against participation by third parties, including a third-party requester
- M. APPEAL IN *EX PARTE* REEXAMINATION
 1. Participatory Rights
 2. Appeal to Board
 3. Court appeal
- N. SERIAL REQUESTS AND MULTIPLE PTO PROCEEDINGS
 1. Subsequent request after denial of earlier request
 2. Subsequent request filed during pendency of earlier reexamination
 3. Subsequent request after allowance
 4. Subsequent request after reexamination certificate
 5. Subsequent RFR filed by a different requester
 6. Merger, suspension, and multiple PTO proceedings
 7. "Quasi *inter partes*" *ex parte* reexamination
- O. STATISTICS FOR *EX PARTE* REEXAMINATION RESULTS



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- P. CONCURRENT REEXAMINATION AND LITIGATION PROCEEDINGS, AND THEIR INTERPLAY
 - 1. Stay of litigation pending reexamination
 - 2. No stay of reexamination pending litigation
 - 3. Concurrent reexamination and litigation
 - 4. Supplemental pleadings after RC
 - 5. Telling jury about pending reexamination
 - 6. Court orders relating to reexamination
 - 7. Obligations to produce materials from reexamination
 - 8. Effect on litigation and on appeal of post-judgment reexamination determinations
 - Q. CONSEQUENCES OF *EX PARTE* REEXAMINATION ON LITIGATION OF VALIDITY ISSUES
 - 1. No official estoppel on third-party requester
 - 2. Heightened presumption of validity if claims survive
 - 3. Unofficial estoppel effects on third-party requester
 - 4. Broadened claims are invalid
 - R. CONSEQUENCES OF REEXAMINATION ON LITIGATION OF INFRINGEMENT ISSUES
 - 1. Effective date of new or amended claims
 - 2. Intervening rights
 - 3. Opening up design-around possibilities
 - 4. Effects of reexamination prosecution history
 - S. CONSEQUENCES OF REEXAMINATION ON LITIGATION OF UNENFORCEABILITY ISSUES
 - 1. Inequitable conduct during prior prosecution
 - 2. Inequitable conduct during reexamination
 - T. STRATEGIC CONSIDERATIONS
 - 1. General strategic considerations for weighing reexamination against litigation
 - 2. Strategic considerations for patent-owner requesters
 - 3. Strategic considerations for third-party requesters
- VI. *INTER PARTES* REEXAMINATION**
- A. INTRODUCTION
 - B. SOURCES OF LAW
 - C. OVERVIEW OF PROCESS
 - D. CONGRESSIONAL INTENT
 - E. WHO CAN FILE AN RFIPR?
 - 1. Only third parties can file
 - 2. Requester must not be estopped from requesting
 - 3. Generally not permitted if IPR already pending
 - 4. Statistics
 - F. WHEN CAN AN RFIPR BE FILED?
 - 1. Anytime during enforceable life of patent
 - 2. But only for patent from application filed on or after November 29, 1999
 - 3. Request date affects requester's appeal rights
 - G. CRITERIA FOR GRANTING AN RFIPR
 - 1. Same as for *ex parte* reexamination request
 - 2. Statistics (% granted vs. % denied)
 - H. HOW TO FILE A REQUEST FOR *INTER PARTES* REEXAMINATION
 - 1. Request for *inter partes* reexamination requirements



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2. Optional items to consider including
- I. PTO HANDLING OF A REQUEST FOR *INTER PARTES* REEXAMINATION
 1. Flowchart
 2. Control number assigned
 3. Assigned to CRU for clerical processing
 4. SNQP determination
 5. Statutorily required to issue order granting or denying reexamination in three months
 6. If request is denied
- J. *INTER PARTES* REEXAMINATION PROSECUTION
 1. Flowchart
 2. First Office action (usually accompanies order granting IPR)
 3. No interviews
 4. Patent owner's response
 5. Supplemental responses
 6. Third-party requester comments
 7. Subsequent Office actions
 8. "After-final" practice in reexamination
 9. NIRC
 10. Reexamination certificate
 11. Reexamination proceedings are publicly open on PAIR
- K. APPEAL IN *INTER PARTES* REEXAMINATION
 1. Appeal to Board
 2. Federal Circuit appeal
- L. MULTIPLE PTO PROCEEDINGS
 1. Notice of prior or concurrent proceedings
 2. Who may file a subsequent request for reexamination?
 3. SNQP
 4. Merger of multiple PTO proceedings; suspension
- M. STATISTICS FOR *INTER PARTES* REEXAMINATION RESULTS
- N. CONCURRENT REEXAMINATION AND LITIGATION PROCEEDINGS AND THEIR INTERPLAY
 1. Stay of litigation pending inter partes reexamination
 2. Stay of reexamination pending litigation
 3. Otherwise litigation interplay is same as with *ex parte* reexamination
- O. CONSEQUENCES OF *INTER PARTES* REEXAMINATION ON LITIGATION OF VALIDITY ISSUES: ESTOPPEL
 1. Scope of estoppel on third-party requester
 2. Forums where estoppel applies
- P. CONSEQUENCES OF *INTER PARTES* REEXAMINATION ON LITIGATION OF INFRINGEMENT ISSUES
- Q. CONSEQUENCES OF *INTER PARTES* REEXAMINATION ON LITIGATION OF UNENFORCEABILITY ISSUES
- R. STRATEGIC CONSIDERATIONS
 1. Same general strategic considerations for weighing reexamination against litigation as with *ex parte* reexamination
 2. *Inter partes* vs. *ex parte* reexamination

VII. POST-GRANT REVIEW PROCEEDINGS