

Focusing on *Inter Partes* Reexamination

The country is in the midst of a growing wave of reexamination challenges. Caught up in that wave is a relatively new procedure known as *inter partes* reexamination. A study conducted by Bromberg & Sunstein reveals that early adopters of this new process have enjoyed tremendous success.

Here are two recent examples. NTP succeeded in patent litigation in court and received a settlement of \$600 million from RIM the makers of the Blackberry. MercExchange won a \$25 million judgment against eBay for patent infringement. In both cases, the asserted patents have been rejected by the US Patent and Trademark Office ("USPTO") in *ex parte* reexamination proceedings. The impact of these ongoing reexaminations on the patent enforcement campaigns of these patent holders remains to be seen. But clearly, there is an increased awareness that reexamination challenges may work where court challenges have come up short.

Bromberg & Sunstein strategically balances litigation and reexamination tactics, that draw on our deep expertise and focus on patent litigation and patent prosecution. As in any reexamination, an *inter partes* reexamination challenges in the USPTO the patentability of claims issued in a U.S. patent. Unique to an *inter partes* proceeding, the requester can now comment on all patent owner submissions and appeal adverse decisions. Patent owners have found these reexaminations difficult because they cannot talk to the patent examiner. Only written communications are permitted. Many practitioners have approached *inter partes*

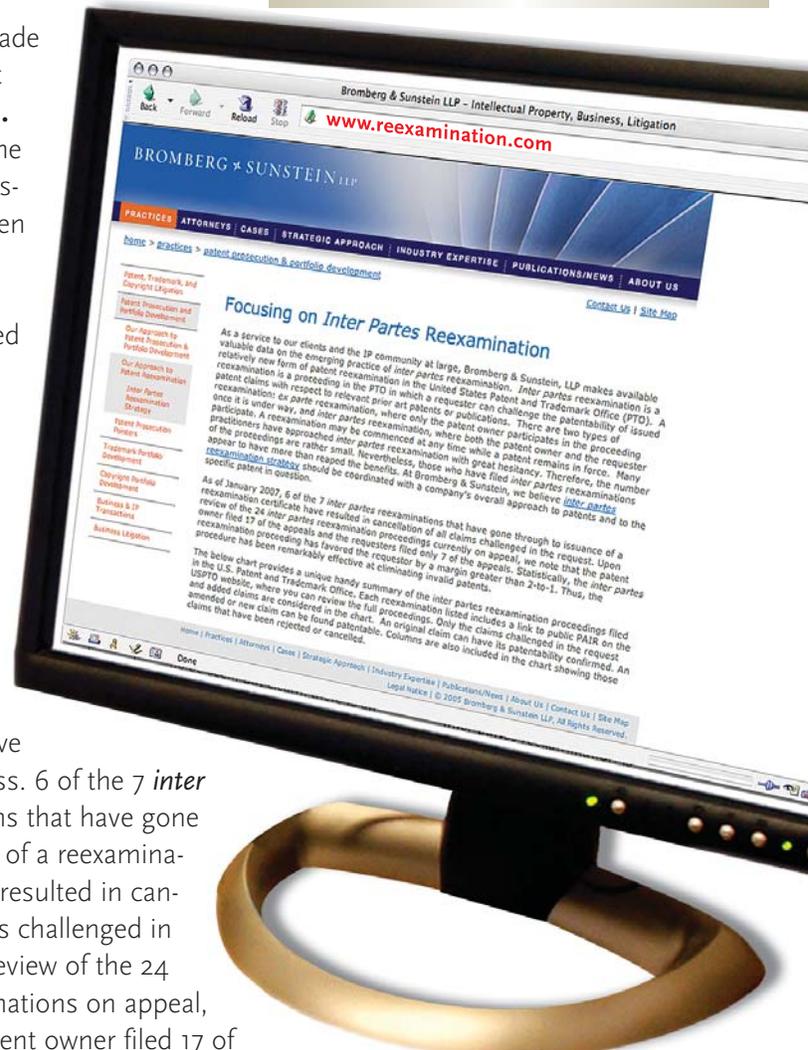
reexamination of patents with great hesitancy. The concern is that if the patent is not knocked out, the law provides an estoppel essentially precluding the challenger from raising prior art against the patent in a later court litigation.

Bromberg & Sunstein LLP has now examined all of the *inter partes* reexaminations filed in the USPTO and have made its findings public at www.reexamination.com. A table of all the reexaminations is displayed. The data given for each reexamination includes the number of challenged original and added claims and the status of these claims. Each reexamination is listed with a hyperlink to its docket on the USPTO's PAIR website.

As of January 2007, requesters have enjoyed great success. 6 of the 7 *inter partes* reexaminations that have gone through to issuance of a reexamination certificate have resulted in cancellation of all claims challenged in the request. Upon review of the 24 *inter partes* reexaminations on appeal, we note that the patent owner filed 17 of the appeals and the requesters filed only

7 of the appeals. *Inter partes* reexamination is thus becoming a serious alternative or prelude to litigation. We will periodically update our website by revising the unique compilation of data along with our strategic analyses. ✨

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Reexamination No.	Reexamination Results						
	Status	Requested Claims	Added Claims	Rejected/ Objected	Original Confirmed	Amendment Patentable	Disclaimed/ Cancelled
95/000.001	Certificate Issued	36	0	N/A	0	0	36
95/000.002	Certificate Issued	20	0	N/A	0	0	20
95/000.003	Pending	113	50	162	0	0	1
95/000.004	Certificate Issued	7	0	N/A	0	0	7
95/000.005	Appeal by Patent Owner Pending	14	0	14	0	0	0
95/000.006	Appeal by Patent Owner Pending	15	1	12	0	0	4
95/000.007	Pending	22	7	29	0	0	0
95/000.008	Appeal by Patent Owner Pending	5	5	10	0	0	0
95/000.009	Appeal by Requestor Pending	17	0	0	17	0	0

Inter Partes Reexamination Table Excerpt