

Sophisticated Use of Reexamination and Reissue

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Strategies for Patentee

AVOID REISSUES

File Continuation Applications

Bulletproof the Patent

- n Make sure examiner is aware of closest prior art
- n Reissue for examination of non-patent and non-publication prior art
- n Ex parte reexamination for patents and publications

Strengthen Patent

n Obtains USPTO stamp of approval over newly discovered art

n Enhances presumption of validity

Challenge Inter Partes Reexamination of Continuation or Divisional

What is an original
application?

Original Application

n “shall apply to any patent that issues from an **original application** filed in the United States on or after that date [November 29, 1999]” Sec. 4608 of AIPA 1999

n “a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the **original application.**”
35 USC § 121

Strategies for Patent Challenger

Sneak Attack

- n Ex parte Reexamination may be filed anonymously
- n Difficult for patentee to amend claims optimally to cover an unknown competitive design
- n Design around guided by claim amendments

Getting heard in an Ex Parte Reexamination

- n Responding to Patent Owner is more difficult than ever:
 - u May reply to Owner's Statement, but only if one is filed
 - u May file a second Request for Reexamination, but must show a different substantial new question of patentability, *In re Bass*, 314 F.3d 575 (Fed.Cir. 2002) no longer followed by USPTO, see MPEP §2240 (II)
- n Available against any patent
- n No appeal by third party requestor, but no estoppel either
- n Reexam may impact claim construction and summary judgment

Fight Patentee's Attempts to Strengthen Patent

n Protest

- u Guide examiner to reject claims

n Inter partes Reexamination

- u Guide examiner to reject claims
- u Deprive patentee of examiner interviews, if merged
- u But must show different substantial new question of patentability, if second reexamination

No Interviews

Estoppel

- n** Amendments and statements by patent owner during prosecution of reexamination may result in prosecution history estoppel
- n** Requester estopped from asserting invalidity over prior art documents in litigation, unless newly discovered

Written Declarations

OK, but

nNo Discovery

nNo Oral Testimony

nNo Cross-Examination

nNo Motion Practice

Requester is “estopped from challenging at a later time, in any civil action , any fact determined during the process of such reexamination, except with respect to a fact determination later proved erroneous based on information unavailable at the time of the inter partes reexamination.” 1999 Public Law 106-113 §4607

Patent Reexamination Becomes More Appealing

- n *Inter Partes* Reexamination may be appealed to Federal Circuit by third party requestor
- n May now be based on previously cited reference - *In re Portola Packaging* overruled by 2002 Justice Department Authorization Act

Stay Co-pending Litigation

35 USC §318



No Presumption of Validity:

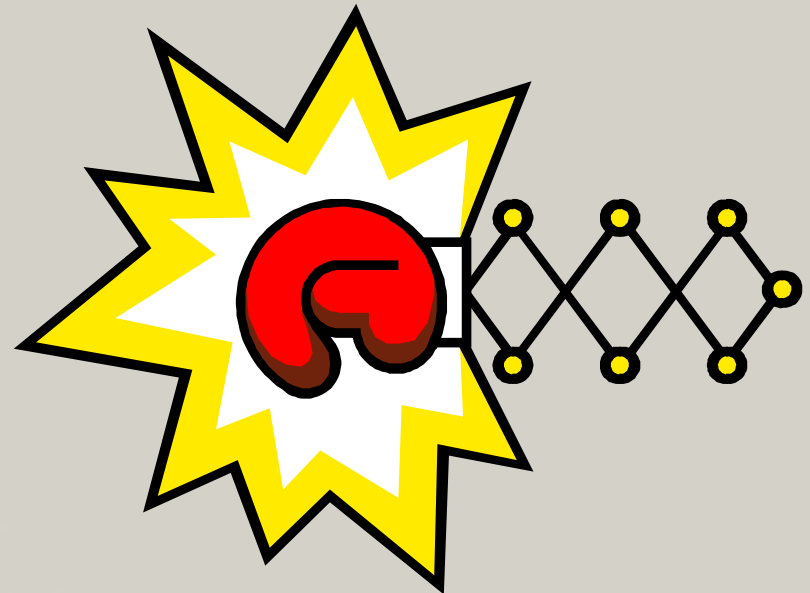
Broadest Reasonable
Interpretation of the
Claims - *In re Hiniker Co.*, 150
F.3d 1362 (Fed. Cir. 1998)

No Continuations

Patent Litigation

nClaim
construction

nPick your best
arguments



Reexamination Offers a One-Two Punch



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One: Left Jab Reexamination

- n First, claims are attacked without benefit of presumption of validity in reexamination
- n The claims are construed broadly in reexamination
- n In reexamination claims are invalidated or, if the prior art is avoided, narrowed

Two: Right Hook

n Narrowed claim construction can be asserted in litigation to avoid infringement completely, the narrowed construction may not have been possible w/o reexam

n A narrowed claim establishes intervening rights