

## Post-Issuance Options: The Benefits and Risks of Reexamination and Reissue

Congratulations, your patent has issued. Using the time you no longer spend chatting with your patent attorney, you decide to catch up on old (as in, before your filing date) issues of your favorite technical magazine. You come across an article that seems quite similar to your invention, and you begin to wonder: are my claims too broad/narrow?

Overbroad or overly narrow claims are examples of aspects of an issued patent that may be modified through either reexamination or reissue. In each of reexamination and reissue, prosecution of an issued patent is reopened to address areas of concern in the issued patent. However, reexamination and reissue are not interchangeable – each offers its own benefits and its own risks. Before requesting one of reexamination or reissue of your patent, it is important to be aware of what is required of you, what is required of your patent, and what effects the reexamination or reissue could have in the future.

### Reexamination

Reexamination offers an opportunity for patent owners (and patent challengers) to reopen prosecution of an issued patent within the period of enforceability of the patent.<sup>1</sup> Reexamination will only be granted in light of a *substantial new question of patentability*.<sup>2</sup> Which begs the question: what qualifies as a “substantial new question of patentability?” The answer is twofold.

First, the substantial new question of patentability must arise out of one or more patents or printed publications.<sup>3</sup> Other types of prior art (e.g., prior sale or public knowledge) cannot be used as a basis for requesting reexamination. The substantial new question of patentability may arise out of patents or publications already considered during prosecution if presented in a new light in the reexamination request, or out of newly-discovered patents or publications.<sup>4</sup> Second, the substantial new question of patentability must be *truly new*, meaning it cannot solely be based on a rejection already considered during prosecution.<sup>5</sup>

In order to initiate a reexamination, a request must be made to the Patent and Trademark Office (“PTO”) that identifies the patents and/or publications, the substantial new question of patentability, and each claim for which reexamination is requested; it must also provide a detailed explanation of the pertinence and manner of applying the patents and/or publications to every claim for which reexamination is requested.<sup>6</sup> If the request is initiated by a patent owner, the request may additionally include (a) an explanation of how the claims to be reexamined are distinguishable from the identified patents and/or publications, and (b) proposed amendments to one or more of the claims to be reexamined.<sup>7</sup>

For a patent challenger, reexamination comes in two forms: *ex parte* and *inter partes*. In an *ex parte* reexamination, a patent challenger cannot take any action beyond the filing of a request for reexamination.<sup>8</sup> In contrast, *inter partes* reexamination allows a patent challenger to participate in the reexamination proceedings beyond the filing of the request.<sup>9</sup> On its face, *inter partes* reexamination seems to be a preferable course of action for most patent challengers, but in fact, *ex parte* reexamination is significantly more popular.<sup>10</sup> There are three main reasons for this.<sup>11</sup> First, *ex parte* reexamination allows a patent challenger to remain anonymous, thereby avoiding retaliatory action by the patent owner.<sup>12</sup> Second, *ex parte* reexamination is less expensive than *inter partes* reexamination based on the reduced request fee (currently \$2,520.00 for *ex parte* reexamination

versus \$8,800 for *inter partes* reexamination) and the ability to avoid the fees associated with ongoing participation in an *inter partes* reexamination.<sup>13</sup> Third, a patent challenger whose request for an *inter partes* reexamination results in an order for reexamination is estopped from asserting at a later time, in any civil action, the invalidity of a claim finally determined to be valid and patentable on any ground that the third-party requester raised or *could have raised* during the *inter partes* reexamination proceedings.<sup>14</sup>

Once a request for reexamination is granted, the patent is examined in a manner similar to that of normal prosecution, with the exceptions that (a) requests for extension of time must be supported by a showing of sufficient cause<sup>15</sup> and (b) requests for continued examination are not available.<sup>16</sup> The reexamination is handled by an Examiner in a special Central Reexamination Unit at the PTO instead of the original Examiner.<sup>17</sup> Following reexamination, a reexamination certificate is issued by the PTO that notes any cancellations or amendments to the claims of the issued patent.<sup>18</sup>

## Reissue

Reissue offers an opportunity for patent owners to reopen prosecution of an issued patent any time before the expiration date of the patent. Reissue will only be granted to correct errors that occurred without deceptive intent and that cause the patent to be wholly or partly inoperative or invalid.<sup>19</sup>

Examples of errors that may cause a patent to be deemed wholly or partly inoperative or invalid include claims that are too narrow, claims that are too broad, inaccuracies in the specification or drawings, a missing or incorrect claim for foreign priority, and a missing or incorrect reference to a prior copending applications.<sup>20</sup> Examples of errors that generally will not cause the patent to be deemed wholly or partly inoperative or invalid include typographical or clerical errors.<sup>21</sup>

Unlike reexamination, reissue may allow for broadening of one or more claims of a patent, provided that the reissue is requested within two years of the grant of the patent.<sup>22</sup> A reissue that broadens one or more claims of a patent is referred to as a broadening reissue.<sup>23</sup> However, such broadening is not without limit. Not surprisingly, reissue precludes the incorporation of new matter into any portion of the patent, including the claims.<sup>24</sup>

Further, reissue precludes the “recapture” of any subject matter surrendered during prosecution of the patent.<sup>25</sup> Recapture refers to an attempt to remove from a claim a limitation that was added during prosecution to overcome a rejection.<sup>26</sup> Typically, if a limitation that was added during prosecution to overcome a rejection is completely removed from the claim in a broadening reissue, there is recapture.<sup>27</sup> Recently, though, the United States Court of Appeals for the Federal Circuit noted that while a limitation introduced to overcome a rejection may not be completely removed due to the recapture doctrine, “[t]he limitation may be modified . . . so long as it continues to materially narrow the claim scope relative to the surrendered subject matter such that the surrendered subject matter is not entirely or substantially recaptured.”<sup>28</sup>

To request reissue, a patent owner must file a reissue oath or declaration that includes a statement that the patent owner believes the original patent to be “wholly or partly inoperative or invalid.”<sup>29</sup> The patent owner must further specify the error that caused the patent to be wholly or partly inoperative or invalid.<sup>30</sup> One must recognize the importance of the reissue oath – the patent owner’s statement that the patent, as issued, is *wholly or partly inoperative or invalid* may create significant estoppel for

the patent owner. This estoppel may have two notable effects: intervening rights and claim construction issues.

Intervening rights refers to the rights of a competitor to rely on the claims of the issued patent until the patent reissues.<sup>31</sup> In some cases, intervening rights will be granted to a competitor who, “prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissue patent,” thereby freeing the competitor of past damages for actions that would have infringed the reissued patent, but not the original patent (absolute intervening rights).<sup>32</sup> Further, when “substantial preparation was made before the grant of the reissue,” the court may allow for the continued manufacture or sale of the product that infringes the reissue patent (equitable intervening rights).<sup>33</sup>

| <b>Problem</b>   | <b>Reexamination or Reissue?</b>       | <b>Who can request?</b>     |
|--|--|-----------------------------|
| <b>Failure under § 112 (Enablement, Best Mode)</b>   | Reissue                                | Patent Owner                |
| <b>Failure under § 101 Patentable Subject Matter)</b>  | Reissue                                | Patent Owner                |
| <b>Missing or Incorrect Claim for Foreign Priority</b>   | Reissue                                | Patent Owner                |
| <b>Missing or Incorrect Reference to Prior Copending Application</b>                                 | Reissue                                | Patent Owner                |
| <b>Typographical Error</b>   | Neither (Certificate of Correction)    | Patent Owner                |
| <b>Inventorship</b>  | Reissue (or Certificate of Correction) | Patent Owner                |
| <b>Claims Too Narrow</b>   | Reissue                                | Patent Owner                |
| <b>Claims Too Broad</b>  | Reissue or Reexamination               | Patent Owner or Third Party |
| <b>Failure to Cite a Pertinent Reference that Raises a Substantial New Question of Patentability</b> | Reissue or Reexamination               | Patent Owner or Third Party |
| <b>Substantive Error in Specification</b>  | Reissue                                | Patent Owner                |
| <b>Substantive Error in Drawings</b>   | Reissue                                | Patent Owner                |
| <b>Failure to Include One or More Dependent Claims</b>   | Reissue <sup>39</sup>                  | Patent Owner                |

Claim construction issues can also arise when a reissued patent is asserted in litigation because statements made in a reissue oath may affect the construction of the claims in the reissued patent. For example, in *Lucky Litter, LLC v. International Trade Commission*, the asserted patent included a claim that recited that a “comb moves toward the discharge position [of a litter chamber] automatically upon the occurrence of a predetermined event.”<sup>34</sup> In an effort to preserve the validity of the patent over a particular reference raised in litigation, the appellee asserted that the

“predetermined event” had to be understood, in light of the specification, to be only a “cat exit.”<sup>35</sup> In response, the appellant pointed to a reissue oath filed in a request for broadening reissue of the asserted patent, which identified as an error in the issued patent claims that were too narrow as a result of being limited to a cat exit.<sup>36</sup> The court determined that the statement in the reissue oath required the term “predetermined event” to be construed according to its plain meaning as opposed to the appellee’s proposed construction.<sup>37</sup>

## Reexamination vs. Reissue

Reexamination and reissue each offer their own benefits and risks. There are a number of issues to consider before launching into either process. First, consider the purpose of your request. For example, if you wish to broaden your claims, reissue is your only option. If you are a patent owner and wish to pass a reference through the PTO, reexamination is likely your best option, and is your only option if you do not believe your claims need to be amended. If you are a third party that would like to invalidate the claims of a competitor, reexamination is your only option. In addition, if your patent has expired, but is still within the remaining period of enforceability, only reexamination can be used.<sup>38</sup>

Second, consider the consequences of each. Before requesting a reexamination, be sure to remember that your claims may be confirmed but could also be narrowed. Also, remember that continued prosecution is not permitted in reexamination proceedings. And before requesting a reissue, put careful consideration into your reissue oath to avoid creating unwanted estoppel. In addition, you must be aware of the possibility of intervening rights in both reissue and reexamination.

Finally, if you have a chain of pendency back to the issued patent, consider filing a continuation application rather than applying for reexamination or reissue. In some cases, a continuation application may offer a solution without the risks involved in reexamination and reissue.

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### Endnotes

1. 37 C.F.R. § 1.510(a) (2010). Infringement occurring during the lifetime of a patent may be enforced for up to six years following the expiration date of the patent. 35 U.S.C. § 286.
2. 35 U.S.C. § 303(a) (2006).
3. 37 C.F.R. § 1.510(b)(1) (2010).
4. M.P.E.P. § 2216 (8th ed. Rev. 7, Jul. 2010).
5. *Id.*
6. 37 C.F.R. § 1.510 (b)(1)-(2) (2010).
7. 37 C.F.R. § 1.510 (b)(2), (e) (2010).
8. There is one exception: if a patent owner submits a statement in response to the request for *ex parte* reexamination, the patent challenger may submit a reply to the patent owner’s statement. 37 C.F.R. §§ 1.530(c), 1.535 (2010).
9. 37 C.F.R. § 1.947 (2010).

10. In 2010, 780 *ex parte* reexamination requests were filed, as compared with only 281 *inter partes* reexamination requests. U.S. Patent and Trademark Office, *Ex Parte Reexamination Filing Data*, Mar. 31, 2011; U.S. Patent and Trademark Office, *Inter Partes Reexamination Filing Data*, Mar. 31, 2011.
11. W. Todd Baker, *Ex Parte Patent Reexamination & Patent Reissue – Opportunities and Pitfalls*, Intell. Prop. Course Handbook Series, Jan.-Feb. 2011, at 4.
12. *Id.*; M.P.E.P. § 2213.
13. 37 C.F.R. § 1.20 (a)-(b) (2010); Baker, *supra* note 11, at 4.
14. 35 U.S.C. § 315(c) (2010).
15. 37 C.F.R. § 1.550(c) (2006).
16. M.P.E.P. § 2271.
17. M.P.E.P. § 2236 (I).
18. 35 U.S.C. § 307(a) (2006).
19. 35 U.S.C. § 251 (2006).
20. M.P.E.P. § 1402.
21. Typically, these errors may be corrected via a certificate of correction, as described in M.P.E.P. § 1481.
22. 35 U.S.C. § 251 (2006).
23. M.P.E.P. § 1412.03.
24. M.P.E.P. § 1411.02.
25. M.P.E.P. § 1412.02.
26. For a more comprehensive discussion of recapture, *see* M.P.E.P. § 1412.02.
27. M.P.E.P. § 1412.02(I)(C).
28. *In re Mostafazadeh*, No. 2010-1260, 2011 WL 1642830, at \*4 (Fed. Cir. May 3, 2011). Notably, the Federal Circuit made this statement in a decision affirming the PTO's Board of Patent Appeals and Interferences rejection of the claims of a reissue application on the basis of recapture.
29. 37 C.F.R. § 1.175(a)(1) (2010).
30. *Id.*
31. 35 U.S.C. § 252 (2006); M.P.E.P. § 1460. Intervening rights resulting from reexamination proceedings parallels the intervening rights resulting from reissue patents. 35 U.S.C. §§ 307(b), 316(b).
32. 35 U.S.C. § 252 (2006).
33. *Id.* Intervening rights may be granted following a reexamination as well. M.P.E.P. §§ 2293, 2693.
34. *Lucky Litter LLC v. Int'l Trade Comm'n*, 403 Fed. Appx. 490, 493 (Fed. Cir. 2010).
35. *Id.* at 494.
36. *Id.* at 493 (noting that “recitations regarding a cat exit sensor and a delay means . . . are too limiting of the invention.”).
37. *Id.* at 494.
38. *See* 37 C.F.R. 1.150(a) (2010).
39. *See In re Tanaka*, No. 2010-1262, 2011 WL 1437887, at \*5 (Fed. Cir. Apr. 15, 2011).