



Central Reexamination Unit and the AIA

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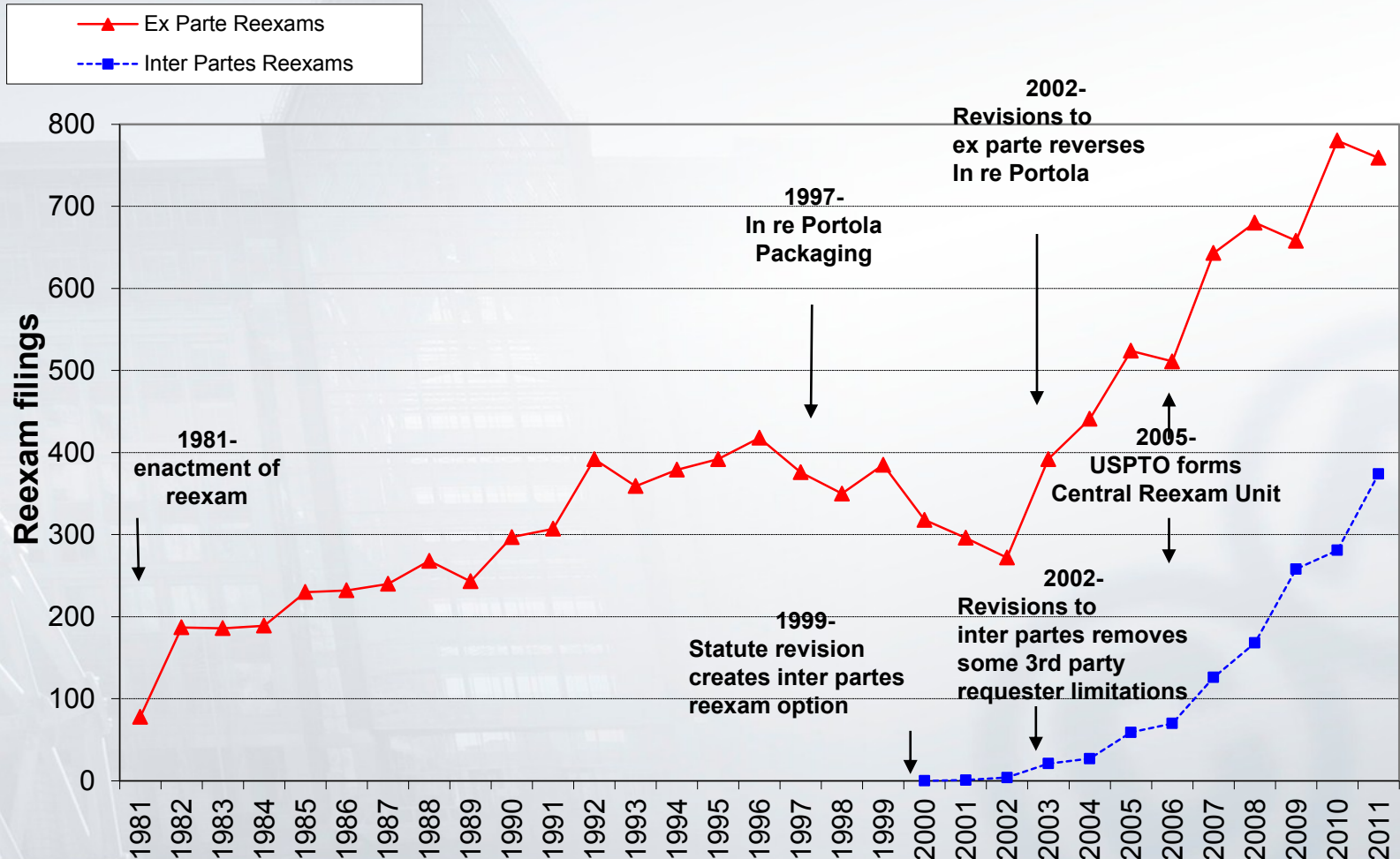
Central Reexamination Unit at a Glance

- GS-15 Reexamination Specialists with several years of primary examiner experience
- Currently at 85+
- 16 Technical Support Staff (TSS)
- 10 Supervisory Reexamination Specialists and 1 Supervisor for the TSS



Reexamination Filings

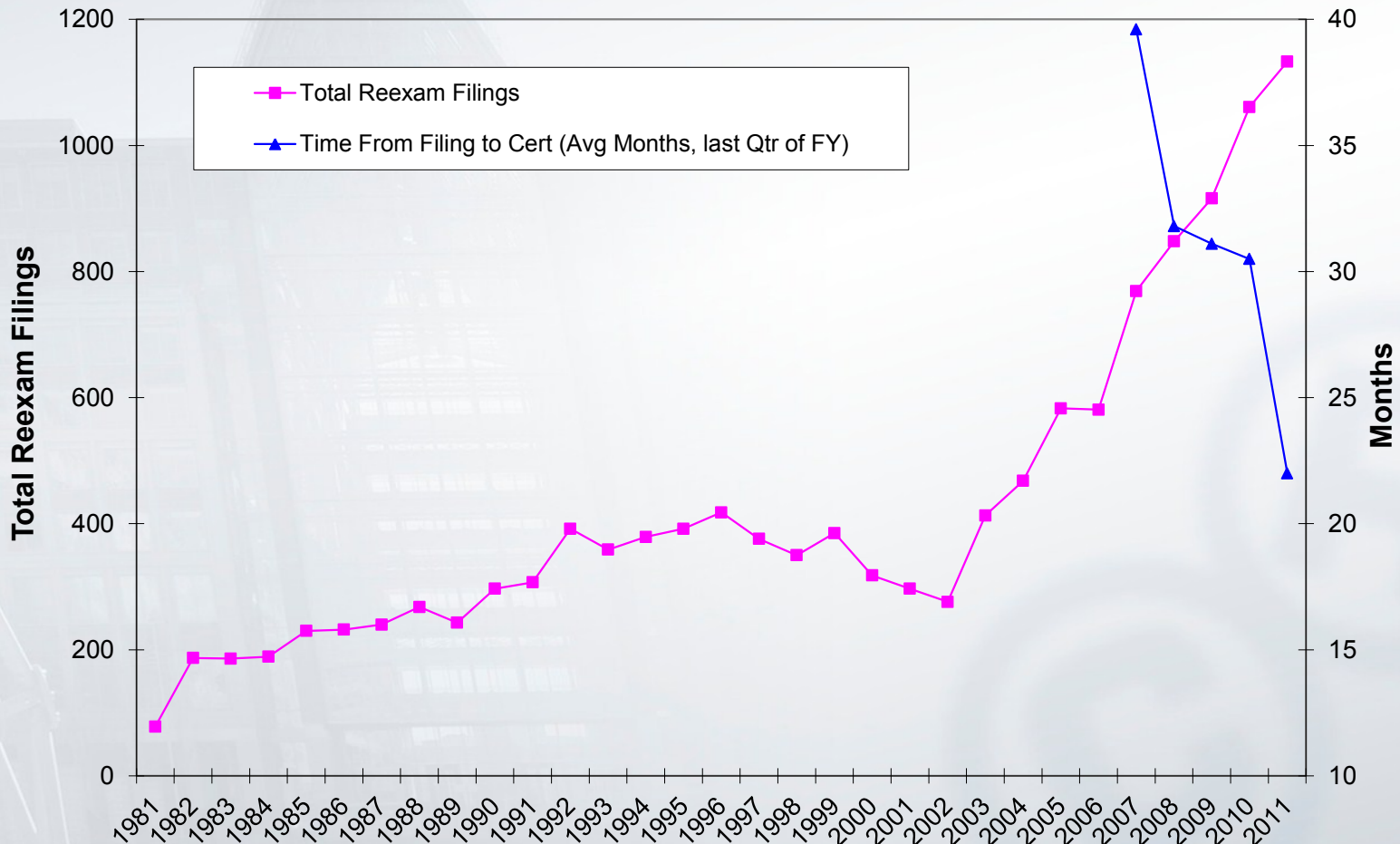
Reexamination Filings and Key Events





Reexamination Filings and Recent Timeliness Improvements

Reexam Filings and Time to Certify





BPAI Reexamination Stats

FY 2012 (ytd, through Jan.)	Appeals Received	Appeals Disposed	Appeals Pending
Ex Parte	39	51	14
Inter Partes	70	40	81



More Reexamination Statistics

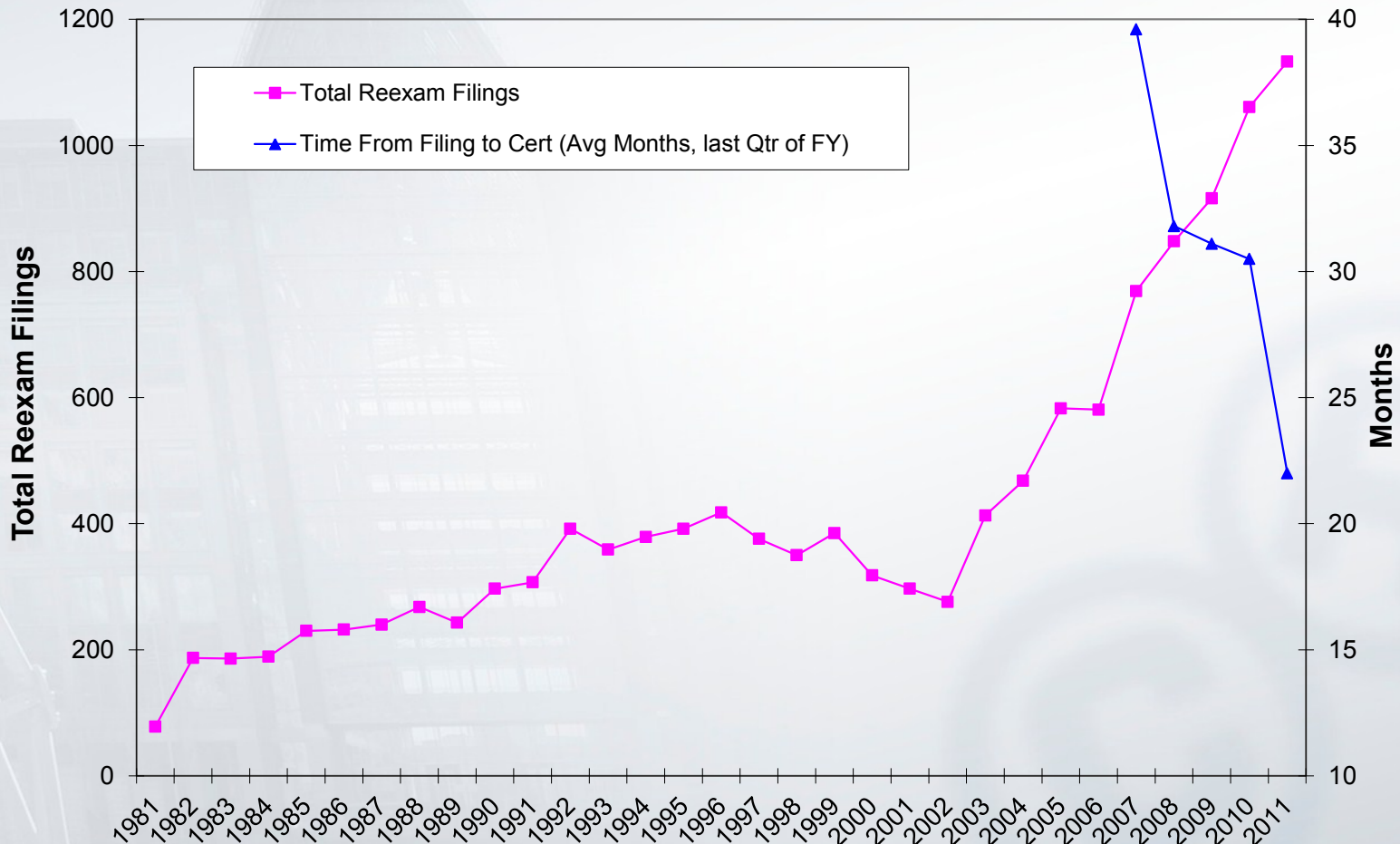
Full reexamination statistics may be found on the USPTO website

- http://www.uspto.gov/patents/Reexamination_operational_statistic_through_FY2011Q3.pdf (operational)
- http://www.uspto.gov/patents/EP_quarterly_report_June_2011.pdf (historical *ex parte* stats)
- http://www.uspto.gov/patents/IP_quarterly_report_June_2011.pdf (historical *inter partes* stats)
- <http://www.uspto.gov/ip/boards/bpai/dashboards/index.jsp> (appeals stats)



Reexamination Filings and Recent Timeliness Improvements

Reexam Filings and Time to Certify





Initiatives to Improve Processing and Pendency of Reexamination Proceedings

- Increased staffing of CRU
- Waiver of Patent Owner Statement period for *Ex parte* (pilot program)
- Expedited handling of CRU papers by contractors
- Revamping of data transfer between CRU and publications branch (on-going)
- Revamping of CRU TSS processing procedures (initial stages)



REEXAMINATION AND THE AIA

- Revision of Standard for Granting an *Inter Partes* Reexamination Request, 76 Fed. Reg. 59055 (Sept. 23, 2011) (Final rule) per section 6 of the AIA
- Transition from *Inter partes* reexamination to *Inter partes* Review (IPR) at the Patent Trial and Appeal Board (PTAB) effective September 16, 2012
- Supplemental Examination commences September 16, 2012



Standard for *Inter Partes* Reexamination

A request for *inter partes* reexamination filed during the transition year (prior to September 16, 2012) will not be granted unless:

- the information presented in the request shows that there is a reasonable likelihood that the requester will prevail with respect to at least 1 of the claims challenged in the request (the “reasonable likelihood” standard).
- *Inter partes* reexaminations ordered, which are based upon requests filed prior to September 16, 2012, will continue, and be governed by the *inter partes* reexamination statutes and rules (remain in the CRU)



Standard for *Inter Partes* Reexamination

- *Inter partes* reexamination requests filed on or after September 16, 2011, but before September 16, 2012:
 - The reasonable likelihood standard is applicable in determining whether the request for *inter partes* reexamination will be granted.
- Any request for *inter partes* reexamination submitted on or after September 16, 2012, will not be accorded a filing date, and any such request will not be granted.



Standard for *Inter Partes* Reexamination

- The reasonable likelihood standard is different from the substantial new question standard.
- Reasonable likelihood standard does not require that the requester establish a *prima facie* case.
- The reasonable likelihood standard does not apply to *ex parte* reexaminations.



Standard for *Inter Partes* Reexamination

For example: In an *inter partes* reexamination request, claims 1-10 are asserted to be anticipated by U.S. Patent No. 9,123,456 (the '456 patent).

- Requester provided a detailed all elements analysis of how the '456 patent is applied to claims 1 and 2, citing to specific teachings, drawings, and reference numbers, for the purpose of establishing that each and every limitation of claims 1 and 2 are disclosed by the '456 patent.
- The order granting reexamination found that requester had demonstrated a reasonable likelihood of prevailing by providing evidence addressing all the elements of claims 1 and 2.



Standard for *Inter Partes* Reexamination

- Requester argued that claims 3-10 were also anticipated by the '456 patent, and reexamination was appropriate since the '456 patent, as applied, evidenced a reasonable likelihood to prevail.
- As to the specifics of dependent claims 3-10, requester only generally discussed the claims, and did not give any citations to specific teachings in the '456 patent that addressed the limitations set forth in claims 3-10.
- The order found that requester did not demonstrate a reasonable likelihood of prevailing, as evidence addressing the elements of claims 3-10 was not provided, and a review of the '456 patent concluded that the limitations were not disclosed.



Supplemental Exam

(Effective September 16, 2012)

- New 35 U.S.C. § 257
- Patent owner may request supplemental examination of a patent to “consider, reconsider, or correct information” believed to be relevant to the patent. § 257(a)
 - Proposed rule 601(a): Request must be filed by owner of the entire right, title, and interest in the patent
 - Proposed rule 601(c): Third party participation is prohibited



Supplemental Exam (cont.)

- “Information” that forms the basis of the request is not limited to patents and printed publications. § 257(a)
 - Proposed rule 605(a): Number of items of information is limited to 10 per request
 - Proposed rule 605(a): Unlimited number of requests may be filed at any time



Supplemental Exam (cont.)

- Proposed rule 610: Recites contents of a request and consists of 12 parts including:
 - List of each item of information and its publication date;
 - Identification of each issue raised by each item of information;
 - Explanation for each identified issue;
 - Identification of how each item of information is relevant to each aspect of the patent to be examination and how each item of information raises each identified issue;
 - Copy of each item of information; and
 - Summary of each document over 50 pages in length



Supplemental Exam (cont.)

- USPTO must decide whether the information in the request raises a “substantial new question of patentability” within 3 months from the request. § 257(a)
 - Proposed rule 620 (a): SNQ decision “will generally be limited to” review of the issue identified in the request as applied to the patent claims
 - Proposed rule 620(e): No interviews in supplemental examination, but possible if ex parte reexamination instituted
 - Proposed rule 620(f): No claim amendment in supplemental examination, but possible if ex parte reexamination instituted



Supplemental Exam (cont.)

- Supplemental examination concludes with a supplemental reexamination certificate indicating whether any item of information raised an SNQ. § 257(a)
 - If SNQ, then the Director must order an *ex parte* reexamination. § 257(b)
 - Proposed rule 625(a): certificate will be electronic



Supplemental Exam (cont.)

- *Ex parte* reexamination conducted under 35 U.S.C. chapter 30 and 37 CFR 1.510 et seq. (the *ex parte* reexamination statute and rules), except:
 - Patent owner does not have the right to file a statement; and
 - USPTO will address each SNQ without regard to whether it is raised by a patent or printed publication.
§ 257(b)



Supplemental Exam (cont.)

- Inequitable conduct immunization, § 257(c)
 - Information considered, reconsidered, or corrected during supplemental examination cannot be the basis for rendering a patent unenforceable so long as the supplemental exam and any ordered ex parte reexamination are finished before the civil action is brought, § 257(c)(1) & (c)(2)(B)
 - But does not apply to information raised in a civil action brought before supplemental exam sought. § 257(c)(2)(A)



Supplemental Exam (cont.)

- Director is authorized to establish fees, and if *ex parte* reexamination is ordered, fees for *ex parte* reexamination to be collected in addition to fee for supplemental examination, § 257(d)(1)
 - Proposed rule 20(k)(1) & (2): \$5,180 for supplemental examination and \$16,120 for *ex parte* reexamination order pursuant to a supplemental examination (total of \$22,100)
 - Proposed rule 610(a): total fee must accompany request
 - Proposed rule 26(c): *ex parte* reexamination fee will be refunded if *ex parte* reexamination not ordered
 - Proposed rule 20(k)(3): non-patent document over 20 sheets has extra cost



Supplemental Exam (cont.)

- If Director learns of “material fraud” committed in connection with the patent subject to supplemental exam, the Director:
 - must confidentially refer the matter to the Attorney General; and
 - may take other action. § 257(e)
- Office regards “material fraud” to be narrower in scope than inequitable conduct as defined in *Therasense*. 77 Fed. Reg. at 3667



Ex Parte Reexamination Fee

- Proposed rule 20(c)(1): *Ex parte* reexamination fee not pursuant to a supplemental examination is increased to \$17,750 from current \$2,520



Fee Methodology

- Supplemental exam and reexamination fees set under 35 U.S.C. § 41(d)(2) for cost recovery and not under Section 10 of the AIA
 - May later be adjusted when USPTO exercises Section 10 fee setting authority
- See Cost Calculations for Supplemental Examination and Reexamination (January 25, 2012), available at http://www.uspto.gov/aia_implementation/cost_calc_supplemental_exam.pdf



Additional Changes to Reexamination Practice (non-AIA)

- Notice posted April 25, 2011 requesting comments and public meeting on the proposed changes.
 - Written comment period ended June 29, 2011
- Public meeting held June 1, 2011



Proposed Changes to Streamline Reexamination Proceedings

- Eight proposed changes to both *Ex Parte* and *Inter Partes* reexam practice
 - Two proposed changes specific to *Ex Parte* reexam
 - Three proposed changes specific to *Inter Partes* reexam
- In light of passage of the AIA on September 16, 2011, only proposed changes to *Ex parte* will be covered



Proposed Changes to Streamline Reexamination Proceedings

Proposed Changes to *Ex Parte*

- Petitions practice more clearly defined
- Requester declaration & evidence limited to request
- Addressing Patent Owner's submissions
 - Amendment & evidence limited to request
 - Amendments accompanied by explaining how new claim language renders claims patentable



Proposed Changes to Streamline Reexamination Proceedings

Proposed Changes to *Ex Parte* (con't)

- Make permanent the pilot on waiver of Patent Owner's statement
- If no waiver of Patent Owner's statement, the order granting will include provisional first Office action
- Addressing requestor presentation of SNQ
 - Consistent format
 - Each SNQ must be "new" and non-cumulative
 - Explain how each reference applies to every limitation
- Examiner may select one or more representative rejections



Thank you

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