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Parallel proceedings study and notice regarding options for reissue and reexamination during AIA trials

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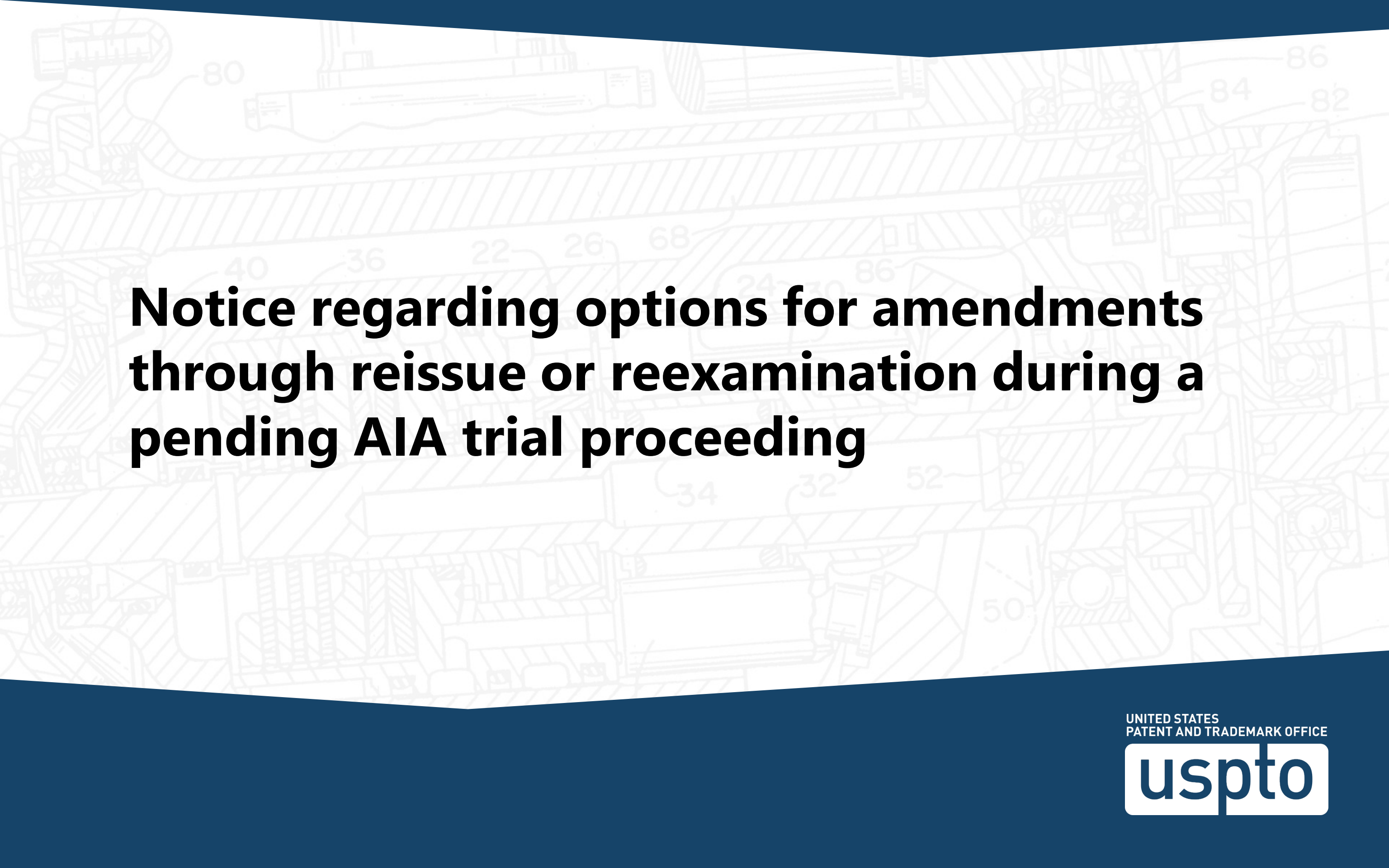
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Question/comment submission

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A faint, light gray technical drawing of a mechanical assembly, possibly a piston or engine component, serves as the background. It features various numbered callouts (e.g., 80, 86, 84, 82, 40, 36, 22, 26, 68, 24, 30, 86, 34, 32, 52, 50, 50) and hatching lines indicating different materials or sections.

Notice regarding options for amendments through reissue or reexamination during a pending AIA trial proceeding

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Introduction

- On October 29, 2018, the Office published a request for comment (RFC) on proposed changes to motion to amend (MTA) practice in AIA trials.
- The office received 49 comments in response to this RFC as of December 21, 2018 (closing date for comments).
 - Comments also included requests for clarification regarding existing reissue and reexamination procedures at the Office.

Introduction

- In response to comments, the Office issued the following two notices:
 1. Notice regarding a new pilot program concerning MTA practice and procedures in trial proceedings under the AIA before the PTAB, 84 FR 9497 (March 15, 2019) and
 2. Notice regarding options for amendments by patent owner through reissue or reexamination during a pending AIA trial proceeding.

Amendments through reissue or reexamination

This notice provides:

- A summary of current practice regarding existing office procedures that apply to reissue and reexamination, including after a petitioner files an AIA petition challenging claims of same patent, after board institutes a trial, and after board issues a final written decision (FWD)
- Summary information about factors the Office currently considers when determining:
 - Whether to stay or suspend a reissue proceeding, or stay a reexamination proceeding, that involves a patent at issue in an AIA proceeding; and
 - When and whether to lift such a stay or suspension

Amendments through reissue or reexamination

To conduct a full assessment of the issues, and to obtain sources of citations in papers submitted to the Office, please continue to consult:

- relevant statutes,
- regulations,
- case law, and
- the Office's Manual of Patent Examining Procedure (MPEP).

Amendments through reissue or reexamination

- The Office will consider a reissue application or a request for reexamination any time before, but not after, either:
 - (1) Office issues a certificate that cancels all claims of a patent, or
 - (2) Federal Circuit issues a mandate in relation to a decision that finds all claims of a patent are invalid or unpatentable.

Amendments through reissue or reexamination

The Office will not issue a trial certificate (e.g., canceling all claims) relating to a patent at issue in an AIA proceeding until after either:

1. Deadline for filing a notice of appeal to Federal Circuit has passed without a party filing an appeal, which is:
 - 63 days after the date of a FWD, or
 - 63 days after the date of a decision on a request for rehearing regarding the FWD.
2. All decisions or determinations in relation to an appeal to the Federal Circuit regarding the patent are finally resolved.

Amendments through reissue or reexamination

- Thus, patent owners (POs) may avail themselves of a reissue application or a request for reexamination before, during, or after an AIA trial concludes with a FWD, as long as application or request is timely filed.
- If the Office issues a certificate cancelling all claims of a patent:
 - MPEP 1449.01 provides guidance on further prosecution of a reissue application.
 - MPEP 2286 (IV) provides guidance on further prosecution of a reexamination proceeding.

Amendments through reissue or reexamination

- For example, a PO may file a reissue application or a request for reexamination within 63 days of a FWD regarding the patent at issue in an AIA trial.
- Actions taken by Office in response to such an application or request will depend on the timing of the filing and other relevant facts and issues.

Reissue applications

- PO may file a reissue application to amend claims before, during, or after an AIA trial concludes with a FWD.
- 35 U.S.C. § 251 requires an “error”
 - Error requirement is satisfied by a PO’s failure to previously present narrower claims.
 - *See, e.g., In re Tanaka*, 640 F.3d 1246, 1251 (Fed. Cir. 2011)

Reissue applications

- Thus:
 - No admissions as to patentability of original claims are required.
 - Oath accompanying a reissue application may include a statement about an error related to original patent's failure to earlier present narrower claims, *see* MPEP 1414(II).
- A reissue then proceeds through examination in much the same way as an application for a patent under original examination.
 - May be stayed, as discussed in more detail to follow

Reissue applications

- An “application for reissue of a patent shall constitute an offer to surrender that patent, and the surrender shall take effect upon reissue of the patent.” 37 CFR § 1.178(a)
- PO may abandon a reissue application at any time before reissue of the patent.
 - E.g., after obtaining a favorable result in a FWD or on appeal
- Before reissuance, original patent is not surrendered and remains in effect.

Reissue applications

- Office provides third party notice (by announcement of the reissue application in the Official Gazette) and a limited opportunity for a third party to be heard (by filing a protest).
- 35 U.S.C. § 315(b) bar triggered by service of a complaint alleging infringement of the original patent may not apply to the reissued patent.

***Ex parte* reexamination**

- PO also may seek to amend its claims by filing a request for *ex parte* reexamination before, during, or after an AIA trial concludes with a FWD.
- Reexamination presents considerations not present with regard to reissue applications.

***Ex parte* reexamination**

- Director is required to determine whether a request for reexamination raises “a substantial new question [SNQ] of patentability affecting any claim of the patent concerned.”
35 U.S.C. § 303
- SNQ is not raised if the “question of patentability has already been . . . decided in an earlier concluded examination or review of the patent by the Office” MPEP 2242(I)
- Once an SNQ is established, a SNQ is not needed for new or amended claims.

***Ex parte* reexamination**

- SNQ cannot be a question raised in a ground already decided in a FWD.
 - A later-filed request must have an SNQ different than that addressed in the FWD.
- SNQ cannot be established based on new questions raised in relation to amended claims proposed during reexamination.
 - SNQ is “established for the existing claims in the patent in order to grant reexamination.” MPEP 2242(I)
 - Reexamination “request should be decided on the wording of the patent claims in effect at that time (without any proposed amendments).” MPEP 2221
 - 35 U.S.C. § 303 requires SNQ to be “affecting any claim of the patent.”

***Ex parte* reexamination**

- Prior to issuance of a FWD, an SNQ may be established based on a question raised in a ground presented in an AIA petition. *See* MPEP 2242(I).
- If Patents grants a reexamination request, however, the Office may stay the reexamination pending a FWD in a AIA trial addressing the same patent.

Reissue vs. reexamination

In contrast to reissue:

- Reexamination results in issuance of a certificate in the original patent, rather than issuance of a new patent.
- § 315(b) one-year bar triggered by service of a complaint alleging infringement of the original patent may apply to a reexamined patent, even if reexamination involves amended claims.

Reissue vs. reexamination

- Reissue may address all statutory requirements relating to patentability (i.e., 35 U.S.C. §§ 101, 102, 103, 112).
- Reexamination generally addresses only issues relating to §§ 102 and 103, as well as § 112 under limited circumstances (i.e., only as raised by newly added subject matter in an amendment).
- Reexamination proceeding must be based on prior art consisting of patents and printed publications (35 U.S.C. §§ 301, 302).

Stays of reissue or reexamination

- The Director has authority to determine approach regarding stays of a reissue or *ex parte* reexamination proceeding during the pendency of an AIA trial proceeding of the same patent (35 U.S.C. §§ 315(d), 325(d)).
- The Director has authorized the Board to enter an order to effect a stay, transfer, consolidation, or termination of parallel Office proceedings involving the same patent during pendency of an AIA trial proceeding (37 CFR §§ 42.3(a), 42.122(a), 42.222(a)).
- **The Board ordinarily will stay a parallel Office proceeding where good cause exists.**
 - **Good cause may exist if, for example, an on-going AIA proceeding is addressing the same or overlapping claims of a patent at issue in a parallel office proceeding.**

Motions to stay or lift stays in AIA proceedings

- Parties may request authorization to file a motion to stay a reissue or reexamination, or a motion to lift a stay, at any time during pendency of an AIA proceeding.
- The Board typically will consider motions to stay a concurrent office proceeding (or may impose a stay *sua sponte*):
 - o After institution of an AIA trial proceeding, and
 - o Before the filing of a notice of appeal or the deadline for filing a notice of an appeal to Federal Circuit has passed.

Non-limiting factors considered by the Board when deciding whether to grant a stay of a reissue or reexamination

- Whether claims challenged in a related AIA proceeding are the same as or depend directly or indirectly from claims at issue in concurrent parallel proceeding;
- Whether same grounds of unpatentability or the same prior art are at issue in both proceedings;
- Whether concurrent parallel proceeding will duplicate efforts within the Office;
- Whether concurrent parallel proceeding could result in inconsistent results between proceedings (e.g., whether substantially similar issues are presented in concurrent parallel proceeding)

Non-limiting factors considered by Board when deciding whether to grant a stay of a reissue or reexamination (continued)

- Whether amending claim scope in one proceeding would affect claim scope in another proceeding;
- Respective timeline and stage of each proceeding;
- Statutory deadlines of the respective proceedings;
- Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot.

Denying institution under 35 U.S.C. § 325(d)

- The Board may deny institution under § 325(d) of a requested AIA trial proceeding if a parallel reissue application or reexamination proceeding, for example, is:
 - o In a more advanced stage, and
 - o involves overlapping issues with the proposed AIA trial proceeding.

Suspension of a reissue application by Patents

- Patents may suspend a parallel reissue proceeding either *sua sponte* or on request of applicant under 37 CFR § 1.103.
- Patents typically will consider similar factors discussed above but will weigh them in view of relevant facts and circumstances at the time suspension is being considered.
- *See, e.g.,* MPEP 1442.02: Patents typically will suspend when there is concurrent litigation or a pending trial before the Board.
- Patents may or may not suspend a reissue application if it is evident to the examiner, or the applicant indicates, for example:
 1. “the . . . trial before the PTAB has been terminated”
 2. “there are no significant overlapping issues between the application and the litigation or pending trial before the PTAB” or
 3. “it is applicant’s desire that the application be examined at that time”.

Non-limiting factors considered by the Board when deciding whether to lift a stay

- Whether factors considered when ordering stay (i.e., factors indicating good cause) have changed from when stay was ordered;
- Whether PO has requested adverse judgment or canceled all claims at issue in AIA trial proceeding;
- Whether PO is requesting rehearing of, or appealing, the FWD;
- Whether PO agrees to abide by estoppel provisions in 37 CFR § 42.73(d)(3) (i.e., not obtain a claim patentably indistinct from a claim cancelled or found unpatentable during AIA trial proceeding);
- Whether lifting stay would be in the interests of efficient administration of the Office and integrity of the patent system.

When ordering a stay of a parallel proceeding

- The Board generally will indicate that a stay will remain in place “pending the termination or completion of the instant proceeding”.
 - o Thus, absent a motion to lift the stay, a stay typically will remain in place until at least after the deadline for filing of a notice of an appeal to Federal Circuit has passed.
 - o Issuance of trial certificate signifies completion of an AIA proceeding and automatically lifts a stay entered with the language noted above.

Motion to lift a stay of a parallel proceeding

- If PO files a motion to lift a stay after a FWD:
 - The Board typically will lift stay, absent reasons not to do so, e.g., in view of factors discussed above.
 - The Board typically will lift a stay if PO proposes amendments in a reissue or reexamination in a meaningful way not previously considered by the Office.
 - o Meaningful amendments include those that narrow the scope of claims considered in an AIA proceeding or otherwise attempt to resolve issues identified in a FWD.

Other non-limiting factors considered by Patents when deciding whether to lift a reissue suspension:

- If requested by PO after Board issues a FWD (or a relevant rehearing decision), Patents may lift a suspension of (or not suspend) a related reissue while an appeal to Federal Circuit regarding the FWD is pending.
- Patents may lift a suspension if PO adequately shows that reissue application attempts to:
 1. Resolve issues with original or proposed substitute claims identified in FWD (e.g., amends claims in a meaningful way not previously considered by Office, also taking into account estoppel provisions, if applicable); or
 2. Correct an unrelated issue with patent (e.g., correction of a priority claim, inventorship, or a drawing).
- Otherwise, Patents generally will not lift a suspension.

During appeal to the Federal Circuit

- As noted previously, under certain circumstances, the Office will proceed with a reissue application or request for *ex parte* reexamination after the Board issues a FWD relating to the same patent.

Reissue proceedings and Federal Circuit appeals

- After a FWD issues, as long as PO files in a timely manner, and raises issues different than those already considered in the AIA proceeding (e.g., amendments meaningfully different than those in a previously presented motion to amend), the Office typically will consider a reissue application (subject to possible suspension considerations).
- If a Federal Circuit appeal remains ongoing when an examiner identifies allowable subject matter, the Office typically will not pass a reissue application to allowance until Federal Circuit appeal concludes.
- The examiner may need to reevaluate status of allowable subject matter in view of a decision by Federal Circuit.

Reissue options after Federal Circuit appeal

- After Federal Circuit appeal concludes, PO may confer with examiner and decide how to proceed with reissue:
 - o For example:
 - Proceed to issuance,
 - File a request for continued examination (RCE) for further amendments/ prosecution, or
 - Abandon reissue application.

Reexamination options after the Federal Circuit appeal

- Unlike reissue applications, POs do not have the option to abandon *ex parte* reexamination proceedings.
- Once started, reexaminations proceed with special dispatch to completion (*see* 35 U.S.C. § 305).
- Thus, after the Office determines that it is appropriate to lift a stay, or that a stay is not appropriate, reexamination typically will continue to completion, notwithstanding a Federal Circuit appeal of a FWD on the same patent.

Reexamination options after Federal Circuit appeal

- If the Office identifies allowable subject matter, or determines that some or all claims are unpatentable, the Office typically will issue a NIRC and reexamination certificate, even if a relevant Federal Circuit appeal is ongoing, unless PO timely files a notice of appeal in the reexamination (for Board review).
- PO may appeal a final rejection of any claim to the Board by filing a notice of appeal within required time.
- Thus, to ensure a reexamination certificate does not cancel original patent claims that are separately on appeal at the Federal Circuit, PO must timely file an appeal of any final rejection of those original claims.

Question/comment submission

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AIA trial/reexam/reissue parallel proceedings study

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Purpose

- Explore the interaction between parallel proceedings at the USPTO (e.g., AIA proceedings, reexamination, and reissue) involving issued patents.
- Determine how many patents had overlapping proceedings, and if so, what was the timing between the proceedings.
- Attempt to identify trends in the use of the proceedings by the parties.

Methodology

- This study was conducted in collaboration with the Central Reexamination Unit (CRU).
- The statistics depict data from the start of AIA filings (September 16, 2012) through mid-year FY18 (March 31, 2018).
- The study covered any corresponding reissue or reexam filed through mid-year FY18 (March 31, 2018) for the challenged patents.
- We analyzed 5,056 patents challenged in the AIA proceedings and any corresponding reissue and reexam for those challenged patents.

Reissues and “reexams”

A reissue is an application to correct an error in an *unexpired patent*.

- The reissue applicant is the *original patentee*, or the current patent owner, if there has been an assignment.

In this study, we refer to the following as “reexams”:

- Ex parte reexaminations (“EP reexams”)

Who can request an EP reexam? Anyone, including the patent owner, except those barred by estoppel provisions.

When can an EP reexam be filed? Any time during the patent’s period of enforceability.

- Inter partes reexaminations (before September 16, 2012) (“IP reexams”)

Who was able to request an IP reexam? Any third party requester.

When was an IP reexam able to be filed? Any time during the patent’s period of enforceability (for a patent issued from an original application filed on or after November 29, 1999).

- Supplemental examinations (“SEs”)

Who can request an SE? A patent owner.

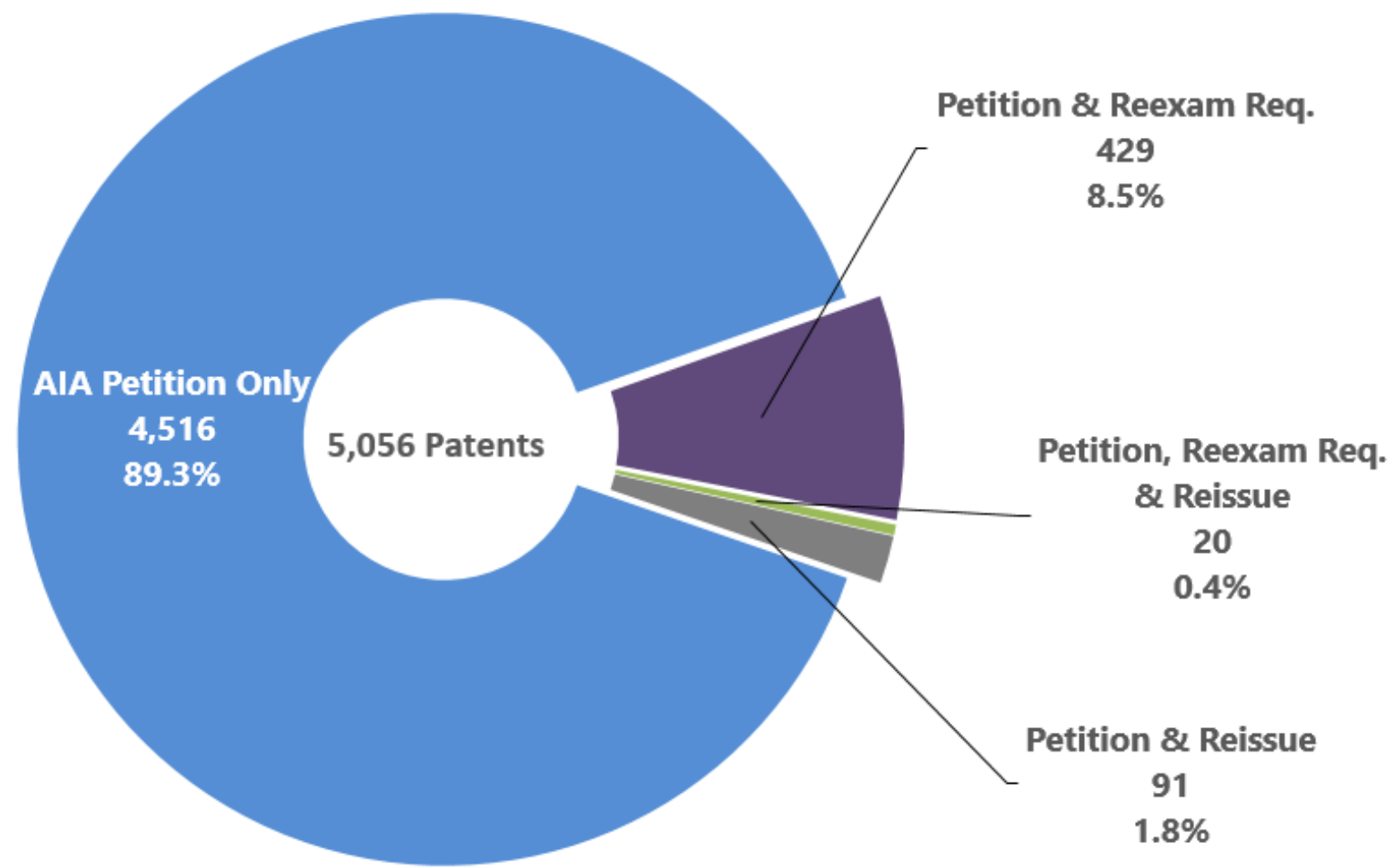
When can an SE be filed? Any time during the patent’s period of enforceability.

Summary

- 89% of patents challenged in AIA proceedings have not had any associated reexams or reissues.
- Decrease from FY12 to mid-year FY18 in percentage of patents that have received both:
 - Reexam request and/or reissue application
 - AIA petition
- In 71.5% of all patents that had both reexam request and an AIA petition, the reexam request was filed before the AIA petition.
- In 70.3% of all patents that had both reissue and an AIA petition, the reissue application was filed on or after the AIA petition.
- There were about four times as many patents that had an AIA petition and a reexam request as patents that had an AIA petition and a reissue.

Patents with a reexam request or reissue and challenged in AIA proceeding

(As of mid-year FY18: Sept. 16, 2012 – Apr. 1, 2018)



Patents with a **reexam** request and challenged in AIA proceeding

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**How has the percentage of
patents challenged in an AIA
proceeding also having
corresponding **reexam**
changed over time?**

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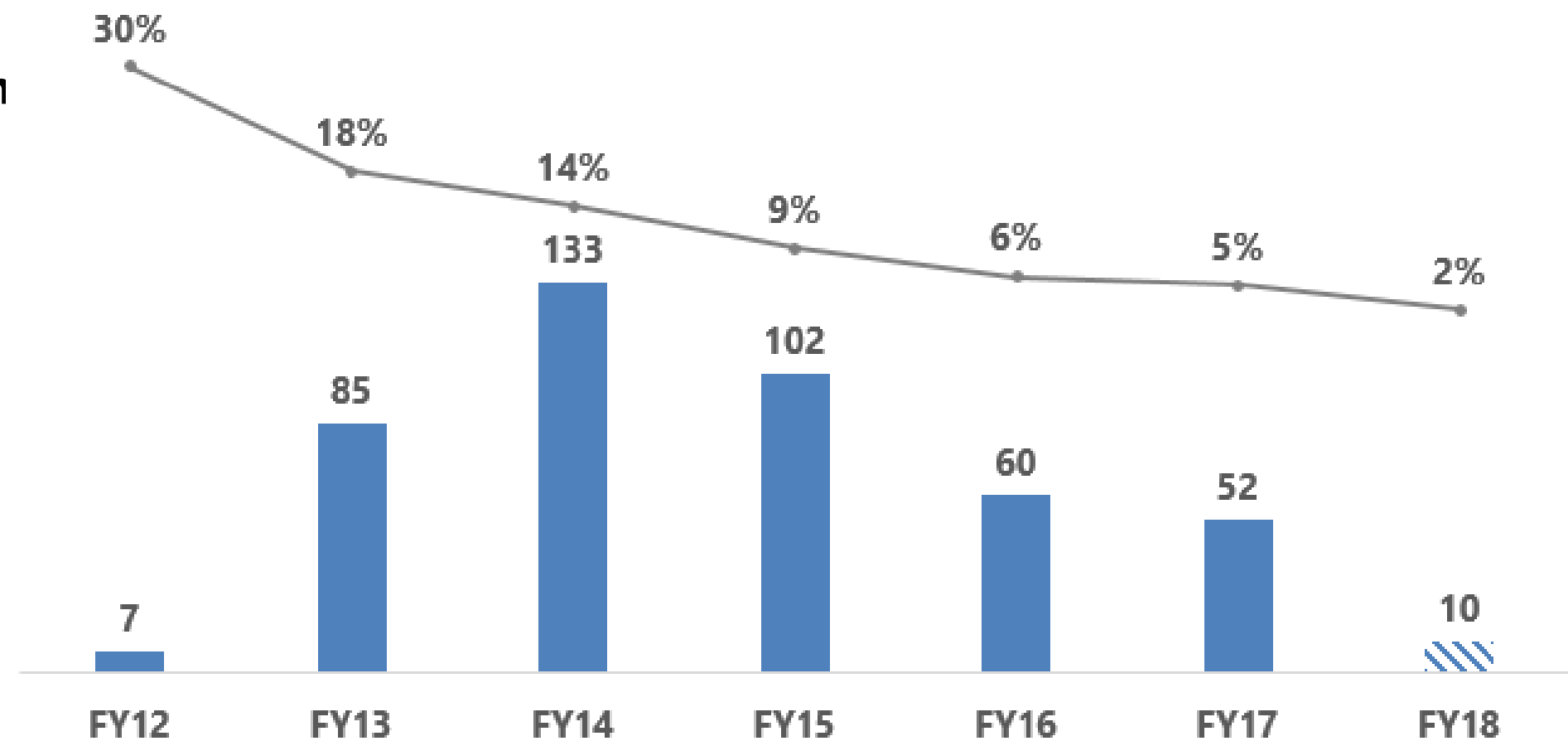


Patents with a reexam request and challenged in AIA proceeding

(As of mid-year FY18: Sept. 16, 2012 to Apr. 1, 2018)

Percentage of All
Patents Challenged in
AIA Proceedings

Patents with a
Reexam Request and
Challenged in AIA
Proceedings



When was the **reexam filed
in relation to the AIA
proceeding milestones?**

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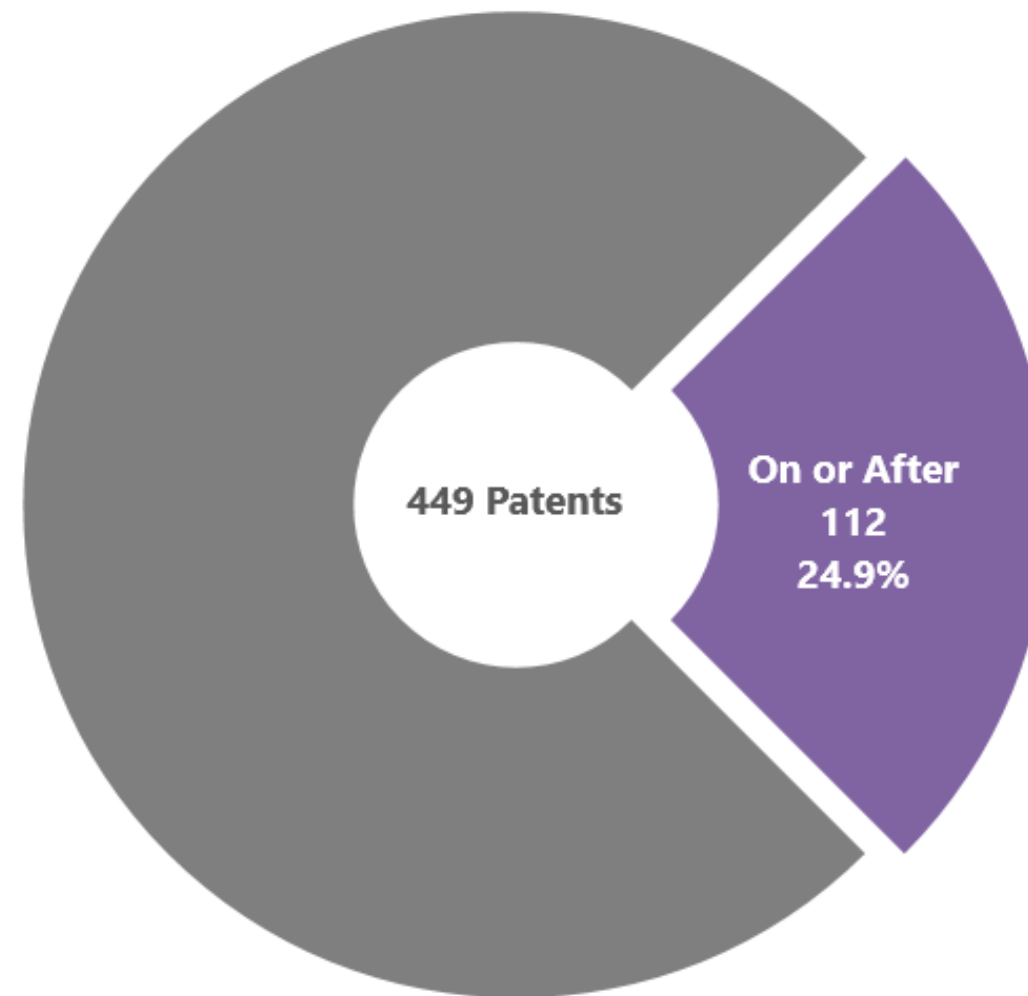
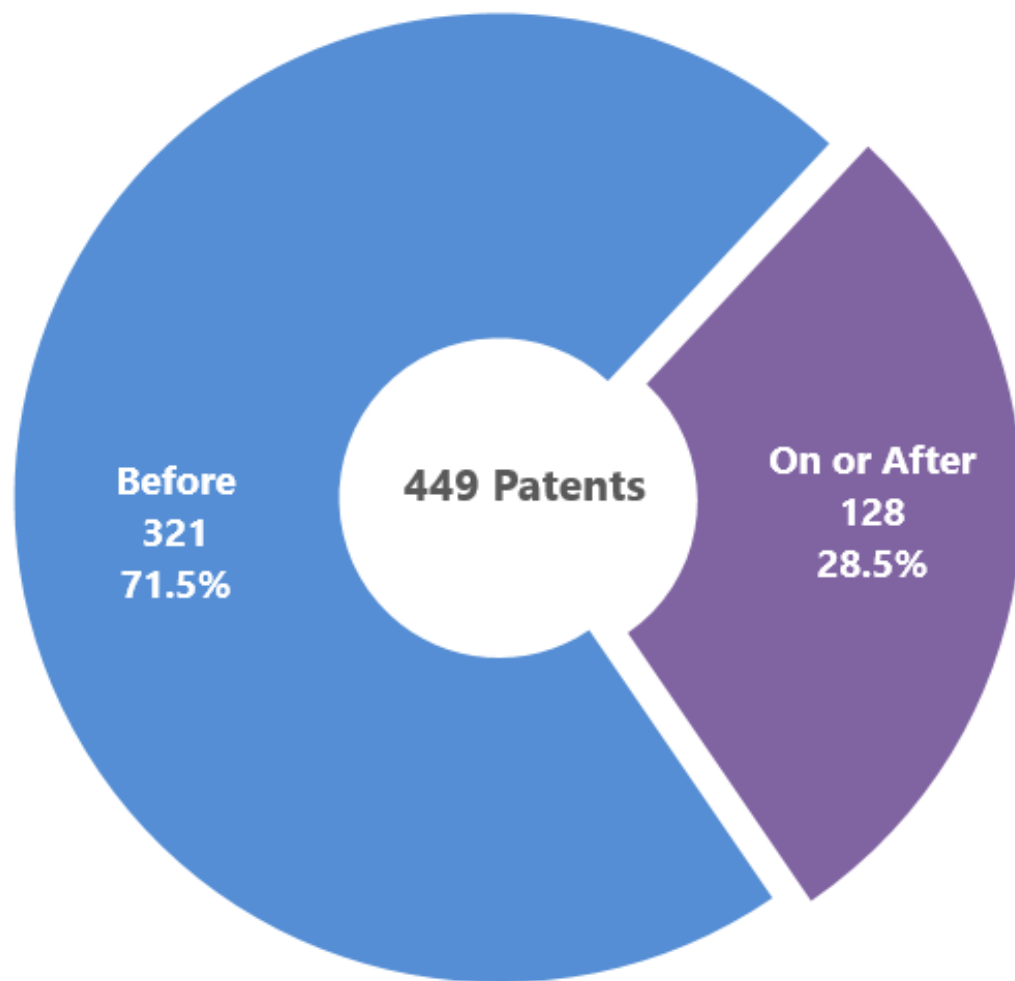


Was the first reexam filed on or after...

(As of mid-year FY18: Sept. 16, 2012 to Apr. 1, 2018)

...the filing date of the first AIA petition?

...the date of the first decision on institution?



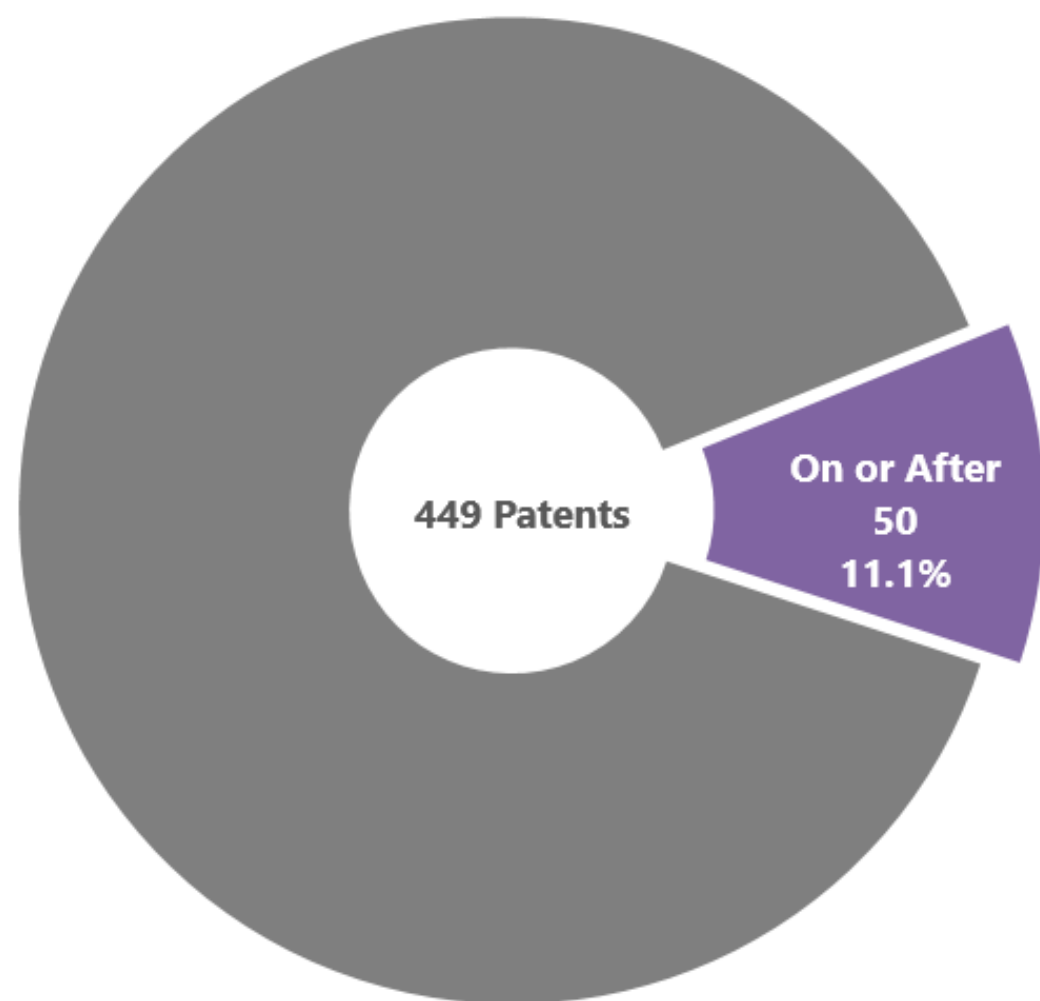
409 of the 449 patents have had at least one decision on institution in any AIA proceeding.

273 of the 449 patents have had at least one petition instituted.

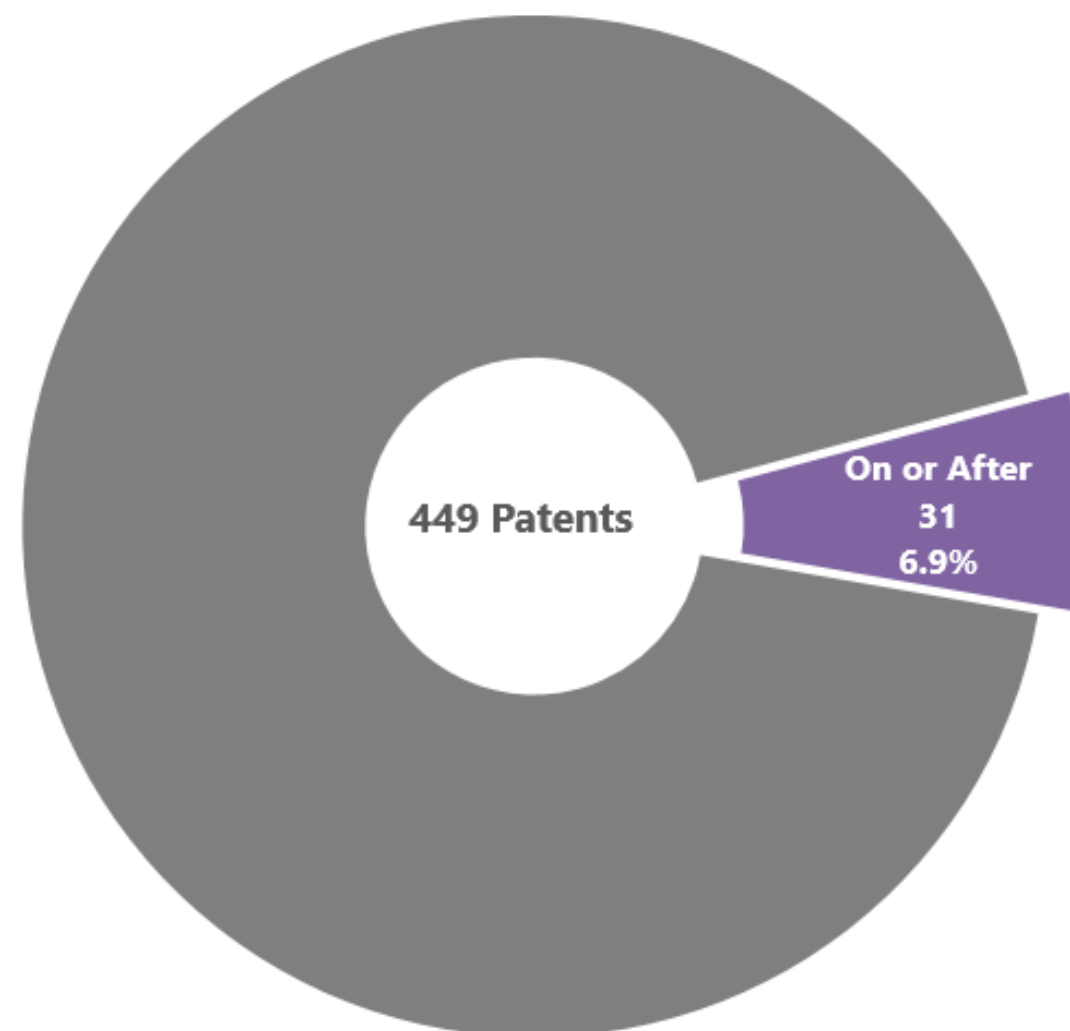
Was the first reexam filed on or after...

(As of mid-year FY18: Sept. 16, 2012 to Apr. 1, 2018)

...the date that the first AIA proceeding terminated?

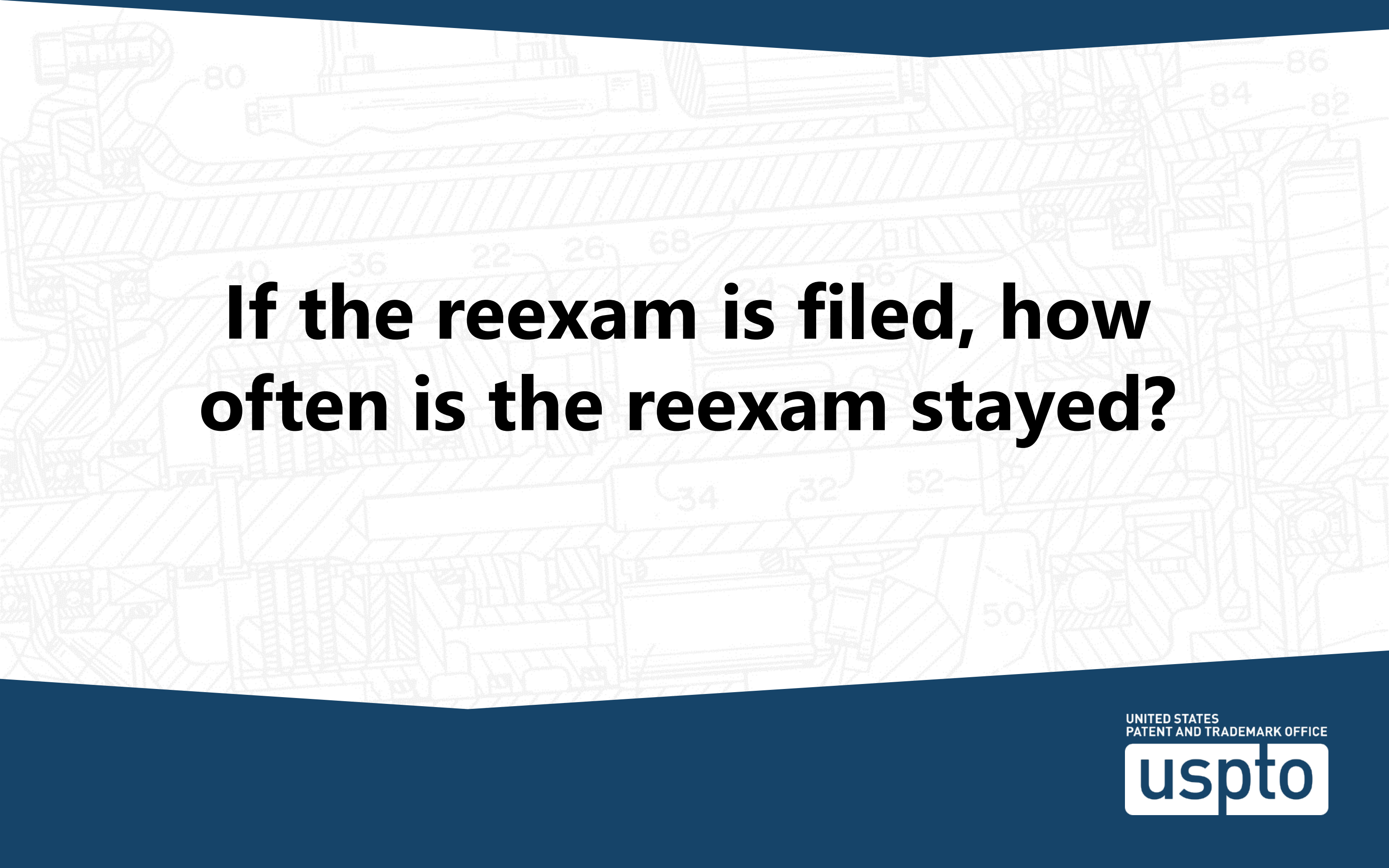


...the date of the first final written decision issued?



179 of the 449 patents have had a final written decision in any AIA proceeding.

Termination means that the proceeding concluded for any reason including request for adverse judgment, settlement, or final written decision.



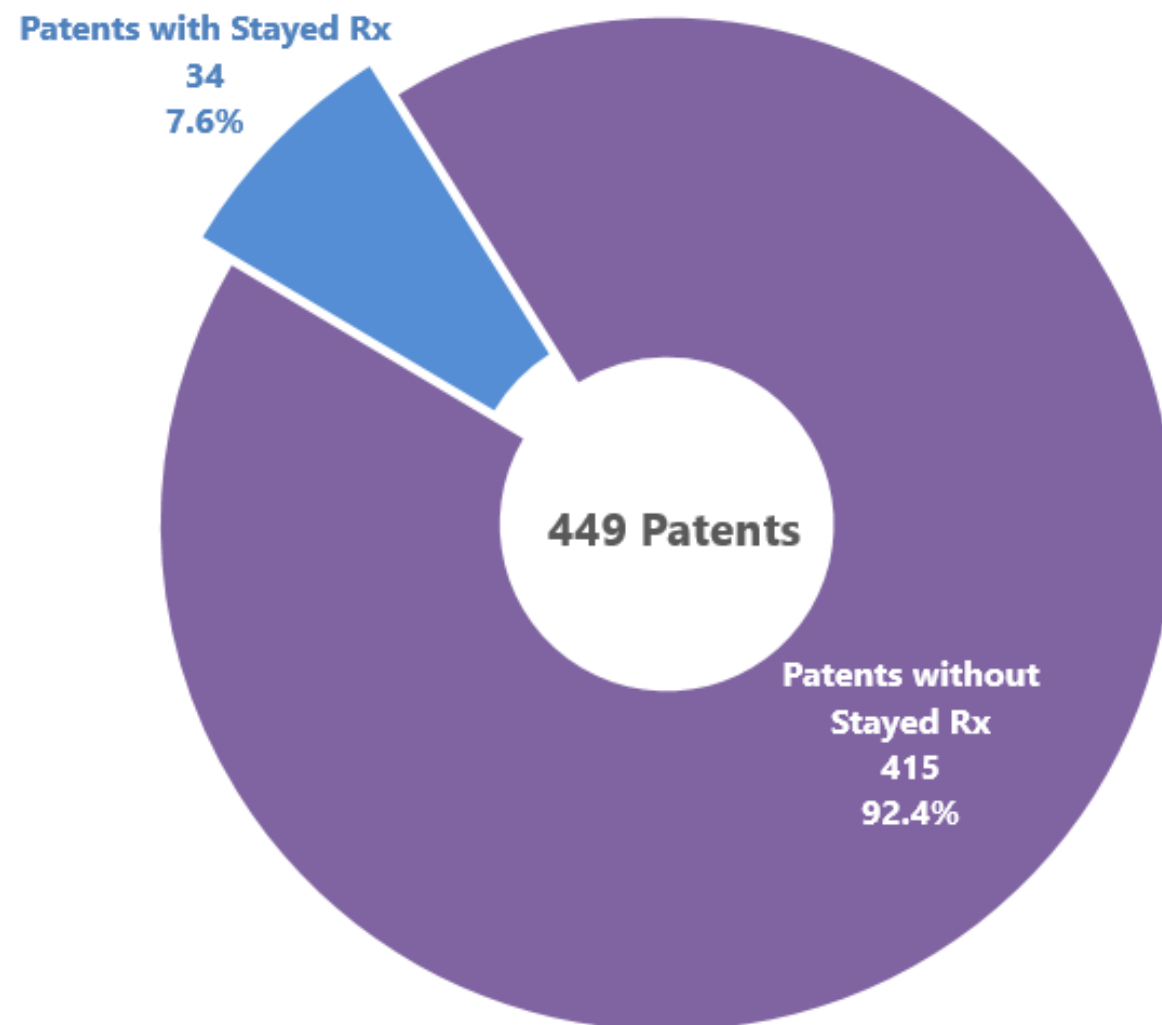
**If the reexam is filed, how
often is the reexam stayed?**

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Percent of patents with reexams stayed

(As of mid-year FY18: Sept. 16, 2012 to Apr. 1, 2018)



Patents with a **reissue** and challenged in AIA proceeding

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**How has the percentage of
patents challenged in AIA
proceeding also having a
corresponding **reissue**
changed over time?**

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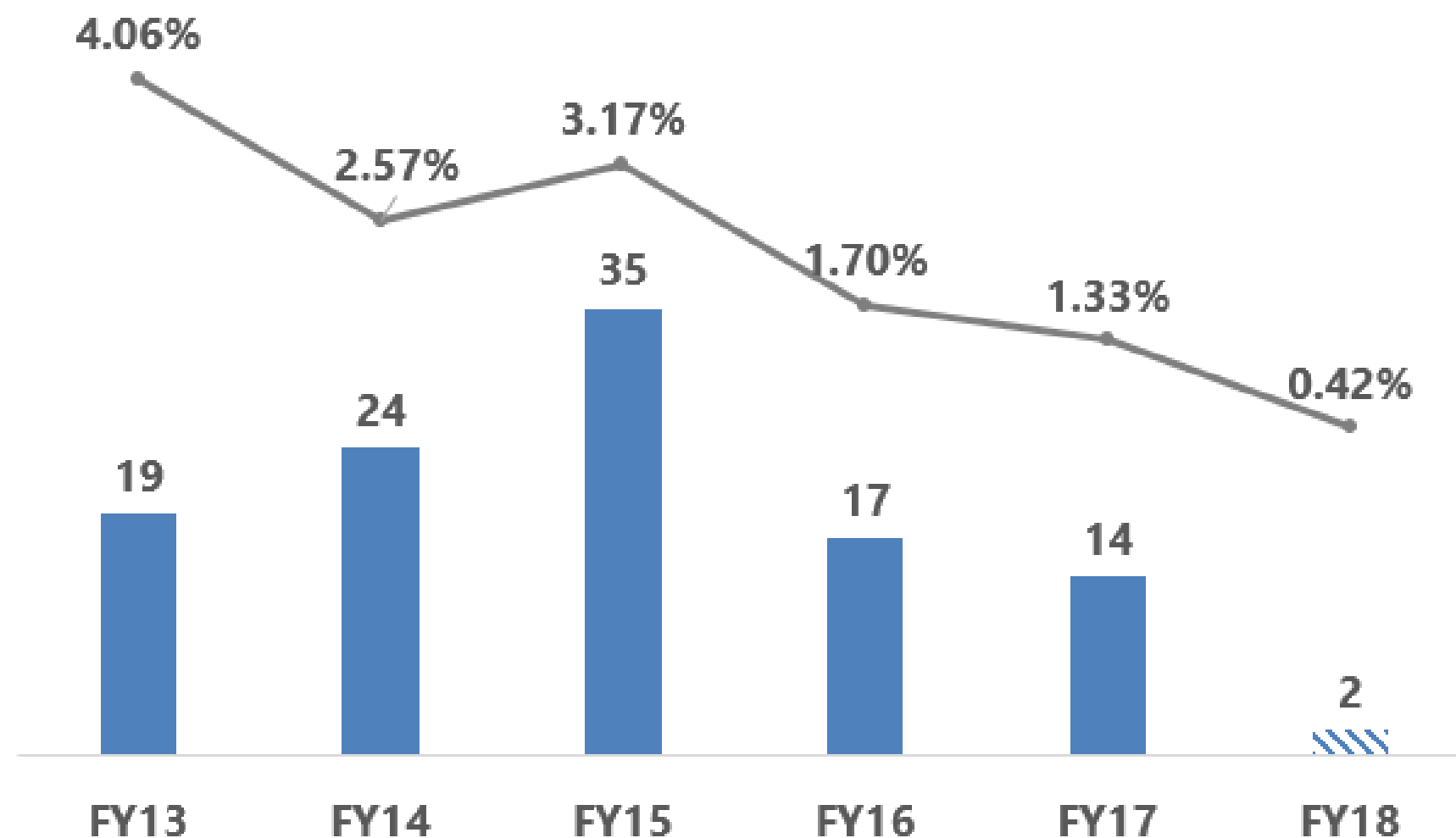


Patents with a reissue and challenged in AIA proceeding

(As of mid-year FY18: Sept. 16, 2012 to Apr. 1, 2018)

Percentage of all patents
Challenged in AIA
proceedings

Patents with a
reissue and an AIA
petition



When is the **reissue filed
in relation to the AIA
proceeding milestones?**

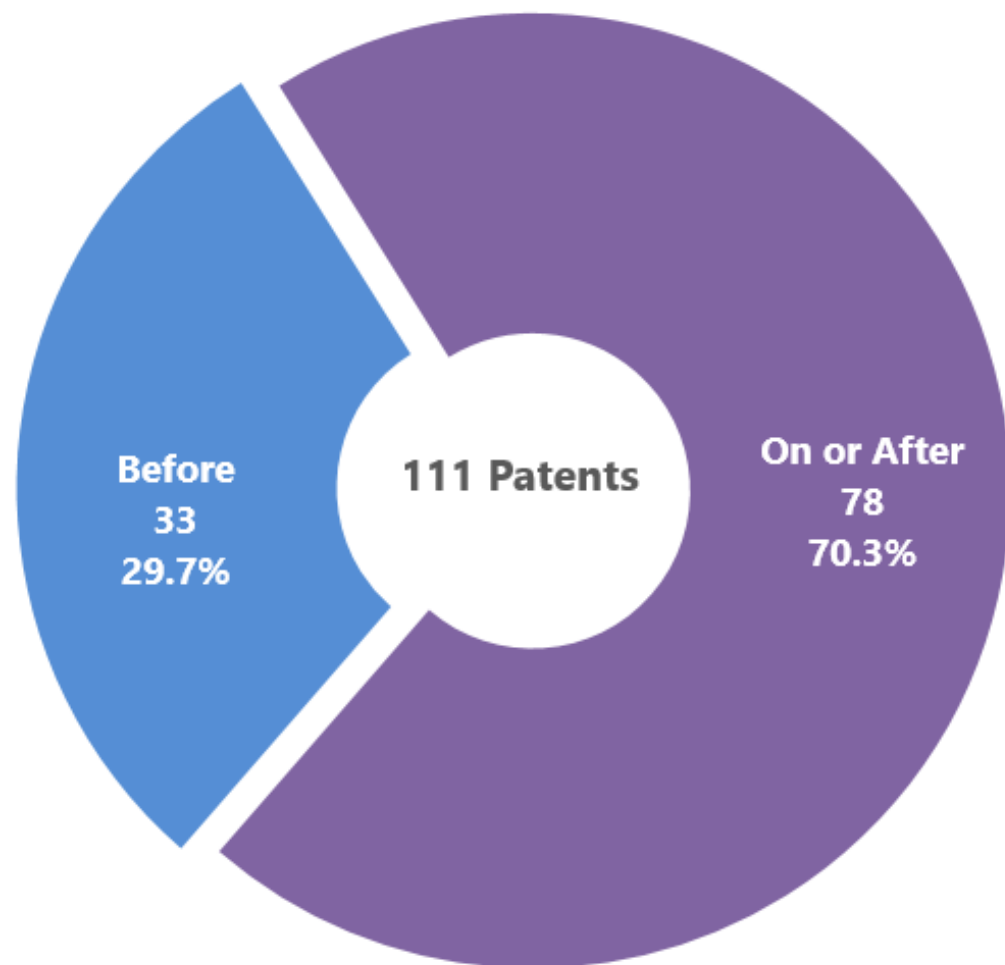
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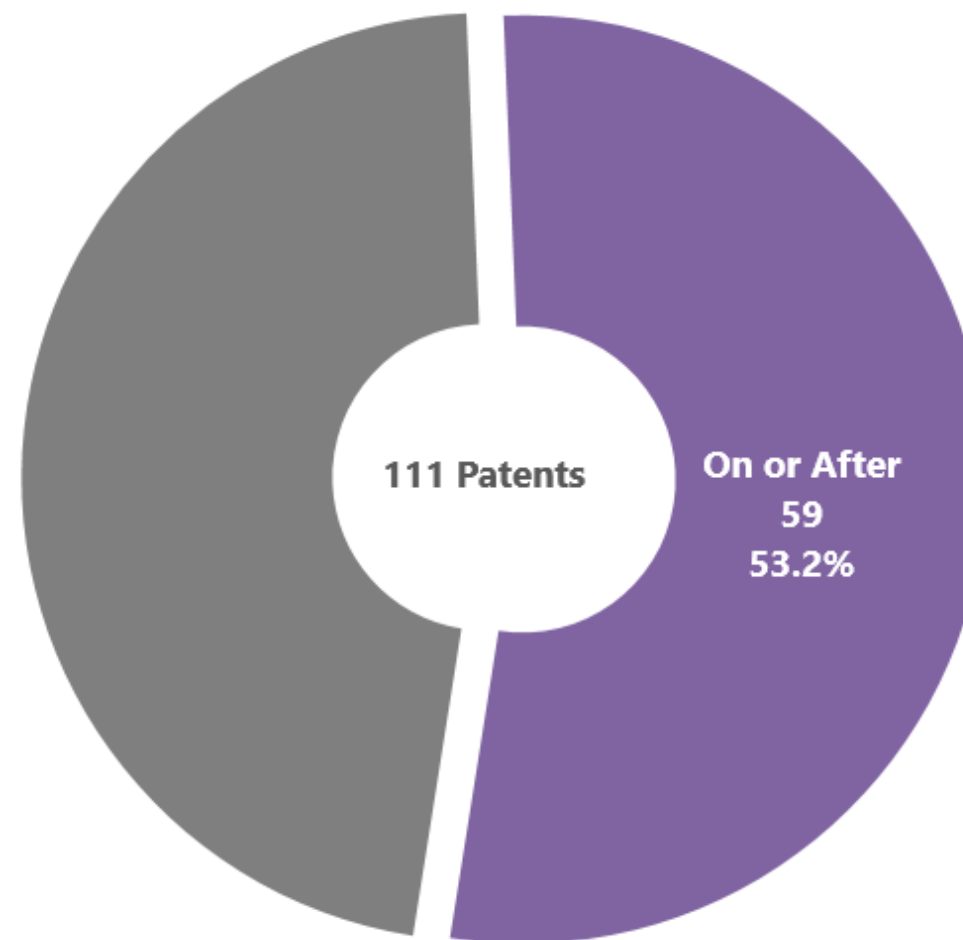
Was the reissue filed on or after...

(As of mid-year FY18: Sept. 16, 2012 to Apr. 1, 2018)

...the filing date of the first AIA petition?



...the date of the first decision on institution?



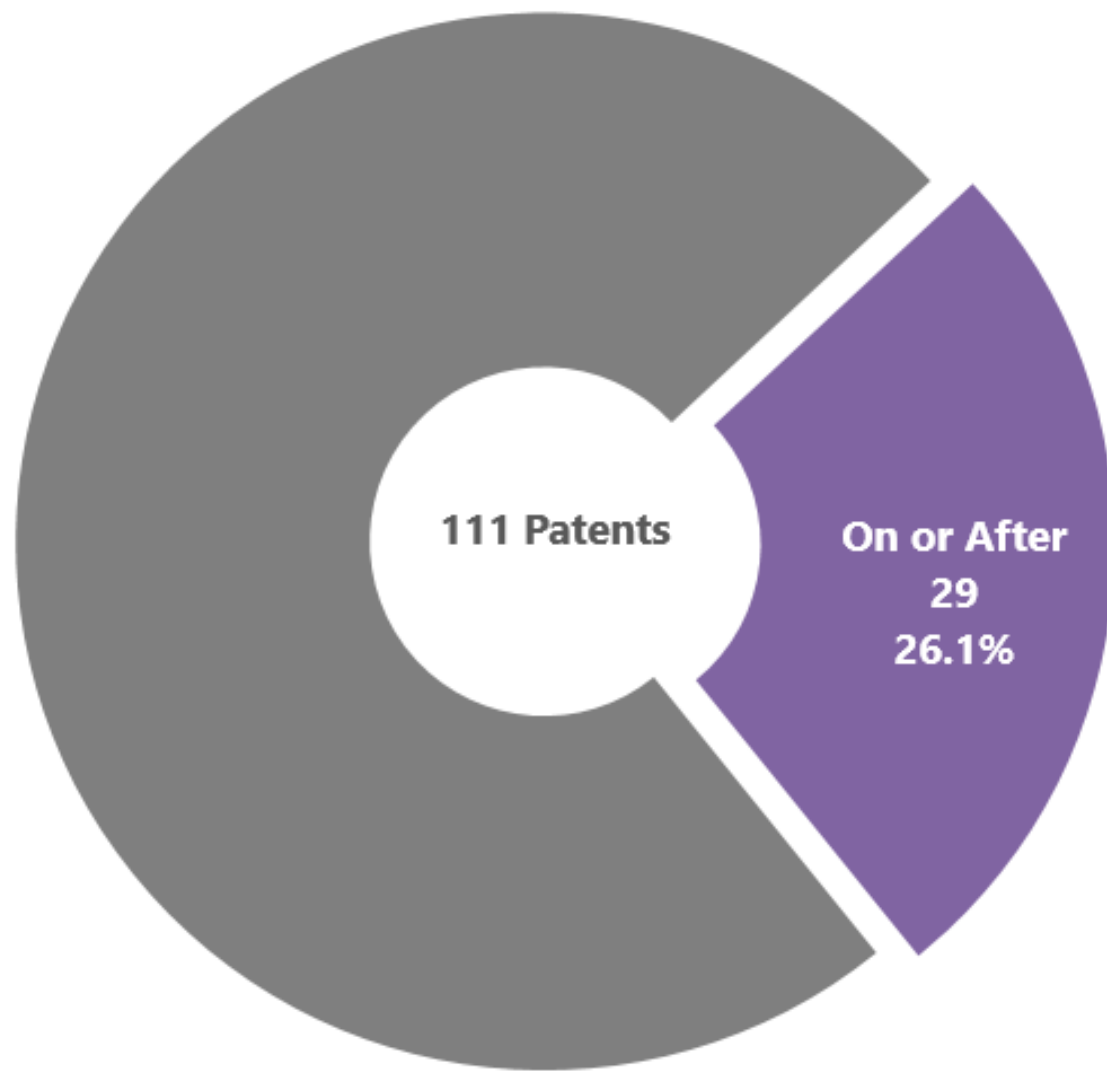
101 of the 111 patents have had a decision on institution in any AIA proceeding.

90 of the 111 patents have had at least one petition instituted.

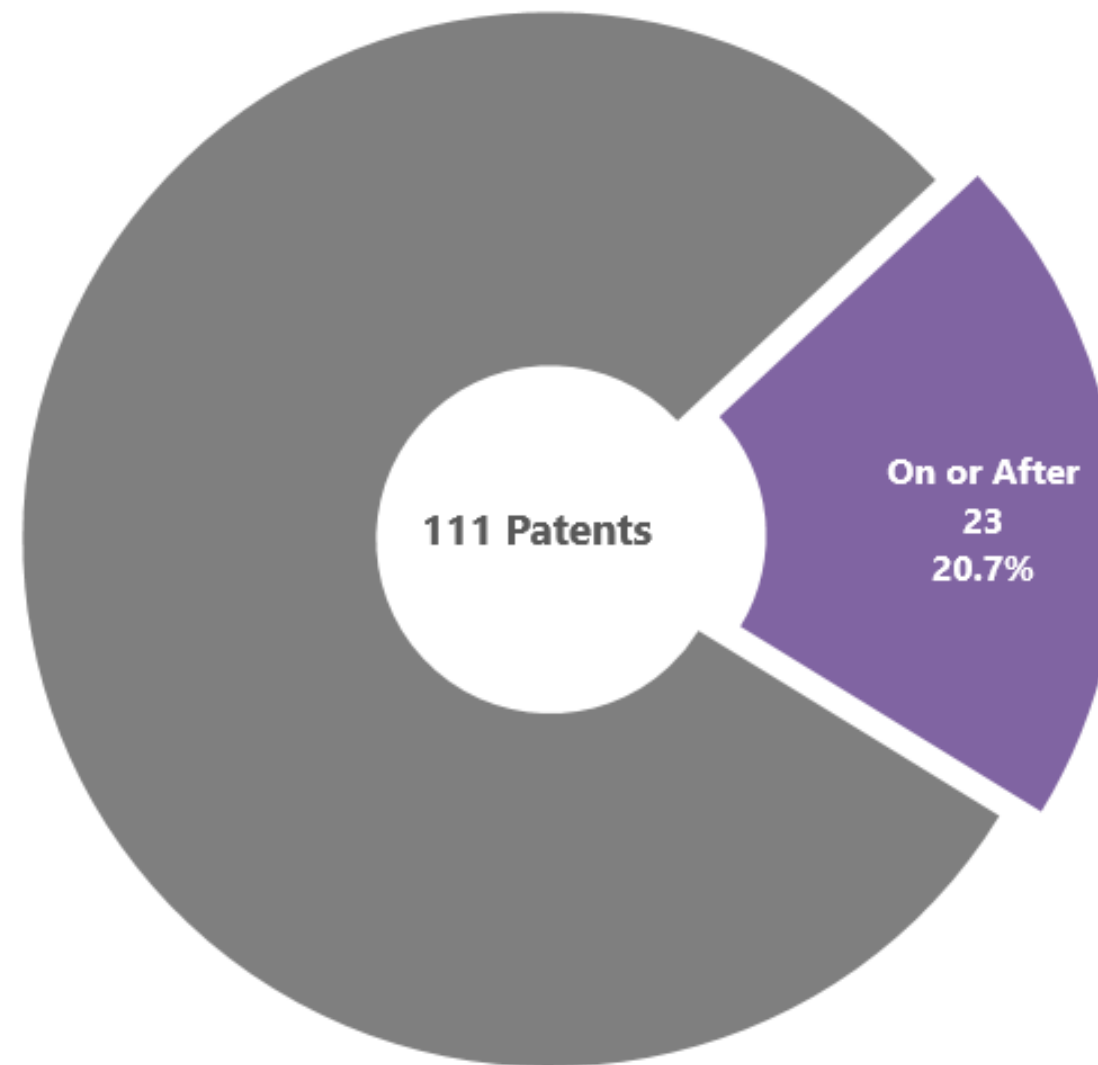
Was the reissue filed on or after...

(As of mid-year FY18: Sept. 16, 2012 to Apr. 1, 2018)

...the date that the first AIA proceeding terminated?

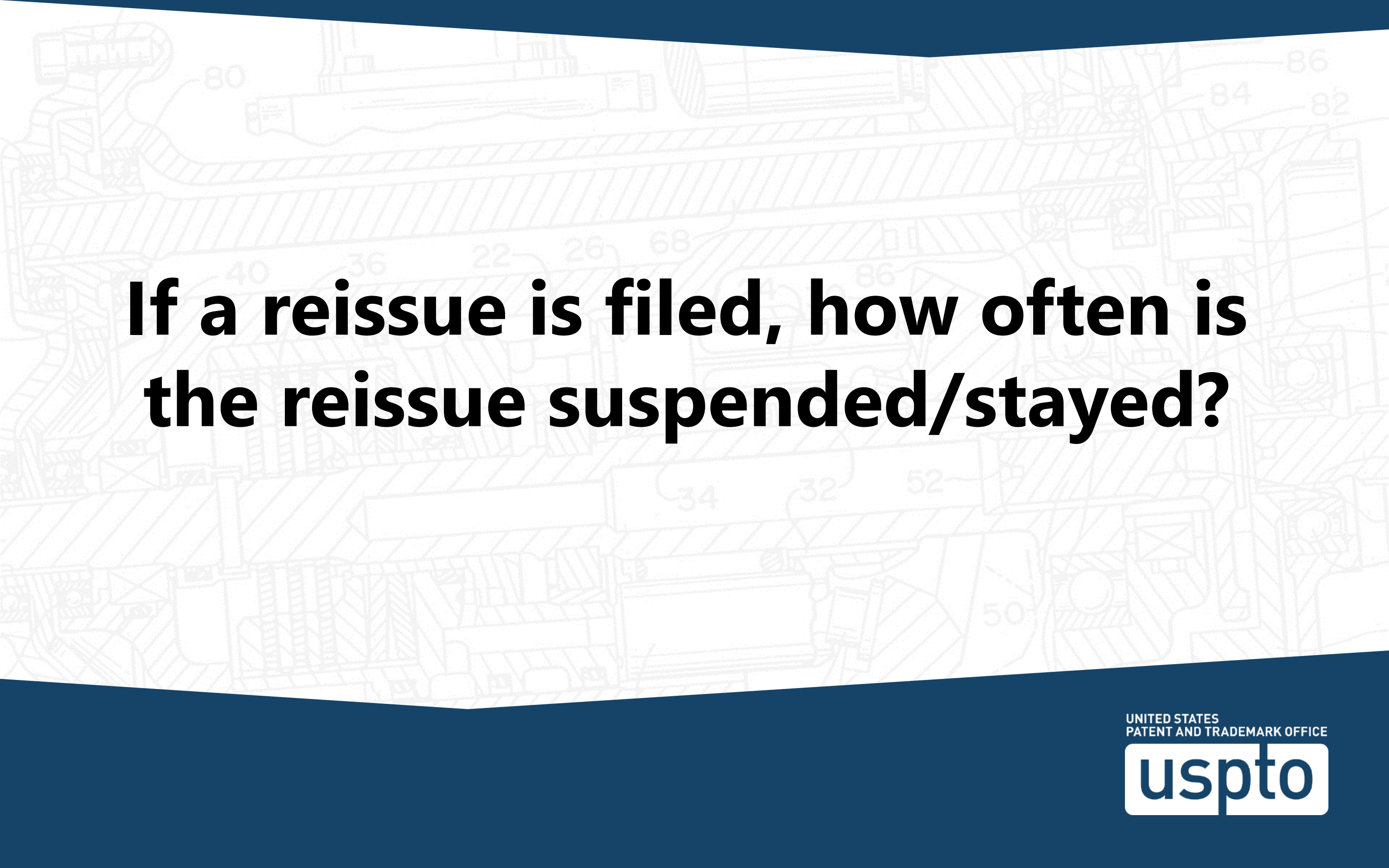


...the date of the first final written decision issued?



64 of the 111 patents have had a final written decision in any AIA proceeding.

Termination means that the proceeding concluded for any reason including request for adverse judgement, settlement, or final written decision.



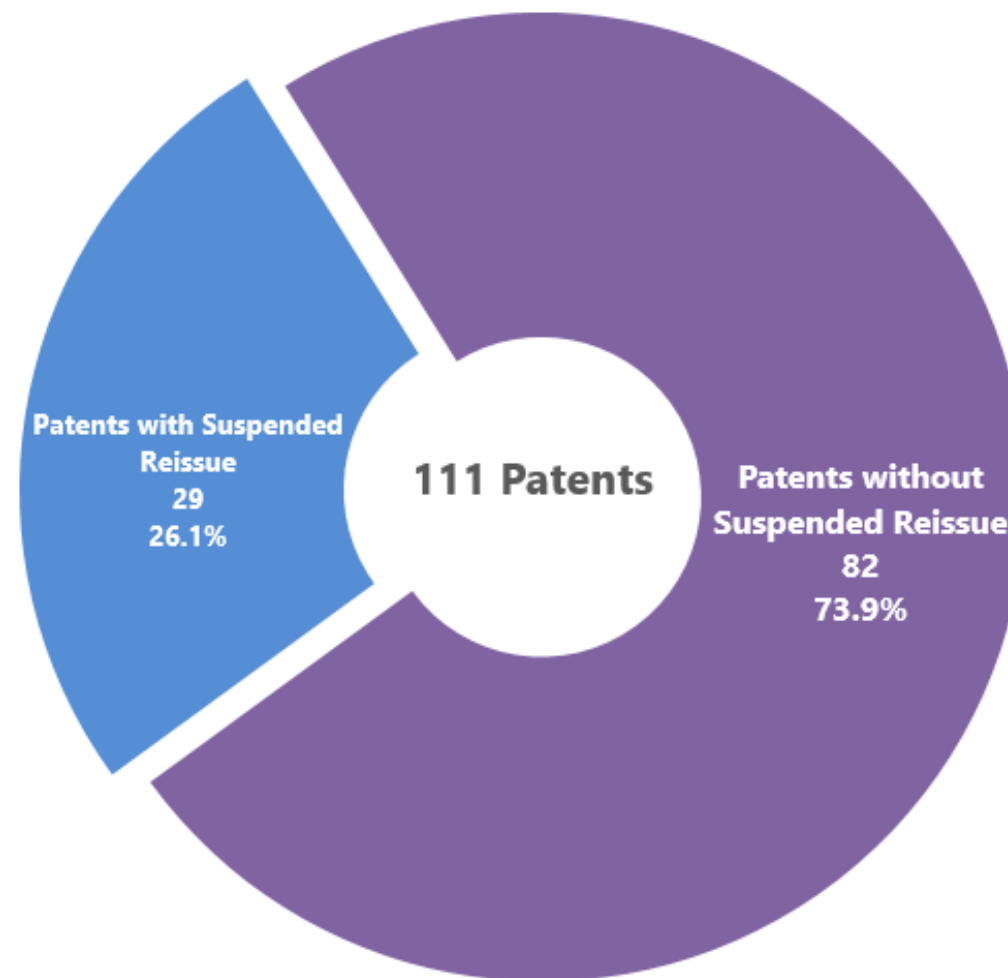
**If a reissue is filed, how often is
the reissue suspended/stayed?**

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Percent of patents with reissues suspended/stayed

(As of mid-year FY18: Sept. 16, 2012 to Apr. 1, 2018)



These suspensions/stays can be instituted by either the examiner or PTAB.

Recap

- 89% of patents challenged in AIA proceedings have not had any associated reexams or reissues.
- Decrease from FY 12 to mid-year FY18 in percentage of challenged patents that have received both:
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Thank You

