

Chapter 2600 Optional Inter Partes Reexamination

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2601 Introduction [Added R-2]

The reexamination statute was amended on November 29, 1999 by Public Law 106-113. Public Law 106-113 expanded reexamination by providing an “*inter partes*” option; it authorized the extension of reexamination proceedings via an optional *inter partes* reexamination procedure in addition to the existing *ex parte* reexamination procedure. See Title IV, subtitle F (§§ 4601 through 4608) of the “Intellectual Property and Communications Omnibus Reform Act of 1999,” S. 1948 (106th Cong. 1st Sess. (1999)). Section 1000(a)(9), Division B, of Public Law 106-113 incorporated and enacted into law the “Intellectual Property and Communications Omnibus Reform Act of 1999” (S. 1948). As a result, new sections 311-318 of title 35 United States Code directed to the optional *inter partes* reexamination proceeding were added by Public Law 106-113.

The reexamination statute was again amended on November 2, 2002, by Public Law 107-273, 116 Stat. 1758, 1899-1906 (2002). Public Law 107-273 expanded the scope of what qualifies for a substantial new question of patentability upon which a reexamination may be based (see MPEP § 2642, POLICY IN SPECIFIC SITUATIONS, part A), expanded the third party requester's appeal rights to include appeal to the Court of Appeals for the Federal Circuit (see MPEP § 2679), and made technical corrections to the statute. See the 21st Century Department of Justice Appropriations Authorization Act, TITLE III - INTELLECTUAL PROPERTY, Subtitle A - Patent and Trademark Office, Section 13105, of the “Patent and Trademark Office Authorization Act of 2002” - Enacted as part of Public Law 107-273 on November 2, 2002.

The optional *inter partes* alternative provides third party requesters with a greater opportunity to participate in reexamination proceedings, while maintaining most of the features which make reexamination a desirable alternative to litigation in the Federal Courts (e.g., low cost relative to Court proceedings, expedited procedure).

The optional *inter partes* alternative also provides third party requesters with appeal rights to appeal to the Board of Patent Appeals and Interferences (Board) and to participate in the patent owner's appeal to the Board.

For any *inter partes* reexamination proceeding commenced on or after November 2, 2002, the third party requester also has the appeal rights to appeal to the Court of Appeals for the Federal Circuit and to participate in the patent owner's appeal to the Federal Circuit. For an *inter partes* reexamination proceeding commenced prior to November 2, 2002, however, no appeal rights are provided for the third party requester to appeal to the Court of Appeals for the Federal Circuit, nor to participate in the patent owner's appeal to the Court. See MPEP § 2683.

Exercising the *inter partes* option is conditioned (by Public Law 106-113) on the third party requester accepting a statutory estoppel against subsequent review, either by the Office or by a Federal Court, of the issues that were or could have been raised in the reexamination proceeding. These limits, which will be discussed in this Chapter are aimed at preventing *inter partes* reexamination proceedings from being used to harass patent owners.

The final rules to implement the statutory *inter partes* reexamination option was published in the Federal Register on December 7, 2000 (65 Fed. Reg. 76756) and in the *Official Gazette* on January 2, 2001 (1243 O.G. 12). The final rule notice stated that the changes to the rules of practice to implement the optional *inter partes* reexamination provisions of the American Inventors Protection Act of 1999 would become effective on February 5, 2001. The notice includes not only the text of the final rules, but also a

discussion of the rules and analysis of the comments received, which serve as guidance in the implementation of the rules.

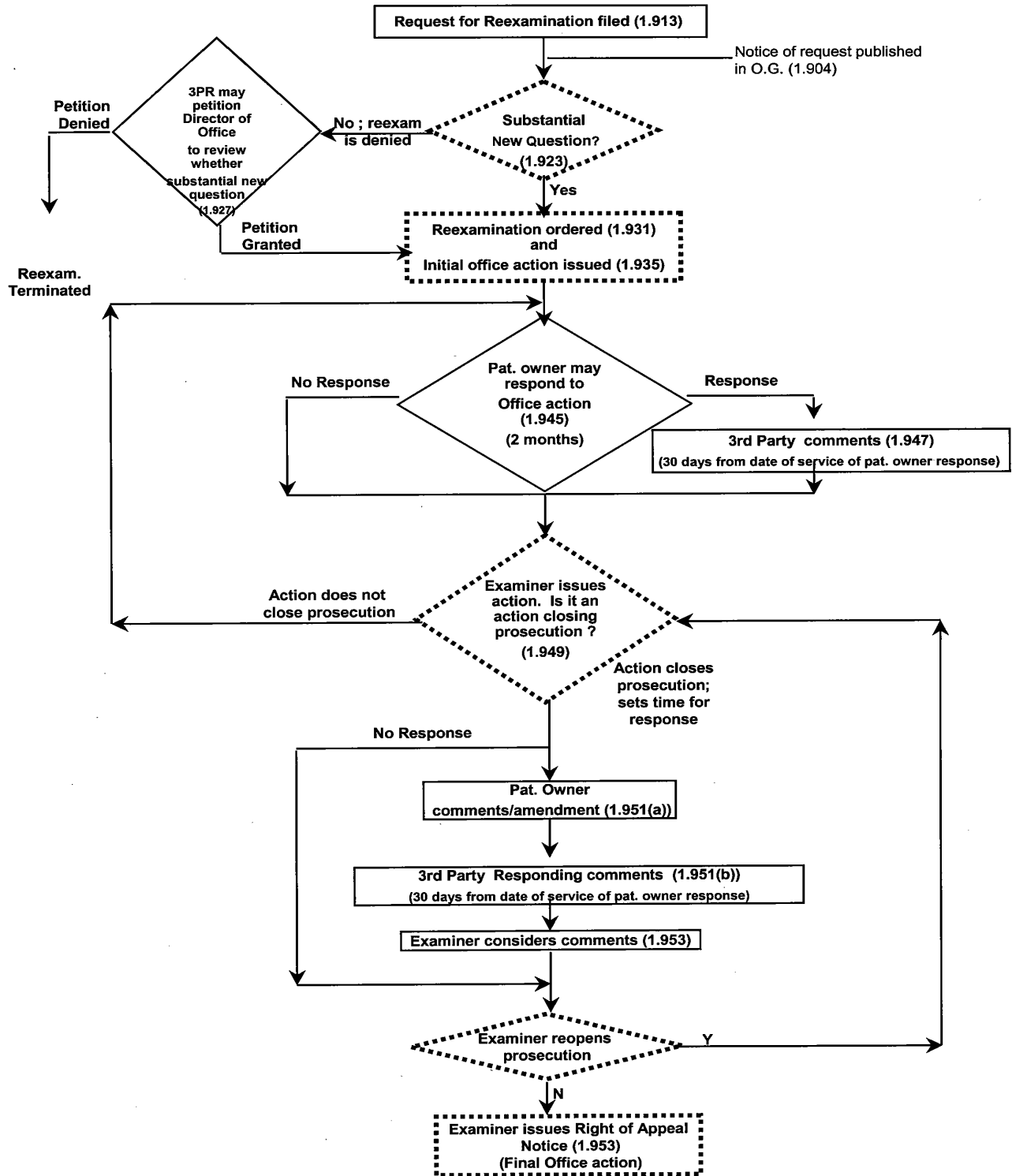
Both the statutory *inter partes* reexamination option, 35 U.S.C., Chapter 31, and the new *inter partes* reexamination rules, 37 CFR, Sub-part H, apply to all reexamination proceedings for patents issuing from applications filed on or after November 29, 1999. For a patent issued from an application filed prior to November 29, 1999, the statutory *inter partes* reexamination option is not available, only the *ex parte* reexamination is available (see 37 CFR, Sub-part D, 37 CFR 1.510 *et seq.*).

See MPEP Chapter 2200 (section 2209 *et seq.*) for guidance on the procedures for *ex parte* reexamination proceedings.

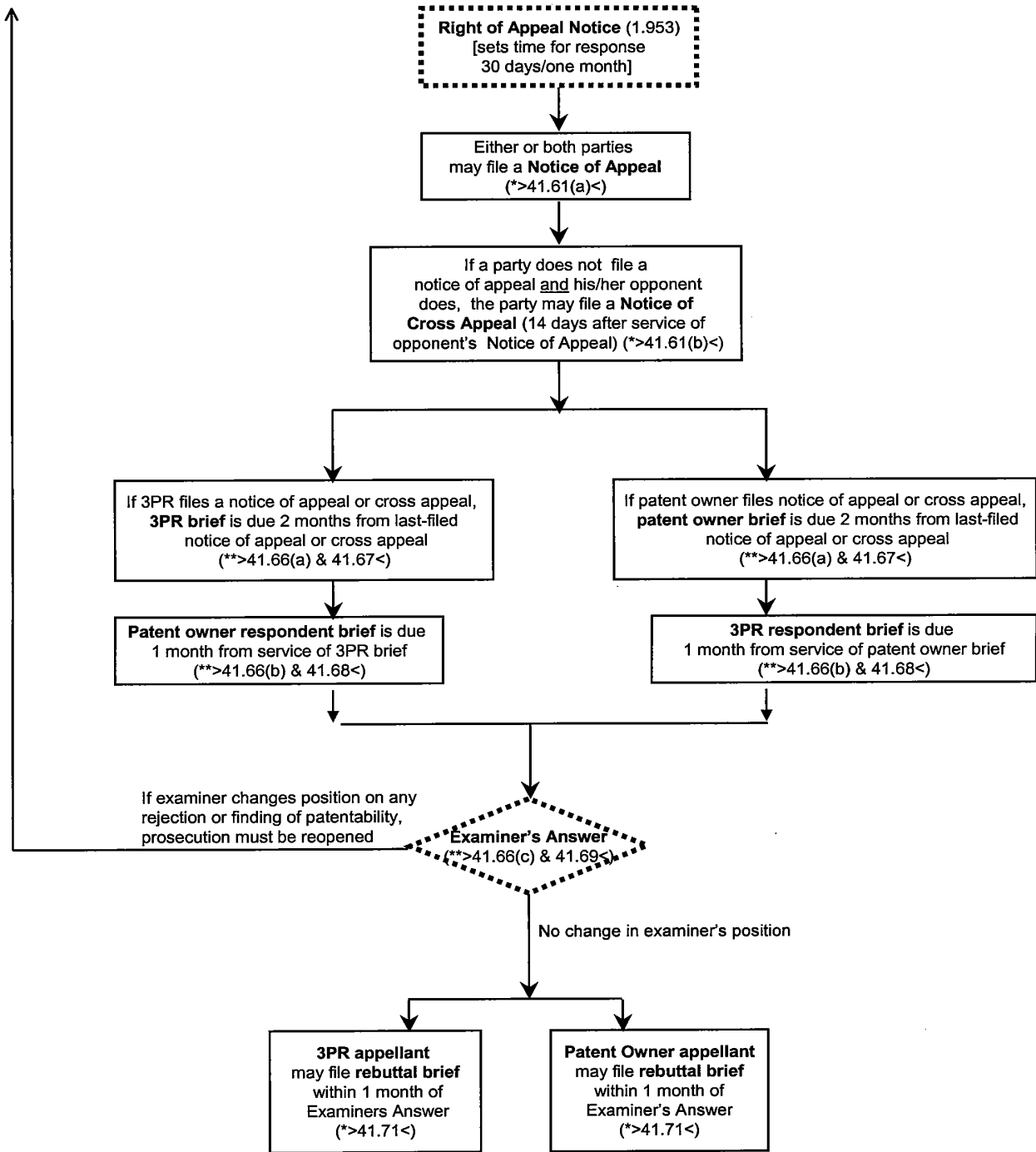
2601.01 Flowcharts [R-3]

The flowcharts show the general flow for the various stages of *inter partes* reexamination proceedings. The first flowchart shows the procedures before appeal. The second flowchart shows the appeal procedure with a single 3rd party requester. The third flowchart shows the procedures following a Board decision for reexamination proceedings commenced prior to November 2, 2002. The fourth flowchart shows the procedures following a Board decision for reexamination proceedings commenced on or after November 2, 2002.

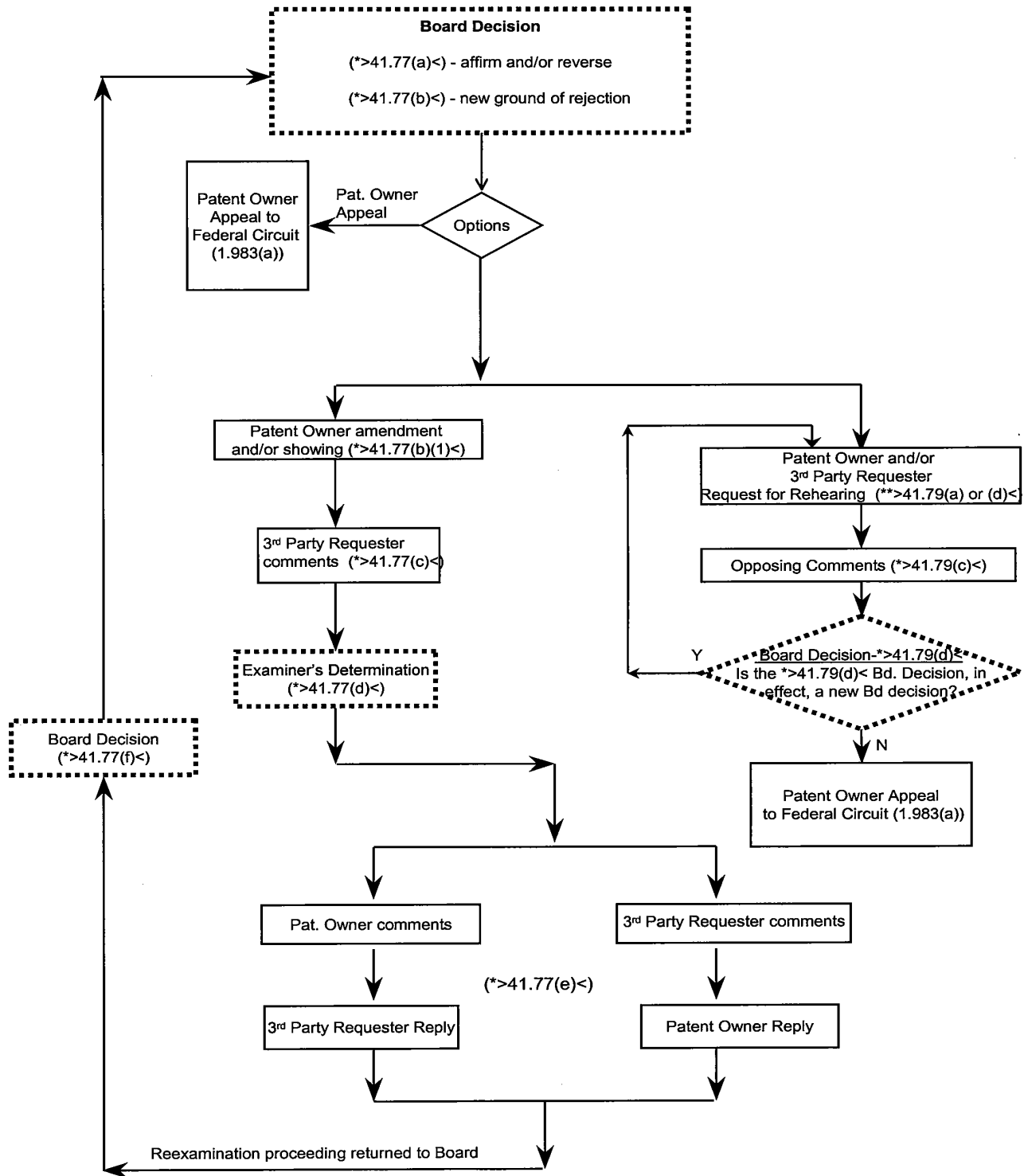
**Inter Partes Reexamination (applicable rule section)
PROCEDURE BEFORE APPEAL**



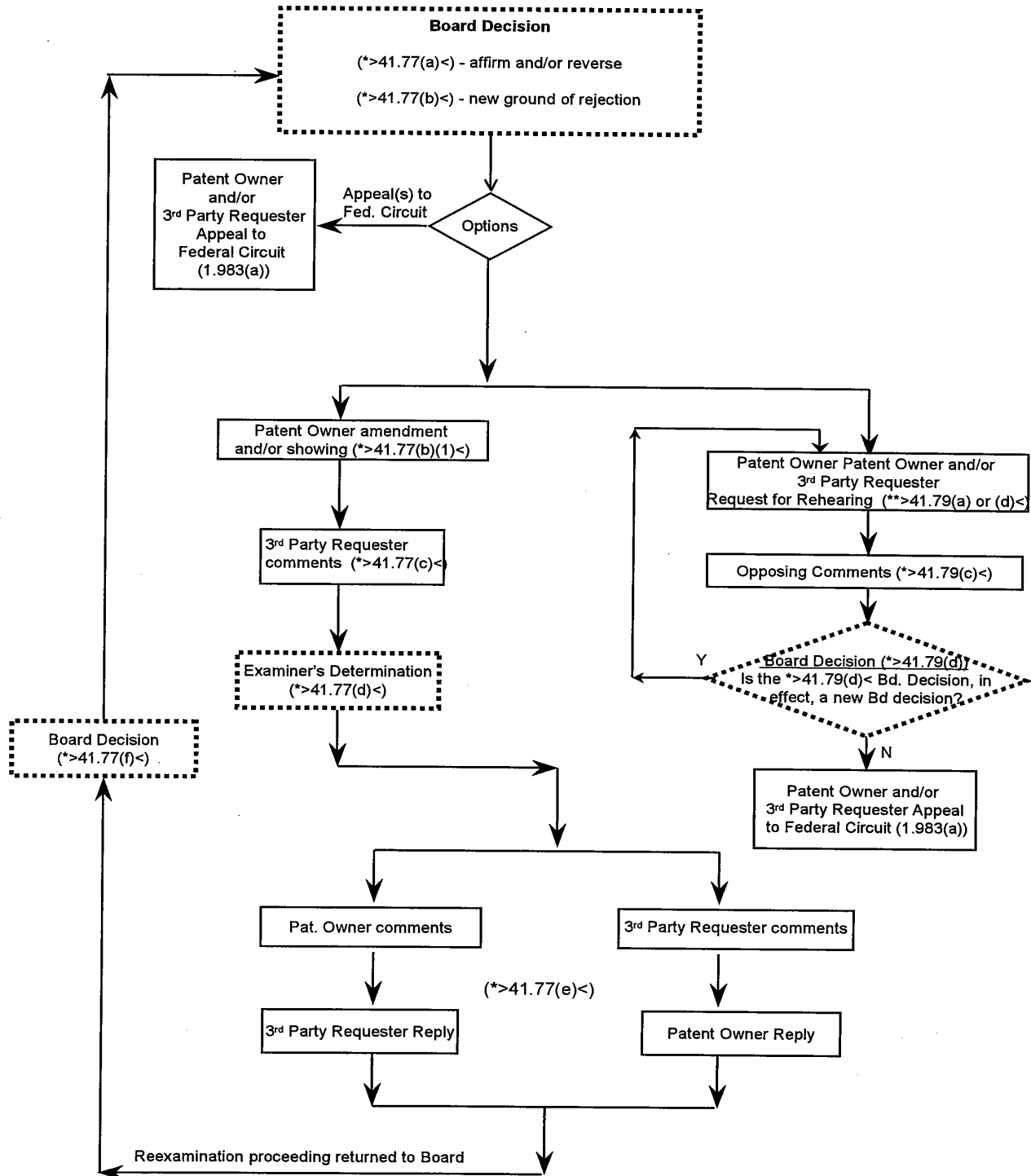
Inter Partes Reexamination (applicable rule section)
APPEAL PROCEDURE
 Single Third Party Requester



**Inter Partes Reexamination (applicable rule section)
 Procedures Following Board Decision for Reexaminations
 Commenced Prior to November 2, 2002**



Inter Partes Reexamination (applicable rule section)
**Procedure Following Board Decision for Reexaminations
 Commenced On or After November 2, 2002**



2602 Citation of Prior Art [R-3]

35 U.S.C. 301. Citation of prior art.

Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential.

37 CFR 1.501. Citation of prior art in patent files.

(a) At any time during the period of enforceability of a patent, any person may cite, to the Office in writing, prior art consisting of patents or printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of the patent. If the citation is made by the patent owner, the explanation of pertinency and applicability may include an explanation of how the claims differ from the prior art. Such citations shall be entered in the patent file except as set forth in §§ 1.502 and 1.902.

(b) If the person making the citation wishes his or her identity to be excluded from the patent file and kept confidential, the citation papers must be submitted without any identification of the person making the submission.

(c) Citation of patents or printed publications by the public in patent files should either: (1) Reflect that a copy of the same has been mailed to the patent owner at the address as provided for in § 1.33(c); or in the event service is not possible (2) Be filed with the Office in duplicate.

37 CFR 1.902. Processing of prior art citations during an *inter partes* reexamination proceeding.

Citations by the patent owner in accordance with § 1.933 and by an *inter partes* reexamination third party requester under § 1.915 or § 1.948 will be entered in the *inter partes* reexamination file. The entry in the patent file of other citations submitted after the date of an order for reexamination pursuant to § 1.931 by persons other than the patent owner, or the third party requester under either § 1.915 or § 1.948, will be delayed until the *inter partes* reexamination proceeding has been terminated. See § 1.502 for processing of prior art citations in patent and reexamination files during an *ex parte* reexamination proceeding filed under § 1.510.

Public Law 106-113 did not affect the manner of the public's citation of prior art under 37 CFR 1.501 in a patent. Likewise, it did not affect the Office's handling of a 37 CFR 1.501 prior art citation in a patent where no reexamination proceeding is pending for that patent when the citation is filed.

Where an *inter partes* reexamination proceeding is pending when a prior art citation is filed, the following applies:

If the prior art citation satisfies 37 CFR 1.501 and is submitted prior to an order to reexamine, the cited documents (citations) will be considered in an *inter partes* reexamination proceeding as a prior art citation would be considered in an *ex parte* reexamination proceeding. See MPEP § 2206.

If the prior art citation satisfies 37 CFR 1.501 and is submitted **after an order to reexamine**, the citation will be considered as follows:

(A) A patent owner citation will normally be considered if it is submitted in time to do so before the reexamination certificate issues.

(B) A third party requester citation will be considered if it is submitted as part of a third party requester comments submission under 37 CFR 1.947 or 1.951(b) (made as required by 37 CFR 1.948), or in a properly filed request for reexamination under 37 CFR 1.915 or 1.510.

(C) Any other prior art citation satisfying 37 CFR 1.501 which is submitted after an order to reexamine will be retained (stored) in the Technology Center (in which the reexamination proceeding is being examined) until the reexamination is *>concluded<*, after which it will be placed in the file of the patent. 37 CFR 1.902.

See MPEP §§ 2202 through 2206 and 2208 for the manner of making such citations and Office handling of same.

2609 *Inter Partes* Reexamination [R-3]

The *inter partes* reexamination statute and rules permit any third party requester to request *inter partes* reexamination of a patent which issued from an original application was filed on or after November 29, 1999, where the request contains certain elements (see 37 CFR 1.915(b)) and is accompanied by the fee required under 37 CFR 1.20(c)(2). The Office initially determines if “a substantial new question of patentability” (35 U.S.C. 312(a)) is presented. If such a new question has been presented, reexamination will be ordered. The reexamination proceedings which follow the order for reexamination are somewhat similar to regular examination procedures in patent applications; however, there are notable differences. For example, there are certain limitations as to the kind of rejections which may be made, a third party requester may participate throughout the proceeding, there is an

“action closing prosecution” and a “right of appeal notice” rather than a final rejection, special reexamination forms are to be used, and time periods are set to provide “special dispatch.” When the prosecution of an *inter partes* reexamination proceeding is terminated, an *inter partes* reexamination certificate is issued to indicate the status of all claims following the reexamination and concludes the reexamination proceeding.

The basic characteristics of *inter partes* reexamination are as follows:

(A) Any third party requester can request *inter partes* reexamination at any time during the period of enforceability of the patent (for a patent issued from an original application filed on or after November 29, 1999);

(B) Prior art considered during reexamination is limited to prior patents or printed publications applied under the appropriate parts of 35 U.S.C. 102 and 103;

(C) A substantial new question of patentability must be present for reexamination to be ordered;

(D) If ordered, the actual reexamination proceeding is essentially *inter partes* in nature;

(E) Decision on the request must be made not later than *three months* from its filing date, and the remainder of proceedings must proceed with “special dispatch” within the Office;

(F) If ordered, a reexamination proceeding will normally be conducted to its conclusion and the issuance of an *inter partes* reexamination certificate;

(G) The scope of the patent claims cannot be enlarged by amendment;

(H) Reexamination and patent files are open to the public, but see paragraph (I) below;

(I) The reexamination file is scanned to provide an electronic copy of the file. All public access to and copying of reexamination proceedings may be had from the electronic copy. The paper file is not available to the public.

2610 Request for *Inter Partes* Reexamination [Added R-2]

35 U.S.C. 311. Request for *inter partes* reexamination

(a) IN GENERAL.— Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

(b) REQUIREMENTS.— The request shall—

(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an *inter partes* reexamination fee established by the Director under section 41; and

(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

(c) COPY.— The Director promptly shall send a copy of the request to the owner of record of the patent.

37 CFR 1.913. Persons eligible to file request for *inter partes* reexamination.

Except as provided for in § 1.907, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a request for *inter partes* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501.

37 CFR 1.915. Content of request for *inter partes* reexamination.

(a) The request must be accompanied by the fee for requesting *inter partes* reexamination set forth in § 1.20(c)(2).

(b) A request for *inter partes* reexamination must include the following parts:

(1) An identification of the patent by patent number and every claim for which reexamination is requested.

(2) A citation of the patents and printed publications which are presented to provide a substantial new question of patentability.

(3) A statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.

(4) A copy of every patent or printed publication relied upon or referred to in paragraphs (b)(1) through (3) of this section, accompanied by an English language translation of all the necessary and pertinent parts of any non-English language document.

(5) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.

(6) A certification by the third party requester that a copy of the request has been served in its entirety on the patent owner at the address provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy of the request must be supplied to the Office.

(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the *inter partes* reexamination.

(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

