

Outline of:

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Perspective of large corporation that both enforces, and defends against, a significant volume of patents

Need not be limited to inter partes reexamination only

- Separate inter partes reexamination and post grant opposition procedures can co-exist
- Multiple procedures exist for patentees to address patent defects
- Use of certificate of correction and reissue procedures tailored to different sets of defects
- Inter partes reexamination and post grant opposition proceedings can be similarly tailored
- Allows more options to be tested to find what works
- Procedures can later be merged once we know what works

Time to initiate challenge to patent validity

- No time limit for inter partes reexamination
- Many proposals for post grant opposition reference European Patent Office strict time limit of 9 months after patent issuance
- Strict time limit is harsh - why create a new procedure and severely restrict its use - reminds one of inter partes reexamination
- Unjust to remove avenue for challenge merely because of passage of a limited period of time
- Often patents are not commercialized until many years after issuance - strict time limit essentially forces (impossible) prediction of business for next 20 years
- If compromise must be sought with those seeking quiet title, must at least allow for later challenges under reasonable conditions that limit undue harassment of patentee (based on apprehension or actual suit, agreement of the parties, progressively increasing fees, limits on number of challenges per party, etc)

Anonymity

- Real party in interest challenging patent must be identified in inter partes reexamination
- Should be changed for both inter partes reexamination post grant opposition

- Under some circumstances, it may be difficult, even impossible for real party interest to remain anonymous
- If patent has not been asserted against challenger, revealing oneself as challenger is tantamount to painting a bulls-eye on one's corporate logo by informing the patentee of concerns of infringement
- If real party in interest must be identified to verify certain facts relating to eligibility of challenge, USPTO can act as screen - the real party in interest can be identified to the USPTO but not to the patentee

Grounds for review

- Inter partes reexamination limited to challenges in view of documented prior art
- Other grounds for invalidity are also suitable for challenge, such as 112 issues (not best mode)
- Post grant opposition could be a procedure separate from inter partes reexamination to allow for such additional grounds for challenge

Estoppel

- Inter partes reexamination estoppel in view of issues raised or that could have been raised
- Definition of "could have" unclear - need better predictability
- Fear of bringing inter partes reexamination because of possibility that best prior art missed
- Need to eliminate could have raised estoppel in all post patent issuance challenges