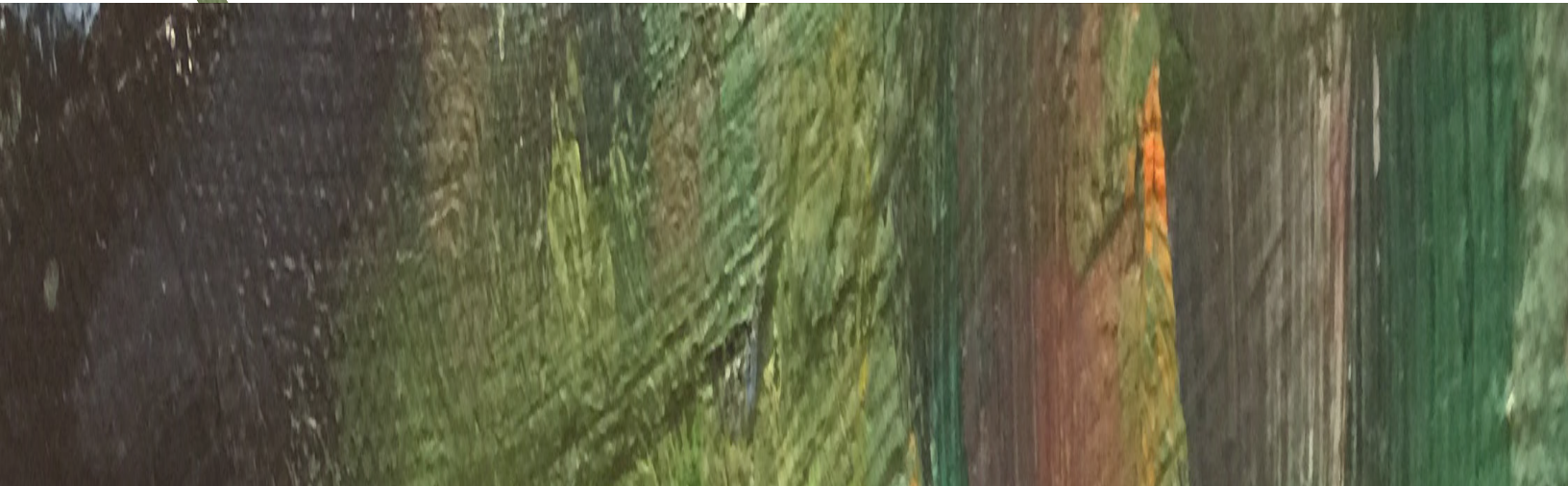


Q&A

POST-GRANT PROCEEDINGS



Q&A

QUESTIONS AND ANSWERS

POST-GRANT PROCEEDINGS

Overview

Inter Partes Review

Post-Grant Review

Covered Business Method Review

Ex Parte Reexamination

Supplemental Examination

Reissue

Certificate of Correction

POST-GRANT PROCEEDINGS

OVERVIEW

What are post-grant proceedings?

Post-grant proceedings provide a mechanism for a patent owner to increase the value of a patent or for other parties to shrink the rights afforded by a patent. There are multiple types of post-grant proceedings, which have different characteristics and purposes, but all involve the U.S. Patent and Trademark Office (“Patent Office”) taking action with the potential to affect the validity or scope of an issued patent. We have used post-grant proceedings in high-stakes disputes where literally billions of dollars hang on the validity of a patent or in more mundane scenarios to correct a minor error or resolve an ambiguity in a patent. Regardless of the scenario, choosing the right proceeding and executing a well thought-out strategy is critical.

What are the types of post-grant proceedings?

The major post-grant proceedings are:

- *Inter partes* review
- Post-grant review
- Covered business method patent review
- *Ex parte* reexamination
- Supplemental examination
- Reissue
- Certificate of Correction

Who can initiate a post-grant proceeding?

Who can start the proceeding depends on the type of proceeding. Only third parties can initiate a “review” proceeding, while only patent owners can initiate supplemental examination, reissue, and Certificate of Correction proceedings. Anyone can initiate an *ex parte* reexamination.

WHY INITIATE A POST-GRANT PROCEEDING?

For Patent Owners: Post-grant proceedings can be started for various reasons. In many instances, the patent owner does not make the choice, but is instead responding to a challenge to its patent lodged by another party. The patent owner has the choice to walk away from the patent. However, if another party is concerned enough about the patent to mount a challenge, it may be an indication that there are valuable patent rights in play and the patent owner should vigorously defend the post-grant challenge.

Other times, proceedings may be initiated by a patent owner to strengthen an issued patent. By returning the patent to the Patent Office, the patent owner can remove what might be a cloud over the patent, make the patent litigation-ready, and, in special circumstances, even make the patent broader.

For Challengers: Third parties can initiate a post-grant proceeding, and frequently do so when an issued patent poses a risk to their business. However, there are numerous other reasons that a third party might want the patent narrowed or invalidated. Frequently, third parties bring post-grant proceedings as an adjunct to litigation. However, a challenge to a patent may be a way to resolve a licensing dispute or avoid litigation.

In addition to the opportunity to win a post-grant challenge and avoid all liability for infringing a patent, the existence of a post-grant proceeding may be a basis for a judge in a patent litigation to stay that litigation during the post-grant proceeding. A stay of litigation may be a tactical benefit to a challenger, delaying or avoiding costs, and providing time to design-around a patent or better prepare a defense in the litigation.

HOW DO I PREPARE FOR A POST-GRANT PROCEEDING?

For Patent Owners: Best practices for preparing for a post-grant proceeding will vary from case to case and proceeding to proceeding, but as a general matter you will need to work closely with your technical and legal teams to either initiate or defend against a post-grant proceeding.

Technically talented attorneys who can identify characteristics of a valuable invention will be invaluable in the process. Those attorneys should have extensive experience working with the Patent Office in both patent prosecution and post-grant proceedings. Of course, skill in the art of technical persuasion can greatly increase the chances of success.

You should work closely with those attorneys to develop a persuasive technical story of invention.

For Challengers: When bringing a post-grant challenge, third parties often use time to prepare to their advantage. Developing a technical story of invalidity by investigating the prior art can greatly increase chances of success. As post-grant proceedings are decided by technically trained administrative patent judges or examiners, presenting a complete picture of invalidity that will withstand technical scrutiny may be crucial to success.

Anticipating responses by the patent owner should also be a part of the preparation. As with preparations by the patent owner, finding technically talented, experienced attorneys skilled at advocating technical cases can be crucial to success.

WHAT CAN BE WON IN A POST-GRANT PROCEEDING?

For Patent Owners: A patent owner's goal is to emerge from a post-grant proceeding with valuable patent rights. For most proceedings, that goal is achieved if all the claims in the patent are confirmed as patentable. Confirmation may come in the form of a certificate issued by the Patent Office. In other instances, it may come from the Patent Office not taking any action that cancels claims or otherwise acknowledging that there is no problem with the patent.

In some cases, emerging with valuable patent rights can also mean adding or amending claims. These new or amended claims, except in some unique situations mentioned later, will be narrower than the claims originally issued in the patent. Nonetheless, if they more tightly cover a competitive product and are less susceptible to challenge, new or amended claims can provide significant value by foreclosing defenses that an accused infringer might raise in court.

For Challengers: The challenger's goal is usually to reduce risk from a patent – or at least remove the threat of claims about which it is concerned from an infringement standpoint. That threat may be removed by outright cancellation of the claims or by forcing the patent owner to make amendments that so reduce the scope of the claims that they are no longer a risk.

In some instances, a post-grant challenge can prompt the Patent Office to make statements that reduce the risk from a patent. The Patent Office, for example, may be prompted to identify problems with a patent or state an interpretation of the patent that will aid the challenger in litigation.

The proceedings vary in terms of how much control the challenger has in achieving its goals. Review proceedings allow the challenger full participation through the initial decision, and often in an appeal. The challenger has very restricted rights to participate in *ex parte* reexamination, which usually end once the request is filed. There is even less ability to participate in reissue, supplemental examination, or Certificate of Correction proceedings.

Accordingly, careful selection of the most appropriate post-grant proceeding can drive the result.

WHAT HAPPENS AFTER CLAIMS ARE AMENDED OR CANCELED?

For Patent Owners: Claims that are not amended in a post-grant proceeding can be enforced during or after the proceeding, even for infringement that happened before the proceeding. All rights in claims that are canceled end when the cancellation becomes effective.

Claim amendments will generally work prospectively. Once a claim addition or amendment becomes effective, it can be licensed or enforced against a party that starts infringing after that. With an average life of a patent of 15 or more years, prompt correction of a patent can secure years of valuable rights. Unless the claim amendment is so minor as to not make any substantive change to the claim, the claim can only be enforced for future infringement.

For Challengers: The challenger can be relieved of liability for any claim that is canceled. Actions fully completed before a claim is canceled, including final decisions in court actions and payments made on licenses, likely cannot be undone even if based on a claim that is later canceled in post-grant review. However, any future decisions, even in suits for infringement that happened before the post-grant proceeding, should be made as if the canceled claim never existed.

The same is true for retrospective actions on amended claims that are not substantially identical to the original claims in the patent. Though amended claims can be enforced prospectively, a challenger can benefit from forcing claim amendments in a post-grant proceeding in several ways. If the challenger is not taking any action that is covered by the amended claim, there will be no liability. Even if the challenger is taking covered actions, often the post-grant proceeding gives the challenger time to change its behavior to avoid the amended claims. Additionally, a challenger may persuade a court that enforcing an amended claim would be unfair based on actions the challenger took while thinking the patent contained no valid claims covering the challenger's actions. This concept, called **intervening rights**, can be of significant value, even though the patent continues to exist in narrowed form.

INTER PARTES REVIEW

What is *inter partes* review?

Inter partes review is a type of administrative trial, conducted in front of a panel of administrative patent judges (APJs) at the Patent Office, to determine whether claims in an issued patent are valid. An *inter partes* review is focused solely on validity issues.

As with the other "review" procedures discussed later, *inter partes* review is intended as something of a hybrid between civil patent litigation and patent prosecution. It has more limited discovery than civil litigation and is decided by technically trained APJs, not a jury.

Who can initiate *inter partes* review?

Anyone who is not the patent owner may request an *inter partes* review, subject to certain limits.

How do I start an *inter partes* review?

To start an *inter partes* review, you must file a petition with the Patent Office presenting arguments and evidence that claims of the issued patent are the same as or too similar to identified patents or printed publications to be patentable. You must demonstrate in the petition that you have a reasonable likelihood of prevailing and proving that at least one of the claims is invalid.

Are there time limits on requesting an *inter partes* review?

Yes.

- If you have been sued for patent infringement, you can only request *inter partes* review of that patent within one year of being served with the complaint.
- If you have initiated a declaratory judgment litigation challenging the validity of the patent, you cannot request an *inter partes* review of the patent.

- *Inter partes* review may not be requested while post-grant review is ongoing or could be requested. For many patents, this means that *inter partes* review can be requested only nine months or more after the patent issues.

How does an *inter partes* review proceed?

After the petition is filed, the patent owner has three months to file a preliminary response, if it wishes. The Patent Office then has a further three months to decide whether to initiate the review.

If the Patent Office initiates the review, there is a 12-month period in which the review must be completed. During this period, many activities occur in short order: the patent owner files a response to the petition and perhaps a motion to amend claims; the petitioner replies to the response and opposes any motion to amend; the parties submit declarations and conduct limited discovery; the parties file motions to exclude evidence and set the case for a hearing; a hearing is conducted in front of a panel of three APJs; and the APJs issue a final written decision.

The third-party petitioner stays involved throughout the *inter partes* review.

After the Patent Trial and Appeal Board renders its final written decision, the patent owner can appeal to the U.S. Court of Appeals for the Federal Circuit, and in most cases the challenger also has the right of appeal, if the decision goes against it.

How long does an *inter partes* review take?

Inter partes reviews are fast by Patent Office standards – often faster than litigation in court and other post-grant options, often taking about half the time of an *ex parte* reexamination.

The Patent Office was tasked by the U.S. Congress to complete *inter partes* reviews within 12 months of instituting the review (though the Patent Office may extend this period by up to six months for good cause). Typically this means the entire process (before appeal) will conclude within 18 months of the filing of a petition.

As a result, district courts may be more likely to stay co-pending patent infringement litigation in view of an *inter partes* review, as compared to an *ex parte* reexamination. This decision is primarily at the district court judge's discretion, however.

What is the “estoppel” that an *inter partes* review can trigger?

A price for the right to participate in an *inter partes* review is

that the petitioner cannot argue later that a claim is invalid on any ground that the petitioner “raised or reasonably could have raised” during the review. This prohibition is called an “estoppel.”

The estoppel applies to other proceedings in front of the Patent Office and to any litigation. All three of the new “review” procedures have estoppel provisions, which apply in the same way to other Patent Office actions, district court lawsuits, and International Trade Commission investigations. The estoppel associated with *inter partes* review does not, however, bar all subsequent challenges to the validity of a patent. Because there are many challenges to a patent that cannot be raised in an *inter partes* review, that means there are challenges to validity that are not estopped. In fact, assessing options in the event that all claims of a patent are not invalidated is often a key consideration in deciding whether *inter partes* review should be filed.

Is *inter partes* review worth it?

The answer depends on the case. In general, however, *inter partes* review has proven to be a favorable mechanism for challenging patents, and is initiated about 75% of the time. Once initiated, approximately 80% of the claims considered are canceled. Advantages to the third-party challenger include the ability to challenge a competitor's patent without facing potential damages or an injunction, to pursue a proceeding focused solely on validity, and to remain engaged throughout. The challenger does not have to overcome the presumption of patent validity, as in litigation.

Potential risks include the costs, the possible trigger of an infringement lawsuit by the patent owner if one has not already been initiated, and estoppel provisions if the challenger loses.

From the patent owner's view, all of the “review” procedures are defensive. If they are initiated by a challenger, the patent owner needs to consider how to turn them to its advantage, such as by amending the claims in a helpful fashion, or initiating a patent infringement lawsuit.

POST-GRANT REVIEW

What is post-grant review?

Post-grant review is another “review” procedure established by the America Invents Act. It is similarly a trial-like procedure where administrative patent judges determine whether an

issued patent's claims are valid in view of particular invalidity arguments brought by a third-party requester. Unlike *inter partes* review, post-grant review is not limited to invalidity based on prior art patents and printed publications, but can extend to prior art products, prior sales, and patentable subject matter issues.

As many *inter partes* review and post-grant review procedures are similar, this portion of the Q&A focuses on the differences.

Who can initiate a post-grant review?

As with *inter partes* review, anyone but the patent owner can initiate a post-grant review.

How do I start a post-grant review?

You must file a petition with the Patent Office arguing that certain claims of an issued patent are invalid. Unlike *inter partes* review, in post-grant review you can raise any validity attack. So you can base your arguments on not just prior art patents and printed publications, but also other prior art activity, public uses, and offers for sale, and you can raise written description and enablement problems.

As in *inter partes* review, you must demonstrate that you have a reasonable likelihood of prevailing and proving that at least one of the claims is invalid, or alternatively that the petition raises a novel or unsettled legal question.

Are there time limits on requesting a post-grant review?

Yes. Post-grant review is only available for patent applications filed after March 16, 2013. In addition, the petition must be filed within nine months after the patent issues. Finally, as with *inter partes* review, a third party which brings a declaratory judgment lawsuit for invalidity of the patent cannot petition for post-grant review. Similarly, a third party which alleges invalidity in a counterclaim to a patent infringement suit is not barred.

How does a post-grant review proceed?

Once initiated, the procedures for a post-grant review are essentially the same as for an *inter partes* review. The statutes use almost identical language. The time frames for the review are the same, as are the procedures for appeal.

Does post-grant review trigger estoppel?

Yes. Post-grant review has an estoppel provision identical to that in *inter partes* review, which applies to issues the petitioner raised or reasonably could have raised in the post-grant review.

Is post-grant review worth it?

As with the other "review" procedures, the answer depends

on the case. The advantages and risks of each review procedure are broadly similar, so the one picked depends upon which is available for a particular patent.

COVERED BUSINESS METHOD REVIEW

What is covered business method review?

Covered business method review is the last type of "review" procedure. It borrows all of its procedures from post-grant review:

- Anyone who is not the patent owner can initiate either kind of review, **except** that the petitioner in a covered business method review must also have been sued or charged with infringement of the patent.
- The grounds for invalidity are the same in both types of review.
- The standards to initiate review are the same.
- The procedures and time frame are the same.
- The same estoppel provisions apply to both reviews, except that the covered business method review estoppel is narrower. It applies only to issues the petitioner actually raised in the review, not to issues it reasonably could have raised.
- Both reviews have the same fees and anticipated costs.

This section focuses only on differences from post-grant review.

What is a "covered business method?"

The America Invents Act (AIA) defines a "covered business method" as a patent that "claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service." The AIA also specifies that the term does not include "patents for technological inventions."

This type of review is aimed specifically at challenging business method patents in the financial field, and nothing else, but the interpretation of "financial product or service" can be quite broad.

When can I initiate a covered business method review?

For patents filed before March 16, 2013, you can petition for a covered business method review at any time after the patent issues.

For patents filed after March 16, 2013, you can file the petition only nine months or more after the patent issues.

In either case, however, you have to have been sued or charged with infringement of the patent before you file the petition.

Will covered business method reviews continue to be available indefinitely?

No. Unlike the other two types of review, covered business method reviews may not be requested after September 16, 2020.

Are there other differences from post-grant review?

The only other significant difference is that the statute sets out a list of factors for district courts to consider when deciding whether to stay co-pending litigation in view of covered business method reviews. While these factors should make a stay more likely than one based on the other types of review, the district court judge still has discretion in how to apply the factors.

EX PARTE REEXAMINATION

What is *ex parte* reexamination?

Ex parte reexamination proceeds before an examiner in the Patent Office's Central Reexamination Unit, to determine the impact of a "substantial new question of patentability" (SNQ) on an issued patent.

As the name implies, reexamination is an additional examination of an issued patent. It determines whether the claims of the patent should have been issued, when a new question as to the patent's validity is considered. This issue has to be one that was not squarely considered during initial prosecution.

Who can initiate an *ex parte* reexamination?

Anyone can start an *ex parte* reexamination, unless you have already lost a challenge to the patent in another post-grant proceeding that creates an estoppel. Even the Patent Office can start *ex parte* reexamination on its own, but that is rare.

As in *inter partes* review, third parties may initiate *ex parte* reexaminations after they have been accused of infringing the patent to either invalidate claims of the patent or force the patent owner to narrow them. Because there is no requirement that *ex parte* reexamination be brought within one year of suit, it can be brought late in a litigation, sometimes as a fallback in case the trial does not go as expected. Additionally, because *ex parte* reexamination may be filed anonymously, it is sometimes used to proactively

remove or limit competitive patents before litigation is filed.

A patent owner may start a reexamination because it learns of new prior art after the patent issues, and wants to strengthen the patent. The patent owner would use the reexamination to submit the new art to the Patent Office, and try to demonstrate why the claims are still valid over the art. However, if the goal is to get confirmation that the patent is fine as is, supplemental examination may be a better option. If amendments to the claims are needed to avoid the new art, reexamination might be appropriate. Reissue might also be appropriate in this circumstance, and might provide advantages.

How do I initiate an *ex parte* reexamination?

To start an *ex parte* reexamination, you file a request for reexamination with the Patent Office. In the request, you must demonstrate how prior art patents or printed publications raise one or more SNQs that were not considered during earlier examination.

Within about three months, an examiner will determine whether one or more SNQs have been raised, and if so, order a reexamination. The patent owner may respond to the order, but frequently makes a strategic decision not to. Thereafter, the examiner will begin the process of considering whether the claims are patentable.

How does a reexamination proceed?

Any party can bring a request with the Patent Office to start an *ex parte* reexamination. The request must show that there is an SNQ the Patent Office should address.

Even if a third party requested the reexamination, once reexamination begins it is conducted solely between the patent owner and the Patent Office. An *ex parte* reexamination is similar to regular patent prosecution, with an examiner issuing actions to which the patent owner responds. However, there are important differences. *Ex parte* reexamination is intended to be fast, which limits the number of actions that an examiner will issue and imposes limits on time for response. Additionally, claim amendments can only narrow claims, so there may be less flexibility in amending claims than in regular patent prosecution.

The examiner will issue an initial office action, accepting or rejecting the claims being reexamined. Assuming the claims are rejected, the patent owner will then respond and attempt to persuade the examiner that the claims should be allowed, amend the claims, or add new claims.

Depending on the issues considered, the examiner may issue several actions. The process will eventually conclude, either by the examiner indicating all claims presented are patentable or issuing a final office action. There is, in theory,

no limit on the number of office actions that are issued. In practice, however, the second office action is typically final – placing a premium on the ability to quickly identify and resolve issues. The patent owner can appeal that final action within the Patent Office to the Patent Trial and Appeal Board (PTAB). If the patent owner does not agree with the PTAB's decision, it can then appeal to the U.S. Court of Appeals for the Federal Circuit.

How long will a reexamination take?

The length of an *ex parte* reexamination depends on the number and complexity of issues being considered, on the particular examiner that has responsibility for the reexamination, and on whether the patent owner wishes to fight every issue or is willing to amend or narrow certain claims to have them allowed.

The Patent Office's statistics give the average time from filing to conclusion as about two and a half years. If there is an appeal to the PTAB or Federal Circuit, however, the time frame can be significantly longer (up to five to seven years in some cases).

Is *ex parte* reexamination worth it?

The answer, of course, depends on the case. For a third-party requester, the advantages include challenging the validity of claims outside of patent litigation, perhaps having a pending patent infringement litigation stayed until the reexamination concludes, and the relatively low costs as compared to challenging validity in litigation or *inter partes* review. Prevailing in reexamination by having the claims of a patent canceled can wipe out liability for infringement. Even if the claims are narrowed, but are then confirmed as patentable, liability for any past actions may be wiped out. Thus, there are multiple ways a challenger could win in an *ex parte* reexamination.

For the patent owner, the advantages include the possibility of strengthening the patent by having its claims confirmed over prior art not considered in the original examination. Even having amended but stronger claims issued can be a benefit for the patent owner. These benefits for the patent owner are risks to the requester, and *vice versa*.

What are the key differences between *ex parte* reexamination and review proceedings?

- **Speed:** Review proceedings are about twice as fast as *ex parte* reexamination, and sometimes faster.
- **Deadlines for Initiating:** *Ex parte* reexamination may be initiated at any time after the patent issues, while the review procedures have limitations on timing.
- **Amendments:** A patent owner can make amendments at least once in *ex parte* reexamination. This is more

limited than in reissue, where multiple amendments will be entertained, but more liberal than in review proceedings, where the patent owner is allowed to propose amendments only once. Those amendments are usually not accepted by the Patent Office, because the patent owner must prove that the amendments make the claims meet all requirements for patentability, even if not part of the review. The Patent Office usually finds that the patent owner has not met this burden.

- **Discovery:** Review offers the possibility of some discovery, both in terms of requesting documents and depositions, although much more limited than litigation. Reexamination, because it does not involve the challenger after initiation, does not include discovery.
- **Trial vs. Examination:** Review is a trial in which administrative patent judges make a decision based on evidence presented. Reexamination, as indicated by its name, is more like another examination of the patent in which an examiner may make an independent investigation of validity.
- **Settlement:** Review allows the parties to settle their dispute. The Patent Office will typically approve the settlement. Reexamination does not allow the parties to settle.
- **Estoppel:** Review triggers certain estoppels, barring some future challenges to the validity of the patent, while *ex parte* reexamination does not, leaving the challenger free to request other reexaminations or reviews or challenge validity in court.
- **Intervening Rights:** All of the post-grant proceedings have the potential to give rise to intervening rights as a result of claim amendments that substantively change the scope of the claim. These rights will apply regardless of whether the proceeding is requested by a challenger or the patent owner.
- **Cost:** Review is likely more expensive than *ex parte* reexamination, both in terms of Patent Office fees and other costs, although review is still likely less expensive than patent litigation in court.

SUPPLEMENTAL EXAMINATION

What is supplemental examination?

Supplemental examination is a relatively new procedure, under which the patent owner can ask the Patent Office to consider, reconsider, or correct information believed to be relevant to an issued patent.

Who can request supplemental examination?

Only the patent owner can request supplemental examination.

What are the grounds for supplemental examination?

Reasons for supplemental examination can be anything related to patentability. This includes not only novelty and non-obviousness, but any other matter relating to any ground of patentability.

How does a patent owner request supplemental examination?

The patent owner submits a request for supplemental examination to the Patent Office, a copy of the relevant information (for example, prior art documents), and an explanation of the relevance of the information to the patent. Although not required, the patent owner will also typically want to explain why the claims are still valid in view of the new information.

What does the Patent Office do with the request?

Within three months, the Patent Office must determine if the information submitted raises a “substantial new question of patentability” (SNQ). If the information does not raise an SNQ, the Patent Office will issue an order stating so and terminating the supplemental examination. If the information raises one or more SNQs, the Patent Office will order an *ex parte* reexamination of the patent. That reexamination will cover each SNQ raised by the information. The reexamination will then proceed along the same lines as any other *ex parte* reexamination.

Why would a patent owner want to request supplemental examination?

Supplemental examination can quickly make a patent more ready for litigation or licensing by offering the possibility of a quick confirmation of patentability. A finding by the Patent Office that the submitted information does not raise an SNQ strengthens the patent. A judge or jury in litigation is less likely to invalidate a patent based on issues that were squarely addressed by the Patent Office. A party approached to take a license is less likely to refuse on the grounds that the patent is invalid if their basis for alleging the patent is invalid has already been considered and rejected by the Patent Office.

A second advantage is that a patent cannot be held unenforceable on the basis of information that was not submitted during the original examination, if that information is submitted in a supplemental examination request before the issue is raised in litigation. Because patents are frequently challenged in litigation on the

theory that information known to the patent owner should have been submitted for consideration by the examiner, using supplemental examination to foreclose this issue can reduce the cost of enforcement and increase the value of the patent.

What are the risks of supplemental examination?

One risk is that the Patent Office may declare a reexamination, and cancel or require narrowing amendments to the claims. This is a risk of any owner-initiated procedure that causes the patent to be examined again, as discussed in connection with reexamination.

Is supplemental examination worth it?

Once again, the answer depends on the case. Supplemental examination has advantages to the patent owner in quickly strengthening the patent and protecting against unenforceability allegations. But it may also trigger a reexamination, and the unenforceability protections have limits.

If there are questions as to the validity of an issued patent, a patent owner will often be better off requesting supplemental examination, rather than requesting reexamination directly.

REISSUE

What is reissue?

Reissue is a process by which a patent can effectively be issued a second time to correct an error. While the statute requires that the error render the patent wholly or partially inoperative or invalid, it is often relatively easy to meet this standard, as failing to include claims that are sufficiently detailed may be an error that justifies reissue.

Who can request reissue?

Only the current owner of a patent can request reissue.

What are the grounds for reissue?

A broad range of errors can be corrected by reissue. Typical errors correctable by reissue include a defective specification or drawing, claims that are too narrow or too broad, or failure to correctly reference priority documents. As reissue is used only to correct an error, it cannot be used to undo an intentional action during the original prosecution. It cannot be used, for example, to broaden claims to cover

subject matter surrendered by claim amendments to obtain allowance of the patent.

How does a patent owner request reissue?

A patent owner can request reissue by filing a reissue patent application that includes a declaration identifying one or more errors to be corrected.

When can a reissue application be filed?

A reissue application can be filed at any time during the enforceable term of a patent. However, broader claims can be pursued in a reissue application only if the intent to broaden the claims is clearly expressed in a reissue application within two years of the issue date of the original patent. Such a “broadening reissue” is different than other post-grant proceedings, where amendments can only narrow the claims. A reissue application can also be filed as a continuation of another reissue application – creating much greater flexibility than in reexamination.

What does the Patent Office do with the request for reissue?

A reissue application is examined in the same manner as a non-reissue, non-provisional application, although slightly different procedural rules govern how certain tasks are to be performed. Reissue applications are normally examined by the same examiner who issued the patent for which reissue is requested.

Reissue is intended to be quick, with reissue applications intended to be acted on by the examiner in advance of other applications. However, historically, reissue applications have not been acted on with the same speed as reexaminations. The additional flexibility of reissue, enabling more interactions with an examiner, also extends the time for completing a reissue relative to a reexamination.

What happens when a reissue application is allowed?

After a reissue application is allowed, the Patent Office will publish a reissued patent that effectively replaces the original patent. Before a patent can be reissued, the original patent must be surrendered.

Why would a patent owner want to request reissue?

A patent owner may request reissue to correct one or more errors discovered after a patent issues. The reissue process can in some instances be used to prepare a patent for litigation by “cleaning up” issues discovered when performing pre-suit diligence. For instance, broader claims may be pursued to better cover a competitor’s product or

service, or narrower claims that more clearly avoid prior art can be added. Reissue can also be considered as an alternative way to introduce claim amendments to avoid prior art cited during an *inter partes* review proceeding. This approach to introducing claim changes may be preferable because narrowing claim amendments can be added as a matter of right during reissue proceedings, whereas the introduction of claim amendments during *inter partes* review proceedings must be justified and, at least historically, has been allowed only in rare circumstances.

CERTIFICATE OF CORRECTION

What is a Certificate of Correction?

A Certificate of Correction is a paper published by the Patent Office, upon request, to correct clerical or typographical errors that appear in an issued patent.

Who can request a Certificate of Correction?

Only the current patent owner can request a Certificate of Correction.

What are the grounds for a Certificate of Correction?

A Certificate of Correction can be used to correct clerical or typographical errors made either by the applicant or the Patent Office.

Why would a patent owner want to request a Certificate of Correction?

Even though a Certificate of Correction is intended to correct clerical or typographical errors, those errors sometimes have significant consequences. A missing digit in a priority claim, for example, can deprive a patent owner of a priority date needed to avoid invalidating prior art. As another example, a claim limitation needed to distinguish over a prior art reference may be inadvertently omitted or misstated, or unwanted verbiage that prevents a claim from covering a competitor’s product or service may be accidentally included. A Certificate of Correction can often be obtained relatively quickly, and is unlikely to expose the patent to further examination, such as might occur if a correction is made through reissue. The value of a Certificate of Correction should not be overlooked when considering options prior to litigation or licensing activities.

Does a Certificate of Correction impact the enforceability of the original patent?

Maybe. Changes made by a Certificate of Correction apply only to acts of infringement that occur after the certificate publishes. This “prospective only” enforceability can, in certain instances, effectively limit the enforceable term of a patent to the period a Certificate of Correction issues. However, if the claim in its uncorrected form would have been found invalid, the correction can expand the patent owner’s rights.

COST

What do post-grant proceedings cost?

The costs vary widely, depending on the type of proceeding and your objectives in the proceeding. Costs include fees paid to the Patent Office, attorney fees, and often expenses. *Inter partes* review, post-grant review and covered business method patent review are likely to be more expensive than *ex parte* reexamination, supplemental examination, or reissue. However, even these contested review proceedings, depending on the situation and objectives, can cost more than initially obtaining a patent. Therefore, it is best to discuss your specific situation and objectives with the post-grant specialists at Wolf Greenfield to develop a winning plan and acceptable budget.

Wolf Greenfield’s Post Grant Proceedings Group has successfully handled numerous IPRs, reexaminations, and other post-grant proceedings for industry leaders. Our vast experience in complex Patent Office proceedings and high-stakes patent litigation combined with our technical expertise has led to our market-leading success rate. For more information, please visit www.wolfgreenfield.com.

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Q&A on Intellectual Property Litigation

Q&A on Licensing and Transactions

Q&A on Patents

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