

**Submission of the UNITED STATES PATENT AND TRADEMARK
OFFICE in reply to WIPO Circular 7992, regarding revisions to the
preliminary study on opposition systems (SCP/14/5)**

**This submission is further to the request by the Secretariat for information and statistical
data on national laws and practices related to opposition systems**

August 15, 2011

Summary

The United States provides post-grant reexamination procedures to verify whether the claimed subject matter of a granted patent is patentable.

The reexamination of a patent can be requested by anyone at any time while the patent is enforceable. The steps to request reexamination include filing a “request for reexamination”, providing copies of the prior art relied upon (only patents and printed publications are allowed), providing an explanation of a “substantial new question of patentability” raised by the prior art, paying the appropriate fee, and giving notice to the patent owner.

There are two varieties of reexamination procedures which may be requested. In the *ex parte* reexamination procedure, the requester of the procedure, once the request is filed, is no longer allowed to participate in the proceedings. The interaction is then exclusively between the USPTO examiner and the patent owner. The Office may also initiate an *ex parte* reexamination.

In the *inter partes* reexamination, the requester has the right to participate in the proceedings between the patent owner and the Office. The requester also has the right to appeal to the Board of Patent Appeals and Interferences (the Board) and to the Court of Appeals for the Federal Circuit (CAFC), as well as to participate in the patent owner’s appeals to the Board and the CAFC.

Other options exist to challenge issuance of a patent from an application. Under 37 CFR 1.99, patent owners may notify an examiner that a pending application contains claims that interfere with their patent. Although the patent owner cannot initiate an interference proceeding, which only the examiner may do, the patent owner can point out to the examiner claims in an application that are believed to interfere.

A protest may be filed by a member of the public against a pending application, to challenge issuance of a patent from the application. However, there are strict timing requirements that must be complied with when initiating protest proceedings, such as filing the protest before the patent application is published.

Provisions for Ex Parte Reexamination

The reexamination statute and rules permit any person to file a request for an *ex parte* reexamination if "a substantial new question of patentability" is presented, as defined in 35 U.S.C. 303(a). If such a question is deemed to have been presented, reexamination will be ordered.

Reexamination proceedings are similar to regular examination procedures in patent applications. Some notable differences include certain limitations on the kind of rejections which may be made, and time periods that are set to provide "special dispatch." When the reexamination proceeding is concluded, a reexamination certificate is issued to indicate the status of all claims following the reexamination.

Ex parte reexamination is conducted under the following provisions:

- (1) Anyone can request reexamination at any time during the period of enforceability of the patent;
- (2) The prior art considered during reexamination is limited to patents or printed publications applied under the appropriate parts of 35 U.S.C. 102 and 103;
- (3) A substantial new question of patentability must be present before reexamination can be ordered;
- (4) If ordered, the actual reexamination proceeding is ex parte in nature;
- (5) A decision on the request must be made no later than 3 months from its filing, and the remainder of proceedings must proceed with "special dispatch" within the Office;
- (6) If ordered, a reexamination proceeding will normally be conducted to its conclusion with the issuance of a reexamination certificate;
- (7) The scope of a claim cannot be enlarged by amendment; and
- (8) All reexamination and patent files are open to the public.

A request for ex parte reexamination must include the following parts:

- 1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.
- (2) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinence and manner of applying the cited prior art to every claim for which reexamination is requested. If appropriate, the party requesting reexamination may also point out how the claims are distinguishable over the cited prior art.
- (3) A copy of every patent or printed publication relied upon or referred to in paragraph (b)(1) and (2) of this section accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication.
- (4) A copy of the entire patent for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent.
- (5) A certification that a copy of the request, if filed by someone other than the patent owner, has been served in its entirety on the patent owner.
- (6) If the request is filed by the patent owner, it may also include a proposed amendment.

The patent owner may appeal the reexamination decision of the USPTO to the Board, and further to the CAFC. The ex-parte reexamination requester, if other than the patent owner, has no right to participate in either appeal.

Provisions for Inter Partes Reexamination

The reexamination statute was amended on November 29, 1999 and expanded by providing an "inter partes" option. This section authorizes the extension of reexamination proceedings via an optional inter partes reexamination procedure in addition to the ex parte reexamination procedure. Only a third party, and not the patent owner, is permitted to request an inter partes reexamination.

The inter partes reexamination 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, such as lower cost relative to Court proceedings and expedited procedure.

During the inter partes reexamination, third party requesters as well as the patent owner are given the right to appeal unfavorable USPTO decisions to the Board. In addition, a third party requester is allowed to participate in a patent owner's appeal to the Board.

In the inter partes reexamination proceeding the patent owner can further appeal the decision of the Board to the CAFC. The third party requester also has rights to appeal the USPTO's decision to the Court of Appeals for the Federal Circuit, and to participate in the patent owner's appeal to the CAFC.

Exercising the inter partes option is conditioned 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 are aimed at preventing inter partes reexamination proceedings from being used to harass patent owners.

Both the ex parte reexamination option and the inter partes reexamination option are available 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, and only the ex parte reexamination is available.

A Substantial New Question of Patentability

Both ex parte and inter partes reexamination procedures are ordered only when there is "a substantial new question of patentability" in at least one claim of the patent. If there is no such "question", the reexamination cannot take place. The meaning and scope of the "substantial new question of patentability" is developed according to the case law.

A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and/or publications would be considered important, then the examiner should find that "a substantial new question of patentability" exists.

However, if the same substantial question of patentability has already been decided previously, reexamination will not be proper. For example, if the examiner finds that the additional prior art patents or printed publications are merely cumulative to similar prior art already fully

considered in a previous examination of the claim, there is no “substantial new question of patentability”.

Accordingly, for "a substantial new question of patentability" to exist, it is necessary that:

(A) The prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim. This means that the teaching of the prior art is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and

(B) The same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim.

It is not necessary for the prior art submitted to form a "prima facie" case of unpatentability. A “substantial new question of patentability" as to a patent claim may exist even if the examiner would not necessarily reject the claim as either anticipated by or obvious in view of those prior art patents or printed publications.

Statistical data on the performance of the USPTO reexamination program is provided in Appendix A.

Other Systems

Other options exist to challenge issuance of a patent from an application prior to grant of the patent.

Rule 99: Third-party submission in published application

A submission by a member of the public of patents or publications relevant to a pending published application may be entered in the application file if the application is still pending when the submission and application file are brought before the examiner. The submission generally must be filed within two months of the application’s publication date, or prior to the mailing of a notice of allowance, whichever is earlier.

The submission under Rule 99 shall not include any explanation of the patents or publications provided, or any other information. The Office will not enter such explanation or information if it is included in a submission under Rule 99. The submission is also limited to ten total patents or publications.

Protest

A protest may be filed by a member of the public against a pending application, to challenge issuance of a patent from the application. In this case, the protester is entitled to provide written comments describing the relevance to the claims of the pending application of the patents, publications or other information being submitted as prior art.

However, under 37 CFR 1.291, the protest must be filed before the challenged pending application is published, or if the application is not published, before a Notice of Allowance is

issued. Thus, a protest can only take place when the challenger has personal knowledge of the application being filed.

Statistical data on the number of filed protests for the years 1996-2011 is contained in Appendix B.

Appendix A

Inter Partes Reexamination Filing Data – June 30, 2011

1.	Total requests filed since start of <i>inter partes</i> reexam on 11/29/99.....	1286 ¹	
2.	Number of filings by discipline		
	a. Chemical Operation	224	17%
	b. Electrical Operation	676	53%
	c. Mechanical Operation	371	29%
	d. Design Patents	15	1%
3.	Annual Reexam Filings		
	<u>Fiscal Yr.</u> <u>No.</u> <u>Fiscal Yr.</u> <u>No.</u> <u>Fiscal Yr.</u> <u>No.</u> <u>Fiscal Yr.</u> <u>No.</u>		
	2000 0 2003 21 2006 70 2009 258		
	2001 1 2004 27 2007 126 2010 281		
	2002 4 2005 59 2008 168 2011YTD 271		
4.	Number known to be in litigation.....	910	71%
5.	Decisions on requests.....	1155	
	a. No. granted.....	1099	95%
	(1) By examiner	1092	
	(2) By Director (on petition)	7	
	b. No. not granted.....	53	5%
	(1) By examiner	48	
	(2) Reexam vacated	5	
6.	Overall reexamination pendency (Filing date to certificate issue date)		
	a. Average pendency	36.6 (mos.)	
	b. Median pendency	33.0 (mos.)	
7.	Total <i>inter partes</i> reexamination certificates issued (1999 - present).....	278	
	a. Certificates with all claims confirmed	35	13%
	b. Certificates with all claims canceled (or disclaimed)	123	44%
	c. Certificates with claims changes	120	43%

¹Of the requests received in FY 2011, 3 requests have not yet been accorded a filing date, and 5 requests have had preprocessing terminated, for failure to comply with the requirements of 37 CFR 1.915. See Clarification of Filing Date Requirements for *Ex Parte* and *Inter Partes* Reexamination Proceedings, Final Rule, 71 Fed. Reg. 44219 (August 4, 2006).

Ex Parte Reexamination Filing Data - June 30, 2011

1. Total requests filed since start of <i>ex parte</i> reexam on 07/01/81.....	11604 ¹
a. By patent owner	3761 33%
b. By other member of public	7677 66%
c. By order of Commissioner	166 1%
2. Number of filings by discipline	
a. Chemical Operation	3180 27%
b. Electrical Operation	4323 37%
c. Mechanical Operation	3922 34%
d. Design Patents	179 2%
3. Annual <i>Ex Parte</i> Reexam Filings	
Fiscal Yr. No. Fiscal Yr. No. Fiscal Yr. No. Fiscal Yr. No.	
1981 78 (3 mos.) 1989 243 1997 376 2005 524	
1982 187 1990 297 1998 350 2006 511	
1983 186 1991 307 1999 385 2007 643	
1984 189 1992 392 2000 318 2008 680	
1985 230 1993 359 2001 296 2009 658	
1986 232 1994 379 2002 272 2010 780	
1987 240 1995 392 2003 392 2011YTD 581	
1988 268 1996 418 2004 441	
4. Number known to be in litigation.....	3823.....33%
5. Decisions on requests.....	11095
a. No. granted.....	10182.....92%
(1) By examiner	10064
(2) By Director (on petition)	118
b. No. denied	913.....8%
(1) By examiner	878
(2) Reexam vacated	35

¹Of the requests received in FY 2011, 6 requests have not yet been accorded a filing date, and preprocessing of 33 requests was terminated for failure to comply with the requirements of 37 CFR 1.510. See Clarification of Filing Date Requirements for *Ex Parte* and *Inter Partes* Reexamination Proceedings, Final Rule, 71 Fed. Reg. 44219 (August 4, 2006).

6.	Total examiner denials (includes denials reversed by Director).....			996	
	a. Patent owner requester		468	48%	
	b. Third party requester		528	52%	
7.	Overall reexamination pendency (Filing date to certificate issue date)				
	a. Average pendency		25.7 (mos.)		
	b. Median pendency		20.0 (mos.)		
8.	Reexam certificate claim analysis:	Owner	3 rd Party	Comm'r	
		<u>Requester</u>	<u>Requester</u>	<u>Initiated</u>	<u>Overall</u>
	a. All claims confirmed	21%	24%	11%	23%
	b. All claims cancelled	9%	13%	23%	11%
	c. Claims changes	70%	63%	66%	66%
9.	Total <i>ex parte</i> reexamination certificates issued (1981 – present)			8375	
	a. Certificates with all claims confirmed		1913	23%	
	b. Certificates with all claims canceled		960	11%	
	c. Certificates with claims changes		5502	66%	
10.	Reexam claim analysis – requester is patent owner or 3 rd party or Commissioner initiated.				
	a. Certificates – PATENT OWNER REQUESTER			3026	
	(1) All claims confirmed		646	21%	
	(2) All claims canceled		264	9%	
	(3) Claim changes		2116	70%	
	b. Certificates – 3 rd PARTY REQUESTER			5192	
	(1) All claims confirmed		1249	24%	
	(2) All claims canceled		660	13%	
	(3) Claim changes		3283	63%	
	c. Certificates – COMMISSIONER INITIATED REEXAM			157	
	(1) All claims confirmed		18	11%	
	(2) All claims canceled		36	23%	
	(3) Claim changes		103	66%	

Appendix B

FY	Description	Entries
2011	Protest - 3rd Party (before publication or with applicant's consent)	4
2010	Protest - 3rd Party (before publication or with applicant's consent)	6
2009	Protest - 3rd Party (before publication or with applicant's consent)	13
2008	Protest - 3rd Party (before publication or with applicant's consent)	5
2007	Protest - 3rd Party (before publication or with applicant's consent)	7
2006	Protest - 3rd Party (before publication or with applicant's consent)	6
2005	Protest - 3rd Party (before publication or with applicant's consent)	12
2004	Protest - 3rd Party (before publication or with applicant's consent)	31
2003	Protest - 3rd Party (before publication or with applicant's consent)	5
2001	Protest - 3rd Party (before publication or with applicant's consent)	2
2000	Protest - 3rd Party (before publication or with applicant's consent)	5
1999	Protest - 3rd Party (before publication or with applicant's consent)	7
1998	Protest - 3rd Party (before publication or with applicant's consent)	4
1997	Protest - 3rd Party (before publication or with applicant's consent)	9
1996	Protest - 3rd Party (before publication or with applicant's consent)	11