

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Boardside Chat: ***Inter Partes & Ex Parte*** **Reexamination Appeals**

Administrative Patent Judges Jeffrey B. Robertson and Rae Lynn P. Guest

Patent Trial and Appeal Board

Webinar Series (1 of 5)

February 2, 2016

UNITED STATES
PATENT AND TRADEMARK OFFICE



Boardside Chats

Date	Time	Topic	Speakers
Tuesday, April 5	Noon to 1 pm Eastern Time	Relationship between AIA, reexamination, and reissue proceedings	Judges Joni Chang and Sally Medley
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Agenda

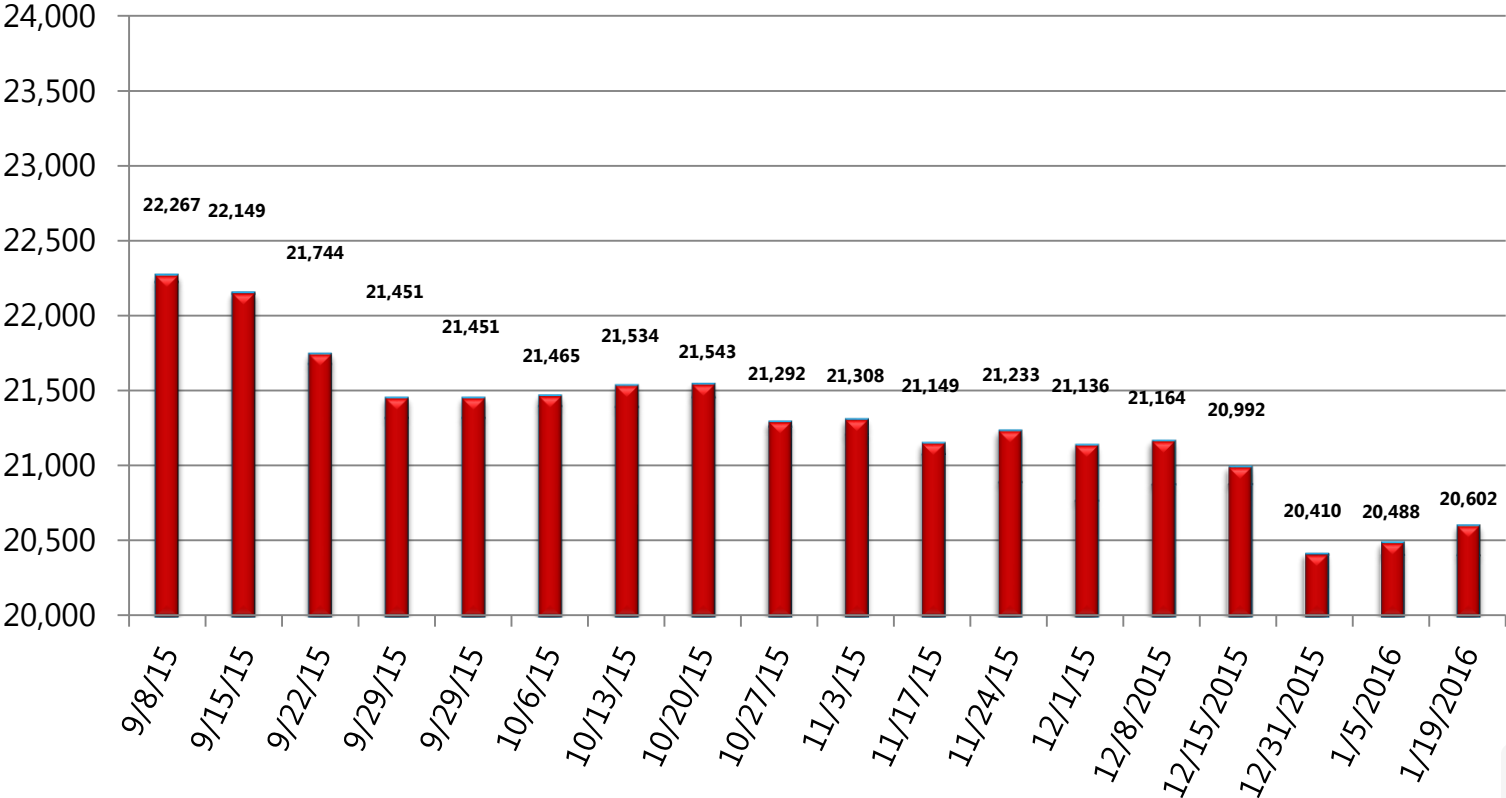
Topics	Presenter
Reexam Appeal Statistics	Lead Judge Jeff Robertson Judge Rae Lynn Guest
Reexam Process Through Appeal	
Q&A with audience	Ms. Gongola (moderator)

Reexam Appeal Statistics

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Pending *Ex Parte* Appeals Inventory (excluding appeals from reexamination proceedings)



Pendency of Ex Parte Appeals

(October 1, 2015 through present)

Technology Center	Average Months From Docketing Notice to Board Decision
1600	27.7
1700	24.5
2100	34.2
2400	37.7
2600	34.4
2800	32.6
3600	31.4
3700	32.0

Expedited Patent Appeal Pilot (EPAP)

- *Ex parte* appeal accorded special status when another *ex parte* appeal is withdrawn
- Pilot effective June 19, 2015 for up to a year
- 2 months to decide petition and 4 months from the date of petition grant to decide appeal
- Data through January 6, 2016: 22 petitions filed (20 granted and 2 denied); Average time to decide petition approximately 2 days

Small Entity Pilot Program

- Small entities with a single pending appeal may secure expedited review of that appeal
- Agree to review based on one claim
- No rejections under §112
- 2 months to decide petition and 4 months from the date of petition grant to decide appeal
- Data through January 6, 2016: 15 petitions filed (10 granted and 5 denied); Average time to decide petition approximately 11 days

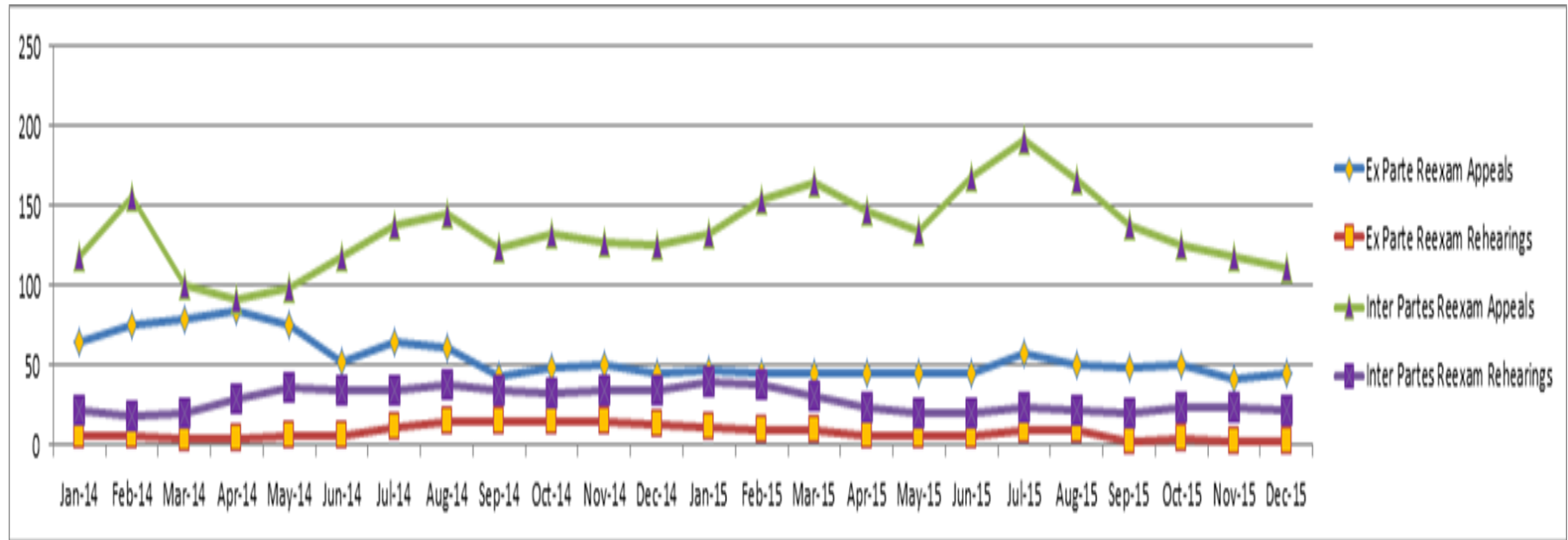
Ex Parte Reexamination Appeal Statistics

	Ex Parte Reexam FY 2012	Ex Parte Reexam FY 2013	Ex Parte Reexam FY 2014	Ex Parte Reexam FY 2015
PTAB Pendency (months)	4	6	5.65	4.75
Disposals	114	116	130	75
Inventory	66	74	57	50

***Inter Partes* Reexamination Appeal Statistics**

	Inter Partes Reexam FY 2012	Inter Partes Reexam FY 2013	Inter Partes Reexam FY 2014	Inter Partes Reexam FY 2015
PTAB Pendency (months)	5.9	6.3	5.85	6.24
Disposals	154	239	230	219
Inventory	113	134	159	157

Reexamination Appeal Inventory



Reexam Process through Appeal

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Ex Parte Reexamination (EPX)

Request for Reexamination filed by Patent Owner (PO) or Third Party Requester (TPR) (1.510)

Substantial New Question of Patentability (SNQ)? (1.515(a)) If yes, reexam ordered. If no, reexam is terminated.

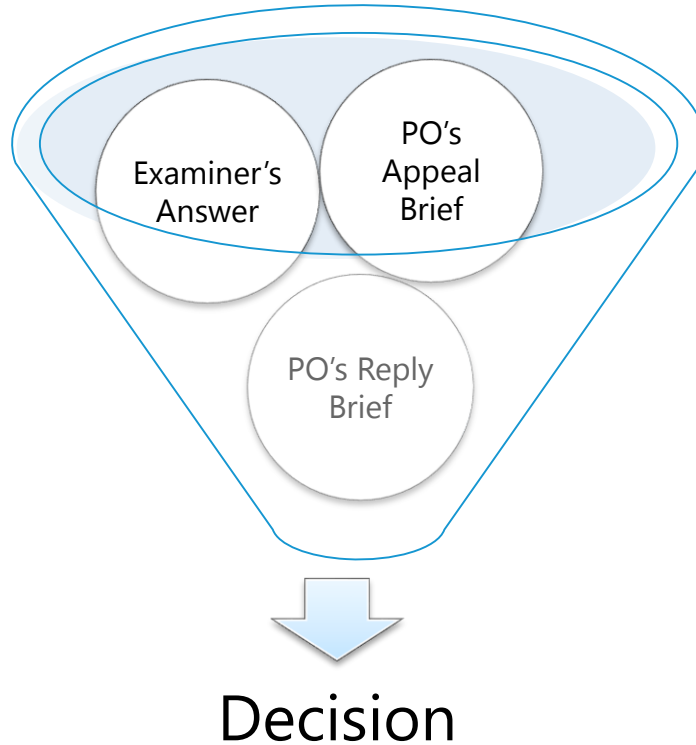
Examiner issues Office action.
If PO does not respond, a Notice of Intent to Issue a Reexamination Certificate (NIRC) is issued.

Examiner issues final rejection.
PO responds.

Examiner considers PO's response and either reopens prosecution or maintains the rejection.

Appeal (41.31)

Potential Briefs in an EPX Appeal



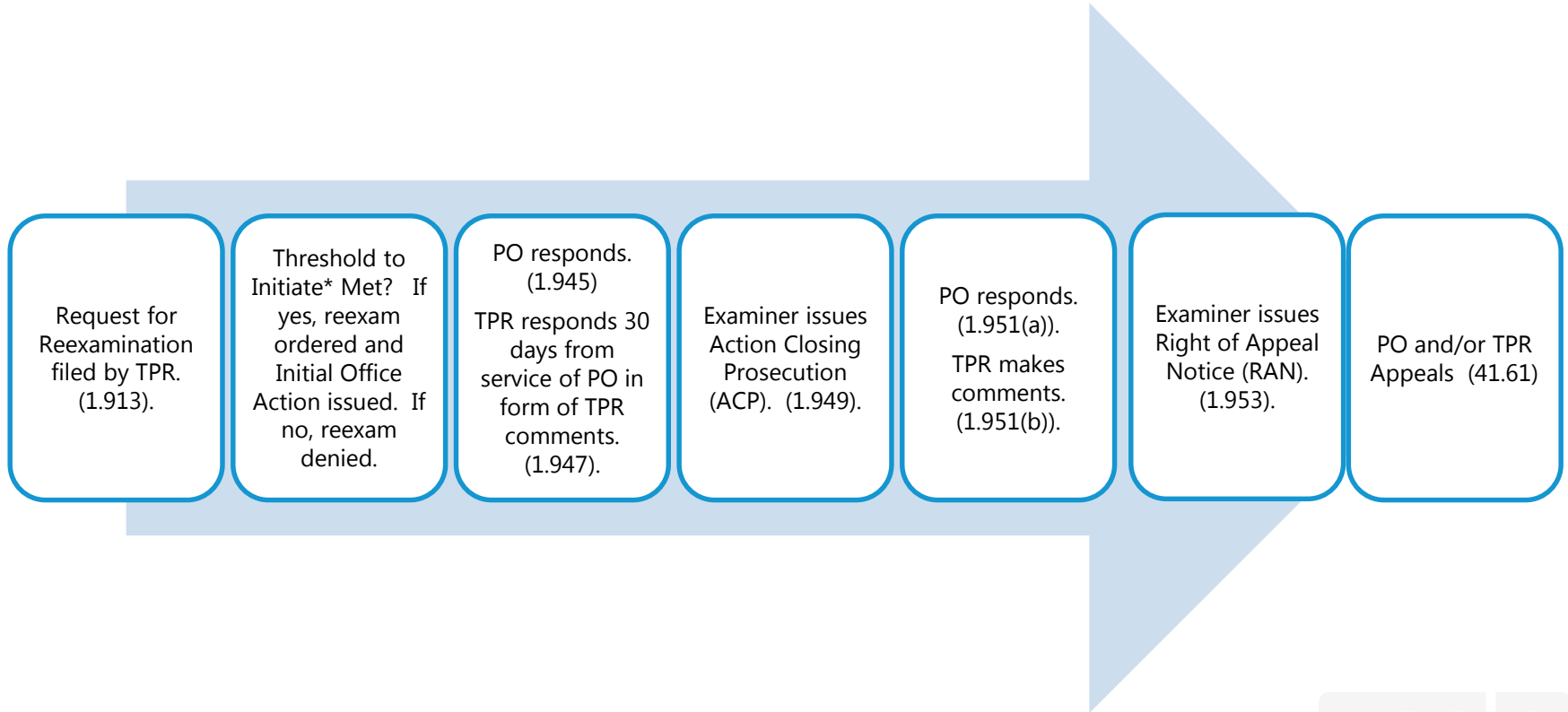
EPX Appeals are Similar to *Ex Parte* Appeals

- Only the PO has a right of appeal
- Examiner submits an Examiner's Answer in response to PO's Appeal Brief
- Appellant has 20 minutes for oral argument

Director Ordered EPX

- May be initiated by the USPTO at any time – 35 U.S.C. §303(a)
- May also be initiated as a result of PO requested Supplemental Examination – 35 U.S.C. § 257(b)

Inter Partes Reexamination (IPX)

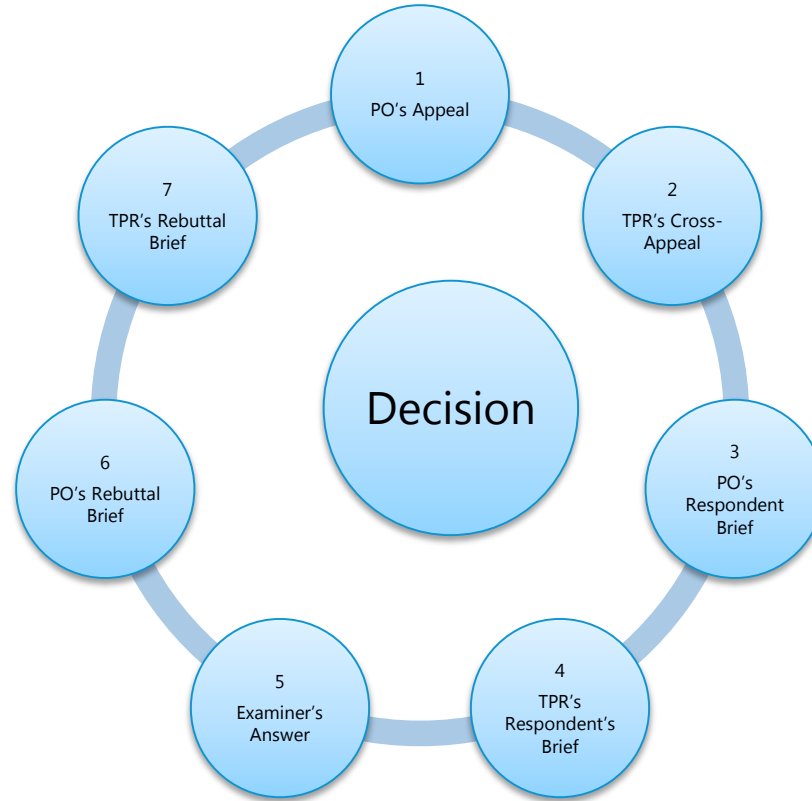


*SNQ for IPX filed before 9/16/11 – or – “a reasonable likelihood that the requester would prevail with respect to at least one of the claims challenged in the request” for IP reexaminations filed 9/16/11 to 9/15/12.

IPX Grounds for Appeals

- PO may appeal outstanding rejections that are initiated by TPR and adopted by Examiner or initiated by Examiner
- TPR may also appeal the Examiner's Decision to confirm patentability of claims by withdrawing or not adopting any of TPR's proposed rejections

Documents Considered in IPX Appeals



IPX Appeals - Oral Hearings

- Unless otherwise ordered, the Board allows:
 - **30 minutes** for **each Appellant or Respondent** that requested hearing; and
 - **20 minutes** for Examiner
- Appellants may want to reserve time for rebuttal
- For cross appeals, there are **2 different appeals**
 - Generally, both parties are still given **30 minutes**, but both parties can reserve time for rebuttal
 - Board may be flexible on time concerning the additional issues to be addressed
- No Appellants or Respondents can participate in oral hearing **unless** they:
 - requested a hearing, **and**
 - submitted the fee

IPX Appeals: New Grounds of Rejection (NGR)

- 2 types of NGR in Board opinions:
 - if the Board **reverses** the Examiner's determination **not** to make a proposed rejection, or
 - if the Board **knows** of any grounds not raised in the appeal for rejecting any pending claim, it **may** include in its opinion a statement to that effect
- Board Decision containing NGR is not final

Substantial New Question (SNQ)

- Appealable issue in *ex parte* reexaminations but not in *inter partes* reexaminations
 - Waived unless: (1) reconsideration was first requested during reexamination before the Examiner (after 6/25/2010) and (2) Patent Owner raises the issue in the Appeal Brief
- Previously cited prior art may be a basis for reexamination if the context and scope are such that the reference is being considered for a substantially different purpose. 35 U.S.C. § 303(a)
 - *See e.g., In re Swanson*, 540 F.3d 1368, 1380 (Fed. Cir. 2008) (anticipatory reference used as a secondary reference in an obviousness rejection constitutes a SNQ)

Claim Interpretation

- Prior to Expiration of the Patent - Broadest Reasonable Interpretation (BRI)
 - *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (“The ‘broadest reasonable construction’ rule applies to reexaminations as well as initial examinations.”); see also *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984)
- If Patent has Expired – the standard changes to that similar to District Court
 - *Ex Parte Papst-Mortoren*, 1 USPQ2d 1655 (BPAI 1986) (“[A] policy of liberal claim construction may properly and should be applied. Such a policy favors a construction of a patent claim that will render it valid, i.e., a narrow construction, over a broad construction that would render it invalid.”)

Amendments - Effect of Patent Expiration

- When a patent expires while undergoing reexamination, any amendments made prior to its expiration and before a Notice of Intent to Issue a Reexamination Certificate (NIRC) is mailed, are withdrawn
- Expiration can occur anytime during the reexamination process, including during appeal

Questions?

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Thank You



