

Chapter 2600: Optional Inter Partes Reexamination

2601 Introduction

2601.01 Flowcharts

2602 Citation of Prior Art

2609 Inter Partes Reexamination

2610 Request for Inter Partes Reexamination

2611 Time for Requesting Inter Partes Reexamination

2612 Persons Who May File a Request

2613 Representative of Requester

2614 Content of Request for Inter Partes Reexamination

2615 Fee for Requesting Inter Partes Reexamination

2616 Substantial New Question of Patentability/Reasonable Likelihood That Requester Will Prevail

2617 Statement in the Request Applying Prior Art

2618 Copies of Prior Art (Patents and Printed Publications)

2619 Copy of Printed Patent

2620 Certificate of Service

2622 Address of Patent Owner

2623 Withdrawal of Attorney or Agent

2624 Correspondence

2625 Untimely Paper Filed Prior to First Office Action

2626 Initial Processing of Request for Inter Partes Reexamination

2627 Incomplete Request for Inter Partes Reexamination

A. Discovery of Non-Compliance with Filing Date Requirement(s) Prior to Assigning a Filing Date

1. Notice of Failure to Comply with Reexamination Request Filing Requirements
2. Failure to Remedy Defect(s) in “Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements”

B. Non-Compliance with Filing Date Requirement(s) Discovered After Initial Issuance of Notice of Reexamination Request Filing Date

1. Decision Vacating Filing Date
2. Failure to Remedy Defect in Decision Vacating Filing Date

2629 Notice of Request for Inter Partes Reexamination in Official Gazette

2630 Constructive Notice to Patent Owner

2631 Processing of Request Corrections

2632 Public Access

2632.01 Determining If a Reexamination Request Was Filed for a Patent

2634 Fee Processing and Procedure

2635 Record Systems

2636 Assignment of Reexamination

I. EXAMINER ASSIGNMENT OF THE REEXAMINATION PROCEEDING

(A) Examiner Assignment Policy

(B) Consequences of Inadvertent Assignment to an "Original Examiner"

2638 Time Reporting

2640 Decision on Request

I. REQUEST FOR REEXAMINATION OF THE PATENT AFTER REISSUE OF THE PATENT

II. SECOND OR SUBSEQUENT REQUEST FILED DURING REEXAMINATION

2641 Time for Deciding Request

2642 Criteria for Deciding Request

I. SUBSTANTIAL NEW QUESTION OF PATENTABILITY/REASONABLE LIKELIHOOD THAT REQUESTER WILL PREVAIL

- A. For reexaminations filed prior to September 16, 2011:
- B. For reexaminations filed on or after September 16, 2011, and prior to September 16, 2012

II. POLICY AS TO SUBSTANTIAL NEW QUESTION OF PATENTABILITY IN SPECIFIC SITUATIONS

- A. Prior Favorable Decisions by the U.S. Patent and Trademark Office on the Same or Substantially Identical Prior Art in Relation to the Same Patent.
- B. Prior Adverse Decisions by the Office on the Same or Substantially Identical Prior Art in the Same Patent.
- C. Prior Adverse Reissue Application Final Decision by the Director of the Office or the Board Based Upon Grounds Other Than Patents or Printed Publications.
- D. Prior Favorable or Adverse Decisions on the Same or Substantially Identical Prior Art Patents or Printed Publications in Other Cases not Involving the Patent.

III. POLICY WHERE A FEDERAL COURT DECISION HAS BEEN ISSUED ON THE PATENT

- A. Final Holding of a Failure to Prove Invalidity by the Courts.
- B. Non-final Holding of Invalidity or Unenforceability by the Courts.
- C. Final Holding of Invalidity or Unenforceability by the Courts.

2643 Claims Considered in Deciding Request

2644 Prior Art on Which the Determination Is Based

2646 Decision Ordering Reexamination

I. PROCESS OF PREPARING THE DECISION ON THE REQUEST, AND ANY ACCOMPANYING OFFICE ACTION

II. PETITION TO VACATE THE ORDER GRANTING REEXAMINATION

III. PRIOR ART SUBMITTED AFTER THE ORDER

2647 Decision Denying Reexamination

2647.01 Examples of Decisions on Requests

2647.02 Processing of Decision

2648 Petition From Denial of Request

2654 Conduct of Inter Partes Reexamination Proceedings

2655 Who Reexamines

2656 Prior Art Patents and Printed Publications Reviewed by Examiner in Reexamination

2657 Listing of Prior Art

2658 Scope of Inter Partes Reexamination

I. PRIOR ART PATENTS OR PRINTED PUBLICATIONS, AND DOUBLE PATENTING

II. COMPLIANCE WITH 35 U.S.C. 112

III. CLAIMS IN PROCEEDING MUST NOT ENLARGE SCOPE OF THE CLAIMS OF THE PATENT

A. Criteria for Enlargement of the Scope of the Claims

B. Amendment of the Specification

C. Rejection of Claims Where There Is Enlargement

IV. OTHER MATTERS

A. Patent Under Reexamination Subject of a Prior Office or Court Decision

B. "Live" Claims That Are Reexamined During Reexamination

C. Restriction Not Proper in Reexamination

D. Ancillary Matters

E. Claiming Foreign and Domestic Priority in Reexamination

F. Correction of Inventorship

G. Affidavits in Reexamination

H. Issues Not Considered in Reexamination

I. Request for Reexamination Filed on Patent after it Has Been Reissued

2659 Res Judicata and Collateral Estoppel in Reexamination Proceedings

2660 First Office Action

I. PREPARATION AND MAILING OF FIRST OFFICE ACTION

II. TYPES OF FIRST ACTION ON THE MERITS

III. FORM AND CONTENT OF FIRST OFFICE ACTION ON THE MERITS
THAT IS NOT AN ACP

IV. PROCESS OF PREPARING THE ACTION

V. SAMPLE FIRST OFFICE ACTION

2660.02 The Title

2660.03 Dependent Claims

2661 Special Status for Action

2662 Time for Response and Comments

2664 Mailing of Office Action

2665 Extension of Time for Patent Owner Response

2666 Patent Owner Response to Office Action

I. SUBSTANCE OF THE RESPONSE

II. PROCEDURAL CONSIDERATIONS OF THE RESPONSE

III. SUPPLEMENTAL RESPONSE TO OFFICE ACTION

2666.01 Amendment by Patent Owner

2666.02 Correction of Patent Drawings

2666.03 Correction of Inventorship

2666.04 Fees for Adding Claims

2666.05 Third Party Comments After Patent Owner Response

I. TIMELINESS

II. CONTENT

III. EXAMINER WITHDRAWS A GROUND OF REJECTION

2666.06 Service of Papers

2666.10 Patent Owner Does Not Respond to Office Action

I. OFFICE ACTION PRIOR TO ACTION CLOSING PROSECUTION

II. ACTION CLOSING PROSECUTION

III. RIGHT OF APPEAL NOTICE AND APPEAL

IV. FAILURE OF THIRD PARTY REQUESTER TO TIMELY SUBMIT PAPER

2666.20 Third Party Does Not Comment After Patent Owner Response

2666.30 Submission Not Fully Responsive to Non-final Office Action

I. NO NOTIFICATION BY TELEPHONE

II. FURTHER DISCUSSION

2666.40 Patent Owner Completion of Response and Third Party Comments Thereon

2666.50 Examiner Issues Notice of Defective Paper in Inter Partes Reexamination

2666.60 Response by Patent Owner/Third Party to Notice of Defective Paper

2667 Handling of Inappropriate or Untimely Filed Papers

I. TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED

A. Filed by Patent Owner

1. Premature Response/Comments by Patent Owner
2. Response Is Too Long
3. Improper Patent Owner Response
4. Improper Petition

B. Filed by Third Party Requester

1. Premature Comments by Third Party Requester
2. Submission Is Too Long
3. Improper Comments
4. Improper Petition

C. Filed by Third Party Other Than Third Party Requester

II. TYPES OF DEFECTIVE PAPERS TO BE RETAINED IN THE "REEXAMINATION FILE"

A. Filed by Patent Owner

1. Unsigned Papers
2. No Proof of Service
3. Late Papers
4. Defective Amendment
5. Premature Appeal

B. Filed by Third Party Requester

1. Unsigned Papers
2. No Proof of Service
3. Late Papers
4. Premature Appeal

III. PAPERS LOCATED IN THE “STORAGE AREA”

2668 Petition for Entry of Late Papers for Revival of Reexamination Proceeding

- I. PETITION BASED ON UNAVOIDABLE DELAY
- II. PETITION BASED ON UNINTENTIONAL DELAY
- III. RENEWED PETITION
- IV. PETITION REQUIREMENTS

2670 Clerical Handling

2671 Examiner Action Following Response/Comments or Expiration of Time for Same

- I. RECONSIDERATION
- II. CASE IS TAKEN UP FOR ACTION
- III. OPTIONS AS TO OFFICE ACTION TO ISSUE

2671.01 Examiner Issues Action on Merits That Does Not Close Prosecution

- I. WHEN A NON-ACP ACTION IS ISSUED
- II. OVERALL CONTENT
- III. REVIEW OF AMENDATORY MATTER UNDER 35 U.S.C. 112
- IV. WITHDRAWAL OF REJECTION

- V. ISSUES NOT WITHIN SCOPE OF REEXAMINATION
- VI. COVER SHEET
- VII. SIGNATORY AUTHORITY
- VIII. CONCLUDING PARAGRAPHS
- IX. PROCESS OF PREPARING THE ACTION
- X. NO RESPONSE BY PATENT OWNER

2671.02 Examiner Issues Action Closing Prosecution (ACP)

- I. CONTENT
- II. REVIEW OF AMENDATORY MATTER UNDER 35 U.S.C. 112
- III. WITHDRAWAL OF REJECTION
- IV. ISSUES NOT WITHIN SCOPE OF REEXAMINATION
- V. COVER SHEET
- VI. SIGNATORY AUTHORITY
- VII. CONCLUDING PARAGRAPHS
- VIII. PROCESS OF PREPARING THE ACTION
- IX. WHERE PATENT OWNER FAILS TO RESPOND AND CLAIMS HAVE BEEN FOUND PATENTABLE
- X. ART CITED BY PATENT OWNER DURING PROSECUTION

2671.03 Panel Review

- I. MAKE-UP OF THE PANEL
- II. PANEL PROCESS
- III. WHAT THE CONFERENCES SHOULD ACCOMPLISH
- IV. CONSEQUENCES OF FAILURE TO HOLD CONFERENCE

2672 Patent Owner Comments/Amendment After ACP and Third Party Requester Responsive Comments

- I. ONE OPPORTUNITY TO MAKE SUBMISSIONS UNDER 37 CFR 1.951(a) AND (b)

- II. TIME FOR MAKING PATENT OWNER SUBMISSION UNDER 37 CFR 1.951(a)
- III. PATENT OWNER MAKES SUBMISSION AFTER ACP; LIMITATION ON PATENT OWNER'S SUBMISSION
- IV. PATENT OWNER MAKES SUBMISSION AFTER ACP; THIRD PARTY REQUESTER COMMENTS ARE LIMITED
- V. PATENT OWNER DOES NOT MAKE SUBMISSION AFTER ACP
- VI. ACTION CLOSING PROSECUTION - PREMATURE

2673 Examiner Consideration of Submissions After ACP and Further Action

- I. WHEN THE CASE IS TAKEN UP FOR ACTION
- II. OPTIONS AS TO WHICH ACTION TO ISSUE
- III. ACTION TAKEN BY EXAMINER

2673.01 Reopening Prosecution After ACP

- I. MANDATORY REOPENING
- II. DISCRETIONARY REOPENING

2673.02 Examiner Issues Right of Appeal Notice (RAN)

- I. EXAMINER NEVER ISSUES A NIRC AFTER ACP
- II. EXPEDITED RIGHT OF APPEAL NOTICE
- III. PANEL REVIEW CONFERENCE

2674 Appeal in Inter Partes Reexamination

2674.01 Cross Appeal After Original Appeal

2675 Appellant Brief

2675.01 Respondent Brief

2675.02 Informalities in One or More of the Briefs

2676 Appeal Conference

2677 Examiner's Answer

- I. REQUIREMENTS FOR EXAMINER'S ANSWER

II. PROCESSING OF COMPLETED ANSWER

2678 Rebuttal Briefs

2679 Office Treatment of Rebuttal Brief

2680 Oral Hearing

2681 Board Decision

I. BOARD DECISION MAY CONTAIN NEW GROUND OF REJECTION

II. NON-FINAL BOARD DECISIONS

III. NO BOARD RECOMMENDATION OF AMENDMENT TO MAKE CLAIM
PATENTABLE

IV. REVIEW OF BOARD DECISION BY PETITION

V. PUBLICATION OF BOARD DECISIONS

2682 Action Following Decision

I. NO NEW GROUNDS: THE BOARD AFFIRMS, REVERSES A REJECTION, OR
AFFIRMS-IN-PART (AND REVERSES ONLY AS TO REJECTION(S))

A. No Action Taken by Parties to the Appeal

B. A Request for Rehearing of the Decision

II. NEW GROUND OF REJECTION BY BOARD

A. Proceeding under 37 CFR 41.77(b)(2): Requesting Rehearing of the Decision
Which Includes a New Ground of Rejection

B. Proceeding under 37 CFR 41.77(b)(1): Requesting Reopening of Prosecution
and Submission of Amendment or Showing of Facts After Decision Which
Includes a New Ground of Rejection

1. Patent Owner's Submission under 37 CFR 41.77(b)(1)

2. Third Party Requester Comments under 37 CFR 41.77(c)

3. Examiner's Determination under 37 CFR 41.77(d)

4. Comments under 37 CFR 41.77(e)

C. No submission under 37 CFR 41.77(b)(1) or (2)

III. REMAND BY BOARD

A. Reopening Prosecution of Case

2683 Appeal to Courts

I. APPEAL TO UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT IS AVAILABLE

A. For Any Inter Partes Reexamination Proceeding "Commenced" on or After November 2, 2002

1. Appeal to the Federal Circuit
2. Cross Appeal
3. Participation in Other Party's Appeal

B. For Any Inter Partes Reexamination Proceeding "Commenced" Prior to November 2, 2002

II. APPEAL TO U.S. DISTRICT COURT IS NOT AVAILABLE

2684 Information Material to Patentability in Reexamination Proceeding

2685 No Interviews on Merits in Inter Partes Reexamination Proceedings

2686 Notification of Existence of Prior or Concurrent Proceedings and Decisions Thereon

2686.01 Multiple Copending Reexamination Proceedings

I. WHEN PROCEEDINGS ARE MERGED

II. WHEN PROCEEDING IS SUSPENDED

III. MERGER OF REEXAMINATIONS

A. The Prosecution Stage, After Merger

IV. PROCEEDINGS NOT MERGED

V. FEES IN MERGED PROCEEDINGS

VI. PETITION TO MERGE MULTIPLE COPENDING REEXAMINATION PROCEEDINGS

2686.02 Copending Reexamination and Interference Proceedings

I. ATTEMPTING TO PROVOKE AN INTERFERENCE WITH A PATENT INVOLVED IN A REEXAMINATION PROCEEDING

II. MOTION TO SUSPEND INTERFERENCE UNDER 37 CFR 41.121(a)(3)
PENDING THE OUTCOME OF A REEXAMINATION PROCEEDING

III. REQUEST FOR REEXAMINATION FILED DURING INTERFERENCE

IV. PETITION TO STAY REEXAMINATION PROCEEDING BECAUSE OF
INTERFERENCE

V. ACTION IN INTERFERENCE FOLLOWING REEXAMINATION

2686.03 Copending Reexamination and Reissue Proceedings

I. TIME FOR MAKING DECISION ON MERGING OR STAYING THE
PROCEEDINGS

II. CONSIDERATIONS IN DECIDING WHETHER TO MERGE THE REISSUE
AND REEXAMINATION OR WHETHER TO STAY ONE OF THEM

A. Reissue About To Issue, Reexamination Requested

B. Reissue Pending, Reexamination Request Filed

C. Reexamination Proceedings Underway, Reissue Application Filed

D. Examiner Assignment

III. CONDUCT OF MERGED REISSUE AND REEXAMINATION PROCEEDING

IV. *INTER PARTES* REEXAMINATION, *EX PARTE* REEXAMINATION, AND
REISSUE APPLICATION FOR THE SAME PATENT

V. PETITION TO MERGE REISSUE APPLICATION AND *INTER PARTES*
REEXAMINATION PROCEEDING OR TO STAY EITHER OF THE TWO
BECAUSE OF THE EXISTENCE OF THE OTHER

VI. FEES IN MERGED PROCEEDINGS

VII. INTERVIEWS IN MERGED PROCEEDINGS

VIII. EXAMINER'S AMENDMENT TO PLACE PROCEEDING IN CONDITION
FOR ALLOWANCE IN MERGED REISSUE/*INTER PARTES* REEXAMINATION

2686.04 Reexamination and Litigation Proceedings

I. COURT-ORDERED/SANCTIONED REEXAMINATION PROCEEDING,
LITIGATION STAYED FOR REEXAMINATION, OR EXTENDED PENDENCY
OF REEXAMINATION PROCEEDING CONCURRENT WITH LITIGATION

II. FEDERAL COURT DECISION KNOWN TO EXAMINER AT THE TIME THE DETERMINATION ON THE REQUEST FOR REEXAMINATION IS MADE

III. REEXAMINATION WITH CONCURRENT LITIGATION BUT ORDERED PRIOR TO FEDERAL COURT DECISION

IV. FEDERAL COURT DECISION ISSUES AFTER *INTER PARTES* REEXAMINATION ORDERED

V. DISCUSSION OF EFFECT OF LITIGATION WHERE REQUESTER WAS A PARTY TO THE LITIGATION

VI. LITIGATION REVIEW AND CRU APPROVAL

2686.05 Reexamination and Inter Partes Review Proceedings, Post-Grant Review, and Covered Business Method Patent Review

2687 Notice of Intent to Issue Inter Partes Reexamination Certificate (NIRC) and Conclusion of Reexamination Proceeding

I. INSTANCES WHERE A NIRC WOULD BE APPROPRIATE

II. PREPARATION OF THE NIRC ACTION

A. No Allowed Claims

B. At Least One Allowed Claim

III. EXAMINER'S AMENDMENT TO PLACE PROCEEDING IN CONDITION FOR NOTICE OF INTENT TO ISSUE *INTER PARTES* REEXAMINATION CERTIFICATE

IV. REASONS FOR PATENTABILITY AND/OR CONFIRMATION

V. PREPARATION OF THE CASE FOR PUBLICATION

VI. REEXAMINATION REMINDERS

A. Handling of Multiple Dependent Claims

B. The Title of the Patent

VII. REEXAMINATION PROCEEDINGS IN WHICH ALL THE CLAIMS ARE CANCELED

2687.01 Examiner Consideration of Submissions After NIRC

2688 Issuance of Inter Partes Reexamination Certificate

2689 Reexamination Review

- 2690 Format of Inter Partes Reexamination Certificate
- 2691 Notice of Inter Partes Reexamination Certificate Issuance in Official Gazette
- 2692 Distribution of Certificate
- 2693 Intervening Rights
- 2694 Concluded Reexamination Proceedings
- 2695 Reexamination of a Reexamination
- 2696 USPTO Forms To Be Used in Inter Partes Reexamination