Reissue and Reexamination Strategies and Tactics
with Concurrent Litigation
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CASE STUDIES OF INTER PARTES REEXAMINATION PROCEEDINGS

Eugene T. Perez
Birch, Stewart, Kolasch & Birch, LLP
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Introduction

Compared to an *ex parte* reexamination procedure, an *inter partes* reexamination proceeding provides a third party requester (hereinafter referred to as “TPR”) with a greater opportunity to participate, while maintaining most of the features which make reexamination a desirable alternative to litigation in the Federal Courts.

The *inter partes* reexamination starts with the filing of a request for reexamination, wherein the request must set forth the facts relevant to the reexamination, primarily facts pertaining to the application of the new prior art to the claims for which reexamination is requested. Typically, should the United States Patent & Trademark Office (“USPTO”) grant the *inter partes* reexamination, a first Office Action issues. With certain timelines, the patent owner files a response to the Office Action and the TPR can respond to any response filed by the patent owner.

However, mistakes are made by both the patent owner and TPR during the course of the *inter partes* reexamination proceeding. In fact, mistakes can be made at any stage of the *inter partes* reexamination proceeding (i.e., initial requirements for filing the request for *inter partes* reexamination all the way to appeal). Certain *inter partes* reexamination proceedings are discussed below that highlight such mistakes, with suggestions on how to avoid such problems in the future.
Errors In Proposing a Substantial New Question of Patentability

The request for *inter partes* reexamination must include the appropriate fee and the several items recited in 37 Code of Federal Regulations Patents, Trademarks, and Copyrights (“C.F.R.”) § 1.915(b). One such requirement is a statement pointing out each “substantial new question of patentability” (SNQ of patentability) based on the cited patents and printed publications to every claim for which reexamination is requested.²

A SNQ of patentability is defined as a reasonable examiner would consider the prior art important in deciding whether or not the claim is patentable.³ This is a lower standard than a *prima facie* of unpatentability.

As stated in 37 C.F.R. § 915(b)(3), the TPR must also provide a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested (emphasis added). For a proposed

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¹ 37 C.F.R. § 1.20(c)(2) (currently $8,800); see also 37 C.F.R. § 1.915(a) and Manual of Patent Examining Procedure (M.P.E.P.) § 2610.

² 37 C.F.R. 1.915(b)(3).

³ M.P.E.P. § 2642.
rejection for obviousness, TPR must provide at least one basis for combining the cited references, and a statement of why the claim(s) under reexamination would have been obvious over the proposed reference combination.

Still, a reexamination request relying on previously applied prior art that asks the Office to look at the art again based solely on the Supreme Court’s clarification of the legal standard for determining obviousness under 35 United States Code (“U.S.C.”) § 103(a) in KSR International Co. v Teleflex Inc., without presenting the art in new light or different way, will not raise a substantial new question of patentability as to the patent claims. Still, a request may properly raise a substantial new question of patentability by raising a material, new analysis of a previously considered reference(s) under the rationales set forth in KSR.

In providing a “detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested,” the TPR can provide some teaching, suggestion or motivation as a basis for combining two cited references.

6 See M.P.E.P. § 2616.
7 Several rationales are set forth in KSR Int’l; see also M.P.E.P. § 2173.
8 See M.P.E.P. § 2616.
In Reexamination Control No. 95/000,103, the TPR proposed the following rejection for obviousness:

(i) Reexamination is requested of claims 1-3 and 5-8 of Chang in view of U.S. Patent Nos. 6,678,892 ("Lavelle"); 4,983,951 ("Igarashi"); and Japanese Pub. No. 2001047921 ("Yamaoka").

A claims chart was also provided that compared the features of the disputed patent claims with the Lavelle, Igarashi and Yamaoka references. Then, the TPR states:

III. Statement Pointing Out Each Substantial New Question Of Patentability

There are 9 claims in Chang. Claims 1 and 5 are independent, claims 2-4 and 6-9 depending from claims 1 and 5, respectively. All the elements of claims 1 and 5 of Chang are shown or are inherently shown by Lavelle in view of Igarashi and further in view of Yamaoka. Therefore, claims 1 and 5 are rendered obvious by Lavelle in view of Igarashi and Yamaoka. Each of the dependent claims 2-3 and 6-8 are also shown to have been disclosed by Lavelle in view of Igarashi and Yamaoka.

Accordingly, a substantial new question of patentability based on Lavelle in view of Igarashi and further in view of Yamaoka exists for each of claims 1-3 and 5-8.

The following is the subsequent Action Closing Prosecution, wherein the rejection was not adopted:
The Examiner did not adopt the TPR’s proposed rejection as since the TPR inadequately explained how the prior art met the claimed limitations:
A) REASON #1

The third party requester alleges that claim 1 of the Chang patent is rendered obvious by the combined showing of Lavelle et al. [U.S. Patent #6,678,892], Igarashi [U.S. Patent #4,983,951], and Kamoaka [JP #2001-047921] for the reasons set forth in the claim chart that appears on pages 2-6 of the request. However, when one reviews this claim chart, one finds that the requester never explains how each and every limitation of claim 1 might be met by the combined teachings/showings of this prior art. For example, the Requester clearly indicates that element 122 of Figures 1A and 1B in Lavelle et al. is relied on for the showing of the recited “radio,” and that element 128 (or 130) of Figures 1A and 1B in Lavelle et al is relied on for the showing of the recited “first wireless transmitter.” However, the claim chart fails to address where the applied prior art shows or suggests using the “radio” of Lavelle et al. (122) to receive the audio signals that are transmitted from the “first wireless transmitter” (128/130). Specifically, as described in Lavelle et al, it appears that the “radio” (122) is a selectable source of the audio signaling that is transmitted to a plurality of headphones (152 and 154) via the “first wireless transmitter” (128/130) and, more specifically, that Lavelle et al never shows or suggests using the “radio” to receive the audio signaling that is transmitted from “first wireless transmitter.”
Another reason the USPTO did not adopt the TPR’s rejection was due to the lack of a statement of motivation to combine the references:

Thus, the TPR did not provide a detailed explanation accounting for all claimed features, and fails to provide sufficient motivation, or some other KSR rationale, for combining Lavelle, Igarashi and Yamaoka. The TPR should not simply rely on a claims chart in the request for inter partes reexamination.

Other Errors in Providing a SNQ of Patentability

The following are examples of inappropriate language in proposing a rejection in a request for inter partes reexamination⁹:

• Claim 1 is unpatentable under 35 U.S.C. § 102(b) as being

⁹ See also M.P.E.P. § 2617(I).
anticipated by, or in the alternative, under 35 U.S.C. § 103 as being obvious over the Smith reference.

- Claim 1 is unpatentable under 35 U.S.C. § 103 as being obvious over Smith and/or Charles.

(Emphasis added.)

The TPR inadequately setting forth a SNQ of patentability for each claim in Reexamination Control No. 95/001,001:

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Claim 36 of the '902 patent is obvious under 35 U.S.C. 103(a) over Focsaneanu '910 in view of Farese '685 and Jonas '792 or Arango '078;"

The request asserts that there are 39 substantial new questions of patentability (see pages 19–24). Requester has provided (see pages 20–24) 33 distinct proposed obviousness (103) rejections without a corresponding detailed explanation. For example, for Claim 68 alone, Requester is proposing to combine seven references:

“Claim 68 of the '902 patent is obvious under 35 U.S.C. 103(a) over Focsaneanu '910 in view of Jonas '792 or Arango '078 or Farese '685 or Matsukawa '411 or Yoshida '516 and Lucent”

While the corresponding claim chart provides (see pages 369–414) an exemplary job of explaining each reference separately the request fails to explain how each reference is combined with each of the above references presented for claim 68 which requester desires the Office to look at.

Extensions of Time Are Not Automatic

The provisions of 37 CFR §§ 1.136(a) and 1.136(b) are not applicable to inter partes reexamination proceedings under any circumstances. Thus, extensions of time are not automatic, and instead must be requested ahead of the due date in the form of a
petition (along with the appropriate fee – currently $200).

A request for a first month extension of time requires “sufficient cause”. In no case, will the mere filing of a request for extension of time automatically effect any extension, because the showing of cause may be insufficient or incomplete.

Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in “extraordinary situations”.

Possible reasons for requesting extension of time:

- Length of Office Action (e.g., multiple grounds of rejections), including number of references cited;
- Location of Patent Owner (e.g., abroad);
- Availability of attorney(s), inventors, declarants, in-house counsel;
- Consultation among inventors or experts needed to prepare possible Rule 131/132 Declarations;
- More experimental testing needed; and
- A comparison of the receipt date versus mailing date of Office Action shows a longer than expected delay.

A two month extension of time was granted in Reexamination Control No. 95/000,153, wherein a part of the September 28, 2007 Decision is reproduced below:

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10 M.P.E.P. § 2665.
Patent Owner's Showing of Sufficient Cause to Grant an Extension of Time

The petition for extension of time states that the various legal and technical personnel associated with Patent Owner and Licensee and conducted the first of several teleconferences discussing the issues raised in the ACP. In view of the complexity of these issues, an in-person meeting has been scheduled to maximize access to technical expertise and information. Patent Owner and Licensee are considering the necessity of conducting additional testing in response to the position taken by the examiner that would likely take at least two months. An extension of time of two months is requested to fully analyze the complex issues and develop responsive positions on behalf of the Patent Owner.

On balance, it is considered that the petition explains the “sufficient cause” for an extension of time. It is clear that the Office action is substantial and that Patent Owner requires consultation with technical personnel and Patent Owner to prepare a complete response. Patent Owner has set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period. When balanced against the requirement of 35 USC 314(c) that this proceeding be handled with special dispatch, Owner’s showing is adequate to justify the grant of a two-month extension of time in which to file a response to the outstanding Office action. Accordingly, the period of time for filing a reply to the Office action dated September 5, 2007 is extended to run three months from the date of the Office action and is due on December 5, 2007. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

The Page/Word Limits on Responses & Briefs

Whether responding to the first Office Action or the Action Closing Prosecution, 37 C.F.R. §1.943(b) sets for a 50-page limit on responses by either the patent owner or TPR.

There is also a limit of thirty pages or 14,000 words when filing an appellant brief, and a limit of fifteen page or 7,000 words when
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filing all other types of briefs.\(^{11}\)

Furthermore, any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 C.F.R. §1.943.\(^{12}\)

Affidavits or declarations that are excluded from the page limit requirements include:

- declarations attempting to swear behind (antedate) the filing date of a reference;
- declaration establishing the date of a printed publication; and
- declarations that provide comparative test data and an analysis of same.\(^{13}\)

Also, if the patent owner’s or TPR’s affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome/supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included as a part of the page limit.

\(^{11}\) 37 C.F.R. §1.943(c).

\(^{12}\) M.P.E.P. § 2667.

\(^{13}\) M.P.E.P. § 2667.
Finally, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome.

**Provisions of 37 C.F.R. § 1.116**

Subsequent to the first Office Action and upon a determination by the patent examiner that the issues have been “clearly developed”, the Examiner may issue an Action Closing Prosecution (“ACP”) which severely limits further attempts by the patent owner to introduce any additional changes to the patent claims or evidence supporting patentability.\(^{14}\)

After the ACP issues, the patent owner may once file written comments and/or present a proposed amendment to the claims within the time period set in the ACP.\(^{15}\) Normally, the ACP will set a period of 30 days or one month (whichever is longer) from the mailing date of the ACP. Where the patent owner files comments and/or a proposed amendment, the third party requester may once file comments responsive to the patent owner’s submission within 30 days from the date of service of the patent owner’s submission on the third party requester.\(^{16}\)

\(^{14}\) 37 C.F.R. § 1.949.

\(^{15}\) 37 C.F.R. § 1.951(a).

\(^{16}\) 37 C.F.R. § 1.951(b).
Upon issuance of the ACP, a Notice of Appeal ("NOA") cannot be filed by either party at this point. After receiving any additional comments from the patent owner, and any additional optional comments from the third party requester, the patent examiner may then issue a “Right of Appeal Notice” (or “RAN”) which then allows either party to appeal the reexamination.  

37 C.F.R. §§ 1.949 and 1.951 and M.P.E.P. § 2672 set the standard for the patent owner’s option after an ACP issues. As stated in 37 C.F.R. § 1.951(a) and M.P.E.P. § 2672, any amendment as proposed by the patent owner is governed by the strict criteria of 37 C.F.R. § 1.116 ("Rule 116") as to whether or not such amendment should be admitted. Rule 116, subsection (b)(1)-(3), allows entry of a proposed amendment only when:

- an amendment is made to cancel claims or to comply with any requirement of form expressly set forth in previous Office Action;
- (2) an amendment presenting rejected claims in better form for consideration on appeal that may be admitted; or
- (3) an amendment touching the merits of the application or patent under reexamination may be admitted based on a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

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Thus, the patent owner has limited options once the ACP issues. Any substantive changes to the claims will likely result in the in the filed Amendment not being entered.

In Reexamination Control No. 95/000,138, the patent owner filed an amendment (on March 29, 2007) after the ACP (dated January 26, 2007) that was not entered. In the Amendment after the ACP, the independent claims were amended, and some claims were and some were added. However, the patent owner overall presented additional claims without canceling a corresponding number of finally rejected claims. Further, the newly incorporated subject matter in the independent claims originated from the specification and not from an existing dependent claims. Thus, as indicated in the RAN of November 29, 2007, the Amendment after ACP was not entered since it raised “new issues” and increased the number of claims. The claims on appeal are those as pending before issuance of the ACP.

**Petitions**

There are three types of petitions as provided for in 37 C.F.R. §§ 1.181-183. Each type of petition serves a different purpose.
(A) Rule 181 Petition

Regarding a Rule 181 petition, there are two types: (1) a premature ACP invoking supervisory authority of the USPTO Director; and (2) denial of entry of amendments filed in response to an ACP.¹⁸

Regarding the first type of Rule 181 petition (a premature ACP invoking supervisory authority of the USPTO Director), a typical situation is where an ACP has issued, and then the patent owner files an amendment wherein the claims are amended to address the ground(s) of prior art rejection(s). Thereafter, the RAN indicates whether or not the claim amendments are entered for purposes of appeal. If the claim amendments are not entered, the patent owner may file a Rule 181 petition to request entry. However, many of these petitions are dismissed.¹⁹

Still, a Rule 181 petition to reopen prosecution was granted in Reexamination Control No. 95/000,153 (see USPTO decision dated December 10, 2008). This was because the Examiner in the RAN included a rejection of a claim that was not included in the ACP. Thus, the Examiner essentially made a new rejection in the RAN, which the USPTO found the ACP as being premature since the patent owner has had no opportunity to respond to the new rejection.

¹⁸ M.P.E.P. § 2672(VI) and § 2673.02.

¹⁹ See, e.g., Reexamination Control Nos. 95/000,010, 95/000,020, 95/000,025, 95/000,070 and 95/000,071.
Note that 37 C.F.R. § 182(f) indicates a two month window to file the Rule 181 petition (from the mailing date of the RAN, wherein this time period is not extendable. The TPR can respond to any filed petition within 30 days of date of service. Also, filing a petition does not toll the time period for filing a notice of appeal of cross appeal.

Regarding the second type of Rule 181 petition (denial of entry of amendments filed in response to an ACP), this type of petition is relatively rare. This type of petition was filed and dismissed in Reexamination Control No. 95/000,043.

(B) Rule 183 Petition

A Rule 183 petition can be used to waive a rule specific in 37 C.F.R. It is worth noting that as stated in M.P.E.P. § 2673.02, when a Rule 181 petition is filed, the USPTO encourages that a Rule 183 petition be also filed to request waiver of the prohibition of an extension of time for filing an appeal brief. In effect, the petitioner is requesting that the due date for filing the appeal brief be tolled.

As an example of a rule to be waived, and as mentioned, a response to a first Office Action or to the ACP cannot exceed 50
pages in length (but excludes claims and references). Pat
ten Owner appellant briefs are not to exceed 30 pages or 14,000
words. A Rule 183 petition can be filed to waive these such
page/word limits.

For instance, in Reexamination Control No. 95/000,020, the patent
owner petitioned (on February 23, 2007) to waive the provisions of
37 C.F.R. § 1.943(c) to exceed the page/word limit for filing an
appellant brief:

Patent Owner, NTP, Inc., ("Patent Owner") by and through the undersigned counsel,
hereto petitions the Commissioner of Patents and Trademarks to suspend the page and word
count limitations imposed by 37 C.F.R. § 1.943 and grant Patent Owner leave to submit an
Appeal Brief that fully and completely addresses each of the allegations and rejections presented
by the Patent Office in its Action Closing Prosecution and Right of Appeal. Alternatively, if

The USPTO granted the Rule 183 petition in a decision dated
March 9, 2007. The decision gave a page limit for the appellant’s
brief to not exceed 60 pages or 28,000 words in length:

1. The petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) is granted to the extent that
the page limit for the appellant’s brief is extended to not exceed 60 pages or 28,000 words in
length.

20 37 C.F.R. § 1.943(b).

21 37 C.F.R. § 1.943(c).
In Reexam. Control No. 95/000,071, the Patent Owner filed a Rule 183 petition to waive the rules of 37 CFR § 111(a)(2). In effect, the Patent Owner wanted entry of the response after the ACP issued, wherein 50 new claims were added, and reopening of prosecution. However, the USPTO dismissed the Petition.

(C) Rule 182 Petition

As the third type of petition, a Rule 182 petition is used for “questions not specifically provided for. For instance, a Rule 182 petition can be used by the patent owner to reopen prosecution.

When the RAN issues, the patent owner can appeal, but has no right to reopen prosecution by filing a Request for Continued Examination (“RCE”), since the provisions of 37 C.F.R. § 1.114 apply to an “application” and not a “patent. However, the provisions of 1292 Off. Gaz. Pat. Office 20 (Official Gazette dated March 1, 2005) allows for Request for Continued Reexamination practice (like RCE for normal prosecution):

“It is noted that, as a consequence of the changes made to MPEP 2240, a patent owner will now be prevented from obtaining entry of an amendment and/or evidence not entered after final rejection in an ex parte reexamination proceeding by filing another request for reexamination based on the same substantial question of patentability raised/existing in the pending
reexamination proceeding. In order to provide relief to the patent owner, the Office plans to propose a revision to the patent rules to provide for the filing of a request for continued reexamination (RCR) which would be similar to the request for continued examination (RCE) practice for applications. If the RCR practice is implemented, the patent owner, by filing an RCR, could obtain continued prosecution on the merits in the reexamination proceeding, including entry of an amendment and/or evidence that was denied entry after a final rejection in an ex parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding. Until these new rules become effective, however, patent owners are advised to use either: (1) the petition procedure under 37 CFR 1.181 to seek review of a denial of entry of an amendment submitted after final rejection in an ex parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding; or (2) the petition procedure under 37 CFR 1.182 to seek relief that is not currently provided by an existing rule, but that would be provided when a new request for continued reexamination (RCR) practice is in effect.” (Emphasis added.)

Thus, a Rule 182 petition for RCR can be filed to reopen prosecution of the reexamined patent. However, remember that
this is a petition that needs a decision from the USPTO. Further, simply filing the Petition does not toll the time period for filing a response to an outstanding Office Action.