Reexaminations & Reissues

Complimentary to our *inter partes* review practice, Perkins Coie is also highly experienced in the use of reissues and *ex parte reexams*. As a patent owner being challenged with an IPR, the filing of a reissue patent application can be a significant strategic advantage. Moreover, on the petitioner side where an IPR may be barred for a variety of reasons, the use of the *ex parte reexam* may still apply pressure to the patent owner. In either case, Perkins Coie has filed hundreds of reissue patent applications and *ex parte reexams* on behalf of clients.

**Supplemental Reexamination**

Once a patent is issued, its owner can file a request for supplemental examination to amend the patent’s claims by identifying one or more possible substantial new questions of patentability on any grounds. This new procedure under the AIA is intended to help immunize the patent holder against inequitable conduct claims as well as to allow issues to be considered by the USPTO beyond the patent or printed publication references.

The Central Reexamination Unit (CRU) reviews all requests for supplemental examination and determines within three months of filing whether there are any actual substantial new questions of patentability among those the patent holder has identified. If such new questions are found, an *ex parte* reexamination is ordered on them.

**Ex Parte Reexamination**

Unlike the other post-grant procedures, *ex parte* reexamination is not new under the AIA and has remained largely unchanged since it was instituted in 1981. It is available to both the patent holder and a third-party petitioner—who can remain anonymous—and can be filed at any time after a patent has been issued.

This post-grant procedure can be attractive to patent holders who want to obtain a presumption of validity over patent or printed publication references that come to light after a patent is issued. For third parties, *ex parte* reexamination can be beneficial because it allows for the challenge of a patent without incurring any of the estoppel penalties that apply for other post-grant proceedings established by the AIA.

To amend the patent or show invalidity, the patent holder or petitioner must show that there is a substantial new question of patentability. However, the only grounds allowed to amend or show invalidity are anticipation or obviousness, and prior art usage is limited to patents and publications. There is also no discovery allowed.

The Central Reexamination Unit (CRU) of the USPTO reviews all requests for *ex parte* reexamination. Only the patent holder may appeal the CRU's decision to the PTAB, and only negative PTAB decisions can be appealed to the Federal Circuit.

**Reissue**

Similar to the supplemental examination, a patent holder can apply for reissue to amend a patent’s claims but only if the basis for the amendment is that an error in the original application renders the patent either partly or wholly invalid or inoperative. Like *ex parte* reexamination, reissue is not new under the AIA.

Examples of such errors can include claims that were too broad or too narrow, claims that failed to use a particular claim type or that failed to claim a disclosed subject matter. The reissue application can use any prior art references and must identify how any errors will be addressed, either by amendment or presentation of new claims. Any application for reissue that broadens the claims must be filed within two years of the original issuance.
The amended claims are examined in the same manner as any other patent application except that the recapture doctrine may apply and inventors must sign a reissue declaration. Appeals, continuations and divisionals can all be filed in the same manner as any other patent application, and estoppel does not apply.

NEWS

07.03.2019
*Nate Kelley Quoted in The National Law Journal - Patent Lawsuits Up in 2019; PTAB Filings Down*

General News
The National Law Journal
Nate Kelley was quoted in *The National Law Journal* article, "Patent Lawsuits Up in 2019; PTAB Filings Down," regarding PTAB’s increasing reluctance to hold trials on patent validity challenges.

06.21.2019
*IAM Recognizes 33 Perkins Coie Attorneys as Top IP Practitioners and Names Firm a U.S. Litigation Leader*

Press Releases
Perkins Coie is pleased to announce that the firm and 33 of its intellectual property attorneys were recognized by *Intellectual Asset Management* in the IAM Patent 1000 list for 2019, which recognizes the world’s leading patent professionals who are the best in class in patent prosecution, licensing and litigation.

06.20.2019
*Gene Lee Mentioned in Law360 - PTAB Axes 2 Card Game Patents Under Alice*

General News
Law360
Partner Gene Lee was mentioned in the *Law360* article, "PTAB Axes 2 Card Game Patents Under Alice," regarding his representation of Bally when the Patent Trial and Appeal Board invalidated two card game patents at the center of a licensing dispute between Bally and another casino game maker.

06.18.2019
*Managing Intellectual Property Recognizes 26 Perkins Coie Attorneys as IP Stars and Two as Top 250 Women in IP*

Press Releases
Perkins Coie is pleased to announce that the firm and 26 of its intellectual property attorneys were recognized in *Managing Intellectual Property*'s (MIP) 2019 IP Stars list. Additionally, two women partners, Shannon Bloodworth, Firmwide Co-Chair of the Intellectual Property practice, and Grace Han Stanton again landed on the MIP Top 250 Women in IP list.

05.15.2019
*Brandon White Quoted in Law360 - The Do's and Don'ts of Extra Discovery at the PTAB*

General News
Law360
Brandon White was quoted in the *Law360* article, "The Do's and Don'ts of Extra Discovery at the PTAB," regarding how to handle the discovery process with the Patent Trial and Appeal Board.

05.15.2019
*Perkins Coie Partner Gene Lee Appointed to NYIPLA Board of Directors*

Press Releases
Perkins Coie is pleased to announce that Gene Lee, a partner in the firm’s Patent Litigation practice, was appointed to the New York Intellectual Property Law Association’s (NYIPLA) Board of Directors at the 2019 Annual Meeting held on May 14, 2019.

05.14.2019
*Nate Kelley Mentioned in Multiple Publications Regarding the Invalidation of Johnson & Johnson’s Drug Patent*

General News
Nate Kelley was mentioned in multiple publications regarding the U.S. Court of Appeals for the Federal Circuit’s ruling to uphold the U.S. Patent Trial and Appeal Board decision to invalidate a patent on Johnson & Johnson's prostate cancer drug, Zytiga.

05.07.2019
*Perkins Coie Ranked Nationally Across All Areas of IP Law by Managing IP*

Press Releases
Perkins Coie is pleased to announce that it has been ranked nationally in every area of intellectual property by *Managing IP* in its 2019 IP Stars rankings, including patent litigation, post-grant proceedings and patent prosecution.

04.10.2019
*Perkins Coie Awarded Managing IP Patent Impact Case and Washington, D.C. IP Litigator of the Year*

Press Releases
Perkins Coie is pleased to announce that it was named as having a patent impact case of the year by *Managing IP*'s Americas Awards for the successful representation of Mylan in its industry-shaping win in *Saint Regis Mohawk Tribe v. Mylan*. 
Pharmaceuticals Inc., which convinced the U.S. Court of Appeals for the Federal Circuit that Indian tribal sovereign immunity cannot block the Patent Trial and Appeal Board (PTAB) from undertaking inter partes reviews (IPRs).

PUBLICATIONS

07.18.2019

The Ripple Effect of SAS Institute v. Iancu on IPR Practice
Articles
Law360
In April 2018, the U.S. Supreme Court held in SAS Institute Inc. v. Iancu that the Patent Trial and Appeal Board must institute inter partes review either on all claims raised in a petition or none of them.

June 2019

IPR>>IRL: A brief guide to the essentials of inter partes reviews in real life
Attorney Publications
Because IPR proceedings provide a faster and cheaper alternative to district court litigation, the process has become a popular means for challenging issued patent claims. This summary breaks down the IPR process and identifies some basic strategic considerations for challengers and patent owners. Read the full IPR>>IRL

03.29.2019

New USPTO Motion-To-Amend Program Raises Concerns
Articles
Law360
The U.S. Patent and Trademark Office announced a new pilot program directed toward motion-to-amend practice during inter partes reviews and other trial proceedings under the America Invents Act. This article describes the pilot program and raises some concerns about one of its key pillars: interim guidance on the patentability of the proposed amended claims.

PRESENTATIONS

09.11.2019

PTAB Endgame: The Final Written Decision, Rehearing and Appeals to the CAFC
Speaking Engagements
Co-presenter
USPTO Post-Grant Patent Trials 2019: New Challenges & Tactics / New York, NY

06.12.2019 - 06.15.2019

FCBA Bench & Bar Conference
Sponsorship
Federal Circuit Bar Association
Colorado Springs, Colorado

04.08.2019

FCBA – Updates From the PTAB: Past, Present and Future
Speaking Engagements
Panelist
Santa Clara University School of Law / Santa Clara, CA

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RELATED SERVICES

PRACTICES

• Inter Partes Review (IPR)
• Covered Business Method Review (CBM)
• Post-Grant Review
• Post-Grant Proceedings