

Patent Opposition & Revocation

United States

In contrast to Australia, the US relies predominately upon the process of 'reexamination' for arguing against the validity of a patent. Reexamination is conducted by the USPTO, with a course of appeal lying with the Court of Appeals for the Federal Circuit. Reexamination is of course only applicable to issued patents.

Pre-Issue:

Chapter 1901 – Protest Under 37 CFR 1.291

- A 'protest' is literally a protest against the application for a patent. It is designed to bring information to the attention of the USPTO that is relevant to avoiding the issue of invalid patents.
- 'Protest' occurs during patent prosecution, and it *must* be submitted *prior* to either the publication of the patent application, or the mailing of a notice of allowance (whichever occurs first) [Note: a 'protest' could be submitted after publication etc, however it would require the express written consent of the patent applicant).
 - Generally speaking, a protest should be submitted as early as possible so as to provide the examiner with ample time to consider it.
- Any member of the public may submit a 'protest'. It must however be served on the applicant in accordance with section 1.248.
- A protest must of course identify the application against which the protest is directed.
- A 'protest' must also include:
 - A listing of the patents, publications, or information relied upon;
 - A concise explanation of the relevance of each listed item;
 - A copy of each listed patent or publication or other item of information in written form or at least the pertinent portions thereof; and
 - An English translation of any non-English language patent, publication or information provided in written form that is to be relied upon.
- A 'protestor' does not obtain a prima facie 'right' to argue the protest before the USPTO. Active participation ends upon submission of the protest. Further participation may however be allowed at the sole discretion of the Commissioner of Patents and Trademarks (although such further participation is limited to the provision of additional prior art, or new issues that could not have been presented at an earlier date).

- Protests may be based on any information or facts that are adverse to patentability. Although the substance of the protest is most important, information contained within a protest should be set forth in accordance with section 1.291(b).
- Section 1.291(a) allows the inclusion within a protest of information that is subject to a court-imposed protective or secrecy order, and information that constitutes Trade Secret information. Such information may be made public if the ‘reasonable examiner’ would consider the information important in deciding whether to allow the application to issue as a patent.
- Section 1.291(c) enables the examiner to require the patent applicant to respond to issues raised by the protest – this requirement however is limited to issues that are reasonably necessary in order for the primary examiner to decide questions raised by the protest and which are before the primary examiner for decision.
- There is no opportunity to complete an incomplete protest...I would assume that this bar would extend to the making of corrections.
- Generally an examiner will make no consideration of issues relating to fraud, inequitable conduct or violations of duty of disclosure.
- The examiner will report the results of protest consideration to the Technology Centre Director.
- Note also that at any time during the period of enforceability of a patent, any person may cite in writing prior art that is pertinent and applicable to the patent: section 1.501(a).

Post-Issue:

Section 134

35 U.S.C. 134 Appeal to the Board of Patent Appeals and Interferences.

(c) THIRD-PARTY.- A third-party requester in an inter partes proceeding may appeal to the Board of Patent Appeals and Interferences from the final decision of the primary examiner favorable to the patentability of any original or proposed amended or new claim of a patent, having once paid the fee for such appeal.

Section 141

35 U.S.C. 141 Appeal to the Court of Appeals for the Federal Circuit.

An applicant dissatisfied with the decision in an appeal to the Board of Patent Appeals and Interferences under section 134 of this title may appeal the decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal the applicant waives his or her right to proceed under section 145 of this title. A patent owner, or a third-party requester in an inter partes reexamination proceeding, who is in any reexamination proceeding dissatisfied with the final decision in an appeal to the Board of Patent Appeals and Interferences under section 134 may appeal the decision only to the United States Court of Appeals for the Federal Circuit. A party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences on the interference may appeal the decision to the United States Court of Appeals for the Federal Circuit, but such

appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal in accordance with section 142 of this title, files notice with the Director that the party elects to have all further proceedings conducted as provided in section 146 of this title. If the appellant does not, within thirty days after filing of such notice by the adverse party, file a civil action under section 146, the decision appealed from shall govern the further proceedings in the case.

Section 301

35 U.S.C. 301 Citation of prior art.

Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential.

Section 302

35 U.S.C. 302 Request for reexamination.

Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title. The request must be in writing and must be accompanied by payment of a reexamination fee established by the Director pursuant to the provisions of section 41 of this title. The request must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. Unless the requesting person is the owner of the patent, the Director promptly will send a copy of the request to the owner of record of the patent.

Section 311

35 U.S.C. 311 Request for inter partes reexamination

(a) IN GENERAL.- Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

(b) REQUIREMENTS.- The request shall-

(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and

(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

(c) COPY.- The Director promptly shall send a copy of the request to the owner of record of the patent.

Post-Issue:

Section 301: Citation of prior art

- Any person may submit any prior art (consisting of patents or printed publications) that the person believes to be relevant to the patentability of any claim of a patent during the period of enforceability of the patent.
- If a written explanation of the pertinency of the prior art is included with the submission, the citation of prior art and explanation will form part of the official patent file.
- The period of enforceability of a patent is the duration of the patent term + 6 years under the statute of limitations.
- Please note that issues will arise re the submission of prior art by third parties after the date of any order for reexamination.

Section 302: Ex Parte Re-examination

- Any person may file a request for ex parte re-examination at any time during the period of enforceability of the patent on the basis of any prior art cited under section 301. If a ***'substantial new question of patentability'*** is identified, reexamination will be granted. The request must set out the following:
 1. Statement identifying each substantial new question of patentability based on prior patents and printed publications;
 2. Identify each claim for which re-examination is requested + a detailed explanation for the pertinency and manner of applying the cited prior art to every claim for which re-examination is requested.
 3. Copies of all prior art must be provided (with an English translation).
 4. A copy of the entire patent to which re-examination is to apply must be included.
 5. A copy of the request for re-examination must be served on the patent owner.
 6. The fee for re-examination must be included.
- The re-examination procedure is ex parte in nature.
- Amendments may be made to the patent specifications during the re-examination process. Such amendments however may not enlarge the scope of the claim, they are designed merely to promote accurate conformity.
- Where re-examination results in the final cancellation of claims from the patent, the patentee may not renew or continue the proceedings by refiling under 37 CFR 1.53(b) or (d), nor file a request for continued examination under 37 CFR 1.114.

- Where the examiner determines that a re-examination proceedings is ready for final rejection (i.e. cancellation of a claim or entire patent) a patentability review conference must be convened. Essentially this conference acts in a similar fashion to an appeals conference.
- After the Final Rejection, a patent holder has 2 months in which to file a Response (subject to extension depending on the circumstances).
- After the Final Rejection, amendments may be filed prior to the Appeal Brief (and entered upon the Appeal) if they merely eliminate matters of appeal or adopt examiner's suggestions.
- Appeals:
 - o A patent owner who has been subject to an unfavourable re-examination decision may appeal to the Board of Patent Appeals and Interferences under section 134 of 35 U.S.C. within 2 months of the last office action. This process is not available for patent holders who have obtained a favourable decision (*Greenwood v. Seiko Instruments*, 8 USPQ2d 1455 (D.D.C. 1988)).
 - o An appeal for court/judicial review may be made by the patent owner under sections 141 to 145 of 35 U.S.C. in response to an unfavourable decision of the Board of Patent Appeals and Interferences.
 - o There is no avenue of appeal from *ex parte* reexamination for third parties. Please note however that the courts have allowed a third party requestor to become involved in hearings in appropriate circumstances [see *In re Etter*, 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985) and *Reed v. Quigg*, 230 USPQ 62 (D.D.C. 1986). See also MPEP § 1216, § 1216.01, and § 1216.02. Note also that a third party requester who is permitted to intervene in a civil action has no standing to appeal the court's decision, *Boeing Co. v. Comm'r*, 853 F.2d 878, 7 USPQ2d 1487 (Fed. Cir. 1988)].

Section 311: *Inter partes* reexamination

Any third party may request *inter partes* reexamination.

35 U.S.C. 311 Request for inter partes reexamination

(a) IN GENERAL.- Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

(b) REQUIREMENTS.- The request shall-

(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and

(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

(c) COPY.- The Director promptly shall send a copy of the request to the owner of record of the patent.

Section 251

Section 301

Section 302

Section 311

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