
Patents: Post-Grant Podcast — S02Ep02: Reissue vs. Reexamination in IPR and PGR Practice (Part 1)
Recorded January 2023

Andrew Zappia:

Greetings and welcome to Troutman Pepper's *Patents: Post-Grant Podcast* series. My name is Andy Zappia and I'm joined by my colleagues Mike Goldman and Megan O'Gara. We're doing something a little different in the podcast series this time because we've got a multipart topic. We're going to do a series of three podcasts on this particular topic because we think it's interesting and it's a little complicated too. So luckily, we have two real experts on the podcast to help us walk through it. The focus of this series of podcasts will be the use of reissue or reexamination, procedures for amending claims as an alternative to the motion to amend option that's available in inter partes review proceedings, or IPR proceedings, or post-grant review proceedings.

The three portions of this podcast are going to be, for this portion, part one, we're just going to talk about reissue versus reexamination. And the pros and cons of using one or the other in the context of a post-grant review proceeding. And then for parts two and three, we're going to dive deeper into reissue if that's the tool chosen. And then for part three, we're going to look more closely at reexam if that tool is chosen. But to start off and just to do some table setting on this, one question that often comes up is why are these procedures even considered in the context of post-grant review proceedings. Especially because there is a motion to amend option as part of those proceedings? So, Meg, I don't know if you want to comment on why these other procedures come up in this context.

Megan Thisse O'Gara:

Sure. I'm happy to lead us off here, and Mike can jump in with his expertise as he sees fit. This was highlighted in a 2019 notice from the USPTO, these two procedures and the use of these two existing procedures as a way to amend claims post-grant. A tool to use by patent owners that were faced with particularly an IPR challenge or a post-grant review challenge. Because the motion to amend practice has proven so difficult to amend claims during those trials at the patent office. These reissue, reexam procedures are existing procedures. These weren't new from AIA, and so the patent office put out this notice clarifying the use of these and how they can be used in conjunction with an IPR proceeding.

Michael Goldman:

I think the patent office in issuing this notice is continuing to feel some pressure to improve the amendment process in conjunction with post-grant proceedings because they have not been particularly successful so far. I think we have a situation where the board, the PTAB, does not really shown a great desire to want to deal with these things and has established procedures that make it difficult to be successful in achieving an amendment of claims. And in addition, of course, you're in an adversarial proceeding where not only is the entity within the patent office that's going to decide whether you can have these additional claims or these amendments, but you have an adversary that's telling them why they shouldn't allow those amendments.

Michael Goldman:

In contrast, you get rid of the adversary in a patent owner-initiated reexamination or a reissue. You have an organization within the patent office that's different than the PTAB that's in the business of issuing patents if there's patentability established, and in permitting amendments when appropriate. And of course, you don't have an adversary to get in the way of what the patent owner wants as far as amendments go. There's a lot to be said for why one should be looking at these, not diminished by the fact that the patent office is now, in this notice, actually suggesting that one look at those.

Andrew Zappia:

I assume that this comes up because if you're a patent owner in an IPR or PGR and you look at the arguments being made against your patent, you might think, "Well, I've got a better chance of keeping patentable claims by amending them somehow." I would think patent owners who are faced with that kind of challenge, that's when they start thinking about motion to amend or is reissue better or is reexamination better, if they feel like they need to make amendments. Is that when this arises?

Megan Thisse O'Gara:

I think that's right. I think that's when folks are really looking at these procedures is with amendments in mind. I think that's exactly right.

Andrew Zappia:

And I think it can also come up, and we'll get to this more when we talk about the particular mechanics, for some of these procedures, and maybe all of them, you can even look at them after you get a decision from the PTAB, right?

Megan Thisse O'Gara:

Absolutely. You can file reissue application or request reexam before, during, or after that trial. After the final written decision, as long as you precede some of the cutoffs, the issuance of the trial certificate or the conclusion of any appeal.

Andrew Zappia:

I guess motion to amend no, that you have to make during the actual procedure, but these other ones you can do late in the process, right?

Megan Thisse O'Gara:

Yeah, absolutely.

Andrew Zappia:

I was thinking, before we get too much into the pros and cons, it might be helpful just to talk a little bit about the basics of what these procedures are for listeners who aren't as familiar or don't regularly practice in issue or reexamination. Meg, maybe you could start out by just saying a little bit about what reissue is, the basics of how it works, and some of the things you think about when you're considering it.

Megan Thisse O'Gara:

Sure, absolutely. These are cases that we handle quite a bit. But a lot of folks aren't familiar with them, so I think it is important to go over the basics. Reissue of a patent is available by statute under section 251, 35 U.S.C. 251. It can be used to correct a variety of errors in an issued patent, that includes correcting errors in the specification, correcting errors in inventorship, perfecting priority, a host of things. But important to our conversation here is really correcting errors in the claims. And those errors can be claiming more than you had a right to claim, so you'd be narrowing your claims. Or less than you had a right to claim if you're within two years, and that would be broadening your claims. When you correct errors in the claims, I think it's important to point out that you're typically doing that via reissue practice when you don't have any other patent family members pending. When you don't have opportunity to present those narrower claims or those broader claims in the context of a continuation or a divisional application that might be pending within the same family as the patent at issue.

Michael Goldman:

If you did in fact have the opportunity to avoid reissue and in fact, go into a continuation or a divisional and present those new claims, generally speaking, we view that as the way to go rather than reissue. So, reissue is certainly beneficial, but not necessarily a preferred mode when you have that luxury of a pending case from the original family.

Megan Thisse O'Gara:

Absolutely.

Andrew Zappia:

When you're thinking about reissue, what are some of the rules and limitations and things like that that come up when you're thinking about maybe using that procedure?

Megan Thisse O'Gara:

Mike and I typically when we counsel clients in what to think about when they're considering reissue, one of the very first things we address is that the duty of disclosure reattaches. It attaches for both when a reissue application is filed or when, in the context of reexamination, when a reexamination is ordered by the patent office. But it's something that should be front of mind for patent owners when they're considering these procedures, that they need to be prepared to deal with the duty of disclosure. And they really need to be considering that all the way through the process.

Megan Thisse O'Gara:

But speaking more about amending the claims and the limitations around amending the claims, which is particular to our topic here. A reissue application that only seeks to narrow the claims is a much simpler case as far as limits than broadening the claims. So, if you're narrowing the claims, you can really do that any time during the life of the patent. And you can also do that to just introduce what we refer to as hedge claims, or claims of intermediate scope, simply adding dependent claims. And that's important, we will talk about that later today. But you can file that at any time to introduce those hedge claims. Broadening, Mike, if you want to take the lead on

some of the limits around filing those broadening claims, because that's a really important consideration.

Michael Goldman:

Yeah, pretty much when we have a patent that we're looking to reissue for any reason, perhaps because we think there's a validity issue, even though the focus might be on narrowing the claims to get around that problem. The questions always asked, do we have an opportunity to amend? So that we're broader and get a win out of the process by perhaps broadening the claims in some other way that still would be valid over the priority of concern, but would provide that opportunity to have a broader claim in some other respect? So, we always ask for that. As long as it's within two years of issue that we're looking at reissue, that always should be on the table for anyone considering reissue for any reason.

Megan Thisse O'Gara:

And then the limitations around that, if you are within those two years, there are other considerations. Certainly, time is of the essence because you need to be looking at that two-year window. And also, you need to be looking at whatever subject matter may have been surrendered during original prosecution because you can't amend your claims till we pass through that surrendered subject matter. And we have a whole other podcast actually on that very topic, so I'm not going to dive too deep into that issue, but it is a big issue when it comes to broadening your claims in reissue.

Andrew Zappia:

I would think for a patent owner wanting to amend claims and looking at reissue, they might be a little concerned or scared by this concept of error. What is the notion of error and should patent owners be worried about doing a reissue in court, admitting an error?

Megan Thisse O'Gara:

That can be a really difficult topic for patent owners. Not only you're correcting an error, you really need to say that you're correcting the error on the record. You need to provide documentation to the patent office describing that error. But I don't think it needs to be really that intimidating. You only need to cite at least one error that can form the basis of reissue under the statute, and that error can be as simple as failure to file additional hedge claims. Failure to file additional claims of intermediate scope. Those additional dependent claims when we're talking about amending claims, that can be a really good avenue for those patent owners that are reluctant about an error statement on the record. Would you agree with that, Mike?

Michael Goldman:

Yeah, I think hedge claiming is a great way out except for the most anxious of patent holders about an admission of error, because really, you're not saying anything is terribly wrong with the patent. You just like to have some more claims. And I think that should be comforting to people that are worried about it. Whereas if you're sitting there and saying that you claim too much, i.e., your claims are not valid, well that doesn't look particularly appealing. So, if that's your error, that's not something people want to do. Or even if you say you claim too little, well that could have adverse effects in litigation reflecting a worry about whether your existing claims are

covering somebody's infringing activity. Or what you think is infringing activity. So, I think the hedge claims in general is a good procedure to avoid risk in any context of admitting error.

Andrew Zappia:

We're going to talk later in this series about more detail about the mechanics. But let's say you get through the reissue process, and you end up with allowable claims at the end, what happens then?

Megan Thisse O'Gara:

It's a really important question, especially later in our conversation. You get a new patent. You get a reissue patent, it begins with a capital R-E. It is a reissued patent, and you surrender the original patent. The filing of the application itself, it's important. And this is an important topic of conversation where we counsel clients to talk about. The filing of the reissue application itself is just an offer to surrender the patent, should a reissue patent actually go to issue. So that's a really important detail that patent holders need to be aware of.

Andrew Zappia:

Maybe let's talk about reexamination a little bit because how is it different from reissue?

Megan Thisse O'Gara:

Yeah. It is quite different. And just starting with the basic fact that a reissue is an application for reissue of patent, it's a reissue application. Whereas an ex parte reexamination, patent owner requested reexamination is not. It's a request. So, it's not something that's just simply filed and begins prosecution. It is a request that then needs to be acted on by the central reexam unit to decide whether or not to order a reexamination or not. There's a couple other important differences. A reexamination can be requested by any person at any time during enforceability of the patent. Here we're talking about the patent owner themselves being that any person, right. They're going back to the patent office and requesting reexamination of their own patent. And like we said before, reexamination must be requested, and that request must be then granted by the patent office. That's different than the reissue application that's simply filed.

Megan Thisse O'Gara:

A reexamination also has a different threshold for ordering that reexamination based on the request. The patent office has to find, and the patent owner in this context would need to present in their request something called a substantial new question of patentability. And that needs to be based on patents or printed publications. So, it's quite limited the basis for the substantial new question of patentability. There's a few things to unpack, but the key thing to remember is that the request has to identify those patents or printed publications that present a new non-cumulative teaching, that was not previously considered by the USPTO. And that calls in to question the patentability of those claims. And that's what the request needs to set out and the patent office needs to decide.

Andrew Zappia:

So, I guess in the context of saying IPR or PGR. A patent owner sees references that are raised, right, and they could go to reexamination and say, these references raised a substantial

new question of patentability, and then use that mechanism to amend the claims to try to deal with those or other references?

Megan Thisse O'Gara:

Yes, that's it, and you can only narrow your claims in the context of reexam. That's another important difference between reexam and reissue. You can only narrow your claims in reexam.

Andrew Zappia:

Now, there's statistics out there about how often a reexam request is granted such that the reexam starts.

Megan Thisse O'Gara:

It's a really high rate of order based on reexam requests, I think it's greater than 90%, and reexam is ordered after a reexam request is filed.

Andrew Zappia:

I guess that's a big difference from motions to amend in say IPR, PGR because last I looked, success rates on those are under 30%.

Megan Thisse O'Gara:

Yeah, it was a significant difference there.

Michael Goldman:

But of course, it should be kept in mind that the granting is just starting the show in a reexam. It's not really anything definitive.

And what happens after granting is a lot of times, which is I guess good for the patent holder, a patent will emerge or a certificate confirming patent ability will emerge from a reexam. So, it's different in that way as well. Presumably if you've got a well-founded amendment and you can persuade the central reexam unit that it is patentable, well, you're doing that ex parte and hopefully being successful.

Andrew Zappia:

It sounds like in reexam, the patent office looks at anticipation or obviousness, based on printed publications. In reissue when they're trying to decide whether to reissue the patent, they're not limited. They can look at other stuff like 101 or 112, is that right?

Megan Thisse O'Gara:

Yeah, absolutely. Reissue is a full scope of examination as you would normally have in regular prosecution. That's another really key difference between reissue and reexam is reexam is based on patents or printed publications. It looks at novelty and non-obviousness to a limited extent. Section 112 compliance for any amendments you make. Or 112 may come into play if you're looking at a potential prior art that you could swear behind or there's an issue of priority, let's put it that way. 112 can come into play when there's an issue of priority at play. But those are the primary bases for examination in reexam context.

Andrew Zappia:

So, I guess the same question I asked before I say you get through the reexamination, you have allowed claims, then what happens?

Megan Thisse O'Gara:

So, in the context of a reexam, you get a reexamination certificate at the end that basically proclaims the outcome, and any amendments that have been made to the claims. But it is a certificate that's appended to the original patent. And that's a big difference between reissue and reexam in this conversation. A reissue is a new patent and a reexam results in a certificate that is appended to the original patent.

Andrew Zappia:

Thanks for the real helpful summary of these procedures. So, I guess we get back to our original topic of patent owners, an IPR or PGR, and they don't like the motion to amend option, but they think they're in a better position altering the claims in some manner. You've got these two tools there, what are some of the pros and cons of them? And how do you figure out how to make the choice if you feel you have to go down on this road?

Megan Thisse O'Gara:

Sure. I think it's probably helpful that we'd summarize a few of the differences between the two, and then we can talk through some of the advantages of those differences between reissue and reexam. We talked a little bit about you can just file a reissue application versus requesting a reexamination that then has to be acted on by the patent office and ordered or not. That's a difference. The threshold of a substantial new question of patentability in a reexamination versus the need for an error statement in a reissue application. A full examination in a reissue, which we can talk about in a little bit, but that might be a little bit scary on 112 for some folks.

Andrew Zappia:

Or 101 potentially, right?

Megan Thisse O'Gara:

Yeah, absolutely.

Megan Thisse O'Gara:

Something that we didn't talk about yet, but you can't withdraw a reexamination once it's ordered. And a reissue application, you actually can abandon the reissue application at any point during prosecution. The original patent, as we talked about, is just an offer for surrender, if a reissue actually issues. So, you could actually abandon your reissue application and leave the original patent in place. In the context of claims, you can only narrow and reexam. But you really have no ability to extend prosecution in a reexamination context the way you would in a reissue. In a reissue, you can file RCEs, you can file continuations or divisional reissue applications once you file that original reissue.

Megan Thisse O'Gara:

But in a context of a reexam, there is no request for continued examination or RCE practice. And there's no continuation or divisional filings permitted. So, the reexamination is really a standalone procedure for that patent.

Andrew Zappia:

Just listening to it, other than the scope of examination, it sounds like reissue has a lot of benefits. Let me know if you agree with that.

Megan Thisse O'Gara:

We talked a little bit about at the end of a reissue application, you get allowable subject matter. You actually get a new patent, a reissued patent versus a reexamination proceeding where you get a certificate of reexam that's really appended to the original patent. And the important issue there for a patent owner deciding what procedure they might want to use if they're weighing these two procedures is if there is a one-year estoppel period at play under 315B in the IPR proceeding where there's a limited opportunity for your adversary to file an IPR proceeding after being served a complaint alleging infringement, you have an opportunity to keep that door closed with a reexam.

Michael Goldman:

I think there's a lot to be said for using reissue. I mean that in general, I think we'd like that procedure in any context as far as a post-grant procedure compared to reexam. But we have to remember that this notice from the patent office did present both choices as possibilities, and I talked about some of the pluses and minuses. So, I think the fact that notice does mention both, suggests that consideration of reexamination is appropriate and that reexamination does have something to offer.

Well, I think there are pros and cons, so maybe to get into a little more detail, why reexam is something to consider in addition to reissue when you're trying to go outside the PTAB to have a motion to amend or to have an amendment considered. As we talked about, reissue can proceed if there's an error. And we've talked about how hedge claims may afford an opportunity to help a nervous patent holder raise an error that's not terribly consequential. On the other hand, reexamination doesn't look at error. There just has to be a substantial new question of patentability in order to get over the hump of having the request granted. That can be equally or even perhaps more inconsequential if you simply raised as a substantial new question of patentability, whatever was raised in the, say it's on IPR. Raised in the IPR against the original claims and simply say that the IPR petition raises a substantial new question of patentability. So basically, your SNQ as we call it, substantial new question of patentability, doesn't raise any new issue that's not already before the patent office.

Megan Thisse O'Gara:

Yeah, I think that's right Mike, and I think, you know, that may be more palatable since it's already been raised by your adversary during the IPR proceeding for instance. I suppose it does depend on the timing of your filing of a reexam because it won't be a substantial new question of patentability if the PTAB's already handed down its final written decision on that question. So, if you're using, for instance, the same art or grounds presented in an IPR proceeding, you'd

want to make sure your timing as a patent owner was right. If you chose reexamine, you wanted to use those grounds for your SNQ to get your request granted.

Michael Goldman:

Another thing we touched on, but just to kind of hammer home the issue. There is a difference in the scope of examination that takes place in reexam versus reissue. And basically, a reexamination is going to look at the same kinds of things that would be looked at in an IPR. Prior patent or print publication-based challenges to patentability. On the other hand, reissue can look at anything that normal examination would look at, including as we've talked about 101 and 112 issues. So, if you as a patent holder have some concern about whether bringing it back into the patent office is going to reopen those issues, you might want to think real hard about using reissue.

Andrew Zappia:

That was great. Mike and Meg, and thanks to our listeners for listening to this podcast. We invite you to join us for our next two installments in this series where we'll dive deeper into reissue and reexamination in this context. In the meantime, Troutman Pepper's intellectual property team will continue helping its clients develop and implement global protection and commercialization strategies for intellectual property. For more information on how we can help you, please visit our website at troutman.com. You can also subscribe and listen to this and other podcasts in our series on post-grant procedures, including on Apple, Google, and Spotify. Thank you.

Copyright, Troutman Pepper Hamilton Sanders LLP. These recorded materials are designed for educational purposes only. This podcast is not legal advice and does not create an attorney-client relationship. The views and opinions expressed in this podcast are solely those of the individual participants. Troutman Pepper does not make any representations or warranties, express or implied, regarding the contents of this podcast. Information on previous case results does not guarantee a similar future result. Users of this podcast may save and use the podcast only for personal or other non-commercial, educational purposes. No other use, including, without limitation, reproduction, retransmission or editing of this podcast may be made without the prior written permission of Troutman Pepper. If you have any questions, please contact us at troutman.com.