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New Preorder Patent Owner Rights in *Ex Parte* Reexamination

SPEAKERS

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In this episode of the *Post-Grant Podcast*, Andy Zappia, Bryan Smith, and Ted Merkel explore a significant new director memo that changes how *ex parte* reexaminations are initiated at the Patent Office. They explain what *ex parte* reexam is, when and why it is used, and how new preorder patent owner submissions shape strategy for both requesters and patent owners. They also discuss how tightening IPR rules have driven more filers toward reexam, and when this new preorder procedure may or may not make a meaningful difference in whether a reexamination gets ordered.

Transcript

Patents: Post Grant Podcast – New Preorder Patent Owner Rights in *Ex Parte* Reexamination

Host: Andy Zappia

Guests: Bryan Smith, Ted Merkel

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Andy Zappia (0:00:05):

Greetings and welcome to Troutman Pepper Locke's *Patent Post-Grant Podcast Series*. My name is Andy Zappia and I'm joined today by my colleagues Bryan Smith and Ted Merkel. In this installment of our *Post-Grant Podcast* series, we are going to take a look at some new rules that just issued from the Director at the Patent Office relating to *ex parte* reexam practice. Now, just to set the table a bit, listeners to this podcast are gonna be generally familiar with the *ex parte* reexam procedure, but I'll give just a little quick summary so we all know what we're talking about. Under the patent rules, a requester can seek reexamination of a patent, and there's no real standing requirement to seek reexamination. You can put in a reexamination request. When you put in the request, it has to be done during patent term. And when you put in the request, it has to be based on what's called a substantial new question of patentability, which basically means not an issue that the office has already considered. And it has to be based on patents or printed publications and theories of basically obviousness or anticipation. In the procedure, the requester can be anonymous, and the request goes to the Central Reexam Unit. So it doesn't go to the PTAB; it goes to the Central Reexam Unit. With regard to *ex parte* reexams, there aren't any estoppels, which means, say you bring a reexam and you don't succeed, you're not limited in arguments you could make in, for example, district court. So you could put in a reexam and make the same arguments in district court even if you lost the reexam. But that's what estoppels are.

Andy Zappia (0:01:43):

If the Central Reexam Unit finds a substantial new question of patentability, it'll order the reexam. And that means the patent will be put back into examination. It's similar to normal examination procedures, but there are some restrictions, like some of the timing rules are different, and you can't do RCEs and things like that in reexam. Getting reexams ordered, meaning started, is very typical. The order rate is right around 90%, meaning reexam requests are ordered, that means a reexam is started. That doesn't mean the patent is found invalid or all or most of the claims are knocked out. If you look at success rates in reexam, meaning some or all of the claims are knocked out, those are much lower, under 20%. And at the end of the process, if a reexam is ordered, a reexam certificate will issue. The last thing about *ex parte* reexam that's pertinent to our discussion is the requester doesn't participate after the request. That's why it's called *ex parte* reexam. The only caveat to that is if a reexam is ordered and then a patent owner puts in a patent owner statement, the requester gets to respond to that. That doesn't happen that often because it's usually a bad idea if you're the patent owner to put in a patent owner statement. So a lot of times that never happens. And this is really where the new rule comes in, because this procedure has been changed a bit. So, Bryan, do you want to summarize a little bit what this Director memo is on *ex parte* reexam practice?

Bryan Smith (0:03:14):

Sure. The Director's memo allows the patent owner to submit a paper prior to the order granting reexam to provide information to the Central Reexam Unit that may be useful in making the substantial new question, or SNQ, determination. This new procedure actually provides a waiver of prior regulations that excluded the patent owner from involvement prior to the issuance of a reexam order. The paper is limited in length to 30 pages. It may be accompanied by a declaration, but the substance of the argument has to be in those 30 pages of the main filing, and incorporation by reference is not allowed, as is typical in reexam papers. This new pre-order paper must be filed no later than 30 days after the service of the initial request. Due to the tight timeframe in which the Patent Office has to make these reexam order decisions. Although the memo actually provides that the pre-order paper should be filed as soon as possible to give the Patent Office time to make these determinations, the regulations provide that the paper can be submitted as a matter of right. It doesn't require any petition or fee.

Bryan Smith (0:04:23):

However, the paper must comply with the service and formatting rules typical in reexams. And one of the biggest issues is the actual content of the paper and the arguments that can be made. Some of the memo is a little unclear on this, but it seems that the papers must be carefully tailored in scope to address whether the asserted teachings would have been considered important to a reasonable examiner. There's some issue about whether the paper can challenge the newness of a reference, that is whether it's cumulative or duplicative. Part of the memo states pre-order papers should not address these aspects as those matters can be evaluated by the Office on the patent owner submission at a later time. Further, the patent owner is restricted from making any discretionary denial arguments under 325(d) as to whether the patents are involved in other actions before the Office that would allow for discretionary denial.

Bryan Smith (0:05:18):

The memo provides that non-compliant papers may be refused consideration by the Office, although it's interesting to see what effect that will be because the papers will have been read and reviewed by the Office. Compliant papers can be used by the reexam unit to make the determination of whether the request meets the relevant standard to establish an SNQ and whether the reexam should be ordered. Importantly, the requester gets only a very limited opportunity to respond to these pre-order papers. They must submit any reply with a petition and pay the required fee, and the arguments are expressly limited to issues that the pre-order paper includes misrepresentations of law or fact. Any reply would be limited to 10 pages and must be filed within 15 days of service of the pre-order paper. So it affords the patent owner very little opportunity to respond to these arguments that may go directly to whether the reexam gets ordered or not.

Andy Zappia (0:06:14):

This was issued very recently, right? This was just issued April 1st.

Bryan Smith (0:06:17):

It came out April 1st and it appears that it would apply to reexams served on or after April 5th, although there's some lack of clarity on that as well.

Andy Zappia (0:06:28):

So Ted, I'm interested first in how big a change you see this as being and also when do you think this would make a difference in reexams?

Ted Merkel (0:06:37):

It is a big change in many respects because up until this change in the policy or procedure, the patent owner didn't have any say whatsoever as to whether or not a reexam gets ordered. So in that respect, it is a big change. It gives the patent owner at least one bite at the apple here to try and get the reexam declined. We will probably see some statistics showing the effectiveness of this policy change and the ability of the patent owner to divert reexams from happening. Three, six months down the road, I imagine the Patent Office will start sending some or sharing some statistics with us. So it remains to be seen, but I could foresee this having an impact on a certain percentage of the reexams that are filed.

Andy Zappia (0:07:35):

Yeah. As I was thinking about this, if someone files a reexam with all new references, an entirely new obviousness combination, right? If these pre-order papers are really focused on substantial new question, it might not make that much difference because if it's a whole new combination, usually you're able to meet that SNQ threshold. But if they go in with some of the same references considered, or sometimes people try reexam with the same references that were considered in normal prosecution, but they argue a different aspect of them, then maybe this makes more of a difference. What do you think about that?

Ted Merkel (0:08:11):

That's probably true. It's gonna be a much closer call as to whether or not there actually is a substantial new question where you've got some cumulative references that you're cobbling together, as opposed to going in with a brand new set or brand new combination with a new primary reference. There, it's pretty clear you're gonna have a substantial new question. I guess the only issue, based on what Bryan shared earlier, the only issue is whether or not, as the requester, you've done everything you need to show that the claims would have been obvious or anticipated by those new references. If there's some limitation of the claims that the requester has not adequately addressed, this new policy will allow the patent holder to address that.

Andy Zappia (0:09:01):

Yeah, they can kind of sneak it in a little bit somewhere, right? And we always counsel folks in reexam to do a very fulsome request, right? 'Cause oftentimes it's your only... Usually it's your only chance.

Ted Merkel (0:09:13):

Yeah, with a fully written declaration to support everything you're asserting.

Andy Zappia (0:09:18):

Absolutely. And we also usually tell clients, there's no page limit. Don't overload it. Pick a good ground and maybe have one other ground, but don't put in five, that sort of thing. You want it focused but fulsome, basically, right? And that is maybe even more important now that the patent owner gets some say pre-order. I was sitting back and thinking about this a little bit in the overall context of what we've seen at the PTAB and the Patent Office in the current administration. And it seems to me we've seen a number of steps being taken to make the requirements for these post-grant proceedings more stringent to get them started, right? So we've seen lots of things on the inter partes review side, right? And we've done some podcasts on those. And now we're seeing another procedure added that could lead to more denials of *ex parte* reexams, potentially. And I don't think it's a coincidence that there's been a number of articles published and stats published that as the IPR procedure has had rules become more strict, you've seen an increase in *ex parte* reexams. So to what degree do you think this is kind of reactive to that? Like they're saying, "Well, we don't want everyone to go running to *ex parte* reexam. We're gonna do something on this one too."

Bryan Smith (0:10:43):

It's directly relevant. Resources at the Patent Office have been stretched thin and, as you mentioned, they're trying to close the door to the IPR route through discretionary denial, which has led to a significant increase in these reexam proceedings. And this gives the Patent Office an out to maybe get rid of some of these pre-order, given that previously there was over 90% grant rate. So this may drastically change those statistics.

Andy Zappia (0:11:11):

Yeah, and the other part is the whole settled expectations doctrine they've created. If there's an older patent you're worried about, reexam might be the route you have to go, right? So I think that's another reason why people have been turning to reexam.

Ted Merkel (0:11:25):

One thing that I have seen over the last nine to 12 months is patent owners petitioning for discretionary denial in reexams. I've looked at a handful of those and a lot of times what ends up happening is that procedurally that gets shuttled over to the reexam unit and it gets folded into the SNQ inquiry as a procedural matter. But this new policy is not intended to affect those petitions for discretionary denial since that's not any subject matter that can be dealt with by these new pre-order statements. So we're going to continue to see petitions requesting discretionary denial in reexams and raising some of the similar issues that we've seen raised in IPRs.

Andy Zappia (0:12:20):

Right, and you might also then have this pre-order submission also from patent owners. They may try multiple avenues, right?

Ted Merkel (0:12:28):

That's right.

Andy Zappia (0:12:29):

Well, I think what we'll do is we'll sit back and kind of see what happens with this and maybe we'll do an update podcast in six months and kind of see if we can glean whether this is really making a big difference or not.

Ted Merkel (0:12:40):

Yeah, and hopefully by then we will have filed a couple reexams and we'll have some practical experience.

Andy Zappia (0:12:46):

We may have some personal experience.

Ted Merkel (0:12:48):

Yeah, that's right. I'm expecting at least one.

Andy Zappia (0:12:51):

Exactly. Well, thanks for your comments and there's lots of interesting things happening at the Patent Office and lots of new ways of doing business. We'll try to keep our listeners updated as these developments continue. Troutman Pepper Locke'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 could help you, please visit our website, 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 very much.

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