Boardside Chat:

*Inter Partes & Ex Parte Reexamination Appeals*

Administrative Patent Judges Jeffrey B. Robertson and Rae Lynn P. Guest

Patent Trial and Appeal Board
Webinar Series (1 of 5)
February 2, 2016
<table>
<thead>
<tr>
<th>Date</th>
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<th>Topic</th>
<th>Speakers</th>
</tr>
</thead>
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<tr>
<td>Topics</td>
<td>Presenter</td>
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<td></td>
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<tr>
<td>Reexam Appeal Statistics</td>
<td>Lead Judge Jeff Robertson, Judge Rae Lynn Guest</td>
<td></td>
<td></td>
</tr>
<tr>
<td>Reexam Process Through Appeal</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>Q&amp;A with audience</td>
<td>Ms. Gongola (moderator)</td>
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</tbody>
</table>
Pending *Ex Parte* Appeals Inventory (excluding appeals from reexamination proceedings)
# Pendency of Ex Parte Appeals

(October 1, 2015 through present)

<table>
<thead>
<tr>
<th>Technology Center</th>
<th>Average Months From Docketing Notice to Board Decision</th>
</tr>
</thead>
<tbody>
<tr>
<td>1600</td>
<td>27.7</td>
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<tr>
<td>1700</td>
<td>24.5</td>
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<tr>
<td>2100</td>
<td>34.2</td>
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<tr>
<td>2400</td>
<td>37.7</td>
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<tr>
<td>2600</td>
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<td>2800</td>
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<tr>
<td>3700</td>
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Expedited Patent Appeal Pilot (EPAP)

- *Ex parte* appeal accorded special status when another *ex parte* appeal is withdrawn

- Pilot effective June 19, 2015 for up to a year

- 2 months to decide petition and 4 months from the date of petition grant to decide appeal

- Data through January 6, 2016: 22 petitions filed (20 granted and 2 denied); Average time to decide petition approximately 2 days
Small Entity Pilot Program

- Small entities with a single pending appeal may secure expedited review of that appeal
  - Agree to review based on one claim
  - No rejections under §112
  - 2 months to decide petition and 4 months from the date of petition grant to decide appeal
  - Data through January 6, 2016: 15 petitions filed (10 granted and 5 denied); Average time to decide petition approximately 11 days
### Ex Parte Reexamination Appeal Statistics

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<tr>
<th></th>
<th>Ex Parte Reexam FY 2012</th>
<th>Ex Parte Reexam FY 2013</th>
<th>Ex Parte Reexam FY 2014</th>
<th>Ex Parte Reexam FY 2015</th>
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<tbody>
<tr>
<td><strong>PTAB Pendency (months)</strong></td>
<td>4</td>
<td>6</td>
<td>5.65</td>
<td>4.75</td>
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<tr>
<td><strong>Disposals</strong></td>
<td>114</td>
<td>116</td>
<td>130</td>
<td>75</td>
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<tr>
<td><strong>Inventory</strong></td>
<td>66</td>
<td>74</td>
<td>57</td>
<td>50</td>
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# Inter Partes Reexamination Appeal Statistics

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<tr>
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<th>Inter Partes Reexam FY 2015</th>
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<tr>
<td><strong>PTAB Pendency (months)</strong></td>
<td>5.9</td>
<td>6.3</td>
<td>5.85</td>
<td>6.24</td>
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<tr>
<td><strong>Disposals</strong></td>
<td>154</td>
<td>239</td>
<td>230</td>
<td>219</td>
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<tr>
<td><strong>Inventory</strong></td>
<td>113</td>
<td>134</td>
<td>159</td>
<td>157</td>
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Reexamination Appeal Inventory
Reexam Process through Appeal
**Ex Parte Reexamination (EPX)**

- **Request for Reexamination** filed by Patent Owner (PO) or Third Party Requester (TPR) (1.510)
- **Substantial New Question of Patentability (SNQ)?** (1.515(a)) If yes, reexam ordered. If no, reexam is terminated.
- **Examiner issues Office action.** If PO does not respond, a Notice of Intent to Issue a Reexamination Certificate (NIRC) is issued.
- **Examiner issues final rejection.** PO responds.
- **Examiner considers PO’s response and either reopens prosecution or maintains the rejection.**
- **Appeal (41.31)**
Potential Briefs in an EPX Appeal

- Examiner’s Answer
- PO’s Appeal Brief
- PO’s Reply Brief

Decision
EPX Appeals are Similar to *Ex Parte* Appeals

- Only the PO has a right of appeal

- Examiner submits an Examiner’s Answer in response to PO’s Appeal Brief

- Appellant has 20 minutes for oral argument
Director Ordered EPX

• May be initiated by the USPTO at any time – 35 U.S.C. §303(a)

• May also be initiated as a result of PO requested Supplemental Examination – 35 U.S.C. § 257(b)
Inter Partes Reexamination (IPX)

Request for Reexamination filed by TPR. (1.913).

Threshold to Initiate* Met? If yes, reexam ordered and Initial Office Action issued. If no, reexam denied.

PO responds. (1.945)
TPR responds 30 days from service of PO in form of TPR comments. (1.947).

Examiner issues Action Closing Prosecution (ACP). (1.949).

PO responds. (1.951(a)).
TPR makes comments. (1.951(b)).

Examiner issues Right of Appeal Notice (RAN). (1.953).

PO and/or TPR Appeals (41.61).

*SNQ for IPX filed before 9/16/11 – or – “a reasonable likelihood that the requester would prevail with respect to at least one of the claims challenged in the request” for IP reexaminations filed 9/16/11 to 9/15/12.
IPX Grounds for Appeals

• PO may appeal outstanding rejections that are initiated by TPR and adopted by Examiner or initiated by Examiner

• TPR may also appeal the Examiner’s Decision to confirm patentability of claims by withdrawing or not adopting any of TPR’s proposed rejections
Documents Considered in IPX Appeals

1. PO's Appeal
2. TPR's Cross-Appeal
3. PO's Respondent Brief
4. TPR's Respondent's Brief
5. Examiner's Answer
6. PO's Rebuttal Brief
7. TPR's Rebuttal Brief

Decision
IPX Appeals - Oral Hearings

- Unless otherwise ordered, the Board allows:
  - 30 minutes for each Appellant or Respondent that requested hearing; and
  - 20 minutes for Examiner

- Appellants may want to reserve time for rebuttal

- For cross appeals, there are 2 different appeals
  - Generally, both parties are still given 30 minutes, but both parties can reserve time for rebuttal
  - Board may be flexible on time concerning the additional issues to be addressed

- No Appellants or Respondents can participate in oral hearing unless they:
  - requested a hearing, and
  - submitted the fee
IPX Appeals: New Grounds of Rejection (NGR)

- 2 types of NGR in Board opinions:
  - if the Board *reverses* the Examiner’s determination *not* to make a proposed rejection, or
  - if the Board *knows* of any grounds not raised in the appeal for rejecting any pending claim, it *may* include in its opinion a statement to that effect

- Board Decision containing NGR is not final
Substantial New Question (SNQ)

- Appealable issue in *ex parte* reexaminations but not in *inter partes* reexaminations
  - Waived unless: (1) reconsideration was first requested during reexamination before the Examiner (after 6/25/2010) and (2) Patent Owner raises the issue in the Appeal Brief

- Previously cited prior art may be a basis for reexamination if the context and scope are such that the reference is being considered for a substantially different purpose. 35 U.S.C. § 303(a)
  - See *e.g.*, *In re Swanson*, 540 F.3d 1368, 1380 (Fed. Cir. 2008) (anticipatory reference used as a secondary reference in an obviousness rejection constitutes a SNQ)
Claim Interpretation

• Prior to Expiration of the Patent – Broadest Reasonable Interpretation (BRI)
  – In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004) (“The ‘broadest reasonable construction’ rule applies to reexaminations as well as initial examinations.”); see also In re Yamamoto, 740 F.2d 1569, 1571 (Fed. Cir. 1984)

• If Patent has Expired – the standard changes to that similar to District Court
  – Ex Parte Papst-Mortoren, 1 USPQ2d 1655 (BPAI 1986) (“[A] policy of liberal claim construction may properly and should be applied. Such a policy favors a construction of a patent claim that will render it valid, i.e., a narrow construction, over a broad construction that would render it invalid.”)
Amendments - Effect of Patent Expiration

- When a patent expires while undergoing reexamination, any amendments made prior to its expiration and before a Notice of Intent to Issue a Reexamination Certificate (NIRC) is mailed, are withdrawn.

- Expiration can occur anytime during the reexamination process, including during appeal.
Questions?
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