

Correcting a Potentially Invalid Issued Patent

AUTHOR: JOSEPH ROLNICKI

This article follows up an article wrote earlier in the year on the topic of correcting an issued U.S. Patent. In that article I discussed correcting an incorrect or ineffective patent by filing a reissue application for the patent. Filing a reissue patent application is not the only means offered by the U.S. Patent and Trademark Office for correcting an issued patent. A procedure for having an issued patent reexamined by the Patent Office is also available.

During the life of an issued U.S. Patent, situations can occur where the validity of the patent can be called into question. For example, if information on a patented invention is publicly available before the date that a patent application for the invention is filed at the Patent Office, and for one reason or another, the Patent Office did not become aware of the information during the examination of the patent application and the patent application issues as a patent, then that publicly available information could potentially invalidate the issued patent.

A more specific example is where an owner of a U.S. Patent becomes aware of a patent or printed publication that discloses subject matter similar to the invention of the U.S. Patent, and the patent or publication predates the U.S. Patent. Although the patent or publication was publicly available on a date that predates the filing date of the patent application that issued as the U.S. Patent, for one reason or another, the owner of the U.S. Patent and the U.S. Patent Office were not aware of the existence of the patent or publication during the examination of the patent application that issued as the U.S. Patent. Thus, the publicly available information of the patent or publication was not considered by the U.S. Patent Office during the examination of the patent application that issued as the U.S. Patent. Depending on how similar the disclosure of the patent or publication is to the invention of the U.S. Patent, the "prior art" of the patent or publication could potentially invalidate the U.S. Patent. Stated differently, had the U.S. Patent Office known of the patent or publication, would the U.S. Patent Office still have issued the U.S. Patent?

This uncertainty in the validity of the U.S. Patent would be of great concern to the U.S. Patent owner. The U.S. Patent owner would be hesitant to exercise their patent rights against copying competitors. If the U.S. Patent was involved in patent infringement litigation, the U.S. Patent could potentially be invalidated by the prior art patent or publication and the litigation lost. The uncertainty in the validity of the U.S. Patent alone could render the patent worthless to the U.S. Patent owner. This would be especially concerning to a small business owner or an owner of a startup business where the existence of the business is dependent on the U.S. Patent.

In a situation such as that discussed above where publicly available information or prior art in the form of an issued patent or printed publication calls into question the validity of a U.S. Patent, the U.S. Patent Office provides a procedure by which the patent owner can request that their patent be reexamined in view of the prior art to ensure that their patent is valid over the prior art.

There are different types of patent reexamination procedures offered by the U.S. Patent Office, one of which can be initiated at the request of the patent owner. This procedure is referred to as ex parte reexamination of a patent. Ex parte reexamination is a request that the U.S. Patent Office reexamine an issued patent based on other prior issued patents or printed publications that predate the filing date of the issued patent. The reexamination is limited to the disclosures of only prior issued patents or printed publications. Other types of prior art are not eligible.

The prior art patent or printed publication must disclose information that raises a “substantial” new question of the patentability of one or more claims of the issued patent. It is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. The request for reexamination must demonstrate that a patent or printed publication that is relied on in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the examination of the patent application that resulted in the issued patent. The substantial new question of patentability may be based on prior art previously considered by the Patent Office if the prior art is presented in a new light or a different way that was not considered during the earlier examination of the patent application that issued as the patent.

Ex parte reexamination of a patent can be requested at any time during the period of enforceability of the patent. To request a reexamination, the requester must submit a formal “Request for Exparte Reexamination” to the U.S. Patent and Trademark Office. The Request must include the following parts:

- (1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.
- (2) An identification of every claim of the patent for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art patents or printed publications to every claim for which reexamination is requested.
- (3) A copy of every patent or printed publication that is prior art or was publicly available before the filing date of the patent application that is relied on or referred to in (1) and (2) above.
- (4) A copy of the entire issued patent for which reexamination is requested.

(5) A certification that a copy of the Request for Reexamination has been served on the patent owner if the requester is not the patent owner.

(6) A certification by a third-party requester that statutory estoppel provisions of 35 USC 351(e)(1) or 35 USC 352(e)(1) do not prohibit the requester from filing the request for reexamination of the patent.

The request for reexamination is reviewed by a panel of three experienced Patent Office Examiners within a specialized unit of the Patent Office called the Central Reexamination Unit (CRU). The CRU oversees the examination and handling of ex parte reexaminations, as well as other post-grant patent proceedings. The CRU is staffed with senior primary patent examiners and supervisory patent examiners having a wide range of technical expertise and advanced patent legal knowledge. If the CRU finds that the request presents or raises a substantial new question of patentability, the CRU orders a reexamination of the patent.

Once reexamination of the patent is ordered by the CRU, the patent goes through another examination process by the CRU that is similar to the initial examination of the patent application that issued as the reexamined patent. If the CRU rejects any of the claims being reexamined in light of the new question of patentability raised by the prior art patents and printed publications presented with the request for reexamination, the patent owner is given an opportunity to amend or cancel the rejected claims just as in the initial examination of the patent application that issued as the reexamined patent. The patent owner also has the opportunity to submit new claims just as in the initial examination of a patent application, provided the new claims are not broader in scope than the original claims of the patent being reexamined. If the CRU rejects the claims of the reexamined patent a second time and makes the rejection a “Final Rejection”, the patent owner has the opportunity to appeal the final rejection decision to the Patent Trial and Appeal Board just as in the initial examination of the patent application. The patent owner also has the opportunity to file an appeal of a final rejection to the Court of Appeals for the Federal Circuit.

Once the reexamination of the patent has been concluded, a “Certificate of Reexamination” is issued by the Patent Office. The Certificate makes any amendments to the patent claims that are a result of the reexamination of the patent. If all the claims of the patent are rejected by the CRU and the rejection is not appealed, the patent is nullified.

A detailed discussion of the laws, rules and procedures governing Ex Parte Reexamination may be found in the Manual of Patent Examining Procedure (MPEP) Chapter 2210 (9th Ed., June 2020). The current version of the MPEP can be found on the internet website of the United States Patent and Trademark Office, <http://www.uspto.gov>, by typing “MPEP” in the “Search our site” box at the upper right of the home page and clicking the green arrow.