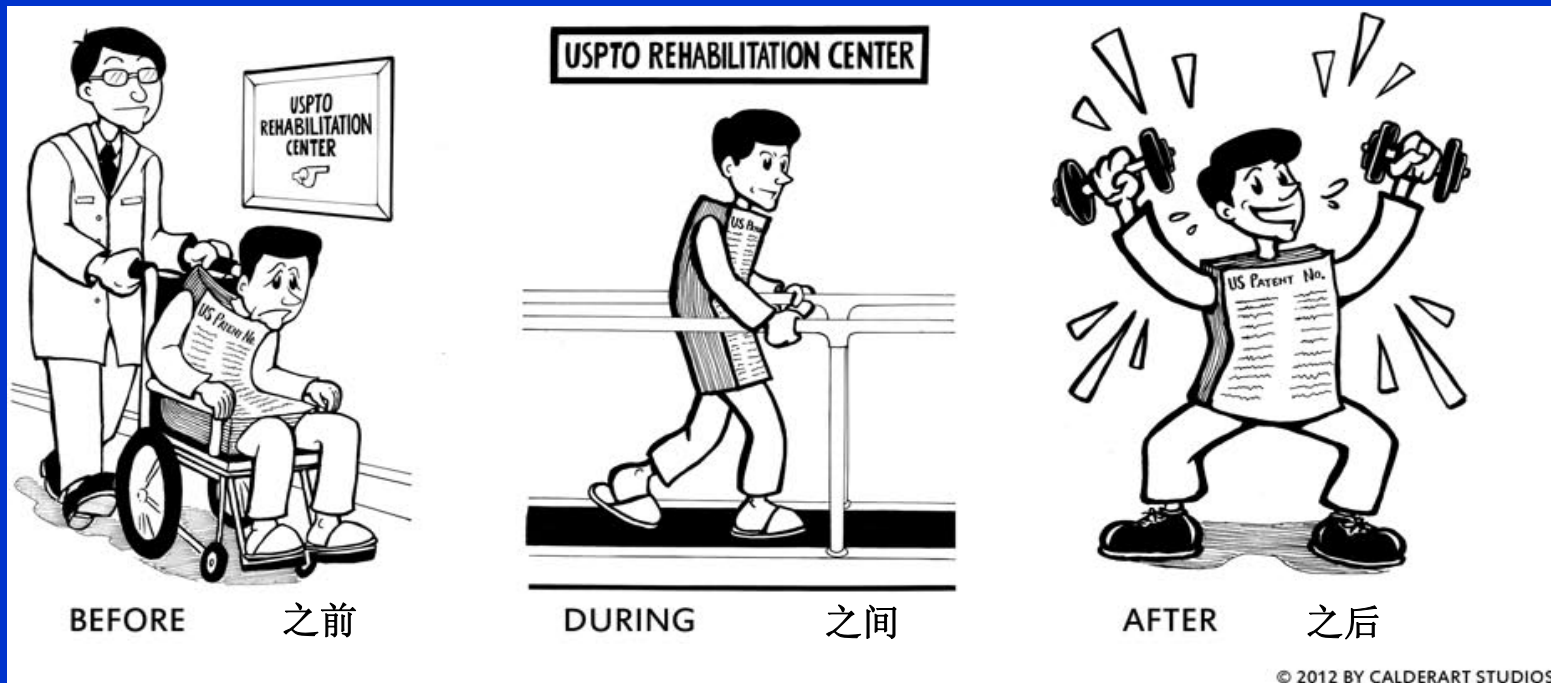


# REHABILITATING OR STRENGTHENING THE U.S. PATENT THAT MAY BE DEFECTIVE OR VULNERABLE TO THIRD PARTY VALIDITY CHALLENGE

THREE EX PARTE PROCEDURES IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE (USPTO) AVAILABLE  
TO PATENT OWNERS

美国专利的恢复或强化  
--- 针对可能有缺陷的或者容易受  
第三方有效性挑战的漏洞的专利

美国专利商标局提供给专利拥有者的  
三种单方面的法律程序



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# I. INTRODUCTION

## A. SOME COMMON DEFECTS AND VULNERABILITIES IN U.S. PATENTS

### 1. Claims are Invalid

- ◆ **Claims are Invalid on Prior Art Grounds, i.e., for Lack of Novelty (Anticipation) and/or for Obviousness**
  - **Prior Art Not of Record**
  - **Prior Art of Record**
- ◆ **Claims are Invalid on Formal Grounds**
  - **Specification Fails to Satisfy the Written Description Requirement**
  - **Specification Fails to Satisfy the Enablement Requirement**
  - **Claims Fail to Satisfy the Definiteness Requirement**

### 2. Claims Fail to Adequately Cover the Invention

- ◆ **Claims are Too Narrow**
- ◆ **Claims Miss the Invention Entirely**
- ◆ **Claims Fail to Cover a Disclosed Invention**

## I. INTRODUCTION (continued...)

### 3. Error(s) and/or Omission(s) of Fact in the Specification

- ◆ Misdescription(s) and Mischaracterization(s) of the Prior Art
- ◆ Error(s) in the Description of the Invention
- ◆ Selective Presentation of Experimental Data

### 4. Error(s) and/or Omission(s) of Fact During Prosecution

- ◆ Erroneous or Misleading Statement(s) In an Attorney's Submission
- ◆ Declaration/Affidavit Submitted During Prosecution, e.g., to Disprove or Rebut a *Prima Facie* Case of Obviousness, is of Questionable Evidentiary Value

### 5. Failure to Comply With the Duty of Disclosure

## **I. INTRODUCTION (continued...)**

### **B. CIRCUMSTANCES GIVING RISE TO A PATENT OWNER'S CONCERN FOR THE VALIDITY AND/OR VULNERABILITY OF ITS U.S. PATENT**

- 1. Fortuitous Recognition of an Actual or Potential Defect or Vulnerability by Patent Owner's In-house or Outside Patent Counsel**
- 2. Prelitigation Investigation Undertaken by Patent Owner in Contemplation of Enforcement of its Patent**
- 3. Patent Due Diligence Investigation in Contemplation of Merger, Acquisition, Patent License or Other Technology Transfer, etc.**
- 4. Information Received From Patent Owner's Non-IP Employee(s), e.g., R&D Staff, Sales Representatives, Technical Support Personnel, etc., or From Parties in Privity With Patent Owner, e.g., Licensees, Joint Technology Development Partners, etc.**
- 5. Patent Owner's Attempt at Prelitigation Enforcement of Its Patent**

## **I. INTRODUCTION (continued...)**

- 6. Third Party Citation of (1) Prior Art Patents or Printed Publications and/or (2) Statements of the Patent Owner Filed in a Proceeding Before a Federal Court or the USPTO Presenting Patent Owner's Position on the Scope of Claim(s) of Its Patent**
- 7. Third Party Challenge to the Validity of Patent Owner's Patent**
  - ◆ **U.S. District Court**
    - **Defense and/or Counterclaim of Invalidity Pleaded by Third Party-Accused Infringer in Patent Owner's Suit for Patent Infringement**
    - **Declaratory Judgment Action by Third Party Threatened With Suit for Patent Infringement by Patent Owner**
  - ◆ **U.S. International Trade Commission**
    - **Defense of Invalidity Pleaded by Third Party Respondent-Importer in a Proceeding Brought by the Patent Owner Under Section 337 of the Tariff Action of 1930 (19 U.S.C. §1337) Seeking an Order for the Exclusion of Importation of Allegedly Infringing Articles**

## I. INTRODUCTION (continued...)

- ◆ **U.S. Patent and Trademark Office**
  - *Ex Parte* Reexamination
  - *Inter Partes* Review
  - Post-Grant Review
- 8. **Third Party Challenge to the Patentability/Validity of the Patent Owner's Corresponding or Related Foreign Patent Application/Patent**

## **II. THE WHY, WHETHER AND WHEN OF PURSUING REHABILITATION OF A POTENTIALLY DEFECTIVE OR VULNERABLE U.S. PATENT**

### **A. SOME COMMON RATIONALES FOR PURSUING REHABILITATION**

- 1. The Patent is Vital to the Current Success and/or Future Prospects of the Owner's Business**
- 2. The Patent is, or is Likely to Become, an Income-producing Asset**
  - The Patent Owner Currently Practices, Or is Likely to Practice, the Claimed Invention**
  - The Patent is Currently Licensed to one or More Third Parties and/or is a Possible Candidate for Licensing**
  - The Patent is a Key Component of the Patent Owner's Future Commercial Plans**
  - The Patent is Being Infringed and Significant Benefits and Advantages Stand to Be Gained by the Patent Owner From "Cleaning Up" its Patent in an *Ex Parte* Procedure in the USPTO Prior to Bringing Suit for Enforcement**
- 3. The Patent is Part of a Patent Thicket Protecting the Patent Owner's Core Patented Technology**
- 4. The Patent Will Likely Come Under Critical Evaluation as the Result of a Due Diligence Study Carried Out in Contemplation of an Investment, Merger or Acquisition by an Interested Third Party**
- 5. The Patent, or a Foreign Counterpart, Has Already Attracted the Unwelcome Attention of a Third Party/Competitor**



## **II. THE WHY, WHETHER AND WHEN OF PURSUING REHABILITATION OF A POTENTIALLY DEFECTIVE OR VULNERABLE U.S. PATENT**

### **B. FACTORS INFLUENCING THE DECISION WHETHER OR NOT TO PURSUE REHABILITATION**

- 1. Level of Importance of the Patent to the Owner's Business**
- 2. Likelihood of Success**
- 3. Risks**
- 4. Cost**
  - **USPTO Fees**
  - **Legal Fees**

### **C. TIMING OF THE REHABILITATION PROCEDURE**

- 1. Initiating the Rehabilitation Procedure Soon After the Apparent Defect or Vulnerability in the Patent Has Come to Light**
  - **But Only if the Current Level of Importance of the Patent to the Owner's Business is Deemed to Warrant It**
  - **Without Regard for the Current Level of Importance of the Patent to the Owner's Business**
- 2. Initiating the Rehabilitation Procedure Only After Some Future Event Has Established or Confirmed the Importance of the Patent to the Owner's Business - the "Wait and See" Attitude**

### III. THREE REHABILITATION PROCEDURES CONDUCTED *EX PARTE* IN THE USPTO – A COMPARISON

#### COMPARISON OF REISSUE, SUPPLEMENTAL EXAMINATION AND *EX PARTE* REEXAMINATION

POINT OF COMPARISON	REISSUE	SUPPLEMENTAL EXAMINATION	<i>EX PARTE</i> REEXAMINATION
Statute	35 U.S.C. §§251, 252	35 U.S.C. §257	35 U.S.C. §§301-307
Rules of Practice	37 C.F.R. 1.171-1.178	37 C.F.R. 1.601-1.625	37 C.F.R. 1.501-1.570
Purpose of Procedure	To correct a patent that through error is wholly or partly inoperative or invalid by reasons of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim.	To consider, reconsider, or correct information believed to be relevant to a patent.	<ol style="list-style-type: none"> <li>1. To consider prior art (inclusive of prior art previously of record) consisting of patents or printed publications that requester believes to have a bearing on the patentability of a particular claim or claims of a particular patent.</li> <li>2. To address each substantial new question of patentability (SNQ) identified in an order for reexamination pursuant to 35 U.S.C. §257(b) where reexamination is initiated by the patent owner's request for supplemental examination.</li> </ol>
Who May File	Original patentee or the patent owner.	Patent owner.	Any person, i.e., the patent owner, a third party or the USPTO Director on his own initiative. <b>Note:</b> only those requests for reexamination filed by the patent owner will be considered herein. Requests for reexamination initiated by a third party or by the Director are beyond the scope of this webinar.

### III. THREE REHABILITATION PROCEDURES CONDUCTED *EX PARTE* IN THE USPTO - A COMPARISON (continued...)

POINT OF COMPARISON	REISSUE	SUPPLEMENTAL EXAMINATION	<i>EX PARTE</i> REEXAMINATION
<p>Defects Curable or Potential Challenges to Validity/Enforceability That May be Addressed and Resolved</p>	<ol style="list-style-type: none"> <li>1. Defective specification (inclusive of the claims) or drawing, e.g., a specification containing a technical error or misdescription of the invention.</li> <li>2. Claim(s) invalid on any prior art and/or formal ground.</li> <li>3. Claim is excessively narrow or altogether fails to cover the invention.</li> <li>4. Failure to bring material prior art to the attention of the PTO.</li> </ol>	<ol style="list-style-type: none"> <li>1. Claim(s) invalid on one or more prior art and/or formal grounds.</li> <li>2. Unenforceability due to patent owner's possibly inequitable conduct, e.g., failure to bring material prior art (prior publication, prior sale, etc.) to the attention of the USPTO or presentation of false or misleading information in a declaration in order to secure grant of a patent.</li> </ol>	<ol style="list-style-type: none"> <li>1. Claim(s) invalid for anticipation and/or obviousness as evidenced by prior patents and printed publications whether or not of record.</li> <li>2. When reexamination is initiated by the patent owner's request for supplemental examination, each SNQ identified in the order for reexamination pursuant to 35 U.S.C. § 257(b).</li> </ol>
<p>Eligible Patents and Period for Filing</p>	<p>Any patent during the period of its enforceability.</p>	<p>Any patent during the period of its enforceability. More than one request may be field during the period of the patent's enforceability.</p>	<p>Any patent during the period of its enforceability.</p>

### III. THREE REHABILITATION PROCEDURES CONDUCTED *EX PARTE* IN THE USPTO - A COMPARISON (continued...)

POINT OF COMPARISON	REISSUE	SUPPLEMENTAL EXAMINATION	<i>EX PARTE</i> REEXAMINATION
Filing Requirements	<p>1. Entire specification, claims and drawings (if any) of the original patent. New matter prohibited.</p> <p>2. Amendment of specification, claims and/or drawings (current practice regarding the making of amendments generally applicable).</p> <p>3. An oath (or declaration) made by the inventor(s) with written consent of patent owner; <i>exceptions</i>: oath/declaration may be made by the patent owner if the application is for other than a broadening reissue or if the application for the original patent was filed by the patent owner.</p> <p>The oath must include the identification of at least one error and the statement that applicant believes the patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent. Identification of the claim(s) applicant seeks to broaden. A claim is a broadened claim if the claim is broadened in <i>any</i> respect.</p> <p>Application for a broadening reissue must be filed within 2 years from the grant of the original patent.</p> <p>4. Filing Fees (other than a small entity):</p> <ul style="list-style-type: none"> <li>- Basic Fee                   \$390</li> <li>- Search Fee                 \$540</li> <li>- Examination Fee         \$760</li> <li>                                      \$1690</li> </ul>	<p>1. Required contents include:</p> <ul style="list-style-type: none"> <li>- list of the items of information (up to 12) and copies thereof;</li> <li>- identification of each claim for which supplemental examination is requested; and,</li> <li>- detailed explanation of relevance of each item of information to each claim for which supplemental examination is requested.</li> </ul> <p>2. Permissible contents include:</p> <ul style="list-style-type: none"> <li>- an explanation of how the claims patentably distinguish over the items of information; and,</li> <li>- an explanation of why each item of information does or does not raise a substantial new question of patentability (SNQ).</li> </ul> <p>3. Fees:</p> <ul style="list-style-type: none"> <li>- Processing Fee           \$5,140</li> <li>- <i>Ex parte</i> Reexamination Fee   \$16,120</li> <li>                                              \$21,260</li> </ul>	<p>1. A statement pointing out each SNQ based on cited prior patents and printed publications.</p> <p>2. Identification of every claim for which reexamination is requested.</p> <p>3. Detailed explanation of the pertinence and manner of applying the cited prior art to every claim for which reexamination is requested.</p> <p>4. The patent owner may point out how claims distinguish over the cited prior art.</p> <p>5. A copy of each cited item of prior art to be accompanied, where applicable, by an English language translation.</p> <p>6. Copy of patent for which reexamination is requested.</p> <p>7. The patent owner may include a proposed amendment. No broadening of the scope of a claim will be permitted.</p> <p>8. Fee - \$17,750</p>

### III. THREE REHABILITATION PROCEDURES CONDUCTED *EX PARTE* IN THE USPTO - A COMPARISON (continued...)

POINT OF COMPARISON	REISSUE	SUPPLEMENTAL EXAMINATION	<i>EX PARTE</i> REEXAMINATION
Conduct of Examination	<ol style="list-style-type: none"> <li>1. Examination is governed by the same statutory provisions and rules applicable to the examination of non-reissue, non-provisional applications.</li> <li>2. Applicant may not recapture subject matter given up during prosecution of the original patent.</li> <li>3. Applicant must inform the USPTO of any prior or concurrent procedures involving the original patent including reissues, reexamination and litigations, and the results thereof.</li> </ol>	<ol style="list-style-type: none"> <li>1. Within 3 months of filing the request, USPTO will determine whether an SNQ is raised by any item of information as to any identified claim(s).</li> <li>2. Patent owner must promptly notify USPTO of any prior or concurrent post-patent USPTO proceeding involving the patent (e.g., reissue, <i>ex parte</i> reexamination).</li> <li>3. Interviews are prohibited.</li> <li>4. No amendment may be filed.</li> </ol>	<ol style="list-style-type: none"> <li>1. Within 3 months of the request, a first examiner will determine whether the request raises at least one SNQ. Where an SNQ is found, the determination will include an order for <i>ex parte</i> reexamination, such examination to be conducted by a second examiner. Where no SNQ has been found, a portion of the fee (\$13,430) will be refunded.</li> <li>2. Within two months of the order for reexamination, the patent owner may file a statement on the SNQ, including any proposed amendment. The statement must clearly point out why the claim is not anticipated or rendered obvious.</li> <li>3. Patent owner has 30 days to respond to any Office Action. In response to a rejection, the patent owner may propose an amendment. No broadening of the scope of a claim will be permitted.</li> <li>4. Interviews with examiners permissible.</li> </ol>

### III. THREE REHABILITATION PROCEDURES CONDUCTED *EX PARTE* IN THE USPTO - A COMPARISON (continued...)

POINT OF COMPARISON	REISSUE	SUPPLEMENTAL EXAMINATION	<i>EX PARTE</i> REEXAMINATION
Conclusion of Procedure	<ol style="list-style-type: none"> <li>1. Original patent surrendered upon grant of the reissue. The reissue is enforceable on the same terms as, and for the unexpired term of, the original patent.</li> <li>2. Intervening rights may be available.</li> </ol>	<ol style="list-style-type: none"> <li>1. Supplemental examination concludes with the issuance of a certificate indicating the result of the determination whether an SNQ is raised.</li> <li>2. If it is determined that an SNQ is raised, <i>ex parte</i> reexamination will be ordered.</li> <li>3. If it is determined that an SNQ is not raised, <i>ex parte</i> reexamination is not ordered and the reexamination fee (\$16,120) is refunded.</li> <li>4. <i>Ex parte</i> reexamination, if ordered, is conducted in accordance with 37 C.F.R. §§1.530-1.570 except that the patent owner may not file a statement in response to the PTO's order for reexamination and may not submit claim amendments or new claims in response to the order. Reexamination may be conducted on the basis of any item of information submitted in the request for supplemental examination and is not limited to patents and printed publications or to subject matter that has been added or deleted during reexamination.</li> <li>5. Immunizes patent owner against future charges that the patent was procured through inequitable conduct.</li> </ol>	<ol style="list-style-type: none"> <li>1. Issuance and publication of the <i>ex parte</i> reexamination certificate concludes the <i>ex parte</i> reexamination proceeding.</li> <li>2. A reexamined patent with amended or new claims has much the same effects as a reissue patent including the possible existence of intervening rights.</li> <li>3. Appeal may be made from an adverse decision to the Patent Trial and Appeal Board (PTAB) and beyond, if desired, to the Federal Circuit.</li> </ol>

## **IV. CORRECTION OF OTHER PATENT DEFECTS**

- A. Disclaimer (35 U.S.C. §253; 37 CFR 1.321)**
- B. Certificate of Correction**
  - ◆ **USPTO Mistake (35 U.S.C. §254; 37 CFR 1.322)**
  - ◆ **Applicant's Mistake (35 U.S.C. §255; 37 CFR 1.323)**
- C. Correction of Named Inventor (35 U.S.C. §256; 37 CFR 1.324)**

## V. CONCLUSION

**Actual and potential defects and vulnerabilities in a U.S. patent can range from the minor and readily correctible (if, indeed, they need to be corrected at all), to the major and validity-threatening. The latter, if not timely and effectively dealt with, may have the capacity for rendering a patent of considerable importance to its owner's business valueless and unenforceable.**

**From our discussion during this webinar, we have seen that depending on the particular facts and circumstances involved, there are a number of options and strategies available to a patent owner who may want to repair a defective patent or enhance the strength of a potentially vulnerable patent in advance of a foreseeable third party validity challenge.**

**—THANK YOU FOR ATTENDING  
THIS WEBINAR —**

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## 五、结论

在美国专利中实际存在的和潜在的缺陷以及漏洞中，有一些是不重要且容易更正的（如果需要更正的话），而有一些是非常重要的，如果不能及时有效地解决这些重要的问题，将会使一些对于公司极有价值的专利变得毫无价值和不可执行。

从我们在本次网络讲座的探讨中，我们可以看到，根据所涉及的具体事实和情况，美国专利局为专利权人提供了一些方案和策略以帮助专利权人在面临第三方有效性挑战的情况下恢复其有缺陷的专利。

—谢谢您参加本次网络讲座—

**Dilworth & Barrese, LLP**