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USPTO Issues Guidance on Options to Amend through Reissue and Reexamination during AIA Trials

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On October 29, 2018, the US Patent & Trademark Office (USPTO or Office) issued a Notice requesting comments on proposed modifications to motion to amend (MTA) practice. The Office received a number of comments and questions concerning the interplay between reexamination and reissue proceedings during a co-pending AIA trial (*inter partes* review (IPR), post grant review (PGR) or covered business method (CBM) review). Today, the USPTO responded to those comments by publishing a Notice discussing the handling of requests to amend claims through reexamination and reissue proceedings during co-pending AIA trials. Notably, the Notice was intended to summarize rather than amend or alter existing practice.

The Office indicated that it will consider a reissue application or a request for reexamination any time before, but not after, either (1) the Office issues a trial certificate cancelling all claims in a patent, or (2) the Federal Circuit issues a mandate concerning a decision finding all claims invalid. The Office will issue trial certificates after either the period for filing a notice of appeal from an AIA trial decision has closed (63 days after (i) a final written decision (FWD) or (ii) a decision on a request for rehearing following a FWD)), or an appeal to the Federal Circuit has been finally resolved.

Additional important takeaways from the Notice include:

-Patent Owners (PO's) may avail themselves of reissue or reexamination before, during, or even *after* an AIA trial has concluded, so long as it is filed before the Office has issued a trial certificate, effectively providing PO's with an additional option to try and amend their claims.

-On motion or on its own, the Office will likely stay examination of a reissue application or reexamination pending a FWD in an AIA trial addressing the same patent. A showing of good cause is required. The Notice provides several factors that may be considered in deciding whether to stay or lift a stay of a co-pending reissue or reexamination proceeding. A motion to lift a stay after FWD will likely be granted if the PO has proposed amendments in that proceeding in a meaningful way not previously considered by Office, e.g., narrower claims than those previously considered in a related AIA trial.

-The one-year bar to filing an IPR/PGR under 35 USC 315(b) after service of a complaint does not apply to a reissued patent, which is considered a new patent. In contrast, the one-year bar does apply to reexamined

patents, which are not considered new patents, even if the reexamination certificate results in amended claims.

-Since reexamination requires raising a substantial new question of patentability (SNQ), a PO cannot raise a question in a ground already decided in a FWD. A SNQ may be based on such grounds, however, *during* an AIA trial. A SNQ cannot be based on denied amended claims in an AIA trial.

-The Office may deny institution of an AIA trial if a parallel Office proceeding is more advanced and involves overlapping issues.

-If a stay of a reissue application is lifted on PO's motion pending Federal Circuit appeal of a FWD, the USPTO will delay issuing any notice of allowance pending resolution of the appeal. But reexamination typically will continue to completion, notwithstanding a Federal Circuit appeal.

Today's USPTO Notice continues Director Iancu's push to provide meaningful mechanisms for permitting PO's to amend claims during AIA trials. Now, in addition to the recently-launched MTA pilot program, which provides PO's up to two opportunities to present amended claims, the Office has confirmed that PO's may file for reissue or reexamination, even after a negative FWD, effectively affording a third opportunity for PO's to amend their claims.